

If a party elects to rely upon a proposition of law, he can not ask for a rehearing in order to introduce evidence when the decision is against him. *Farcot v. Rice*, 15 O. G. 563.

A party may obtain a rehearing although the evidence is not such as would entitle him to a new trial in an action at law. *Eccard v. Drawbaugh*, 24 O. G. 301; *contra*, *I. C. Pattee*, 2 O. G. 618; *Marsh v. Dodge*, 2 O. G. 643; *Dodd v. Cobb*, 10 O. G. 462; *Merrill v. Glidden*, 10 O. G. 863; *Slade v. Blair*, 15 O. G. 830; *Yost v. Powell*, 13 O. G. 122; *Gardner v. Dudley*, 18 O. G. 683; *Wicks v. McAvoy*, 18 O. G. 859.

On a motion for a rehearing on the same evidence, the question always is whether the findings of fact in the former decision are either wholly unsupported by or clearly in conflict with the evidence. *Packard v. Sanford*, 16 O. G. 1182.

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

A rehearing may be granted even after a patent has been granted to the successful applicant. *Hibbard v. Richmond*, 17 O. G. 1155.

A motion for a rehearing will not be allowed if one of the claims has been amended since the hearing. *Hoffman*, 16 O. G. 857.

A motion for a rehearing should set forth the facts themselves which constitute the ground for the application, and not merely refer to the affidavits, so that the commissioner may understand the ground and its validity. *Huttner v. Knox*, 15 O. G. 294.

An *ex parte* affidavit is not competent evidence to be used in support of a motion to reopen an interference. *Connor v. Williams*, 15 O. G. 386.

Practice.

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

The commissioner may declare more than one interference, and a hearing and decision between the applicant for a patent and A, whether in favor of one or the other, forms no rule for a decision between the applicant and B in the case of an interference declared. The proceedings are independent and *inter alios*. *Potter v. Dixon*, 2 Fish. 381; s. c. 5 Blatch. 160.

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

If an interference between an applicant and two patents is determined against the applicant, the jurisdiction of the patent office ceases, and it can not then determine the question of priority as between the patents. *Marshall v. Fish*, 16 O. G. 139.

If the preliminary statements show that the date of the invention of the last applicant was subsequent to the filing of the prior application, the first applicant may move for an immediate adjudication of the case on the record. *Huntley v. Smith*, 23 O. G. 795; *Starr v. Farmer*, 23 O. G. 2325.

If a party has an interest in an invention and a power of attorney, he may interfere to have a concession of priority made by his principal set aside and an interference reinstated. *Pratt v. Hammond*, 16 O. G. 1235.

An applicant can not file a disclaimer after an interference has been declared without notice to the adverse party. *Shinn*, 16 O. G. 458.

If an interference is declared between a generic and specific claim, and priority is awarded to the inventor of the generic claim, a patent will not be issued for the specific claim in subordination to the patent for the generic claim except upon the application of the inventor. *William Gardner*, 17 O. G. 626.

If a sole inventor who has taken out a patent jointly with another files an application in his own name, his rights on an interference are not concluded by a mere denial of the joint patentee. *Lovrien v. Banister* 18 O. G. 299.

If a patent has been awarded, a second patent can not on interference be awarded to an assignee. *Swift v. Rochow*, 17 O. G. 450.

If a decision of the commissioner rejecting an application for want of novelty is reversed on appeal, an interference pending between that application and another may be reinstated. *Cruikshank v. Strong*, 17 O. G. 511.

The mere fact that a party has a caveat which antedates the other interfering applications will not warrant an immediate adjudication of priority. *Booth v. Lyman*, 18 O. G. 132.

If a junior applicant files a preliminary statement which affects the *prima facie* case made by a prior application, a demand for an immediate adjudication can only be made on motion with notice to the adverse party. *Booth v. Lyman*, 17 O. G. 393.

If a reference to a prior invention is discovered after the declaration of an interference, the interference may be suspended until the question of patentability is discovered. *Stone v. Greaves*, 17 O. G. 260.

The mere making of a motion does not necessarily stay the proceedings in the case. A motion in order to operate as a stay must be accompanied by a petition to that effect. An order should then be entered at or before the hearing of said motion, granting or refusing the petition. *DuBois v. McCloskey*, 17 O. G. 1158.

If the decision on an interference is in favor of an applicant, the commissioner can not suspend the issue of a patent, for his duties then are merely ministerial and the statute is mandatory. The words "may issue" must be construed as shall. *James Sargent*, 12 O. G. 475.

Although an application may contain claims which have not been put in interference with a prior patent, yet the applicant can not have a patent for them before the decision in the interference case if they are shown in the prior patent. *Wheeler*, 23 O. G. 1031.

The issue of a patent can not be suspended because a party to an interference has filed a bill in equity where all the questions may be decided *de novo*. *James Sargent*, 12 O. G. 475; *Edwin L. Paine*, 13 O. G. 407.

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

If the evidence shows that the invention of the party who was the prior inventor had been in public use for more than two years before the filing of his application, the application may be referred to the primary examiner for consideration. *Quimby v. Randall*, 14 O. G. 748.

Although there is evidence to show that the invention was in public use for more than two years prior to the application, yet a reference to a primary examiner to determine that point can only be made when the

case is brought regularly before the commissioner on appeal. *Finch v. Bailey*, 25 O. G. 191.

Decision.

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

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

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

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

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

A party who was defeated in an interference is precluded from again setting up title to any matter which was properly determined therein. *John Burge*, 13 O. G. 498.

Although a party who accepts a patent issued in pursuance of a stipulation signed by his attorney in an interference case is bound by the stipulation, yet the stipulation can not be enforced upon a subsequent application. *Tucker v. Kahler*, 15 O. G. 966.

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

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

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

Depositions.

The commissioner may by rule provide for the use of *ex parte* affidavits to be used against an applicant for a patent. *Hedges v. Daniels*, 17 O. G. 394.

A deposition can not be taken in a foreign country to be used in an interference case unless it is authorized by rule. *Aet v. Saratoga*, 16 O. G. 810.

A deposition can not be taken before a consul in a foreign country without previous authority from the commissioner. *Lauder v. Crowell*, 16 O. G. 405.

A foreign inventor can not on an interference with an American inventor have a commission issued to prove that his invention was made in a foreign country prior to the time when it was patented or published. *Rumpff v. Kohler*, 23 O. G. 1831.

Notice.

When *ex parte* affidavits are used to oppose an application for a patent the applicant is entitled to a reasonable opportunity to cross-examine the affiants and to rebut their statements. *Hedges v. Daniels*, 17 O. G. 394.

A notice to take testimony which will not enable the adverse party to reach the place except by travelling both day and night is not sufficient. *Hoag v. Abbott*, 14 O. G. 471.

A notice of twenty-four hours to take depositions at a distant place is not sufficient. *Hoosier Drill Co. v. Ingels*, 15 O. G. 1013.

If no reasonable notice of the time of taking deposition is given, the right to object to its use is not lost by its use at a hearing where the party did not appear. *Hoosier Drill Co. v. Ingels*, 15 O. G. 1013.

If the notice of the time of taking depositions is unreasonable, the party does not waive the objection by accepting service of the notice. *Hoosier Drill Co. v. Engels*, 15 O. G. 1013.

Although a notice to take testimony is not sufficient, yet the testimony is admissible unless seasonable objection is made thereto. *Hoag v. Abbott*, 14 O. G. 471.

Extension of Time.

Although an affidavit for an extension of time to take testimony in an interference case does not show due diligence, yet time may be allowed under proper restrictions. *Appleby v. Morgan*, 16 O. G. 96.

If a party opposes an application for an extension of time to take testimony on the ground that the proposed testimony is immaterial, the extension will not be allowed unless he attempts to contradict the testimony which is to be supported by the new evidence. *Kenerson v. Brown*, 16 O. G. 857.

An extension of time to take rebutting testimony to prove that the adverse party is not an original inventor, will not be granted unless it is shown that his attention was called to the matter during his examination. *Neracher v. Cain*, 16 O. G. 220.

If an application for an extension of time to take testimony sets forth oral evidence and written evidence which is merely cumulative, and the examiner refuses to extend the time upon an admission of the truth of the oral testimony, no application for an extension can be subsequently made. *Lomont v. Kromer*, 16 O. G. 1141.

SEC. 4906. The clerk of any court of the United States, for any district or territory wherein testimony is to be taken for use in any contested case pending in the patent office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such district or territory, com-

manding him to appear and testify before any officer in such district or territory authorized to take depositions and affidavits, at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him.

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

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

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

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

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

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

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

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

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

the board of examiners in chief; having once paid the fee for such appeal.

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

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

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

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

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

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

An appeal to the examiners in chief lies only from such action of the primary examiner as is judicial in its nature, that is, such as respects the patentability, novelty, or utility of an invention. *Krake*, 1 Dec. Com. 100; *Morton*, 3 Dec. Com. 169.

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

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

If the applicant fails to set forth the reasons of appeal, he may amend it by inserting them. *Richardson*, 16 O. G. 261.

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

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

If an application is rejected because the combination is not patentable, the appeal should be taken to the examiners in chief. *Barcellos*, 17 O. G. 110.

If the objection to the form of the claim is not valid, the applicant may appeal to the examiners in chief from a rejection of the claim. *Winterlich*, 17 O. G. 55.

Where the description is sufficiently clear and the decision of the examiner relates to the scope of the claim or the patentability of that which he understands to be included in the terms of the claim, the rejection is for lack of patentable subject-matter, the appeal must be to the board of examiners in chief. *Charles C. Doten*, 12 O. G. 846.

If an amendment is rejected because it involves a departure from the invention described in the original application, an appeal may be taken to the examiners in chief. *Lanstrom*, 17 O. G. 744.

If the examiner of interferences decides that neither party is the first and original inventor, an appeal may be taken to the examiners in chief. *Wood v. Eames*, 17 O. G. 512.

If an interference is dissolved on the ground that one of the devices is not operative, the case becomes *ex parte*, and is appellable not directly to the commissioner, but first to the examiners in chief. *Fuller v. Brush*, 16 O. G. 1188.

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

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

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

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

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

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

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

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

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

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

If an application is rejected because the invention or a part thereof is not operative, an interlocutory appeal can not be taken to the commissioner. *Muhl*, 17 O. G. 744.

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

Only such matters as affect office practice, and are interlocutory in their nature, are appellable direct to the commissioner. *D. L. Proudfit*, 10 O. G. 585; *Du Motay*, 16 O. G. 499.

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

An appeal from the decision of a principal examiner, requiring the division of an application, must be taken to the commissioner in person. *Linus Yale, Jr.*, 1 Dec. Com. 110; *Leopold Lehman*, 2 Dec. Com. 70.

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

If the primary examiner rejects an application on the merits, the board of examiners in chief must render a real and not a *pro forma* judgment. *Buchanan*, 16 O. G. 1049.

The decision of the examiners in chief is binding on the primary examiner. *Rodgers*, 16 O. G. 545.

When a case on appeal is for any reason returned to the primary examiner, it takes precedence over all other applications before him except other similar appeal cases previously returned to him. *John Bigelow*, 14 O. G. 821.

The appellant must pay the fee on each appeal from a decision in an interference case as to priority of invention, although the decision in one case disposes of others. *Hedderwick*, 15 O. G. 472.

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

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

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

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

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

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

The commissioner has the power to revise the order of an examiner in refusing or granting a rehearing. *Loring v. Hall*, 15 O. G. 471.

The commissioner will not in general reverse an order granting a rehearing. *Loring v. Hall*, 15 O. G. 471.

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

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

If an objection to an irregularity in the citation of a reference could have been brought before the board of the examiners in chief on a motion

for a rehearing, it can not be raised on an appeal before the commissioner. *Thomas Phillips*, 12 O. G. 311.

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

The concurrent decisions of lower tribunals upon questions of fact will not be set aside upon appeal except for manifest error. *Hazelip v. Richardson*, 10 O. G. 746.

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

Although the examiner of interferences and the examiners in chief concur on a question of fact, yet the commissioner may reach a different conclusion, for their judgment is not binding on him. *Packard v. Sandford*, 16 O. G. 1182; *Dickson v. Kinsman*, 18 O. G. 1225.

If a case has been decided by one commissioner, his successor will not reopen it unless the party shows such a ground as would entitle him to a new trial. *Huttner v. Knox*, 16 O. G. 1046; *John L. Mason*, 2 Dec. Com. 20.

When a case is pending on appeal before the commissioner, the interference can not be dissolved on the ground that the issue is uncertain unless the objection was taken before the examiner. *Englemann v. Vester*, 16 O. G. 96.

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

If a commissioner dissolves an interference on the ground of want of novelty on the part of the applicant, the latter may have the claim formally rejected so that he can regularly take an appeal. *Knox*, 16 O. G. 1048.

The extent of a judgment as *res judicata* is to be determined not by the word, but by the substance of the decision. *Pennie*, 17 O. G. 330.

Although an alternative writ of mandamus was issued to the commissioner to show cause why he should not re-examine a decision in an interference case, yet if he resigns, the patent may be issued by his successor. *Withington v. Locke*, 15 O. G. 426.

If an applicant desires to amend the specifications after the decision, the amendment may be made before a primary examiner. *Reynolds*, 24 O. G. 993; *Hitt*, 25 O. G. 192.

SEC. 4911. If such party, except a party to an interference, is dissatisfied with the decision of the commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc.

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

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

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

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

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

An applicant whose patent has been refused may appeal, although the commissioner improperly put him into interference with another. *Ex parte Platts & Walden*, 15 O. G. 827.

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

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

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

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

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

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

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

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

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

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

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

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

The supreme court is limited to the reasons of appeal, for the appeal is only an appeal from so much of the decision as is affected by the reason. *Arnold v. Bishop*, Cranch Pat. Dec. 103; *Smith v. Flickenger*, Cranch Pat. Dec. 116.

The supreme court can only examine into the reasons of appeal, and the record and proceedings as far as they apply thereto, for the purpose of ascertaining whether the commissioner has made an erroneous decision, and can not revise the decision on any other ground than that upon which the application was rejected. *Ex parte Conklin*, 1 McArthur 375; s. c. 5 O. G. 235.

An officer or counsel of the patent office may appear and argue the questions involved in the appeal. *Perry v. Cornell*, Cranch Pat. Dec. 132.

A decision in an interference case is not conclusive as between the patentee, whose patent was in controversy, and persons who were not parties to the interference, for estoppels must be mutual. *Perry v. Starrett*, 3 Ban & Ard. 485; s. c. 14 O. G. 599.

A decision in an interference case will not prevent a person who purchased a machine from the defeated party from contesting the novelty of the invention by setting up the prior invention of another. *Peck St. W. Co. v. Lindsay*, 18 O. G. 63; s. c. 5 Ban & Ard. 390; s. c. 2 Fed. Rep. 688.

A decision on an interference in favor of a patent and against an application, is not conclusive as to priority of invention in an action against third parties. *Perry v. Perry* 14 O. G. 599.

The decision of the commissioner is conclusive on the question of priority as between the parties. *Shuter v. Davis*, 24 O. G. 303; s. c. 16 Fed. Rep. 564; *Holliday v. Pickhardt*, 22 O. G. 420; s. c. 12 Fed. Rep. 147.

SEC. 4915. Whenever a patent on application is refused, either by the commissioner of patents or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the patent office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the commissioner; and all the expenses

of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not.

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

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

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

If a party whose claim is rejected on an interference files a bill under this section, he may introduce new evidence in addition to that produced in the Patent Office. *Ex parte Squire*, 12 O. G. 1025; s. c. 3 Ban & Ard. 133.

Although an agreement by one joint inventor is merely executory to assign future inventions, yet the joint inventors can not have a patent issued to them. *Rumsteller v. Atkinson*, 23 O. G. 940.

For practice under this section, see *Greeley v. Commissioner*, 6 Fish. 675; s. c. 1 Holmes 284; 4 O. G. 612; *Prentiss v. Ellworth*, 2 Whart. Dig. 365; *ex parte Arkell*, 15 Blatch. 437; s. c. 4 Ban & Ard. 80.

The jurisdiction conferred by this section is not appellate but is independent and original. *Whipple v. Miner*, 23 O. G. 2236; s. c. 15 Fed. Rep. 117.

If the commissioner determines the question of priority on an interference between two applicants, the unsuccessful applicant can not obtain an injunction against the issuing of the patent on a mere allegation of error of judgment. *Whipple v. Miner*, 23 O. G. 2236; s. c. 15 Fed. Rep. 117.

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

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

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

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

When Surrender Allowed.

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

The statute embraces only the right to a reissue where, from an unintentional error in the description of the invention, the patent is wholly "inoperative or invalid." It is not enough that the applicant for the reissue shall state that the patent is not fully valid and available to him. This does not meet the clear and explicit requirements of the statute. *Whiteley v. Swayne*, 4 Fish. 117; s. c. 7 Wall. 685; *Poage v. McCormick*, 15 Fed. Rep. 398; *vide Gold & S. T. Co. v. Wiley*, 17 Fed. Rep. 234.

If the original patent is neither inoperative nor invalid, and if no error has been occasioned by accident or mistake, the presumption is that the patentee abandoned to the use of the public everything which he may have invented, but did not include in his claim or specification. *Ex parte Conklin*, 1 McArthur 375; s. c. 5 O. G. 235.

The word "specification" when used without the word "claim" means both description and claim. Therefore a reissue is allowed when the specification is defective or insufficient in regard to either the description or the claim or both, and the specification may be corrected in regard to either the description or the claim or both. *Wilson v. Coon*, 19 O. G. 482; 18 Blatch. 532; s. c. 6 Fed. Rep. 611; *Smith v. Merriam*, 19 O. G. 601; s. c. 6 Fed. Rep. 713.

A patent whose claim does not embrace a part of the invention shown in the specification may be invalid or inoperative. *Anilin Fabrik v. Higgin*, 14 O. G. 414; s. c. 15 Blatch. 290; s. c. 3 Ban & Ard. 462.

A reissue may be allowed, although a suit could be maintained on the specification and claim as they are. *Wilson v. Coon*, 19 O. G. 482; s. c. 18 Blatch. 532; s. c. 6 Fed. Rep. 611.

If the original patent is valid and operative, and the claim covers the invention described in the specification, the reissue is void. *Giant P. Co. v. Cal. V. P. Co.*, 18 O. G. 1339; s. c. 4 Fed. Rep. 720.

Where it is apparent on the face of the patent or by contemporary records that no accident, inadvertence or mistake could have occurred, the reissue is void. *James v. Campbell*, 104 U. S. 356; s. c. 21 O. G. 337.

This section was never intended to allow a patent to be enlarged, but to allow the correction of mistakes inadvertently committed and the restriction of claims which had been improperly made or which had been made too broad. In a clear case of mistake—not error of judgment—the patent may undoubtedly be enlarged, but that should be the exception, not the rule. *Swain T. Manuf. Co. v. Ladd*, 102 U. S. 409; s. c. 19 O. G. 62; s. c. 11 O. G. 153; s. c. 2 Ban & Ard. 488.

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

It not infrequently happens that a judicial interpretation of the specification or claim of a patent, or both, discloses to the inventor and patentee for the first time the defects in the instrument, and shows him that he has unwittingly restricted his rights within narrower limits than his discovery, or so inartificially described his invention that he has failed to secure any substantial advantage by it. Such a disclosure furnishes a proper occasion for a surrender and reissue when the error was inadvertent, and is clearly within the beneficent design of the statute. *Poppenhusen v. Falke*, 2 Fish. 213; *Doughty v. West*, 3 Fish. 580; s. c. 6 Blatch. 429; *Bliss v. Gaylord Manuf. Co.*, 6 Blatch. 279.

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

If the specification is defective or doubtful in some particulars, the patent may be surrendered for the purpose of making the description more clear, although it is not void. *Woodworth v. Hall*, 1 M. & W. 248; s. c. 2 Robb 495; *Parham v. Sewing Machine Co.*, 4 Fish. 468.

The provision allowing a surrender may perhaps be regarded more justly as affirming the propriety of the usage which had obtained under the former laws and had been repeatedly recognized by the courts, and as prescribing in addition the conditions and incidents which should attach to it thereafter. It is hardly to be supposed that the merely clerical error of an engrossing subordinate, or the accidental inadvertence of the commissioner himself, is not capable of being rectified or supplied now, just as it was before the adoption of this provision. *French v. Rogers*, 1 Fish. 133; *Morris v. Huntington*, 1 Paine 348; s. c. 1 Robb 448; *Grant v. Raymond*, 6 Pet. 218; s. c. 1 Robb 604.

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

It is the duty of the commissioner to correct errors in the letters patent when applied to, and to minute the correction on or in them, as these matters are between him, representing the government, and the patentee. He need not resign or reseal the letters, for he adopts them as his own act by redelivering the patent after it is amended, as much as he adopts the writing of it on the paper or parchment. The record or enrollment must be made to correspond with the letters as amended. *Woodworth v. Hall*, 1 W. & M. 248, 349; s. c. 2 Robb 495; *Dental Vulcanite Co. v. Wetherbee*, 3 Fish. 87; s. c. 2 Cliff. 555.

A patent which has been extended may be surrendered and a reissue granted. *Gibson v. Harris*, 1 Blatch. 167; *Wilson v. Rosseau*, 4 How. 646; s. c. 1 Blatch. 3; s. c. 2 Robb 373.

A reissue of a reissue is valid. The statute authorizes the reissue of "any patent." A reissued patent is none the less a patent within the meaning of this section because it is a reissued patent. *Selden v. Stock-*

well S. L. G. B. Co., 20 O. G. 1377; s. c. 19 Blatch. 544; s. c. 9 Fed. Rep. 390.

If a reissue is invalid because it is not for the same invention as the original patent, the patentee may surrender it and obtain a second reissue. *American D. R. B. Co. v. Sullivan Machine Co.*, 14 Blatch. 119; s. c. 2 Ban & Ard. 522; *American D. R. B. Co. v. Sheldon*, 17 Blatch. 208; s. c. 4 Ban & Ard. 551.

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

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

The surrender and the reissue, no matter how often they recur, are reciprocal, each in consideration of the other, and forming together but a single act between the parties. It would be unconscientious to retain the consideration while denying the validity of the grant. If the reissue is invalid for want of authority to make it, the surrender is ineffective for want of authority to accept it, and so the patent stands as if there had been no surrender. *French v. Rogers*, 1 Fish. 133; *Woodworth v. Hall*, 1 W. & M. 389; s. c. 2 Robb 517; *Woodworth v. Edwards*, 3 W. & M. 120; s. c. 2 Robb 610.

The surrender of a patent is an abandonment of it, and the patentee takes upon himself the risk of getting a reissue or losing all. If the application for a reissue is rejected after a contest on the merits in an interference with other claimants, the decision is as fatal to his original patent as to his right to a reissue. *Peck v. Collins*, 103 U. S. 660; s. c. 19 O. G. 1137.

Practice.

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

An applicant for a reissue who has filed his application with the acting commissioner, and paid the requisite amount of fees, has done all in his power to make his application effectual, and has a right to consider it properly before the commissioner. *Commissioner v. Whiteley*, 4 Wall. 522.

It is the first duty of the commissioner to receive the application, what-

ever he may do subsequently. Without this initial step there can be no examination, and indeed no rightful knowledge of the subject on his part. *Commissioner v. Whiteley*, 4 Wall. 522.

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

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

The issuing of one set of new letters patent for the three different terms before existing, when the old specification is sought to be corrected, is open to some questions concerning its legality. The most obvious mode would be to renew each separately, or renew only the old letters and their specification, and let the others be cured or aided by relation back to the original one. *Woodworth v. Hall*, 1 W. & M. 248, 389 ; s. c. 2 Robb 495, 517.

If each form of an apparatus is fairly a distinct and separate part of the thing patented, a separate reissue may be taken for each. *Selden v. Stockwell S. L. G. B. Co.*, 20 O. G. 1737 ; s. c. 19 Blatch. 544 ; s. c. 9 Fed. Rep. 390.

If a reissue is granted upon the surrender of the patent, it is not invalidated by the subsequent granting of other reissues. *Atwood v. Portland Co.*, 5 Ban & Ard. 533 ; s. c. 10 Fed. Rep. 283.

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

The new patent, in case of reissue, should be granted for the unexpired term only. *Woodworth v. Stone*, 3 Story 749 ; s. c. 2 Robb 296.

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

It is questionable whether any evidence is competent or admissible in an action between third persons involving the validity of the patent, to show that the officer who signed it was not legally appointed, the power of the officer himself not being put directly in issue in a proceeding where he is a party. *Woodworth v. Hall*, 1 Wood & M. 389; s. c. 2 Robb 517.

The signature of a person as acting commissioner carries as much verity and legality on the face of a certificate to a patent as that of the commissioner himself, until it be shown, if it can be properly, that the acting appointment was not in truth made in the manner authorized by law. *Woodworth v. Hall*, 1 Wood & M. 248, 389; s. c. 2 Robb 495, 517.

It would seem to be necessary to have the Secretary of the Interior sign anew or assent to an amendment of an error in a patent, as he is a distinct officer, and without signing anew or assenting would not authenticate the letters as amended. *Woodworth v. Hall*, 1 Wood & M. 248, 389; s. c. 2 Robb 495, 517.

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

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

Parties to Surrender.

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

It is not in the power of the patentee, by the surrender of his patent, to affect, without their consent, the rights of third persons to whom he has previously passed his interest in the whole or a part of the patent. This consent may be manifested either by joining in the surrender with the patentee, or by previously authorizing it, or by subsequently ratifying or approving it. To take advantage and benefit of it would be a ratification. When such consent is given, the rights of the party so consenting in and to the old patent are forever gone. It may, too, be considered as a sound and settled principle, that a person to whom the patentee has passed his interest in part of the old patent, is entitled, upon a surrender of the same by the patentee, and the obtaining of a reissued patent, to the same right

under the reissued patent that he had to the old one. The patentee can not, by taking a reissue, deprive him of the same right to it that he had to the old one, if he wishes to take the benefit of such right. But when he does take advantage and benefit of the reissued patent, he consents to give up, and does give up, the right which he had under the old one. It does not follow from this, however, that because a third person to whom a patentee has passed his interest in a part of the patent, is entitled to the same right to a reissued patent that he had to the old one, he is compelled to take under the reissued one, and thereby compelled to give up the right which he had under the old one. If he were, his rights might be injuriously affected without his consent. If he were so compelled, an assignee under the old patent of an exclusive territorial right would be forced, without his consent, to give up damages which he might be entitled to under the old patent for a violation of rights secured to him by that patent. And it might so happen that the old patent surrendered was a valid one, and that the reissued one was invalid, or that the rights secured by the former were important, while the rights secured by the latter were of little consequence. Third persons can, therefore, hold under the old patent notwithstanding the surrender and reissue. *Potter v. Holland*, 1 Fish. 327; s. c. 4 Blatch. 206; *Smith v. Mercer*, 5 Penn. L. J. 529; s. c. 4 West. L. J. 49; *Woodworth v. Stone*, 3 Story 749; s. c. 2 Robb 296; *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206; *McBurney v. Goodyear*, 65 Mass. 569.

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

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

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

New letters, with an amended specification, is the same invention as that covered by the original patent, and a conveyance of it once, therefore, for a specified term, is good for the term, whether an amended specification is filed or not before the term closes. *Woodworth v. Hall*, 1 Wood & M. 248, 389; s. c. 2 Robb 495, 517.

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

The grant of a reissue is evidence that the person to whom it is granted had the title to the patent. *American D. R. B. Co. v. Sheldon*, 17 Blatch. 208; s. c. 4 Ban & Ard. 551.

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

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

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

Where an assignment covers the whole interest of an inventor, present and prospective, it is more regular that the application for a surrender should be made by the assignee, but even in that case the reissue will not be void, if the assignment is duly recorded in the patent office, and the application for the surrender and reissue is made with the consent of the assignee. If the reissue is correct in form, and there is no proof of fraud, intentional error, or concealment, a mere wrongdoer can not defend himself against the charge of infringement by proving that the proceedings which led to the reissue were irregular, unless it is shown that the proceedings were contrary to law, or that the patent was granted to the wrong party. *Dental Vulcanite Co. v. Wetherbee*, 3 Fish. 87; s. c. 2 Cliff. 555; *Woodworth v. Stone*, 3 Story 749; s. c. 2 Robb 296; *Meyer v. Bailey*, 8 O. G. 437; s. c. 2 Ban & Ard. 73.

Although an assignment is invalid at the time of reissue, yet if the assignor subsequently ratify it, the reissue to the assignee is valid. *Campbell v. James*, 18 O. G. 979; s. c. 17 Blatch. 43; s. c. 4 Ban & Ard. 456.

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

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

A grantee of an exclusive territorial right need not unite in the application for a reissue. *Meyer v. Bailey*, 8 O. G. 437; s. c. 2 Ban & Ard. 73; *Commissioner v. Whiteley*, 4 Wall. 522.

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

The reissue may be made in the name of the administrator of the patentee, for an invention is personal property, and possesses value beyond the first patent on it, being valuable for purposes abroad as the ground for a patent there, and also for a renewal at home. *Woodworth v. Hall*, 1 Wood & M. 248, 389; s. c. 2 Robb 495, 517.

Where a reissue is granted to an administrator, it will be taken for granted that the person in whose name the patent was issued established his legal right to it before the commissioner, and the court can not go behind the grant to ascertain whether this was so or not. *Northwestern Co. v. Philadelphia Co.*, 6 O. G. 34; s. c. 1 Ban & Ard. 177; *Woodworth v. Hall*, 1 Wood & M. 248, 389; s. c. 2 Robb 495, 517; *Goodyear v. Hullihen*, 3 Fish. 251; s. c. 1 Hughes 492.

A grant in case of a reissue in trust for the heirs-at-law of the patentee, their heirs, administrators or assigns, is at most a mere verbal error, if the trust has any validity whatever, for the new patent will, by operation of law, enure to the sole benefit of the parties in whose favor the law designed it should operate, and not otherwise. *Woodworth v. Stone*, 3 Story 749; s. c. 2 Robb 296.

An executor of the patentee may surrender the patent and obtain a reissue. *Carew v. Boston Elastic Fabric Co.*, 5 Fish. 90; s. c. 1 Holmes 45; 1 O. G. 91; s. c. 3 Cliff. 356.

If one of several executors surrenders a patent, and takes a reissue to himself as executor, the grant vests the legal title in him exclusively. The suffix of executor signifies the trustee character in which he assumed to act, and in which he was recognized and dealt with by the commissioner. The designation and trust which it implies does not prevent the passage of the legal title, or qualify the estate which accompanies it. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

A reissue is valid although there is an error in spelling the name of the grantee if he is the person to whom the patent was granted and to whom the reissue was intended to be granted. *Bignall v. Harvey*, 18 O. G. 1275; s. c. 18 Blatch. 353; s. c. 5 Ban & Ard. 636; s. c. 4 Fed. Rep. 334.

When Decision of Commissioner Conclusive.

The specification may be defective or insufficient either by a mistake of law as to what is required to be stated therein in respect to the claim of the inventor, or by a mistake of fact in omitting things which are indispensable to the completeness and exactness of the invention, or of the mode of constructing or making or using the same. Whether the invention claimed in the original patent and that claimed in the new amended patent is substantially the same, is and must be in many cases a matter of great nicety and difficulty to decide. It may involve considerations of fact as well as of law. Who is to decide the question? The true answer is, the commissioner of patents; for the law intrusts him with the authority not only to accept the surrender, but to grant the new amended patent. He is bound, therefore, by the very nature of his duties, to inquire into and

ascertain whether the specification is definite or insufficient in point of law or fact, and whether the inventor has claimed more than he invented, and in each case, whether the error has arisen from inadvertency, accident or mistake, or with a fraudulent or deceptive intention. No one can well doubt that in the first instance, therefore, he is bound to decide the whole law and facts arising under the application for the new patent. *Prima facie*, therefore, it must be presumed that the new amended patent has been rightfully granted by him. *Allen v. Blunt*, 3 Story 742; s. c. 2 Robb 288; *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Phila. & Trenton R. R. Co. v. Stimpson*, 14 Pet. 448; s. c. 2 Robb 46.

It is not necessary for the reissued patent to contain any recitals that the prerequisites to the grant of it have been duly complied with, for the law makes the presumption. *Phila. & Trenton R. R. Co. v. Stimpson*, 14 Pet. 448; s. c. 2 Robb 46; *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516.

The power of accepting the surrender of the original patent, and of granting a reissue of it, is confided exclusively to the commissioner, and is to be exercised judicially by him. The presumption is that he has exercised it lawfully, and that the reasons for which alone its exercise could be invoked have been sufficiently shown to exist. His decision is final, and is to be treated as foreclosing all inquiry into the existence or sufficiency of the facts which are prescribed as necessary to authorize him to grant a reissue. *Parham v. Sewing Machine Co.*, 4 Fish. 468; *Gage v. Nelson*, 23 O. G. 2119; s. c. 14 Blatch. 293; s. c. 12 O. G. 753; s. c. 3 Ban & Ard. 55; *Smith v. Merriam*, 19 O. G. 601; s. c. 6 Fed. Rep. 713.

The decision of the commissioner is not conclusive if he grants a reissue in a case where he has no authority under the statute to act, or exceeds his authority. *Giant P. Co. v. Cal. V. P. Co.*, 18 O. G. 1339; s. c. 4 Fed. Rep. 720; *Flower v. Rayner*, 19 O. G. 425; s. c. 5 Fed. Rep. 793.

All matters of fact involved in the hearing of an application to reissue a patent, and in granting it, are conclusively settled by the decision of the commissioner granting the application. Matters of construction arising on the face of the instrument are still open, but all matters of fact connected with the surrender and reissue are closed in a suit for an infringement by the decision of the commissioner. *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Jordan v. Dobson*, 4 Fish. 232; s. c. 7 Phila. 533; 2 Abb. U. S. 398; *Blake v. Stafford*, 3 Fish. 294; s. c. 6 Blatch. 195; *La Baw v. Hawkins*, 6 O. G. 724; s. c. 1 Ban & Ard. 428; *Colt v. Young*, 2 Blatch. 471; *Stimpson v. Westchester R. R. Co.*, 4 How. 380; s. c. 2 Robb 335; *Swift v. Whisen*, 3 Fish. 343; s. c. 2 Bond 115; *Forbes v. Barstow Stove Co.*, 2 Cliff. 379; *Allen v. Blunt*, 3 Story 742; s. c. 2 Robb 288; *Poppenhusen v. Falke*, 2 Fish. 181; s. c. 4 Blatch. 493; *Woodworth v. Stone*, 3 Story 749; s. c. 2 Robb 296; *French v. Rogers*, 1 Fish. 133; *Potter v. Holland*, 1 Fish. 382; s. c. 4 Blatch. 238; *Thomas v. Shoe M. Manuf. Co.*, 16 O. G. 541; s. c. 3 Ban & Ard. 557; *Selden v. Stockwell, S. L. G. B. Co.*, 20 O. G. 1397; s. c. 19 Blatch. 544; s. c. 9 Fed. Rep. 390; *Combined Can Co. v. Lloyd*, 11 Fed. Rep. 149; s. c. 39 Leg. Int. 82.

The presumption is that, in granting the reissue, the commissioner discharged his duty faithfully and correctly. This involves the idea that he granted it on account of mistake or inadvertence in the description or specification of the invention attached to the first letters; and therefore that he issued the new one as a matter of course, with a different amended description or specification, but for the same invention. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530; *Smith v. Mercer*, 5 Penn. L. J. 529; s. c. 4 West. L. J. 49; *Hussey v. Bradley*, 2 Fish. 362; s. c. 5 Blatch. 134; *Crompton v. Belknap Mills*, 3 Fish. 536; *Birdsell v. McDonald*, 6 O. G. 682; s. c. 1 Ban & Ard. 165; *Bantz v. Elsas*, 6 O. G. 117; s. c. 1 Ban & Ard. 351; *Doherty v. Haynes*, 6 O. G. 118; s. c. 4 Cliff. 291; s. c. 1 Ban & Ard. 289; *Woodworth v. Edwards*, 3 W. & M. 120; s. c. 2 Robb 610; *Swift v. Whisen*, 3 Fish. 343; s. c. 2 Bond 115; *Woodward v. Densmore*, 4 Fish. 163; *American Pavement Co. v. Elizabeth*, 6 Fish. 424; s. c. 3 O. G. 522; *Aultman v. Holley*, 6 Fish. 534; s. c. 11 Blatch. 317; 5 O. G. 3; *Hussey v. McCormick*, 1 Fish. 509; s. c. 1 Biss. 300; *Blake v. Stafford*, 3 Fish. 294; s. c. 6 Blatch. 195; *Hussey v. Bradley*, 2 Fish. 362; s. c. 5 Blatch. 134; *Morris v. Royer*, 3 Fish. 176; s. c. 2 Bond 66; *Poppenhusen v. Falke*, 2 Fish. 181; s. c. 4 Blatch. 493; *O'Reilly v. Morse*, 15 How. 62; *Jordan v. Dobson*, 4 Fish. 232; s. c. 2 Abb. U. S. 398; 7 Phila. 533; *Middletown Co. v. Judd*, 3 Fish. 141; *Goodyear v. Berry*, 3 Fish. 439; s. c. 2 Bond 189; *Knight v. Railroad Co.*, 3 Fish. 1; s. c. Taney 106; *M. & P. Manuf. Co. v. Du Brul*, 12 O. G. 351; s. c. 2 Ban & Ard. 618.

The *prima facie* inference or presumption in respect to the identity of the invention is open to be contradicted by proper evidence. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530; *Goodyear v. Berry*, 3 Fish. 439; s. c. 2 Bond 189.

Where the commissioner accepts a surrender of an original patent, and grants a new patent, his decision in the premises in a suit for an infringement is final and conclusive, and is not re-examinable in such suit, unless it is apparent upon the face of the patent that he has exceeded his authority—that there is such a repugnancy between the old and the new patent, that it must be held as matter of legal construction that the new patent is not for the same invention as that embraced and secured in the original patent. *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Graham v. Mason*, 5 Fish. 1; s. c. 4 Cliff. 88; *La Baw v. Hawkins*, 6 O. G. 724; s. c. 1 Ban & Ard. 428; *Glue Co. v. Upton*, 97 U. S. 3; s. c. 4 Cliff. 237; s. c. 1 Ban & Ard. 497; s. c. 6 O. G. 837; *Collar Co. v. Van Dusen*, 23 Wall. 530; s. c. 10 Blatch. 119; 7 O. G. 919; s. c. 2 O. G. 361; s. c. 5 Fish. 597; *Wells v. Gill*, 6 Fish. 89; s. c. 2 O. G. 590; *Metropolitan Co. v. Tool Co.*, 1 Holmes 161.

Identity of Original and Reissue.

The reissue must, by the express words of the section, be for the same invention, and consequently, where it appears on a comparison of the two instruments as matter of law, that the reissued patent is not for the same

invention as that embraced and secured in the original patent, the reissue is invalid, as that state of fact shows that the commissioner, in granting the new patent, exceeded his jurisdiction. *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Sickles v. Evans*, 2 Fish. 417; s. c. 2 Cliff. 203; *Battin v. Taggart*, 1 Fish. 139; *Carhart v. Austin*, 2 Fish. 543; s. c. 2 Cliff. 528; *Burr v. Duryee*, 2 Fish. 275; s. c. 1 Wall. 531; *Swift v. Whisen*, 3 Fish. 343; s. c. 2 Bond 115; *Sickles v. Falls Co.*, 2 Fish. 202; s. c. 4 Blatch. 508; *Goodyear v. Berry*, 3 Fish. 439; s. c. 2 Bond 189; *Wood Paper Co. v. Fibre Co.*, 3 Fish. 362; s. c. 6 Blatch. 27; *Wood Paper Co. v. Heft*, 3 Fish. 316; s. c. 8 Wall. 333; *Whiteley v. Swayne*, 4 Fish. 117; s. c. 7 Wall. 685; *Vogle v. Semple*, 11 O. G. 923; s. c. 7 Biss. 382; s. c. 2 Ban & Ard. 556; *Collar Co. v. Van Dusen*, 23 Wall. 530; s. c. 10 Blatch. 119; 7 O. G. 919; 2 O. G. 361; s. c. 5 Fish. 597; *Russell v. Dodge*, 93 U. S. 460; s. c. 11 O. G. 151; *American Wood Paper Co. v. Fibre Disintegrating Co.*, 23 Wall. 566; *Wicks v. Stevens*, 2 Woods, 310; s. c. 2 Ban & Ard. 318; *Hall v. Withington*, 6 O. G. 933; *Johnson v. Beard*, 8 O. G. 435; s. c. 2 Ban & Ard. 50; *Consolidated O. W. P. Co. v. Eaton*, 12 Fed. Rep. 865; *Ball v. Withington*, 1 Ban & Ard. 549; *Adams & W. Manuf. Co. v. Meyrose*, 12 Fed. Rep. 440; *Johnson v. Railroad Co.*, 105 U. S. 539; s. c. 22 O. G. 329; *Worden v. Fisher*, 21 O. G. 1957; s. c. 11 Fed. Rep. 505; *Hayes v. Seton*, 12 Fed. Rep. 120; *Heald v. Rice*, 104 U. S. 737; s. c. 21 O. G. 1443; s. c. 13 Pac. L. R. 33; *Guidet v. Brooklyn*, 105 U. S. 550; s. c. 21 O. G. 1692; *Matthews v. Machine Co.*, 105 U. S. 54; s. c. 21 O. G. 1349; *Hart v. Thayer*, 21 O. G. 791; 10 Fed. Rep. 746; *Holmes v. Plainville Manuf. Co.*, 9 Fed. Rep. 757; *Kells v. McKenzie*, 20 O. G. 1663; s. c. 9 Fed. Rep. 284; *Atwater Manuf. Co. v. Beecher M. Co.*, 8 Fed. Rep. 608; *Manufacturing Co. v. Corbin*, 103 U. S. 786; s. c. 20 O. G. 297; s. c. 14 O. G. 3; s. c. 14 Blatch. 396; s. c. 3 Ban & Ard. 109; *Meyer v. Maxheimer*, 20 O. G. 1162; s. c. 9 Fed. Rep. 99; *Crompton v. Knowles*, 7 Fed. Rep. 199; *Flower v. Rayner*, 19 O. G. 424; s. c. 5 Fed. Rep. 793; *Cowell v. Sessions*, 17 Fed. Rep. 450; *Scaife v. Magens*, 19 O. G. 791; *Kelleher v. Darling*, 14 O. G. 673; s. c. 4 Cliff. 424; s. c. 3 Ban & Ard. 438; *Railway Co. v. Sayles*, 97 U. S. 554; s. c. 15 O. G. 243; s. c. 2 Biss. 52; s. c. 2 Fish. 584; *American M. P. Co. v. Atlantic M. Co.*, 15 O. G. 467; s. c. 5 Dillon 127; s. c. 4 Ban & Ard. 48; *Doane & W. Manuf. Co. v. Smith*, 24 O. G. 302; s. c. 15 Fed. Rep. 459; *Curtis v. Branch*, 15 O. G. 919; s. c. 4 Ban & Ard. 189; *Nye v. Allen*, 23 O. G. 2328; s. c. 15 Fed. Rep. 114; *Cammeyer v. Newton*, 16 O. G. 720; s. c. 4 Ban & Ard. 139; *Seibert C. O. E. Co. v. Harpers S. L. Co.*, 4 Fed. Rep. 328; *Knapp v. Shaw*, 23 O. G. 2236; s. c. 15 Fed. Rep. 115; *Putnam v. Tinkham*, 4 Fed. Rep. 411; *Andrews v. Hovey*, 16 Fed. Rep. 387; *Gould v. Spicer*, 15 Fed. Rep. 344; *Ball v. Langles*, 18 O. G. 1405; s. c. 102 U. S. 128; *Garneau v. Dosier*, 102 U. S. 230; s. c. 19 O. G. 61; *Moffitt v. Rogers*, 106 U. S. 423; s. c. 23 O. G. 270; s. c. 4 Ban & Ard. 225; *Gosling v. Roberts*, 106 U. S. 39; s. c. 22 O. G. 1785.

If the original patent was declared void for want of novelty, a reissue

which contains something new and patentable is void. *Id.* it is not for the same invention. *Jones v. McMurray*, 2 Hughes 527; s. c. 13 O. G. 6; s. c. 3 Ban & Ard. 130.

A reissue can not be made for the mere purpose of enlarging the claim, unless the application is made within a reasonable time after the granting of the patent. *Miller v. Brass Co.*, 21 O. G. 201; s. c. 104 U. S. 350; s. c. 12 O. G. 667; s. c. 14 Blatch. 282; s. c. 3 Ban & Ard. 20.

When it is apparent on the face of the instrument upon the mere comparison of the original patent with the reissue, that there has been unreasonable delay in applying for a reissue, made for the mere purpose of enlarging the claim, it is competent for the court to declare the reissue to be void. *Miller v. Brass Co.*, 104 U. S. 350; s. c. 21 O. G. 201; s. c. 12 O. G. 667; s. c. 14 Blatch. 282; s. c. 3 Ban & Ard. 20; *Combined Can Co. v. Lloyd*, 11 Fed. Rep. 149; s. c. 39 Leg. Int. 82; *Turrell v. Bradford*, 23 O. G. 1623; *Gage v. Herring*, 23 O. G. 2119; s. c. 14 Blatch. 293; s. c. 12 O. G. 753; s. c. 3 Ban & Ard. 55; *Matthews v. Machine Co.*, 105 U. S. 54; s. c. 21 O. G. 1349; *Hyatt v. Southworth*, 15 Fed. Rep. 751; *Newton v. Furst & B. Manuf. Co.*, 15 C. L. N. 113; s. c. 14 Fed. Rep. 465; *Streit v. Lauter*, 11 Fed. Rep. 309; *Jones v. Baker*, 22 O. G. 771; s. c. 11 Fed. Rep. 597; *Pope Manuf. Co. v. Marqua*, 15 Fed. Rep. 400; *Neacy v. Allis*, 22 O. G. 1621; s. c. 13 Fed. Rep. 874; *Hayes v. Seton*, 12 Fed. Rep. 120; *Sheriff v. Fulton*, 22 O. G. 87; s. c. 12 Fed. Rep. 136; *Tillinghast v. Hicks*, 23 O. G. 739; s. c. 13 Fed. Rep. 388; *Johnson v. Railroad Co.*, 105 U. S. 539; s. c. 22 O. G. 329; s. c. 15 Blatch. 192; s. c. 3 Ban & Ard. 428; *Holt v. Keeler*, 22 O. G. 1291; s. c. 13 Fed. Rep. 464; *Brainard v. Cramme*, 22 O. G. 769; s. c. 12 Fed. Rep. 621; *Searles v. Bouton*, 12 Fed. Rep. 874; *Searles v. Bouton*, 22 O. G. 946; *Washburn & M. Manuf. Co. v. Fuchs*, 16 Fed. Rep. 661; *Ives v. Sargent*, 17 Fed. Rep. 447; *McKay v. Stowe*, 17 Fed. Rep. 516.

If an objection is made to a claim and the patentee disclaims it in order to obtain his letters patent, a reissue setting up the claim is void. *Leggett v. Avery*, 101 U. S. 256; s. c. 17 O. G. 445; *Putnam v. Pinkham*, 4 Fed. Rep. 411; *Putnam v. Hutchinson*, 12 Fed. Rep. 187; s. c. 14 C. L. N. 289; *Edgerton v. F. & B. Manuf. Co.*, 21 O. G. 251; s. c. 10 Biss. 402; s. c. 9 Fed. Rep. 450.

A patentee can not obtain a reissue so as to embrace a feature which he discarded in his original application, although he was the first inventor. *Streit v. Lauter*, 11 Fed. Rep. 309.

Although a claim in the application for the original patent was rejected, yet it may be inserted in the reissue. *Kells v. McKenzie*, 20 O. G. 1663; s. c. 9 Fed. Rep. 284.

Power is conferred upon the commissioner to allow the specification to be amended if the patent is inoperative or invalid, and, in that event, to issue the patent in proper form. And he may, under that authority, allow the patentee to redescribe his invention, and to include in the description and claims of the patent not only what was well described before, but whatever else was suggested or substantially indicated in the specifica-

tions, model or drawings which properly belong to the invention as actually made and perfected. *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Morris v. Royer*, 3 Fish. 176; s. c. 2 Bond 66; *Parham v. Sewing Machine Co.*, 4 Fish. 468; *Decker v. Grote*, 6 Fish. 143; s. c. 10 Blatch. 331; 3 O. G. 65; *Dorsey Co. v. Marsh*, 6 Fish. 387; s. c. 9 Phila. 395; *Black v. Thorne*, 5 Fish. 550; s. c. 10 Blatch. 66; 2 O. G. 388; *Westinghouse v. G. & R. Brake Co.*, 9 O. G. 538; s. c. 2 Ban & Ard. 55; *Woodward v. Dinsmore*, 4 Fish. 163; *Sarven v. Hall*, 5 Blatch. 415; s. c. 9 Blatch. 524; 1 O. G. 437; *Washing Machine Co. v. Lincoln*, 4 Fish. 379; *Bliss v. Gaylord Manuf. Co.*, 7 Blatch. 279; *Swift v. Whisen*, 3 Fish. 343; s. c. 2 Bond 115; *Wells v. Jacques*, 5 O. G. 364; s. c. 1 Ban & Ard. 60; *Nat'l Spring Co. v. Union Car Spring Manuf. Co.*, 12 Blatch. 180; s. c. 2 O. G. 224; s. c. 1 Ban & Ard. 240; *Chicago Fruit House Co. v. Busch*, 4 Fish. 395; s. c. 2 Biss. 472; *Bantz v. Elsas*, 6 O. G. 17; s. c. 1 Ban & Ard. 351; *Penn Salt Co. v. Thomas*, 5 Fish. 148; s. c. 3 Phila. 144; *Union Paper Collar Co. v. Leland*, 1 Holmes 427; s. c. 7 O. G. 221; s. c. 1 Ban & Ard. 491; *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; *Wilson v. Coon*, 19 O. G. 482; s. c. 18 Blatch. 532; s. c. 6 Fed. Rep. 611; *American D. R. B. Co. v. Sheldon*, 17 Blatch. 208; s. c. 4 Ban & Ard. 551; *Wells v. Gill*, 1 Ban & Ard. 77.

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

A reissue will not be declared void on the ground that it is not for the same invention as the original patent, if such a result can be avoided by a liberal application of the maxim that letters patent are to receive a liberal construction, and, if practicable, to be so interpreted as to uphold and not destroy the right of the inventor. *Glue Co. v. Upton*, 97 U. S. 3; s. c. 6 O. G. 837; s. c. 4 Cliff. 237; s. c. 1 Ban & Ard. 497.

Mere verbal discrepancies are entitled to but little consideration, especially where there is substantial accordance between the original and reissued patents. *Dorsey Co. v. Marsh*, 6 Fish. 387; s. c. 9 Phila. 395; *Tarr v. Folsom*, 1 Holmes 312; s. c. 5 O. G. 92; s. c. 1 Ban & Ard. 24; *Jordan v. Dobson*, 4 Fish. 232; s. c. 2 Abb. U. S. 398; 7 Phila. 533; *Wells v. Jacques*, 5 O. G. 364; s. c. 1 Ban & Ard. 60; *Dental Vulcanite Co. v. Wetherbee*, 3 Fish. 87; s. c. 2 Cliff. 555; *Wonson v. Peterson*, 13 O. G. 548; s. c. 3 Ban & Ard. 249.

Variations from the description given in the former specification do not necessarily imply that it is for a different discovery. The right to surrender the old patent and receive another in its place was given for the purpose of enabling the patentee to give a more perfect description of his invention, when any mistake or oversight was committed in his first. It necessarily, therefore, varies from it. *La Baw v. Hawkins*, 6 O. G. 724; s. c. 1 Ban & Ard. 428; *O'Reilly v. Morse*, 15 How. 62; *Smith v. G. D. & Co.*, 93 U. S. 486; s. c. 1 Holmes 354; 5 O. G. 585; 11 O. G. 246; s. c. 1 Ban & Ard. 201; s. c. 4 A. L. T. (N. S.) 74; *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530; *Parham v. Sewing Machine Co.*, 4 Fish. 468; *Hussey v. McCormick*, 1 Fish. 569; s. c. 1 Biss. 300; *Carey v. Boston Elastic Fabric Co.*, 5 Fish. 90; s. c. 1 Holmes 45; 1 O. G. 91; s. c. 3 Cliff. 336; *Poppenhusen v. Falke*, 2 Fish. 213; *Aultman v. Holley*, 6 Fish. 534; s. c. 11 Blatch. 317; 5 O. G. 3; *Crompton v. Belknap Mills*, 3 Fish. 536; *Pearl v. Ocean Mills*, 11 O. G. 2; s. c. 2 Ban & Ard. 469; *Blake v. Stafford*, 3 Fish. 294; s. c. 6 Blatch. 195; *Wells v. Jacques*, 5 O. G. 364; s. c. 1 Ban & Ard. 60; *Tucker v. Tucker Manuf. Co.*, 10 O. G. 464; s. c. 4 Cliff. 397; s. c. 2 Ban & Ard. 401; *Morse v. Bain*, 9 West. L. J. 106; *Glue Company v. Upton*, 97 U. S. 3; s. c. 6 O. G. 837; s. c. 4 Cliff. 237; s. c. 1 Ban & Ard. 497; *Putnam v. Yerrington*, 9 O. G. 689; s. c. 2 Ban & Ard. 237; *Stevens v. Pritchard*, 10 O. G. 505; *Lorillard Co. v. McDowell*, 11 O. G. 640; s. c. 34 Leg. Int. 78; 4 Pitts. L. J. 119; *Bridge v. Brown*, 1 Holmes 53; *Searles v. Van Nest*, 13 O. G. 772; s. c. 3 Ban & Ard. 121; *American D. R. B. Co. v. Sullivan M. Co.*, 14 Blatch. 119; s. c. 2 Ban & Ard. 522; *Atlantic G. P. Co. v. Rand*, 16 O. G. 87; s. c. 16 Blatch. 250; s. c. 4 Ban & Ard. 263; *St. Louis Stamping Co. v. Quimby*, 16 O. G. 135; s. c. 4 Ban & Ard. 192; *Thomas v. Shoe M. Manuf. Co.*, 16 O. G. 541; s. c. 3 Ban & Ard. 557; *Christman v. Rumsey*, 17 O. G. 903; s. c. 17 Blatch. 148; s. c. 38 How. Pr. 114; s. c. 4 Ban & Ard. 506; *Stephenson v. Second Ave. R. R. Co.*, 5 Ban & Ard. 116; s. c. 1 Fed. Rep. 416; *Tyler v. Welch*, 17 O. G. 1508; s. c. 18 Blatch. 209; s. c. 5 Ban & Ard. 11; s. c. 3 Fed. Rep. 636; *Wisner v. Dodd*, 5 Ban & Ard. 447; s. c. 2 Fed. Rep. 781; *Campbell v. James*, 18 O. G. 979; s. c. 17 Blatch. 43; s. c. 4 Ban & Ard. 456; *McCreary v. Penn. Canal Co.*, 5 Fed. Rep. 367; s. c. 37 Leg. Int. 447; *Washburn & M. Manuf. Co. v. Haish*, 19 O. G. 173; s. c. 10 Biss. 65; s. c. 4 Fed. Rep. 900; *Marks v. Fox*, 18 Blatch. 502; s. c. 6 Fed. Rep. 727; *Selden v. Stockwell S. L. G. B. Co.*, 20 O. G. 1737; s. c. 19 Blatch. 544; s. c. 9 Fed. Rep. 390; *Crandal v. Watters*, 21 O. G. 945; s. c. 9 Fed. Rep. 651; *Loercher v. Crandal*, 21 O. G. 863; s. c. 11 Fed. Rep. 872; *Strobridge v. Landers*, 21 O. G. 1027; s. c. 11 Fed. Rep. 880; *Searles v. Worden*, 21 O. G. 1955; s. c. 11 Fed. Rep. 501.

It is the right of the patentee and his representative to enlarge or restrict his claim, so as to give validity to the patent and secure the invention. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; *Morey v. Lockwood*, 8 Wall. 230; *Worswick Manuf. Co. v. Steiger*, 17 Fed. Rep. 250; *Yale Lock Manuf. Co. v. Berkshire Natl. Bank*, 17 Fed. Rep. 531.

Although the original patent is invalid, yet the scope thereof can not be enlarged upon a surrender to correct the mistake. *Sheriff v. Fulton*, 22 O. G. 87; s. c. 12 Fed. Rep. 136.

If the original specification does not describe a part as severable, but describes it as an inseparable part of an article, the reissue can not claim it either separately or in combination. *Blackman v. Hibbler*, 17 O. G. 107; s. c. 17 Blatch. 333; s. c. 4 Ban & Ard. 641; s. c. 25 I. R. R. 394.

If a patentee has limited his real invention by a misstatement of its principles, he may restate and if need be enlarge his specification so as to include the same invention which was plainly the subject of, but was not fully secured by the original patent. *Yale Lock Manuf. Co. v. Scovill Manuf. Co.*, 18 Blatch. 248; s. c. 5 Ban & Ard. 519; s. c. 3 Fed. Rep. 288.

A claim can be enlarged in a reissue only when an actual mistake has occurred, not from a mere error of judgment, but a real *bona fide* mistake inadvertently committed, such as a court of chancery in cases within its ordinary jurisdiction would correct. *Miller v. Brass Co.*, 21 O. G. 201; s. c. 104 U. S. 350; s. c. 12 O. G. 667; s. c. 14 Blatch. 282; s. c. 3 Ban & Ard. 20.

If the invention in the original patent and the reissue are the same, no departure however wide in the reissue concerning the mode of applying the invention or the subjects to which it is to be applied will invalidate it. *De Florez v. Reynolds*, 14 Blatch. 505; s. c. 3 Ban & Ard. 292.

A reissue is valid although it states several modes in which an apparatus may be made operative while the original patent only stated one mode. *Broadnax v. Cent. S. Y. & T. Co.*, 5 Ban & Ard. 609; s. c. 4 Fed. Rep. 214.

A reissue may change the form of the construction of the machine and substitute a well-known equivalent for one of the parts. *Putnam v. Hutchinson*, 12 Fed. Rep. 131.

If the form is not the essential feature of the invention, but may be greatly modified without altering the essential characteristics of the invention, the reissue may change the form. *Abbe v. Clark*, 13 O. G. 274; s. c. 3 Ban & Ard. 211.

New matter must not be introduced in a reissue. By new matter is not meant merely the introduction of a new ingredient in a patented composition, but any change in the original specification and claim whereby a new and substantially different composition and results are secured. *U. S. Felting Co. v. Haven*, 3 Dillon 131; s. c. 9 O. G. 253; s. c. 2 Ban & Ard. 164.

A reissue can not be declared void on the ground that new matter has been introduced, unless that fact clearly appears. *Dederick v. Cassell*, 20 O. G. 1233; s. c. 9 Fed. Rep. 306.

Whether the reissue is for the same invention as the original patent can not be determined from a comparison thereof without the model. *Hendy v. Golden S. & M. I. Works*, 8 Saw. 468.

The fact that the specification gives less prominence to some terms of

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

A specification may be defective, not only in omitting to give a full description of the mode of constructing a machine, but also in omitting to describe fully in the claim the nature, extent and character of the invention, and the latter defect may be amended as well as the former. *Carver v. Braintree Manuf. Co.*, 2 Story 432; s. c. 2 Robb 141.

A reissue can not be sustained by reference to an application that was pending when the original patent was granted. *Washburn & M. Manuf. Co. v. Fuchs*, 16 Fed. Rep. 661.

If there is any doubt as to the construction of the language in a reissued patent, the construction may be aided by reference to the original patent. *Ely v. Monson Manuf. Co.*, 4 Fish. 64; *Sutro v. Moll*, 19 Blatch. 89; s. c. 8 Fed. Rep. 919.

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

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

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

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

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

Whether the defect vitiated the original patent is immaterial, for it does not affect the rights under the new patent, even if the first patent were void. *Stimpson v. Westchester R. R. Co.*, 4 How. 380 ; s. c. 2 Robb 335.

The patentee can not embrace in his reissued patent any patentable improvements not described, suggested or indicated in the application, or model, or specification, or drawings. Such additions made to the specifications are interpolations and not amendments, and consequently the commissioner has no authority to allow them to be made. Although the invention as originally made did as a matter of fact embrace those devices, yet they can not be added. The commissioner has no authority except in certain special cases to hear parol proof as to what the invention was, and allow the applicant to amend his specification and claim so as to include them, and if he does, his decision will not be conclusive, for the decision of the commissioner is not conclusive as to his own jurisdiction. *Sickles v. Evans*, 2 Fish. 417 ; s. c. 2 Cliff. 203 ; *Seymour v. Osborne*, 5 Fish. 555 ; s. c. 11 Wall. 516 ; *Carhart v. Austin*, 2 Fish. 543 ; s. c. 2 Cliff. 528 ; *Knight v. Railroad Co.*, 2 Fish. 1 ; s. c. Taney 106 ; *Hoffheims v. Brandt*, 3 Fish. 218 ; *Sarven v. Hall*, 5 Fish. 415 ; s. c. 9 Blatch. 524 ; 1 O. G. 437 ; *Kirby v. Dodge Manuf. Co.*, 6 Fish. 156 ; s. c. 10 Blatch. 307 ; 3 O. G. 181 ; *Adjustable Window Screen Co. v. Boughton*, 1 Ban & Ard. 327 ; *Gill v. Wells*, 22 Wall. 1 ; s. c. 6 O. G. 881 ; 2 A. L. T. (N. S.) 181 ; *Covell v. Pratt*, 18 O. G. 301 ; s. c. 18 Blatch. 126 ; s. c. 5 Ban & Ard. 380 ; s. c. 2 Fed. Rep. 359 ; *vide Hussey v. Bradley*, 2 Fish. 362 ; s. c. 5 Blatch. 134 ; *Allen v. Blunt*, 3 Story 742 ; s. c. 2 Robb 288.

A patentee may state new results in the reissue without subjecting himself to the imputation of incorporating new matter, for he is entitled to all the uses to which his patent may be applied, and to all the beneficial results which legitimately follow the use of his instrumentalities. *Putnam v. Yerrington*, 9 O. G. 689 ; s. c. 2 Ban & Ard. 237.

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

A reissue may claim a feature shown in the original model, though not specifically claimed in the specification. *Calkins v. Bertraud*, 6 Biss. 494 ; s. c. 9 O. G. 795 ; s. c. 2 Ban & Ard. 215 ; *Meyer v. Goodyear I. G. Manuf. Co.*, 22 O. G. 681 ; s. c. 11 Fed. Rep. 891 ; *Crandal v. Watters*, 21 O. G. 945 ; s. c. 9 Fed. Rep. 659 ; *Reissner v. Anness*, 13 O. G. 870 ; s. c. 3 Ban & Ard. 176.

If the patentee described a thing in the specification, he may claim it in the reissue. *Flint v. Roberts*, 4 Ban & Ard. 168 ; *Atwood v. Portland Co.*, 5 Ban & Ard. 533 ; s. c. 10 Fed. Rep. 283.

A drawing may be changed in a matter that does not affect the claim. *Pearl v. Appleton Co.*, 5 Ban & Ard. 553 ; s. c. 3 Fed. Rep. 153.

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

2 Ban & Ard. 229; *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 language of the claim may be changed if the change conforms to the drawing in the original patent. *Booth v. Parks*, 1 Flippin 381; s. c. 1 Ban & Ard. 225.

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

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

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

A part of the original invention may be omitted in the reissued patent, for there is nothing in the policy or terms of the patent act which forbids it. *Dorsey Co. v. Marsh*, 6 Fish. 387; s. c. 9 Phila. 395; *Carver v. Braintree Manuf. Co.*, 1 Story 432; s. c. 2 Robb 141; *Boomer v. Power Co.*, 13 Blatch. 107; *Knight v. Railroad Co.*, 3 Fish. 1; s. c. Taney 106; *Chicago Fruit House Co. v. Ba.*, 4 Fish. 395; s. c. 2 Biss. 472; *Parham v. Sewing Machine Co.*, 4 Fish. 468; *Williams Manuf. Co. v. Blundel*, 22 O. G. 177; s. c. 11 Fed. Rep. 411; *Albright v. Cel. T. H. Co.*, 12 O. G. 227; s. c. 2 Ban & Ard. 629.

If an expression in a claim is not consistent with the other words in the specification which describe the properties and functions of the ingredients in the composition, it may be omitted in the reissue. *Atlantic Giant Powder Co. v. Goodyear*, 12 O. G. 45; s. c. 3 Ban & Ard. 161.

A reissue may omit some of the features mentioned in the original patent if such omission will not enlarge the operation of the thing patented. *Gould v. Randall*, 10 Fish. 1081; s. c. 3 Ban & Ard. 324.

A certificate of the master of the vessel does not conclude the defendant, but he may show that the vessel has been changed. *Johnson v. Beard*, 8 O. G. 435; s. c. 2 Ba.

A drawing which is not indicated in the original specification may be added in the reissue. *Paper Bag Co. v. Nixon*, 6 Fish. 402; s. c. 4 O. G. 129; *A. L. T.* 129.

Although the court may receive evidence when there is neither model nor drawing, the power to grant a reissue is restricted to the granting of a reissue of the same invention. *Powder Co. v. Powder Works*, 98 U. S. 126; s. c. 1 O. G. 289; s. c. 2 Saw. 448; s. c. 2 Ban & Ard. 131.

Although there is no model or drawing, yet a reissue can not be granted

for an invention not shown in the original patent upon proof that the addition was really a part of the original invention. *Averill C. P. Co. v. Nat'l M. P. Co.*, 22 O. G. 585; s. c. 9 Fed. Rep. 462.

If the original patent is for a machine, the reissue can not claim a process, although the process was described in the original specification. *Wing v. Anthony*, 106 U. S. 142; *New v. Warren*, 22 O. G. 587; *cont. v.* *Clark v. Kennedy Manuf. Co.*, 11 O. G. 68; s. c. 14 Blatch. 79; s. c. 2 Ban & Ard. 479.

If the original patent is for a process it may be reissued in two parts, one for the process and the other for the product. *Tucker v. Dana*, 7 Fed. Rep. 213.

If the original patent is for a process, a reissue may embrace the process and the product. *Merrill v. Yeomans*, 1 Holmes 331; s. c. 5 O. G. 267; 11 O. G. 970; s. c. 94 U. S. 568; s. c. 1 Ban & Ard. 47.

If the invention of a process does not involve the invention of a compound and the patent therefor is not a patent for making the compound and does not describe it, a reissue for the compound is void. *Powder Co. v. Powder Works*, 98 U. S. 126; s. c. 15 O. G. 289; s. c. 2 Saw. 448; s. c. 2 Ban & Ard. 131.

If the original specification and drawings show that some definite result is accomplished by the action of a sub-combination, the reissue may claim such sub-combination, although it was not claimed in the original. *Gage v. Herring*, 23 O. G. 2119; s. c. 14 Blatch. 293; s. c. 12 O. G. 753; s. c. 3 Ban & Ard. 55; *Kerosene Lamp Heater Co. v. Littell*, 13 O. G. 1009; s. c. 3 Ban & Ard. 312; *Christman v. Rumsey*, 17 O. G. 903; s. c. 17 Blatch. 148; s. c. 38 How. Pr. 114; s. c. 4 Ban & Ard. 506; *Dederich v. Cassell*, 20 O. G. 1233; s. c. 9 Fed. Rep. 306; *Turrell v. Spaeth*, 14 O. G. 377; s. c. 3 Ban & Ard. 458.

If a patentee takes a patent for a combination, he can not obtain a reissue containing claims for the several parts of the combination, unless the application is made within a reasonable time. *Bantz v. Frantz*, 105 U. S. 160; s. c. 21 O. G. 2037.

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

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

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

An inventor who has omitted to claim separate new devices or severable and distinct combinations in the original patent, may make a sur-

render and take a reissue for the distinct combinations or separate devices. *Wheeler v. Clipper Co.*, 6 Fish. 1; s. c. 10 Blatch. 181; 2 O. G. 442; *Cochrane v. Deener*, 11 O. G. 637; s. c. 94 U. S. 780.

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

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

When the inventor in the specification of the original patent, describes a new and useful combination of a number of elements performing in combination certain functions less than he has claimed, he may, in the reissue, claim such combination of the less number which he has described, suggested, or substantially indicated as his invention, but failed to include in his claims. *Pearl v. Ocean Mills*, 11 O. G. 2; s. c. 2 Ban & Ard. 469.

If a patentee who has taken out a patent merely for a combination of all the elements of the machine, without any suggestion, indication or intimation that any other invention of any kind has been made, subsequently discovers that he can accomplish a new and useful result by a combination embracing less than the whole number of the elements included in his patent, he can not secure his right to this subsequent invention by a surrender of the first patent, and a reissue which includes the second combination as well as the first. *Gill v. Wells*, 22 Wall. 1; s. c. 6 O. G. 881; 2 A. L. T. (N. S.) 101; *Miller v. Brass Company*, 104 U. S. 350; s. c. 21 O. G. 201; s. c. 12 O. G. 667; s. c. 14 Blatch. 282; s. c. 3 Ban & Ard. 20; *Cammeyer v. Newton*, 16 O. G. 720; s. c. 4 Ban & Ard. 139; *Blackman v. Hibbler*, 17 Blatch. 333; s. c. 17 O. G. 107; s. c. 4 Ban & Ard. 641; *Washburn & M. Manuf. Co. v. Fuchs*, 16 Fed. Rep. 661; *Fay v. Preble*, 14 Fed. Rep. 652; s. c. 15 C. L. N. 122.

A patentee can not surrender a patent for an invention consisting of a combination of old elements, and amend the descriptive parts of the specification by striking out the entire description of one of the elements of the combination and inserting in lieu thereof a full description of several other devices, without any allegation that they are the equivalents of the one whose description is stricken out, or any explanation whatever showing the reason why the change was made. *Gill v. Wells*, 22 Wall. 1; s. c. 6 O. G. 881; 2 A. L. T. (N. S.) 101.

A patentee, when he surrenders an original patent, can not amend the specification by striking out from the original the correct description of one of the ingredients of the patented combination, and substituting in its place the description of other devices not well known at the date of the original patent, as a proper substitute for the ingredient whose descrip-

tion is stricken out. *Gill v. Wells*, 22 Wall. 1; s. c. 6 O. G. 881; 2 A. L. T. (N. S.) 101.

If the original patent specified a certain material, a reissue may specify the equivalents for it. *Dunbar v. White*, 23 O. G. 1446; s. c. 15 Fed. Rep. 747.

If the claims are for separate and distinct improvements, separate patents may be granted upon the reissue. *Bennett v. Fowler*, 8 Wall. 445; *Brown v. Deere*, 19 O. G. 361; s. c. 6 Fed. Rep. 484.

A new product or manufacture, and a new process or method of producing the new article, are the proper subjects of separate and distinct claims in an original patent, and if the claims are not so made, the patentee upon a return of the patent for correction and reissue, may have several patents for the distinct and separate parts of his invention. *Goodyear v. Providence Rubber Co.*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; *Goodyear v. Wait*, 3 Fish. 242; s. c. 5 Blatch. 468; *Goodyear v. Honsinger*, 3 Fish. 147; s. c. 2 Biss. 1; *Penn Salt Co. v. Thomas*, 5 Fish. 148; s. c. 8 Phila. 144; *Anilin Fabrik v. Hamilton Manuf. Co.*, 13 O. G. 273; s. c. 3 Ban & Ard. 235; *Anilin Fabrik v. Higgin*, 15 Blatch. 290; s. c. 14 O. G. 414; s. c. 3 Ban & Ard. 462; *Tucker v. Burditt*, 4 Ban & Ard. 569.

If the patent does not relate to a machine, the specification may be made more definite and certain so as to embrace the claim made, or the claim may be so modified as to correspond with the specification, but this is the extent to which modifications can be made. *Powder Co. v. Powder Works*, 15 O. G. 289; s. c. 98 U. S. 126; s. c. 3 Saw. 448; s. c. 2 Ban & Ard. 131.

If the original invention was for a process in the use of an article, a reissue for a compound of the article with other substances is void. *Powder Co. v. Powder Works*, 15 O. G. 289; s. c. 98 U. S. 126; s. c. 3 Saw. 448; s. c. 2 Ban & Ard. 13.

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

not be in effect more than one deed for the whole lot. No more would be secured by the two patents than is authorized by law to be secured, or than could be secured by one. The two in effect would constitute but one. *Potter v. Holland*, 1 Fish. 327; s. c. 4 Blatch. 206.

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

If the original patent is not introduced in evidence, the question whether the reissued patent is for the same invention as the original patent can not be raised. *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Doherty v. Haynes*, 6 O. G. 118; s. c. 4 Cliff. 291; s. c. 1 Ban & Ard. 289; *Eureka v. Bailey Co.*, 11 Wall. 488; *Reedy v. Scott*, 23 Wall. 352; s. c. 7 O. G. 463; *Searles v. Bouton*, 21 O. G. 1784; s. c. 12 Fed. Rep. 140; *Consolidated O. W. P. Co. v. Eaton*, 12 Fed. Rep. 865; *Bickford v. Laporte*, 5 Ban & Ard. 349.

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

Matters of fact are not open in a suit for an infringement, as to whether the reissue is for the same invention as the original patent. The conclusion must always be in favor of the reissue, unless it appears upon a comparison of the two instruments that the reissue as a matter of legal construction is not for the same invention as the original. *Stevens v. Pritchard*, 10 O. G. 505; s. c. 4 Cliff. 417; s. c. 2 Ban & Ard. 396.

Whether the new patent granted upon the surrender of the old one is substantially for a different invention from the first one, is a question for the jury on the evidence. *Stimpson v. Westchester R. R. Co.*, 4 How. 380; s. c. 2 Robb 335; *Battin v. Taggart*, 17 How. 7; s. c. 2 Wall. Jr. 101; *Swift v. Whisen*, 3 Fish. 343; s. c. 2 Bond 115; *Morris v. Royer*, 3 Fish. 176; s. c. 2 Bond 66.

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

Although some of the claims in a reissue are void, yet the reissue may be valid as to other claims. *Starrett v. Athol Machine Co.*, 23 O. G. 1729; s. c. 14 Fed. Rep. 910; *Gould v. Spicer*, 15 Fed. Rep. 344; *Gold & S. T. Co. v. Wiley*, 17 Fed. Rep. 234; *Cote v. Moffitt*, 15 Fed. Rep. 345; *Wood v. Packer*, 17 Fed. Rep. 650; *National P. C. Co. v. Gunnison*, 17 Fed. Rep. 812; *Fetter v. Newhall*, 17 Fed. Rep. 841; s. c. 25 O. G. 502.

Fraud.

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

Very clear and decisive evidence is required in order to invalidate a patent upon an allegation of fraud in the reissue. *Swift v. Whisen*, 3 Fish. 343; s. c. 1 Bond 115; *Jordan v. Dobson*, 4 Fish. 232; s. c. 2 Abb. U. S. 398; 7 Phila. 533.

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

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

Effect of Reissue.

The reissue must be considered as a continuation of the original patent, and the rights of the patentee are to be determined by the state of things as they existed at the time of the original application. The new patent and the proceedings on which it issues have relation to the original transaction. The time of the privilege still runs from the date of the original patent. The application may be considered as appended to the original application, and if the new patent is valid the law must be considered as satisfied, if the machine was not known or used before that application. *Grant v. Raymond*, 6 Pet. 218; s. c. 1 Robb 604; *Shaw v. Cooper*, 7 Pet. 292; *Read v. Bowman*, 2 Wall. 591; *Crompton v. Belknap Mills*, 3 Fish. 536.

When a patent is surrendered, and new letters are taken out with an amended specification, the patent is considered to operate from the commencement of the original term, except as to suits for violations committed before the amendment. The amendment is not because the former patent or specification was utterly void, but because it was defective or doubtful in some particular which it was expedient to make more clear. But it is still a patent for the same invention. It can by law include no new one, and it covers only the same term of time which the former patent and its extensions did. The new letters relate back to the commencement of the original term, and for many purposes operate from that time. This is in strict analogy to amended writs and amended judgments, which for most purposes have the same effect as if the amended matter was in

them originally. *Woodworth v. Hall*, 1 Wood & M. 248, 389; s. c. 2 Robb 495, 517; *Grant v. Raymond*, 6 Pet. 218; s. c. 1 Robb 604; *Stanley v. Whipple*, 2 McLean 35; s. c. 2 Robb 1; *Smith v. Pearce*, 2 McLean 176; s. c. 2 Robb 13; *House v. Young*, 3 Fish. 335.

In law, a reissued patent is generally considered, except in respect to infringements prior to its issue, as if granted at the date of the original patent; and the corrected patent, in respect to all subsequent infringements, is made to take effect as though it had been so issued originally, even though the original patent was invalid. *Hussey v. Bradley*, 2 Fish. 362; s. c. 5 Blatch. 134; *Stanley v. Whipple*, 2 McLean 35; s. c. 2 Robb 1; *Grant v. Raymond*, 6 Pet. 218; s. c. 1 Robb 604.

Clerical amendments of letters patent relate back to the date of the letters patent, as much as any like clerical amendments of declarations or pleas or judgments. *Woodworth v. Hall*, 1 Wood & M. 389; s. c. 2 Robb 517.

No prior use under the defective patent can authorize the use of the invention after the issuing of the renewed patent. Any person using an invention protected by a renewed patent is guilty of an infringement, however long he may have used the same after the date of the defective and surrendered patent. *Stimpson v. Westchester R. R. Co.*, 4 How. 380; s. c. 2 Robb 335; *Carr v. Rice*, 1 Fish. 198; *Hussey v. Bradley*, 2 Fish. 362; s. c. 5 Blatch. 134; *Bliss v. Brooklyn*, 4 Fish. 596; s. c. 8 Blatch. 533; *Howe v. Williams*, 2 Fish. 395; s. c. 2 Cliff. 245; *Grant v. Raymond*, 6 Pet. 218; s. c. 1 Robb 604; *Bloomer v. Stolley*, 5 McLean 158; *Agawam Co. v. Jordan*, 7 Wall. 583; *McWilliams Manuf. Co. v. Blundell*, 22 O. G. 177; s. c. 11 Fed. Rep. 419.

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

When letters patent are amended in a material mistake, they can only operate as to third persons for causes accruing after the correction. It may be different if the mistake is entirely clerical. *Woodworth v. Hall*, 1 Wood & M. 248, 389; s. c. 2 Robb 495, 517; *Brown v. Hinkley*, 6 Fish. 370; s. c. 3 O. G. 384.

A surrender of the patent to the commissioner within the sense of the provision means an act which in judgment of law extinguishes the patent. It is a legal cancellation of it, and hence it can no more be the foundation for the assertion of a right after the surrender, than an act of Congress which has been repealed. The antecedent suits depend upon the patent existing at the time they were commenced, and unless it exists and is in force at the time of trial and judgment, the suits fall. *Moffit v. Gaar*, 1 Fish. 610; s. c. 1 Black. 273; 1 Bond 315; *Eddy v. Dennis*, 95 U. S. 560; s. c. 4 Fish. 423.

A surrender after a final judgment or decree does not affect such judgment or decree. *Mevs v. Conover*, 11 O. G. 1111; s. c. 11 Blatch. 197; s. c. 6 Fish. 506.

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

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

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

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

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

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

An application for a reissue must point out the particular defects and show how and in what manner the patent is thereby rendered inoperative and invalid. *Pfaunder*, 23 O. G. 269.

An application for a reissue must specifically point out the defects in the patent. A mere expression of opinion is not sufficient. *Timken*, 24 O. G. 1089.

A statement that the error arose from a misunderstanding or mistake of the attorney is not sufficient. *Wilkins*, 24 O. G. 1271.

An application for a reissue must show how the supposed errors arose. *Timken*, 24 O. G. 1089.

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

A stranger who has no application or patent that interferes with a patent, can not oppose the granting of a reissue. *New Process Fermentation Co.*, 23 O. G. 629.

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

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

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

Any claims may be justly embodied in a reissue which could have been allowed in the original application, although it enables the patentee to control devices which, though different in construction, are substantially the equivalents of the patented invention. *Bissell & Moore Manuf. Co.*, 2 Dec. Com. 157; *Borntraeger*, 16 O. G. 358.

If the original patent was taken out for a mechanical apparatus, the reissue can not claim a process. *Pfaunder*, 22 O. G. 1881.

Whether an application for a reissue is sufficient must be determined by the statements therein contained, without reference to the action on the merits in the case before the granting of the patent. *Timken*, 24 O. G. 1089.

A patentee may apply for a reissue although an interference is pending against the original patent, but when the reissue is granted it may be substituted in the interference in the place of the original patent. *Gay*, 19 O. G. 1496.

If the original patent shows four regenerators arranged in pairs and varied in size, the reissue may state the reason for the variance. *C. William Siemen*, 12 O. G. 626.

If a party in order to avoid an interference takes a claim out of an application and files a new application for this, and the patent therefor is first issued, he may on a reissue of the later patent claim a device shown in the original application, although it is shown in the patent first issued. *Kirby*, 16 O. G. 1095.

If a reissue does not refer to a specific claim, it is an abandonment of it, although it was referred to in the original patent. *McCormick*, 17 O. G. 267.

A reissue may indicate additional uses to which the invention may be put. *Palmer*, 17 O. G. 976.

Where one patent claims an improvement of an entire machine, and also shows without claiming a particular improvement of one of its parts, and a later patent claims only the particular improvement, matter which relates only to that part and which is shown in both, but not claimed in either of the patents, may be embraced in a reissue of a later patent. *Sylvanus D. Locke*, 16 O. G. 1149.

If a patentee makes a variation in the location of the parts, he is not entitled in a reissue to claim all the results that follow in the train of such a variation. *Nicholas Seibert*, 12 O. G. 268.

This clause does not authorize a radical departure from the original invention and the setting up in the reissue of a substantially different invention. No amount of proof regarding an entirely different invention, however satisfactory it may be in showing that the same was within the knowledge of the inventor at the time of applying for his original patent, could justify its introduction therein by a reissue. *A. Dreckerhoff*, 12 O. G. 429.

If the patentee never contemplated the use of a sub-combination without including an additional element, he can not claim the sub-combination in a reissue. *Redmond v. Parham*, 16 O. G. 359.

A reissue will not be granted if there has been unreasonable delay in applying for it. *Flynn*, 23 O. G. 2029.

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

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

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

It can not be objected to a claim in an application for reissue for the first time, that the specified invention has been abandoned since the date of the original patent, because not urged before, and having gone into extensive use. *Conklin & Stafford*, 2 O. G. 543.

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

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

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

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

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

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

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

If a patentee did not understand the philosophy of a feature in his machine at the time when he applied for a patent, he can not insert a claim for an art or method in a reissue. *Seibert*, 16 O. G. 262.

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

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

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

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

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

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

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

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

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

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

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

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

If a disclaimer was inserted by mistake or inadvertence, it may be withdrawn on the reissue. *Daniels v. Chesterman*, 13 O. G. 4.

An admission that another was a prior inventor may be shown to have been made by mistake. *Daniels v. Chesterman*, 13 O. G. 4.

If a party who invents one species before any other person invents either the genus itself or any of its species, obtains a patent only for the species, he may insert a claim for the genus in a reissue. *Ewart*, 17 O. G. 448.

A party who has obtained a patent with a specific claim may insert a generic claim in a reissue, although he abandoned a specific claim in order to get the patent. *Ewart*, 17 O. G. 448.

If the original patent is for a specific device, a reissue can not add another specific claim, although the original specification referred to a prior application in which it was contained. *McClintock*, 17 O. G. 267.

If the original patent contains a generic claim and a specific claim, the reissue can not insert another specific claim, although it was described in the original patent. *McCormick*, 17 O. G. 267.

A reissue which enlarges or expands a claim will not be allowed after an unreasonable delay. *Lee*, 23 O. G. 342.

Nothing but what was shown in the original specification, drawings, or model, can be introduced into a reissue. *W. C. Dodge*, 1 Dec. Com. 27; *Joseph Ridge, Assignor*, 1 Dec. Com. 46; *Willis Humiston*, 1 Dec. Com. 47; *Aberdeen Keith*, 2 Dec. Com. 69; *Galen Orr*, 2 Dec. Com. 113; *Wm. A. Lewis*, 3 Dec. Com. 82; *George E. Waring, Jr.*, 3 Dec. Com. 228; *Elisha Waters*, 8 O. G. 399; *Nehemiah T. Folsom*, 2 Dec. Com. 170; *Hicks*, 16 O. G. 546; *Fauck v. Doty*, 13 O. G. 322.

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

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

If there is a model and a drawing, no evidence outside of the record is admissible to prove the scope or detail of the original invention. *Stockwell v. Haines*, 12 O. G. 137.

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

If the original model shows a certain feature, the patentee may claim it in a reissue, although he did not understand the philosophy of its operation at the time he applied for a patent. *Seibert*, 16 O. G. 262.

If the claim sought to be inserted in a reissue is not described or referred to in the original specification, nor shown in the drawing, its existence in

model must be a matter of certainty and not merely of conjecture. *Stockwell v. Haines*, 12 O. G. 137.

If the specification describes the invention as shown in the drawing and the drawing contradicts the model, a reissue can not be granted for a feature shown in the model, but proved by the drawing not to be a part of the invention. *Hunt*, 15 O. G. 831.

If a part of a model which may be located in several ways is lost, the patentee will not be permitted to supply it and locate it in a particular way, whereby a certain result may be produced, except upon satisfactory proof that it was so located originally. *Nicholas Seibert*, 12 O. G. 268.

Secondary evidence of the form of the model is not competent, although it has been destroyed. *F. A. Williams*, 14 O. G. 202.

If a reissue has been granted for one division, the original patent is annulled and no subsequent application can be made for another division. *Whiteley & Gage*, 1 Dec. Com. 53; *Andrew Whiteley*, 1 Dec. Com. 70.

The several divisions of a reissue must be issued to the same party. They can not be issued to different parties. *Smith*, 16 O. G. 1233.

If more than one invention is claimed in an application for a reissue, a division may be required. *Lippincott*, 16 O. G. 632.

A patent may be issued for one division of a reissue application, and subsequently a patent may be issued for the remaining divisions. *Greaves*, 18 O. G. 623.

A patentee who has discovered that certain elements of a combination are capable of a more extended use than is disclosed in the patent, can not have a reissue in a division with a claim of these special parts for the general effects. *James Powell*, 13 O. G. 911.

If an applicant elects to divide his claims, he can reinstate the claim that has been eliminated when the other is rejected. *Preston*, 17 O. G. 853.

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

possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

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

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

When Patent Valid.

This section is intended to cover inadvertencies and mistakes of the law, as well as inadvertencies and mistakes of fact. *Wyeth v. Stone*, 1 Story 273; s. c. 2 Robb 23.

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

The patentee can not maintain an action unless the part invented can be clearly distinguished from that claimed but not invented. *Vance v. Campbell*, 1 Fish. 483; s. c. 1 Black. 427; *Runford Works v. Lauer*, 5 Fish. 615; s. c. 10 Blatch. 122; 3 O. G. 249; *Rice v. Garnhart*, 34 Wis. 453.

If the claim is for the whole machine, and the invention consists in an improvement, the invention will be good so far as it extends. *Peterson v. Wooden*, 3 McLean 248; s. c. 2 Robb 116; *Hotchkiss v. Oliver*, 5 Denio 314.

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

If a patentee makes a claim which is not well founded in the same patent with other claims which are well founded, he may disclaim within a reasonable time that which he had no right to claim, and then his patent will be good as to the residue, as good as if it had issued originally only for the claims which are valid. *Seymour v. McCormick*, 3 Blatch. 209; s. c. 19 How. 96; *Tuck v. Bramhill*, 3 Fish. 400; s. c. 6 Blatch. 95; *Taylor v. Archer*, 4 Fish. 449; s. c. 8 Blatch. 315; *Burdett v. Estey*, 15 O. G. 877; s. c. 15 Blatch. 349; s. c. 4 Ban & Ard. 7; *Schillinger v. Gunther*, 16 O. G. 905; s. c. 17 Blatch. 66; s. c. 4 Ban & Ard. 479.

If a reissue contains one claim that is void because it is broader than the invention claimed in the original patent, a disclaimer may be made as to the void claim. *Tyler v. Galloway*, 22 O. G. 3072; s. c. 12 Fed. Rep. 567.

If the invention that remains after a disclaimer is not a material part of the thing patented, then the patent is void. *Root v. E. N. Welch Manuf. Co.*, 17 Blatch. 478; s. c. 5 Ban & Ard. 189; s. c. 4 Fed. Rep. 423.

In connection with a disclaimer of a claim or part of a claim, a patentee may eliminate or withdraw those parts of the specification on which the disclaimed claim or part of the claim is founded. *Schillinger v. Gunther*, 16 O. G. 905; s. c. 17 Blatch. 66; s. c. 4 Ban & Ard. 479.

If the patentee omits to make a disclaimer, but brings a suit for a violation of his patent, and it satisfactorily appears upon the trial that he is entitled to be protected in a portion of the claims set up in his patent, but that he is not entitled to be protected in respect to another portion, he is still entitled to damages for the violation of the valid portion of his claims, the same as if all the claims were valid, so far as regards the mere right of recovery, but he gets no costs. *Seymour v. McCormick*, 3 Blatch. 209; s. c. 19 How. 96; *Burdett v. Estey*, 15 O. G. 877; s. c. 15 Blatch. 349; s. c. 4 Ban & Ard. 7; *Christman v. Rumsey*, 17 O. G. 903; s. c. 17 Blatch. 148; s. c. 38 How. Pr. 114; s. c. 4 Ban & Ard. 506; *vide Heinrich v. Luther*, 6 McLean 345.

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

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

After a disclaimer has been properly filed, the construction of the patent must be the same as it would be if the matter so disclaimed had never been included in the description of the invention or the claims of the specification. *Dunbar v. Myers*, 11 O. G. 35; s. c. 94 U. S. 187.

A new specification which is not completed by a surrender of the old one, can not be considered as a disclaimer. *Hovey v. Stevens*, 3 W. & M. 17; s. c. 2 Robb 567.

A disclaimer can not be used for the purpose of altering or reforming the description of an invention. *Hails v. Albany Stove Co.*, 16 Fed. Rep. 240.

A disclaimer can not enlarge the scope of the patent. *White v. E. P. G. Manuf. Co.*, 24 O. G. 205.

When Filed.

A disclaimer may be filed as well after as before the commencement of a suit. *Smith v. Nichols*, 6 Fish. 61; s. c. 21 Wall. 112; 1 Holmes 172; 2 O. G. 649; *O'Reilly v. Morse*, 15 How. 62; *Hall v. Wiles*, 2 Blatch. 194; *Silsby v. Foote*, 20 How. 378; s. c. 2 Blatch. 260; *Seymour v. McCormick*, 19 How. 96; s. c. 3 Blatch. 209; *Singer v. Walmsley*, 1 Fish. 558; *Tuck v. Bramhill*, 3 Fish. 400; s. c. 6 Blatch. 95; *Wyeth v. Stone*, 1 Story 273; s. c. 2 Robb 23; *Brooks v. Jenkins*, 3 McLean 432; *Gage v. Herring*, 21 O. G. 2119; s. c. 14 Blatch. 293; s. c. 12 O. G. 753; s. c. 3 Ban & Ard. 55; *vide Reed v. Cutter*, 1 Story 590; s. c. 2 Robb 81; *Parker v. Stiles*, 5 McLean 44.

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

A court of equity ought not to interfere to grant a perpetual injunction, whatever may be the right and remedy at law, unless a disclaimer has been in fact filed at the patent office before the suit is brought. The granting of such an injunction is a matter resting in the sound discretion of the court, and if the court should grant a perpetual injunction before any disclaimer is filed, it may be that the patentee may never afterwards, within a reasonable time, file any disclaimer. *Wyeth v. Stone*, 1 Story 273; s. c. 2 Robb 23.

There may be a decree for a perpetual injunction, each party to pay his own costs, without any actual previous disclaimer of record in the patent office. But the circuit courts will not make any decree beyond the perpetual injunction without an actual disclaimer previously recorded in the patent office. *Aiken v. Dolan*, 3 Fish. 197; *Myers v. Frame*, 4 Fish. 493; s. c. 8 Blatch. 446; *Atwater Manuf. Co. v. Beecher Manuf. Co.*, 8 Fed. Rep. 608.

Who may File.

If an assignee does not join with the patentee in a disclaimer, the disclaimer can not operate in favor of the assignee in any suit either at law or in equity. *Wyeth v. Stone*, 1 Story 273; s. c. 2 Robb 23; *Myers v. Frame*, 4 Fish. 493; s. c. 8 Blatch. 446.

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

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

If an administrator, in whose name a patent has been extended, expressly states that he is the patentee, and refers to the patent as showing

his interest, this is a sufficient statement of his interest. *Brooks v. Jenkins*, 3 McLean, 432.

Delay.

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

When the objectionable claim has been sanctioned by the commissioner of patents, and held to be valid by a circuit court, the patentee has a right to insist upon it, and not disclaim it until the highest court to which it can be carried has pronounced its judgment. Such delay is not unreasonable, and will not render the patent altogether void. *O'Reilly v. Morse*, 15 How. 62; *Seymour v. McCormick*, 19 How. 96; s. c. 3 Blatch. 209; *Potter v. Whitney*, 3 Fish. 77; s. c. 1 Lowell 87.

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

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

Whether the neglect or delay to enter a disclaimer is unreasonable is a mixed question of law and fact, and must be decided by the jury under the instructions of the court. *Brooks v. Jenkins*, 3 McLean 432; *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206; *Lippincott v. Kelley*, 1 West. L. J. 513.

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

suit and those deriving title under them subsequent to the rendition of such judgment.

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

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

The proceeding contemplated by this section is an ordinary proceeding in chancery. It is not a summary proceeding but an adversary proceeding, in which the party must file the usual bill in chancery and issue the subpoena required by chancery practice. *L. & M. Tobacco Co. v. Miller*, 17 O. G. 798; s. c. 1 McCrary 31; s. c. 5 Ban & Ard. 237; s. c. 1 Fed. Rep. 203.

In a proceeding under this section, the subpoena can not be served on parties who live out of the district where the suit is instituted. *L. & M. Tobacco Co. v. Miller*, 17 O. G. 798; s. c. 1 McCrary 31; s. c. 5 Ban & Ard. 237; s. c. 1 Fed. Rep. 203.

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

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

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

Two patents interfere within the meaning of this section when they claim the same invention in whole or in part. *Gold & Silver Ore Co. v. U. S. Ore Co.*, 3 Fish. 489; s. c. 6 Blatch. 307; *Gilmore v. Golay*, 3 Fish. 522; *Garratt v. Seibert*, 98 U. S. 75; s. c. 15 O. G. 383; *Putnam v. Hutchinson*, 12 Fed. Rep. 131.

If a person who stands by and acquiesces in the purchase of a patent, subsequently takes out a patent in his own name for the same invention, his patent may be declared void on a bill filed by the purchaser. *Natl. F. D. Co. v. Hibbard*, 21 O. G. 635; s. c. 9 Fed. Rep. 558.

A party is not entitled to any benefit under this section, unless the patents are for the same invention. An averment that the defendant claims an interference and denial of such claim does not authorize a suit as for an interference. *Celluloid Manuf. Co. v. Goodyear D. V. Co.*, 13 Blatch. 375; s. c. 10 O. G. 41; s. c. 2 Ban & Ard. 334.

The power of the circuit court in a case of interfering patents is not confined to the specific remedy pointed out by this section, but authorizes the granting of an injunction. The power conferred on the circuit courts to entertain bills in equity in controversies arising under the patent act is a general equity power, and carries with it all the incidents belonging to

that species of jurisdiction. The power conferred not only enables the court to decree a final remedy, but to take care that the subject of the controversy shall not be rendered valueless pending the litigation. *Potter v. Dixon*, 2 Fish. 381; s. c. 5 Blatch. 160.

Where both patents are void for want of novelty, the court may enter a decree declaring both patents void. *Foster v. Lindsay*, 3 Dillon 126; s. c. 7 O. G. 514; 8 O. G. 1032; s. c. 1 Ban & Ard. 605; s. c. 2 Ban & Ard. 172.

If the question of priority of invention has been already tried, that judgment is conclusive. *U. S. & F. S. F. Co. v. Asbestos Felting Co.*, 18 Blatch. 312; s. c. 19 O. G. 362; s. c. 5 Ban & Ard. 624; s. c. 4 Fed. Rep. 813.

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

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

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

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

Parties.

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

The patentee is entitled to recover at law, no matter what private agreement subsists between him and any other person or persons, unless he has made a legal assignment and transfer of his interest in the invention. *Park v. Little*, 3 Wash. C. C. 196; s. c. 1 Robb 17; *Blanchard v. Eldridge*, 1 Wall. Jr. 337; s. c. 2 Robb 737.

A licensee can not maintain an action in his own name. *Suydam v. Day*, 2 Blatch. 20; *Gayler v. Wilder*, 10 How. 477.

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

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

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

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

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

An assignee acquires his title to a patent with a right of action in his own name only by force of the statute. Such exclusive right of action exists in favor of a sole assignee only in two cases, namely, where he acquires by assignment the whole interest in a patent or a grant, or conveyance of the whole interest within some particular district or territory. *Suydam v. Day*, 2 Blatch. 20; *Tyler v. Tuel*, 6 Cranch 324; s. c. 1 Robb 14.

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

The grantee of the exclusive right to construct and use, and vend to others to be used, two patented machines within a certain town, can maintain an action for an infringement. Although limited to the use of two machines within the town, the right to use them is exclusive. No other party, not even the patentee, can use a right under the patent within the territory, without infringing the grant. *Wilson v. Rousseau*, 4 How. 646; s. c. 1 Blatch. 3; s. c. 2 Robb 373.

A suit for an infringement committed after the assignment was made and recorded must be in the name of the assignee. *Herbert v. Adams*, 4 Mason 15; s. c. 1 Robb 505.

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

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

The patentee and an assignee of a moiety may join in an action for an infringement. *Whittemore v. Cutter*, 1 Gallis. 429; s. c. 1 Robb 28.

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

The assignee of the patent and of a claim for damages may maintain an action at law in his own name to recover the damages. *Spring v. Domestic S. M. Co.*, 22 O. G. 1445; s. c. 13 Fed. Rep. 446.

Infringement.

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

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

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

It is not necessary that the defendant's machine should be an exact copy of the patentee's machine. All that is required is that the defendant's machine should be substantially like the patentee's machine. *Waterbury Brass Co. v. N. Y. Brass Co.*, 3 Fish. 43; *Greer v. Castle*, 24 O. G. 1176.

It is a familiar rule that to copy the principle or mode of operation described in the patent is an infringement, although such copy should be totally unlike the original in form or proportions. If it were not so, no question of infringement could arise. If the machine complained of were a copy in form of the machine described in the specification, it would be at once seen to be an infringement. It could be nothing else. It is only ingenious diversities of form and proportion, presenting the appearance of something unlike the thing patented, which give rise to questions. *Winans v. Denmead*, 15 How. 330.

So long as the patentee's ideas are found in the construction and arrangement, no matter what may be its form, or shape, or appearance, the party using it is appropriating his invention, and must be held to be an infringer. *Potter v. Wilson*, 2 Fish. 102; *Carter v. Baker*, 4 Fish. 404; s. c. 1 Saw. 512; *Decker v. Grote*, 6 Fish. 143; s. c. 10 Blatch. 331; 3 O. G. 65; *Decker v. Griffith*, 10 Blatch. 343, note; *Hyndman v. Roots*, 97 U. S. 224; s. c. 13 O. G. 868.

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

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

The word "substantial," as applied in actions for an infringement, is not susceptible of an exact definition. The law looks more to the substance of things than their forms. *Brooks v. Bicknell*, 3 McLean 250; s. c. 2 Robb 118.

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

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

The making of a machine fit for use, and with a design to use it for

profit, is an infringement of the patent right. *Whittemore v. Cutter*, 1 Gallis. 429; s. c. 1 Robb 28; *Bloomer v. Gilpin*, 4 Fish. 50.

The word "making" is equally as applicable to machines as to compositions of matter, and there is no difficulty in holding that the using or vending of a patented composition is a violation of the right of the proprietor. *Whittemore v. Cutter*, 1 Gallis. 429; s. c. 1 Robb 28.

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

The patent law was intended to secure to an inventor his whole invention or discovery, but not unless he claimed to be secured in the whole. If he claims only a part, or some particular form, such part or particular form only is secured to him. *Hawes v. Gage*, 5 O. G. 494; *Boston E. F. Co. v. Rubber Thread Co.*, 1 Holmes 372; s. c. 5 O. G. 696; s. c. 1 Ban & Ard. 222; *American Pin Co. v. Oakville Co.*, 3 Blatch. 190; *Bliss v. Haight*, 3 Fish. 621; s. c. 7 Blatch. 7; *Sickles v. Gloucester Manuf. Co.*, 1 Fish. 222; s. c. 3 Wall. Jr. 186; *Rich v. Close*, 4 Fish. 279; s. c. 8 Blatch. 41; *Many v. Sizer*, 1 Fish. 31; *Waterbury Brass Co. v. Miller*, 5 Fish. 48; s. c. 9 Blatch. 77; *How v. Williams*, 2 Fish. 395; s. c. 2 Cliff. 245; *Meissner v. Devoe Manuf. Co.*, 5 Fish. 285; s. c. 9 Blatch. 363; 2 O. G. 545; *Poppenhusen v. N. Y. G. P. Co.*, 4 Blatch. 253; *Smith v. Elliott*, 5 Fish. 315; s. c. 9 Blatch. 400; 1 O. G. 331; *Doughty v. West*, 2 Fish. 553; *Evarts v. Ford*, 6 Fish. 587; s. c. 5 O. G. 58; *Fuzzard Manuf. Co. v. Dickenson*, 3 Fish. 289; s. c. 6 Blatch. 80; *Consolidated Fruit Jar Co. v. Wright*, 12 Blatch. 149; s. c. 6 O. G. 327; s. c. 94 U. S. 92; s. c. 1 Ban & Ard. 320; *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; *Le Fever v. Remington*, 13 Fed. Rep. 86; *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S. 274; s. c. 12 O. G. 980; *Tinker v. W. E. M. & R. Manuf. Co.*, 5 Ban & Ard. 92; s. c. 1 Fed. Rep. 138; *Del. C. & I. Co. v. Packer*, 5 Ban & Ard. 296; s. c. 1 Fed. Rep. 851; *Knox v. Gt. Western Q. Mining Co.*, 6 Saw. 430; s. c. 4 Ban & Ard. 25; s. c. 4 Fed. Rep. 809.

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

It is not necessary to constitute an infringement that a man should work by the specification contained in the patent. He might not even know there was such a patent, and yet infringe it. *Matthews v. Skates*, 1 Fish. 602; *Parker v. Haworth*, 4 McLean 370; s. c. 2 Robb 725.

If the peculiar invention of the patentee is embodied in the defendant's machinery, however it may be combined with other machinery, it is appropriated the same as if it were used alone and separate from those connections. *Sickels v. Borden*, 3 Blatch. 535; *Johnson v. Root*, 1 Fish.

351; *Poppenhusen v. Falke*, 2 Fish. 181; s. c. 4 Blatch. 493; *Foster v. Moore*, 1 Curt. 279; *Pitts v. Wemple*, 6 McLean 558; *Hoffheins v. Brandt*, 3 Fish. 218; *Waterbury Brass Co. v. N. Y. Brass Co.*, 3 Fish. 43; *Howes v. Nute*, 4 Fish. 263; s. c. 4 Cliff. 173; *Mallory v. White*, 4 Fish. 628; s. c. 8 Blatch. 552; *Doughty v. Day*, 5 Fish. 224; s. c. 9 Blatch. 262; *Flint v. Roberts*, 4 Ban & Ard. 165.

An invasion of a patent by splitting the invention in two, and making two operations where only one is necessary, is an infringement. *Baldwin v. Bernard*, 5 Fish. 75; s. c. 9 Blatch. 509, *n.*; 2 O. G. 320.

Whoever erects or uses a patented machine does it at his peril. He takes upon himself all the chances of the patent being originally valid, or of its being afterwards made so by a surrender of it and the grant of a new patent which may cure any defects. *Ames v. Howard*, 1 Sum. 482; s. c. 1 Robb 689.

Infringement as Affected by Result.

Where the machines are substantially the same, and operate in the same manner to produce the same result, they must be in principle the same. The same result must be understood to mean the same kind of result, though there may be a difference in extent. The result is the same according to this definition whether one produces more than another or not, if the operation is to make the same article. *Gray v. James*, 1 Pet. C. C. 394; s. c. 1 Robb 120; *Imlay v. Railroad Co.*, 1 Fish. 340; s. c. 4 Blatch. 227.

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

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

The identity or the difference between two machines is sought, in the first place, by a comparison of them, either in their elements or as a system. *Wilson v. Baruum*, 2 Fish. 635; s. c. 1 Wall. Jr. 347; 8 How. 258; s. c. 1 Robb 749.

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

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

Slight differences in degree can not be regarded as of weight in determining a question of substantial similarity or substantial difference. One thing may be a little longer or a little shorter than another, or it may work

a little better or a little worse, and yet the two may be substantially the same. *Cahoon v. Ring*, 1 Fish. 397 ; s. c. 1 Cliff. 592.

Similarities or differences are not to be judged by the name of things, but the machines, or their several devices or elements, must be examined in the light of what they do, or what office or function they perform, and how they perform it. One thing is substantially the same as another if it perform substantially the same function or office in the same way to attain the same result, and things are substantially different when they perform different duties, or in a different way, or produce a different result. For the same reason similarities or differences are not determined by the mere fact that things are apparently the same, or of a different shape or form, but the true test of similarity or difference is the same in regard to shape or form as in regard to names. In both cases regard must be paid to the mode of operation, or the way the parts work, and the result as well as the means by which the result is attained. *Cahoon v. Ring*, 1 Fish. 397 ; s. c. 1 Cliff. 592 ; *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600 ; s. c. 3 Cliff. 639 ; *Machine Co. v. Murphy*, 97 U. S. 120 ; s. c. 13 O. G. 366 ; *Am. D. R. B. Co. v. Sheldon*, 17 Blatch. 208.

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

By the principles of a machine is not meant the original elementary principles of motion, which philosophy and science have discovered, but the *modus operandi*, the peculiar device or manner of producing any given effect. *Whittemore v. Cutter*, 1 Gallis. 478 ; s. c. 1 Robb 40.

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

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

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

The question is not which is best or is most perfect, but whether the one mode is an infringement of the rights secured by the other. *Howe v. Abbott*, 2 Story 190 ; s. c. 2 Robb 99 ; *Sickles v. Gloucester Manuf. Co.*, 1 Fish. 222 ; s. c. 3 Wall. Jr. 186 ; *Colt v. Mass. Arms Co.*, 1 Fish. 108 ; *Blanchard v. Beers*, 2 Blatch. 411 ; *Cox v. Griggs*, 2 Fish. 174 ; s. c. 1 Biss. 362 ; *Forbes v. Barstow Stove Co.*, 2 Cliff. 379 ; *Pitts v. Wemple*, 2 Fish. 10 ; s. c. 1 Biss. 87 ; *Yale Manuf. Co. v. North*, 3 Fish. 279 ; s. c. 5 Blatch. 455 ; *Alden v. Dewey*, 1 Story 336 ; s. c. 2 Robb 17 ; *Carter v. Baker*, 4 Fish. 404 ; s. c. 1 Saw. 512 ; *McComb v. Brodie*, 5 Fish. 384 ; s. c. 1 Woods 153 ; 2 O. G. 117 ; *Imlay v. Railroad Co.*, 1 Fish. 340 ; s. c.

4 Blatch. 227; *Wheeler v. Clipper Co.*, 6 Fish. 1; s. c. 10 Blatch. 181; 2 O. G. 442; *Adams v. Joliet Manuf. Co.*, 12 O. G. 91; s. c. 3 Ban & Ard. 1.

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

It is no defence that the result is not as good, if it is substantially the same in kind, and is produced substantially by the same means: *Roberts v. Harnden*, 2 Cliff. 500.

The superiority of the defendant's machine over that of the patentee is immaterial, except so far as it goes to show a substantial difference between them. *Alden v. Dewey*, 1 Story 336; s. c. 2 Robb 17.

Two things are not the same when one is in practice substantially better than the other, if the second improvement is not gained by the use of the same means or known mechanical equivalents. *Mitchell v. Tilghman*, 4 Fish. 599; s. c. 19 Wall. 287; 5 O. G. 299; s. c. 9 Blatch. 1; s. c. 2 Fish. 518.

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

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

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

The greater utility, which may be regarded as evidence tending to show that some new principle or mechanical power or mode of operation producing a new kind of result has been introduced, must be derived from the changes introduced, and not from the use of better material or greater skill or care in the manufacture. *Many v. Sizer*, 1 Fish. 17; *Trader v. Messmore*, 7 O. G. 385; s. c. 1 Ban & Ard. 639.

If the practical operation and effect of two machines is essentially different, the law looks more to the result of the mechanical arrangement

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

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

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

If the patent embraces one or more elements of a machine, but not the entire machine, any person may make, use or vend all other parts of the machine, and may employ an element analogous to that which is patented, provided it is substantially different. *Union Sugar Refinery v. Matthiesen*, 2 Fish. 600; s. c. 3 Cliff. 639.

Formal Change.

A patentee is not confined to the precise arrangement in the construction of his machine which he has described in his patent. Formal changes are nothing; mere mechanical changes are nothing; all these may be made outside of the description to be found in the patent, and yet the machine after it has been thus changed in its construction is still the machine of the patentee, because it contains his invention, the fruits of his mind, and embodies the discovery which he has brought into existence and put into practical operation. *Le Roy v. Tatham*, 2 Blatch. 474; s. c. 14 How. 156; *Sargent v. Larned*, 2 Curt. 340; *Brooks v. Jenkins*, 3 McLean 432; *Cox v. Griggs*, 2 Fish. 174; s. c. 1 Biss. 362; *Taylor v. Archer*, 4 Fish. 449; s. c. 8 Blatch. 315; *Blanchard's Factory v. Warner*, 1 Blatch. 258; *Stanley v. Whipple*, 2 McLean 35; s. c. 2 Robb 1; *Jurgensen v.*

Magnin, 5 Fish. 237; s. c. 9 Blatch. 294; *Buck v. Hermance*, 1 Blatch. 398; *Bantz v. Elsas*, 6 O. G. 117; s. c. 1 Ban & Ard. 351; *Odiorne v. Winkley*, 2 Gallis. 51; s. c. 1 Robb 52; *Imlay v. Railroad Co.*, 1 Fish. 340; s. c. 4 Blatch. 227; *Mowry v. Whitney*, 3 Fish. 157; s. c. 4 Fish. 141, 207; 5 Fish. 496; 14 Wall. 620; 2 Bond 45; s. c. 1 O. G. 492; *Good-year Dental Co. v. Gardner*, 4 Fish. 224; s. c. 3 Cliff. 408; *Cook v. Howard*, 4 Fish. 269; *Woodpaper Co. v. Glens Falls Co.*, 4 Fish. 324; s. c. 8 Blatch. 513; *Eddy v. Dennis*, 95 U. S. 560; s. c. 4 Fish. 423; *Hoffman v. Aronson*, 4 Fish. 456; s. c. 8 Blatch. 324; 4 A. L. T. (N. S.) 110.

A change in form from the construction of an existing machine is not a substantial change in the eye of the patent law, nor is a change in proportions. These changes require no great ingenuity; at all events, they do not call for the exercise of the inventive faculties. They are simply the work of a mechanic of ordinary skill, and are entitled to no particular consideration on an inquiry to the question of identity between the construction of two machines. *Le Roy v. Tatham*, 2 Blatch. 474; s. c. 14 How. 156; *Many v. Jagger*, 1 Blatch. 372; *O'Reilly v. Morse*, 15 How. 62; *Gray v. James*, 1 Pet. C. C. 394; s. c. 1 Robb 120; *Case v. Brown*, 2 Fish. 268; s. c. 2 Wall. 320; 1 Biss. 382; *Lowell v. Lewis*, 1 Mason 182; s. c. 1 Robb 131; *Singer v. Walmsley*, 1 Fish. 558; *Myers v. Frame*, 4 Fish. 493; s. c. 8 Blatch. 446; *Smith v. Downing*, 1 Fish. 64; *Park v. Little*, 3 Wash. C. C. 196; s. c. 1 Robb 17; *Reutgen v. Kanowrs*, 1 Wash. C. C. 168; s. c. 1 Robb 1; *Dixon v. Moyer*, 4 Wash. C. C. 68; s. c. 1 Robb 324; *Brooks v. Bicknell*, 3 McLean 250; s. c. 2 Robb 118; *Judson v. Cope*, 1 Fish. 615; s. c. 1 Bond 327; *Brooks v. Jenkins*, 3 McLean 432; *Wilbur v. Beecher*, 2 Blatch. 132; *Parker v. Stiles*, 5 McLean 44; *Gibson v. Harris*, 1 Blatch. 167; *Davis v. Palmer*, 2 Brock. 298; s. c. 1 Robb 518; *Hussey v. McCormick*, 1 Fish. 509; s. c. 1 Biss. 300; *Johnson v. Root*, 1 Fish. 351; *Morey v. Lockwood*, 8 Wall. 230; *Whiteley v. Kirby*, 11 Wall. 678; *Cahoon v. Ring*, 1 Fish. 397; s. c. 1 Cliff. 592; *Aiken v. Dolan*, 3 Fish. 197; *Many v. Sizer*, 1 Fish. 17; *Roberts v. Harneden*, 2 Cliff. 500; *Potter v. Wilson*, 2 Fish. 102; *Conover v. Dohrman*, 3 Fish. 382; s. c. 6 Blatch. 60; *Colt v. Mass. Arms Co.*, 1 Fish. 108; *Teese v. Phelps*, 1 McAl. 48; *Clark Patent Co. v. Copeland*, 2 Fish. 221; *Blake v. Eagle Works Manuf. Co.*, 4 Fish. 591; s. c. 3 Biss. 77; *Pitts v. Wemple*, 2 Fish. 10; s. c. 1 Biss. 87; *Jackson v. Allen*, 120 Mass. 64; *Zinn v. Weiss*, 7 Fed. Rep. 914; *Lull v. Clark*, 22 O. G. 1535; s. c. 17 Fed. Rep. 456.

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

must be disregarded, and the substance of its arrangement and its method of working must be examined for the purpose of seeing whether the ideas of the inventor are incorporated in it. *Sickles v. Borden*, 3 Blatch. 535; *Treadwell v. Parrott*, 3 Fish. 124; s. c. 5 Blatch. 369; *Gibson v. Harris*, 1 Blatch. 167.

A difference in the mechanical arrangement and construction of two machines is not necessarily a test by which to determine that the two are not identical. They may be apparently very different externally, and still embrace the same substantial identity in principle or mode of operation. So, on the other hand, the converse of the proposition is equally true. The two may apparently be very similar externally, and still in principle and mode of operation be very different. There is no better mode of examining a question of this kind than to inquire whether the mechanical arrangement and construction of the two embrace the same set of ideas, the same leading features, or ideas, which in practical operation produce the useful result. In other words, whether the arrangement and combination of the parts of machinery found in each are substantially the same, and operate in substantially the same way in producing the result. Hence, the real question as it respects the identity of the two machines, looks simply to their mechanical arrangement and construction as to whether or not the defendant's incorporates in its structure and operation the spirit and substance of the plaintiff's improvement, that is, uses the arrangement and mechanism of the plaintiff's to perform the same function or produce the same effect in the same way or substantially the same way. *Le Roy v. Tatham*, 2 Blatch. 474; s. c. 14 How. 156; *Smith v. Higgins*, 1 Fish. 537; *Sickles v. Borden*, 3 Blatch. 535; *Florence S. M. Co. v. G. & B. S. M. Co.*, 110 Mass. 70; *Morris v. Barrett*, 1 Fish. 461; s. c. 1 Bond 254; *Birdsell v. McDonald*, 6 O. G. 682; s. c. 1 Ban & Ard. 165; *Blanchard v. Beers*, 2 Blatch. 411; *Whipple v. Baldwin Manuf. Co.*, 4 Fish. 29.

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

Where form and substance are inseparable, it is enough to look at the form only. Where they are separable, where the whole substance of the invention may be copied in a different form, it is the duty of courts and juries to look through the form for the substance of the invention—for that which entitled the inventor to his patent, and which the patent was designed to secure. Where that is found there is an infringement, and it is not a defence that it is embodied in a form not described and in terms claimed by the patentee. *Winans v. Denmead*, 15 How. 330; s. c. 4 Am. L. J. 498; *Many v. Jagger*, 1 Blatch. 372; *Sargent v. Larned*, 2 Curt. 340; *McMurry v. Mallory*, 4 Hughes 265; s. c. 5 Fed. Rep. 593.

If a party makes a merely formal change in the important part of a

machine, he is an infringer, although he has to modify the other parts of the machine in order to meet such change and attain the results which were attained by the patented machine. *Union P. B. M. Co. v. P. & W. Co.*, 15 O. G. 423.

Where form is of the essence of the invention, a machine different in form is not an infringement, although it attains the same object. *Werner v. King*, 96 U. S. 218; s. c. 13 O. G. 176.

Equivalents.

When, in mechanics, one device does a particular thing or accomplishes a particular result, every other device known or used in mechanics, which skilful and experienced workmen know will produce the same result or do the same particular thing, is a known mechanical substitute for the first device. It is sufficient to constitute known mechanical substitutes, that when a skilful mechanic sees one device doing one particular thing, that he knows the other devices whose use he is acquainted with will do the same thing. *Carter v. Baker*, 4 Fish. 494; s. c. 1 Saw. 512.

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

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

The substantial equivalent of a thing is the same as the thing itself. If two machines do the same work in substantially the same way and accomplish substantially the same result, they are the same. *Cahoon v. Ring*, 1 Fish. 397; s. c. 1 Cliff. 592; *Foss v. Herbert*, 2 Fish. 31; s. c. 1 Biss. 121; *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600; s. c. 3 Cliff. 639; *Waterman v. Thomson*, 2 Fish. 461; *White v. Boker*, 3 Fish. 66.

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

The substitution of a mechanical equivalent, as it is termed in the construction of a machine, is not a substantial change. There are very many devices in construction that can be made by a skilful mechanic, differing very much from each other in appearance, but which in the eye of the patent law are regarded as identical. For instance, an inventor in the

construction of his machine, desires a given power in order to give practical operation and effect to his discovery. One mechanic may furnish the power by means of a lever; another by means of a screw—two very different instruments; yet so far as the use of the instruments, and so far as their purpose to furnish the power is concerned, they are regarded simply as mechanical equivalents, and the use of one in one machine does not distinguish that machine from a machine in which the other is found. So, too, a given power may be obtained by a spring, or by a weight, or by a pulley—apparently very different devices, yet as they are used for the same purpose and to accomplish the same end in machinery, they are regarded as substantially identical. *Le Roy v. Tatham*, 2 Blatch. 474; s. c. 14 How. 156; *Page v. Ferry*, 1 Fish. 298; *O'Reilly v. Morse*, 15 How. 62; *Latta v. Shawk*, 1 Fish. 465; s. c. 1 Bond. 259; *Case v. Brown*, 2 Fish. 268; s. c. 2 Wall. 320; 1 Biss. 382; *Colt v. Mass. Arms Co.*, 1 Fish. 108; *Smith v. Downing*, 1 Fish. 64; *Gallahue v. Butterfield*, 6 Fish. 203; s. c. 10 Blatch. 232; 2 O. G. 645; *Singer v. Walmsley*, 1 Fish. 558; *Roots v. Hyndman*, 6 Fish. 439; s. c. 4 O. G. 29; *Seymour v. McCormick*, 2 Blatch. 240; s. c. 16 How. 480; *Foss v. Herbert*, 2 Fish. 31; s. c. 1 Biss. 121; *Ives v. Hamilton*, 6 Fish. 244; s. c. 92 U. S. 426; 10 O. G. 336; *Pitts v. Edmonds*, 2 Fish. 52; s. c. 1 Biss. 168; *Sarven v. Hall*, 6 Fish. 495; s. c. 11 Blatch. 295; 4 O. G. 666; *Standard M. M. Co. v. Teague*, 15 Fed. Rep. 390; *Kimball v. Hess*, 15 Fed. Rep. 393.

The doctrine respecting the use of mechanical equivalents is not confined by the patent law to those elements which are strictly known as such in the science of mechanics. In the present advanced stage of that science, there are different well-known devices, any one of which may be adopted to effect a given result, according to the judgment of the constructor. The mere substitution of one of these for another can not be treated as an invention. It does not belong to the subject of invention, but of construction. The substance of the invention does not consist in the identical devices used, but in a practicable and described mode of effecting certain operations, and when the patentee has described what those operations are, and one practicable mode of effecting them, he has enabled constructors to effect these operations, not only by the identical devices he employed, but by all other known substitutes. *Foster v. Moore*, 1 Curt. 279; *Wilt v. Grier*, 19 O. G. 427; s. c. 5 Fed. Rep. 450; *Yale Lock Manuf. Co. v. Norwich Natl. Bank*, 19 Blatch. 123; s. c. 6 Fed. Rep. 377.

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

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

Although a handle is not in general the equivalent of a lever, yet if it is

used to perform the same functions in substantially the same way, it may be an equivalent. *Brown v. Guild*, 23 Wall. 181; s. c. 6 O. G. 392; 7 O. G. 739.

A device which has apparently different mechanical adaptabilities can not be considered a mechanical equivalent. Mechanical equivalents are not those merely which produce the same result. *Smith v. Marshall*, 10 O. G. 375; s. c. 2 Ban & Ard. 371.

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

If the change constitutes a mechanical equivalent in reference to the means used by the patentee, and if, besides being an equivalent, it accomplishes some other advantage beyond the effect or purpose accomplished by the patentee, it will still be an infringement as respects what is covered by the patent, although the further advantage may be a patentable subject as an improvement on the former invention. *Foss v. Herbert*, 2 Fish. 31; s. c. 1 Biss. 121; *Converse v. Cannon*, 2 Woods 7; s. c. 9 O. G. 105; *Carstaedt v. U. S. Corset Co.*, 13 Blatch. 371; 10 O. G. 3; s. c. 2 Ban & Ard. 331; *Sarven v. Hall*, 5 Fish. 415; s. c. 9 Blatch. 524; 1 O. G. 437.

Although the commissioner required the patentee to disclaim a claim in specific terms for an equivalent, yet he may treat a person who uses it as an infringer. *Union M. C. Co. v. U. S. C. Co.*, 11 O. G. 1113; s. c. 2 Ban & Ard. 593.

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

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

Where a patent is granted for a composition made of several ingredients, it covers and embraces known equivalents of each of the ingredients. *Matthews v. Skates*, 1 Fish. 602; *Woodward v. Morrison*, 5 Fish. 357; s. c. 1 Holmes 124; 2 O. G. 120; *Byam v. Eddy*, 2 Blatch. 521; *U. S. Felting Co. v. Manuf. Co.*, 9 O. G. 202; s. c. 2 Ban & Ard. 167; *Allen v. Hunter*, 6 McLean 303; *Poppenhusen v. Falke*, 2 Fish. 213; *Byam v. Eddy*, 24 Vt. 666.

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

When the patent is for a composition, the question is not whether two substances were ever equivalents for any purpose before, but whether

they are equivalents for the purpose specified in the patent. *Goodyear D. V. Co. v. Preterre*, 14 O. G. 346.

A substitute for one ingredient in a composition which has every property and performs every function of the original is an equivalent, although it does something more and better. *Atlantic Giant Powder Co. v. Goodyear*, 13 O. G. 45; s. c. 3 Ban & Ard. 161.

When a product arrived at by certain defined stages or processes is patented, only those things can be considered as equivalents for the elements of the manufacture which perform the same function in substantially the same way. The same result may be reached by different processes, each of them patentable, and one process is not infringed by the use of any number of its stages less than all of them. *Goodyear D. V. Co. v. Davis*, 19 O. G. 543; s. c. 102 U. S. 222; s. c. 3 Ban & Ard. 115.

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

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

Mere formal alterations of a combination in letters patent do not constitute any defence to the charge of infringement, as the inventor of a combination is as much entitled to suppress every other combination of the same ingredients to produce the same result, not substantially different from what he has invented and caused to be patented, as the inventor of any other patented improvement. Such inventors may claim equivalents as well as any other class of inventors, and they have the same right to suppress every other subsequent improvement not substantially different from what they have invented and secured by letters patent. The withdrawal of one ingredient in a patented combination and the substitution of another which was well known at the date of the patent as a proper substitute for the one withdrawn, is a mere formal alteration of the combination, and if the ingredient substituted performs substantially the same function as the one withdrawn, such substitution of one ingredient for another will not avoid the charge of infringement. *Storrs v. Howe*, 10 O. G. 421; s. c. 4 Cliff. 388; s. c. 2 Ban & Ard. 420; *Vogle v. Semple*, 11 O. G. 923; s. c. 7 Biss. 382; s. c. 2 Ban & Ard. 556; *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Taylor v. Garretson*, 5 Fish. 116; s. c. 9 Blatch. 156; *Gould v. Rees*, 6 Fish. 106; s. c. 15 Wall. 187; 2 O. G. 624; *Gill v. Wells*, 22 Wall. 1; s. c. 6 O. G. 881; 2 A. L. T. (N. S.) 101; *Conover v. Roach*, 4 Fish. 12; *Blake v. Robertson*, 6 Fish. 509; s. c. 11 Blatch. 237; 6 O. G. 297; 11 O. G. 877; s. c. 94 U. S. 728; *Conover v. Rapp*, 4 Fish. 57; *Webster v. Carpet Co.*, 5 O. G. 522; s. c. 1 Ban & Ard. 84; *Railway Co. v. Sayles*, 97 U. S. 554; s. c. 15 O. G. 243;

s. c. 3 Biss. 52; s. c. 4 Fish. 584; *Heald v. Rice*, 104 U. S. 737; s. c. 21 O. G. 1443; s. c. 13 Pac. L. R. 33; *Union Sugar Refinery v. Mathiessen*, 2 Fish. 600; s. c. 3 Cliff. 639; *Washing Machine Co. v. Lincoln*, 4 Fish. 379; *Graham v. Mason*, 5 Fish. 1; s. c. 4 Cliff. 88; *Carter v. Baker*, 4 Fish. 404; s. c. 1 Saw. 512; *King v. Louisville Cement Co.*, 6 Fish. 336; s. c. 4 O. G. 181; *Gorham v. Mixer*, 1 Am. L. J. 539; *Cochrane v. Deener*, 11 O. G. 637; s. c. 94 U. S. 780; *Odorless Excav. Co. v. McCauley*, 2 Ban & Ard. 570; *Putnam v. Hutchinson*, 12 Fed. Rep. 131; *Bickford v. Laporte*, 5 Ban & Ard. 349; *Dederick v. Cassell*, 20 O. G. 1233; s. c. 9 Fed. Rep. 306; *Graham v. McCormick*, 10 Biss. 39; s. c. 21 O. G. 1533; s. c. 5 Ban & Ard. 244; s. c. 11 Fed. Rep. 859; *Clough v. Barker*, 106 U. S. 166; *Turrell v. Spaeth*, 14 O. G. 377; s. c. 3 Ban & Ard. 458; *Adams v. Moline Wagon Works Co.*, 16 Fed. Rep. 236; *Sands v. Wardwell*, 3 Cliff. 277; *American Whip Co. v. Lombard*, 14 O. G. 900; s. c. 4 Cliff. 495; s. c. 3 Ban & Ard. 598; *Edgerton v. Breck*, 5 Ban & Ard. 42; *Imhacuser v. Buerk*, 101 U. S. 674; s. c. 17 O. G. 795; s. c. 1 Ban & Ard. 337; *Ready Roofing Co. v. Taylor*, 15 Blatch. 95; s. c. 3 Ban & Ard. 368; *Babcock v. Judd*, 17 O. G. 1351; s. c. 5 Ban & Ard. 127; s. c. 1 Fed. Rep. 408; *Holly v. Vergennes Machine Co.*, 18 Blatch. 327; s. c. 18 O. G. 1177; s. c. 4 Fed. Rep. 74; *Willimantic L. Co. v. Clark Thread Co.*, 4 Ban & Ard. 133; *Knapp v. Joubert*, 19 Blatch. 148; s. c. 7 Fed. Rep. 219; *Clough v. Manuf. Co.*, 106 U. S. 178; s. c. 22 O. G. 2157.

Mere Mechanical Skill.

In order to determine whether the change in the arrangement and construction of an existing machine is to be considered as a substantial change or not, it must be ascertained and determined whether the change is the result of mechanical skill worked out by mechanical devices—of a knowledge that belongs to that department of labor, or whether the change is the result of mind, of genius, of invention in which there is something more than mere mechanical skill and ingenuity. A change in the arrangement and construction is not substantial unless there is embodied in it, over and beyond the skill of the mechanic, that inventive element of the mind which is to be found in every machine or improvement that is the proper subject of a patent. *Le Roy v. Tatham*, 2 Blatch. 474; s. c. 14 How. 156; *Case v. Brown*, 2 Fish. 268; s. c. 2 Wall. 320; 1 Biss. 382; *Seymour v. McCormick*, 2 Blatch. 240; s. c. 16 How. 480; *Gibson v. Harris*, 1 Blatch. 167; *Hamilton v. Ives*, 6 Fish. 244; s. c. 3 O. G. 30; *Blanchard v. Beers*, 2 Blatch. 411; *Union Paper Bag Co. v. Nixon*, 6 Fish. 402; s. c. 4 O. G. 31; *Gibson v. Van Dresar*, 1 Blatch. 532; *Birdsell v. McDonald*, 6 O. G. 682; s. c. 1 Ban & Ard. 165; *Forbes v. Barstow Stove Co.*, 2 Cliff. 379; *Coffin v. Ogden*, 3 Fish. 640; s. c. 7 Blatch. 61; *Goodyear v. Honsinger*, 3 Fish. 147; s. c. 2 Biss. 1; *Potter v. Schenck*, 3 Fish. 82; s. c. 1 Biss. 515; *Thayer v. Wales*, 5 Fish. 130; s. c. 9 Blatch. 170; *Renwick v. Pond*, 5 Fish. 569; s. c. 10 Blatch. 39; 2 O. G. 392.

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

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

The mere exercise of skill, ingenuity, thought, and experiment, in the production of an article, is not sufficient to obviate the charge of infringement, for it may be that they would produce an article substantially the same, though formally different, or might be employed to prevent a similitude in form, although the principle be the same, and so evade the patent. *Many v. Sizer*, 1 Fish. 17.

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

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

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

When an Infringement.

The inquiry is not whether the principle of the two articles is the same. If the principle is the same, and the effect is similar in both, in contemplation of law they are identical. *Buerk v. Imhausen*, 5 O. G. 752; *Hike v. P. & W. R. R. Co.*, 6 O. G. 575; *Kursheedt v. Werner*, 12 Blatch. 530; s. c. 8 O. G. 146; s. c. 2 Ban & Ard. 81; *Wicks v. Stevens*, 2 Woods 310; s. c. 2 Ban & Ard. 318; *G. & B. Manuf. Co. v. Tirrell*, 12 Blatch. 144; s. c. 8 O. G. 2; s. c. 1 Ban & Ard. 315; *King v. Werner*, 12 Blatch. 270; s. c. 8 O. G. 361; s. c. 1 Ban & Ard. 386; *R. & E. Manuf. Co. v. P. & F. C. Manuf. Co.*, 12 Blatch. 36; s. c. 7 O. G. 383; *Union Paper Bag Co. v. Newell*, 6 Fish. 582; s. c. 11 Blatch. 379; 5 O. G. 459; *Aultman v. Holley*, 6 Fish. 534; s. c. 11 Blatch. 317; 5 O. G. 3; *Bigelow v. Matthews*, 7 Blatch. 77; *McMillin v. Barclay*, 5 Fish. 189; s. c. 4 Brews. 275; *McComb v. Brodie*, 5 Fish. 384; s. c. 1 Woods 153; 2 O. G. 117; *Brooks v. Bicknell*, 3 McLean 250; s. c. 2 Robb 118; *Blanchard v. Putnam*, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond 84; *Latta v. Shawk*, 1 Fish. 465; s. c. 1 Bond 259; *Doubleday v. Sherman*, 3 Fish. 369; *Stuart v. Shantz*, 6 Fish. 35; s. c. 2 O. G. 524; 9 Phila. 376; *Buerk v. Valentine*, 5 Fish. 366; s. c. 9 Blatch. 479; 2 O. G. 295; *Jenkins v. Johnson*, 5 Fish. 433; s. c. 9 Blatch. 516; *Marsh v. Seymour*, 97 U. S. 348; s. c. 13 O. G. 723; s. c. 6 Fish. 115; s. c. 2 O. G. 675; 9 Phila. 380; *Baldwin v. Schultz*, 5 Fish. 75; s. c. 9 Blatch. 494; 2 O. G. 315; *Parker v. Haworth*, 4 McLean 370; s. c. 2 Robb 725; *Potter v. Davis Sewing Machine Co.*, 3 Fish. 472; *Smith v. Pearce*, 2 McLean 176; s. c. 2 Robb 13; *Harwood v. Mill River Co.*, 3 Fish. 526; *McComb v. Beard*, 6 Fish. 254; s. c. 10 Blatch. 350; 3 O. G. 33; *Sarven v. Hall*, 6 Fish. 495; s. c. 11 Blatch. 295; 4 O. G. 666; *Barclay v. Thayer*, 12 Blatch. 109; s. c. 6 O. G. 2; s. c. 1 Ban & Ard. 267; *Woolcocks v. Many*, 5 Fish. 72; s. c. 9 Blatch. 139; *Wheeler v. Clipper Co.*, 6 Fish. 1; s. c. 10 Blatch. 181; 2 O. G. 442; *Black v. Thorne*, 5 Fish. 550; s. c. 10 Blatch. 66; 2 O. G. 388; *Sloat v. Patton*, 1 Fish. 154; *Ormsbee v. Wood*, 3 Fish. 372; *Kidd v. Spence*, 4 Fish. 37; *Hawes v. Washburne*, 5 O. G. 491; *King v. Mandelbaum*, 4 Fish. 577; s. c. 8 Blatch. 468; *Tremaine v. Hitchcock*, 23 Wall. 518; s. c. 7 O. G. 1055; s. c. 8 Blatch. 440; s. c. 4 Fish. 508; *Corliss v. W. & W. Manuf. Co.*, 2 Fish. 199; *Doubleday v. Sherman*, 3 Fish. 371; *Kendrick v. Emmons*, 6 Fish. 452; s. c. 1 Holmes 334; 4 O. G. 398; *Westlake v. Cartter*, 6 Fish. 519; s. c. 4 O. G. 636; *Seymour v. McCormick*, 3 Blatch. 209; s. c. 19 How. 96; *La Baw v. Hawkins*, 6 O. G. 724; s. c. 1 Ban & Ard. 428; *Knox v. Loweree*, 6 O. G. 802; s. c. 1 Ban & Ard. 589; *Weston v. Nash*, 1 Holmes 488; s. c. 7 O. G. 1096; s. c. 2 Ban & Ard. 40; *Harts-horne v. Almy*, 1 Holmes 493; s. c. 8 O. G. 94; s. c. 2 Ban & Ard. 46; *Stover v. Halsted*, 13 Blatch. 95; s. c. 8 O. G. 558; s. c. 2 Ban & Ard. 98; *Magic Ruffle Co. v. Elm City Co.*, 13 Blatch. 151; s. c. 8 O. G. 773; s. c. 2 Ban & Ard. 152; *Schillinger v. Gunther*, 11 O. G. 831; s. c. 14 Blatch. 152; s. c. 2 Ban & Ard. 544; *N. Y. Rubber Co. v. Chaskel*, 9 O. G. 923; *Earle v. Harlow*, 9 O. G. 1018; s. c. 2 Ban & Ard. 264; Dal-

ton *v.* Nelson, 13 Blatch. 357; s. c. 9 O. G. 1112; s. c. 2 Ban & Ard. 225; Pickering *v.* Phillips, 10 O. G. 420; s. c. 4 Cliff. 383; s. c. 2 Ban & Ard. 417; Tucker *v.* Tucker Manuf. Co., 10 O. G. 464; s. c. 4 Cliff. 397; 2 Ban & Ard. 401; Collender *v.* Came, 4 Cliff. 393; s. c. 10 O. G. 467; s. c. 2 Ban & Ard. 412; 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; Stevens *v.* Pritchard, 4 Cliff. 417; s. c. 10 O. G. 505; s. c. 2 Ban & Ard. 390; Holbrook *v.* Small, 10 O. G. 508; s. c. 2 Ban & Ard. 396; Blake *v.* Robertson, 94 U. S. 728; s. c. 11 O. G. 877; s. c. 6 O. G. 297; s. c. 11 Blatch. 237; s. c. 6 Fish. 509; Olcott *v.* Hawkins, 2 Am. L. J. 317; Whipple *v.* Baldwin Manuf. Co., 4 Fish. 29; Whipple *v.* Middlesex Co., 4 Fish. 41; Carter *v.* Baker, 4 Fish. 404; s. c. 1 Saw. 512; Parham *v.* Sewing Machine Co., 4 Fish. 468; Henderson *v.* Cleveland Stove Co., 12 O. G. 94; s. c. 2 Ban & Ard. 604; Adams *v.* Joliet Manuf. Co., 12 O. G. 91; s. c. 3 Ban & Ard. 1; Foye *v.* Nichols, 22 O. G. 2240; s. c. 13 Fed. Rep. 125; Frost *v.* Marcus, 13 Fed. Rep. 88; Welling *v.* La Bau, 12 Fed. Rep. 875; Tibbals *v.* Daby, 11 Fed. Rep. 903; Ben & B. Manuf. Co. *v.* Hollister, 5 Ban & Ard. 136; s. c. 4 Fed. Rep. 83; Franz P. Knitting M. Co. *v.* Bickford, 18 O. G. 734; Plimpton *v.* Winslow, 5 Ban & Ard. 563; s. c. 3 Fed. Rep. 323; Kimball *v.* Hess, 15 Fed. Rep. 393; Theberath *v.* R. & C. H. T. Co., 5 Ban & Ard. 584; 3 Fed. Rep. 151; N. Y. C. P. Co. *v.* Wilson, 2 Fed. Rep. 904; Standard Measuring M. Co. *v.* Teague, 15 Fed. Rep. 390; McDonald *v.* Sidenberg, 18 O. G. 193; Forehand *v.* Porter, 15 Fed. Rep. 256; Tyler *v.* Welch, 18 Blatch. 209; s. c. 17 O. G. 1508; s. c. 5 Ban & Ard. 11; s. c. 5 Fed. Rep. 636; Roberts *v.* Schreiber, 18 O. G. 125; s. c. 5 Ban & Ard. 591; s. c. 2 Fed. Rep. 855; Evory *v.* Candee, 5 Ban & Ard. 435; s. c. 2 Fed. Rep. 542; Coupe *v.* Weatherhead, 23 O. G. 1927; s. c. 16 Fed. Rep. 673; Williams *v.* Candee, 18 Blatch. 140; s. c. 5 Ban & Ard. 418; s. c. 2 Fed. Rep. 683; Miller *v.* Pickering, 16 Fed. Rep. 540; s. c. 40 Leg. Int. 182; Woven W. M. Co. *v.* Wire W. B. Co., 5 Ban & Ard. 277; s. c. 1 Fed. Rep. 222; Spaeth *v.* Gibson, 23 O. G. 1732; Stebbins H. E. Manuf. Co. *v.* Stebbins, 17 O. G. 1348; s. c. 5 Ban & Ard. 199; s. c. 4 Fed. Rep. 445; Graham *v.* Gammon, 7 Biss. 490; s. c. 3 Ban & Ard. 7; Albright *v.* Cel. H. T. Co., 12 O. G. 227; s. c. 2 Ban & Ard. 629; Harper *v.* Cooke, 5 Ban & Ard. 50; Evory *v.* Burt, 23 O. G. 2121; s. c. 15 Fed. Rep. 112; Klein *v.* Park, 13 O. G. 5; s. c. 3 Ban & Ard. 145; Bullock Printing Press Co. *v.* Jones, 13 O. G. 124; s. c. 3 Ban & Ard. 195; Megraw *v.* Carroll, 5 Ban & Ard. 324; Hoe *v.* Cole, 13 O. G. 500; Searles *v.* Van Nest, 13 O. G. 772; s. c. 3 Ban & Ard. 121; Andrews *v.* Eames, 23 O. G. 1123; s. c. 15 Fed. Rep. 109; Guidet *v.* Brooklin, 13 O. G. 773; s. c. 3 Ban & Ard. 291; H. B. & M. Manuf. Co. *v.* Sargeant, 14 O. G. 45; s. c. 3 Ban & Ard. 263; Hall *v.* Jones, 14 O. G. 378; s. c. 3 Ban & Ard. 455; American Manuf. Co. *v.* Lane, 15 O. G. 421; s. c. 14 Blatch. 438; s. c. 3 Ban & Ard. 268; De Florez *v.* Reynolds, 14 Blatch. 505; s. c. 3 Ban & Ard. 292; Atlantic G. P. Co. *v.* Dittmar P. M. Co., 17 Blatch. 531; s. c. 17 O. G. 969; s. c. 5 Ban & Ard. 222; s. c. 1 Fed. Rep. 328; Johnson *v.*

Omon, 3 Hughes 290; Onderdonk *v.* Fanning, 5 Ban & Ard. 85; s. c. 4 Fed. Rep. 148; Buzzell *v.* O'Connell, 4 Fed. Rep. 325; Dunbar *v.* Estabrook, 5 Ban & Ard. 68; s. c. 4 Fed. Rep. 545; Robinson *v.* Sutter, 10 Biss. 100; s. c. 19 O. G. 127; s. c. 8 Fed. Rep. 828; Tyler *v.* Crane, 19 O. G. 128; s. c. 7 Fed. Rep. 775; Bridgeport Wood Finishing Co. *v.* Hooper, 18 Blatch. 459; s. c. 20 O. G. 156; s. c. 5 Fed. Rep. 63; Straw S. M. Co. *v.* Eames, 18 Blatch. 520; s. c. 19 O. G. 359; s. c. 6 Fed. Rep. 181; Wilt *v.* Grier, 19 O. G. 427; s. c. 5 Fed. Rep. 450; Woven Wire Mattress Co. *v.* Palmer, 5 Ban & Ard. 455; s. c. 5 Fed. Rep. 812; Fischer *v.* Hayes, 19 Blatch. 26; s. c. 20 O. G. 239; s. c. 6 Fed. Rep. 76; Potter *v.* Stewart, 18 Blatch. 561; s. c. 19 O. G. 997; s. c. 7 Fed. Rep. 217; Waring *v.* Johnson, 19 Blatch. 38; s. c. 19 O. G. 1068; s. c. 6 Fed. Rep. 500; Putnam *v.* Van Hofe, 19 Blatch. 63; s. c. 19 O. G. 1352; s. c. 6 Fed. Rep. 897; Marks *v.* Fox, 18 Blatch. 502; s. c. 6 Fed. Rep. 727; American D. R. B. Co. *v.* Sheldon, 17 Blatch. 208; s. c. 4 Ban & Ard. 551; Hobbs *v.* King, 19 O. G. 1709; s. c. 8 Fed. Rep. 91; Hammerschlag *v.* Scamoni, 20 O. G. 1449; s. c. 20 O. G. 75; s. c. 7 Fed. Rep. 584; Colignon *v.* Hayes, 20 O. G. 447; s. c. 8 Fed. Rep. 912; Barber *v.* Hallett, 20 O. G. 449; s. c. 4 Ban & Ard. 213; s. c. 10 Fed. Rep. 130; Woven Wire Mattress Co. *v.* Wire Web Bed Co., 8 Fed. Rep. 87; Cole *v.* Moffitt, 8 Fed. Rep. 152; Cal. A. S. P. Co. *v.* Perine, 7 Saw. 190; s. c. 20 O. G. 813; s. c. 8 Fed. Rep. 821; Steam G. & L. Co. *v.* Miller, 20 O. G. 889; s. c. 8 Fed. Rep. 314; Shannon *v.* Stationery Co., 10 Biss. 498; s. c. 9 Fed. Rep. 205; Cox *v.* Ramsdell, 4 Ban & Ard. 326; McKesson *v.* Carnrick, 9 Fed. Rep. 44; Chalmers S. P. N. Co. *v.* Pierce, 9 Fed. Rep. 152; MacDonald *v.* Shepard, 4 Ban & Ard. 343; Macdonald *v.* Sidenberg, 4 Ban & Ard. 586; White *v.* Heath, 22 O. G. 500; s. c. 10 Fed. Rep. 291; Star Salt Castor Co. *v.* Alden, 10 Fed. Rep. 555; Strobbridge *v.* Launder, 21 O. G. 1027; s. c. 11 Fed. Rep. 880; American Bell Tel. Co. *v.* Dolbear, 23 O. G. 535; s. c. 15 Fed. Rep. 448; Brett *v.* Quintard, 10 Fed. Rep. 741; Ward *v.* Grand Detour Plow Co., 14 Fed. Rep. 696; Union Stone Co. *v.* Allen, 14 Fed. Rep. 353; Wallicks *v.* Cantrell, 21 O. G. 1878; s. c. 12 Fed. Rep. 790; Loud *v.* Stone, 11 Fed. Rep. 721; Gottfried *v.* Crescent B. Co., 22 O. G. 1447; s. c. 13 Fed. Rep. 479; Weeks *v.* Buffalo Scale Co., 11 Fed. Rep. 901; Brainard *v.* Cramme, 22 O. G. 769; s. c. 12 Fed. Rep. 621; Barker *v.* Todd, 22 O. G. 1448; s. c. 13 Fed. Rep. 473; Myers *v.* Duker, 1 Ban & Ard. 535; Gold & S. T. Co. *v.* Wiley, 17 Fed. Rep. 234; Wallace *v.* Noyes, 23 O. G. 435; s. c. 13 Fed. Rep. 172; United Nickel Co. *v.* Melchior, 17 Fed. Rep. 340; Schillinger *v.* Greenway Brewing Co., 24 O. G. 495; s. c. 17 Fed. Rep. 744; Brett *v.* Quintard, 17 Fed. Rep. 529; Dunham *v.* Kimball, 17 Fed. Rep. 810.

If a device operates in substantially the same way as the device in the patentee's invention it is an infringement, although it was not known or in use at the date of that invention. Potter *v.* Stewart, 18 Blatch. 561; s. c. 19 O. G. 997; s. c. 7 Fed. Rep. 215.

The inventor usually sets forth what he conceives to be the best form or mode under which his machine may be used to produce the required

result. In order to ascertain the true nature and value of his invention, the substance and principle of it must be separated from its accidents; its essence from its modes. A mere change in the latter while the former are retained will not acquit the party making it from the charge or guilt of pirating the invention. *Blanchard v. Reeves*, 1 Fish. 103.

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

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

A patent for a device can not be avoided by dividing it into two parts which, when combined, produce the same result in substantially the same way. *Wheeler v. Clipper Co.*, 6 Fish. 1; s. c. 10 Blatch. 181; 2 O. G. 442; *Strobridge v. Lindsay*, 19 O. G. 1285; s. c. 6 Fed. Rep. 510.

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

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

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

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

s. c. 10 Blatch. 232 ; 2 O. G. 645 ; *Odiorne v. Denney*, 13 O. G. 965 ; s. c. 3 Ban & Ard. 287.

Although a patentee is entitled only to his own particular improvement, yet if the defendant takes the principal thing and merely changes the forms of the minor parts by using well-known equivalents, he infringes the patent. *Singer Manuf. Co. v. Henry Stewart Manuf. Co.*, 20 O. G. 524 ; s. c. 8 Fed. Rep. 920.

If a machine is so constructed as to conform to the description in the patent except as to one particular, but with the design that this effect shall be attained by the action or wearing of the parts in use, it is an infringement. *American D. R. B. Co. v. Sullivan Machine Co.*, 14 Blatch. 119 ; s. c. 2 Ban & Ard. 522.

If an article is in substance the same as that described in the patent it is an infringement, although it is employed for a purpose not mentioned in the patent. *Ginn v. Weiss*, 7 Fed. Rep. 914.

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

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

Where a slight change is made in a machine by which a new result is brought about, the invention is not extended beyond the change ; but where something elementary is discovered, and fairly constitutes a part of the invention, no other person is permitted to use that elementary part without paying tribute to the patentee. *Cornell v. D. & B. Brewing Co.*, 11 O. G. 331 ; s. c. 7 Biss. 346 ; s. c. 2 Ban & Ard. 514.

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

When the invention embraces the entire machine, any person is an infringer who, without license, makes or uses any portion of the machine. Under such a patent the patentee holds the exclusive right to make and use, and vend to others to be used, the entire machine ; and if another, without license, makes, uses or vends any portion of it, he invades the rights of the patentee. *Union Sugar Refinery v. Mathiessen*, 2 Fish. 600 ; s. c. 3 Cliff. 639 ; *Mabie v. Haskell*, 2 Cliff. 507 ; *Moody v. Fiske*, 2 Mason 112 ; s. c. 1 Robb 312.

When a device is capable of being used in another mode, and all its benefits are fully secured if it is so used, a change in the mode will be deemed an infringement. *Union Paper Bag Co. v. Nixon*, 9 O. G. 591 ; s. c. 1 Flippin 491 ; s. c. 2 Ban & Ard. 244.

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

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

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

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

If there is more than one claim in a patent, it is not necessary to prove that the defendant has infringed all the claims, but it is sufficient if any one of such claims has been infringed. *Singer v. Walmsley*, 1 Fish. 558; *McComb v. Brodie*, 5 Fish. 384; s. c. 1 Woods 153; 2 O. G. 117; *Wyeth v. Stone*, 1 Story 273; s. c. 2 Robb 23; *Cook v. Ernest*, 5 Fish. 396; s. c. 1 Woods 195; 2 O. G. 89; *Morris v. Barrett*, 1 Fish. 461; s. c. 1 Bond 254; *Foss v. Herbert*, 2 Fish. 31; s. c. 1 Biss. 121; *Pitts v. Whitman*, 2 Story 609; s. c. 2 Robb 180; *Moody v. Fiske*, 2 Mason 112; s. c. 1 Robb 312; *Colt v. Mass. Arms Co.*, 1 Fish. 108; *Pitts v. Wemple*, 2 Fish. 10; s. c. 1 Biss. 87; *Proctor v. Brill*, 4 Fed. Rep. 415.

If the addition of a part is nothing more than any practical mechanic or operator could supply as soon as any difficulty is discovered, the manufacture and sale of the original machine is an infringement, although it would not operate under some circumstances without such part. *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.

An improvement will not justify the use of the prior patent without the consent of the first patentee. *O'Reilly v. Morse*, 15 How. 62; *Alden v. Dewey*, 1 Story 336; s. c. 2 Robb 17; *Gray v. James*, 1 Pet. C. C. 394; s. c. 1 Robb 120; *Hays v. Sulsor*, 1 Fish. 533; s. c. 1 Bond 279; *Johnson v. Root*, 1 Fish. 351; *Howe v. Morton*, 1 Fish. 586; *Forbes v. Barstow Stove Co.*, 2 Cliff. 379; *Foss v. Herbert*, 2 Fish. 31; s. c. 1 Biss. 121; *Tilghman v. Werk*, 2 Fish. 229; s. c. 1 Bond 511; *Pitts v. Edmonds*, 2 Fish. 52; s. c. 1 Biss. 168; *Imlay v. Railroad Co.*, 1 Fish. 340; s. c. 4 Blatch. 227; *Carr v. Rice*, 1 Fish. 198; *Woodworth v. Rogers*, 3 W. & M. 135; s. c. 2 Robb 625; *Conover v. Roach*, 4 Fish. 12; *Foster v. Moore*,

1 Curt. 279; *Blake v. Stafford*, 3 Fish. 294; s. c. 6 Blatch. 195; *Brooks v. Bicknell*, 4 McLean 70; *Middletown Co. v. Judd*, 3 Fish. 141; *Pitts v. Wemple*, 6 McLean 558; *Goodyear v. Berry*, 3 Fish. 439; s. c. 2 Bond 189; *Goodyear v. Muller*, 3 Fish. 420; *Colt v. Mass. Arms Co.*, 1 Fish. 108; *Goodyear Dental Co. v. Evans*, 3 Fish. 390; s. c. 6 Blatch. 121; *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206; *Winans v. N. Y. & Harlem R. R. Co.*, 4 Fish. 1; *Whipple v. Baldwin Manuf. Co.*, 4 Fish. 29; *Cook v. Howard*, 4 Fish. 269; *Whipple v. Middlesex Co.*, 4 Fish. 41; *Cowing v. Rumsey*, 4 Fish. 275; s. c. 8 Blatch. 36; *Conover v. Rapp*, 4 Fish. 57; *Eickenmeyer Machine Co. v. Pearce*, 6 Fish. 219; s. c. 10 Blatch. 203; 3 O. G. 150; *Chicago Fruit House Co. v. Busch*, 4 Fish. 395; s. c. 2 Biss. 472; *Fales v. Wentworth*, 5 Fish. 302; s. c. 1 Holmes 96; 2 O. G. 58; *Burrall v. Jewett*, 2 Paige 134; *Jenkins v. Walker*, 5 Fish. 347; s. c. 1 Holmes 120; 1 O. G. 359; *Johnson v. Linen Co.*, 33 Conn. 436; *American Pavement Co. v. Elizabeth*, 6 Fish. 424; s. c. 3 O. G. 522; *Waterbury Brass Co. v. Miller*, 5 Fish. 48; s. c. 9 Blatch. 77; *Wells v. Gill*, 6 Fish. 574; s. c. 4 O. G. 669; *Westinghouse v. G. & R. Brake Co.*, 9 O. G. 538; s. c. 2 Ban & Ard. 55; *Hartshorn v. Shorey*, 9 O. G. 595; s. c. 2 Ban & Ard. 233; *Morse v. Bain*, 9 West L. J. 106; *Blake v. Robertson*, 94 U. S. 728; s. c. 11 O. G. 877; s. c. 6 O. G. 297; s. c. 11 Blatch. 237; s. c. 6 Fish. 509; *Kittle v. Frost*, 5 Fish. 213; s. c. 9 Blatch. 214; *Pearl v. Ocean Mills*, 11 O. G. 2; s. c. 2 Ban & Ard. 469; *Murphy v. Kissling*, 1 Holmes 432; s. c. 7 O. G. 302; s. c. 1 Ban & Ard. 534; *Arkell v. Paper Bag Co.*, 7 Blatch. 475; *Bachelor v. Moulton*, 6 Fish. 488; s. c. 11 Blatch. 303; 4 O. G. 501; *Turrell v. Spaeth*, 14 O. G. 377; s. c. 3 Ban & Ard. 458; *Hower v. McNeal*, 15 Blatch. 193; s. c. 15 O. G. 608; s. c. 3 Ban & Ard. 376; *United Nickel Co. v. Harris*, 15 Blatch. 319; s. c. 17 O. G. 325; s. c. 3 Ban & Ard. 637; *Strobridge v. Lindsay*, 18 O. G. 62; s. c. 5 Ban & Ard. 411; s. c. 2 Fed. Rep. 692; *American D. R. B. Co. v. Sheldon*, 17 Blatch. 208; s. c. 4 Ban & Ard. 551; *Cervallis F. Co. v. Curran*, 8 Fed. Rep. 150; s. c. 13 C. L. N. 399; *Searls v. Worden*, 21 O. G. 1955; s. c. 11 Fed. Rep. 501; *Cross v. Mackinnon*, 22 O. G. 586; s. c. 11 Fed. Rep. 601.

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

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

The original patentee can not use an improvement upon his patent without a license from the inventor. *Pitts v. Wemple*, 6 McLean 558; *Conover v. Roach*, 4 Fish. 12; *Whipple v. Baldwin Manuf. Co.*, 4 Fish. 29; *Tucker v. Spaulding*, 13 Wall. 453; s. c. 1 O. G. 144; s. c. 5 Fish. 297; s. c. 1 Deady 649; *Reutgen v. Kanowrs*, 1 Wash. C. C. 168; s. c. 1 Robb 1.

If two patentees who own two patents of which one is an improvement on the other enter into an agreement that one shall manufacture the

article of one material and the other of another material, one may treat the other as an infringer if he violates the agreement. *Star S. C. Co. v. Crossman*, 4 Cliff. 568; s. c. 3 Ban & Ard. 281.

If a patentee takes out a patent for a machine and afterwards within two years takes out a patent for the product, a person can not use the machine to make the product after the expiration of the patent on the machine, although the machine can only be used to make the product. *McKay v. Dibert*, 19 O. G. 1351; s. c. 5 Fed. Rep. 587; *McKay v. McKnight*, 5 Fed. Rep. 593.

When no Infringement.

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

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

When a patentee covers with his patent the material of which a part of his machine is composed, he entirely endangers his right to prosecute when a different and inferior material is employed, and especially one which he himself, after repeated experiments, had rejected. *Aiken v. Bemis*, 3 W. & M. 348; s. c. 2 Robb 644.

If a person of competent skill could not, from the description given by the patentee, make a machine like the defendant's, then there is no infringement. If he could not make one substantially like the defendant's, it would follow either that the thing patented could not, from the description given by the patentee, be made by a person of competent skill, or that, when made, it would be substantially different from the defendant's. This, however, merely involves the question of substantial identity. *Many v. Sizer*, 1 Fish. 17; *Schneider v. Lovell*, 22 O. G. 499; s. c. 10 Fed. Rep. 666.

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

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

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

After a patent has been obtained for a particular thing by one person, another person, without appropriating that patent, may invent a new mode of accomplishing the same or a similar object, and the latter will

be entitled to a patent for his discovery. He must, however, invent something material and new that is essential to the subject-matter of the invention. If he introduces a new element or principle into the subject-matter of the invention, there is no infringement. *Pitts v. Wemple*, 2 Fish. 10 ; s. c. 1 Biss. 87.

If the state of the art is such that the patent must be confined within narrow limits, an article will not be deemed to be an infringement unless it possesses all the characteristics of the thing patented. *Scott v. Evans*, 11 Fed. Rep. 726.

Where the defendant's device was obviously invented for a purpose entirely different from that of the patented machine, and was not intended as an evasion of the patent, the evidence of actual infringement should be so clear as to admit of no other reasonable construction. *Nat'l C. B. S. Co. v. Detroit L. & N. R. R. Co.*, 4 Fed. Rep. 224 ; s. c. 13 C. L. N. 66.

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

If the invention claimed be itself but an improvement on a known machine, by a mere change of form or combination of parts, the patentee can not treat another as an infringer who has improved the original machine by use of a different form or combination performing the same functions. The inventor of the first improvement can not invoke the doctrine of equivalents to suppress all other improvements which are not colorable invasions of the first. *Burr v. Duryee*, 2 Fish. 275 ; s. c. 1 Wall. 531 ; *McCormick v. Talcot*, 20 How. 402 ; s. c. 6 McLean 539 ; *Union Sugar Refinery v. Mathiessen*, 2 Fish. 600 ; s. c. 3 Cliff. 639 ; *Taylor v. Garretson*, 5 Fish. 116 ; s. c. 9 Blatch. 156 ; *Merriam v. Van Nest*, 13 O. G. 597.

An evasion of a patent which is not an invasion of it is *damnum absque injuria*. Every man has a right to make an improvement in a machine and evade a previous patent, provided he does not invade the rights of the patentee. *Burr v. Duryee*, 2 Fish. 275 ; s. c. 1 Wall. 531 ; *Kneass v. Schuylkill Bank*, 4 Wash. C. C. 9 ; s. c. 1 Robb 303 ; *Toohey v. Harding*, 1 Fed. Rep. 174 ; s. c. 1 Hughes 254 ; s. c. 5 Ban & Ard. 195.

An improvement in the principle of a machine is no invasion of the patentee's privilege. *Park v. Little*, 3 Wash. C. C. 196 ; s. c. 1 Robb 17.

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

If it has been decided that an article was not an infringement of the original patent, it can not infringe a reissue, for the two must be for the same invention. *Cammeyer v. Newton*, 16 O. G. 720 ; s. c. 4 Ban & Ard. 139.

A party may use devices made according to the patent after the expiration thereof, although he uses them in connection with machinery not covered by the patent, but made during the term thereof, to be used for

the purpose of infringing the patent. *American D. R. B. Co. v. Sutherland F. M. Co.*, 18 Blatch. 148 ; s. c. 5 Ban & Ard. 347 ; s. c. 2 Fed. Rep. 353.

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

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

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

The patentee can not claim the result or effect. He can only claim the mode which he devised for attaining the result. Any one can produce the same result by other and different modes, and still not violate the patentee's claim. Results are not patented, but only means used to produce results. In order to constitute a violation, there must be a use of the same methods substantially as those adopted by the patentee. *Case v. Brown*, 2 Fish. 268 ; s. c. 2 Wall. 320 ; 1 Biss. 382 ; *Carver v. Hyde*, 16 Pet. 513 ; *Smith v. Higgins*, 2 Fish. 97 ; *Burr v. Cowperthwait*, 4 Blatch. 163 ; *Evarts v. Ford*, 6 Fish. 587 ; s. c. 5 O. G. 58 ; *Brooks v. Jenkins*, 3 McLean 432 ; *Wheeler v. Simpson*, 6 O. G. 435 ; s. c. 1 Ban & Ard. 420 ; *Foss v. Herbert*, 2 Fish. 31 ; s. c. 1 Biss. 121 ; *Burden v. Corning*, 2 Fish. 477 ; *Lee v. Blandy*, 2 Fish. 89 ; s. c. 1 Bond 361 ; *American Pin Co. v. Oakville Co.*, 3 Blatch. 190.

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

One machine or manufacture is not a violation of another, within the purview of the patent law, unless it is substantially the same. It need not be identical, but it must be similar in the principle or mode of operation. *Ashcroft v. B. & L. R. R. Co.*, 1 Holmes 366 ; s. c. 5 O. G. 725 ; *Wheeler v. Simpson*, 6 O. G. 435 ; s. c. 1 Ban & Ard. 420 ; *Mouroe v. Dover Stamping Co.*, 1 Holmes 413 ; s. c. 6 O. G. 685 ; s. c. 1 Ban & Ard. 401 ; *Merrill v. Yeomans*, 1 Holmes 331 ; s. c. 5 O. G. 267 ; 11 O. G. 970 ; s. c. 94 U. S. 568 ; s. c. 1 Ban & Ard. 47 ; *U. S. Steam Gauge Co. v. Am. Steam Gauge Co.*, 1 Holmes 309 ; s. c. 5 O. G. 208 ; s. c. 1 Ban & Ard. 30 ; *Cammeyer v. Newton*, 12 Blatch. 122 ; s. c. 5 O. G. 753 ; 11 O. G. 287 ; s. c. 94 U. S. 225 ; s. c. 1 Ban & Ard. 294 ; *Sweetster v. Helms*, 10 O. G. 4 ; s. c. 2 Ban & Ard. 263 ; *Mann v. Bayliss*, 10 O. G. 113, 789 ; *Smith v. Downing*, 1 Fish. 64 ; *Alden v. Dewey*, 1 Story 336 ; s. c. 2 Robb 17 ; *Forsyth v. Clapp*, 6 Fish. 528 ; s. c. 1 Holmes 278 ; 4 O. G. 527 ; *Potter v. Thayer*, 6 Fish. 603 ; s. c. 1 Holmes 293 ; 5 O. G. 32 ; *Dalton v. Jennings*, 93 U. S. 271 ; s. c. 12 Blatch. 96 ; 5 O. G. 15 ; 11 O. G. 11 ; s. c. 1 Ban & Ard. 256 ; *Page v. Ferry*, 1 Fish. 298 ; *West v. Silver Wire Skirt*, 3 Fish. 306 ; s. c. 5 Blatch. 477 ; *Kirby v. Dodge Manuf. Co.*, 6 Fish. 156 ; s. c. 10 Blatch. 307 ; 3 O. G. 181 ; *Lake v.*

Fitzgerald, 6 Fish. 420; *Meissner v. Devoe Manuf. Co.*, 5 Fish. 285; s. c. 9 Blatch. 363; 2 O. G. 545; *Doubleday v. Bracheo*, 2 Fish. 560; *Dyson v. Danforth*, 4 Fish. 133; *Dibble v. Augur*, 7 Blatch. 86; *Dibble v. Sibley*, 7 Blatch. 209; *Hailes v. Van Wormer*, 7 Blatch. 443; *Bliss v. Haight*, 3 Fish. 621; s. c. 7 Blatch. 7; *Hudson v. Draper*, 4 Fish. 256; s. c. 4 Cliff. 178; *Crosby v. Lapouraille*, Taney 374; *Price v. Kelley*, 11 O. G. 639; s. c. 2 Ban & Ard. 534; *Florence Manuf. Co. v. Boston D. Co.*, 1 Holmes 415; s. c. 6 O. G. 728; s. c. 1 Ban & Ard. 396; *Jones v. Merrill*, 8 O. G. 401; *Trader v. Messmore*, 7 O. G. 385; s. c. 1 Ban & Ard. 639; *Tufts v. Machine Co.*, 1 Holmes 459; s. c. 8 O. G. 239; s. c. 1 Ban & Ard. 633; *Goodyear D. V. Co. v. Flagg*, 9 O. G. 153; *Ashcroft v. Hollings*, 11 O. G. 879; *Scaife v. Fulton*, 9 O. G. 1164; s. c. 2 Ban & Ard. 235; *Estabrook v. Dunbar*, 10 O. G. 909; s. c. 2 Ban & Ard. 427; *Smith v. Clark*, 3 Am. L. J. 155; *DeLong v. Bickford*, 13 Fed. Rep. 32; *Walters v. Crandal*, 22 O. G. 261; s. c. 11 Fed. Rep. 868; *Andrews v. Long*, 12 Fed. Rep. 871; *Bridge v. Excelsior Manuf. Co.*, 105 U. S. 618; s. c. 21 O. G. 1955; *White v. Noyes*, 18 O. G. 857; s. c. 2 Fed. Rep. 782; *Fletcher v. Selden*, 16 Blatch. 468; s. c. 4 Ban & Ard. 394; *Zane v. Soffe*, 5 Ban & Ard. 284; s. c. 2 Fed. Rep. 229; *Williams v. Barker*, 18 O. G. 243; 5 Ban & Ard. 453; s. c. 2 Fed. Rep. 649; *Clarke v. Johnson*, 17 O. G. 1401; s. c. 16 Blatch. 495; *Van Marter v. Miller*, 15 Blatch. 562; s. c. 2 Ban & Ard. 124; *Whitnum v. Seaman*, 17 O. G. 626; *Manny v. Ogler*, 16 Fed. Rep. 658; *Covell v. Pratt*, 18 Blatch. 126; s. c. 18 O. G. 301; s. c. 5 Ban & Ard. 380; s. c. 2 Fed. Rep. 359; *Thatcher Heating Co. v. Spear*, 17 O. G. 623; s. c. 5 Ban & Ard. 88; *Warth v. Brownung*, 17 O. G. 624; s. c. 5 Ban & Ard. 341; *Hicks v. Moller*, 16 O. G. 805; s. c. 4 Ban & Ard. 434; *Bridge v. Excelsior Manuf. Co.*, 17 O. G. 259; *Fletcher v. Selden*, 16 Blatch. 468; s. c. 4 Ban & Ard. 394; *Miller v. Smith*, 16 O. G. 313; s. c. 4 Ban & Ard. 314; *Metropolitan W. M. Co. v. St. Louis W. G. Co.*, 12 O. G. 940; *National Car B. S. Co. v. Boston A. R. Co.*, 23 O. G. 1034; s. c. 15 Fed. Rep. 462; *Yaengling v. Johnson*, 1 Hughes 607; s. c. 3 Ban & Ard. 99; *Werner v. King*, 96 U. S. 218; s. c. 13 O. G. 176; *Goodyear D. V. Co. v. Davis*, 12 O. G. 560; *Joyce v. Chillicothe Foundry*, 15 O. G. 260; *Brown v. Rubber Step Manuf. Co.*, 13 O. G. 369; s. c. 3 Ban & Ard. 232; *Yale Lock Manuf. Co. v. Scoville Manuf. Co.*, 15 Fed. Rep. 342; *Ashcroft v. Boston & L. R. R. Co.*, 97 U. S. 189; s. c. 13 O. G. 865; s. c. 5 O. G. 725; s. c. 1 Holmes 366; s. c. 1 Ban & Ard. 215; *Moore v. Ludlow*, 14 O. G. 1; *Babcock v. Judd*, 15 Fed. Rep. 160; *Schzmacher v. Cornell*, 96 U. S. 549; *Duff v. Sterling Pump Co.*, 23 O. G. 1622; *Clough v. G. & B. Manuf. Co.*, 15 O. G. 1009; s. c. 22 O. G. 2241; s. c. 3 Ban & Ard. 523; *Broadnax v. Cent. S. Y. & T. Co.*, 5 Ban & Ard. 609; s. c. 4 Fed. Rep. 214; *Hoffheins v. Russell*, 23 O. G. 2030; *Clarke v. Johnson*, 18 Blatch. 450; s. c. 18 O. G. 1276; s. c. 4 Fed. Rep. 437; *Sharp v. Reissner*, 23 O. G. 1530; s. c. 15 Fed. Rep. 919; *Whitnum v. Seaman*, 5 Ban & Ard. 95; s. c. 4 Fed. Rep. 436; *Stebbins H. E. M. Co. v. Stebbins*, 17 O. G. 1348; s. c. 5 Ban & Ard. 199; s. c. 4 Fed. Rep.

445; *Parsons v. Colgate*, 24 O. G. 203; s. c. 15 Fed. Rep. 600; *Matthews v. Schoenberger*, 18 Blatch. 357; s. c. 18 O. G. 1464; s. c. 4 Fed. Rep. 634; *Pentlarge v. N. Y. Bung & B. Co.*, 5 Ban & Ard. 594; *Knox v. Gt. Western Q. Mining Co.*, 6 Saw. 430; s. c. 4 Ban & Ard. 25; s. c. 4 Fed. Rep. 809; *Tucker v. Corbin*, 5 Ban & Ard. 287; *Fletcher v. Blake*, 19 O. G. 221; *Novelty Paper Box Co. v. Stapler*, 5 Fed. Rep. 919; s. c. 38 Leg. Int. 76; *New York B. & P. Co. v. Sibley*, 23 O. G. 1444; s. c. 15 Fed. Rep. 386; *Tucker v. Burditt*, 5 Ban & Ard. 220; s. c. 5 Fed. Rep. 808; *National Manuf. Co. v. Myers*, 15 Fed. Rep. 238; *Tucker v. Corbin*, 5 Fed. Rep. 810; *Matthews v. Chambers*, 19 O. G. 789; s. c. 6 Fed. Rep. 874; *Root v. Lamb*, 19 O. G. 937; s. c. 7 Fed. Rep. 222; *Knapp v. Shaw*, 23 O. G. 2236; s. c. 15 Fed. Rep. 115; *Crompton v. Knowles*, 7 Fed. Rep. 204; *Gottfried v. C. Seip. B. Co.*, 10 Biss. 368; s. c. 8 Fed. Rep. 322; *Holmes v. Osborn*, 7 Fed. Rep. 671; *Woven Wire Mattress Co. v. Simmons*, 10 Biss. 394; s. c. 20 O. G. 955; s. c. 7 Fed. Rep. 723; *Consolidated S. V. Co. v. Crosby S. & V. Co.*, 7 Fed. Rep. 768; *Railway Register Co. v. Highland S. R. Co.*, 4 Ban & Ard. 116; *Clark v. Beecher Manuf. Co.*, 7 Fed. Rep. 816; *Palmer v. Gatling Gun Co.*, 19 Blatch. 392; s. c. 20 O. G. 815; s. c. 8 Fed. Rep. 513. *Buffum v. Oakland Manuf. Co.*, 4 Ban & Ard. 599; *Moffitt v. Rogers*, 106 U. S. 423; s. c. 23 O. G. 270; s. c. 4 Ban & Ard. 225; *Dodge v. Fearey*, 20 O. G. 1590; s. c. 8 Fed. Rep. 329; *Consolidated S. V. Co. v. Kunkle*, 23 O. G. 630; s. c. 14 Fed. Rep. 732; *Judd v. Babcock*, 8 Fed. Rep. 605; *Blatherwick v. Carey*, 10 Biss. 494; s. c. 9 Fed. Rep. 202; *Delong v. Bickford*, 22 O. G. 2242; *Judd v. Babcock*, 23 O. G. 92; *Irwin v. Metropolitan T. & T. Co.*, 20 O. G. 1452; s. c. 9 Fed. Rep. 517; *Neacy v. Allis*, 22 O. G. 1621; s. c. 13 Fed. Rep. 874; *Tucker v. Sargent*, 20 O. G. 1522; s. c. 19 Blatch. 538; s. c. 9 Fed. Rep. 299; *Onderdonk v. Fanning*, 19 Blatch. 363; s. c. 9 Fed. Rep. 106; *New Process Fermentation Co. v. Baltz*, 10 Fed. Rep. 289; s. c. 39 Leg. Int. 33; *Morgan E. R. Co. v. Pullman*, 14 Fed. Rep. 648; s. c. 15 C. L. N. 106; *Newton v. Furst & B. Manuf. Co.*, 14 Fed. Rep. 465; s. c. 15 C. L. N. 113; *Coes v. Collins Co.*, 22 O. G. 417; s. c. 9 Fed. Rep. 905; *Hart v. Thayer*, 21 O. G. 791; s. c. 10 Fed. Rep. 746; *Spill v. Celluloid Manuf. Co.*, 10 Fed. Rep. 290; *Campbell v. Kavanaugh*, 11 Fed. Rep. 83; *Delamater v. Woodruff*, 11 Fed. Rep. 414; *Ives v. Hartford S. & A. Co.*, 11 Fed. Rep. 510; *Backus W. M. Co. v. Tuerk*, 17 Fed. Rep. 350; *Schmidt v. Friese*, 21 O. G. 1876; s. c. 12 Fed. Rep. 563; *Dodds v. Stoddard*, 24 O. G. 799; *Pelham v. Demarest*, 22 O. G. 772; s. c. 12 Fed. Rep. 494; *Cowell v. Sessions*, 17 Fed. Rep. 450; *Crowell v. Beardsley*, 12 Fed. Rep. 627; *Cal. A. S. P. Co. v. Freeborn*, 8 Saw. 443; *Ives v. Hartford S. & A. Co.*, 22 O. G. 1037; *Gold & S. T. Co. v. Wiley*, 17 Fed. Rep. 234; *Eclipse Windmill Co. v. May*, 17 Fed. Rep. 344; *McKay v. Stowe*, 17 Fed. Rep. 516.

Experiment.

It was not the intention of Congress to punish a man who constructed a machine merely for philosophical experiments, or for the purpose of ascertaining the sufficiency of the machine to produce the described effects. *Whittemore v. Cutter*, 1 Gallis. 429; s. c. 1 Robb 28; *Rumford Works v. Lauer*, 5 Fish. 615; s. c. 10 Blatch. 122; 3 O. G. 349.

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

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

Combination.

To constitute an infringement of a combination, the whole combination must be used, because the patentee claims not the various parts, but the whole combination together. *Case v. Brown*, 2 Wall. 320; s. c. 2 Fish. 268; 1 Biss. 382; *Barrett v. Hall*, 1 Mason 447; s. c. 1 Robb 207; *Smith v. Downing*, 1 Fish. 64; *Carr v. Rice*, 1 Fish. 198; *Carr v. Rice*, 1 Fish. 325; s. c. 4 Blatch. 200; *Bell v. Daniels*, 1 Fish. 372; s. c. 1 Bond 212; *Latta v. Shawk*, 1 Fish. 465; s. c. 1 Bond 259; *Singer v. Walmsley*, 1 Fish. 558; *Lee v. Blandy*, 2 Fish. 89; s. c. 1 Bond 361; *Bean v. Smallwood*, 2 Story 408; s. c. 2 Robb 133; *Vance v. Campbell*, 1 Fish. 483; s. c. 1 Black 427; *Silsby v. Foote*, 1 Blatch. 445; s. c. 14 How. 218; *Howe v. Abbott*, 2 Story 190; s. c. 2 Robb 99; *McCormick v. Talcott*, 20 How. 402; s. c. 6 McLean 539; *Evans v. Eaton*, 1 Pet. C. C. 322; s. c. 3 Wheat. 454; s. c. 1 Robb 68, 243; *Brooks v. Bicknell*, 4 McLean 70; *Brooks v. Jenkins*, 3 McLean 432; *Parker v. Haworth*, 4 McLean 370; s. c. 2 Robb 725; *Foss v. Herbert*, 2 Fish. 31; s. c. 1 Biss. 121; *Pitts v. Wemple*, 6 McLean 558; *Hale v. Stimpson*, 2 Fish. 565; *Many v. Sizer*, 1 Fish. 17; *Dodge v. Card*, 2 Fish. 116; s. c. 1 Bond 393; *Pitts v. Wemple*, 2 Fish. 10; s. c. 1 Biss. 87; *Crompton v. Belknap Mills*, 3 Fish. 536; *Fisher v. Craig*, 3 Saw. 69; s. c. 1 Ban & Ard. 365; *Haselden v. Ogden*, 3 Fish. 378; *Washing Machine Co. v. Tool Co.*, 20 Wall. 342; s. c. 1 Holmes 161; *Roberts v. Harnden*, 2 Cliff. 500; *Bridge v. Brown*, 6 Fish. 236; s. c. 1 Holmes 205; 3 O. G. 121; *Nicholson Co. v. Hatch*, 3 Fish. 432; s. c. 4 Saw. 692; *Brown v. Hinkley*, 6 Fish. 370; s. c. 3 O. G. 384; *Wood Paper Co. v. Fibre Co.*, 3 Fish. 362; s. c. 6 Blatch. 27; *Cammeyer v. Newton*, 12 Blatch. 122; s. c. 5 O. G. 753; 11 O. G. 287; s. c. 94 U. S. 225; s. c. 1 Ban & Ard. 294; *Blanchard v. Putnam*, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond 84; *Dunbar v. Myers*, 11 O. G. 35; s. c. 94

U. S. 187; *Fuzzard Manuf. Co. v. Dickinson*, 3 Fish. 289; s. c. 6 Blatch. 80; *Densmore v. Schofield*, 4 Fish. 148; *Heald v. Rice*, 21 O. G. 1443; s. c. 104 U. S. 737; s. c. 13 Pac. L. R. 33; *Rich v. Close*, 4 Fish. 279; s. c. 8 Blatch. 41; *Reedy v. Scott*, 23 Wall. 352; s. c. 7 O. G. 463; *Coolidge v. McCone*, 2 Saw. 571; s. c. 5 O. G. 458; 1 A. L. T. (N. S.) 214; s. c. 1 Ban & Ard. 78; *Sanford v. Merrimac Hat Co.*, 10 O. G. 466; s. c. 4 Cliff. 404; *Eddy v. Dennis*, 95 U. S. 560; s. c. 4 Fish. 423; *Sands v. Wardwell*, 3 Cliff. 277; *Schumacher v. Cornell*, 96 U. S. 549; *Craig v. Smith*, 4 Dillon 349; s. c. 1 Ban & Ard. 556; 2 Cent. L. J. 256; *Pearl v. Appleton Co.*, 5 Ban & Ard. 553; s. c. 3 Fed. Rep. 153; *Faurot v. Hawes*, 3 Fed. Rep. 456; *Gage v. Herring*, 23 O. G. 2119; s. c. 14 Blatch. 293; s. c. 12 O. G. 753; s. c. 3 Ban & Ard. 55; *Water Meter Co. v. Desper*, 101 U. S. 332; *Wicke v. Ortrum*, 19 O. G. 867; *Fay v. Preble*, 14 Fed. Rep. 652; s. c. 15 C. L. N. 122; *Goss v. Cameron*, 23 O. G. 741; s. c. 14 Fed. Rep. 576; *Matteson v. Caine*, 8 Saw. 498.

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

A patentee can not repudiate one of the parts of his combination after another inventor has taught him how to dispense with it. *Hale v. Simpson*, 2 Fish. 565; *Coolidge v. McCone*, 2 Saw. 571; s. c. 5 O. G. 458; 1 A. L. T. (N. S.) 214; s. c. 1 Ban & Ard. 78.

If a part is not an essential or material element of the invention, a party can not evade the patent by not using it, although the patent is for a combination. *Latta v. Shawk*, 1 Fish. 465; s. c. 1 Bond 259; *McWilliams Manuf. Co. v. Blundell*, 22 O. G. 177; s. c. 11 Fed. Rep. 419.

If a patentee claims a combination of certain elements or parts, none of them can be declared to be immaterial. The patentee makes them all material by the restricted form of his claim. *Water Meter Co. v. Desper*, 101 U. S. 332.

A party who uses all the elements of a combination is an infringer, although he uses others in addition. *Williams v. B. & A. R. R. Co.*, 16 O. G. 906; s. c. 17 Blatch. 21; s. c. 4 Ban & Ard. 441.

Where some parts of a combination are new and those parts are taken and used in the same manner but with different things from the rest of the combination patented, a part of the patented invention is taken, although the whole is not, and it is an infringement to that extent. *Sharp v. Tift*, 17 O. G. 1282; s. c. 18 Blatch. 132; s. c. 5 Ban & Ard. 399; s. c. 2 Fed. Rep. 697.

If the invention consists not only in the combination but in the improvement of several of the parts of which that combination is composed, the violation of one of them is an infringement. *Parker v. Haworth*, 4 McLean 370; s. c. 2 Robb 722; *Pitts v. Wemple*, 6 McLean 558; *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600; s. c. 3 Cliff. 639.

If a part only of a combination which separate from the rest is new and patentable, is taken, the taking of that part is an infringement *pro tanto*. *Adair v. Thayer*, 4 Fed. Rep. 441 ; s. c. 17 Blatch. 468 ; s. c. 5 Ban & Ard. 118.

If a patentee combines parts that are old, another may combine the same parts so long as he does not use the same combination. *Pattee v. Moline Plow Co.*, 22 O. G. 173 ; s. c. 10 Biss. 377 ; s. c. 9 Fed. Rep. 821 ; *Washburn & M. Manuf. Co. v. Griesche*, 16 Fed. Rep. 669.

No one can by combining several devices, each of which is old, thereby deprive others of the right to use them separately, or of the right to use them in new combinations, or of the right to use some of them in combination, omitting others. *Hailes v. Van Wormer*, 7 Blatch. 443 ; *Pattee v. Moline Plow Co.*, 22 O. G. 173 ; s. c. 10 Biss. 377 ; s. c. 9 Fed. Rep. 821.

If a change in the mode of arranging the elements of a combination produces a different and better result, there is no infringement. *Habeman v. Whitman*, 5 Ban & Ard. 530.

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

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

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

Although a party in lieu of one element in a combination uses another element which accomplishes the same result in the same mode of operation and in addition to it performs other functions which are novel and useful, yet the substitute is in law an equivalent for the element so omitted. *Zeun v. Kaldenberg*, 23 O. G. 2514 ; s. c. 16 Fed. Rep. 539 ; *Maynadier v. Tenney*, 2 Ban & Ard. 615.

If a party uses all the parts of a combination but one, and for that substitutes another mechanical structure substantially different in its construction and operation, he is not guilty of an infringement. It is not the same combination if it substantially differs from it in any of its parts. *Eames v. Godfrey*, 1 Wall. 78 ; *Merriam v. Drake*, 5 Fish. 259 ; s. c. 9 Blatch. 336 ; *Prouty v. Ruggles*, 16 Pet. 336 ; s. c. 1 Story 568 ; s. c. 2 Robb 75, 92 ; *Knox v. Murtha*, 5 Fish. 174 ; s. c. 9 Blatch. 205 ; *Stimson v. Balt. & Sus. R. R. Co.*, 10 How. 329 ; *Eddy v. Dennis*, 95 U. S. 560 ; 4 Fish. 423 ; *Smith v. Marshall*, 10 O. G. 375 ; s. c. 2 Ban & Ard. 371 ; *Densmore v. Schofield*, 4 Fish. 148 ; *American Pavement Co. v. Elizabeth*, 4 Fish. 189 ; *American B. L. Co. v. Barnes*, 9 Fed. Rep. 465.

If the patentee limits one element of his combination to a certain material, a combination containing the element made of another material is not an infringement. *Harris v. Allen*, 15 Fed. Rep. 106 ; s. c. 15 C. L. N. 174.

If a substance was not known as a substitute for an element in a combination at the time of the invention thereof, the use of it in lieu of the element is not an infringement. *Colgate v. Law Tel. Co.*, 5 Ban & Ard. 437.

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

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

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

The essential character of a machine is not varied by a mutual interchange of form and direction between the two elements of which it is a combination, while both object and effect remain as before. *Wilson v. Barnum*, 2 Fish. 635 ; s. c. 1 Wall. Jr. 347 ; 8 How. 258 ; s. c. 2 Robb 749.

Although the patentee is the inventor of one part of a combination, still if it is only claimed in combination with the other parts, a party does not infringe the patent unless he uses the whole combination. *Foster v. Moore*, 1 Curt. 279 ; *Rowell v. Lindsay*, 19 O. G. 1565 ; s. c. 10 Biss. 217 ; s. c. 6 Fed. Rep. 290.

A change of location of a part in a combination will not evade a patent if no new function is performed by the changed member in its new location. *Adams v. Joliet Manuf. Co.*, 12 O. G. 91 ; s. c. 3 Ban & Ard. 1 ; *Knox v. Great W. Q. Mining Co.*, 1½ O. G. 897.

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

If the subsequent combination is new, or if the ingredient substituted for the one withdrawn is a newly discovered one, or even an old one performing some new function, and was not known at the date of the patent as a proper substance for the ingredient withdrawn, there is no infringement, for a new combination or a newly discovered ingredient substituted for the one omitted, or even an old one performing a new function not known at the date of the patent as a proper substitute for the one withdrawn, is not an equivalent for the ingredient omitted within the meaning of the patent law. *Gould v. Rees*, 6 Fish. 106 ; s. c. 15 Wall. 187 ; 2 O. G. 624 ; *Crompton v. Belknap Mills*, 3 Fish. 536 ; *Fuller v. Yentzer*, 11 O. G. 597 ; s. c. 94 U. S. 299 ; s. c. 1 Ban & Ard. 520 ; *Seymour v. Osborne*, 3 Fish. 555 ; s. c. 11 Wall. 516.

A slight or immaterial change in the ingredients of a compound or in

the manner of preparing them will not relieve the party from the charge of infringing. If, for example, a man were to use the ingredients specified in the patent, and were to add a small portion of some other article, or were to vary the proportions so that the result would not be materially changed, it would be an infringement. *Matthews v. Skates*, 1 Fish. 602; *Woodward v. Morrison*, 5 Fish. 357; s. c. 1 Holmes 124; 2 O. G. 120; *Ryan v. Goodwin*, 3 Sum. 514; s. c. 1 Robb 725; *Goodyear v. Gutta Percha Co.*, 2 Fish. 312; *Wood Paper Co. v. Fibre Co.*, 3 Fish. 362; s. c. 6 Blatch. 27; *Atlantic G. P. Co. v. Mowbray*, 12 O. G. 111.

If the defendant uses an article that was not known as an equivalent at the date of the patent in substitution for another in a compound, there is no infringement, although the article contains the chemical elements which constitute the other in a new chemical combination. *Wonson v. Gilman*, 11 O. G. 1011; s. c. 2 Ban & Ard. 590.

Process.

If the patent is for a process, the manufacture and sale of an article made according to the process is an infringement. *Bridgeport Wood Finishing Co. v. Hooper*, 5 Fed. Rep. 63; 18 Blatch. 459; s. c. 20 O. G. 156.

If a process omits one of the elements in the patented process and does not employ an equivalent therefor, it is not an infringement. *Dittmar v. Rix*, 17 O. G. 973; s. c. 5 Ban & Ard. 240; s. c. 1 Fed. Rep. 342; *Cotter v. New Haven C. Co.*, 13 Fed. Rep. 234; *Hammerschlag v. Garrett*, 21 O. G. 1199; s. c. 10 Fed. Rep. 479.

If the product is new and independent of the process, a patent therefor is infringed by the manufacture of the new product by any mode of manufacture. *Anilin Fabrik v. Hamilton Manuf. Co.*, 13 O. G. 273; s. c. 3 Ban & Ard. 235.

A patent for a method of doing certain work is not infringed unless the work is done in substantially the same manner and by substantially the same mechanism. *Goss v. Cameron*, 23 O. G. 741; s. c. 14 Fed. Rep. 546.

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

It would seem that where a patent is obtained without a claim to the invention of the machinery through which a valuable result is produced, a precise specification is required, and the test of infringement is whether the defendant has used substantially the same process to produce the same result. *Le Roy v. Tatham*, 14 How. 156 ; s. c. 2 Blatch. 474.

Licensee.

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

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

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

If the right of a licensee is conditional upon the payment of the consideration, and he combines with an infringer to use a machine without complying with his contract, he will be deemed to have abandoned his contract. *Steam Cutter Co. v. Sheldon*, 5 Fish. 475 ; s. c. 10 Blatch. 1.

If contiguous lines are not prohibited from carrying messages by reason of their contiguity to the complainant's lines, there is no infringement of the rights of an assignee to a line between certain points when such contiguous lines transmit messages between those points by a circuitous route. *West. Tel. Co. v. Mag. Tel. Co.*, 21 How. 456 ; *West. Tel. Co. v. Penniman*, 21 How. 460.

If a licensee repudiates the license, he is an infringer. *Fetter v. Newhall*, 17 Fed. Rep. 841.

Purchasers.

The sale or use of the product of a patented machine is no violation of the exclusive right to use, construct, or sell the machine itself ; and the patent for a new and improved process by which any product or manufacture before known in commerce may be made in a cheaper and better manner, grants nothing but the exclusive right to use the particular process. Where a known manufacture or process is in the market, purchasers are not bound to inquire whether it was made on a patented machine or by a patented process. *Goodyear v. Central R. R. Co.*, 1 Fish. 626 ; s. c. 2 Wall. Jr. 356 ; *Boyd v. McAlpin*, 3 McLean 427 ; s. c. 2 Robb 277 ; *Pitcher v. U. S.*, 1 Ct. Cl. 7 ; *Boyd v. Brown*, 3 McLean 295 ; s. c. 2 Robb 203.

If the patent is for a process, a sale of the product is no infringement. *Merrill v. Yeomans*, 11 O. G. 970 ; s. c. 94 U. S. 568 ; s. c. 1 Holmes 331 ; s. c. 5 O. G. 267 ; s. c. 1 Ban & Ard. 47.

If the patentee is the discoverer or inventor of a new manufacture or composition of matter, it is clear that his franchise or sole right to use, and vend to others to be used, is the new composition or substance itself. The product and the process constitute one discovery. In such a case the use of the product is an infringement of the patent. *Goodyear v. Central R. R. Co.*, 1 Fish. 626; s. c. 2 Wall, Jr. 356.

Whether the inventor in any given case has a patent for the article manufactured, or only for the product or material of which it is composed, the unconditional sale of the manufactured article carries with it the absolute dominion over the material as well as over the manufactured article. Having manufactured the material, and sold it for a satisfactory compensation, whether as material or in the form of a manufactured article, the patentee, so far as that quantity of the product of his invention is concerned, has enjoyed all the rights secured to him by his letters patent, and the manufactured article, and the material of which it is composed, go to the purchaser for a valuable consideration, discharged of all the rights of the patentee previously attached to it, or impressed upon it by the statute under which the patent is granted. *Goodyear v. Beverly Rubber Co.*, 1 Cliff. 348.

The original patentee, in selling rights for counties or States, may, by a special covenant, prohibit the assignee from vending the product beyond the limits of his own exclusive right, but in such a case the remedy would be on the contract and not under the patent law, for the law protects the thing patented and not the product. *Boyd v. Brown*, 3 McLean 295; s. c. 2 Robb 203.

Although a licensee is restricted to the manufacture of the product for one particular purpose, yet when he sells his manufactures, the material of which they are composed passes to the purchaser discharged of the peculiar privileges secured by the patent. Absolute dominion over the material passes to the purchaser when the sale is made, and he is not obliged to keep the manufactures as waste articles, or throw them away when they cease to be of value as manufactures, but may use the material for any other lawful purpose to which it can be applied. *Goodyear v. Beverly Rubber Co.*, 1 Cliff. 348.

The grant of a machine is in law a grant of the use of it. If a party has the right to a machine and to the use of it, he may work it himself or by his agents, or lease it out to any other person. *Reutgen v. Kanowrs*, 1 Wash. C. C. 168; s. c. 1 Robb 1.

If one element of a combination is worn out, the machine is gone. A party who takes the remaining elements and uses them in a new machine is guilty of an infringement. *Craig v. Fisher*, 2 Saw. 345; s. c. 5 Pac. L. R. 52; *American C. T. Co. v. Bullard*, 17 Blatch. 160; s. c. 17 O. G. 389; s. c. 4 Ban & Ard. 520.

Second purchasers acquire the same rights as their vendor had, and may do with the article or its materials whatever the first purchaser could have lawfully done if he had not parted with the title. *Goodyear v. Beverly Rubber Co.*, 1 Cliff. 348.

A purchaser acquires an absolute, unconditional title to that which is the subject of a patent, and may continue to use it until it is worn out, or repair it, or improve upon it as he pleases, in the same manner as if dealing with any other kind of property. *Goodyear v. Beverly Rubber Co.*, 1 Cliff. 348; *Union M. C. Co. v. U. S. C. Co.*, 11 O. G. 1113; s. c. 2 Ban & Ard. 593; *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; *Gottfried v. C. Seip B. Co.*, 10 Biss. 368; s. c. 8 Fed. Rep. 322.

When a repair of a thing patented is of itself a new manufacture embracing all parts of the patented combination, it is an infringement. *Goodyear D. V. Co. v. Preterre*, 14 O. G. 346; s. c. 15 Blatch. 274; s. c. 3 Ban & Ard. 471.

If the identity of the old machine was destroyed and the machine now used is substantially a new construction, there is an infringement. *Gottfried v. P. Best B. Co.*, 17 O. G. 675; s. c. 5 Ban & Ard. 4.

Infringers.

The only persons who can be held for damages are those who own or have some interest in the business of making, using or selling the thing which is an infringement. *United Nickel Co. v. Worthington*, 23 O. G. 939; s. c. 13 Fed. Rep. 392.

A sheriff who merely sells the materials of which a patented machine is composed, under an execution against the patentee, is not liable for an infringement. The purchaser merely buys the materials with the right to apply them in such manner as the law allows, and acts at his peril. *Sawin v. Guild*, 1 Gallis. 485; s. c. 1 Robb 47.

Although an administrator sells articles which infringe a patent, yet he is not liable in his representative capacity. *Thompson v. Canterbury*, 12 Fed. Rep. 485.

A party who uses a patented hotel register containing advertisements is an infringer, and not merely the advertisers. *Hawes v. Washburne*, 5 O. G. 491; *Hawes v. Gage*, 5 O. G. 494.

A party who buys and sells the product of a patented machine under a real contract with the manufacturer, is not liable for an infringement. *Keplinger v. De Young*, 10 Wheat. 358; s. c. 1 Robb 458.

If the contract is not a real one, or does not constitute the sole connection between the parties, or the transaction is merely colorable, with a view to evade the law, the purchaser of the product will be liable. *Keplinger v. De Young*, 10 Wheat. 358; s. c. 1 Robb 458.

A person who sells the patented invention on commission is liable as an infringer. *Steiger v. Heidelberger*, 18 Blatch. 426; s. c. 18 O. G. 1463; s. c. 4 Fed. Rep. 455.

A suit may be instituted against a person who sells the patented invention on commission, although an action is pending against his principal. *Steiger v. Heidelberger*, 18 Blatch. 426; s. c. 18 O. G. 1463; s. c. 4 Fed. Rep. 455.

A party who employs another to make the thing patented is an infringer. *Andrews v. Creegan*, 19 O. G. 1146 ; s. c. 19 Blatch. 113 ; s. c. 7 Fed. Rep. 477.

Although a workman furnishes his own tools and is paid by the piece, yet the employer is liable if the workman uses the thing patented in doing the work. *Wooster v. Marks*, 17 Blatch. 368 ; s. c. 5 Ban & Ard. 56.

Although persons form an organization and take out a certificate of incorporation under a State law, yet they are liable for an infringement. *St. Louis Stamping Co. v. Quinby*, 18 O. G. 571.

The directors and stockholders of a corporation are not liable for an infringement committed by the corporation. *United Nickel Co. v. Worthington*, 23 O. G. 939 ; s. c. 13 Fed. Rep. 392.

If an officer of a corporation owns all the stock, he is personally liable for the profits made by the corporation in infringing a patent. *Smith v. Standard L. M. Co.*, 25 O. G. 393.

The statute does not embrace every workman who may be employed in making parts of a patented machine, or one who may sell them as the shopman or clerk of another. The maker and seller intended by the statute is the principal who employs these subordinate agents, the person for whom, by whose direction and on whose account the machines are made and sold, the person who receives the profits of the sale, he is the seller and the maker. It is he who claims title and property in the thing, and who undertakes to transfer it to the purchaser. The workmen employed by him for stipulated wages have nothing to do with his right or with his invasion of the rights of another. They work under his direction and sell on his account. *Delano v. Scott*, Gilp. 489 ; s. c. 1 Robb 700 ; *United Nickel Co. v. Worthington*, 23 O. G. 939 ; s. c. 13 Fed. Rep. 392 ; *Williams v. Empire Trans. Co.*, 14 O. G. 423 ; s. c. 3 Ban & Ard. 533.

The agent of a transit company, for making contracts for freight, is not liable to an action at law for the use of a patented article upon the cars used in carrying the freight, if he has no authority to direct whether the patented article shall be used on the cars or not. *Lightner v. Kimball*, 1 Lowell 211.

A party who sells the thing patented as agent for another is an infringer. *Morse v. Davis*, 5 Blatch. 40 ; *Potter v. Crowell*, 3 Fish. 112 ; s. c. 1 Abb. U. S. 89.

A party who constructs a patented machine is liable for an infringement, although he was employed by another. *Bryce v. Dorr*, 3 McLean 582 ; s. c. 2 Robb 302.

A person who lets his tools and machinery to another who makes articles that infringe the patent is not liable as an infringer. *Starrett v. Athol Machine Co.*, 23 O. G. 1729 ; s. c. 14 Fed. Rep. 910.

When one in the employ of a corporation does an act in the business of his employment for the benefit of the corporation, which it adopts and approves and takes advantage of, it will be deemed to have authorized the act, and will be as much bound by it as though expressly authorized. *Poppenhusen v. Gutta Percha Comb Co.*, 2 Fish. 62.

Where a corporation acting in that character directs an act to be done which infringes the rights of a patentee, it may be sued in an action on the case. *Kneass v. Schuylkill Bank*, 4 Wash. C. C. 9; s. c. 1 Robb 303.

If the liability of a municipal corporation to suit is limited to cases of contract, it can not be sued for an infringement. *Jacobs v. Commissioners*, 4 Fish. 81; s. c. 1 Bond 500; *Allen v. Brooklyn*, 4 Fish. 598; s. c. 8 Blatch. 535.

If the machine used by the fire department is obtained at the expense of the municipal corporation, the corporation is liable for the infringement, although the fire department may be for certain purposes a distinct corporation, and possibly, to some extent, independent of the action of the corporation of the city in its entire corporate capacity. *New York v. Ransom*, 1 Fish. 252; s. c. 23 How. 487; *Bliss v. Brooklyn*, 4 Fish. 596; s. c. 8 Blatch. 533.

Although a department is an independent corporation, yet if it is the mere agent of a municipal corporation, the latter is liable for an infringement by the former. *Brickill v. New York*, 18 O. G. 463; s. c. 18 Blatch. 273; s. c. 5 Ban & Ard. 544; s. c. 7 Fed. Rep. 479.

Although a municipal corporation derives its authority from the State, yet it is liable for an infringement. *Allen v. New York*, 17 O. G. 1281; s. c. 17 Blatch. 350.

If one public corporation buys the articles and another pays for them, both are liable for the infringement. *Allen v. New York*, 17 O. G. 1281; s. c. 17 Blatch. 350.

Where parties contract for implements, machines, or structures to contain a patented article, without any knowledge that the contractor is an infringer, or intends to use the thing patented without authority, it is not the just and legal implication from the contract, that the party ordering the article contemplates that the contractor will violate the rights of the patentee, or that he thereby commands or directs an infringement. An agent of a corporation, who merely makes a contract for the construction of cars containing the thing patented, is not liable as an infringer. *Lightner v. Brooks*, 2 Cliff. 287.

If a contractor violates the patent right of another he is answerable for the infringement. He can not defend himself against the claim by asserting that he committed the wrong under a contract. *Jacobs v. Commissioners*, 4 Fish. 81; s. c. 1 Bond 500.

All the parties guilty of a tort are deemed principals. *Baldwin v. Sibley*, 1 Cliff. 150.

The general rule of the common law is *volenti non fit injuria*, and in accordance with this maxim no one can maintain an action for a wrong, where he has consented or contributed to the act of which he complains. It is true that in general the law imports damage from the violation of a right, but damage has never been presumed by law, from an act in which the plaintiff co-operated. *Byam v. Bullard*, 1 Curt. 100.

No sale is an infringement within the meaning of the statute, except one which is within the terms of the grant contained in the letters patent.

which is a grant of an exclusive right to make, use, and vend to others to be used. A sale to the patentee's agent is a sale to him, and such a sale is not *per se* an infringement. *Byam v. Bullard*, 1 Curt. 100.

If the patentee's agent purchased the patented article at a shop where it and similar articles may be expected to be found for sale, and if it was sold to him in the usual course of the trade there, and if he saw others exposed for sale, it would be a natural inference that this was not the only article sold. *Byam v. Bullard*, 1 Curt. 100.

Although the patentee directed the purchase of the article, the sale of which is claimed to be an infringement, yet if the sale was made in the usual course of the respondent's business, it is evidence that he is dealing in those articles. *De Florez v. Reynolds*, 14 Blatch. 505; s. c. 3 Ban & Ard. 292.

A person who is employed by the patentee to ascertain whether a party who has been enjoined is violating the injunction, and who thereupon buys the thing patented from the party, is not liable in an action to him for communicating the facts to the patentee. *Knowles v. Peck*, 42 Conn. 386.

If a patentee acquiesces in the sale of a machine without restriction he is estopped from afterwards claiming that it is an infringement. *Detweiler v. Voegel*, 19 Blatch. 482; s. c. 8 Fed. Rep. 600.

If a patentee becomes agent for another with whom he has made a contract for the manufacture of his machines, and in that capacity sells one and receives a part of the proceeds, he is estopped from alleging that the use of that machine is an infringement. *Downton v. Yaeger Milling Co.*, 9 Fed. Rep. 403.

An officer of the government is liable for an infringement, although he acted as officer in the performance of his duties for the benefit of the government. *Campbell v. James*, 17 Blatch. 43; s. c. 4 Ban & Ard. 456; s. c. 18 O. G. 979.

The workmen and employes of the government who do work for it in a specific form by the orders of the government, can not be held liable for infringing a patent in doing such work. *Heaton v. Quintard*, 7 Blatch. 73.

The government can not make use of a patented improvement any more than a private individual without a license of the inventor or making compensation to him. *U. S. v. Burns*, 12 Wall. 246; *Cammeyer v. Newton*, 12 Blatch. 122; s. c. 5 O. G. 753; 11 O. G. 287; s. c. 94 U. S. 225; s. c. 1 Ban & Ard. 294.

A contractor who has agreed to furnish articles to the government can not use a patented invention without license of the inventor. *Atlantic Works v. Brady*, 23 O. G. 1330; s. c. 4 Cliff. 408; s. c. 2 Ban & Ard. 436; s. c. 10 O. G. 702; *Cammeyer v. Newton*, 12 Blatch. 122; s. c. 5 O. G. 753; 11 O. G. 287; s. c. 94 U. S. 225; s. c. 1 Ban & Ard. 294.

Although a party has a license to make the patented article, yet, if he buys and sells them when made by others, the parties who buy from him are infringers. *Searls v. Bouton*, 21 O. G. 1784; s. c. 12 Fed. Rep. 140.

A party who sells an extract to be used by others in a compound is

liable as an infringer as well as those who actually use the compound. *Bowker v. Dows*, 15 O. G. 510; s. c. 3 Ban & Ard. 518. .

Although a party who made a machine with the consent of the patentee sells it after the expiration of the patent, yet there is no infringement. *Reay v. Rau*, 23 O. G. 1928; s. c. 15 Fed. Rep. 749.

It is no infringement to make or fashion the articles which are to form a patented armor, for they do not become armor until they are put on the vessel. *Heaton v. Quintard*, 7 Blatch. 73.

The mere manufacture of a separate element of a patented combination is not in and of itself an infringement, unless it is conducted with the intent of aiding an infringement. *Saxe v. Hammond*, 1 Holmes 456; s. c. 7 O. G. 781; s. c. 1 Ban & Ard. 629.

If one person manufacturing one part of a combination acts in concert with another who manufactures the other part, they will be deemed joint infringers. *Wallace v. Holmes*, 5 Fish. 37; s. c. 9 Blatch. 65; 1 O. G. 117; *Coolidge v. McCone*, 2 Saw. 571; s. c. 5 O. G. 458; 1 A. L. T. (N. S.) 214; s. c. 1 Ban & Ard. 78.

If a party manufactures one important part of a combination, without any actual prearrangement with another to manufacture the other part, each sale is a proposal to the purchaser to supply the other part, and renders the manufacturer an infringer. *Turrell v. Spaeth*, 8 O. G. 986; s. c. 2 Ban & Ard. 185; *Wallace v. Holmes*, 5 Fish. 37; s. c. 9 Blatch. 65; 1 O. G. 117; *Renwick v. Pond*, 5 Fish. 569; s. c. 10 Blatch. 39; 2 O. G. 392; *Richardson v. Noyes*, 10 O. G. 507; s. c. 2 Ban & Ard. 398; *New York B. & B. Co. v. Hoffman*, 20 O. G. 1450; s. c. 9 Fed. Rep. 199.

If the patent is limited to the use of an article in a certain connection, a party who manufactures the article is not an infringer, although others do so use it. *Keystone Bridge Co. v. Iron Co.*, 5 Fish. 468; s. c. 1 O. G. 471; 9 Phila. 374.

If a part of a combination is susceptible of use in other ways, a party who manufactures it is not, in the absence of proof of a conspiracy, liable as an infringer. *Coolidge v. McCone*, 2 Saw. 571; s. c. 5 O. G. 458; 1 A. L. T. (N. S.) 214; s. c. 1 Ban & Ard. 78; *Campbell v. Kavanaugh*, 11 Fed. Rep. 83; *Maynard v. Pawling*, 18 O. G. 244; s. c. 5 Ban & Ard. 551; s. c. 3 Fed. Rep. 711.

If the patent is for the use of a certain compound, as a substitute for leaven in the preparation of farinaceous food, a person who prepares and sells self-raising flour containing the ingredients, with the intent and purpose of enabling the buyer to turn the compound into bread by the use of water and heat, is an infringer. *Rumford Chemical Works v. Hecker*, 10 O. G. 289; s. c. 2 Ban & Ard. 351.

If one joint owner of a patent uses an infringing device he is liable to the other owners. *Herring v. Gas Consumers Association*, 21 O. G. 203; s. c. 3 Ban & Ard. 253; s. c. 13 O. G. 637; s. c. 9 Fed. Rep. 556.

No Fixed Measure of Damages.

A patentee whose rights are infringed has his election of remedies. He may treat the infringer who illegally appropriates the invention to his own use, making profit thereby, as his trustee in respect of such profits, and compel him to account therefor in equity. On the other hand, the patentee may sue at law for the damages which he has sustained, and those damages he is entitled to recover, whether the defendant has made any profits or not. In such an action it is precisely what is lost to the patentee, and not what the defendant has gained, which is the legal measure of damages to be awarded. *Cowing v. Rumsey*, 4 Fish. 275; s. c. 8 Blatch. 36.

It must be apparent that there cannot be any one rule of damages which will equally apply to all cases. The mode of ascertaining actual damages must necessarily depend on the peculiar nature of the monopoly granted. An inventor may find his profit to consist in a close monopoly, forbidding any one to compete with him in the market, the patentee being himself able to supply the whole demand at his own price. If any person could use the invention or discovery by paying what a jury might suppose to be the fair value of a license, it is plain that competition would destroy the whole value of the monopoly. In such a case the profit of the infringer may be the only criterion of the actual damage of the patentee. But one who invents some improvement in the machinery of a mill could not claim that the profits of the whole mill should be the measure of damages for the use of his improvement. Where the profits of the patentee consist neither in the exclusive use of the thing invented or discovered, nor in the monopoly of making it for others to use, it is evident that this rule could not apply. The only actual damage which the patentee suffers in such a case is the non-payment of the price which he puts on his license, with interest, and no more. There may be cases, as where the thing has been used but for a short time, in which the jury should find less than that sum, and there may be cases where, from some peculiar circumstances, the patentee may show actual damages to a larger amount. Of this a jury must judge from the evidence, under instructions from the court, that they can find only such damages as have actually been proved to have been sustained. Where an inventor finds it profitable to exercise his monopoly by selling licenses to make or use his improvement, he has himself fixed the average of his actual damage when his invention has been used without his license. If he claims anything above that amount, he is bound to substantiate his claim by clear and distinct evidence. It is only where from the peculiar circumstances of the case, no other rule can be found, that the defendant's profits become the criterion of the patentee's loss. Actual damages must be actually proved, and can not be assumed as a legal inference from any facts which amount not to actual proof of the fact. What a patentee would have made if the infringer had not interfered with his rights is a question of fact and not a judgment of law. The question is not what speculatively he may have lost, but what actually he did lose. The

rule of damages must not be such as would be better entitled to the epithet of "speculative," "imaginary," or "fanciful," than that of "actual." *Seymour v. McCormick*, 16 How. 480; s. c. 2 Blatch. 240.

The jury are to give the actual damages which the patentee has sustained, not vindictive or speculative damages, but such damages as the patentee by his proofs shows that he has actually sustained by the infringement of his patent. *New York v. Ransom*, 1 Fish. 252; s. c. 23 How. 487; *Wilbur v. Beecher*, 2 Blatch. 132; *Teese v. Phelps*, 1 McAl. 48; *Haselden v. Ogden*, 3 Fish. 378; *Parker v. Hulme*, 1 Fish. 44; *Russell v. Place*, 5 Fish. 134; s. c. 9 Blatch. 173; *Kneass v. Schuylkill Bank*, 4 Wash. C. C. 9; s. c. 1 Robb 303; *Hall v. Wiles*, 2 Blatch. 194; *Whittemore v. Cutter*, 1 Gallis. 478; s. c. 1 Robb 40.

The true course is to leave the jury at large to estimate the actual damages according to the circumstances of each particular case. The price of the machine, the nature, actual state and extent of the use of the patentee's invention, and the particular losses to which he may have been subjected by the piracy, are all proper ingredients to be weighed by the jury in estimating the damages. *Earle v. Sawyer*, 4 Mason 1; s. c. 1 Robb 491; *Carr v. Rice*, 1 Fish. 198; *Hubbell v. U. S.*, 5 Ct. Cl. 1.

Defendant's Profits.

The damages sustained by the patentee, and not another's gain, is made the rule, but the profit made by the defendant is a fair and legal subject for the calculation and judgment of the jury. Although the profit is not the amount to be recovered as damages, yet it is that from which a calculation or estimate of that damage may be rightfully made. *Whitney v. Emmett*, Bald. 303; s. c. 1 Robb 567; *Parker v. Banker*, 6 McLean 631; *Cowing v. Rumsey*, 4 Fish. 275; s. c. 8 Blatch. 36; *Carter v. Baker*, 4 Fish. 404; s. c. 1 Saw. 512.

There is no unbending or unyielding rule of damages, though that usually recognized as the true rule has been to give to the patentee as damages the amount of profits which the defendant has derived from the use of the invention, not the amount which he might have realized, or which he made from the use of improvements other than those of the patentee, but what he actually did make by the use of the invention as patented. *Bell v. Daniels*, 1 Fish. 372; s. c. 1 Bond 212; *Latta v. Shawk*, 1 Fish. 465; s. c. 1 Bond 259; *Wintermute v. Redington*, 1 Fish. 239; *Matthews v. Skates*, 1 Fish. 602; *Case v. Brown*, 2 Fish. 268; s. c. 2 Wall. 320; 1 Biss. 382; *Hall v. Wiles*, 2 Blatch. 194; *Sickels v. Borden*, 3 Blatch. 535; *Buck v. Hermance*, 1 Blatch. 398; *Pitts v. Edmonds*, 2 Fish. 52; s. c. 1 Biss. 168; *Page v. Ferry*, 1 Fish. 298.

The rule of damages is the profits which have been derived to the defendant by means of the invention over any other mode which the defendant had a right to adopt. *Serrell v. Collins*, 1 Fish. 289; *Cox v. Griggs*, 2 Fish. 174; s. c. 1 Biss. 362; *Wilbur v. Beecher*, 2 Blatch. 132; *Tilghman v. Werk*, 2 Fish. 229; s. c. 1 Bond 511; *Smith v. Pearce*, 2 McLean 176; s. c. 2 Robb 13.

The true criterion is the advantage which the defendant obtained, or might by skill have obtained, by using the patented device over the use of the old device, and the value of this advantage in money. *Campbell v. Barclay*, 5 Biss. 179.

If the patentee has taken certain elements before known, and combined them, and applied them to other parts of a machine constructed after his own fashion, and made the machine in question as a whole, he is entitled to recover the profits made upon the entire machine. *Carter v. Baker*, 4 Fish. 404 ; s. c. 1 Saw. 512.

If any portion of the profits is properly to be credited to an improvement made by the defendant, the burden rests upon him to show affirmatively that fact, and how much of the profits ought to be credited to the improvement and deducted from the profits of the sale of the whole machine as improved, for he has caused the confusion of rights. *Carter v. Baker*, 4 Fish. 404 ; s. c. 1 Saw. 512.

If any of the profits arose from an improvement made by the defendant, they do not belong to the patentee. *Carter v. Baker*, 4 Fish. 404 ; s. c. 1 Saw. 512.

The profit made by the defendant, and that lost by the patentee, are among the elements which the jury may consider. *Philp v. Nock*, 17 Wall. 460.

The extent of the benefits accruing directly to the defendant should undoubtedly form an element for consideration when the question of damages is considered. If the invention is valuable, and the defendant, by its use, has diminished his expenses, the jury are at liberty to infer that if he had admitted the patentee's rights he would have paid the amount thus saved, or a large portion of it, as the consideration for a license to use the invention, rather than abandon its use, and that the patentee has therefore lost by the infringement what the defendant would have so paid to secure such license. It is for this reason that the benefits received by the defendant from the use of the invention in the consequent reduction of his expenses, are proper subjects for consideration in determining the patentee's damages. *New York v. Ransom*, 1 Fish. 252 ; s. c. 23 How. 487.

The profits realized by the defendant are proper to be taken into consideration, but are not conclusive as to the extent of the injury, which may be either greater or less. A patentee may be manufacturing his patented article himself, and making it to a profit, while another man may make it to a disadvantage, and yet the spurious article carried into the market may displace the original. In such case the injury to the patentee would be greater than any profit upon the spurious production. On the other hand a defendant's article may not displace the original, and in that case the injury would be less. It may be that a patentee may derive a profit from licensing other parties to construct his invention, and any piracy upon it by depriving him of any portion of the profits of such licenses would be an injury to be taken into account. A party concerned in infringing a patent stands in a different position from the patentee, not having been

previously subjected to the expense and labor to which the latter is frequently exposed, in the process of invention and experiment. Hence the person who enters upon the business without previous expense may very well afford to sell machines at less profit than the patentee. The latter must have his profit not only for the expense of putting in operation the improvement, but by way of indemnity for the previous time, labor and money which he has been obliged to bestow on the invention. He must, therefore, charge a higher price to cover these greater expenses. *Pitts v. Hall*, 2 Blatch. 229 ; *Campbell v. Barclay*, 5 Biss. 179 ; *Many v. Sizer*, 1 Fish. 17.

If the patentee claims the privilege of selling at a higher rate, the probabilities of his having been able to sell as many machines at a higher price, or as many at any price, as were sold by him and the defendant together, should be taken into consideration. *Carter v. Baker*, 4 Fish. 404 ; s. c. 1 Saw. 512.

If the patentee has sustained other damages beyond the profits actually received by the defendant, he is entitled to recover them. *Carter v. Baker*, 4 Fish. 404 ; s. c. 1 Saw. 512.

Plaintiff's Loss.

In an action at law the profit which the plaintiff might have made is not the primary or controlling measure of damages. *Burdell v. Denig*, 92 U. S. 716.

Where profits are the proper measure of damages it is the profit which the infringer makes or ought to make, and not the profit which the plaintiff can show that he might have made, that governs the measure of damages. *Burdell v. Denig*, 92 U. S. 716.

The rule is to give the actual damage or loss incurred by reason of the infringement, and that is the profits which the patentee would have made if he had not been embarrassed by the interference of the defendant's machine, because the law presumes that the patentee would have had the patronage which was diverted by the defendant. The profits which the patentee has lost in consequence of the infringement afford, therefore, a criterion by which to determine the amount of damages he has sustained. *Le Roy v. Tatham*, 2 Blatch. 474 ; s. c. 14 How. 156 ; *Pitts v. Hall*, 2 Blatch. 229 ; *Wintermute v. Redington*, 1 Fish. 239 ; *McComb v. Brodie*, 5 Fish. 384 ; s. c. 1 Woods 153 ; 2 O. G. 117 ; *Morris v. Barrett*, 1 Fish. 461 ; s. c. 1 Bond 254 ; *Heald v. Rice*, 104 U. S. 737 ; s. c. 21 O. G. 1443 ; s. c. 13 Pac. L. R. 33 ; *Wayne v. Holmes*, 2 Fish. 20 ; s. c. 1 Bond 27.

The profits which the patentee might have made if he had made and sold the articles which the defendant manufactured and sold, are not conclusive evidence of the actual damages, for there must also be proof that the patentee was prepared to supply the articles, and was prevented from doing so by the competition of the defendant, and was thus limited, hindered, checked, or interfered with in his business, or otherwise actually

damaged to that amount. *Goodyear v. Bishop*, 2 Fish. 154; *Hawes v. Washburne*, 5 O. G. 491; *Magic Ruffle Co. v. Douglass*, 2 Fish. 330; *Teese v. Phelps*, 1 McAl. 48.

The profits lost to the patentee must be the direct and legitimate fruits of the patent. He may have sustained damages from his inability to sell other articles, but they are too remote. *Carter v. Baker*, 4 Fish. 404; s. c. 1 Saw. 512.

If the patent is for an entire machine, the patentee is entitled as damages to the profits he could have made in constructing and vending his machine, over and above the mere profits arising out of its manufacture, that is, the mere profits of its mechanical construction, and not the profits that grow out of the exclusive right to manufacture the invention under the patent. The latter belong to the patentee, while the former, the mere mechanical profits, are excluded from the damages. *Seymour v. McCormick*, 3 Blatch. 299; s. c. 19 How. 96.

If the right of a grantee is the mere right to construct the machine within certain limits, implying a right to sell outside of such limits, but without any right to use or authorize others to use the machine, the injury sustained by the grantee as the result of an infringement of his exclusive right is to be measured by the profit which he realized as a manufacturer from making it. *Jenkins v. Greenwald*, 2 Fish. 37; s. c. 1 Bond 126.

If the patentee prefers to sell the thing patented in one locality, he is entitled to the profits he might have made were it not for the infringement, although he accepted a royalty in another locality. *Heald v. Rice*, 104 U. S. 737; s. c. 21 O. G. 1443; s. c. 13 Pac. L. R. 33.

License Fee.

Profits are not the primary or true criterion of damages for infringement in an action at law. That rule applies eminently and mainly to cases in equity. On the other hand, a sale of licenses, or a royalty, constitutes the primary and true criterion of damages in an action at law. In the absence of satisfactory evidence of either class in the forum to which it is most appropriate, the other may be resorted to as one of the elements on which the damages may be ascertained. *Burdell v. Denig*, 92 U. S. 716; *Sickels v. Borden*, 3 Blatch. 535; *Hogg v. Emerson*, 11 How. 437; s. c. 2 Blatch. 1; *Colt v. Mass. Arms Co.*, 1 Fish. 108; *Goodyear v. Bishop*, 2 Fish. 154; *Philp v. Nock*, 17 Wall. 460; *Packet Co. v. Sickles*, 19 Wall. 611; *Seymour v. McCormick*, 16 How. 480; s. c. 2 Blatch. 240; *Burdell v. Denig*, 2 Fish. 588; *Seymour v. McCormick*, 3 Blatch. 209; s. c. 19 How. 96; *Proctor v. Brill*, 4 Fed. Rep. 415.

If the test of the license fee cannot be applied, the patentee is entitled to an amount which will compensate him for the injury to which he has been subjected by the piracy. *Philp v. Nock*, 17 Wall. 460.

Where the patented improvement has been used only to a limited extent and for a short time, the amount should be less than the license fee. *Birdsall v. Coolidge*, 93 U. S. 64; s. c. 10 O. G. 748; *Judson v. Bradford*, 16 O. G. 171; s. c. 3 Ban & Ard. 539.

The price for which the plaintiff has sold his rights to certain territory is no criterion by which to determine the amount of the damage sustained by an infringement in other territory. *Campbell v. Barclay*, 5 Biss. 179.

There are, no doubt, cases in which the license price may be a criterion, but there are few instances in which the patentee ought to be concluded by a former offer to sell. *Bell v. Daniels*, 1 Fish. 372; s. c. 1 Bond 212; *Parker v. Hulme*, 1 Fish. 44.

It is incumbent on the patentee to prove the amount of the license fee. *Burdell v. Denig*, 2 Fish. 588.

Divers Items.

If the patentee has sustained damages beyond those arising from the actual interference of the defendant in making and putting into market similar machines, he may recover them. The question of damage is very much at large, and rests in the sound discretion of the jury. *Seymour v. McCormick*, 2 Blatch. 240; s. c. 16 How. 480.

It is the making and selling to be used, and not the selling or buying, or making alone, for which full damages are usually given. *Hogg v. Emerson*, 11 How. 587; s. c. 2 Blatch. 1.

If a use of the machine is actually proved, the rule of damages should be the value of the use of such a machine during the time of the illegal use. *Whittemore v. Cutter*, 1 Gallis. 478; s. c. 1 Robb 40.

If the article made according to the patentee's invention is more valuable than when made according to the prior mode, this difference of value may be considered in estimating the damages. *Waterbury Brass Co. v. N. Y. Brass Co.*, 3 Fish. 43.

Where the counsel on both sides are content with a measure of damages prescribed by themselves, it is not usual or necessary for the court to interfere at all. *Earle v. Sawyer*, 4 Mason 1; s. c. 1 Robb 491.

If the patentee has been compelled to carry his stock over from one season to another, the value of the use of his capital may be taken into consideration. *Carter v. Baker*, 4 Fish. 404; s. c. 1 Saw. 512.

If the plaintiff has two patents, and sues only for an infringement of one, his recovery must be limited to the damages arising from the infringement of that patent alone, and the part of the price for which he could have sold the thing patented due to that patent alone is all that can be taken into consideration. *Carter v. Baker*, 4 Fish. 404; s. c. 1 Saw. 512.

Evidence of the utility and advantage of the invention over the old modes and devices that had been used for working out similar results is appropriate to aid in estimating the amount of damages. *Suffolk Co. v. Hayden*, 4 Fish. 86; s. c. 3 Wall. 315; *Smith v. Higgins*, 1 Fish. 537; *Waterbury Brass Co. v. N. Y. Brass Co.*, 3 Fish. 43.

The character or condition of the parties to the suit can not be taken into account in estimating the damages. *Suffolk Co. v. Hayden*, 4 Fish. 86; s. c. 3 Wall. 315.

Where an inventor has invented only an improvement, and there is a violation of his right under his patent to use that improvement in connection with the invention of others, or in connection with a machine previously known and used, his damages must be limited to the value of his improvement in connection with the other elements of the machine. That is a subject in regard to which it may be difficult to give definite proof, but the difficulty does not change the legal principle which applies. *Seymour v. McCormick*, 16 How. 480; s. c. 2 Blatch. 240; *Burdell v. Denig*, 2 Fish. 588; *Seymour v. McCormick*, 3 Blatch. 209; s. c. 19 How. 96.

Unless the jury is satisfied that the patentee has abandoned the privileges secured to him, his failure to bring suit against others infringing such patent should have no effect in reference to the question of damages. In other words, if he has dedicated his rights to the public, he can not recover at all; but if he has not, although he has failed to bring suits for the purpose of enforcing his rights, the jury can not reduce the damages which he has actually sustained, because the statute gives him his actual damages. *New York v. Ransom*, 1 Fish. 252; s. c. 23 How. 487.

Ignorance of the existence of the patent right does not furnish a reason for allowing no damages. *Hogg v. Emerson*, 11 How. 587; s. c. 2 Blatch. 1.

The intent not to injure never exonerates the party from all damages for the actual injury or encroachment, though it may mitigate them. *Hogg v. Emerson*, 11 How. 587; s. c. 2 Blatch. 1; *Parker v. Corbin*, 4 McLean 462; s. c. 2 Robb 736.

The jury, in estimating the damages, may take into account the interest, if they choose, and give it by way of damages. *Le Roy v. Tatham*, 2 Blatch. 474; s. c. 14 How. 156; *Seymour v. McCormick*, 2 Blatch. 240; s. c. 16 How. 480; *vide Silsby v. Foote*, 20 How. 378; s. c. 2 Blatch. 260.

The damages are not to be estimated for the whole term of the patent, but only for the period of the infringement, where the license fee is not taken as the measure of the damages. *Suffolk Co. v. Hayden*, 4 Fish. 86; s. c. 3 Wall. 315.

Where the infringement is confined to a part of the thing sold, the recovery must be limited accordingly. It can not be as if the entire thing were covered by the patent, or where that is the case, as if the infringement were as large as the monopoly. *Philp v. Nock*, 17 Wall. 460.

A patentee is not able to give the exact amount of damages that he has sustained with the utmost accuracy. It is not in his power. He does the best he can. If he is wrong in his calculation, the defendant can put him right. The defendant knows the profit he has made. *Conover v. Rapp*, 4 Fish. 57.

Neither expenses nor counsel fees incurred in the vindication of his rights can be allowed to the patentee as damages. *Blanchard's Factory v. Warner*, 1 Blatch. 258; *Whittemore v. Cutter*, 1 Gallis. 429; s. c. 1 Robb 28; *Philp v. Nock*, 17 Wall. 460; *Teese v. Huntingdon*, 23 How. 2; *Parker v. Hulme*, 1 Fish. 44; *Stimpson v. Railroads*, 1 Wall. Jr. 164;

s. c. 2 Robb 595 ; *Simpson v. Leiper*, 2 Whart. Dig. 363 ; *contra*, *Pierson v. Eagle Screw Co.*, 3 Story 402 ; s. c. 2 Robb 268 ; *Parker v. Corbin*, 4 McLean 462 ; s. c. 2 Robb 736 ; *Boston Manuf. Co. v. Fiske*, 2 Mason 119 ; s. c. 1 Robb 320 ; *Adams v. Edwards*, 1 Fish. 1 ; *Allen v. Blunt*, 2 W. & M. 121 ; s. c. 2 Robb 530 ; *Alden v. Dewey*, 1 Story 336 ; s. c. 2 Robb 17 ; *Washburn v. Gould*, 3 Story 122 ; s. c. 2 Robb 206 ; *Hays v. Sulsor*, 1 Fish. 532 ; s. c. 1 Bond 279.

The patentee can not claim damages for the use of an improvement upon his invention. *Sayles v. Railroad Company*, 2 Fish. 523 ; s. c. 1 Biss. 468.

No damages can be allowed except for the use prior to the date of the writ. *Suffolk Co. v. Hayden*, 4 Fish. 86 ; s. c. 3 Wall. 515.

There is no reason for granting a new trial on account of damages given according to a rate admitted by the party himself to be a proper one in his own case. *Earle v. Sawyer*, 4 Mason 1 ; s. c. 1 Robb 91.

If the damages are excessive the plaintiff may remit the excess. *Russell v. Place*, 5 Fish. 134 ; s. c. 9 Blatch. 173.

The damages can not exceed the amount claimed in the declaration. *Tucker v. Spaulding*, 13 Wall. 453 ; s. c. 1 O. G. 142 ; s. c. 5 Fish. 297 ; s. c. Deady 649 ; *Wirfans v. N. Y. & Harlem R. R. Co.*, 4 Fish. 1.

Reissue.

If a patent has been surrendered, the damages should be limited to such as accrued by the use of the machine after the new patent was granted. *Ames v. Howard*, 1 Sum. 482 ; s. c. 1 Robb 689 ; *Agawam Co. v. Jordan*, 7 Wall. 583.

If the patent is surrendered for defects in the specification, and a reissue granted, the defendant is liable for damages for any unlicensed use of the machine after the granting of the reissue, although his machine was put up before that time. A person purchasing property against the right of another, when the owner is without evidence of his title, can not hold or use it after the evidence of his superior right is acquired by the real owner. *Carr v. Rice*, 1 Fish. 198.

Nominal Damages.*

The damages must not rest in conjecture, but must be susceptible of proof and be actually proved. *Whitney v. Emmett*, Bald. 303 ; 1 Robb 567 ; *Philp v. Nock*, 17 Wall. 460 ; *Carter v. Baker*, 4 Fish. 404 ; s. c. 1 Saw. 512 ; *Tucker v. Spaulding*, Deady 649 ; s. c. 13 Wall. 453 ; 1 O. G. 144 ; s. c. 5 Fish. 297.

The burden of showing the extent of the damages rests upon the patentee. *Carter v. Baker*, 4 Fish. 404 ; s. c. 1 Saw. 512.

If the patentee rests his case after merely proving an infringement of his patent, he may be entitled to nominal damages, but no more. He can not call on a jury to guess out his case without evidence. Actual damages must be calculated, not imagined ; and an arithmetical calculation can not be made without certain data on which to make it. *Burdell v. Denig* 2

Fish. 588; *New York v. Ransom*, 1 Fish. 252; s. c. 23 How. 487; *Hall v. Bird*, 3 Fish. 595; s. c. 6 Blatch. 438; *Campbell v. Barclay*, 5 Biss. 179; *Proctor v. Brill*, 4 Fed. Rep. 415.

Where the law has given a right, and a remedy for the violation of it, such violation of itself imports damage; and in the absence of all other evidence, the law presumes a nominal damage to the party. *Whittemore v. Cutter*, 1 Gallis. 429, 478; s. c. 1 Robb 28, 40; *Poppenhusen v. Gutta Percha Comb Co.*, 2 Fish. 62.

It is competent for the jury to give nominal damages if they think that the patentee has acted in such a manner that the defendant has been misled. *Adams v. Edwards*, 1 Fish. 1; *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206.

For the mere making of a machine, without selling or using it, the damages would be nominal. *Carter v. Baker*, 4 Fish. 404; s. c. 1 Saw. 512.

If the defendant has constructed but few machines after he knew of the existence of the patent, nominal damages merely may be recovered. *Bryce v. Dorr*, 3 McLean 582; s. c. 2 Robb 302.

Increase of Damages.

The jury should estimate the single damages, and the court, if it sees proper, will treble the damages found by the jury in awarding the proper judgment. *Whittemore v. Cutter*, 1 Gallis. 478; s. c. 1 Robb 40; *Evans v. Hettick*, 3 Wash. C. C. 408; s. c. 7 Wheat. 453; s. c. 1 Robb 166, 417; *Motte v. Bennett*, 2 Fish. 642; *Livingston v. Jones*, 2 Fish. 207; s. c. 3 Wall. Jr. 330.

The trebling of the damages is a matter that rests in the discretion of the court. *Stimpson v. Railroads*, 1 Wall. Jr. 164; s. c. 2 Robb 595.

The object of this provision is to remunerate patentees who are compelled to sustain their patents against wanton and persevering infringers. The spirit of the act does not include suits brought upon an expired patent which are merely cases of collection, the sole object being the recovery of damages. *Bell v. McCullough*, 1 Fish. 380; s. c. 1 Bond 194; *Brodie v. Ophir Mining Co.*, 4 Fish. 137; s. c. 5 Saw. 608.

If the infringement is deliberate and intentional the court will increase the damages. It is not reasonable that an inventor should be compelled to spend his means in protecting himself without indemnity, and so practically lose the benefit of the invention which the law designed to secure him. *Russell v. Place*, 5 Fish. 134; s. c. 9 Blatch. 173; *Peek v. Frame*, 5 Fish. 113; s. c. 9 Blatch. 194.

The omission to file a disclaimer before the commencement of the suit affords ground for the consideration of the court in the exercise of its discretion on an application for an increase of the damages. The party infringing the patent may have been misled by the specification, and may have honestly supposed that it was void and afforded no protection to the patentee. The actual damages for the infringement would, therefore, seem as a general rule to be all that can be reasonably claimed. *Guyon v. Serrell*, 1 Blatch. 244.

Even where the disclaimer was not filed till after the commencement of the suit, there may be exceptions to the general rule. Cases may arise where the circumstances are aggravated, and such as to repel altogether the *bona fides* of the infringement in which the power to increase the verdict should be exercised. Each case must depend on its own circumstances. *Guyon v. Serrell*, 1 Blatch. 244.

The law will not in general give treble damages to an assignee. *Schwartzel v. Holenshade*, 3 Fish. 116; s. c. 2 Bond 29.

The words "with costs" were probably added from abundant caution to exclude any inference of an intention to limit the amount of the judgment to the precise sum as increased, which would have excluded costs. When costs can not be recovered, because a disclaimer was not filed till after the commencement of the suit, the rights of the plaintiff and the power of the court in respect to damages remain the same as if costs were allowed, and the court may, if it sees proper, increase them. *Guyon v. Serrell*, 1 Blatch. 244.

Transfer by Judgment.

A recovery where no license fee has been established will not vest the infringer with the right to continue the use. *Suffolk Co. v. Hayden*, 4 Fish. 86; s. c. 3 Wall. 315.

If the patent fee is adopted as the measure of damages, the right to the further use of the invention passes to the defendant. *Sickels v. Borden*, 3 Blatch. 535.

If a patentee does not use the patented machine himself, nor establish a patent fee, but manufactures the patented articles and sells them at fixed prices, seeking his compensation in the profits of the manufacture and sale at such fixed prices, and another party infringes the patent by making and selling the patented article, and the patentee sues the party so infringing, and claims to recover, and does recover, the full amount of profits which he himself would have obtained on the article, had he manufactured and sold it at the ordinary price, by such claim and recovery he adopts the sale made by the party infringing, and the right to use the specific article so sold, and for which the recovery has been had, vests in the purchaser. *Spaulding v. Page*, 4 Fish. 641; s. c. 1 Saw. 702; 4 A. L. T. (N. S.) 166; *Perrigo v. Spaulding*, 13 Blatch. 389; s. c. 12 O. G. 352; s. c. 2 Ban & Ard. 348; *Booth v. Seivers*, 19 O. G. 1140; *Steam S. C. Co. v. Windsor Manuf. Co.*, 17 Blatch. 24; s. c. 4 Ban & Ard. 445.

The price of the invented machine is not the proper measure of damages, because the verdict would not entitle the defendant to use the machine subsequently. The statute gives to the inventor the exclusive right of making and using his invention, and the court can not compel the defendant to purchase, or the patentee to sell this right. *Earle v. Sawyer*, 4 Mason 1; s. c. 1 Robb 491; *Whittemore v. Cutter*, 1 Gallis. 478; s. c. 1 Robb 40.

If the damages allowed by the decree were merely for the use of the thing patented, a payment thereof will not entitle the defendant to continue to use it. *Matthews v. Spangenberg*, 23 O. G. 1624.

If a decree against a manufacturer merely allows nominal damages, it is no bar to an action against a purchaser. *Blake v. Greenwood Cemetery*, 16 Fed. Rep. 676.

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

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

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

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

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

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

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defences may be pleaded in any suit in equity for relief

against the alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

Statute Revised—July 8, 1870, ch. 230, § 61, 16 Stat. 208.

Prior Statutes—April 10, 1790, ch. 7, § 6, 1 Stat. 111.—February 21, 1793, ch. 11, § 6, 1 Stat. 322.—July 4, 1836, ch. 357, § 15, 5 Stat. 123.

Declaration.

The infringement of a patent is a *tort*, but as the wrongful act is not committed with direct force, and the injury is the indirect effect of the wrongful act, the form of action is that description of *tort* called trespass on the case. *Stein v. Goddard*, 1 McAl. 82.

There is no solid foundation on which to rest the right of a patentee to support an action on the case for the violation of his exclusive right, except that settled and reasonable common law basis of all such actions: injury and damage—injury by a violation of the incorporeal right, and damage, at least nominal, presumed by the law to arise from such violation. *Byam v. Bullard*, 1 Curt. 100.

A declaration ought always to show a title in the plaintiff, and that with convenient certainty. It ought to state all matters that are of the essence of the action, without which the plaintiff fails to show a right in point of law to ask for the judgment of the court in his favor. If his title depends upon the performance of certain acts, he must aver the performance of those acts. *Gray v. James*, 1 Pet. C. C. 476; s. c. 1 Robb 140.

The declaration must aver that the patent was issued and delivered to the patentee. An allegation that the patent was made out is not sufficient. *Cutting v. Myers*, 4 Wash. C. C. 220; s. c. 1 Robb 159.

As the patentee's title rests upon a patent from the United States, the form of which is prescribed by the act of Congress, the declaration must show that the patent is such as the law requires. *Cutting v. Myers*, 4 Wash. C. C. 220; s. c. 1 Robb 159.

It is not necessary that the patentee in his pleading shall specify all the acts done by him to obtain a patent in order that it may appear upon the face of the declaration that the mode of proceeding pointed out by the statute has been pursued. It is sufficient to set forth the grant in substance. The court will presume in favor of the grant that everything was rightly and solemnly done which the law requires, in order to authorize the issuing of the patent. *Wilder v. McCormick*, 2 Blatch. 31; *Cutting v. Myers*, 4 Wash. C. C. 220; s. c. 1 Robb 159.

It is sufficient to state the substance of the grant, but if the specification professes to set forth the grant according to its tenor, the slightest variance is fatal. *Tryon v. White*, 1 Pet. C. C. 96; s. c. 1 Robb 64.

A general averment of an extension in due form of law, before the expiration of the term for which the original patent was granted, is sufficient. *Phelps v. Comstock*, 4 McLean 353.

It would be more formal to annex a copy of the letters patent and specification to the declaration and to refer thereto in the declaration, but the common practice is to simply make profert of the letters patent, and there seems to be no substantial objection to it. *Pitts v. Whitman*, 2 Story 609; s. c. 2 Robb 189.

The profert of the letters patent makes the letters patent, when produced, a part of the declaration, and so gives all the certainty as to the invention and improvement patented, which is required by law. *Pitts v. Whitman*, 2 Story 609; s. c. 2 Robb 189.

The words "as by the said letters patent and specification, all in due form of law, ready in court to be produced, will fully appear," is equivalent to profert in the most formal and ample terms. They tender the entire grant to the inspection of the court and party. *Wilder v. McCormick*, 2 Blatch. 31.

The declaration need not aver at what time the invention patented was made. The patent law nowhere requires the patentee to allege or prove the specific time of his invention. *Wilder v. McCormick*, 2 Blatch. 31.

If the declaration does not set out the nature of the invention, it is demurrable. *Peterson v. Wooden*, 3 McLean 248; s. c. 21 Robb 116.

A breach which is as broad as the right set forth in the declaration and granted by the patent, is not only sufficient, but that is the most correct manner of pleading. *Cutting v. Myers*, 4 Wash. C. C. 220; s. c. 1 Robb 159.

The declaration must tender an issue upon the novelty and utility of the discovery patented, these being essential to the enforcement of any exclusive privilege under the patent, but the question of the regularity of the proceedings in petitioning for and obtaining the patent and that of the correctness of the judgment of the commissioner in awarding it are not material and cannot be inquired into. *Wilder v. McCormick*, 2 Blatch. 31.

If the declaration embodies all that is essential to enable the plaintiff to give evidence of his right and of its violation by the defendant, and affords to the defendant the opportunity to interpose every defence allowed him by the law, the court will not encourage objections merely critical, and will seek to sustain pleadings substantially sufficient, and will thus avoid useless delays and expense. *Wilder v. McCormick*, 2 Blatch. 31.

The plaintiff is confined to giving evidence of infringements during the period which he specifies in his declaration. If it were otherwise, the recovery in the suit would be no bar to another action for any anterior breach, since it could not judicially appear that any damages had been recovered for any such anterior breach, and the form of the declaration itself specifying the term would repel any presumption to the contrary. *Eastman v. Bodfish*, 1 Story 528; s. c. 2 Robb 72.

If the case stated in the declaration is precisely within the statute, an averment that the act complained of is against the form of the statute is mere matter of form, the want of which will be cured by a verdict, hence the omission of it is not a ground for a nonsuit. *Tryon v. White*, 1 Pet. C. C. 96; s. c. 1 Robb 64.

Where the original patent and a patent for an improvement on it are united in the same person, they constitute an entire right, and must be asserted as such in an action for an infringement. The wrong complained of is for a violation of the entire right united in the plaintiff by the different patents and assignments. The right set up is an entirety, and being united in the same individual, is not susceptible of a division. As well might different actions be brought for trespass upon a close, on the ground that the land was held under distinct titles. *Case v. Redfield*, 4 McLean 526; s. c. 2 Robb 741.

Distinct causes of action may be set forth in the same count. A reiteration of infringements of a patent may be sued for and recompensed in one action. There is no known doctrine of the law that requires a plaintiff to split up into separate actions grievances of that character. *Wilder v. McCormick*, 2 Blatch. 31.

If a patent is extended by a special act of Congress, and the plaintiff wishes to recover for infringements under both the original and extended patent, he must file distinct and independent counts for each patent. *Eastman v. Bodfish*, 1 Story 528; s. c. 2 Robb 72.

Where a matter is so essentially necessary to be proved to establish the plaintiff's right to recovery that the jury could not be presumed to have found a verdict for him unless it had been proved at the trial, the omission to state that matter in express terms in the declaration is cured by the verdict. The mere omission to aver that the assignment under which the plaintiff claims was recorded, will not be deemed fatal on a motion in arrest of judgment, for it is a case of a good title defectively stated. *Dobson v. Campbell*, 1 Sum. 319; s. c. 1 Robb 681.

If enough is stated in the declaration to show title in the plaintiff, and with sufficient certainty to enable the court to give judgment, but with less certainty than the case admitted of, and which, for the purpose of notice to the adverse party or otherwise, ought to have been stated, the defect is cured by the verdict. The court will presume that all such omissions were supplied and obscurities explained at the trial by the evidence given to the jury. *Gray v. James*, Pet. C. C. 476; s. c. 1 Robb 140.

If the declaration contains all the necessary allegations to show that the patent was regularly granted, and designates the patent by the terms used in the patent itself, it will be sufficient on a demurrer or motion in arrest of judgment. *Gray v. James*, Pet. C. C. 476; s. c. 1 Robb 140; *Cutting v. Myers*, 4 Wash. C. C. 220; s. c. 1 Robb 159.

Although a breach is too general in not stating the number of machines used by the defendant, yet it is cured by a verdict, since it is fairly to be presumed that proof of that fact was given to the jury. *Gray v. James*, Pet. C. C. 476; s. c. 1 Robb 140.

Plea.

This section appears to be drawn on the idea that the defendant would not be at liberty to contest the validity of the patent on the general issue. It therefore intends to relieve the defendant from the difficulties of pleading

when it allows him to give in evidence matter which does not affect the patent. But the notice is directed for the security of the plaintiff, and to protect him against that surprise to which he might be exposed from an unfair use of this privilege. The notice is a substitute to which the defendant is not obliged to resort. The notice is to be given only when it is intended to offer the special matter in evidence on the general issue. The defendant is not obliged to pursue this course. He may still plead specially, and then the plea is the only notice which the plaintiff can claim. *Evans v. Eaton*, 3 Wheat. 454; s. c. 1 Pet. C. C. 322; s. c. 1 Robb 68. 243; *Grant v. Raymond*, 6 Pet. 218; s. c. 1 Robb 604; *Read v. Miller*, 3 Fish. 310; s. c. 2 Biss. 12; *Phillips v. Comstock*, 4 McLean 525; s. c. 2 Robb 724; *Day v. New Eng. Car Co.*, 3 Blatch. 179; *contra*, *Wilder v. Gayler*, 1 Blatch. 597.

If the notice and the plea contain the same defence, the defendant must elect on which he will rely and abandon the other, or the court will on motion strike out the plea. *Latta v. Shawk*, 1 Fish. 465; s. c. 1 Bond 259; *Wilder v. Gayler*, 1 Blatch. 597; *Read v. Miller*, 3 Fish. 310; s. c. 2 Biss. 12.

If the defendant pleads instead of giving notice, and the plea is not put in thirty days before the term, the plaintiff is entitled to a continuance. *Phillips v. Comstock*, 4 McLean 525; s. c. 2 Robb 724; *Latta v. Shawk*, 1 Fish. 465; s. c. 1 Bond 259.

A plea which claims a right in the defendant to continue in the use of the patented discovery, from the fact of a title to such use derived by him through the patentee, or seeks to avoid the title of the plaintiff acquired by direct assignment from the patentee, by alleging matters outside of that assignment which prevent its passing any title to him, either because of the incapacity of the grantee in that respect to make such grant, or because of an outstanding paramount right in others, does not amount to the general issue and may be pleaded. The implied admission of the right of the patentee through whom the plaintiff makes title is sufficient in law to afford color for the avoidance. *Day v. New Eng. Car Co.*, 3 Blatch. 179.

Recoupment is a matter which is never pleaded in bar. *Birdsall v. Perego*, 5 Blatch. 251.

If a plea in avoidance contains no denial of matters alleged in the declaration, they must be considered as admitted, unless the matters alleged in the plea are a sufficient answer to the action. *Moore v. Marsh*, 7 Wall. 515.

A plea in avoidance which is hypothetical and does not admit the cause of action is bad. *Morse v. Davis*, 5 Blatch. 40.

A plea in bar must contain a full defence against the right of the plaintiff, and if it fall short of this, it is bad on demurrer. If the truth of the plea may be admitted, and the action is still maintainable, the plea is essentially defective. *Smith v. Ely*, 5 McLean 76; s. c. 15 How. 137.

Oyer of letters patent is not demandable as of a deed, but being a matter of record, it is accessible to the defendant, and should be stated in the plea, as it is not necessarily a part of the declaration, so as to enable the court

to act upon the face of the plea. *Smith v. Ely*, 5 McLean 76; s. c. 15 How. 137.

A plea of an abandonment should state the facts on which the pleader relies as showing an abandonment. *Root v. Ball*, 4 McLean 177; s. c. 2 Robb 513.

A plea that the defendant was acting as the agent of another is bad if it does not disclose the name of the principal. *Morse v. Davis*, 5 Blatch. 40.

If no fraud appears on the face of the patent, the defendant is not at liberty to set up that the patent has been fraudulently obtained. *Railroad Co. v. Dubois*, 12 Wall. 47.

The plea of not guilty puts in issue the novelty of the invention as well as the charge of infringement. *Blanchard v. Putnam*, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond 84; *vide* *Evans v. Hettick*, 3 Wash. C. C. 408; s. c. 7 Wheat. 453; s. c. 1 Robb 166, 417; *Gray v. James*, Pet. C. C. 394; s. c. 1 Robb 120.

A State statute can not limit the time within which actions for infringements for patents may be brought in the federal courts. *Anthony v. Carroll*, 9 O. G. 199; s. c. 2 Ban & Ard. 195; *Collins v. Peebles*, 2 Fish. 541; *Parker v. Hallock*, 2 Fish. 543; *Read v. Miller*, 3 Fish. 310; s. c. 2 Biss. 12; *Wood v. Cleveland Rolling Mill*, 4 Fish. 550; *Sayles v. Dubuque & S. C. R. R. Co.*, 5 Dill. 561; s. c. 3 Ban & Ard. 219; *Stevens v. Kans. Pac. R. R. Co.*, 5 Dill. 486; *Wetherill v. Zinc Co.*, 1 Ban & Ard. 485; *contra*, *Sayles v. Richmond F. & P. R. R. Co.*, 3 Hughes 172; s. c. 16 O. G. 43; s. c. 4 Ban & Ard. 239; *Hayden v. Great Falls Manuf. Co.*, 3 Fed. Rep. 519; *Hayward v. St. Louis*, 11 Fed. Rep. 427; *Hayden v. Oriental Mills*, 15 Fed. Rep. 605; *Parker v. Hawk*, 2 Fish. 58; *Howes v. Nute*, 4 Fish. 263; s. c. 4 Cliff. 173; *Rich v. Ricketts*, 7 Blatch. 230.

The inferior courts may prescribe rules to regulate the time and manner of filing pleas. *Packet Co. v. Sickles*, 19 Wall. 611.

The right to plead the statute of limitations does not depend on the pleasure or discretion of the court. *Packet Co. v. Sickles*, 19 Wall. 611.

Notice.

It is very clear that this section does not enumerate all the defences of which the defendant may legally avail himself, for he may clearly give, in evidence, that he never did the act attributed to him, or that he has a license or authority from the patentee. *Whittemore v. Cutter*, 1 Gallis. 429; s. c. 1 Robb 28.

There are defences of which a party may avail himself under the general issue, without giving notice to the patentee, because no such notice is required by the statute, as, for instance, that there is no specification, or that the specification is altogether ambiguous and unintelligible, or that the patent is broader than the discovery, or that it is for an improvement which the specification does not so particularly describe as to distinguish it from the original invention, and perhaps others similar in principle. *Kneass v. Schuylkill Bank*, 4 Wash. C. C. 9; s. c. 1 Robb 303; *Grant v. Raymond*, 6 Pet. 218; s. c. 1 Robb 604.

Most of the matters required by this section to be set forth in a notice could be given in evidence under the general issue, without notice, were it not for the section; or, to speak more accurately, are involved in the general issue. They are affirmative facts which the plaintiff would be bound to maintain as essential to the validity of his patent. *Wilder v. Gayler*, 1 Blatch. 597.

The object of this most salutary provision is to prevent patentees being surprised at the trial of the cause by evidence of a nature which they could not be presumed to know or be prepared to meet, and thereby to subject them either to most expensive delays or to a loss of their cause. *Phila. & Trenton R. R. Co. v. Stimpson*, 14 Pet. 448; s. c. 2 Robb 46; *Teese v. Huntingdon*, 23 How. 2; *Wilder v. Gayler*, 1 Blatch. 597.

All that the act requires is that notice of the special matter to be offered in evidence at the trial shall be in writing, and be given to the plaintiff or his attorney more than thirty days before the trial. By the plain terms of the law it is a right conferred upon the defendant, and of course he may exercise it in the manner and upon the conditions therein pointed out, without any leave or order from the court. When the notice is properly drawn, and duly and seasonably served and filed in court as a part of the pleadings, nothing further is required to give the defendant the full and unrestricted benefit of the provision. *Teese v. Huntingdon*, 23 How. 2.

The act does not attempt to prescribe the particulars which such a notice shall contain. It simply requires notice. But the least effect which can be allowed to this requirement is that the notice should be so full and particular as to answer the end in view. This end was not merely to put the patentee on inquiry, but to relieve him from the necessity of making useless inquiries and researches, and enable him to fix, with precision, upon what is relied on by the defendant, and to prepare himself to meet it at the trial. This highly salutary object should be kept in view, and a corresponding disclosure exacted from the defendant of all those particulars which he must be presumed to know, and which he may safely be required to state without exposing him to any risk of losing his rights. Less than this would not be reasonable notice, and therefore would not be such a notice as the act must be presumed to have intended. *Silsby v. Foote*, 14 How. 218; s. c. 1 Blatch. 445.

If the defendant discovers that the first notice is defective, or not sufficiently comprehensive to admit his defence, he may give another to remedy the defect or supply the deficiency, subject to the same condition, that it must be in writing and be served more than thirty days before the trial. *Teese v. Huntingdon*, 23 How. 2.

Where the first day of the term is the day of trial, the notice must be served on the plaintiff's counsel thirty days before the first day of the term. *Westlake v. Cartter*, 6 Fish. 518; s. c. 4 O. G. 636.

A plea which has been stricken out by the court on motion of the plaintiff is not a sufficient legal notice. *Silsby v. Foote*, 1 Blatch. 445; s. c. 14 How. 218.

If the defendant has given the notice required by the act, he may proceed to prove the facts therein set forth by any legal and competent testimony. For that purpose he may call and examine witnesses upon the stand, or he may introduce any deposition which has been legally taken in the cause. Under those circumstances depositions taken before the notice was served, as well as those taken afterward, are generally admissible. *Teese v. Huntingdon*, 23 How. 2.

No evidence under the general issue can be given upon any of the points of which the statute requires that notice shall be given to the patentee, unless such notice has been duly given. *Kneass v. Schuylkill Bank*, 4 Wash. C. C. 9; s. c. 1 Robb 303; *vide Gray v. James*, Pet. C. C. 394; s. c. 1 Robb 120.

If the notice states that the evidence is to be used for one purpose, it can not be used for another. *Pennock v. Dialogue*, 4 Wash. C. C. 538; s. c. 2 Pet. 1; s. c. 1 Robb 466, 542.

No notice is necessary in order to justify the admission of evidence for the purpose of showing the state of the art at the date of the patentee's invention. *Vance v. Campbell*, 1 Fish. 483; s. c. 1 Black 427; *Brown v. Piper*, 91 U. S. 37; s. c. 1 Holmes 20; 10 O. G. 417; s. c. 4 Fish. 175; *Westlake v. Cartter*, 6 Fish. 519; s. c. 4 O. G. 636; *Delong v. Bickford*, 13 Fed. Rep. 32.

No notice is necessary to authorize the inquiry whether the machine used by the defendant is like the model exhibited in court. *Evans v. Hettick*, 7 Wheat. 453; s. c. 3 Wash. C. C. 408; s. c. 1 Robb 166, 417.

It is incumbent on the defendant to show his right to introduce the evidence. *Silsby v. Foote*, 14 How. 218; s. c. 1 Blatch. 445; *Blanchard v. Putnam*, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond 84.

Demurrer.

Variances between the declaration and the writ cannot be taken advantage of on general demurrer. *Wilder v. McCormick*, 2 Blatch. 31.

Defects of form can not suspend the action of the court unless they are made the ground of a special demurrer. *Teese v. Phelps*, 1 McAl. 17.

Concealment.

If the specification embraces too much, the patentee is not bound to prove affirmatively that this occurred by accident or mistake, and not from an intention to deceive or defraud the public. The law presumes no one to have acted illegally or fraudulently. *Hotchkiss v. Oliver*, 5 Denio 314.

The thing for which the patent is granted should be truly and fully described in the specification, but if this is done, so as clearly to distinguish it from all other things before known, and so as to enable any person skilled in the art of which it is a branch, or with which it is most nearly connected, to make and use the same, it is sufficient. The matters not disclosed must appear to have been concealed for the purpose of deceiving

the public to invalidate the patent. *Park v. Little*, 3 Wash. C. C. 196; s. c. 1 Robb 17; *Gray v. James*, Pet. C. C. 394; s. c. 1 Robb 120; *Burden v. Corning*, 2 Fish. 477; *Whittemore v. Cutter*, 1 Gallis. 429; s. c. 1 Robb 28; *vide*, *Grant v. Raymond*, 6 Pet. 218; s. c. 1 Robb 604; *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.

What degree of evidence ought to be required to prove such fraudulent intention must rest with the jury to decide. Positive evidence can seldom be expected, nor is it necessary. The law, it is true, requires that such intention should fully appear, but still it may be presumed from circumstances entirely to the satisfaction of the jury. *Gray v. James*, Pet. C. C. 394; s. c. 1 Robb 120; *Dyson v. Danforth*, 4 Fish. 133.

If the specification and drawings are materially defective, they afford a presumption of a designed concealment. *Whittemore v. Cutter*, 1 Gallis. 429; s. c. 1 Robb 28.

If the parts concealed are so essential and so obviously necessary to be disclosed that no mechanic skilled in the art could reasonably be expected to understand the subject so as, from the description given, to make the machine, it would be difficult to impute the omission of the patentee to a fair motive. *Gray v. James*, Pet. C. C. 394; s. c. 1 Robb 120; *Reutgen v. Kanowrs*, 1 Wash. C. C. 168; s. c. 1 Robb 1.

Surreptitious Obtaining of Patent.

An allegation that the original patentee fraudulently and surreptitiously obtained the patent for that which he well knew was invented by another, is not sufficient to defeat the patent, unless it is accompanied by the further allegation that the alleged first inventor was at the time using reasonable diligence in adapting and perfecting the invention. *Agawam Co. v. Jordan*, 7 Wall. 583; *Reed v. Cutter*, 1 Story 590; s. c. 2 Robb 81; *Singer v. Walmsley*, 1 Fish. 558.

If the defendant was the first inventor of the thing patented, and was using reasonable diligence to adapt and perfect the same, and did perfect it, and the patent to the patentee was issued while the *caveat* of the defendant was on file in the patent office, without any notice being given to the defendant by the commissioner, then the patent was unjustly obtained. *Phelps v. Brown*, 1 Fish. 479; s. c. 4 Blatch. 362.

Description.

This provision requires: 1st. a description of the alleged invention; 2d. that it shall be contained in a work of a public character; 3d. that this work was made accessible to the public by publication before the discovery of the invention by the patentee. *Reeves v. Keystone Bridge Co.*, 5 Fish. 456; s. c. 1 O. G. 466; 9 Phila. 368; 5 A. L. T. 150.

If the alleged prior description laid before a mechanic skilled in building machines would not enable him, without invention, to build a machine substantially like the patentee's, it will not amount to that kind of public

notice or knowledge which can interfere with a subsequent patent. *Carr v. Rice*, 1 Fish. 198; *Reeves v. Keystone Bridge Co.*, 5 Fish. 456; s. c. 1 O. G. 466; 9 Phila. 368; 5 A. L. T. 150; *Roberts v. Dickey*, 4 Fish. 532; s. c. 4 Brews. 260; 1 O. G. 4; *Buerk v. Valentine*, 5 Fish. 366; s. c. 9 Blatch. 479; 2 O. G. 295; *McMillin v. Barclay*, 5 Fish. 189; s. c. 4 Brews. 275; *Baldwin v. Schultz*, 5 Fish. 75; s. c. 9 Blatch. 494; 2 O. G. 315; *Tilghman v. Morse*, 5 Fish. 323; s. c. 9 Blatch. 421; 10 O. G. 574; *Renwick v. Cooper*, 6 Fish. 31; s. c. 10 Blatch. 201; *Pitts v. Wemple*, 2 Fish. 10; s. c. 1 Biss. 87; *Parker v. Stiles*, 5 McLean 44; *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206; *Stimpson v. Woodman*, 3 Fish. 98; s. c. 10 Wall. 117; *Cahill v. Brown*, 15 O. G. 697; s. c. 3 Ban & Ard. 580.

If the prior publication describes the article, that will defeat a patent for a manufacture, although it does not teach a manufacturer how to make it. *Cohn v. U. S. Corset Co.*, 93 U. S. 366; s. c. 12 Blatch. 225; 6 O. G. 259; 11 O. G. 457; s. c. 1 Ban & Ard. 340; *ex parte McClosky* 3 McArthur, 14.

It must be directly proved that the work was published before the date of the patentee's invention. This is not deducible from the imprint of the title-page. That the work was then printed may be inferred from the imprint, but when it was put in circulation and offered to the public is a distinct fact which must be proved independently. The intended circulation of a book of a public nature may be presumed from its being put into print, but it does not follow that the work was made accessible to the public as soon as it was printed. *Reeves v. Keystone Bridge Co.*, 5 Fish. 456; s. c. 1 O. G. 466; 9 Phila. 368; 5 A. L. T. 150.

A written description of a machine, although illustrated by drawings, which has not been given to the public, does not constitute an invention within the meaning of the patent law. It may be so full and precise as to enable any one skilled in the art to which it appertains to construct the machine described, but until it has been embodied in a form capable of useful operation, it has not attained the proportion or character of a complete invention. However suggestive and valuable it may be as an untried theory, it is ineffective against the practical and useful product of inventive skill. *Northwestern Co. v. Philadelphia Co.*, 6 O. G. 34; s. c. 1 Ban & Ard. 177; *Lyman V. & R. Co. v. Lalor*, 12 Blatch. 303; s. c. 6 O. G. 642; s. c. 1 Ban & Ard. 403.

A mere reference to a volume of thirteen hundred pages is not sufficient notice. The defendant should indicate in his notice what particular things described in the printed publication he intends to aver are substantially the same as the thing patented. This he may do either by reference to pages or titles, and perhaps in other ways, for the particular manner in which the things referred to are referred to, must depend much upon the contents of the volume and their arrangement. *Silsby v. Foote*. 14 How. 218; s. c. 1 Blatch. 445.

A book of which no notice has been given can not be used as evidence to prove a prior invention. *Pennock v. Dialogue*, 4 Wash. C. C. 538; s. c. 2 Pet. 1; s. c. 1 Robb 466, 542; *Lippincott v. Kelly*, 1 West. L. J. 513.

A volume produced in pursuance of a notice to establish a prior description of the machine is not evidence of the fact that the machine was partially successful, although it so states. *Seymour v. McCormick*, 19 How. 96 ; s. c. 3 Blatch. 209.

A prior description of a part can not invalidate a patent for the whole. *Westinghouse v. G. & R. Brake Co.*, 9 O. G. 538 ; s. c. 2 Ban & Ard. 55.

The description of the invention in books must be before the discovery, and not before the application. *Adams v. Edwards*, 1 Fish. 1.

If the books do not describe the invention in all its material combinations, they are no bar to the validity of the invention. *Adams v. Edwards*, 1 Fish. 1.

The expression "patented" means only inventions laid open to the public and protected to the inventors by a patent. *Schoerken v. S. & C. & B. Manuf. Co.*, 19 O. G. 1493 ; s. c. 19 Blatch. 209 ; s. c. 7 Fed. Rep. 469.

The fact that a foreign patent is certified is evidence that it is an open and not a secret patent. *Schoerken v. S. & C. & B. Manuf. Co.*, 19 O. G. 1493 ; s. c. 19 Blatch. 209 ; s. c. 7 Fed. Rep. 469.

If the application for a patent is prior to the application for a prior patent, that is sufficient to overcome the description in the prior patent. *Allen v. New York*, 17 O. G. 1281 ; s. c. 17 Blatch. 350.

A mechanical patent is not void, although it is issued more than two years after the issuing of a design patent describing the same thing, if the application was made in less than two years. *Collender v. Griffith*, 18 Blatch. 110 ; s. c. 18 O. G. 241 ; s. c. 5 Ban & Ard. 372 ; s. c. 2 Fed. Rep. 206.

It is no objection to a patent that the improvement is embraced in a claim in a prior patent which is void because it is a claim for a principle. *O'Reilly v. Morse*, 15 How. 62.

A rejected specification, with drawings, can not be treated as a publication, because it lacks the essential quality of a publication in that it is not designed for general circulation, nor is it made accessible to the public generally. It is placed in the custody of the commissioner, not that it may thereby become known to the public, but for the special purpose of being examined and passed upon by him. Although it may incidentally become known to any one whose researches in the patent office may disclose its existence, it is not therefore published within the meaning of the statute. *Northwestern Co. v. Philadelphia Co.*, 6 O. G. 34 ; s. c. 1 Ban & Ard. 177 ; *Gage v. Nelson*, 23 O. G. 2119 ; s. c. 14 Blatch. 293 ; s. c. 12 O. G. 753 ; s. c. 3 Ban & Ard. 55 ; *Rubber Step Manuf. Co. v. Metropolitan R. R. Co.*, 13 O. G. 549 ; s. c. 3 Ban & Ard. 252 ; *Barker v. Stowe*, 14 O. G. 559 ; s. c. 15 Blatch. 49 ; s. c. 3 Ban & Ard. 337 ; *Howes v. McNeal*, 15 Blatch. 103 ; s. c. 15 O. G. 608 ; s. c. 3 Ban & Ard. 376.

The deposit of a written description of an invention in the patent office is not a publication of it within the meaning of the statute, for the description is not designed for general circulation, nor is it made accessible to the public generally. *Lyman V. & R. Co. v. Lalor*, 12 Blatch. 303 ; s. c. 6 O. G. 642 ; s. c. 1 Ban & Ard. 403.

A reissue of one patent subsequent in date to another patent can not affect the novelty or validity of the latter if there is nothing in the specifications or drawing of the original patent which affects it. *Hitchcock v. Tremaine*, 5 Fish. 537; s. c. 9 Blatch. 550; 1 O. G. 633.

When a patentee describes an alternate mode of effecting an object, it is a good ground for refusing a subsequent patent for either of them to another person. *Ex parte McClosky*, 3 McArthur 14.

A mere drawing unaccompanied by any description whatever is not admissible under a notice of a description in a printed publication. *Judson v. Cope*, 1 Fish. 615; s. c. 1 Bond 327.

An illustration by a drawing is not such a description as the statute contemplates. *Reeves v. Keystone Bridge Co.*, 5 Fish. 456; s. c. 1 O. G. 436; 9 Phila. 368; 5 A. L. T. 150.

No evidence is admissible to prove that the invention described in the alleged prior patent or printed publication was made prior to the date of such patent or printed publication, for the reason that the patent or printed publication can only have the effect as evidence that is given to it by the act of Congress. *Kelleher v. Darling*, 14 O. G. 673; s. c. 4 Cliff. 424; s. c. 3 Ban & Ard. 438.

Novelty.

The patentee's suit is founded on his patent, and unless he is himself the original inventor he cannot recover. *Evans v. Hettick*, 3 Wash. C. C. 408; s. c. 7 Wheat. 453; s. c. 1 Robb 166, 417.

The defendant can not be allowed to surprise the patentee by evidence of a prior invention of which no notice was given him. *O'Reilly v. Morse*, 15 How. 62; *Parker v. Haworth*, 4 McLean 370; s. c. 2 Robb 725; *Westlake v. Cartter*, 6 Fish. 519; s. c. 4 O. G. 636; *Root v. Ball*, 4 McLean 177; s. c. 2 Robb 513; *Phila. & Trenton R. R. Co. v. Stimpson*, 14 Pet. 448; s. c. 2 Robb 46; *Blanchard v. Putnam*, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond 84.

Evidence in regard to the state of the art is proper to be considered by the court in construing the patent and determining what invention is claimed, but has no legitimate bearing upon the question whether the patentee was the first inventor, unless notice has been duly given that it will be used for that purpose. *Railroad Co. v. DuBois*, 12 Wall. 47.

When the novelty of the invention is not open to inquiry by the pleadings, the defendant can not put in evidence a patent granted to another, for such evidence is immaterial. The only question is, whether the defendant's machine infringes the patentee's invention. *Blanchard v. Putnam*, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond 84.

Prior Use.

The mere filing of a model is not an application. "Application" in this connection includes the paper or some written paper, and its presentation to the commissioner. *Henry v. Frankestown Soapstone Co.*, 17 O. G. 569; s. c. 5 Ban & Ard. 108; s. c. 2 Fed. Rep. 78.

A change in the specification as filed in the first instance, or the subsequent filing of a new one whereby a patent is still sought for the substance of the invention as originally claimed, or a part of it, can not in anywise affect the sufficiency of the original application or the legal consequences flowing from it. To produce that result, the new or amended specification must be intended to serve as the basis of a patent for a distinct and different invention, and one not contemplated by the specification as submitted at the outset. *Sewall v. Jones*, 91 U. S. 171; s. c. 9 O. G. 47; s. c. 3 Cliff. 563; s. c. 6 Fish. 343; s. c. 3 O. G. 630; *Godfrey v. Eames*, 1 Wall. 317; *Blandy v. Griffith*, 3 Fish. 609; *Rich v. Lippincott*, 2 Fish. 1; *Dental Vulcanite Co. v. Wetherbee*, 3 Fish. 87; s. c. 2 Cliff. 555; *Singer v. Braunsdorf*, 7 Blatch. 521; *Smith v. O'Connor*, 6 Fish. 469; s. c. 2 Saw. 461; s. c. 4 O. G. 633; *Smith v. G. D. V. Co.*, 93 U. S. 486; s. c. 1 Holmes 354; 11 O. G. 246; 5 O. G. 585; s. c. 4 A. L. T. N. S. 74; s. c. 1 Ban & Ard. 201; *Bell v. Daniels*, 1 Fish. 372; s. c. 1 Bond 212; *Singer v. Walmsley*, 1 Fish. 558; *Howes v. McNeal*, 15 O. G. 608; s. c. 15 Blatch. 103; s. c. 3 Ban & Ard. 376; *Smith v. O'Connor*, 2 Saw. 461; s. c. 6 Fish. 469; s. c. 4 O. G. 633.

If a party chooses to withdraw his application for a patent and pay the forfeit, intending at the time of such withdrawal to file a new petition, and he accordingly does so, the two petitions are to be considered as parts of the same transaction, and both as constituting one continuous application within the meaning of the law. *Godfrey v. Eames*, 1 Wall. 317; *Howe v. Newton*, 2 Fish. 531.

The filing of a second application may be considered as in the nature of a petition for a review of the previous rulings, and relates back to the prior application. *Blandy v. Griffith*, 3 Fish. 609.

The filing of a second application after the rejection of the first will be deemed to be a mere continuance of the prior application. *Smith v. G. D. V. Co.*, 93 U. S. 486; s. c. 1 Holmes 354; 5 O. G. 585; 11 O. G. 246; s. c. 1 Ban & Ard. 201; s. c. 4 A. L. T. (N. S.) 74; *Goodyear D. V. Co. v. Willis*, 7 O. G. 41; s. c. 1 Flippin 385; s. c. 1 Ban & Ard. 568; *Henry v. Stove Co.*, 9 O. G. 408; s. c. 2 Ban & Ard. 221; *Weston v. White*, 13 Blatch. 447; s. c. 2 Ban & Ard. 364; *Colgate v. West. U. Tel. Co.*, 14 O. G. 943; s. c. 15 Blatch. 365; s. c. 4 Ban & Ard. 37; *Graham v. McCormick*, 21 O. G. 1533; s. c. 10 Biss. 39; 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 a new application is a continuance of a prior one is a question of fact. *Bevin v. East Hampton Bell Co.*, 5 Fish. 23; s. c. 9 Blatch. 50; *Godfrey v. Eames*, 1 Wall. 317; *Weston v. White*, 13 Blatch. 447; s. c. 2 Ban & Ard. 364; *Rich v. Lippincott*, 2 Fish. 1.

If a party withdraws his application upon its rejection by the patent office, without any intent to file a new petition, and acquiesces in the decision, this is an abandonment of it, so that there will be no continuity between it and a subsequent application. *United States Rifle Co. v. Whitney Arms Co.*, 11 O. G. 373; s. c. 14 Blatch. 94; s. c. 2 Ban & Ard. 493.

If the second application is not for the same invention as the first, and the invention has been in public use for more than two years prior to the time of making the second, the patent will be void. *Rich v. Lippincott*, 2 Fish. 1.

If the inventor amends his application so as to exclude a certain device, and immediately applies for a patent for that device, the patent will only relate back to the last application. *Pelton v. Waters*, 7 O. G. 425; s. c. 21 I. R. R. 125; s. c. 1 Ban & Ard. 599.

The statute does not prescribe the time within which a patent shall be applied for after the invention is perfected. Where it has not been abandoned to the public, and has not been in public use or on sale, no lapse of time, however protracted, bars an application for a patent, or affects its validity after it has been granted. *Wood v. Cleveland Rolling Mill*, 4 Fish. 550; *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530; *Russell Manuf. Co. v. Mallory*, 5 Fish. 632; s. c. 10 Blatch. 140; 2 O. G. 495.

The provision allowing two years' use to the inventor applies to previous cases as well as to subsequent cases. *Adams v. Edwards*, 1 Fish. 1.

If the invention is used in public for more than two years before the inventor applies for letters patent, it is conclusive evidence of a dedication of such invention to the public, and the patent is void. *New York v. Ransom*, 23 How. 487; s. c. 1 Fish. 252; *Pitts v. Hall*, 2 Blatch. 229; *Rich v. Lippincott*, 2 Fish. 1; *Consolidated Fruit Jar Co. v. Wright*, 12 Blatch. 149; s. c. 6 O. G. 327; s. c. 94 U. S. 92; s. c. 1 Ban & Ard. 320; *Seymour v. McCormick*, 3 Blatch. 240; s. c. 16 How. 480; *Sanders v. Logan*, 2 Fish. 167; *Dunlap v. Minetree*, 1 O. G. 463; *Tappan v. Nat. Bank Note Co.*, 2 Fish. 195; s. c. 4 Blatch. 509; *Cleveland v. Towle*, 3 Fish. 525; *American Leather Co. v. American Tool Co.*, 4 Fish. 284; s. c. 1 Holmes 503; *Sisson v. Gilbert*, 5 Fish. 199; s. c. 9 Blatch. 185; *Worley v. Tobacco Co.*, 104 U. S. 340; s. c. 21 O. G. 559; *Burrall v. Rumsey*, 13 O. G. 123; *Egbert v. Lippman*, 104 U. S. 333; s. c. 21 O. G. 75; s. c. 15 Blatch. 295; s. c. 3 Ban & Ard. 468; *Andrews v. Hovey*, 16 Fed. Rep. 387; *Bates v. Coe*, 98 U. S. 31; s. c. 15 O. G. 337; *Schneider v. Thill*, 5 Ban & Ard. 595; *Union P. B. M. Co. v. Atlas Bag Co.*, 6 Fed. Rep. 398; *Manning v. Cape Ann I. & G. Co.*, 23 O. G. 2413; s. c. 4 Ban & Ard. 612; *Edgerton v. F. & B. Manuf. Co.*, 21 O. G. 251; s. c. 10 Biss. 402; s. c. 9 Fed. Rep. 450; *Kells v. McKenzie*, 20 O. G. 1663; s. c. 9 Fed. Rep. 284; *Hall v. Macneale*, 23 O. G. 937; *Jones v. Barker*, 22 O. G. 771, s. c. 11 Fed. Rep. 597; *Plimpton v. Winslow*, 23 O. G. 1731; s. c. 14 Fed. Rep. 919; *Clark P. H. Co. v. Ferguson*, 17 Fed. Rep. 79; s. c. 24 O. G. 1090.

If a party who has failed to prosecute his application within two years after he is notified of its rejection files a second application, the two years within which a public use will not invalidate the patent are to be computed from the second and not from the first application. *Lindsay v. Stein*, 21 O. G. 1613; s. c. 10 Fed. Rep. 907.

If the patent has been reissued, the two years is to be computed not

from the date of the reissue, but from the date of the application for the original patent. *Shaw v. Colwell Lead Co.*, 11 Fed. Rep. 711.

It is sufficient to defeat the right of a patentee to show that his invention had been in public use or on sale more than two years prior to his application without proof that it was with his consent or allowance. *Keleher v. Darling*, 14 O. G. 673; s. c. 4 Cliff. 424; s. c. 3 Ban & Ard. 438; *Egbert v. Lippman*, 14 O. G. 822; s. c. 15 Blatch. 295; s. c. 104 U. S. 333; s. c. 3 Ban & Ard. 468; *contra*, *Campbell v. New York*, 20 O. G. 1817; s. c. 9 Fed. Rep. 500.

If another puts the invention into public use more than two years before the application for the patent, the patent is void. *Burton v. Greenville*, 18 O. G. 411; s. c. 5 Ban & Ard. 541; s. c. 3 Fed. Rep. 642; s. c. I. R. R. 251.

Mere prior knowledge alone without use of the invention is not sufficient to defeat the patent. *Searls v. Bouton*, 21 O. G. 1784; s. c. 12 Fed. Rep. 140.

The use of the invention by individuals, even with the permission of the patentee, will not invalidate the patent, unless it continues for more than two years prior to the filing of the application for a patent therefor in the patent office. *Teese v. Phelps*, 1 McAl. 48; *Sewall v. Jones*, 91 U. S. 171; s. c. 9 O. G. 47; s. c. 3 Cliff. 563; 6 Fish. 343; s. c. 3 O. G. 630; *Smith v. Ely*, 5 McLean 76; s. c. 15 How. 137; *Andrews v. Carman*, 13 Blatch. 307; s. c. 9 O. G. 101; s. c. 2 Ban & Ard. 277; *Bell v. Daniels*, 1 Fish. 372; s. c. 1 Bond 212; *Wyeth v. Stone*, 1 Story 273; s. c. 2 Robb 23; *Root v. Ball*, 4 McLean 177; s. c. 2 Robb 513; *Seymour v. McCormick*, 2 Blatch. 240; s. c. 16 How. 480; *Goodyear v. Matthews*, 1 Paine 300; s. c. 1 Robb 50; *Heinrich v. Luther*, 6 McLean 345; *Sickels v. Mitchell*, 3 Blatch. 548; *Agawam Co. v. Jordan*, 7 Wall. 583; *American Whip Co. v. Hampden Whip Co.*, 5 Ban & Ard. 122; s. c. 4 Fed. Rep. 536.

The right to the future use is lost by a public use for more than two years prior to the application, however great the hindrances to such application, and whether caused by the want of pecuniary means or other misfortune. *Sisson v. Gilbert*, 5 Fish. 109; s. c. 9 Blatch. 185.

By public use is meant a use in public; that is to say, if the inventor himself makes and sells the thing to be used by others, or if it is made by one other person only, with his knowledge and without objection, before his application for a patent, *a fortiori*, if he suffers it to get into general use, it will have been in public use. *Rich v. Lippincott*, 2 Fish. 1.

The defence of a prior invention and the defence of prior public use and sale stand upon a different footing and depend upon widely different proof. In the former case the gist of the defence is that the invention was first made and reduced to practice by another, but in the latter case the gist of the defence is that the invention though made by the patentee went into public use or was on sale more than two years before he filed his application for a patent. *Keleher v. Darling*, 14 O. G. 673; s. c. 4 Cliff. 424; s. c. 3 Ban & Ard. 438.

It is not a public knowledge of his invention that precludes an inventor

from obtaining a patent for it, but a public use or sale of it. *Elizabeth v. Pavement Co.*, 97 U. S. 126 ; s. c. 6 O. G. 772 ; s. c. 3 O. G. 522 ; s. c. 6 Fish. 424 ; s. c. 1 Ban & Ard. 463.

If the inventor allows his machine to be used by other persons generally either with or without compensation, or if it is put on sale with his consent for such use, it is in public use. *Elizabeth v. Pavement Co.*, 97 U. S. 126 ; s. c. 6 O. G. 772 ; s. c. 3 O. G. 522 ; s. c. 6 Fish. 424 ; s. c. 1 Ban & Ard. 463.

Whether the use of an invention is public or private does not necessarily depend upon the number of persons to whom the use is known. If an inventor having made his device gives or sells it to another to be used by the donee or vendee without limitation or restriction or injunction of secrecy and it is so used, such use is public within the meaning of the statute even though the use and knowledge of the use may be confined to one person. *Egbert v. Lippman*, 104 U. S. 333 ; s. c. 21 O. G. 75 ; s. c. 14 O. G. 822 ; s. c. 15 Blatch. 295 ; s. c. 3 Ban & Ard. 468.

Some inventions are by their very character only capable of being used where they can not be seen or observed by the public eye, nevertheless if an inventor sells a machine of which his invention forms a part and allows it to be used without restriction of any kind, the use is a public use, within the meaning of the law. *Egbert v. Lippman*, 104 U. S. 333 ; s. c. 21 O. G. 75 ; s. c. 14 O. G. 822 ; s. c. 15 Blatch. 295 ; s. c. 3 Ban & Ard. 468.

To constitute the public use of an invention it is not necessary that more than one of the articles shall be publicly used. The use of a great number may tend to strengthen the proof of public use, but one well defined case of public use is just as effectual to annul the patent as many. *Egbert v. Lippman*, 104 U. S. 333 ; s. c. 21 O. G. 75 ; s. c. 14 O. G. 822 ; s. c. 15 Blatch. 295 ; s. c. 3 Ban & Ard. 468.

The fact that a sale was conditional does not without further evidence prove that the sale was experimental, for the fact that the purchaser had doubts about the article does not prove any on the part of the seller. *Henry v. Francestown Soapstone Co.*, 17 O. G. 569 ; s. c. 5 Ban & Ard. 108 ; s. c. 2 Fed. Rep. 78.

Sales in the usual course of business, whether absolute or conditional, if they are sales of the thing patented, work a forfeiture of the invention. *Henry v. Francestown Soapstone Co.*, 17 O. G. 569 ; s. c. 5 Ban & Ard. 108 ; s. c. 2 Fed. Rep. 78.

If a machine is used in a factory where the workmen are not pledged to secrecy, this is a public use, although chance visitors are excluded from the factory ; for it is enough that any one or more persons not under a pledge of secrecy saw the invention practiced, or even might have seen it if they had used their opportunities. *Perkins v. N. C. & G. P. Co.*, 17 O. G. 1285 ; s. c. 5 Ban & Ard. 395 ; s. c. 2 Fed. Rep. 451.

When the subject of invention is a machine, it may be tested and tried in a building either with or without closed doors. In either case such use is not public use within the meaning of the statute so long as the inventor is engaged in good faith in testing its operation. *Elizabeth v. Pavement*

Co., 97 U. S. 126; s. c. 6 O. G. 772; s. c. 3 O. G. 522; s. c. 6 Fish. 424; s. c. 1 Ban & Ard. 463.

A single instance of sale, purchase or use under the circumstances specified in the section, will render the patent void. Consolidated Fruit Jar Co. v. Wright, 12 Blatch. 149; s. c. 6 O. G. 327; s. c. 94 U. S. 92; s. c. 1 Ban & Ard. 320; Henry v. Frankestown Soapstone Co., 17 O. G. 569; s. c. 5 Ban & Ard. 108; s. c. 2 Fed. Rep. 78.

There is an obvious distinction between a public use or a use by the public and an experimental use in public. Many inventions can only be tested in that way. Locomotive Truck Co. v. Railroad Co., 6 O. G. 924; s. c. 1 Ban & Ard. 470; American Whip Co. v. Hampden Co., 5 Ban & Ard. 122; s. c. 4 Fed. Rep. 536.

Acts of an inventor to determine the value, utility or success of his invention are to be liberally construed if the acts are not inconsistent with the clear intention to hold the exclusive privilege. Jennings v. Pierce, 15 Blatch. 42; s. c. 3 Ban & Ard. 361.

If the thing patented can not be tested in private, a public use may be deemed experimental. Campbell v. New York, 20 O. G. 1817; s. c. 9 Fed. Rep. 500.

The permission to another to try the thing invented in order to induce him to aid the inventor in getting a patent may be regarded as an experimental use. Sinclair v. Backus, 17 O. G. 1503; s. c. 5 Ban & Ard. 81; s. c. 4 Fed. Rep. 539.

If the use is a mere experiment it is not a public use, although the public incidentally derives a benefit from it. Elizabeth v. Pavement Co., 97 U. S. 126; s. c. 6 O. G. 772; s. c. 3 O. G. 522; s. c. 6 Fish. 424; s. c. 1 Ban & Ard. 463.

Although the machine is put up and used in the premises of another and the use inures to the benefit of the owner of the establishment, yet if it is used under the surveillance of the inventor for the purpose of enabling him to test the machine, it is a mere experimental use and not a public use. Elizabeth v. Pavement Co., 97 U. S. 126; s. c. 6 O. G. 772; s. c. 3 O. G. 522; s. c. 6 Fish. 424; s. c. 1 Ban & Ard. 463.

If the use for profit is incidental and subordinate to the experimental use, the entire use may be considered as experimental. Jennings v. Pierce, 15 Blatch. 42; s. c. 3 Ban & Ard. 361.

If the inventor uses the machine with a *bona fide* intent of testing its qualities, such use is not a public use, although he makes no alterations. Elizabeth v. Pavement Co., 97 U. S. 126; s. c. 6 O. G. 772; s. c. 3 O. G. 522; s. c. 6 Fish. 424; s. c. 1 Ban & Ard. 463.

A patentee may carry his invention back so as to anticipate others, and at the same time declare that it was so incomplete that his use was only experimental. Macdonald v. Shepard, 4 Fed. Rep. 228.

If the use prior to the period of two years before the application for the patent was by way of trial, and resulted in a change in the construction of the machine, it will not work a forfeiture of the right of the patentee. Pitts v. Hall, 2 Blatch. 229; Sewall v. Jenes, 91 U. S. 171; s. c. 9 O. G.

47; s. c. 3 Cliff. 563; s. c. 6 Fish. 343; s. c. 3 O. G. 630; *Winans v. Schen. & Troy R. R. Co.*, 2 Blatch. 279; *Page v. Bowers*, 1 O. G. 521; *Winans v. N. Y. & Harlem R. R. Co.*, 4 Fish. 1; *Birdsell v. McDonald*, 6 O. G. 682; s. c. 1 Ban & Ard. 165; *American Leather Co. v. American Tool Co.*, 4 Fish. 284; s. c. 1 Holmes 503; *Henry v. Stove Co.*, 9 O. G. 408; s. c. 2 Ban & Ard. 221; *Andrews v. Carman*, 13 Blatch. 307; s. c. 9 O. G. 1011; s. c. 2 Ban & Ard. 277; *U. S. Rifle Co. v. Whitney Arms Co.*, 11 O. G. 373; s. c. 14 Blatch. 94; s. c. 2 Ban & Ard. 495; *Locomotive Truck Co. v. Railroad Co.*, 6 O. G. 924; s. c. 1 Ban & Ard. 470; *Campbell v. James*, 18 O. G. 979; s. c. 17 Blatch. 43; s. c. 4 Ban & Ard. 456; *Andrews v. Cross*, 19 O. G. 1705; *Graham v. McCormick*, 21 O. G. 1533; s. c. 10 Biss. 39; 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; *Emery v. Cavanagh*, 17 Fed. Rep. 242.

The use and sale which will render a patent void is the use and sale of the perfected invention, and not of the invention in an imperfect, inchoate and experimental condition. But the distinction between the invention and the machine which embodies it must be observed. The invention may be perfect, and the machine which embodies that invention may be an imperfect machine. *American Leather Co. v. American Tool Co.*, 4 Fish. 284; s. c. 1 Holmes 503.

The question is whether the machine, at the time of the sale, was perfect in the sense that it embodied a completed invention, and not whether it was perfect in mechanical execution. A perfect machine, in the sense of the word perfect, means a perfected invention, not a perfectly constructed machine, but a machine so constructed as to embody all the essential elements of the invention in a form that would make them practical and operative so as to accomplish the result. But it is not necessary that it should accomplish the result in the most perfect manner, and be in a condition where it was not susceptible of a higher degree of perfection in its mere mechanical construction. *American Leather Co. v. American Tool Co.*, 4 Fish. 284; s. c. 1 Holmes 503; *Sisson v. Gilbert*, 5 Fish. 109; s. c. 9 Blatch. 185; *Henry v. Frankestown Soapstone Co.*, 17 O. G. 369; s. c. 5 Ban & Ard. 108; s. c. 2 Fed. Rep. 78.

If the article sold was what the inventor considered an imperfect form of the invention, it is not a sale of the invention and will not invalidate the patent. *Henry v. Frankestown Soapstone Co.*, 17 O. G. 569; s. c. 5 Ban & Ard. 108; s. c. 2 Fed. Rep. 78.

It is not enough to prove that the inventor has sold an earlier and less perfect article, that is, less perfect in the sense of the patent law, even if the thing sold would be within the claim of the patent. In other words, the test is not necessarily whether the article sold would infringe the invention by embodying a part of it, but whether it is the invention, that embodies the whole of it. *Draper v. Wattles*, 16 O. G. 629; s. c. 3 Ban & Ard. 618.

If a machine is imperfect and requires continuous experiments to remedy the defects in its organization, a use of such a machine for more than two

years before the application for a patent for the perfected machine will not make the patent void. *Sprague v. Smith & G. Manuf. Co.*, 12 Fed. Rep. 721.

If the machine as originally constructed is subsequently altered so as to make a machine substantially different in its construction and mode of operation, the time begins to run from the date of the completion of the last machine. *Haskell v. Shoe M. Manuf. Co.*, 15 O. G. 509 ; s. c. 3 Ban & Ard. 553.

A machine which, whether entirely satisfactory or not, has for a long time been run in the ordinary course of business, and which is patented precisely as it was used, is not an experimental machine. *Perkins v. N. C. & G. P. Co.*, 17 O. G. 1285 ; s. c. 5 Ban & Ard. 395 ; s. c. 2 Fed. Rep. 451.

Consent and allowance may be inferred from acquiescence. *Sisson v. Gilbert*, 5 Fish. 109 ; s. c. 9 Blatch. 185.

If the patentee uses the thing patented himself, for more than two years prior to the time of applying for a patent, the patent will be void. *McMillin v. Barclay*, 5 Fish. 189 ; s. c. 4 Brews. 275.

If the prior use relied on is a use by the inventor or by persons with his consent and allowance, it is not necessary to notify him of the names of the persons using the invention, or of the place where used. *American Leather Co. v. American Tool Co.*, 4 Fish. 284 ; s. c. 1 Holmes 503.

Forfeiture by prior use is not favored in law, but is regarded as being somewhat harsh in its operation on individual rights. *Pitts v. Hall*, 2 Blatch. 229 ; *Henry v. Stove Co.*, 9 O. G. 408 ; s. c. 2 Ban & Ard. 221 ; *Page v. Bowers*, 1 O. G. 521.

An inventor may stipulate for a sale of his invention before it is completed without vitiating his claim. *Sparkman v. Higgins*, 1 Blatch. 205.

An agreement for the transfer of the invention for the joint benefit of the inventor and those who will advance money for the manufacture of the machines invented, not carried into execution and unaccompanied by any public use of the machine, but being prospective in its character, not consummated until within two years before the application for the patent, does not affect its validity. *Eln City Co. v. Wooster*, 6 Fish. 452 ; s. c. 4 O. G. 83.

If a design is worked upon the face of a button, it may perhaps be said to be sold with the button. In this view a sale of the button would be a sale of the design, and not simply of the product of the invention. *Booth v. Garely*, 1 Blatch. 247.

If the patentee has sold the patent to another, his testimony that he put the patented invention in use more than two years prior to the application for the patent will be disregarded unless it is confirmed by others. *Sinclair v. Backus*, 17 O. G. 1503 ; s. c. 5 Ban & Ard. 81 ; s. c. 4 Fed. Rep. 539.

Abandonment.

Abandonment means a general abandonment to the public. It is a dedication to the public, a giving up of the claim to a monopoly in the

invention. *American Leather Co. v. American Tool Co.*, 4 Fish. 284; s. c. 1 Holmes 503.

Abandonment must result from the intention of the patentee expressly declared or indicated by his acts. *McMillin v. Barclay*, 5 Fish. 189; s. c. 4 Brews. 275.

The intention to abandon need not be expressed in words. *Planing Machine Co. v. Keith*, 101 U. S. 479; s. c. 17 O. G. 1031; s. c. 4 Ban & Ard. 100.

At common law, the right of property of an inventor to his invention or discovery passed from him as soon as it went into public use with his consent. It was then regarded as having been dedicated to the public as common property, and subject to the common use and enjoyment of all. *Wilson v. Rousseau*, 4 How. 646; s. c. 1 Blatch. 3; s. c. 2 Robb 373; *American Leather Co. v. American Tool Co.*, 4 Fish. 284; s. c. 1 Holmes 503; *Dudley v. Mayhew*, 3 N. Y. 9.

It is competent for a patentee at any time by overt acts or by express dedication, to abandon or surrender to the public for their use, all the rights secured by his patent, if such is his pleasure clearly and deliberately expressed. So if for a series of years the patentee acquiesces without objection in the known public use by others, of his invention, or stands by and encourages such use, such conduct will afford a very strong presumption of such an actual abandonment or surrender. *A fortiori*, the doctrine will apply to a case where the patentee has openly encouraged or silently acquiesced in such use by the very parties whom he afterwards seeks to prohibit by injunction from any further use, for in this way he may not only mislead them into expenses or acts or contracts against which they might otherwise have guarded themselves, but his conduct operates as a surprise, if not as a fraud upon them. *Wyeth v. Stone*, 1 Story 273; s. c. 2 Robb 23; *Consolidated Fruit Jar Co. v. Wright*, 12 Blatch. 149; s. c. 6 O. G. 327; s. c. 94 U. S. 92; s. c. 1 Ban & Ard. 320; *Gray v. James*, 1 Pet. C. C. 394; s. c. 1 Robb 120.

It makes no difference in the principle that the article so publicly used and afterwards patented was made by a particular individual who did so by the private permission of the inventor. *M'Clurg v. Kingsland*, 1 How. 202; s. c. 2 Robb 105; *Pennock v. Dialogue*, 2 Pet. 1; s. c. 4 Wash. C. C. 598; s. c. 1 Robb 466, 542.

If the inventor, after his invention is perfected, acquiesces in its use in public for a less term than two years, without applying for a patent, and by such acquiescence abandons his invention, concluding not to patent it, but to dedicate it to the public use, he can not recall such dedication or defeat such abandonment by a subsequent application for a patent, and the patent is therefore void. *New York v. Ransom* 1 Fish. 252; s. c. 23 How. 487; *Teese v. Phelps*, 1 McAl. 48; *Consolidated Fruit Jar Co. v. Wright*, 12 Blatch. 149; s. c. 6 O. G. 327; s. c. 94 U. S. 92; s. c. 1 Ban & Ard. 320; *Bell v. Daniels*, 1 Fish. 372; s. c. 1 Bond 212; *M'Clurg v. Kingsland*, 1 How. 202; s. c. 2 Robb 105; *American Leather Co. v. American Tool Co.*, 4 Fish. 284; s. c. 1 Holmes 503; *Earl v. Page*, 6 N. H. 477; *Pennock v. Dialogue*, 2 Pet. 1; s. c. 4 Wash. C. C. 538; s. c. 1 Robb 466, 542.

The acquiescence of an inventor in the public use of his invention can in no case be presumed where he has no knowledge of such use. But this knowledge may be presumed from the circumstances of the case. *Shaw v. Cooper*, 7 Pet. 292; s. c. 1 Robb 643.

Those who rely upon the ground that a party has by abandonment forfeited a legal right secured to him in due form of law for the purpose of defeating his enjoyment of that right, must make out the point clearly and satisfactorily beyond any reasonable doubt or hesitation, because the law does not favor an abandonment, and throws upon the party who seeks to obtain the benefit of a forfeiture the burden of proving it beyond all reasonable question. *Seymour v. McCormick*, 2 Blatch. 240; s. c. 16 How. 480; *Pitts v. Hall*, 2 Blatch. 229; *Wyeth v. Stone*, 1 Story 273; s. c. 2 Robb 23; *American Leather Co. v. American Tool Co.*, 4 Fish. 284; s. c. 1 Holmes 503; *McMillin v. Barclay*, 5 Fish. 189; s. c. 4 Brews. 275; *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; *Birdsell v. McDonald*, 6 O. G. 682; s. c. 1 Ban & Ard. 165; *Hovey v. Henry*, 3 West. L. J. 153.

An inventor may abandon his invention and surrender or dedicate it to the public. The inchoate right thus once gone, can not afterwards be resumed at his pleasure; for where gifts are once made to the public in this way, they become absolute. The question which generally arises at trials is a question of fact, rather than of law, whether the acts or acquiescence of the party furnish in the given case satisfactory proof of an abandonment or dedication of the invention to the public. *Pennock v. Dialogue*, 2 Pet. 1; s. c. 4 Wash. C. C. 538, s. c. 1 Robb 466, 542; *Sanders v. Logan*, 2 Fish. 167; *Marsh v. Sales*, 7 A. L. Rev. 355; s. c. 5 Fish. 610; *Wayne v. Holmes*, 2 Fish. 20; s. c. 1 Bond 27; *Mellus v. Silsbee*, 4 Mason 108; s. c. 1 Robb 506; *Wittemore v. Cutter*, 1 Gallis. 478; s. c. 1 Robb 40; *Kenwall v. Winsor*, 21 How. 322; *Morris v. Huntington*, 1 Paine 348; s. c. 1 Robb 448; *Shaw v. Cooper*, 7 Pet. 292; s. c. 1 Robb 643; *Booth v. Garely*, 1 Blatch. 247; *Consolidated Nitrate Jar Co. v. Wright*, 12 Blatch. 149; s. c. 6 O. G. 327; s. c. 94 U. S. 92; s. c. 1 Ban & Ard. 320; *Sprague v. Adriance*, 14 O. G. 308; s. c. 3 Ban & Ard. 124; *Williams v. B. & A. R. R. Co.*, 16 O. G. 906; s. c. 17 Blatch. 21; s. c. 4 Ban & Ard. 421; *Andrews v. Cross*, 19 O. G. 1705; s. c. 19 Blatch. 204; s. c. 8 Fed. Rep. 269.

Lapse of time does not *per se* constitute abandonment. It may be a circumstance to be considered. The circumstances of the case other than mere lapse of time almost always give complexion to the delay, and either excuse it or give it conclusive effect. The statute has made contemporaneous public use with the consent and allowance of the inventor a bar when it exceeds two years. But in the absence of that and any other colorable circumstances, there is no mere period of delay which ought *per se* to deprive an inventor of his patent. *Andrews v. Carman*, 13 Blatch. 307; s. c. 9 O. G. 1011; s. c. 2 Ban & Ard. 277; *Russell Manuf. Co. v. Mallory*, 5 Fish. 632; s. c. 10 Blatch. 140; 2 O. G. 495; *Freund v. King*, 11 O. G. 2; *Page v. Bowers*, 1 O. G. 521; *Birdsell v. McDonald*, 6 O. G. 682; s. c. 1 Ban & Ard. 165.

No man is to be permitted to lie by for years and then take out a patent. If he has been practicing his invention with a view of improving it, and thereby rendering it a greater benefit to the public before taking out a patent, that ought not to prejudice him. But it should always be a question submitted to the jury what was the intention of the delay, and whether the allowing the invention to be used without a patent should not be considered an abandonment or present of it to the public. *Morris v. Huntington*, 1 Paine 348; s. c. 1 Robb 448; *Shaw v. Cooper*, 7 Pet. 292; s. c. 1 Robb 643; *Treadwell v. Bladen*, 4 Wash. C. C. 703; s. c. 1 Robb 531; *Goodyear v. Matthews*, 1 Paine 300; s. c. 1 Robb 50.

The mere fact of making or selling an improvement or invention, or of putting it into public use at any time within two years before the application for a patent, is not of itself an abandonment of the invention to the public. Something more must be done within the two years. There must be some acts of the inventor indicating an intention on his part to devote his improvement to the public in general, in order to authorize the conclusion that he has so abandoned it. There must be a design to devote the invention to the public at large as a gratuity, and without receiving a consideration for its bestowal. *Seymour v. McCormick*, 2 Blatch. 240; s. c. 16 How. 480; *Pitts v. Hall*, 2 Blatch. 229.

The mere fact that a new article is shown in the drawings of a patent for a machine is not an abandonment of it until the statutory forfeiture of use for two years has been incurred. *Hatch v. Moffitt*, 15 Fed. Rep. 252.

If the inventor did not intend to take a patent, and manifested that intent by his declarations or conduct, and thereupon it was copied, and so went into use, he cannot afterwards take a valid patent. *Kendall v. Winsor*, 21 How. 322.

A declaration of an intention to abandon the invention to the public does not bind the inventor, for he is entitled to the *locus pœnitentiæ*. There must be something more than mere words to fasten on him the intention which, in judgment of law, will work an abandonment of his invention. There must be acts. The mere declaration of an intention to dedicate the invention to the public can not be regarded as equivalent to an actual dedication. *Pitts v. Hall*, 2 Blatch. 229; *Page v. Bowers*, 1 O. C. 521.

It is the acquiescence in the known user by the public, without objection or qualification, and not the extent of the actual user, which constitutes the ground for inferring abandonment or surrender of the patent. If the patentee means to surrender his exclusive right in a qualified manner, or for a qualified trade, he should at the very time give public notice of the nature and extent of his allowance of the public use, so that all persons may be put upon their guard, and not expose themselves to losses or perils which they have no means of knowing or averting during his general silence or acquiescence. *Wyeth v. Stone*, 1 Story 273; s. c. 2 Robb 23.

If the invention was publicly used for a long period by the inventor himself, not in the way of experiment, but for gain, the patent is void. *Bell v. Daniels*, 1 Fish. 372; s. c. 1 Bond 212.

The jury has a right to infer an abandonment from the patentee's acquiescence in the use of the invention by others, his neglect to assert his claims by suit or otherwise, his omission to sell licenses to use such invention, his neglect to make efforts to realize any personal advantage from his patent, and similar circumstances. *New York v. Ransom*, 1 Fish. 252; s. c. 23 How. 487.

If the knowledge of the invention is surreptitiously obtained and communicated to the public, it will not affect the right of the inventor. Under such circumstances no presumption can arise in favor of an abandonment of the right of the inventor to the public, though an acquiescence on his part will lay the foundation for such a presumption. *Kendall v. Winsor*, 21 How. 322; *Shaw v. Cooper*, 7 Pet. 292; s. c. 1 Robb 643; *Page v. Bowers*, 1 O. G. 521.

If the invention, through fraudulent means, is made known to the public, the inventor should assert his right immediately, and take the necessary steps to legalize it. No matter by what means an invention may be communicated to the public, any acquiescence in the public use by the inventor will be an abandonment of his right. If the right were asserted by him who fraudulently obtained it, perhaps no lapse of time would give validity to it, but the public stand in an entirely different relation to the inventor. *Shaw v. Cooper*, 7 Pet. 292; s. c. 1 Robb 643.

The use of an invention by the special permission of the patentee, under a license limited to one or two persons, is not a use of it by the public, and does not constitute an abandonment. *McCay v. Burr*, 6 Penn. 147.

A patent for a combination which does not specify that the patentee has invented any of the parts, is a dedication of such parts to the public. *Battin v. Taggart*, 2 Wall. Jr. 101; s. c. 17 How. 74.

If the inventor makes a mistake as to one of the improvements claimed, but is clearly entitled to a patent as to the other, he can not be justly said to have abandoned either during a litigation as to his right to both. *Adams v. Jones*, 1 Fish. 527.

The putting of a device intended to perfect the working of a patented machine upon such machine when sold, will not necessarily imply that the patentee intended to abandon it to the public, or put it in public use, or on sale. That is a question of fact purely. Whether the inventor put it on merely for the purpose of experiment, or put it on and sold it with the rest of the machine for gain and profit, and let it go into public use, is a question of fact. *American Leather Co. v. American Tool Co.*, 4 Fish. 284; s. c. 1 Holmes 503.

Where the jury are satisfied that the patentee has not abandoned his invention and privileges granted by the letters patent, his neglect to prosecute parties infringing such patent will not bar his right to recover such damages as he has actually sustained by the defendant's infringement. *New York v. Ransom*, 1 Fish. 252; s. c. 23 How. 487.

The inventor will not be deemed to have abandoned his invention by licensing a few persons to use his invention to ascertain its utility, or by

any such acts of peculiar indulgence and use as may fairly consist with the clear intention to hold the exclusive privilege. *Mellus v. Silsbee*, 4 Mason 108; s. c. 1 Robb 506; *American Leather Co. v. American Tool Co.*, 4 Fish. 284; s. c. 1 Holmes 503.

Mere delay in applying for a patent will not vitiate it if it is not unreasonable. *Webster v. Carpet Co.*, 5 O. G. 522; s. c. 1 Ban & Ard. 84.

Mere forbearance to apply for a patent during the progress of experiments, and until the party has perfected his invention and tested its value by actual practice, affords no just grounds for any presumption of any abandonment. *Agawam Co. v. Jordan*, 7 Wall. 583; *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; *Locomotive Truck Co. v. R. R. Co.*, 6 O. G. 927; s. c. 1 Ban & Ard. 470.

A sale or use of the invention, with the knowledge or consent of the patentee in the intermediate time between the application for a patent and a grant thereof, furnishes no foundation to presume that the inventor means to abandon his invention to the public. *Ryan v. Goodwin*, 3 Sumn. 514; s. c. 1 Robb 725; *Howe v. Newton*, 2 Fish. 531.

By the application filed in the patent office the inventor makes a full disclosure of his invention, and gives public notice of his claim for a patent. It is conclusive evidence that the inventor does not intend to abandon it to the public. The delay afterwards interposed, either by the mistakes of the public officers or the delays of courts, where gross laches can not be imputed to the applicant, can not affect his rights. The statute forfeits the right of an inventor to a patent only where the invention has been in public use more than two years before the application. A man may justly be treated as having abandoned his application if it be not prosecuted with reasonable diligence. But involuntary delays not caused by the laches of the applicant will not work a forfeiture of his right. *Henry v. Stove Co.*, 9 O. G. 408; s. c. 2 Ban & Ard. 221; *Adams v. Jones*, 1 Fish. 527; *Howard v. Christy*, 10 O. G. 981; s. c. 2 Ban & Ard. 457; *Johnson v. Fassman*, 5 Fish. 471; s. c. 1 Woods 138; 2 O. G. 94; *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; *Blandy v. Griffith*, 3 Fish. 609; *Clark v. Scott*, 5 Fish. 245; s. c. 9 Blatch. 301; 1 O. G. 4; *Dental Vulcanite Co. v. Wetherbee*, 3 Fish. 87; s. c. 2 Cliff. 555; *Goodyear D. & V. Co. v. Willis*, 7 O. G. 41; s. c. 1 Flippin 385; s. c. 1 Ban & Ard. 562; *Goodyear v. Hills*, 3 Fish. 134.

The pendency of an application for a patent for an invention repels any inference of abandonment or dedication from the omission to again claim it, though described in a patent granted upon a subsequent application for a patent for another invention. *Suffolk Co. v. Hayden*, 3 Wall. 315; *Singer v. Braunsdorf*, 7 Blatch. 521.

The pendency of an application for a patent for an invention repels any inference of an abandonment or dedication from the omission to claim it in another application where it is described. *Suffolk Co. v. Hayden*, 4 Fish. 86; s. c. 3 Wall. 315.

The proof of an abandonment of an application depends upon two circumstances; whether the inventor meant to give it up, or whether, being needy, he gave up, during a short time, for want of funds. A man of genius, who has made a discovery, should not be deprived of it in consequence of a want of means to prosecute his labors to their final consummation, if he intended to persevere. Even if the application was withdrawn, his claim will be valid if he kept it up in his own mind, and meant to keep it up before the patent office, and did not abandon it, but merely suspended operations till he could get the means. *Adams v. Edwards*, 1 Fish. 1.

A party can not be held accountable for delays in the patent office, and an abandonment will not be inferred therefrom. The law looks with indulgence upon the delays which arise from the circumstances of the party who may make an invention, and it is only when the invention is intentionally abandoned or neglected, or the party shows by his acts that he has not done all that he could have done, that the law declares that he shall not be protected in his invention. *Sayles v. Railroad Company*, 2 Fish. 523; s. c. 1 Biss. 468; *Ryan v. Goodwin*, 3 Sumn. 514; s. c. 1 Robb 725; *Root v. Ball*, 4 McLean 177; s. c. 2 Robb 513; *Rich v. Lippincott*, 2 Fish. 1; *McMillin v. Bray*, 5 Fish. 189; s. c. 4 Brews. 275.

If a party, upon the rejection of his application, withdraws all the papers except a drawing, and then permits his invention to go into notorious public use for a long time, the application will be deemed to be abandoned. *Bevin v. East Hampton Bell Co.*, 5 Fish. 23; s. c. 9 Blatch. 50.

If an inventor does not prosecute his application with reasonable diligence, but withdraws the papers from the patent office and abandons the invention to the public, a subsequent patent therefor will be void. *Bevin v. East Hampton Bell Co.*, 5 Fish. 23; s. c. 9 Blatch. 50.

If the application is rejected, the applicant is obliged, within a reasonable time, to take some action on the subject, either by an appeal from the commissioner, or by a bill in equity in the proper court. If he does not, there is a presumption of an abandonment which can not be rebutted by a mere denial of an intention to abandon. *Marsh v. Commissioner*, 5 Fish. 610; s. c. 3 Biss. 321; 2 O. G. 340.

If an inventor, after the rejection of his application, takes no steps for many years to reinstate it, to renew it, or to appeal, but sees his invention go into common use, he may be deemed to have abandoned it. *Planing Machine Co. v. Keith*, 101 U. S. 479; s. c. 17 O. G. 1031; s. c. 4 Ban & Ard. 400.

The objection that the invention has been abandoned may be raised, although the commissioner has granted a patent. *Planing Machine Co. v. Keith*, 101 U. S. 479; s. c. 17 O. G. 1031; s. c. 4 Ban & Ard. 400.

If the patentee, subsequent to the date of his letters patent, abandons his invention to the public, and waives and abandons the exclusive privileges intended to be secured by such patent, he cannot recover. *New York v. Ransom*, 1 Fish. 252; s. c. 23 How. 487; *Bell v. Daniels*, 1 Fish. 372; s. c. 1 Bond 212.

After the issue of letters patent, the abandonment must be shown to be positive, actual and intentional by some act or declaration of the inventor, or by such gross laches as indicates unmistakably an intention to abandon the invention to the public. *Johnson v. Fassman*, 5 Fish. 471; s. c. 1 Woods 138; 2 O. G. 94; *Bell v. Daniels*, 1 Fish. 372; s. c. 1 Bond 212.

A party may obtain a patent for an invention and let it lie in the patent office without use, and no one else would have the right to use such invention because it is his property. *Pitts v. Wemple*, 2 Fish. 10; s. c. 1 Biss. 87.

A patentee who is prevented by poverty from making machines or selling rights under his patent, will not be deemed to have abandoned it. *Hoffheins v. Brandt*, 3 Fish. 218; *Gray v. James*, 1 Pet. C. C. 394; s. c. 1 Robb 120.

If the patent is valid, the inventor is not bound by law to construct his invention in order to preserve his patent. *Wheeler v. Clipper Co.*, 6 Fish. 1; s. c. 10 Blatch. 181; 2 O. G. 442; *Broadnax v. Cent. S. Y. & T. Co.*, 5 Ban & Ard. 609; s. c. 4 Fed. Rep. 214.

Notice of Previous Knowledge.

The party giving notice is not bound to be so specific as to relieve the other from all inquiry or effort to investigate the facts. If he fairly puts his adversary in the way that he may ascertain all that is necessary to his defence, it is all that can be required, and he is not bound by his notice to impose an unnecessary and embarrassing restriction upon his own right of producing proof of what he asserts. When in addition to the town or city in which a large machine is used, the name and residence of the witness by whom that use is to be proved, is also given, there is sufficient precision and certainty in the notice. *Wise v. Allis*, 9 Wall. 737; *Smith v. Frazer*, 5 Fish. 543; s. c. 2 O. G. 175

The statute does not require that the names of the witnesses who may be called to testify to such prior invention, or use, shall be stated. It is only the names and residences of the persons alleged to have invented or to have had prior knowledge of the thing patented that is required. *Planing Machine Co. v. Keith*, 101 U. S. 479; s. c. 17 O. G. 1031; s. c. 4 Ban & Ard. 400; *Wilton v. Railroads*, 1 Wall. Jr. 192; s. c. 2 Robb 641; *Allis v. Buckstaff*, 22 O. G. 1705; *Sutro v. Moll*, 19 Blatch. 89; s. c. 8 Fed. Rep. 909.

The statute requires that the notice should set forth the name of the person who had knowledge of the use and the place where it was used. A witness whose name is not so given, can not testify in regard to such prior use. *Judson v. Cope*, 1 Fish. 615; s. c. 1 Bond 327; *Kelleher v. Darling*, 14 O. G. 673; s. c. 4 Cliff. 424; s. c. 3 Ban & Ard. 328.

A witness can not testify unless the notice also states "where the same was used." *Silby v. Foote*, 14 How. 218; s. c. 1 Blatch. 445; *Scaris v. Bouton*, 21 O. G. 1784; s. c. 12 Fed. Rep. 140.

Notice of the time when the person possessed the knowledge or use of the invention is not required by the statute. The name of the person

and of his place of residence, and the place where it has been used, are sufficient. If, therefore, the notice mentions the time, the defendant is not limited to the time mentioned, but may give evidence of its use at other times. *Phillips v. Page*, 24 How. 164; *Evans v. Kremer*, Pet. C. C. 215; s. c. 1 Robb 66.

If the notice merely alleges a use within the United States, evidence can not be given of a use in England. *Dixon v. Moyer*, 4 Wash. C. C. 68; s. c. 1 Robb 324.

A notice which refers merely to the county in which the alleged prior invention was used is defective. This reference is not sufficiently definite and explicit as to the place to fill the requirements of the spirit of the act. *Hays v. Sulsor*, 1 Fish. 532; s. c. 1 Bond 279.

If a witness testifies without objection for want of notice, this is a waiver of notice. *Planing Machine Co. v. Keith*, 17 O. G. 1031; s. c. 101 U. S. 479; s. c. 4 B. & A. 100.

If the notice alleges a certain patent in which the invention is alleged to be described, this is a sufficient foundation for adding the patent in evidence. *Lock Co. v. Higgins*, 105 U. S. 580; 21 O. G. 2031; s. c. 16 O. G. 675; s. c. 15 B. & A. 146; s. c. 4 Ban & Ard. 88.

Burden of Proof.

Upon the plea of not guilty it is incumbent on the plaintiff to prove not merely that the defendant had made, used or sold a machine, but that it substantially infringed the patent for which the plaintiff has obtained his patent. *Dixon v. Moyer*, 4 Wash. C. C. 68; s. c. 1 Robb 324.

The plaintiff charges an infringement, which is a wrongful act in the nature of a trespass, and inasmuch as no one is presumed to do wrong, the rule is that the plaintiff who alleges that another has committed a wrongful act must prove it. *Refinery v. Mathiessen*, 2 Fish. 600; s. c. 3 Cliff. 639; *Wright v. ...* Fish. 372; s. c. 1 Bond 212; *Forbes v. Barstow Stove Co.*, 3 Fish. 479; *Brooks v. Jenkins*, 3 McLean 432; *Hudson v. Draper*, 4 Fish. 178; *Parker v. Stiles*, 5 McLean 44; *Francis v. Melick*, 1 Fish. 237; s. c. 5 Fish. 153; 1 O. G. 48; 8 Phila. 157; *Johnson v. Roo*, 1 Fish. 351; *Cahoon v. Ring*, 1 Fish. 397; s. c. 1 Cliff. 592; *Many v. Siser*, 1 Fish. 17; *Latta v. Shawk*, 1 Fish. 465; s. c. 1 Bond 259; *Matthews v. Skates*, 1 Fish. 602; *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206; *Judson v. Cope*, 1 Fish. 615; s. c. 1 Bond 327; *Swift v. Whisen*, 3 Fish. 343; s. c. 2 Bond 115; *Price v. Kelly*, 20 O. G. 1452; *Railroad Co. v. Mellon*, 104 U. S. 112; s. c. 20 O. G. 1891.

Doubts as to whether there has been an infringement or not must inure in favor of the defendant, as he is not to be deprived of a right which is common to every citizen, unless it shall clearly appear that his machine is substantially like the one claimed by the patentee. *Brooks v. Jenkins*, 3 McLean 432.

The expressions in the specifications are those of the patentee, and the burden of proof rests on him to explain and to clear them of ambiguity. *Kneass v. Schuylkill Bank*, 4 Wash. C. C. 9; s. c. 1 Robb 303.

The burden of proof is on the defendant, to show that the patentee was not the first inventor. *Brooks v. Jenkins*, 4 McLean 432; *Ashcroft v. Cutter*, 6 Blatch. 511; *Cahoon v. Ring*, 1 Fish. 397; s. c. 1 Cliff. 592; *Parham v. Sewing Machine Co.*, 4 Fish. 468; *Earle v. Sawyer*, 4 Mason 1; s. c. 1 Robb 491; *Winans v. N. Y. & Harlem R. R. Co.*, 4 Fish. 1; *Latta v. Shawk*, 1 Fish. 465; s. c. 1 Bond 259; *Brodie v. Ophir Mining Co.*, 4 Fish. 137; s. c. 5 Saw. 608; *Waterman v. Thomson*, 2 Fish. 461; *Goodyear Dental Co. v. Gardner*, 4 Fish. 224; s. c. 3 Cliff. 408; *Whitney v. Emmett*, Bald. 303; s. c. 1 Robb 567; *Masury v. Tiemann*, 4 Fish. 524; s. c. 8 Blatch. 426; *Pitts v. Hall*, 2 Blatch. 229; *Dixon v. Moyer*, 4 Wash. C. C. 68; s. c. 1 Robb 324; *Tompkins v. Gage*, 2 Fish. 577; s. c. 5 Blatch. 268; *Agawam Co. v. Jordan*, 7 Wall. 583; *Forbes v. Barstow Stove Co.*, 2 Cliff. 379; *Konold v. Klein*, 3 Ban & Ard. 26; *Sands v. Wardwell*, 3 Cliff. 277; *Washburn & M. Manuf. Co. v. Haish*, 10 Biss. 65; s. c. 19 O. G. 173; s. c. 4 Fed. Rep. 900; *Green v. French*, 21 O. G. 1351; s. c. 11 Fed. Rep. 591; *Doubleday v. Beatty*, 22 O. G. 859; s. c. 11 Fed. Rep. 729.

It is not enough that he raise a doubt in the minds of the jury on that point, he must satisfy them of the fact. *Magic Ruffle Co. v. Douglass*, 2 Fish. 330; *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; *Tompkins v. Gage*, 2 Fish. 577; s. c. 5 Blatch. 268; *Crouch v. Speer*, 6 O. G. 187; s. c. 1 Ban & Ard. 145; *Jordan v. Dobson*, 4 Fish. 232; s. c. 2 Abb. N. S. 398; 7 Phila. 533; *Mowry v. Whitney*, 3 Fish. 157; s. c. 4 Fish. 141; 5 Fish. 496; 14 Wall. 620; 2 Bond 45; s. c. 1 O. G. 492; *Hawes v. Antisdel*, 8 O. G. 685; s. c. 2 Ban & Ard. 10; *Taylor v. Wood*, 12 Blatch. 110; 8 O. G. 90; s. c. 1 Ban & Ard. 270.

The proof must be clear that the prior invention is the same in principle as that of the patentee. Doubts on this point must inure in favor of the patent. *Brooks v. Jenkins*, 3 McLean 432; *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600; s. c. 3 Cliff. 639; *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206; *Parham v. Sewing Machine Co.*, 4 Fish. 468; *Roberts v. Dickey*, 4 Fish. 532; s. c. 4 Brews. 260; 1 O. G. 4; *McMillin v. Barclay*, 5 Fish. 189; s. c. 4 Brews. 275; *Clark v. Scott*, 5 Fish. 245; s. c. 9 Blatch. 301; 1 O. G. 4; *Rogers v. Beecher*, 18 O. G. 793; s. c. 5 Ban & Ard. 619; s. c. 3 Fed. Rep. 639; *Miller v. Smith*, 18 O. G. 1047; s. c. 5 Fed. Rep. 359; *Stillwell & B. Manuf. Co. v. Cin. Gas Co.*, 7 O. G. 829; s. c. 1 Ban & Ard. 610.

Where the patent has been acquiesced in for a long time, the proof of a prior invention must be established by a clear preponderance of evidence. *Gear v. Grosvenor*, 6 Fish. 314; s. c. 1 Holmes 215; 3 O. G. 380; *Blanchard v. Putnam*, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond 84.

When the defendant shows a knowledge and use prior to the date of the patent, the burden is on the plaintiff to show that his invention was prior to such knowledge and use. *Loom Co. v. Higgins*, 21 O. G. 2031; s. c. 105 U. S. 580; s. c. 16 O. G. 675; s. c. 15 Blatch. 446; s. c. 4 Ban & Ard. 88.

If the defendant proves a knowledge and use by others prior to the date of the application for the patent, the burden is then shifted to the patentee to prove an invention or discovery prior to that thus shown by the defendant. *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.

The burden of proof to show an abandonment is on the defendant. *Hoffheins v. Brandt*, 3 Fish. 218.

The burden of proof to show a public use for more than two years before the application for the patent is on the defendant. *Hovey v. Henry*, 3 West. L. J. 153; *Brown v. Guild*, 23 Wall. 181; s. c. 6 O. G. 392; 7 O. G. 739; *Comstock v. Sandusky Seat Co.*, 13 O. G. 230; s. c. 3 Ban & Ard. 188; *Campbell v. James*, 18 O. G. 979; s. c. 17 Blatch. 43; s. c. 4 Ban & Ard. 456.

If the defendant alleges a license, the burden of proof is on him to establish it. *Watson v. Smith*, 20 O. G. 300; s. c. 7 Fed. Rep. 350.

The burden of proof is on the defendant to prove that the specification is so defective as not to enable a skilful mechanic to construct the machine claimed. *Brooks v. Jenkins*, 3 McLean 432.

The burden of proof is on the defendant to show that a machine made according to the patent is not a practical machine. *Fifield v. Whittemore*, 17 Fed. Rep. 513.

Presumption from Patent.

No patent is issued without an examination at the patent office by persons skilled in the subject, into the specification and the subject and extent of the claims. The commissioner is intrusted by law with the power and duty of granting patents for new and useful inventions. He is authorized to grant a patent only for a new and useful invention or improvement, and it is to be presumed that he has performed his duty. Under these circumstances, the patent when issued affords *prima facie* evidence of the novelty and utility of the invention patented, which *prima facie* evidence is sufficient to establish such novelty and utility, unless it is rebutted by countervailing testimony. *Potter v. Holland*, 1 Fish. 382; s. c. 4 Blatch. 238; *Blanchard v. Putnam*, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond 84; *Hussey v. Bradley*, 2 Fish. 362; s. c. 5 Blatch. 134; *New York v. Ransom*, 23 How. 487; s. c. 1 Fish. 252; *Magic Ruffle Co. v. Douglass*, 2 Fish. 330; *Matthews v. Skates*, 1 Fish. 602; *Teese v. Phelps*, 1 McAl. 48; *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600; s. c. 3 Cliff. 639; *Lowell v. Lewis*, 1 Mason 182; s. c. 1 Robb 121; *Cox v. Griggs*, 2 Fish. 174; s. c. 1 Biss. 362; *Adams v. Edwards*, 1 Fish. 1; *Wintermute v. Redington*, 1 Fish. 239; *Clark Patent Co. v. Copeland*, 2 Fish. 221; *Bell v. Daniels*, 1 Fish. 372; s. c. 1 Bond 212; *White v. Allen*, 2 Fish. 440; s. c. 2 Cliff. 224; *Rich v. Lippincott*, 2 Fish. 1; *Poppenhusen v. Gutta Percha Comb Co.*, 2 Fish. 62; *Parker v. Hulme*, 1 Fish. 44; *Waterman v. Thomson*, 2 Fish. 461; *Corning v. Burden*, 15 How. 252; *Allen v. Hunter*, 6 McLean 303; *Alden v. Dewey*, 1 Story 336; s. c.

2 Robb 17; Brooks v. Jenkins, 3 McLean 432; Heinrich v. Luther, 6 McLean 345; Johnson v. Root, 1 Fish. 351; Wayne v. Holmes, 2 Fish. 20; s. c. 1 Bond 27; Crompton v. Belknap Mills, 3 Fish. 536; Cahoon v. Ring, 1 Fish. 397; s. c. 1 Cliff. 592; Woodworth v. Rogers, 3 W. & M. 135; s. c. 2 Robb 625; Haselden v. Ogden, 3 Fish. 378; Pitts v. Edmonds, 2 Fish. 52; s. c. 1 Biss. 168; Blanchard v. Putnam, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond 84; Hudson v. Draper, 4 Fish. 253; s. c. 4 Cliff. 178; Many v. Sizer, 1 Fish. 17; Seymour v. Osborne, 3 Fish. 555; s. c. 11 Wall. 516; Waterbury Brass Co. v. N. Y. Brass Co., 3 Fish. 43; Mitchell v. Tilghman, 19 Wall. 287; s. c. 4 Fish. 599; 5 O. G. 299; s. c. 2 Fish. 518; s. c. 9 Blatch. 1; Sands v. Wardwell, 3 Cliff. 277; Kelleher v. Darling, 14 O. G. 673; s. c. 4 Cliff. 424; s. c. 3 Ban & Ard. 438; Thatcher Heating Co. v. Drummond, 3 Ban & Ard. 138; Union Stone Co. v. Allen, 14 Fed. Rep. 353; s. c. 39 Leg. Int. 442.

The patent when produced in evidence, whether it be an original or a reissued one, is *prima facie* evidence that the thing granted required invention, and that the patentee was the inventor or discoverer thereof. Serrell v. Collins, 1 Fish. 289; Conover v. Rapp, 4 Fish. 57; Forbes v. Barstow Stove Co., 2 Cliff. 379; Suffolk Co. v. Hayden, 4 Fish. 86; s. c. 3 Wall. 315; Roberts v. Harnden, 2 Cliff. 500; Goodyear Dental Co. v. Gardner, 4 Fish. 224; s. c. 3 Cliff. 408; Dental Vulcanite Co. v. Wetherbee, 3 Fish. 87; s. c. 2 Cliff. 555; Cook v. Howard, 4 Fish. 269; Knight v. Railroad Co., 3 Fish. 1; s. c. Taney 106; Sherman v. Champlain Co., 31 Vt. 162; Ayling v. Hull, 2 Cliff. 494; Mitchell v. Tilghman, 4 Fish. 599; s. c. 19 Wall. 287; 5 O. G. 299; s. c. 9 Blatch. 1; s. c. 2 Fish. 518; Hoffheins v. Brandt, 3 Fish. 218; Potter v. Holland, 1 Fish. 382; s. c. 4 Blatch. 206; Winans v. N. Y. & Harlem R. R. Co., 4 Fish. 1; Tucker v. Spaulding, 13 Wall. 453; s. c. 1 O. G. 144; s. c. 5 Fish. 297; s. c. Deady 649; Whipple v. Baldwin Manuf. Co., 4 Fish. 29.

The patent is not conclusive evidence that the invention is novel or useful. Wright v. Wilson, 11 Rich. 144; Bierce v. Stocking, 77 Mass. 174.

The presumption of utility and novelty arising from the grant of a patent is strengthened by its extension. Mowry v. Whitney, 3 Fish. 157; s. c. 4 Fish. 141; 5 Fish. 496; 14 Wall. 620; 2 Bond 45; s. c. 1 O. G. 492; Swift v. Whisen, 3 Fish. 343; s. c. 2 Bond 115; Cook v. Ernest, 5 Fish. 396; s. c. 1 Woods 195; 2 O. G. 89.

The presumption of utility arising from the grant of the patent can only be repelled by clear proof that it is utterly worthless. Tilghman v. Werk, 2 Fish. 229; s. c. 1 Bond 511.

A patent to parties as joint inventors is *prima facie* evidence that the invention was joint. Hotchkiss v. Greenwood, 4 McLean 456; s. c. 11 How. 248; s. c. 2 Robb 730.

A patent relates back where the question of novelty is in issue to the date of the invention, and not to the time of the application for issue. Klein v. Russell, 19 Wall. 433; Dixon v. Moyer, 4 Wash. C. C. 68; s. c. 1 Robb 324; *contra*, Union Sugar Refinery v. Mathiessen, 2 Fish. 600; s. c. 3 Cliff. 639; Wing v. Richardson, 2 Fish. 535; s. c. 2 Cliff. 449;

White *v.* Allen, 2 Fish. 440 ; s. c. 2 Cliff. 224 ; Johnson *v.* Root, 2 Fish. 291 ; s. c. 2 Cliff. 108 ; Sewall *v.* Jones, 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.

The patent is *prima facie* evidence that, in the specification, there is contained a description in such full, clear and exact terms as will enable any one skilled in the art to which it appertains to put it in practice. Poppenhusen *v.* Gutta Percha Comb Co., 2 Fish. 62.

If the evidence does not show the date of the application for the patent, the application will be presumed to have been made on the day of the date of the patent. Worley *v.* Loker Tobacco Company, 104 U. S. 340 ; s. c. 21 O. G. 559.

If a copy of the application is not produced, the presumption is that it corresponds with the patent. Loom Co. *v.* Higgins, 21 O. G. 2031 ; s. c. 105 U. S. 580 ; s. c. 15 Blatch. 446 ; s. c. 16 O. G. 675 ; s. c. 4 Ban & Ard. 88.

If the defendant has a patent for his invention, he may give it in evidence, for he is entitled to the benefit of the presumption in his favor arising from an investigation of the originality of his invention, and the judgment of the public officers, that his machine is new and not an infringement of the patent previously granted. If the plaintiff's patent in a doubtful case may have some weight in turning the scale in his favor, it is but just that the defendant should have the same benefit from his ; *valeat quantum valeat*. The parties should contend on an equal field and be allowed to use the same weapons. Corning *v.* Burden, 15 How. 252 ; American Pin Co. *v.* Oakvill Co., 3 Blatch. 190 ; Brown *v.* Selby, 4 Fish. 363 ; s. c. 2 Biss. 457 ; Stearns *v.* Barrett, 1 Mason 153 ; s. c. 1 Robb 97 ; Goodyear Dental Co. *v.* Gardner, 4 Fish. 224 ; s. c. 3 Cliff. 408.

The granting of a subsequent patent is *prima facie* evidence that the use of the devices thus patented does not infringe a prior patent. Corning *v.* Burden, 15 How. 252 ; Smith *v.* Woodruff, 6 Fish. 476 ; s. c. 1 McArthur 459 ; 4 O. G. 635 ; Burden *v.* Corning, 2 Fish. 477 ; Westlake *v.* Carter, 6 Fish. 519 ; s. c. 4 O. G. 636 ; Many *v.* Sizer, 1 Fish. 17 ; Trader *v.* Messmore, 7 O. G. 385 ; s. c. 1 Ban & Ard. 639 ; N. Y. Rubber Co. *v.* Chaskel, 9 O. G. 923.

A patent subsequent in date can not have the effect as evidence to overcome the *prima facie* presumption otherwise afforded by the introduction of one of prior date, that the patentee was the original and first inventor of what is therein described as his improvement. Goodyear Dental Co. *v.* Gardner, 4 Fish. 224 ; s. c. 3 Cliff. 408.

Evidence.

The oath recited in the patent is evidence, and the jury are entitled to judge of its force. Alden *v.* Dewey, 1 Story 336 ; s. c. 2 Robb 17 ; Woodworth *v.* Rogers, 3 W. & M. 135 ; s. c. 2 Robb 625.

Parol evidence is not admissible to show the time when the application for a patent was made. Wayne *v.* Winter, 6 McLean 344.

The letters of the patentee to the commissioner, containing applications for a patent, are admissible. *Pettibone v. Derringer*, 4 Wash. C. C. 215; s. c. 1 Robb 152.

If the signature of a letter acknowledging the receipt of an application for a patent is proved, the letter is competent as an official act and document of a public officer in relation to such a subject, and a part of the transaction. Being made at the time and in relation to the subject, it is a competent declaration as a part of the *res gestæ*, and explanatory of what took place. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530; *Pike v. Potter*, 3 Fish. 55.

A copy of the file wrapper and other papers connected with the application are not competent evidence to prove that the invention was made at the time the oath to the specifications was taken. *Howes v. McNeal*, 4 Fed. Rep. 151; s. c. 17 O. G. 799; s. c. 5 Ban & Ard. 77.

An application for a patent can not carry the date of the invention back to its own date unless it is an application for substantially the same invention for which the patent is granted without material variation or addition. *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.

When the defence consists of an anticipation by a prior patent, the plaintiff may show that the actual date of his invention was prior to the contesting patent. *Tyler v. Crane*, 19 O. G. 128; s. c. 7 Fed. Rep. 775.

When a patent bears on its face a particular construction, such construction may be confirmed by the correspondence between the applicant and the commissioner of patents. *Goodyear D. V. Co. v. Davis*, 102 U. S. 222; s. c. 19 O. G. 543; 3 Ban & Ard. 115.

A certified copy of a patent cancelled on account of a defective specification is competent evidence to prove a prior invention. *Delano v. Scott*, Gilp. 489; s. c. 1 Robb 700.

If there are any inaccuracies in a certified copy of a patent, they may be shown by other certified copies. A former and defective transcript will not affect a full and corrected copy. *Brooks v. Jenkins*, 3 McLean 432.

The plaintiff cannot give in evidence an exemplification of a patent differing in date, and in the name or style of the improvement patented, from the patent set forth in his replication, to a plea alleging the invalidity of the patent. *Bellas v. Hays*, 5 S. & R. 427.

Neither the report of the examiner nor the decision of the commissioner, upon the question of the extension of a patent, is competent evidence to establish the invalidity of the original patent in an action for the recovery of the amount stipulated to be paid for an assignment thereof, although the extension is refused on the ground of the invalidity of the original patent. *McMahon v. Tyng*, 96 Mass. 167.

If the minutes of a corporation of which the patentee was a member, are read to prove the want of novelty, the patentee can not read other portions of the minute book to prove that the corporation acknowledged him to be the inventor, unless they are necessary to explain the parts

which have been read. If part of a statement be read by one side, the other side may insist upon having the whole read, but a subsequent declaration or statement by the corporation does not come within this exception. *Pennock v. Dialogue*, 4 Wash. C. C. 538; s. c. 2 Pet. 1; s. c. 1 Robb 466, 542.

The minute book of a corporation can not be used as evidence to prove a prior invention, because it is a private and not a public work. *Pennock v. Dialogue*, 4 Wash. C. C. 538; s. c. 2 Pet. 1; s. c. 1 Robb 466, 542.

The minute book of a corporation of which the patentee was a member, and to which he furnished minutes, may be used as evidence to prove a prior invention. *Pennock v. Dialogue*, 4 Wash. C. C. 538; s. c. 2 Pet. 1; s. c. 1 Robb 466, 542.

A receipt which gives a right to use certain machines may be used to reduce the amount of the recovery, and not as a complete bar, and for this purpose is admissible under the general issue. *Burdell v. Denig*, 92 U. S. 716.

The patentee can not prove that one part of a combination claimed in the patent is immaterial and useless. *Vance v. Campbell*, 1 Fish. 483; s. c. 1 Black 427.

The affirmative statement of a witness as to what he saw and heard is entitled to more credit than the negative statement of another witness that he did not see or hear the same thing. *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600; s. c. 3 Cliff. 639.

A mistake as to date is a frequent occurrence even with honest witnesses, and where it satisfactorily appears that it was but an unintentional error, the fact that such a mistake was made is not entitled to much weight as affecting the credit of the witness. *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600; s. c. 3 Cliff. 639.

No comparison can be instituted between the defendant's machine and an alleged prior invention. Prior inventions can only be compared with the patented invention upon the issue of novelty. The defendant's machine can only be compared with the patentee's upon the issue of infringement. *Judson v. Cope*, 1 Fish. 615; s. c. 1 Bond 327.

If Congress passes an act for the relief of a patentee by extending his patent, relying upon his representations, equity and good conscience demand that he shall be held to them. *Union Manuf. Co. v. Lounsbury*. 2 Fish. 389.

Evidence that a compromise made by another was not founded on any admission of the patentee's right in the invention is irrelevant and inadmissible. *Phila. & Trenton R. R. Co. v. Stimpson*, 14 Pet. 448; s. c. 2 Robb 46.

In case of either a latent or a patent ambiguity, collateral facts and the circumstances in which the parties were placed when the agreement was made may be given in evidence; in the first case, to ascertain something extrinsic or matter out of the instrument where there is no ambiguity from the language of it, and in the other when from defective terms the intention of the parties can not be collected from them. *Troy Factory v. Corning*, 14 How. 193; s. c. 1 Blatch. 467.

If the novelty of the invention is impeached, the patentee may give evidence to prove that the working of his machine is different and decidedly superior in its results to the alleged prior invention. *Judson v. Cope*, 1 Fish. 615 ; s. c. 1 Bond 327.

The declarations of third parties as to the name and reputation of the machine used by the defendant are inadmissible. The persons from whom the witness received information on this subject ought to be called on to give it on oath, and in the regular way. *Evans v. Hettick*, 3 Wash. C. C. 408 ; s. c. 7 Wheat. 453 ; s. c. 1 Robb 166, 417.

The fact that a person is subject to fits of derangement is no objection either to his competency or credibility, if he is sane at the time of giving his testimony. *Evans v. Hettick*, 3 Wash. C. C. 408 ; s. c. 7 Wheat. 453 ; s. c. 1 Robb 166, 417.

The patentee can not be asked whether he has ascertained that a statement made by him that the patent had been tested in court is untrue, in an action instituted by him to recover the amount due under a contract upon the sale thereof, where the defence is that the representation was false and fraudulent, for the question implies that the information has been obtained since the making of the representation. *McMahon v. Tyng*, 96 Mass. 167.

Evidence that the persons, of whose prior use of the invention the defendant has given testimony, have paid the plaintiff for licenses to use it since his patent, is entitled to but very little weight, but ought not to be absolutely rejected. Connected with other testimony, and under some circumstances, even the opinion of a party may be worth something. *Evans v. Eaton*, 3 Wheat. 454 ; s. c. Pet. C. C. 322 ; s. c. 1 Robb 68, 243 ; *Evans v. Hettick*, 3 Wash. C. C. 408 ; s. c. 7 Wheat. 453 ; s. c. 1 Robb 166, 417.

The defendant, upon an examination in chief, may ask his witness if his machine is like the model of the patentee's machine. *Evans v. Hettick*, 3 Wash. C. C. 408 ; s. c. 7 Wheat. 453 ; s. c. 1 Robb 166, 417.

In an action for fraud in the sale of a patent right, a remark of the vendor in the course of a conversation about the sale, that the best way to sell patent rights is to take notes and indorse them, so that no question can be made about the patent, is relevant. *Peck v. Bacon*, 18 Conn. 377.

If a party does not have a machine of any kind, a witness can not be asked whether such party offered to take a license from the patentee. It is an act among strangers which ought not to prejudice the defendant. *Evans v. Hettick*, 3 Wash. C. C. 408 ; s. c. 7 Wheat. 453 ; s. c. 1 Robb 166, 417.

Exhibits introduced by a party without needful explanation will not receive much consideration. *Miller v. Smith*, 18 O. G. 1047 ; s. c. 5 Fed. Rep. 359.

In an action at law upon a sealed instrument, failure of consideration or fraud in the consideration is not admissible for the purpose of avoiding the obligation. *Hartshorn v. Day*, 3 Fish. 32 ; s. c. 19 How. 211.

The patentee is not barred by any admission as to the validity of his patent. *Adams v. Edwards*, 1 Fish. 1.

An inquiry into what the patentee invented is proper, because it may aid in giving a construction to his patent, but his legal right is that which is secured to him by his patent, and if he has invented anything else, meritorious or otherwise, still, if it is not embraced in the patent, then he can maintain no suit upon it. He is necessarily confined to that which is granted to him by the deed from the government, which is called a patent. *Johnson v. Root*, 1 Fish. 351.

A contract made by the defendant with the plaintiff for the right to use the machine is admissible as evidence of the utility of the invention. *Lee v. Blandy*, 2 Fish. 89; s. c. 1 Bond 361.

Whenever a witness is called to impeach the credit of another, he must know what is generally said of the witness whose credit is impeached by those among whom the last-named witness resides, in order that he may be able to answer the inquiry either as to his general character in the broader sense, or as to his general reputation for truth and veracity. He is not required to speak from his own knowledge of the acts and transactions from which the character and reputation of the witness have been derived, nor, indeed, is he allowed to do so, but he must speak from his own knowledge of what is generally said of him by those among whom he resides and with whom he is chiefly conversant, and any question that does not call for such knowledge is an improper one and ought to be rejected. *Teese v. Huntingdon*, 23 How. 2.

An inquiry into the principles and mode of operation of the machine of a third person, merely to test the knowledge and correctness of a witness, is irrelevant, for a witness can not be examined as to a mere collateral fact, having no relevancy to the issue, in order to draw from him an answer which may, by other evidence, be shown incorrect, and thereby discredit him. Such an inquiry, moreover, would embarrass the jury by drawing their attention to the principles of a machine not in controversy. *Odiorne v. Winkley*, 2 Gallis. 51; s. c. 1 Robb 52.

Testimony in regard to the reputation of a witness may properly be excluded by the court when it applies to a period of time so remote from the transaction involved in the controversy as thereby to become entirely unsatisfactory and immaterial, and as the law can not fix that period of limitation it must necessarily be left to the discretion of the court. *Teese v. Huntingdon*, 23 How. 2.

The plaintiff, in the cross-examination of a witness produced to repel the rebutting evidence, can not ask him whether one of the defendant's witnesses is not subject to fits of mental derangement, for the testimony might have been obtained on the primary examination of the witnesses. *Evans v. Hettick*, 3 Wash. C. C. 408, s. c. 7 Wheat. 453; s. c. 1 Robb 166, 417.

Every circumstance which can affect the veracity of a witness, whether it concerns his moral character or arises from some interest which he may have in the question, or from feelings and wishes favorable to one or the other of the parties, should be taken into consideration. *Evans v. Hettick*, 3 Wash. C. C. 408; s. c. 7 Wheat. 453; s. c. 1 Robb 166, 417;

Tucker v. Spaulding, 13 Wall. 453 ; s. c. 1 O. G. 144 ; s. c. 5 Fish. 297 ; s. c. 1 Deady 649.

A party has no right to cross-examine any witness except as to facts and circumstances connected with the matters stated in his direct examination. If he wishes to examine him as to other matters, he must do so by making the witness his own, and calling him as such in the subsequent progress of the cause. Phila. & Trenton R. R. Co. v. Stimpson, 14 Pet. 448 ; s. c. 2 Robb 46.

The court will judicially take notice of matters of science which are in common knowledge and use. Brown v. Piper, 91 U. S. 37 ; s. c. 1 Holmes 20 ; 10 O. G. 417 ; s. c. 4 Fish. 175 ; Terhune v. Phillips, 99 U. S. 592 ; McCloskey v. Dubois, 19 O. G. 1286 ; s. c. 20 O. G. 371 ; s. c. 19 Blatch. 205 ; s. c. 3 Fed. Rep. 710 ; Walker v. Rawson, 4 Ban & Ard. 128.

The invention is an intellectual process or operation, and, like all other expressions of thought, can, in many cases, scarcely be made known except by speech. The invention may be consummated and perfect, and may be susceptible of complete description in words, a month or even a year before it can be embodied in any visible form, machine or composition of matter. The conversations and declarations of the patentee stating that he had made an invention, and describing its details and explaining its operations, are properly to be deemed an assertion of his right at that time as an inventor to the extent of the facts and details which he then makes known, although not of their existence at an antecedent time. Such conversations and declarations, coupled with a description of the nature and objects of the invention, are to be deemed a part of the *res gestæ*, and legitimate evidence that the invention was then known to and claimed by him, and thus its origin may be fixed at least as early as that period. Phila. & Trenton R. R. Co. v. Stimpson, 14 Pet. 448 ; s. c. 2 Robb 46 ; Evans v. Hettick, 3 Wash. C. C. 408 ; s. c. 7 Wheat. 453 ; s. c. 1 Robb 166, 417.

The mode of conducting trials, the order of introducing evidence, and the times when it is to be introduced, are properly matters belonging to the practice of the circuit courts. Probably the practice in no two States of the Union is the same, and therefore in each State the circuit courts must necessarily be vested with a large discretion in the regulation of their practice. If every party had a right to introduce evidence at any time, at his own election, without reference to the stage of the trial in which it is offered, it is obvious that the proceedings of the court would often be greatly embarrassed, the purposes of justice obstructed, and the parties themselves surprised by evidence destructive of their rights, which they could not have foreseen or in any manner have guarded against. All courts are, therefore, vested with a large measure of discretion on this subject, to prevent the most mischievous consequences in the administration of justice to suitors, and the circuit courts possess this discretion in as ample a manner as other judicial tribunals. Phila. & Trenton R. R. Co. v. Stimpson, 14 Pet. 448 ; s. c. 2 Robb 46.

Evidence to prove that there are material differences between the origi-

nal patent and the reissue can not be admitted after the defendant's counsel has stated in open court that he has closed his case, and after the plaintiff, in consequence of that declaration, has discharged his own witnesses. *Phila. & Trenton R. R. Co. v. Stimpson*, 14 Pet. 448; s. c. 2 Robb 46.

The representations of the specifications may be such as to afford satisfactory proof that the alleged invention is neither new nor useful. *Collar Co. v. Van Dusen*, 23 Wall. 530; s. c. 10 Blatch. 119; 7 O. G. 919; s. c. 2 O. G. 361; s. c. 5 Fish. 597.

Parol Evidence.

Parol evidence, bearing upon written contracts and papers, ought not to be admitted without the production of such written contracts and papers, so as to enable both the court and the jury to see whether or not the admission of the parol evidence, in any manner, will trench upon the rule that parol evidence is not admissible to vary or contradict written contracts or papers. *Phila. & Trenton R. R. Co. v. Stimpson*, 14 Pet. 448; s. c. 2 Robb 46.

Parol, or secondary evidence of the contents of a written instrument, is inadmissible without previous proof of the loss of the original, or of its being in the actual possession of the adverse party, and notice given to produce it. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530.

Before a party is allowed to give secondary or parol evidence of the contents of a written instrument supposed to be in the possession of the opposite party, he must first prove the possession of it as well as the notice. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530.

If the written instrument was sent by private hand, then the person carrying it can testify whether he delivered it. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530.

If a written instrument is sent by mail, then, where notice is to be brought home to the correspondent, the letter must be shown to have been received. The law does not presume that it was received. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530.

Proof that a written instrument is in the possession of the adverse party may be by the affidavit of the party, and be disproved by the affidavits of his opponent, and interrogatories be put in the discretion of the court to each by the other. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530.

The evidence to prove that a written instrument is in the possession of the opposite party is weighed under liberal views, rather than technical scruples, and in connection with all the other evidence and circumstances bearing on the point. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530.

The evidence to justify the admission of parol or secondary evidence of the contents of a written instrument must be offered to the court. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530.

It is not permitted to a party to control a written agreement by parol testimony of declarations or conversations at the time it was completed,

or before, which would contradict, add to or alter the written agreement, either in the case of a latent or patent ambiguity. *Troy Factory v. Corning*, 14 How. 193; s. c. 1 Blatch. 467; *Ruggles v. Eddy*, 5 Fish. 581; s. c. 10 Blatch. 52.

If the defence is that the machine was constructed with the consent of the patentee, this may be established by competent oral testimony. *Black v. Hubbard*, 12 O. G. 842; s. c. 3 Ban & Ard. 39.

Experts.

There are various classes of cases which depend upon the knowledge of a peculiar art or science for their solution, of a particular business requiring a peculiar knowledge in order to form a satisfactory judgment of the question involved. In such cases, the law allows testimony to be given by those skilful in the particular art, science, or profession, and permits them to give their opinions as results which they arrive at from an examination of the questions of fact that are before the jury. *Johnson v. Root*, 1 Fish. 351; *Cahoon v. Ring*, 1 Fish. 397; s. c. 1 Cliff. 592; *Many v. Sizer*, 1 Fish. 17.

The opinion of skilful witnesses, whether the principles of two machines are the same, is competent evidence to be introduced in a patent cause, but care should be taken to distinguish what is meant by a principle. The true legal meaning of the principle of a machine, with reference to the patent act, is the peculiar structure or constituent parts of such machine. In this view, the question may be very properly asked in cases of doubt or complexity, of skilful persons, whether the principles of two machines be the same or different. *Barrett v. Hall*, 1 Mason 447; s. c. 1 Robb 207; *Conover v. Rapp*, 4 Fish. 57; *Tillotson v. Ramsay*, 51 Vt. 309.

An expert can not be asked whether he has ascertained from investigations in scientific works or otherwise that the invention was not novel, for the question seeks to establish an historical fact under the guise of a scientific opinion. *McMahon v. Tyng*, 96 Mass. 167.

When the subject of investigation is an alleged invention of complex mechanism both new and useful, and the alleged invention relates to mechanism, in which advances have been made since its date, the conclusions of witnesses as to non-invention, if admissible at all, are to be received with hesitation, because in a large class of cases it is difficult for them to place their minds in the condition of the person who was groping his way towards the development of what is now plain but was then unknown. *Yale Lock Manuf. Co. v. Norwich Natl. Bank*, 6 Fed. Rep. 377; s. c. 19 Blatch. 123.

The opinion of a witness in regard to what a prior invention might have been applied to, is not admissible, for it is a mere matter of speculation. The speculative opinions of a witness can not be given in evidence. *Judson v. Cope*, 1 Fish. 615; s. c. 1 Bond 327.

It is competent for an expert to testify that the practical manner of giving effect to the principle embodied in the machine used by the defend-

ant is entirely different from the practical manner of giving effect to the principle embodied in the patentee's machine, and that the principles of the two machines, as well as the practical manner of carrying out those principles, are different. *Corning v. Burden*, 15 How. 252.

It is competent for an expert to testify that the machine used by the defendant differs in point of mechanical structure and mechanical action from the machine described in the patent. *Corning v. Burden*, 15 How. 252.

Experts may be examined as to the meaning of terms of art, on the principle of *cuique in sua arte credendum*, but not as to the construction of written instruments. They are not, therefore, competent to give an opinion as to the construction of the patent. *Corning v. Burden*, 15 How. 252; *Jackson v. Allen*, 120 Mass. 64; *Winans v. N. Y. & Erie R. R. Co.*, 1 Fish. 213; s. c. 21 How. 88; *Day v. Stellman*, 1 Fish. 487; *Ely v. Monson Manuf. Co.*, 4 Fish. 64.

Great respect is due to the views and opinions of scientific individuals and practical mechanics on the question of identity of different mechanical structures. From their acquaintance with the elements of mechanical science, they are enabled satisfactorily to decide the question, while to others it might seem involved in obscurity and doubt. *Parker v. Stiles*, 5 McLean 44; *Potter v. Muller*, 2 Fish. 465; *French v. Rogers*, 1 Fish. 133.

Experience has shown that opposite opinions of persons professing to be experts may be obtained to any amount, and it often occurs that not only many days, but even weeks are consumed in cross-examinations to test the skill or knowledge of such witnesses and the correctness of their opinions, wasting the time and wearying the patience of both court and jury, and perplexing instead of elucidating the questions involved in the issue. *Winans v. N. Y. & Erie R. R. Co.*, 1 Fish. 213; s. c. 21 How. 88; *Conover v. Rapp*, 4 Fish. 57; *Mitchell v. Tilghman*, 4 Fish. 599; s. c. 2 Fish. 518; s. c. 9 Blatch. 1; s. c. 19 Wall. 287; 5 O. G. 299; *King v. Louisville Cement Co.*, 6 Fish. 336; s. c. 4 O. G. 181.

Widely as experts differ in opinion in the trial of patent causes, those differences are almost always traceable to the assumption of different postulates. Their opinions differ because they are given on substantially different cases. When their minds can be drawn to the same point, and they use the same words in the same sense, they rarely differ. *Sargent v. Carter*, 1 Fish. 277.

The mere opinion of experts, when not sustained by pointing out clearly the particulars of difference or coincidence between pieces of machinery constructed to produce the same results, and working out those results by means so nearly identical as to create a strong presumption of a common origin, can not afford proof very satisfactory to the mind that the judgment of the witnesses ought to be adopted. *U. S. Annunciator Co. v. Sanderson*, 3 Blatch. 184.

It is unsafe in many particulars to rely on the opinion of witnesses as to the identity of two machines, for the reason that they may not have a

clear perception in what the identity consists, and in that case their opinions, whether they are identical or not identical, should have no weight with the jury. *Conover v. Rapp*, 4 Fish. 57.

An examination should be made to see whether the opinions of experts embrace in them any question of law. When a question of law is involved in the opinion of experts, that is not to be left to a jury. *Ely v. Monson Manuf. Co.*, 4 Fish. 61.

When the opinions of experts are expressed in *ex parte* affidavits, and there is no opportunity for the court to ascertain in what sense they use important words, or what facts they take into view, or what standards of comparison they assume, their opinions are of comparatively little use in guiding the court to a safe conclusion. *Sargent v. Carter*, 1 Fish. 277.

In passing upon the identity or diversity of machines in principle, it is more satisfactory to ascertain the precise differences and agreements than to take the mere opinions of witnesses, and when such differences and agreements can be subjected to the eyes, they almost supersede all the evidence of mere opinion. *Barrett v. Hall*, 1 Mason 447; s. c. 1 Robb 207; *Livingston v. Jones*, 1 Fish. 521; *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Kelleher v. Darling*, 14 O. G. 673; s. c. 4 Cliff. 424; s. c. 3 Ban & Ard. 438.

Ocular demonstration is better than the opinions of experts. *Adams v. Jones*, 1 Fish. 527; *Hoffheins v. Brandt*, 3 Fish. 218; *Blanchard v. Putnam*, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond 84.

The statement of a fact by one who has seen a machine work is better, if reliable, than the mere opinion of ever so scientific an expert. *Cox v. Griggs*, 2 Fish. 174; s. c. 1 Biss. 362.

The jury are not bound by the opinions of experts. They are introduced only to aid the jury, and the jury may rely upon them so far as they shall think proper. The jury in forming a judgment upon such testimony may take into view their ability, their knowledge of the art or profession in which they are engaged, the fairness with which they express an opinion, the impartiality of that opinion, the reasons that may be assigned for that opinion, and all those considerations which go to create a confidence or a distrust of the opinions which are given. *Bierce v. Stocking*, 77 Mass. 174; *Johnson v. Root*, 1 Fish. 351; *Many v. Sizer*, 1 Fish. 17; *Hudson v. Draper*, 4 Fish. 256; s. c. 4 Cliff. 178; *Carter v. Baker*, 4 Fish. 404; s. c. 1 Saw. 512; *Tucker v. Spaulding*, 13 Wall. 453; s. c. 1 O. G. 142; s. c. 1 Deady 649; s. c. 5 Fish. 297; *Cahoon v. Ring*, 1 Fish. 397; s. c. 1 Cliff. 592; *Cox v. Griggs*, 2 Fish. 174; s. c. 1 Biss. 362; *Conover v. Roach*, 4 Fish. 12; *Whipple v. Baldwin Manuf. Co.*, 4 Fish. 29; *Conover v. Rapp*, 4 Fish. 57; *Page v. Ferry*, 1 Fish. 298; *Waterbury Brass Co. v. New York Brass Co.*, 3 Fish. 43.

Estoppel.

The defendant is not estopped by any prior offer made by him to take a license from the patentee. If the offer amounted to an acknowledgment

that the patentee was the original inventor, this may be used as evidence of that fact, but it would not entitle the patentee to a verdict if the fact is proved to be otherwise. *Evans v. Eaton*, Pet. C. C. 322; s. c. 3 Wheat. 454; s. c. 1 Robb 6², 243.

Although a patentee has been guilty of negligence in prosecuting an infringer, yet that is no defence to an action at law. *Concord v. Norton*, 16 Fed. Rep. 477.

If an expression in a patent is withdrawn by a surrender and reissue, the patentee is not estopped from disputing its truth. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530.

If several patents are taken out by several patentees for a several invention, and the same patentees afterwards take out a joint patent for the same as a joint invention, the parties are not absolutely estopped by the former patents from asserting the invention to be joint, but the former patents are very strong evidence against the joint invention. The reason of this doctrine is not that estoppels are odious in law, but that a party may innocently make a mistake as to the extent of his own invention. A party may suppose that he has invented what in truth has been partly suggested by another mind. *Barrett v. Hall*, 1 Mason 447; s. c. 1 Robb 207.

The dismissal of a proceeding in chancery is usually pleaded in bar to a subsequent proceeding, and averments are made that the dismissal was on the merits. But if it is not so pleaded and averred, and is only offered in evidence, then the evidence *dehors* the record, if not in it, should accompany the record and prove all which is proper to show that the dismissal was the result of a judicial inquiry, and disposed of the rights of the parties involved in the proceedings. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530.

If the same merits or points are not again agitated in the second suit, then the first decision, being on different matters, can not bind or control the second suit. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530.

A verdict rendered on an issue sent to be tried at law is not admissible as evidence in another suit between the same parties, if the complainant dismissed the bill without any judgment on the merits. A mere verdict in any suit does not, as a matter of course, settle the rights of the parties. It is open to numerous exceptions growing out of rulings on evidence that was offered, and opinions or principles involved in the merits, and may be set aside for various errors in them, or for misbehavior of the jury. *Allen v. Blunt*, 2 W. & M. 121; s. c. 3 Story 742; s. c. 2 Robb 282, 530.

A judgment in an action where the novelty and originality of the invention were put in issue by the pleadings precludes the defendant from raising the same questions in a subsequent action, although he endeavors to sustain it by additional evidence. *Dubois v. P. W. & B. R. R. Co.*, 5 Fish. 208.

Province of Jury.

The question in respect to an assertion or surrender of the rights of an inventor, whether it be sought in his declarations or acts, or in forbearance or neglect to speak or act, is an inquiry or conclusion of fact, and peculiarly within the province of a jury guided by legal evidence submitted to them at the trial. *Kendall v. Winsor*, 21 How. 322; *Battin v. Taggart*, 17 How. 74; s. c. 2 Wall. Jr. 101; *American Leather Co. v. American Tool Co.*, 4 Fish. 284; s. c. 1 Holmes 503.

When a claim does not point out and designate the particular elements which compose a combination, but only declares, as it properly may, that the combination is made up of so much of the described machinery as effects a particular result, it is a question of fact which of the described parts are essential to produce that result, and to this extent, not the construction of the claim strictly speaking, but the application of the claim, should be left to the jury. *Silsby v. Foote*, 14 How. 218; s. c. 1 Blatch. 445.

A question of infringement is one of fact which it is the province of a jury to decide. *Rich v. Lippincott*, 2 Fish. 1; *Case v. Brown*, 2 Fish. 268; s. c. 2 Wall. 320; 1 Biss. 382; *Brooks v. Jenkins*, 3 McLean 432; *Batten v. Taggart*, 17 How. 74; s. c. 2 Wall. Jr. 101; *Blanchard v. Putnam*, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond 84; *Carter v. Baker*, 4 Fish. 404; s. c. 1 Saw. 512; *Orr v. Burwell*, 15 Ala. 378.

It is for the court to say what is identity in point of law. *Latta v. Shawk*, 1 Fish. 465; s. c. 1 Bond 259.

Whether two machines are the same in substance or not is a question of fact for the jury. *Carver v. Hyde*, 16 Pet. 513; *Le Roy v. Tatham*, 2 Blatch. 474; s. c. 14 How. 156; *Many v. Jagger*, 1 Blatch. 372; *Colt v. Mass. Arms Co.*, 1 Fish. 108; *Blanchard's Factory v. Warner*, 1 Blatch. 258; *Kidd v. Spence*, 4 Fish. 37; *Tillotson v. Ramsay*, 51 Vt. 309.

Whether one compound of given proportions is substantially the same as another compound varying in the proportions, is a question of fact. *Tyler v. Boston*, 7 Wall. 327.

Whether a given improvement is a patentable invention is a mixed question of law and fact, and should not in ordinary cases be disposed of on demurrer and without the intervention of a jury. *Teese v. Phelps*, 1 McAl. 17.

Whether the description is so particular as to enable a mechanic to construct the machine is a question for the jury. *Brooks v. Jenkins*, 3 McLean 432; *Goodyear v. Wait*, 3 Fish. 242; s. c. 5 Blatch. 468; *Parker v. Stiles*, 5 McLean 44; *Forbes v. Barstow Stove Co.*, 2 Cliff. 379; *Davis v. Palmer*, 2 Brock. 298; s. c. 1 Robb 518; *Page v. Ferry*, 1 Fish. 298; *Hogg v. Emerson*, 2 Blatch. 1; s. c. 6 How. 437; 11 How. 587; s. c. 2 Robb 655; *Judson v. Moore*, 1 Fish. 544; s. c. 1 Bond 285; *Wayne v. Holmes*, 2 Fish. 20; s. c. 1 Bond 27; *Evans v. Eaton*, 7 Wheat. 356; s. c. 3 Wash. C. C. 443; s. c. 1 Robb 193, 336; *Carver v. Braintree Manuf. Co.*, 2 Story 432; s. c. 1 Robb 141; *Battin v. Taggart*, 17 How. 74; s. c. 2 Wall. Jr. 101.

If the identity of the inventions described in two patents does not appear upon their face without the assistance of experts, the question should be submitted to the jury. *Hawkes v. Remington*, 111 Mass. 171.

It is the province of the court to decide what constitutes novelty of invention. *Parker v. Stiles*, 5 McLean 44.

Whether an invention is novel is a question of fact for the jury to determine. *Sickels v. Borden*, 3 Blatch. 535; *Turrill v. Railroad Company*, 1 Wall. 491; *Many v. Jagger*, 1 Blatch. 372; *Serrell v. Collins*, 1 Fish. 289; *Parker v. Stiles*, 5 McLean 44; *Battin v. Taggart*, 17 How. 74; s. c. 2 Wall. Jr. 101; *Swift v. Whisen*, 3 Fish. 343; s. c. 2 Bond 115.

It is the duty of the court to construe the patent and specifications for the purpose of determining what the claim of the discovery or invention is, and it is the province of the jury under the instructions of the court as to what the invention is, to determine whether such invention is new and useful. *Wintermute v. Redington*, 1 Fish. 239; *Parker v. Hulme*, 1 Fish. 44; *Poppenhusen v. Gutta Percha Comb Co.*, 2 Fish. 62.

When it becomes a matter of inquiry whether the benefits of a patent are of sufficient consequence to be protected by the arm of the government, the question should be left to the jury. *Langdon v. De Groot*, 1 Paine 203; s. c. 1 Robb 433.

Whether an invention of a composition can be used in any case with advantage without first ascertaining, by experiment, the proportion to be employed, is a question to be decided by a jury, upon the evidence of persons skilled in the art to which the patent appertains. *Wood v. Underhill*, 5 How. 1; s. c. 2 Robb 588.

Whether the invention itself be thus specifically described with reasonable certainty is a question of law upon the construction of the terms of the patent. *Lowell v. Lewis*, 1 Mason 187; s. c. 1 Robb 131; *Wintermute v. Redington*, 1 Fish. 239; *Wilton v. Railroad Co.*, 2 Whart. Dig. 359.

Whether the specification is sufficiently clear and certain in its description of the invention involves a question of law only in part, or so far as regards the construction of the written words used. *Hogg v. Emerson*, 6 How. 437; s. c. 2 Blatch. 1; s. c. 2 Robb 655; *Forbes v. Barstow Stove Co.*, 2 Cliff. 379; *Howes v. Nute*, 4 Fish. 263; s. c. 4 Cliff. 173.

Whether the specification is uncertain and insufficient is a question of law for the court. *Wayne v. Holmes*, 2 Fish. 20; s. c. 1 Bond 27.

In questions of identity or diversity, it is not the construction of written instruments, but the character of the invention that is sought, and this is a question of fact. In case of a conflict between a prior and a subsequent patent, the question of identity is a question of fact for the jury and not a question of law for the court. *Bischoff v. Wethered*, 9 Wall. 812; *Stevens v. Pierpont*, 42 Conn. 360; *Waterbury Brass Co. v. N. Y. Brass Co.*, 3 Fish. 43; *Jackson v. Allen*, 120 Mass. 64; *Tucker v. Spalding*, 5 Fish. 297; s. c. 13 Wall. 453; 1 O. G. 144. s. c. 1 Deady 649.

Trial by jury, though an inestimable right, is not a trial without a court,

and it is not so regarded either by the Constitution or the laws of Congress. It is as much the duty of the court to determine the questions raised as to the admissibility of evidence as it is that of the jury to determine its weight after it is received. It is the imperative duty of the court to rule out testimony which in law is not admissible. *Cahoon v. Ring*, 1 Fish. 397; s. c. 1 Cliff. 592.

All questions of the force and effect of the testimony, of the credit which shall be given to witnesses, of the facts which shall be considered to be established, of inferences to be drawn from them, are matters for the jury alone. *Johnson v. Root*, 1 Fish. 351.

If the jury find that a witness has wilfully sworn falsely to a fact material to the issue, they are at liberty, if they deem it proper to do so, to disbelieve everything he has stated in the case. *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600; s. c. 3 Cliff. 639.

The jury are to judge of the credibility of witnesses under the instructions of the court. *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600; s. c. 3 Cliff. 639.

The determination of the court upon questions of law is conclusive upon the parties and upon the jury. *Conover v. Roach*, 4 Fish. 12.

Practice.

All torts are joint as well as several, and the patentee may recover a verdict against one, though the other defendant is acquitted. *Reutgen v. Kanowrs*, 1 Wash. C. C. 168; s. c. 1 Robb 1.

The court, though reasonably requested, is not bound to instruct the jury on points not arising in the case, or on abstract and irrelevant propositions. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530.

The court is never bound to give an instruction to a jury upon a point of law, even when pertinent and relevant to the facts of the case, precisely in the form and manner in which it is put by counsel, for that may sometimes have a tendency to mislead the jury and withdraw their attention from the merits of the case. All that it is the duty of the court to do is to give such instructions to the jury in point of law as clearly arise upon the evidence, and are proper for the consideration of the jury upon the issues before them, in such terms and in such a manner as shall comport with the real merits and justice of the case, and enable the jury to give a proper verdict in point of law. *Pitts v. Whitman*, 2 Story 609; s. c. 2 Robb 189.

A motion for leave to amend by adding the name of a party who, at the time of the infringement, had the exclusive right under the patent, will not be granted, for it will amount to the institution of a new suit materially different both as to plaintiff and rights of action. *Goodyear v. Bourn*, 3 Blatch. 266.

If the patentee has obtained a patent in his own name in fraud of the rights of another who is a joint inventor, he is in equity a trustee for the other, and though possibly at law a verdict must be rendered for the

patentee against such joint inventor, still the jury may give merely nominal damages. *Reutgen v. Kanowrs*, 1 Wash. C. C. 168; s. c. 1 Robb 1.

An infringement, by a patentee, of the exclusive right conferred upon a grantee, is no defence to an action by the patentee to recover the license fee which the grantee stipulated to pay for each machine sold by him. *Birdsall v. Perego*, 5 Blatch. 251.

Courts are called upon only to decide questions that are before them. A judge, sometimes, in giving an opinion, uses language which, although it is always entitled to consideration and respect, yet, in reference to questions that were not before the court, and the decision of which was not necessary to the decision of the questions before it, is not of binding authority. *Day v. Stillman*, 1 Fish. 487.

The judges of the circuit courts ought not to hold themselves bound and the rights of parties concluded by the language of a judge of the Supreme court, unless such language was strictly applicable to the case then before the court. *Day v. Union Rubber Co.*, 20 How. 216; s. c. 3 Blatch. 488.

So far as principles involving the validity of a patent have been settled by the decisions upon it in other courts, they will be regarded as final and authoritative. *Goodyear v. Berry*, 3 Fish. 439; s. c. 2 Bond 189.

A defective notice does not afford a foundation for a motion by the defendant for the withdrawal of a juror, on the ground of surprise arising out of the ruling of the court in respect to the notice and the evidence offered under it, and under any circumstances it is a matter resting altogether in the discretion of the court. *Silsby v. Foote*, 14 How. 218; s. c. 1 Blatch. 445.

The court has no power to order a peremptory nonsuit against the will of the plaintiff. *Silsby v. Foote*, 14 How. 218; s. c. 1 Blatch. 445.

If a juror becomes ill after the plaintiff's counsel begins his opening address, before any evidence is given, he may be discharged from the panel, and the court may treat such discharge as simply creating a vacancy on the panel, and may proceed to fill it in the usual way by having a twelfth juror drawn and sworn. This practice must be confined to cases where it is apparent that the party objecting receives no injury. *Silsby v. Foote*, 14 How. 218; s. c. 1 Blatch. 445.

If the jury disagree and are discharged, the case can not be tried again at the same term by a new jury selected from the residue of the panel, but must go over to await another venire. *Wilson v. Barnum*, 2 Fish. 635; s. c. 1 Wall. Jr. 347; 8 How. 258; s. c. 2 Robb 749.

A special verdict is sufficient if the court can collect the point in issue out of it, although it does not in terms find the issue joined by the parties. *Stearns v. Barrett*, 1 Mason 153; s. c. 1 Robb 97.

When the verdict is not expressed substantially in the terms of the issue, the case ought to be extremely clear that should induce a court to make it the ground of a final judgment. *Stearns v. Barrett*, 1 Mason 153; s. c. 1 Robb 97.

Where there is a material repugnancy in the verdict it is not competent

for the court to reject either part of the finding, for it is utterly impossible for the court to decide which is the truth of the case, and even if it could, there is no authority to substitute its own opinion for that of the jury. In such a case the repugnancy will be fatal. A verdict which finds two inconsistent material facts is void, and can not be the foundation for a legal judgment. *Stearns v. Barrett*, 1 Mason 153; s. c. 1 Robb 97.

The right of the plaintiff to costs follows from a verdict in his favor for any amount of damages, whether nominal or compensatory, and without any reference to the action of the court in adjudging an increase of damages. *Merchant v. Lewis*, 1 Bond 172.

Arrest of Judgment.

It is not a sufficient ground to support a motion in arrest of judgment, that the declaration does not set forth the act complained of as contrary to the statute. This is not necessary where damages are sought for on account of an injury done. *Parker v. Haworth*, 4 McLean 370; s. c. 2 Robb 725.

A motion in arrest of judgment ought properly to be heard after the motion for a new trial, which, if granted, might supersede the other motion. *Pitts v. Whitman*, 2 Story 609; s. c. 2 Robb 189.

New Trial.

If in the hurry of a trial, a ruling of the court in admitting evidence is erroneous, but afterwards becomes immaterial or unnecessary in consequence of other evidence, a new trial will not be granted. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530.

If the error consists in an instruction in regard to the measure of damages, the plaintiff may avoid a new trial by consenting that the verdict be reduced to nominal damages. *Cowing v. Rumsey*, 4 Fish. 275; s. c. 8 Blatch. 36.

A new trial should not be granted for a cause existing at the trial, but which was not stated or excepted to then. The more especially is this so when any wrong or misleading of the jury was likely to flow from the objection not being made. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530.

If a party chooses to carry a question to the jury, he can not complain on that ground, and ask for a new trial, when the verdict is against him. *Silsby v. Foote*, 14 How. 218; s. c. 1 Blatch. 445.

In order to justify the granting of a new trial, it must be so clearly shown that the verdict is against the weight of evidence as to raise a strong presumption that the jury either wantonly abused their powers or made some inadvertent mistake. *Aiken v. Bemis*, 3 W. & M. 348; s. c. 2 Robb 644; *Johnson v. Root*, 2 Fish. 291; s. c. 2 Cliff. 108; *Bray v. Hartshorn*, 1 Cliff. 538.

Although the verdict of a jury is of less weight in patent cases than in other civil causes, yet it will not be set aside unless they were palpably mistaken, and the weight of the evidence was decidedly against the verdict. *Roberts v. Schuyler*, 12 Blatch. 444; s. c. 2 Ban & Ard. 5.

If the verdict is decidedly against the evidence in the cause, it will be set aside. *Wilson v. James*, 3 Blatch. 227.

It must be a very aggravated and oppressive case where the court would feel justified in setting up its own opinion, even if decidedly different from that of the jury, as to the true amount of damages, and award a new trial on that ground. *Allen v. Blunt*, 2 W. & M. 121; s. c. 2 Robb 530; *Alden v. Dewey*, 1 Story 336; s. c. 2 Robb 17; *Whitney v. Emmett*, Bald. 303; s. c. 1 Robb 567; *Aiken v. Bemis*, 3 W. & M. 348; s. c. 2 Robb 644; *Stimpson v. Railroads*, 1 Wall. Jr. 164; s. c. 2 Robb 595.

Error in awarding excessive damages may sometimes be obviated by allowing the prevailing party to remit the excess, and that course is frequently adopted in cases where the court is satisfied that the error has resulted from oversight or mere inadvertence; but where the finding is not only contrary to the evidence, but in direct contravention of the charge of the court, the error can not in general be remedied in that way. *Johnson v. Root*, 2 Fish. 291; s. c. 2 Cliff. 108.

Irregularity on the part of the party charged, or of the jury, must be satisfactorily proved, in order to lay the foundation for the interposition of the court; but when the irregular conduct is established, it is not necessary that it should certainly appear that it influenced the jury. In that state of the case it is sufficient that the irregularity appears to be of such a character that it might have affected the impartiality of the proceedings. *Johnson v. Root*, 2 Fish. 291; s. c. 2 Cliff. 108.

It is not necessary that the attempt to influence the jurors should be made by one of the parties, nor even by his agent. It is sufficient if it clearly appear that it was done in his behalf. *Johnson v. Root*, 2 Fish. 291; s. c. 2 Cliff. 108.

It is never necessary to show that the misconduct controlled or determined the verdict, provided it was of a character that it might have had an undue influence. *Johnson v. Root*. 2 Fish. 291; s. c. 2 Cliff. 108.

A new trial will not be granted upon the discovery of new evidence, if the information might have been obtained by the use of reasonable diligence. *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206.

If a party, by the use of ordinary diligence, could have obtained full evidence to any point which could properly sustain his defence, there is no reason for granting him a new trial merely because he could, upon further reflection and further lights, make a fuller and better defence. *Ames v. Howard*, 1 Sum. 482; s. c. 1 Robb 689.

A new trial will not be granted upon the discovery of new evidence, if the information was within the reach of the party before the trial was concluded. *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206.

A new trial is never granted upon the discovery of mere cumulative evidence, where there is no other ground of objection to the verdict. *Ames v. Howard*, 1 Sum. 482; s. c. 1 Robb 689.

If the new evidence is to subordinate points and particular facts not before agitated, it is not cumulative, although the general subject was discussed. *Aiken v. Bemis*, 3 W. & M. 348; s. c. 2 Robb 644.