

*Winans v. Schen. & Troy R. R. Co.*, 2 Blatch. 279; *Evans v. Hettick*, 3 Wash. C. C. 408; s. c. 7 Wheat. 453; s. c. 1 Robb 166, 417; *Sewall v. Jones*, 91 U. S. 171; s. c. 9 O. G. 47; s. c. 3 O. G. 630; s. c. 3 Cliff. 563; s. c. 6 Fish. 343.

If the alleged prior machine is abandoned after experimental trials as useless, a presumption will arise that the alleged invention is not identical with one subsequently patented to another person, the merits and utility of which are proved by its general use and admitted superiority over all others. *Wayne v. Holmes*, 2 Fish. 20; s. c. 1 Bond 27; *Suffolk Co. v. Hayden*, 4 Fish. 86; s. c. 3 Wall. 315; *Parham v. Sewing Machine Co.*, 4 Fish. 468; *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530; *Blake v. Eagle Works Manuf. Co.* 4 Fish. 591; s. c. 3 Biss. 77.

In order to entitle a person to a patent, he must be the original inventor, not only in relation to the United States, but to other parts of the world. *Sewall v. Jones*, 91 U. S. 171; s. c. 9 O. G. 47; s. c. 6 Fish. 343; s. c. 3 O. G. 630; s. c. 3 Cliff. 563.

If an inventor takes out a patent in a foreign country and here, and on account of a prior invention makes a disclaimer in the foreign patent which is omitted in the American patent, the American patent must also be limited by such disclaimer. *Ashcroft v. Boston & L. R. R. Co.*, 13 O. G. 865; s. c. 97 U. S. 189; s. c. 1 Holmes 366; s. c. 5 O. G. 725; s. c. 1 Ban & Ard. 215.

A patent can not be obtained for an invention known and practiced in a foreign country. A patentee must be an inventor, not an importer. *Thompson v. Haight*, 1 U. S. L. J. 582.

It is a presumption of law that when a patent has been obtained, and the specifications and drawings recorded in the patent office, every man who subsequently takes out a patent for a similar machine has a knowledge of the preceding patent. *Odiorne v. Winkley*, 2 Gallis. 51; s. c. 1 Robb 52.

A subsequent inventor can not oust the first inventor of his right under his patent, although he may be a subsequent inventor without any knowledge of the prior existence of the machine, or communication with the first inventor. *Woodcock v. Parker*, 1 Gallis. 438; s. c. 1 Robb 37.

If the original inventor chooses not to obtain a patent for his invention, it becomes public property by his abandonment, and no other person can obtain a patent for it. *Evans v. Eaton*, 1 Pet. C. C. 323; s. c. 3 Wheat. 454; s. c. 1 Robb 68, 243; *Colt v. Mass. Arms Co.*, 1 Fish. 108; *Whipple v. Baldwin Manuf. Co.*, 4 Fish. 29.

### **Date of Invention.**

The date of the invention as perfected and reduced to successful use is important, for, by the rules of law, when a dispute arises as to the priority of an invention, a patentee is allowed to show the real date of it. *Parker v. Hulme*, 1 Fish. 44; *Judson v. Cope*, 1 Fish. 615; s. c. 1 Bond 327.

The question of priority is not one of scientific precedence. It is purely a question of invention applied in a practical form to a specific use. *French v. Rogers*, 1 Fish. 133.

The mere speculation of a philosopher or a mechanic, which has never been tried by the test of experience, or put into practical operation, will not deprive a subsequent inventor, who has employed his labor and his talents in putting it into practice, of the reward due to his ingenuity and enterprise. *Bedford v. Hunt*, 1 Mason 302; s. c. 1 Robb 148.

The mere suggestion of the idea of an application of a principle to practical purposes will not defeat the claim of the patentee, if no such application was made before he made it, for the person who first reduces the idea to practical application and use is entitled to a patent. *Silsby v. Foote*, 1 Blatch. 445; s. c. 14 How. 218.

The mere conception of the invention, however perfect the idea may have been, and although the inventor actually described the plan to one person, is not sufficient, unless he completed the invention and reduced it to practice in the form of an operative machine. Original and first inventors are entitled to the benefits of their inventions, if they reduce them to practice and reasonably comply with the requirements of the patent law in procuring letters patent for the protection of their exclusive rights. While the suggested invention, however, rests merely in the mind of the originator of the idea, it is not completed within the meaning of the patent law. Mere discovery of an improvement does not constitute it the subject-matter of a patent, although the ideas which it involves may be new; but the new set of ideas, in order to become patentable, must be embodied into working machinery and adapted to practical use. *White v. Allen*, 2 Fish. 440; s. c. 2 Cliff. 224; *Sickels v. Borden*, 3 Blatch. 535; *Smith v. O'Connor*, 6 Fish. 469; s. c. 2 Saw. 461; 4 O. G. 633; *Poppenhusen v. Gutta Percha Comb Co.*, 2 Fish. 62; *Putnam v. Hickey*, 5 Fish. 334; s. c. 3 Biss. 157; *Ellithorpe v. Robertson*, 2 Fish. 83; s. c. 4 Blatch. 307; *Masury v. Anderson*, 6 Fish. 457; s. c. 11 Blatch. 162; 4 O. G. 55; *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206; *Henry v. Stove Co.*, 9 O. G. 408; s. c. 2 Ban & Ard. 221; *Johnson v. Root*, 2 Fish. 291; s. c. 2 Cliff. 108; *Warner v. Anders*, 11 O. G. 109; *Agawam Co. v. Jordan*, 7 Wall. 583; *Winans v. N. Y. & Harlem R. R. Co.*, 4 Fish. 1; *Wilton v. R. R. Co.*, 2 Whart. Dig. 360; *Webb v. Quintard*, 5 Fish. 276; s. c. 9 Blatch. 352; 1 O. G. 525; *Smith v. Prior*, 2 Saw. 461; s. c. 4 O. G. 623; s. c. 6 Fish. 469.

The time of the invention is neither the date of the patent nor the time when the idea was first conceived by the inventor. It is the time when the idea is not only distinct and complete in the mind of the inventor, but that idea is reduced to practice and embodied in some distinct form. This must necessarily be some time more or less before the date of the patent, and some time more or less after the first conception of the inventor. When the idea first enters into the mind of the inventor it is almost necessarily in a crude and imperfect state. His mind will naturally dwell and reflect upon it. It is not until his reflections, investigations and

experiments have reached such a point of maturity that he not only has a clear and definite idea of the principle and of the mode and manner in which it is to be practically applied to useful purposes, but has reduced his idea to practice, and embraced it in some distinct form, that it can be said he has achieved a new and useful invention. That is the real time of his invention, though it may be months or years before he obtains a patent for it. *Matthews v. Skates*, 1 Fish. 602; *Brodie v. Ophir Mining Co.*, 4 Fish. 137; s. c. 5 Saw. 608.

He is the first inventor in the sense of the statute, and entitled to a patent for his invention, who has first perfected and adapted the same to use, and until the invention is so perfected and adapted to use it is not patentable. An imperfect and incomplete invention resting in mere theory, or in intellectual notion, or in uncertain experiments, and not actually reduced to practice and embodied in some distinct machinery, apparatus, manufacture or composition of matter, is not, and indeed can not be patentable, since it is utterly impossible under such circumstances to comply with the fundamental requisites of the statute. In a race of diligence between two independent inventors he who first reduces his invention to a fixed, positive and practical form would seem to be entitled to a priority of right to a patent therefor. *Reed v. Cutter*, 1 Story 590; s. c. 2 Robb 81; *Kinsman v. Parkhurst*, 1 Blatch. 488; s. c. 18 How. 289; *Silsby v. Foote*, 2 Blatch. 260; s. c. 20 How. 378; *Rich v. Lippincott*, 2 Fish. 1; *White v. Allen*, 2 Fish. 440; s. c. 2 Cliff. 224; *Ellithorpe v. Robertson*, 2 Fish. 83; s. c. 4 Blatch. 307; *Agawam Co. v. Jordan*, 7 Wall. 583; *Whiteley v. Swayne*, 4 Fish. 117; s. c. 7 Wall. 685; *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Hubbell v. U. S.*, 5 Ct. Cl. 1; *Aibright v. Cel. H. T. Co.*, 12 O. G. 227; s. c. 2 Ban & Ard. 629; *Moore v. Thomas*, 3 Ban & Ard. 13.

How invariable is it that after a great invention has been brought before the world, has become known to the public, and been put in a form to be useful, that people start up in various places and declare that they invented the same thing long ago. These pretended prior inventors had thought of such a thing; had perhaps had a conception of such a thing, but had never carried it to the extent of making it of practical utility so that the world could obtain possession of it. But when they find that another has completed that which they had begun they are astonished that they did not see, think they must have seen all that is necessary, and claim that they have invented it. After having seen what has been done the mind is very apt to blend the subsequent information with prior recollections, and confuse them together. Prophecy after the event is easy prophecy. *Howe v. Underwood*, 1 Fish. 160; *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

It is usually the case when any valuable discovery is made, or any new machine of great utility has been invented, that the attention of the public has been turned to that subject previously, and that many persons have been making researches and experiments. Philosophers and mechanicians may have in some measure anticipated in their speculation the

possibility or probability of such discovery or invention; many experiments may have been unsuccessfully tried, coming very near, yet falling short of the desired result. The invention when perfected may truly be said to be the culminating point of many experiments, not only by the inventor, but by many others. He may have profited indirectly by the unsuccessful experiments and failures of others, but that gives them no right to claim a share of the honor or profit of the successful inventor. It is when speculation has been reduced to practice, when experiment has resulted in discovery, and when that discovery has been perfected by patient and continued experiments—when some new compound, art, manufacture, or machine has been thus produced which is useful to the public, that the party making it becomes a public benefactor, and entitled to a patent. *Goodyear v. Day*, 2 Wall. Jr. 283; *Hubbell v. U. S.*, 5 Ct. Cl. 1; *Jones v. Vankirk*, 2 Fish. 586; *Pike v. P. & W. R. R. Co.*, 1 Holmes 445; s. c. 6 O. G. 575; s. c. 1 Ban & Ard. 560; *Roberts v. Reed Torpedo Co.*, 3 Brews. 558; s. c. 3 Fish. 629; *Westinghouse v. G. & R. Brake Co.*, 9 O. G. 538; s. c. 2 Ban & Ard. 55; *Wood v. Cleveland Rolling Mill*, 4 Fish. 550; *Railway Co. v. Sayles*, 97 U. S. 554; s. c. 15 O. G. 243; s. c. 3 Biss. 52; s. c. 4 Fish. 584; *Whittlesey v. Ames*, 18 O. G. 357; s. c. 9 Biss. 225; s. c. 5 Ban & Ard. 96; s. c. 13 Fed. Rep. 893.

The date of the invention is the date of the discovery of the principle involved, and the attempt to embody that in some machine, not the date of the perfecting of the instrument. But the party can not get a patent till he perfects it in some sense of the word, that is, until he goes on and makes improvements to render it practical and useful. *Colt v. Mass. Arms Co.*, 1 Fish. 108; *National Oil Co. v. Arctic Oil Co.*, 4 Fish. 514; s. c. 8 Blatch. 416; *Clark v. Scott*, 15 Fish. 245; s. c. 9 Blatch. 301; 1 O. G. 4; *McWilliams Manuf. Co. v. Blundell*, 11 Fed. Rep. 419; s. c. 22 O. G. 177.

The law means by invention not maturity. It must be the idea struck out, the brilliant thought obtained, the great improvement in embryo. The inventor must have that, but if he has that, he may be years in improving and maturing it. It may require half a life, but in that time he must have devoted himself to it as much as circumstances would allow. But the period when he strikes out the plan which he afterwards patents, that is the time of the invention—that is the time when the discovery occurs. *Adams v. Edwards*, 1 Fish. 1.

In order to determine the precise date of an invention, it must be determined at what time the patentee first perfected the intellectual production, or the idea or conception of the thing patented, so that without more inventive power or further trial or experiment, he could have successfully applied it in practice, and could at once have complied with that provision of the statute which requires that an inventor before he shall receive a patent for the invention or discovery, shall deliver to the patent office a written description of his invention, and explain the principles and several modes in which he has contemplated the application of that

principle or character by which it may be distinguished from other inventions. And in order to determine whether any other person has invented the same thing patented by the patentee prior to the patentee's invention thereof, the same rule must be applied in determining the date of such alleged prior invention. *New York v. Ransom*, 1 Fish. 252; s. c. 23 How. 487; *Stimpson v. Woodman*, 3 Fish. 98; s. c. 10 Wall. 117.

It is only when some person by labor and perseverance has been successful in perfecting some valuable manufacture by ingenious improvements and labor-saving devices, that his patent is sought to be annulled by digging up some useless, rusty, forgotten contrivances of unsuccessful experimenters. *Adams v. Jones*, 1 Fish. 527; *Ex parte Birdsell*, 1 O. G. 465; *Woodward v. Dinsmore*, 4 Fish. 163; *Wood v. Cleveland Rolling Mill*, 4 Fish. 550; *Gottfried v. P. Best B. Co.*, 17 O. G. 675; s. c. 5 Ban & Ard. 4.

The alleged prior invention must have been a practical invention capable of performing the object of the maker. *Case v. Brown*, 2 Fish. 268; s. c. 2 Wall. 320; 1 Biss. 382; *Wayne v. Holmes*, 2 Fish. 20; s. c. 1 Bond 27; *Harwood v. Mill River Co.*, 3 Fish. 526.

### Proof of Invention.

In most cases a sufficient use of the alleged prior invention must be shown to prove that it will accomplish what is claimed, otherwise it rests in the region of mere experiment. *Railway Co. v. Sayles*, 97 U. S. 554; s. c. 15 O. G. 243; s. c. 4 Fish. 584; s. c. 3 Biss. 52.

If the first inventor reduced his theory to practice, and put his machine or other invention into use, the law never would intend that the greater or less use in which it might be, or the more or less widely the knowledge of its existence might circulate, should constitute the criterion by which to decide upon the validity of any subsequent patent for the invention. *Rich v. Lippincott*, 2 Fish. 1.

An experiment may be a trial either of an incomplete mechanical structure, to ascertain what changes or additions may be necessary to make it accomplish the design of its projector, or of a completed machine, to illustrate or test its practical efficiency. Obviously in the first case, the incompleteness of the inventor's efforts, if they are then abandoned, will have no effect upon the rights of a subsequent inventor. But if the experiment proves the capacity of the machine to effect what its inventor proposed, the law assigns to him the merit of having produced a complete invention. *Northwestern Co. v. Philadelphia Co.*, 6 O. G. 34; s. c. 1 Ban & Ard. 177.

The fact of making or exhibiting an article never before seen or heard of by the witnesses who prove the fact is at least *prima facie* evidence of invention, until other evidence is given to prove that the same article was invented, known or in use at an antecedent period of time, and that the patentee had only embodied the conceptions and the discovery of some other person. *Pennock v. Dialogue*, 4 Wash. C. C. 538; s. c. 2 Pet. 1; s. c. 1 Robb 466, 542.

The only question is whether the patentee is the original inventor of an art not known or used before; consequently it is clearly immaterial whether the first experiment of his invention is made by himself or by others. *Pennock v. Dialogue*, 4 Wash. C. C. 538; s. c. 2 Pet. 1; s. c. 1 Robb 466, 542.

The alleged prior machine must be a machine completed and reduced to practice, in contradistinction to an experimental machine, or a machine made by the supposed inventor in the prosecution of experiments and inquiries. *Cahoon v. Ring*, 1 Fish. 397; s. c. 1 Cliff. 592; *Cox v. Griggs*, 2 Fish. 174; s. c. 1 Biss. 362; *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Murphy v. Eastham*, 5 Fish. 306; s. c. 1 Holmes 113; 2 O. G. 61; *Stimpson v. Woodman*, 3 Fish. 98; s. c. 10 Wall. 117; *Eickemeyer Machine Co. v. Pearce*, 6 Fish. 219; s. c. 10 Blatch. 403; 3 O. G. 150; *Allis v. Buckstaff*, 22 O. G. 1705; s. c. 13 Fed. Rep. 879.

The phrase "reduced to practice" does not import the bringing of the invention into use. When applied to an invention it generally means the reduction of it into such form that it may be used so as not to be a mere theory. *Heath v. Hildreth*, Cranch Pat. Dec. 96; *Perry v. Cornell*, Cranch Pat. Dec. 132.

In order to defeat a patent it is sufficient to show that the patentee was not the first and original inventor, without proving that the first inventor had put his invention into practice. *Hildreth v. Heath*, Cranch Pat. Dec. 96.

If a party discovers the practical mode and contrives the practical means of accomplishing a result he is entitled to a patent for his invention although ignorant of the philosophical or abstract principle which is involved in it. *Brown v. Piper*, 4 Fish. 175; s. c. 1 Holmes 20; 91 U. S. 37; s. c. 10 O. G. 417; *Woodward v. Dinsmore*, 4 Fish. 163.

If a patent is for a process it is not sufficient to show that any prior apparatus could have been used to practice the process. It must appear affirmatively that it actually was put to such practical use. *Brown v. Piper*, 4 Fish. 175; s. c. 1 Holmes 20; 91 U. S. 37; s. c. 10 O. G. 417.

The putting of an invention into use is generally strong evidence of a reduction of it to practice. But it may be a completed invention put into a practical form ready for practical use, and reduced to practice without being put into use in the general acceptance of that word. If the adaptation to use, or even the use itself, is merely experimental, the invention is not perfected. But use is not necessarily required in order to show perfection or completion. In respect to most inventions, use not merely experimental is one of the best proofs of the reduction of an invention to practice. But a piece of mechanism may be shown to have been completed and not to have rested in experiment, and to have been capable from its structure of working successfully so as to deprive a subsequent independent invention of the same thing of the merit of novelty in the patent law, without its being shown that such piece of mechanism was actually used before the making of such subsequent invention. *Coffin v. Ogden*, 3 Fish. 640; s. c. 7 Blatch. 61.

If a prior inventor makes a machine and applies it to actual use this is a complete invention, although he did not take a patent for it. *Stephenson v. Brooklyn C. T. R. Co.*, 19 Blatch. 473; s. c. 14 Fed. Rep. 457.

It is not sufficient that some part incorporated into an invention was perfected so that it did not require further alteration, unless that part could be a machine so as to be of some practical utility. It must have been embodied and connected with a machine, which as a whole, taking that part, was of some practical utility, in order to prevent other people coming afterward from having the benefit of an invention which embraces that, and perfects a machine that renders that part useful. *Johnson v. Root*, 1 Fish. 351.

In order to be perfected in the eye of the law it is not necessary that the invention shall be carried to a point where there can not be any subsequent improvement, that it shall be made as good as it can possibly be made as a practical machine, but that the invention shall be completed so as to be of some practical utility. It need not be of any high degree; if it is of any practical utility, although of a very low degree, and has been completed so as to be of practical utility and considered as completed, then it may be said to be perfected in the eye of the law. *Johnson v. Root*, 1 Fish. 351.

To constitute a prior invention the party alleged to have made it must have proceeded so far as to have entitled himself to a patent in case he had made an application. *Allen v. Hunter*, 6 McLean 303.

If a person understood his invention and applied it successfully in one or two instances, this is a sufficient reduction to practice to defeat the claim of a subsequent inventor. *Miller v. Force*, 21 O. G. 947; s. c. 9 Fed. Rep. 603.

An invention relating to machinery may be exhibited either in a drawing or in a model, so as to lay the foundation of a claim to priority, if it is sufficiently plain to enable those skilled in the art to understand it. *Loom Co. v. Higgins*, 105 U. S. 580; s. c. 21 O. G. 2031; s. c. 16 O. G. 675; s. c. 15 Blatch. 446; s. c. 4 Ban & Ard. 88.

The making of drawings of conceived ideas is not such an embodiment of conceived ideas into practical and useful form as will defeat a patent which has been granted. *Ellithorpe v. Robertson*, 2 Fish. 83; s. c. 4 Blatch. 307.

When the inventor's idea is perfected by a practical adaptation of it in the form of mechanism, a rejected specification, with the drawings, is a valuable guide in ascertaining the date of the invention, the design of the inventor, and the principle, intended functions, and mode of operation of his mechanism, and must therefore, necessarily, be considered in connection with it. *Northwestern Co. v. Philadelphia Co.*, 6 O. G. 34; s. c. 1 Ban & Ard. 177.

Although a *caveat* is understood to be filed in order to allow the party to perfect his machine, yet if, in point of fact, the invention had been perfected in the eye of the law, then it is to be deemed 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 invention will not date from the filing of the *caveat* unless the *caveat* and the patent are for the same invention. *American Pavement Co. v. Elizabeth*, 4 Fish. 189.

If only a model was made, yet unless a machine capable of being used was made prior to the invention set forth in the patent, then such alleged prior invention never was completed, and can not affect the validity of the patent, although the model was capable of operation for the purpose of experiments. *Cahoon v. Ring*, 1 Fish. 397 ; s. c. 1 Cliff. 592 ; *Stainthorp v. Humiston*, 4 Fish. 107 ; *Lyman V. & R. Co. v. Lalor*, 12 Blatch. 303 ; s. c. 6 O. G. 642 ; s. c. 1 Ban & Ard. 403 ; *Stillwell & B. Manuf. Co. v. Cincinnati Gas Co.*, 7 O. G. 829 ; s. c. 1 Ban & Ard. 610.

Witnesses who speak of circumstances occurring many years ago are liable to mistake the particular year, unless they have some evidence of a documentary character or otherwise, or some leading fact in relation to which there can be no error upon which they may rely to show the particular time, and this fact should be borne in mind in weighing their testimony. *Sayles v. Railroad Co.*, 2 Fish. 523 ; s. c. 1 Biss. 468 ; *Smith v. Fay*, 6 Fish. 446 ; *Parker v. Hulme*, 1 Fish. 44 ; *Blake v. Eagle Works Manuf. Co.*, 4 Fish. 591 ; s. c. 3 Biss. 77 ; *Wing v. Richardson*, 2 Fish. 535 ; s. c. 2 Cliff. 449 ; *Hawes v. Antidel*, 8 O. G. 685 ; s. c. 2 Ban & Ard. 10 ; *Ely v. Monson Manuf. Co.*, 4 Fish. 64 ; *Baldwin v. Schultz*, 5 Fish. 75 ; s. c. 9 Blatch. 494 ; 2 O. G. 315 ; *Suffolk Co. v. Hayden*, 4 Fish. 86 ; s. c. 3 Wall. 315 ; *Wood v. Cleveland Rolling Mill*, 4 Fish. 550 ; *Thatcher Heating Co. v. Carbon Stove Co.*, 10 O. G. 1051 ; s. c. 4 Ban & Ard. 68 ; *Zane v. Peck*, 9 Fed. Rep. 101 ; *Eastman v. Hinckel*, 5 Ban & Ard. 1.

### **Abandoned Experiments.**

Cases undoubtedly occur where an individual employed in inventing or in making experiments in that behalf, feeling dissatisfied with the results of his efforts, becomes discouraged in prosecuting an investigation, and finally loses all confidence in the prospect of his ultimate success, and under the influence of such discouragements, or from a desire to engage in more profitable business, or to pursue a more pressing or favorite undertaking, decides to break up what he has accomplished, and lays the parts aside, not positively intending to abandon the subject, yet wholly uncertain whether he will ever resume it, or make any further use of the parts so laid aside. Such cases do not show an unconditional abandonment of the undertaking, but an indefinite suspension of the same, and an entire uncertainty during such suspension whether the interested party will ever furnish the invention to the public. Where an invention is thus voluntarily broken up and laid aside, without any controlling impediment in the way of an application for a patent, and under all the other conditions specified in the preceding proposition, and another in the mean time invents the same thing without any knowledge of that which is so sus-



pended, and reduces the same to practice, applies for and takes out his patent and introduces the patented invention into public use, he must be regarded as the original and first inventor of the improvement. *White v. Allen*, 2 Fish. 440; s. c. 2 Cliff. 224.

It is not enough to defeat a patent already issued that another conceived the possibility of effecting what the patentee accomplished. To constitute a prior invention, the party alleged to have produced it must have proceeded so far as to have reduced his idea to practice, and embodied it in some distinct form. Crude and imperfect experiments, equivocal in their results, and then given up for years, can not be permitted to prevail against an original inventor who has perfected his improvement and obtained his patent. *Kinsman v. Parkhurst*, 1 Blatch. 488; s. c. 18 How. 289; *Teese v. Phelps*, 1 McAl. 48; *Allen v. Hunter*, 6 McLean 303; *Webb v. Quintard*, 5 Fish. 276; s. c. 9 Blatch. 352; 1 O. G. 525; *Union Sugar Refinery v. Matthiesson*, 2 Fish. 600; s. c. 3 Cliff. 639; *Whiteley v. Swayne*, 4 Fish. 117; s. c. 7 Wall. 685; *Potter v. Wilson*, 2 Fish. 102; *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206; *Gottfried v. P. Best B. Co.*, 17 O. G. 675; s. c. 5 Ban & Ard. 4.

An unsuccessful experiment abandoned, although involving the same idea or principle, will not invalidate a patent granted to a subsequent inventor who has reduced the invention to successful practice, and published it by obtaining letters patent. If a person has some vague idea of the application of the principle which another party has made available, if he makes numerous trials and long-continued experiments, if those trials and experiments never result in such a knowledge upon his part as will enable him to put in successful practice the idea of which he has this vague and undefined notion, he has never become an inventor in the sense of the patent law; he has never embodied the principle so as to make it available for practical use, and the party who embodies the principle and makes it available for practical use is the party who is entitled to a patent and to protection under the patent law. *United Nickel Co. v. Authes*, 5 Fish. 517; s. c. 1 Holmes 135; 1 O. G. 578; *Blake v. Rawson*, 6 Fish. 74; s. c. 1 Holmes 200; 3 O. G. 122; *New York v. Ransom*, 1 Fish. 252; s. c. 23 How. 487; *Stainthorp v. Elkinton*, 1 Fish. 349; *Taylor v. Wood*, 12 Blatch. 110; s. c. 8 O. G. 90; s. c. 1 Ban & Ard. 270; *Singer v. Walmsley*, 1 Fish. 558; *Wayne v. Holmes*, 2 Fish. 20; s. c. 1 Bond 27; *Hubbell v. U. S.*, 5 Ct. Cl. 1; *Sickles v. Borden*, 3 Blatch. 535; *Smith v. Allen*, 2 Fish. 572; *Roberts v. Dickey*, 4 Fish. 532; s. c. 3 Brews. 260; 1 O. G. 4; *Many v. Jagger*, 1 Blatch. 372; *Seymour v. McCormick*, 19 How. 96; s. c. 3 Blatch. 209; *Sayles v. Railroad Co.*, 2 Fish. 523; s. c. 1 Biss. 468; *Whiteley v. Swayne*, 7 Wall. 685; s. c. 4 Fish. 117; *Smith v. G. F. Co.*, 1 Holmes 340; s. c. 5 O. G. 429; *Smith v. G. D. V. Co.*, 93 U. S. 487; s. c. 1 Holmes 354; 5 O. G. 585; 11 O. G. 246; 4 A. L. T. (N. S.) 74; s. c. 1 Ban & Ard. 201; *La Baw v. Hawkins*, 6 O. G. 724; s. c. 1 Ban & Ard. 428; *Many v. Sizer*, 1 Fish. 17; *Gold & Silver Ore v. U. S. Ore Co.*, 3 Fish. 409; s. c. 6 Blatch. 307; *Smith v. Fay*, 6 Fish. 446; *Aultman v. Holley*, 6 Fish. 534; s. c. 11 Blatch. 317; 5 O. G. 3;

*Ex parte* Boardman, 1 O. G. 304; *Latta v. Shawk*, 1 Fish. 465; s. c. 1 Bond 259; *Winans v. N. Y. & Harlem R. R. Co.*, 4 Fish. 1; *Reeves v. Keystone Bridge Co.*, 5 Fish. 456; s. c. 9 Phila. 368; 1 O. G. 466; 5 A. L. T. 150; *Hitchcock v. Tremaine*, 9 Blatch. 550; s. c. 1 O. G. 633; s. c. 5 Fish. 537; *Matthews v. Skates*, 1 Fish. 602; *Suffolk Co. v. Hayden*, 4 Fish. 86; s. c. 3 Wall. 315; *Doughty v. Day*, 5 Fish. 224; s. c. 9 Blatch. 262; *Gallahue v. Butterfield*, 6 Fish. 203; s. c. 10 Blatch. 232; 2 O. G. 645; *Decker v. Grote*, 6 Fish. 143; s. c. 10 Blatch. 331; 3 O. G. 65; *Ellithorpe v. Robertson*, 2 Fish. 83; s. c. 4 Blatch. 307; *Stainthorp v. Humiston*, 4 Fish. 107; *Nat'l Spring Co. v. Union Car Spring Manuf. Co.*, 12 Blatch. 80; s. c. 6 O. G. 224; s. c. 1 Ban & Ard. 240; *Robertson v. Secombe Co.*, 6 Fish. 268; s. c. 10 Blatch. 481; 3 O. G. 412; *Waterman v. Thomson*, 2 Fish. 461; *Hoffman v. Aronson*, 4 Fish. 456; s. c. 8 Blatch. 324; 4 A. L. T. (N. S.) 110; *Singer v. Braunsdorf*, 7 Blatch. 521; *Ball v. Murry*, 10 Penn. 111; *Wilcox v. Comp*, 7 Blatch. 126; *Albright v. Celluloid H. T. Co.*, 12 O. G. 227; s. c. 2 Ban & Ard. 629; *Marsh v. Seymour*, 97 U. S. 348; s. c. 13 O. G. 723; s. c. 2 O. G. 675; s. c. 6 Fish. 115; s. c. 9 Phila. 380; *Am. Whip Co. v. Lombard*, 14 O. G. 900; s. c. 4 Cliff. 495; s. c. 3 Ban & Ard. 598; *Whittlesey v. Ames*, 18 O. G. 357; s. c. 9 Biss. 225; s. c. 5 Ban & Ard. 96; s. c. 13 Fed. Rep. 893; *Wilson v. Coon*, 19 O. G. 482; s. c. 18 Blatch. 532; s. c. 6 Fed. Rep. 611; *Putnam v. Hollender*, 19 O. G. 1423; s. c. 19 Blatch. 48; s. c. 6 Fed. Rep. 882; *Davis v. Brown*, 20 O. G. 1021; s. c. 19 Blatch. 263; s. c. 9 Fed. Rep. 347; *Zane v. Peck*, 9 Fed. Rep. 101; *Spring v. Domestic S. M. Co.*, 21 O. G. 633; s. c. 9 Fed. Rep. 505; *Woven Wire Mattress Co. v. Whittlesey*, 8 Biss. 23; *Chalmers S. P. N. Co. v. Cramp*, 5 Ban & Ard. 66; *Miller v. Pickering*, 16 Fed. Rep. 540; s. c. 40 Leg. Int. 182; s. c. 25 O. G. 89.

A machine, in order to anticipate any subsequent discovery, must be perfected, that is, made so as to be of practical utility, and not to be merely experimental, and to end in experiment. The terms "being an experiment" and "ending in experiment" are used in contradistinction to the term "being of practical utility." Until of practical utility, the public attention is not called to the invention. It does not give to the public that which the public lays hold of as beneficial. If it is an experiment only, and ends in experiment, and is laid aside as unsuccessful, however far it may have been advanced, however many ideas may have been combined in it which subsequently taken up might, when perfected, make a good machine, still not being perfected, it has not come before the public as a useful thing, and is therefore entirely inoperative as affecting the rights of those coming afterwards. *Howe v. Underwood*, 1 Fish. 160.

An imperfect embodiment of the idea will not deprive a subsequent inventor of his right to a patent. *Richardson v. Noyes*, 10 O. G. 507; s. c. 2 Ban & Ard. 398.

If the alleged prior machine was merely made for the purpose of experiment, and not practically tested, it will not be regarded as a perfected invention. The mere knowledge by an individual of a prior mechanical structure similar to the one patented which has not been

used practically, will not defeat the novelty of the later patent. *Swift v. Whisen*, 3 Fish. 343; s. c. 2 Bond 115.

If it appears that the alleged prior invention or discovery was only an experiment, and was never perfected or brought into actual use, but was abandoned and never revived by the alleged inventor, the mere fact of having unsuccessfully applied for a patent therefor can not take the case out of the category of unsuccessful experiments. *Brown v. Guild*, 23 Wall. 181; s. c. 6 O. G. 392; 7 O. G. 739; *Union P. B. M. Co. v. P. & W. Co.*, 15 O. G. 423; s. c. 15 Blatch. 160; s. c. 3 Ban & Ard. 403.

The devices contained in an abandoned experiment can not be used to defeat the patent of an independent and successful inventor. *Aultman v. Holley*, 6 Fish. 534; s. c. 11 Blatch. 317; 5 O. G. 3.

If a process is practiced once as an experiment, and then abandoned, this mere experiment will not be an obstacle to the right of a subsequent inventor. *Brown v. Piper*, 4 Fish. 175; s. c. 1 Holmes 20; 91 U. S. 37; s. c. 10 O. G. 417.

The fact that the alleged prior machine was not actually put into practical use affords grounds for presuming that it was a mere experiment. *Cahoon v. Ring*, 1 Fish. 397; s. c. 1 Cliff. 592.

The desertion of an invention consisting of a machine never patented may be proved by showing that the inventor, after he had constructed it, and before he had reduced it to practice, broke it up as something requiring more thought and experiment, and laid the parts aside as incomplete, provided it appears that those acts were done without any definite intention of resuming his experiments and of restoring the machine. *Seymour v. Osborne*, 11 Wall. 516; s. c. 3 Fish. 555.

If the inventor produced a complete invention, but was repulsed by the patent office, and abandoned further efforts to secure the full benefit of the invention to himself and the public, such abandonment does not reduce his matured invention to the grade of a mere experiment. *Northwestern Co. v. Philadelphia Co.*, 6 O. G. 34; s. c. 1 Ban & Ard. 177.

If the disuse of a machine for a time was due to circumstances connected with the demand and supply of the product and independent of the efficiency of the mechanism, it can not be deemed an abandoned experiment. *Snow v. Tapley*, 13 O. G. 548; s. c. 3 Ban & Ard. 228.

### **Use of Invention.**

If the prior machine is perfect and capable of use, it is not necessary that it should be actually used, but it must have been capable of such use. *Parker v. Ferguson*, 1 Blatch. 407; *Pitts v. Wemple*, 2 Fish. 10; s. c. 1 Biss. 87.

It is not necessary that the prior inventor shall have worked the process with the same degree of skill and success as the patentee attains. It is sufficient if he did it with a degree of success which demonstrated its usefulness. *Waterman v. Thomson*, 2 Fish. 461; *Pitts v. Wemple*, 2 Fish. 10; s. c. 1 Biss. 87.

The mere fact that the prior inventor ceased to use his machine, because he had no occasion to do so, is of itself of no importance. *Waterman v. Thomson*, 2 Fish. 461.

If the invention was successful, and no change of mechanism was needed, its use may be altogether discontinued; but this will not give a subsequent inventor the right to take it up and appropriate it exclusively. *Shoup v. Henrici*, 9 O. G. 1162; s. c. 2 Ban & Ard. 249.

### **Diligence in Perfecting Invention.**

He who invents first has the prior right if he uses reasonable diligence in adapting and perfecting his invention. *White v. Allen*, 2 Fish. 440; s. c. 2 Cliff. 224; *Reed v. Cutter*, 1 Story 590; s. c. 2 Robb 81; *Singer v. Walmsley*, 1 Fish. 558; *Kneeland v. Sheriff*, 18 O. G. 242; s. c. 5 Ban & Ard. 482; s. c. 2 Fed. Rep. 901; *Electric R. S. Co. v. Hall R. S. Co.*, 6 Fed. Rep. 603.

It is the right and privilege of a party, when an idea enters his mind in the essential form of invention, to perfect by experiment and reasonable diligence his original idea, so as not to be deprived of the fruit of his skill and labor by a prior patent, if he is the first inventor; but there must be a reasonable diligence looking to all the facts of the case. *Cox v. Griggs*, 2 Fish. 174; s. c. 1 Biss. 362; *Winans v. Schen. & Troy R. R. Co.*, 2 Blatch. 279; *Whitney v. Emmett*, Bald. 303; s. c. 1 Robb 567; *National Oil Co. v. Arctic Oil Co.*, 4 Fish. 514; s. c. 8 Blatch. 416.

If two inventors conceive the invention at about the same time, the one who first reduces it to practice is the first inventor. *Seibert C. O. C. Co. v. Phillips L. Co.*, 10 Fed. Rep. 677.

If two parties are jointly experimenting and equally meritorious, a doubt should be solved in favor of him who first obtains a patent. *Cox v. Griggs*, 2 Fish. 174; s. c. 1 Biss. 362.

The relation borne to the public by inventors, and the obligations they are bound to fulfil in order to secure for the former protection and the right to remuneration, by no means forbid a delay requisite for completing an invention, or for a test of its value or success by a series of sufficient and practical experiments; nor do they forbid a discreet and reasonable forbearance to proclaim the theory or operation of a discovery during its progress to completion and preceding an application for protection in that discovery. *Kendall v. Winsor*, 21 How. 322.

No delay in taking out a patent is fatal to the earliest or first inventor, unless he abandons his discovery to the public, or by his consent allows it to be put in public use or on sale for two years before taking out a patent. If there has been no such abandonment or public use, the earliest invention will prevail over a succeeding one, though the latter may be made and used before letters patent are taken out for the first. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530; *Hildreth v. Heath*, Cranch Pat. Dec. 96.

If the patentee was induced to believe that his invention had been

anticipated, and decided to keep it a secret and practice it for his own benefit, but applied for a patent as soon as he discovered his mistake, he did use reasonable diligence. *Ayling v. Hull*, 2 Cliff. 494.

If the inventor, after he has perfected his invention, unreasonably delays his application for a patent, and other persons before such application is made actually perfect and apply the same invention to practical use, and give the knowledge thereof to the public, and the first inventor, after the knowledge of such subsequent invention or discovery, and its public use, fails to make objection and to apply without unreasonable delay for a patent for his invention, he can not sustain his patent, because he failed to give to the public that consideration for the grant of exclusive privileges upon which all valid patents must be based. *New York v. Ransom*, 23 How. 487; s. c. 1 Fish. 252.

If an inventor has not used reasonable diligence in perfecting and adapting his invention, he will not be protected against a subsequent inventor, although he had previously conceived the idea of the invention, and sketched it on paper. *Reeves v. Keystone Bridge Co.*, 5 Fish. 456; s. c. 9 Phila. 368; 1 O. G. 466; 5 A. L. T. 150; *Carlton v. Atwood*, 2 A. L. T. R. 129; *Kirby v. Johnson*, 1 O. G. 405; *Gates v. Benson*, 3 A. L. T. (U. S.) 113; *Agawam Co. v. Jordan*, 7 Wall. 583; *Electric R. S. Co. v. Hall R. S. Co.*, 6 Fed. Rep. 603; *Detroit L. Manuf. Co. v. Renchard*, 9 Fed. Rep. 293.

If the inventor used reasonable diligence in perfecting and adapting his invention he may show the inceptive invention by sketches and drawings, and the protection of the patent will be carried back to that date. *Draper v. Potomska Mills Corporation*, 13 O. G. 276; s. c. 3 Ban & Ard. 214.

### **Effect of Concealment.**

If the first inventor makes the discovery in his closet, and confines the knowledge to himself, such knowledge will not invalidate a subsequent patent to another. *Whitney v. Emmett*, Bald. 303; s. c. 1 Robb 567; *Rowley v. Mason*, 2 A. L. T. (U. S.) 106; *Judson v. Bradford*, 16 O. G. 171; s. c. 3 Ban & Ard. 539.

It would be strange, indeed, if, because the first inventor would not permit other persons to know his invention, or to use it, he should thereby be deprived of his right to obtain a patent, and it should devolve upon a subsequent inventor, merely from his ignorance of any prior invention or prior use, or that a subsequent inventor should be entitled to a patent, notwithstanding a prior knowledge or use of the invention by one person, and yet should be deprived of it by a like knowledge or use of it by two persons. *Reed v. Cutter*, 1 Story 590; s. c. 2 Robb 81.

If the alleged first inventor did not make his discovery public, but used it simply for his own private purpose, and it was finally forgotten or abandoned, such discovery and use will not defeat the rights of a subsequent inventor, if he is an original, though not the first inventor. *Gayler v. Wilder*, 10 How. 477; *Hall v. Bird*, 3 Fish. 595; s. c. 6 Blatch. 438; *Bullock P. P. Co. v. Jones*, 13 O. G. 124; s. c. 3 Ban & Ard. 195.

If only a single specimen of the alleged prior machine was made, whether capable of use, and whether actually used or not by the party making it for the purpose of testing its operation; it will not invalidate a patent by a subsequent inventor, if it was kept in the possession of the maker from the knowledge of the public, and subsequently broken up, and the essential parts of it did not exist at the time of the subsequent invention, so that the public could derive the knowledge of it from the machine itself, but merely from the memory of the maker. *Cahoon v. Ring*, 1 Fish. 397; s. c. 1 Cliff. 592; *Sayles v. Railroad Company*, 2 Fish. 523; s. c. 1 Biss. 468; *Stainthorp v. Humiston*, 4 Fish. 107; *Piper v. Brown*, 4 Fish. 175.

An inventor who withholds his invention from the public designedly, and with the view of applying it indefinitely and exclusively for his own profit, does not come within the objects or policy of the Constitution or acts of Congress. He does not promote, and if aided in his design would impede, the progress of science and the useful arts. Hence if, during such a concealment, an invention similar to or identical with his own, should be made and patented, or brought into use without a patent, the latter could not be inhibited or restricted, upon proof of its identity with a machine previously invented and withheld or concealed by the inventor from the public. *Kendall v. Winsor*, 21 How. 322.

If there has been, at any time, and under any circumstances, an accidental discovery similar in character to that which the patentee has patented, but the public obtained no knowledge of the invention, then the invention was not produced by the party who made such discovery. In other words, if the party did not comprehend the invention, he added nothing to his own stock of knowledge, and the fact, if observed by other men, added nothing to the knowledge of science upon that subject. Therefore, the invention was not made until the party contriving, or others observing, the invention, saw that it could be made available for the purpose of producing a result similar to the one which the patentee mentions in his specification. *New York v. Ransom*, 23 How. 487; s. c. 1 Fish. 252.

It is well known that centuries ago discoveries were made in certain arts, the fruits of which have come down, but the means by which the work was accomplished are at this day unknown; the knowledge has been lost for ages; yet, if any one now were to discover an art thus lost, and it were a useful improvement, he would be entitled to a patent. Yet he would not literally be the first and original inventor, but he would be the first to confer on the public the benefit of the invention. He would discover what is unknown, and communicate knowledge which the public had not the means of obtaining without his invention. *Gayler v. Wilder*, 10 How. 477.

### Utility.

An invention is not useful which will not enable the operator to accomplish the desired result. *Mitchell v. Tilghman*, 4 Fish. 599; s. c. 19 Wall. 287; 5 O. G. 299; s. c. 9 Blatch. 1; s. c. 2 Fish. 518; *Hubbell v. U. S.*, 5 Ct. Cl. 1; *Royer v. Russell*, 20 O. G. 1819; s. c. 9 Fed. Rep. 696.

It is not sufficient that the invention is useful for some purpose. If it is impracticable to be used for the purpose for which it was patented, the patent is void. *Rowe v. Blanchard*, 18 Wis. 441.

If no person can make use of the invention advantageously, the patent is void. *Dickinson v. Hall*, 31 Mass. 217; *Ross v. Wolfinger*, 5 O. G. 117; *Bliss v. Brooklyn*, 6 Fish. 289; s. c. 10 Blatch. 521; 3 O. G. 269.

The law does not look to the degree of utility. It simply requires that the invention shall be capable of use, and that the use be such as sound morals and policy do not discountenance. *Bedford v. Hunt*, 1 Mason 302; s. c. 1 Robb 148; *Dunbar v. Marden*, 13 N. H. 311.

The invention must be useful to an appreciable extent, although the measure of that usefulness is not material. Any degree of utility appreciable by a jury is sufficient. *Conover v. Roach*, 4 Fish. 12.

The court will not be very rigid as to the degree of utility. It will not inquire into the precise *quantum* of value, but if the invention is useful in any degree, and not absolutely worthless, the patent will be sustained. *Vance v. Campbell*, 1 Fish. 483; s. c. 1 Black 427; *Tilghman v. Werk*, 2 Fish. 229; s. c. 1 Bond 511; *Ex parte Geo. Richardson*, 2 O. G. 3.

The question is not whether the invention is useful beyond all other machines in use for effecting the object for which it was designed, but whether it is capable in some degree of beneficial use, or will in some degree subserve the purpose of its design, or whether, on the contrary, it is merely mischievous and injurious, or pernicious, or frivolous and worthless. *Dunbar v. Marden*, 13 N. H. 311; *Crouch v. Speer*, 6 O. G. 187; s. c. 1 Ban & Ard. 145.

If the invention is useful, it is not necessary that the thing patented should be the best possible thing of the kind that could be made. *Winans v. Schen. & Troy R. R. Co.*, 2 Blatch. 279; *Wilbur v. Beecher*, 2 Blatch. 132; *Crompton v. Belknap Mills*, 3 Fish. 536.

The law does not require the patentee to prove his discovery to be useful to an eminent or large degree. It is sufficient if it produces an improved article at less cost or with more expedition than other known methods. *Carr v. Rice*, 1 Fish. 198.

The question is not whether the patented machine does its work better or faster than any other machine in the same department of labor. If it is to a certain degree useful and is original with the patentee, it belongs to him alone, whether it does less or more work. *Wilbur v. Beecher*, 2 Blatch. 132.

To what extent an invention must be useful to render it the subject of a patent, will depend on the particular circumstances of each case, and for which no general rule can be given, but it must, in some small measure at least, be beneficial to the community. This utility is to be tested not merely by the benefits which the patentee may obtain, but by the advantages which the public are to derive from it. *Langdon v. De Groot*, 1 Paine 203; s. c. 1 Robb 423.

It is not necessary that the invention should be of general utility. The word useful is incorporated into the statute in contradistinction to mis-

chievous or immoral. For instance, a new invention to poison people or to promote debauchery, or to facilitate private assassination, is not a patentable invention. But if the invention steers wide of these objections, whether it be more or less useful is a circumstance very material to the patentee but of no importance to the public. All that the law requires is that the invention shall not be frivolous or injurious to the well-being, good policy, or sound morals of society. *Lowell v. Lewis*, 1 Mason 182; s. c. 1 Robb 131; *Page v. Ferry*, 1 Fish. 298; *Cox v. Griggs*, 2 Fish. 174; s. c. 1 Biss. 362; *Wintermute v. Reddington*, 1 Fish. 239; *Adams v. Edwards*, 1 Fish. 1; *Smith v. O'Connor*, 6 Fish. 469; s. c. 2 Saw. 461; 4 O. G. 633; *Doherty v. Haines*, 6 O. G. 118; s. c. 4 Cliff. 291; s. c. 1 Ban & Ard. 289; *Wilson v. Janes*, 3 Blatch. 227; *Kneass v. Schuylkill Bank*, 4 Wash. C. C. 9; s. c. 1 Robb 303; *Whitney v. Emmett*, Bald. 303; s. c. 1 Robb 567; *Adams v. Loft*, 4 Ban & Ard. 495.

An invention which is neither frivolous nor mischievous, if it be of any use, is embraced within the spirit of the law, whether it be more or less useful. *Page v. Ferry*, 1 Fish. 298; *Cook v. Ernest*, 5 Fish. 396; s. c. 1 Woods 195; 2 O. G. 89; *Many v. Sizer*, 1 Fish. 17; *Westlake v. Cartter*, 6 Fish. 519; s. c. 4 O. G. 636; *Clark Patent Co. v. Copeland*, 2 Fish. 221; *Converse v. Cannon*, 2 Woods 7; s. c. 9 O. G. 105; *Wayne v. Holmes*, 2 Fish. 20; s. c. 1 Bond 27; *Winans v. Schen. & Troy R. R. Co.*, 2 Blatch. 279; *Bedford v. Hunt*, 1 Mason 302; s. c. 1 Robb 148; *Hoffheins v. Brandt*, 3 Fish. 218; *Wilson v. Hentges*, 26 Minn. 288.

The beauty of an ornament is one great test of its utility. *Magic Ruffle Co. v. Douglass*, 2 Fish. 330.

The jury are not to conclude that there is no utility in an improvement from its apparent simplicity, nor from the fact that it may not be the best mode of effecting the result. This last consideration would affect the value of the patent, but not its validity. *Bell v. Daniels*, 1 Fish. 372; s. c. 1 Bond 212.

In the absence of proof that the thing patented is absolutely frivolous and worthless, the presumption of utility raised by the patent itself would be sufficient, so far as the question of utility is concerned, to sustain the patent. *Parker v. Stiles*, 5 McLean 44; *Lee v. Blandy*, 2 Fish. 89; s. c. 1 Bond 361; *Hays v. Sulsor*, 1 Fish. 532; s. c. 1 Bond 279; *Vance v. Campbell*, 1 Fish. 483; s. c. 1 Black 427; *Tilghman v. Werk*, 2 Fish. 229; s. c. 1 Bond 511; *Mowry v. Whitney*, 3 Fish. 157; s. c. 14 Wall. 620; 1 O. G. 492.

In ascertaining the usefulness of an invention it is not important that it should be more valuable than other modes of accomplishing the same result, but it must be a practical method of doing the thing designed, in which its utility will more or less consist. *Roberts v. Ward*, 4 McLean 565; *Winans v. Schen. & Troy R. R. Co.*, 2 Blatch. 279; *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516.

The only legal quality or aid which an alleged invention can draw from the art with which it is connected in the specification is that which relates to its utility. *Morton v. N. Y. Eye Infirmary*, 2 Fish. 320; s. c. 5 Blatch. 116.



Utility in most cases is a question of fact, as it usually depends upon the evidence resulting from actual experiment. *Mitchell v. Tilghman*, 4 Fish. 599; s. c. 19 Wall. 287; 5 O. G. 299; s. c. 9 Blatch. 1; s. c. 2 Fish. 518.

Any saving in labor or expense is a proper subject to be considered in deciding the question of utility. *Hays v. Sulsor*, 1 Fish. 532; s. c. 1 Bond 279; *Gray v. James*, Pet. C. C. 476; s. c. 1 Robb 144; *Simpson v. Mad River R. R. Co.*, 6 McLean 603; *Middletown Co. v. Judd*, 3 Fish. 141; *Watson v. Cunningham*, 4 Fish. 528.

That a machine, when first applied in practice, does not perfectly accomplish the work for which it was designed, or does not accomplish all that its inventor supposed it would, is not enough to secure its rejection as a patentable invention. Correction of defects arising from imperfect material, and not involving reorganization of the machine, will not change its fundamental character and subject it to condemnation as impracticable in its original condition. Taken as a whole in its construction and operation, if it is an advance upon the state of the art to which it appertains, furnishing a better though still imperfect method of performing a useful function than was before available, it is not to be discarded as destitute of patentable worth. *Marsh v. Seymour*, 97 U. S. 348; s. c. 13 O. G. 723; s. c. 6 Fish. 115; s. c. 9 Phila. 380; 2 O. G. 675.

If a machine can be applied to any beneficial purpose it is useful. *Dickinson v. Hall*, 31 Mass. 217.

If a patent is not useful for some beneficial purpose it is void. *Lester v. Palmer*, 86 Mass. 145.

Utility is not an infallible test of originality. The patent law requires a thing to be new as well as useful in order to entitle it to the protection of the statute. *Stanley Works v. Sargent*, 4 Fish. 443; s. c. 8 Blatch. 344.

The effect produced by a change is often an appropriate though not a controlling consideration in determining the character of the change itself. *Stanley Works v. Sargent*, 4 Fish. 443; s. c. 8 Blatch. 344; *Monce v. Adams*, 12 Blatch. 1; s. c. 7 O. G. 177; s. c. 1 Ban & Ard. 126.

If an article is so expensive that manufacturers would not be induced to make it, the fact may be a very important consideration, but is not necessarily conclusive. *Many v. Sizer*, 1 Fish. 17.

An improvement is not useful which, in effecting a subsidiary truth, as arresting the sparks of a locomotive, is destructive of the ends of the principal machine. *Wilton v. R. R. Co.*, 2 Whart. Dig. 360.

An invention which constantly exposes the operator to the loss of his life, or to great bodily harm, can not be regarded as useful within the meaning of the patent law. *Mitchell v. Tilghman*, 4 Fish. 599; s. c. 19 Wall. 287; 5 O. G. 299; s. c. 9 Blatch. 1; s. c. 2 Fish. 518.

An extensive use of the patented article raises a presumption of its utility. *Adams v. Edwards*, 1 Fish. 1; *Heald v. Rice*, 104 U. S. 737; s. c. 21 O. G. 1443; s. c. 13 Pac. L. R. 33; *Smith v. O'Connor*, 2 Saw. 461;

s. c. 4 O. G. 633; s. c. 6 Fish. 469; *Albright v. Cel. T. H. Co.*, 12 O. G. 227; 2 *Ban & Ard.* 629; *Megraw v. Carroll*, 5 *Ban & Ard.* 324.

If the invention was useful at the time when it was discovered, the patent will be valid, although it has been superseded by later inventions. *Wheeler v. Clipper Co.*, 6 Fish. 1; s. c. 10 Blatch. 181; 2 O. G. 442; *Poppenhusen v. Gutta Percha Comb Co.*, 2 Fish. 62.

The fact that other superior devices have been invented, and have driven it out of use, does not tend to prove that it lacks utility. *Cook v. Ernest*, 5 Fish. 396; s. c. 1 Woods 195; 2 O. G. 89.

If another person can superadd something which will remove all the defects of an invention, and render it useful, it immediately becomes valuable, not on account of its own qualities, but because of its capacity to receive the improvement, and with its aid to become useful. *Gray v. James*, Pet. C. C. 476; s. c. 1 Robb 140; *Ex parte Lipman*, 1 O. G. 304.

A patent is void if the machine will not answer the purpose for which it was intended, without some addition, adjustment, or alteration which the mechanic who is to construct it must introduce of his own invention. *Burrall v. Jewett*, 2 Paige 134.

A machine can not be pronounced useless or impracticable because it is susceptible of improvement which will obviate or prevent embarrassment to its more perfect operation. *Wheeler v. Clipper Co.*, 6 Fish. 1; s. c. 10 Blatch. 181; 2 O. G. 442.

The comparative value of the thing invented is not material so far as the exclusive right is concerned, beyond the fact that the article is useful or of some value. An article made according to a known method may be better than other articles made in the same manner, on account of its superior mechanism, but this is no foundation of an exclusive right. *Hotchkiss v. Greenwood*, 4 McLean 456; s. c. 11 How. 248; s. c. 2 Robb 730; *Many v. Jagger*, 1 Blatch. 372.

The objection that the invention is not useful generally comes with bad grace from a person charged with an infringement, because if the invention is of no utility, then he ought not to use it, and the very fact of his using it shows that his practice and his professions as regards the utility of the invention are very much at variance. *Many v. Jagger*, 1 Blatch. 372; *Turrill v. Ill. Cent. R. R. Co.*, 3 Fish. 330; s. c. 2 Biss. 66; *Gray v. James*, Pet. C. C. 394; s. c. Pet. C. C. 476; s. c. 1 Robb 120, 140; *Robertson v. Garrett*, 6 Fish. 278; s. c. 10 Blatch. 490; *Lee v. Blandy*, 2 Fish. 89; s. c. 1 Bond 361; *Heald v. Rice*, 104 U. S. 737; s. c. 21 O. G. 1443; s. c. 13 Pac. L. R. 33; *Poppenhusen v. Gutta Percha Comb Co.*, 2 Fish. 62; *Winans v. N. Y. & Erie R. R. Co.*, 1 Fish. 213; s. c. 21 How. 88; *Simpson v. Mad River R. R. Co.*, 6 McLean 603; *Middletown Co. v. Judd*, 3 Fish. 141; *Foye v. Nichols*, 22 O. G. 2243; s. c. 13 Fed. Rep. 128.

If the defendant has used the invention itself, or something substantially like it, he is estopped from denying its utility, for use implies utility, and it would be fair to presume that the party would not use it if he thought it of no utility. *Hays v. Sulsor*, 1 Fish. 532; s. c. 1 Bond 279; *Vance v. Campbell*, 1 Fish. 483; s. c. 1 Black 427; *Smith v. O'Connor*, 6 Fish. 469; s. c. 2 Saw. 461; 4 O. G. 633.

### What is Patentable.

At common law an inventor has no exclusive right to his invention or discovery. That exclusive right is the creature of the statute, and to that the courts must look to see if the right claimed in a given case is within its terms. The true field of inquiry is to ascertain whether or not the alleged invention set forth in the specification is embraced within the scope of the statute. *Morton v. N. Y. Eye Infirmary*, 2 Fish. 320 ; s. c. 5 Blatch. 116 ; *Latta v. Shawk*, 1 Fish. 465 ; s. c. 1 Bond 259.

Whatever may be the extent of the terms of the grant under the Constitution, the only power that Congress has exercised is the power to give a patent for a "new and useful art, machine, manufacture, or composition of matter." *Singer v. Wamsley*, 1 Fish. 558.

The terms "art, machine, manufacture, or composition of matter" are intended to cover the whole range of useful invention to every piece of which some one of them and to many more than one of them will apply. *Anilin Fabrik v. Cochrane*, 16 Blatch. 155 ; s. c. 4 Ben & Ard. 215.

### Principle.

A machine is a concrete thing consisting of parts, or of certain devices and combinations of devices. The principle of a machine is properly defined to be its mode of operation, or that peculiar combination of devices which distinguishes it from other machines. A machine is not a principle or an idea. Because the law requires a patentee to explain the mode of operation of his peculiar machine which distinguishes it from others, it does not authorize a patent for a mode of operation as exhibited in a machine. There is no authority in the statute to grant a patent for a principle, or a mode of operation, or an idea or any other abstraction. *Burr v. Duryee*, 2 Fish. 275 ; s. c. 1 Wall. 531 ; *Stone v. Sprague*, 1 Story 270 ; s. c. 2 Robb 10 ; *Case v. Brown*, 2 Fish. 268 ; s. c. 2 Wall. 320 ; 1 Biss. 382 ; *Sullivan v. Redfield*, 1 Paine 441 ; s. c. 1 Robb 477 ; *Barrett v. Hall*, 1 Mason 447 ; s. c. 1 Robb 207 ; *Hatch v. Moffit*, 15 Fed. Rep. 252 ; *Yale Lock Manuf. Co. v. Berkshire Natl. Bank*, 17 Fed. Rep. 531.

In its naked ordinary sense, a discovery is not patentable. A discovery of a new principle, force, or law operating, or which can be made to operate on matter, will not entitle the discoverer to a patent. It is only where the explorer has gone beyond the mere domain of discovery, and has laid hold of the new principle, force, or law and connected it with some particular medium or mechanical contrivance by which or through which it acts on the material world, that he can secure the exclusive control of it under the patent laws. He then controls his discovery through the means by which he has brought it into practical action, or their equivalent, and only through them. It is then an invention, although it embraces a discovery. Sever the force or principle discovered from the means or mechanism through which he has brought it into the domain of invention, and it immediately falls out of that domain and eludes his grasp. It is then a naked discovery, and not an invention. Every in-

vention may, in a certain sense, embrace more or less of discovery, for it must always include something that is new ; but it by no means follows that every discovery is an invention. It may be the soul of an invention, but it can not be the subject of the exclusive control of the patentee or the patent law until it inhabits a body, no more than can a disembodied spirit be subjected to the control of human laws. *Morton v. N. Y. Eye Infirmary*, 2 Fish. 320 ; s. c. 5 Blatch. 116.

The intellectual conception of a possible process, without a potential working of it out, is not patentable. If an inventor merely conceives a mechanical process in his mind, and then sets to work to construct a machine to work that process, and works it out in no other way, and the machine fails to work successfully, then his claim as the inventor of a process is as groundless as his claim as the inventor of a machine. *Union Manuf. Co. v. Lounsbury*, 2 Fish. 389.

The beneficent and imposing character of a discovery can not change the legal principles upon which the law of patents is founded, nor abrogate the rules by which judicial construction must be governed. These principles and rules are fixed and uninfluenced by shades and degrees of comparative merit. They secure to the inventor a monopoly in the manufacture, use, and sale of very humble contrivances of limited usefulness, the fruits of indifferent skill and trifling ingenuity, as well as those grander products of his genius which confer renown on himself and extensive and lasting benefits on society. But they are inadequate to the protection of every discovery by securing its exclusive control to the explorer to whose eye it may be first disclosed. A discovery may be brilliant and useful, and not patentable. *Morton v. N. Y. Eye Infirmary*, 2 Fish. 320 ; s. c. 5 Blatch. 116.

A principle may be embodied and applied so as to afford some result of practical utility in the arts and manufactures, and under such circumstances a principle may be the subject of a patent. It is, however, the embodiment and application of the principle which constitute the grant of the patent. The principle so embodied and applied, and the principle of such embodiment and application, are essentially distinct, the former being a truth of exact science, or a law of natural science, or a rule of practice ; the latter a practice founded on such truth, law, or rule. *Wintermute v. Redington*, 1 Fish. 239 ; *Wing v. Richardson*, 2 Fish. 535 ; s. c. 2 Cliff. 449 ; *Blanchard v. Eldridge*, 2 Whart. Dig. 358 ; *McComb v. Brodie*, 5 Fish. 384 ; s. c. 1 Woods 153 ; 2 O. G. 117 ; *Singer v. Walmsley*, 1 Fish. 558 ; *Sickles v. Borden*, 3 Blatch. 535.

The distinction between a patent for a principle and a patent which can be supported is, that there must be an embodiment of the principle in some practical mode described in the specification for carrying it into actual effect ; and then a patent may be taken out, not for the principle, but for the mode of carrying the principle into effect. However brilliant the discovery of the new principle may be, to make it useful it must be applied to some practical purpose. Short of this no patent can be granted. *Le Roy v. Tatham*, 22 How. 132.

A patent is not good for an effect, or the result of a certain process, as that would prohibit all other persons from making the same thing by any means whatsoever. *Le Roy v. Tatham*, 14 How. 156; s. c. 2 Blatch. 474; *Sangster v. Miller*, 2 Fish. 563; s. c. 5 Blatch. 243; *Ex parte Hobson*, 1 O. G. 141; *Carr v. Rice*, 1 Fish. 325; s. c. 4 Blatch. 200; *Sickels v. Falls Co.*, 2 Fish. 202; s. c. 4 Blatch. 508; *Whittemore v. Cutter*, 1 Gallis. 478; s. c. 1 Robb 40; *Brown v. Selby*, 4 Fish. 363; s. c. 2 Biss. 457; *Shaw & W. Co. v. Lovejoy*, 7 Blatch. 232.

It is not purpose or results that are the subject of patent, but the instrumentality, contrivance or machinery through the agency of which results are effected. If two inventions are the same in fact, whatever may be claimed by either party in effect, they are one as a necessary legal consequence. *Ex parte Merrill*, 1 McArthur 301; s. c. 5 O. G. 120.

A claim for a thing fabricated in a given form, for a specific purpose, and out of materials so united that the combined fabric is impressed with the peculiar qualities which belong to each of its constituents, is not a claim for a mere abstract result. *Union Paper Collar Co. v. White*, 7 O. G. 698; s. c. 2 Ban & Ard. 60.

### Art.

The word "art" in the patent laws, as well as in the Constitution, means a useful art, or a manufacture which is beneficial, and which is required to be described with exactness in its mode of operation, and of course can be protected only in the mode and to the extent thus described. *Smith v. Downing*, 1 Fish. 64.

A patent may be for a new and useful art, but it must be practical; it must be applicable and referrible to something which may prove it to be useful. A mere abstract principle is unsusceptible of appropriation by patent. *Evans v. Eaton*, Pet. C. C. 322; s. c. 3 Wheat. 454; s. c. 1 Robb 68, 243.

An art as such may be made the subject of a patent. The constitutional provision under which the patent laws are framed looks to the promotion of "useful arts." The act places "a new and useful art" among the discoveries it proposes to protect, and assigns to it the first place on the list. There is no reason of policy which should deny protection to an art while extending it to the machinery or processes which the art teaches, employs and makes useful. *French v. Rogers*, 1 Fish. 133.

A combination of arrangements and processes to work out a new and useful result is a new and useful art. A novel process or method of operation that amounts to a successful application of known things to a practical use is patentable as an art. *Roberts v. Dickey*, 4 Fish. 532; s. c. 4 Brews. 260; 1 O. G. 4.

If the invention is not a machine, manufacture or composition of matter, it must be an art in order to be patentable. *Jacobs v. Baker*, 7 Wall. 295.

A claim may be construed to be for a new art and not a new manufacture. *Collender v. Bailey*, 13 O. G. 277; s. c. 3 Ban & Ard. 217.

### Process.

A process *eo nomine* is not made the subject of a patent in any act of Congress. It is included under the general term "useful art." An art may require one or more processes or machines in order to produce a certain result or manufacture. The term machine includes every mechanical device, or combination of mechanical powers and devices, to perform some function and produce a certain effect or result. But where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes or methods or operations are called processes. A new process is usually the result of discovery; a machine, of invention. It is for the discovery or invention of some practicable method or means of producing a beneficial result or effect, that a patent is granted, and not for the result or effect itself. It is when the term process is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means which are not effected by mechanism or mechanical combinations. But the term process is often used in a more vague sense, in which it can not be the subject of a patent. Thus it is said that a board is undergoing the process of being planed, grain of being ground, iron of being hammered or rolled. Here the term is used subjectively or passively, as applied to the material operated on, and not to the method or mode of producing that operation, which is by mechanical means or the use of a machine, as distinguished from a process. In this use of the term it represents the function of a machine, or the effect produced by it on the material subjected to the action of the machine. But it is well settled that a man can not have a patent for the function or abstract effect of a machine, but only for the machine which produces it. *Corning v. Burden*, 15 How. 252; *Cochran v. Deener*, 11 O. G. 637; s. c. 94 U. S. 780; *Wood Paper Co. v. Fibre Co.*, 3 Fish. 362; s. c. 6 Blatch. 27; *Brown v. Piper*, 4 Fish. 175; s. c. 91 U. S. 37; 1 Holmes 20; s. c. 10 O. G. 417; *Smith v. Frazer*, 5 Fish. 543; s. c. 2 O. G. 175; *Tilghman v. Morse*, 5 Fish. 323; s. c. 9 Blatch. 421; 1 O. G. 574; *Tilghman v. Proctor*, 102 U. S. 707; s. c. 19 O. G. 859; *American Bell T. Co. v. Spencer*, 20 O. G. 299; s. c. 8 Fed. Rep. 509; *United Nickel Co. v. Pendleton*, 15 Fed. Rep. 739; *American B. T. Co. v. Dolbear*, 23 O. G. 535; s. c. 15 Fed. Rep. 448.

"Process," or "method," when used to represent the means of producing a beneficial result, are, in law, synonymous with art, provided the means are not effected by mechanism or mechanical combinations. *Brown v. Piper*, 4 Fish. 175; s. c. 91 U. S. 37; 1 Holmes 20; s. c. 10 O. G. 417.

The word principle is used by elementary writers on patent subjects, and sometimes in adjudications of courts, with such a want of precision in its application as to mislead. It is admitted that a principle is not patentable. A principle in the abstract is a fundamental truth, an original cause, a motive; these can not be patented, as no one can claim in either of them an exclusive right. Nor can an exclusive right exist to a new

power, should one be discovered in addition to those already known. Through the agency of machinery a new steam power may be said to have been generated. But no one can appropriate this power exclusively to himself under the patent laws. The same may be said of electricity, and of any other power in nature which is alike open to all, and may be applied to useful purposes by the use of machinery. In all such cases the processes used to extract, modify and concentrate natural agencies constitute the invention. The elements of the power exist; the invention is not in discovering them, but in applying them to useful objects. *Le Roy v. Tatham*, 14 How. 156; s. c. 2 Blatch. 474; 22 How. 132; *New York v. Ransom*, 23 How. 487; s. c. 1 Fish. 252; *Wyeth v. Stone*, 1 Story 273; s. c. 2 Robb 23; *O'Reilly v. Morse*, 15 How. 62; *Whitney v. Emmett*, Bald. 303; s. c. 1 Robb 567; *Lowell v. Lewis*, 1 Mason 182; s. c. 1 Robb 131; *Buchanan v. Howland*, 2 Fish. 341; s. c. 5 Blatch. 151; *Silby v. Foote*, 2 Blatch. 260; s. c. 20 How. 378; *Poillon v. Schmidt*, 3 Fish. 476; s. c. 6 Blatch. 299; *Smith v. Ely*, 5 McLean 76; s. c. 15 How. 137; *Tremaine v. Hitchcock*, 23 Wall. 518; s. c. 7 O. G. 1055; s. c. 4 Fish. 508; s. c. 8 Blatch. 440; *Detmold v. Reeves*, 1 Fish. 127; *Roberts v. Dickey*, 4 Fish. 532; s. c. 4 Brews. 240; 1 O. G. 4; *Blanchard v. Eldridge*, 2 Whart. Dig. 358; *Smith v. Downing*, 1 Fish. 64; *Wood v. Cleveland Rolling Mill*, 4 Fish. 550; *Tilghman v. Werk*, 2 Fish. 229; s. c. 1 Bond 511; *Bell v. Daniels*, 1 Fish. 372; s. c. 1 Bond 212; *Shaw & W. Co. v. Lovejoy*, 7 Blatch. 232.

Where a party has discovered a new application of some property in nature never before known or in use, by which he has produced a new and useful result, the discovery is the subject of a patent, independently of any peculiar or new arrangement of machinery for the purpose of applying the new property in nature, and hence the inventor has the right to use any means, old or new, in the application of the new property to produce the new and useful result to the exclusion of all other means. Otherwise a patent would afford no protection to an inventor in cases of this description, because if the means used by him for applying his new idea must necessarily be new, then in all such cases the novelty of the arrangement used for the purpose of effecting the application would be involved in every instance of infringement, and the patentee would be bound to make out, not only the novelty in the new application, but also the novelty in the machinery employed by him in making the application. *Silby v. Foote*, 2 Blatch. 260; s. c. 20 How. 378.

A process is a mode of treatment of certain materials to produce a given result. It is an act or a series of acts to be performed on the subject-matter to be transformed and reduced to a different state or thing. *Cochrane v. Deener*, 94 U. S. 780; 11 O. G. 637.

The machinery pointed out as suitable to perform a process may or may not be new or patentable, while the process itself may be altogether new, and produce an entirely new result. The process may be patentable irrespective of the particular form of the instrumentalities used. *Cochrane v. Deener*, 94 U. S. 780; s. c. 11 O. G. 637.

A claim for a process carried into effect by an apparatus is valid. *Black v. Thorne*, 5 Fish. 550; s. c. 10 Blatch. 66; 2 O. G. 338.

He who first utilizes and applies a peculiar property of a material is entitled to a patent for such application, whether he was the first person to discover the peculiarity or not. *Mulford v. Pearce*, 13 Blatch. 173; s. c. 9 O. G. 204; s. c. 2 Ban & Ard. 190.

A new mode or manner of producing a motion may be patentable. *Hovey v. Stevens*, 3 W. & M. 17; s. c. 2 Robb 567.

The idea of forcing water from the earth into a well-pit by the use of artificial power, when made available by a method whereby it is put to practical use, is patentable as a process. *Andrews v. Carman*, 13 Blatch. 307; s. c. 9 O. G. 1011; s. c. 2 Ban & Ard. 277; *Andrews v. Wright*, 13 O. G. 969; s. c. 3 Ban & Ard. 329; *Andrews v. Cross*, 19 O. G. 1705; s. c. 19 Blatch. 294; s. c. 8 Fed. Rep. 269.

The elements of the process may be old, but when combined for the purpose of putting a new idea to practical use they constitute a new and useful process. *Andrews v. Carman*, 13 Blatch. 307; s. c. 9 O. G. 1011; s. c. 2 Ban & Ard. 277.

There is a distinction between a machine and a process. A machine is a thing. A process is an act or a mode of acting. The one is visible to the eye—an object of perpetual observation. The other is a conception of the mind, seen only by its effects when being executed or performed. *Tilghman v. Proctor*, 102 U. S. 707; s. c. 19 O. G. 859.

A mere mechanical operation is not patentable as a process, and is not within the protection of the patent law when taken apart from the means of performing it. *MacKay v. Jackman*, 22 O. G. 85; s. c. 12 Fed. Rep. 615; *New v. Warren*, 22 O. G. 589.

### **Machine.**

Patentable inventions pertaining to machines may be divided into four classes: 1st, entire machines; 2d, separate devices of a machine; 3d, new devices of a machine in combination with old elements, all embraced in one claim, or with separate claims for what is new, together with a claim for the new combination of all the elements; 4th, devices or elements of a machine in combination where all the devices or elements are old. *Sanford v. Merrimac Hat Co.*, 10 O. G. 466; s. c. 4 Cliff. 404.

All machines may be regarded as merely devices by the instrumentality of which the laws of nature are made applicable and operative to the production of a particular result. He who first discovers that a law of nature can be so applied, and, having devised machinery to make it operative, introduces it in a practical form to the knowledge of his fellow men, is a discoverer and inventor of the highest grade, not merely of the mechanism, the combination of iron, brass and wood in the form of levers, screws or pulleys, but the force which operates through the mechanical medium, the principle; and this title as a discoverer he may lawfully assert and secure to himself by letters patent, thus establishing



his property not only in the formal device, but in the essential principle which his machine was the first to embody, to exemplify, to illustrate, to make operative and to announce to mankind. *Parker v. Hulme*, 1 Fish. 44.

If the party claims a whole machine, it must in substance be a new machine, that is, it must be a new mode, method or application of mechanism to produce some new effect, or to produce an old effect in a new way. *Woodcock v. Parker*, 1 Gallis. 438; s. c. 1 Robb 37.

If the patentee is the inventor of a mode of making a machine in a different manner from any ever before made, and it thereby produces a new and useful result by a new combination of old materials, he may claim the whole machine. When there is an addition to an old machine, or part of an old machine, or a mere alteration of some of its subordinate parts, the claim can only be for an improvement; but where the whole mode of forming the thing and its effect are new, it may be claimed as new. *Geiger v. Cook*, 3 W. & S. 266.

A patent may be obtained for a function as embodied in a particular machine, whose mode of operation and general structure are pointed out. *Blanchard v. Sprague*, 2 Story 164; s. c. 3 Sum. 535; s. c. 1 Robb 734, 742; *Parham v. Sewing Machine Co.*, 4 Fish. 468.

A patent for an arrangement to produce a given mechanical result is not a patent for a function, but a patent for the means when especially arranged to produce the result. *Renwick v. Pond*, 5 Fish. 569; s. c. 10 Blatch. 39; 2 O. G. 392.

If the patentee is the inventor of both the apparatus and the process, he may claim the apparatus when employed to work the process. *Black v. Thorne*, 5 Fish. 550; s. c. 10 Blatch. 66; 2 O. G. 388.

A device may be patentable although it has not in itself, apart from any connection with or application to other known devices or instrumentalities, capacity to produce practically useful results. *Wheeler v. Clipper Co.*, 6 Fish. 1; s. c. 10 Blatch. 181; 2 O. G. 442.

A hotel register constructed to receive advertisements about its margin is patentable as a structure. *Hawes v. Washburn*. 5 O. G. 491; *Hawes v. Cook*, 5 O. G. 493.

A discovery that the attachment of an advertisement permanently to a balloon is a good mode of advertising is not patentable as an apparatus. *Gould v. Commissioner*, 1 McArthur 410; s. c. 5 O. G. 121.

### Combinations.

The word "machine" in the statute includes new combinations as well as new organizations of mechanism, and hence there may be a patent for new combinations of machinery to produce certain effects, whether the machines constituting the combination be new or old. *Wintermute v. Redington*, 1 Fish. 239; *Williams v. Rome W. & O. R. R. Co.*, 15 O. G. 563; s. c. 15 Blatch. 200; s. c. 3 Ban & Ard. 413.

In order to render a combination patentable, the results must be a product of the combination and not a mere aggregate of several results, each

the complete product of one of the combined elements. Merely bringing old devices into juxtaposition, and there allowing each to work out its own effect without the production of something novel, is not invention. *Hailes v. Van Wormer*, 20 Wall. 353; s. c. 5 O. G. 89; s. c. 7 Blatch. 443; *Booth v. Parks*, 1 Flippin 381; s. c. 1 Ban & Ard. 225; *Sarven v. Hall*, 5 Fish. 415; s. c. 9 Blatch. 524; 1 O. G. 437; *Ross v. Wolfinger*, 5 O. G. 117; *Sawyer v. Bixby*, 9 Blatch. 361; s. c. 1 O. G. 165; s. c. 5 Fish. 283; *Perry v. Co-operative Foundry*, 22 O. G. 1624; s. c. 12 Fed. Rep. 436; *Perry v. Co-operative Foundry*, 12 Fed. Rep. 149; *Rubber C. H. T. Co. v. Welling*, 97 U. S. 7; s. c. 13 O. G. 727; s. c. 7 O. G. 608; s. c. 1 Ban & Ard. 282; *Loom Co. v. Higgins*, 105 U. S. 580; s. c. 21 O. G. 2031; s. c. 16 O. G. 675; s. c. 15 Blatch. 446; s. c. 4 Ban & Ard. 88; *Blackman v. Hibbler*, 17 Blatch. 333; s. c. 17 O. G. 107; s. c. 4 Ban & Ard. 641; s. c. 25 I. R. R. 394; *Double Pointed T. Co. v. T. R. Manuf. Co.*, 18 O. G. 683; s. c. 5 Ban & Ard. 465; s. c. 3 Fed. Rep. 26; *Slawson v. Railroad Co.*, 17 Blatch. 512; s. c. 24 O. G. 99; s. c. 5 Ban & Ard. 210; s. c. 4 Fed. Rep. 531; *Fisher v. Connaris*, 1 Mackey 212; s. c. 20 O. G. 957; *Beatty v. Hodges*, 19 Blatch. 381; s. c. 20 O. G. 1666; s. c. 8 Fed. Rep. 610; *Pickering v. McCullough*, 104 U. S. 310; s. c. 21 O. G. 73; s. c. 13 O. G. 818; s. c. 3 Ban & Ard. 279; *Combined Can Co. v. Lloyd*, 11 Fed. Rep. 149; s. c. 39 Leg. Int. 82; *Doubleday v. Roess*, 22 O. G. 861; s. c. 11 Fed. Rep. 737; *Thatcher Heating Co. v. Burtis*, 22 O. G. 262; s. c. 12 Fed. Rep. 569; *Sawyer v. Miller*, 12 Fed. Rep. 725; *Clark P. H. Co. v. Ferguson*, 24 O. G. 1090; s. c. 17 Fed. Rep. 79; *Wood v. Packer*, 17 Fed. Rep. 650.

All the parts or devices of the combination claimed must co-operate to produce a given result, in order to form a legitimate combination; and if one part does not co-operate with the others, the patent is void for want of unity and co-operation of its several parts. *Swift v. Whisen*, 3 Fish. 343; s. c. 2 Bond 115; *Hoffman v. Young*, 18 O. G. 794; *Stephenson v. Brooklyn C. T. R. R. Co.*, 19 Blatch. 473; s. c. 14 Fed. Rep. 457.

Co-operation does not mean merely acting together or simultaneously but unitedly to a common end, a unitary result; each and every part must have its sub-function to perform and each must have a certain relation to and dependence upon the other. *Hoffman v. Young*, 18 O. G. 794.

A combination to be patentable must produce a different force or effect or result in the combined forces or processes from that given by their separate parts. There must be a new result produced by their union; if not, it is only an aggregation of separate elements. *Reckendorfer v. Faber*, 92 U. S. 347; s. c. 12 Blatch. 68; 5 O. G. 697; 10 O. G. 71; s. c. 1 Ban & Ard. 229.

Either the instrumentalities employed, or the effect caused by their operation, must be new to constitute a patentable combination. If substantially the same devices have been used before for a like purpose, or if they are applied merely to effectuate a method known and practiced before, such employment of them will not be protected by a patent. *Northwestern Co. v. Philadelphia Co.*, 6 O. G. 34; s. c. 1 Ban & Ard. 177.

A combination in mechanism must consist of distinct mechanical parts

having some relation to each other, and each having some function in the organism. *Yale Manuf. Co. v. North*, 3 Fish. 279; s. c. 5 Blatch. 455.

Where one or more of the parts are new, and the combination is for that reason made to produce a new result, there is something more than a mere aggregation. *Gallahue v. Butterfield*, 6 Fish. 203; s. c. 10 Blatch. 232; 2 O. G. 645.

If one device performs a different function from that for which it is substituted, it may be patentable in combination with other devices. *Irwin v. Dane*, 9 O. G. 642.

If the arrangement produces a new result, it is patentable as a combination and is not a mere aggregation. *Stillwell & B. Manuf. Co. v. Cincinnati Gas Co.*, 1 Ban & Ard. 610; s. c. 7 O. G. 829; *Western E. Manuf. Co. v. Chicago E. Manuf. Co.*, 14 Fed. Rep. 691.

Such things are patentable as the discoverer undertakes to apply in combination or separately so as to produce new and beneficial results. It need not be a new material. It need not be an entirely new machine. It need not be wholly or throughout new application. When it is a combination, it must bring some new features into the combination and produce new and beneficial results. If it does that, it is of no matter how slight is the change. *Adams v. Edwards*, 1 Fish. 1.

To make a valid claim for a combination, it is not necessary that the several elementary parts of the combination should act simultaneously. If those elementary parts are so arranged that the successive action of each contributes to produce some one practical result, which result, when attained, is the product of the simultaneous or successive action of all the elementary parts viewed as one entire whole, a valid claim for thus combining those elementary parts may be made. *Furbush v. Cook*, 2 Fish. 668; *Birdsell v. McDonald*, 6 O. G. 682; s. c. 1 Ban & Ard. 165; *Gage v. Nelson*, 23 O. G. 2119; s. c. 12 O. G. 753; s. c. 14 Blatch. 293; s. c. 3 Ban & Ard. 55; *Hoffman v. Young*, 5 Ban & Ard. 316; s. c. 2 Fed. Rep. 74; *Hoe v. Cottrell*, 17 Blatch. 546; s. c. 18 O. G. 59; s. c. 5 Ban & Ard. 256; s. c. 1 Fed. Rep. 597; *McKesson v. Carndick*, 19 Blatch. 158; s. c. 21 O. G. 137; *Davis v. Brown*, 19 Blatch. 263; s. c. 20 O. G. 1021; s. c. 9 Fed. Rep. 647.

If the patentee is the inventor of a new device, he may restrict his claim to the device when used in some special connection. *Russell Manuf. Co. v. Mallory*, 5 Fish. 632; s. c. 10 Blatch. 140; 2 O. G. 495.

A combination is an entirety. If one of the elements is given up as immaterial and useless, the thing claimed disappears. *Vance v. Campbell*, 1 Fish. 483; s. c. 1 Black 427.

If a combination requires new devices to make it operative, and the several parts, when combined, produce a new result, it is patentable. *Buerk v. Imhausen*, 5 O. G. 752.

A claim for a combination of parts is inoperative unless it shows some useful result which can be produced by the mechanism alone. *Edgerton v. F. & B. Manuf. Co.*, 10 Biss. 402; s. c. 9 Fed. Rep. 450; s. c. 21 O. G. 261.

A patent for a combination of a fire-lighter and a bundle of kindling wood is void. *Alcott v. Young*, 21 O. G. 251; s. c. 9 Fed. Rep. 450.

If the idea of a combination is a meritorious invention, it will be deemed new, although a competent mechanic could easily adapt the parts. *Brown v. Whittemore*, 5 Fish. 524; s. c. 2 O. G. 248.

A combination which consists only of the application of a piece of rubber to one end of the same piece of wood which makes a lead pencil, is not patentable, for a handle in common does not create a new or combined operation. *Reckendorfer v. Faber*, 92 U. S. 347; s. c. 12 Blatch. 68; 5 O. G. 697; 10 O. G. 71; s. c. 1 Ban & Ard. 229.

In a just sense that is a combination which requires different things, or different contrivances, or different arrangements to be brought together to accomplish the given end. *Carver v. Braintree Manuf. Co.*, 2 Story 432; s. c. 1 Robb 141.

An added element which increases the efficiency of a combination of itself effective is of the nature of an improvement, but when the added element is essential to the production of any useful result, such addition is not an improvement, but its use gives birth to the only patentable, because the first useful combination. *Bliss v. Brooklyn*, 6 Fish. 289; s. c. 10 Blatch. 521; 3 O. G. 269.

A patent for a combination is not a patent for all and each of the parts. *Treadwell v. Bladen*, 4 Wash. C. C. 703; s. c. 1 Robb 531.

If a new combination produces a new result it is patentable. *Hawes v. Washburne*, 5 O. G. 491; *Fitch v. Bragg*, 20 O. G. 1589; s. c. 8 Fed. Rep. 588.

If the different effects produced by a combination were all produced by the same application of machinery in separate parts, and the patentee merely combined them together or added a new effect, such combination would not sustain a claim for the whole machine. *Whittemore v. Cutter*, 1 Gallis. 478; s. c. 1 Robb 40.

If one element of a proposed combination is covered by a subsisting patent held by another, the patent office can not grant a patent for the whole combined machine, for it can not grant any right in an invention which is the property of another. *Larabee v. Cortlan*, 3 Fish. 5; s. c. Taney 180.

### **Manufacture.**

A machine may be new, and the product or manufacture proceeding from it may be old. In that case the former would be patentable and the latter not. The machine may be substantially old and the product new. In that event the latter, and not the former, would be patentable. Both may be new, or both may be old. In the former case both may be patentable, in the latter neither. The same remarks apply to processes and their results. Patentability may exist as to either, neither, or both, according to the fact of novelty or the opposite. The patentability, or the issuing of a patent as to one, in nowise affects the rights of the inventor or discoverer as to the other. They are wholly disconnected and independent facts. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

There is not only a distinction, but a wide difference, between one who merely invents a new method or process by which a well-known fabric, product or manufacture is produced in a cheaper or better way, and the discoverer of a new compound substance or manufacture having qualities never found to exist together in any other material. In the first case the inventor can patent nothing but his process, and not his composition of matter. In the latter, both are new and original, and both patentable—not severally, but as one discovery or invention. *Goodyear v. Central R. R. Co.*, 1 Fish. 626; s. c. 2 Wall. Jr. 356; *Goodyear v. Wait*, 3 Fish. 242; s. c. 5 Blatch. 468; *Waterbury Brass Co. v. Miller*, 5 Fish. 48; s. c. 9 Blatch. 77; *Merrill v. Yeomans*, 1 Holmes 331; s. c. 5 O. G. 267; s. c. 94 U. S. 568; s. c. 11 O. G. 970; s. c. 1 Ban & Ard. 47; *United Nickel Co. v. Pendleton*, 15 Fed. Rep. 739.

A manufacture or a product of a process may be no novelty, while at the same time the process or agency by which it is produced may be both new and useful. *American Wood Paper Co. v. Fibre Disintegrating Co.*, 23 Wall. 566.

A process to obtain an extract from a subject from which it has never been taken may be the creature of invention, but the thing itself, when obtained, can not be called a new manufacture. *American Wood Paper Co. v. Fibre Disintegrating Co.*, 23 Wall. 566.

An article in common use can not be patented as a new article merely because it is fabricated by the use of new and improved machinery. *Draper v. Hudson*, 6 Fish. 327; s. c. 1 Holmes 208; 3 O. G. 354; *Wooster v. Calhoun*, 6 Fish. 514; s. c. 11 Blatch. 215.

A product is not patentable on the mere ground that a machine makes it more perfectly than it can be made without a machine, for improvements in degree or quality are not the subject of a patent. *Wooster v. Calhoun*, 6 Fish. 514; s. c. 11 Blatch. 215.

### **Improvements.**

An improvement has essential reference to a subject-matter to be improved. It is not an original, but embraces and either adds to or alters the original. *Fage v. Ferry*, 1 Fish. 298.

An improvement upon an old contrivance, in order to be of sufficient importance to be the subject of a patent, must embody some originality and something substantial in the change, producing a more useful effect and operation. *Hall v. Wiles*, 2 Blatch. 194; *Buck v. Hermance*, 1 Blatch. 398; *Smith v. Pearce*, 2 McLean 176; s. c. 2 Robb 13.

It is not necessary, in any improvement, that the application to the new and useful purpose should be made by the very best apparatus that can be devised. The question does not depend on the degree of usefulness. If the application that was made of the principle operated successfully, so as to be practically useful, although it might not have been the very best, yet it was not a failure. *Silsby v. Foote*, 2 Blatch. 260; s. c. 20 How. 378; *Many v. Jagger*, 1 Blatch. 372.

Particular changes may be made in the construction and operation of an old machine, so as to adapt it to a new and valuable use not known before, and to which the old machine had not been and could not be applied without these changes, and under these circumstances and conditions, if the machine, as changed and modified, produces a new and useful result, it may be patented. Such change in an old machine may consist alone of a new and useful combination of the several parts of which it is composed, or it may consist of a material alteration or modification of one or more of the several devices which enter into its construction, or it may consist in adding new devices. *Bray v. Hartshorn*, 1 Cliff. 538; *Turrill v. Illinois Cent. R. R. Co.*, 3 Fish. 330; s. c. 3 Biss. 66.

A new device is not in law an improvement upon the machine which it supersedes. It is an improvement on the old machine only in that sense that any new and useful mechanical device to accomplish a given object is an improvement on all other known mechanical devices to accomplish the same object. It is not something in aid of the old mode and to make the old mode better. It dispenses with and discards the old modes, and substitutes in their place other means to accomplish a useful result. It is not an addition to any old mode, to be used in conjunction with such old mode, and to make such old mode better and more effectual. *Potter v. Holland*, 1 Fish. 382; s. c. 4 Blatch. 238.

Any person may make an improvement upon a patent, but all that he can patent is his own invention, that is, the improvement. *Colt v. Mass. Arms Co.*, 1 Fish. 108; *Larabee v. Cortlan*, 3 Fish. 5; s. c. 1 Taney 180; *Cochrane v. Deener*, 11 O. G. 637; s. c. 94 U. S. 780; *Conover v. Roach*, 4 Fish. 12.

There is nothing in the statute that forbids an inventor to take out a patent for an improvement upon his invention. Any other inventor may do so, and there can be no reason in justice or in policy for refusing the like privilege to him. When there is no positive law to the contrary, he must stand on the same footing with any other inventor of an improvement upon a previous discovery. Nor is he bound in his new patent to refer specially to his former one. All that the law requires of him is that he shall not claim as new what is covered by a former invention, whether made by himself or any other person. *O'Reilly v. Morse*, 15 How. 62; *Smith v. Ely*, 5 McLean 76; s. c. 15 How. 137.

### **Knowledge and Use.**

The words "by others" were added to remove the doubt formerly entertained whether a use by the patentee himself, before his application for a patent, would not deprive him of his right to a patent. They are not designed to denote a plurality of persons by whom the use should be, but to show that the use should be by some other person or persons than the patentee. *Reed v. Cutter*, 1 Story 590; s. c. 2 Robb 81; *Wyeth v. Stone*, 1 Story 273; s. c. 2 Robb 23.

By knowledge and use Congress meant knowledge and use existing in

a manner accessible to the public. *Gayler v. Wilder*, 10 How. 477; *Cahoon v. Ring*, 1 Fish. 397; s. c. 1 Cliff. 592.

The true meaning of this clause is that the invention must not have been known or used by the public. If it were necessary to employ others to assist in the original structure or use by the inventor himself, or if his invention should be pirated by another, or used without his consent, it can scarcely be supposed that the legislature had within its contemplation such knowledge or use. *Pennock v. Dialogue*, 2 Pet. 1; s. c. 4 Wash. C. C. 538; s. c. 1 Robb 466, 542; *Ryan v. Goodwin*, 3 Sum. 514; s. c. 1 Robb 725; *Shaw v. Cooper*, 7 Pet. 292; s. c. 1 Robb 643; *Morris v. Huntington*, 1 Paine 348; s. c. 1 Robb 448; *Sewall v. Jones*, 91 U. S. 171; s. c. 9 O. G. 47; s. c. 3 O. G. 630; s. c. 3 Cliff. 563; s. c. 6 Fish. 343; *Treadwell v. Bladen*, 4 Wash. C. C. 703; s. c. 1 Robb 531; *Whitney v. Emmett*, Bald. 303; s. c. 1 Robb 567.

Public use is opposed to private use. If a man has an invention and uses it privately, and nobody knows of it, then the use of it can not debar another person from inventing or patenting it. The evidence of a public use as opposed to a private use need not be a general use by the community, but it must be an open use, however, so that the structure and *modus operandi* are apparent. One evidence of public use is the manufacture of an article publicly and openly for sale; not universally, but still publicly; not by one person alone, and for his own private use, but the manufacture of it publicly, the offering of it for sale publicly. A man is not to lie by and let the public—several persons—use his invention without objection, because he thus misleads them. He is not to lie by and let it be sold in public stores. *Adams v. Edwards*, 1 Fish. 1.

The first inventor has a right to a patent, though there may have been a knowledge and use of the thing invented by others, before his application for a patent, if such knowledge or use was not anterior to his discovery. *Mellus v. Silsbee*, 4 Mason 108; s. c. 1 Robb 506.

It is not enough to show that a machine like the one described in the patent was made, but there must be proof that it was used prior to the patentee's invention. This is the test of what is required to defeat the title of a patentee of an improved machine. *Parker v. Hulme*, 1 Fish. 44; *Pennock v. Dialogue*, 4 Wash. C. C. 538; s. c. 2 Pet. 1; s. c. 1 Robb 466, 542.

A mere application for a patent is not a bar to the granting of a patent to another. It can only have a bearing on the question of prior invention or discovery. *Brown v. Guild*, 23 Wall. 181; s. c. 6 O. G. 392; 7 O. G. 739; *Putnam v. Hutchinson*, 12 Fed. Rep. 127; s. c. 14 C. L. N. 289.

If the thing was known and used by others in this country before the alleged discovery, then it is not patentable. *Roemer v. Simon*, 95 U. S. 214; s. c. 12 O. G. 796; s. c. 1 Ban & Ard. 138.

If a patentee in his patent concedes that a part is old, he can not contradict that admission. *Moffett v. Rogers*, 8 Fed. Rep. 147.

The prior use of an alleged invention must be a public use, and not a private use. If an invention is made and used in a private way, and then

thrown aside and not given to the public, a patent granted to a subsequent inventor would be a valid patent. *Haselden v. Ogden*, 3 Fish. 378; *Cahoon v. Ring*, 1 Fish. 397; s. c. 1 Cliff. 592.

The greater or less use in which the prior invention may have been, or the more or less widely the knowledge of its existence may have circulated, does not constitute the criterion by which to decide upon the validity of any subsequent patent. Any patent may therefore be defeated by showing that the thing secured by the patent had been discovered and put into actual use prior to the discovery of the patentee, however limited the use or knowledge of the prior discovery may have been. *Bedford v. Hunt*, 1 Mason 302; s. c. 1 Robb 148.

The prior knowledge and use by a single person is sufficient. The number is immaterial. *Coffin v. Ogden*, 18 Wall. 120; s. c. 5 O. G. 270.

Whether the machine was in fact operated for a greater or less time is of no importance, except so far as that may tend to show that it was or was not a mere experiment; in that view the fact is of some consequence. But if the machine was capable of doing work, then the fact that it was operated but a short time, and abandoned for other reasons than because it failed as a machine, is of no consequence. *Stimpson v. Woodman*, 3 Fish. 98; s. c. 10 Wall. 117.

If a machine has been in public use, whether it fell into disuse or not, a subsequent inventor can not obtain a patent for it so as to exclude others from using it if they choose to do so. *Evans v. Hettick*, 3 Wash. C. C. 408; s. c. 7 Wheat. 453; s. c. 1 Robb 166, 417.

It is sufficient to show that the invention was "known or used" by others before the patentee discovered or invented the article or improvement patented, without showing a general use thereof, in order to defeat the patent for want of novelty. *Rice v. Garnhart*, 34 Wis. 453.

An experiment is such a use as the statute contemplates. If the machine is perfected so as to accomplish the function claimed for it, then it would be a use within the meaning of the patent law. *Singer v. Walmsley*, 1 Fish. 558; *Rice v. Garnhart*, 34 Wis. 453.

An experiment with a machine amounts to a using of it within the meaning of the act, although it is found not to answer as well as expected and is thrown aside. *Watson v. Bladen*, 4 Wash. C. C. 580; s. c. 1 Robb 510.

The imparting of a knowledge of the construction of the mechanism to persons connected with the business to which it appertains, who saw it and understood its arrangement, is the giving to the public of such a knowledge of it as a completed invention as will deprive a subsequent inventor of the right to be considered in law as the first inventor thereof. *Coffin v. Ogden*, 3 Fish. 640; s. c. 7 Blatch. 61.

A printed description of an invention is not deemed to be published until after it has been left for some time in a place accessible to the public. *Coburn v. Schroeder*, 22 O. G. 419; s. c. 11 Fed. Rep. 425.



**Patent.**

A patent should not be granted when the right to it is doubtful. *Ex parte Kemper*, Cranch Pat. Dec. 89.

There seems to have been no good reason at first, unless it were a fiscal one, on the part of the Government when issuing patents, why more than one invention in favor of the same inventor should not be embraced in one instrument, like more than one tract of land in one deed or patent for land. Each could be set out in separate articles or paragraphs as different counts for different matters in libels in admiralty, or declarations at common law, and the specifications could be made distinct for each and equally clear. But to obtain revenue, the public officers have generally declined to issue letters for more than one patent described in them. The courts have been disposed to acquiesce in the practice as conducive to clearness and certainty, and if letters issue otherwise inadvertently, to hold them, as a general rule, null. *Hogg v. Emerson*, 6 How. 437; s. c. 2 Blatch. 1; s. c. 2 Robb 655.

If two machines are patented by the same patent which are wholly independent of each other, and distinct inventions for unconnected objects, the patent is void. The same rule applies to a patent for several distinct improvements upon different machines having no common object or connected operation. For if different inventions might be joined in the same patent for entirely different purposes and objects, the patentee would be at liberty to join as many as he might choose at his own mere pleasure in one patent, which seems to be inconsistent with the language of the statute, which speaks of the thing patented and not of the things patented, and of a patent for an invention, and not of a patent for inventions. *Wyeth v. Stone*, 1 Story 273; s. c. 2 Robb 23; *Evans v. Eaton*, 3 Wheat. 454; s. c. Pet. C. C. 322; s. c. Robb 68, 243; *Moody v. Fiske*, 2 Mason 112; s. c. 1 Robb 312.

A patent in which *ex majore cautela*, the improvement has been unnecessarily split into three distinct patents, may be treated as one patent with three distinct claims. *Pennsylvania Salt Manuf. Co. v. Guggenheim*, 3 Fish. 423.

It is difficult, perhaps impossible, to lay down any general rule by which to determine when a given invention or improvement shall be embraced in one, two, or more patents. Some discretion must necessarily be left to the commissioner. It is often a nice and perplexing question. *Bennett v. Fowler*, 8 Wall. 445; *Goodyear v. Wait*, 3 Fish. 242; s. c. 5 Blatch. 468.

A patent may be taken out for several machines, if it is a patent for each machine as a distinct and independent invention, but for the same common purpose and auxiliary to the same common end. The patentee may lawfully unite in one patent all the modes in which he contemplates the application of his invention, and all the different sorts of machinery or modifications of machinery by which or to which it may be applied, and if each is new there is no just ground of objection to his patent reaching them all. *A fortiori*, this rule is applicable where each of the

machines is but an improvement or invention conducing to the accomplishment of one and the same general end. *Wyeth v. Stone*, 1 Story 273; s. c. 2 Robb 23; *Hogg v. Emerson*, 6 How. 437; s. c. 2 Blatch. 1; s. c. 2 Robb 655; 11 How. 587; s. c. 2 Blatch. 1; *Densmore v. Schofield*, 4 Fish. 148; *McComb v. Brodie*, 5 Fish. 384; s. c. 1 Woods 153; 2 O. G. 117; *Maxheimer v. Meyer*, 20 O. G. 1162; s. c. 9 Fed. Rep. 460.

The same patent may embrace a combination and the elements which make up the combination. *Foss v. Herbert*, 2 Fish. 31; s. c. 1 Biss. 121; *Jacques v. Wells*, 5 O. G. 364; *Root v. Ball*, 4 McLean 177; s. c. 2 Robb 513.

If the patentee has invented certain improved machines which are capable of a distinct operation, and has also invented a combination of those machines to produce a connected result, the same patent can not be at once for the combination and for each of the improved machines, for the inventions are as distinct as if the subjects were entirely different. *Barrett v. Hall*, 1 Mason 447; s. c. 1 Robb 207.

There may be a patent for a combination of many parts, and at the same time for an arrangement of some of the parts constituting another combination, but still a part of the larger. *Jacques v. Wells*, 5 O. G. 364; *Foss v. Herbert*, 2 Fish. 31; s. c. 1 Biss. 121; *Garratt v. Seibert*, 7 Pac. L. R. 116; s. c. 22 Pitts. L. J. 18.

It is no objection to the validity of a patent that it contains a claim for a machine combining several distinct improvements, each of which is the invention of the patentee, and claims for each of these several and distinct improvements. In other words the patentee may, in such a case, take out a valid patent for the combination, and also include therein a right to each distinct improvement severally contained in the same machine. *Pitts v. Whitman*, 2 Story 609; s. c. 2 Robb 189.

The patentee may embrace two improvements on the same machine in the same patent. *Morris v. Barrett*, 1 Fish. 461; s. c. 1 Bond 254; *Moody v. Fiske*, 2 Mason 112; s. c. 1 Robb 312.

Although an improvement is practically useful and operative only when taken in connection with other mechanical devices, yet it may be the subject of a separate claim. *Jacques v. Wells*, 5 O. G. 364.

If an inventor has invented a new process producing a new product, he may take a separate patent for each. *Sewall v. Jones*, 6 Fish. 343; s. c. 3 O. G. 630; s. c. 3 Cliff. 563; s. c. 91 U. S. 171; s. c. 9 O. G. 47.

When an inventor gets all that he has invented or discovered in one claim, it is better that he should not be permitted to set up and embarrass the public with another claim which gives no additional security or protection to his invention. *Putnam v. Yerrington*, 9 O. G. 689; s. c. 2 Ban & Ard. 237.

The fact that a single invention is made the subject of two distinct claims in the same specification—in other words is claimed twice—will not render the patent void. The blemish is mere tautology, which, while it may make the instrument less clear and exact, will not impair its validity. *Tompkins v. Gage*, 2 Fish. 577; s. c. 5 Blatch. 268.

Where a specification, by ambiguity and a needless multiplication of nebulous claims, is calculated to mislead and deceive the public, the patent is void. *Carlton v. Bokee*, 6 Fish. 40; s. c. 17 Wall. 463; 2 O. G. 520.

One void claim does not vitiate the entire patent, if made by mistake or inadvertence, and without any wilful default or intent to defraud or mislead the public. *Carlton v. Bokee*, 6 Fish. 40; s. c. 17 Wall. 463; 2 O. G. 520; *Kelleher v. Darling*, 4 Cliff. 424; s. c. 14 O. G. 673; s. c. 3 Ban & Ard. 438.

If two separate patents are issued at the same time for the same invention, they are both void. *Sewall v. Jones*, 6 Fish. 343; s. c. 3 O. G. 630; s. c. 3 Cliff. 63; s. c. 91 U. S. 171; s. c. 9 O. G. 47.

A grant of a subsequent patent for an invention is an estoppel to the patentee to set up any prior grant for the same invention which is inconsistent with the terms of the last grant. *Barrett v. Hall*, 1 Mason 447; s. c. 1 Robb 207.

An inventor can have but a single valid patent for his invention. The first he obtains, while it remains unrepealed, is an estoppel to any future patent for the same invention. The public by the first patent acquire an inchoate interest which can not be defeated by any merely ministerial acts of the officers of the Government. *Odiorne v. Amesbury Nail Factory*, 2 Mason 28; s. c. 1 Robb 300; *Morris v. Huntington*, 1 Paine 348; s. c. 1 Robb 448; *Treadwell v. Bladen*, 4 Wash. C. C. 708; s. c. 1 Robb 531; *Sickels v. Falls Co.*, 2 Fish. 202; s. c. 4 Blatch. 508.

If two patents are obtained for the same invention, the last and not the first is void. *Suffolk Co. v. Hayden*, 3 Wall. 315; s. c. 4 Fish. 86; *Morris v. Huntington*, 1 Paine 348; s. c. 1 Robb 448; *Johnson v. Fassman*, 5 Fish. 471; s. c. 1 Woods 138; 2 O. G. 94.

The patentee can not in a court of law show that the first patent is void. It being issued on his own representation, and according to his own specification as to the extent of the right claimed, he is estopped by his own act. *Morris v. Huntington*, 1 Paine 348; s. c. 1 Robb 448.

No subsequent patent can take away rights secured by a prior patent. *Sickels v. Tileston*, 4 Blatch. 109; *Stuart v. Shantz*, 6 Fish. 35; s. c. 9 Phila. 376; 2 O. G. 524.

A patentee can not include in a subsequent patent any invention embraced or described in a prior one granted to himself. *James v. Campbell*, 104 U. S. 356; s. c. 21 O. G. 337; *Mackay v. Jackman*, 22 O. G. 85; s. c. 12 Fed. Rep. 615.

Although one application describes an invention which is not claimed, yet the inventor may file a second application and obtain a second patent, for the invention which is so described and not claimed in the first patent. *Graham v. McCormick*, 21 O. G. 1533; s. c. 5 Ban & Ard. 244; s. c. 11 Fed. Rep. 859; *Graham v. Geneva L. C. Manuf. Co.*, 21 O. G. 1536; s. c. 11 Fed. Rep. 138.

Whether two patents cover the same invention must be determined by the tenor and scope of their claims, not by the descriptions in the specifications. *McMillan v. Rees*, 17 O. G. 1222; s. c. 5 Ban & Ard. 269; s. c. 1 Fed. Rep. 722.

Separate patents for severable parts of the same invention may be granted although the whole invention is fully described in each of them to explain the purpose and mode of operation of the parts covered by the claims in such patents. *McMillan v. Rees*, 17 O. G. 1222; s. c. 5 Ban & Ard. 269; s. c. 1 Fed. Rep. 722.

A patent is not necessarily void by reason of an error in the Christian name of the grantee, where it supplies on its face an added description by which the patentee may be certainly identified. Extrinsic proof is admissible to identify the patentee, and if he is thus identified, effect will be given to the grant accordingly. *Northwestern Co. v. Philadelphia Co.*, 6 O. G. 34; s. c. 1 Ban & Ard. 177.

### Invention.

An article to be patentable must not only differ from others, but must also indicate at least in some degree an exercise of inventive genius. *Levi C. Goodale*, 2 O. G. 589; *Watts Cooke*, 1 Dec. Com. 6; *E. R. Fenno*, 1 Dec. Com. 9; *James Murphy*, 1 Dec. Com. 24; *Lewis Abraham*, 1 Dec. Com. 59; *Stevens & Powers*, 1 Dec. Com. 63; *P. W. Dean*, 1 Dec. Com. 77; *R. M. Thompson*, 1 Dec. Com. 81; *H. M. Biedler*, 1 Dec. Com. 91; *Thomas M. Taylor*, 1 Dec. Com. 3; *J. C. Gaston*, 2 Dec. Com. 12; *Samuel Sharrock*, 2 Dec. Com. 46; *Abner H. Love*, 2 Dec. Com. 79; *G. W. Schermerhorn*, 2 Dec. Com. 122; *P. Millspaugh*, 2 Dec. Com. 134; *Moule & Bannehr*, 2 Dec. Com. 87; *Jonathan Dennis, Jr.*, 3 Dec. Com. 107; *Milligan & Higgins*, 3 Dec. Com. 215; *James McColgan*, 6 O. G. 327; *George W. Lavees*, 9 O. G. 921; *Julius Gerson*, 11 O. G. 244; *Wm. S. Hicks*, 10 O. G. 112; *Bates v. Geeger*, 2 O. G. 492; *A. N. Towne*, 1 Dec. Com. 39; *J. H. Sherwood*, 6 O. G. 361; *M. G. Slemmons*, 6 O. G. 604; *Charles H. Ackerson*, 1 Dec. Com. 74; *A. T. Barnes*, 1 Dec. Com. 81; *B. E. Hale*, 2 Dec. Com. 14; *Alanson Cary*, 2 Dec. Com. 38; *Robert Price*, 2 Dec. Com. 48; *Samuel Blue*, 2 Dec. Com. 89; *Henry Heath*, 3 Dec. Com. 212; *W. B. G. Taylor*, 3 Dec. Com. 309; *George Petry*, 3 Dec. Com. 325; *Henry W. Gould*, 4 O. G. 611; *George I. Anders*, 13 O. G. 964; *Cowper*, 16 O. G. 176.

A distinction must be drawn and maintained between invention and skill or good judgment. *D. E. Aiken*, 2 O. G. 274; *Hall & Hall*, 2 O. G. 589; *Stout, T. B.*, 1 Dec. Com. 4; *Powers & Stevens*, 1 Dec. Com. 45; *Waldemar Petersen*, 1 Dec. Com. 47; *J. A. Smith*, 1 Dec. Com. 83; *J. W. Sheppard*, 3 Dec. Com. 59; *Samuel Thacker*, 3 Dec. Com. 84; *Wm. H. Foye*, 3 Dec. Com. 188; *Lewis J. Atwood*, 6 O. G. 223; *McLaren & Coventry*, 10 O. G. 335; *Chambers v. Tucker*, 11 O. G. 1009; *Strong v. Cruikshank*, 12 O. G. 138; *Blackmen v. Morray*, 13 O. G. 175; *Wild v. Smith*, 15 O. G. 513; *Marshall*, 15 O. G. 1011; *Holcomb*, 15 O. G. 48.

The law does not intend that a patent shall be granted for every small mechanical contrivance, which, although new and useful, evinces in its production nothing more than the exercise of ordinary mechanical judgment. *Atwood*, 17 O. G. 570.

The first inventor of a new and useful device is entitled to a patent, even if its production was accidental and not appreciated at the time. *Garratt v. Siebert*, 2 O. G. 469.

The mere knowledge that certain things might be done, and would be valuable, does not amount to the conception of an invention. *Wicks v. Dubois*, 11 O. G. 244.

A conception which does not take any concrete form, but remains a mere mental abstraction, is not a conception in the sense of the law. *Farmer v. Brush*, 17 O. G. 150.

An invention does not pass absolutely from the domain of experiment until it has been actually used in public. If it is abandoned before such public use, it is an abandoned experiment. *Mallett v. Cogger*, 16 O. G. 45.

There is no novelty in practicing on a small scale what has been practiced on a large one before, or in practicing it for a different purpose. *Woodward v. Reist*, 1 Dec. Com. 34.

A conception may of itself require invention, and be novel and patentable, though it requires no ingenuity to put it in practice. *Henry Waterman*, 1 Dec. Com. 51.

An improvement of an existing device rendering its parts more adjustable in a manner well known, and by the exercise of mechanical skill and judgment alone, is not patentable. *Henry Gross*, 11 O. G. 739.

An incomplete conception of a device does not constitute invention as defined either by the courts or the office. *Gordon v. Withington*, 9 O. G. 1009.

An objection to an application may concede that the article is new, but deny that any invention was involved in its production, and no reference is required to establish this ground of rejection. *W. H. Wilkinson*, 2 Dec. Com. 22; *G. Hibbard*, 4 O. G. 54.

If novelty or usefulness is established, invention must be presumed. *Morse v. Clark*, 1 O. G. 275.

Perfected conception is invention. It is sufficient to describe it so accurately, even orally, as to enable an expert to make the thing conceived. *Woodbury v. Wilcox*, 2 A. L. T. R. 129.

When doubt exists as to the applicant's right to a patent, the fact that the granting thereof can do no harm to the public has some weight in determining the action of the office. *Charles P. Mixer*, 1 O. G. 48.

Doubts as to patentability, in cases when a really new thing is produced, ought to be resolved in favor of the inventor; and where he presents a new combination, he is entitled to a liberal consideration of it. *Thomas Bond*, 2 Dec. Com. 2.

If an instrument is the first which has accomplished the desired object, it should receive a patent, although the improvement upon what was known before seems to be such as an ordinary mechanic could have produced. *Jeremiah Kenney*, 1 Dec. Com. 95; *J. J. Urmston*, 2 Dec. Com. 13; *James R. Hyde*, 3 Dec. Com. 109.

Where parts are dispensed with, and other devices employed in their places, rendering certain additions necessary, there is presumptive evidence of invention as distinguished from mere skill. *J. G. & J. S. Armstrong*, 2 O. G. 704; *David F. Fetter*, 2 Dec. Com. 175; *Geo. W. Nesmith*, 3 O. G. 268; *Charles Frazier*, 6 O. G. 681.

Liberal encouragement should be given to the authors of inventions, yet no needless restraint should be placed upon citizens in the exercise of their judgment and skill. *Amos M. Smith*, 2 O. G. 674; *Geo. W. Blake*, 1 Dec. Com. 9; *Joseph Thorne*, 1 Dec. Com. 76.

### **Inventions in Change.**

The mere application of an old device to an old purpose is not patentable. *David H. Morrison*, 2 Dec. Com. 50; *John Underwood*, 2 Dec. Com. 52; *J. R. Bugbee*, 2 Dec. Com. 63; *Nathan Martz*, 2 Dec. Com.

18; *Streeter v. Stoddard*, 2 Dec. Com. 91; *Daniel Hallady*, 3 Dec. Com. 302; *James F. Garratt*, 5 O. G. 148; *G. T. Smith*, 6 O. G. 470.

A patent will be refused where the new application of an old process is but a double use of it. *E. C. Little*, 1 Dec. Com. 25; *H. M. Carter*, 1 Dec. Com. 96; *William Thie*, 2 Dec. Com. 61; *Osborne & Dayton*, 2 Dec. Com. 149; *Jas. T. Cree*, 3 Dec. Com. 83; *Hall & Averill*, 3 Dec. Com. 194; *James Arkell*, 3 Dec. Com. 257; *John Stephenson*, 5 O. G. 363; *Bloomfield Brower*, 7 O. G. 40; *Lovejoy v. Hill*, 17 O. G. 331.

The mere application of an old article to a new use does not involve invention. *Dewitt C. Baxter*, 2 O. G. 470; *E. J. Webster*, 1 Dec. Com. 9; *Charles H. Ackerson*, 1 Dec. Com. 74; *Wm. Linden*, 1 Dec. Com. 108; *Ira D. Warner*, 1 Dec. Com. 109; *Adams Glasgow*, 2 Dec. Com. 40; *D. N. B. Coffin, Jr.*, 2 Dec. Com. 62; *A. J. Dexter*, 2 Dec. Com. 90; *Benjamin Greeley*, 2 Dec. Com. 106; *Franklin H. Webb*, 1 Dec. Com. 78; *Kuder Seiple et al.*, 2 Dec. Com. 117; *Charles Powell*, 2 Dec. Com. 134; *Milton G. Wood*, 2 Dec. Com. 180; *Herman A. Gunther*, 3 Dec. Com. 199; *Holmes & Gilmore*, 3 Dec. Com. 204; *E. S. Renwick*, 3 Dec. Com. 214; *John E. Atwood*, 3 Dec. Com. 216; *J. B. Slawson*, 3 Dec. Com. 281; *J. C. Cooke*, 3 Dec. Com. 294; *William Molesworth*, 3 Dec. Com. 308; *L. C. Clark*, 3 O. G. 239; *B. B. Keyes*, 3 O. G. 268; *Joseph H. Sperry*, 3 O. G. 467; *Ellicott D. Averill*, 8 O. G. 400; *M. E. Berolzheimer*, 2 Dec. Com. 33; *J. G. G. Ganet*, 2 Dec. Com. 48; *H. J. Wickham*, 2 Dec. Com. 61; *Charles H. Toll*, 4 O. G. 500; *Josiah Holmes*, 8 O. G. 1; *Fisher*, 17 O. G. 570; *Horatio N. Cook*, 12 O. G. 1077.

When adaptation is required to secure a new result by applying an old device to a new use, invention is presumed, and the new organization may be patentable. *Levi Stevens*, 1 O. G. 223.

The application of an old device to a different and not analogous purpose may be patentable. *Murdick Lytle*, 1 O. G. 359; *Wild v. Smith*, 15 O. G. 513.

The employment of an old device in a new or modified way to produce a new and useful result is patentable. *John Burnham*, 1 O. G. 164.

The mere exchange of a feature of a device for a different but not novel one of the same kind, to be used in the same way, does not indicate invention. *Lloyd v. Engeman*, 2 O. G. 674; *R. A. Leeds*, 1 Dec. Com. 13; *Sherrell & Warner*, 1 Dec. Com. 15; *Louis S. Robbins*, 1 Dec. Com. 84; *George Schoenberg*, 2 Dec. Com. 36; *R. J. Gatling*, 2 Dec. Com. 92; *Samuel S. McNaughton*, 4 O. G. 525; *R. D. Young*, 6 O. G. 361.

A party who merely perfects an invention in detail which in general principle of operation was devised by another, is not entitled to a patent. *Charles H. Carter*, 14 O. G. 201.

The mere substitution of one material for another does not produce invention. *J. P. Chattillon*, 2 O. G. 115; *Philip C. Schuyler*, 2 O. G. 174; *P. A. Sabatton*, 2 O. G. 703; *P. Y. Brown*, 1 Dec. Com. 18; *Dimond & Doolittle*, 1 Dec. Com. 64; *L. B. Hamilton*, 2 Dec. Com. 14; *A. H. Baldwin*, 2 Dec. Com. 50; *John Farrell*, 2 Dec. Com. 105; *R. R. Miller*, 2 Dec. Com. 114; *L. E. Truesdell*, 2 Dec. Com. 123; *M. Landenberger*, 3 Dec. Com. 179; *J. W. Wattles*, 3 O. G. 291; *P. M. J. Chamblant*, 4 O. G. 106; *Wiard*, 16 O. G. 858; *Thomas Phillips*, 12 O. G. 311.

If the substitution of one material for another produces valuable changes in the art, it is patentable. *Rees*, 16 O. G. 460; *Roby*, 16 O. G. 545.

The substitution of one mechanical equivalent for another is not patentable. *John D. Wilber*, 1 O. G. 379; *John D. Murray*, 12 O. G. 187.

If one mechanical device in substitution for another in a particular place performs a new function not contemplated or called for in any other position, it is patentable. *James Greaves*, 12 O. G. 312.

A patent may be granted where a different method of operation is produced, and an improvement made by the substitution of one old device for another. *John K. Bigelow*, 2 O. G. 273; *J. J. Munger*, 1 Dec. Com. 3; *Samuel Sykes*, 1 Dec. Com. 9; *G. W. Adwen*, 1 Dec. Com. 23; *J. P. Tuttle*, 2 Dec. Com. 3; *Jason A. Bidwell*, 3 Dec. Com. 59; *Crossley v. Leger*, 16 O. G. 722.

Mechanical changes in structure or form which simply render an article a little better in quality, or more attractive in appearance or cheaper in construction, do not constitute invention. *Sullivan*, 16 O. G. 359.

Omission followed by reorganization may constitute patentable novelty, but mere omission does not. *George McRoy*, 1 Dec. Com. 58.

Where redeemable tickets have been used, a plan to redeem a portion only is not patentable. *W. W. Bierce*, 11 O. G. 1108.

The mere duplication of another's patent is not invention, and can not be patented. *G. C. Perkins*, 2 O. G. 469; *B. F. Peaslee*, 2 O. G. 543; *Charles Lawrence*, 1 Dec. Com. 83; *Eccleston & Coville*, 2 Dec. Com. 51; *Eaton, Hitchcock & Wells*, 2 Dec. Com. 51; *T. E. Jones*, 2 Dec. Com. 87; *John Ellerby*, 2 Dec. Com. 100; *F. M. Shepard*, 2 Dec. Com. 104; *Chambers v. Tucker*, 11 O. G. 1009.

If a peculiar situation is discovered, not necessarily obvious before from its nature, in which to apply an old process to produce a useful result, it is patentable, being more than applying an old device to a new use. *W. W. Leggett*, 2 O. G. 199.

If a new and better result is accomplished by a change in the position of old elements, and in the formation of some of them, a patent will be issued. *Eloi Bouscay, Jr.*, 9 O. G. 743.

If the change is not fundamental, but merely in the degree of the capacity for use, it is not patentable. *Millers Falls Manuf. Co.*, 1 O. G. 47.

If a change produces a difference in degree only, and not a difference in substance, it is not patentable. *B. J. Hobson*, 1 O. G. 141.

If a change of form modifies the principle of operation, and produces a superior article of manufacture, it is patentable. *Chas. P. Mixer*, 1 O. G. 48.

A change of form which renders an instrument more useful is patentable, although the change is simple. *Ira D. Warner*, 1 Dec. Com. 41; *Vosburgh & Ludden, Assignors*, 1 Dec. Com. 80; *King & Rowland*, 2 Dec. Com. 136; *J. H. McWilliams*, 3 Dec. Com. 177; *John & James Dobson*, 4 O. G. 499; *William Wachs*, 8 O. G. 907.

A passenger ticket which is simply a contract or method of doing business is not patentable. *A. E. Sheldon*, 13 O. G. 817.

The patentable features of a ticket like those of any other substantive thing must depend upon peculiarities of mechanical construction. The printed matter upon the ticket is nothing more than an arbitrary direction as to how such ticket is to be used, and can have no more bearing upon the patentability of the ticket itself than can printed directions for use upon any other article of manufacture affect its patentable novelty. *Lee*, 18 O. G. 624.

### Suggestions.

Where one communicates the details of an invention to a workman who has never heard of the principle before, he may be presumed to have originated it, if reduced to practice by the latter at his request. *Wilcox v. Woodbury*, 1 Dec. Com. 17; *Foster & Townsend v. Fowle*, 1 Dec. Com. 35; *Spofford v. Moore*, 2 Dec. Com. 6; *Hale v. Field*, 2 Dec. Com. 12; *T. Hall v. T. S. Hall*, 2 Dec. Com. 25; *Duckworth v. Crompton*, 2 Dec. Com. 43; *Hopkins v. Hardick*, 2 Dec. Com. 141; *Spencer & Saylor*

*v. Trafford*, 3 Dec. Com. 119; *Russell & Scow*, 5 O. G. 149; *Gilbert*, 5 O. G. 428; *Chase v. Witter*, 9 O. G. 593.

Where one of two who are claiming an invention communicates his ideas to the other who embodies them, there may be good ground for holding the man who makes the suggestions to be the inventor. *Riley v. Baumann*, 3 Dec. Com. 101; *Hamilton v. Foster*, 1 Dec. Com. 30; *Bates v. Marsh*, 3 Dec. Com. 253.

An inventor may adopt minor improvements in his invention, which are suggested by another, and the latter does not thereby acquire any interest in the invention. *Yost v. Heston*, 3 Dec. Com. 226; *Bradford v. Imlay*, 16 O. G. 314; *Yost v. Powell*, 13 O. G. 122; *Hall v. Johnson*, 23 O. G. 2411.

An operative having first constructed and put into actual use an apparatus embodying the invention is the prior inventor as against the employer, he being skilled in the art while his employer was not, and the evidence being contradictory on other points. *Edwards v. Requa*, 1 Dec. Com. 28; *Johnston v. Pimlott*, 2 Dec. Com. 44; *Mallett v. Crosby*, 2 Dec. Com. 56; *Coburn v. Smith*, 3 Dec. Com. 290; *Walter De Sano v. C. F. Ritchel*, 9 O. G. 792.

An employee is not estopped from claiming an invention against his employer unless he, by his admissions or conduct, induced the latter to perform any act or refrain from the same in regard to the particular invention. *Taylor v. Bourguignon*, 16 O. G. 958.

As between employer and employee, matters merely auxiliary or tributary to the main invention give to the employee no claim as an inventor, and in regard to such features as amount to independent inventions, a presumption exists in favor of the employer as the author of the same, which can only be overcome by conclusive and unequivocal proof. *Harrison v. Hogan*, 18 O. G. 921.

If one suggests an idea in a general way, and the other falls in with it, and by his aid develops it and gives it practical embodiment, the two may be considered joint inventors. *Chase & White v. Chase*, 4 O. G. 4.

No presumption arises against a workman that an improvement which he makes belongs to his employer, when he is employed to make a specified article, not to labor generally nor to embody an invention of his employer. *Holman v. Foley*, 2 Dec. Com. 97.

When the presumption of a joint invention has been created by the filing of a joint application for a patent, it can be overthrown only by evidence of the most unequivocal character. *Wheeler v. Russell*, 1 O. G. 183; *Yost v. Powell*, 13 O. G. 122; *Perkins v. Compton*, 12 O. G. 43.

In a joint invention, the result of mutual suggestions, counsel and effort, all the parties are entitled to share, and the invention will not be divided. *Shaw v. Keith et al.*, 9 O. G. 641; *Joseph Barsaloux*, 9 O. G. 883.

### Novelty.

It is not enough that an article of manufacture is new, in the ordinary sense, to render it patentable, but it must possess novelty, as the word is understood in the statute, and give evidence of inventive genius. *Charles A. Moore*, 3 Dec. Com. 249; *Horace Beach*, 3 O. G. 607; *William L. Smith*, 4 O. G. 349; *Judd M. Cobb*, 5 O. G. 751; *John W. Orr*, 6 O. G. 77; *Crouch v. Roemer*, 11 O. G. 1112; *Perkins*, 16 O. G. 1098; *Joseph Funck*, 14 O. G. 157.

Where the invention differs substantially, and not merely colorably, from some prior patent, there is patentable merit. *Springer v. Stanton*, 2 O. G. 2; *B. P. Corban*, 2 O. G. 30; *Rowley v. Mason*, 1 Dec. Com. 4;



Geo. Schneider, 1 Dec. Com. 24; Charles Robinson, 1 Dec. Com. 44; P. J. Dwyer, 1 Dec. Com. 57; M. H. Collins, 1 Dec. Com. 82; B. F. Woodside, 2 Dec. Com. 1; George F. Pinkham, 2 Dec. Com. 34; L. F. Follansbee, 2 Dec. Com. 127; J. B. Slawson, 2 Dec. Com. 177; J. A. & T. Wood, 3 Dec. Com. 56; James Duthie, 3 Dec. Com. 85; Case & Baillie, 3 Dec. Com. 307; Thomas Slaight, 4 O. G. 82; James D. Culp, 5 O. G. 427; Joseph B. Sprague, 6 O. G. 469; *Hoe v. Scott*, 14 O. G. 447; *Zane v. Peck*, 12 O. G. 518; *Schoen*, 16 O. G. 1003; *Pratt*, 16 O. G. 1005; *Spear*, 16 O. G. 1052.

A machine designed to accomplish a certain object is not anticipated by one accomplishing the same object only occasionally, and without its having been extended. *Geo. H. Brown*, 1 Dec. Com. 10.

Where the improvement is not shown in the references, and is not of so obvious a character that it would have been suggested by any of the prior contrivances, a patent may issue. *Charles Moseley*, 2 Dec. Com. 53; *G. C. Stillman*, 3 Dec. Com. 173; *Arnold v. Wilcox*, 7 O. G. 558; *J. S. McIntire*, 9 O. G. 300; *C. H. Davis*, 9 O. G. 537.

The first inventor is he who makes the article, not he who finds a use for it. *Cheesebrough v. Toppan*, 1 O. G. 464.

If an applicant avails himself of a portion of a plan used to make one article, and supplies everything necessary to constitute a complete and novel process for making another article, a patent should be granted. *Louis McMurray*, 8 O. G. 473.

If a device secures different results by different means from those employed by prior inventors, it is patentable. *J. C. White*, 1 O. G. 163.

If the two machines are different in operation and construction, the later is patentable. *B. P. Corbin*, 2 O. G. 30.

If the application of the article be new and useful, it can not be said to be anticipated by the prior use of any other, which lacks the quality that gives it utility, no matter how striking the resemblance. *Geo. E. Deering*, 1 Dec. Com. 26; *A. C. Platt*, 1 Dec. Com. 42; *Hopson & Brooks*, 3 Dec. Com. 153; *R. C. Phillips*, 3 Dec. Com. 273; *W. W. Goodwin*, 3 O. G. 347.

A patentable difference exists between two processes, when by one a solution could only be forced into a body, and by the other through it. *Ransome v. Norris*, 2 O. G. 295.

An incomplete and practically inoperative device is not sufficient ground for rejecting the product of an operative one, though the two devices may be alike in some respects. *J. L. Mason*, 2 O. G. 644.

An invention will be considered novel, although counterparts of it are referred to of an earlier date than the application, if they do not antedate a previous application to which it relates back. *J. R. McClintock*, 3 Dec. Com. 325.

Where neither of the references upon which an application is rejected is so analogous to the invention presented as to suggest it, the application will be allowed. *A. G. Lesner*, 3 Dec. Com. 204; *Charles A. Moore*, 3 Dec. Com. 249; *Geo. W. Hawes*, 3 Dec. Com. 255; *David H. Morrison*, 3 Dec. Com. 327; *Henry Reynolds*, 6 O. G. 295.

A patent with a generic claim can only be used to restrict a specific claim of a subsequent inventor. *Waterman*, 17 O. G. 451.

An invention can not be presumed to have been made before the filing of the application, when it was founded on theory alone, and had not been practiced. *Reed v. Roberts*, 1 Dec. Com. 88; *De La Mar v. Surens*, 1 Dec. Com. 94.

If an inventor has devised new means to accomplish a certain result, it

is not enough to refer him to devices wherein it is evident that a like intention exists. *Twitchell*, 6 O. G. 506.

A party can not claim what was discovered by a prior inventor, although his improvement has made the article commercially valuable. *Sargent & Burge*, 11 O. G. 1055.

If two inventors are on equal terms in respect to the invention, and both contribute to its essential parts, the patent would be invalid if issued to one of them. *Carter v. Perry*, 8 O. G. 518.

A joint invention can not be carried back to a date earlier than that at which the subject-matter was first discussed by the parties. *Dwyer v. Dickey*, 10 O. G. 585.

In whatever field of art a new and useful invention appears, a patent for it, duly applied for, can not lawfully be refused. *Ward*, 4 O. G. 350.

The mere fact of the first inventor having lost his right to a patent does not entitle a junior inventor to step forward and obtain one. *Collins v. England*, 1 Dec. Com. 66.

If the invention, covered by a given claim, be novel, the combination of the elements of said claim, with other devices, is allowable in another claim, if legitimate. *M. Smith*, 2 O. G. 117; *Minar, Stevens et al.*, 2 Dec. Com. 47.

An inventor can not obtain a patent for a device which is described in a prior patent granted to him. *Hill and Prentice*, 24 O. G. 1176.

The oath of the applicant is sufficient to avoid an objection on account of the granting of an English patent to him and another jointly. *Siemens*, 11 O. G. 1107.

A printed specification of a foreign patent is not competent evidence to prove the date of the invention or that the patentee was the inventor in his favor. *Lauder v. Crowell*, 16 O. G. 405.

A foreign inventor can not prove that he made or used his invention in a foreign country before the date of his patent for any purpose. *Laufrey*, 20 O. G. 892; *Rumpff v. Kohler*, 23 O. G. 1831.

If an American citizen makes an invention in a foreign country and there has it patented, the earliest date that can be given to his invention as against a rival inventor in this country is the date of the foreign patent. *Bell v. Brooks*, 19 O. G. 290.

A foreign inventor may show that he made the invention known in this country prior to the date of any foreign patent cited against him. *Laufrey*, 20 O. G. 892.

If the same invention has been patented by two foreigners in a foreign country, the party holding the prior patent is entitled to a patent if he is an original inventor. *Lauder v. Crowell*, 16 O. G. 405.

If the same invention has been patented by two foreigners in a foreign country, the prior patent is a bar to the granting of a patent to the party holding the subsequent patent. *Lauder v. Crowell*, 16 O. G. 405.

The discoverer of a principle who first devises a method for carrying the principle into effect, and first invents or combines means to accomplish the several steps in that method, is entitled to the exclusive use of the method itself, and also of the means by him invented or combined for its practical execution. *Bell v. Gray*, 15 O. G. 776.

The conduct of a party will not estop him from showing that he is the sole inventor, but effect will be given to the estoppel by issuing a joint patent for a sole invention. *Berlew v. Berlew*, 16 O. G. 457.

If a patent is issued to two or more persons as joint inventors upon an application which erroneously describes the invention as joint instead of sole, it can not be corrected so that a patent may be issued to the real sole inventor. *Barsaloux*, 14 O. G. 233.

### Reducing to Practice.

Priority of conception, coupled with due diligence in reducing to practice, constitutes priority of invention. *Wheeler v. Russell*, 1 O. G. 183; *Perkins v. Compton*, 13 O. G. 43; *Wyman v. Knowles*, 13 O. G. 320; *Kirchner v. Blair*, 13 O. G. 364; *Young v. Rogers*, 18 O. G. 732; *Hockhausen v. Weston*, 18 O. G. 857; *Brown v. LaDow*, 18 O. G. 1049; *Locke v. Levaley*, 20 O. G. 671; *Hull v. Lowden*, 20 O. G. 741; *McTammany v. Needham*, 18 O. G. 1050.

The merits of an improvement belong to the one who first conceived and gave practical form and effect to it. *De Sano v. Ritchel*, 9 O. G. 792.

As between two independent inventors, he who first perfects the invention is entitled to the patent, and it can not avail the other to refer back to crude experiments. *Browne v. Ludlow*, 2 Dec. Com. 16; *Duchemin v. Richardson*, 2 Dec. Com. 31; *Bingham v. Watkins*, 2 Dec. Com. 42; *Crowell v. Sim*, 2 Dec. Com. 72; *Richardson v. Denza*, 2 Dec. Com. 156; *Knight v. Annan*, 3 Dec. Com. 34; *Davis, Edson et al.*, 4 O. G. 500; *Stanton & Perley*, 4 O. G. 500; *Clark & Osborn*, 5 O. G. 667; *Macdonald v. Chase*, 6 O. G. 359; *Rees v. Richards*, 7 O. G. 36; *Bird*, 14 O. G. 234; *Towers v. Pease*, 13 O. G. 175; *Green v. Field*, 16 O. G. 587; *Hunt v. King*, 17 O. G. 200; *Fulgham v. Westcott*, 18 O. G. 571; *Levalley v. Ewart*, 20 O. G. 672.

The first of two competitors who reduces the invention to practice is entitled to the patent, although another may have first conceived it. *Hoeltge v. Hoeller*, 3 Dec. Com. 309; *Jones v. Pendleton*, 3 Dec. Com. 314; *Smith v. Barter*, 7 O. G. 1; *Ware v. Bullock*, 7 O. G. 39; *Arnold v. Wilcox*, 7 O. G. 558; *Oliver v. Zeller*, 10 O. G. 416; *Hallidie*, 12 O. G. 1077; *Martin v. Bogle*, 12 O. G. 625; *McKenna v. Redden*, 16 O. G. 458; *Blenn v. Gale*, 16 O. G. 459; *Gardner v. Dudley*, 17 O. G. 801.

Although the party who files the last application was the first to conceive the invention, yet he is not entitled to a patent as against a prior applicant, who was the first to reduce the invention to practice, even though his invention was reduced to practice by some other person. *Burgess v. Wetmore*, 16 O. G. 765.

If the first inventor reduces his invention to practice contemporaneously with his rival and files the first application, he is entitled to a patent. *Bering v. Haworth*, 14 O. G. 117.

If an applicant for a patent was the first to clearly originate the invention, and diligent in reducing it to practice, he will be considered the prior inventor as against the patentee. *Withington v. Locke*, 11 O. G. 417.

The party who originates a device and puts it into general use is the prior inventor, although his competitor had previously made successful experiments, but had abandoned them. *Merrill v. Atwood*, 1 Dec. Com. 6; *Chipman v. Fales*, 1 Dec. Com. 44; *Coles v. Loud*, 2 Dec. Com. 4; *Lamson v. Wardwell*, 2 Dec. Com. 33; *Dimond v. Hayden*, 2 Dec. Com. 34; *Bovey v. Graham*, 2 Dec. Com. 189; *Frevert v. Gahr*, 3 O. G. 660; *Lagowitz v. Topham*, 9 O. G. 742; *Gross v. Sargent*, 11 O. G. 788.

He who first reduces an invention to a practical form is entitled to the patent, though another conceived it before him and explained it to others. *Lyon v. Altmaier*, 1 Dec. Com. 15; *Jennings v. Winter*, 1 Dec. Com. 38.

If the one who first conceives a device exercises reasonable diligence in reducing it to practice, he will be considered the prior inventor, although another has succeeded before him in perfecting it and reducing it to practice. *William S. Carr*, 5 O. G. 30; *Proctor v. Ackroyd*, 6 O. G. 603; *Freeborne v. Foye*, 9 O. G. 884; *Etches v. Prescott*, 17 O. G. 267.

The one who first conceives the invention and completes a model that operates, perfectly before his competitor, and carries it to the greatest degree of perfection, is entitled to priority. *Withington v. Whitney*, 3 Dec. Com. 310; *Smith v. Edson*, 7 O. G. 827; *Baldwin v. Bigelow*, 7 O. G. 1011.

If a patentee is first to conceive an invention, first to make a model, the first to apply for a patent, and the first to obtain the grant, he is not required to have put his invention to practical use before obtaining a patent. *Busha v. Phelps*, 9 O. G. 1010.

The one who first reduces an invention to a practical form by embodying it in a machine in use, is entitled to a patent, unless a prior inventor is at the time using due diligence in adapting and perfecting the same invention. *Crane v. Whitehead*, 7 O. G. 219.

Where an invention is voluntarily laid aside, without anything being done in the way of an application for a patent, and another, in the mean time, without any knowledge of this fact, invents and reduces the same thing to practice, after applying for and taking out a patent, he must be regarded as the original and first inventor. *Edson v. Coffin*, 1 Dec. Com. 58; *Reed v. Roberts*, 1 Dec. Com. 88; *Erbe v. Hill*, 1 Dec. Com. 29; *Wheeler v. Chenoweth*, 1 Dec. Com. 43; *Doty v. Osborne*, 1 Dec. Com. 77; *McClure v. Miller*, 2 Dec. Com. 122; *Wheeler v. Peters*, 2 Dec. Com. 141; *Gray v. Hale*, 3 Dec. Com. 129; *Willcox v. Duncan*, 3 Dec. Com. 195; *Hanvey v. Willard*, 3 Dec. Com. 297; *Hoeltge v. Hoeller*, 3 Dec. Com. 309; *Battee v. Russell*, 3 O. G. 181; *Vinton v. Pierce*, 3 O. G. 629; *Hyatt & French*, 4 O. G. 609; *Bradford v. Corbin*, 6 O. G. 223; *Hart v. Little*, 7 O. G. 962; *Lay v. Wiard*, 9 O. G. 349; *Gross v. Sargent*, 11 O. G. 788.

It is only in these cases in which actual use is necessarily demanded to establish the date of the completion of an invention that it becomes important in determining the question of priority. *Little v. Stephenson*, 3 O. G. 379.

If an inventor has used due diligence throughout, he may date his invention back to the time when he made the drawings for the foreign machine, and will be awarded priority over one who invented afterward. *Lay v. Ballard*, 3 O. G. 687.

A drawing alone is not sufficient to show that the inventor reduced his invention to practice. *Millward v. Barnes*, 11 O. G. 1060.

To prove priority of invention, it is not enough to show that the applicant was engaged upon one of the same character, without proof of its identity. *Black v. Locke*, 1 Dec. Com. 13.

If the invention is simple and single, the one who first discovers it can not be superseded as inventor without proof of laches or abandonment, there being nothing left of its construction for experiment to develop. *Smith & Jordan*, 5 O. G. 89.

The inventor of an apparatus who has reduced it to actual practice and then left it, can not claim improvements upon it, although he may have contemplated them, if he never reduced them to form. *Trotter v. Bartlett*, 7 O. G. 3.

The question of priority will be decided in favor of the party who, before the other made the invention, had produced specimens shown to be like exhibits on file and embodying it. *Clark v. Fletcher*, 1 Dec. Com. 21; *Logan v. Holdiman*, 2 Dec. Com. 45.

The one who first reduces the invention to practice is entitled to the patent if his competitor rests his claim on suggestions, verbal descriptions and lost sketches, though they were made before. *John W. Cochran*, 1 Dec. Com. 30; *Edson v. Coffin*, 1 Dec. Com. 58; *Wood v. Crowell*, 1 Dec. Com. 107; *Hart v. Little*, 7 O. G. 962; *Dana v. Greenleaf*, 9 O. G. 198.

An experimental use of an invention, though continued for three days, and though it worked satisfactorily, is not a reduction of it to practice, if no further use was made of the invention, and it was afterwards lost. *Stoddard & Perry*, 6 O. G. 33.

An imperfect and incomplete invention, resting in mere theory or in uncertain experiments, and not actually reduced to practice and embodied in some machinery, is not patentable. *Lay v. Wiard*, 9 O. G. 349.

Reduction to practice can only be effected by the material embodiment of the invention in the form in which it is designed for use. *Stephenson v. Goodell*, 9 O. G. 1195.

If an adaptation to use, or even use itself, is merely experimental, the invention is not perfected. *Lagowitz v. Topham*, 9 O. G. 742.

If the device does not of itself afford evidence of its capability of use, then the applicant must show that he has put the device to practical use or ascertained its capability of practical use. *Ackerman v. Archer*, 15 O. G. 562.

A reduction to practice is effected by one successful working machine as certainly as by one hundred. *Lake v. Kempster*, 16 O. G. 1187.

A reduction to practice may be effected by means of an experimental working machine as well as in any other way if the result of the experiment is a success. *Packard v. Sandford*, 16 O. G. 1182.

If the inventor who was the first to conceive and the first to reduce to practice abandons his invention before a public use, then a subsequent inventor may claim a patent. *Packard v. Sandford*, 16 O. G. 1182; *Gill v. Scott*, 23 O. G. 25.

In order to defeat a patent it is not necessary for an applicant to show that he conceived the invention and reduced it to practice before the time at which such invention was conceived by the patentee. *McTammany v. Needham*, 18 O. G. 1050.

In order to defeat a patent, an alleged prior machine must be shown to be practically, and not merely experimentally, useful. *Sargent v. Burge*, 11 O. G. 1055.

If the principle of an invention is shown to be practicable in a machine, it is entitled to protection, though the machine is rude and imperfect. *Knight v. Annan*, 3 Dec. Com. 34.

The true date of invention is at the point where the work of the inventor ceases and the work of the mechanic begins. *Cameron v. Brick*, 3 Dec. Com. 89; *Stevens v. Putnam*, 18 O. G. 520.

An invention which consists of a combination of elements is not complete until all the elements are combined. *Samuel C. Moore*, 7 O. G. 697.

A person may prove priority of invention by establishing that he was the first to conceive the idea of the invention and the mode of putting it into practice, and used due diligence in adapting and perfecting it. *Chapman v. Candee*, 2 O. G. 245; *Reisinger v. Clark*, 2 O. G. 339; *Mayhew v. Wardwell*, 1 Dec. Com. 5; *Mowbray v. Shaffner*, 2 Dec. Com. 35; *Eames v. Gill*, 2 Dec. Com. 42; *Leonard v. Runyon*, 2 Dec. Com. 56; *Kissam v. Collins*, 2 Dec. Com. 127; *Jenkins & Norton v. Putman*, 2 Dec. Com. 156; *Edison v. Foote & Randall*, 3 Dec. Com. 80; *Corsett & Lowe v. White*, 3 Dec. Com. 154; *Disston v. Emerson*, 3 Dec. Com. 162; *Ives v. Swan*, 3 Dec. Com. 167; *Smith v. Hopkins*, 3 O. G. 347; *Rice v. Winchester*, 3 O. G. 348; *Hollingsworth v. Burleigh*, 3 O. G. 583; *Perley & Orr*, 5 O. G. 457; *Hammond v. Laird*, 7 O. G. 170; *McBride v. Henderson*, 7 O. G. 300.

The party who first makes a model and applies for a patent with due diligence is the first inventor, although another made the first machine,

for the law rewards the first inventor rather than the first maker. *Morse v. Clarke*, 1 O. G. 275.

If an inventor shows a patentable invention in his application, it is not necessary that he shall prove actual reduction to practice. *Starr v. Farmer*, 23 O. G. 2325.

### Diligence.

As between applicants, the question of reasonable diligence only arises where one conceives the idea of the invention first, and the other is first to perfect and reduce it to practice. *Allen v. Gilman*, 2 O. G. 293; *Erbe v. Hill*, 1 Dec. Com. 29; *Hunt v. Woods*, 1 Dec. Com. 34; *Freeland & Ward v. Trent*, 1 Dec. Com. 93; *Duchemin v. Richardson & Stein*, 2 Dec. Com. 31; *Bradley v. Rafael*, 2 Dec. Com. 50; *Hosea Ball*, 2 Dec. Com. 97.

A race of diligence between two inventors never begins until the date of the later conception. If the one who first conceives the invention is also the first to reduce to practice, the race of diligence ends. *Packard v. Sandford*, 16 O. G. 1182.

When an inventor has reduced his invention to practice, the question of diligence is between him and the public. *McTammany v. Needham*, 18 O. G. 1050.

As between the public and an inventor who reduces his invention to practice in private, there is no obligation of diligence resting on the inventor. It is only when another inventor appears that any such obligation arises. *Packard v. Sandford*, 16 O. G. 1182; *Farmer v. Brush*, 17 O. G. 150.

If the one who is the first to conceive is the one who first reduces the invention to practice, his obligation from that time is not one of diligence as between himself and his competitor. It takes an entirely different form. It is an obligation to the public not to abandon or forget his invention. *Lake v. Kempster*, 16 O. G. 1187; *Packard v. Sandford*, 16 O. G. 1182; *Farmer v. Brush*, 17 O. G. 150.

Diligence in perfecting an invention is a relative term, and the law does not require that an inventor who is engaged in developing a number of improvements at the same time shall devote all his time and energy to one at the expense of the others. *McTammany v. Needham*, 18 O. G. 1050.

Although the first and original inventor is guilty of laches in applying for a patent after the perfection of his invention, yet this will not give a subsequent inventor a right to a patent. *Harmet v. Reese*, 21 O. G. 1875.

Where one is the first to conceive an invention, and the other was the first to reduce it to practice, the claim of the latter is founded upon the reduction to practice, and derives no aid from his previous efforts; but the former must show that he was reasonably diligent from the time of the conception of the invention to its completion. His diligence is not to be compared with that of his competitor, but must stand as an independent fact. *Millward v. Barnes*, 11 O. G. 1060.

An inventor, in order to preserve his rights, is not required to devote all his energies to the development of his invention, to the exclusion of all other matters. The law only demands reasonable diligence. *Munger v. Connell*, 1 O. G. 491.

The party who first made the invention should prevail if he never intended to abandon it, though he did not apply for a patent until his opponent had applied several years afterward. *Rowley v. Mason*, 1 Dec. Com. 4.

An inventor is not prejudiced in his right to a patent by any delay between the making of his invention and the filing of his application, unless meanwhile the invention has gone into public use. *Israel Townsend*, 3 Dec. Com. 60.

To constitute complete invention it must be shown that the device has been used, or that reasonable diligence has been employed in applying it to this last and surest test. *Hanscom v. Latham*, 9 O. G. 1157; *Palm v. Behel*, 10 O. G. 701; *Stephenson v. Goodell*, 9 O. G. 1195.

A prior inventor has lost his right to an invention if he has delayed applying for a patent for an unreasonable time after his competitor obtained one, although he had a caveat pending when the application of the latter was filed. *Kenyon v. Wesson*, 3 Dec. Com. 10; s. c. 3 Dec. Com. 91.

An inventor has not forfeited his invention by delay, who has obtained a patent for it before his competitor applied for one. *Bingham v. Watkins*, 2 Dec. Com. 42, 186.

If a party has forfeited his right to a patent by want of diligence, he is not the prior inventor, and can not, therefore, have abandoned his invention to the public. *Jenkins v. Barney*, 3 O. G. 119.

Although others have applied for a patent to which that sought by the applicant would be subordinate, that furnishes no excuse for his neglecting to make his application for several years. *Wright v. Clay*, 2 Dec. Com. 11.

If an inventor has fully worked out the idea, and shows that he intends to pursue it to a practical use, he is entitled to a reasonable time to perfect and test. *Tingley & Carpenter*, 3 Dec. Com. 236.

Mere delay in applying for a patent after the invention has been perfected will not warrant a judgment of priority in favor of a subsequent inventor. *Traut v. Hawley*, 10 O. G. 979.

If nothing is shown in the evidence to account for an inventor's delay in reducing his invention to practice, he must be held chargeable with want of diligence. *Hovey Hufeland*, 6 O. G. 31.

If an inventor employs an attorney to file his application for a patent, and is deceived by false representations that it was done, the delay thus fraudulently caused is not unreasonable or such as to work abandonment. *Case v. Hastings*, 7 O. G. 557.

If an inventor, after perfecting his invention, keeps it secret, and withholds it from public use until another invents the same thing and applies for a patent therefor, he loses his right to a patent. *Monce v. Adams*, 1 O. G. 1.

If the delay consists merely in forbearing to apply for a patent, the first inventor is entitled to a patent, although he files the application after the application of a subsequent inventor. *Freund v. King*, 11 O. G. 2.

### Utility.

Any invention, however simple, saving time and labor, and not before anticipated, may be awarded a patent. *Geo. Richardson*, 2 O. G. 3; *Samuel Toomey*, 1 Dec. Com. 109; *John P. Harrington*, 2 Dec. Com. 37; *William Brown*, 1 Dec. Com. 45; *W. E. Phelps*, 2 Dec. Com. 48; *A. S. Collins*, 2 Dec. Com. 57; *Arthur Harris*, 2 Dec. Com. 62; *Rutger B. Miller*, 3 Dec. Com. 85; *L. E. Love*, 3 Dec. Com. 276; *Orison Underwood*, 4 O. G. 449.

The utility of an article of manufacture is tested by the advantage gained in its use and the saving effected in its production. *W. Butterfield*, 2 O. G. 88.

Cheapness alone will not confer patentability upon a machine that possesses no other merit. *McLaren & Coventry*, 10 O. G. 335.

If the simpler means consist in the substitution of one mechanical equivalent for another, the difference is not patentable. *Eloi Bouscay, Jr.*, 9 O. G. 743.

A patent may be granted for a distinct part of a device or machine, although it becomes useful only in connection with its corresponding parts. *Johnson*, 18 O. G. 1052.

### **What is Patentable.**

A party who has devised a mode of doing a particular thing so as to dispense with an instrument formerly used, is entitled to a patent for that mode, but not for every mode of doing it without the use of the instrument. *A. Arkell*, 1 O. G. 28.

A claim for a result or effect, and not for the result as produced, is bad. *N. J. Simonds*, 2 Dec. Com. 23; *Beavis*, 16 O. G. 1233.

A functional claim is one that has for its subject the performance of an act merely, and not the means by which that act is executed. *Ignatius Hahn*, 8 O. G. 597.

An improved system of irrigation, constituting an improvement in the art, may be the subject of a patent. *James Y. Carmichael*, 10 O. G. 864.

The products of a new process can not be monopolized unless they can be distinguished from the products of other processes. *Henry Loewenberg*, 1 Dec. Com. 92.

The term manufacture seems to distinguish the thing made from the process or machine by which it is made. *Charles H. Ackerson*, 1 Dec. Com. 74; *William R. Blanchard*, 2 Dec. Com. 59; *L. E. Truesdell*, 2 Dec. Com. 123.

An applicant can not describe a machine which will perform a certain function, and then claim the function itself and all other machines that may be invented for the same purpose. *L. G. Harrison, Jr.*, 10 O. G. 373; *Frederick Roloson*, 15 O. G. 471.

An article of manufacture is patentable only when it is a complete device, ready for use or for sale in the market. *Peter Campbell*, 2 O. G. 644; *Samuel B. Jerome*, 3 O. G. 64; *Augustus Adams*, 3 O. G. 150.

The product of an invention must be regarded as an entirety, and, if new, the applicant is entitled to all the characteristics which it may now be known or may hereafter be discovered to possess. *Herbert W. G. Tweddle*, 10 O. G. 747.

A single device may contain subject-matter for a design patent, and one for a structure patent, that for one being a particular ornamentation, that for the other the structure of the device, involving its mechanical uses. *H. W. Collender*, 2 O. G. 360.

An article of peculiar shape, intended to serve a useful purpose, may be the subject of a patent. *T. T. D. Doolittle*, 2 O. G. 275.

### **Combinations.**

A patentable combination must consist of something more than mere assemblages or arrangement of parts. The parts must act upon each other either mediately or intermediately, so that the action or character of one is affected, influenced or produced by the action or character of the other. *Chas. Van Waggenen*, 1 O. G. 89; *John Burnham*, 1 O. G. 164; *Lewis Miller*, 1 O. G. 431; *Philip E. Ackert*, 1 O. G. 253; *L. B. Prindle*,



1 O. G. 404; Daniel J. La Duc, 1 O. G. 549; Thomas Kerr, 1 Dec. Com. 16; Jones & Boyce, 1 Dec. Com. 16; Joseph Thorne, 1 Dec. Com. 76; John Stephenson, 5 O. G. 363; Clymer & Riley, 6 O. G. 505; H. J. Huttner, 14 O. G. 118; Little *v.* Sargent, 12 O. G. 186; Edward Campbell, 14 O. G. 83; Joseph Funck, 3 McArthur 460; s. c. 14 O. G. 158; Scott *v.* Ford, 14 O. G. 413; Waring *v.* Wilkerson, 15 O. G. 246; Cardwell, 15 O. G. 293; Knowlton, 15 O. G. 343; James Lee, 15 O. G. 512; Ducsh, 16 O. G. 543.

The mere assembling of an aggregation of old devices, each separately performing its own function, into immediate proximity with each other, does not make a combination in a patentable sense. George B. Clarke, 3 Dec. Com. 178; McCormick & Baker, 3 Dec. Com. 246; John H. Coes, 6 O. G. 1; Henry Hooper, 6 O. G. 360; Patrick Fitzgibbons, 10 O. G. 375.

Separate devices or combinations of devices, that have no community of operation in effecting a common result, should not be incorporated in the same application. C. O. Sobinski, 10 O. G. 3; A. L. Bogart, 10 O. G. 113; C. F. Dietrich, 11 O. G. 195.

If the aggregation of the different parts produces a new result, this is decisive of the fact that there has been invention, and that the combination is patentable. J. B. Slawson, 1 O. G. 254.

In order that a combination may be rendered patentable, there must be a novel assemblage of parts exhibiting invention. Lynch *v.* Dryden, 3 O. G. 407; B. S. Baker, 4 O. G. 156.

If the substitution of one material for another, in a combination, produces a new and useful article of manufacture, it is patentable. W. S. Cottrell, 1 O. G. 436.

A combination should be regarded as an entirety, and it can not be said that some of its features have been used to perform their separate functions in other positions and arrangements. Jesse Reynolds, 9 O. G. 744.

Where neither of several parts of a structure affects or influences the action of the other, no legitimate combination exists between them. Thomas J. Flagg, 2 Dec. Com. 104; Benjamin Morse, 3 O. G. 467.

A claim will be refused although the combinations specified embrace a device for which a claim has already been allowed, if the latter ought to have been rejected. Amos Rank, 3 Dec. Com. 235.

It is necessary that a combination should contain all the essential elements to secure some distinct and definable result in the operation of a machine. A. A. Rheutan, 5 O. G. 521; George M. Holmes, 6 O. G. 360.

If a new combination produces an old effect more economically, or a new, or a better effect, and all the elements co-operate in producing it, the combination is patentable. David Eynon, 3 Dec. Com. 239; E. Sampson, 3 Dec. Com. 277; Henry Hooper, 6 O. G. 360; Seeley M. Sherman, 10 O. G. 1054.

It is not every change in the arrangement of the elements of a combination which may form the foundation of a legitimate claim, but only such as are necessary to constitute a valid combination of the same parts. Streeter *v.* Stoddard, 2 Dec. Com. 91.

If devices are in their operation especially adapted to each other, belonging to the same class of inventions, and are used in connection to subserve a common end, they constitute a legitimate combination. Warren Noyes, 8 O. G. 818.

If the combination is new and produces new and useful results, the application for a patent can not be refused. Maurice Fitzgibbons, 3 Dec. Com. 77; Fisk, Clark & Flagg, 3 Dec. Com. 172; James P. Hilliard, 3 Dec. Com. 179; J. M. Stone, 4 O. G. 54; T. N. Foster, 4 O. G. 377; George N. Palmer, 6 O. G. 506; Jas. S. Ray, 7 O. G. 40.

The patentability of a combination is not affected by the circumstance that the elements combined produce distinct subsidiary results, if while producing these subsidiary results, they also co-operate to produce an ultimate result which is different from or the resultant of the several particular results produced by the subordinate combinations. *Glidden v. Copeland*, 15 O. G. 920.

A mechanical combination is not complete so as to be patentable unless it accomplishes some definite result, step or effect, but that effect may either be the aggregate result of the operation of the devices as a whole or a subsidiary result or effect. *Glidden v. Copeland*, 15 O. G. 920.

If a subsequent inventor adds a new element to the combination, he is entitled to a patent on the entire combination subordinate to the claim of the prior inventor. *Hewitt v. Harmon*, 16 O. G. 724.

If the parts are not integral parts of an invariable structure, but are separable and may perform their legitimate functions alone and in other organisms, the combination is patentable although they are united by casting. *Bland*, 15 O. G. 775.

A combination is patentable although it does not include the operating device. *Banks v. Snediker*, 17 O. G. 508.

If a new ingredient is added to an existing composition of matter, and it is thereby materially changed in form and quality, it is patentable. *James & William Horlick*, 7 O. G. 828.

A mere transfer of a combination of elements to a new structure, where it operates in the same way to produce the same result, is not patentable. *Jacob Dunton et al.*, 10 O. G. 243.

The new grouping of devices must be accompanied by evidence of invention, and must produce a new result. *Horace Holt*, 5 O. G. 148; *George W. Morse*, 6 O. G. 763; *John C. Richards*, 9 O. G. 1062.

Where the elements of the combination are old, but the combination itself is new, and all the parts of it co-act to produce the result, there is patentable merit. *S. C. Forsaith*, 1 Dec. Com. 111; *T. N. Foster*, 4 O. G. 377, *John H. Coes*, 6 O. G. 1; *Hosea Ball*, 2 Dec. Com. 110.

A novel arrangement of well-known parts which are specially adapted to co-operate in producing an improved result, shows invention, and is patentable. *Jno. Farrell*, 2 O. G. 340; *Julius King*, 2 O. G. 618; *Blinn v. Gale*, 16 O. G. 723.

A device, which is already patented, does not thereby render a combination embracing it patentable, if it is not improved, and performs no unexpected function. *C. Rubens & Co.*, 2 Dec. Com. 49; *George Petry*, 2 Dec. Com. 105.

If an applicant does not present a combination essentially different from a prior one, a patent will be refused. *George Crompton*, 4 O. G. 82.

A compound consisting of old ingredients arranged in a new manner, and possessing superior qualities, is patentable. *Heide & Wirtz*, 8 O. G. 817.

An assemblage of distinctive individual parts, which is less than a combination of them, falls short of invention. *Benjamin S. Castle*, 4 O. G. 179.

### Process.

The process by which an article is constructed is a matter altogether distinct from the article itself, so far as its patentability is concerned. *Geo. H. Sellers*, 2 O. G. 246; *W. E. Bond*, 1 Dec. Com. 17; *Robert A. Cheesebrough*, 1 Dec. Com. 18.

A patent will not be allowed for a process which is really intended for the adulteration of an article of food. *Morris & Watson*, 2 Dec. Com. 71; *Peter W. Weida*, 6 O. G. 681.

A process is an entirety and consists in certain steps taken to produce a certain result, each step being necessary for the production of the desired result. It is not consistent with such an invention to split it up and make the different steps of the process subjects of separate claims. *Wheat*, 16 O. G. 360.

A process is not patentable unless there is some new and useful mode of operation or some new result arising from the special adaptation of the old apparatus to the new purpose. *H. J. Huttner*, 14 O. G. 118.

If there is a mere aggregation of processes, each accomplishing its well known result independently of the other, the combination is not patentable. *Rice v. Burt*, 17 O. G. 799.

### Abandonment.

Abandonment can only be established by positive proof, and not by mere presumption or inference. *Russell & Scow*, 5 O. G. 149; *Stephen Hull*, 9 O. G. 1; *Cushman v. Parham*, 9 O. G. 1108; *Hockausen v. Watson*, 18 O. G. 857.

The question of abandonment is not one of mere mental operation. A mere mental purpose or intention to give the public at some future time the benefit of a completed invention unaccompanied by any corresponding acts or words amounts to nothing, and the presumption raised by the acts of the party of a purpose to abandon will not be overcome by his testimony that he mentally intended not to abandon it. *Farmer v. Brush*, 17 O. G. 150.

Abandonment is the cessation of all effort to furnish the invention for public use. Such abandonment may be voluntary and absolute, as when the invention is deliberately thrown aside with a purpose never to resume it, but it may also occur when the invention is thrown aside not with a purpose never to resume it but without any purpose to resume it. *Farmer v. Brush*, 17 O. G. 150.

Neglect to confer the benefits of the invention on the public, whether it is or is not accompanied by neglect to apply for a patent, is evidence of an abandonment. *Farmer v. Brush*, 17 O. G. 150.

Testimony as to an intent not to abandon will be construed in connection with the acts of the party, and although it may throw light upon such acts and taken in connection with them may determine their meaning and effect, yet it will not be always decisive when contradictory rather than explanatory of such acts. *Farmer v. Brush*, 17 O. G. 150.

If the inventor keeps his invention secret or abandons it, his rights when he seeks the benefit of it do not relate back through the intermediate interval to the original invention so as to give him the benefit of its date as against a rival inventor. *Farmer v. Brush*, 17 O. G. 150.

If an inventor requests that the patent shall not be issued, but kept in the secret archives of the office, and then lies by for a long time until the public obtain possession of the invention, he will be deemed to have abandoned it. *Woodbridge*, 15 O. G. 564.

Abandonment will not arise from mere lapse of time, and will not be presumed where the invention is not in public use, and the applicant is the first inventor. *Woerd v. Bacon*, 1 Dec. Com. 16; *Gillet v. Gillis*, 1 Dec. Com. 68; *Dickson v. Kinsman*, 18 O. G. 1224.

The law permits such use of an invention before applying for a patent as will fully demonstrate whether it is or not useful and practical. *Channing & Farmer*, 3 Dec. Com. 114; *Baldwin v. Bigelow*, 7 O. G. 1011.

To constitute forfeiture of the right to a patent, the negligence of the applicant must amount to such acquiescence in the use of the invention or in the claim by another as its inventor that he is estopped from asserting title in himself. *Green v. Field*, 16 O. G. 587.

If the inventor held the article for sale more than two years before his application, he is not entitled to a patent, although he did not make a shipment until after that time. *Hubbard v. Myers*, 16 O. G. 1051.

It is not necessary that the use should have been a continuing use, extending over more than two years prior to the application, to render a patent void; it is sufficient if it be a public use or sale. *Young v. Hoard*, 2 Dec. Com. 59; *Charles W. Jenkins*, 4 O. G. 351.

If an inventor, by express acts, has raised a strong presumption that he intended to abandon his invention, in order to revive his right he must file a new application. *Timothy Gordon*, 6 O. G. 543.

If a model is destroyed, and the inventor perfects other devices for producing the same results, it affords strong presumptive evidence of an abandonment of the invention shown in such model. *Barnes v. Clinton*, 9 O. G. 1158.

Parties acting as principal and agent in the sale of an article more than two years before filing their application, are equally prevented from obtaining a patent, without regard to which may be the actual inventor. *Keller et al. v. Felder*, 10 O. G. 944.

A public use of an invention must always be distinguished from a merely experimental one, and any use which can reasonably be regarded as experimental should be so held. *Charles W. Jenkins*, 4 O. G. 351.

The mere fact that a patent was granted to another more than two years before the application of the real inventor, is not fatal to his claim. *Page v. Bowers*, 1 O. G. 521.

The abandonment of an invention by sale for more than two years prior to the filing of an application is not established by inferences in the absence of clear proof as to dates. *Massey v. Sawyer*, 8 O. G. 557.

An invention which has been completed and in use seven years before the original application was filed, but not claimed in the patent sought to be reissued, and which has been embodied meanwhile in other patents, has been abandoned. *Doty v. Osborne & Ballard*, 1 Dec. Com. 77.

If a subsequent inventor alleges an abandonment by a prior inventor, the burden of proof is on him. *Lake v. Kempster*, 16 O. G. 1187.

A subsequent inventor is not entitled to a patent whether the prior inventor abandoned the invention to the public or not. *Young v. Van Dusen*, 16 O. G. 95.

### **Description.**

A published description of an invention is sufficient, notwithstanding the testimony of experts that a mechanic could not construct the instrument from it. *Taylor & Banks*, 2 O. G. 519.

A pattern book, without any descriptive matter contained in it, can not be regarded as a printed publication, such as is contemplated as being a bar to the issue of a patent. *T. B. Atterbury*, 9 O. G. 640.

An invention can not be held to antedate patents granted before the application, on the ground that it was described in a still earlier application, if it was there described as connected with an essential device which is now omitted. *James R. McClintock*, 2 Dec. Com. 64.

A rejected application will not be considered a bar to a new application for a patent for the same invention by another party. *Rouse & Stoddard*, 7 O. G. 169; *Brown v. Guild*, 6 O. G. 392; *Crane v. Whitehead & Ather-ton*, 7 O. G. 219; *S. B. Sexton*, 9 O. G. 251.

A subsequent inventor can not be allowed to patent a device clearly shown in any part of the application for a prior patent. *Edward Strain*, 2 Dec. Com. 150; *Thos. J. Magruder*, 3 Dec. Com. 104; *E. Wheeler*, 4 O. G. 3.

A description in a reissued patent is sufficient, although the matter was improperly introduced on the reissue. *George Richardson*, 7 O. G. 1053.

SEC. 4887. No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented, or caused to be patented, in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years.

*Statute Revised*—July 8, 1870, ch. 270, § 25, 16 Stat. 201.

*Prior Statutes*—July 4, 1836, ch. 357, § 8, 5 Stat. 120.—March 3, 1839, ch. 88, § 6, 5 Stat. 354.

The provisions of this section relate to patents which are applied for here after the issue of a foreign patent. *French v. Rogers*, 1 Fish. 133; *American Leather Co. v. American Tool Co.*, 1 Holmes 503; s. c. 4 Fish. 284.

A foreign inventor may obtain a valid patent, although his foreign patent is void. *Cornley v. Marckwald*, 24 O. G. 498; 17 Fed. Rep. 83.

An applicant whose invention has been patented abroad must state that fact and give the date of any and all such foreign patents. *Ex parte Bland*, 15 O. G. 828.

Although the application was filed before the filing of the application for a foreign patent, yet if the foreign patent is granted first the patent must be limited so as to expire with the foreign patent. *Bate Refrig. Co. v. Gillett*, 22 O. G. 1205; s. c. 13 Fed. Rep. 553.

A patent is not void because it runs for a period of seventeen years instead of seventeen years from the date of the foreign patent. *O'Reilly v. Morse*, 15 How. 62; *Goff v. Stafford*, 14 O. G. 748; s. c. 3 Ban & Ard. 610; *DeFlorez v. Reynolds*, 17 Blatch. 426; s. c. 17 O. G. 503; s. c. 4

Ban & Ard. 140 ; s. c. 8 Fed. Rep. 434 ; *Contra*, Paillard *v.* Gautschie, 20 O. G. 1893 ; Smith *v.* Ely, 5 McLean 76 ; s. c. 15 How. 137.

The American patent will expire at the same time with the foreign patent, but can not exceed the term of seventeen years. Weston *v.* White, 13 Blatch. 364 ; s. c. 9 O. G. 1196 ; s. c. 2 Ban & Ard. 321 ; Nathan *v.* N. Y. Elevated R. R. Co., 5 Ban & Ard. 280 ; s. c. 2 Fed. Rep. 225 ; Tilghman *v.* Proctor, 102 U. S. 707 ; s. c. 19 O. G. 859 ; American D. R. B. Co. *v.* Sheldon, 17 Blatch. 303 ; s. c. 4 Ban & Ard. 603 ; Siemens *v.* Sellers, 23 O. G. 2234.

An American patent must be limited so as to expire at the same time as a prior foreign patent, whether the foreign patent is a secret or a public patent. Gramme E. Co. *v.* Arnoux & H. E. Co., 25 O. G. 193.

If an American patent is issued after the issue of a foreign patent, it expires on the same day as the foreign patent, although the application was filed before the application for the foreign patent. Gramme E. Co. *v.* Arnoux & H. E. Co., 25 O. G. 193.

Congress employs the words "the foreign patent," evidently referring to the term of the foreign patent to define the term of the domestic patent. This provision does not include any subsequent prolongation or extension of the monopoly beyond what was then vested in the foreign patentee. Henry *v.* Providence Tool Co., 14 O. G. 855 ; s. c. 3 Ban & Ard. 501.

Although the foreign patent has been extended, yet the patent expires with the expiration of the original term. Bate Refrig. Co. *v.* Gillett, 22 O. G. 1205 ; s. c. 13 Fed. Rep. 553 ; Henry *v.* Providence Tool Co., 14 O. G. 855 ; s. c. 3 Ban & Ard. 501 ; Reissner *v.* Sharp, 16 Blatch. 383 ; s. c. 16 O. G. 355 ; s. c. 4 Ban & Ard. 366.

If the patent was granted prior to 1870 it will not expire when the foreign patent becomes void from the omission to pay the annual fee, nor will a reissue granted after that time be void. Anilin Fabrik *v.* Hamilton Manuf. Co., 13 O. G. 273 ; 3 Ban & Ard. 235.

The provisions of this section evidently refer to the fact that the invention has been patented by the inventor himself. Kendrick *v.* Emmons, 9 O. G. 201 ; s. c. 2 Ban & Ard. 208.

If a person surreptitiously, without the knowledge or authority of the inventor, takes out letters patent in a foreign country, he can not thereby deprive the inventor of any of his rights. Kendrick *v.* Emmon, 9 O. G. 201 ; s. c. 2 Ban & Ard. 208.

The mere fact that a patent has been issued does not of itself prove the introduction into common use without the necessity of other testimony. Weston *v.* White, 13 Blatch. 364 ; s. c. 9 O. G. 1196 ; s. c. 2 Ban & Ard. 321.

If the invention was first patented in a foreign country, the patent in this country is void if the invention was in public use for more than two years prior to the application for it. Henry *v.* Providence Tool Co., 14 O. G. 855.

If the thing patented is used in public for more than two years prior to

the application for the patent the patent is void, although the use was not by the public generally. *Henry v. Providence Tool Co.*, 14 O. G. 855; s. c. 3 Ban & Ard. 501.

An applicant may be required to state whether or not he has a patent in a foreign country. *U. S. v. Marble*, 22 O. G. 1365.

If the applicant has taken out a foreign patent for his invention he may be required to state the fact and give the date of the patent. *Toufflin*, 15 O. G. 657; *Anon.* 21 O. G. 1197.

The American patent need not be confined to the precise matter covered by the foreign patent. *C. W. Siemens*, 11 O. G. 969.

If the patent includes some claims that are covered by a foreign patent, it may be issued subject to the limitation arising from the foreign patent without a division of the application. *Unsworth*, 15 O. G. 882.

If new features are added to those of the foreign patent, and in combination therewith, a limitation of the grant can not be made, but in such case specific mention should be made of the part patented abroad by particular reference to the date and number of the foreign patent, if the matter is separately claimed. *C. W. Siemens*, 11 O. G. 979.

If the application includes the same subject-matter as the foreign patent, with immaterial variations, the patent should be limited to expire at the same time with the foreign patent. *C. W. Siemens*, 11 O. G. 969.

If the proper restriction in the grant can be accomplished by a division of an application, such division should be required. *C. W. Siemens*, 11 O. G. 979.

If a patent is made up of separate and distinct inventions, each of which is the subject of a foreign patent, and the foreign patent for one part either expires or is forfeited for non-payment of a tax thereon, the patentee may either obtain a reissue or file a disclaimer, and thus abandon the claim to such part. *I. L. Pulvermacher*, 10 O. G. 2.

Upon the allowance of a patent, the examiner should enter on the file wrapper the fact that a foreign patent has been granted and the date of the same, or, if more than one, the date of the earliest to expire. *C. W. Siemens*, 11 O. G. 979.

The facts that may be before the commissioner touching the existence and date of a foreign patent for the same invention should be inserted in the patent. *Anon.* 21 O. G. 1197; *C. W. Siemens*, 11 O. G. 979.

An application for a reissue must state whether a foreign patent has or has not been obtained. *Beck*. 17 O. G. 329.

A reissue should state the date and number of the foreign patent the same as an original patent. *C. W. Siemens*, 11 O. G. 1107.

The date upon which the completed specifications were filed and patent sealed will be considered the date of a foreign patent. *Chambers et al. v. Duncan et al.*, 9 O. G. 741; *Chambers et al. v. Duncan et al.*, 10 O. G. 787; *James Cochran*, 1 Dec. Com. 60; *Edward Maynard*, 1 Dec. Com. 54; *Eades v. Jewsbury*, 1 Dec. Com. 90; *Robert Mushet*, 2 Dec. Com. 106.

Where an applicant seeks letters patent for an invention already patented abroad, his American patent, if issued, will be limited to seventeen years from the date of the grant of the foreign patent. *Hermann v. Gilmore*, 1 Dec. Com. 23; *Eades v. Jewsbury*, 1 Dec. Com. 90.

If an application is not made here within six months after the invention was patented abroad, the term of the patent should be the usual time from the date of the foreign patent. *James Cochran*, 1 Dec. Com. 60.

A foreign patent granted after the patentee files his American application, but before he obtains his American patent, does not limit the term of the American patent. *Mann*, 17 O. G. 330.

Where an applicant seeks letters patent for an invention already patented by him abroad, and there is a single well-authenticated instance of a use in public, it constitutes a legal "public" use, and the application will be refused. *Hermann v. Gilmore*, 1 Dec. Com. 23.

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

*Statute Revised*—July 8, 1870, ch. 230, § 26, 16 Stat. 201.

*Prior Statutes*—April 10, 1790, ch. 7, § 2, 1 Stat. 110.—February 21, 1793, ch. 11, § 1, 1 Stat. 318.—July 4, 1836, ch. 357, § 6, 5 Stat. 119.

### **Character of Proceeding.**

The authority of the commissioner to issue grants is not in the nature of jurisdiction in its common and technical acceptation. He issues the grant when he has evidence satisfactory to his own mind that the claimant is entitled to receive it. But that adjudges nothing as to the real right. That question is unaffected, and remains to be examined and decided between parties contesting it without prejudice or advantage from the letters patent. *Wilder v. McCormick*, 2 Blatch. 31; *Potter v. Stevens*, 2 Fish. 163; *Grant v. Raymond*, 6 Pet. 218; s. c. 1 Robb 604.

All the proceedings in the patent office on the subject of patents are *ex parte*, except in the case of interfering applications. The department



acts rather ministerially than judicially, and upon the representation of the applicant, without entering into an examination of the question of right. *Morris v. Huntington*, 1 Paine 348; s. c. 1 Robb 448; *Potter v. Stevens*, 2 Fish. 163.

The commissioner in issuing patents may be considered as a ministerial officer. If the prerequisites of the law are complied with, he can exercise no judgment on the question whether the patent shall be issued. *Grant v. Raymond*, 6 Pet. 218; s. c. 1 Robb 604.

### **Clearness.**

It is not necessary that an inventor shall reduce his invention to practical use before the patent is obtained. No such condition is required by the statute. It is enough that the inventor has perfected his invention, and is able to furnish to the patent office such specifications and model as the law requires. *Wheeler v. Clipper Co.*, 6 Fish. 1; s. c. 10 Blatch. 181; 2 O. G. 442.

The requirements of this section are prerequisites to the granting of the patent, and unless the prerequisites are complied with, a party sued for the infringement of a patent may show that they have not been complied with, and in that way defeat the patent. They are conditions precedent to the right of the commissioner to grant a patent. *New York v. Ransom*, 23 How. 487; s. c. 1 Fish. 252; *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Latta v. Shawk*, 1 Fish. 465; s. c. 1 Bond 259; *Grant v. Raymond*, 6 Pet. 218; s. c. 1 Robb 604.

The specification has two objects: One is to make known the manner of constructing the machine, if the invention is of a machine, so as to enable artisans to make and use it, and thus to give the public the full benefit of the discovery after the expiration of the patent. The other is to put the public in possession of what the party claims as his own invention, so as to ascertain if he claim anything that is in common use, or is already known, and to guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented. *Evans v. Eaton*, 7 Wheat. 356; s. c. 2 Wash. C. C. 443; s. c. 1 Robb 193, 336; *Forbes v. Barstow Stove Co.*, 2 Cliff. 379; *Mabie v. Haskell*, 2 Cliff. 507; *Conover v. Roach*, 4 Fish. 12.

It makes no difference whether the effect is produced by mechanical principles, or by chemical agency, or by the application of discoveries in natural science, as in either case the requirement of the statute is imperative that the patentee must describe the method, process, or means he employs in full, clear, and exact terms, and the end which the invention accomplishes. *Mitchell v. Tilghman*, 4 Fish. 599; s. c. 19 Wall. 287; 5 O. G. 299; s. c. 9 Blatch. 1; s. c. 2 Fish. 518.

The specification must be perfect of itself, and can not be aided by reference to other matters. *Head v. Stevens*, 19 Wend. 411.

The law confers an exclusive patent right on the inventor of anything new and useful, as an encouragement and reward for his ingenuity, and for the expense and labor attending the invention. But this monopoly

is granted for a limited term only, at the expiration of which the invention becomes the property of the public. Unless, therefore, such a specification were made as would at all events enable other persons of competent skill to construct similar machines, the advantages to the public which the statute contemplates would be defeated. It is not necessary, however, that the specification should contain an explanation level with the capacities of every person; but it should be expressed in such full, clear, and exact terms, that a person skilled in the art or science of which it is a branch, would be enabled to construct the patented invention. *Lowell v. Lewis*, 1 Mason 182; s. c. 1 Robb 131; *Wintermute v. Redington*, 1 Fish. 239; *Brooks v. Jenkins*, 3 McLean 432; *Page v. Ferry*, 1 Fish. 298; *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Teese v. Phelps*, 1 McAl. 48; *Westlake v. Cartter*, 6 Fish. 519; s. c. 4 O. G. 636; *Lamb v. Hamblen*, 11 Fed. Rep. 722; *Loom Co. v. Higgins*, 105 U. S. 580; s. c. 21 O. G. 2031; 16 O. G. 675; s. c. 15 Blatch. 446; s. c. 4 Ban & Ard. 88; *Smith v. Pryor*, 2 Saw. 461; s. c. 4 O. G. 633; s. c. 6 Fish. 469; *Stillwell & B. Manuf. Co. v. Cin. G. & C. Co.*, 7 O. G. 829; s. c. 1 Ban & Ard. 610.

The skill and knowledge deemed competent is that which is addressed to the subject-matter, and is not the highest skill or the greatest knowledge, but that of practical workmen of ordinary skill in the particular business. *Page v. Ferry*, 1 Fish. 298; *Smith v. O'Connor*, 6 Fish. 469; s. c. 2 Saw. 461; 4 O. G. 633; *Mabie v. Haskell*, 2 Cliff. 507; *Lippincott v. Kelly*, 1 West. L. J. 513.

The description need not be so clear as to be understood by an individual wholly unskilled in the structure of machines. *Brooks v. Bicknell*, 3 McLean 250; s. c. 2 Robb 118; *Many v. Sizer*, 1 Fish. 17; *Mowry v. Whitney*, 3 Fish. 157; s. c. 4 Fish. 141; 5 Fish. 496; 14 Wall. 620; 2 Bond 45; *Forbes v. Barstow Stove Co.*, 2 Cliff. 379.

Unless on the mere description of the thing itself, its utility and the manner of its use are obvious, the patentee should always describe the manner of its employment to make it useful, so that a mechanic of proper skill can not only construct the thing itself, but can give it practical application to the purpose for which it is useful. *Eddy v. Dennis*, 95 U. S. 560; s. c. 4 Fish. 423.

In determining whether the specification is sufficiently full, clear and exact to enable any person skilled in the art to construct the machine, the jury are to look at the models and drawings as well as the specification, and also to the state of the art at the time of the invention. *Singer v. Walmsley*, 1 Fish. 558; *Earle v. Sawyer*, 4 Mason 1; s. c. 1 Robb 491; *Hogg v. Emerson*, 6 How. 437; s. c. 2 Blatch. 1; 11 How. 587; s. c. 2 Robb 655; *Burrall v. Jewett*, 2 Paige 134.

If from the specification and the drawings taken together, any person skilled in the art could construct and use the device therein described without invention of his own, which would attain the result claimed for it in the patent, then the patent is good, although there may be a mistake in describing the action of some part of the device, but which mistake could

be easily discovered by the mechanic when he came to examine the same. *Singer v. Walmsley*, 1 Fish. 558.

A patentee has the right to assume that those who desire to understand all the conditions under which the invention can be operated, are acquainted with the preceding state of the art immediately connected with this particular subject. *Tompkins v. Gage*, 2 Fish. 577; s. c. 5 Blatch. 268.

An intelligent mechanic is chargeable with a knowledge of the state of the art in relation to the subject upon which he is called to exercise his skill. *Treadwell v. Parrott*, 3 Fish. 124; s. c. 5 Blatch. 369.

The specification need not describe that which is within the ordinary knowledge of any workman who may be employed to put up the apparatus or construct the machine. Such a workman, however, must have a competent knowledge of the work; that is, technically, be what the law calls an expert. *Page v. Ferry*, 1 Fish. 298; *Monce v. Adams*, 12 Blatch. 1; s. c. 7 O. G. 177; s. c. 1 Ban & Ard. 126; *Pearce v. Mulford*, 102 U. S. 112; s. c. 18 O. G. 1223; s. c. 2 Ban & Ard. 190; 13 Blatch. 173; s. c. 9 O. G. 204; *Kneass v. Schuylkill Bank*, 4 Wash. C. C. 9; s. c. 1 Robb 303.

The utmost precision in the description of a machine is not to be expected, nor is it essential. Parts of machinery and processes generally known, need not be described. A wedge, pulleys, rollers, rack and pinion, and other things known to all mechanics, will be supplied by the mechanic without stating their size or structure. Nor is it essential to state the proportionate parts of a machine, nor the velocity of its operation. These are matters of adjustment for the eye and judgment of the constructor. Whether a machine be large in its parts or small, its motion slow or quick, makes no difference in the principle of it. By a detailed description of things generally known, and not essential to the invention, the statement is rendered more prolix and less perspicuous. *Brooks v. Jenkins*, 3 McLean 432.

Absolute precision as to details is not required in the specification. It is only intended as a guide, but it is not the sole instructor. The special skill of the mechanic, derived from familiarity with the art, may be applied in aid of the instruction given by the specification, and this skill may be exerted to modify any direction in the specification as to the matters of mere adjustment or adaptation of the invention to its intended use. *Dorsey Co. v. Marsh*, 6 Fish. 387; s. c. 9 Phila. 395.

When the patent is for a new manufacture, the law does not require that all its constituent parts shall be described. The description is sufficient if it enables those who use it and deal in it, to recognize it. *Anilin Fabrik v. Higgin*, 14 O. G. 414; s. c. 15 Blatch. 219; s. c. 3 Ban & Ard. 462.

The definiteness of a specification must vary with the nature of its subject. Addressed, as it is, to those skilled in the art, it may leave something to their skill in applying the invention, but it must not mislead them. *Mowry v. Whitney*, 5 Fish. 513; s. c. 14 Wall. 434; 1 O. G. 499.

The statute must have a fair and reasonable construction. If the invention can be constructed by the exercise of skill and judgment on the

part of a mechanic, the specification is sufficient. In carrying out any invention, the exercise of some skill and judgment on the part of the mechanic called to construct it, will always be required. Something must necessarily be left to him. If with the exercise of ordinary intelligence and skill, the invention can be constructed from the information given by the patent, the specification answers the requisite of the statute. *Judson v. Moore*, 1 Fish. 544; s. c. 1 Bond 285; *Swift v. Whisen*, 3 Fish. 343; s. c. 2 Bond 115; *Mowry v. Whitney*, 5 Fish. 513; s. c. 14 Wall. 434; 1 O. G. 499.

If a part is omitted which is so common and obvious as to suggest itself to any competent mechanic, this omission will not vitiate the patent. *Union Paper Bag Co. v. Nixon*, 6 Fish. 402; s. c. 4 O. G. 31; *Stillwell & B. Manuf. Co. v. Cincinnati Gas Co.*, 7 O. G. 829; s. c. 1 Ban & Ard. 610.

It is not essential that the inventor shall be sufficiently learned to thoroughly understand or accurately state, the philosophy of a process which he has invented and reduced to practical use. *Cahill v. Beckford*, 1 Holmes 48.

If the specification sets forth the thing to be done in such a manner that it can be reproduced, it need not set forth the scientific principle upon which the operation depends. *Andrews v. Cross*, 19 O. G. 1705; s. c. 19 Blatch. 294; s. c. 8 Fed. Rep. 269.

If eulogiums on the invention are fraudulently inserted to mislead and operate to deceive others in regard to the actual construction of the thing claimed and the mode of applying it to use, they may render the patent void, but where the thing is correctly described, notwithstanding such exaggerations, they are immaterial. *Aultman v. Holley*, 6 Fish. 534; s. c. 11 Blatch. 317; 5 O. G. 3.

The patentee is not confined to technical words, but should rather employ those in popular use and better understood by all. The fewer technical terms are used the better, if the subject is intelligible without them. *Hovey v. Stevens*, 3 W. & M. 17; s. c. 2 Robb 567.

The specification must be complete in its description of the invention. No defects can be obviated by extraneous evidence at the trial. *Brooks v. Jenkins*, 3 McLean 432; *Dixon v. Moyer*, 4 Wash. C. C. 68; s. c. 1 Robb 324.

If the construction of the machine demands the solution of a problem that requires experiment, the specification is void. *Loom Co. v. Higgins*, 105 U. S. 530; s. c. 16 O. G. 675; s. c. 15 Blatch. 446; s. c. 4 Ban & Ard. 88.

Where a useful result is produced by the use of certain means for which the inventor or discoverer obtains a patent, the means described must be the essential and absolutely necessary means, and not mere adjuncts which may be used or abandoned at pleasure. *Russell v. Dodge*, 93 U. S. 460; s. c. 11 O. G. 151.

If the patentee has discovered much and discloses little, he patents no more than he claims. He will not be allowed afterward, when the extent of his right shall be the subject of controversy, either by expanding into

a general expression what was limited before in a particular form, or by tracing the line that leads back from consequences to remote causes, to infer the radical mystery of his invention, and then argue that he had described it by implication from the first, and so claim ownership of it in his patent. *Detmold v. Reeves*, 1 Fish. 127.

Against the practical demonstration of the sufficiency of the specification afforded by the actual construction of the machine, argumentative speculation, reinforced though it may be by the untested opinions of experts, will be of little avail. *Dorsey Co. v. Marsh*, 6 Fish. 387; s. c. 9 Phila. 395.

A reference to the specification as embodying the substantial form of the invention is proper, if it does not introduce confusion and uncertainty, and is often necessary for restraining the too great generality or enlarging the literal narrowness of the claim. *Brown v. Guild*, 23 Wall. 181; s. c. 6 O. G. 392; 7 O. G. 739.

A specification is not defective for want of certainty and clearness, if a fixed rule is given, although it declares that the rule may to some extent be safely departed from. *Tilghman v. Werk*, 2 Fish. 229; s. c. 1 Bond 511.

One patent can not derive any aid or support from a subsequent patent to the same inventor. *Wheeler v. Clipper Co.*, 6 Fish. 1; s. c. 10 Blatch. 181; 2 O. G. 442.

A remote and extreme defect will not be seized hold of for the purpose of destroying an ingenious and useful invention. *Blanchard's Factory v. Warner*, 1 Blatch. 258.

### Mode of Construction.

The inventor is bound so to describe his invention that the article can be made by one skilled in the art, and it is his duty to describe the best mode which he knows. *Magic Ruffle Co. v. Douglass*, 2 Fish. 330; *Page v. Ferry*, 1 Fish. 298.

It is not incumbent upon the patentee to suggest all the possible modes by which his design can be carried out. It is sufficient for him to state the modes which he contemplates to be best, and to add that other mere formal variations from these modes he does not deem to be unprotected by his patent. *Carver v. Braintree Manuf. Co.*, 2 Story 432; s. c. 2 Robb 141; *Dibble v. Augur*, 7 Blatch. 86; *Blanchard v. Eldridge*, 2 Whart. Dig. 358.

If the inventor describes his invention so that a person skilled in the art can make it, and attempts *bona fide* to describe the best mode to make it, and fails, this does not avoid his patent. *Magic Ruffle Co. v. Douglass*, 2 Fish. 330.

The patentee need not specify the kind of power to be employed, or the method of applying it in working the machine. *Carr v. Rice*, 1 Fish. 198; *Lippincott v. Kelly*, 1 West. L. J. 513.

If no particular mechanical means are claimed for the mode of applying

power in working the machine, the patentee is at liberty to use any known to mechanics skilled in machinery of that particular kind, and not requiring invention to prepare or apply it. *Carr v. Rice*, 1 Fish. 198; *Waterbury Brass Co. v. Miller*, 5 Fish. 48; s. c. 9 Blatch. 77.

It is not essential that the patentee should state of what material every part of the machine should be made. The principle is the same whether such part be composed of wood or metal. *Brooks v. Bicknell*, 3 McLean 250; s. c. 2 Robb 118.

A specification which extends to the material is ill-advised unless it adds, as is usual, that it claims the invention if made of any other material in the form described. *Aiken v. Bemis*, 3 W. & M. 348; s. c. 2 Robb 644.

In patents for machines, it is usual to say that the parts may be made of any suitable materials, and that means known materials. But even if it does not, a person who should afterwards discover a new material, would have no right to make the machine; and the inventor is protected against a machine when made of any such material, though the second inventor should have the exclusive right to the new material. In patents for machines, the patentee by such a phrase intends to point out that the arrangement or combination does not depend on the use of the precise material, where others may serve the purpose. *Washing Machine Co. v. Lincoln*, 4 Fish. 379.

If an invention is both new and useful, it can not be impeached because it does not accomplish all that a sanguine inventor has claimed for it. *Eames v. Cook*, 2 Fish. 146.

### Claim.

The statute requires that the invention shall be particularly specified for the purpose of warning an innocent purchaser or other person using the machine of his infringement, and at the same time of taking from the inventor the means of practicing upon the credulity or fears of other persons, by pretending that his invention was different from its ostensible objects. *Brooks v. Fisk*, 15 How. 212; *Merrill v. Yeomans*, 11 O. G. 970; s. c. 94 U. S. 568; s. c. 5 O. G. 267; s. c. 1 Ban & Ard. 47; s. c. 1 Holmes 331; *Gottfried v. P. Best B. Co.*, 17 O. G. 675; s. c. 5 Ban & Ard. 4; *Delaware C. & I. Co. v. Packer*, 24 O. G. 1273.

The magnitude and variety of interests involved in patents require accuracy, precision, and care in the preparation of all the papers on which the patent is founded. The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights. *Merrill v. Yeomans*, 1 Holmes 331; s. c. 11 O. G. 970; 5 O. G. 267; s. c. 94 U. S. 568; s. c. 1 Ban & Ard. 47; *Hovey v. Stevens*, 3 W. & M. 17; s. c. 2 Robb 567.

It is the duty of the inventor to describe each modification of his invention in the specification. *Sargent v. Carter*, 1 Fish. 277.

The specification must distinctly indicate the parts or features of a machine which are essential to the production of the proposed result. If

they are not described, whether they relate to the construction or the mere adjustment of a machine, their use by others is not unlawful. *Barry v. Gugenheim*, 5 Fish. 452; s. c. 1 O. G. 382.

Where a patentee, in his specification, states and sums up the particulars of his invention, he is confined to such summary, and can not afterwards be permitted to sustain his patent by showing that some part which he claims in his summing up as his invention, though not his invention, is of slight value or importance in his patent. *Moody v. Fiske*, 2 Mason 112; s. c. 1 Robb 312.

In anomalous cases, as, for instance, when a new product has been discovered, and the process of compounding it or obtaining it is disclosed, the patentee, by stating his discovery and revealing his process, does all that he is required to do or can do. The careful separation of new from old, the limitation of claims to particular parts or combinations, can not be required as a substantial part of the specification. If a specification sets forth a discovery, a new composition of matter, and the process for compounding it, that should be taken as the extent of his claim and the measure of franchise. *Goodyear v. Central R. R. Co.*, 1 Fish. 626; s. c. 2 Wall. Jr. 356.

The nature of the invention must be considered, to see whether its form and its substance are separable. If they are separable, then the inventor, unless he disclaims other forms, is deemed to claim every form in which his invention may be copied. *Murphy v. Eastham*, 5 Fish. 306; s. c. 1 Holmes 113; 2 O. G. 61.

A patentee can only claim the differences and advantages which he has specified. *McCloskey v. Du Bois*, 20 O. G. 371; s. c. 19 O. G. 1286; s. c. 19 Blatch. 205; s. c. 8 Fed. Rep. 710.

If a claim embraces the same elements as a preceding claim with the addition merely of a feature that is an incident to the machine set forth in the preceding claim, it is void. *Combined Can Co. v. Lloyd*, 11 Fed. Rep. 149; 39 Leg. Int. 82.

### Composition.

A patent for a new composition of matter should state the component parts of the invention claimed with clearness and precision, and not leave the person attempting to use the discovery to find it out by experiment. *Tyler v. Boston*, 7 Wall. 327; *Jenkins v. Walker*, 5 Fish. 347; s. c. 1 Holmes 120; 1 O. G. 359.

If the amount of an article in a compound may be varied within pretty wide limits without affecting the result except in degree, and this can be ascertained readily without experiment, then a direction to use a "small quantity" is sufficiently clear and certain. *Bowker v. Dows*, 15 O. G. 510; s. c. 3 Ban & Ard. 518.

If a general rule for the proportions in which the ingredients are to be used is given, it is sufficient. In most compositions of matter some small difference in the proportions must occasionally be required, since the in-

redients proposed to be compounded must sometimes be, in some degree, superior or inferior to those most commonly used. *Wood v. Underhill*, 5 How. 1; s. c. 2 Robb 588; *Goodyear v. Wait*, 3 Fish. 242; s. c. 5 Blatch. 468; *Francis v. Mellor*, 5 Fish. 153; s. c. 8 Phila. 157; 1 O. G. 48; 5 A. L. T. 237.

When the specification of a new composition of matter gives only the names of the substances which are to be mixed together, and states the relative proportions vaguely or ambiguously, the patent is void. *Jenkins v. Walker*, 5 Fish. 347; s. c. 1 Holmes 120; 1 O. G. 359.

If the invention can not be used with advantage in any case without first ascertaining by experiment the proportion of the ingredients to be employed, it is not patentable, because by the terms of the statute the inventor is not entitled to a patent unless his description is so full, clear, and exact as to enable any one skilled in the art to compound and use it. If from the nature and character of the ingredients to be used they are not susceptible of such exact description, the inventor is not entitled to a patent. *Wood v. Underhill*, 5 How. 1; s. c. 2 Robb 588.

When the specification of a new composition of matter gives only the names of the substances which are to be mixed together, without stating any relative proportion, it is the duty of the court to declare the patent to be void. The same rule prevails where it is apparent that the proportions are stated ambiguously and vaguely. In such cases it is evident on the face of the specification that no one can use the invention without first ascertaining by experiment the exact proportion of the different ingredients required to produce the result intended to be obtained. *Wood v. Underhill*, 5 How. 1; s. c. 2 Robb 588.

If a man makes a new compound, he is not limited to the use of the same precise ingredients in making that compound. If the same purpose can be accomplished by him by the substitution in part of other ingredients in the composition, he may extend his patent so as to embrace them also. *Ryan v. Goodwin*, 3 Sum. 514; s. c. 1 Robb 725.

If the patent merely suggests a substitute for one of the ingredients, it contemplates the same proportions of the two ingredients. *Tyler v. Boston*, 7 Wall. 327.

### **Improvements.**

The patentee is bound to describe in full and exact terms in what his invention consists, and if it be an improvement only upon an existing machine, he should distinguish what is new and what is old in his specification, so that it may clearly appear for what the patent is granted. The reason of this principle of law will be manifest upon the slightest examination. A patent is grantable only for a new and useful invention, and unless it be distinctly stated in what that invention specifically consists, it is impossible to say whether it ought to be patented or not; and it is equally difficult to know whether the public infringe upon or violate the exclusive right secured by the patent. The patentee is clearly not entitled to include in his patent the exclusive use of any machine already



known, and if he does, his patent will be broader than his invention, and consequently void. If therefore the description in the patent mixes up the old and the new, and does not distinctly ascertain for which in particular the patent is claimed, it is void; since if it covers the whole, it covers too much, and if not intended to cover the whole, it is impossible for the court to say what in particular is covered as a new invention. *Lowell v. Lewis*, 1 Mason 182; s. c. 1 Robb 131; *Langdon v. De Groot*, 1 Paine 203; s. c. 1 Robb 423; *Sullivan v. Redfield*, 1 Paine 441; s. c. 1 Robb 477; *Evans v. Hettick*, 3 Wash. C. C. 408; s. c. 7 Wheat. 453; s. c. 1 Robb 166, 417; *Smith v. Downing*, 1 Fish. 64; *Allen v. Hunter*, 6 McLean 303; *Wayne v. Holmes*, 2 Fish. 20; s. c. 1 Bond 27; *Wintermute v. Redington*, 1 Fish. 239; *Evans v. Eaton*, 7 Wheat. 356; s. c. 3 Wash. C. C. 443; s. c. 1 Robb 193, 336; *Phillips v. Page*, 24 How. 164; *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Bray v. Hartshorn*, 1 Cliff. 538; *Blake v. Sperry*, 2 N. Y. Leg. Obs. 251; *Hovey v. Stevens*, 1 W. & M. 290; s. c. 2 Robb 479; *Brown v. Selby*, 4 Fish. 363; s. c. 2 Biss. 457; *Cross v. Huntley*, 13 Wend. 385; *Davis v. Bell*, 8 N. H. 500; *Head v. Stevens*, 19 Wend. 411; *Turner v. Johnson*, 2 Cranch. C. C. 287; *Brooks v. Jenkins*, 3 McLean 432; *Barrett v. Hall*, 1 Mason 447; s. c. 1 Robb 207; *Dixon v. Moyer*, 4 Wash. C. C. 68; s. c. 1 Robb 324; *McClure v. Jeffrey*, 8 Ind. 79.

If a patent is for an improvement of a machine, the specification must state in what the improvement specifically consists, and it must be limited to such improvement. If, therefore, the terms are so obscure or doubtful that the court cannot say what is the particular improvement which the patentee claims, and to what it is limited, the patent is void for ambiguity. *Barrett v. Hall*, 1 Mason 447; s. c. 1 Robb 207; *Woodcock v. Parker*, 1 Gallis. 438; s. c. 1 Robb 37; *Dixon v. Moyer*, 4 Wash. C. C. 68; s. c. 1 Robb 324.

There is no distinction between an improvement on a machine patented, and one not so. In both cases the improvement must be described, but with this difference that in the former case it may be sufficient to refer to the patent and the specification for a description of the original machine, and then to state in what the improvements on such original machine consist, whereas in the latter case it will be necessary to describe the original machine and also the improvement. *Evans v. Eaton*, 3 Wash. C. C. 443; s. c. 7 Wheat. 356; s. c. 1 Robb 193, 336; *Isaacs v. Cooper*, 4 Wash. C. C. 259; s. c. 1 Robb 332.

The old instrument or thing on which the improvement is made need not be described where there is a reference to it in general terms, for this affords all the information which is necessary to a person skilled in that department. *Many v. Jagger*, 1 Blatch. 372; *Davis v. Palmer*, 2 Brock. 298; s. c. 1 Robb 518; *Winans v. N. Y. & Erie R. R. Co.*, 1 Fish. 213; s. c. 21 How. 88.

There is a class of cases to which these stringent rules do not apply, although the discovery is in the nature of an improvement on what is old. Where any new contrivances, combinations or arrangements are made use

of in machinery, although the chief agents are well known, those contrivances, combinations or arrangements may constitute a new principle, and then the application or practice will necessarily be new also. In such a case the new and improved method of producing a useful result or effect is as much the subject of a patent as an entire new machine. *Wintermute v. Redington*, 1 Fish. 239.

When the invention consists of an improvement on an old machine, it may be taken for granted that a practical mechanic is acquainted with the construction of the machine on which the improvement is made. *Ives v. Hamilton*, 92 U. S. R. 426; s. c. 6 Fish. 244; 1 O. G. 336.

In describing the improvement of a machine in use and well known, it is not necessary to state in detail the structure of the entire and improved machine. It is only necessary to describe the improvement by showing the parts of which it consists, and the effects which it produces. Such a description in reference to the machine improved is sufficient. *Brooks v. Bicknell*, 3 McLean 250; s. c. 2 Robb 118; *Brooks v. Jenkins*, 3 McLean 432.

In the description of an improvement and the directions for constructing the improved machine, it is not necessary to state those matters which, it is apparent, would be proper or indispensable in its structure. *Wayne v. Holmes*, 2 Fish. 20; s. c. 1 Bond 27.

There is nothing in the patent law which in terms requires the patentee to state what is new and what is old. If the patentee by his specification, including the summary claim at its close, points out and distinguishes what he claims as his own invention, it is all that is required. It implies that all the rest is old, or, if not old, that the applicant does not claim it so far as that patent is concerned. No particular form of words is necessary if the meaning is clear. This applies equally to patents for combinations and patents for improvements. *Brown v. Guild*, 23 Wall. 181; s. c. 6 O. G. 392; 7 O. G. 739.

If the specification contains a description of what is old and known, as well as what is new, what is claimed as new must be distinguished. In specifying an improvement in a machine, however, it may be necessary and, when so, it is proper, to describe the whole machine as it operates with the improvement, in order to make the description understood by a person of the trade to which it belongs, and if the patentee fails to do this, his patent fails for obscurity. The simple purpose of the law in requiring the patentee to distinguish new from old is that it may distinctly appear what his invention is. *Wintermute v. Redington*, 1 Fish. 239.

It is difficult to define the exact cases when the whole machine may be deemed a new invention, and when only an improvement of an old machine. The cases often approach very near to each other. Where a specific machine already exists producing certain effects, if a mere addition is made to such machine to produce the same effect in a better manner, a patent cannot be taken for the whole machine, but only for the improvement. In like manner if to an old machine some new combination be added to produce new effects, the right to a patent is limited to

the new combination. On the other hand, if well-known effects are produced by machinery in all its combinations entirely new, a patent may be claimed for the whole machine. So if the principles of the machine are new, either to produce a new or old effect, the inventor may well entitle himself to the exclusive right of the whole machine. *Whittemore v. Cutter*, 1 Gallis. 478; s. c. 1 Robb 40; *Odiorne v. Winkley*, 2 Gallis. 51; s. c. 1 Robb 52.

The patentee need not describe particularly and disclaim all the old parts, and the more especially is this unnecessary when such disclaimer is manifestly in substance the result of his claiming as new only the portions which he does describe specially. *Hogg v. Emerson*, 6 How. 437; s. c. 2 Blatch. 1; s. c. 2 Robb 655; *Evans v. Eaton*, 7 Wheat. 356; s. c. 3 Wash. C. C. 443; s. c. 1 Robb 193, 336.

Every mechanical part, principle or combination which is mentioned in the specification, but which is not included in the invention as claimed and limited, must by necessary implication be considered as admitted to be old or in use before, and the patent is not invalid because it has not in express words particularly stated them to be old. *Winans v. N. Y. & Erie R. R. Co.*, 1 Fish. 213; s. c. 21 How. 88.

For the purpose of enabling artisans to construct the machine, it may be necessary for the inventor of an improvement to state so much of the old machine as will make his specification of the structure intelligible. *Evans v. Eaton*, 7 Wheat. 356; s. c. 3 Wash. C. C. 443; s. c. 1 Robb 193, 336.

A description of the original machine is only necessary when there is no other way in which it can be ascertained with reasonable certainty in what the improvement consists and how it is to be applied. If the patent is for an improvement in a machine already in use and well known to those skilled in the art, there is no need to describe it. *Harmon v. Bird*, 22 Wend. 113.

If the patentee particularly describes and specifies what he claims as new and as his invention, the patent is not void because in the description of the whole machine, including the element that he says is his invention, he includes elements which are old, but which he claims to be newly combined with new elements. *Rheem v. Holliday*, 16 Penn. 547; *Holliday v. Rheem*, 18 Penn. 465.

### **Combination.**

A combination is sufficiently described if the devices of which it is composed are named, their mode of operation given, and the new and useful result to be accomplished pointed out so that those skilled in the art and the public may know the extent and nature of the claim, and what the parts are which co-operate to produce the described new and useful result. *Seymour v. Osborne*, 3 Fish. 555; 1 . . . 516; *Parks v. Booth*, 17 O. G. 1089; s. c. 102 U. S. 96; s. c. . . Flippin 381; s. c. 1 Ban & Ard. 225.

If the description of a combination clearly indicates the method of its use and its relation to the other mechanical elements operating with it, a claim for a combination of part of them is good, although it may not embrace some that are essential to the operative efficiency of the combination. A combination to be valid must have the attribute of practical utility; but this is not to be determined by a reference to the abstract practicability of the elements claimed to compose it. Resort must be had to the whole specification, and if it is therein properly described, its relations to co-operative mechanism indicated and explained, and the method of its use in connection therewith directed, it is a good combination, and will support a restricted claim for it if it is practically operative. *Parham v. Sewing Machine Co.*, 4 Fish. 468; *Furbush v. Cook*, 2 Fish. 668.

It is not requisite to include in the claim for a combination as elements thereof all parts of the machine which are necessary to its action, save as they may be understood as entering into the mode of combining and arranging the elements of the combination. *Furbush v. Cook*, 2 Fish. 668.

A patent for a combination is valid although the claim contains an element not stated to be an element in the specification. *Hoe v. Cottrell*, 17 Blatch. 546; s. c. 18 O. G. 59; s. c. 5 Ban & Ard. 256; 1 Fed Rep. 597.

### **Defects that render Patent Void.**

If anything material in respect to the construction or working of the machine is omitted in the specification, the patentee loses all claim to the exclusive use of his discovery. *Carr v. Rice*, 1 Fish. 198.

A patent is valid although there are irregularities and omissions in normal acts to be done by the inventor and his duly constituted attorney, preparatory to and connected with the issuing thereof. *Hoe v. Cottrell*, 17 Blatch. 546; s. c. 18 O. G. 59; s. c. 5 Ban & Ard. 256; 1 Fed. Rep. 597.

If the actual invention is not a material and substantial part of the thing patented, and definitely distinguishable from the other parts claimed, the patent is void. *Hotchkiss v. Oliver*, 5 Denio 314.

If the allegations and suggestions of the petition are not substantially recited in the patent, the patent will be void. *Evans v. Chambers*, 2 Wash. 125; s. c. 1 Robb 7.

If the specification is not in such full, clear and exact terms as to enable any one skilled in the art to construct the invention therein described without experiments of his own, then the patent is void. *Singer v. Walmsley*, 1 Fish. 558; *Hovey v. Stevens*, 3 W. & M. 17; s. c. 2 Robb 567; *Gray v. James*, 1 Pet. C. C. 394; s. c. 1 Robb 120; *Judson v. Moore*, 1 Fish. 544; s. c. 1 Bond 285; *Wayne v. Holmes*, 2 Fish. 20; s. c. 1 Bond 27; *Winans v. Schen. & Troy R. R. Co.*, 2 Blatch. 279; *Grant v. Raymond*, 6 Pet. 218; s. c. 1 Robb 604; *Downton v. Yaeger Milling Co.*, 17 O. G. 906; s. c. 1 McCrary 26; s. c. 5 Ban & Ard. 112; s. c. 1 Fed. Rep. 199; *Schneider v. Thill*, 5 Ban & Ard. 565; *contra*, *Whittemore v. Cutter*, 1 Gallis, 429; s. c. 1 Robb 28.

A claim broader than the actual invention of the patentee is, for that very reason, upon the principles of common law, utterly void, and the patent is a nullity. *Wyeth v. Stone*, 1 Story 273; s. c. 2 Robb 23; *Parker v. Stiles*, 5 McLean 44; *Tyler v. Devel*, 1 Am. L. J. 248; *Barrett v. Hall*, 1 Mason 447; s. c. 1 Robb 207; *Moody v. Fisk*, 2 Mason 112; s. c. 1 Robb 312; *Hovey v. Stevens*, 3 W. & M. 17; s. c. 2 Robb 567; *Parker v. Sears*, 1 Fish. 93; *Terry Clock Co. v. New Haven Clock Co.*, 17 O. G. 708; s. c. 3 Ban & Ard. 332; *Maguire v. Eames*, 18 Blatch. 321; s. c. 5 Ban & Ard. 617; s. c. 8 Fed. Rep. 761; *vide Whitney v. Emmett*, Bald. 303; s. c. 1 Robb 567; *Gray v. James*, Pet. C. C. 394; s. c. 1 Robb 120; *Park v. Little*, 3 Wash. C. C. 196; s. c. 1 Robb 17; *Lowell v. Lewis*, 1 Mason 182; s. c. 1 Robb 131; *Whittemore v. Cutter*, 1 Gallis. 429; s. c. 1 Robb 28.

A claim in the alternative is void for uncertainty, for nothing is claimed absolutely. *Carr v. Rice*, 1 Fish. 325; s. c. 4 Blatch. 200.

An alternative claim is invalid only in those cases where it claims positively neither of several subjects, but is good if all of many which are mentioned are claimed as one or the other is employed by an infringer. If it is said that A or B is claimed, this asserts a right to neither; but to claim the one or the other as they are used with an assertion that it has been discovered that both are interchangeably available for specified purposes, is not an alternative claim. *Union Paper Bag Co. v. Nixon*, 6 Fish. 402; s. c. 4 O. G. 31.

If the patent is for the whole of a machine, and the discovery is only for an improvement, the patent is void. *Evans v. Eaton*, Pet. C. C. 322; s. c. 3 Wheat. 454; 7 Wheat. 356; s. c. 3 Wash. C. C. 443; s. c. 1 Robb 68, 193, 243, 236; *Whittemore v. Cutter*, 1 Gallis. 478; s. c. 1 Robb 40; *Odiorne v. Winkley*, 2 Gallis. 51; s. c. 1 Robb 52; *Winans v. N. Y. & Erie R. R. Co.*, 1 Fish. 213; s. c. 21 How. 88; *Aiken v. Dolan*, 3 Fish. 197; *Holliday v. Rheem*, 16 Penn. 465; *Darst v. Brockway*, 11 Ohio 462; *contra*, *Goodyear v. Mathews*, 1 Paine 300; s. c. 1 Robb 50.

Unless the vagueness or ambiguity is very clear and unmistakable, the patent will not be declared void on that ground. *Swift v. Whisen*, 3 Fish. 343; s. c. 2 Bond 115.

A specification void in part is void *in toto*. *Head v. Stevens*, 19 Wend. 411.

### Specification.

If the applicant merely signed a blank specification which was afterwards filled up by his attorney, a patent issued on such an application is void. *Benton*, 23 O. G. 341.

The applicant should point out at the outset of his specification the particular art, machine, article or composition of matter to which his invention relates, so that the remainder of the specification may be read with reference to some object clearly had in view by him. After the class of invention to which the application pertains has been mentioned, then should follow a more minute description of the parts of the invention, reference being had to the different views and parts as shown by the drawing, if a drawing is furnished. Then if the invention consists of an im-

provement in a particular class of machines or a particular art, he should state what is old, distinguish the new therefrom and set forth the object to be accomplished by the improvement. Then there should be a description of its operation or of the manner in which the result desired is produced, and lastly a summary of the invention in the form of a claim or claims, which specifically point out the particular part or parts constituting the actual improvement which the applicant claims as his invention. *Thompson*, 16 O. G. 588.

If a part of the machine is old the specification should distinguish what is old from what is new. *Gilbert*, 16 O. G. 763.

An applicant who has specifically described a mode of carrying out the invention can not give a vague description of other modes. *Howe*, 24 O. G. 1090.

A specification should be descriptive, and not discuss the merits or demerits of other patents or inventions. *Wm. L. Williams*, 1 O. G. 225.

Applicants must confine their specifications to the matter sought to be claimed by their patent. *D. M. Smith*, 3 Dec. Com. 84.

The description of an old improvement, even though not claimed, should be eliminated from the specification. *James A. Woodbury*, 1 Dec. Com. 86.

A reference to a caveat concerns the history, and not the description, of an invention, and should not be cited in a specification in an application for a patent. *Thomas J. Chubb*, 2 O. G. 519.

It is not required that all the elements entering into the construction of a device be mentioned, unless its novelty demands it; but only such as will constitute it an operative whole need be named. *James Farrow*, 2 O. G. 57.

The parts of a combination must be specified only up to that point beyond which the presence of the parts not named will be presumed from the known state of the art or the necessities of the case. *Moses G. Wilder*, 3 Dec. Com. 125; *H. J. Kent*, 3 Dec. Com. 301.

Where a part of a combination is capable of useful operation by itself, the inventor may embrace a claim for the combination and for such part in one patent. *James D. Sturges*, 1 O. G. 204.

So much of the drawings and specification as repeats the description of the patented machine should be stricken out before the case can be examined on its merits. *D. M. Smith*, 2 Dec. Com. 69.

The interpretation of the language of a patent must have regard to the objects of the invention, and harmonize therewith. The signification of terms at the date of a patent must govern, and not those acquired afterwards. *McDougal v. Eames & Seely*, 2 O. G. 86.

If a long time has elapsed in considering the merits of the invention, formal objections are disregarded. *Bate*, 15 O. G. 1012.

### Claims.

Every new device described in an application should be patented under it, or under a division of it. *Lewis J. Atwood*, 1 Dec. Com. 98; *James R. Hyde*, 3 Dec. Com. 109.

The public has a right to know the exact limitations of a patentee's monopoly, and for that reason the law requires distinct, exact, and sharply defined claims. *John M. Cornell*, 1 O. G. 573; *T. C. Hopper*, 2 O. G. 4; *Perry & Lay*, 1 Dec. Com. 3; *J. C. Cooke*, 3 Dec. Com. 312; *Fairbanks & Robinson*, 3 O. G. 65; *Frederick W. Dabne*, 7 O. G. 1095; *J. C. Gould*, 10 O. G. 203; *Charles E. Williams*, 10 O. G. 748; *Elbers*, 12 O. G. 1076; *Skinner*, 19 O. G. 662.

Ambiguous claims should not be allowed on the ground that the courts would sustain them, if they can do so only upon a forced construction. *Joseph Thorne*, 1 Dec. Com. 76.

Ambiguous phrases should not be employed, in granting letters patent, to make a claim good which, without them, would be bad and unpatentable. *C. Rubens & Co.*, 1 Dec. Com. 107; *H. Waterman*, 1 Dec. Com. 70; *James Arkell*, 3 Dec. Com. 263; *J. C. Gould*, 10 O. G. 203; *Du Motay*, 16 O. G. 1002.

Ambiguous words in a claim, such as "substantially as and for the purpose set forth," used as a limiting clause, are insufficient, unless so placed as to be specially significant. *John Sperry*, 2 O. G. 387; *The Collins Co.*, 2 O. G. 617; *Orrin Rice*, 5 O. G. 522.

The words "or equivalent devices, as described," may be used in a claim. *W. P. Walton*, 10 O. G. 165.

Whenever the words "equivalent" or "equivalents" occur in a claim, in such a connection as to have an equivocal signification, their use in that connection must be inhibited. *Daniel F. Haasz*, 4 O. G. 610.

An alternative claim is uncertain and can not be allowed. *Reid v. Roebuck*, 15 O. G. 882; *McDougall*, 18 O. G. 130.

A claim whose language is so broad that it may embrace more than the particular thing produced by the inventor and its equivalents can not be allowed. *Anders v. Gilliland*, 19 O. G. 177.

A claim which is so broad that it is fairly susceptible of an interpretation that renders it functional can not be allowed. *Ives*, 15 O. G. 385.

If an applicant in filing a claim that is so broad as to be applicable to two different constructions, refers to one construction as the substance of the invention and the other as a modified form, the applicant upon a rejection of the claim can file only an application for the former which he has thus elected to take. *Heaton*, 15 O. G. 1054.

If the invention consists in an improvement, the claim need not embrace a part which is common to all machines of that kind. *Kitson*, 20 O. G. 1750.

If a claim is indefinite or lacks tangible matter, it will not be allowed. *P. G. L. G. Designolle*, 13 O. G. 227.

If the claim is full, clear and exact, the commissioner will not interfere with the applicant either in the choice of his words or the form in which they are stated. *P. G. L. G. Designolle*, 13 O. G. 227.

A claim should express no more and no less than is necessary to convey an accurate understanding of the actual invention, if it consists in some addition to or alteration of an existing structure. *Joseph Funck*, 14 O. G. 158.

Claims which recite definitely the article invented, and contain in addition matter descriptive of the functions of certain parts, are not objectionable. *J. J. Gray*, 11 O. G. 229.

Parts which may be rendered unnecessary by a ready substitute need not be explicitly cited in a combination claim. *O. E. McMurray*, 8 O. G. 943.

Specific reference to devices by letter in a claim is a restriction upon the devices described in the specification. *C. W. Marsh*, 2 O. G. 197.

Where a combination has no function, except in connection with some element not mentioned, the latter is inferentially included, and its introduction into the claim produces no real change. *William F. West*, 2 O. G. 30.

The introduction of dead elements into a claim of several combinations

does not change the nature of it; but where a new element is introduced, modifying the operation of the former combination, the claim is not identical with the first. *William F. West*, 2 O. G. 30.

A claim for a combination which is distinguishable from others only by a single element should specify it. *Charles Rubens & Co., Assignees*, 1 Dec. Com. 107; *Henry Waterman*, 2 Dec. Com. 70.

Where the scope of the invention extends only to the specific devices presented, a broad claim will be refused. *Joseph I. Pennock*, 2 O. G. 590.

A feature essential to the operation of a device should be included in the claim therefor. *Farnsworth v. Andrews*, 9 O. G. 195.

Every claim should be so drawn as to plainly indicate the nature of the invention sought to be covered by it. *Thomas J. Mayall*, 4 O. G. 210.

Nothing should be embraced in a claim which has not been previously set forth. *Owen Dorsey*, 2 Dec. Com. 17; *J. W. Wattles*, 3 O. G. 291.

### Joinder of Claims.

An applicant may use several claims in different forms for substantially the same invention. *Perry & Lay*, 1 Dec. Com. 3; *Evans W. Shippen*, 3 O. G. 727; *Martin v. Bogle*, 12 O. G. 625.

If the invention is simple and can be clearly stated in one claim, it should not be set out in a series of claims, which all mean the same thing. *Woodruff*, 17 O. G. 453.

Two distinct species can not be embraced in one patent, though belonging to one genus of inventions. *Robert N. Eagle*, 2 Dec. Com. 137.

An applicant may make one generic claim, but he can not claim different classes of inventions in the same application. *Kent*, 17 O. G. 686.

If a generic claim for a process describes one of the processes embraced in the claim, it is sufficient. *Wilson*, 16 O. G. 95.

Whenever a generic claim and distinct modifications are retained in the same application, the claims other than the generic ones must be confined to some single species. *E. O. Howland*, 12 O. G. 889.

Whenever a generic claim can be maintained which will include the modifications or specific devices described or exhibited in the drawings, then the specific devices may be retained in the same application. *E. O. Howland*, 12 O. G. 889.

When no generic claim can be maintained there is such diversity in the claims as requires a division of the application. *E. O. Howland*, 12 O. G. 889.

When the substitution of one form for another does not involve invention, the forms do not constitute several species of the genus, but are modifications of a single species, and may be embraced in one patent. *Kook & Hall*, 16 O. G. 543.

Two distinct claims for a process can not be joined in the same application unless they bear to each other the relation of process and sub-process, or that of genus and species. *Smith*, 16 O. G. 630; *McDougall*, 18 O. G. 130.

A claim for a mechanical process, and for the means by which it is carried on, may be united in the same application. *Tyne*, 17 O. G. 56.

A claim for a method and a claim for the means can not be united in the same application. *Bates*, 16 O. G. 266.

A patent will not be granted to the same person for an apparatus, and also for the principle upon which it operates. *William Lowe*, 2 Dec. Com. 39.



It is not the design of the patent law to grant a separate patent to every possible application of a process. *W. H. Howell*, 9 O. G. 921.

A patent will not be granted for a product to one who already has one for the process which describes it. *McCracken v. Russell*, 1 Dec. Com. 35.

If a process and its product are not inseparable in their nature they can not be joined in one application. *O'Neill*, 16 O. G. 1049.

If one has invented a process or a machine, by which he turns out a new and improved manufacture, he is entitled to a patent for the article as well as the process or machine. *George Lupton*, 5 O. G. 489.

An application for a machine and its product can not be joined if they are distinct and independent inventions. *Bancroft*, 20 O. G. 1893; *Murray v. Wuterick*, 3 O. G. 659; *Winterlich*, 16 O. G. 404; *Winterlich*, 16 O. G. 808.

If an article is not necessarily the result of the action of a machine, the applications for patents for the article and machine should be separate. *Junker & Wolf*, 11 O. G. 110.

Where an apparatus is used in a process to produce a new article, the applicant may claim the apparatus, the process and the article, in one patent. *A. D. Elbers*, 12 O. G. 2; *P. A. Dailey*, 13 O. G. 228.

If one ingredient of the composition is omitted in one of the claims, the composition is so changed as to become the subject of a separate application. *G. & I. Loeser*, 9 O. G. 837.

If devices constitute necessary elements in the production of the result they need not be the subjects of separate applications. *Jesse Jopling*, 8 O. G. 1032; *Clinton & Knowlton*, 9 O. G. 249; *Bigelow*, 13 O. G. 913; *Möller*, 16 O. G. 338.

Where the improvements have nothing to do with the combination, but are of general application, the applicant is entitled to no more favor than if he attempted to patent improvements upon two independent machines under one grant. *Leopold Lehmann*, 2 Dec. Com. 70; *J. T. Cree*, 2 Dec. Com. 78.

Several combination claims may be united in the same application, although the parts can not be used to accomplish the results at the same time. *Smith*, 17 O. G. 271.

If the invention consists in an article of manufacture, a claim for a combination and for sub-combinations may be joined in one application. *Freese*, 17 O. G. 1095.

All the parts of a machine which co-operate, whether simultaneously or consecutively to produce a single effect or result, may lawfully be combined in one patent. *Cauhape*, 17 O. G. 328.

If the particular feature is a part of and especially adapted to the machine in which it is claimed and contributes to its successful operation, it may be included in a patent for the machine, although it is capable of performing its particular function in another machine. *Frederick G. Sargent*, 15 O. G. 512.

If several devices constitute a complete set, of which the operation of each in a certain order is necessary to accomplish the desired result, they may be united in one application. *F. F. Gokey*, 15 O. G. 295.

Every claim in an application, in order to be valid, must, in one sense, cover an independent invention, yet all the claims must pertain to one common device or subject of invention. *Robert M. Franklin*, 4 O. G. 105.

Two claims in an application should be more clearly distinguished than by omitting from one of them a feature specified in the other, and which is usual and indispensable to those that are mentioned. *George Richardson*, 3 Dec. Com. 303.

### Division.

If two or more distinct inventions are united in one application, that are capable of division, and which belong to different classes, or involve a double labor of examination, or have no community of operation, the commissioner should require the application to be divided. Linus Yale, Jr., 1 Dec. Com. 110; E. R. Sumner, 3 Dec. Com. 180; Abel Combs, 3 Dec. Com. 209; Henry M. Stow, 3 O. G. 322; John F. Shepard, 3 O. G. 522; Lones *et al.*, 4 O. G. 582; Henry Birun, 5 O. G. 521; Wm. Tucker, 6 O. G. 470; John Gillies, 10 O. G. 415; Sol. Kuh, 10 O. G. 587; A. D. Elbers, 12 O. G. 2; Henry Law, 12 O. G. 940; R. W. Hamilton, 13 O. G. 122; Cardwell, 15 O. G. 293; Hookham, 16 O. G. 545; Dinkenbihler, 16 O. G. 810; Matthew Hogan, 16 O. G. 907; Augustine O. David, 16 O. G. 1139; Wenzel, 17 O. G. 512.

In requiring the division of an application, the nature and extent of the division should be clearly indicated. Kernard Knott, 8 O. G. 238.

The requirement of a division of an application presupposes that matter exists which might constitute the subjects of two or more patents. Richard Pintsch, 11 O. G. 597.

If joint inventors file an application for a patent for a design, and then subsequently conclude to divide the claim and apply for two patents, the second application for a part of the invention must be sworn to. Tieman, 11 O. G. 1.

One need not divide his application and apply for a separate patent for each form which he shows by way of illustration in his specification. Barak T. Nichols, 4 O. G. 105.

An application for a patent need not be divided if all the elements of the apparatus are to be used conjointly for a definite and single purpose. Westenhaven & Adair, 5 O. G. 695; Cowper, 16 O. G. 499.

If the application contains two claims that can not be joined, the applicant may elect to take either of them at any time before he has bound himself by estoppel to take the other. Andrews, 15 O. G. 1056.

When an applicant is manifestly acting in good faith and not seeking to procure an examination of several claims in one application, the examination should be made before a division is required. R. D. Sanders, 13 O. G. 818.

Although several inventions are improvements on one machine, yet if they are independent improvements a separate patent must be taken for each invention. Van Matteson, 24 O. G. 389.

### Two Patents.

Under no circumstances can the same inventor become entitled to receive from the government more than one patent for the same invention and covering the same ground. John C. Duckworth, 2 Dec. Com. 150; C. B. Cottrell, 9 O. G. 495; Luther O. Crocker, 1 Dec. Com. 6.

An inventor can not be allowed to go back and obtain a second patent for the same invention upon the earlier form of the application. James R. Hyde, 3 Dec. Com. 109.

The existence of one patent which is void for want of novelty does not justify the granting of another patent for the same thing. Blackman v. Morray, 13 O. G. 175.

### Two Applications.

An inventor may file a subsequent application, although it involves the same subject-matter as the prior application, but when a patent has been granted on one application, no patent can be allowed on any other application having similar claim. *Peter Langlois*, 14 O. G. 84.

Where an inventor has two applications pending at the same time, and a patent is granted upon the one last filed, in which is shown but not claimed an invention which is or may be claimed in the application first filed, the protection for such invention may be secured in the application first filed. *Emerson*, 17 O. G. 1451.

If an applicant files a second application covering matter shown in the prior application, but not claiming it, and a patent is first issued thereon, he is entitled to have the first application considered on its merits without obtaining a reissue. *Stempel*, 16 O. G. 316.

**SEC. 4889.** When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the patent office; and a copy of the drawing, to be furnished by the patent office, shall be attached to the patent as a part of the specification.

*Statute Revised*—July 8, 1870, ch. 230, § 27, 16 Stat. 201.

*Prior Statutes*—Feb. 21, 1793, ch. 11, § 3, 1 Stat. 321.—July 4, 1836, ch. 357, § 6, 5 Sta 119.—March 3, 1837, ch. 45, § 6, 5 Stat. 193.

The requirement that the applicant shall furnish drawings, though directory in its terms, is not a condition, and it has obvious reference in point of time to the issuing of the patent, and not to the filing of the petition for it. *French v. Rogers*, 1 Fish. 133.

The drawing becomes a part of the patent, and may be referred to to help out the description. *Hogg v. Emerson*, 2 Blatch. 1; s. c. 6 How. 437.

The drawings are to be treated as part of the written specification, and may be referred to to show the nature and character and extent of the claim, as well as to compose a part of the description. *Washburn v. Gould*, 3 Story 122; s. c. 2 Kobb 206.

It is not necessary, in order to make a patent valid, that the patentee should so make the drawings in his patent that they can be used as working drawings, or that a machine made in accordance with the exact scale of the drawings which accompany the patent in the patent office, should be an operative machine. All that is necessary is that the patentee shall so describe his invention that a mechanic skilled in the art to which that invention relates, will be able, by the aid of the description and drawings of the patent, to embody that invention in a practical, operative, efficient and effectual form. *American Leather Co. v. American Tool Co.*, 4 Fish. 284; s. c. 1 Holmes 503.

The express terms of the clause no more require that the written references shall be incorporated in the specification than that the drawings shall be. If the references required are written on the drawings, the terms of the statute are satisfied. *Hogg v. Emerson*, 2 Blatch. 1; s. c. 6 How. 437; 11 How. 587; s. c. 2 Robb 655.

Unless references are necessary to an understanding of the invention, their omission cannot vitiate the patent. The description of the machine, accompanied by a drawing, may be in many cases understood without references. *Brooks v. Bicknell*, 3 McLean 250; s. c. 2 Robb 118; *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206.

A drawing must be furnished when the case admits of it whether it is useful or necessary or not. *Chase*, 16 O. G. 809.

It is not necessary to use letters of reference to the drawing, in order to render a claim more definite. *E. L. Parker*, 3 Dec. Com. 293.

An applicant for a patent need not furnish a drawing of the whole of the machine which he claims to have improved, provided the machine is well known to the public, or a description of it readily accessible. *Christopher C. Tracy*, 8 O. G. 144; *Edward J. Kemp*, 15 O. G. 775.

Where the operation of the old parts of a machine is modified, controlled or unusually affected by the improvement, the drawing should show the whole machine. *Edward J. Kemp*, 15 O. G. 775.

If no novelty is claimed in a feature of an invention it need not be illustrated by drawings unless they are essential to such a description as will enable those skilled in the art to practice the invention. *Carter*, 16 O. G. 809; *Edward J. Kemp*, 15 O. G. 775.

It is not necessary for the applicant to illustrate by drawings the several steps in each stage of a sub-process. *Carter*, 16 O. G. 809.

If the claim is for a combination the drawing should show the parts combined. *Edward J. Kemp*, 15 O. G. 775; *Rulof Dodge*, 2 Dec. Com. 149.

**SEC. 4890.** When the invention or discovery is of a composition of matter, the applicant, if required by the commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment.

*Statute Revised*—July 8, 1870, ch. 230, § 28, 16 Stat. 201.

*Prior Statutes*—February 21, 1793, ch. 11, § 3, 1 Stat. 321.—July 4, 1836, ch. 357, § 6, 5 Stat. 119.

If the specification for a composition clearly describes the composition and all the ingredients and proportions in language perfectly intelligible to those skilled in the art, the patent will not be invalidated by a failure to deposit a sample of the ingredients in the patent office. This requirement, like some others, is made obligatory before the granting of the patent. It is for the commissioner to decide before granting the patent, whether it has been complied with. If he does so decide and grants the patent, that can not be subsequently impeached by evidence tending to

show want of compliance with the law as to giving notice or paying fees or performing the other acts required to be done before the patent is granted, and the performance of which is to be proved to the satisfaction of the commissioner, whose decision on these questions is final where he has jurisdiction. *Tarr v. Folsom*, 1 Holmes 312; s. c. 5 O. G. 92; s. c. 1 Ban & Ard. 94; *Anilin Fabrik v. Cochrane*, 16 Blatch. 155; s. c. 4 Ban & Ard. 215.

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

*Statute Revised*—July 8, 1870, ch. 230, § 29, 16 Stat. 201.

*Prior Statutes*—April 10, 1790, ch. 7, § 2, 1 Stat. 110.—February 21, 1793, ch. 11, § 3, 1 Stat. 321.—July 4, 1836, ch. 357, § 6, 5 Stat. 119.

A model will be required in every case when the nature of the invention admits of such illustration, except the applications upon designs. *John Murdock*, 6 O. G. 506.

A model will not be required unless it is useful as an aid in examining into the state of the art or in the construction of the specification and drawing. *Jove*, 17 O. G. 801.

As the purpose of the model is to assist in the reading of the drawing, the model must correspond with the drawing and specification. *James W. Schoonmaker*, 13 O. G. 595.

An applicant for a patent for an improvement on a machine need not furnish a model of the whole machine if it is well known to the public or a description of it is readily accessible. *Christopher C. Tracy*, 8 O. G. 144; *Edward J. Kemp*, 15 O. G. 775.

An applicant for a patent for a combination must furnish a model. *Rulof Dodge*, 2 Dec. Com. 149.

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

the government of the United States, or before any notary public of the foreign country in which the applicant may be.

*Statute Revised*—July 8, 1870, ch. 230, § 30, 16 Stat. 209.

*Prior Statutes*—February 21, 1793, ch. 11, § 3, 1 Stat. 1.—July 4, 1836, ch. 357, § 6, 5 Stat. 119.—August 29, 1842, ch. 263, § 4, 5 Stat. 544.

The taking of the oath that the patentee is the true inventor or discoverer of the art, machine, or improvement, is but a prerequisite to the granting of the patent, and in no degree essential to its validity. It is not a condition precedent without which the patent fails. *Whittemore v. Cutter*, 1 Gallis. 429; s. c. 1 Robb 28; *Crompton v. Belknap Mills*, 3 Fish. 536; *Dyer v. Rich*, 42 Mass. 180; *contra*, *Child v. Adams*, 1 Fish. 189; s. c. 3 Wall. Jr. 20.

The mere presence of a blank form of the oath, with the jurat not signed by any magistrate, on file in the case in the Patent Office, can not overcome the direct recital of the letters patent that the oath was taken. *Crompton v. Belknap Mills*, 3 Fish. 536.

The recital in the patent that the required oath was taken before the same was granted is, in the absence of fraud, conclusive evidence that the necessary oaths were so taken. *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516.

The oath may be taken elsewhere than before the commissioner. *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516.

If the inventor signs the petition in which he declares himself to be the inventor, but omits to sign the affidavit, it is for the department to determine whether the necessary oath is shown or not, and its decision upon that question is final. *De Florez v. Reynolds*, 14 Blatch. 505; s. c. 3 Ban & Ard. 292.

There is no provision which requires that the jurat to the application shall be dated, and consequently the omission of the date of the day or month does not affect the validity of the patent. *French v. Rogers*, 1 Fish. 133.

If an application is amended after the death of the inventor, so as to embrace an invention different from that shown in the original application, without any additional oath by his administrator or executor, the patent is void. *Eagleton Manuf. Co. v. W. B. & C. Manuf. Co.*, 17 O. G. 1504; s. c. 18 Blatch. 218; s. c. 5 Ban & Ard. 475; s. c. 2 Fed. Rep. 774.

An applicant may be required to make oath that the invention has not been in public use in this country for more than two years prior to his application. *Rowan*, 22 O. G. 1037.

An applicant can not be required to make oath that the invention was not known or used prior to his application. *Rowan*, 22 O. G. 1037.

The oath of an applicant is not a mere formal matter, but is required by act of Congress, because it goes to assure the novelty and utility of the invention. *Eaton, Blodgett & Mills*, 4 O. G. 525.

The objection that a specification was made out on papers signed and sworn to in blank will be waived if a specification properly described and sworn to is substituted. *De La Mar v. Gaurens & Behrens*, 1 Dec. Com. 94.

A new oath must accompany the divisional portion of an application the same as if it were an original application. *James Heginbotham*, 8 O. G. 237.

An affidavit taken before a burgomaster is not sufficient. *Warnant v. Warnant*, 17 O. G. 265.

If the affidavit was not taken before the proper officer, the omission is not supplied by an affidavit to a preliminary statement. *Warnant v. Warnant*, 17 O. G. 265.

SEC. 4893. On the filing of any such application and the payment of the fees required by law, the commissioner of patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor.

*Statute Revised*—July 8, 1870, ch. 230, § 31, 16 Stat. 202.

*Prior Statutes*—April 10, 1790, ch. 7, § 1, 1 Stat. 109.—July 4, 1836, ch. 357, § 7, 5 Stat. 119.

The commissioner is required to cause an examination to be made of the alleged invention or discovery, but he is not specifically told by what particular officers he is to have the examination made. *Hull v. Commissioner*, 7 O. G. 559; s. c. 8 O. G. 46; s. c. 2 McArthur 90, 125.

The commissioner is not bound to issue the patent, although the examiners in chief decide in favor of the applicant; but he may examine the evidence and withhold the patent. *Hull v. Commissioner*, 7 O. G. 559; s. c. 8 O. G. 46; s. c. 2 McArthur 90, 125.

The commissioner, with the approval of the Secretary of the Interior, has the power to institute proceedings for the purpose of inquiring into allegations of a public use or sale of an invention more than two years prior to the application for a patent. *In re Alteneck*, 23 O. G. 269.

If the commissioner investigates allegations in regard to a public use or sale of the invention more than two years prior to the application for a patent, he must give the applicant an opportunity to cross-examine the witness. *In re Alteneck*, 23 O. G. 269.

A protest against the issuing of letters patent for a certain device will not be considered, unless it is accompanied with legitimate proof showing presumptively that the application against which the protest is directed has been or is about to be filed. *Neale*, 15 O. G. 511.

If an assignment is not sufficient to warrant the grant of a patent to the assignee, either as sole or joint grantee, it is not sufficient to entitle him to appear in proceedings upon the application. *Hammond v. Pratt*, 16 O. G. 1235.

A parol assignment is not sufficient to entitle the party to appear and assert the right to become a joint patentee or to conduct the application in place of the inventor. *Hammond v. Pratt*, 16 O. G. 1235.

The issuing of all patents is at the control of the commissioner, and he may stop any one for good cause, although the examiners in chief have decided on appeal that it ought to issue. *Stephen Hull*, 1 Dec. Com. 68; *Moody v. Hudson*, 1 Dec. Com. 108; *Morris & Watson*, 2 Dec. Com. 71.

The commissioner will not arrest the issue of a patent allowed by the examiners in chief, except in cases in which it is beyond question that their judgment is erroneous or opposed to the general policy of the patent office. *Disston v. Traut*, 1 O. G. 305.

The commissioner can not ignore an objection to patentability whenever his attention is called to it by the examiner in chief or the primary examiner, although the objection may be made in an irregular manner. *William S. Smoot*, 11 O. G. 1010.

If there is an allegation that the invention has been in use for more than two years prior to the application, the commissioner may refer the case to the examiner of interferences, with direction to provide for taking evidence. *Frederick Alteneck*, 23 O. G. 2233.

If the commissioner discovers that there is no novelty in a patent before he affixes the seal of the office to it, he may withhold it, although it has been signed by the commissioner and the Secretary of the Interior. *Franklin B. Hunt*, 13 O. G. 771.

When the commissioner deems it improper to complete the issue of a patent after it has been signed, he should transmit the same to the Secretary of the Interior with all the papers in the case before taking any further action thereon, with his reasons for declining to complete the issue. *Franklin B. Hunt*, 13 O. G. 771.

**SEC. 4894.** All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the commissioner of patents that such delay was unavoidable.

*Statute Revised*—July 8, 1870, ch. 230, § 32, 16 Stat. 202.

*Prior Statute*—March 2, 1861, ch. 88, § 12, 12 Stat. 248.

The statute does not interpose an absolute bar to the granting of a patent where the application has not been completed and prepared for examination within two years. The delay may be condoned by proof that it was unavoidable. The decision of the fact is committed to the



commissioner. If it is shown to his satisfaction that the delay was unavoidable, the application is not to be regarded as abandoned. He is invested with the power to grant the patent, and he may exercise it subject to the duty of determining that the preparation of the application for examination was not unnecessarily delayed after two years. The sufficiency of the evidence is for him. He is the only judge to be satisfied, and his judgment is conclusive. *McMillin v. Barclay*, 5 Fish. 189; s. c. 4 Brews. 275.

If the inventor has been incapacitated for business by mental disorder, the application will not be deemed to be abandoned. *Ballard v. Pittsburgh*, 12 Fed. Rep. 783.

Although a party fails to prosecute his application within two years after he is notified of its rejection, yet he may file a new application for the same invention, for it is not the invention but the application that is deemed to be abandoned. *Lindsay v. Stein*, 21 O. G. 1613; s. c. 10 Fed. Rep. 907.

This section comprehends the abandonment of applications only, which is a different thing from the abandonment of an invention to the public. *William H. Golding*, 8 O. G. 141.

If after an application is withdrawn another is not filed in two years, it may reasonably be presumed that the applicant has no intention of renewing it. *Hamilton v. Foster*, 1 Dec. Com. 30; *John W. Orr*, 1 Dec. Com. 33; *Edson v. Coffin*, 1 Dec. Com. 65; *Benson v. Bennett*, 2 Dec. Com. 26; *Gates v. Benson*, 2 Dec. Com. 65; *W. W. Williams*, adm'r, 2 Dec. Com. 109; *Hiram H. Marsh*, 2 Dec. Com. 151; *Cryer*, 17 O. G. 452.

If a second application is filed within two years of the date of the withdrawal, this renewal may be regarded as establishing a continuity of application, which makes it necessary that a public use, such as will operate as a bar to the grant of a patent, shall have taken place two years before the filing of the first application. *S. Howes*, 1 O. G. 227.

Delay in the prosecution of an application may be excused by satisfactory proof. *Alfred Shoe*, 3 Dec. Com. 62; *R. A. Stewart*, 4 O. G. 365; s. c. 5 O. G. 1; *Stephen Hull*, 9 O. G. 1.

Delay in prosecuting an application is not excused because the applicant is too deeply engaged in other pursuits; nor by anything short of such embarrassments as unavoidably prevent him. *Gray v. Hale*, 3 Dec. Com. 129.

If an applicant neglects to prosecute his application for two years after the office have rejected it, it will be held to be abandoned, unless it be shown that such delay was unavoidable. *W. D. Leavitt*, 3 O. G. 212; *vide Weitling v. Cabell*, 2 O. G. 223.

If a party omits to ask for the hearing of an appeal before the commissioner for two years, the application will be deemed to be abandoned. *W. E. Woodbridge*, 15 O. G. 564.

If an applicant does not prosecute his application within two years after any action thereon, it will be deemed to have been abandoned, unless the delay was unavoidable. *Smith v. Dimond*, 20 O. G. 742.

If no steps are taken towards prosecuting an application for two years after notice of the last action of the office upon it, except to enter a formal abandonment and request a return of the model, it must be considered abandoned. *Freeham Graham*, 3 O. G. 211; *Lee & Smith*, 5 O. G. 58.

The apparent date of a paper requesting further action may or may not be correct. It may be wholly deceptive and intended to mislead. The only date that can be regarded as entirely reliable is that of filing as indicated by the official stamp on the paper. *Henry H. Blake*, 3 O. G. 2.

The day of the last action in the patent office will be excluded in computing the period of two years within which the applicant must prosecute his case in order to avoid a forfeiture. *Musser*, 16 O. G. 858.

If a claim which has been rejected is amended in mere matter of form and then rejected a second time, a mere request for a reconsideration of the decision is not such a prosecution of the application as will take the case out of the operation of this section. *Barton H. Jenks*, 14 O. G. 747.

An application which has been forfeited by a failure to prosecute can not be revived, unless the party establishes the utmost good faith and diligence in his conduct. *Thomas Mayor*, 13 O. G. 912.

A prior rejected or withdrawn application can not be held as a bar to the issue of a patent under a subsequent application. *G. B. Sexton*, 9 O. G. 251.

Neglecting to take any steps in prosecuting an application for a reissue for two years after the last action of the office upon it does not work an abandonment of it. *N. H. Galusha*, 3 O. G. 321.

An applicant may take an appeal from an adverse decision at any time within two years after the decision. *Reynolds*, 24 O. G. 993.

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

• *Statute Revised*—July 8, 1870, ch. 230, § 33, 16 Stat. 202.

*Prior Statute*—March 3, 1837, ch. 45, § 6, 5 Stat. 193.

The words "the assignee" mean the assignee in any degree and however remote. They are not limited to the immediate assignee of the inventor, but embrace the ultimate assignee. *Selden v. Stockwell S. L. G. B. Co.*, 20 O. G. 1737; *s. c.* 19 *Blatch*. 544; *s. c.* 9 *Fed. Rep.* 390.

No assignment of an unpatented invention is required to be recorded by this section, unless it is an assignment on which a patent is to be issued to "the assignee," and in such case the invention must be so identified in the assignment by a reference to a specification or an application, or

otherwise, that there can be no mistake as to what particular invention is intended. *Wright v. Randel*, 21 O. G. 493; s. c. 19 Blatch. 495; s. c. 8 Fed. Rep. 591.

When an assignment of an interest in the invention is recorded in the patent office, the patent may be issued to the inventor and assignee jointly. *Wright v. Randel*, 19 Blatch. 495; s. c. 21 O. G. 493; s. c. 8 Fed. Rep. 591.

If the assignment which divested the inventor of his interest in the patent was made before July 8, 1870, the specification for a reissue need not be signed by the inventor. *Selden v. Stockwell S. L. G. B. Co.*, 20 O. G. 1377; 19 Blatch. 544; s. c. 9 Fed. Rep. 390.

A patent cannot be granted to an assignee where the inventor himself would not be entitled to a patent. *Tatham v. Loring*, 5 N. Y. Leg. Obs. 207.

If assignments have been made, the commissioner of patents must be governed by the record in determining to whom a patent shall issue. *Thomas A. Edison v. United States*, 7 O. G. 423; *Edwin L. Paine*, 13 O. G. 407.

SEC. 489<sup>e</sup> When any person having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the decedent, if he shall have died intestate; or if he shall have been disposing of the same, then in trust for his devisee in as full manner and on the same terms and conditions as if the same might have been claimed or enjoyed by him during his lifetime; and when the application is made by his legal representatives, the oath or affirmation to be made shall be so varied in form that it can be taken by them.

*Statute Revised*—July 8, 1870, ch. 230, § 34, 16 Stat. 202.

*Prior Statutes*—April 17, 1800, ch. 25, § 2, 2 Stat. 38.—July 4, 1836, ch. 357, § 10, 5 Stat. 121.

A patent issued to an executor will be valid, although the trust is not expressed on the face thereof, for the law creates the trust. *Stimpson v. Rogers*, 4 Blatch. 333; *Northwestern Co. v. Philadelphia*, 6 O. G. 34; s. c. 1 Ban & Ard. 177.

The import of this provision is that while the legal title to the invention is devolved upon the administrator, he must take and hold it subject to any equities existing as against the inventor in his lifetime. Where

the inventor parted with the equitable title, the administrator holds it under exactly the same conditions, and subject to the same limitations of his interest in it. *Northwestern Co. v. Philadelphia Co.*, 6 O. G. 34; s. c. 1 Ban & Ard. 177.

An administrator with relation to letters patent is substantially a trustee for the heirs of the inventor, but in order to act he must make proof of his representative character. Foreign letters of administration are not good evidence of it. *Robert Ransome's Ex'rs*, 2 Dec. Com. 143.

If an applicant dies, his executor need not file a new application, but may be made a party to the pending application. *Rice v. Burt*, 16 O. G. 1050.

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

*Statute Revised*—July 8, 1870, ch. 230, § 35, 16 Stat. 202.

*Prior Statutes*—June 25, 1864, ch. 159, § 1, 13 Stat. 194.—March 3, 1865, ch. 112, § 1, 13 Stat. 533.

The decision of the commissioner in regard to abandonment upon a renewed application is not conclusive, and all the defences which can be made to a patent granted upon an original application may be made to a patent granted upon a renewed application. *U. S. Rifle Co. v. Whitney Arms Co.*, 11 O. G. 373; s. c. 14 Blatch. 94; s. c. 2 Ban & Ard. 493; *Marsh v. Commissioner*, 5 Fish. 610; s. c. 3 Biss. 321; 2 O. G. 340; *Planing Machine Co. v. Keith*, 101 U. S. 479; s. c. 17 O. G. 1031; s. c. 4 Ban & Ard. 100.

If applicants file new applications, such as have been before filed by them and abandoned, the proper action is not to reject them on reference to the former application, but to refuse to consider them, because the right to file them does not exist. *Andrew Mills*, 7 O. G. 961; *George Crompton*, 9 O. G. 5; *Alfred Shoe*, 3 Dec. Com. 62; *Robert McCully*, 6 O. G. 153; *Timothy Gordon*, 6 O. G. 543; *Davies v. Hartman*, 9 O. G. 351.

An application cannot be renewed if the motion therefor is made more than two years after the allowance of the patent. *Hardy*, 12 O. G. 1075.

An inventor may file a second application although more than two years have elapsed since the allowance of a prior application which was forfeited for non-payment of the final fee. *Livingston*, 20 O. G. 1747.

The filing of a naked petition for the renewal of a rejected application does not of itself renew the case, but the petition must be accompanied by a demand for the action appropriate to the next stage of proceeding. *Millspaugh*, 2 Dec. Com. 112.

If an application is made for an article and a process, and the claim for the article is rejected, such claim can only be renewed by an application for a reissue of the patent for the process. *Arkell*, 11 O. G. 1111; *C. B. Cottrell*, 9 O. G. 495.

**SEC. 4898.** Every patent, or any interest therein, shall be assignable in law by an instrument in writing; and the patentee, or his assigns or legal representatives, may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance, shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the patent office within three months from the date thereof.

*Statute Revised*—July 8, 1870, ch. 230, § 36, 16 Stat. 203.

*Prior Statutes*—February 21, 1793, ch. 11, § 4, 1 Stat. 322.—July 4, 1836, ch. 357, § 11, 5 Stat. 121.

### **Construction.**

This section is confined to assignments, grants, and conveyances of interests in patents after they are issued. *Wright v. Randel*, 19 Blatch. 495; s. c. 18 O. G. 857; s. c. 8 Fed. Rep. 591.

### **Mode of Assigning.**

The monopoly granted to the patentee is for one entire thing. It is the exclusive right of making, using, and vending to others to be used, the improvement he has invented, and for which the patent is granted. The monopoly did not exist at common law, and the rights therefore which may be exercised under it can not be regulated by the rules of the

common law. It is created by the act of Congress, and no rights can be acquired in it unless authorized by statute, and in the manner the statute prescribes. *Gayler v. Wilder*, 10 How. 477.

There are three classes of persons in whom the patentee can vest an interest of some kind in the patent. They are an assignee, a grantee of an exclusive sectional right, and a licensee. An assignee is one who has had transferred to him in writing the whole interest of the original patent, or any undivided part of such whole interest, in every portion of the United States; and no one, unless he has had such an interest transferred to him, is an assignee. A grantee is one who has had transferred to him in writing the exclusive right under the patent to make and use, and to grant to others to make and use, the thing patented within and throughout some specified part or portion of the United States. Such right must be an exclusive sectional right, excluding the patentee therefrom. A licensee is one who has had transferred to him in writing or orally a less or different interest than either the interest in the whole patent or an undivided part of such whole interest, or an exclusive sectional interest. *Potter v. Holland*, 1 Fish. 327; s. c. 4 Blatch. 206; *Hill v. Whitcomb*, 1 Holmes 317; s. c. 5 O. G. 430; s. c. 1 Ban & Ard. 34; *Gayler v. Wilder*, 10 How. 477; *Blanchard v. Eldridge*, 1 Wall. Jr. 337; s. c. 2 Robb 737; *Pitts v. Jameson*, 15 Barb. 310; *Buss v. Putney*, 38 N. H. 44; *Therebath v. Celluloid Manuf. Co.*, 5 Ban & Ard. 577; s. c. 3 Fed. Rep. 143.

As the grants of the crown were at common law construed with the greatest strictness, the privileges granted by a patent for a monopoly would probably not have been treated as capable of assignment, unless made so by the letter of the grant. Patents are now granted to the inventor, his executor, administrator, and assigns. They are, therefore, assignable as other personal chattels by force of the grant which creates them. *Blanchard v. Eldridge*, 1 Wall. Jr. 337; s. c. 2 Robb 737.

An assignment of an interest in a patent is not required to be under seal. *Gottfried v. Miller*, 104 U. S. 521; s. c. 21 O. G. 711; s. c. 10 Fed. Rep. 471.

A patent, privilege, or monopoly, could not be assigned at common law, except by deed, for the reason that, being a franchise and part of the royal prerogative, it could only subsist by grant. As a general rule, an assignment of an interest in a patent must be in writing, for the reason that such transactions are required to be recorded, and in fact and reality are not authorized to be made in any other way. *Baldwin v. Sibley*, 1 Cliff. 150; *Jordan v. Dobson*, 4 Fish. 232; s. c. 2 Abb. U. S. 398; 7 Phila. 533; *Davy v. Morgan*, 56 Barb. 218.

An agreement which would be valid without recording need not be in writing. *Blakeney v. Goode*, 30 Ohio St. 350.

A contract by an inventor to take the patent in trust for the joint and equal benefit of himself and another need not be in writing. *Blakeney v. Goode*, 30 Ohio St. 350.

If an agent has been licensed to sell patented machines for the patentee, a verbal assignment of his right is valid. *Springfield v. Drake*, 58 N. H. 19.

An assignment is a grant in writing of the whole or a part of the exclusive right vested in the patentee by the letters patent, and it makes no difference whether such part be designated as an undivided part of the whole patent, or as the grant of the exclusive right of the patentee within a particular district. *Baldwin v. Sibley*, 1 Cliff. 150; *Farrington v. Gregory*, 4 Fish. 221.

It was obviously not the intention of Congress to permit several monopolies to be made out of one and divided among different persons within the same limits. Such a division would inevitably lead to fraudulent impositions upon persons who desired to purchase the use of the improvement, and would subject a party who, under a mistake as to his rights, used the invention without authority, to be harassed by a multiplicity of suits instead of one, and to successive recoveries of damages by different persons holding different portions of the patent right in the same place. *Gayler v. Wilder*, 10 How. 477; *Suydam v. Day*, 2 Blatch. 20.

If an assignment is acknowledged before a notary public, it is not necessary to prove the signature of the assignor. *New York Pharmaceutical Association v. Tilden*, 23 O. G. 272; s. c. 14 Fed. Rep. 471.

### Construction.

There is no magic in particular words, and they should be construed as they stand, and are used in the particular instrument, and in searching for the true interpretation, the courts will look to all the provisions of the instrument, and give such effect to it as its obvious object and design require. The words license and empower may be construed to mean grant, if that will effectuate the true intent and apparent object of the parties. *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206.

Contracts are usually made with reference to the established law of the land, and should be so understood and construed unless otherwise clearly indicated by the terms of the agreement. *Wilson v. Rousseau*, 4 How. 646; s. c. 1 Blatch. 3; s. c. 2 Robb 373.

The exclusive rights of a patentee are specially guarded from intrusion, but the contracts which he makes to share them with third persons are interpreted and enforced just as other legal engagements. *Morse v. O'Reilly*, 6 Penn. L. J. 501.

Reference may be made to the circumstances under which a contract was made, as affording the means of applying the language employed in the instrument to the subject-matter of the agreement. *Read v. Bowman*, 2 Wall. 591.

A reference to the specification renders it allowable to examine those documents in connection with the assignment as means of ascertaining the true intent and meaning of the parties. *Read v. Bowman*, 2 Wall. 591.

General words in an agreement should be restrained by the particular occasion of using them. *Troy Factory v. Corning*, 14 How. 193; s. c. 1 Blatch. 467.

If an assignment recites the letters patent, giving their date and the

name of the patentee, it is sufficient to pass the title to the invention patented, although the invention is misnamed. *Harmon v. Bird*, 22 Wend. 113.

If there is any doubt in the construction of an assignment, it should be resolved against the grantor, for he is chargeable with any obscurity in this respect. *Smith v. Selden*, 1 Blatch. 475; *May v. Chaffee*, 5 Fish. 167; s. c. 2 Dillon 385.

Where there is doubt as to the proper construction of an instrument, a subsequent confirmatory instrument is entitled to great consideration; but where its meaning is clear in the eye of the law, the error of the parties can not control its effect. *Railroad Co. v. Trimble*, 10 Wall. 367.

The date of a deed may always be controlled by evidence of the actual delivery. If an agreement recites the deed and states that it was then made, this is conclusive that the deed was then made, and the date is immaterial. *Dyer v. Rich*, 42 Mass. 180.

The interpretation of a contract is to be determined by the sense in which the parties intended to use the terms employed to express it. *Wetherill v. Zinc Co.*, 6 Fish. 50; s. c. 9 Phila. 385; 2 O. G. 471.

The sense in which the parties intended to use the terms employed in a contract must be gathered from the instrument itself, irrespective of declarations written or oral by either party, as to his understanding of its meaning or as to his motives in making it. *Wetherill v. Zinc Co.*, 6 Fish. 50; s. c. 9 Phila. 385, 2 O. G. 471.

In aid of the interpretation of a contract, it is proper to consider facts cognate to the subject of the contract and within the knowledge of the parties to which it may therefore be presumed that the stipulations of the contract were intended to be applied, and by which their effect and meaning were to be governed. *Wetherill v. Zinc Co.*, 6 Fish. 50; s. c. 9 Phila. 385; 2 O. G. 471.

Each case must be judged of as well by the terms of the grant of privilege as also by the situation of the parties or the circumstances under which they act. *Steam Cutter Co. v. Sheldon*, 5 Fish. 477; s. c. 10 Blatch. 1.

An assignment of an interest in an invention secured by letters patent is a contract, and, like all other contracts, is to be construed so as to carry out the intention of the parties. *Nicolson Co. v. Jenkins*, 14 Wall. 452; s. c. 4 Fish. 201; 5 Fish. 491; 1 Abb. U. S. 567; 1 O. G. 465; 3 A. L. T. (U. S.) 177.

Where certain terms are used in a grant which have a well-known general meaning, then in the interpretation of such grant such well-known general meaning must be given to the terms used, unless it appears that some other or different meaning was intended by them. *Goodyear v. Cary*, 4 Blatch. 271.

No court is at liberty to add to the terms used any meaning beyond their ordinary import, unless there are some supplementary expressions to justify such a construction. *Woodworth v. Sherman*, 3 Story 171; s. c. 2 Robb 257.



It is not to be presumed that a grantor intends to grant more than he has a right to grant, or that a grantee intends to receive by way of grant that to which he has a full right without a grant. *Goodyear v. Cary*, 4 Blatch. 271.

Every part of a deed should be examined in order to ascertain whether the interpretation to be given to a particular clause is the true one. *Goodyear v. Cary*, 4 Blatch. 271; *Baldwin v. Sibley*, 1 Cliff. 150.

Courts of equity do not regard the forms of instruments, but look to the intent, and give to the acts of the parties the construction which that intent justifies and requires, so far as it can be done consistently with general principles. *Hall v. Speer*, 6 Pitts. L. J. 403; *Perry v. Corning*, 7 Blatch. 195.

A limitation to patents which the party holds in his own right applies to patents of which he is the apparent but not real owner, but does not exclude patents of which his tenure is not exclusive. *Wetherill v. Zinc Co.*, 6 Fish. 50; s. c. 9 Phila. 335; 2 O. G. 471.

If the grantee is unable to make the stipulated payments, and the transfer is treated as a nullity by both parties, it will not be regarded as in force. *Railroad Co. v. Trimble*, 10 Wall. 367.

If the payment of an annuity is not a condition to the vesting of an interest in the patent, an omission or refusal to pay will not give the patentee a right to rescind the contract, or have the effect to remit him to his interest in the patent as patentee. The right to the annuity rests in covenant. *Hartshorn v. Day*, 3 Fish. 32; s. c. 19 How. 211; *Day v. Union Rubber Co.*, 20 How. 216; s. c. 3 Blatch. 488, *Day v. Candee*, 3 Fish. 9; *Goodyear v. Union Rubber Co.*, 4 Blatch. 63; *Steam Cutter Co. v. Sheldon*, 5 Fish. 477; s. c. 10 Blatch. 1.

When an assignment provides that a forfeiture of the grant shall not take place if the grantor does not use reasonable diligence to promote the success of the invention, there will be no forfeiture if he is in default. *Buckley v. Sawyer Manuf. Co.* Fed. Rep. 358.

If a party, in consideration of an assignment of a patent, agrees to give the patentee a certain percentage of the profits arising from the sale of the patented article, and of the right to manufacture it, this contains an implied contract that the business shall be carried on if profitable. *Wilson v. Marlow*, 66 Ill. 385.

A deed conveys a title, although it may have covenants in it which have not been performed. There are things which rest in grant, and things which rest in covenant. If the covenant fails by the *laches* of the grantor, the grant nevertheless stands. The covenant does not affect the grant; the grant passes the title and operates *in præsentia*. *Day v. Stelman*, 1 Fish. 487.

### Assignment.

The delivery of an assignment to the attorney of the assignor, to be delivered upon the happening of a contingency, is a sufficient delivery, although the assignor dies before the contingency happens. *Hammond v. Hunt*, 4 Ban & Ard. 111.

The consideration expressed in an assignment is not conclusive upon the parties. The assignee, in an action by the assignor for the price, may prove that the assignor for the amount named therein also agreed to give him the benefit of additional improvements, and had not done so. *Wheeler v. Billings*, 38 N. Y. 263.

If an instrument is in words and effect no more than an appointment of a party as the patentee's sole agent, in terms irrevocable, yet giving him only an interest by way of commissions in the proceeds of the sale of the articles manufactured and sold by him in the execution of his agency, the patentee may make an assignment of the same territory to another. *Kempton v. Bray*, 99 Mass. 350.

If an assignment containing a provision for its cancellation on six months' notice provides that the assignor shall receive a certain sum for each year during the term of the agreement, from the premiums, and the assignee elects to cancel the assignment before the termination of a year, the assignor may recover a proportionate sum for the time that the assignee actually enjoyed the benefit of the contract. *Gale v. Nourse*, 81 Mass. 300.

A mere assignment under a State insolvent law does not pass the debtor's interest in a patent, for the statute contemplates a written instrument signed by the owner of the patent, and duly recorded in the patent office, as necessary to vest the legal title in the purchaser. *Ashcroft v. Walworth*, 5 Fish. 528; s. c. 1 Holmes 152; 2 O. G. 546.

A judgment debtor may be compelled, on proceedings supplemental to an execution, to execute and deliver an assignment of his interest in a patent to a receiver. *Clan Ranald v. Wyckoff*, 41 N. Y. Supr. 527; *Barnes v. Morgan*, 6 T. & C. 105; s. c. 10 N. Y. Supr. 703; *Ager v. Murray*, 21 O. G. 1197; s. c. 20 O. G. 1311; 105 U. S. 126; s. c. 1 Mackey 87; *Pacific Bank v. Robinson*, 20 O. G. 1314; s. c. 57 Cal. 520; *Carver v. Peck*, 131 Mass. 291.

A creditor may maintain a bill to reach the interest of a debtor in a patent, although the patent is void for want of novelty or utility. *Gillett v. Bate*, 86 N. Y. 87.

If the patentee does not make an assignment to a receiver appointed in proceedings supplemental to an execution, a sale by the latter will not pass an interest in the patent. *Gordon v. Anthony*, 16 O. G. 1135; s. c. 16 Blatch. 234; s. c. 4 Ban & Ard. 248.

If an instrument excepts such property as is exempt by law, it will not pass an interest in a patent. *Campbell v. James*, 18 O. G. 1111; s. c. 18 Blatch. 92; s. c. 5 Ban & Ard. 354; s. c. 2 Fed. Rep. 338.

The thing to be assigned is not the mere parchment on which the grant is written, but the monopoly which the grant confers, the right of property which it creates. *Railroad Co. v. Trimble*, 10 Wall. 367.

If an agent employed to sell a patent right secretly purchases it from the principal without disclosing the fact that he is a purchaser, and then sells parts thereof to others, he can not, upon being called upon to account for the profits, repurchase such parts and tender them to the principal. *Jeffries v. Wiester*, 2 Saw. 135.

An interest in the net proceeds of collections under a patent does not necessarily amount to legal ownership of the patent itself. *Jordan v. Dobson*, 4 Fish. 232; s. c. 7 Phila. 533; 2 Abb. U. S. 398.

An assignment by a patentee in such general terms as are usual in speaking of the thing to which the patented part is attached, conveys the right to make and use the thing actually patented. *Myers v. Turner*, 17 Ill. 179; *Hill v. Thuermer*, 13 Ind. 351.

Although an assignment grants only the right to manufacture and sell, yet it passes the legal right to the entire patent, for the right to sell carries with it the right to use the machine sold. *Nellis v. Pennock Manuf. Co.*, 22 O. G. 1131; s. c. 13 Fed. Rep. 451.

If the patentee assigns the patent to two persons as trustees, with power to them to sell and assign it, an assignment by one alone is void, for the power is joint. *Wescott v. Wayne Agricultural Works*, 11 Fed. Rep. 298.

An instrument can not be construed as an assignment unless it contains some operative words showing an intention to assign. *Campbell v. James*, 18 Blatch. 92; s. c. 18 O. G. 1111; s. c. 5 Ban & Ard. 354; 2 Fed. Rep. 338.

An assignment of the patent, excepting counties previously sold, is not void for uncertainty, because it is capable of being made certain by evidence, showing what counties have been actually sold. *Washburn & M. Mfg. Co. v. Haish*, 19 O. G. 173; s. c. 4 Fed. Rep. 900.

If an assignment is conditional, a license by the assignee after a breach of the condition is void. *Abbett v. Zusi*, 5 Ban & Ard. 38.

If an assignment is a grant upon a condition precedent, an offer on the part of the grantee to perform the condition does not give effect to the grant so as to vest the title in the grantee. *Pitts v. Hall*, 3 Blatch. 201.

If the purchaser, in consideration of an assignment, agrees to pay a certain sum within a certain time, or reassign the interest so received, and fails to pay within the time, the patentee acquires the right to demand a reassignment, and if not reassigned he can recover the value. All that the purchaser is bound to do is to offer to reassign the interest. *Manvel v. Holdrege*, 45 N. Y. 151.

If a patentee agrees to sell an interest in an original patent, he does not comply with the contract by an assignment of an interest in a subsequent patent for an improvement. *Pearson v. Portland*, 69 Me. 278.

If the contract is to pay a certain sum as soon as a decree is obtained establishing the validity of the patent, the money is not payable upon obtaining a decree *pro confesso*, for that is interlocutory merely. *Russell v. Lathrop*, 122 Mass. 300.

If a patentee agrees to allow another to use the thing patented, he breaks the contract by suing out an injunction against the latter as an infringer. *Sullings v. Goodyear D. V. Co.*, 36 Mich. 313.

If an inventor having a pending application for several modes of manufacturing an article, sells the exclusive right to all the modes to another, he can not compel the latter to accept a patent for only one mode. *Serviss v. Stockstill*, 30 Ohio St. 418.

When the payment is to be made upon an assignment of the patent, the purchaser is not bound to accept an assignment and make the payment after the patent has been declared void on an interference proceeding. *Peck v. Collins*, 76 N. Y. 376.

If a patent is taken in the name of another in trust for the inventor, but with the right to purchase at a price to be fixed by arbitrators, the inventor can not maintain an action prior to an award. *Perkins v. United S. E. L. Co.*, 24 O. G. 204; 16 Fed. Rep. 513.

Limitations in respect to territorial limits, extent of use, and the like, may be, and in general are, provided by express terms or stipulations. *Steam Cutter Co. v. Sheldon*, 5 Fish. 477; s. c. 10 Blatch. 1.

The assignment of an exclusive right to make and use, and to vend to others the patented machine within a certain territory, authorizes the assignee to vend the products of the machine elsewhere. The restriction in the assignment is to be construed as applying solely to the using of the machine. There is no restriction as to place of the sale of the product. *Simpson v. Wilson*, 4 How. 709; s. c. 2 Robb 469.

A special grant of the right of vending, over and above that of making and using, in an assignment, is wholly unnecessary where the assignment contemplates the exclusive right within a certain district, so as to give the assignee the whole interest. The exclusive right of fabricating and using necessarily comprises the whole beneficial interest, and the right of parting with it, or any part of it, is incident to the right of property. The latter was specially secured by the statute *ex majori cautela* to obviate all difficulty on the subject. *Bellas v. Hays*, 5 S. & R. 427.

An assignee can not assign the entire right for a particular territory, and then sell single machines to be used in the same territory after the expiration of the patent. *Union Paper Bag Co. v. Nixon*, 9 O. G. 691; s. c. 1 Flippin 491; s. c. 2 Ban & Ard. 244.

If a patentee sell a territorial right, he can not use another machine substantially the same within that territory. *Ferree v. Smith*, 29 La. An. 811.

A covenant that the covenantee shall enjoy the exclusive use of the patent within a certain territory, such use being limited to a certain number of machines, passes the entire interest of the patentee in the thing patented for the territory, and vests it in the covenantee. *Ritter v. Serrell*, 2 Blatch. 379.

This section refers to the grant of an exclusive right in a patent, and the term exclusive comprehends not only an exclusive right to the whole patent, but an exclusive right to the patent in a particular section of the country. A limitation of the number of the machines to be manufactured by the grantee, or a reservation of a right by the patentee to construct machines within the territory, does not destroy the exclusive character of a grant. *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206.

The assignment of a patent does not carry with it a transfer of the right to damages for an infringement committed before such assignment. *Moore v. Marsh*, 7 Wall. 515.

A claim for damages arising from an infringement may be assigned. The profits are not regarded in the light of unliquidated damages. The right to recover rests upon the principle that the party complained of has unlawfully appropriated to himself the benefits of an improvement or discovery which belongs to another, and that so far as he has made profit by such appropriation, he is liable to the party injured. This profit is ascertainable by evidence, and does not, like the claim for damages in an action for a tort, rest in the mere discretion of a court or jury. *Jenkins v. Greenwald*, 2 Fish. 37; s. c. 1 Bond 126; *Campbell v. James*, 18 Blatch. 92; s. c. 18 O. G. 1111; s. c. 5 Ban & Ard. 354; s. c. 2 Fed. Rep. 338; *Shaw v. Colwell Lead Co.*, 11 Fed. Rep. 711; *Consolidated O. W. P. Co. v. Eaton*, 12 Fed. Rep. 865; *Hamilton v. Rollins*, 5 Dill. 495; s. c. 3 Ban & Ard. 157; *Campbell v. James*, 5 Ban & Ard. 630; s. c. 5 Fed. Rep. 806.

The right to the damages which accrued in the lifetime of the patent is a mere chose in action after the expiration of the patent, and not assignable. *Bell v. McCullough*, 1 Fish. 380; s. c. 1 Bond 194.

An assignor may prove by parol that he sold the patent to another who then sold it to the assignee, and that the assignment was made directly from him to the assignee to save the expense of two assignments. *Tillotson v. Ramsay*, 51 Vt. 309.

Although a party is the assignee of several patents for combinations, yet he has no greater rights than the assignors, for each patent must rest on its own merits alone. *Washburn & M. Manuf. Co. v. Griesche*, 16 Fed. Rep. 669.

### Agent.

An agency is revocable, but an agency coupled with an interest is not revocable. *Burdell v. Denig*, 2 Fish. 588; s. c. 92 U. S. 716.

Where an assignment is executed by an agent, there must be proof of the agent's authority. *Stone v. Palmer*, 28 Mo. 539.

An agent can not execute an assignment under seal unless he has authority under seal. *Bellas v. Hays*, 5 S. & R. 427.

The execution of an assignment by affixing the name and seal of the agent, and not the name and seal of the principal, is not a good execution of the authority. *Bellas v. Hays*, 5 S. & R. 427.

No confirmation of an assignment defectively executed in the name of an agent, can make it the deed of the principal short of affixing the name and seal of the principal. *Bellas v. Hays*, 5 S. R. 427.

### Corporation.

A corporation has the power to purchase a patent if such purchase is necessary to carry into execution the purposes and objects for which it was created. *Blanchard's Factory v. Warner*, 1 Blatch. 258; *Dorsey Harvester Rake Co. v. Marsh*, 6 Fish. 387.

Although the assignor adds the word "president" to his name, yet it is a good execution of the deed for himself, but will not convey any interest of the corporation. *Campbell v. James*, 17 Blatch. 43; s. c. 18 O. G. 979; s. c. 4 Ban & Ard. 456.

A certificate of an interest in a patent, purporting to be signed by the secretary of a corporation to be subsequently organized, is not such an assignment as the statute requires. *Hope Iron Works v. Holden*, 58 Me. 146.

A contract will bind a corporation, although its officer uses his private seal instead of the corporate seal, if he was duly authorized to make it, or his act was subsequently ratified. *Eureka Co. v. Bailey Co.*, 11 Wall. 488.

An assignment to an incorporated company not at the time organized will inure to its use when organized, at least by way of estoppel, and be good against the grantor, whether it took effect on its delivery to pass any property or not. *Dyer v. Rich*, 42 Mass. 180.

An assignment of a patent by a corporation is valid, although it is not under the corporate seal. *Gottfried v. Miller*, 104 U. S. 521; s. c. 21 O. G. 711; s. c. 10 Fed. Rep. 471.

### **Personal Representatives.**

If the court which pronounced a judgment has jurisdiction over the subject-matter, a proper case for its exercise will be presumed to have been sufficiently presented, and the adjudication to be right. The granting of letters of administration to a party, by a court of competent jurisdiction, is conclusive of his legal right to the grant of them. *Northwestern Co. v. Philadelphia Co.*, 6 G. G. 34; s. c. 1 Ban & Ard. 177.

The right of an executor or administrator of the patentee will be determined according to the law of the patentee's domicile at the time of his decease. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; s. c. 2 Cliff. 351.

The right of an administrator in a patent is not acquired, and can not be assigned under State laws. The act of Congress directs the mode in which an assignment shall be made and where it shall be recorded. The administrator may sell the patent the same as any other personal property of the estate, and there is no reason why the right may not be conveyed in parts so as to suit purchasers. *Brooks v. Jenkins*, 3 McLean 432.

Administrators of an estate are not, properly speaking, trustees in whom is vested the legal title. The law clothes them with certain powers, by which they are enabled to transmit the legal title of property. Acts done by one of them, which relate to the delivery, gift, sale or release of the decedent's goods or personal property, are deemed the acts of all. An assignment by one administrator will therefore pass the whole interest in the patent. *Wintermute v. Redington*, 1 Fish. 239.

The purchaser of personal property from an administrator need not show that the formality required by the law has been complied with, for he can hold it unless the transaction is fraudulent. *Brooks v. Jenkins*, 3 McLean 432.

An assignment by a person as administrator will pass the right held by the person as executor. *Newell v. West*, 13 Blatch. 114; s. c. 8 O. G. 598; s. c. 9 O. G. 1110; s. c. 2 Ban & Ard. 113.

**Estoppel.**

A man can pass by grant or assignment only that which he now possesses, and which is in existence at the time either actually or potentially. His grant or assignment is therefore by its natural interpretation limited to the rights and things which are then in existence, and which he has power to grant, unless he uses other language which imports an intention to grant what he does not now possess and what is not now in existence. In the latter case the language does not even then operate strictly as an assignment or grant, but only as a covenant or contract which a court of equity will carry into full effect when the right or thing comes *in esse*. *Woodworth v. Sherman*, 3 Story 171; s. c. 2 Robb 257.

If a party making an assignment at a time when he has no title, subsequently acquires title, and then testifies in an action brought by the assignee that the assignee became the owner under such assignment, he will be estopped from setting up a title against the respondent. *Littlefield v. Perry*, 21 Wall. 205; s. c. 7 O. G. 964; *Sherman v. Champlain Co.*, 31 Vt. 162; *Gottfried v. Miller*, 104 U. S. 521; s. c. 21 O. G. 711; s. c. 10 Fed. Rep. 471.

An assignment made by one who has no title, with the written assent of the party in whom the title is vested, is effective as a transfer of the title. *Sherman v. Champlain Co.*, 31 Vt. 162.

A mere assignment of the right, title and interest of the assignor, without anything more, will not operate as an estoppel to pass a title subsequently acquired by the assignor. *Perry v. Corning*, 7 Blatch. 195.

If a patent is issued to a corporation after it is incorporated it is estopped from proving that it had no corporate existence at the time of the assignment of the invention to it in order to defeat a claim for royalty. *Bommer v. American Spring Co.*, 44 N. Y. Sup. 454.

If there is a controversy as to whether the article made by the respondent is the same as the patentee's, an agreement will not operate as an estoppel. *Roemer v. Simon*, 12 O. G. 796; s. c. 95 U. S. 214; s. c. 1 Ban & Ard. 138.

If the inventor did not know that others were making any advancements or investments of either capital or skill on faith that the ground he had begun to occupy was open to all, he is not estopped from setting up his invention. *Sprague v. Adriance*, 14 O. G. 308; s. c. 3 Ban & Ard. 124.

**Warranty.**

The vendor of a patent impliedly warrants the validity of the patent. *Faulks v. Kamp*, 17 O. G. 851; s. c. 17 Blatch. 432; s. c. 5 Ban & Ard. 73; s. c. 3 Fed. Rep. 898.

A person who sells a patent impliedly warrants the title, and is estopped from alleging the invalidity of the patent in an action by the grantee. *Faulks v. Kamp*, 17 Blatch. 432; s. c. 17 O. G. 851; s. c. 5 Ban & Ard. 73; s. c. 3 Fed. Rep. 898; *Onderdonk v. Fanning*, 5 Ban & Ard. 85; s. c. 4 Fed. Rep. 148; *Consolidated M. P. Co. v. Guilder*, 9 Fed. Rep. 155.

A provision in an assignment that the grantee shall have the benefit of the patent as fully as the patentee holds it, does not amount to a warranty that the patent is valid. *McKenzie v. Bailie*, 4 C. L. B. 209.

### Assignment before Patent.

The discoverer of a new and useful improvement is vested by law with an inchoate right to its exclusive use, which he may perfect and make absolute by proceeding in the manner which the law requires. An assignment of his whole interest, whether before or after the patent is issued, is equally within the provisions of the act. If it is made before the issuing of the patent, no new assignment need be made, although the patent is issued to the discoverer. When the patent issues, the legal right to the monopoly and property it creates is by operation of the assignment vested in the assignee. *Gayler v. Wilder*, 10 How. 477; *Rathbone v. Orr*, 5 McLean 131; *Rich v. Lippincott*, 2 Fish. 1; *Herbert v. Adams*, 4 Mason 15; s. c. 1 Robb 505; *Hammond v. M. & H. Organ Co.*, 1 Holmes 296; s. c. 92 U. S. 724; s. c. 5 O. G. 31; s. c. 6 Fish. 599; *Wright v. Randel*, 19 Blatch. 495; s. c. 21 O. G. 493; s. c. 8 Fed. Rep. 591.

Whether the machine is perfected or not at the time of the sale is immaterial, if the inventor agrees to make it perfect and procure a patent. *Rathbone v. Orr*, 5 McLean 131.

An assignment is valid, although it is made after the rejection of the application of the inventor by the commissioner, and an appeal from that decision. *Gay v. Cornell*, 1 Blatch. 506.

An assignment of an imperfect invention, with all improvements upon it that the inventor may make, is equivalent in equity to an assignment of the perfected results, and the patentee takes the patent for an improvement in trust for the assignee. *Littlefield v. Perry*, 21 Wall. 205; s. c. 7 O. G. 964.

A contract to assign all improvements in a certain machine may cover everything then in embryo in the mind of the inventor, though not yet matured. An intent to cover all improvements ever made at any future time would be likely to be expressed in explicit language to that effect. *Nesmith v. Calvert*, 1 W. & M. 34; s. c. 2 Robb 311.

If an inventor who has covenanted to take out letters patent for another at his request and cost, takes them out without an advance of the costs or authority from the covenantor, he will be deemed to hold them in trust for the covenantee. *Emmons v. Sladdin*, 9 O. G. 352; s. c. 2 Ban & Ard. 199.

If a covenant to execute deeds of conveyance of the part sold, as soon as may be after letters patent shall have issued, does not give the grantee a legal title, a *jus in re*, it clearly confers on him a *jus ad rem*, an equitable right to the thing itself, and is not a mere executory contract to account for the proceeds. *Clum v. Brewer*, 2 Curt. 506.

Although an agent who is employed to aid an inventor in constructing and perfecting a machine gets a patent therefor, yet this is no breach of the contract of employment. *Green v. Willard I. B. Co.*, 1 Mo. Ap. 202.



Unless an employee is expressly required by his contract to exercise his inventive faculties for the benefit of his employer, he alone is entitled to a patent for an invention made during the period of the employment, and the employer is not entitled to an assignment thereof. *Hapgood v. Hewitt*, 21 O. G. 1786; s. c. 11 Fed. Rep. 422.

A party who engages an inventor to make inventions and improvements for his benefit, has no legal or equitable title to an invention made after the contract was terminated. *Appleton v. Bacon*, 2 Black 699.

If an inventor who is employed to make improvements takes the patent in his own name, he must put the other party in some default before he can claim the exclusive ownership of the improvements. *Continental Co. v. Empire Co.*, 4 Fish. 428; s. c. 8 Blatch. 295.

Although a firm of which the inventor is a member pays the expense of obtaining a patent, yet if the patent is taken in his name it belongs not to the firm but to him. *McWilliams Manuf. Co. v. Blundell*, 22 O. G. 177; 11 Fed. Rep. 419.

A contract by an inventor to allow another to take out a patent for the invention in his own name may be proved by parol. *Lockwood v. Lockwood*, 63 Iowa 509.

If an assignment of an interest in one patent does not purport to give rights in another invention, it can not operate by way of estoppel to give the assignee an interest in a subsequent patent therefor. *Warren v. Cole*, 15 Mich. 265.

An assignment of a patent and the invention therein patented will not give the assignee any right to any other invention. *United Nickel Co. v. Am. N. P. Works*, 4 Ban & Ard. 74.

If a party invents or discovers and keeps secret a process of manufacture, whether a proper subject for a patent or not, he has not indeed an exclusive right to it as against the public or against those who in good faith acquire knowledge of it, but he has a property in it which a court of chancery will protect against one who, in violation of contract and breach of confidence, undertakes to apply it for his own use, or to disclose it to third persons. *Peabody v. Norfolk*, 98 Mass. 452.

An assignment of an invention after a patent has been ordered to be issued and before the issue of the patent will pass a legal title to the patent. *U. S. Stamping Co. v. Jewett*, 18 O. G. 1529; s. c. 18 Blatch. 469; s. c. 7 Fed. Rep. 869.

### **Renewal.**

If the patentee assigns the invention, the assignment carries with it the right to a renewal as an incident, unless there is something in the instrument to indicate a different intention. *Hendrie v. Sayles*, 98 U. S. 546.

If a special act permits an administrator to apply for a patent where the original application has failed, the patent will not enure to the benefit of an assignee. *Fire Extinguishing Manuf. Co. v. Graham*, 16 Fed. Rep. 543.

### Extension.

An inventor has not only an inchoate right to obtain letters patent securing to him the exclusive right to his invention for the original term, but also a further inchoate right to have the term extended, provided he shall fail without fault to obtain a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into public use. This title of an inventor to obtain an extension may be the subject of a contract of sale. There is nothing in the nature or incidents of such a right to distinguish it as a subject of sale from the inchoate right to obtain the original patent. Each appertains to the inventor by reason of his invention. Each is incomplete, and its completion depends upon the compliance by the inventor with conditions, and the performance by public officers of certain acts prescribed by law. It is true the title of an inventor to an extension is still further qualified by a further condition of his failure to obtain remuneration from the enjoyment of the exclusive right for the first term of fourteen years. But though this is an additional condition which may render parties less willing to contract, its existence does not change the nature of the right, and it no more prevents it from being the subject of a contract of sale than any other condition which is attached to it. *Clum v. Brewer*, 2 Curt. 506; *Newell v. West*, 13 Blatch. 114; s. c. 8 O. G. 593; 9 O. G. 1110; s. c. 2 Ban & Ard. 113; *Railroad Co. v. Trimble*, 10 Wall. 367; *Hammond v. M. & H. Organ Co.*, 1 Holmes 296; s. c. 92 U. S. 724; s. c. 5 O. G. 31; s. c. 6 Fish. 599; *Hoffheins v. Brandt*, 3 Fish. 218; *Hendrie v. Sayles*, 98 U. S. 346; *Prime v. Brandon Manuf. Co.*, 16 Blatch. 483; s. c. 4 Ban & Ard. 379; *Consolidated F. J. Co. v. Mason*, 7 Daly 64.

The franchise which the patent grants consists altogether in the right to exclude every one from making, using or vending the thing patented without the permission of the patentee. This is all that he obtains by the patent. When he sells the exclusive privilege of making or vending it for use in a particular place, the purchaser buys a portion of the franchise which the patent confers. He obtains a share in the monopoly, and that monopoly is derived from and exercised under the protection of the United States. The interest he acquires necessarily terminates at the time limited for its continuance by the law which created it. The patentee can not sell it for a longer time. The purchaser buys with reference to that period, the time for which the exclusive privilege is to endure being one of the chief elements of its value. He therefore has no just claim to share in a further monopoly subsequently acquired by the patentee. He does not purchase or pay for it. *Bloomer v. McQuewan*, 14 How. 539.

A sale of the invention before letters patent are obtained does not necessarily carry with it the exclusive right for the extended term, because this right is not a mere incident of the invention. Its existence is made to depend not only on matter which is subsequent to the invention, but exclusively personal to the inventor himself, and only he or his personal representatives can obtain it. But where an inventor has in terms sold to another person a part of his invention, he has done that

which is quite consistent with the intent to have that other person participate in all the rights which he as an inventor can acquire by law, and where the invention is the subject sold, it would be natural to expect to find in the instrument of sale something showing an intention that the purchaser should be interested not merely in the original letters patent, but in any extension thereof, securing the exclusive right to the same invention which was the subject of sale. *Clum v. Brewer*, 2 Curt. 506.

An ordinary assignment of the right in the patentee will not convey any right in an extension of the patent. The intention to assign such an interest must be expressed. *Case v. Redfield*, 4 McLean 526; s. c. 2 Robb 741; *Gear v. Grosvenor*, 6 Fish. 314; s. c. 1 Holmes 215; 3 O. G. 380; *Woodworth v. Sherman*, 3 Story 171; s. c. 2 Robb 257; *Brooks v. Bicknell*, 4 McLean 64; *Hodge v. Railroad Co.*, 3 Fish. 410; s. c. 6 Blatch. 85, 165; *Goodyear v. Hullahen*, 3 Fish. 251; s. c. 2 Hughes 492; *Wetherill v. Zinc Co.*, 6 Fish. 50; s. c. 9 Phila. 385; 2 O. G. 471.

The right to an extension is contingent and personal to the inventor, and does not pass as an incident to a grant of the invention and appurtenant thereto. *Mowry v. Railroad Co.*, 10 Blatch. 89; s. c. 5 Fish. 587; *Clum v. Brewer*, 2 Curt. 506.

The phrase "to the full end of the term for which letters patent are or may be granted," will convey a right to an extension. *Railroad Co. v. Trimble*, 10 Wall. 367; *Ruggles v. Eddy*, 5 Fish. 581; s. c. 10 Blatch. 52; *Nicolson Co. v. Jenkins*, 14 Wall. 452; s. c. 4 Fish. 201; 5 Fish. 491; 1 Abb. U. S. 567; 1 O. G. 465; 3 A. L. T. (N. S.) 177; *Thayer v. Wales*, 5 Fish. 448; *Phelps v. Comstock*, 4 McLean 353; *Gear v. Grosvenor*, 6 Fish. 314; s. c. 1 Holmes 215; 3 O. G. 380; *Case v. Redfield*, 4 McLean 526; s. c. 2 Robb 471; *Gear v. Holmes*, 6 Fish. 595; *Emmons v. Sladdin*, 9 O. G. 352; s. c. 2 Ban & Ard. 199; *vide Hodge v. Railroad Co.*, 3 Fish. 410; s. c. 6 Blatch. 85; *Labaree v. Peoria, P. & J. R. R. Co.*, 3 Ban & Ard. 180.

The term "renewal" is a proper and apt word to confer an interest in the extension of a patent. *Pitts v. Hall*, 3 Blatch. 201; *Goodyear v. Cary*, 4 Blatch. 271; *Chase v. Walker*, 3 Fish. 120.

The terms "rights and property that I may have from any letters patent for the same," are broad enough to include the extended letters patent. *Clum v. Brewer*, 2 Curt. 506.

An assignment of the invention after the patent has been issued, without any other language to indicate the intention of the parties, does not import a conveyance of the right to an extended term. *Waterman v. Wallace*, 13 Blatch. 128; s. c. 2 Ban & Ard. 126.

A licensee's or assignee's right is necessarily bounded by the same limits as that of the licensor or patentee, that is to say, to the original term granted by the patent to the licensor or patentee. If afterwards the patent is renewed, it is a new grant independent of the old, and the patentee is entitled to the sole and exclusive benefit thereof, unless the licensees or assignees under them have, by their original contract, secured to themselves by express covenant or grant, a right to the benefit of the renewed patent. *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206.

The right of the patentee to an extension will not pass to his trustee in insolvency appointed prior to the expiration of the original patent. *Schaum v. Baker*, 2 A. L. T. (N. S.) 15.

Unless there is an express stipulation in a grant or assignment looking to an extension of the patent by a special act of Congress, the court is bound to construe the instrument and each and all of its provisions as relating to the existing right in respect to which the parties were contracting with each other. *Gibson v. Cook*, 2 Blatch. 144.

An interest in a future extension of a patent by a special act of Congress is not the subject of assignment or grant at common law, or within the sense of this section. *Gibson v. Cook*, 2 Blatch. 144.

If a special act is passed allowing an extension under the general law, the rights of the patentee are to be governed by the general law. *Prime v. Brandon Manuf. Co.*, 16 Blatch. 453; s. c. 4 Ban & Ard. 379.

If an assignment is made to a patentee to enable him to get an extension, an agreement that he will hold the extension for the benefit of the assignor can not be enforced. *Prime v. Brandon Manuf. Co.*, 16 Blatch. 453; s. c. 4 Ban & Ard. 379.

### Recording.

Three cases only of the recording of assignments are provided for in this section: 1st. An assignment of the whole patent; 2d. An assignment of any undivided part thereof; 3d. A grant or conveyance of the exclusive right under the patent within any specified part or portion of the United States. *Brooks v. Byam*, 2 Story 525; s. c. 2 Robb 161; *Blanchard v. Eldridge*, 1 Wall. Jr. 337; s. c. 2 Robb 737; *Stevens v. Head*, 9 Vt. 174.

A license is not required by law to be recorded in the patent office in order to give effect and validity to it. *Brooks v. Byam*, 2 Story 525; s. c. 2 Robb 161; *Chambers v. Smith*, 5 Fish. 12; s. c. 7 Phila. 575; *Farrington v. Gregory*, 4 Fish. 221; *Buss v. Putney*, 38 N. H. 44; *Consolidated Fruit Jar Co. v. Whitney*, 2 Ban & Ard. 30.

If the patent has expired, an assignment of the mere right of action to recover damages need not be recorded. *Gear v. Fitch*, 16 O. G. 1231; s. c. 3 Ban & Ard. 573.

The provision as to recording assignments is merely directory for the protection of *bona fide* purchasers without notice. Even though they are not recorded within the prescribed time, they are valid against a mere wrong-doer piratically invading the patent right. *Pitts v. Whitman*, 2 Story 609; s. c. 2 Robb 189; *Stone v. Palmer*, 28 Mo. 539; *Hall v. Speer*, 6 Pitts. L. J. 403; *Olcott v. Hawkins*, 2 Am. L. J. 317; *Brooks v. Byam*, 2 Story 525; s. c. 2 Robb 161; *Boyd v. McAlpin*, 3 McLean 427; s. c. 2 Robb 277; *Case v. Redfield*, 4 McLean 526; s. c. 2 Robb 741; *McKernan v. Hite*, 6 Ind. 428; *Louden v. Birt*, 4 Ind. 56.

It seems a necessary, or at least a just inference, from this language, that until the assignee has so recorded the assignment, he is not substituted to the right and responsibility of the patentee, so as to maintain

any suit at law or in equity founded thereon. *Wyeth v. Stone*, 1 Story 273; s. c. 2 Robb 23.

It is immaterial that an assignment is not recorded until after the suit is brought. It is like the common case of a deed required by law to be registered where it is sufficient to be registered before the trial, although after the suit is brought, for it is still admissible in evidence as a deed duly registered. *Pitts v. Whitman*, 2 Story 609; s. c. 2 Robb 189.

An unrecorded assignment is valid between the parties thereto. *Holden v. Curtis*, 2 N. H. 61; *Black v. Stone*, 33 Ala. 327; *Moore v. Bare*, 11 Iowa 198; *vide Higgins v. Strong*, 4 Blackf. 182; *Mullikin v. Latchem*, 7 Blackf. 136; *McFall v. Wilson*, 6 Blatch. 260.

An assignment in bankruptcy will pass the bankrupt's interest in a patent, although it is not recorded in the patent office. *Prime v. Brandon Manuf. Co.*, 16 Blatch. 453; s. c. 4 Ban & Ard. 379.

In order to guard against an outstanding title of over three months' duration, the purchaser need only look to the records of the patent office. *Gibson v. Cook*, 2 Blatch. 144.

Within the period of three months a purchaser must protect himself in the best way that he can, as an unrecorded prior assignment will prevail. *Gibson v. Cook*, 2 Blatch. 144.

The unrecorded assignment to prevail over a subsequent assignment must be in writing, so that it may be recorded within the time limited. *Gibson v. Cook*, 2 Blatch. 144.

A party claiming under a subsequent assignment does not hold a good title as against the prior unrecorded assignment, unless he paid a valuable consideration therefor. *Saxton v. Aultman*, 15 Ohio St. 471.

Where the assignment merely purports to transfer the right and title of the assignor, it will not cut off an unrecorded assignment, if there is anything upon which the second assignment can operate, although it is recorded first. No inference can be drawn from such language in the absence of any proof upon the subject that the assignor intended a fraud upon the first assignee. *Turnbull v. Plow Co.*, 6 Biss. 225; s. c. 7 O. G. 173; s. c. 1 Ban & Ard. 544; *Ashcroft v. Walworth*, 5 Fish. 528; s. c. 1 Holmes 152; 2 O. G. 546; *Hamilton v. Kingsbury*, 17 Blatch. 460; s. c. 17 O. G. 847; s. c. 5 Ban & Ard. 157; s. c. 4 Fed. Rep. 428; *Turnbull v. Weir Plow Co.*, 9 Biss. 334; s. c. 23 O. G. 91; s. c. 5 Ban & Ard. 288; s. c. 14 Fed. Rep. 108.

The record of an assignment of an unpatented invention is not constructive notice thereof to a subsequent purchaser, for this section is confined to assignments, grants and conveyances of interests in patents after they are issued. *Wright v. Randel*, 21 O. G. 493; s. c. 19 Blatch. 495; s. c. 8 Fed. Rep. 591.

If a party claims under an instrument that is not required to be recorded against a subsequent purchaser who holds under an assignment from a person having a title on record, the burden of proof is on him to show that such purchaser at the time of making his purchase had notice of the prior interest. *Wright v. Randel*, 19 Blatch. 495; s. c. 21 O. G. 493; s. c. 8 Fed. Rep. 591.

A *bona fide* purchaser for a valuable consideration, whose assignment is duly recorded, will not be affected by any parol contract made between the parties to a prior assignment as to what it should cover. *Campbell v. James*, 18 Blatch. 92; s. c. 18 O. G. 1111; s. c. 5 Ban & Ard. 354; 2 Fed. Rep. 338.

A reference in a deed to a use of the patented machine by another is sufficient notice to the grantee to put him on inquiry as to the rights of the party so using it. *Prime v. Brandon Manuf. Co.*, 16 Blatch. 453; s. c. 4 Ban & Ard. 379.

If the means of knowledge are at hand, a purchaser will be presumed to know the facts to which an inquiry would lead him. *Mitchell v. Hawley*, 4 Fish. 388; s. c. 6 Fish. 331; 16 Wall. 544; 3 O. G. 241; 1 O. G. 306; s. c. 9 Blatch. 1.

An unrecorded assignment will prevail over the rights of a subsequent purchaser who takes with notice of the prior assignment. *Continental Co. v. Empire Co.*, 4 Fish. 428; s. c. 8 Blatch. 295; *Peck v. Bacon*, 18 Conn. 377.

If the assignee is a corporation of which the patentee is the director and manager it has notice through him of all prior unrecorded assignments. *Continental Co. v. Empire Co.*, 4 Fish. 428; s. c. 8 Blatch. 295; *Steam Cutter Co. v. Sheldon*, 5 Fish. 477; s. c. 10 Blatch. 1.

If there is no evidence that there is any purchaser who has any claim paramount to an unrecorded assignment, and the contract has been partially performed, the only remedy of a purchaser from the assignee is in damages for a breach of the contract. *Moore v. Bare*, 11 Iowa 198.

If there is an omission or misdescription in the assignment, the assignee is not entitled to have the instrument reformed, and the true description inserted, to the prejudice of a subsequent *bona fide* purchaser for a valuable consideration, who took the title after the lapse of more than three months. *Gibson v. Cook*, 2 Blatch. 144; *Woodworth v. Cook*, 2 Blatch. 151.

The record of an assignment by a person purporting to be an administrator is notice of a sale by the same party as executor. *Newell v. West*, 13 Blatch. 114; s. c. 8 O. G. 598; 9 O. G. 1110; s. c. 2 Ban & Ard. 113.

The recording of a license does not affect the rights of any one. *Chambers v. Smith*, 5 Fish. 12; s. c. 7 Phila. 575.

A license to use a machine will prevail over a subsequent assignment. *Continental Co. v. Empire Co.*, 4 Fish. 428; s. c. 8 Blatch. 295.

Although a license which confers the right to make is recorded, yet a party who purchases from the licensee is not protected against the effect of unrecorded contemporaneous instruments which take away the right to make. *Hamilton v. Kingsbury*, 17 O. G. 147; s. c. 17 Blatch. 460; s. c. 5 Ban & Ard. 157; s. c. 4 Fed. Rep. 428.

The right of a *bona fide* purchaser for a valuable consideration of an interest, whereof an assignment is not required to be recorded, will prevail over the right of a person holding a contract therefor. *Gibson v. Cook*, 2 Blatch. 144.

**License.**

A license is an authority coupled with an interest in its execution. It is not so much a property or interest *in rem*, as a right of user for the benefit of the licensee. *Brooks v. Byam*, 2 Story 525 ; s. c. 2 Robb 161.

Licenses to make and use, when derived from the patentee, or from one holding a territorial right, by virtue of a valid conveyance from him, are not required to be recorded, and consequently need not be in writing. *Baldwin v. Sibley*, 1 Cliff. 150 ; *Marston v. Swett*, 66 N. Y. 206 ; s. c. 11 N. Y. Sup. 153 ; s. c. 6 T. & C. 534.

A patent right ought not to be deemed an entirety, but to be divisible so as to permit a grant of the exclusive right to construct to one person, to use to another, and to vend to another. *Adams v. Burke*, 17 Wall. 453 ; s. c. 1 Holmes 40 ; 4 Fish. 392 ; s. c. 1 O. G. 282 ; *Washburn v. Gould*, 3 Story 122 ; s. c. 2 Robb 206 ; *Jenkins v. Greenwald*, 2 Fish. 37 ; s. c. 1 Bond 126 ; *Steam Cutter Co. v. Sheldon*, 5 Fish. 477 ; s. c. 10 Blatch. 1.

A licensee who signs a license is bound by it although he does not read it. *M'Kay v. Jackman*, 17 Fed. Rep. 641.

A license is valid although the licensee accepts it under the stress of an injunction. *M'Kay v. Jackman*, 17 Fed. Rep. 641.

A patentee may so convey the right to make as to involve or include the right either to sell or use what the grantee makes. He may also so convey the right to use as to imply the right to sell within the same limits, as well as to make the thing patented, within them. The circumstances, nature, and words of each grant must decide the construction which is just and legal. *Woodworth v. Curtis*, 2 W. & M. 524 ; s. c. 2 Robb 603 ; *Steam Cutter Co. v. Sheldon*, 5 Fish. 477 ; s. c. 10 Blatch. 1.

The right to make carries with it the right to sell, but does not necessarily imply the right to use the machine when made and sold. *Jenkins v. Greenwald*, 2 Fish. 37 ; s. c. 1 Bond 126 ; *Bicknell v. Todd*, 5 McLean 236.

The grant of a right to use and sell the thing patented confers the power to dispose of the right to use to others, because the purchase of a patented thing always carries with it the right to use the thing purchased by implication. *Farrington v. Gregory*, 4 Fish. 221 ; *Turnbull v. Weir Plow Co.*, 9 Biss. 334 ; s. c. 23 O. G. 91 ; s. c. 5 Ban & Ard. 288 ; s. c. 14 Fed. Rep. 108.

The grant of the right to use a machine passes the right to make the machine or procure it to be made. *Steam Stone Cutter Co. v. Short-sleeves*, 16 Blatch. 381 ; s. c. 4 Ban & Ard. 364 ; *Steam Cutter Co. v. Sheldon*, 10 Blatch. 1 ; s. c. 5 Fish. 477 ; *Bicknell v. Todd*, 5 McLean 236.

A grant of the exclusive right to use and sell the thing patented with a reservation of the right to make, confers upon the grantee the right to make and the exclusive right to use and sell, and reserves to the grantor the right to make in common with the grantee. *Hamilton v. Kingsbury*, 14 O. G. 448 ; s. c. 17 Blatch. 460 ; s. c. 5 Ban & Ard. 157 ; s. c. 4 Fed. Rep. 428.

A patentee may confer upon others such qualified privilege, whether of making, selling to others, or using, as he sees fit, whether within specified limits, or under limitations of quantity or number or restricted use. *Dorsey R. H. Rake Co. v. Bradley Manuf. Co.*, 12 Blatch. 202; s. c. 1 Ban & Ard. 330.

A patentee may grant the exclusive right to make and sell the patented invention within specified territory, and yet limit the use of the thing so made and sold within specified limits. *Dorsey R. H. Rake Co. v. Bradley Manuf. Co.*, 12 Blatch. 202; s. c. 1 Ban & Ard. 330.

There is a distinction between the grant of the right to make and vend a patented machine, and the grant of the right to use it. Purchasers of the exclusive privilege of making or vending the patented machine, in a specified place, hold a portion of the franchise which the patent confers, and the interest which they acquire terminates at the time limited for its continuance by the law which created it, unless it is expressly stipulated to the contrary. *Bloomer v. Millinger*, 1 Wall. 340; *Blanchard v. Whitney*, 3 Blatch. 307; *Mitchell v. Hawley*, 4 Fish. 599; s. c. 16 Wall. 544; 5 O. G. 299; s. c. 2 Fish. 518.

A license is irrevocable unless by some fault of the parties or their mutual consent if no power is reserved to revoke it. *Kelly v. Porter*, 8 Saw. 482.

A license to use the invention is valid after the granting of the patent, although the claims are amended after the execution thereof. *Kelly v. Porter*, 8 Saw. 482.

A license or contract for the use of an invention is subject to the same rules of construction as apply to any other contract. *Wetherill v. Zinc Co.*, 6 Fish. 50; s. c. 9 Phila. 385; 2 O. G. 471.

If an employee makes an invention and permits his employer to use it prior to the application for a patent, there may be an inference of a license. *M'Clurg v. Kingsland*, 1 How. 202; s. c. 2 Robb 105; *Slemmer's Appeal*, 58 Penn. 155; *Chabot v. Button Hole Co.*, 9 Phila. 378; s. c. 6 Fish. 73; *Wilkins v. Spafford*, 13 O. G. 675; s. c. 3 Ban & Ard. 274; *Magoun v. New England Glass Co.*, 3 Ban & Ard. 114.

If a party is allowed to use the invention prior to the application for a patent, without any notice of a claim to an exclusive right, a license or grant from the inventor may be presumed. *M'Clurg v. Kingsland*, 1 How. 202; s. c. 2 Robb 105.

A patentee is not estopped by his silence in omitting to assert his claim to an invention, unless it has misled another to his hurt, and that is not done where a patent is obtained before any expenditure is made. *Railroad Co. v. Dubois*, 12 Wall. 47.

An estoppel must necessarily grow out of some declaration or act of the inventor, by which the party was induced to believe that he might rightfully or innocently use the invention. If he appropriated it without consulting the inventor, and the latter was passive when he knew it, because he was powerless to prevent it, he is not estopped from asserting his right when he is in a condition to enforce it. *McMillin v. Barclay*, 5



Fish. 189; s. c. 4 Brews. 275; *Russell Manuf. Co. v. Mallory*, 5 Fish. 632; s. c. 10 Blatch. 140; 2 O. G. 495.

A grant to use and sell the thing patented is not an assignment, but a license. *Farrington v. Gregory*, 4 Fish. 221.

A conveyance of the exclusive right, within a certain specified territory, to use and vend the patented invention, but reserving to the grantor the right to make it, is a license. *Sanford v. Messer*, 5 Fish. 411; s. c. 1 Holmes 149; 2 O. G. 470.

A contract for a purchase of a portion of a patent right may be good between the parties as a license, and enforced as such in courts of justice, but the legal title to the monopoly remains in the patentee. *Sanford v. Nesser*, 5 Fish. 411; s. c. 1 Holmes 149; 2 O. G. 470.

If a license absolute on its face is in the possession of the licensee, the burden of proof is on the licensor to prove that it was delivered as an escrow. *Mellon v. Del. Lack. & W. R. R. Co.*, 21 O. G. 1616.

If the title of a licensor, who merely holds under a license, is voidable for fraud, a licensee has no right under his license after he has notice of the superior right. *Consolidated Fruit Jar Co. v. Whitney*, 2 Ban & Ard. 375.

Although a licensee pays a royalty after the expiration of the patent, yet he cannot recover it back. *M'Kay v. Jackman*, 17 Fed. Rep. 641.

### Construction.

Every person who pays the patentee for a license to use his process becomes the owner of the product, and may sell it to whom he pleases, or apply it to any purpose, unless he binds himself by covenants to restrict his right of making and vending certain articles that may interfere with the special business of some other licensee. *Washing Machine Co. v. Earle*, 2 Fish. 203; s. c. 3 Wall. Jr. 320.

Where the preliminary arrangement for a license was that the license should be in writing, there is no contract between the parties until it is delivered to and accepted by the licensee, and if he refuses to accept such a license there is no license. *Tilghman v. Hartel*, 9 O. G. 886; s. c. 2 Ban & Ard. 260.

A license to use a machine at one place will not authorize its use at another place. *Wicke v. Kleinknecht*, 7 O. G. 1098; s. c. 1 Ban & Ard. 608.

Where a license is to use in a certain building, the licensee may use the thing patented in an enlargement of the building. *England v. Thompson*, 3 Cliff. 271.

If a license to a railroad corporation authorizes it to use the invention on all the roads then owned or thereafter owned or operated by it, the patentee can not call in question its right to operate any road. *Matthews v. Pennsylvania Railroad*, 8 Fed. Rep. 45; s. c. 38 Leg. Int. 253.

If a license stipulates that the royalty shall be reduced as soon as a license is granted to another at a lower rate, the licensee is entitled to the

reduction upon the granting of a license to manufacture a certain number of machines at a certain price. *Florence S. M. Co. v. G. & B. S. M. Co.*, 110 Mass. 70.

If a party takes a license to use certain patented articles for a certain term, and no longer, this is a waiver of any prior permission, although it was taken under a mistake of law. *Wooster v. Taylor*, 12 Blatch. 384; s. c. 8 O. G. 644; s. c. 1 Ban & Ard. 594.

The reasonable construction of a license to a corporation is that it extends no further than the authority conferred upon it by its charter at the time the license was given. *Emigh v. Chicago B. & Q. R. R. Co.*, 2 Fish. 387; s. c. 1 Biss. 400.

If a man owns two rights to manufacture goods by patents of different dates, and sells to A his right under one specifically, and to B the right to manufacture the goods generally, the fair construction of the latter grant will be held to be a conveyance of the right to manufacture under both patents, because in the first grant, when he intends to limit it to one, he so recites on the face of the grant, and in the second he does not. *Day v. Stellman*, 1 Fish. 487.

Where one having a right for a valuable consideration paid, agrees with another that the latter shall have the enjoyment of that right, and gives a power of attorney to enable him to possess and enforce that right, he is not by law permitted to revoke that power so as deprive the other party of the right. In such a case the power of attorney is a power coupled with an interest not merely in the execution of the power, not merely an interest in that which is produced by the power, but in the thing itself. *Day v. Candee*, 3 Fish. 9.

If a patentee covenants not to grant licenses to others, an agreement not to make any claim on another for any alleged infringement is essentially a license, and a breach of the covenant. *Jackson v. Allen*, 120 Mass. 64.

If the license contains no express covenant that the patent is valid, it does not amount to a warranty that the licensee shall enjoy the privilege against persons not claiming under the licensor. *Jackson v. Allen*, 120 Mass. 64.

If a license contains no warranty or covenant that the patentee is the inventor of the improvement, he is not estopped from proving the invalidity of the patent to affect the amount of damages for violating a stipulation to sue infringers. *Jackson v. Allen*, 120 Mass. 64.

Whether an order upon a licensee and a note payable out of the royalty due from him, are taken in full satisfaction of a debt, or only as a method of collecting it, is a question of fact. *Taylor v. Collins*, 102 Mass. 248.

A patentee in granting to another the right to make and sell the patented invention, may retain to himself the exclusive right to make and sell for export or use in other countries. *Dorsey R. H. Rake Co. v. Bradley Manuf. Co.*, 12 Blatch. 202; s. c. 1 Ban & Ard. 330.

A licensee, unless restrained by contract, is at liberty to manufacture and sell as many articles as he pleases either by the old method or by any

new machine which may be invented. *Burr v. Duryee*, 2 Fish. 275 ; s. c. 1 Wall. 531.

A license to the licensee and his assigns, to employ six persons in the manufacture of the thing patented, is an entirety, and incapable of division, or of being broken up into fragments in the possession of different persons. If it is assignable, the assignment must be of the entirety of the license to the assignee, and it can not be apportioned among different persons in severalty. Whoever is to be employed is to be employed by the licensee and his assigns. All must be employed by one and the same party. The language ought to be exceedingly clear that should lead a court to construe an instrument of this sort granting a single right of privilege to a particular person or his assigns, as also granting a right or license to split the same right into fragments among many persons in severalty, and thus make it apportionable as well as transmissible. *Brooks v. Byam*, 2 Scory 525 ; s. c. 2 Robb 161.

A license to use one machine will always be construed to be an authority to use a machine, unless in express terms it be limited to the identical machine referred to. *Wilson v. Stolley*, 4 McLean 275.

If the license merely authorizes the licensee to use two machines constructed according to the patent, he may use two at all times, whether constructed by himself or another. If he constructs machines and sells them to others to be used, he is an infringer of the patent and liable to an action. If he uses but two, he is within the letter and spirit of his contract. If he should construct a dozen, yet if he use but two, he does not break his contract. *Burr v. Duryee*, 2 Fish. 275 ; s. c. 1 Wall. 531.

If a license to use one machine covers the whole term, and is not limited to any particular machine, it confers the right to repair or change machines, but only one machine in number can be used at one time. *Woodworth v. Curtis*, 2 W. & M. 524 ; s. c. 2 Robb 603 ; *Wilson v. Stolley*, 4 McLean 275 ; *Steam Cutter Co. v. Sheldon*, 5 Fish. 477 ; s. c. 10 Blatch. 1.

A licensee of a right to use may repair his machine, but he can not construct one. *Bicknell v. Todd*, 5 McLean 236 ; *Woodworth v. Curtis*, 2 W. & M. 524 ; s. c. 2 Robb 603.

If a licensee promises to pay a royalty for every article manufactured according to the patent, he must do so although the articles so manufactured are not satisfactory. *Palmer's Appeal*, 96 Penn. 106.

If the contract provides that the proceeds of all suits for violations of the patent shall be divided equally between the patentee and the licensee, but that the licensee shall not institute a suit without the consent of the patentee, the licensee may terminate a suit, or make a settlement which will be binding without the institution of a suit. *Burdell v. Denig*, 2 Fish. 588 ; s. c. 92 U. S. 716.

A licensee holding under a license which only applies to machines that are both made and sold by him, or used and sold by him, and made without authority from the patentee, is not liable for a royalty upon machines purchased by him from another licensee, if they are purchased

before the expiration of the quarter at the end of which the license of the vendor by its terms would be forfeited. *Howe v. Wooldredge*, 94 Mass. 18.

If the license contains a provision that if the licensee ceases to use the machine for a certain time, such neglect shall be considered as an abandonment of the license on his part. A formal notice by the patentee that he considers the neglect an abandonment is not necessary. A refusal to receive the royalty would be sufficient. *Wilson v. Stolley*, 5 McLean 1.

If an assignee who has agreed to pay a royalty on all machines sold by him, makes an assignment for the benefit of creditors, the estate is liable for a royalty on all complete machines sold, but not on incomplete machines, although the trustee gave notice at the sale that the purchasers would be liable for the royalty. *Ex parte Morris*, 8 W. N. 178.

If the license contains a stipulation that the licensee if he wishes it may use the thing patented during an extended term upon the payment of a patent fee, the payment of the fee is a condition precedent to the right to use it. *England v. Thompson*, 3 Cliff. 271.

Although a license is made to a firm and a contract made at the same time to employ one partner for a sum equal to the royalty, yet the firm upon taking an assignment of the contract can not maintain a bill in equity to set off the claim for services against the claim for royalty. *Walker v. Brooks*, 125 Mass. 241.

If the patentee accepts a surrender of the license from a part of the licensees, the other licensees may maintain an action for a breach of a covenant contained therein, notwithstanding such surrender. *Therebath v. Celluloid Manuf. Co.*, 5 Ban & Ard. 577; s. c. 3 Fed. Rep. 143.

Although a patentee grants a license to a corporation that performs a public duty such as a common carrier, yet it can not be compelled to do an act in excess of the power conferred upon it by the license. *American R. I. Co. v. Connecticut I. Co.*, 49 Conn. 352.

### **Assignment of License.**

Whether a license is or is not assignable is to be determined not merely by the term "license," but by an inquiry into the fair meaning and intention of the parties, and it may be affected not merely by the words of license, but by the nature of the transaction, the consideration paid, and other circumstances showing that an assignable right was conferred. *Dorsey R. H. Rake Co. v. Bradley Manuf. Co.*, 12 Blatch. 202; s. c. 1 Ban & Ard. 330.

A mere license to a party, without having his assigns, or equivalent words to them, showing that it was meant to be assignable, is only the grant of a personal power to the licensee, and is not transferable by him to another. *Troy Factory v. Corning*, 14 How. 193; s. c. 1 Blatch. 467; *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; *Baldwin v. Sibley*, 1 Cliff. 150; *Bull v. Pratt*, 1 Conn. 342; *Lilienthal v. Washburn*, 8 Fed. Rep. 707; *Wortendyke v. White*, 2 Ban & Ard. 25; *Putnam v. Hollender*, 19 O. G. 1423; s. c. 19 Blatch. 48; s. c. 6 Fed. Rep. 882.

A license to a corporation expires upon the dissolution of the corporation. *Hapgood v. Hewitt*, 21 O. G. 1786; s. c. 11 Fed. Rep. 422.

A license which is granted in consideration of an agreement on the part of the licensee to use his skill in introducing the patented article into use is a vested right that passes to his personal representatives upon his death, although it does not use the words administrators, executors or assigns. *Oliver v. Morgan*, 10 Heisk. 322.

The words "legal representatives" in a license mean those who represent the grantee by a legal and valid transfer, whether voluntary or otherwise, and makes the license assignable. *Hamilton v. Kingsbury*, 15 Blatch. 64; s. c. 14 O. G. 448; s. c. 3 Ban & Ard. 346.

A license to a licensee and his assigns to use one machine is assignable. A machine, and the right to use it, is personal property rather than a mere patent right, and has all the incidents of personal property, and is thus subject to pass by sale. *Woodworth v. Curtis*, 2 W. & M. 524; s. c. 2 Robb 603; *Wilson v. Stolley*, 4 McLean 275; *Wilson v. Stolley*, 5 McLean 1.

If a license is personal, the licensee can not arrange with others to manufacture the patented article for him. *Houghton v. Rowley*, 9 Phila. 288; *Rubber Co. v. Goodyear*, 9 Wall. 788; s. c. 2 Fish. 499; 2 Cliff. 351.

The receipt of the royalty from the party to whom a licensee has transferred his license will be deemed a waiver of a requirement that such transfer shall not be made without the written consent of the licensor. *Blemer v. Gilpin*, 4 Fish. 50; *Wilde v. Smith*, 8 Daly 196.

A mere license is not apportionable, so as to permit the licensee to grant to others separate rights to use or work the patent by subdividing the rights which have been granted to him. *Consolidated Fruit Jar Co. v. Whitney*, 1 Ban & Ard. 356.

The assignment of a license will not release the licensee from his covenant to pay the royalty. *Wilde v. Smith*, 8 Daly 196.

If a licensee assigns his contract, the question whether the licensor and assignee agreed that the latter should become a party to the contract is a question of fact, although the licensor received money as royalty from such assignee. *Gaylord v. Case*, 1 C. L. B. 382.

A party who has taken an assignment of a license obtained by fraud is not entitled to be permitted to complete contracts entered into after notice of the fraud. *Consolidated Fruit Jar Co. v. Whitney*, 1 Ban & Ard. 356.

If two corporations, each having a license to use the thing patented, are consolidated, the new corporation will also have the right to use it. *Lightner v. Railroad Co.*, 1 Lowell 338.

A transfer of the rolling stock of a railroad, to which the thing patented is attached, to a creditor with the right to receive the revenues until his debt is paid, constitutes him merely an agent or trustee of the corporation, and his use of the thing patented is covered by a license to the corporation, and he is not an infringer. *Emigh v. Chamberlain*, 2 Fish. 192; s. c. 1 Biss. 367.

If the licensees form a corporation, and then transfer the patented articles to it, with the intent that it shall have the right to sell them without being liable to the patentee, this constitutes such a sale as to render them liable for the royalty. *Marsh v. Dodge*, 6 T. & C 568; s. c. 11 N. Y. Supr. 278; s. c. 66 N. Y. 533.

If a licensee takes a partner in the business of manufacturing the thing patented, a sale to his partner of his interest in the firm is such a sale as to render him liable for the royalty. *Wilder v. Sterns*, 48 N. Y. 656.

If a license is made to a firm, one partner may, upon the dissolution of the firm, purchase the interest of his copartner, and continue to use the thing patented. *Belding v. Turner*, 4 Fish. 446; s. c. 8 Blatch. 321.

The patentee is not required to give notice of any restriction to a voluntary purchaser of a licensee's right to enable him to hold such purchaser to the restricted use and enjoyment of the invention stipulated in the license. It is the duty of the purchaser to inform himself of the nature of the licensee's ownership and the extent of his right. *Chambers v. Smith*, 5 Fish. 12; s. c. 7 Phila. 575.

A purchaser of a licensee's interest at a judicial sale acquires only the licensee's title in the thing sold. *Chambers v. Smith*, 5 Fish. 12; s. c. 7 Phila. 575.

If a license which is granted in consideration of a royalty is assigned, the assignee takes it with the incumbrance attached to it, and a duty and obligation rest upon him to pay the royalty. *Goodyear v. Congress Rubber Co.*, 3 Blatch. 449.

In the absence of an express stipulation, a patentee has no lien upon a license to secure the royalty due under it when it is assigned to another. *Goodyear v. Congress Rubber Co.*, 3 Blatch. 449.

### **Purchase of Patented Article.**

A purchaser, in using a patented implement or machine, exercises no rights created by the act of Congress, nor does he derive title to it by virtue of the franchise or exclusive privilege granted to the patentee. The inventor might lawfully sell it to him, whether he had a patent or not, if no other patentee stood in his way. When the machine passes to the hands of the purchaser, it is no longer within the limits of the monopoly. It passes outside of it, and is no longer under the protection of the act of Congress. If his right to the implement or machine is infringed, he must seek redress in the courts of the State, according to the laws of the State, and not in the courts of the United States, nor under the law of Congress granting the patent. The implement or machine becomes his private individual property, not protected by the laws of the United States, but by the laws of the State in which it is situated. Contracts in relation to it are regulated by the laws of the State and are subject to State jurisdiction. *Bloomer v. McQuewen*, 14 How. 539; *Chaffee v. Boston Belting Co.*, 22 How. 217; *Mitchell v. Hawley*, 4 Fish. 388; s. c. 6 Fish. 331; 16 Wall. 544; 3 O. G. 241; 10 O. G. 306; s. c. 1 Holmes 42; *Union P. B. Co. v. Nixon*, 105 U. S. 766; s. c. 21 O. G. 1275.

The patentee may make any covenant he pleases with his licensees, but he can not compel the public to notice or regard such agreements, or the right conferred or reserved by them. Such covenants do not run with the product like a covenant on land. If his licensees do not perform their agreements, his remedy is by an action against them on the covenants, and not by a recourse to a chancellor to restrain third persons who have purchased from his licensees. *Washing Machine Co. v. Earle*, 2 Fish. 203; s. c. 3 Wall. Jr. 320.

A patent for a process does not give the patentee the power to control the use which persons who purchase may make of the product. A covenant restricting such use to certain articles binds only the parties to it. If a stranger purchase the product from one licensed to use the process, he need look no further, and may use it for his own purposes without inquiring for or regarding any private agreement of licensees. *Washing Machine Co. v. Earle*, 2 Fish. 203; s. c. 3 Wall. Jr. 320.

If a party makes a contract for the thing patented, and the patentee grants a license to the contractor with a reservation of a right to obtain a royalty from such party, which reservation is unknown to him, the reservation is inconsistent with the license. The license to the contractor relieves the party from responsibility. The relieving of the parties primarily liable, by a universal rule of law as well as of justice, relieves those who are only secondarily responsible. *Bigelow v. Louisville*, 3 Fish. 602.

The sale of a machine does not necessarily give an implied right to use it, where the sale is made by a person who has no exclusive right, but a license merely of use. The extent of the transfer must therefore depend on the facts and circumstances of the case. *Wilson v. Stolley*, 4 McLean 275; *Mitchell v. Hawley*, 16 Wall. 544; s. c. 4 Fish. 388; 6 Fish. 331; 3 O. G. 241; 10 O. G. 306; s. c. 1 Holmes 42.

The purchase of a patented article lawfully manufactured and sold, without condition or restriction, by a territorial grantee within the territory, gives the purchaser the right to use or sell the article in another territory for which another person has taken a grant under the patent. If this were not so, the purchaser of a manufactured patented article of wearing apparel might be liable for the use of the patented article in every town and city through which he might travel. By the sale the article ceases to be within the monopoly. *Adams v. Burke*, 4 Fish. 392; s. c. 1 Holmes 40; 17 Wall. 453; 1 O. G. 282; *McKay v. Wooster*, 6 Fish. 375; s. c. 2 Saw. 373; 3 O. G. 44; 6 A. L. T. 169; *May v. Chaffee*, 5 Fish. 160; s. c. 2 Dillon 385.

The patentee himself can not, by a subsequent assignment of his patent, limit the right of the purchaser already vested. *McKay v. Wooster*, 6 Fish. 375; s. c. 2 Saw. 373; 3 O. G. 44; 6 A. L. T. 169.

A sale of a patented machine under an execution as the property of the owner of the patent confers on the vendee the same right to use it as the defendant in the execution had. *Wilder v. Kent*, 23 O. G. 831; s. c. 15 Fed. Rep. 217.

If a person legally acquires title to that which is the subject of letters patent, he may continue to use it until it is worn out, or he may repair it or improve upon it as he pleases, in the same manner as if dealing with property of any other kind. *Chaffee v. Boston Belting Co.*, 22 How. 217.

If the thing patented is an ordinary article of commerce, the patentee who sells it for the purpose of allowing it to be used in the ordinary pursuits of life, thereby waives the right to affix conditions or restrictions to its use or sale, and any such restriction is void. *Cotton Tie Co. v. Simons*, 106 U. S. 89; s. c. 22 O. G. 1976; s. c. 13 O. G. 967; s. c. 3 Ban & Ard. 320.

If a patentee, upon selling a buckle and band as a baling tie, puts upon them the restriction that they shall be used only once, they may be used to confine a bale in transportation from the planter to the consumer, but cannot be used afterwards. *Am. Cotton Tie Co. v. Ballard*, 17 O. G. 389; s. c. 17 Blatch. 160.

Although a restriction is put upon a cotton tie that it shall be used only once, yet it may be transferred from one bale to another while both are on their way from the planter to the consumer. *Am. Cotton Tie Co. v. Ballard*, 17 O. G. 389; s. c. 17 Blatch. 160; s. c. 4 Ban & Ard. 520.

Like other individual property, the patented machine or implement in the hands of a purchaser is subject to State taxation. *Bloomer v. McQuewen*, 14 How. 539.

If a municipal charter requires that work shall be let by contract to the lowest bidder, the city can not contract for the use of a patented article which is owned by one firm. *Dean v. Charlton*, 23 Wis. 590.

If a statute authorizes a public officer to use a patented article, a provision that the contract must be awarded to the lowest bidder must be so construed as not to defeat the authority. *Greaton v. Griffin*, 4 Abb. Pr. N. S. 310.

### **When Licensee Estopped.**

A licensee who manufactures articles similar to the thing patented is estopped to deny that they are made under the license, so long as he retains it. *Marsh v. Dodge*, 6 T. & C. 568; s. c. 11 N. Y. Supr. 278; s. c. 66 N. Y. 533.

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 a 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.

A party who permits a judgment to be entered by default in an action at law, and for a valuable consideration agrees to cease to manufacture the patented article, is estopped from impeaching the validity of the patent. *Brooks v. Moorhouse*, 13 O. G. 499; s. c. 3 Ban & Ard. 229.



If a party merely accepts a license to sell the goods that he has on hand as a compromise to save trouble rather than as a deliberate acknowledgment of the validity of the patent, he will not be estopped from denying the validity thereof. *White v. H. & S. Manuf. Co.*, 5 Ban & Ard. 571; s. c. 3 Fed. Rep. 161.

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 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 defence. *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 a patent, as a defence to an action to recover the royalty. *Bartlett v. Holbrook*, 67 Mass. 114; *White v. Lee*, 23 O. G. 1621; 14 Fed. Rep. 789; *Jones v. Burnham*, 67 Me. 93; *Evory v. Candee*, 17 Blatch. 200; s. c. 4 Ban & Ard. 545; *Gaylord v. Case*, 1 C. L. B. 382; *Magic Ruffle Co. v. Elm City Co.*, 13 Blatch. 151; s. c. 8 O. G. 773; s. c. 2 Ban & Ard. 152; *Birdsall v. Perego*, 5 Blatch. 251; *Marsh v. Dodge*, 6 T. & C. 568; s. c. 11 N. Y. Supr. 278; s. c. 66 N. Y. 533; *Hall Manuf. Co. v. Am. Railway Supply Co.*, 48 Mich. 331.

If a patent is void there is no consideration for an agreement in a license to pay a royalty, and no action can be maintained thereon. *Harlow v. Putnam*, 124 Mass. 553.

If a patent is annulled or destroyed by due and effective legal proceedings, and priority of invention and a patent is awarded to another, a licensee is absolved from liability for royalty without any notice to the licensor. *Marston v. Swett*, 82 N. Y. 526.

If a license admits the validity of the patent, the licensee can not set up a prior parol agreement that he was to be allowed to contest its validity. *Evory v. Candee*, 17 Blatch. 200; s. c. 4 Ban & Ard. 545.

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; *Wooster v. Singer Manuf. Co.*, 23 O. G. 2513; *contra*, *Brooks v. Stolley*, 3 McLean 523; s. c. 2 Robb 281.

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. Hotchkiss*, 16 Conn. 409.

In an action of covenant to recover the royalty for machines actually sold thereunder, the covenantee can not set up the defence of the invalidity of the patent. Such a defence 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; s. c. 66 N. Y. 533; *Bartlett v. Holbrook*, 67 Mass. 114.

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.

### **When Licensor Estopped.**

If a patentee grants a license, he is estopped as against the licensee from denying the novelty of the invention. *Stanley R. & L. Co. v. Bailey*, 14 Blatch. 510; s. c. 3 Ban & Ard. 297.

### **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 fulfil it will not of itself operate to annul and cancel the agreement. *Gibson v. Barnard*, 1 Blatch. 388.

If a license does not contain a provision for revocation or forfeiture, it can not be annulled, although the licensee has failed to comply with the terms thereof. *Cook v. Bidwell*, 20 O. G. 1083.

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.

Although a license is to be void unless the royalty is paid within a certain time, yet it can not be declared void without a demand where it is the duty of the patentee to make a demand. *Dare v. Boylston*, 19 O. G. 725; s. c. 18 Blatch. 548; s. c. 6 Fed. Rep. 493.

If the license provides that in case of default it may be terminated upon written notice to the licensee, it can not be terminated in any other way. *White v. Lee*, 5 Ban & Ard. 572; s. c. 3 Fed. Rep. 222.

If a license to use a machine provides for a termination thereof on notice, an assignee of the license may give the notice. *Wilde v. Smith*, 8 Daly 196.

If a license contains terms of forfeiture, a bill in equity may be maintained to cancel the license if the licensee violates the condition. *Adams v. Meyrose*, 10 Fed. Rep. 671.

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 ; s. c. 66 N. Y. 459 ; *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.*, 7 Biss. 223 ; s. c. 2 Ban & Ard. 327 ; *Whiting v. Graves*, 13 O. G. 455 ; s. c. 3 Ban & Ard. 222.

If two tenants in common of a patent agree that one shall have the exclusive right to manufacture, and in consideration thereof shall pay a royalty to the other, there is a sufficient consideration for the agreement,

although the patent is void. *Marston v. Swett*, 66 N. Y. 206; s. c. 6 T. & C. 534; s. c. 11 N. Y. Supr. 153.

If the part owners of a patent agree to divide the license fees between them, then one may compel the other to render an account of the fees. *Gates v. Fraser*, 9 Bradw. 624.

If an inventor agreed to take a patent for the benefit of himself and another as tenants in common, the latter is entitled to an account of the profits arising from sales of an interest in the patent. *Blakeney v. Goode*, 30 Ohio St. 350.

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 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.*, 7 Biss. 223; s. c. 2 Ban & Ard. 327; *De Witt v. Elmira Nobles Manuf. Co.*, 12 N. Y. Supr. 301; s. c. 66 N. Y. 459; *Clum v. Brewer*, 2 Curt. 506.

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 defence to an action to recover the fee. *Marston v. Swett*, 6 T. & C. 534; s. c. 11 N. Y. Supr. 153; s. c. 66 N. Y. 206.

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.

### **Defence 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. Johnson*, 2 Cranch. C. C. 287; *Nye v. Raymond*, 16 Ill. 153; *Joliffe v. Collins*, 21 Mo. 338; *Springfield v. Drake*, 58 N. H. 19; *vide Elmer v. Pennel*, 40 Me. 430; *Green v. Stuart*, 7 Baxter 418.

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.

If the thing patented is capable of a beneficial use, then an interest in a patent is a valuable consideration for a note, although the thing can not be used profitably. *Nash v. Lull*, 102 Mass. 60; *Neidefer v. Chastain*, 71 Ind. 363; *How v. Richards*, 102 Mass. 64.

When a contract purports to sell a patented invention the vendor can not recover if no patent has ever been obtained. *Shepherd v. Jenkins*, 73 Mo. 510.

A mere claim by others that the thing patented is an infringement of a prior patent is no defence 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*, 15 Ill. 153.

A purchaser in defence 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.

The payee of a note given for a patented machine may enforce it, although the assignment to the payee is merely verbal. *Burke v. Partidge*, 58 N. H. 349.

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 defence 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 cannot 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 might 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 defence 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 cannot 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 defence 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 defence. *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 defence 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 wrongdoers. *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 defence 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 132.

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; s. c. 66 N. Y. 206.

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. Hotchkiss*, 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. Hotchkiss*, 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; s. c. 4 Cliff. 383; s. c. 2 Ban & Ard. 417.

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. *Buss 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.

If a State law does not make a note void unless the words "given for a patent right" are put on the face thereof, a *bona fide* holder may enforce the note. *Haskell v. Jones*, 86 Penn. 173.

### **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 642.

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 Dev. & Bat. Eq. 315; *Cansler v. Eaton*, 2 Jones Eq. 499; *McKenzie v. Bailie*, 4 C. L. B. 209.

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 representation of the value of a patent is no ground for rescinding a contract, although it is false. *Neidefer v. Chastain*, 71 Ind. 363.

Representations, which consist of the opinion of the vendor as to the value of the interest sold, or relate to the price that was given for it, or that has been offered for it, or at which it has been sold, or to the future profits that can be made out of it, are not sufficient to sustain an action of deceit against the vendor. *Bishop v. Small*, 63 Me. 12.

If the vendee had equal means of knowing the value of the patent, and relied on his own judgment in making the purchase, he can not maintain an action for fraud, although the representation was false. *Hess v. Young*, 59 Ind. 379.

The mere payment of an excess beyond the value of the patent is no ground for rescinding the sale. *Percival v. Harger*, 40 Iowa 286; *Cowan v. Mitchell*, 3 Cold. 278.

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.

A representation as to the amount of money that has been realized from the sale of rights in the patent will sustain an action for deceit if they are false. *Somers v. Richards*, 46 Vt. 170; *Newell v. Gatling*, 7 Ind. 147; *Gatling v. Newell*, 9 Ind. 572; *Gatling v. Newell*, 12 Ind. 118.

A representation of the amount derived annually from a royalty on the patent, if false, is a ground for rescinding the contract. *Crossland v. Hall*, 33 N. J. Eq. 111.

A false representation that a patented article is salable is ground for rescinding a contract. *Hull v. Fields*, 76 Va. 594.

If a party was induced to unite with another in the purchase of an interest in a patent upon the false representation that the other was paying the same sum as himself, the sale is fraudulent. *Hess v. Young*, 59 Ind. 379.

A representation that the machine can be bought for a certain price at a certain place is not a ground for rescinding the contract unless it is material. *Neidefer v. Chastain*, 71 Ind. 363.

A misrepresentation as to the cost of an article used in the manufacture of the thing patented is ground for rescinding a sale. *Peffley v. Noland*, 80 Ind. 164.

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.

If a party has a patent, a representation that it is valid is a representation of matter of law, and no ground for rescission. *Rawson v. Harger*, 48 Iowa 269.

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.

If a vendor falsely represents that he has the sole and exclusive right to sell the thing patented, and that it is not covered by any other patent, this is such a misrepresentation as justifies a rescission of the sale, although the vendee could have discovered the fraud by searching the records at the patent office. *McKee v. Eaton*, 26 Kans. 226; *David v. Park*, 103 Mass. 501.

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. 77.

A false representation that the invention is never used, except under the patent, constitutes a good defence to a note given for an interest in the patent, if it is an infringement of a prior patent. *Morrow v. Brown*, 31 Ind. 378.

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 representation that a machine, made according to the patent and model, can be operated successfully, is no defence to an action on a note given for an interest in the patent, although it is false. *Hunter v. McLaughlin*, 43 Ind. 38.

A representation that the improvement is useful is no ground for rescinding a sale of the patent, if the vendee does not rely on that in making the purchase, although it is false. *Percival v. Harger*, 40 Iowa 286.

A representation that the thing patented will be useful to the vendee in his business is no ground for rescinding a contract, although it is false, for it is a representation as to a mere matter of opinion. *Louden v. Birt*, 4 Ind. 568; *Fowler v. Swift*, 3 Ind. 188.

A representation that the invention was novel and useful is a good ground of defence to an action on a note given for an interest in the patent, if it is false. *Johnson v. McCabe*, 37 Ind. 535.

A misrepresentation in regard to the utility of the thing patented may be available in mitigation of damages, but will not constitute a defence 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 defence that he was induced to purchase by means of false and fraudulent representation on the part of the vendor, as to the qualities, capabilities and usefulness of the invention, without returning or offering to resign the patent. *Groff v. Hansel*, 33 Md. 161.

A representation that the machine will work rapidly and effectually is no ground for rescinding the contract, although it is false. *Neidefer v. Chastain*, 71 Ind. 363.

If the purchaser made the contract for an interest in a patent, upon the faith of a machine shown to him by the patentee, and certain improvements were attached thereto at the time, he may avoid the contract, if the inventor of the improvements obtains a patent therefor. *Cowan v. Mitchell*, 11 Heisk. 87.

A representation as to the superiority of the thing patented and the great demand for the same, is no ground for rescinding the contract, although it is false. *Gatling v. Newell*, 12 Ind. 118.

A representation that the quality of the thing made according to the patent is equal to that made in the usual way is ground for rescinding the contract. *Nelson v. Wood*, 62 Ala. 175.

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 defence of fraud to an action on the note. *Bierce v. Stocking*, 77 Mass. 174.

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; *Niel v. Cummings*, 75 Ill. 170.

In an action for deceit in selling the exclusive right to make and sell the thing invented in a certain territory, the vendor may by parol prove that he told the vendee that he had not obtained a patent yet, although the agreement recites that he had obtained it. *Swazey v. Herr*, 11 Penn. 278.

A principal is affected by the false representations of his agent. *Neil v. Cummings*, 75 Ill. 170.

Although there is a misrepresentation as to the novelty of a patent, yet a purchaser can not rescind the contract unless he exercises the right within a reasonable time after he discovers the fraud. *Rawson v. Harger*, 48 Iowa 269; *Kingsley v. Wallis*, 14 Me. 57.

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.

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.

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 mere statement on a note that it was given for a patent right does not constitute a notice of any fraud to an indorsee. *Hereth v. Meyer*, 33 Ind. 511; *Goddard v. Lyman*, 31 Mass. 268; *Hereth v. Merchants' Nat'l Bank*, 34 Ind. 380.

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.

If the vendee brings an action for the fraud, he need not tender a return of the title before bringing the suit. *Hess v. Young*, 59 Ind. 379.

A plea setting up fraud as a defence to a note should offer to return the patent or aver that it is without value. *Burns v. Barnes*, 58 Ind. 436.

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 the patentee, by the use of undue influence, induces another to purchase the patent, the transaction may be rescinded in equity. *Colburn v. Van Velger*, 11 Fed. Rep. 795.

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. *Darst 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.

If a party gives his note to the patentee for the purpose of enabling the latter to sell a part of the patent to another under the belief that he has made a similar purchase, he can not maintain an action to compel a cancellation of the note. *Overshiner v. Wischart*, 59 Ind. 135.

An instrument which confines the party to a particular use of the invention is not an assignment, but a license. *Edwin L. Paine*, 13 O. G. 407.

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. 280, § 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 relieves 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 ; s. c. 2 Robb 105.

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 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 ; s. c. 2 Robb 105.

The 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 ; s. c. 2 Robb 105.

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 ; *Black v. Hubbard*, 12 O. G. 842 ; s. c. 3 Ban & Ard. 39.

The purchaser here spoken of is a purchaser not from a mere wrongdoer, but from the first and true inventor before he obtained his patent. *Pierson v. Eagle Screw Co.*, 3 Story 402 ; s. c. 2 Robb 268 ; *Hovey v. Stevens*, 1 W. & M. 290 ; s. c. 2 Robb 479, *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 ; s. c. 2 Robb 479.

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 ; s. c. 1 Robb 20, 57.

If a member of a firm prior to his application for a patent makes a machine at the expense of the firm and permits its use by the firm, the firm may continue to use it after the grant of a patent. *Wade v. Metcalf*, 16 Fed. Rep. 130.

If a firm acquires the right to use a machine made by a partner, the right does not cease on the dissolution of the firm. *Wade v. Metcalf*, 16 Fed. Rep. 130.

The right of a party who has bought, or constructed a machine before the application for a patent is confined to the specific machines so bought or constructed. *Brickill v. New York*, 18 Blatch. 273; s. c. 18 O. G. 463; s. c. 5 Ban & Ard. 544; s. c. 7 Fed. Rep. 479.

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, § 38, 16 Stat. 203.

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

This section has no application to a case where the infringer makes and uses the device. *Herring v. Gage*, 15 Blatch. 124; s. c. 3 Ban & Ard. 396.

If an article can be stamped at a trifling cost, it must be stamped. *Putnam v. Sudhoff*, 1 Ban & Ard. 198.

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; s. c. 1 A. L. T. 94.

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; s. c. 1 A. L. T. 94; *contra*, *McComb v. Brodie*, 5 Fish. 384; s. c. 1 Woods 153; 2 O. G. 117.

The notice of the infringement required by this section may be either verbal or written. *New York Pharmaceutical Association v. Tilden*, 23 O. G. 272; s. c. 14 Fed. Rep. 721.



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; s. c. 1 A. L. T. 94.

After the expiration of the patent the patentee can not claim the exclusive right to use the word "patent" as a trade-mark on articles manufactured by him. *Fairbanks v. Jacobus*, 14 Blatch. 337; s. c. 3 Ban & Ard. 108.

A patentee may enjoin another from issuing a circular stating that he manufactures articles under the patent, and the party issuing such a circular can not in such a suit question the validity of the patent. *Washburn & M. Manuf. Co. v. Haish*, 4 Ban & Ard. 571.

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 offence, to a penalty of not less than one hundred dollars, with costs; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offence may have been committed.

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

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

### Paragraph Two.

Although a person affixes the word "patent" to an article with intent to imitate the mark or device of a patentee, yet he is not liable under this

section unless the article is covered by the patent. *French v. Foley*, 11 Fed. Rep. 804.

### Paragraph Three.

The penalty is incurred by marking an unpatented article with the word "patent," whether patentable or not. *Oliphant v. Salem Flouring Mills*, 5 Saw. 128 ; s. c. 3 Ban & Ard. 256 ; *contra*, *U. S. v. Morris*, 3 Fish. 72 ; s. c. 2 Bond 23.

If the article is patented a person is not liable under this clause for affixing the word "patent," although he also puts on the article the date of another patent. *French v. Foley*, 11 Fed. Rep. 804.

A patentee who affixes the word "patented," with the day and year when the patent was granted, on an article, is not liable to the penalty, although the patent has expired. *Wilson v. Singer Manuf. Co.*, 16 O. G. 1091 ; s. c. 9 Biss. 173 ; s. c. 4 Ban & Ard. 637 ; s. c. 12 Fed. Rep. 298.

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 offence is committed by affixing the word for that purpose. If it is affixed to an article for that purpose, then the offence 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 offence 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 offence. 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 offence, 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.

Whether the alleged false marking was done with intent to deceive the public is in ordinary cases a question of fact. *Oliphant v. Salem Flouring Mills*, 5 Saw. 128 ; s. c. 3 Ban & Ard. 256.

If a person marks an unpatented article with the word "patent," the presumption is, until the contrary appears, that the mark was placed on the article with the intention to deceive. *Oliphant v. Salem Flouring Mills Co.*, 5 Saw. 128 ; s. c. 3 Ban & Ard. 256.

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. *Nicholls 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.

The 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 offence. *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, specifications, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail, to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his description, specifications, drawings, and model within three months from the time of placing the notice in the post office in Washington, with the usual time required for transmitting it to the caveator added thereto; which time shall be indorsed on the notice. An alien shall have the privilege herein granted, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen.

*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 meantime, 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.

If an applicant on the rejection of his application, files an amendment limiting or restricting the claim, he is bound by this restriction. *New York B. & P. Co. v. Sibley*, 23 O. G. 1444; s. c. 15 Fed. Rep. 386.

Although an inventor takes out a caveat in his own name alone, yet if the invention is in fact joint, it may be carried back to the filing of the caveat. *Hoc v. Kahler*, 12 Fed. Rep. 111.

A caveat may be received and filed on the oath and signature of one only of joint inventors. *G. A. Gray*, 12 O. G. 396.

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.

If an amended application embodies any material addition to or variance from the original, anything new that was not comprised in that, such addition or variation can not be sustained on the original application. *Railroad Co. v. Sayles*, 97 U. S. 554; s. c. 15 O. G. 243; s. c. 3 Biss. 52; s. c. 4 Fish. 584.

### Practice.

An examiner should not reject an application without expressing an opinion. *Coleman*, 18 O. G. 1051.

If an examiner rejects a claim for want of novelty, he should give specific references. *Hill*, 16 O. G. 765; *Fairbanks & Robinson*, 3 O. G. 65; *Albert D. Davis*, 6 O. G. 297.

If the examiner objects to a claim as indefinite, he must point out or indicate in what respects it is indefinite. *Templeton*, 17 O. G. 910.

Upon a decision and notice that all formal objections have been removed, followed by a consideration of the case upon its merits, neither the same formal objections nor any other ought to be insisted on by the examiner without the authority of the commissioner. *Starr*, 15 O. G. 1053.

If an application is rejected on an unexpired patent, it is not sufficient for the applicant to make oath that he made the invention before the filing of the patented application, but the affidavit must set forth the facts that show a prior invention. *Gasser*, 17 O. G. 507.

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.

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.

The notice should state the defects in the application distinctly and definitely. A mere reference to pencil marks on the specifications is not sufficient. *Wilkins*, 24 O. G. 1271.

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.

If an application is rejected on a reference to prior publications, an affidavit of a prior discovery must state the facts. *Saunders*, 23 O. G. 1224; *Graydon*, 25 O. G. 192.

### **Amendment.**

An applicant may be allowed to amend his application so as to introduce new matter, if he makes oath that it was a part of his original invention. *McDougall*, 21 O. G. 1783.

If the application admitted of illustration by drawings, it can not be amended by the introduction of new matter, unless the applicant makes oath that it was a part of his original invention. *Snyder*, 22 O. G. 1975; *Jesse H. Temple*, 12 O. G. 795; *Coleman*, 18 O. G. 1051; *Lamb*, 16 O. G. 405; *Huck*, 16 O. G. 1052; *Wm. C. Dodge*, 3 O. G. 179.

When the invention does not admit of illustration by a drawing, the claim may be amended upon proof that the amendment was a part of the original invention. *Shalters*, 15 O. G. 970.

A party who desires to amend his application should state the reason why he desires to amend. *Winchester*, 17 O. G. 453.

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.

An amendment may be made of a model or drawing if it does not depart from the invention described in the application. *Dunn*, 16 O. G. 1004.

Although the original application was for a continuous process, yet the applicant may amend it so as to make it consist of successive stages. *Wohltmann*, 16 O. G. 723.

If the original application does not describe any mode of producing the article, it may be amended by adding such description. *James Lee*, 15 O. G. 512.

If there is a generic claim, the several species can not be first described in an amended application. *Morrison*, 16 O. G. 359.

If priority of invention is awarded to another on all the claims contained in an application, the applicant can not afterwards amend by inserting other claims. *Cobb*, 16 O. G. 175.

If a party has two applications, and a claim is equally appropriate to both, he can not insert it by an amendment in the first application if it is shown in a patent already issued on the second application. *Emerson*, 16 O. G. 1232.

An amendment may be made, although more than two years have elapsed after the application was filed. *Wm. C. Dodge*, 3 O. G. 179.

If an applicant who has stricken out a claim desires to restore it, he must rewrite it. *Mumler*, 24 O. G. 1090.

An amendment which is substantially the same as the application that has already been rejected, will not be allowed. *Hitt*, 25 O. G. 192.

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 a disclaimer does not affect any material part of the claim it may be signed by the attorney. *Murdoch*, 16 O. G. 957.

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*—February 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.

An applicant can not be put into interference with an applicant who subsequently files an application. *Ex parte Platts & Walden*, 15 O. G. 827.

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; s. c. 1 Ban & Ard. 494; *Wire B. S. M. Co. v. Stevenson*, 11 Fed. Rep. 155; s. c. 39 Leg. Int. 82.

So long as the final decision on an interference proceeding remains unreversed and unaffected by any proceedings authorized to be instituted in equity, it is obligatory and must be deemed *res adjudicata* between the parties. *Peck v. Collins*, 70 N. Y. 376.

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; s. c. 1 Ban & Ard. 494.

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 cannot 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. 132.

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.

### **Declaration of Interference.**

An application is pending until the patent has been signed, sealed and delivered, and if another application is filed covering the same claims prior to the delivery of the patent, an interference should be declared, although a decision has been given in favor of the prior application on one interference. *Lawrence*, 16 O. G. 955; *contra*, *Wright v. Reese*, 11 O. G. 329.

In declaring an interference the examiner should define the subject matter and specify the interfering claims. It is not sufficient to mention the matter constituting the issue without specifying the claims nor to specify the claims without defining the matter. *Stephens v. Bailey*, 13 O. G. 45.

Where two applications, or an application and a patent interfere, all the interferences between them must be set forth in the case in a single count, if they present only a single issue, or in several counts if they present several issues. *Bell v. Gray*, 15 O. G. 776.

If an interference is declared, then all the applications and patents and those only which interfere with each and all of the other applications and patents embraced in each count or subdivision of an interference are to be included in that interference. *Bell v. Gray*, 15 O. G. 776.

If a motion to amend a declaration of an interference has been once refused, it will not be reconsidered unless upon a new state of facts or upon grounds that would support a motion for a new trial. *Lee v. Walsh*, 15 O. G. 563.

If an amendment to an issue in an interference case is ambiguous, it can not be allowed. *Thomas v. Gutman*, 16 O. G. 857.

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.

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.

### **When Interference Declared.**

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.

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 a patentee may claim a particular feature on a reissue, he should be made a party to an interference. *Lee v. Walsh*, 15 O. G. 563.

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 v. Yakel*, 10 O. G. 944.

An interference may be declared between one or more applications and two or more patents, and priority awarded to one of the patents, or to an application according to the facts. *Nicholson v. Bennett*, 16 O. G. 631.

If the claims in two applications are for substantially the same invention, an interference should be declared, although they are in different language. *Drawbaugh v. Blake*, 23 O. G. 1221.

If, pending an application, a patent is issued to a later applicant, the first applicant is entitled to have an interference declared with the patent issued to the later one. *Marston*, 21 O. G. 633.

An application may be put in interference with a prior patent, although the applicant has an English patent prior to the American patent. *Bland*, 16 O. G. 47.

An interference can not be declared between an American inventor and a foreign inventor when there is no evidence of any fact that would invalidate a patent to an American inventor. *Thomas v. Reese*, 16 O. G. 1234; *Thomas v. Reese*, 17 O. G. 195; *Nagel*, 17 O. G. 198.

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.

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.

Where two combinations producing the same effect are identical, except as to a single element which is present in one but wanting in the other, a case of interference arises, because the latter combination if first invented will anticipate and defeat the former. *Banks v. Snediker*, 17 O. G. 508.

An interference may be declared between a generic claim and a claim for a species of the same genus. *William Gardner*, 17 O. G. 626.

If neither party is entitled to a generic claim, an interference can not be declared between them when they claim different specific claims. *William Gardner*, 17 O. G. 626.

If the different claims do not have the same meaning, there is no interference, although they use the same words in describing devices that are substantially different. *Greenough v. Drummond*, 16 O. G. 586; *Nicholson v. Bennett*, 16 O. G. 631.

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.

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. *Bacheller v. Porter*, 1 Dec. Com. 64; *Berliner v. Gower*, 15 O. G. 1055.

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*, 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.

An interference can not be declared merely because the applicant may possibly during the pendency of the case make a claim that will interfere. *Nicholson v. Bennett*, 16 O. G. 631.

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.

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.

If, pending an interference between A, B and C, D files an application not claiming or showing the invention in interference, but claiming other matter claimed by A and shown by B and C, he is entitled to an interference with A, and also upon an amendment of their applications with B and C, without waiting for the final adjudications of the pending interference. *Smith*, 17 O. G. 447.

If a party who is successful on an interference fails to pay the final fee within the time limited by law, an interference may be declared between the unsuccessful party and a subsequent applicant, and, if the latter succeeds, he may obtain a patent. *Anon.* 12 O. G. 979.

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*, 5 O. G. 339.

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.

### **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 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. Jacobson*, 9 O. G. 964; *Hunt v. King*, 17 O. G. 200.

It is not necessary that the preliminary statement shall fix the exact day of the completion of the invention. *Connor v. Williams*, 15 O. G. 386.

It is not necessary that the preliminary statement shall fix with absolute precision both the exterior limits of the period of time to be covered by the proof, but it is necessary that it shall fix the first of those limits. Any interval between the day declared and the day proven must extend forwards and not backwards. *Connor v. Williams*, 15 O. G. 386.

A preliminary statement that the invention was completed several days before a designated day is tantamount to a declaration that it was completed on or about that day. *Connor v. Williams*, 15 O. G. 386.

An applicant in his preliminary statement may be required to set forth the nature and extent of the use of his invention from the time of its perfection until he filed his application. *J. E. Dermody*, 14 O. G. 202.

It is not necessary that the preliminary statement shall set forth the extent of use after completion, if it clearly shows that the invention was completed within the period of two years prior to the filing of the application. *John W. Wheat*, 14 O. G. 787.

An amendment of a preliminary statement will not be allowed after the adverse party has taken his testimony. *Hopkins v. Le Roy*, 18 O. G. 859.

Where it is made reasonably certain that a mistake has been made in the preliminary statement, the party may be allowed to amend it at any time before the testimony is closed. *Moore v. Brown*, 22 O. G. 1882.

A preliminary statement cannot 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. Zeller*, 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 v. Cabel*, 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.

Neubocker & Schafhaus, 4 O. G. 319 ; Little v. Lillie, 10 O. G. 543 ; Anson v. Woodbury, 11 O. G. 243.

The examiners may force the parties to bring an interference case to a conclusion. Taylor v. Sheffler, 24 O. G. 1175.

### 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.

A wife is a competent witness for her husband in an interference case. Koen v. Quint, 23 O. G. 1330.

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. Earle 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, 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 ; Powers v. Pease, 13 O. G. 175 ; Wyman v. Knowles, 13 O. G. 320 ; Leighton, 14 O. G. 199 ; Hall v. Johnson, 23 O. G. 2411.

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 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. 1009.

An applicant, in order to overcome a patent, need only establish priority of invention by such proof as would in a possessory action, either real or personal, be sufficient to support a recovery against a defendant in possession. Fulgham v. Westcott, 16 O. G. 1005.

If there is no preponderance of evidence in favor of either party, the decision must be in favor of the patent. Fulgham v. Westcott, 16 O. G. 1005.

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.

There is a presumption in favor of the 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.

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 v. Benson*, 2 Dec. Com. 65.

Although an applicant filed the first application, yet if he abandoned that, and then filed a second application after an application had been filed by another, the burden of proof is on him to show priority of invention. *Henderson v. Reese*, 25 O. G. 191.

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. *Hazelip v. Richardson*, 10 O. G. 746.

An application can be deemed to be filed only from the time of the payment of the fee, and if that occurred after the filing of another application, then the applicant takes the burden of showing priority of invention, although he first sent the papers to the patent office. *Lapham v. Bettendorf*, 16 O. G. 137.

If the parties had applications pending at the same time, and an interference is declared on an application for a reissue, the same rule will be applied in determining the question of priority of invention as if an interference had been declared on the applications. *Davis v. Scharffe*, 14 O. G. 345.

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

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*, 10 O. G. 825.

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.

The wife of an applicant is not a competent witness in an interference case. *Workman v. McNaught*, 16 O. G. 216.

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.

*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.

The filing of an application for a patent is the strongest proof possible of the fact of invention at the date of the application. *Huutley v. Smith*, 18 O. G. 795.

The testimony of the applicant that he conceived the invention at a certain time may be sufficient to establish that fact if he testifies that he then produced an operative instrument. *Dickson v. Kinsman*, 18 O. G. 1224; *Dickson v. Kinsman*, 18 O. G. 1225.

A mere naked assertion of the time of invention is of small importance compared with a statement of facts constituting the alleged invention, for it involves a mixed question of law and fact. *Slade v. Blair*, 17 O. G. 261.

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

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

If the preliminary statement alleges that the invention was made on or about a certain day, the party can not adduce proof of matter prior to the specific date alleged. *Bering v. Haworth*, 14 O. G. 117.

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.

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*, 2 O. G. 293.

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.

A concession of priority does not constitute evidence of the date of an invention as against any party except the one who makes it. *Burgess v. Wetmore*, 16 O. G. 765.

If the evidence shows that a party is the first and original inventor, a concession of priority which can not operate as an assignment will not give the adverse party a right to a patent. *Packard v. Sanford*, 16 O. G. 1182.

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.

If an interference arises between an American and a foreign inventor, the latter may carry the date of his invention back to the time of its importation into the United States. *Thomas v. Reese*, 17 O. G. 195.

The principle of estoppel does not apply in determining the question of priority in an interference. *Swift v. Rochow*, 17 O. G. 450.

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*, 9 O. G. 688.

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.

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.

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 v. Scrymgeour*, 2 O. G. 705.

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*, 2 Dec. Com. 153; *Crane & Rogers*, 3 Dec. Com. 230; *Dana v. Greenleaf*, 9 O. G. 198; *Smith v. Perry*, 9 O. G. 638.

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 Sanno*, 10 O. G. 941.

If the evidence shows that the invention was publicly sold more than two years before the filing of the application, the applicant, although entitled to priority, will not be permitted to introduce evidence to show that such use was experimental. *Stearns v. Prescott*, 13 O. G. 121.

Rebutting testimony which is not taken in pursuance of the rule can not be allowed. *Connor v. Williams*, 15 O. G. 386.

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 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 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.

### **Dissolution.**

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*, 3 Dec. Com. 68; *Pugh v. Hamilton*, 3 Dec. Com. 116; *Waters v. Yost*, 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*, 3 O. G. 180; *Sherwood v. Searles*, 1 Dec. Com. 112; *Stearns v. Wingfield*, 3 Dec. Com. 67; *Pearl & Sawyer*, 5 O. G. 694; *Smith v. Winchell*, 13 O. G. 1127.

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; *Funck v. Doty*, 13 O. G. 322.

An interference will be dissolved when it is discovered that the invention in controversy is not patentable. *Lynch v. Dryden*, 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 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*, 3 Dec. Com. 68; *Pugh v. Hamilton*, 3 Dec. Com. 116; *Crane & Rogers*, 3 Dec. Com. 230.

When an interference is declared between parties who have a patent as joint inventors, and one of them as sole inventor, it should be dissolved, if both declare that there was no joint invention. *Walton v. Dennis*, 16 O. G. 959.

If the evidence shows that neither party made the invention singly, but that they made it jointly, the interference will be dissolved. *Taylor v. Martin*, 16 O. G. 138.

If the parties have made oath to a joint application, an interference will not be dissolved, although the affidavit was not taken before the proper officer. *Warnant v. Warnant*, 17 O. G. 265.

Although the patentability of an invention has been sustained notwithstanding a reference, yet a motion may be made to dissolve an interference on the same reference. *Stone v. Greaves*, 17 O. G. 397.

If an issue is made on a generic claim, the interference can not be dissolved upon filing a disclaimer of a specific claim. *Walsh v. Shinn*, 16 O. G. 1006.

If the party filing the latter application disclaims all interest in the invention, the interference will be dissolved. *Laverty v. Flagg*, 16 O. G. 1141.

If an applicant connects himself with a prior foreign patent, the interference can not be dissolved on motion. *Von Alteneck v. Thomson*, 17 O. G. 571.

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. *Hernance 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.

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.

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.

If the case is pending before the examiner of interferences, a motion to dissolve an interference on the ground of lack of patentability of the subject-matter can only be made before him. *Barney v. Kellogg*, 17 O. G. 1096.

A motion to dissolve an interference may be made at any stage of the proceedings, whether before or after the filing of a preliminary statement. *Banks v. Snediker*, 16 O. G. 1096.

A motion to dissolve an interference on the ground that the subject matter is not patentable should be made at the outset. *Blinn v. Gale*, 16 O. G. 459.

A motion to dissolve an interference will not be entertained without proof of notice to the adverse party. *Gray v. Bell*, 15 O. G. 385 ; *Bell v. Gray*, 15 O. G. 776.

If the operativeness of a device is denied on a motion to dissolve an interference, the applicant may submit affidavits to prove that it is operative. *Fuller v. Brush*, 16 O. G. 1188.

If a motion for a dissolution of an interference has been decided, another motion on the same ground can not be entertained. *Banks v. Snediker*, 17 O. G. 508.

If a motion to dissolve an interference on the ground of want of novelty in the invention, is overruled, the party may immediately file a protest against the issue of a patent on the ground of the non-patentability of the invention. *Fowler v. Benton*, 17 O. G. 266.

If it is necessary to make new parties, an interference should be suspended but not dissolved. *Maloney v. Kidwell*, 16 O. G. 1139.

If a motion is made to dissolve an interference because the invention in controversy has been in public use for more than two years, the interference may be suspended and the case remanded to the primary examiner, who may consider *ex parte* affidavits. *Hedges v. Daniels*, 17 O. G. 152.

A proceeding will not be suspended although the title to a patent which is in interference, is in litigation between alleged owners. *Keith v. Faure*, 25 O. G. 289.

If the notice of the refusal of the primary examiner to dissolve an interference limits the appeal to ten days, the time begins to run from the receipt of the notice. *George E. Buckley*, 24 O. G. 1175.

### 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*, 1 Dec. Com. 78 ; *Aldrich v. Bingham*, 3 Dec. Com. 90 ; *Hamilton v. Fisher*, 3 Dec. Com. 271 ; *Stevens v. Putnam*, 18 O. G. 519 ; *Rogers v. Bear*, 16 O. G. 908.

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 ; *Richmond v. Hibbard*, 16 O. G. 908.

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 v. Gliddon*, 10 O. G. 863.

A rehearing will not be granted to allow a party to introduce evidence which he could have obtained by the use of reasonable diligence. *Josselyn v. Swezey*, 15 O. G. 702 ; *Withington v. Gordon*, 17 O. G. 329.

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 default in an interference case will not be set aside if the party has been guilty of laches. *Jones v. Greenleaf*, 15 O. G. 560.

If a party availing himself of a default in an interference case obtains a patent, he cannot upon discovering that his opponent was the prior inventor have the default set aside where the adverse party has been guilty of laches. *Jones v. Greenleaf*, 15 O. G. 560.