

When a new trial is granted for newly discovered evidence, the terms usually are that the costs of the former trial be first paid. *Aiken v. Bemis*, 3 W. & M. 348; s. c. 2 Robb 644.

Depositions to be used on a motion for a new trial may always without a special order be *ex parte*. *Aiken v. Bemis*, 3 W. & M. 348; s. c. 2 Robb 644.

If counter affidavits offered by the adverse party go to establish strong cumulative proofs the other way, the court will always decline to interfere with the verdict, because it will not undertake to measure the weight of the new testimony upon either side, or send the parties again to a litigation upon the chances of a verdict upon new conflicting evidence. *Ames v. Howard*, 1 Sum. 482; s. c. 1 Robb 689.

A party who moves for a new trial upon the ground of the discovery of new evidence can not put in new rebutting evidence to the affidavits of the adverse party, offered in reply to those first offered by himself. He must present his whole case at once to the court, and not lead it on through a series of confirming and rebutting proofs, thus protracting the cause to an unreasonable extent. *Ames v. Howard*, 1 Sum. 482; s. c. 1 Robb 629.

SEC. 4921. The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case.

*Statute Revised*—July 8, 1870, ch. 230, § 55, 16 Stat. 206.

*Prior Statutes*—February 15, 1819, ch. 19, § 1, 3 Stat. 481.—July 4, 1836, ch. 357, § 16, 5 Stat. 123.

### **Parties.**

A contract for the purchase of any portion of the patent right may be good between the parties as a license, and enforced as such in the courts

of justice; but the legal right in the monopoly remains in the patentee, and he alone can maintain an action against a third party who commits an infringement upon it. *Gayler v. Wilder*, 10 How. 477; *Sanford v. Messer*, 5 Fish. 411; s. c. 1 Holmes 149; 2 O. G. 470; *Blanchard v. Eldridge*, 1 Wall. Jr. 337; s. c. 2 Robb 737.

A patentee who has granted a license to make and vend the thing patented within a certain territory, in consideration of the payment of a certain sum for each article so manufactured and sold, reserving to himself the right to sell the thing patented within the territory, is a party aggrieved, and may proceed in equity for the protection of his rights. *Hussey v. Whiteley*, 2 Fish. 120; s. c. 1 Bond 407.

Although a patentee has granted a license to another giving him the exclusive right to use the invention for a limited period, yet he may file a bill against an infringer. *Still v. Reading*, 20 O. G. 1025; s. c. 9 Fed. Rep. 40.

A person who holds the legal title to the patent may maintain a bill in equity, and the fact that others claim an interest therein constitutes no defence of which an infringer can take advantage. *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.

Although a person holds the title in trust, yet he has sufficient interest to maintain a bill in equity. *Campbell v. James*, 18 O. G. 979; s. c. 17 Blatch. 43; s. c. 4 Ban & Ard. 456.

A party who holds the legal title and has an interest in the damages to be recovered for an infringement, is a necessary party. *North v. Kershaw*, 4 Blatch. 70.

If the patentee owns the patent he is entitled to recover the profits, although he has a partner. *Sargent v. Yale Lock Manuf. Co.*, 17 O. G. 105; s. c. 17 Blatch. 244; s. c. 4 Ban & Ard. 574.

If a member of a firm which owns a patent dies, the surviving partners may sue for an infringement. *Loercher v. Crandal*, 21 O. G. 863; s. c. 11 Fed. Rep. 872.

If the State laws permit a *feme covert* to own property as if she were a *feme sole*, she may bring an action for the infringement of a patent in her own name without joining her husband. *Lorillard v. Standard Oil Co.*, 17 O. G. 1507; s. c. 18 Blatch. 199; s. c. 5 Ban & Ard. 432; s. c. 2 Fed. Rep. 902; *Fetter v. Newhall*, 17 Fed. Rep. 841; s. c. 25 O. G. 502.

A patentee can not delegate to another the right to bring a suit in the name of the latter when the suit is not in any way for the benefit of such other person. *Goldsmith v. Am. P. C. Co.*, 18 O. G. 192; s. c. 18 Blatch. 82; s. c. 5 Ban & Ard. 300.

If a person has the right to bring a suit in the name of another he need not obtain his consent or signature to each suit. *Bassett v. Malone*, 11 Fed. Rep. 801.

If an assignment transfer the right to damages for prior infringements the assignee may maintain a suit in equity to recover the same. *Hamil-*



ton *v.* Rollins, 5 Dillon 495 ; s. c. 3 Ban & Ard. 157 ; Jenkins *v.* Greenwald, 2 Fish. 37 ; s. c. 1 Bond 126 ; Shaw *v.* Colwell Lead Co., 11 Fed. Rep. 711 ; Campbell *v.* James, 2 Fed. Rep. 338 ; 18 O. G. 1111 ; s. c. 18 Blatch. 921 ; s. c. 5 Ban & Ard. 354.

A patentee who has assigned his interest prior to the filing of a bill can not obtain an injunction. Morse *v.* O'Reilly, 6 Penn. L. J. 501.

An assignee of a territorial interest in a patent may maintain an action in his own name. Chambers *v.* Smith, 3 Fish. 12 ; s. c. 7 Phila. 575 ; Olcott *v.* Hawkins, 2 Am. L. J. 317.

A grantee may maintain a bill, although he derives his title through a foreign administrator, and there need be no domestic administrator. Smith *v.* Mercer, 5 Penn. L. J. 529 ; s. c. 4 West. L. J. 49.

A party who has merely an interest in the profits, without any legal title in the patent, need not be made a party complainant. Goodyear *v.* Central R. R. Co., 1 Fish. 626 ; s. c. 2 Wall. Jr. 356.

A court of equity, upon a bill by the legal owner of a patent right, can not enjoin the equitable owner from using the thing patented. It considers the equitable title the true title. Clum *v.* Brewer, 2 Curt. 506 ; Day *v.* Candee, 3 Fish. 9 ; Chase *v.* Walker, 3 Fish. 120 ; Continental Co. *v.* Empire Co., 4 Fish. 428 ; s. c. 8 Blatch. 295 ; Whiting *v.* Graves, 13 O. G. 455 ; s. c. 3 Ban & Ard. 222.

The party having an equitable title may maintain a bill in equity against a party having the legal title. Ruggles *v.* Eddy, 5 Fish. 581 ; s. c. 10 Blatch. 52.

If the patentee infringes the rights of a licensee, the licensee may sue in his own name. The breach of trust is an infringement, and its redress involves a suit arising under the patent laws. Littlefield *v.* Perry, 21 Wall. 205 ; s. c. 7 O. G. 964 ; Perry *v.* Littlefield, 17 O. G. 51 ; s. c. 17 Blatch. 272 ; s. c. 18 O. G. 571 ; s. c. 4 Ban & Ard. 624 ; s. c. 2 Fed. Rep. 464 ; Stanley R. & L. Co. *v.* Bailey, 14 Blatch. 510 ; s. c. 3 Ban & Ard. 297.

One tenant in common has as good right to use and to license third persons to use the thing patented as the other tenant in common. Neither can come into a court of equity and assert a superior equity, unless it has been created by some contract modifying the rights which belong to them as tenants in common. Clum *v.* Brewer, 2 Curt. 506.

A mere licensee can not sue strangers who infringe. In such case redress is obtained through or in the name of the patentee or his assignee. Littlefield *v.* Perry, 21 Wall. 205 ; s. c. 7 O. G. 964 ; Hill *v.* Whitcomb, 5 O. G. 430 ; s. c. 1 Holmes 317 ; s. c. 1 Ban & Ard. 34 ; Nelson *v.* McMann, 16 O. G. 761 ; s. c. 16 Blatch. 139 ; s. c. 4 Ban & Ard. 203 ; Union P. B. Co. *v.* Nixon, 21 O. G. 1275 ; s. c. 105 U. S. 766 ; Hayward *v.* Andrews, 23 O. G. 533 ; s. c. 106 U. S. 672 ; s. c. 12 Fed. Rep. 786 ; Ingalls *v.* Tice, 14 Fed. Rep. 352 ; Wilson *v.* Chickering, 23 O. G. 1730 ; s. c. 14 Fed. Rep. 917 ; Gamewell Fire Alarm Tel. Co. *v.* Brooklyn, 22 O. G. 1978 ; s. c. 14 Fed. Rep. 225 ; Ingalls *v.* Tice, 22 O. G. 2160 ; s. c. 14 Fed. Rep. 279.

A licensee may file a bill in equity to enjoin any party who has actually infringed his right under the license. *Brammer v. Jones*, 3 Fish. 340; s. c. 2 Bond 100.

A licensee has not such an interest as requires him to be joined as a party complainant. *Potter v. Wilson*, 2 Fish. 102; *Grover & Baker S. Co. v. Sloat*, 2 Fish. 112; *Nellis v. Pennock Manuf. Co.*, 22 O. G. 1131; s. c. 13 Fed. Rep. 451.

A foreign administrator of the patentee may maintain a suit in the circuit court without taking out new letters of administration in the State where the suit is brought. The title to a patent is regulated by an act of Congress. *Smith v. Mercer*, 5 Penn. L. J. 529; s. c. 4 West. L. J. 49; *Goodyear v. Hullihen*, 3 Fish. 251; s. c. 1 Hughes 492; *Hodge v. Missouri Railroad*, 4 Fish. 161; s. c. 1 Dillon 104.

A corporation created under the laws of one State may file a bill in a circuit court in another State. *Elm City Co. v. Wooster*, 6 Fish. 452; s. c. 4 O. G. 83.

A corporation, unless restrained by its charter, may engage in the manufacture of the thing patented in another State. *Grover & Baker S. Co. v. Sloat*, 2 Fish. 112; *Blanchard's Factory v. Warner*, 1 Blatch. 258.

Where one person has the legal title to a patent, and another person has an equitable right in the same, and a suit in equity is instituted complaining of an infringement, the person having the legal right, and the one having an equitable right which has been violated, should join as complainants. *Stimpson v. Rogers*, 4 Blatch. 333; *Aiken v. Dolan*, 3 Fish. 197; *Dibble v. Augur*, 7 Blatch. 86.

If a patentee has granted an exclusive license to another he can not maintain a bill in equity without joining the licensee. *Hammond v. Hunt*, 4 Ban & Ard. 111.

The patentee and a licensee may unite in a bill to enjoin an infringement of the interest owned by the licensee. *Goodyear v. Central R. R. Co.*, 1 Fish. 626; s. c. 2 Wall. Jr. 356; *Goodyear v. Allyn*, 3 Fish. 374; s. c. 6 Blatch. 33; 1 A. L. T. 94; *Dorsey R. & H. Rake Co. v. Bradley Manuf. Co.*, 12 Blatch. 202; s. c. 1 Ban & Ard. 380.

If the patentee has given a license to the defendant, which has been forfeited by a breach of the condition, he is a necessary party to the suit in order to take advantage of the condition, although he has assigned his interest in the patent to another. *Woodworth v. Cook*, 2 Blatch. 151.

The assignor and assignee may unite in a bill in equity for an infringement that occurred before the assignment. *Anthony v. Carroll*, 9 O. G. 199; s. c. 2 Ban & Ard. 195.

If the assignment of a claim for past damages and profits is in connection with and incident to a transfer of the title to the patent, the assignor is not a necessary party to a bill to recover damages and profits before as well as after the assignment. *Henry v. Stove Co.*, 9 O. G. 408; s. c. 2 Ban & Ard. 221.

Until an assignment is made, all suits must be brought in the name of the personal representative of the patentee. The next of kin or heirs



have no title or interest in the patent, and should not be joined as parties complainant. *Hodge v. Missouri Railroad*, 4 Fish. 161 ; s. c. 1 Dillon 104.

Although the patentee is to have a certain percentage of the amount recovered in a suit by an assignee, yet he need not be made a party if he files a disclaimer of all interest in the decree and in any money which may be paid in pursuance thereof. *Graham v. Geneva L. C. Manuf. Co.*, 21 O. G. 1536 ; s. c. 11 Fed. Rep. 138.

Although the complainant becomes bankrupt after the commencement of the suit, yet if he obtains the title again before any objection is raised, he may prosecute the suit in his own name. *Gear v. Fitch*, 16 O. G. 1231.

Although an assignment of an original patent may convey the right to an extension, yet if the grantee accepts an assignment of a part interest in an extension, all the grantees may unite in a bill for an infringement. *Edgerton v. Breck*, 5 Ban & Ard. 42.

A party who is interested in the patent out of a certain territory may unite with a party who owns the patent within the territory to obtain an injunction to prevent sales of the alleged infringing articles, if they are sold out of the territory. *Buck v. Cobb*, 9 Law Rep. 545.

The patentee may be made a party complainant, jointly with the grantee, of a right to a certain territory. *Woodworth v. Wilson*, 4 How. 712 ; s. c. 2 Robb 473 ; *Ogle v. Ede*, 4 Wash. C. C. 584 ; s. c. 1 Robb 516.

Where a reissue has been granted to an administrator, the heirs of the patentee are necessary parties to the bill. *Northwestern Co. v. Philadelphia Co.*, 6 O. G. 34 ; s. c. 1 Ban & Ard. 177.

Where the patentee, in his lifetime, parted with his equitable title to the invention, his heirs are not necessary parties if a reissue has been granted to the administrator. *Northwestern Co. v. Philadelphia Co.*, 6 O. G. 34 ; s. c. 1 Ban & Ard. 177.

If other persons named as executors did not prove the will, and had nothing to do with the surrender or reissue of letters patent, and the reissue is granted to one executor alone, they need not be made parties to a bill to restrain the infringement of the reissued patent. *Rubber Co. v. Good-year*, 2 Fish. 499 ; s. c. 9 Wall. 788 ; 2 Cliff. 351.

When the patent is owned by a firm, one partner can not file a bill without joining his copartner. *Ambler v. Chouteau*, 3 Cent. L. J. 333.

A member of a joint stock association which infringes the patent may be sued without joining the other members. *Tyler v. Galloway*, 22 O. G. 1294 ; s. c. 11 Fed. Rep. 477.

Where a final decision can not be made between the parties litigating, without directly affecting and prejudicing the rights of others not made parties, the objection may be taken at the hearing, and it may and ought to be raised and acted upon by the court itself. *Florence Co. v. Singer Co.*, 4 Fish. 329 ; s. c. 8 Blatch. 113.

Where the case can not be decided between the parties, it will not avail to suggest that the absentees are beyond the jurisdiction of the circuit court, or have such residence or citizenship that to make them parties

would defeat that jurisdiction. *Florence Co. v. Singer Co.*, 4 Fish. 329 ; s. c. 8 Blatch. 113.

If the patentee joins with a party who has no joint interest sufficient to maintain the bill, the bill will be dismissed. *Wyeth v. Stone*, 1 Story 273.

Objections as to parties are not favored when postponed to the final hearing upon the pleadings and proofs. *Potter v. Wilson*, 2 Fish. 102 ; *Dibble v. Augur*, 7 Blatch. 86.

If a bill treats the defendant as an infringer, the objection that the complainant has no title to the patent may be taken at the hearing, although the defendant is a licensee. *Pelham v. Edelmeyer*, 15 Fed. Rep. 262.

If the want of proper parties complainant is not set up in the answer, it will not avail unless the case, if made at the hearing, is one in which the court can not proceed to a decree between the parties before the court without prejudice to the rights of those who are proper to be made parties, but who are not brought into court. *Wallace v. Holmes*, 5 Fish. 37 ; s. c. 9 Blatch. 65 ; 1 O. G. 117.

A person who merely gives a license for the use of his own patent to the person who commits the alleged infringement, can not be made a party defendant unless his patent covers, or his license, in form or effect, has some connection with the infringement of the complainant's patent. *Hussey v. Bradley*, 2 Fish. 362 ; s. c. 5 Blatch. 134.

The manufacturer and the party who sells the alleged infringement of the thing patented may be sued jointly, although they act independently. *Buck v. Cobb*, 9 Law Rep. 545.

The lessor and lessee of a machine may be joined as parties defendant. *Jacques v. Wells*, 5 O. G. 364.

The officer of a corporation who made a contract in its behalf to allow another to use an infringing machine may be made a party defendant with the infringer. *Nichols v. Pearce*, 7 Blatch. 5.

If the secretary of a joint stock association does not participate in the profits he is not liable. *Tyler v. Galloway*, 22 O. G. 1294 ; s. c. 13 Fed. Rep. 477.

A bill may be maintained against the directors of a corporation who have the management and superintendence of the business, and under whose direction the patented articles are manufactured and sold. *Good-year v. Phelps*, 3 Blatch. 91.

If the bill is filed against one director alone, it ought to appear that he has the power to direct the use or disuse of the patented machine. *Jones v. Osgood*, 3 Fish. 591 ; s. c. 6 Blatch. 435.

If one does not in person perform the work, but procures another to do it for his advantage on a machine owned by himself, he can still be restrained, and is estopped from denying *qui facit per alium, facit per se*. *Woodworth v. Hall*, 1 W. & M. 248, 389 ; s. c. 2 Robb 495, 517.

It may be that any workman on the machine, though not interested in it, is liable to be restrained in order to prevent evasions by treating all as principals who are aiding. *Woodworth v. Hall*, 1 W. & M. 248, 389 ; s. c. 2 Robb 495, 517 ; *Boyd v. McAlpin*, 3 McLean 427 ; s. c. 2 Robb 277.



Possibly if one hires another to do work on a machine he may be restrained. *Woodworth v. Hall*, 1 W. & M. 248, 389; s. c. 2 Robb 495, 517.

If the principal and his employes are joined as parties defendant, the bill will be dismissed as to the employes. *Hussey v. McCormick*, 1 Fish. 509; s. c. 1 Biss. 300; *Sargent v. Larned*, 2 Curt. 340.

Parties who are acting in concert in the use of the machine which constitutes the alleged infringement of the complainant's rights, may be joined as parties defendant. The fact that as between themselves they are connected together as the stockholders, managers and servants of a corporation, does not exempt them from the restraints of an injunction. *Poppenhusen v. Falke*, 2 Fish. 181; s. c. 4 Blatch. 493; *Goodyear v. Phelps*, 3 Blatch. 91.

If the owner of tools and machinery rents them to a person who infringes the patent, he may be enjoined. *Starrett v. Athol Machine Co.*, 23 O. G. 1729; s. c. 14 Fed. Rep. 910.

A bill in equity will lie against a public officer for an infringement of a patent, although he used the thing patented solely in the service of the government. *Forchand v. Porter*, 15 Fed. Rep. 256.

### Bill.

It is irregular to entitle the bill in the cause, because until the bill is filed there is no cause pending. An address to the circuit court without the words in equity is sufficient. *Sterrick v. Pugsley*, 1 Flippin 350.

It is not necessary that the complainant shall deduce his title by setting forth the various assignments. A simple averment that the title to the patent is vested in the complainant is sufficient. *Nourse v. Allen*, 3 Fish. 63; s. c. 4 Blatch. 376.

A general charge of infringement is all that is necessary to require the defendant to answer the bill, and the particulars of the infringement need not be specified. It would obviously be a very inconvenient practice to require the complainant to set out at length the details of his invention and of the defendant's manufacture. The bill would be very voluminous, and not necessarily more clear or explicit. *Turrell v. Cammerrer*, 3 Fish. 462; *Poppenhusen v. Falke*, 2 Fish. 181; s. c. 4 Blatch. 493.

The bill may allege the character of the improvement and infringement in general terms, without describing the nature of the improvement either in the language of the specifications or in any other way. *Haven v. Brown*, 6 Fish. 413.

If an injunction is applied for, the bill should allege an unquestioned use for some length of time. *Gutta Percha Co. v. Goodyear Rubber Co.*, 3 Saw. 542.

Where there has been a thorough trial at law, and a verdict for the patent approved by the court, it is usual and proper to make it the subject of an allegation in the bill. *Doughty v. West*, 2 Fish. 553.

The bill need not allege that the patentee has marked the articles made

or vended under the patent as required by the patent law. *Goodyear v. Allyn*, 3 Fish. 374; s. c. 6 Blatch. 33; 1 A. L. T. 94.

If the complainant desires to rely upon a prior judgment at law rendered in his favor against the defendant as matter of estoppel, he should aver the judgment in the bill. If no such averment is made, the judgment will not be deemed an estoppel. *Blandy v. Griffith*, 3 Fish. 609.

A bill of complaint by a corporation need not state where the corporation is located or has its place of business. *Nat. Hay Rake Co. v. Harbert*, 2 W. N. 100.

If the patentee has granted a license to another, a bill filed by him must contain an allegation that the defendant is acting without authority from the licensee. *Still v. Reading*, 20 O. G. 1025; s. c. 9 Fed. Rep. 20.

If the conditions attached to a license are conditions subsequent, the bill need not allege that the licensee has kept and fulfilled them. *Stanley R. & L. Co. v. Bailey*, 14 Blatch. 510; s. c. 3 Ban & Ard. 297.

If a bill seeks for an injunction after the expiration of a patent, it should allege that the defendant is using machines made during the term of the patent in infringement thereof or that the complainant fears such use. *American D. R. B. Co. v. Rutland M. Co.*, 18 Blatch. 146; s. c. 5 Ban & Ard. 345; s. c. 2 Fed. Rep. 355.

Although the defendant does not infringe the whole invention, yet the bill need not specify the particular claims that are violated. *Thatcher Heating Co. v. Carbon Stove Co.*, 15 O. G. 1051; s. c. 4 Ban & Ard. 68.

A bill can not be brought for the infringement of distinct patents which are not capable of being used together in making a single structure. *Hayes v. Dayton*, 18 Blatch. 420; s. c. 18 O. G. 1406; s. c. 8 Fed. Rep. 702; *Hayes v. Bickelhaupt*, 19 O. G. 177; *Pope Manuf. Co. v. Marqua*, 15 Fed. Rep. 400; *Barney v. Peck*, 24 O. G. 101; s. c. 16 Fed. Rep. 413.

If several patents are for inventions that are used in the construction of one machine, allegations of an infringement of each patent may be joined in one bill. *Gamewell Fire Alarm Tel. Co. v. Chilicothe*, 7 Fed. Rep. 351; *Kelleher v. Darling*, 14 O. G. 673; s. c. 4 Cliff. 424; s. c. 3 Ban & Ard. 438; *Nellis v. Pennock Manuf. Co.* 22 O. G. 1131; s. c. 13 Fed. Rep. 451; *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Nourse v. Allen*, 3 Fish. 63; s. c. 4 Blatch. 376.

If two inventions covered by different patents are used in a single machine, the bill may charge an infringement of both patents, although the two devices are not necessarily used in connection with each other. *Horman Patent Manuf. Co. v. Brooklyn C. R. R. Co.*, 15 Blatch. 444; s. c. 4 Ban & Ard. 86.

A complainant who owns several patents can not charge an infringement of each in one bill, unless he avers that the machine sold by the defendant contains all the improvements embraced in his patents. *Nellis v. McLanahan*, 6 Fish. 286.

If the same article is an infringement of two patents held by the same person, the two causes of action may be joined in the same bill. *Gillespie v. Cummings*, 3 Saw. 259; s. c. 1 Ban & Ard. 587.



If two assignments cover the same territory, a violation of the right conferred by each may be joined in the same bill. *Gillespie v. Cummings*, 3 Saw. 259; s. c. 1 Ban & Ard. 587.

No one but the government, either in its own name or in the name of its appropriate officer, or by some form of proceeding which gives official assurance of the sanction of proper authority, can institute judicial proceedings for the purpose of vacating or rescinding the patent which the government has issued to an individual, except in the cases provided for by the statute. *Mowry v. Whitney*, 5 Fish. 513; s. c. 14 Wall. 434; 1 O. G. 499.

The courts can recognize the United States as a plaintiff on the record only when the record shows that the United States appears as plaintiff by the district attorney for the district in which the suit is brought. The fact that the suit is instituted on behalf of the United States by the person who is district attorney, and that he acts as such in instituting the suit on behalf of the United States, must appear by the face of the bill or declaration. *U. S. v. Doughty*, 7 Blatch. 424.

An information to repeal a patent should be in the name of the United States, and should be filed by the district attorney in the name and on behalf of the United States. *Att. Gen. v. Rumford Works*, 9 O. G. 1062; s. c. 2 Ban & Ard. 298.

The practice is usually for the complainant to make oath to his bill when it is signed, but this is not imperative or uniform. It is not done if he is absent or indisposed, though it should be done, probably before the hearing, unless it be a bill by a corporation, or unless an answer under oath is not asked, or unless an oath to the bill is waived, or its absence is not objected to by the respondent when first heard. *Woodsworth v. Edwards*, 3 W. & M. 120; s. c. 2 Robb 610; *Rogers v. Abbott*, 4 Wash. C. C. 514; s. c. 1 Robb 465; *Nat'l Hay Rake Co. v. Harbert*, 2 W. N. 100.

If the bill is brought by the patentee and a licensee for the benefit of the licensee, the licensee is the proper party to verify it. *Goodyear v. Allyn*, 3 Fish. 374; s. c. 6 Blatch. 33; 1 A. L. T. 94.

When it appears from the face of the bill that the assignment has never been recorded, the court is bound to take notice of the defect, even though no objection is taken in the pleadings, for it is not the case of a title defectively set forth, but of a title defective in itself. *Wyeth v. Stone*, 1 Story 273; s. c. 2 Robb 23.

If the patent is surrendered while the suit is pending, the action fails, and no remedy can be had for an infringement of a reissue, except by a new suit. *Reedy v. Scott*, 23 Wall. 352; s. c. 7 O. G. 463; *Fry v. Quinlan*, 13 Blatch. 205; *contra*, *Woodworth v. Stone*, 3 Story 749; s. c. 2 Robb 296; *Sarven v. Hall*, 5 Fish. 415; s. c. 9 Blatch. 524; 1 O. G. 437; *Jones v. Barker*, 22 O. G. 771; s. c. 11 Fed. Rep. 599.

If the patent is surrendered after the filing of the bill, it is not necessary that there should be any new breach of the old patent, or any breach of the new patent. The case is not like that of an action at law for the

breach of a patent, to support which it is indispensable to establish a breach before the suit was brought. But in a suit in equity the doctrine is far otherwise. A bill will lie for an injunction, if the patent right is admitted or has been established, upon well-grounded proof of an apprehended intention of the defendant to violate the patent right. A bill *quia timet* is an ordinary remedial process in equity. *Woodworth v. Stone*, 3 Story 749; s. c. 2 Robb 296; *Wheeler v. McCormick*, 4 Fish. 433; s. c. 8 Blatch. 267.

After a bill has been filed in one district for infringements committed in that district, the complainant may file another bill in another district for subsequent infringements. *Wheeler v. McCormick*, 4 Fish. 433; s. c. 8 Blatch. 267; *Penn Salt Co. v. Myers*, 1 W. N. 377.

If the patentee seeks for an injunction on the ground of an infringement, and states nothing about a contract which authorized the use, and such a contract appears by the answer, he must amend his bill before he can impeach the contract. *Hartshorn v. Day*, 3 Fish. 32; s. c. 19 How. 211; *Wilson v. Stolley*, 4 McLean 275.

Where the rights of the parties under a reissue were in issue under the answer and the replication, the court may allow the bill to be amended, even after a final decree, by inserting an averment of the reissue. *Tre-maine v. Hitchcock*, 23 Wall. 518; s. c. 7 O. G. 1055; s. c. 8 Blatch. 440; s. c. 4 Fish. 508.

The question of abandonment of a license can not be raised unless the issue is made by the pleadings, for the proof must correspond with the allegations. *Wilson v. Stolley*, 4 McLean 275.

The bill of complaint ought to waive an answer under oath. *Slesinger v. Buckingham*, 8 Saw. 469.

### **Supplemental Bill.**

A petition for leave to file a supplemental bill need not embrace the averment intended to be inserted in the bill, but merely set forth the ground on which the relief is applied for. *Parkhurst v. Kinsman*, 8 N. Y. Leg. Obs. 73.

On an application for leave to file a supplemental bill, the only question is whether the petition states facts and circumstances which, if properly pleaded, would sustain a supplemental bill. *Parkhurst v. Kinsman*, 8 N. Y. Leg. Obs. 73.

A supplemental bill may be filed to bring in a party who has been acting in collusion with the defendant since the filing of the original bill. *Parkhurst v. Kinsman*, 8 N. Y. Leg. Obs. 73.

If, after the filing of the answer, a discovery is sought as to particulars not mentioned in the original bill, a supplemental bill may be filed. *Parkhurst v. Kinsman*, 8 N. Y. Leg. Obs. 73.

A party to whom the complainant has assigned his title since the commencement of the suit, has no interest in an infringement before his right accrued, and a motion by him for leave to file a supplemental bill is a matter in the discretion of the court. *Dean v. Mason*, 20 How. 198.



If the complainant, having surrendered his patent while the action is pending, files a supplemental bill, the irregularity will be deemed to be waived by filing an answer and taking evidence. *Reedy v. Scott*, 23 Wall. 353; s. c. 7 O. G. 463.

### **Bill of Revivor.**

A person who acquires an interest in the suit by an assignment before the death of the complainant and not by the death of the complainant, can not sustain a bill of revivor. *Metal Stamping Co. v. Crandall*, 18 O. G. 1531.

If one of the partners dies while a bill is pending against the firm to recover profits for an infringement by them, a bill of revivor can not be maintained to bring in his personal representative, unless it is alleged that the complainant is unable to procure satisfaction from the survivor. *Troy Iron & Nail Factory v. Winslow*, 11 Blatch. 513; s. c. 2 Ban & Ard. 98.

### **Cross Bill.**

A cross bill can only be filed by leave of the court, after due notice to the complainant. *Webster Loom Co. v. Short*, 10 O. G. 1019.

There is no law which authorizes an order of publication on a cross bill against a non-resident complainant. *Webster Loom Co. v. Short*, 10 O. G. 1019.

The respondent may file a cross bill although he has previously filed a bill in a State court for the same purpose. *Brandon Manuf. Co. v. Prime*, 14 Blatch. 371; s. c. 3 Ban & Ard. 191.

If a person who has not been previously made a party is a necessary party to the suit, he may be brought in by a cross bill. *Brandon Manuf. Co. v. Prime*, 14 Blatch. 371; s. c. 3 Ban & Ard. 191.

### **Demurrer.**

A misjoinder of parties complainant may be taken advantage of by a general demurrer. *Hodge v. Missouri Railroad*, 4 Fish. 161; s. c. 1 Dillon 104.

Whether a reissue is for the same invention as the original patent is a question that may be raised on a demurrer to the bill if the bill sets forth both the original patent and reissue in full. *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 no order is entered for the revival of the suit, an administrator may demur to a bill of revivor, although the time allowed under the rule to answer has expired. *Atterbury v. Gill*, 13 O. G. 276; s. c. 2 Flippin 239; s. c. 3 Ban & Ard. 174.

If the defendant demurs to the whole bill and at the same time files an answer setting up everything that is in the demurrer, the answer is a waiver of the demurrer. *Adams v. Howard*, 21 O. G. 264.

Although a defendant demurs to the whole bill and files an answer thereto at the same time, yet the complainant waives the error by joining in demurrer. *Hayes v. Dayton*, 18 O. G. 1406 ; s. c. 18 Blatch. 420 ; s. c. 8 Fed. Rep. 702.

Upon a demurrer to a bill of complaint, the court can not act upon the admission of the complainant's counsel. *Perry v. Corning*, 6 Blatch. 134.

### Plea.

The office of a plea is to present to the court a single point of defence, and it is bad if it contains several grounds each of which is an independent defence having no relation to the other. *Reissner v. Anness*, 12 O. G. 842 ; s. c. 3 Ban & Ard. 148.

A plea which does not bring the case to a single decisive point, but raises the issues usually raised in an answer, is bad. *White v. Lee*, 4 Fed. Rep. 916.

A defence that the defendant has not infringed the patent can not be taken by plea. *Sharp v. Reissner*, 20 O. G. 1061 ; s. c. 9 Fed. Rep. 445.

A defence of a want of novelty must be set up by answer and not by a technical plea. *Carrick v. McKisson*, 8 Fed. Rep. 807.

A plea that a party is a *bona fide* purchaser for value is bad if it does not set forth the consideration that was actually paid. *Secombe v. Campbell*, 18 Blatch. 108 ; s. c. 5 Ban & Ard. 429 ; 2 Fed. Rep. 357.

A plea in bar may be filed in order to raise the objection of the non-joinder of a necessary party. *Hammond v. Hunt*, 4 Ban & Ard. 111.

The filing of two pleas, without special leave given for that purpose, is irregular, and both are liable to be overruled as improperly interposed. *Wheeler v. McCormick*, 4 Fish. 433 ; s. c. 8 Blatch. 267.

A defence that the complainant is not incorporated must be pleaded in abatement, and can not be pleaded in bar or given in evidence under the general issue. If the defendant pleads to the merits, he admits the capacity of the complainant to sue, and waives any objection thereto. *Dental Vulcanite Co. v. Wetherbee*, 3 Fish. 87 ; s. c. 2 Cliff. 555.

If the defendant intends to question the right of an executor or complainant to sue in a representative character, he should do so by a plea or by the answer. If the question is not raised in that way, the objection will not be entertained at the hearing. *Rubber Co. v. Goodyear*, 2 Fish. 499 ; s. c. 9 Wall. 788 ; 2 Cliff. 351.

If a defendant omits to set up the non-joinder of other infringers as parties defendant, he must do so by plea or answer, or it will be disregarded at the hearing. *Wallace v. Holmes*, 5 Fish. 37 ; s. c. 9 Blatch. 65 ; 1 O. G. 117.

An objection to the jurisdiction of the court is probably too late if it is only made after the answer is put in, the replication filed and the evidence published. *Nesmith v. Calvert*, 1 W. & M. 34 ; s. c. 2 Robb 311.

In order to constitute the fact of a want of parties a good defence, it must be shown by the plea that the persons alleged to be necessary parties



are alive and within the jurisdiction of the court. *Goodyear v. Toby*, 6 Blatch. 130.

If the complainant sets a plea down for argument, he thereby admits the facts therein alleged, and the sufficiency of the plea is the question to be considered. *Wheeler v. McCormick*, 4 Fish. 433; s. c. 8 Blatch. 267.

The setting of a plea down for hearing is a waiver of any irregularity in the filing of a plea, such as the omission of the certificate of counsel that it is in his opinion well founded in point of law, and of the affidavit of the party that it is not interposed for delay. *Goodyear v. Toby*, 6 Blatch. 130.

If a plea of the pendency of a prior suit for the same cause of action makes a copy of the bill in the prior suit a part thereof, the court will examine the bill as well as the plea. *Wheeler v. McCormick*, 4 Fish. 483; s. c. 8 Blatch. 267.

If a plea is double, it may be set down as an answer, or the respondent may elect which of the several grounds of defence he will stand on. *Reissner v. Anness*, 12 O. G. 842; s. c. 3 Ban & Ard. 148.

If the defendant files a plea averring that he does not use all the patents mentioned in the bill, it will be overruled as bad in substance, although the complainant files a replication thereto. *Matthews v. L. & G. Manuf. Co.*, 17 O. G. 1284; s. c. 18 Blatch. 84; s. c. 5 Ban & Ard. 319; s. c. 2 Fed. Rep. 232.

Where a replication is filed to a plea, the complainant has the right to begin and close the proofs. *Reissner v. Anness*, 13 O. G. 870; s. c. 3 Ban & Ard. 176.

If a plea may contain a defence, the court in directing the defendant to answer may save the benefit of the plea to him at the hearing. *Albright v. Empire Trans. Co.*, 14 O. G. 523.

When a plea is overruled, the defendant should be allowed to answer. *Wooster v. Blake*, 20 O. G. 158; s. c. 7 Fed. Rep. 186.

If a plea admits the main allegations of the bill, a decree will be entered for the complainant upon overruling the plea. *Lilienthal v. Washburn*, 8 Fed. Rep. 707.

A defendant may by plea set up the defence that the reissue is void because it is not for the same invention as the original patent. *Hubbell v. De Laud*, 22 O. G. 1883.

### Answer.

The rules of pleading in chancery require that the defence of a prior invention shall be set up in the answer so as to enable the complainant to meet it. If no such defence is set up, evidence of such prior invention can not be regarded. *O'Reilly v. Morse*, 15 How. 62; *Geier v. Goettinger*, 7 O. G. 563; s. c. 1 Ban & Ard. 553; *Pitts v. Edmonds*, 2 Fish. 52; s. c. 1 Biss. 168; *Pickering v. Phillips*, 10 O. G. 420; s. c. 4 Cliff. 483; s. c. 2 Ban & Ard. 417; *Howe v. Williams*, 2 Fish. 395; s. c. 2 Cliff. 245; *Orr v. Merrill*, 1 W. & M. 376; s. c. 2 Robb 331; *Eureka Co. v. Bailey Co.*, 11 Wall. 488; *Jordan v. Dobson*, 4 Fish. 232; s. c. 2 Abb. U. S. 398; 7 Phila. 533; *Forbes v. Barstow Stove Co.*, 2 Cliff. 379.

A defence that the invention is not a patentable subject, that is, that it is not a new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, may be made, although it was not set up in the answer. *Guidet v. Barber*, 5 O. G. 149.

When the defence of a prior invention is set up, the settled practice in equity is to require the respondent, as a condition precedent to such a defence, to give the complainant substantially the same information in his answer as is required of a defendant in an action at law. *Agawam Co. v. Jordan*, 7 Wall. 583; *Cook v. Howard*, 4 Fish. 269; *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Collender v. Griffith*, 11 Blatch. 212; s. c. 3 O. G. 689; *Decker v. Grote*, 6 Fish. 143; s. c. 10 Blatch. 331; 3 O. G. 65; *La Baw v. Hawkins*, 6 O. G. 724; s. c. 1 Ban & Ard. 428; *Earl v. Dexter*, 1 Holmes 412; s. c. 6 O. G. 729; s. c. 1 Ban & Ard. 400; *Brown v. Hall*, 3 Fish. 531; s. c. 6 Blatch. 401; *Graham v. Mason*, 5 Fish. 1; s. c. 4 Cliff. 88; *Union P. B. M. Co. v. P. & W. Co.*, 15 O. G. 423; s. c. 15 Blatch. 160; s. c. 3 Ban & Ard. 403.

If the respondent intends to contest the novelty of the invention, his denial in that behalf should be explicit, unqualified, and unconditional. *Graham v. Mason*, 5 Fish. 1.; s. c. 4 Cliff. 88.

If there is a general denial that the patentee was the first and original inventor, and a special one, the respondent will be limited to the special one. *Agawam Co. v. Jordan*, 7 Wall. 583; *Middletown Co. v. Judd*, 3 Fish. 141.

If the answer merely sets up the defence that the patentee was not the first and original inventor of the improvement described in a certain claim, he can not prove a want of novelty in the whole invention. *Bates v. Coe*, 98 U. S. 31; s. c. 15 O. G. 337;

The defence that the thing patented did not require invention may be made at the hearing, although it is not set up in the answer. *Slawson v. Railroad Co.*, 24 O. G. 99; s. c. 17 Blatch. 512; s. c. 5 Ban & Ard. 210; s. c. 4 Fed. Rep. 531.

If the issue of the novelty of the invention is not raised by the pleadings, evidence to show the state of the art can have no effect on the case beyond the aid it may give the court in construing the patent. *Middletown Co. v. Judd*, 3 Fish. 141; *American Saddle Co. v. Hogg*, 5 Fish. 353; s. c. 1 Holmes 177; 2 O. G. 595; *La Baw v. Hawkins*, 6 O. G. 724; s. c. 1 Ban & Ard. 428.

If the question of abandonment or surrender is not raised in the answer as a matter of defence, it is not in issue between the parties, and the whole evidence taken on the point is irrelevant and can not be looked to as a matter in judgment. The defect in the pleadings puts the question entirely beyond the reach of the court. *Wyeth v. Stone*, 1 Story 273; s. c. 2 Robb 23; *Williams v. B. & A. R. R. Co.*, 16 O. G. 906; s. c. 17 Blatch. 21; s. c. 4 Ban & Ard. 441.

Evidence that the invention was on sale and in public use for more than two years prior to the application for a patent is not admissible, unless the defence is set up in the answer. *Agawam Co. v. Jordan*, 7 Wall. 583;



*Kelleher v. Darling*, 14 O. G. 673; s. c. 4 Cliff. 424; s. c. 3 Ban & Ard. 438; *Bates v. Coe*, 15 O. G. 337; s. c. 98 U. S. 31.

An objection to the title of the complainant which is not taken in the answer, or made the subject of examination or inquiry before the examiner, will not be entertained at the hearing. *Glover & Baker S. Co. v. Sloat*, 2 Fish. 112.

Unreasonable neglect or delay in filing a disclaimer can not be set up as a defence, unless it is alleged in the answer. *Burden v. Corning*, 2 Fish. 477.

The defence that the patentee did not mark his articles as patented can not be taken unless it is set up in the answer. *Herring v. Gage*, 15 Blatch. 124; s. c. 3 Ban & Ard. 396; *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; s. c. 2 Cliff. 351.

The defence that the description of the invention is not set forth in such full, clear and exact terms as to enable any person skilled in the art to which it appertains to practice the invention or to make the thing patented, is not available unless it is set up in the answer. *Jennings v. Pierce*, 15 Blatch. 42; s. c. 3 Ban & Ard. 361; *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

A defence which is not set up in the answer can not be relied on at the hearing. *Goodyear v. Providence Rubber Co.*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; *Wonson v. Peterson*, 13 O. G. 548; s. c. 3 Ban & Ard. 249.

Evidence may be given to show that the patent is void, although it is not specially pleaded unless it goes so far as to attempt to make out a defence which the statute requires to be specially pleaded. *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 defence that the patent is void because the application was amended after the death of the inventor, so as to embrace an invention not shown in the original application, may be taken, although it is not specially pleaded. *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.

If the defendant denies the validity of the patent, he can not set up a permissive use as a defence. *Shaw v. Colwell Lead Co.*, 11 Fed. Rep. 711.

An answer may set up the defence that the patent is invalid and that the defendant has a license, for they are not inconsistent. *National Manuf. Co. v. Myers*, 7 Fed. Rep. 355.

If there has been a trial at law, and the bill charges that the defendant will in future violate the right secured by the patent unless he is restrained by an injunction, the defendant, in his answer, should distinctly state that he does not intend in future to do the specific things which the court has determined he has no right to do. *Poppenhusen v. Gutta Percha Co.*, 2 Fish. 74; s. c. 4 Blatch. 184.

The defendant is in no default by refusing to answer any part of the

bill to which he is not specially interrogated, but if the answer responds to the charges in the bill, it will not be held impertinent. *Brooks v. Bicknell*, 3 McLean 250 ; s. c. 2 Robb 118.

Evasive answers to specific inquiries, if not positively equivalent to admissions, afford strong presumptive evidence against the respondent. *Agawam Co. v. Jordan*, 7 Wall. 583.

An allegation that a reissue was obtained under false representations should be made in distinct language, without equivocation, and, if relied on at all, should be the subject of very distinct proof. *Doughty v. West*, 2 Fish. 553.

The answer to the charge of infringement should be distinct and un-evasive. *Jordan v. Wallace*, 5 Fish. 185 ; s. c. 8 Phila. 165.

A defence of abandonment and of public use for more than two years before the application for the patent ought not to be blended in the same allegation, as they depend in many respects upon different principles. *Sewall v. Jones*, 6 Fish. 343 ; s. c. 3 O. G. 630 ; s. c. 3 Cliff. 563 ; s. c. 91 U. S. 171 ; s. c. 9 O. G. 47.

If the defendant claims any right under a license, he must show that he has done everything on his part which in equity he can be required to do, to entitle him to the right asserted. An alleged violation of the contract by the complainant will not help the equity of the defendant, for if he justifies under the license, he must show that he has done all that is necessary to entitle him to its benefit. *Brooks v. Stolley*, 3 McLean 523 ; s. c. 2 Robb 281.

Where a clause is omitted in an assignment through mistake or accident, the matter thus entitling the party to an amendment of his contract may be set up by way of equitable defence against a proceeding involving the rights of the parties under the instrument, and which would not be maintainable if the clause in question had formed a part of the contract. *Woodworth v. Cook*, 2 Blatch. 151.

Although the strict legal title may be in the complainant, yet if the defendant has an equitable title he may avail himself of it, for a party who asks for equity is bound to do equity. *Day v. Candee*, 3 Fish. 9.

The complainant is entitled to an answer upon oath to all the material allegations of the bill, although he has not annexed any special interrogatories to the bill. *Perry v. Corning*, 6 Blatch. 134.

If the answer in the names of both defendants is signed and sworn to by only one, it will be taken off the files, but with leave to refile it after striking out the name of the other party. *Bailey Washing Machine Co. v. Young*, 12 Blatch. 199.

A motion to file an answer after default is generally addressed to the discretion of the court. Under some circumstances the court, for the purposes of justice, will go great lengths in opening a default and allowing an answer to be filed. *Dean v. Mason*, 20 How. 198.

An objection that the answer does not disclose the names and places of residence of those who had prior knowledge of the thing, and where it had been used, ought in general to be taken by exception, as the defect is the



proper subject of amendment. *Graham v. Mason*, 5 Fish. 1; s. c. 4 Cliff. 48.

The issues raised in chancery suits must be raised by the allegations in the bill and answer, and whenever either the bill or answer is defective, the defect must be cured by amendment, and can not be cured by filing special notices. The filing of a notice of special matter is wholly irregular. *Doughty v. West*, 2 Fish. 553.

A paper filed without leave to amend can not be regarded as an amendment to the original answer. *Dental Vulcanite Co. v. Wetherbee*, 3 Fish. 87; s. c. 2 Cliff. 555.

An amendment of an answer will not be allowed unless there is reasonable ground to believe that evidence can be produced to support it. *Hicks v. Otto*, 17 Fed. Rep. 539.

The respondent may be allowed to file a supplemental answer denying the validity of the patent, if the application for leave so to do is made within a reasonable time after he discovers the fact. *Morehead v. Jones*, 3 Wall. Jr. 306; *Snow v. Tapley*, 13 O. G. 548; s. c. 3 Ban & Ard. 228.

If the respondent sets up a new defence, he may be compelled to pay the costs that have accrued on the abandoned defence. *Morehead v. Jones*, 3 Wall. Jr. 306.

If the answer admits an infringement, the respondent will not be permitted to file a supplemental answer denying the infringement, unless he alleges a mistake of fact or of law in the answer. *Morehead v. Jones*, 3 Wall. Jr. 306.

An amendment of an answer will not make testimony admissible which was taken under objection before the answer was amended, for the party had a right to rely upon his objection, and elect not to cross-examine or offer rebutting proof. *Roberts v. Buck*, 6 Fish. 325; s. c. 1 Holmes 224; 3 O. G. 268.

Where the complainant will not be taken by surprise, an amendment of the answer may be allowed upon the terms that defendant is not to recover costs up to the time of filing it. *Roberts v. Buck*, 6 Fish. 325; s. c. 1 Holmes 224; 3 O. G. 268.

If the defendant desires to amend his answer, so as to set up the defence that the patented invention was in public use for more than two years before the granting of the patent, he must show something more than that he was guilty of laches in omitting to set it up in the original answer. *Webster Loom Co. v. Higgins*, 9 O. G. 965; s. c. 13 Blatch. 349.

If there is a general averment that the patentee was not the first and original inventor, and he will not be taken by surprise, the defendant may be allowed to amend his answer, even at the final hearing, so as to set up the defence with more particularity. *Brown v. Hall*, 3 Fish. 531; s. c. 6 Blatch. 401.

If the answer omitted to give the proper notice of a prior invention, the court may allow an amendment at the hearing *nunc pro tunc* as of the time the answer was filed. *Roberts v. Ryer*, 6 Fish. 293; s. c. 91 U. S. 150; 11 Blatch. 11; 3 O. G. 550; 10 O. G. 204.

If the defendant has by an agreement admitted the validity of the patent, a motion for leave to amend the answer so as to deny the novelty of the invention may be refused. *Pentlarge v. Beeston*, 15 Blatch. 347; s. c. 4 Ban & Ard. 23.

If an allegation in an answer is one of construction rather than of fact, the answer may be amended by striking out the allegation. *Prime v. Brandon Manuf. Co.*, 16 Blatch. 453; s. c. 4 Ban & Ard. 379.

If a successor to a corporation is duly summoned and proceeds to a hearing without filing an answer, it can not file an answer after a decree has been entered, although no decree *pro confesso* has been entered. *Allen v. New York*, 18 Blatch. 239; s. c. 5 Ban & Ard. 461; s. c. 7 Fed. Rep. 483.

When the defendant, in his answer, admitted an infringement, he will not, after a decree, reference and report of the master, be allowed to amend his answer, so as to deny the infringement, where the admission arose from a want of diligence on his part, or a want of intelligence on the part of his counsel. *Ruggles v. Eddy*, 5 Fish. 581; s. c. 11 Blatch. 524; s. c. 10 Blatch. 52; s. c. 1 Ban & Ard. 92.

Good cause for allowing an amendment of an answer, so as to set up a new defence, is not shown when it appears that the matter of the proposed amendment could with reasonable diligence have been sooner introduced into the answer. *India Rubber Co. v. Phelps*, 4 Fish. 315; s. c. 8 Blatch. 85; *Rumford Chemical Works v. Hecker*, 10 O. G. 289; s. c. 2 Ban & Ard. 351; *Hitchcock v. Tremaine*, 5 Fish. 537; s. c. 9 Blatch. 550; 1 O. G. 633; *Webster Loom Co. v. Higgins*, 13 Blatch. 349; s. c. 9 O. G. 965; *Richardson v. Croft*, 20 O. G. 372; s. c. 11 Fed. Rep. 800.

If the new defence is dependent wholly on parol evidence, the courts hesitate in allowing any practice which may encourage carelessness, negligence or inattention in making answers, or which may leave room for the introduction of testimony manufactured for the occasion. *India Rubber Co. v. Phelps*, 4 Fish. 315; s. c. 8 Blatch. 85.

An answer which is not responsive to the bill is not evidence in favor of the defendant. *Sargent v. Larned*, 2 Curt. 340.

If the bill only requires an answer under oath to certain interrogatories, the answer is not evidence of the facts averred therein. *Wren v. S. & O. Manuf. Co.*, 18 O. G. 857; s. c. 5 Ban & Ard. 61.

An admission made in the answer is not waived by the complainant's going into the proofs and otherwise treating it as an open question. It would be subversive of all sound practice, and tend largely to defeat the ends of justice, if the courts should refuse to accept a fact as settled which is distinctly alleged in the bill and admitted in the answer. *Jones v. Morehead*, 1 Wall. 155.

The proofs and the allegations must correspond. The examination of the case by the court is confined to the issues made by the pleadings. Proofs without the requisite allegations are as unavailing as such allegations would be without the requisite proofs to support them. Objections which are not taken in the answer can not be entertained. *Rubber Co. v.*



Goodyear, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; Blandy v. Griffith, 3 Fish. 609; Yale Manuf. Co. v. North, 3 Fish. 279; s. c. 5 Blatch. 455; Howes v. Nute, 4 Fish. 263; s. c. 4 Cliff. 173; Russell Manuf. Co. v. Mallory, 5 Fish. 632; s. c. 10 Blatch. 140; 2 O. G. 495.

An allegation of a use of the invention with the consent of the patentee, for more than two years prior to the application for a patent, is of no avail unless sustained by proofs. Seymour v. Osborne, 3 Fish. 555; s. c. 11 Wall. 516.

An amendment of an answer will not be allowed after an interlocutory decree, if the defendant can have the benefit of it before the master. Evory v. Candee, 5 Ban & Ard. 67.

### Replication.

If the complainant elect to try the case upon bill and answer, he will not be allowed to file a replication after an adverse decision and proceed to take evidence to support his bill, although he offers to pay costs. Balingier v. Mackey, 14 Blatch. 355.

If the complainant excuses his omission to file a replication on account of a pending negotiation for a compromise, he may be allowed to file it *nunc pro tunc*. Robinson v. Randolph, 4 Ban & Ard. 317.

If the parties proceed to take evidence on the merits, the defendant is estopped from raising any objection because no replication has been filed. Fischer v. Wilson, 16 O. G. 455; s. c. 16 Blatch. 220; s. c. 4 Ban & Ard. 228.

If a replication contains a general traverse and special matter, the special matter may be disregarded and the replication stand as a general traverse. Wren v. S. & O. Manuf. Co., 18 O. G. 857; s. c. 5 Ban & Ard. 61.

A replication can not make a new and different case from that stated in the declaration. Burdell v. Denig, 15 Fed. Rep. 397.

### Issues for Jury.

The circuit courts have jurisdiction of controversies arising under the patent laws, by direct grant from Congress. They do not act as ancillary to a court of law, and do not, therefore, require the patentee to establish his legal right in a court of law, and by the verdict of a jury. Sanders v. Logan, 2 Fish. 167.

There is, on account of the judge being the same for the equity and the law hearings, much less reason than in England for sending questions to a court of law in the federal tribunals. Brooks v. Norcross, 2 Fish. 661.

One of the most arduous and daily duties of a court of chancery is to decide questions of fact, and if it declines to do so, unless in ordinary and adjudged excepted cases, it declines to do what neither the legislature nor the law in chancery has excused it from the responsibility of doing. It has no more power to decline this responsibility, merely because a party

requests it or from timidity as to consequences, or a willingness to avoid labor, than to decline any other duty imposed on it by law. When it may use a jury, then it has the law so settled previously for its vindication, but if it does so in other cases, however desirable to a party or the court itself, it has not the sanction of law, and does not only do wrong to that, but to the other parties in the case who oppose the request. *Brooks v. Norcross*, 2 Fish. 661; *Wilson v. Barnum*, 2 Fish. 635; s. c. 1 Wall. Jr. 347; 8 How. 258; *Blanchard v. Reeves*, 1 Fish. 103.

Federal courts of equity under the Constitution and the laws of Congress, have the power of deciding every question of law or fact which may arise in equity suits over which they have complete jurisdiction, and consequently it is not indispensably necessary as a matter of law in any case that any question in an equity court should be sent to a jury. *Goodyear v. Providence Rubber Co.*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; *Ayling v. Hull*, 2 Cliff. 494; *Goodyear v. Hullihen*, 3 Fish. 251; s. c. 2 Hughes 492; *Shelly v. Brannan*, 4 Fish. 198; s. c. 2 Biss. 315.

It is not a matter of course to order a feigned issue, but the party applying must lay a foundation for it. A feigned issue is not to be granted, unless the opinion of a jury is found to be needed. *Van Hook v. Pendleton*, 1 Blatch. 187; *Brooks v. Norcross*, 2 Fish. 661.

The practice of sending the parties to law to have the validity of the patent decided, when that is denied in the answer, is founded more on convenience than necessity. It always rests in the sound discretion of the court. A trial at law is ordered by a chancellor to inform his conscience, not because either party may demand it as a right, or that a court of equity is incompetent to judge of questions of fact or of legal titles. The courts do not always consider it a proper exercise of their discretion to order such issues to be tried at law before granting a final injunction. *Goodyear v. Day*, 2 Wall. Jr. 283; *Goodyear v. Providence Rubber Co.*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; *Footte v. Silsby*, 1 Blatch. 545; *Ayling v. Hull*, 2 Cliff. 494; *Cochrane v. Deener*, 11 O. G. 637; s. c. 94 U. S. 780.

The general rule is, that an interlocutory order for issues to a jury in an equity suit will not be made until all the proofs are taken and publication has passed. The reason for the rule is, that such an order should not in general be granted at all where the truth of the facts can be conveniently and satisfactorily ascertained by the court itself, and as that question can not usually be determined in advance of publication, the motion should be deferred to that stage of the controversy. *Goodyear v. Providence Rubber Co.*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

The court will not order an issue to try the validity of the patent, if it feels no doubt or difficulty which would be removed or confirmed by a verdict. *Goodyear v. Day*, 2 Wall. Jr. 283; *Buchanan v. Howland*, 2 Fish. 341; s. c. 5 Blatch. 151; *Goodyear v. Providence Rubber Co.*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; *Ely v. Monson Manuf. Co.*, 4 Fish. 64.

Whether the reissued patent is for the same invention as the original, involves a question of fact. A court of equity has the power to pass upon



this or any other facts that may be put in issue by a bill and answer. If the fact is involved in considerable doubt, that may be a reason why it should be sent to a jury. *Poppenhusen v. Falke*, 2 Fish. 181; s. c. 4 Blatch. 493.

When the question whether a reissued patent is for the same invention as the original, is intimately connected with inferences to be drawn from the changes in the specification and claim as presented in the reissue, when compared with the original, and the significance of these inferences depends more or less upon the construction to be given to the instrument, there is no occasion for the intervention of a jury for the purpose of determining the fact of the identity of the inventions described in the old and new patents. *Poppenhusen v. Falke*, 2 Fish. 181; s. c. 4 Blatch. 493.

If the validity of the patent or the fact of infringement is doubtful, the court may at the final hearing order the cause to stand over a reasonable time for the trial of the questions at law. *Muscan Hair Co. v. Am. Hair Manuf. Co.*, 4 Fish. 320; s. c. 4 Blatch. 174; *Crosby v. Lapouraille*, Taney 374.

The court will not direct an issue to try the validity of the patent, after the case has been set down for final hearing on the exhibits and proofs, without any motion or order of the court for such an issue. *Goodyear v. Day*, 2 Wall. Jr. 283.

A motion that the proceedings be stayed until there is a trial at law, or a verdict upon issue framed under the order of the court, ought not in general to be granted, where it appears that a trial at law and a hearing in equity have already been had, and that both have resulted in favor of the complainant. *Howe v. Williams*, 2 Fish. 395; s. c. 2 Cliff. 245.

If a court of equity directs an action at law to be brought to determine the legal right, the declaration may omit a claim for damages, and refer to the suit in equity for an explanation of the omission, in order to prevent a judgment from operating as a bar to an account in that suit. *Knox v. Great Western Q. M. Co.*, 3 Saw. 422.

The verdict, when certified from the court to which the issues were sent, is never to be regarded as conclusive, but only as advisory, and may be set aside or even overruled. *Silsby v. Foote*, 20 How. 378; s. c. 2 Blatch. 260; *Brooks v. Bicknell*, 4 McLean 70; *Sickels v. Youngs*, 3 Blatch. 293.

The preponderance of the evidence against the verdict must be striking and clear to authorize a court to order a new trial of an issue sent to be tried at law. The conscience of the chancellor, it is said, must be satisfied. The word conscience here means nothing more than a sacred and legal conviction in the mind of the court that the verdict is not sustained by the evidence. *Brooks v. Bicknell*, 4 McLean 70.

### **Motion for Preliminary Injunction.**

A motion for an injunction which is in accordance with a special prayer in the bill, is proper. *Orr v. Littlefield*, 1 W. & M. 13; s. c. 2 Robb 322; *Goodyear v. Muller*, 3 Fish. 420.

When an injunction is applied for on the ground of a violation of a right to an invention secured by patent, it is incumbent on the party making the application to swear at the time of making it as to his belief that he is the original inventor. For although when he obtained his patent he might very honestly have sworn to his belief of such being the fact, yet circumstances may have subsequently intervened, or information have been communicated, sufficient to convince him that it was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect. *Sullivan v. Redfield*, 1 Paine 441; s. c. 1 Robb 477; *Rogers v. Abbott*, 4 Wash. C. C. 574; s. c. 1 Robb 465.

If the bill alleges that the patentee was the first and original inventor of the thing patented, and is sworn to, a separate affidavit to that fact is not necessary. *Young v. Lippman*, 5 Fish. 230; s. c. 9 Blatch. 277; 2 O. G. 249.

On a motion for a provisional injunction the patentee must rest on the case stated in the bill. *Cooper v. Mattheys*, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413.

The patentee may file affidavits stating the matters set forth in the bill with more particularity, and referring to collateral matters which explain or tend to support and strengthen it. *Cooper v. Mattheys*, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413.

Either party may take and read the affidavits of other persons. *Cooper v. Mattheys*, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413; *Wickershaft v. Jones*, 2 Whart. Dig. 363.

It is irregular to swear a person in a suit before the bill is filed, and if an affidavit is so entitled it will be excluded. The irregularity consists in having the affidavit sworn to under the title of a suit in which no bill has been filed. If the title is omitted there will be no irregularity. The purpose for which it is intended should be stated in the affidavit. *Baldwin v. Bernard*, 5 Fish. 442; s. c. 9 Blatch. 509 *n.*; 2 O. G. 320; *Sterrick v. Pugsley*, 1 Flippin 350.

The proper venue of an affidavit taken before a United States commissioner, is "United States of America, District of ———," naming the district and State for which the commissioner was appointed. It is irregular to give the State and county. *Sterrick v. Pugsley*, 1 Flippin 350.

The affidavits in support of a motion for a preliminary injunction must allege the facts that constitute an infringement, and not merely charge an infringement. *Kirby Bung Manuf. Co. v. White*, 17 O. G. 974; s. c. 1 McCrary 155; s. c. 5 Ban & Ard. 263; s. c. 1 Fed. Rep. 604.

A hearing of both parties is contemplated on an application for an injunction. The defendant may, therefore, file an answer before the time for answering expires, and it will have the same effect as any other answer. *Brooks v. Bicknell*, 3 McLean 250; s. c. 2 Robb 118.

If no answer is filed it will be assumed that the facts stated in the bill and not contradicted, are true. *Cooper v. Mattheys*, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413.

The answer of the defendant is considered as an affidavit on a motion



for a preliminary injunction. *Cooper v. Mattheys*, 5 Penn. L. J. 38 ; s. c. 8 Law Rep. 413 ; *Parker v. Brant*, 1 Fish. 58.

If the answer denies an allegation in the bill, the denial will be taken to be true on a motion for a provisional injunction. *Boyd v. Brown*, 3 McLean 295 ; s. c. 2 Robb 203.

A mere denial in the answer of all equity in the bill will not prevent the granting of an injunction. In the case of special injunctions, where affidavits and counter affidavits are produced, it is in the discretion of the court whether to issue the injunction or refuse it. *Orr v. Littlefield*, 2 W. & M. 13 ; s. c. 2 Robb 323 ; *Parker v. Brant*, 1 Fish. 58.

A general allegation on information and belief in an affidavit by the defendant amounts to nothing. If he has any information sufficient to warrant a belief in the truth of what is stated, he is bound to disclose it for the judgment of the court, if it is to be of any avail to him. He can not swear to the conclusion and withhold the particulars of the information. *Young v. Lippman*, 5 Fish. 230 ; s. c. 9 Blatch. 277 ; 2 O. G. 249.

If the complainant alleges that the defendant uses a certain machine, and the defendant does not deny it, this is an admission that he uses such a machine. *Ely v. Monson Manuf. Co.*, 4 Fish. 64.

Where there is a charge of infringement, it is in the power of the party charged to bring into court the article that he uses, so that the court can see what he does use. It is his duty to tell the court what he uses, and to describe it. It is not sufficient to aver vaguely and generally that the article is not an infringement, for that is a question for the court to decide on the facts. *Ely v. Monson Manuf. Co.*, 4 Fish. 64.

An affidavit by the solicitor for the defendant that he is advised and believes that the defendant's machine does not infringe the patent, will be disregarded if it gives no reason why the defendant does not himself swear to the dissimilarity of his machine, or why some competent machinist does not do so, and does not point out any dissimilarities. *Mers v. Conover*, 11 O. G. 1111 ; s. c. 3 Fish. 386 ; s. c. 11 Blatch. 197.

No affidavit of the defendant, unsupported by other testimony, can be considered as evidence to overthrow any averment in the bill. *Cooper v. Mattheys*, 5 Penn. L. J. 38 ; s. c. 8 Law Rep. 413.

On a motion for an interlocutory injunction, the grant of a patent to the defendant has no other effect than as it indicates the opinion which highly respectable and skilful officers have formed on an *ex parte* examination of the case, and is not conclusive. *Wilson v. Barnum*, 2 Fish. 635 ; s. c. 1 Wall. Jr. 347 ; 8 How. 258 ; s. c. 2 Robb 749 ; *Jones v. Merrill*, 8 O. G. 401 ; *Goodyear Dental Co. v. Evans*, 3 Fish. 390 ; s. c. 6 Blatch. 121 ; *Morse Co. v. Estabrook Co.*, 3 Fish. 515 ; *Sargent Manuf. Co. v. Woodruff*, 5 Biss. 444 ; *American Pavement Co. v. Elizabeth*, 4 Fish. 189 ; *Burleigh R. D. Co. v. Lobdell*, 1 Holmes 450 ; s. c. 7 O. G. 836 ; s. c. 1 Ban & Ard. 626 ; *contra*, *Goodyear v. Dunbar*, 1 Fish. 472 ; s. c. 3 Wall. Jr. 310.

Affidavits to be used in support of, or in opposition to, special motions, ought always to be served on the opposite counsel a reasonable time be-

fore the motion is brought on. Where this is not done the court may reject the affidavits, or, in its discretion, allow the same to be read, giving the opposite party the option to proceed with the hearing, or to take time for the perusal and examination of the affidavits, and production of affidavits in reply. *Sterrick v. Pugsley*, 1 Flippin 350.

It is not necessary for the defendant to give to the complainant previous notice of his defence. He is entitled to make it by answer and depositions when the motion for an injunction is brought on for a hearing. *Day v. Car Spring Co.*, 3 Blatch. 154.

If the complainant desires to file counter affidavits, the hearing may be postponed. *Day v. Car Spring Co.*, 3 Blatch. 154.

The patentee may file additional affidavits contradicting any statements made by the defendant in his affidavit. *Cooper v. Mattheys*, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413; *Goodyear v. Muller*, 3 Fish. 420; *Union Paper Bag Co. v. Binney*, 5 Fish. 166; *Day v. Car Spring Co.*, 3 Blatch. 154; *vide Illingworth v. Spaulding*, 9 Fed. Rep. 154.

Affidavits which do not refer to title may be offered in support of the bill and in contradiction of the answer. *Brooks v. Bicknell*, 3 McLean 250; s. c. 2 Robb 118.

The complainant can not file additional affidavits which are not in reply to the defendant's case. *Union Paper Bag Co. v. Binney*, 5 Fish. 166.

If the proof of the infringement is not satisfactory, the court may suspend the motion to allow the evidence to be supplied. *Hodge v. Railroad Co.*, 3 Fish. 410; s. c. 6 Blatch. 85.

If the patentee does not by counter affidavits deny the statements of the defendant, such facts are assumed to be true. *Cooper v. Mattheys*, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413.

The defendant can not by further proof on his part reply to rebutting evidence. This is alike the rule at law and in equity. No court permits a defendant to make a new defence to proofs or arguments made in reply to his own. He has one hearing or chance alone, and must abide the advantage placed in the hands of the complainant. *Day v. Car Spring Co.*, 3 Blatch. 154.

When evidence is not accessible at the time when the complainant's case is made up, the order of proof may be varied on suitable terms, giving the defendant an opportunity to answer the new matter. *Union Paper Bag Co. v. Binney*, 5 Fish. 166.

If the bill or affidavits state any fact not denied in the affidavits filed by the defendant, such fact is assumed to be true. *Cooper v. Mattheys*, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413; *Wells v. Gill*, 6 Fish. 89; s. c. 2 O. G. 590.

Upon a motion for a preliminary injunction, the court will decline to decide the question of infringement, upon a mere inspection of the machines without other evidence, if they are complicated in their structure. *Howe v. Morton*, 1 Fish. 586; *Cooper v. Mattheys*, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413; *U. S. Annunciator Co. v. Sanderson*, 3 Blatch. 184.



Upon a motion for a preliminary injunction, a new patent granted upon a surrender of the old one must be taken *prima facie* to be for the same invention as the old patent. *Woodworth v. Stone*, 3 Story 749 ; s. c. 2 Robb 296.

A voluntary appearance and the filing of an answer is a waiver of any informality in the service of the notice of a motion for a provisional injunction. *Brammer v. Jones*, 3 Fish. 340 ; s. c. 2 Bond 100.

If a demurrer is filed, it should be first heard and disposed of before the merits of the application for an injunction are considered. *Woodworth v. Edwards*, 3 W. & M. 120 ; s. c. 2 Robb 610.

The motion for a provisional injunction is heard in a summary way upon *ex parte* affidavits. A summary hearing is had upon a necessity more or less urgent for the immediate interposition of the court, and it is presumed that there is not time for that full and thorough investigation which is to be made upon the final hearing, where the witnesses can be subjected to cross-examination, and the process of the court may be used to compel the attendance of the witnesses and the production of evidence. *Grover & Baker S. Co. v. Williams*, 2 Fish. 133 ; *Day v. Boston Belting Co.*, 16 Law Rep. 330.

### **Prior Suit.**

An injunction when asked before the trial and resisted is never to issue as a matter of course till the trial. There must in such case, in order to obtain it in advance, be proof not only of a patent, but also of some length of use under it, or some considerable sales of it, or some recovery establishing the validity of the patent, so as to impart to it weight or strength as valid beyond the mere issue of it. *Hovey v. Stevens*, 1 W. & M. 290 ; s. c. 2 Robb 479 ; *Isaacs v. Cooper*, 4 Wash. C. C. 259 ; *Blake v. Boiselier*, 16 O. G. 854 ; s. c. 5 Ban & Ard. 352 ; *McGuire v. Eames*, 15 Blatch. 312 ; s. c. 3 Ban & Ard. 499 ; *Onderdonk v. Fanning*, 5 Ban & Ard. 562.

The provisional injunction may be refused if the complainant does not aver any prior adjudication in his bill to support the application. *Parker v. Brant*, 1 Fish. 58.

If the bill omits to aver a prior adjudication it may be amended and the injunction then issued. *Parker v. Brant*, 1 Fish. 58.

There is no necessity that the validity of a patent should be established by a trial at law, when there is no sufficient denial of the invention in the answer. *Sickels v. Mitchell*, 3 Blatch. 548.

If the validity of the patent has not been established on a trial either at law or in equity, and the exclusive right which the patent purports to grant has not been acquiesced in by the public, the right of the patentee must be clear and free from doubt, and the infringement must be equally clear. *North v. Kershaw*, 4 Blatch. 70.

A previous use is not an absolute and indispensable element of granting a preliminary injunction. If the validity of the patent has been established by a judgment, a preliminary injunction may be allowed without

evidence of an extensive previous use. *American M. P. Co. v. Christian*, 4 Dillon 448; s. c. 3 Ban & Ard. 42.

If the validity of the patent is not assailed and the proof of infringement is clear, a preliminary injunction may be granted, although there is no prior adjudication or exclusive enjoyment of the invention. *N. Y. G. Sugar Co. v. Am. G. Sugar Co.*, 10 Fed. Rep. 835.

If the results of the previous trials have been conflicting, and there is a strong denial of the originality of the invention in the affidavits, the provisional injunction will be refused. *Allen v. Sprague*, 1 Blatch. 567; *Batten v. Silliman*, 3 Wall. Jr. 124; *Grover & Baker S. Co. v. Williams*, 2 Fish. 133.

The force of a recovery goes upon the ground that the patentee does not sleep over his claim or interests so as to mislead others, and that whenever the validity of his claim has been tried he has sustained it as if good. *Orr v. Littlefield*, 1 W. & M. 13; s. c. 2 Robb 323.

Formerly it was generally the practice of the courts, in adjudicating upon patents, when there was a seriously disputed question of fact, to send the matter to a jury; but lately the tendency of the courts has been to consider the cases themselves upon full proof, instead of sending them to a jury. The decision of a competent court, accustomed to the investigation of facts in relation to matters of art and science, is more satisfactory than the verdict of a jury. There is usually a great mass of evidence. Many of the jurors are not accustomed to such investigations, their minds become fatigued, their recollection of the testimony imperfect, and few, if any, take minutes of the evidence. Hence the mere fact that a jury has not passed upon the case will not have much weight, if in other respects the injunction ought to issue. *Potter v. Fuller*, 2 Fish. 251; *Potter v. Muller*, 2 Fish. 465.

If the prior adjudications were rendered upon a different construction of the patent from that claimed in the pending suit, they will not authorize an injunction. *Mowry v. Railroad Co.*, 5 Fish. 587; s. c. 10 Blatch. 89.

Where a trial at law has been had, resulting in a verdict in favor of the patentee, and the right to the improvement patented has been fully established to the satisfaction of the court, and the infringement of right made clear, such a trial resulting in such a verdict is sufficient, without any other proof, to authorize the court to grant an injunction to prevent any future violation of right. Such a trial, with such a result, affords sufficient proof that in future there will be an infringement, unless such infringement is restrained by injunction. It is under such circumstances almost a matter of course that the injunction should be allowed. *Sickles v. Tileston*, 4 Blatch. 109; *Parker v. Brant*, 1 Fish. 58; *Orr v. Badger*, 7 Law Rep. 465; *Poppenhusen v. Gutta Percha Co.*, 2 Fish. 74; s. c. 4 Blatch. 184; *Potter v. Muller*, 2 Fish. 465; *Potter v. Stevens*, 2 Fish. 163; *Potter v. Fuller*, 2 Fish. 251; *Orr v. Littlefield*, 1 W. & M. 13; s. c. 2 Robb 323; *Potter v. Whitney*, 3 Fish. 77; s. c. 1 Lowell 87; *Putnam v. Weatherbee*, 1 Holmes 497; s. c. 8 O. G. 320; s. c. 2 Ban & Ard. 78; *Goodyear v. Hullihen*, 3 Fish. 251; s. c. 1 Hughes 492; *Jones v. Merrill*,



8 O. G. 401; *Thompson v. Mendelsohn*, 5 Fish. 187; s. c. 8 Phila. 166; *Robertson v. Hill*, 6 Fish. 465; s. c. 4 O. G. 132; *American Shoe Co. v. National Shoe Co.*, 11 O. G. 740; s. c. 2 Ban & Ard. 551; *U. S. & F. Felting Co. v. Asbestos Felting Co.*, 10 O. G. 828.

A judgment given on verdict and default under an agreement, if not collusive, is as strong, if not stronger evidence of the patentee's rights than it would have been if the claim were so doubtful as to be sent to a jury for decision, rather than so little doubtful as to be admitted or agreed to after being legally examined. *Orr v. Littlefield*, 1 W. & M. 13; s. c. 2 Robb 323; *Grover & Baker S. Co. v. Williams*, 2 Fish. 133; *Potter v. Fuller*, 2 Fish. 251; *McWilliams Manuf. Co. v. Blundell*, 22 O. G. 177; s. c. 11 Fed. Rep. 419.

An interlocutory injunction will not be granted if the verdicts establishing the complainant's title have been obtained on inconsistent and contradictory claims, so that the court can not say with certainty what is or what is not an infringement of the patent. *Parker v. Sears*, 1 Fish. 93.

The fact that a bill of exceptions has been taken upon points which involve the validity of the patent does not present an insuperable objection to the granting of a provisional injunction. The court is bound to exercise its own judgment upon the questions involved in the bill of exceptions, with a view to see whether the litigation that remains presents such serious doubts concerning the title as ought to influence its judgment in granting or withholding the injunction. *Furbush v. Bradford*, 1 Fish. 317; s. c. 21 Law Rep. 471; *Wells v. Gill*, 6 Fish. 89; s. c. 2 O. G. 590; *Morris v. Lowell Manuf. Co.*, 3 Fish. 67; *Hartshorn v. Day*, 3 Fish. 32; s. c. 19 How. 211.

If the prior judgment was between the same parties, the allowance of an injunction is almost a matter of course. *Poppenhusen v. N. Y. Gutta Percha Co.*, 2 Fish. 74; s. c. 4 Blatch. 184.

The injunction will be allowed if the defendant was interested in the defence of the prior suit and had a full opportunity to contest the validity of the patent. *Robertson v. Hill*, 6 Fish. 468; s. c. 4 O. G. 132; *Wells v. Gill*, 6 Fish. 89; s. c. 2 O. G. 590; *U. S. & F. Felting Co. v. Asbestos Felting Co.*, 10 O. G. 828; *Robinson v. Randolph*, 4 Ban & Ard. 163.

If the defendant contributed toward the expenses of defending the prior suit, the injunction will be allowed, although he alleges that he can produce additional witnesses to testify to a fact which was in controversy in such prior suit. *Birdsell v. Manuf. Co.*, 6 O. G. 604; s. c. 1 Ban & Ard. 426.

A prior adjudication in a suit against other parties is not conclusive, but the considerations which would justify the court on a motion for a provisional injunction in renewing the discussion of a patentee's title after solemn hearing and judgment at law, must be such as if presented to his view after a trial at law would induce him to set aside a verdict. *Parker v. Brant*, 1 Fish. 58; *Thayer v. Wales*, 5 Fish. 130; s. c. 9 Blatch. 170; *American Pavement Co. v. Elizabeth*, 4 Fish. 189; *Wells v. Gill*, 6 Fish. 89; s. c. 2 O. G. 590; *Tilghman v. Mitchell*, 4 Fish. 615; s. c. 9 Blatch.

18; *American M. P. Co. v. Atlantic M. Co.*, 4 Dillon 100; s. c. 3 Ban & Ard. 168; *Bailey W. M. Co. v. Adams*, 3 Ban & Ard. 96; s. c. 23 I. R. R. 344.

If the patent has been adjudged to be valid in the same court after a prolonged contest, a preliminary injunction will be granted, although no preliminary injunction has been awarded in another court in a prior case. *Atlantic Giant Powder Co. v. Goodyear*, 13 O. G. 45; s. c. 3 Ban & Ard. 161.

If the decree in the prior suit was entered by collusion, it is not sufficient to entitle the patentee to a preliminary injunction. *Kirby Bung Manuf. Co. v. White*, 17 O. G. 974; s. c. 1 McCrary 155; s. c. 5 Ban & Ard. 263; s. c. 1 Fed. Rep. 604; *Hayes v. Leton*, 5 Fed. Rep. 521.

If the evidence is different, the court will not be bound by a decision in another circuit. *Edgerton v. F. & B. Manuf. Co.*, 21 O. G. 251; s. c. 10 Biss. 402; s. c. 9 Fed. Rep. 450.

Although a patent has been sustained by a prior adjudication, yet a preliminary injunction will not be granted if the point in dispute was not settled by the prior adjudication. *Steam G. & L. Co. v. Miller*, 11 Fed. Rep. 718.

A decision declaring a patent invalid will not be followed on a motion for a preliminary injunction if the evidence shows that the decision was erroneous. *U. S. Stamping Co. v. King*, 17 O. G. 1399; s. c. 17 Blatch. 55; s. c. 4 Ban & Ard. 469; s. c. 7 Fed. Rep. 860.

If a decree was first against the patent, a subsequent decree in favor of the patent entered upon the agreement of the parties will not have much weight on a motion for a preliminary injunction. *Spring v. Domestic S. M. Co.*, 16 O. G. 721; s. c. 4 Ban & Ard. 427.

If the trial at law has not been satisfactory, an injunction will be denied. *Day v. Hartshorn*, 3 Fish. 32.

A decision upon a motion for a preliminary injunction is not such an adjudication as is required as a foundation for a preliminary injunction in another circuit. *Warner v. Bassett*, 19 Blatch. 145; s. c. 7 Fed. Rep. 468.

On a motion for a preliminary injunction a decision of the commissioner upon an interference between the same parties is sufficient to cast the burden of proof upon the respondent. *Pentlarge v. Beeston*, 14 Blatch. 352; s. c. 3 Ban & Ard. 142.

If the decision in the patent office on an interference was in favor of the patentee, then he is entitled to a preliminary injunction against the adverse party. *Smith v. Halkard*, 16 Fed. Rep. 414; s. c. 23 O. G. 1833; *Holliday v. Pickhardt*, 22 O. G. 420; s. c. 12 Fed. Rep. 147.

If priority has been awarded to the complainant, on an interference declared between him and the defendant, a preliminary injunction will be granted, although the patent is recent, unless the defendant can show that he is acting in good faith in contending that neither party was the first inventor. *Greenwood v. Braher*, 17 O. G. 115; s. c. 5 Ban & Ard. 302; s. c. 1 Fed. Rep. 856.

If the commissioner on an interference decided that the respondent's



machine was not an infringement of the complainant's patent, a preliminary injunction will be refused. *Yuengling v. Johnson*, 1 Hughes 607; s. c. 3 Ban & Ard. 99.

A party who voluntarily assumes the position of infringing an existing patent after a decision of the court in another case sustaining its validity, can not allege that any particular hardship attends his case, when the court decides that the apparent title of the patentee is such that he must refrain from further infringing until he has proved the invalidity of the patent on a trial at law. *Sargent v. Seagrave*, 2 Curt. 553.

A decision on a motion for an attachment is not sufficient to warrant a preliminary injunction where the infringement is positively denied, without reference to the facts proven in the case. *Sargent Manuf. Co. v. Woodruff*, 5 Biss. 444.

The decree of a court of chancery is more persuasive evidence than the verdict of a jury. *Goodyear v. Muller*, 3 Fish. 420; *American M. & P. Co. v. Christian*, 4 Dillon 448; s. c. 3 Ban & Ard. 42; *Colgate G. & S. Tel. Co.*, 16 O. G. 583; s. c. 16 Blatch. 503; s. c. 4 Ban & Ard. 415; *United Nickel Co. v. Manhattan Brass Co.*, 16 Blatch. 68; s. c. 4 Ban & Ard. 173; *Clarke v. Johnson*, 16 Blatch. 495; 17 O. G. 1401; s. c. 4 Ban & Ard. 403; *Steam G. & L. Co. v. Miller*, 20 O. G. 889; s. c. 8 Fed. Rep. 314; *Blaisdell v. Puffer*, 4 Ban & Ard. 500; *Odorless Excav. Co. v. Lauman*, 12 Fed. Rep. 788; *Blaisdell v. Dows*, 4 Ban & Ard. 499; *Coburn v. Clark*, 24 O. G. 899.

When a prior decree is relied on as the ground for a preliminary injunction, there should be a careful investigation of the precise points decided and of the alleged infringement. *Coburn v. Clark*, 24 O. G. 899.

If there has been no action at law nor length of possession, the injunction will be refused if the injury would not be irreparable. *Earth Closet Co. v. Fenner*, 5 Fish. 15.

If the court in the prior case decided that the machine used by the defendant was an infringement of the patent, an injunction will be awarded, although it was made under a subsequent patent. *Sickels v. Tileston*, 4 Blatch. 109.

If the complainant omits to apply for a preliminary injunction until the case is nearly ready for final hearing, it will not be granted, although the validity of the patent was sustained in another action prior to the commencement of the suit. *Andrews v. Spear*, 4 Dillon 472; s. c. 3 Ban & Ard. 82.

### **Prior Use.**

If the validity of the patent has not been established by an action at law, a preliminary injunction will not be granted unless there has been an exclusive possession of some duration under it. *Sullivan v. Redfield*, 1 Paine 441; s. c. 1 Robb 477; *Hockholzer v. Eager*, 2 Saw. 361; *Isaacs v. Cooper*, 4 Wash. C. C. 259; s. c. 1 Robb 332; *Tappan v. Nat'l Bank Note Co.*, 2 Fish. 195; s. c. 4 Blatch. 509; *Brown v. Hinkley*, 6 Fish. 370; s. c. 3 O. G. 384; *Jones v. Field*, 12 Blatch. 494; s. c. 2 Ban & Ard. 39; *Warner v. Bassett*, 19 Blatch. 145; s. c. 7 Fed. Rep. 468.

The ground on which acquiescence is important is that it shows exclusive possession, which if it has been of long standing, open and notorious, is a clear foundation of a presumption of title. It is not always, however, so satisfactory as positive adjudications, because it may have arisen from the comparatively small commercial value of the invention, and in that case shows only that no one has thought it worth infringing. *Potter v. Whitney*, 3 Fish. 77; s. c. 1 Lowell 87; *Tappan v. Nat'l Bank Note Co.*, 2 Fish. 195; s. c. 4 Blatch. 509; *Grover & Baker S. Co. v. Williams*, 2 Fish. 133; *McWilliams Manuf. Co. v. Blundell*, 11 Fed. Rep. 419.

If the possession and use under a patent has been of sufficient duration and exclusiveness, it may be the foundation of an interlocutory injunction. *Goodyear v. Central R. R. Co.*, 1 Fish. 626; s. c. 2 Wall. Jr. 356; *Foster v. Moore*, 1 Curt. 299; *American Shoe Co. v. National Shoe Co.*, 11 O. G. 740; s. c. 2 Ban & Ard. 551; *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206; *Ogle v. Ege*, 4 Wash. C. C. 584; s. c. 1 Robb 516; *Howe v. Newton*, 2 Fish. 531; *Sargent v. Carter*, 1 Fish. 277; *Woodworth v. Sherman*, 3 Story 171; s. c. 2 Robb 257; *Morse Co. v. Esterbrook Co.*, 3 Fish. 515; *Consolidated M. P. Co. v. Guildler*, 9 Fed. Rep. 155; *White v. Heath*, 22 O. G. 500; s. c. 10 Fed. Rep. 291.

If the bill does not aver that the patentee has ever sold or used his improvement, the motion will be denied. *Isaacs v. Cooper*, 4 Wash. C. C. 259; s. c. 1 Robb 332.

If the motion is refused because the bill does not aver that the patentee has ever sold or used his improvement, the bill may be amended. *Isaacs v. Cooper*, 4 Wash. C. C. 259; s. c. 1 Robb 332.

When possession for some years has existed, or numerous sales or recoveries have occurred, the court will not refuse an injunction, or dissolve it on a denial of the validity of the patent by a respondent, either through affidavits or an answer, or other pleadings. *Hovey v. Stevens*, 1 W. & M. 290; s. c. 2 Robb 479; *Cook v. Ernest*, 5 Fish. 396; s. c. 1 Woods 195; 2 O. G. 89; *Brooks v. Bicknell*, 3 McLean 250; s. c. 2 Robb 118; *Gibson v. Betts*, 1 Blatch. 163; *Woodworth v. Rogers*, 3 W. & M. 135, s. c. 2 Robb 625; *Hussey v. Whiteley*, 2 Fish. 120; s. c. 1 Bond 407.

Mere lapse of time is not sufficient to show a public recognition of the patentee's claim. The acquiescence in the patent must be attended with circumstances indicating that such acquiescence would not have occurred if any fair doubt had existed as to the validity of the patent. *Guidet v. Palmer*, 6 Fish. 82; s. c. 10 Blatch. 217.

In order to raise a presumption in favor of the patent, the use prior to the application therefor must be public under an avowed claim of a right to a patent. Otherwise there is no exclusive possession as against the public, and no claim in which the public can acquiesce. A secret use prior to the application for a patent will not, therefore, be taken into account on a motion for a provisional injunction. *Tappan v. Nat'l Bank Note Co.*, 2 Fish. 195; s. c. 4 Blatch. 509.

Exclusive possession and sales made between the date of the invention



and the application for a patent may be considered. *Sargeant v. Seagrave*, 2 Curt. 553.

The possession must be sufficient to justify a presumption in favor of the validity of a patent. *Potter v. Muller*, 2 Fish. 465.

Injunctions are granted without a previous trial at law, in cases where the owner of the patent shows a clear case of infringement, and has been in the possession and enjoyment of the exclusive right for a term of years, without any successful impeachment of its validity. Such possession and enjoyment, aided by the presumptions arising from the patent itself, are usually regarded as sufficient to warrant an injunction to restrain an infringement. *Potter v. Muller*, 2 Fish. 465; *Miller v. Androscoggin Pulp Co.*, 5 Fish. 340; s. c. 1 Holmes 142; 1 O. G. 409; *Parker v. Brant*, 1 Fish. 58.

A sufficient possession will warrant a provisional injunction even where great doubt is felt concerning the validity of the patent. *Sargeant v. Seagrave*, 2 Curt. 553.

It is not possible to fix any precise term of years during which the exclusive possession must have continued. The reason for the presumption in favor of the validity of the grant is the acquiescence of the public in the exclusive right of the patentee, which, it may reasonably be assumed, would not exist unless the right was well founded. It is obvious that this public acquiescence is entitled to more or less weight according to the degree of utility of the machine and the number of persons whose trade or business is affected by it. *Foster v. Moore*, 1 Curt. 279; *Sargeant v. Seagrave*, 2 Curt. 553.

The courts have seldom refused an injunction on account of the shortness of the time after the grant, however brief, if long enough to permit articles or machines to be constructed by the patentee in conformity with his claim, and to be sold publicly and repeatedly, and they have been so sold and used under the patent without dispute. *Orr v. Littlefield*, 1 W. & M. 13; s. c. 2 Robb 323; *Potter v. Muller*, 2 Fish. 465;

The shortest term of use is three years, and in most of the cases the time has been several years longer. *Hovey v. Stevens*, 1 W. & M. 290; s. c. 2 Robb 479.

It is not necessary that the possession shall have been undisturbed. *Cook v. Ernest*, 2 Fish. 396; s. c. 1 Woods 195; 2 O. G. 89.

An unsuccessful attempt to interrupt a possession strengthens the presumption that arises from it. It tends to show that persons who have found it for their interest to question the right, have questioned it, and for a time have refused to submit to it, but, on inquiry, have submitted. Such submission is the most persuasive kind of acquiescence. *Sargeant v. Seagrave*, 2 Curt. 553.

Each case must depend on its own circumstances. Those circumstances are the extent of the use or sales by the patentee, the degree of utility of the invention, and the number of persons whose business is affected by it, and who are interested to question the exclusive right. *Sargeant v. Seagrave*, 2 Curt. 553.

The time of the possession in case of a reissue is to be computed from the date of the original issue or grant. *Orr v. Littlefield*, 1 W. & M. 13; s. c. 2 Robb 323; *Grover & Baker S. Co. v. Williams*, 2 Fish. 133; *Orr v. Badger*, 7 Law Rep. 465.

A preliminary injunction will not be granted when the defendant has been in possession and use of the invention for a long period of time adverse to the title of the complainant and under claim and color of right. *Hall v. Spier*, 6 Pitts. L. J. 403; *Isaacs v. Cooper*, 4 Wash. C. C. 259; s. c. 1 Robb 332.

Where possession alone is relied on as a basis for a motion for a preliminary injunction, the infringement must be palpable. *Burleigh Drill Co. v. Lobdell*, 1 Holmes 450; s. c. 7 O. G. 836; s. c. 1 Ban & Ard. 825.

### **Preliminary Injunction.**

It is not a matter of course to grant an injunction upon the mere exhibition of the patent, and an allegation that it has been infringed. The patent may be, upon a trial at law, *prima facie* evidence of the right, but in order to warrant an interference by injunction there ought to be but little if any doubt as to the validity of the patent. *Sullivan v. Redfield*, 1 Paine 441; s. c. 1 Robb 477; *Thomas v. Weeks*, 2 Paine 92; *Isaacs v. Cooper*, 4 Wash. C. C. 259; s. c. 1 Robb 332; *Serrell v. Collins*, 4 Blatch. 61.

The power to grant an injunction has existed from the early ages of chancery jurisdiction, and is remedial and useful as a preventative of injury and a multiplicity of suits, when it is properly exercised. An injunction is intended to aid or protect what seems to be a legal title. It is granted for this purpose when issued before a trial on presumptive evidence offered of such a title. It does not delay or retard a trial, but makes the *prima facie* title prevail till then. *Woodworth v. Rogers*, 3 W. & M. 135; s. c. 2 Robb 625; *Orr v. Littlefield*, 1 W. & M. 13; s. c. 2 Robb 323; *Buck v. Cobb*, 9 Law Rep. 545.

The issuing of an interlocutory injunction is always a matter of discretion with the court, and depends on the peculiar circumstances of each case. *Parker v. Sears*, 1 Fish. 93; *Earth Closet Co. v. Fenner*, 5 Fish. 15; *Potter v. Davis Sewing Machine Co.*, 3 Fish. 472; *Goodyear v. Rust*, 3 Fish. 456; s. c. 6 Blatch. 229; *Potter v. Crowell*, 3 Fish. 112; s. c. 1 Abb. U. S. 89; *Irwin v. Dane*, 4 Fish. 359; s. c. 2 Biss. 442; *Coburn v. Brainard*, 16 Fed. Rep. 412.

The right of the party to the most speedy and effectual protection against a meditated wrong is as complete as his right to redress for wrongs already inflicted, and the accident of position confers no right on one party, whether he be plaintiff or defendant, at the expense of the other. The special injunction of equity may be abused to the injury of an opponent, but it is no less on that account the duty of the judge to grant it when in the exercise of his best discretion he believes that it is called for by the merits and exigency of the case. *Smith v. Mercer*, 5 Penn. L. J. 529;



s. c. 4 West. L. J. 49; *Hussey v. Whiteley*, 2 Fish. 120; s. c. 1 Bond 407; *Potter v. Muller*, 2 Fish. 465; *Potter v. Schenck*, 1 Biss. 155; s. c. 3 Fish. 82; *Hodge v. Hudson River R. R. Co.*, 6 Blatch. 165; s. c. 3 Fish. 410.

In acting on applications for a provisional injunction there is much latitude for discretion. The application may be granted or refused unconditionally, or terms may be imposed on either of the parties as conditions for making or refusing the order. The state of the litigation where the patentee's title is denied, the nature of the invention, the character and extent of the infringement complained of, and the comparative inconvenience which will be occasioned to the respective parties by allowing or denying the motion, must all be considered in determining whether it shall be allowed or refused, and if at all, whether absolutely or upon some and what conditions. *Furbush v. Bradford*, 1 Fish. 317; s. c. 21 Law Rep. 471; *Hodge v. Hudson River R. R. Co.*, 6 Blatch. 165; s. c. 3 Fish. 410.

The court will regard the comparative expense and inconvenience to which the parties will be subjected in case of granting the injunction on the one hand or withholding it on the other, and if the effect of granting an injunction will be very injurious and the refusal will subject the complainant to a comparatively slight inconvenience, the preliminary injunction will be refused. *Hockholzer v. Eager*, 2 Saw. 361; *Parker v. Sears*, 1 Fish. 93; *Biss v. Brooklyn*, 4 Fish. 596; s. c. 8 Blatch. 533; *Furbush v. Bradford*, 1 Fish. 317; s. c. 21 Law Rep. 471; *Gear v. Holmes*, 6 Fish. 595; *Goodyear v. Dunbar*, 1 Fish. 472; s. c. 3 Wall. Jr. 310; *Morris v. Lowell Manuf. Co.*, 3 Fish. 67; *Hoe v. Boston D. A. Corporation*, 23 O. G. 1124; s. c. 14 Fed. Rep. 914; *Dorsey R. H. Rake Co. v. Bradley Manuf. Co.*, 12 Blatch. 202; s. c. 1 Ban & Ard. 330; *New York G. S. Co. v. Am. G. Sugar Co.*, 10 Fed. Rep. 835; *Tillinghast v. Hicks*, 23 O. G. 739; s. c. 13 Fed. Rep. 388.

Where an injunction would be disastrous to the defendant, and of no advantage to the complainant, it will not be granted if the defendant will file a bond with proper security to secure to the complainant the profits and damages which may be ultimately awarded. *Dorsey Co. v. Marsh*, 6 Fish. 387; s. c. 9 Phila. 395; *Morris v. Shelbourne*, 4 Fish. 377; s. c. 8 Blatch. 266.

There is not much force in the objection that an injunction would produce irreparable injury if it merely prohibits the sale of articles which are manufactured elsewhere. *Potter v. Fuller*, 2 Fish. 251.

If the injunction leads to serious injury in suspending works, the court can require security of the complainant to indemnify for it if the patent is avoided. *Orr v. Littlefield*, 1 W. & M. 13; s. c. 2 Robb 322; *Morse v. O'Reilly*, 6 West. L. J. 102.

There is no power, the exercise of which is more delicate, which requires greater caution, deliberation and sound discretion, or is more dangerous in a doubtful case, than the issuing of an injunction. It is the strong arm of equity that never ought to be extended unless to cases of great injury, where courts of law can not afford an adequate or commen-

surate remedy in damages. The right must be clear, the injury impending or threatened. An injunction will be refused till the court is satisfied that a right is about to be destroyed or irreparably injured, or that great and lasting injury is about to be done by an illegal act. *Hall v. Speer*, 6 Pitts. L. J. 403.

The responsibility of the defendant for any profits or damages that may be decreed against him is a material circumstance. *Morris v. Lowell Manuf. Co.*, 3 Fish. 67; *Guidet v. Palmer*, 6 Fish. 82; s. c. 10 Blatch. 217; *Pullman v. B. & O. R. R. Co.*, 4 Hughes 236; s. c. 19 O. G. 224; s. c. 5 Fed. Rep. 72.

Where the validity of the patent is fully established, and the infringement is clear, a party has a right to protection by injunction, although it may cause great injury to the infringer. *Potter v. Fuller*, 2 Fish. 251.

If no special damage will result to the defendant or his business, the injunction will be granted. *Howe v. Newton*, 2 Fish. 531.

It is too much for a defendant in a clear case to insist upon having the privilege of using a patented invention, for the reason that he is able to pay the damages that may be awarded against him at the end of a protracted litigation to ascertain their amount. The patentee may not be as able to prosecute a suit as the defendant is to defend. The inconvenience which may result from an injunction does not in such a case afford sufficient ground for withholding it. *Sickels v. Mitchell*, 3 Blatch. 548.

In most cases an injunction will not be granted until the right of the complainant has been established at law; but where the injury would be irreparable, an injunction will be granted. The infringement of a patent constitutes an exception to the general rule. *Brooks v. Bicknell*, 3 McLean 250.

If the defendant has little or no property, and can not pay the damages which might be recovered against him for an infringement of the patent, the injury would be irreparable. *Brooks v. Bicknell*, 3 McLean 250; s. c. 2 Robb 118; *Goodyear v. Muller*, 3 Fish. 420.

If more injury may result to the complainant from a refusal of the injunction than to the defendant by granting it, the injunction will be granted. *Irwin v. Dane*, 4 Fish. 359; s. c. 2 Biss. 442.

Damage that may result from the groundless fears of others is no ground for refusing a preliminary injunction. *Rumford Chemical Works v. Vice*, 11 O. G. 600; s. c. 14 Blatch. 179.

Although a decision has been made against the validity of the original patent on account of defects in the specifications, yet a preliminary injunction may be granted on a reissue. *Schneider v. Bassett*, 13 Fed. Rep. 351; s. c. 22 O. G. 1447.

The court, as a condition for allowing an injunction, may require that the complainant shall give bond to indemnify the defendant in the event that the right of the complainant shall not be sustained upon the final hearing. *Brammer v. Jones*, 3 Fish. 340; s. c. 2 Bond 100; *Shelly v. Brannan*, 4 Fish. 198; s. c. 2 Biss. 315; *Allis v. Stowell*, 23 O. G. 1033; s. c. 15 Fed. Rep. 242.



Upon granting an injunction, the court may direct that unless a suit is brought at the next term to try the legal title, the injunction shall then be dissolved. *Woodworth v. Rogers*, 3 W. & M. 135 ; s. c. 2 Robb 625 ; *Orr v. Merrill*, 1 W. & M. 376 ; s. c. 2 Robb 331 ; *Serrell v. Collins*, 4 Blatch. 61 ; *Orr v. Littlefield*, 1 W. & M. 13 ; s. c. 2 Robb 323 ; *Rogers v. Abbott*, 4 Wash. C. C. 514 ; s. c. 1 Robb 465.

The practice on a motion for a preliminary injunction is to protect the complainant without unnecessarily injuring the defendant. Hence the form of the order varies with the circumstances of each case. In one case there may be such circumstances as require an injunction *simpliciter*, but ordinarily a bond and order for accounting suffices, and sometimes simply an order for accounting. *Kirby Bung Manuf. Co. v. White*, 17 O. G. 974 ; s. c. 1 McCrary 155 ; s. c. 5 Ban & Ard. 263 ; s. c. 1 Fed. Rep. 604.

The granting of an injunction being a matter entirely within the discretion of the court, it is for the court to say whether the rights of the complainant are so clear that he ought to be protected by injunction, or whether they are not so clear but that he may be made secure by sufficient guaranties by bond and security. *Ely v. Monson Manuf. Co.*, 4 Fish. 64.

The defendant can not have the injunction stayed upon giving bond, with security, to the patentee for his damages when the infringement is clear and the right to the injunction manifest. *Tracy v. Torry*, 2 Blatch. 275 ; *Tilghman v. Mitchell*, 4 Fish. 615 ; s. c. 9 Blatch. 13 ; *Gibson v. Van Dresar*, 1 Blatch. 532 ; *Conover v. Mers*, 3 Fish. 386 ; *Consolidated Fruit Jar Co. v. Whitney*, 1 Ban & Ard. 356 ; *Ely v. Monson Manuf. Co.*, 4 Fish. 64 ; *McWilliams Manuf. Co. v. Blundell*, 22 O. G. 177 ; s. c. 11 Fed. Rep. 419.

The decree for an injunction may provide for its dissolution on the defendant's giving bond with security to account to the patentee should his right be finally established. *Brooks v. Bicknell*, 3 McLean 250 ; s. c. 2 Robb 118 ; *Foster v. Moore*, 1 Curt. 279 ; *Gilbert & Barker Manuf. Co. v. Bussing*, 12 Blatch. 426 ; s. c. 8 O. G. 144 ; s. c. 1 Ban & Ard. 621 ; *Howe v. Morton*, 1 Fish. 586 ; *Jones v. Merrill*, 8 O. G. 401 ; *Furbush v. Bradford*, 1 Fish. 317 ; s. c. 21 Law Rep. 471 ; *U. S. Annunciator Co. v. Sanderson*, 3 Blatch. 184 ; *Stainthorp v. Humiston*, 2 Fish. 311 ; *Goodyear v. Hills*, 3 Fish. 134 ; *American Pavement Co. v. Elizabeth*, 4 Fish. 189 ; *Goodyear v. Honsinger*, 3 Fish. 147 ; s. c. 2 Biss. 1 ; *Sykes v. Manhattan Co.*, 6 Blatch. 496 ; *American M. & P. Co. v. Christian*, 4 Dillon 448 ; s. c. 3 Ban & Ard. 42 ; *Irwin v. McRoberts*, 16 O. G. 853 ; s. c. 4 Ban & Ard. 411 ; *Greenwood v. Braher*, 17 O. G. 1151 ; s. c. 5 Ban & Ard. 302 ; s. c. 1 Fed. Rep. 856.

A bond can only be required in a case in which if it is not given the injunction must issue. *American M. P. Co. v. Atlantic M. Co.*, 4 Dillon 100 ; s. c. 3 Ban & Ard. 168.

If the amount of the bond as at first fixed is subsequently found not to be sufficient, it may be increased. *Irwin v. McRoberts*, 16 O. G. 853 ; s. c. 4 Ban & Ard. 411.

If the court refuses a provisional injunction upon condition that the

defendant file with the clerk a monthly account of all articles manufactured and sold by him, an account giving such a description of the articles as is sufficient to enable persons in the trade to determine the value or price of them in the market, is a compliance with the order, although the prices and the names of the purchasers are not stated. *Wilder v. Gaylor*, 1 Blatch. 511.

The court may refuse an injunction if the defendant will pay a reasonable license fee to the complainant and accept a license. *Hodge v. Hudson River R. R. Co.*, 6 Blatch. 165; s. c. 3 Fish. 410; *Colgate v. Gold & S. Tel. Co.*, 16 O. G. 583; s. c. 16 Blatch. 583; s. c. 4 Ban & Ard. 415.

If the defendant's machine contains a valuable improvement which is not contained in the patent, the court may provide that if the defendant will file a bond to account for the profits, an injunction shall not issue. *Stainthorp v. Humiston*, 2 Fish. 311.

A provisional injunction is always refused if upon the facts presented there is a fair doubt whether the defendant has infringed. *Dodge v. Card*, 2 Fish. 116; s. c. 1 Bond 393; *Hardy v. Marble*, 23 O. G. 438; s. c. 10 Fed. Rep. 752.

If the defendant shows a belief that he has a just defence, and is not a wilful pirate of the patentee's invention, it should be a case of evident mistake of law or fact, or both, in the defence which he sets up which will justify the court in granting an injunction. *Goodyear v. Dunbar*, 1 Fish. 472; s. c. 3 Wall. Jr. 310; *Batten v. Silliman*, 3 Wall. Jr. 124.

It is not enough to authorize the granting of an injunction that the complainant has taken out a patent, and thus obtained a public grant and the sanction or opinion of the patent office in favor of his right. There must be something stronger than the mere issue, for in that there is no opposing party, no notice and no trial with any one of his rights. *Orr v. Littlefield*, 1 W. & M. 13; s. c. 2 Robb 323; *Tappan v. Nat'l Bank Note Co.*, 2 Fish. 195; s. c. 4 Blatch. 509; *Grover & Baker S. Co. v. Williams*, 2 Fish. 133.

If the complainant's invention is merely an improvement upon a prior patent, the fact that he is infringing such prior patent can not affect the motion for an injunction. The case of each patentee must be treated separately on its merits when presented. *Young v. Lippman*, 5 Fish. 230; s. c. 9 Blatch. 277; s. c. 2 O. G. 249.

If a party who has been using a machine sells his interest prior to the filing of the bill, an injunction will not be granted against him. *Brammer v. Jones*, 3 Fish. 340; s. c. 2 Bond 100.

A writ of injunction is to act as a remedy against a threatened wrong by preventing the commission of such wrong, and it is not necessary before a writ to prevent a wrong can issue that the wrong should actually have been committed. If it were, the remedy by injunction would be a very inadequate one. If the rights of a party under a patent have been fully and clearly established, and an infringement of such rights is threatened; or if when they have been infringed, the party has good reason to believe they will continue to be infringed, an injunction will issue. *Poppenhusen v. Gutta Percha Co.*, 2 Fish. 74; s. c. 4 Blatch. 184.



No interlocutory injunction should issue unless the complainant's title and the defendant's infringement are admitted, or are so palpable and clear that the court can entertain no doubt on the subject. The court is not bound, in this stage of the cause, to decide doubtful and difficult questions of law, or disputed questions of fact, nor exercise this high and dangerous power in doubtful cases, before the alleged offender has an opportunity of a full and fair hearing. *Parker v. Sears*, 1 Fish. 93; *Sickels v. Youngs*, 3 Blatch. 293; *Jones v. Osgood*, 3 Fish. 591; s. c. 6 Blatch. 435; *Grover & Baker S. Co. v. Williams*, 2 Fish. 133; *American Pavement Co. v. Elizabeth*, 4 Fish. 189; *Fisher v. Domestic S. M. Co.*, 22 O. G. 1207; s. c. 12 Fed. Rep. 495; *Marks v. Corn*, 23 O. G. 94; s. c. 11 Fed. Rep. 900; *Cross v. Livermore*, 21 O. G. 139; 9 Fed. Rep. 607; *Illingworth v. Spaulding*, 9 Fed. Rep. 154; *Ballou Shoe M. Co. v. Dizer*, 5 Ban & Ard. 540; *Pullman v. B. & O. R. R. Co.*, 4 Hughes 236; s. c. 19 O. G. 224; 5 Fed. Rep. 72; *American C. Lining Co. v. Beale*, 5 Ban & Ard. 529; *National F. D. Co. v. Dearborn*, 24 O. G. 497; *Margot v. Schnetzer*, 24 O. G. 101; s. c. 15 Fed. Rep. 118; *Bradley & H. Manuf. Co. v. Parker*, 17 Fed. Rep. 240; *Zinsser v. Cooledge*, 17 Fed. Rep. 538.

Cases often occur where the answer or affidavits are equivocal or evasive, or disclose a state of facts which show that the conclusions drawn from them are clearly erroneous and founded on a mistake of the law, as when an infringement is denied and a model admitted which shows a palpable infringement, and it is evident that the denial is made under a gross mistake of the true and settled construction of the patent, or where the originality of the invention is denied in general terms, and infringement is admitted, and the patent has been fully established at law, and it is evident that the denial of its validity is but a matter of obstinate opinion, or a mistake of law. Such cases, and only such, can be considered as exceptions to the general rule. *Parker v. Sears*, 1 Fish. 93.

If the defendant admits the infringement, but asserts that after notice or service of the injunction he refrained from the use of the thing patented, and asserts that he will not afterwards infringe, it is no reason why an injunction should not issue and be made perpetual. The complainant, in such a case, is not obliged to rest his interests on the mere asseveration of the party that he will not repeat the act of infringement. Having once been a wrongdoer, the law supposes the probability of his being so again, and will impose the proper restraint to prevent the repetition of the wrongful act. *Jenkins v. Greenwald*, 2 Fish. 37; s. c. 1 Bond 126; *Potter v. Crowell*, 3 Fish. 112; s. c. 1 Abb. U. S. 89; *Goodyear v. Berry*, 3 Fish. 439; s. c. 2 Bond 189; *Rumford Chemical Works v. Vice*, 11 O. G. 600; s. c. 14 Blatch. 179; *White v. Heath*, 22 O. G. 500; s. c. 10 Fed. Rep. 291; *Amer. Bell T. Co. v. Ghegan*, 23 O. G. 537.

The usual practice is to postpone the consideration of difficult or doubtful points till the final hearing of the cause, and not to decide the whole merits of a cause on a mere preliminary motion. *Goodyear v. Central R. R. Co.*, 1 Fish. 626; s. c. 2 Wall. Jr. 356; *Hovey v. Stevens*,

1 W. & M. 290; s. c. 2 Robb 479; Jones v. Hodges, 1 Holmes 37; Livingston v. Van Ingen, 1 Paine 45; s. c. 4 Am. L. J. 56; Winans v. Eaton, 1 Fish. 181; Smith v. Selden, 1 Blatch. 475; Cooper v. Mattheys, 5 Penn. L. J. 38; s. c. 8 Law. Rep. 413; Am. C. Loom Co. v. Manchester C. L. Co., 20 O. G. 372; Brewster v. Parry, 14 Fed. Rep. 694; Evans v. Kelley, 23 O. G. 192; s. c. 13 Fed. Rep. 903.

When the objection relates to the technical form or signature of papers connected with the letters patent, and the doubts arise from acts of public officers, and not any neglect or wrong of the patentee, the injunction should not be dissolved. More especially should an injunction once granted not be disturbed for such doubts, when the term for trial of the merits is near. *Woodworth v. Hall*, 1 W. & M. 389; s. c. 1 Robb 517.

To warrant the exercise of the extraordinary power of the court in granting a preliminary injunction, the case presented should be free from ambiguity or confusion. Especially should this rule be applied to a case where the alleged infringement is in the disputed territory that lies between the limits fixed by the original patent and those fixed by the re-issued patent, for whatever of difficulty or uncertainty there may be arising out of the difference between the two specifications is the fault or misfortune of the patentee, and not of the respondent, and should be borne by the former, and not the latter. *Poppenhusen v. Falke*, 2 Fish. 181; s. c. 4 Blatch. 493.

The existence of a substantial doubt as to the question of identity of the inventions described in a reissued patent and the original is a proper ground for refusing to grant a preliminary injunction. *Poppenhusen v. Falke*, 2 Fish. 181; s. c. 4 Blatch. 493; *Grover & Baker S. Co. v. Williams*, 2 Fish. 133.

A mere denial by an answer of the equity of the bill does not prevent the court from looking into the law and the facts of the case when a special injunction is moved for, and granting or refusing it according to its discretion. Where the title to an injunction does not depend upon any controverted or doubtful facts, but upon the interpretation to be put by the court upon a written instrument, the court should interpret it on such motion, and grant or refuse the injunction according to the result of that interpretation. There may be cases in which there is so much doubt what the parties to the instrument intended to effect by it, that the court may think it proper to suspend its judgment until the surrounding circumstances can be more fully and safely examined on a final hearing. It is possible, also, that where there are grave doubts concerning the legal effect of an instrument, the court might decline to interfere by special injunction, even though, if compelled to decide, their decision must be in favor of the complainant. Probably the circumstances of the case, and the degree of mischief which would be suffered by refusing the injunction, compared with the inconvenience and loss occasioned by granting it, would control the action of the court in the case supposed. But in general, if the title to a temporary injunction depends on the construction of a deed, the court will construe it and act accordingly, whatever



view of that question the answer may have presented. *Clum v. Brewer*, 2 Curt. 506; *Goodyear v. Central R. R. Co.*, 1 Fish. 626; s. c. 2 Wall. Jr. 356; *Hodge v. Hudson River R. R. Co.*, 6 Blatch. 165; s. c. 3 Fish. 410; *U. S. Stamping Co. v. King*, 17 O. G. 1399; s. c. 17 Blatch. 55; s. c. 4 Ban & Ard. 469; s. c. 7 Fed. Rep. 860.

To authorize a provisional injunction it is not necessary that all the grants of right to the patentee shall have been infringed. All that is required is that some of them shall have been so infringed. *Potter v. Holland*, 1 Fish. 382; s. c. 4 Blatch. 238.

A temporary injunction may be granted restraining the defendant from using the invention covered by some of the claims in the patent, and the question as to the others postponed until the case comes up for hearing upon the pleadings and proofs. *Colt v. Young*, 2 Blatch. 471.

It is doubtful whether a misjoinder of parties as plaintiff's can defeat a prayer for a preliminary injunction not to use an invention in which any of them are interested. Such a misjoinder can not probably be objected to at all in equity, though in the final judgment it will be entered up in favor of those alone who appear to have some right and interest to be protected. *Woodworth v. Hall*, 1 W. & M. 248, 389; s. c. 2 Robb 495, 417.

Though technical objections are to be weighed and examined and allowed to prevail if legal, yet they ought to be treated with no particular indulgence. In all inquiries in equity, the leaning in doubtful points must certainly be rather against than in favor of them, and more especially must it be so in preliminary injunctions where the decision is only temporary, and may be dissolved on motion at any time on showing fuller proof as to anything affecting the merits of the controversy. *Woodworth v. Hall*, 1 W. & M. 248, 389; s. c. 2 Robb 495, 417.

If the defendant's patent was granted after a full hearing before the patent office, on testimony taken on an interference declared between the application for such patent and the complainant's patent, a preliminary injunction will be denied. *Asbestos Felting Co. v. U. S. & F. Felting Co.*, 13 Blatch. 453; s. c. 10 O. G. 828; s. c. 2 Ban & Ard. 369.

If the defendant resides out of the district and carries on the business there, in the course of which he committed the alleged infringement, the injunction may be refused. *Goodyear v. Chaffee*, 3 Blatch. 268; *Jones v. Osgood*, 3 Fish. 591; s. c. 6 Blatch. 435; *Wilson Packing Co. v. Clapp*, 13 O. G. 368; s. c. 8 Biss. 154; s. c. 3 Ban & Ard. 243; *vide Thompson v. Mendelsohn*, 5 Fish. 187; s. c. 8 Phila. 166.

The mere fact that several parties interested in a patent have made a common fund for the purpose of protecting their common rights by prosecuting infringers, is no ground for refusing an injunction. *Potter v. Fuller*, 2 Fish. 251.

A preliminary injunction can not be resorted to for the purpose of obtaining a contract, although the bid of the defendant is the lowest. *American Pavement Co. v. Elizabeth*, 4 Fish. 189.

An injunction is a proper remedy, because the supposed offence being constantly repeated, the causes of action and the multiplicity of suits would probably become much extended, and the relief at law prove very defective. It is useful as a bill of peace. *Orr v. Littlefield*, 1 W. & M. 13; s. c. 2 Robb 331.

If there appears from the affidavits such a repugnancy in point of fact as makes it necessary to decide on the relative truth of their conflicting statements or the credibility of the witnesses, no prudent judge will undertake so dangerous an inquiry in the first stage of the cause. The great object is to look for that full information which will lead his mind to a certainty as to all material facts, for doubt or uncertainty is fatal to the motion. *Cooper v. Mattheys*, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413.

In applying for an injunction, the patentee seeks either to interrupt the course of the common law, or to obtain some relief which he can not have at law. He must consequently state and make out a case for equitable relief, on such facts as bring his case within the jurisdiction of courts of equity and proper for its exercise. Hence, if he fails to satisfy the conscience of the chancellor affirmatively, he has no case before him, for the doubt or uncertainty as to facts is of the same effect on a motion as their non-existence. *Cooper v. Mattheys*, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413; *American Pavement Co. v. Elizabeth*, 4 Fish. 189; *Fales v. Wentworth*, 5 Fish. 302; s. c. 1 Holmes 96; 2 O. G. 58; *Gutta Percha Co. v. Goodyear Rubber Co.*, 3 Saw. 542.

If the defendant does not set up his patent in his answer, the fact that he has one will not prevent the granting of a preliminary injunction. *Zinn v. Weiss*, 7 Fed. Rep. 914.

Where a subsequent patent set up by the defendant contains in itself satisfactory evidence on its face, when read by experts, that its process involves an infringement of a prior patent, a provisional injunction will be granted. *Goodyear Dental Co. v. Evans*, 3 Fish. 390; s. c. 6 Blatch. 121.

If the patentee is able and willing to supply the market, an injunction will be granted, although the defendant is willing to accept a license. *Baldwin v. Schultz*, 5 Fish. 75; s. c. 9 Blatch. 494; 2 O. G. 315.

The remedy by injunction in patent cases is given by courts of equity, on account of the insufficiency of that given by a court of law. It is in its nature preventive, where irreparable mischiefs are apprehended, or when the patentee is likely to be vexed with a multiplicity of suits. *Battin v. Silliman*, 3 Wall. Jr. 124.

If the proof is insufficient, an injunction may be withheld until the complainant satisfactorily establishes the acquiescence of the public, and explains any apparent laches on his part. *Sykes v. Manhattan Co.*, 6 Blatch. 496.

If the questions to be decided are difficult and complicated, especially if they involve disputed facts which have never been passed on by a court or jury, then, although the court may be inclined to think the complainant is right, yet it will not interfere, whether the questions relate to title or



infringement. There is, therefore, always an element of discretion entering into the consideration of this question, and all that a complainant is entitled to is the best judgment of the court upon a question of judicial discretion, and not absolutely to an injunction on any given state of facts. *Potter v. Whitney*, 3 Fish. 77; s. c. 1 Lowell 87; *Jones v. Osgood*, 3 Fish. 591; s. c. 6 Blatch. 435; *Beane v. Orr*, 9 O. G. 255; s. c. 2 Ban & Ard. 176; *Tilghman v. Hartwell*, 1 W. N. 52; *Day v. Candee*, 3 Fish. 9; *Goodyear v. Hills*, 3 Fish. 134; *Wells v. Jacques*, 5 Fish. 136.

If the patentee has stood by for many years without complaint or demand of compensation, this is conclusive proof that a continuance of a use of his invention for a few weeks or even months longer, if paid for in the end, will not be an injury of such an irreparable nature as to require the sharp and hasty remedy of an injunction. *Parker v. Sears*, 1 Fish. 93; *Jones v. Merrill*, 8 O. G. 401; *Cooper v. Mattheys*, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413; *North v. Kershaw*, 4 Blatch. 70; *Whitney v. Rollstone Machine Works*, 8 O. G. 908; s. c. 2 Ban & Ard. 170; *Goodyear v. Honsinger*, 3 Fish. 147; s. c. 2 Biss. 1; *Morris v. Lowell Manuf. Co.*, 8 Fish. 67; *Spring v. Domestic S. M. Co.*, 16 O. G. 721; s. c. 4 Ban & Ard. 427; *United Nickel Co. v. New H. S. M. Co.*, 24 O. G. 1177; *Ballou Shoe Manuf. Co. v. Dizer*, 5 Ban & Ard. 540.

Laches in applying for an injunction can not be imputed to a patentee unless he knows or has the means of knowing that there is an infringement. *Wortendyke v. White*, 2 Ban & Ard. 25.

Mere forbearance to sue after notice given by the complainant to the defendant to cease infringing the patent does not in the absence of any affirmative encouragement affect the right to a preliminary injunction. *Collignon v. Hayes*, 20 O. G. 447; s. c. 8 Fed. Rep. 912.

The laches of the complainant in permitting the defendant, with his knowledge, to use the patented article, is ground for refusing a preliminary injunction. *Hockholzer v. Eager*, 2 Saw. 361; *Sloat v. Plympton*, 2 Whart. Dig. 365; *Sperry v. Ribbons*, 3 Ban & Ard. 260.

A patentee can not be charged with acquiescence because he proceeded first against that which was a more palpable and obvious violation of his right, or because he did not bring suit against all the machines which infringed upon it. *Van Hook v. Pendleton*, 1 Blatch. 187; *Green v. French*, 16 O. G. 215; s. c. 4 Ban & Ard. 169; *McWilliams Manuf. Co. v. Blundell*, 22 O. G. 177; s. c. 11 Fed. Rep. 419.

A delay of three months after the discovery of the infringement before filing a bill is no ground for refusing an injunction where the defendant has not been induced to change his position. *Union Paper Bag Co. v. Binney*, 5 Fish. 166.

If the complainant has acquiesced in the manufacture of the thing patented by the defendant, with an understanding that the compensation should ultimately be fixed by agreement, and the defendant is ready to pay such compensation as the court may allow, the defendant will be permitted to complete his existing contracts. *Smith v. Sharp's Rifle Co.*, 3 Blatch. 545.

The fact that the patent is about to expire is no ground for refusing a preliminary injunction, if the patentee has been involved in continuous litigation. *Rumford Chemical Works v. Vice*, 11 O. G. 600; s. c. 14 Blatch. 179.

An irregularity in the service of the subpoena is no reason for withholding an injunction against a defendant who has notice of the motion and appears to oppose it. *Thayer v. Wales*, 5 Fish. 130; s. c. 9 Blatch. 170.

If notes are received as the consideration for a license, with a stipulation that if they or either of them are not paid as they fall due, then the license shall be void, the license is forfeited the moment one of the notes becomes due and is not paid, and it is optional with the patentee to resort to his remedy at common law to enforce the collection of the notes or to treat the right of the licensee as forfeited under the stipulation, and obtain an injunction against the licensee. *Woodworth v. Weed*, 1 Blatch. 165; *Abbett v. Zusi*, 5 Ban & Ard. 38.

The fact that the complainant grants licenses at a fixed sum, and that the defendant is not a maker and vendor, but only one who uses the machine, is a circumstance to be taken into account, but is not a sufficient reason for refusing the writ, excepting in combination with other circumstances, either of doubt as to title or of hardship in the operation of the injunction. *Howe v. Newton*, 2 Fish. 531; *Furbush v. Bradford*, 1 Fish. 317; s. c. 21 Law Rep. 471; *Potter v. Schenck*, 1 Biss. 515; s. c. 3 Fish. 82; *Morris v. Lowell Manuf. Co.*, 3 Fish. 67; *vide Livingston v. Jones*, 2 Fish. 207; s. c. 3 Wall. Jr. 330; *Batten v. Silliman*, 3 Wall. Jr. 124; *McMillan v. Conrad*, 16 Fed. Rep. 128; *Hoe v. Boston D. A. Corporation*, 23 O. G. 1124; s. c. 14 Fed. Rep. 914.

Where the patentee seeks his profit solely by means of a royalty, a preliminary injunction will not be granted, if the defendant will pay the royalty into court to abide the event of the suit. *Blake v. Greenwood Cemetery*, 13 O. G. 1046; s. c. 14 Blatch. 342; s. c. 3 Ban & Ard. 112.

Although the defendant has not paid the royalty under his license, yet a preliminary injunction will not be granted if the patentee has violated his agreement by granting licenses to others at lower rates. *Crowell v. Parmenter*, 18 O. G. 360; s. c. 3 Ban & Ard. 480.

When a license is granted to any one to use a patent, which license is accompanied with an obligation in favor of the patentee, on the part of the one to whom it is granted, to do or not to do a particular thing, and which obligation is the consideration upon which the license is granted, he upon whom the obligation rests must perform it, and if he will not perform it an injunction will be granted to restrain him from any further right to use the patent under license. *Goodyear v. Congress Rubber Co.*, 3 Blatch. 449.

A party who has a contract for the exclusive right to sell the thing patented is entitled to a preliminary injunction against the patentee, although the latter claims that the contract was obtained by fraud. *Godard v. Wild*, 17 Fed. Rep. 845.



A preliminary injunction may be granted for the violation of a valid claim in a reissue, although a disclaimer of the void claims was not filed before the suit was brought. *Duff v. Calkins*, 25 O. G. 601.

A preliminary injunction may be issued against the purchaser of an article, although an interlocutory decree for an account has been entered against the manufacturer. *Tucker v. Burditt*, 4 Ban & Ard. 569.

If the defendant withdraws his opposition to a motion for a preliminary injunction before it is decided, no decision will be given on the merits, although the case was fully argued. *American M. P. Co. v. Vail*, 15 Blatch. 315; s. c. 4 Ban & Ard. 1.

If the motion for a preliminary injunction is denied upon defects then pointed out, it can not be renewed on papers designed to cure those defects, after the defendant has closed his proofs for final hearing. *Wooster v. Howe Machine Co.*, 16 O. G. 314; s. c. 4 Ban & Ard. 319.

### **Dissolution of Injunction.**

The filing of an answer denying under oath the legal title of the complainant is not sufficient to dissolve an injunction already specially granted on a hearing. The presumptions arising from the answer may be disproved by evidence on the part of the complainant, and then counter testimony is admissible on the part of the respondent to sustain his answer. After this it becomes the duty of the court to balance these allegations and proofs, and decide how the weight of them is, and whether in the exercise of a sound discretion on them the injunction ought to be dissolved or not. *Woodworth v. Rogers*, 3 W. & M. 135; s. c. 2 Robb 625; *Orr v. Merrill*, 1 W. & M. 376; s. c. 2 Robb 331.

If the defendant on a motion to dissolve an injunction produces evidence on matters not involved in the original motion for an injunction sufficient to throw a doubt over the question of the novelty of the invention, the injunction will be dissolved. *Young v. Lippman*, 5 Fish. 230; s. c. 9 Blatch. 277; 2 O. G. 249.

The motion to dissolve an injunction must be denied unless the proofs overcome the equity of the bill and the evidence supporting it. *Sparkman v. Higgins*, 1 Blatch. 205.

The presumption is that an injunction which was granted after a hearing was rightly issued. The burden is on the defendant on a motion for a dissolution to overcome that presumption. It is open to be overcome by new matter or evidence arising since the injunction was imposed, though very seldom by matter then existing which the party neglected to present to the consideration of the court. *Woodworth v. Rogers*, 3 W. & M. 135; s. c. 2 Robb 625; *Hussey v. Whiteley*, 2 Fish. 120; s. c. 1 Bond 407.

If the issue and facts involved in a motion for a dissolution before the district judge are substantially those submitted to and passed upon by the circuit judge in granting the injunction, it will be improper to order its dissolution. It would be wrong in a district judge to review or set aside the action of the circuit judge—at least the reasons that would justify such

a course must be peculiar and stringent. *Hussey v. Whiteley*, 5 Fish. 120; s. c. 1 Bond 407.

The continuance or dissolution of an injunction is entirely within the sound discretion of the court. If the court considers the right of the patentee doubtful, it is not simply on that ground required to dissolve the injunction. Other circumstances must be considered. *Orr v. Badger*, 7 Law Rep. 465; *Perry v. Littlefield*, 5 Ban & Ard. 334.

If the patent would be sustained on the final hearing upon the facts as they appear on the motion, the injunction will not be dissolved. *Richardson v. Croft*, 11 Fed. Rep. 800; *Bassett v. Malone*, 11 Fed. Rep. 801.

If the answer does not properly set up a public use for more than two years before the application for the patent, and the time for taking proofs for final hearing has expired, an application to dissolve a preliminary injunction on account of such prior use will not be entertained. *Union Paper Bag Co. v. Newell*, 11 Blatch. 549; s. c. 5 O. G. 173; s. c. 1 Ban & Ard. 113.

If the complainant during the pendency of the suit assigns all his interest in the patent to another, the injunction must be dissolved. *Kinsman v. Parkhurst*, 1 Blatch. 488; s. c. 18 How. 289.

An injunction already granted may be dissolved upon the defendant's filing a bond to secure the payment of such sum as may be awarded by the final decree. *Wilson v. Barnum*, 2 Fish. 635; s. c. 1 Wall. Jr. 347; 8 How. 258; s. c. 2 Robb 749.

The court may direct that an injunction shall be dissolved unless the complainant shall file a bond to indemnify the defendant. *Wilson v. Barnum*, 2 Fish. 635; s. c. 1 Wall. Jr. 347; 8 How. 258; s. c. 2 Robb 749.

If the patentee recovers a decree against the vendor and levies on his property, he cannot have an injunction against the vendee while the levy remains. *Steam Stone Cutter Co. v. Sheldon*, 15 Fed. Rep. 608.

### **Final Injunction.**

An injunction is either provisional or perpetual. The first is either common or special,—common being such as is granted upon the defendant's default, either in appearing or answering, and is only applicable to restrain proceedings at law, and special being such as is granted upon the special grounds arising out of the circumstances of the case. Special injunctions are issued sometimes on the merits disclosed by the answer, sometimes on affidavits before the answer is filed, and sometimes even without notice and before the defendant has appeared. A perpetual injunction is a part of the decree made at the hearing upon the merits, whereby the defendant is perpetually inhibited from the assertion of a right, or perpetually restrained from the commission of an act which would be contrary to equity and good conscience. *Motte v. Bennett*, 2 Fish. 642.



The provisions of this section in no manner import that the foundation of the jurisdiction of the court rests on its authority to grant an injunction. On the contrary the language employed would seem to indicate that Congress, for greater caution, made the power to grant injunctions explicit and positive; perhaps to avoid an inference that the process of injunction, being merely a mode of relief in equity, could only issue in cases which under the general practice of courts of equity were brought up specifically by injunction bills. *Nevins v. Johnson*, 3 Blatch. 80.

If the court has jurisdiction of the person of the defendant it may restrain him, although the construction and use of the thing patented take place beyond the jurisdiction of the court. *Boyd v. McAlpin*, 3 McLean 427; s. c. 2 Robb 277; *Wilson v. Sherman*, 1 Blatch. 536; *Thompson v. Mendelsohn*, 5 Fish. 187; s. c. 8 Phila. 166; *Wheeler v. McCormick*, 4 Fish. 433; s. c. 8 Blatch. 267.

No injunction can be issued at the instance of a patentee to restrain a junior patentee from bringing suits on his patent before the patent is declared invalid. *Asbestos Felting Co. v. U. S. & F. Felting Co.*, 13 Blatch. 453; s. c. 10 O. G. 828; s. c. 2 Ban & Ard. 369.

The circuit court has no jurisdiction to restrain the complainant from prosecuting other suits against parties who purchased the thing patented from the defendant, although a decree has been entered requiring the defendant to account for profits arising from the sales thereof. *Rumford Chemical Works v. Hecker*, 11 Blatch. 552; s. c. 5 O. G. 644; s. c. 1 Ban & Ard. 120.

An injunction may be granted at the final hearing, although there has been no trial at law or motion for a preliminary injunction. *Buchanan v. Howland*, 2 Fish. 341; s. c. 5 Blatch. 151; *Dougherty v. West*, 2 Fish. 553; *Motte v. Bennett*, 2 Fish. 642; *Hoffheins v. Brandt*, 3 Fish. 218.

There is no adequate remedy at law, for the law does not give a complete remedy to those whose property is invaded. If each infringement were to be made a distinct cause of action, the remedy would be worse than the evil, for the inventor might be ruined by the necessity of perpetual litigation without ever being able to have a final establishment of his right. In addition to this consideration, the patentee could have no preventive at law to restrain the future use of his invention injuriously to his title and interests. *Motte v. Bennett*, 2 Fish. 642.

The granting or refusal of an injunction rests in the sound discretion of the court. A rash or indiscreet exercise of this power may be very oppressive, of no use to the complainant and ruinous to the defendant. As a remedy it should be administered only for prevention or protection. Where it is not necessary for these purposes it is merely vindictive, injuring one party without benefit to the other. To issue an injunction in a case where neither prevention nor protection is sought or required, but only compensation, would be an abuse of power. *Sanders v. Logan*, 2 Fish. 167.

If there is no estoppel, an injunction is a matter of right where a legal title is to be vindicated. *Merriam v. Smith*, 11 Fed. Rep. 588.

If the defendant has been guilty of an infringement, an injunction will be awarded, although the defendant no longer infringes. *Bullock Printing Press Co. v. Jones*, 13 O. G. 124; s. c. 3 Ban & Ard. 195.

An injunction may be granted restraining the sale of infringing machines made during the term of the patent, although the patent has since expired. *American D. R. B. Co. v. Sheldon*, 18 Blatch. 50; s. c. 5 Ban & Ard. 292; s. c. 1 Fed. Rep. 870; *American D. R. B. Co. v. Rutland M. Co.*, 18 Blatch. 147; s. c. 5 Ban & Ard. 346; 2 Fed. Rep. 356.

Although a party has the exclusive right to use the class of articles to which the invention pertains in a certain place, yet he may be enjoined from using the thing patented. *Colgate v. Inter-Ocean Tel. Co.*, 17 O. G. 194; s. c. 17 Blatch. 308; s. c. 4 Ban & Ard. 609.

If the inventor did not know that others were making any advancements or investments of either capital or skill on the faith that the ground he had begun to occupy was open to all, he is not estopped from setting up his invention. *Sprague v. Adriance*, 14 O. G. 308; s. c. 3 Ban & Ard. 124.

An experimental use is a technical infringement sufficient to authorize an injunction, but not sufficient to authorize a reference to ascertain damages. *Albright v. Celluloid H. T. Co.*, 12 O. G. 227; s. c. 2 Ban & Ard. 629.

An injunction may be granted although the defendant in selling the article merely acted as a salesman for the owner. *Maltby v. Bobo*, 14 Blatch. 53; s. c. 2 Ban & Ard. 459.

If the complainant has accepted a certain compensation for the use of the thing patented, reserving his right to an additional sum, an injunction will not be granted, for the use is not unlawful. *Blanchard v. Sprague*, 1 Cliff. 288.

Where the complainant makes an assignment after the granting of an injunction, and then files an amended bill, the defendant, after answering the amended bill without taking exception on account of the assignment, can not have the injunction dissolved on that ground. *T. & P. Salt Co. v. Barry*, 2 W. N. 100.

If the patentee assigns his patent while the bill is pending, an injunction will not be granted. *Boomer v. Power Co.*, 13 Blatch. 107; s. c. 2 Ban & Ard. 107; *Wheeler v. McCormick*, 6 Fish. 551; s. c. 11 Blatch. 334; 4 O. G. 692.

If it appears that an improvement is not materially useful, and has only been used to a limited extent, an injunction is not the appropriate remedy. *Lowell Manuf. Co. v. Carpet Co.*, 2 Fish. 472.

A person who owns one patent may be enjoined from putting on articles made by him marks indicating that they are made under another patent. *W. & M. Manuf. Co. v. Haish*, 18 O. G. 465.

A person who puts on articles made by him marks indicating that they are made under a patent, can not set up the invalidity of the patent to defeat the injunction. *W. & M. Manuf. Co. v. Haish*, 18 O. G. 465.

If a patentee makes a contract giving another the exclusive right to sell



the thing patented, he may be enjoined from selling. *Goddard v. Wilde*, 17 Fed. Rep. 845.

If a carrier refuses to disclose the names of the persons who deliver infringing articles to him for transportation, he may be enjoined from receiving the articles. *Am. Cotton Tie Co. v. McCrady*, 17 O. G. 565; s. c. 17 Blatch. 291; s. c. 4 Ban & Ard. 388.

When a party obtains a decree settling the right to an injunction in respect to the matter in controversy, the practice is to make the injunction a part of the decree. That is the right of the party, unless some special grounds of hardship to the defendant are shown. *Potter v. Mack*, 3 Fish. 428; *Rumford Chemical Works v. Hecker*, 11 O. G. 330; s. c. 2 Ban & Ard. 386.

The court has the power to suspend the injunction until the account shall be determined upon and the decree finally made upon that account. Such power exists as incidental to equity proceedings. *Potter v. Mack*, 3 Fish. 428.

If a reasonable doubt exists in the mind of the court as to its decision upon the merits, or if there is any reason to suppose that the injunction has been indiscreetly granted, the defendant may be allowed to continue to use his machine under proper security until the coming in of the master's report; but if the court is fully satisfied with its decision, such permission will not be granted. *Mowry v. Whitney*, 3 Fish. 157; s. c. 4 Fish. 141, 207; 5 Fish. 496; 14 Wall. 620; 2 Bond 45; s. c. 1 O. G. 492; *Barnard v. Gibson*, 7 How. 650; *Heysinger v. Dennison Manuf. Co.*, 39 Leg. Int. 452.

An injunction will not be suspended to allow the defendant to change his machine so as to avoid an infringement, unless there is proof of the probability of success. *Macauley v. White S. M. Co.*, 21 O. G. 204.

An interlocutory decree will not be suspended until the final decree upon the defendant's giving bond, although the patent is about to expire. *Brown v. Deere*, 19 O. G. 1217; s. c. 6 Fed. Rep. 487.

If the complainant brings money into court in compliance with the terms imposed upon him by the court, as a condition for granting an injunction to restrain the defendant from declaring a forfeiture of the license, the defendant thereby acquires an equitable lien upon the fund, and in case the bill is dismissed for want of jurisdiction, the court will make no order disposing of the money until the right between the parties is determined in some appropriate proceeding either at law or in equity. *Florence Machine Co. v. Singer Co.*, 4 Fish. 348; s. c. 8 Blatch. 177.

### Practice.

An allegation of abandonment is an allegation in avoidance of the claim of the complainant, and the facts therein stated must be proved, and the burden of proof is upon the respondent. *Howe v. Williams*, 2 Fish. 395; s. c. 2 Cliff. 245.

The burden of proof rests upon the defendant to sustain averments in

the answer which are not responsive to the allegations of the bill. *Hoffheins v. Brandt*, 3 Fish. 218.

Something more must be produced than the evidence of a single witness, to overcome an answer under oath and responsive to the bill. *Woodworth v. Hall*, 1 W. & M. 248, 389; s. c. 2 Robb 495, 517; *Hovey v. Stevens*, 1 W. & M. 290; s. c. 2 Robb 479.

If the denial of the infringement in the answer is not positive, and the testimony of the witness is strongly corroborated by other facts and circumstances bearing on the question of infringement, the fact will be considered as established. *Goodyear v. Berry*, 3 Fish. 439; s. c. 1 Bond 189.

Documents can not be given in evidence after the argument of the case has commenced, as a matter of right, but only on terms to be imposed by the court. *Stainthorp v. Humiston*, 4 Fish. 107; *Knapp v. Shaw*, 23 O. G. 2236; s. c. 15 Fed. Rep. 115.

If it appears that the complainant has a meritorious cause of action upon the merits, it is competent for the court to allow additional proofs to obviate merely formal objections. *Goodyear v. Beverly Rubber Co.*, 1 Cliff. 348.

An appearance and the filing of an answer is a waiver of any irregularity in the service of a subpoena. *Goodyear v. Chaffee*, 3 Blatch. 268.

An assignment of the complainant's interest in the patent after the commencement of the suit will not affect his right to an account for the profits that accrued prior to the assignment. *Dean v. Mason*, 20 How. 198.

Exceptions to the general rule in the English chancery are binding on the Federal courts, as much as the rule itself. The exception constitutes the rule. *Brooks v. Bicknell*, 3 McLean 250; s. c. 2 Robb 118.

The rule of comity always observed by the Justices of the Supreme Court in cases which admit of being carried before the whole court, is to conform to the opinions of each other, if any have been given. *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206; *Putnam v. Yerringer*, 9 O. G. 689; s. c. 2 Ban & Ard. 237; *Goodyear v. Providence Rubber Co.*, 2 Fish. 499; s. c. 2 Cliff. 351; 9 Wall. 788; *Rumford Chemical Works v. Hecker*, 10 O. G. 289; s. c. 2 Ban & Ard. 351; *Goodyear D. V. Co. v. Willis*, 7 O. G. 41; s. c. 1 Flippin 385; s. c. 1 Ban & Ard. 568; *Hammerschlag v. Garrett*, 9 Fed. Rep. 43; s. c. 38 Leg. Int. 276; *American B. L. Co. v. Cotter*, 21 O. G. 1030; s. c. 11 Fed. Rep. 728; *Strobridge v. Landers*, 21 O. G. 1027; s. c. 11 Fed. Rep. 880; *Scarles v. Worden*, 21 O. G. 1955; s. c. 11 Fed. Rep. 501.

This rule of comity has no application, either by its terms or the reason on which it is founded, to motions for injunctions where error may be followed by irremediable mischief. *Many v. Sizer*, 1 Fish. 31; *Cornell v. Littlejohn*, 9 O. G. 837, 932; s. c. 2 Ban & Ard. 324; *Potter v. Whitney*, 3 Fish. 77; s. c. 1 Lowell 87; *Sargent Manuf. Co. v. Woodruff*, 5 Biss. 444.

A decision of a circuit judge will be taken to be the law of the circuit until either a state of facts is proved which will present a different case, or until the conclusion of law upon the facts is overruled by the Supreme Court. *McCloskey v. Hamill*, 22 O. G. 2122; s. c. 15 Fed. Rep. 750.



If the defendant desires to test the prior adjudication in the Supreme Court, and complainant refuses to stipulate that the proofs taken in another case may be filed in the one pending, the rule will not be followed in granting a preliminary injunction. *Goodyear D. V. Co. v. Willis*, 7 O. G. 41; s. c. 1 Flippin 385; s. c. 1 Ban & Ard. 315.

If the record presents a different state of facts, the decision in another circuit will not be followed. *G. & B. Manuf. Co. v. Walworth*, 9 O. G. 746.

If the court as a matter of comity declines to adjudge the question of novelty on certain claims, in view of the adjudication of a co-ordinate court, the decree should so state. *Rumford Chemical Works v. Hecker*, 11 O. G. 330; s. c. 2 Ban & Ard. 386.

A decision not upon pleadings and proofs, but a decision or opinion on a motion for an injunction, can be hardly claimed to settle a question. *Florence Co. v. Singer Co.*, 4 Fish. 329; s. c. 8 Blatch. 113.

A decision by the Supreme Court as to the validity of a patent and the infringement thereof is conclusive in another case, unless the two cases can be distinguished. *Richardson v. Lockwood*, 4 Cliff. 128.

The circuit court has no authority to rescind a rule adopted by the Supreme Court for the government of its practice in chancery. *Jenkins v. Greenwald*, 2 Fish. 37; s. c. 1 Bond 126.

The examination of the defendant as a witness by the complainant is not a waiver of the right to the decree against him. *Jenkins v. Greenwald*, 2 Fish. 37; s. c. 1 Bond 126.

A party who purchases from the defendant *pendente lite*, and with actual notice of the suit, is bound by the same equities as the defendant. *Kinsman v. Parkhurst*, 18 How. 289; s. c. 1 Blatch. 488.

If an assignment is made *pendente lite*, the circuit court may protect the right of the real owners to the fruits of the recovery as against those who are merely nominal owners. *Campbell v. James*, 2 Fed. Rep. 338; 18 O. G. 1111; s. c. 18 Blatch. 92; s. c. 5 Ban & Ard. 354.

Under the prayer for general relief, the court may award damages to the complainant. *Emerson v. Simm*, 6 Fish. 281; s. c. 3 O. G. 293.

If a complainant files a bill for an alleged infringement which took place after the filing of the first bill, he will not be compelled to elect between the two proceedings, but on the motion of the defendant he may be required to enter into a stipulation that the testimony taken in one case, so far as it is relevant, may be used in the other, and that both cases shall be set down for hearing at the same time. *Turrell v. Spaeth*, 9 O. G. 1163; s. c. 2 Ban & Ard. 315.

The court will not so far take notice of parol agreements of counsel made or alleged to be made out of court, as to undertake, when there is a conflict of opinion between the respective counsel as to the terms of the agreement or a difference of recollection as to its existence or meaning, to decide the question of comparative accuracy of recollection or construction. *American Saddle Co. v. Hogg*, 6 Fish. 67; s. c. 1 Holmes 177; 2 O. G. 595.

If the complainant threatens to institute an action against parties who have purchased from the defendant, the court, on cross-petition, may enjoin the complainant from bringing any suit against any vendee of the defendant, based upon a user which may become the subject of account in the case. *Birdsell v. Hagerstown Co.*, 11 O. G. 641; s. c. 1 Hughes 64; *Allis v. Stowell*, 16 Fed. Rep. 783.

A suit against a purchaser will not be restrained while a suit is pending against the manufacturer, unless the devices involved in the two suits are the same. *Allis v. Stowell*, 16 Fed. Rep. 783.

The mere entry of an interlocutory decree for an account will not bar an action against a party who purchased from the defendant. *Gilbert & Barker Manuf. Co. v. Bussing*, 12 Blatch. 426; s. c. 8 O. G. 144; s. c. 1 Ban & Ard. 621.

A patentee can not take compensation for an infringement, including manufacture, sale and use, and thereafter enjoin a purchaser from the use for which he has taken compensation. *Gilbert & Barker Manuf. Co. v. Bussing*, 12 Blatch. 426; s. c. 8 O. G. 144; s. c. 1 Ban & Ard. 621.

The equitable liability of an infringer is not determined by his death, and a bill of revivor against his personal representatives will lie to prevent the abatement of the suit brought in his lifetime to enforce it. *Smith v. Baker*, 5 O. G. 496; s. c. 1 Ban & Ard. 117; s. c. 19 I. R. R. 149; *Atterbury v. Gill*, 13 O. G. 276; s. c. 2 Flippin 239; s. c. 3 Ban & Ard. 174.

Before a decree the inquiry is as to the fact of infringement. The extent of the infringement arises upon a reference for an account after a decree. *Turrell v. Spaeth*, 8 O. G. 986; s. c. 2 Ban & Ard. 185.

If a suit is brought for an infringement of a patent, the circuit court has jurisdiction to determine all questions concerning the title to the patent as between the parties complainant. *Campbell v. James*, 18 O. G. 1111; s. c. 18 Blatch. 92; s. c. 5 Ban & Ard. 354; s. c. 2 Fed. Rep. 338.

The proof must show an infringement prior to the filing of the bill. *Slessinger v. Buckingham*, 8 Saw. 469.

If a suit is pending to annul a prior patent, the bill may be retained until that prior suit is determined. *Lockwood v. Cutter Tower Co.*, 11 Fed. Rep. 724.

The fruits of the decree will be awarded to those who are the real owners of the patent, although their rights have been acquired since the commencement of the suit. *Campbell v. James*, 18 O. G. 1111; s. c. 18 Blatch. 92; s. c. 5 Ban & Ard. 354; s. c. 2 Fed. Rep. 338.

No notice can be taken of the action of the circuit court upon a motion for a new trial upon a verdict rendered upon issues sent to a court of law, unless the evidence is reported with the verdict. *Watt v. Starke*, 101 U. S. 247; s. c. 17 O. G. 1093.

### **Evidence.**

In an equity case the judge may examine the model if it is put in evidence, and form a judgment upon its novelty. *Everett v. Thacher*, 16 O. G. 1046; s. c. 2 Flippin 234; s. c. 3 Ban & Ard. 435; s. c. 7 A. L. Rec. 197.



Hearsay evidence will be considered if no objection to it is made on the record. *Fischer v. Neil*, 19 O. G. 603 ; s. c. 6 Fed. Rep. 89.

If no objection is taken either before the examiner or at the hearing to evidence of a prior invention on the ground that no sufficient notice thereof has been given, this is a waiver of the notice. *Roemer v. Simon*, 95 U. S. 214 ; s. c. 12 O. G. 796 ; s. c. 1 Ban & Ard. 138 ; *Loom Co. v. Higgins*, 21 O. G. 2031 ; 105 U. S. 580 ; s. c. 16 O. G. 675 ; s. c. 15 Blatch. 446 ; s. c. 4 Ban & Ard. 88 ; *Roemer v. Simm*, 5 O. G. 555 ; s. c. 12 O. G. 796 ; s. c. 95 U. S. 214 ; s. c. 1 Ban & Ard. 138 ; s. c. 2 Ban & Ard. 72 ; *Crouch v. Speer*, 6 O. G. 187 ; s. c. 1 Ban & Ard. 145 ; *Barker v. Shoots*, 20 Blatch. 178.

If objection is properly made to the testimony of a witness who is not produced until all the evidence on both sides is closed, his testimony can not be considered, although his name was mentioned in the notice. *Crouch v. Speer*, 6 O. G. 187 ; s. c. 1 Ban & Ard. 145.

If an objection is taken on the record, no testimony taken after the lapse of the time fixed by the rule can be read. *Wooster v. Clark*, 21 O. G. 264 ; s. c. 9 Fed. Rep. 854.

Although evidence is not taken within the time prescribed by the rule, yet it will be considered unless there is a motion to suppress it. *Matthews v. Spangenberg*, 23 O. G. 92.

An objection before the commissioner to the examination of a witness must state specifically the ground of the objection in order that the opposite party may have the opportunity of removing it if possible. *Planing Machine Co. v. Keith*, 101 U. S. 479 ; s. c. 17 O. G. 1031 ; s. c. 4 Ban & Ard. 100.

If the respondent in his answer set up the defence that the patentee was not the first and original inventor of the thing patented, and gave the names and residences of some witnesses and prayed leave to insert the names and residences of others if any should be discovered, the answer may be amended at the hearing *nunc pro tunc* by inserting the names and residences of witnesses whose evidence has been taken before the examiner. *Roemer v. Simon*, 12 O. G. 796 ; s. c. 95 U. S. 220 ; s. c. 1 Ban & Ard. 138.

An objection in general terms to the testimony of a witness who testifies to knowledge of the prior use of a machine is not sufficient, although he is not named in the answer, for an objection of that kind is waived unless it is distinctly made. *Barker v. Stowe*, 14 O. G. 559 ; s. c. 15 Blatch. 49 ; s. c. 3 Ban & Ard. 337.

If evidence is competent to show the state of the art at the time of the invention, then an omission to object to it at the time when it is taken is not a waiver of the objection that it is not competent to show a want of novelty where no such defence is pleaded. *Zane v. Soffe*, 5 Ban & Ard. 284 ; s. c. 2 Fed. Rep. 229.

Although the testimony to show a prior knowledge of the machine was taken before the defence was set up in the answer, yet if the witnesses were cross-examined the testimony may be allowed to stand. *Allis v. Buckstaff*, 22 O. G. 1705 ; s. c. 13 Fed. Rep. 379.

If an answer does not explicitly deny an infringement, then proof that the defendant had a machine is sufficient evidence that he used it. *Gear v. Fitch*, 3 Ban & Ard. 573; s. c. 16 O. G. 1231.

If the complainant calls the defendant as his witness, he can not compel him to disclose the names of more than one person to whom he has sold the article alleged to be an infringement. *Roberts v. Walley*, 14 Fed. Rep. 167.

If the complainant on examination before the master testifies to the cost of making the article, the defendant may require him to produce his books. *Wisner v. Dodds*, 14 Fed. Rep. 655.

Evidence which should be taken in chief can not be taken in rebuttal. *Barker v. Shoots*, 20 Blatch. 178.

### **License.**

Even if a contract to refrain from the manufacture of a patented article can not be enforced, as being against public policy, this will afford no answer to a claim for an account of profits actually realized by prosecuting the business, there being no connection between the illegal stipulation and the profits of the business. *Kinsman v. Parkhurst*, 18 How. 289; s. c. 1 Blatch. 488.

The purchase of a license does not estop the licensee from denying the validity of the patent, in order to protect his right to use a machine not embraced by the license. The recitals in a deed can estop no one but parties or privies who are claiming under or against it, and in the controversy founded on its covenants. If such machine should be challenged as an infringement of the patent, he has the right to defend himself by any plea that any other person might use. *Burr v. Duryee*, 2 Fish. 275; s. c. 1 Wall. 531.

Where a contract has been violated in its essential terms, or has been made impossible of execution, equity will relieve if it can do so without prejudice, but it never enforces anything in the nature of a forfeiture, whether stipulated in the contract or implied from circumstances. *Morse v. O'Reilly*, 6 Penn. L. J. 501.

Equity may relieve against a forfeiture; it never inflicts one. If the licensee infringes the patent without violating his contract, an injunction will not be granted restraining him from all use of the patent. *Burr v. Duryee*, 2 Fish. 275; s. c. 1 Wall. 531; *Wilson v. Sherman*, 1 Blatch. 536.

If a licensee fails to comply with the condition on which the license depends, he may be enjoined as an infringer. *Woodworth v. Cook*, 2 Blatch. 151; *Wilson v. Sherman*, 1 Blatch. 536; *Day v. Hartshorn*, 3 Fish. 32; *Cohn v. Nat'l Rubber Co.*, 15 O. G. 829; s. c. 3 Ban & Ard. 568; *contra*, *Morse v. O'Reilly*, 6 Penn. L. J. 501.

An infringement by a licensee who fails to perform the conditions of his license is different from an ordinary infringement where no contract has been made by the parties. In the latter case an absolute injunction is



the only adequate relief; but in the former, if the use goes beyond the conditions, there is an infringement which must stand upon the general ground unaffected by the contract, and as to such use the injunction should be absolute. If the defendant has failed to comply with the conditions of the license, an injunction will be granted unless he conforms to them. A court of chancery will not decree the cancellation of a contract, except for fraud or mistake, or grant an injunction which will have that effect. *Brooks v. Stolley*, 3 McLean 523; s. c. 2 Robb 281.

An unpaid royalty due from the licensee to the patentee affords no ground for enjoining an assignee of the license who has paid the royalty that has accrued since the assignment. *Goodyear v. Congress Rubber Co.*, 3 Blatch. 449.

The recovery of a judgment for the arrears of royalty does not preclude the patentee from enforcing the forfeiture of the license for non-payment, for he may resort to either or both remedies. *Armstrong v. Hanlenbeck*, 3 N. Y. Leg. Obs. 43.

If a party repudiates a license for the purpose of contesting the validity of the patent, he can not set it up again when the patent is sustained. *Moody v. Taber*, 1 Holmes 325; s. c. 5 O. G. 273; s. c. 1 Ban & Ard. 41; *Cohn v. Nat'l Rubber Co.*, 15 O. G. 829; s. c. 3 Ban & Ard. 568.

If the defendant is dissatisfied with the terms of a license he should abandon it; but if he claims rights under it, he must conform to the conditions on which it was granted, even though he avers that he did not understand it and was overreached. *Brooks v. Stolley*, 3 McLean 523; s. c. 2 Robb 281.

A grant of an exclusive license to sell is to be enforced against the grantor so long as it lasts, whether the remainder of the contract is mutual or not, providing the whole contract, including the grant, is not so unequal as to be void in a court of equity. *Singer Manuf. Co. v. Union B. & E. Co.*, 6 Fish. 480; s. c. 1 Holmes 253; 4 O. G. 553.

If a patentee sells the thing patented in violation of the rights of a licensee, the latter may maintain a bill in equity against the purchaser and the patentee where the circuit court has jurisdiction on account of the residence of the parties, for the remedy at law is not as practical and efficient to the ends of justice and its prompt administration as the equitable remedy. *Hill v. Whitcomb*, 1 Holmes 317; s. c. 5 O. G. 430; s. c. 1 Ban & Ard. 34.

A licensee can not maintain a bill for an injunction and account against a patentee and a party who purchased a machine from him in violation of the license, for the purchaser is not an infringer. *Hill v. Whitcomb*, 1 Holmes 317; s. c. 5 O. G. 430; s. c. 1 Ban & Ard. 34.

A party can not secretly acquire the outstanding right of another, if any, and set it up against his joint owner in derogation of his rights under an agreement entered into with knowledge of this alleged title. *Kinsman v. Parkhurst*, 18 How. 289; s. c. 1 Blatch. 488.

**Attachment.**

On a motion for an attachment, affidavits to show that the patentee was not the first and original inventor of the thing patented are immaterial and irrelevant. That question was settled, so far as the injunction is concerned, when the writ was granted. *Whipple v. Hutchinson*, 4 Blatch. 190; *Woodworth v. Rogers*, 3 W. & M. 135; s. c. 2 Robb 625; *Liddle v. Cory*, 7 Blatch. 1.

On a motion for an attachment, the decree must be deemed conclusive of all questions fairly involved in the suit, and until it be set aside as determining beyond dispute the validity of the patent, and that the acts complained of in the suit were an infringement. *Liddle v. Cory*, 7 Blatch. 1; *Woodworth v. Rogers*, 3 W. & M. 135; s. c. 2 Robb 625; *Phillips v. Detroit*, 16 O. G. 627; s. c. 2 Flippin 92; s. c. 3 Ban & Ard. 150.

If the instrument is not of the same kind as that involved in the decree, and is covered by a patent, a strong and obvious case of infringement beyond all questions of mere colorable difference is necessary in order to render the party liable for contempt. *Buerk v. Imhauser*, 11 O. G. 112; s. c. 2 Ban & Ard. 465.

It is not enough to arrest a summary exercise of the power of the court that the proofs of the violation of the decree are conflicting, or that the thing used by the respondent is in some of its features different from the thing whose use is interdicted. The evidence must be carefully weighed, and as it establishes clearly or falls short of establishing a substantial transgression, it is the duty of the court to act or forbear to act accordingly. *Wetherill v. Zinc Co.*, 5 O. G. 460; s. c. 1 Ban & Ard. 105.

No attachment will be issued unless the violation of the injunction is plain and proved to the satisfaction of the court. *Birdsell v. Hagerstown Manuf. Co.*, 11 O. G. 420; s. c. 1 Hughes 59; s. c. 2 Ban & Ard. 519.

In a proceeding for an attachment for a violation of an injunction, the service of the writ claimed to have been disregarded should not be left in doubt. *Whipple v. Hutchinson*, 4 Blatch. 190.

The writ, as a general rule, ought to contain a concise description of the particular acts or things in respect to which the party is enjoined, so that there may be no misapprehension on the subject. *Whipple v. Hutchinson*, 4 Blatch. 190; *Goodyear v. Muller*, 3 Fish. 209; s. c. 5 Blatch. 429.

Where an injunction is issued restraining a party from using any part of a machine, he should take the judgment of the court whether he can leave off certain parts and use the rest, and not take it for granted that he will not thus violate the injunction. The true course is to move for a dissolution of the injunction, or ask for security from the complainant. *Hamilton v. Simons*, 5 Biss. 77.

A party who has been enjoined from infringing a patent can not work in the factory of another where the thing patented is an infringement. *Goodyear v. Muller*, 3 Fish. 209; s. c. 5 Blatch. 429.

A party who has been enjoined from infringing a patent can not sell



the thing patented as agent of another party. *Potter v. Muller*, 1 Bond 601.

The defendant, after the issuing of an injunction, may manufacture articles which do not infringe the patent. *Wire Railing Co. v. Walker*, 2 Fish. 179; *Byam v. Eddy*, 24 Vt. 666.

If the differences between the thing patented and the article made by the defendant are not merely colorable, but raise questions not before raised between the parties, the issues can not be decided on a motion for an attachment, but will be left to be tried in an action brought for that purpose. *Liddle v. Cory*, 7 Blatch. 1; *Putnam v. Hollender*, 11 Fed. Rep. 75; *Bate Refrig. Co. v. Eastman*, 11 Fed. Rep. 902.

If an injunction is granted against a corporation, it is binding upon the officer of a corporation who has notice of the writ and its contents whether he is personally served or not. *Phillips v. Detroit*, 16 O. G. 627; s. c. 2 Flippin 92; s. c. 3 Ban & Ard. 150.

If an injunction is issued against a corporation, all persons who act for it or in its behalf with notice of the writ or its contents may be attached for contempt whether they were actually served with it or not. *Phillips v. Detroit*, 16 O. G. 627; s. c. 2 Flippin 92; s. c. 3 Ban & Ard. 150.

If a person having charge of a public work permits the contractor to violate the patent after the granting of the injunction, and accepts the work, he is liable to attachment. *Phillips v. Detroit*, 16 O. G. 627; s. c. 2 Flippin 92; s. c. 3 Ban & Ard. 150.

If the president of a corporation which has been enjoined devises the plan for violating the injunction, he may be attached for contempt. *Wetherill v. Zinc Co.*, 5 O. G. 460; s. c. 1 Ban & Ard. 105.

If a machine which has been sold is returned after the injunction, the defendant may resell it if he returned the machine in the account of profits. *Allis v. Stowell*, 19 O. G. 727.

The mere sending of a machine to an agent is not a violation of an attachment. *McKay v. Scott S. S. M. Co.*, 20 O. G. 372.

A mere advertisement that a party makes the machine is not a violation of an injunction. *Allis v. Stowell*, 19 O. G. 727.

A party who sells machines which he is prohibited from selling is guilty of a contempt, although he does not sell or send them within the territorial jurisdiction of the court. *Macaulay v. White S. M. Co.*, 21 O. G. 496; s. c. 9 Fed. Rep. 698.

If an injunction permits a party to use, but prohibits a sale, a sale of an article that was in use at the time of the issue thereof is a violation of it. *Colgate v. G. & S. Tel. Co.*, 17 O. G. 193; s. c. 4 Ban & Ard. 559; *Colgate v. Western Union Tel. Co.*, 17 O. G. 194; s. c. 4 Ban & Ard. 562.

If the machine used by the defendant is not the same as that specified in the injunction, and is not a plainly colorable evasion of the injunction, the question whether it is an infringement or not will not be determined on a motion for an attachment. *Onderdonk v. Fanning*, 5 Ban & Ard. 431; s. c. 2 Fed. Rep. 568.

If a father and minor son are both employed in the same business, the

father may be held liable for a contempt if the minor son manufactures and sells articles which the father is enjoined from manufacturing and selling. *Dunks v. Grey*, 5 Ban & Ard. 635 ; s. c. 3 Fed. Rep. 862.

If a license, which is given as a part of a compromise which provides for a perpetual injunction, contains a power of revocation on certain contingencies, the injunction may be enforced by an attachment for contempt if the license is revoked. *Pentlarge v. Beesten*, 18 Blatch. 38 ; s. c. 5 Ban & Ard. 326 ; s. c. 1 Fed. Rep. 862.

If the defendant knows fully what he does when he manufactures an article in violation of an injunction, he is guilty of a contempt, although he does not think he is infringing or is advised that he is not. *Atlantic G. P. Co. v. Dittmar P. M. Co.*, 20 O. G. 1380 ; s. c. 9 Fed. Rep. 316.

The advice of counsel is no justification for a violation of an injunction, although it will be considered in imposing the fine. *Phillips v. Detroit*, 16 O. G. 627 ; s. c. 2 Flippin 92 ; s. c. 3 Ban & Ard. 150.

If the defendant lease the machine to one of the complainants, the acceptance of the lease is an equitable release of the defendant, and he will not be liable for contempt on account of such use. *Smith v. Patton*, 6 Penn. L. J. 189.

The court will not impose a fine equivalent to the royalty required by the patentee. *Phillips v. Detroit*, 16 O. G. 627 ; s. c. 2 Flippin 92 ; s. c. 3 Ban & Ard. 150.

If the violation of the injunction was not wilful, the defendant will be required merely to pay the profits or damages and costs. *Ready Roofing Co. v. Taylor*, 15 Blatch. 95 ; s. c. 3 Ban & Ard. 368 ; *Matthews v. Spangenberg*, 23 O. G. 1624.

If the defendant desires to mitigate the pecuniary fine to be imposed, he should present his inability to respond in a manner leaving it free from all question. *Doubleday v. Sherman*, 4 Fish. 253 ; s. c. 8 Blatch. 45.

A party who has violated an injunction may be compelled to pay the expenses of the attachment and the counsel fees of the complainant. *Doubleday v. Sherman*, 4 Fish. 253 ; s. c. 8 Blatch. 45 ; *Schillinger v. Gunther*, 11 O. G. 831 ; s. c. 14 Blatch. 152 ; s. c. 2 Ban & Ard. 544 ; *Phillips v. Detroit*, 16 O. G. 627 ; s. c. 2 Flippin 92 ; s. c. 3 Ban & Ard. 150 ; *Searls v. Worden*, 13 Fed. Rep. 716.

If the defendant acted under competent advice, and had no intention of disobeying the order of the court, no fine will be imposed, but he will be required to pay costs. *Carstaedt v. U. S. Corset Co.*, 13 Blatch. 371 ; s. c. 10 O. G. 3 ; s. c. 3 Ban & Ard. 331.

If the defendant is poor, and has been in jail under the attachment for some time, he may be released upon his own recognizance for his appearance whenever ordered to appear, and further proceedings on the attachment may be suspended indefinitely. *Goodyear v. Muller*, 3 Fish. 260 ; s. c. 5 Blatch. 463.

If the complainant proves a wilful violation of the injunction, without showing the extent of it, he is entitled to an allowance for counsel fees and expenses, but not to a further pecuniary fine by way of indemnity.



*Doubleday v. Sherman*, 4 Fish. 253; s. c. 8 Blatch. 45; *Phillips v. Detroit*, 16 O. G. 627; s. c. 2 Flippin 92; s. c. 3 Ban & Ard. 150; *Macaulay v. White S. M. Co.*, 21 O. G. 496; s. c. 9 Fed. Rep. 698.

An order imposing a fine for contempt may be made in the suit, and need not be made in a proceeding in the title of which the United States is made a party. *Fischer v. Hayes*, 20 O. G. 601; s. c. 19 Blatch. 13; s. c. 6 Fed. Rep. 63.

If a State court has granted an injunction restraining the patentee from taking any benefit under an agreement of compromise, a proceeding for contempt for an alleged violation of a decree for a perpetual injunction, entered as a part of that agreement, will be suspended to await the final judgment of the State court. *Pentlarge v. Beeston*, 18 Blatch. 38; s. c. 5 Ban & Ard. 326; s. c. 1 Fed. Rep. 862.

If a defendant who has been adjudged guilty of a contempt will give bond with sureties to pay the amount of the fine whenever the court shall vacate the suspension, the execution of a warrant of commitment may be suspended. *Fischer v. Hayes*, 20 O. G. 672.

### Profits.

Where there is an infringement, the proper practice is to enter an interlocutory decree, and send the cause to a master to ascertain the amount which the complainant is entitled to recover. *Carew v. Boston Elastic Fabric Co.*, 5 Fish. 90; s. c. 1 Holmes 45; 1 O. G. 91; s. c. 3 Cliff. 356; *Jackson v. Breck*, 11 O. G. 112; *Rumford Works v. Lauer*, 5 Fish. 615; s. c. 10 Blatch. 122; 3 O. G. 349; *Andrews v. Creegan*, 19 O. G. 1146; s. c. 1 Ban & Ard. 113; s. c. 7 Fed. Rep. 477.

An account will be ordered, although the testimony shows that the defendant could have used another device of equal advantage. *Bullock Printing Press Co. v. Jones*, 13 O. G. 124; s. c. 3 Ban & Ard. 195.

An interlocutory decree may provide for gains, savings and advantages as well as profits arising from the infringement. *Coburn v. Schroeder*, 20 O. G. 1085; s. c. 19 Blatch. 493; s. c. 8 Fed. Rep. 521.

An interlocutory decree may determine which party shall pay costs. *Coburn v. Schroeder*, 20 O. G. 1085; s. c. 19 Blatch. 493; s. c. 8 Fed. Rep. 521.

The complainant, if he so elects, may waive an account of profits, and bring an action at law. *Furbush v. Bradford*, 1 Fish. 317; s. c. 21 Law Rep. 471.

When there is no dispute about the title, the court may refer the case to a master to take and state an account of the profits which the defendant has made by the use of the patentee's invention. *Allen v. Blunt*, 1 Blatch. 480.

The practice is to take the account of the profits down to the time of the hearing before the master, if the infringement continues to that period, thereby preventing the necessity and expense of a new suit. The right as between the parties to the litigation in respect to the use of the patent

having been decided, there is no question in dispute but the damages. If a second suit were brought, the decree in the first would be conclusive of the right, and the only question open would be that of damages, and as to that question the same defence may be made on taking the account for a time subsequent to the commencement of the suit, as could be made in case a new suit were instituted. *Tatham v. Lowber*, 4 Blatch. 86; *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

The account should include the profits on all the machines, whether bought before or after the commencement of the suit. *Knox v. Great W. Q. Mining Co.*, 14 O. G. 897.

A complainant is entitled to profits from the date of the patent and not from the time when it was actually issued. *Burdett v. Estey*, 19 Blatch. 1; s. c. 5 Ban & Ard. 308; s. c. 3 Fed. Rep. 566.

If the patentee did not introduce his patent into general use, and the defendant was not conscious of an infringement, no profits will be allowed before notice to the defendant of the patentee's claim. *Merriam v. Smith*, 11 Fed. Rep. 588.

Profits may be allowed from the time of notice to the defendant of the patentee's claim. *Merriam v. Smith*, 11 Fed. Rep. 588.

Profits are the proper measure of damages in equity suits, except in certain cases where the injury sustained by the infringement is plainly greater than the aggregate of what was made by the respondent. *Brady v. Atlantic Works*, 15 O. G. 965; s. c. 3 Ban & Ard. 577.

If the infringing machine has been used by two successive companies, the master should ascertain to what extent each has infringed. *Turrill v. Ill. C. R. R. Co.*, 3 Biss. 72.

The account may be taken for profits that accrued after one of the defendants left the partnership, and the liability of the defendants may be apportioned in making up the decree. No decree should be entered against the partner who withdrew from the concern for profits which accrued after such withdrawal. *Tatham v. Lowber*, 4 Blatch. 86; *Troy Factory v. Corning*, 3 Fish. 497; s. c. 6 Blatch. 328.

An officer in the service of the government is liable for the profits, although he has paid them into the treasury. *Campbell v. James*, 18 O. G. 1111; s. c. 18 Blatch. 92; s. c. 5 Ban & Ard. 354; s. c. 2 Fed. Rep. 338.

If a defendant who is a stockholder in a corporation, which is also a defendant, received nothing otherwise than as a stockholder, no decree for profits can be made against him. *Steam Stone Cutter Co. v. Windsor Manuf. Co.*, 17 Blatch. 24; s. c. 4 Ban & Ard. 445.

The complainant is entitled to recover not merely all the profits made by all the defendants while acting together, but also the profits made by a portion of them while acting together or in conjunction with another. *Herring v. Gage*, 15 Blatch. 124; s. c. 3 Ban & Ard. 396.

A release of one of several infringers will not release the others in equity, if it is not under seal, and contains a stipulation that they shall not be released. *Ingels v. Mast*, 6 Fish. 415.

The decree determines the construction of the patent and the fact of



infringement, and the master should only inquire into the extent of the infringement. *Turrill v. Ill. C. R. R. Co.*, 3 Biss. 72.

If the conduct of the defendant has not been such as to commend him to the favor of a court of equity, every doubt and difficulty should be resolved against him in stating the account. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

The master may refuse to go into the general state of the art, either as to the construction of the patent, or the infringement, where the patent has already been construed by the court. *Turrill v. Ill. C. R. R. Co.*, 5 Biss. 344.

In order to recover the profits made by the defendant, the proof must show not merely that he obtained an advantage from the use of the thing patented, but also the worth of the advantage. *Blake v. Greenwood Cemetery*, 16 Fed. Rep. 676.

There can not be any rule for estimating profits which will apply equally to all cases. The mode of estimating profits must depend upon the peculiar nature of the monopoly granted. *Mason v. Graham*, 5 Fish. 290; s. c. 1 Holmes 88; 1 O. G. 608; s. c. 7 O. G. 833; s. c. 23 Wall. 261.

The profits which may be allowed are only such profits and gains as result directly or immediately from the wrongful acts of the infringer. Profits which are remote and contingent are not recoverable. *Piper v. Brown*, 6 Fish. 240; s. c. 1 Holmes 196; 3 O. G. 97.

A patentee is entitled to the profits although the thing patented can be used only in the service of the government. *Campbell v. James*, 18 O. G. 1111; s. c. 18 Blatch. 92; s. c. 5 Ban & Ard. 354; s. c. 2 Fed. Rep. 338.

If the patentee sells the thing patented, the profit is the difference between the cost of a genuine article and the cost of a spurious article. *Putnam v. Sudhoff*, 1 Ban & Ard. 198.

If the patentee manufactures the article for sale, he is entitled to the profits that he would have made if the defendant had bought directly from him. *Putnam v. Lomax*, 10 Biss. 546; s. c. 9 Fed. Rep. 448; *Blake v. Greenwood Cemetery*, 16 Fed. Rep. 671.

If a person who hires a contractor to make the thing patented pays the same price as he would to the inventor, he makes no profits. *Elizabeth v. Pavement Co.*, 97 U. S. 126; s. c. 6 O. G. 772; s. c. 3 O. G. 522; s. c. 1 Ban & Ard. 463; s. c. 6 Fish. 424.

Although a contract is taken in the name of a party, yet if he makes it on behalf of another and merely receives a salary for his services, he makes no profits. *Elizabeth v. Pavement Co.*, 97 U. S. 126; s. c. 6 O. G. 772; s. c. 3 O. G. 522; s. c. 1 Ban & Ard. 463; s. c. 6 Fish. 424.

If the reduction of prices is followed by an increase of sales, the profit arising from the increase of sales must be set off against the diminution of profit on the rest of the sales arising from the reduction of the price. *Ingersoll v. Musgrove*, 14 Blatch. 541; s. c. 3 Ban & Ard. 304.

If the invention enables the defendant to use a cheaper oil for light, the patentee is entitled to the saving as profits. *Williams v. R. W. & O.*

R. R. Co., 17 O. G. 1447; s. c. 18 Blatch. 181; s. c. 5 Ban & Ard. 423; s. c. 2 Fed. Rep. 702.

The patentee is entitled to recover the profits although he exercises his invention not by using the thing patented, but by making and selling it. *Williams v. R. W. & O. R. R. Co.*, 17 O. G. 1447; s. c. 18 Blatch. 181; s. c. 5 Ban & Ard. 423; s. c. 2 Fed. Rep. 702.

If the machine is made in this country, the patentee is entitled to profits, although it is sold abroad. *Ketchum Harvester Co. v. Johnson Harvester Co.*, 19 Blatch. 367; s. c. 8 Fed. Rep. 586.

If the defendant saved money by the use of the patented machine as compared with other means of doing the same work, the complainant is entitled to that profit, although there was a loss in the particular business. *Ill. Cent. R. R. Co. v. Turrill*, 94 U. S. 695; s. c. 12 O. G. 709; s. c. 5 Biss. 344.

If an estimate of profits is nothing but conjecture, without any reliable basis, it can not be the foundation for a decree. *Locomotive S. T. Co. v. Penn. R. R. Co.*, 5 Ban & Ard. 514; s. c. 2 Fed. Rep. 677.

It is incumbent on the complainant to exhibit affirmatively the whole amount of the production, in order to measure the damages and approximate the extent of the profits. *Webster v. Carpet Co.*, 9 O. G. 203; s. c. 2 Ban & Ard. 67; *Goulds Manuf. Co. v. Cowing*, 12 O. G. 942; s. c. 14 Blatch. 315; s. c. 3 Ban & Ard. 75.

It is incumbent on the complainant to give evidence separating the profits which can be allowed from those that can not be allowed, and in the absence of such evidence only nominal profits can be allowed. *Faulks v. Kamp*, 22 O. G. 2244; s. c. 10 Fed. Rep. 675.

The defendant is liable for the profits made in repairing infringing machines, although he is also charged with the profits of the manufacture thereof. *Mason v. Graham*, 5 Fish. 290; s. c. 1 Holmes 88; 1 O. G. 608; s. c. 7 O. G. 833; s. c. 23 Wall. 261.

The rule in chancery is that the amount of profits received by the unlawful use of the machine is in general the damage done to the owner of the patent. It takes away the motive of the infringer of patented rights by requiring him to pay the profits of his labor to the owner of the patent. *Dean v. Mason*, 20 How. 198; *Furbush v. Bradford*, 1 Fish. 317; s. c. 21 Law Rep. 471.

The profits are to be computed and ascertained by finding the difference between cost and yield. In estimating the cost, the elements of the price of materials, interest, expenses of manufacture and sale and other necessary expenditures, if there are any, and bad debts, are to be taken into account, and usually nothing else. The calculation is to be made as a manufacturer calculates the profits of his business. Profit is the gain made upon any business or investment when both the receipts and payments are taken into account. The rule is founded in reason and justice. The controlling consideration is that the wrongdoer shall not profit by his wrong. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; *Tatham v. Lowber*, 4 Blatch. 86; *Piper v. Brown*, 6 Fish. 240; s. c.



1 Holmes 196; 3 O. G. 97; *American S. Co. v. Emerson*, 8 Fed. Rep. 806; *Burdett v. Estey*, 19 Blatch. 1; s. c. 1 Ban & Ard. 625; s. c. 3 Fed. Rep. 566.

An allowance of the profits which the defendant could have made with reasonable diligence is erroneous. *Dean v. Mason*, 20 How. 198; *Livingston v. Woodworth*, 15 How. 346; *Munson v. New York*, 16 Fed. Rep. 560.

The inquiry is not what could be, but what was produced. The estimate should be based, not upon the capacity for production, but upon the actual production. *Webster v. Carpet Co.*, 9 O. G. 203; s. c. 2 Ban & Ard. 67.

It is the additional advantage which the defendant derived from the invention—advantage beyond what he had without it, for which he must account. *Mowry v. Whitney*, 3 Fish. 157; s. c. 4 Fish. 141, 207; 5 Fish. 496; 14 Wall. 620; 2 Bond 45; s. c. 1 O. G. 492; *Black v. Thorne*, 12 Blatch. 20; s. c. 7 O. G. 176; s. c. 1 Ban & Ard. 155; *Tilghman v. Mitchell*, 4 Fish. 599; s. c. 19 Wall. 287; 9 Blatch. 1; *Turrill v. Ill. C. R. R. Co.*, 5 Biss. 344; *Webster v. Carpet Co.*, 9 O. G. 203; s. c. 2 Ban & Ard. 67; *Magic Ruffle Co. v. Elm City Co.*, 11 O. G. 501; s. c. 14 Blatch. 109; s. c. 2 Ban & Ard. 506; *Mers v. Conover*, 11 O. G. 1111; s. c. 14 Blatch. 197; s. c. 6 Fish. 506; *Garretson v. Clark*, 16 O. G. 806; s. c. 4 Ban & Ard. 536; *Locomotive S. T. Co. v. Penn. R. R. Co.*, 5 Ban & Ard. 514; s. c. 2 Fed. Rep. 677; *Wetherill v. N. J. Zinc Co.*, 1 Ban & Ard. 485.

In ascertaining the profits, the comparison must be between the old and the new method. The defendant will not be permitted to show that he could have pursued a more profitable course. *Turrill v. Ill. C. R. R. Co.*, 3 Biss. 72.

In determining the amount of profits, the comparison must be made with machines which at the time of the infringement were known and open to public use, and not with machines that have been invented since. *Knox v. Great W. Q. Mining Co.*, 14 O. G. 897.

Although the defendant might have used another article, yet if that was not known to him, the patentee is entitled to the amount saved as compared with the articles that were known to the defendant. *Campbell v. James*, 2 Fed. Rep. 338; s. c. 18 O. G. 1111; s. c. 18 Blatch. 92; s. c. 5 Ban & Ard. 354.

If the profit arises directly from the use of the thing patented, that profit is the measure of the recovery, and it is unnecessary to consider what profit might have been made from the use of some other device that was open to the defendant. *Herring v. Gage*, 15 Blatch. 124; *Burdett v. Estey*, 19 Blatch. 1; s. c. 5 Ban & Ard. 308; s. c. 3 Fed. Rep. 566.

In estimating the gains and profits, the comparison must be made with that machine which is most favorable to the defendant, although the defendant used an inferior machine. *Locomotive S. T. Co. v. Penn. R. R. Co.*, 5 Ban & Ard. 514; s. c. 2 Fed. Rep. 677.

If the patented device is an essential feature of an article, then the com-

plainant is entitled to the loss sustained by a reduction of profits on the entire article arising from the competition of the infringement. *Sargent v. Yale Lock Manuf. Co.*, 17 Blatch. 244; s. c. 17 O. G. 105; s. c. 4 Ban & Ard. 574; s. c. *Fitch v. Bragg*, 16 Fed. Rep. 243.

If the complainant has assented to the defendant's claim for a license, the defendant's liability depends upon whether the infringements were after and in consequence of the admission, and in reliance upon it and before he had notice that it had been withdrawn. *Gear v. Grosvenor*, 6 Fish. 314; s. c. 1 Holmes 215; 3 O. G. 380.

If the patentee is the infringer against a licensee, and takes out a reissue *pendente lite*, the licensee may claim the profits before as well as after the reissue. *Littlefield v. Perry*, 21 Wall. 205; s. c. 7 O. G. 964.

If a license stipulates that a licensee, when he shall find it impracticable to obtain a contract from a town or city, shall allow such town or city to use the thing patented at a certain price, an infringer can not avail himself of this stipulation so as to limit his liability for profits to that price. *American Pavement Co. v. Elizabeth*, 6 O. G. 764; s. c. 1 Ban & Ard. 439.

If the patent has been surrendered, the patentee is not entitled to an account for profits that accrued prior to the surrender. *Sarven v. Hall*, 5 Fish. 415; s. c. 9 Blatch. 524; 1 O. G. 437; *Buerk v. Valentine*, 5 Fish. 366; s. c. 9 Blatch. 479; 2 O. G. 295.

If the patent is for an entire process made up of several constituents, the defendant will not be responsible for the profits derived from the use of one of the constituents. *Mowry v. Whitney*, 3 Fish. 157; s. c. 4 Fish. 141, 207; 5 Fish. 496; 14 Wall. 620; 2 Bond 45; s. c. 1 O. G. 492.

If the patent is for a combination, the defendant must account for all the profits made by the infringement, and not merely for the difference between such profits and the gains which he might have made by lawful methods. *American Pavement Co. v. Elizabeth*, 6 O. G. 772; s. c. 1 Ban & Ard. 463; *Ruggles v. Eddy*, 12 O. G. 716; s. c. 2 Ban & Ard. 627; *Zane v. Peck*, 23 O. G. 191; s. c. 13 Fed. Rep. 475.

Where the patent is for an improvement, the patentee is not entitled to all the profits that accrued in the manufacture of the whole article, but merely to the profits which were realized as the consequence of the improper use of the improvement. *Littlefield v. Perry*, 21 Wall. 205; s. c. 7 O. G. 964; *Ingels v. Mast*, 1 Flippin 424; s. c. 2 Ban & Ard. 24; *Gould's Manuf. Co. v. Cowing*, 12 Blatch. 243; s. c. 8 O. G. 277; s. c. 1 Ban & Ard. 375; *Gould's Manuf. Co. v. Cowing*, 14 Blatch. 315; s. c. 12 O. G. 942; s. c. 3 Ban & Ard. 75; *Black v. Munson*, 14 Blatch. 265; s. c. 2 Ban & Ard. 623; *Vaughan v. Cent. Pac. R. R. Co.*, 4 Saw. 280; s. c. 3 Ban & Ard. 27; *Starr S. C. Co. v. Crossman*, 4 Ban & Ard. 566; *Maier v. Brown*, 17 Fed. Rep. 736.

Although the patent is for an improvement, yet if the improved article is a new and different species, a specific article having a peculiar value because of the patentee's discovery or invention, the account will be taken for the profits on the whole article, and not merely on the improvement.



*Livingston v. Jones*, 2 Fish. 207; s. c. 3 Wall. Jr. 330; *Pearce v. Mulford*, 102 U. S. 112; s. c. 11 O. G. 741; s. c. 14 Blatch. 141; s. c. 2 Ban & Ard. 542.

Where the invention is used in connection with a machine, the profits on the whole are not to be apportioned according to the cost of each part respectively. *Mason v. Graham*, 23 Wall. 261; s. c. 7 O. G. 833; s. c. 5 Fish. 290; s. c. 1 Holmes 88; 1 O. G. 608.

If the improvement saves the defendant from a loss, he is liable for the saving, although he made no actual profits. *Mevs v. Conover*, 11 O. G. 1111; s. c. 11 Blatch. 197; s. c. 6 Fish. 506; *Knox v. Gt. Western Q. Mining Co.*, 14 O. G. 897; *Ill. Cent. R. R. Co. v. Turrill*, 94 U. S. 695; s. c. 12 O. G. 709; s. c. 5 Biss. 344; *Campbell v. James*, 18 O. G. 1111; s. c. 18 Blatch. 92; s. c. 5 Ban & Ard. 354; s. c. 2 Fed. Rep. 338.

The patentee is not entitled to the savings or profits resulting from the defendant's own invention. *Graham v. Mason*, 23 Wall. 261; s. c. 7 O. G. 833; s. c. 5 Fish. 290.

When a machine is sold with an improvement, the profits are not to be divided according to the cost of the improvement and the cost of the machine respectively, but are to be computed according to the profit on the improvement when sold separately. *Graham v. Mason*, 23 Wall. 261; s. c. 7 O. G. 833; s. c. 5 Fish. 290.

If the invention consists merely of an improvement on an old machine, the patentee is only entitled to the profit on the improvement, although he had the exclusive control of the market until the infringement began. *Garretson v. Clark*, 14 O. G. 485; s. c. 15 Blatch. 70; s. c. 3 Ban & Ard. 352.

Although a patented invention is merely an improvement, yet if the improvement is required to adapt the machine to a particular use, and there is no other way open to the public to supply the demand for that use, the patentee is entitled to the entire profits. *Gould's Manuf. Co. v. Cowing*, 105 U. S. 253; s. c. 21 O. G. 1277.

If the patent covers only one of many features in a machine, the complainant must produce evidence to separate the profits on that feature from the profits on the entire machine. *Calkins v. Bertrand*, 10 Biss. 445; s. c. 8 Fed. Rep. 755.

Although the patented invention is only for a part of an article, yet the patentee is entitled to recover the profits lost by infringing competition on the whole article. *Sargent v. Yale Lock Manuf. Co.*, 17 O. G. 105; s. c. 17 Blatch. 244; s. c. 4 Ban & Ard. 574.

If the invention consists merely in a device to lay concrete pavement in blocks, the patentee is not entitled to the profits on the manufacture of the pavement, but merely to the profits on his special device. *Schillinger v. Gunther*, 14 O. G. 713; s. c. 15 Blatch. 303; s. c. 3 Ban & Ard. 491.

If a patent covers only one of many features in a machine, the patentee is not entitled to the profits arising from the whole machine, but merely to the gains arising from that special feature. *Calkins v. Bertrand*, 10 Biss. 445; s. c. 8 Fed. Rep. 755.

If the profit is derived from the construction of the thing patented as an entirety, the infringer must account for the whole profit, and not merely for the difference between the profit on that and some other similar thing. *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 a patentee in a case where the invention is for an improvement only, fails to show that the use of his invention in connection with other machinery produced a definite part of the whole profits, his recovery of profits must be nominal only. *Kirby v. Armstrong*, 10 Biss. 135; s. c. 19 O. G. 661; s. c. 5 Fed. Rep. 801.

Although the patentee relies upon a license fee for his income from his patent, yet he is entitled to recover the profits made by the respondent, although they exceed the license fee. *Wooster v. Taylor*, 14 Blatch. 403; s. c. 3 Ban & Ard. 241; *Knox v. Great W. Q. Mining Co.*, 14 O. G. 897.

When it is difficult to ascertain the profits with exactness, a license fee may be adopted as the standard of profits. *Emigh v. B. & O. R. R. Co.*, 19 O. G. 935; s. c. 4 Hughes 271; s. c. 6 Fed. Rep. 283.

In general, the defendant should not be charged with interest before the final decree. The profits which are recoverable against an infringer of a patent are in fact a compensation for the injury he has sustained from the invasion of his right. They are the measure of his damages. Though called profits, they are really damages, and unliquidated until the decree is made. Interest is not generally allowable upon unliquidated damages. *Mowry v. Whitney*, 3 Fish. 157; s. c. 4 Fish. 141, 207; 5 Fish. 496; 14 Wall. 620; 2 Bond 45; s. c. 1 O. G. 492; *American Pavement Co. v. Elizabeth*, 6 O. G. 764; s. c. 1 Ban & Ard. 439; *Troy Factory v. Corning*, 3 Fish. 497; s. c. 6 Blatch. 328; *Webster v. Carpet Co.*, 9 O. G. 203; s. c. 2 Ban & Ard. 67; *Littlefield v. Perry*, 21 Wall. 205; s. c. 7 O. G. 964; *Livingston v. Woodworth*, 15 How. 546; *Tatham v. Lowber*, 4 Blatch. 56; *Brady v. Atlantic Works*, 15 O. G. 965; s. c. 3 Ban & Ard. 577; *Parks v. Booth*, 102 U. S. 96; s. c. 17 O. G. 1089; s. c. 1 Flippin 381; s. c. 1 Ban & Ard. 225; *Steam S. C. Co. v. Windsor Manuf. Co.*, 17 Blatch. 24; s. c. 4 Ban & Ard. 445; *Steam S. C. Co. v. Windsor Manuf. Co.*, 18 Blatch. 47; s. c. 5 Ban & Ard. 335; *Holbrook v. Small*, 17 O. G. 55; s. c. 3 Ban & Ard. 625.

If the complainant was not entitled to a decree until he filed a disclaimer, he can not claim interest on the profits until the disclaimer was filed. *Burdett v. Estey*, 19 Blatch. 1; s. c. 5 Ban & Ard. 308; s. c. 3 Fed. Rep. 566.

When a royalty is taken as the measure of damages, interest may be allowed from the time of the infringement. *Locomotive S. T. Co. v. Penn. R. R. Co.*, 5 Ban & Ard. 514. s. c. 2 Fed. Rep. 677.

### **Deductions.**

The complainant must take the profits burdened with the just allowance for those disbursements which enable the defendant to offer the thing pat-



ented to the public in a salable form, and to keep it in the market, before the eye and within the reach of customers, and generally to properly conduct the business of selling and keep due account thereof. The expenses of clerk hire and rent may be deducted. *Hitchcock v. Tremaine*, 5 Fish. 310; s. c. 9 Blatch. 385.

The market value of the materials on hand when the infringement began, may be allowed, but only the cost of those purchased for the infringement. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

If the defendant manufactures the material out of which the thing patented is made, the quantity, if large, may be a ground for reducing the allowance for the price below the ordinary market value. *Troy Factory v. Corning*, 3 Fish. 497; s. c. 6 Blatch. 328.

The loss arising by means of an uncollectible account may be allowed. *American Pavement Co. v. Elizabeth*, 6 O. G. 74; s. c. 1 Ban & Ard. 439.

The use of shop-room and tools is a necessary ingredient in the expense of manufacturing most articles, and may be estimated and allowed as a part of the expense account. *Troy Factory v. Corning*, 3 Fish. 497; s. c. 6 Blatch. 328.

If the machines are made on property owned by the defendant, an allowance for the use thereof may be deducted from the profits. *Steam S. C. Co. v. Windsor Manuf. Co.*, 17 Blatch. 24; s. c. 4 Ban & Ard. 445.

Although the machines are manufactured on property owned by the defendant, yet neither the sum paid for taxes nor the sum paid for insurance can be deducted from the profits. *Steam S. C. Co. v. Windsor Manuf. Co.*, 17 Blatch. 24; s. c. 4 Ban & Ard. 445.

The value of the power employed in using the machine cannot be deducted, unless it is shown that the expense has been paid or incurred. *Herring v. Gage*, 15 Blatch. 124; s. c. 3 Ban & Ard. 396.

If the defendant is a corporation and employs its stockholders in the manufacture of the machines, the salaries paid to them may be deducted from the profits. *Steam S. C. Co. v. Windsor Manuf. Co.*, 17 Blatch. 24; s. c. 4 Ban & Ard. 445.

No allowance can be made as a salary to the defendant, for he is not permitted to gain either wages or salary by a violation of the rights of an inventor. *Williams v. Leonard*, 5 Fish. 381; s. c. 9 Blatch. 476; *Imper v. Brown*, 6 Fish. 240; s. c. 1 Holmes 196; 3 O. G. 97; *contra*, *American Pavement Co. v. Elizabeth*, 6 O. G. 764; s. c. 1 Ban & Ard. 439.

If the defendant paid a royalty to another patentee for the privilege of using his improvement, this payment may be allowed as an expense. *American Pavement Co. v. Elizabeth*, 6 O. G. 764; s. c. 1 Ban & Ard. 439.

If a party is acting in good faith under another patent, the license fees which he has agreed to pay may be deducted. *La Baw v. Hawkins*, 2 Ban & Ard. 561.

If the defendant has made an improvement on the thing patented, the profits derived therefrom are to be deducted from the gross profits on

sales. *Hitchcock v. Tremaine*, 5 Fish. 310; s. c. 9 Blatch. 385; *Steam S. C. Co. v. Windsor Manuf. Co.*, 17 Blatch. 24; s. c. 4 Ban & Ard. 445.

If the defendant seeks a deduction on account of the use of an improvement made by him, the burden of proving the proportion of the profits due to such improvements rests on him. *Carter v. Baker*, 4 Fish. 404; s. c. 1 Saw. 512; *American Pavement Co. v. Elizabeth*, 6 O. G. 764; s. c. 1 Ban & Ard. 439.

The patentee is entitled to any profit the infringer has made by the unlicensed use of the contrivance included in the monopoly, and of that alone, without any regard to profit or loss on the whole structure or machine of which such mechanism forms a part, and without recoupment for losses on other infringing mechanisms made or sold. *Mason v. Graham*, 23 Wall. 261; s. c. 7 O. G. 833; s. c. 5 Fish. 290; s. c. 1 Holmes 88; 1 O. G. 608.

If the defendant sells other articles besides the patented invention, he may deduct a ratable proportion of his general expenses from the profits arising from the sale of the patented invention. *Tremaine v. Hitchcock*, 23 Wall. 518; s. c. 7 O. G. 1055; s. c. 8 Blatch. 440; s. c. 4 Fish. 508; *Brady v. Atlantic Works*, 15 O. G. 965; s. c. 3 Ban & Ard. 577; *Zane v. Peck*, 23 O. G. 191; s. c. 13 Fed. Rep. 475.

The apportionment of expenses among the different kinds of business carried on by the defendant should be according to the gross sales, and not according to the profits received from each kind. *Hitchcock v. Tremaine*, 5 Fish. 310; s. c. 9 Blatch. 385.

If the business as to patented articles and articles not patented is so intermingled and confused that approximate results only are possible, these may be ascertained by taking the proportion of the gross amount of the sales of each kind, to the gross profits on both. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

If the defendant, in one part of his business, saved a certain amount, he is liable for that as profits, although there were no profits on the aggregate results of his whole business. *Conover v. Mevs*, 11 O. G. 1111; s. c. 6 Fish. 506; s. c. 11 Blatch. 197.

If the defendant makes a profit on the sale of some machines, but loses on other machines, he can not deduct the loss from the profits, for each infringement is a separate act and the loss on one sale can not be set off against the profit on another sale. *Steam S. C. Co. v. Windsor Manuf. Co.*, 17 Blatch. 24; s. c. 4 Ban & Ard. 445.

Where the defendant pays a certain sum to the complainant to prevent him from suing those who have purchased machines from him, but with the express understanding that such payment should not affect the right to recover damages from the defendant, he is not entitled to a deduction on that account. *Mason v. Graham*, 23 Wall. 261; s. c. 7 O. G. 833; s. c. 5 Fish. 290; s. c. 1 Holmes 88; 1 O. G. 608.

Interest on the cost of the device can not be deducted unless it is shown that the cost has been paid or incurred. *Herring v. Gage*, 15 Blatch. 124; s. c. 3 Ban & Ard. 396.



### Damages.

The terms "profits" and "damages," as used in the act, are hardly convertible. They seem to mean different things. The latter are to be awarded "in addition" to the former. Profits doubtless refer to what the defendant has gained by the unlawful use of the patented invention, and damages to what the complainant has lost. *Goodyear D. V. Co. v. Van Antwerp*, 9 O. G. 497; s. c. 2 Ban & Ard. 252.

The sole object of this provision is to enable the patentee, by bringing a suit in equity, to recover in such suit not only the profits made by the defendant by means of such infringement, but also the damages sustained by the patentee thereby. In the absence of this provision this could not be done; but under this provision the patentee can not recover as damages any items which he can not recover as damages in an action at law. Consequently, counsel fees can not be recovered as damages. *Bancroft v. Acton*, 7 Blatch. 505.

A complainant is entitled to damages beyond the profits only in those cases where the profits will not compensate for the damages sustained. *Wooster v. Taylor*, 14 Blatch. 403; s. c. 3 Ban & Ard. 241.

If the complainant claims damages he must produce evidence to establish them. *Burdett v. Estey*, 19 Blatch. 1; s. c. 5 Ban & Ard. 308; s. c. 3 Fed. Rep. 566.

Mere estimates, conjectures and opinions do not afford a proper basis to determine the actual damages sustained from a reduction of prices caused by the infringements. *Ingersoll v. Musgrove*, 14 Blatch. 521; s. c. 3 Ban & Ard. 304; s. c. 13 O. G. 966.

If a party wilfully infringes a patent, the proof of loss must be interpreted liberally in favor of the patentee. *Bigelow Carpet Co. v. Dobson*, 21 O. G. 1200; s. c. 10 Fed. Rep. 385.

If a reduction of prices is caused solely and directly by the infringement, the loss of profits consequent upon the infringing competition is a proper ground for awarding damages. *Sargent v. Yale Lock Manuf. Co.*, 17 O. G. 105; s. c. 17 Blatch. 244; s. c. 4 Ban & Ard. 574.

If the invention consists merely in a device for laying concrete pavement in blocks, he can not claim the loss of profits on a contract in which the defendant underbid him, as special damage. *Schillinger v. Gunther*, 14 O. G. 713; s. c. 15 Blatch. 303; s. c. 3 Ban & Ard. 491.

The complainant is not entitled to an allowance for any expenses beyond the taxable costs. *Parks v. Pooth*, 17 O. G. 1089; s. c. 102 U. S. 96; s. c. 1 Flippin 381; s. c. 1 Ban & Ard. 225; *Holbrook v. Small*, 17 O. G. 55; s. c. 3 Ban & Ard. 625.

If the bill prays for both profits and damages, the license fee may be added to the profits. *La Baw v. Hawkins*, 2 Ban & Ard. 561.

If no profits are made, the complainant may be allowed his usual royalty as damages. *Goodyear D. V. Co. v. Van Antwerp*, 9 O. G. 497; s. c. 2 Ban & Ard. 252; *Marsh v. Seymour*, 13 O. G. 723; s. c. 97 U. S. 348; *Kendrick v. Emmons*, 15 O. G. 966; s. c. 3 Ban & Ard. 623;

*Emerson v. Simm*, 6 Fish. 281; s. c. 3 O. G. 293; *Star S. C. Co. v. Crossman*, 4 Ban & Ard. 566.

A royalty can be taken as a measure of damages only where there is a fixed and established price at which a license is granted; no price can be said to be fixed or royalty established where the patentee varies his price according to the courage or ability of an infringer to resist. *Black v. Munson*, 14 Blatch. 265; s. c. 2 Ban & Ard. 623; *Matthews v. Spangenberg*, 14 Fed. Rep. 350.

If there is no fixed and established royalty, the exceptional contracts can not be taken as the measure of damages. *Greenleaf v. Yale Lock Manuf. Co.*, 17 O. G. 625; s. c. 17 Blatch. 253; s. c. 4 Ban & Ard. 583.

A contract between the parties that has been rescinded can not be used as a measure of damages. *Bussey v. Excelsior Manuf. Co.*, 17 O. G. 744; s. c. 1 McCrary 161; s. c. 5 Ban & Ard. 135; s. c. 1 Fed. Rep. 640.

A license fee is not the proper measure of damages if the infringement is of only a part of the invention. *Wooster v. Simonson*, 16 Fed. Rep. 680.

If the inventor has established a license fee and also manufactures the patented article, the price of the article will consist of the cost of the materials, the ordinary profit of manufacture, and an additional profit which is the equivalent of the license fee, but the license fee is the measure of damage for the infringement. *Buerk v. Imhauser*, 10 O. G. 907; s. c. 14 Blatch. 19.

A defendant can not avoid his liability for damages by alleging that he might have used some other machine as advantageously as the complainant's. *Emerson v. Simm*, 6 Fish. 281; s. c. 3 O. G. 293.

The damage must be confined to the direct and immediate consequences of the infringement, and not embrace those which are remote and conjectural. *Buerk v. Imhauser*, 10 O. G. 907; s. c. 14 Blatch. 19.

Where the patent is for an improvement, the damage is that sustained by the use of the improvement alone. *Buerk v. Imhauser*, 10 O. G. 901; s. c. 14 Blatch. 19.

If the patentee gratuitously authorizes a party to manufacture and use the patented invention, he can not recover damages for a use after such authorization. *Proctor v. Brill*, 4 Fed. Rep. 415.

If the complainant does not prove either profits or damages, he is entitled to only nominal damages. *Calkins v. Bertrand*, 10 Biss. 445; s. c. 8 Fed. Rep. 755.

The statute authorizes an increase of damages, not an increase of gains and profits. *Campbell v. James*, 5 Ban & Ard. 630; s. c. 5 Fed. Rep. 806; *Holbrook v. Small*, 17 O. G. 55; s. c. 3 Ban & Ard. 625.

### Master's Report.

If the complainant does not proceed to an accounting under the decree, this may become a ground for dismissing the bill for want of prosecution.



*American D. R. B. Co. v. Sheldon*, 1 Fed. Rep. 870 ; s. c. 18 Blatch. 50 ; s. c. 5 Ban & Ard. 292.

The master should appoint a day for proceeding with the reference and give notice by mail or otherwise to the parties or their solicitors. *Kerosene Lamp Heater Co. v. Fisher*, 5 Ban & Ard. 78 ; s. c. 1 Fed. Rep. 91.

If the defendant does not appear in pursuance of the notice, the master proceeds *ex parte*, and makes out the profits and damages, if he can from the evidence produced by the complainant. *Kerosene Lamp Heater Co. v. Fisher*, 5 Ban & Ard. 78 ; s. c. 1 Fed. Rep. 91.

If it appears that an account of profits is necessary to a just decision of the cause, and is required by the complainant, the master should make an order that the defendant furnish an account by a certain day, and adjourn the hearing to that day. *Kerosene Lamp Heater Co. v. Fisher*, 5 Ban & Ard. 78 ; s. c. 1 Fed. Rep. 91.

The defendant should be served personally with the order to produce his account and notice of the adjournment. The service may be made by any disinterested person and need not be made by the marshal. *Kerosene Lamp Heater Co. v. Fisher*, 5 Ban & Ard. 78 ; s. c. 1 Fed. Rep. 91.

If the master adjusts the interrogatories to be propounded to the defendant, no exception can be taken to his order or brought to a hearing until the final report is filed. *Union Sugar Refinery v. Mathiesson*, 3 Cliff. 146.

Exception should be taken on the spot to each ruling of the master in overruling or sustaining objections to the admission of evidence, if the party intends to contest it. It need not then be drawn up in form, but it should be taken by giving notice to the master, and it is his duty to note the fact in his minutes. The reason of the rule is founded in the interest of justice, as its observance tends to narrow the limits of controversy ; for if the party in whose favor a ruling is made is notified that an exception is taken, and the question is to be revised, he can waive the point and admit or withdraw the evidence, as the case may be, and thus avoid future controversy and delay over it. *Troy Factory v. Corning*, 3 Fish. 497 ; s. c. 6 Blatch. 328 ; *American Pavement Co. v. Elizabeth*, 6 O. G. 764 ; s. c. 1 Ban & Ard. 439 ; *Brown v. Hall*, 3 Fish. 531 ; s. c. 6 Blatch. 401.

An objection to testimony which does not state the ground of the objection is not a legal or valid objection. *Brown v. Hal.*, 3 Fish. 531 ; s. c. 6 Blatch. 401.

Objections to the master's report should be reduced to writing and filed with the master. *Fischer v. Hayes*, 24 O. G. 304 ; s. c. 16 Fed. Rep. 469.

If it is proper to except at all to the master's final report for rulings admitting or rejecting evidence, this can only be done where objections of the same kind have been made to the draft report. *Troy Factory v. Corning*, 3 Fish. 497 ; s. c. 6 Blatch. 328 ; *Garretson v. Clark*, 14 O. G. 485 ; s. c. 15 Blatch. 70 ; s. c. 3 Ban & Ard. 352.

If the interlocutory decree is erroneous, the proper mode to correct the error is not to except to the master's report, but to apply to the court to resettle the decree. *Williams v. Leonard*, 5 Fish. 381 ; s. c. 9 Blatch. 476.

Exceptions to the master's report should point out the error, and the evidence to support the allegation should be referred to in the argument. *Turrill v. Ill. C. R. R. Co.*, 3 Biss. 72.

Where the exception fails to point out the evidence that shows the difference in the cost and use of the machines, it may be disregarded. *Turrill v. Ill. Cent. R. R. Co.*, 5 Biss. 344.

Where the finding of the master is based not merely upon the evidence, but upon a personal inspection made by him with the consent of the parties, it will not be reversed. *Piper v. Brown*, 6 Fis'. 240; s. c. 1 Holmes 196; s. c. 3 O. G. 97.

Where the costs before the master have been augmented by the production of irrelevant testimony, each party may be left to pay his own costs. *Troy Factory v. Corning*, 6 Fish. 85; s. c. 10 Blatch. 223.

The complainant must in the first instance pay the master's fee, and then if he recovers, have it taxed as a part of the costs. *Macdonald v. Shepard*, 10 Fed. Rep. 919; *contra*, *Urner v. Kayton*, 24 O. G. 1178; s. c. 17 Fed. Rep. 539.

If there is a mistake in a master's report, the report may be recommitted at any time before final decree. *McKay v. Jackman*, 24 O. G. 1177.

If the complainant does not ask for the production of the defendant's books before the master, he can not have the case remanded in order to obtain them. *Fischer v. Hayes*, 21 O. G. 301; s. c. 16 Fed. Rep. 460.

If the complainant neglected to put in proper evidence to establish the amount of his damages, although his attention was called to the matter by an exception, the case will not be referred back to the master to enable him to put in additional evidence. *Garretson v. Clark*, 14 O. G. 485; s. c. 15 Blatch. 70; s. c. 3 Ban & Ard. 352.

After a final decree has been ordered, the case will not be remanded to the master for a restatement of the account to bring the profits down to the final decree. *Union Metallic Cartridge Co. v. U. S. Cartridge Co.*, 8 Fed. Rep. 446.

### Rehearing.

Interlocutory decrees are subject to a revision until a final decree is made. *Magic Ruffe Co. v. Elm City Co.*, 21 O. G. 501; s. c. 14 Blatch. 109; s. c. 2 Ban & Ard. 506; *Coburn v. Schroeder*, 22 O. G. 419; s. c. 11 Fed. Rep. 425.

An interlocutory decree may be opened and the bill dismissed if the complainant has an adequate remedy at law. *Spring v. Domestic S. M. Co.*, 22 O. G. 1445; s. c. 13 Fed. Rep. 446.

A decree for a perpetual injunction and for an account of the profits is an interlocutory and not a final decree, and a rehearing may be granted at any time before a final decree. *Reeves v. Keystone Bridge Co.*, 9 O. G. 885; s. c. 2 Ban & Ard. 256; s. c. 2 W. N. 523; *Schneider v. Thill*, 5 Ban & Ard. 595.



The application for a rehearing after an interlocutory decree must be by a petition for leave to file supplemental bill setting forth the newly discovered evidence, and for a rehearing of the cause at the time when the supplemental bill may be ready for hearing. *Reeves v. Keystone Bridge Co.*, 9 O. G. 885; s. c. 2 Ban & Ard. 256; s. c. 2 W. N. 523.

The party desiring a rehearing should file a petition, asking for the same, and obtain an order on the adverse party to show cause on the following rule day, or some other day mentioned, why its prayer should not be granted. The adverse party can then answer the petition, and upon the petition and answer the application can be heard. *Giant Powder Co. v. Cal. V. P. Co.*, 6 Saw. 508.

A petition to set aside an interlocutory decree must be signed by counsel. *Allis v. Stowell*, 18 O. G. 465; s. c. 5 Ban & Ard. 458.

An affidavit to a petition to set aside an interlocutory decree can not be made before an officer who is also attorney for the petitioner. *Allis v. Stowell*, 18 O. G. 465; s. c. 5 Ban & Ard. 458.

A petition for rehearing and leave to amend the answer may be made after the entry of an interlocutory decree. *Allis v. Stowell*, 18 O. G. 465; s. c. 5 Ban & Ard. 458.

A petition for a rehearing on the ground of newly discovered evidence should state the nature of the evidence, and by apt reference make the affidavits a part of the petition. *Allis v. Stowell*, 18 O. G. 465; s. c. 5 Ban & Ard. 458.

A petition for a rehearing on the ground of newly discovered evidence should allege that the evidence was not known to the petitioner until after the decree, the diligence that was used to discover it before that time, the time when the evidence was discovered and the circumstances attending the discovery. *Allis v. Stowell*, 18 O. G. 465; s. c. 5 Ban & Ard. 458.

A motion for a rehearing in order to introduce new evidence is substantially a motion for a new trial, and is governed by the same rules as such motions. *Ready Roofing Co. v. Taylor*, 15 Blatch. 95; s. c. 3 Ban & Ard. 368.

Where a party asks for a rehearing on the ground of newly discovered evidence, he must satisfy the court that the omission to produce the evidence at the former hearing was not due to any negligence on his part, but that he made diligent efforts to discover and obtain it. *Reeves v. Keystone Bridge Co.*, 9 O. G. 885; s. c. 2 Ban & Ard. 256; s. c. 2 W. N. 523; *Munson v. New York*, 22 O. G. 586; *Yerrington v. Putnam*, 2 Ban & Ard. 601; *Barker v. Stowe*, 16 O. G. 807; s. c. 4 Ban & Ard. 485; *Gillette v. Bate Refrig. Co.*, 12 Fed. Rep. 108; *Page v. Holmes B. A. Tel. Co.*, 18 Blatch. 118; s. c. 5 Ban & Ard. 439; s. c. 2 Fed. Rep. 330; *Ingersoll v. Benham*, 3 Ban & Ard. 179; s. c. 14 Blatch. 362.

If an application is made for a rehearing on the ground of newly discovered evidence, there must be plain proof of the sufficiency of the evidence to lead the court to a different result. *Buerk v. Imhauser*, 10 O. G. 907; s. c. 14 Blatch. 19; s. c. 2 Ban & Ard. 452; *Adair v. Thayer*, 20 O. G. 523; s. c. 7 Fed. Rep. 920.

The want of proper expert testimony is no ground for granting a rehearing. Application should have been made to the court prior to the hearing for opportunity to procure and put in such testimony. *Hitchcock v. Tremaine*, 5 Fish. 537; s. c. 9 Blatch. 550; 1 O. G. 633.

The practice of granting a rehearing as a matter of course upon the certificate of two counsel does not prevail in the Federal courts. *American D. R. B. Co. v. Sheldon*, 18 Blatch. 50; s. c. 5 Ban & Ard. 292; s. c. 1 Fed. Rep. 870.

A rehearing may be granted if the new evidence is material. *Craig v. Smith*, 100 U. S. 226; s. c. 17 O. G. 145.

If the complainant is willing to defer the taking of a final decree until the trial of another case in which the alleged new evidence may be used, a rehearing will not be granted. *Collins Company v. Coes*, 20 O. G. 1084; s. c. 8 Fed. Rep. 517.

If the defendant, after the entry of an interlocutory decree, discovers that the complainant took out a patent in a foreign country before he applied for an American patent, he may have the decree amended so as to limit the American patent to the time of the expiration of the foreign patent. *De Florez v. Reynolds*, 17 O. G. 503; s. c. 17 Blatch. 436; s. c. 4 Ban & Ard. 140; s. c. 8 Fed. Rep. 434.

A decree will not be set aside to permit the defendant to put in evidence a foreign patent, if the omission to produce it before the hearing arose from the inexperience of his counsel. *De Florez v. Reynolds*, 17 Blatch. 397; s. c. 4 Ban & Ard. 431.

If a decree is entered by collusion it will be stricken out. *Barker v. Todd*, 23 O. G. 438; s. c. 15 Fed. Rep. 265.

A decree will not be opened to admit a new defence on the ground of neglect on the part of the solicitor, if no good reason is shown for doing so. *Day v. Schwab*, 17 O. G. 1348; s. c. 5 Ban & Ard. 389; s. c. 2 Fed. Rep. 544.

Although a party has a meritorious defence, yet if he deliberately suffers a decree *pro confes.* to be entered against him, with the intention to make no defence, he is not entitled to have such decree stricken out where the result of granting such relief will be of no advantage to him and a disadvantage to the complainant. *Andrews v. Denslow*, 14 Blatch. 182; s. c. 2 Ban & Ard. 587.

The affidavits to be used on an application for a rehearing must be entitled in the cause. *Buerk v. Imhauser*, 10 O. G. 907; s. c. 14 Blatch. 79; s. c. 2 Ban & Ard. 452.

If the defendant has been guilty of laches, a decree for an injunction will not be opened. *Doubleday v. Sherman*, 6 Blatch. 513.

The payment of the taxed costs, without taking measures to open a decree for an injunction, affirms the regularity and validity of the decree, so as to make it impossible for the defendant to have the decree set aside or opened to let in a defence. *Doubleday v. Sherman*, 6 Blatch. 513.

Where an objection is made to the admissibility of evidence before the examiner, to impeach the novelty of the patent, a rehearing will not be allowed in order to let the defendant amend his answer so as to give the



proper notice. *American Saddle Co. v. Hogg*, 6 Fish. 67 ; s. c. 1 Holmes 177 ; 2 O. G. 595.

If the court is not satisfied with the conclusion reached on the testimony it may grant a rehearing, with leave to take additional proofs. *Rumford Works v. Lauer*, 5 Fish. 615 ; s. c. 10 Blatch. 122 ; 3 O. G. 249.

If an interlocutory decree extends an injunction beyond the life of the patent, it may be amended on motion. *De Florez v. Reynolds*, 17 Blatch. 436 ; s. c. 17 O. G. 503 ; s. c. 4 Ban & Ard. 140 ; s. c. 8 Fed. Rep. 434.

Although the fact that a decree was entered by consent is not stated in the decree, yet the decree cannot be corrected on the motion of a stranger to the suit. *In re Iowa B. S. W. Co.*, 5 Ban & Ard. 279.

A decree will not be modified at the instance of a person who is not a party to the suit, although it is used to obtain injunctions against him, if it was entered by consent. *W. & M. Manuf. Co. v. Colwell*, 1 Fed. Rep. 225.

After a decision has been given, third parties can not intervene by petition to have the decree so entered as not to affect rights which they claim upon facts not proved in the case. *Page v. Holmes B. A. Tel. Co.*, 18 Blatch. 118 ; s. c. 5 Ban & Ard. 439 ; s. c. 2 Fed. Rep. 330.

### **Bill of Review.**

Application for leave to file a bill of review on the ground of newly discovered evidence, must be made within a reasonable time after the discovery of the evidence. *Blandy v. Griffith*, 6 Fish. 434.

A bill of review will not be allowed where the newly discovered evidence is merely cumulative as to a point already at issue. *Blandy v. Griffith*, 6 Fish. 434.

If a decree in favor of the complainant is entered by consent, it can not be set aside by a bill of review after the lapse of the term at which it was entered. *In re Pentlarge & Beesten*, 17 Blatch. 306 ; s. c. 4 Ban & Ard. 607.

If the complainant fails to take any evidence, and a decree is entered against him, a bill of review will not be granted on the ground of newly discovered evidence where he could have discovered it by the use of due diligence. *Irwin v. Meyrose*, 12 Cent. L. J. 227 ; s. c. 2 McCrary 244.

### **How far Decree Conclusive.**

A decree for an account is interlocutory and not conclusive. *Rumford Chemical Works v. Hecker*, 10 O. G. 289 ; s. c. 2 Ban & Ard. 351 ; *contra*, *Dayton v. Wright*, 11 O. G. 197 ; s. c. 2 Ban & Ard. 449.

A decree dismissing a bill for want of prosecution is not conclusive of the rights of the parties in a subsequent suit. *Am. D. R. B. Co. v. Sheldon*, 17 Blatch. 208 ; s. c. 4 Ban & Ard. 551.

A verdict upon any fact in an action at law, and judgment thereon, concludes the parties thereto in any subsequent action. *Jacques v. Wells*, 5 O. G. 364.

If the record of an action at law does not disclose the nature of the infringement for which the judgment was entered, it will not, without extrinsic evidence, estop the defendant from denying the novelty or validity of the patent. *Russell v. Place*, 94 U. S. 606; s. c. 12 O. G. 53.

A decree in favor of the defendant in one suit is a bar to a subsequent action on the same patent against the same defendant. *Barker v. Stowe*, 11 Fed. Rep. 303.

A decree against the validity of a patent is not conclusive against the patentee in a suit against a party who took a license from the defendant prior to the commencement of the suit. *Ingersoll v. Jewett*, 16 Blatch. 378; s. c. 4 Ban & Ard. 361.

Although a decree declares one patent prior to another, yet it is not conclusive in another suit between different parties. *Day v. Combination Rubber Co.*, 17 O. G. 1347; s. c. 5 Ban & Ard. 385; s. c. 2 Fed. Rep. 570.

A decree in one case is not conclusive even in another case between the same parties where the article that is alleged to be an infringement is different. *Clarke v. Johnson*, 17 O. G. 1401; s. c. 16 Blatch. 495; s. c. 4 Ban & Ard. 403.

If the validity of the patent has been determined in a suit between parties from whom the complainant and the defendant respectively acquire title, the decree will be deemed to settle that point in the subsequent suit between persons who are thus privies to the former suit. *Am. D. R. B. Co. v. Sheldon*, 17 Blatch. 208; s. c. 4 Ban & Ard. 551.

A decree in favor of the patentee in one suit will estop a person who contributed to defray the expense thereof from disputing the validity of the patent, although he was not a party to the suit. *Miller v. L. & M. T. Co.*, 19 O. G. 1138; s. c. 7 Fed. Rep. 91.

A decree establishing the validity of the patent is conclusive between a party claiming under the complainant and the defendant, together with a party who became his partner after the entry of the decree. *Dayton v. Wright*, 11 O. G. 197; s. c. 2 Ban & Ard. 449.

A judgment in an action against another that was defended by the defendant is conclusive against him. *U. S. & F. S. F. Co. v. Asbestos Felting Co.*, 18 Blatch. 312; s. c. 5 Ban & Ard. 624; s. c. 19 O. G. 362; 4 Fed. Rep. 813.

If an opinion is filed dismissing a bill, the decree subsequently entered will be deemed to take effect from the time of the filing of the opinion. *Barker v. Stowe*, 11 Fed. Rep. 303.

If a decree against a vendor for profits and damages has been satisfied, the vendee is not liable to an action by the patentee. *Perrigo v. Spaulding*, 12 O. G. 352; s. c. 13 Blatch. 389; s. c. 2 Ban & Ard. 348.

If a decree against one infringer is not satisfied, it is not a bar to an action against other joint infringers. *United Nickel Co. v. Worthington*, 23 O. G. 939.

A decree for damages is a bar to an action at law for the same infringement. *United Nickel Co. v. Worthington*, 23 O. G. 939.



### Costs.

The plaintiff in patent cases has never been required to give any security for costs. *Woodworth v. Sherman*, 3 Story 111; s. c. 2 Robb 257; *contra*, *Orr v. Littlefield*, 1 W. & M. 13; s. c. 2 Robb 323.

It is too late to move for security for costs when the case has been once heard on issue joined, and is then opened for a further hearing on an amended answer, as a matter of favor to the defendant, if the non-residence of the complainant appeared on the face of the original bill. *Bliss v. Brooklyn*, 10 Blatch. 217.

The general rule is to give costs to the prevailing party, and no departure will be made beyond what is sustained by sound principles and established precedents. *Hovey v. Stevens*, 3 W. & M. 17; s. c. 2 Robb 567; *Urner v. Kayton*, 17 Fed. Rep. 845.

The exceptions to the general rule should be very few, and rest on very strong grounds. *Hovey v. Stevens*, 3 W. & M. 17; s. c. 2 Robb 567.

If the complainant and defendant each have judgment in their favor on one issue, no costs will be allowed to either party. *Yale Manuf. Co. v. North*, 3 Fish. 279; s. c. 5 Blatch. 455.

When a bill which is filed to recover for an infringement of two distinct patents is sustained only as to one, neither party is entitled to recover costs. *Elfelt v. Steinhart*, 6 Saw. 480; s. c. 5 Ban & Ard. 596; s. c. 11 Fed. Rep. 896.

No costs will be awarded to a defendant who has granted a license to the other defendants to use his own patent, and thus indirectly derive advantages from the infringement by reason of the larger number of sales thereby occasioned, especially when he joins with them in the defence. *Hussey v. Bradley*, 2 Fish. 362; s. c. 5 Blatch. 134.

If the defendant has been misled by the complainant into the belief that his machine did not infringe the patent, he will not be charged with cost. *Sarven v. Hall*, 6 Fish. 495; s. c. 11 Blatch. 295; 4 O. G. 666.

If an objection to the title of the complainant is taken by answer, when it could have been taken by demurrer, the bill may be dismissed without costs. *Brooks v. Bryan*, 2 Story 553.

If the patentee fails on account of a defective specification, and his claim to be the original inventor is not established, costs will be awarded to the respondent. *Hovey v. Stevens*, 3 W. & M. 17; s. c. 2 Robb 567.

Although the complainant only recovers nominal damages, yet the defendant must pay the cost of the reference to the master. *Calkins v. Bertrand*, 10 Biss. 445; s. c. 8 Fed. Rep. 755.

When the complainant recovers only nominal damages he is entitled to costs to the interlocutory decree, and the defendant is entitled to costs from and after such decree, and one bill of costs may be set off against the other. *Fisk v. W. B. & C. Manuf. Co.*, 19 O. G. 545; *Garretson v. Clark*, 16 O. G. 806; s. c. 4 Ban & Ard. 536.

If the parties consent to the taxation of costs in a certain way, they can not withdraw the consent after the costs have been taxed. *Holbrook v. Small*, 17 O. G. 55; s. c. 3 Ban & Ard. 625.

If the defendant offered to pay the profits before the commencement of the suit, each party may be required to pay his own costs. *Ford v. Kurtz*, 12 Fed. Rep. 789; s. c. 14 C. L. N. 362.

Costs are, perhaps, never in fact taxed until after the judgment is rendered, and in many cases can not be taxed until afterwards. Where this is the case, the amount ascertained is usually, under the direction of the court, entered *nunc pro tunc*, as a part of the original judgment. This mode of proceeding is necessary for the purpose of justice, in order to afford the necessary time to examine and decide upon the several items of costs to which the successful party is lawfully entitled. *Sizer v. Many*, 16 How. 98.

The clerk has no authority to fix the compensation to be allowed to a master. *Doughty v. Manuf. Co.*, 4 Fish. 318.

If the costs are not taxed in the circuit court before the transcript of the record is transmitted to the Supreme Court, they may be taxed and inserted in the blank left for that purpose in the original record, upon the receipt of the mandate by the circuit court. *Sizer v. Many*, 16 How. 98.

### Taxable Costs.

Allowance of costs is a right given or refused by statute. *Hathaway v. Roach*, 2 W. & M. 63.

Traveling expenses of the complainant, or his counsel, in attending court, can not be allowed. *Hussey v. Bradley*, 5 Blatch. 210.

Money properly and necessarily paid for telegrams in the progress of the suit may be allowed, but the affidavit showing the actual expenditure must state the payment in detail, and the particular purpose of each telegram, so that the taxing officer may judge of the necessity and propriety of the expenditure, and of its allowance on taxation as a proper disbursement in the suit. *Hussey v. Bradley*, 5 Blatch. 210.

Expenditure for making copies of the pleadings or proofs can be allowed. *Hussey v. Bradley*, 5 Blatch. 210.

The expense of reporting the argument of counsel at the final hearing can not be taxed as a part of the costs. *Hussey v. Bradley*, 5 Blatch. 210.

If the record is printed by an order of the court, the expense may be divided equally between the parties. *Brooks v. Byam*, 2 Story 553.

The expense of printing the testimony is not chargeable against the losing party as an item of costs. The law does not require the testimony to be printed, and if it is, it must be done voluntarily by the party desiring it, and at his own expense. *Spaulding v. Tucker*, 4 Fish. 633; *Hussey v. Bradley*, 5 Blatch. 210; *Troy Factory v. Corning*, 7 Blatch. 16.

The defendant is entitled to have the costs of copies of the various assignments made by the plaintiff taxed. *Hathaway v. Roach*, 2 W. & M. 63.

The defendant can not have the cost of a copy of the patent taxed. *Hathaway v. Roach*, 2 W. & M. 63; *Woodruff v. Barney*, 2 Fish. 244; s. c. 1 Bond 528.



The defendant may be allowed a reasonable compensation for the expense of procuring models of the invention claimed in the patent. *Hathaway v. Roach*, 2 W. & M. 63.

The expense of procuring models not referred to in the patent can not be taxed. *Woodruff v. Barney*, 2 Fish. 244; s. c. 1 Bond 528; *Hussey v. Bradley*, 5 Blatch. 210; *Parker v. Bigler*, 1 Fish. 285; *Hathaway v. Roach*, 2 W. & M. 63.

No fee can be allowed as mileage to the marshal for serving a rule to plead on the defendant. *Parker v. Bigler*, 1 Fish. 285.

The postage paid upon the transmission and return of a commission may be allowed as a part of the costs. *Prouty v. Draper*, 2 Story 199.

When the parties are not the same, the witness has a right to fees in each suit, and cases where the plaintiff alone is a party are in the same category with those where all the parties are different. *Parker v. Bigler*, 4 Fish. 285.

The fees of a witness attending merely by the request of a party, without subpoena, can not be legally taxed against the losing party as a part of the costs for which he is liable. Such a witness does not attend "pursuant to law." *Woodruff v. Barney*, 2 Fish. 244; s. c. 1 Bond. 528; *Spaulding v. Tucker*, 4 Fish. 633; *Hathaway v. Roach*, 2 W. & M. 63; *contra*, *Prouty v. Draper*, 2 Story 199.

There can not be two different modes of calculating distances, an air line for jurisdiction and a zig zag for mileage. When the subpoena is served in another district, mileage can only be allowed for one hundred miles, although the marshal may have actually travelled a greater distance. *Parker v. Bigler*, 4 Fish. 285.

When witnesses come twice at the same term on account of a postponement by agreement of the parties, and not by any order of the court, and not on public account, the presumption of law and fact must be that they continued their attendance, and were paid for it till discharged by the parties or the court, and double travel can not be allowed. *Hathaway v. Roach*, 2 W. & M. 63.

The fees of witnesses who actually attend before the plaintiff becomes nonsuit, though not examined, may be allowed. *Hathaway v. Roach*, 2 W. & M. 63.

Courts of equity may allow costs other than those prescribed in the statute, according as justice and equity may require according to the circumstances of each case. If the testimony of witnesses is taken under a commission by consent, a reasonable sum, as costs for necessary expenses in procuring the attendance of the witnesses, may be allowed. *Spaulding v. Tucker*, 4 Fish. 633.

If a party dispenses with the deposition of a witness, and examines him, the cost of the deposition can not be taxed. *Hathaway v. Roach*, 2 W. & M. 63.

The fee for depositions relates to testimony taken out of court under authority which will entitle it to be read as evidence in court, and has no relation to oral testimony taken in court or before a master. It applies in

cases at common law where depositions are given in evidence on the trial, and in suits in equity where depositions are read at the hearing. *Troy Factory v. Corning*, 7 Blatch. 16.

No *per diem* allowance should be taxed for the attendance before the master, of witnesses whose testimony was afterwards abandoned or given up, or was stricken out or rejected by the master, where the striking out or rejection has been sustained by the court. It would be unreasonable and against the established rule of taxation to tax costs in favor of a party for acts or services which were useless or illegal, and which only led to increased expense and to a waste of the time of the court and of all persons concerned. *Troy Factory v. Corning*, 7 Blatch. 16.

The docket fee of twenty dollars is the highest compensation allowed to a solicitor in a cause, and can be allowed but once. *Troy Factory v. Corning*, 7 Blatch. 16.

Trial and final hearing have well-known definite meanings in the law, and they are used in this statute in that well-known sense. "Trial" is used to describe the process of determining the issues in an action at law, and "final hearing" the submission of the case for a determination thereof upon the pleadings, or pleadings and proofs, or otherwise, so that the case may be finally disposed of. The proceedings before a master upon a reference for a provisional or interlocutory purpose are neither a trial nor a final hearing, and the docket fee of twenty dollars can not be allowed. *Doughty v. Manuf. Co.*, 4 Fish. 318.

SEC. 4921 A (Act of February 16, 1875, § 2, 18 Stat. 316). That said courts, when sitting in equity for the trial of patent cases, may impanel a jury of not less than five and not more than twelve persons, subject to such general rules in the premises as may, from time to time, be made by the Supreme Court, and submit to them such questions of fact arising in such cause as such circuit court shall deem expedient; and the verdict of such jury shall be treated and proceeded upon in the same manner and with the same effect as in the case of issues sent from chancery to a court of law and returned with such findings.

SEC. 4922. Whenever, through inadvertence, accident or mistake, and without any wilful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or



discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity for the infringement of any part thereof, which was *bona fide* his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the patent office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.

*Statute Revised*—July 8, 1870, ch. 230, § 60, 16 Stat. 207.

*Prior Statute*—March 3, 1837, ch. 45, § 9, 5 Stat. 194.

**SEC. 4923.** Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication.

*Statute Revised*—July 8, 1870, ch. 230, § 62, 16 Stat. 208.

*Prior Statute*—July 4, 1836, ch. 357, § 15, 5 Stat. 123.

### **Construction.**

Whether the knowledge by a person in this country of the use of an invention in a foreign country is sufficient to render a patent void is doubted. *Illingworth v. Spaulding*, 9 Fed. Rep. 611.

No description in any printed publication of the thing patented can avoid the patent, unless such description in such printed publication was prior

in point of time to the invention of the patentee. A publication after the invention, but before the application for a patent, is not sufficient. *Bartholomew v. Sawyer*, 1 Fish. 516; s. c. 4 Blatch. 347; *Howe v. Morton*, 1 Fish. 586; *Cochrane v. Deener*, 94 U. S. 780; s. c. 11 O. G. 637; *Lorillard v. Dohan*, 20 O. G. 1537; s. c. 9 Fed. Rep. 509.

A foreign patent or other foreign printed publication describing an invention is no defence to a suit upon a patent of the United States, unless published anterior to the making of the invention or discovery secured by the latter, provided that the American patentee at the time of making application for his patent believed himself to be the first inventor or discoverer of the thing patented. *Elizabeth v. Pavement Co.*, 97 U. S. 126; s. c. 6 O. G. 772; s. c. 3 O. G. 522; s. c. 1 Ban & Ard. 463; s. c. 6 Fish. 424.

The description in a foreign publication, in order to invalidate a patent, must contain and exhibit a substantial representation of the patented improvement, in such full, clear and exact terms as to enable any person skilled in the art or science to which it appertains, to make, construct, and practice the invention to the same practical extent as they would be enabled to do if the information was derived from a prior patent. *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Sewall v. Jones*, 91 U. S. 171; s. c. 9 O. G. 471; s. c. 3 Cliff. 563; s. c. 6 Fish. 343; s. c. 3 O. G. 630; *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 MacArthur 14; *Judson v. Cope*, 1 Fish. 615; s. c. 1 Bond 327; *Hays v. Sulsor*, 1 Fish. 532; s. c. 1 Bond 273; *Cahill v. Brown*, 15 O. G. 697; s. c. 3 Ban & Ard. 580; *Atlantic Giant Powder Co. v. Parker*, 16 O. G. 495; s. c. 16 Blatch. 281; s. c. 4 Ban & Ard. 292; *Nathan v. N. Y. Elevated R. Co.*, 5 Ban & Ard. 280; s. c. 2 Fed. Rep. 225; *Downton v. Yaeger Milling Co.*, 25 O. G. 697.

Although there has been a previous discovery in a foreign country, yet the patent will be good, unless such discovery or some substantial part of it had been patented or described in a printed publication prior to the application. *O'Reilly v. Morse*, 15 How. 62; *Smith v. Ely*, 5 McLean 76; s. c. 15 How. 137; *Roemer v. Simon*, 5 O. G. 555; 12 O. G. 796; s. c. 95 U. S. 214; s. c. 1 Ban & Ard. 138; s. c. 2 Ban & Ard. 72; *Furbush v. Cook*, 2 Fish. 668; *Dawson v. Follen*, 2 Wash. C. C. 311; s. c. 1 Robb 9; *Judson v. Cope*, 1 Fish. 615; s. c. 1 Bond 327; *Bartholomew v. Sawyer*, 1 Fish. 516; s. c. 4 Blatch. 347; *Reutgens v. Kanowrs*, 1 Wash. C. C. 168; s. c. 1 Robb 1; *Parsons v. Colgate*, 24 O. G. 203; s. c. 15 Fed. Rep. 600; *Phillips v. Detroit*, 17 O. G. 191; s. c. 4 Ban & Ard. 347; *Coburn v. Schroeder*, 22 O. G. 419; s. c. 1 Fed. Rep. 425.

If the foreign discovery is not patented or described in any printed publication, it might be known and used in remote places for ages, and the people of this country be unable to profit by it. The means of obtaining knowledge would not be within their reach, and so far as their interest is concerned, it would be the same thing as if the improvement had never been discovered. It is the inventor here that brings it to them and places



it in their possession. As he does this by the effort of his own genius, the law regards him as the first and original inventor, and protects his patent, although the improvement had, in fact, been invented before and used by others. *Gayler v. Wilder*, 10 How. 477; *Sewall v. Jones*, 6 Fish. 343; s. c. 3 O. G. 630; s. c. 3 Cliff. 563; s. c. 91 U. S. 171; s. c. 9 O. G. 47.

This provision goes upon the presumption that if the foreign publication has been made, the patentee may have acquired a knowledge of it, and this presumption is not rebutted by proving as far as a negative can be proved, that the inventor had no knowledge of it. *Allen v. Hunter*, 6 McLean 303; *Swift v. Whisen*, 3 Fish. 343; s. c. 2 Bond 115; *Webb v. Quintard*, 5 Fish. 276; s. c. 9 Blatch. 352; 1 O. G. 525.

In considering whether the patentee did believe himself to be the original inventor of what was patented to him, it is material to determine whether he was in fact the original inventor thereof. If he was, there is an end to all inquiry on that point. If he was not, still he may have believed himself to be so. *Furbush v. Cook*, 2 Fish. 668.

When there is no evidence to the contrary, the presumption is that a patentee at the time of making his application believed himself to be the first inventor or discoverer of the thing patented. *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600; s. c. 3 Cliff. 639.

The word "patented" means covered and made known to the world by a public patent, so as to bring home to the public generally and probably a knowledge of its existence, and deprive any one of the credit and protection of being original if he afterward construct a like machine. A private patent is not within this clause. *Brooks v. Norcross*, 2 Fish. 661.

What is meant by Congress, undoubtedly, is in the first place, that there shall have been an invention, and in the second place, that it shall have been made patent to the world—patented. A specification enrolled after the granting of the patent will be deemed to take effect only from the time of the enrollment so far as it affects other inventors. *Howe v. Morton*, 1 Fish. 586.

A provisional specification does not make the invention described therein patented within the meaning of the statute. *Parsons v. Colgate*, 24 O. G. 203; s. c. 15 Fed. Rep. 600.

The fact whether the patent was private or public ought to be made to appear by the defendant, as he sets up the patent as if coming within the word patented. *Brooks v. Norcross*, 2 Fish. 661.

If no copy of the patent itself is given in evidence, but merely a copy of the specification and drawing, the proof required by law that the invention was in truth patented, is defective. *Brooks v. Norcross*, 2 Fish. 661.

If the machine described in the foreign patent required further invention to make it a practical and operative machine, and to embody the same invention which is described in the American patent, it will not work a forfeiture of the American patent. *American Leather Co. v. American Tool Co.*, 4 Fish. 284; s. c. 1 Holmes 503; *Goff v. Stafford*, 14 O. G. 748; s. c. 3 Ban & Ard. 610.

If the description in a foreign patent is sufficient to show the structure of the article, there need not be any proof otherwise of the existence of the article. *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.

The mere existence of a device in a foreign country, unless patented or described in a printed publication, is not a fact having any significance or recognized at all in connection with our patent laws. *Tucker & Davis*, 2 O. G. 224 ; *Carr v. Davids*, 3 O. G. 440 ; *Smith v. Barter*, 7 O. G. 1 ; *Chambers et al. v. Duncan et al.*, 9 O. G. 741 ; *Chambers v. Duncan*, 10 O. G. 787.

If the invention has been described in a foreign patent, it is not patentable. *Charles Frampton*, 1 O. G. 381.

A foreign patent, to anticipate the novelty of an invention, must contain the device either in a drawing or a description, and in either case the invention must be so distinctly shown or described as to be a matter of certainty, not of inference. *Abial C. Herron*, 1 O. G. 608.

The date of an invention originated abroad can be carried back no further than the time when specimens embodying it are shown, on satisfactory evidence, to have reached this country. *Hovey v. Hufeland*, 2 O. G. 493.

An English patent is a sufficient anticipation of an application, if the description of the invention is sufficiently full, in view of the state of the art, to enable a skilled mechanic to construct it. *J. McClosky*, 9 O. G. 299.

An English provisional specification upon which no patent was issued, can be treated only as a published description in ascertaining the state of the art. *R. O. Lowry*, 1 Dec. Com. 85 ; *Edward Maynard*, 2 Dec. Com. 54.

No previous invention of the same thing, or knowledge or use of the same in any foreign country, can constitute a valid defence to a suit under the patent. *Grell v. Kuhnert*, 1 Dec. Com. 5.

SEC. 4924. Where the patentee of any invention or discovery, the patent for which was granted prior to the second day of March, eighteen hundred and sixty-one, shall desire an extension of this patent beyond the original term of its limitation, he shall make application therefor, in writing, to the commissioner of patents, setting forth the reasons why such extension should be granted ; and he shall also furnish a written statement under oath of the ascertained value of the invention or discovery, and of his receipts and expenditures on account thereof, sufficiently in detail to exhibit a true and faithful account of the loss and profit in any manner accruing to him by reason of the invention or discovery. Such application shall be filed not more than six months nor less than



ninety days before the expiration of the original term of the patent; and no extension shall be granted after the expiration of the original term.

*Statute Revised*—July 3, 1870, ch. 230, § 63, 16 Stat. 208.

*Prior Statutes*—July 3, 1832, ch. 162, § 2, 4 Stat. 559.—July 4, 1836, ch. 357, § 17, 5 Stat. 124.—May 27, 1848, ch. 47, § 1, 9 Stat. 231.

The word “patentee” is used as equivalent to inventor, and the law looks to him as the sole object of its bounty, and means to reward him and him alone for his time, ingenuity and expense in perfecting his invention. *Woodworth v. Sherman*, 3 Story 171; s. c. 2 Robb 257; *Brooks v. Bicknell*, 4 McLean 64.

After the decease of the patentee an extension of a patent may be granted to his administrator. The rights under the patent before its extension remain in every respect the same after its extension. The administrator acts as the trustee of the heirs; he represents the deceased. *Brooks v. Bicknell*, 3 McLean 250; s. c. 2 Robb 118; *Brooks v. Jenkins*, 3 McLean 432; *Washburn v. Gould*, 3 Story 122; s. c. 2 Robb 206; *Wilson v. Rosseau*, 4 How. 646; s. c. 1 Blatch. 3; s. c. 2 Robb 373; *Woodworth v. Sherman*, 3 Story 171; s. c. 2 Robb 257.

The extension may be granted to the patentee, although the original patent has been surrendered and a reissue granted to an assignee. *Crompton v. Belknap Mills*, 3 Fish. 536; *Potter v. Braunsdorf*, 7 Blatch. 97.

The extension may be of the original patent, although there has been a reissue to an assignee without the assent of the patentee. *Potter v. Braunsdorf*, 7 Blatch. 97.

In computing the period of ninety days, the day on which the application is filed is to be included. *Johnson v. McCullough*, 4 Fish. 170.

It is not necessary that the administrator of a patentee shall unite with an assignee in order to obtain an extension of a patent. *Kellberg's Appeal*, 86 Penn. 129.

### **Applicant.**

The grant of extensions is for the benefit of inventors, and not of assignees and speculators. *G. Peberdy*, 2 O. G. 644; *Charles Waters*, 1 Dec. Com. 42; *Cornelius W. Van Vliet*, 1 Dec. Com. 93; *O. W. Minard*, 2 Dec. Com. 36; *Gleason & Crossman*, 2 Dec. Com. 158; *John L. Mason*, 3 Dec. Com. 182; *T. F. Taft*, 3 Dec. Com. 224; *G. W. Hildreth*, 3 Dec. Com. 261; *L. F. Munger*, 3 O. G. 323.

If one appears without any authority from the patentee, or not as executor or administrator, an extension will be refused him. *Torrey & Tilton*, 3 Dec. Com. 245.

The authority of an attorney who signs a petition for an extension for his principal, need not be antecedent to his filing it; if the principal adopts it afterwards it is sufficient. *Henry Voelter*, 2 Dec. Com. 84; *Garrigues' Admr.*, 2 Dec. Com. 88.

If one joint inventor alone files the application, and the other ratifies and unites in it before the expiration of the patent, the application will be

entertained and acted on in the same manner as if both had originally signed it. D. E. Beadle, 1 O. G. 434.

A patent issued to two joint inventors can not be extended upon the several application of one of them. John B. Wickersham, 4 O. G. 155.

A patentee may apply for an extension of the original patent, although an assignee without his consent surrendered the original patent and obtained a reissue. Harriet L. Low, 1 O. G. 203.

Where an assignment has been recently made of a moiety of the invention for a nominal sum, the rule requiring the patentee to show his interest in the extension will not be waived. Thomas Lee, 1 O. G. 434.

A patent may be extended if the inventor owns a half interest in the extended term. Horace Woodman, 1 O. G. 550.

An extension will not be granted if the inventor has no interest remaining in the extended term. John L. Mason, 3 Dec. Com. 182; H. H. Furbish, 3 Dec. Com. 190.

### Statement.

The object of the requirement is to furnish the commissioner data for a reliable judgment as to whether the inventor has been reasonably remunerated, and it is only necessary that the account shall be elaborated to this extent. It is not necessary to give by itself every item of expenditure and receipt on account of the patent. T. H. Willson, 1 O. G. 185.

In order to obtain the extension of a patent, the applicant must furnish a statement, in detail, of what he has received and expended on account of the invention, under oath. John R. Harrington, 2 Dec. Com. 27; Alva B. Taylor, 2 Dec. Com. 68; Levi Averill, 2 Dec. Com. 82; Robert A. Smith, 2 Dec. Com. 87; Albert A. Gray, 2 Dec. Com. 88; Reuben Conins, 3 Dec. Com. 27; A. B. Latta, 3 O. G. 349.

The law requiring an applicant to furnish a statement of the ascertained value of the invention does not necessarily contemplate a *numerical* statement. Peter Cook, 3 Dec. Com. 24; E. F. Whiton, 3 Dec. Com. 201.

The extension may be granted, although the statement was not filed within thirty days from filing the application. Horace Woodman, 1 O. G. 550.

The statement must be under oath and show the ascertained value of the invention, giving the patentee's receipts and expenditures. R. N. Allen, 1 O. G. 278.

Whether an account will be deemed to be sufficiently in detail may be affected by the fact that the party opposing the application does not object to it on that ground. T. H. Willson, 1 O. G. 185.

When the application for an extension is not filed in season, it will not be received and the fee will be returned. J. C. Smith's Adm'rs, 2 Dec. Com. 114.

### Value.

If the previous demand for a patent had been limited, and it was found useful and met with large sales only after an improvement had been applied to it, an extension will not be granted. P. H. Roots, 6 O. G. 391.

Where, upon an application for an extension, the value of the invention can be ascertained only from the sales of a machine embracing others with it, the proportionate value of each may be determined upon the affi-



davit of the applicant, if not inconsistent with their apparent importance. Horace Woodman, 2 Dec. Com. 66.

The extension of a patent will be refused where the patentee has sold his interest in it for a trifling consideration. William Gage, 2 Dec. Com. 100; John F. Boynton, 2 Dec. Com. 125; Andrew M. Hall, 2 Dec. Com. 174; John G. Baker, 1 O. G. 632.

A mere allegation that the inventor has sold rights under his patent is not sufficient, unless he produces the affidavits of the vendees to prove the importance of the invention. P. V. Matthews, 1 O. G. 405.

In showing the value of an invention the patentee is entitled to all uses to which his invention may be found adaptable. John G. Baker, 1 O. G. 632.

Affidavits which merely give the opinions of witnesses, without stating any facts or data, are not sufficient to show the value of the invention. Thomas Lee, 1 O. G. 434; Samuel Falkenberg, 2 O. G. 3; John R. Marton, 1 O. G. 608.

If improvements have been added, the statement of the value of the invention should distinguish how much of the value was due to the portions patented by applicant for extension. John Haseltine, 8 O. G. 45.

Where the value of the invention, and the diligence exercised in introducing it, sufficiently appear from papers filed in the case, though they are not strictly of evidence, the extension of a patent will be allowed. David Munson, 2 Dec. Com. 78.

If a patented machine has proved highly useful, the difference between it and former unsuccessful machines should not be nicely weighed upon a petition for an extension. Cyrus Chambers, Jr., 2 Dec. Com. 124; John A. Montgomery, 4 O. G. 132.

If it is manifest, from the evidence, an invention is valuable, an extension will be granted, although the statements to that effect are defective. David H. Whittemore, 3 Dec. Com. 30; Sidney S. Hogle, 3 Dec. Com. 72; Alonzo M. Giles, 3 Dec. Com. 76.

A patent for a process will not be extended if the composition described to be used in the process was laid aside soon after the patent was granted, and another more effective substituted, which has been kept secret. H. W. Collender, 2 O. G. 727.

Old newspapers are not regarded as such well-known printed matter as can be used in argument, for purposes of evidence, without previous notice. Robert Dick, 2 O. G. 147.

Upon applications for the extension of a patent, the value of the invention will be estimated according to what it was as described in the original patent, irrespective of modifications, improperly interpolated in a reissue. John Taggart, 1 Dec. Com. 102.

Where the invention could have cost but little time, ingenuity or expense, and is not of great public use, an extension will be refused. Hiram Tucker, 1 Dec. Com. 39; M. Riehl, 1 Dec. Com. 52; W. O. Hickok, 1 Dec. Com. 94; William Gee, 2 Dec. Com. 8; Calvin Dodge, 2 Dec. Com. 23; Jabez W. Hayes, 2 Dec. Com. 77; Charles Moore, 2 Dec. Com. 83; G. A. & H. Whipple, 2 Dec. Com. 123; Nathan Martz, 2 Dec. Com. 16; Jean L. Baudelot, 2 Dec. Com. 184; A. C. Gallahue, 3 O. G. 319.

If no attempt is made to prove the invention valuable and important to the public, and no diligence is shown on the part of the inventors in introducing it into public use, an extension will be refused. G. & D. Cook, 3 Dec. Com. 19; John W. Hoard, 3 Dec. Com. 49; Francis D. Ballou, 5 O. G. 29.



If the invention has created and supplied an extensive demand in the market, and has been recognized by the public as one of great utility, an extension will be granted, although there may be grave doubts of its patentability. Wm. E. Lockwood, 3 O. G. 439.

### Profits.

A patentee who has not received as much on account of his invention as he has expended, having been compelled by poverty, and the necessity of protecting his rights, to assign most of his interest in the extension, is entitled to have it renewed. Ira Gill, 3 Dec. Com. 12; James E. A. Gibbs, 3 Dec. Com. 155.

An applicant for an extension is not to be allowed a remuneration increased in proportion to the amount realized from the invention. Isaac M. Singer, 2 Dec. Com. 146.

Where different improvements upon the same machine are protected by successive patents, the separate value of which is not easily determinable, and the remuneration received from them all has been small, without any fault or lack of diligence on the part of the inventor, an extension will be granted. Strong & Ross, 3 Dec. Com. 8.

Where the patent has been, from first to last, in the hands of the patentee, the burden is on him to show that the benefit which he might have derived from the use of his invention was not lost through any fault or neglect of his, before an extension will be granted. D. W. Hughes, 1 Dec. Com. 96; Christian Shunk, 2 Dec. Com. 10; Simon Ingersoll, 2 Dec. Com. 38; Smith & Skinner, 2 Dec. Com. 131; Kelly & Livingstone, 3 Dec. Com. 29; Arnton Smith, 3 Dec. Com. 208; Nicholas Whitehall, 3 Dec. Com. 266.

Whether the patentee has been sufficiently remunerated is not a matter about which the commissioner's judgment can be informed by expert testimony, but must be based solely on facts. Henry Voelter, 12 O. G. 393.

An applicant who makes liberal charges for time, labor and expense bestowed upon the invention, is not entitled to great liberality in the matter of remuneration. Robert Dick, 2 O. G. 147; Jean L. Baudelot, 2 Dec. Com. 184.

If two inventions are so intimately connected in their use that it is impossible to make a distinct statement of receipts and expenditures for each, and the remuneration received from them both has been small, without any fault or lack of diligence on the part of the inventor, an extension will be granted. J. W. Riggs, 3 Dec. Com. 291.

If it appears that the inventor has been reasonably remunerated for the time, ingenuity and expense bestowed upon the invention, an extension will be refused. William R. Landfear, 2 Dec. Com. 176; S. H. & Joseph Strouse, 2 Dec. Com. 182; Jean L. Baudelot, 2 Dec. Com. 184; Orwell H. Needham, 3 Dec. Com. 3; Wm. B. Bates, Adm'r, 3 Dec. Com. 17.

The restriction of the right to manufacture a machine to companies in which the patentee is a shareholder, is perfectly right, if he so chooses, but he will be held to a stricter account of receipts, and will be considered as keeping the manufacture of the invention in his own hands. Perry G. Gardner, 2 O. G. 359; Hiram Tucker, 1 Dec. Com. 39.

Receipts from foreign patents on account of the invention must be embraced in the accounts upon an application for an extension. D. N. Woodward, 3 Dec. Com. 42.

If it is impossible to furnish a detailed account of expenditures on account of some unavoidable accident, and it is evident the inventor has



been insufficiently rewarded without his fault, an extension will be granted. *John Benedict*, 3 Dec. Com. 40; *L. B. & H. A. Myers*, 3 Dec. Com. 55.

If an invention is an obvious one, the first one to produce it is not entitled to the same remuneration for it is as the inventor of an improvement less likely to be discovered. *Marcus P. Norton*, 4 O. G. 156.

An applicant for an extension is not required to account for the profits made under the patent by his assignees, to whom he sold under the pressure of poverty. *Roxanna Rice*, 3 Dec. Com. 95.

If a patent covers an improvement in an article which could be applied to any other, the patentee will be sustained in crediting the invention with only the amount saved by it in the manufacture. *Calvin Adams*, 3 Dec. Com. 45.

There is no definite standard as to adequacy of remuneration, and where the invention is of an important character and of great public benefit, the fact of having been liberally compensated will not work against an extension. *Henry Waterman*, 2 O. G. 247; *H. W. Putnam*, 3 O. G. 240; *Benjamin F. Sturtevant*, 5 O. G. 2.

A patent will not be extended if, according to the applicant's statement, large sums must have been received which are not credited in the accounts, and other unexplained discrepancies occur. *E. G. Allen*, 3 Dec. Com. 269.

An extension will be granted although no detailed accounts were rendered, where it has been rendered impossible by reason of the bankruptcy and death of the patentee, and his failure to receive a reasonable compensation is accounted for. *F. N. Clarke*, 3 Dec. Com. 54; *Brickman & Sisson*, 3 Dec. Com. 92.

A patent will be extended where there has been great outlay in demonstrating its utility without any return, and public interests will be promoted thereby, although the invention is not in public use and its ascertained value not definitely known. *Ross & Winans*, 2 O. G. 440.

Although a subsequent improvement creates a market for a foundation invention, and carries it into more extensive use than it would otherwise have been, yet this is no ground for reducing the account of proceeds from a licensee of the foundation invention. *Henry W. Fuller*, 5 O. G. 643.

If a patent has been extensively infringed, and the infringers are liable for damages to an amount which will give the inventor an ample remuneration, his patent will not be extended. *Geo. B. Arnold*, 5 O. G. 553.

If the patentee has granted permission to others to make his patented device for a specified royalty, and any considerable number has been thus manufactured, such royalty is the fairest measure of profits. *Levis Miller*, 1 O. G. 431.

Where the inventor, without neglect or fault on his part, has failed to obtain from the use and sale of his invention a reasonable remuneration for the time, ingenuity and expense bestowed upon it, an extension will be allowed. *Theodore T. Woodruff*, 2 Dec. Com. 161; *Wendell Wright*, 2 Dec. Com. 167; *Emanuel Andrews*, 2 Dec. Com. 170; *Thomas Nelson*, 2 Dec. Com. 172; *Joseph Kingsland*, 2 Dec. Com. 173; *Joseph H. Goodell*, 2 Dec. Com. 174; *John J. Squire*, 2 Dec. Com. 179; *B. G. Dawley*, 2 Dec. Com. 181; *Isaac A. Dunham*, 2 Dec. Com. 186; *Henry Eddy*, 3 Dec. Com. 4; *James P. Cramer*, 3 Dec. Com. 6; *John G. Vaughan*, 3 Dec. Com. 13; *D. H. Whittemore*, 3 Dec. Com. 14; *Azel S. Lyman*, 3 Dec. Com. 20; *Jas. Stimpson*, 3 Dec. Com. 21; *Seth C. Ellis*, 3 Dec. Com. 22; *P. Cook*, 3 Dec. Com. 24; *Julia M. Milligan*, 3 Dec. Com. 29; *David H. Whittemore*, 3 Dec. Com. 30; *Edgar Huson*, 3 Dec. Com.

33; J. D. Brown, 3 Dec. Com. 39; C. H. & H. E. Davidson, 3 Dec. Com. 71; Isaac Hayden, 3 Dec. Com. 73; Wm. L. Williams, 3 Dec. Com. 93; A. H. Rowand, 3 Dec. Com. 105; James D. Sarvin, 3 Dec. Com. 170; William Kelly, 3 Dec. Com. 186; John Haw, 3 Dec. Com. 191; F. C. Lowthorp, 3 Dec. Com. 192; L. F. Munger, 3 Dec. Com. 203; John P. Manny, 3 Dec. Com. 205; Benaiah Fitts, 3 Dec. Com. 211; B. D. Whitney, 3 Dec. Com. 211; Philip W. McKensie, 3 Dec. Com. 223; Lovejoy & Butterfield, 3 Dec. Com. 267; C. Chambers, 3 O. G. 320; Michael H. Simpson, 2 Dec. Com. 88; Ethan Rogers, 2 Dec. Com. 92; Emily J. Lamson, 2 Dec. Com. 94; Sopia & P. L. Moen, Adm'rs, 2 Dec. Com. 98; Samuel Thomas, 2 Dec. Com. 99; W. & Wm. H. Lewis, 2 Dec. Com. 118; Tobias J. Kindleberger, 2 Dec. Com. 121; D. P. Estep, 2 Dec. Com. 123; George Thompson, 2 Dec. Com. 128; Samuel Morrill, 2 Dec. Com. 134; El Dora Louis, Adm'x, 2 Dec. Com. 148; Thaddeus Fairbanks, 3 Dec. Com. 15; Samuel R. Smith, 3 Dec. Com. 16; D. W. Shares, 3 Dec. Com. 19; Samuel R. Wilmot, 3 Dec. Com. 31; Wm. C. Hicks, 3 Dec. Com. 50; George F. Hutchins, 3 Dec. Com. 57; Elliott Savage, 3 Dec. Com. 69; Ann M. Cooley, 3 Dec. Com. 187; John Toulman, 3 Dec. Com. 214; Charles H. Sayer, 3 Dec. Com. 224.

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

*Statute Revised*—July 8, 1870, ch. 230, § 64, 16 Stat. 208.

*Prior Statute*—July 4, 1836, ch. 357, § 17, 5 Stat. 124.

A notice of an application for an extension of the original patent is sufficient, although it has been surrendered and a reissue granted. *Crompton v. Belknap Mills*, 3 Fish. 536.

The judgment of the commissioner settles conclusively all questions of notice. *Crompton v. Belknap Mills*, 3 Fish. 536; *Brooks v. Bicknell*, 3 McLean 250; s. c. 2 Robb 118; *Gear v. Grosvenor*, 6 Fish. 314; s. c. 1 Holmes 215; 3 O. G. 380.

SEC. 4926. Upon the publication of the notice of an application for an extension, the commissioner shall refer the case to the principal examiner having charge of the



class of inventions to which it belongs, who shall make the commissioner a full report of the case, stating particularly whether the invention or discovery was new and patentable when the original patent was granted.

*Statute Revised*—July 8, 1870, ch. 230, § 65, 16 Stat. 208.

*Prior Statutes*—July 4, 1836, ch. 357, § 17, 5 Stat. 124.—May 27, 1848, ch. 47, § 1, 9 Stat. 231.

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

*Statute Revised*—July 8, 1870, ch. 230, § 66, 16 Stat. 208.

*Prior Statute*—July 4, 1836, ch. 357, § 17, 5 Stat. 124.

The granting of an extended patent is a judicial act. Authority to that end is conferred upon the commissioner of patents. The manner in which it is to be exercised, and the time within which it may be exercised, are prescribed by the act. When an extension is granted in apparent conformity to the act of Congress, the decision of the officer has the attribute of a final judgment. It is not subject to appeal or revision. It can not be shown that the commissioner exceeded or irregularly exercised his authority, except by matter apparent on the face of the patent. *Dorsey Co. v. Marsh*, 6 Fish. 387; s. c. 9 Phila. 395; *Clum v. Brewer*, 2 Curt. 506; *Colt v. Young*, 2 Blatch. 471; *Brooks v. Bicknell*, 3 McLean 250; s. c. 2 Robb 118; *Goodyear v. Providence Rubber Co.*, 2 Fish. 499; s. c.

9 Wall. 788; 2 Cliff. 351; *Jordan v. Dobson*, 4 Fish. 232; s. c. 2 Abb. U. S. 398; 7 Phila. 533.

The decision of the commissioner is not conclusive as to the right of the party to whom an extension is granted to obtain it. *Brooks v. Bicknell*, 3 McLean 250; s. c. 2 Robb 118.

The decision of the commissioner in extending a patent is not conclusive upon the question of his jurisdiction to act in a given case. *Wilson v. Rousseau*, 4 How. 646; s. c. 1 Blatch. 3; s. c. 2 Robb 373.

The entry of a decision upon the file wrapper provisionally, without being promulgated, will be regarded as a minute of the views of the commissioner, and not as a decision. *Wood Paper Co. v. Glen Falls Co.*, 4 Fish. 561; s. c. 8 Blatch. 513.

The expiration of a foreign patent for the same invention forms no objection to the granting of an extension. *Tilghman v. Mitchell*, 4 Fish. 615; s. c. 9 Blatch. 18.

A patent may be extended, although the invention was first patented in a foreign country. *New Am. File Co. v. Nicholson File Co.*, 20 O. G. 524; s. c. 3 Fed. Rep. 816.

A patent may be extended, although a private act was passed fixing the term of the patent. *New Am. File Co. v. Nicholson File Co.*, 20 O. G. 524; s. c. 8 Fed. Rep. 816.

When a patent is extended, the original term and extended term are not considered as one term, but as two distinct terms. *Sayles v. Louisville C. R. R.*, 9 Fed. Rep. 512.

An extension vests an absolute title in the patentee, although he may not have had it at the time of making a surrender and taking a reissue. *Potter v. Empire Sewing Machine Co.*, 3 Fish. 474.

A transcript of an extension is sufficient, although it does not state the payment of the fees, the notice or the grounds of the decision. The proceeding is summary, and does not require the same degree of particularity as a judicial record. The function of the commissioner is in its nature judicial. Parties are brought before him, as well those who oppose the extension of the patent as those who apply for it, and evidence on both sides being heard, the commissioner pronounces his judgment. The proceeding, therefore, is not like a tax sale, where every step must be proved or the title fails, but it is in the nature of a judicial action, where, jurisdiction being acquired, no subsequent errors can affect the title of a purchaser under execution. The courts can not prescribe the form in which duties devolved upon the executive branch of the government shall be performed. They can only say whether enough appears to show that the subject was before the commissioner, and his decision. *Brooks v. Jenkins*, 3 McLean 432.

An allegation that the patent was extended by the commissioner is substantially supported by proof of an extension by the acting commissioner. A provisional officer, who is invested by law with the functions of the commissioner of patents, is properly described as commissioner, so far as the efficacy of his official acts is concerned. *Dorsey Co. v. Marsh*, 6 Fish. 387; s. c. 9 Phila. 395.



The form of an extension, under a special act, may be the same as that in general use. *Agawam Co. v. Jordan*, 7 Wall. 583.

The function of the commissioner in extending a patent is judicial, and his decision is conclusive until it is impeached in a proceeding had directly for that purpose. The extension can not be impeached for fraud not apparent on its face in a collateral proceeding. The regular tribunal is chancery founded on a proceeding by *scire facias*, or by bill or information. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; *Gear v. Grosvenor*, 6 Fish. 314; s. c. 1 Holmes 215; 3 O. G. 380; *Crompton v. Belknap Mills*, 3 Fish. 536; *Eureka Co. v. Bailey Co.*, 11 Wall. 488; *Mowry v. Whitney*, 3 Fish. 157; s. c. 4 Fish. 207; 5 Fish. 496; 14 Wall. 620; 2 Bond 45; s. c. 1 O. G. 492; *Wood Paper Co. v. Glen Falls Co.*, 4 Fish. 324; s. c. 8 Blatch. 513; *Tilghman v. Mitchell*, 4 Fish. 615; s. c. 9 Blatch. 18.

The proof of the alleged fraud in obtaining the extension of a patent must be clear and satisfactory. *Goodyear v. Providence Rubber Co.*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

A bill to vacate an extension filed after the expiration thereof will not be entertained, for the extension has ceased to be of any effect, and there remains nothing which can be the subject of the suit. *Bourne v. Goodyear*, 9 Wall. 811; *Mowry v. Whitney*, 5 Fish. 513; s. c. 14 Wall. 434; 1 O. G. 499.

A party who has consented to an act can not afterwards complain of it as a fraud. *Goodyear v. Providence Rubber Co.*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

If a special act extending a patent is procured by fraud, it is nevertheless binding on the courts, and the only remedy is to obtain a repeal. *Gibson v. Gifford*, 1 Blatch. 529.

### Practice.

Extensions are not granted, like patents, as a matter of strict right, to which the party is entitled on fulfilling certain requirements; they are more subject to the discretion of the commissioner. *Henry Bessemer*, 2 Dec. Com. 9; *Robert Mushet*, 2 Dec. Com. 106; *Wm. E. Ward*, 2 Dec. Com. 126.

Reason of opposition to an extension must be filed twenty days before the day of hearing, and must not be confounded with the notice of opposition. *Christopher Amazeen*, 2 Dec. Com. 132.

In any application for extension, absence of satisfactory proof, both of the value and importance of the invention, and of due diligence in introducing it into notice, is a fatal defect. *Samuel Falkenberg*, 2 O. G. 3; *John M. Heck*, 1 Dec. Com. 19; *Jonathan F. Barrett*, 1 Dec. Com. 40; *R. W. Lewis*, 2 Dec. Com. 8; *Wm. P. Maxson*, 2 Dec. Com. 87; *W. M. Storm*, 2 Dec. Com. 97; *John F. Boynton*, 2 Dec. Com. 125; *Samuel A. Knox*, 2 Dec. Com. 126; *E. W. Sperry*, 2 Dec. Com. 139; *Geo. Hoyt*, 2 Dec. Com. 183; *Lydia Moore*, 3 Dec. Com. 82; *Sylvester Bennett*, 3 Dec. Com. 191; *W. M. C. Cushman*, 3 O. G. 29.

Although the evidence does not give all the information as to the value of the invention, and the diligence of the patentee, which the rules require,

yet, if it gives enough to satisfy the commissioner, an extension will be granted. Henry R. Robbins, 3 O. G. 292.

The application of a pioneer, whose invention has been made more practical by subsequent improvement, is regarded with favor. Hymen L. Lipman, 1 O. G. 304; Eli W. Blake, 1 O. G. 605.

Public policy may demand the extension of a patent to be refused on account of claims which the patentee might insist upon on a reissue. T. J. Stealey, 3 Dec. Com. 317.

Where matters have been improperly interpolated in a reissued patent, an extension of it will be refused. John A. Krake, 1 Dec. Com. 100; Mary G. Pratt, 2 Dec. Com. 2; Christian Shunk, 2 Dec. Com. 10; Abner G. Bevin, 2 Dec. Com. 68; Robert H. Fletcher, 3 Dec. Com. 7; Ethan Allen, 5 O. G. 148.

The extension of a patent will be refused where the claim is practically worthless, and the device has gone into extensive use without any effort to obtain a reissue or check notorious infringements. Sarah A. Holmes, Executrix, 2 Dec. Com. 155.

An application for the extension of a patent which has been reissued in several divisions, will be allowed as to one which embraces the same claim substantially as the original patent, and found to be of value; but will be denied as to the others which embrace claims not in the original. Walter Hunt's Adm'rs, 2 Dec. Com. 29; Levi Bissell, 3 Dec. Com. 207; James R. Floyd, 6 O. G. 541.

When a claim which is allowed to remain on extending a patent, defines the invention by reference to another which is required to be disclaimed, the latter will be understood to remain valid so far as it is connected with the other. S. B. Sexton, 3 O. G. 409.

A patent will not be extended unless it is restricted to the special use described by the device named, if it is one that has been known before in other applications. Sarah Stone, Adm'x, 1 Dec. Com. 48.

Although a patent covering the principle on which a process depends has already been extended, yet a patent to another person, who first discovered the method of making the principle available, and reduced it to successful practice, will also be extended. Samuel Wetherill, 1 Dec. Com. 87.

A reissued patent will not be extended which claims more than was originated by the patentee. W. W. Lyman, 2 O. G. 705; E. W. Goodale, 1 Dec. Com. 82; S. B. Sexton, 3 O. G. 409.

Although the term for which a patent issued has not elapsed, it can not be extended if it has expired in consequence of the expiring of a foreign patent for the same invention. Ernest Gessner, 3 Dec. Com. 48.

The extension of a patent should not be denied because a previous English patent for the same invention has expired, if the specification in the latter was enrolled less than six months before the application was filed on which the American patent was granted. Apperly & Clissold, 2 Dec. Com. 163; John Neville, 2 Dec. Com. 167; Silas G. Putnam, 2 Dec. Com. 168.

Results are not patentable; therefore functional claims, or for results, are refused extension. Robert Dick, 2 O. G. 147.

An extension will be refused where the article did not involve invention, or was not new. P. A. Sabbaton, 2 O. G. 703; T. N. Lupton, 1 Dec. Com. 10; John M. Heck, 1 Dec. Com. 19; Samuel Pelton, 1 Dec. Com. 112; W. H. King, 2 Dec. Com. 79; Edwin *et al.*, 2 Dec. Com. 117; Matthew A. Crooker, 2 Dec. Com. 133; John Worsley, 2 Dec. Com. 176; B. T. Babbitt, 3 Dec. Com. 70; Gideon B. Massey, 3 Dec. Com. 213;



Lawton & Bliss, 3 O. G. 150; R. A. Stewart, 4 O. G. 665; Francis D. Ballou, 5 O. G. 29; H. H. King, 2 Dec. Com. 79.

An extension may be granted and the question of novelty left for the determination of the courts. A. J. Johnson, 1 O. G. 631.

If the courts have sustained the validity of a patent, and no new references are introduced to the notice of the office, the patent is regarded as unimpeachable, and will be extended. Henry Blandy, 2 O. G. 174; George Johnson, Adm'r, 2 Dec. Com. 86; W. W. Lewis, 3 O. G. 92.

If the novelty of the invention has been sustained by the courts, it will be assumed to have been satisfactorily established. Eli W. Blake, 1 O. G. 605.

The extension of a patent will be refused if it be found that the device patented is wanting in novelty, although it has been sustained in two suits at law in which that question was not raised. Mary J. Osborn, Adm'r, 2 Dec. Com. 80; Geo. B. Arnold, 5 O. G. 553.

The question whether an invention was sufficiently perfected when the patent was granted, having been considered at the time, and discussed upon trials in which the patent was sustained, should not be agitated anew upon an application for extension, without good reason. John E. Burrow, 1 Dec. Com. 48.

The novelty of an invention described in a patent for which an extension is prayed, can not be impeached upon the ground that it is described in another patent of nearly the same date, if the grantee in the latter patent has conceded in a written instrument that the applicant is the prior inventor. Thomas J. Chubb, 3 Dec. Com. 233.

An extension may be granted upon *ex parte* affidavits showing that the patentee was the first inventor, although a prior patent had been granted to another. Frederick Nishwitz, 1 O. G. 143.

If it is doubtful whether the inventions shown in a previous patent to the same party were perfected when the prior patent was applied for, an extension will be granted. John Tyler, 2 Dec. Com. 159.

The extension of a patent will be refused if it appears that the process and machine claimed in the reissues of the patent had been described in a prior printed publication. F. P. E. Carré, 4 O. G. 180.

The extension of a patent will be refused where the applicant has held a previous patent, embodying essentially the same principle. W. G. Creamer, 2 Dec. Com. 133; A. B. Latta, 3 O. G. 349.

Upon an application for extension, in determining whether the alleged invention is new or not, the consideration that the patent has been reissued, and has been extended, and has been sustained in litigation, is of especial weight. Calista E. Cox, 2 O. G. 491.

There can be no extension of an original patent when it has been reissued by the patentee himself, or if he has in any manner assented to such reissue. Henry H. Packer, 2 O. G. 31; Chas. G. Dickinson, 3 O. G. 91.

If one has failed to cure an insufficient specification by reissue during the life of the patent, an extension can not be allowed merely to afford an opportunity. George W. Morse, 6 O. G. 296.

Extended patents should contain only such matters as are proved valuable to the public, and the inventor has no right to an extension of what has no value, that subsequent inventors may not be embarrassed. C. W. Marsh, 2 O. G. 197; Thomas Allender, 1 Dec. Com. 46; Robert M. Wilder, 2 Dec. Com. 40; Darlington & Piper, 2 Dec. Com. 133; John L. Mason, 3 Dec. Com. 182; B. J. Lamothe, 3 Dec. Com. 201; Behr & Mongel, Adm'r, 3 O. G. 292.



If the patentee has made an application for a reissue which has been rejected, he can not ask for an extension on the ground that the invention contains a feature which might be covered by a reissue, where it is the same as that named in the application. Ezra Emmert, 1 O. G. 90.

It is sufficient if, upon an extension, devices are disclaimed, except when used in a certain combination which is new. James A. Woodbury, 1 Dec. Com. 86; Timothy Bailey, 1 Dec. Com. 93; Charles T. Eames, 2 Dec. Com. 47; R. M. Hoe, 2 Dec. Com. 68.

A patent may properly be extended with reference to features in the invention which are not covered by the claims, but which are capable of being embraced in a reissue. Ezra Emmert, 1 O. G. 90.

Phrases intended to extend the scope of an invention, although of genuine import, when they overreach the features of the device, can not be allowed in an extension. M. Smith, 2 O. G. 117; Benjamin F. Avery, 2 Dec. Com. 1.

If other conditions are favorable, it is the established practice of the commissioner to grant extensions of patents having only such defects as may be cured by reissue. Thomas J. Mayall, 4 O. G. 582.

A patent will be extended notwithstanding the claim is too broad, when there is not sufficient time to correct it by a reissue. Mary F. Crocker, Adm'x, 1 Dec. Com. 85.

### **Diligence.**

Where the inventors are themselves the manufacturers of their improvements, but have had their profits decreased by infringers introducing inferior machines into the market, and they have used due diligence in bringing them to justice, it can not be charged that their proper remuneration failed by reason of their own neglect or fault. Henry & F. J. L. Blandy, 2 O. G. 174; Lauriston Towne, 3 Dec. Com. 258; John W. Masury, 4 O. G. 1; Hosea Ball, 2 Dec. Com. 110.

An application for extension will be refused where the failure to receive proper remuneration has arisen mainly from applicant's own fault and neglect. John B. Read, 2 Dec. Com. 137; George W. Morse, 2 Dec. Com. 139.

A patent will not be extended where the patentee has not been diligent in introducing his invention, nor where the affidavits as to the value of the invention are general, and no data are furnished from which it can be estimated. Henry A. Rains, 2 Dec. Com. 82; George U. White, 2 Dec. Com. 160; G. W. Francis, 3 Dec. Com. 268; Wm. M. Draper, 3 O. G. 3.

The question of loyalty or disloyalty during the rebellion has no effect upon the status of the applicant, except so far as it pertains to the question of due diligence in introducing his invention into public use. Geo. W. Morse, 1 O. G. 489; Geo. W. Morse, 1 O. G. 607.

The extension will be refused if the patentee did not use due diligence to introduce the invention into public use. Samuel Falkenberg, 2 O. G. 3.

Extension will not be granted an applicant who has failed to receive a reasonable remuneration in consequence of suffering a foreign patent, previously granted, to run out before its regular determination. Robert Mushet, 2 Dec. Com. 106; Wm. E. Ward, 2 Dec. Com. 126; Jos. E. Boyer, 2 Dec. Com. 130.

**SEC. 4928.** The benefit of the extension of a patent shall extend to the assignees and grantees of the right to



use the thing patented, to the extent of their interest therein.

*Statute Revised*—July 8, 1870, ch. 230, § 67, 16 Stat. 209.

*Prior Statute*—July 4, 1836, ch. 357, § 17, 5 Stat. 124.

The extension of a patent is a new grant of the exclusive right or monopoly in the subject of the invention. All the rights of assignees or grantees, whether in a share of the patent or to a specified portion of the territory held under it, terminate and become reinvested in the patentee. This clause is a qualification of such exclusive right. It refers to those who are in the use of the patented article at the time of the extension, and is intended to save to them that right which, without the clause, would be vested again exclusively in the patentee. The phrase "thing patented" as used in the connection here found, with the right simply to use the thing patented, not the exclusive right, which would be a monopoly, necessarily refers to the patented machine and not to the invention, and indeed it is in that sense that the expression is to be understood generally throughout the patent law, when taken in connection with the right to use in contradistinction to the right to make and sell. The phrase "to the extent of their respective interests therein" refers to their interests in the thing patented, and, in connection with the right simply to use, means their interests in the patented machines, be that interest in one or more at the time of the extension. *Wilson v. Rousseau*, 4 How. 646; s. c. 1 Blatch. 3; s. c. 2 Robb 373; *Woodworth v. Sherman*, 3 Story 171; s. c. 2 Robb 257; *Wilson v. Turner*, 4 How. 712; *Taney* 278; s. c. 2 Robb 467.

If that interest was short of the whole of the original term for which the patent was originally issued, it is still to be bounded by it. But if it is an interest in terms designed to be coextensive with all the interest which the patentee now has or may hereafter acquire, not merely to his present rights *in esse*, but with his contingent rights *in posse*, then the section makes that a legal interest which otherwise would be but a mere potential equitable interest to be enforced in equity as a mere right under contract, and not as a fixed present vested interest. *Woodworth v. Sherman*, 3 Story 171; s. c. 2 Robb 257; *Brooks v. Bicknell*, 4 McLean 64.

When a patentee has made and vended to others to be used, one or more of the things patented, to that extent he parts with his exclusive right. He is entitled to but one royalty for a patented machine, and, consequently, when he has himself constructed a machine and sold it or authorized another to construct and sell it, or to construct and use and operate it, and the consideration has been paid to him for the right, he has then to that extent parted with his monopoly, and ceased to have any interest whatever in the machine so sold or so authorized to be constructed and operated. Where such circumstances appear, the owner of the machine, whether he built it or purchased it, if he has also acquired the right to use and operate it during the lifetime of the patent, may continue to use it until it is worn out in spite of any and every extension subsequently

obtained by the patentee or his assignee. *Bloomer v. Millinger*, 1 Wall. 340; *Blanchard v. Whitney*, 3 Blatch. 307; *Wooster v. Seidenberg*, 13 Blatch. 88; s. c. 9 O. G. 244; s. c. 2 Ban & Ard. 91; *Black v. Hubbard*, 12 O. G. 842.

The patentee under the extension is to be vested with the consequences of the acts of his predecessors. He takes the extension just as it falls to him on the expiration of the original patent from those holding under the original patent, and of course is not to be reinstated in all his original rights in every respect as they stood when the original patent was issued. *Goodyear v. Honsinger*, 3 Fish. 147; s. c. 2 Biss. 1.

The protection which the clause affords is limited to those who have a right to use, and in the construction and operation of the clause it should be limited to the exercise of that particular right, although the persons holding that right may also have held during the original term the exclusive right to use, to make and to vend. This right to use is protected, continued and secured only to the extent of the respective interests of such assignees and grantees therein. If the right to use before the extension was limited, it continues under this clause subject to the same limitation. *Day v. Union Rubber Co.*, 3 Blatch. 488; s. c. 20 How. 216.

If a licensee contracts to pay a royalty during the original term and any renewal thereof, he will not be released from his liability upon an extension of the patent. *Union Manuf. Co. v. Lounsbury*, 41 N. Y. 363; s. c. 42 Barb. 125.

If the licensor prohibits the licensee from granting the right to use a machine beyond the original term, a purchaser of a machine from the licensee can not use it during an extended term. Notice to the purchaser of this limitation is not necessary, as the law imposes upon the purchaser the risk as to whether the title of the vendor is such that he can make a valid conveyance as against the real owner. *Mitchell v. Hawley*, 4 Fish. 388; s. c. 6 Fish. 331; 16 Wall. 544; 1 O. G. 306; 3 O. G. 241; s. c. 1 Holmes 42.

If a party was not rightfully in the enjoyment of the thing patented during the original term of the patent, he has no right to use it during the extended term, unless he shows that the use is with the license, consent or knowledge of the patentee, or of some person authorized under him to convey the right. *Chaffee v. Boston Belting Co.*, 22 How. 217.

A party who buys a machine from an infringer, and then subsequently purchases a territorial right from the patentee, thereby acquires a lawful title to the machine, and may use it after the expiration of the patent. *Eunson v. Dodge*, 18 Wall. 414; s. c. 5 O. G. 95.

An assignee who holds the right to make and use the thing patented may continue to use it after the expiration of the patent, but can not make it for use or for any other purpose. *Wood v. Railroad Co.*, 3 Fish. 464; s. c. 2 Biss. 62; *Hodge v. Hudson River R. R. Co.*, 6 Blatch. 165; s. c. 3 Fish. 410.

Those who construct machines, or cause them to be constructed, under the authority of the patentee or his assigns, have the same rights as grantees or assignees. *Bloomer v. Millinger*, 1 Wall. 340.



This clause has no reference to the rights or interests of assignees and grantees under the new and extended term. *Wilson v. Rousseau*, 4 How. 646; s. c. 1 Blatch. 3; s. c. 2 Robb 373.

The terms of the clause are broad and general, and appropriate enough to secure the just rights of all who can be regarded as assignees or grantees of the right to use the patented invention, whether under a purchase of a machine, or a direct assignment or grant of a limited or unlimited right to use, and the equities of the case and the policy of the patent laws require that the clause should be so construed as to give such security. *Day v. Union Rubber Co.*, 20 How. 216; s. c. 3 Blatch. 488; *Woodworth v. Curtis*, 2 W. & M. 524; s. c. 2 Robb 603; *Woodworth v. Cook*, 2 Blatch. 151.

The term "the thing patented," as used in connection with the right simply to use, necessarily refers to the patented machine and not to the invention. A licensee of a patented process has no right to use the process after an extension of the patent. *Wetherill v. Zinc Co.*, 6 Fish. 50; s. c. 9 Phila. 385; 2 O. G. 471; *vide Day v. Union Rubber Co.*, 20 How. 216; s. c. 3 Blatch. 488.

Where a process requires a peculiar machine or apparatus for its practice, and the right to each is held by different persons under different patents, the right to use the machine will not give the right to use the process under an extension. *Wetherill v. Zinc Co.*, 6 Fish. 50; s. c. 9 Phila. 385; 2 O. G. 471.

The right to use the machine after the expiration of the term is not a mere personal right. It is a right of property. The value of it is attached to the thing used. The machine and the right attached to it may pass by sale, devise or levy of execution, or an assignment of an insolvent's effects. *Woodworth v. Curtis*, 2 W. & M. 524; s. c. 2 Robb 603.

Between repairing and replacing there is a difference. Form may be given to a piece of any material, so as to produce an original result, or to aid the efficiency of one already known, and that would be the subject for a patent. It would be the right of a purchaser to repair such a thing as that, so as to give to it what was its first shape, if it had been turned from it, or by filing, grinding or cutting, to keep it up to the performance of its original use. But if, as a whole, it should happen to be broken, so that its parts could not be readjusted, or so much worn out as to be useless, then a purchaser can not make or replace it by another, but he must buy a new one. The doing of either would be entire reconstruction. *Wilson v. Simpson*, 9 How. 109.

The right to repair may extend to a replacement of an essential part of a combination. It comprehends and permits the resupply of the effective ultimate tool of the invention, which is liable to be often worn out or to become inoperative for its intended effect, which the inventor contemplates would have to be frequently replaced anew during the time that the machine, as a whole, might last. The right to replace is not because the tool is of perishable materials, but because the inventor of the machine has so arranged it as a part of the combination that the machine can not

be continued in use without a succession of replacements at short intervals. Unless it were replaced the invention would be of but little use to the inventor or others. The other constituent parts of the invention may not be made with reference to any use of them which will require them to be replaced. These, without having a definite duration, are contemplated by the inventor to last so long as the materials of which they are formed can hold together in use in such combination. No replacement of them at intermediate intervals is meant or is necessary. They may be repaired as the use may require. With such intention they are put into the structure. So it is understood by a purchaser, and beyond the duration of them a purchaser of the machine has not a longer use. But if another constituent part of the combination is meant to be only temporary in the use of the whole, and to be frequently replaced, because it will not last as long as the other parts of the combination, the inventor can not complain, if he sells the use of the machine, that the purchaser uses it in the way the inventor meant it to be used, and in the only way in which the machine can be used. Such a replacement of temporary parts does not alter the identity of the machine, but preserves it, though there may not be in it every part of its original material. *Wilson v. Simpson*, 9 How. 109; *Farrington v. Commissioners*. 4 Fish. 216.

If the different parts of a machine are covered by separate patents, the purchase of a machine will not confer upon the purchaser the right to replace one of the parts when it is worn out. *Aiken v. Manchester Print Works*, 2 Cliff. 435.

When the material of a combination ceases to exist, in whatever way that may occur, the right to renew it depends upon the right to make the invention. If the right to make does not exist, there is no right to rebuild the combination. *Wilson v. Simpson*, 9 How. 109.

When the wearing or injury is partial, then the repair is restoration and not reconstruction. Repairing partial injuries, whether they occur from accident or from wear and tear, is only refitting a machine for use. *Wilson v. Simpson*, 9 How. 109.

A party who purchased a machine during the existence of the original patent is entitled to continue the use of it during the time for which the patent is extended by a special act of Congress, unless there is something in the language of the law requiring a different construction. *Bloomer v. McQuewen*, 14 How. 539; *Bloomer v. Millinger*, 1 Wall. 340; *Blanchard v. Whitney*, 3 Blatch. 307.

If there is no provision in a license beyond the term of the patent, and no condition is imposed by Congress in favor of the licensee in a special act extending a patent, he has no right under the patent after the expiration of the term. *Bloomer v. Stolley*, 5 McLean 158.

An assignee has no interest in an extension procured by a special act, unless his rights are expressly mentioned and reserved. *Gibson v. Gifford*, 1 Blatch. 529.



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

*Statute Revised*—July 8, 1870, ch. 230, § 71, 16 Stat. 209.

*Prior Statutes*—Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543.—March 2, 1861, ch. 88, § 11, 12 Stat. 248.

The patent allowed by this clause is simply for the design itself, and not for the means of producing the design. *Clark v. Beusfield*, 10 Wall. 133.

A patent for a new article of manufacture can not be construed to be a patent for a design. *Cone v. Morgan Envelope Co.*, 4 Ban & Ard. 107.

To entitle a party to the benefit of this provision, there must be an exercise of the inventive faculty. Mere mechanical skill is insufficient. There must be something akin to genius, an effort of the brain as well as the hand. *Northrup v. Adams*, 2 Ban & Ard. 567; s. c. 2 C. L. B. 84; *Wooster v. Crane*, 2 Fish. 583; s. c. 5 Blatch. 282.

To constitute an inventor of a design it is not necessary that the party should have the manual skill and dexterity to make the drafts. If the ideas are furnished by him for producing the result aimed at, he is entitled to avail of the mechanical skill of others to carry out his contrivance practically. *Sparkman v. Higgins*, 1 Blatch. 205.

It is essential to the validity of a patent for a design that it should be a new and original one, but the law does not require that it should be useful. *Miller v. Young*, 33 Ill. 354; *Adams & Westlake Manuf. Co. v. St. Louis Wire Goods Co.*, 12 O. G. 940; s. c. 3 Ban & Ard. 77; *Miller v. Smith*, 18 O. G. 1047; s. c. 5 Fed. Rep. 359; *Perry v. Starrett*, 3 Ban & Ard. 485; s. c. 14 O. G. 599.

To entitle a party to the benefit of the act there must be originality and the exercise of the inventive faculty. There must be originality and

beauty. Mere mechanical skill is insufficient. There must be something akin to genius—an effort of the brain as well as the hand. *Northrup v. Adams*, 12 O. G. 430.

A combination of old designs to be patentable must be such as to produce a new appearance. If the effect produced is simply the aggregation of familiar designs it is not patentable. *Northrup v. Adams*, 12 O. G. 430.

The adaptation of old devices or forms to new purposes, however convenient, useful or beautiful they may be in their new role, is not invention. *Northrup v. Adams*, 12 O. G. 430.

A beautiful appearance is not in itself patentable. The design must be new and original, and the work of invention and genius. *Ex parte Frederick G. Neidringhaus*, 8 O. G. 279; s. c. 2 *McArthur* 149.

A combination of old designs, to be patentable, must produce a new appearance. If the effect produced is simply an aggregation of the old designs, it is not patentable. *Northrup v. Adams*, 2 *Ban & Ard*. 567; s. c. 2 *C. L. B.* 84.

A mere design, which is practically a suggestion that a greater degree of inclination of the sides will make a billiard table more convenient, when other tables already existed which with a view to the same useful result in kind were constructed with a similar bevel, is not invention. *Collender v. Griffith*, 11 *Blatch*. 212; s. c. 3 O. G. 689.

A claim for a design for letters of the alphabet may embrace more than one letter. *Miller v. Smith*, 18 O. G. 1047.

A card for buttons divided by bands into spaces covered with foil is not patentable. *Pratt v. Rosenfeld*, 18 *Blatch*. 234; s. c. 5 *Ban & Ard*. 288; s. c. 3 *Fed. Rep.* 335.

If an article is manufactured by itself, it is a manufacture, although it is never used except in connection with other parts, and a new ornament for it is patentable. *Simpson v. Davis*. 12 *Fed. Rep.* 144.

The mere juxtaposition of old forms of ornaments is not patentable unless the parts when arranged constitute a single ornament. *Simpson v. Davis*, 12 *Fed. Rep.* 144.

If the arrangement of ornaments is new and useful, it is patentable, although the parts are old. *Simpson v. Davis*, 12 *Fed. Rep.* 144.

Although the parts are to a certain extent old, yet if they are made symmetrical of themselves and in respect to each other and connected together with appropriate devices and formed into a whole in a manner that can not be done without inventive genius, the design is patentable. *Perry v. Perry*, 14 O. G. 599.

The patent is *prima facie* evidence of both the novelty and utility of the design. *Lehnbetter v. Holthaus*, 105 U. S. 94; s. c. 21 O. G. 1783.

If the patent for a design is not put in evidence, the court can not, without knowing what is patented, adjudge it to be void for want of novelty. *Miller v. Young*, 33 *Ill.* 354.

The acts of Congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts. They contemplate not so much utility as appearance, and that not an abstract



impression or picture, but an aspect given to those objects mentioned in the acts. It is a new and original design for a manufacture, whether of metal or other material. A new and original design for a bust, statue, bas-relief, or composition in alto or basso rilievo; a new or original impression or ornament to be placed on any article of manufacture; a new and original design for the printing of woollen, silk, cotton, or other fabrics; a new and useful pattern, print or picture, to be either worked into or on any article of manufacture; or a new and original shape or configuration of any article of manufacture—it is one or all of these that the law has in view. The thing invented or produced for which a patent is given, is that which gives a peculiar or distinctive appearance to the manufacture or article to which it may be applied, or to which it gives form. The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public. It therefore proposes to secure for a limited time to the ingenious producer of those appearances, the advantages flowing from them. Manifestly, the mode in which those appearances are produced has very little, if anything, to do with giving increased salableness to the article. It is the appearance itself which attracts attention and calls out favor or dislike. It is the appearance itself, therefore, no matter by what agency caused, that constitutes mainly if not entirely the contribution to the public which the law deems worthy of recompense. The appearance may be the result of peculiarity of configuration or ornament alone or both conjointly, but in whatever way produced, it is the new thing or product which the patent law regards. To speak of the invention as a combination or process, or to treat it as such, is to overlook its peculiarities. As the acts of Congress embrace only designs applied or to be applied, they must refer to finished products of invention rather than to the process of finishing them, or to the agencies by which they are developed. A patent for a product is a distinct thing from a patent for the elements entering into it, or for the ingredients of which it is composed, or for the combination that causes it. In determining whether two designs are substantially the same, the controlling consideration is the resultant effect. *Gorham Manuf. Co. v. White*, 6 Fish. 94; s. c. 14 Wall. 511; 7 Blatch. 513; s. c. 2 O. G. 593.

To constitute an infringement, it is not essential that the appearance should be the same to the eye of an expert. Such a test would destroy all the protection which the statute intended to give. There never could be a piracy of a patented design, for human ingenuity has never yet produced a design in all its details exactly like another, so like that an expert could not distinguish them. No counterfeit bank note is so identical in appearance with the true that an experienced artist can not discern a difference. It is said an engraver distinguishes impressions made by the same plate. Experts, therefore, are not the persons to be deceived. Much less than that which would be substantial identity in their eyes would be undistinguishable in the eyes of men generally, of observers of ordi-

nary acuteness, who bring to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give. It is persons of the latter class who are the principal purchasers of the articles to which designs have given novel appearances, and if they are misled and induced to purchase what is not the article they supposed it to be, the patentee is injured, and that advantage of a market which the patent was granted to secure is destroyed. The purpose of the patent law must be effected if possible, but plainly it can not be if, while the general appearance of the design is preserved, minor differences of detail in the manner in which the appearance is produced, observable by experts, but not noticed by ordinary observers, are sufficient to relieve an imitating design from condemnation as an infringement. If in the eye of an ordinary observer, therefore, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other. *Gorham Manuf. Co. v. White*, 6 Fish. 94; s. c. 14 Wall. 511; 7 Blatch. 513; s. c. 2 O. G. 593; *Miller v. Smith*, 18 O. G. 1047; s. c. 5 Fed. Rep. 359; *Wood v. Dolby*, 20 O. G. 523; s. c. 19 Blatch. 214; s. c. 7 Fed. Rep. 476; *Werner v. Reinhardt*, 20 O. G. 1163; s. c. 10 Fed. Rep. 676; *Lehnbetter v. Holthaus*, 105 U. S. 94; s. c. 21 O. G. 1783.

The true test of identity of design is sameness of appearance, and mere difference of lines in the drawing or sketch, a greater or smaller number of lines, or slight variances in configuration, if insufficient to change the effect upon the eye, will not destroy the substantial identity. An engraving which has many lines may present to the eye the same picture, and to the mind the same idea or conception as another with much fewer lines. The design, however, would be the same. So, a pattern for a carpet or a print may be made up of wreaths of flowers arranged in a particular manner. Another carpet may have similar wreaths arranged in a like manner, so that none but very acute observers could detect a difference. Yet in the wreaths upon one there may be fewer flowers, and the wreaths may be placed at wider distances from each other. Surely in such a case the designs are alike. The same conception was in the mind of the designer, and to that conception he gave expression. *Gorham Manuf. Co. v. White*, 6 Fish. 94; s. c. 14 Wall. 511; 7 Blatch. 513; s. c. 2 O. G. 593; *Root v. Ball*, 4 McLean 177; s. c. 2 Robb 513; *Perry v. Perry*, 14 O. G. 599.

### **What may be Patented.**

A device which manifestly is intended for a trade-mark can not be patented as a design. *William White*, 3 Dec. Com. 304; *William King*, 2 Dec. Com. 109.

If a device relates wholly to its mechanical function, and not to ornamentation, an application for a design patent will be refused. *Charles A. Seaman*, 4 O. G. 691.

The ordinary use of an article is a controlling consideration in determining whether or not it presents proper subject-matter for a design patent. *Bloomfield Brower*, 4 O. G. 450.



A design is useful if it attracts persons to it or to articles made like it. Norton, 22 O. G. 1205.

An article of manufacture is useful if its shape or configuration is of such a character that persons needing it will purchase it because of its shape or configuration in preference to other articles for the same purpose, but different in shape and configuration. Norton, 22 O. G. 1205.

An inventor may obtain a patent for a design, although he has shown it in the drawings annexed to a mechanical patent previously obtained. Alois Palmer, 21 O. G. 1111; *contra*, Stuart & Bridge, 2 Dec. Com. 15; Kohler, 4 O. G. 53.

This section allows a patent for a design that is useful whether it is ornamental or not. Jason Crane, 1 Dec. Com. 7; William N. Bartholomew, 1 Dec. Com. 103; C. R. Fenno, 3 Dec. Com. 52; Shoeninger, 15 O. G. 384; *contra*, Peter C. Parkinson, 3 Dec. Com. 251.

An applicant for a design patent may claim the configuration without the ornamentation. Beattie, 16 O. G. 266.

A fanciful pattern to be wrought into or upon the article forming a part of it and giving to it a certain value by way of a new appearance, is the subject of a design patent. T. E. Parker, 13 O. G. 323.

The material used, or the mode in which an article is constructed, can not be monopolized under a patent for a design. Walter L. Tyler, 3 Dec. Com. 106.

An application for a patent for a product can not be changed into an application for a patent for a design. George H. Sellars, 2 Dec. Com. 58.

Where the function of a device enters into the claim, a patent for a design will not be given. J. F. Diffenderfer, 2 O. G. 57; Peter C. Parkinson, 3 Dec. Com. 251.

New shapes and configurations may be patented as designs, on account of their utility, when that is owing to their form. Wm. N. Bartholomew, 1 Dec. Com. 103.

An old form, when applied to a new article of manufacture, may be considered as a new design. Wm. N. Bartholomew, 1 Dec. Com. 103.

A *mere* substitution of one color for another possesses no element of originality, and indicates no exercise of genius, and can not, therefore, become the subject of a design patent. Phillip Weinberg, 3 Dec. Com. 244.

Designs which promote convenience and utility are embraced within the statute, as well as those which are merely ornamental. Jason Crane, 1 Dec. Com. 7; C. R. Fenno, 2 Dec. Com. 52.

When an alteration in any article is calculated to give it a better appearance merely, it can be protected only by a design patent. T. B. Oglesby, 3 O. G. 211.

### Practice.

If one claim covers the entire design, other claims may be inserted for combination of the several features. Beattie, 16 O. G. 266.

If a complete design consists of parts which are separable, the inventor may claim both parts in one patent. Rogers & Huggins, 13 O. G. 596.

A specification of a design must describe the shape or form of the article without reference to the materials, color or mechanical structure. Traitel, 25 O. G. 783.

Although the specification of a design patent embraces a description of the mode in which the article contemplated is constructed, it will not bar a separate patent for such construction. Wm. N. Bartholomew, 3 Dec. Com. 298.

There is no provision in the act relating to letters patent for designs which forbids the union of two or more claims or clauses of claim in a single patent. Isaac A. Sheppard, 2 Dec. Com. 22.

A claim for a part of a design can not be allowed unless it is a claim for an integral part. Pope, 25 O. G. 230.

All descriptions of the mechanical construction of the article should be eliminated in a design patent, as well as all reference to its purpose as a matter of utility. L. W. Fairchild, 3 O. G. 323.

If the specification and claim are deficient in the requirements of the law respecting clearness, exactness and particularity, an application for a design patent should not be entertained by the examiner. F. G. & W. F. Niedringhaus, 7 O. G. 171.

**SEC. 4930.** The commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs.

*Statute Revised*—July 8, 1870, ch. 230, § 72, 16 Stat. 210.

**SEC. 4931.** Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect.

*Statute Revised*—July 8, 1870, ch. 230, § 73, 16 Stat. 210.

*Prior Statutes*—Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543.—March 2, 1861, ch. 88, § 11, 12 Stat. 248.

An applicant for a design patent must elect, at the time of his application, the term for which he desires his patent to issue, and the payment of a fee corresponding to that election. Israel C. Mayo, 2 Dec. Com. 14.

**SEC. 4932.** Patentees of designs issued prior to the second day of March, eighteen hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries, issued prior to the second day of March, eighteen hundred and sixty-one.

*Statute Revised*—July 8, 1870, ch. 230, § 74, 16 Stat. 210.

*Prior Statute*—March 2, 1861, ch. 88, § 11, 12 Stat. 248.

Upon extending a patent for a design, its utility may be taken into account in estimating its value and importance to the public. B. L. Solomon, 1 Dec. Com. 49.



SEC. 4933. All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries, not inconsistent with the provisions of this title, shall apply to patents for designs.

*Statute Revised*—July 8, 1870, ch. 230, § 76, 16 Stat. 210.

If a design was on sale or in public use for more than two years prior to the application for a patent, it is void. *Theberath v. Rubber & C. H. T. Co.*, 23 O. G. 1121.

SEC. 4934. The following shall be the rates for patent fees :

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

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

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

On filing each caveat, ten dollars.

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

On filing each disclaimer, ten dollars.

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

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

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

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

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

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

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

*Statutes Revised*—July 8, 1870, ch. 230, §§ 68, 75, 16 Stat. 209, 210.—March 24, 1871, ch. 5, § 2, 17 Stat. 1.

*Prior Statutes*—April 10, 1790, ch. 7, § 7, 1 Stat. 112.—February 21, 1793, ch. 11, § 5, 11 Stat. 323.—July 4, 1836, ch. 357, §§ 4, 9, 11, 5 Stat. 118, 121.—March 3, 1839, ch. 88, § 8, 5 Stat. 354.—May 27, 1848, ch. 47, § 2, 9 Stat. 231.—March 2, 1861, ch. 88, § 10, 12 Stat. 248.—June 27, 1866, ch. 143, § 1, 14 Stat. 76.

SEC. 4934 A (Act of March 3, 1883, Ch. 143, 22 Stat. 625). The Secretary of the Interior and the Commissioner of Patents are authorized to grant any officer of the government, except officers and employes of the patent office, a patent for any invention of the classes mentioned in section forty-eight hundred and eighty-six of the Revised Statutes, when such invention is used or to be used in the public service, without the payment of any fee: *Provided*, That the applicant in his application shall state that the invention described therein, if patented, may be used by the government or any of its officers or employes in the prosecution of work for the government, or by any other person in the United States, without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

SEC. 4935. Patent fees may be paid to the commissioner of patents, or to the treasurer or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the patent office, for any purpose, or from any source whatever, shall be paid into the treasury as received, without any deduction whatever.

*Statute Revised*—July 8, 1870, ch. 230, § 69, 16 Stat. 209.

*Prior Statutes*—March 3, 1837, ch. 45, § 14, 5 Stat. 194.—July 20, 1868, ch. 177, § 7, 15 Stat. 119.



**SEC. 4936.** The treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the treasury, or to any receiver or depository, to the credit of the treasury, as for fees accruing at the patent office, upon a certificate thereof being made to the treasurer by the commissioner of patents.

*Statute Revised*—July 8, 1870, ch. 230, § 69, 16 Stat. 209.

*Prior Statute*—August 29, 1842, ch. 263, § 1, 5 Stat. 543.

## CHAPTER TWO.

### TRADE-MARKS.

Sec.	Sec.
4937. Registration of trade-marks authorized.	4945. Penalty for false registration of trade-mark.
4938. Accompanying declaration under oath.	4946. Former rights and remedies preserved.
4939. Restriction on the registration of trade-marks.	4947. Saving as to rights after expiration of term for which a trade-mark has been registered.
4940. Certificates of registry.	4947A. Regulations for transfer of rights to trade-marks.
4941. Duration of protection of registered trade-marks and renewals.	4947B. Registration to procure registration abroad.
4942. Credit for fee.	4947c. Protection of prior rights.
4943. Penalty for counterfeiting trade-mark.	
4944. Restriction upon actions for infringements.	

SEC. 4937 (Act of March 3, 1881, ch. 138, sec. 1, 22 Stat. 504). That owners of trade-marks used in commerce with foreign nations, or with the Indian tribes, provided such owners shall be domiciled in the United States, or located in any foreign country or tribes which by treaty, convention or law, affords similar privileges to citizens of the United States, may obtain registration of such trade-marks by complying with the following requirements:

First. By causing to be recorded in the Patent Office a statement specifying name, domicile, location, and citizenship of the party applying; the class of merchandise and the particular description of goods comprised in such class to which the particular trade-mark has been appropriated; a description of the trade-mark itself, with fac-similes thereof, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade-mark has been used.



Second. By paying into the Treasury of the United States the sum of twenty-five dollars, and complying with such regulations as may be prescribed by the Commissioner of Patents.

### Construction.

The statute does not define the word "trade-mark," or say of what it shall consist. The term is used as though its signification were already well known in the law. Resort must therefore be had to the law outside of the statute, to ascertain what is or what may become a lawful trade-mark. *Moorman v. Hoge*, 2 Saw. 78.

If an arbitrary mark or device has been so long used in connection with an article of manufacture that it has become well known to the trade as designating a particular person's goods, it constitutes a lawful trade-mark. *Morrison v. Case*, 9 Blatch. 548; s. c. 2 O. G. 544.

A simple illustration of a crown in connection with an article, to designate its origin and ownership, is a lawful trade-mark. *Smith v. Reynolds*, 10 Blatch. 100; s. c. 3 O. G. 216.

The name of a town joined to the name of an article is not a legal trade-mark, nor can it be made so by adding the name and place of business of the manufacturer. *Armistead v. Blackwell*, 1 O. G. 603.

The word "centennial" applied to medals generally, is not a good trade-mark. *Hartell v. Vinez*, 2 W. N. 602.

A barrel of peculiar form and dimensions, without any marks, symbols, or devices of any kind impressed upon or connected with it, can not become a trade-mark or a substantive part of a trade-mark. *Moorman v. Hoge*, 2 Saw. 78.

A party can not claim an ornamented tin pail, when used to contain a certain article, as a trade-mark. *Harrington v. Libby*, 14 Blatch. 188; s. c. 12 O. G. 144; s. c. 4 A. L. T. (N. S.) 47.

A manufacturer can not by registering straight lines intersecting each other prevent another from using similar intersecting lines to indicate where the article must be cut in order to cut off a certain quantity. *Dausman & D. T. Co. v. Ruffner*, 15 O. G. 559.

If a trade-mark is claimed by a firm, it is sufficient to give the name of the firm, without giving the names of the individual members. *Smith v. Reynolds*, 10 Blatch. 100; s. c. 3 O. G. 216.

A statement of the number in the street, the city, county, and State where the firm is, is a sufficient statement of the residence and place of business of the firm. *Smith v. Reynolds*, 10 Blatch. 100; s. c. 3 O. G. 216.

If a person is engaged in the manufacture and sale of paints generally, a designation of paints as the class of goods intended to be covered by the trade-mark is sufficient without further specification. *Smith v. Reynolds*, 10 Blatch. 100; s. c. 3 O. G. 216.

If different parties claim the same trade-mark, the commissioner may declare an interference between them. *Hanford v. Westcott*, 16 O. G. 1181.

A decision by the commissioner on an interference is conclusive in a subsequent action between the same parties or their privies. *Hanford v. Westcott*, 16 O. G. 1181.

SEC. 4938 (Act of March 3, 1881, ch. 138, § 2, 22 Stat. 503). That the application prescribed in the foregoing section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified by the person, or by a member of a firm, or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trade-mark sought to be registered, and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce with foreign nations or Indian tribes, as above indicated; and that the description and fac-similes presented for registry truly represent the trade-mark sought to be registered.

#### **Construction.**

The oath annexed to an application for a trade-mark is sufficient, although the seal of the notary is not attached, if that formality is not required by the law of the place where it was administered. *Cochran, McLean & Co.*, 2 O. G. 520.

The statute does not require that the applicant's oath shall be in the exact words of the section. *Vibbard & Sheehan*, 8 O. G. 143.

If an applicant has not complied specifically with all the requirements of the statute, he will not be entitled to the registration of a trade-mark. *Hankinson*, 8 O. G. 89.

The law is as imperative in requiring a *description* of the trade-mark as in requiring a fac-simile thereof, and one will not supply the omission of the other. *Volta Belt Company*, 8 O. G. 144.

SEC. 4939 (Act of March 3, 1881, ch. 138, § 3, 22 Stat. 503). That the time of the receipt of any such application shall be noted and recorded. But no alleged trade-mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign commerce or commerce with Indian tribes as above mentioned,



or is within the provision of a treaty, convention, or declaration with a foreign power; nor which is merely the name of the applicant; nor which is identical with a registered or known trade-mark owned by another and appropriate to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers. In an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark; and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases.

### Construction.

The proceeding before the commissioner is purely *ex parte*. Other parties have no notice, actual or constructive. The decision of the commissioner is not conclusive that the party is entitled to a trade-mark. *Moorman v. Hoge*, 2 Saw. 78.

If a person has registered a trade-mark for a certain article generally, and the same symbol had been in use before he adopted it for certain descriptions thereof, the registration is void, for it is broader than his right. *Smith v. Reynolds*, 10 Blatch. 100; s. c. 3 O. G. 216.

A party who purchases a trade-mark from one partner can not have it registered, for he has not an exclusive right to use it. *Armistead v. Blackwell*, 1 O. G. 603.

No person is entitled to a trade-mark in a numeral which only indicates but does not express the quality of the goods. *Kinney v. Allen*, 1 Hughes 106; s. c. 4 A. L. T. (N. S.) 258.

If a person uses a numeral of a certain form, size, color and style, he may be entitled to use that as a trade-mark. *Kinney v. Allen*, 1 Hughes 106; s. c. 4 A. L. T. (N. S.) 258.

The commissioner may refuse to register alleged trade-marks which are clearly not valid. *Kipling*, 24 O. G. 899.

Parties who employ a word in an experimental way in five or six instances only, do not thereby gain a title to it as a trade-mark, in opposition to one who has, in the meantime, adopted it and put it into general use. *Sternberger v. Thalheimer*, 3 O. G. 120.

A person who is the first to preserve and can an article is not entitled to a trade-mark in the name by which the article has been previously known. *Ams*, 23 O. G. 344.

He who was the first to actually adopt and use a trade-mark for the purpose of indicating ownership or proprietorship of the articles to which the mark is applied, is entitled to it as against the person who was the first to suggest and urge its adoption. *Swift v. Peters*, 11 O. G. 1110.

The law does not require a description of every actual and possible matter that can be used in connection with the mark. The thing of value in the matter of registration is the trade-mark itself. No protection is afforded for the use of scrolls, fanciful figures, or other words which are not an essential part of the mark, and a full description of them will not be allowed. *William S. Kimball*, 11 O. G. 1109.

The production of a judgment establishing the validity of the trade-mark is not essential. The fact that the trade-mark was rightfully in use on the eighth day of July, 1870, may be established by the affidavits of disinterested parties, who have knowledge of the facts, setting forth the length of time the mark has been in notorious use, whether or not it has obtained a commercial value, and is considered by the trade as an indication of the origin and ownership of the articles to which it is affixed. *Rubber Clothing Co.*, 10 O. G. 111.

The right to registration is founded on the adoption of a proper trade-mark, not the property of another party, and the declared intention to use it. *Rothschild*, 7 O. G. 220.

It is no bar to the registry of a trade-mark that it has already been used as such on articles of a different character. *R. W. English*, 2 Dec. Com. 142.

It is only necessary that trade-marks shall be so far original as that when known in the market the goods of one merchant or manufacturer may be distinguished from those of another. *Porter Blanchard's Sons*, 3 Dec. Com. 97; *R. J. Roberts*, 3 Dec. Com. 100; *Dutcher Temple Co.*, 3 Dec. Com. 248; *George E. Glines*, 8 O. G. 435; *Robert Rohland*, 10 O. G. 980.

A trade-mark that is descriptive can not be registered. *Smith*, 16 O. G. 679; *Cohn*, 16 O. G. 680; *Strasburger & Co.*, 20 O. G. 155.

A word which is descriptive of the quality of the article can not be used as a trade-mark. *Goodyear Rubber Co.*, 11 O. G. 1062; *Dole Brothers*, 12 O. G. 939.

A word which is merely inferentially or remotely descriptive may be registered as a trade-mark. *Heyman*, 18 O. G. 922.

The word "crystalline" can not be registered as a trade-mark for artificial stones, because it is descriptive. *Kipling*, 24 O. G. 899.

A barrel constructed of light and dark staves alternately can not be registered as a trade-mark for packages of flour, for it is descriptive. *Halliday Bros.*, 16 O. G. 500.

A device which does not perform the sole office of a trade-mark, but enters into the mechanical structure of the article, can not be registered as a trade-mark. *Jacob Gordon*, 12 O. G. 517.

The word "evaporated" is at once generic and descriptive and can not be registered. *Alden*, 15 O. G. 389.

The word "safety" cannot be registered as a trade-mark applicable to powder, fuse lighters and explosive caps, for it is descriptive. *Safety Powder Co.*, 16 O. G. 136.

The word "swing" cannot be registered as a trade-mark applicable to the socket of a scythe snath. *Thompson, Derby & Co.*, 16 O. G. 137.

A simple outline figure surrounding words purely descriptive of the quality of the article can not be registered as a trade-mark. *G. W. Rader & Co.*, 13 O. G. 596.



A word which has been registered by another can not be registered as an essential element in a trade-mark. *Strasburger & Co.*, 20 O. G. 155.

The minor non-essential elements of a composite symbol of trade can not be registered as a trade-mark. *Coats*, 16 O. G. 544.

A combination of two symbols can not be registered if each has been previously registered separately. *Smith*, 16 O. G. 679.

A representation of a kernel of corn and the word "corn" can not be joined in one registration as a trade-mark. *Peper*, 16 O. G. 678.

A combination of two symbols may be registered, although another has previously registered one of them as a trade-mark for the same article. *Cornwall et al.*, 12 O. G. 138.

If a trade-mark is so nearly like that owned by another as to mislead the public, it can not be registered. *Coggin, Kidder & Co.*, 11 O. G. 1109.

An arbitrary combination of numerals, having no other meaning than to distinguish the applicant's goods in the market and indicate to purchasers that all goods having this mark have one and the same origin, may be used as a trade-mark. *Dawes & Fanning*, 1 O. G. 27.

The designation "lion," whether used pictorially, or written or printed, is a lawful trade-mark for a medicine for a particular disease. *P. G. Weaver*, 10 O. G. 1.

The registration of the mere name of a person, firm, corporation, place, or article, or a word or words indicating kind or quality, will be refused. *Rowe & Post*, 9 O. G. 496; *Dundas, Dick & Co.*, 9 O. G. 538; *Roach*, 10 O. G. 333; *Eagle Pencil Co.*, 10 O. G. 981.

If a person succeeds another in business he may register his name in connection with an arbitrary symbol as a trade-mark. *Friberg & Workum*, 20 O. G. 1164.

The name of a person can not be registered as a trade-mark without his consent. *Sullivan v. Burke*, 16 O. G. 765

A trade-mark which consists merely of the name of the applicant can not be registered. *Fairchild*, 21 O. G. 789.

The name of a person can not be registered as a trade-mark, although it is accompanied by a mark sufficient to distinguish it from the same name when used by others. *Adriance Platt & Co.*, 20 O. G. 1820.

If the name of a patentee has become a generic name to describe the thing patented, the owner of the patent can not have the name registered as a trade-mark. *Consolidated Fruit Jar Co.*, 14 O. G. 269.

If a patentee has several patents for similar articles, an owner of one patent can not have the name registered as a trade-mark. *Consolidated Fruit Jar Co.*, 14 O. G. 269.

The assignee of a trade-mark may have it registered, although it was connected with a patent. *Consolidated Fruit Jar Co.*, 16 O. G. 679.

A geographical name can not be registered as a trade-mark. *Farnum & Co.*, 18 O. G. 413.

A geographical name can not be registered as a trade-mark, although it is joined with something else. *Farnum & Co.*, 18 O. G. 413.

The name of a foreign place which is neither descriptive nor deceptive, but used in a merely fanciful signification, may be registered as a trade-mark. *Cornwall Brothers*, 12 O. G. 312.

The word "London" can not be registered as a trade-mark if its application is descriptive or deceptive. *Knapp*, 16 O. G. 318.

The word "Raleigh" can not be registered as a trade-mark for manufactured tobacco. *Oliver*, 18 O. G. 923.

An unlawful grant of a registration to one party is no reason why an unlawful grant of a registration of the same trade-mark should be made to another. *Wright v. Simpson*, 15 O. G. 968.

A trade-mark can not be registered to be used on "fancy goods," for the term has no well-known and ascertained meaning. There is therefore no practical or substantial limitation of the use. *George Lisner*, 13 O. G. 455.

If a name which originated with a party has been so frequently used that it has become generic to denote a certain article, it can not be registered. *J. H. Hall & Co.*, 13 O. G. 229.

If a party having a trade-mark on a class of goods concedes that another is entitled to it on a particular description, the latter may have his registered. *Sorg v. Welsh*, 16 O. G. 910.

If the application does not set forth a lawful trade-mark, the applicant can not amend it by introducing a new trade-mark that is lawful. *Elias Block & Co.*, 14 O. G. 235.

The applicant must designate the particular nation or Indian tribe in commerce with which the trade-mark has been used. *Strasburger & Co.*, 20 O. G. 155.

The symbols and emblems of secret or other organizations may be registered as a trade-mark. *W. C. Thomas*, 14 O. G. 821.

The word "Masonic" can not be registered as a trade-mark. *Smith*, 16 O. G. 764.

If the use of a name is entirely fanciful and arbitrary, the name may be registered as a trade-mark. *Pace, Talbott & Co.*, 16 O. G. 909.

A waved band of ribbon attached to a cigar box may be registered as a trade-mark. *Stratton & Storm*, 18 O. G. 923.

If the applicant files a fac-simile of his trade-mark, the language of his description is restricted to such a symbol as will conform to the fac-simile. *Duke v. Green*, 16 O. G. 1094.

A likeness of a kernel of corn is not a fac-simile of the word "corn." *Peper*, 16 O. G. 678.

If one partner after the dissolution of a firm alone continues to use it upon the same article, he is entitled to have it registered. *Simpson v. Wright*, 15 O. G. 248.

If a firm which has acquired a trade-mark is dissolved, each becomes a tenant in common thereof, although one possesses the secret of manufacturing the article and neither is entitled to a registration. *Wright v. Simpson*, 15 O. G. 968.

When matter that is the proper subject of a trade-mark is apparently claimed by another, the applicant must establish his right to it before he can have it included in a register of a label. *Jno D. Park*, 12 O. G. 2.

If it appears that each party to an interference is entitled to an undivided half of a trade-mark, the applicant can not obtain a registration, for the law grants registration only to those entitled to the exclusive use of a trade-mark. *McElwee v. Blackwell*, 15 O. G. 658.

The word "French" to be applied to bronze paints can not be registered as a trade-mark, for it tends to deceive the public. *J. Marsching & Co.*, 15 O. G. 294.

If one party has registered the word "swan" as a trade-mark, another party can not have the words "black swan" registered as a trade-mark, for it tends to deceive the public. *Jules E. Caire*, 15 O. G. 248.

If a trade-mark so nearly resembles a prior trade-mark that has been registered as to be calculated to deceive the public, it can not be registered. *Weisert Bros.*, 16 O. G. 680.



An applicant whose application for a trade-mark is refused can not have the fee refunded. *Elias Block & Co.*, 14 O. G. 235.

A newly coined word may be registered as a trade-mark, though it is suggestive of the material from which the article stamped with it is made. *Francis & Mallon*, 3 Dec. Com. 283.

A person has no right to employ a sign or symbol which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore with equal right. *Pratt & Farmer*, 10 O. G. 866.

Generic names and words descriptive of quality are common property, and no one has a right to an exclusive use of them. *C. L. Hawthaway*, 3 Dec. Com. 284; *Solon Palmer*, 3 Dec. Com. 289; *C. E. Richardson et al.*, 3 O. G. 120.

Initial letters add nothing to a phrase which is not a lawful trade-mark without them; neither does the addition of a date help it any. *J. G. Johnson & Co.*, 2 O. G. 315; *Blakeslee & Co.*, 3 Dec. Com. 284.

Where the only essential portion of the trade-mark is descriptive and not distinguishing, registration should be denied. *B. Graham*, 2 O. G. 618; *C. L. Hawthaway & Sons*, 3 Dec. Com. 97; *Robert J. Roberts*, 3 Dec. Com. 113; *E. Kane & Co.*, 9 O. G. 105; *Dundas, Dick & Co.*, 9 O. G. 538.

Every emblem or device that can not be divested of its ordinary signification, and would be either descriptive or deceptive, is unlawful as a trade-mark. *John F. Tolle*, 2 O. G. 415; *The American Sardine Co.*, 3 O. G. 495; *American Lubricating Oil Co.*, 9 O. G. 687; *Bennage v. Phillippi*, 9 O. G. 1159.

A compound trade-mark, one of whose distinguishing features has already been appropriated and registered by another as applied to the same class of merchandise, can not be registered. *J. Bush & Co.*, 10 O. G. 164.

It is no objection to a trade-mark that the several parts of which it is composed have been used separately, provided it is so distinct as not to deceive or mislead the public. *Joseph P. Imbs*, 10 O. G. 463.

It is sufficient if a trade-mark has an original and a distinctive signification as appertaining to the article. *India Rubber Comb Co.*, 8 O. G. 905.

Phrases which are merely descriptive of the quality of the article, or its destined use, can not be registered as trade-marks. *Lawrence & Co.*, 10 O. G. 163; *Edward Warburg & Co.*, 13 O. G. 44.

An applicant for the registration of a trade-mark may include in his specification either a whole class of merchandise or several specified descriptions thereof. *Frank Boehm & Co.*, 8 O. G. 319.

If an individual permanently ceases to use his trade-mark, and consents to its use and adoption by another, he relinquishes his right to it. *Kidd & Co.*, 5 O. G. 337.

If two or more applicants claim the same trade-mark, the matter may be referred to the Examiner of Interferences. *Duke v. Green*, 16 O. G. 1094.

On an interference proceeding the inquiry may extend to the ownership of the trade-mark as well as the priority of adoption. *Hoosier Drill Co. v. Ingels*, 14 O. G. 785.

An interference in trade-mark cases can properly be declared in accordance with the usual practice governing interference cases between applicants for patents. *Lautz Bros. v. Schultz*, 9 O. G. 791; *McElwee*, 13 O. G. 963.

If the applicant is not entitled to the trade-mark, it is not necessary to determine whether another is or not. *Swift v. Peters*, 11 O. G. 1110.

Although a party shows that he once used a trade-mark, yet he must show a continuous use in order to establish a present right to it. *Jacobs v. Lopez*, 23 O. G. 342.

In the absence of evidence, the party who files the first application is entitled to a trade-mark. *Jacobs v. Lopez*, 23 O. G. 342.

SEC. 4940 (Act of March 3, 1881, ch. 138, § 4, 22 Stat. 503). That certificates of registry of trade-marks shall be issued in the name of the United States of America, under the seal of the Department of the Interior, and shall be signed by the commissioner of patents, and a record thereof, together with printed copies of the specifications, shall be kept in books for that purpose. Copies of trade-marks and of statements and declarations filed therewith and certificates of registry so signed and sealed shall be evidence in any suit in which such trade-marks shall be brought in controversy.

#### Construction.

A certified copy is evidence only that what is shown by it to have been filed was filed. It is not evidence that anything required by the statute to be filed, and not shown by the certificate or by the statement annexed to it to have been filed, was filed. A general certificate of the commissioner can not be taken as evidence that the requirements of the law have been met. *Smith v. Reynolds*, 10 Blatch. 85; s. c. 3 O. G. 213.

The statement required by the statute is a separate and distinct thing from the declaration, and when the statute speaks of certified copies of the statement, it does not thereby include the declaration. *Walker v. Reid*, 2 C. L. B. 133.

A certificate which gives a copy of the statement and shows that a declaration was filed, is sufficient. *Walker v. Reid*, 2 C. L. B. 133.

SEC. 4941 (Act of March 3, 1881, ch. 138, § 5, 22 Stat. 503). That a certificate of registry shall remain in force for thirty years from its date; except in cases where the trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of a foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act at the time that such trade-mark



ceases to be exclusive property elsewhere. At any time during the six months prior to the expiration of the term of thirty years such registration may be renewed on the same terms and for a like period.

SEC. 4942 (Act of March 3, 1881, ch. 138, § 6, 22 Stat. 503). That applicants for registration under this act shall be credited for any fee, or part of a fee, heretofore paid into the Treasury of the United States with intent to procure protection for the same trade-mark.

SEC. 4943 (Act of March 3, 1881, ch. 138, § 7, 22 Stat. 503). That registration of a trade-mark shall be *prima facie* evidence of ownership. Any person who shall reproduce, counterfeit, copy or colorably imitate any trade-mark registered under this act and affix the same to merchandise of substantially the same descriptive properties as those described in the registration, shall be liable to an action on the case for damages for the wrongful use of said trade-mark, at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade-mark used in foreign commerce or commerce with Indian tribes, as aforesaid, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful act; and courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy.

#### Construction.

If the trade-mark is for a combination, there is no infringement unless the whole combination is used. *Tucker Manuf. Co. v. Boyington*, 9 O. G. 455.

If a person who has acquired the exclusive use of a mark for particular kinds of paints, obtains a registration of it as a trade-mark for paints generally, this will not enable him to restrain another from its use upon certain paints to which he had been in the habit of affixing the same mark prior to registration. *Smith v. Reynolds*, 13 Blatch. 458.

The protection given by the statute is to the exclusive use of the trade-mark only so far as regards the particular description of goods set forth in

the filed statement as the particular description of goods to or by which the trade-mark has been or is intended to be appropriated. *Osgood v. Rockwood*, 11 Blatch. 310.

It is always a matter of discretion whether to issue an injunction or not in a trade-mark case. *Tucker Manuf. Co. v. Boyington*, 9 O. G. 455.

An alien who brings an action for a violation of his rights under a registered trade-mark need not allege the existence of a treaty between the United States and his country. *Fils v. Sarrazin*, 15 Fed. Rep. 489.

SEC. 4944 (Act of March 3, 1881, ch. 138, § 8, 22 Stat. 504). That no action or suit shall be maintained under the provisions of this act in any case where the trade-mark is used in any unlawful business, or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or under any certificate of registry fraudulently obtained.

SEC. 4945 (Act of March 3, 1881, ch. 138, § 9, 22 Stat. 504). That any person who shall procure the registry of a trade-mark, or of himself as the owner of a trade-mark or an entry respecting a trade-mark, in the office of the Commissioner of Patents, by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence thereof to the injured party, to be recovered in an action on the case.

SEC. 4946 (Act of March 3, 1881, ch. 138, § 10, 22 Stat. 504). That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this act had not been passed.

### Construction.

A person may maintain an action for infringement of a trade-mark, although it has not been recorded at the patent office, for a trade-mark is property independently of the statute. The act is not obligatory. It offers to manufacturers an opportunity to have their trade-marks recorded, but imposes no penalty or forfeiture of right for neglect to so record them. *Rodgers v. Philp*, 1 O. G. 29.



The recording of a trade-mark does not convey any higher rights than the owner had independently of the statute. *Popham v. Wilcox*, 14 Abb. Pr. (N. S.) 206.

SEC. 4947 (Act of March 3, 1881, ch. 138, § 11, 22 Stat. 504). That nothing in this act shall be construed as unfavorably affecting a claim to a trade-mark after the term of registration shall have expired; nor to give cognizance to any court of the United States in an action or suit between citizens of the same State, unless the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe.

SEC. 4947 A (Act of March 3, 1881, ch. 138, § 12, 22 Stat. 504). That the Commissioner of Patents is authorized to make rules and regulations and prescribe forms for the transfer of the right to use trade-marks and for recording such transfers in his office.

#### **Construction.**

A stipulation that any breach of the contract by one party shall release the other party from all obligation under the contract, merely enlarges the right of rescission, but does not enable the party to enjoy the fruits of the contract without compensation where he does not elect to rescind, if the stipulation so broken was not so essential to the contract but that the breach can be compensated by damages. *Coe v. Bradley*, 9 O. G. 541.

When a licensee of a trade-mark is sued for the royalty, he is estopped from proving the invalidity of the trade-mark. *Hilsen v. Libbey*, 44 N. Y. Sup. 12.

SEC. 4947 B (Act of March 3, 1881, ch. 138, § 13, 22 Stat. 504). That citizens and residents of this country wishing the protection of trade-marks in any foreign country, the laws of which require registration here as a condition precedent to getting such protection there, may register their trade-marks for that purpose as is above allowed to foreigners, and have certificate thereof from the Patent Office.

SEC. 4947 c (Act of Aug. 5, 1882, ch. 393, 23 Stat. 298). That nothing contained in the law entitled "An act to authorize the registration of trade-marks and protect the same," approved March third, eighteen hundred and eighty-one, shall prevent the registry of any lawful trade-mark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act.



## CHAPTER THREE.

### COPYRIGHTS.

Sec.	Sec.
4948. Copyrights to be under charge of librarian of Congress.	4960. Penalty for omission.
4949. Seal of office.	4961. Postmasters to give receipts.
4950. Bond of librarian.	4962. Publication of notice of entry for copyright prescribed.
4951. Annual report.	4962 <sub>A</sub> . Copyright mark on designs.
4952. What publications may be entered for copyright.	4963. Penalty for false publication of notice of entry.
4952 <sub>A</sub> . Registration of prints and labels.	4964. Damages for violation of copyright of books.
4953. Term of copyrights.	4965. For violating copyright of maps, charts, prints, &c.
4954. Continuance of term.	4966. For violating copyright of dramatic compositions.
4955. Assignment of copyrights and recording.	4967. Damages for printing or publishing any manuscript without consent of author, &c.
4956. Deposit of title and published copies.	4968. Limitation of action in copyright cases.
4957. Record of entry and attested copy.	4969. Defences to action in copyright cases.
4958. Fees.	4970. Injunctions in copyright cases.
4958 <sub>A</sub> . Fee for recording and certifying assignments.	4971. Aliens and non-residents not privileged.
4959. Copies of copyright works to be furnished to librarian of Congress.	

SEC. 4948. All records and other things relating to copyrights and required by law to be preserved, shall be under the control of the librarian of Congress, and kept and preserved in the library of Congress; and the librarian of Congress shall have the immediate care and supervision thereof, and, under the supervision of the joint committee of Congress on the library, shall perform all acts and duties required by law touching copyrights.

*Statute Revised*—July 8, 1870, ch. 230, § 85, 16 Stat. 212.

*Prior Statute*—February 5, 1859, ch. 22, § 8, 11 Stat. 380.

SEC. 4949. The seal provided for the office of the librarian of Congress shall be the seal thereof, and by it all records and papers issued from the office and to be used in evidence shall be authenticated.

*Statute Revised*—July 8, 1870, ch. 230, § 85, 16 Stat. 212.

SEC. 4950. The librarian of Congress shall give a bond, with sureties, to the treasurer of the United States in the sum of five thousand dollars, with the condition that he will render to the proper officer of the treasury a true account of all moneys received by virtue of his office.

*Statute Revised*—July 8, 1870, ch. 230, § 85, 16 Stat. 212.

SEC. 4951. The librarian of Congress shall make an annual report to Congress of the number and description of copyright publications for which entries have been made during the year.

*Statute Revised*—July 8, 1870, ch. 230, § 85, 16 Stat. 212.

SEC. 4952. Any citizen of the United States or resident therein, who shall be the author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph, or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of the models or designs intended to be perfected as works of the fine arts, and the executors, administrators, or assigns of any such person shall, upon complying with the provisions of this chapter, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing and vending the same; and, in the case of a dramatic composition, of publicly performing or representing it, or causing it to be performed or represented by others. And authors may reserve the right to dramatize or to translate their own works.

*Statute Revised*—July 8, 1870, ch. 230, § 86, 16 Stat. 212.

*Prior Statutes*—May 31, 1790, ch. 15, § 1, 1 Stat. 124.—April 29, 1802, ch. 33, § 2, 2 Stat. 171.—February 3, 1831, ch. 16, § 1, 4 Stat. 436.—August 18, 1856, ch. 169, § 1, 11 Stat. 138.—March 3, 1865, ch. 126, § 1, 13 Stat. 540.



### Subjects of Copyright.

The provisions of this section in relation to photographs are constitutional. *Sarony v. Burrow G. L. Co.*, 17 Fed. Rep. 591; *Schreiber v. Thornton*, 17 Fed. Rep. 603; s. c. 15 C. L. N. 424.

The statute was passed for the encouragement of learning, and was not intended for the encouragement of mere industry, unconnected with learning or science. *Clayton v. Stone*, 2 Paine 382.

Literary merit is not a necessary element of a legal copyright. *Drury v. Ewing*, 1 Bond 540.

The word "chart" as used in this section refers to a form of map. *Ehret v. Pierce*, 18 Blatch. 302; s. c. 10 Fed. Rep. 553.

An advertising card used to display the different colors of paints is not a subject of copyright. *Ehret v. Pierce*, 18 Blatch. 302; s. c. 10 Fed. Rep. 553.

Blank account books are not the subject of copyright. *Baker v. Selden*, 101 U. S. 99; s. c. 17 O. G. 1029.

The copyright of a book on bookkeeping does not confer upon the author the exclusive right to make, sell and use account books prepared upon the plan set forth in such book. *Baker v. Selden*, 101 U. S. 99; s. c. 17 O. G. 1029.

A compilation of information that is useful in a counting-room is a proper subject of a copyright. *Bullinger v. Mackey*, 15 Blatch. 550.

A new arrangement of an old piece of music is a valid subject of copyright. *Schuberth v. Shaw*, 28 A. L. Reg. 248.

The word "print" is used in connection with "engraving, cut, and photograph." It means apparently a picture; something complete in itself, similar in kind to an engraving, cut or photograph. It clearly does not mean something printed on paper that is not intended for use as a picture, but is itself to be cut up and embroidered, and thus made into an entirely different article, as a balloon or a hanging basket. *Rosenbach v. Dreyfuss*, 17 O. G. 1153; s. c. 2 Fed. Rep. 217.

If a chromo is clearly a work of artistic merit it is the subject of a copyright, although the person claiming the copyright expects to obtain his reward indirectly through an increase of profits in his business to be obtained through its gratuitous distribution. *Yuengling v. Schile*, 12 Fed. Rep. 97; s. c. 20 Blatch. 452.

The proprietor of a chromo which was wholly designed, manufactured and completed in a foreign country is not entitled to a copyright thereof. *Yuengling v. Schile*, 12 Fed. Rep. 97; s. c. 20 Blatch. 452.

The word "proprietor" has been used in the copyright laws in the limited and restricted sense of a person who has lawfully acquired the exclusive right of some native or resident artist or author. *Yuengling v. Schile*, 12 Fed. Rep. 97; s. c. 20 Blatch. 452.

The proprietor of a chromo which was invented by another can not claim a copyright therein, unless he shows an exclusive right lawfully derived from the inventor. *Yuengling v. Schile*, 12 Fed. Rep. 27; s. c. 20 Blatch. 452.

The word "print" embraces lithographs. *Yuengling v. Schile*, 12 Fed. Rep. 97; s. c. 20 Blatch. 452.

Before an author can claim a copyright in the plan of arranging his materials, he must make it appear that his book exhibits a substantially new and original system of arrangement of such a character as to require invention. *Bullinger v. Mackey*, 15 Blatch. 550.

There may be a valid copyright in the plan of a book as connected with the arrangement and combination of the materials, and the mode of displaying and illustrating the subject, although all the materials employed and the subject of the work may be common to all other writers. *Greene v. Bishop*, 1 Cliff. 186; *Emerson v. Davies*, 3 Story 768; *Boucicault v. Fox*, 5 Blatch. 87.

A party who first brings together materials drawn from different sources is entitled to a copyright for a compilation. *Gray v. Russell*, 1 Story 11; *Blunt v. Patten*, 2 Paine 393.

Where there is nothing immoral or improper in a print itself, the fact that it may be used by persons to violate the law does not of itself deprive it of the protection of the law. To do this it must appear either that there is something immoral, pernicious, or indecent in the thing *per se*, or that it is incapable of any use except in connection with some illegal or immoral act. *Richardson v. Miller*, 15 A. L. J. 340; s. c. 12 O. G. 3.

A dramatic composition which is grossly indecent and calculated to corrupt the morals of the people is not the proper subject of a copyright. *Martinetti v. Maguire*, 1 Deady 216; s. c. 1 Abb. C. C. 356.

No reporter can have any copyright in judicial decisions. *Wheaton v. Peters*, 8 Wheat. 591; *Little v. Gould*, 2 Blatch. 165.

A reporter of judicial decisions is entitled to a copyright of his work to the extent of his authorship of the composition contained therein. *Little v. Gould*, 2 Blatch. 165; *Little v. Gould*, 2 Blatch. 362; *Myers v. Callaghan*, 5 Fed. Rep. 726; s. c. 10 Biss. 139.

Copyrights of the additions of a work other than the original editions are granted for additions to emendations of or improvements in the work, and every copyright should bear date of the day when it was secured. *Lawrence v. Dana*, 7 O. G. 81; s. c. 4 Cliff. 1; s. c. 2 A. L. T. (N. S.) 402.

The term "book" does not carry with it the requirement that it shall be printed. A book may exist without printing, and such book, when made or composed, is to be entitled to copyright. *Roberts v. Myers*, 23 Law Rep. 396; s. c. 17 Leg. Int. 405.

The literary property intended to be protected by the act is not to be determined by the size, form or shape in which it makes its appearance, but by the subject-matter of the work. *Clayton v. Stone*, 2 Paine 382.

A daily or weekly publication of the state of the market is not the subject of a copyright. *Clayton v. Stone*, 2 Paine 382.

The preliminary steps required by law can not be reasonably applied to a work of so ephemeral a character as a newspaper. *Clayton v. Stone*, 2 Paine 382.



A book need not be a book in the common and ordinary acceptance of the word, viz., a volume made up of several sheets bound together. It may be printed only on one sheet. *Clayton v. Stone*, 2 Paine 382; *Scoville v. Toland*, 6 West. L. J. 84; *Drury v. Ewing*, 1 Bond 540.

A chart which contains a series of diagrams interspersed with printed instructions as to the mode of using them in taking measurements for and cutting garments is the subject of copyright. *Drury v. Ewing*, 1 Bond 540.

A label intended for no other use than to be pasted on vials or bottles containing a medicinal preparation is not the proper subject of a copyright. *Scoville v. Toland*, 6 West. L. J. 84; *Coffeen v. Brunton*, 4 McLean 516.

A written work consisting wholly of directions set in order for conveying the ideas of the author on a stage or public place by means of characters who represent the narrative wholly by action, is as much a dramatic composition as if language or dialogue were used in it to convey ideas. *Daly v. Palmer*, 6 Blatch. 256.

A spectacular piece which consists almost wholly of scenic effects or representations, and in which the dialogue is very scant and meaningless, is not a dramatic composition. *Martinetti v. Maguire*, 1 Deady 216; s. c. 1 Abb. C. C. 356.

Playing cards may be a proper subject of copyright. *Richardson v. Miller*, 15 A. L. J. 340; s. c. 12 O. G. 3.

A person who translates a dramatic composition with the consent of the author is entitled to a copyright. *Shook v. Rankin*, 6 Biss. 477.

A person who deposits in the copyright office the title of a drama not original with himself, can not secure to himself such title to the exclusion of others who have applied such title to a dramatic composition founded on the same story before the date of such deposit. *Benn v. Leclercq*, 30 Leg. Int. 185.

The musical composition contemplated by the statute must be substantially a new and original work, and not a copy of a piece already produced, with additions and variations which a writer of music with skill and experience might readily make. *Jollie v. Jaques*, 1 Blatch. 618; *Reed v. Carusi*, Taney 72.

If an engraving does not involve invention it is not a subject of copyright. *Collender v. Griffith*, 11 Blatch. 212; s. c. 3 O. G. 689.

A photograph is not a print, cut or engraving. *Wood v. Abbott*, 5 Blatch. 325.

A publication of a new and revised set of rules regularly adopted by the court is not a republication of the prior rules. *Banks v. McDivett*, 13 Blatch. 163; s. c. 8 O. G. 860.

### Parties.

To constitute an author, the person must, by his own intellectual labor, applied to the materials of his composition, produce an arrangement or compilation new in itself. *Atwell v. Ferrett*, 2 Blatch. 39.

No person is entitled to a copyright in alterations and improvements made by others at his procurement and for him. *Atwell v. Ferrett*, 2 Blatch. 39.

No person is entitled to a copyright of an historical print which he did not invent or design, but which was invented, designed and engraved by others, although he employed them to do so. *Binns v. Woodruff*, 4 Wash. 48.

Although an author produces a work while in the general employment of another, yet he will not be deemed to have parted with his right and transferred it to his employer unless there is a valid agreement to that effect. *Boucicault v. Fox*, 5 Blatch. 87.

If an actor agrees with the proprietor to write a drama and allow it to be performed at the theatre so long as it draws good audiences, he is entitled to copyright, and the proprietor is a mere licensee. *Roberts v. Myers*, 23 Law Rep. 396; s. c. 17 Leg. Int. 405; *Boucicault v. Fox*, 5 Blatch. 87.

If a person give contributions to the proprietor of a work, the title thereto is vested in the proprietor as the work is done, to the extent of the gift, and no assignment thereof is necessary. *Lawrence v. Dana*, 7 O. G. 81; s. c. 4 Cliff. 1; s. c. 2 A. L. T. (N. S.) 402.

If contributions are given to the proprietor of a work, he may take a copyright. *Lawrence v. Dana*, 7 O. G. 81; s. c. 4 Cliff. 1; s. c. 2 A. L. T. (N. S.) 402.

If contributions are given to be used in one edition of a work, the proprietor acquires no right to use them in any other edition. *Lawrence v. Dana*, 7 O. G. 81; s. c. 4 Cliff. 1; s. c. 2 A. L. T. (N. S.) 402.

The legal assignee of an author is competent to take out a copyright, although he takes it in trust for others. *Little v. Gould*, 2 Blatch. 362.

If a person accepts the office of reporter under a law which prohibits him from having any pecuniary interest therein or taking a copyright therefor, he thereby surrenders his rights as author, and can not confer them on another. *Little v. Gould*, 2 Blatch. 165.

If a person enters the employ of the government under a stipulation that all drawings and sketches made by him shall belong exclusively to it, and Congress orders them to be published, he is not entitled to a copyright. *Heine v. Appleton*, 4 Blatch. 125.

Unless there is a most unequivocal dedication of private letters and papers to the public or to some private person, the author has the exclusive right to a copyright thereof. *Folsom v. Marsh*, 2 Story 100.

The acts of the author in compiling the book may be proven by the testimony of others. *Bullinger v. Mackey*, 15 Blatch. 550.

### Aliens.

The publisher of the work of a foreign author can secure the exclusive right to such publication only by the voluntary and unconstrained forbearance of the trade. *Sheldon v. Houghton*, 5 Blatch. 285.



The term "resident" means a permanent inhabitant. A mere transient visitant whose family, business, intentions and relations are all abroad can not be considered a resident, and the filing of a declaration of an intention to become a citizen can not make him one. *Carey v. Collier*, 56 Niles Reg. 262.

Residence ordinarily means domicile, or the continuance of a person in a place, having his home there. It is not actually necessary that he shall be the occupant of his own house. He may be a boarder or lodger in the house of another. The main question is as to the intention with which a man or person is staying in a particular place. In order to constitute residence it is necessary that a man shall go to a place with the intention of remaining, making it his home or place of abode. *Boucicault v. Wood*, 2 Biss. 34; s. c. 16 A. L. Reg. 539.

If a party takes a house in this country with the intention of remaining here, he is a resident, although he may subsequently return to his own country. *Boucicault v. Wood*, 2 Biss. 34; s. c. 16 A. L. Reg. 539.

In order to become a resident, the intention to remain must exist at the time when the party takes up his abode. *Boucicault v. Wood*, 2 Biss. 34; s. c. 16 A. L. Reg. 539.

### **Infringement.**

An author may be said to be the inventor or creator both of the ideas contained in his book and the combination of words to represent them. Before publication he has the exclusive possession of his invention. But when he has published his book and given his thoughts, sentiments, knowledge or discoveries to the world, they become the common property of his readers, who have the right to use them and communicate them to others clothed in their own language, by lecture or treatise. *Stowe v. Thomas*, 2 Wall. Jr. 547; *Keene v. Clarke*, 5 Robt. 38.

The claim of literary property after publication can not be in the ideas or sentiments as dissevered from the language, idiom, style, or the outward semblance and exhibition of them. The author's exclusive property in the creation of his mind is only in the concrete form which he has given to it, and the language in which he has clothed it. When he has sold his book, the only property which he reserves to himself, or which the law gives to him, is the exclusive right to multiply copies of that particular combination of characters which exhibits to the eyes of another the ideas intended to be conveyed. That is what the law terms copy or copyright. *Stowe v. Thomas*, 2 Wall. Jr. 547; *Greene v. Bishop*, 1 Cliff. 186.

In questions of infringement of copyright, the inquiry is not whether the defendant has used the thoughts, conceptions, information or discoveries promulgated by the original, but whether his composition may be considered a new work requiring invention, learning and judgment, or only a mere transcript of the whole or parts of the original, with merely colorable variations. *Stowe v. Thomas*, 2 Wall. Jr. 547.

A translation of an author's ideas and conceptions into another lan-

guage is not an infringement of a copyright. *Stowe v. Thomas*, 2 Wall. Jr. 547.

If a translator of a dramatic composition obtains a copyright, he can not prevent others from acting a prior translation made with the author's consent in England. *Shook v. Rankin*, 6 Biss. 477.

A fair abridgment of any book is considered a new work, as to write it requires labor and the exercise of judgment. It is only new in the view that the sense of the author is given in a condensed form. *Story v. Holcombe*, 4 McLean 306 ; *Folsom v. Marsh*, 2 Story 100.

Works on law, whether elementary or otherwise, are proper subjects of abridgment. *Story v. Holcombe*, 4 McLean 306.

There is a clear distinction between a compilation and an abridgment. To abridge requires the exercise of the mind, and that is not copying. To compile is to copy from various authors into one work. An abridgment is a condensation of the views of the author ; a compilation consists of selected extracts from different authors. *Story v. Holcombe*, 4 McLean 306.

It may not be essential to exclude extracts entirely from an abridgment, but in making extracts merely there is no condensation of the language of the author, and consequently there is no abridgment of it. *Story v. Holcombe*, 4 McLean 306 ; *Folsom v. Marsh*, 2 Story 100 ; *Greene v. Bishop*, 1 Cliff. 186.

A copy of a book must be a transcript of the language in which the conceptions of the author are clothed, of something printed and embodied in a tangible shape. The same conceptions clothed in another language can not constitute the same composition, nor can it be called a transcript or copy of the same book. *Stowe v. Thomas*, 2 Wall. Jr. 547.

A copy is one thing, an imitation or resemblance another. What degree of imitation constitutes an infringement is a nice question in many cases. *Emerson v. Davies*, 3 Story 768.

It is not sufficient to show that one work may have been suggested by another, or that some parts and pages of it have resemblances to the other. It must be further shown that the resemblances in those parts and pages are so close, so full, so uniform and so striking, as to fairly lead to the conclusion that one is a substantial copy of the other, or mainly borrowed from it. *Emerson v. Davies*, 3 Story 768.

In order to constitute an invasion of a copyright, it is not necessary that the whole of the work shall be copied, or even a large portion of it, in form or in substance. The entirety of the copyright is the property of the author, and it is no defence that another has appropriated a part and not the whole of any property. *Folsom v. Marsh*, 2 Story 100 ; *Greene v. Bishop*, 1 Cliff. 186.

Whether there has been an infringement does not necessarily depend upon the quantity taken. It often depends upon other considerations, the value of the materials taken, and their importance to the sale of the original work. *Folsom v. Marsh*, 2 Story 100.

If so much is taken that the value of the original is sensibly diminished,



or the labors of the author are substantially to an injurious extent appropriated, that is sufficient to constitute a piracy *pro tanto*. *Folsom v. Marsh*, 2 Story 100; *Greene v. Bishop*, 1 Cliff. 186.

It is not necessary that the infringing book shall be the same, word for word, but a mere alteration of a portion of the book will not deprive the author of the protection given by the law, provided there is a use of the book substantially in all respects. *Boucicault v. Wood*, 2 Biss. 34; s. c. 16 A. L. Reg. 539.

Copying is not confined to literal repetition, but includes the various modes in which the matter of any publication may be adopted, imitated or transferred with more or less colorable alteration to disguise the piracy. *Greene v. Bishop*, 1 Cliff. 186; *Drury v. Ewing*, 1 Bond 540.

If a copyright is taken of the letters of a famous person, it is a piracy to write a life of him made up mainly by copying certain letters in full. *Folsom v. Marsh*, 2 Story 100.

In a dramatic composition, the series of events directed in writing by the author in any particular scene is his invention, and a piracy is committed if that in which the whole merit of the scene consists is incorporated in another work without any material alteration in the constituent parts of the series of events, or in the sequence of the events in the series. *Daly v. Palmer*, 6 Blatch. 256.

Movement, gesture and facial expression, which address the eye only, are as much a part of the dramatic composition as is the spoken language which addresses the ear only, and that part of the written composition which gives direction for the movement and gesture is as much a part of the composition, and protected by the copyright, as is the language prescribed to be uttered by the characters. *Daly v. Palmer*, 6 Blatch. 256.

A play which is a mere spectacle, and must be seen to be appreciated, has no value except as it is appreciated by the public. If the result of the exhibition of the original and the alleged infringement is so nearly the same as to produce the impression that they are identical upon ordinary spectators, one should be held to be a mere colorable imitation of the other. *Martinetti v. Maguire*, 1 Deady 216; s. c. 1 Abb. C. C. 356.

No compiler of a book which is a mere compilation of facts from common and universal sources of information, has a monopoly of the subject of which the book treats. Any other person is permitted to enter that department of literature and make a similar book. But the subsequent investigator must investigate for himself from the original sources which are open to all. He can not use the labors of a previous compiler, *animo furandi*, and save his own time by copying the results of the previous compiler's study, although the same results would have been obtained by independent labor. *Banks v. McDivett*, 13 Blatch. 163; s. c. 8 O. G. 860; *Lawrence v. Cupples*, 9 O. G. 254; *Gray v. Russell*, 1 Story 11; *Blunt v. Patten*, 2 Paine 393, 397; *Story v. Holcombe*, 4 McLean 306; *Emerson v. Davies*, 3 Story 768; *Greene v. Bishop*, 1 Cliff. 186; *Farmer v. Calvert Publishing Co.*, 1 Flippin 228; s. c. 5 A. L. T. 158.

If the judge prepares the head notes to the reports, the author of a

digest made up of such head notes has no ground to complain because another author in his digest uses the same. *Chase v. Sanborn*, 6 O. G. 932; s. c. 4 Cliff. 306.

In case of a dictionary or other work of that kind, similarities and some use of a prior work, even to copying of small parts, is allowed, if the main design and execution are in reality novel or improved, and not a mere cover for an important piracy. *Webb v. Powers*, 2 W. & M. 497.

One compiler can not copy the plan or arrangement of another compilation. *Story v. Holcombe*, 4 McLean 306.

Although the plan or arrangement of a book may be secured to an author, if it is the product of his own genius, yet a mere list of debtors and creditors, with their residences, and the amount and value of their debts, does not possess any such novelty of plan or arrangement as will preclude any other person from making and publishing similar lists from independent sources of information. *Lawrence v. Cupples*, 9 O. G. 254.

The right secured by the act is the property in the literary composition, the product of the mind and genius of the author, and not in the name or title given to it. The title does not necessarily involve any literary composition. It may not be, and the statute does not require that it should be, the product of the author's mind. It is a mere appendage which only identifies, and frequently does not in any way describe, the literary composition itself or represent its character, and if there is no piracy of the book, there is no remedy for the use of the title. *Osgood v. Allen*, 1 Holmes 185; s. c. 3 O. G. 124; *Jollie v. Jaques*, 1 Blatch. 618; *Benn v. Leclercq*, 30 Leg. Int. 185.

When the title itself is original and the product of the author's own mind, and is appropriated by the infringement, as well as the whole or a part of the literary composition itself, in protecting other portions of the literary composition the courts will probably also protect the title. *Osgood v. Allen*, 1 Holmes 185; s. c. 3 O. G. 124.

If a party makes a survey, and deposits it in the navy department, with the understanding that he is to have the exclusive right to publish it, a copy from it will be an infringement. *Blunt v. Patten*, 2 Paine 393, 397.

No person has the right to publish letters merely because the government bought the manuscript after another had acquired a copyright therein. *Folsom v. Marsh*, 2 Story 100.

A copyright of a map of one city is not infringed by a map of another city, although the latter is constructed on the same plan and uses the same arbitrary signs and key. *Perris v. Hexamer*, 99 U. S. 674.

When both works are compilations, similarities may arise from the character of the works, and yet one may not be a transcript from the other. *Bullinger v. Mackey*, 15 Blatch. 550.

A chromo designed from a picture found in a foreign publication and circulated in the country before this copyright was obtained is not an infringement. *Johnson v. Donaldson*, 18 Blatch. 287; s. c. 3 Fed. Rep. 22.



SEC. 4952 A (Act of June 18, 1874, ch. 301, § 3, 18, Stat. 79). That in the construction of this act, the words "engraving," "cut" and "print" shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the patent office. And the commissioner of patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law, as to copyright of prints, except that there shall be paid for recording the title of any print or label not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record under the seal of the commissioner of patents, to the party entering the same.

The claim to a label is void if the label was published before its registration. *Marsh v. Warren*, 24 Pitts. L. J. 207; s. c. 9 C. L. N. 395; s. c. 13 O. G. 7.

The bill should allege that the title and label were deposited before the publication of the label. *Marsh v. Warren*, 24 Pitts. L. J. 207; s. c. 9 C. L. N. 395; s. c. 13 O. G. 7.

A label may be entered as a label, although it could also be entered as a trade-mark. *U. S. v. Willcox & G. S. M. Co.*, 1 Mackey 284; s. c. 22 O. G. 1366.

A printed balloon intended to be cut apart and manufactured into a balloon can not be considered as a "pictorial illustration or work connected with the fine arts." *Rosenbach v. Dreyfuss*, 17 O. G. 1153; s. c. 2 Fed. Rep. 217.

A label does not infringe the registry of a label unless it is substantially the same. *Lorillard v. Drummond Tobacco Co.*, 22 O. G. 1208; s. c. 14 Fed. Rep. 111; *Lorillard v. McAlpin*, 22 O. G. 1208; s. c. 14 Fed. Rep. 112.

When matter that is the proper subject of a trade-mark is apparently claimed by another, the applicant must establish his right to it before he can have it included in a register of a label. *Jno. D. Park*, 12 O. G. 2.

If matter in a label is purely arbitrary and fanciful in its nature, it should be required to be stricken out before registration. *W. Simpson & Sons*, 10 O. G. 333.

A print made up of a combination of colors, figures and words, adapted in their use to any goods or merchandise, can be properly registered as a label. *Schumacher & Ettinger*, 9 O. G. 594.

If the superscription is in its main elements a label, the fact that it contains matter which, taken separately, might constitute a trade-mark, is not fatal to its registration. *Orcutt & Son*, 8 O. G. 277.

A label may be registered although it contains the name of the owner, if that name does not purport to be a fac-simile of his signature. *Thaddeus Davids & Co.*, 16 O. G. 94.

A fanciful pattern to be wrought into or upon the article, forming a part of it and giving to it a certain value by way of a new appearance, can not be registered as a label. *T. E. Parker*, 13 O. G. 323.

The words "satin," "polish," may be registered as a label for polish for boots. *Brigham*, 20 O. G. 891.

The words "dirt killer" may be registered as a label. *Waeferling*, 16 O. G. 764.

The line of separation between labels and trade-marks can not be defined in general terms. It is a matter of judgment in each case. *Brigham*, 20 O. G. 891.

If a design can be registered as a trade-mark, it can not be registered as a label. *Schumacher & Ettliger*, 22 O. G. 1291.

A trade-mark can not be registered as a label. *Schumacher & Ettliger*, 22 O. G. 1291; *Alexius Godillot*, 6 O. G. 641.

If a print is of such a character that its use in connection with the article of trade or manufacture is purely arbitrary and fanciful, it can not be registered as a label. *Schumacher v. Ettliger*, 19 O. G. 791.

SEC. 4953. Copyrights shall be granted for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

*Statute Revised*—July 8, 1870, ch. 230, § 87, 16 Stat. 212.

*Prior Statutes*—May 31, 1790, ch. 15, § 1, 1 Stat. 124.—February 3, 1831, ch. 16, § 1, 4 Stat. 436.

SEC. 4954. The author, inventor or designer, if he be still living and a citizen of the United States or resident therein, or his widow or children, if he be dead, shall have the same exclusive right continued for the further term of fourteen years, upon recording the title of the work or description of the article so secured a second time, and complying with all other regulations in regard to original copyrights, within six months before the expiration of the first term. And such person shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more newspapers, printed in the United States, for the space of four weeks.

*Statute Revised*—July 8, 1870, ch. 230, § 88, 16 Stat. 212.

*Prior Statutes*—May 31, 1790, ch. 15, § 1, 1 Stat. 124.—Feb. 3, 1831, ch. 16, §§ 2, 3, 4 Stat. 436, 437.



This section refers to the author and his family, and not to assignees. *Pierpont v. Fowle*, 2 W. & M. 23.

A renewal will not be valid unless there is a valid copyright for the original term. *Wheaton v. Peters*, 8 Pet. 591.

**SEC. 4955.** Copyrights shall be assignable in law, by any instrument of writing, and such assignment shall be recorded in the office of the librarian of Congress within sixty days after its execution; in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice.

*Statute Revised*—July 8, 1870, ch. 230, § 89, 16 Stat. 213.

*Prior Statute*—June 30, 1834, ch. 157, § 1, 4 Stat. 728.

A parol promise for a good consideration, to transfer an interest in a copyright is binding, for the making of the assignment merely concerns the manner of the performance of the promise. *Gould v. Banks*, 8 Wend. 562.

The statute does not say what interest may be assigned, but there is no sufficient reason for preventing an author from conveying a distinct portion of his right. Divisibility as well as assignability enhances the value of his property, for he may find a purchaser able and willing to pay for a part, but not for the whole of his copyright. *Roberts v. Myers*, 23 Law. Rep. 396; s. c. 17 Leg. Int. 405.

The exclusive right to act and represent a drama is distinct from that of printing and publishing, and may be assigned for certain territory and a limited time. *Roberts v. Myers*. 23 Law Rep. 396; s. c. 17 Leg. Int. 405.

A mere assignment of a copyright will not pass a right to a renewal subsequently granted. *Pierpont v. Fowle*, 2 W. & M. 23; *Cowen v. Banks*, 24 How. Pr. 72.

An assignee may maintain an action, although his assignment has never been recorded, for it is valid between the parties. *Webb v. Powers*, 2 W. & M. 497.

A contract to publish a work and give the author a certain price for each copy published, does not give the publisher the sole and exclusive right to publish the work. *Willis v. Tibbals*, 33 N. Y. Sup. 220.

A mere contract for printing and publishing a book does not usually contain anything about the copyright. That is ordinarily retained by the author unless there is an agreement or understanding that the name of the publisher shall be used for that purpose. *Pulte v. Derby*, 5 McLean 328.

If a publisher takes a copyright in his own name under a contract to pay a royalty to the author, he holds it for the purposes of the contract, and can not assign the copyright or publish the work except upon the terms of the contract. *Pulte v. Derby*, 5 McLean 328.

If a contract provides for a first and second edition, and allows the party to print as many as he can sell, the mere fact of inserting the words "third edition" in the title-page of the third impression can not cut off rights expressly given in the agreement. *Pulte v. Derby*, 5 McLean 328.

If a party who has made a contract with a publisher in his capacity as reporter, is deprived of his office, the legal title to his manuscript not then published, nor given to the publisher for publication, will not vest in the publisher, although the contract stipulated that it should be deemed an assignment of the copyright for all matter furnished under it. *Little v. Hall*, 18 How. 165.

If an author delivers his manuscript to a printer for publication with an agreement that he shall be entitled to the copyright forever, this gives him a right to the renewal. *Paige v. Banks*, 13 Wall. 608 ; s. c. 7 Blatch. 152.

A contract to reprint any literary work the copyright to which has been secured to the author, is void unless it is entered into with the consent of the author or his assignee, and the printer who executes the contract with knowledge of the rights of the author can not recover anything for his labor. *Nichols v. Ruggles*, 3 Day 145.

If the joint owners of a copyright make an agreement among themselves in regard to the printing of the work, neither can defeat it by setting up his right as owner to publish. *Gould v. Banks*, 8 Wend. 562.

A relinquishment of a copyright in favor of the State by accepting an office under a statute which so vests it, may be regarded as an assignment by operation of law. *Little v. Gould*, 2 Blatch. 165 ; *Little v. Gould*, 2 Blatch. 362.

If an assignment does not contain any condition by which the title is to be divested upon the failure of the assignee to perform the covenants therein contained, the only remedy of the assignor is by an action for a breach of the covenants. *Mackaye v. Mallory*, 22 O. G. 945 ; s. c. 12 Fed. Rep. 328.

Although an instrument has never been copyrighted, yet a transfer thereof is a sufficient consideration for a promissory note. *Cates v. Bales*, 78 Ind. 285.

A creditor can not levy an execution upon the unpublished manuscript of his debtor. *Dart v. Woodhouse*, 40 Mich. 399.

The incorporeal right to multiply copies of a work, being intangible and resting altogether in grant, is not subject to seizure and sale under an execution at common law, but may be reached by a creditor's bill in equity, where the court may compel the debtor to execute an assignment. *Stephens v. Cady*, 14 How. 528.

The property in an engraved plate of a map and the copyright of the map are altogether different and independent of each other, and a sale of the engraved plate under an execution will not give the purchaser a right to print and publish the map. *Stephens v. Cady*, 14 How. 528 ; *Stephens v. Gladding*, 17 How. 447.



If an author sells the copyright and the matter to be printed, and delivers the matter to the vendee, and the consideration is properly delivered or to be delivered to the author or another for his use, or is money to be paid to the author or another for his use, such property or *choses in action* may be subjected to the payment of the author's debts. *Cooper v. Gunn*, 4 B. Mon. 594.

The statute confers upon all the owners full power, without exacting any obligation in return, to print, publish and sell. It gives no superior right to either. Each can exercise his own right alone, without using or receiving any aid or benefit whatever from the title or property of the others. When one owner at his own expense publishes and sells the book, he is not liable to account to the co-owners for the profits. *Carter v. Bailey*, 64 Me. 458.

SEC. 4956. No person shall be entitled to a copyright unless he shall, before publication, deliver at the office of the librarian of Congress or deposit in the mail addressed to the librarian of Congress, at Washington, District of Columbia, a printed copy of the title of the book or other article, or a description of the painting, drawing, chromo, statue, statuary, or a model or design for a work of the fine arts, for which he desires a copyright, nor unless he shall also, within ten days from the publication thereof, deliver at the office of the librarian of Congress, or deposit in the mail addressed to the librarian of Congress, at Washington, District of Columbia, two copies of such copyright book or other article, or in case of a painting, drawing, statue, statuary, model, or design for a work of the fine arts, a photograph of the same.

*Statute Revised*—July 8, 1870, ch. 230, § 90, 16 Stat. 213.

*Prior Statutes*—May 31, 1790, ch. 15, § 3, 1 Stat. 125.—February 3, 1831, ch. 16, § 4, 4 Stat. 437.

Congress by the statute created the right, and no protection can be claimed unless its provisions have been complied with. *Wheaton v. Peters*, 8 Pet. 591; *Bartlett v. Crittenden*, 5 McLean 32; *Little v. Gould*, 2 Blatch. 165; *Ewer v. Coxe*, 4 Wash. C. C. 487; *Baker v. Taylor*, 2 Blatch. 82; *Jones v. Thorne*, 1 N. Y. Leg. Obs. 408; *Potter v. McPherson*, 28 N. Y. Supr. 559.

Although an author writes under a *nom de plume*, yet he has no exclusive right to the use of that name for writings that have never been copyrighted. *Clemens v. Belford*, 14 Fed. 728; s. c. 15 C. L. N. 153.

The title of a book when connected with the name of the person by whom it was composed indicates its origin sufficiently to require its use to be protected as a trade-mark. *Potter v. McPherson*, 28 N. Y. Supr. 559.

Any person shall be entitled to copyright who before publication, 1st, shall deliver to the librarian a printed copy of the title of the book; and, 2d, shall within ten days after the publication thereof deliver to the librarian two copies of the same. In order to secure a copyright of a book or dramatic composition, the work must be published within a reasonable time after the filing of the title, and two copies be delivered to the librarian. *Boucicault v. Hart*, 13 Blatch. 47; *vide Roberts v. Myers*, 23 Law Rep. 396; s. c. 17 Leg. Int. 405.

The deposit of a title is sufficient although the title-page of the book contains words that are not found in the title, if they are immaterial and no part of the name or title. What the statute requires to be deposited is "a printed copy of the title." The language is not "a printed copy of the title-page," that is, a printed copy of the page containing the title. *Donnelly v. Ivers*, 20 Blatch. 381.

The deposit of a title is sufficient although the title-page of the book does not contain all the words that were in the title deposited, if the words omitted are no part of the substantial title. *Donnelly v. Ivers*, 20 Blatch. 381.

If the publication is made before a deposit of a printed copy of the title, the person is not entitled to a copyright. *Baker v. Taylor*, 2 Blatch. 82; *Chase v. Sanborn*, 6 O. G. 932; s. c. 4 Cliff. 306; *Struve v. Schwedler*, 4 Blatch. 23; *Parkinson v. Lasalle*, 3 Saw. 331.

The mere delivery of a copy of a report to the State before the deposit of the copy of the title with the librarian is not a publication. *Myers v. Callaghan*, 5 Fed. Rep. 726; s. c. 10 Biss. 139.

If the copy of the title and the copies of the book are deposited with the librarian on the same day, the presumption is that the filing of the copy of the title preceded the deposit of the copies of the book. *Myers v. Callaghan*, 5 Fed. Rep. 726; s. c. 10 Biss. 139.

A sale naturally imports publication. As a purchaser has a right to know the contents of a book and make them known to others, the presumption is that a publication followed a sale. *Baker v. Taylor*, 2 Blatch. 82.

The right accrues from the time a copy of the title of the book is deposited in the librarian's office. *Wheaton v. Peters*, 8 Pet. 591.

No copyright is valid unless two copies of the book are delivered to the librarian of Congress within the prescribed time. *Wheaton v. Peters*, 8 Pet. 591; *Chase v. Sanborn*, 6 O. G. 932; s. c. 4 Cliff. 306; *Struve v. Schwedler*, 4 Blatch. 23; *Parkinson v. Lasalle*, 3 Saw. 331; *vide Jollie v. Jaques*, 1 Blatch. 618; *Nichols v. Ruggles*, 3 Day 145.

If the work consists of several volumes, the delivery of the copies of the first volume within the prescribed time, and of the copies of the other volumes before any piracy is committed, or any action is brought therefor, is sufficient. *Dwight v. Appleton*, 1 N. Y. Leg. Obs. 195.



If there has been no publication, no copies of the book need be deposited with the librarian. *Roberts v. Myers*, 23 Law Rep. 396; s. c. 17 Leg. Int. 405.

If the label is published prior to the registration in the patent office, the registration is void. *Marsh v. Warren*, 14 O. G. 678; s. c. 14 Blatch. 263.

The words "works of fine arts" are used in their proper and customary sense, and do not include printed balloons intended to be cut apart and manufactured into balloons. *Rosenbach v. Dreyfuss*, 17 O. G. 1153; s. c. 2 Fed. Rep. 217.

SEC. 4957. The librarian of Congress shall record the name of such copyright book or other article, forthwith, in a book to be kept for that purpose, in the words following: "Library of Congress, to wit: Be it remembered that on the — day of —, A. B., of —, hath deposited in this office the title of a book [map, chart or otherwise, as the case may be, or description of the article], the title or description of which is in the following words, to wit: [here insert the title or description], the right whereof he claims as author [originator, or proprietor, as the case may be], in conformity with the laws of the United States respecting copyrights. C. D., librarian of Congress." And he shall give a copy of the title or description, under the seal of the librarian of Congress, to the proprietor, whenever he shall require it.

*Statute Revised*—July 8, 1870, ch. 230, § 91, 16 Stat. 213.

*Prior Statutes*—May 31, 1790, ch. 15, § 3, 1 Stat. 125.—Feb. 3, 1831, ch. 16, § 4, 4 Stat. 437.

A copy of the record is *prima facie* evidence that a printed title was deposited. *Roberts v. Myers*, 23 Law Rep. 396; s. c. 17 Leg. Int. 405.

SEC. 4958. The librarian of Congress shall receive, from the persons to whom the services designated are rendered, the following fees:

First. For recording the title or description of any copyright book or other article, fifty cents.

Second. For every copy under seal of such record actually given to the person claiming the copyright, or his assigns, fifty cents.

Third. For recording any instrument of writing for the assignment of a copyright, fifteen cents for every one hundred words.

Fourth. For every copy of an assignment, ten cents for every one hundred words.

All fees so received shall be paid into the treasury of the United States.

*Statute Revised*—July 8, 1870, ch. 230, § 92, 16 Stat. 213.

*Prior Statute*—June 30, 1834, ch. 157, § 2, 4 Stat. 728.

SEC. 4958 A (Act of June 18, 1874, ch. 301, § 2, 18 Stat. 79). That for recording and certifying any instrument of writing for the assignment of a copyright, the librarian of Congress shall receive from the persons to whom the service is rendered, one dollar; and for every copy of an assignment, one dollar; said fee to cover, in either case, a certificate of the record, under seal of the librarian of Congress; and all fees so received shall be paid into the treasury of the United States.

SEC. 4959. The proprietor of every copyright book or other article shall deliver at the office of the librarian of Congress, or deposit in the mail addressed to the librarian of Congress at Washington, District of Columbia, within ten days after its publication, two complete printed copies thereof, of the best edition issued, or description or photograph of such article as hereinbefore required, and a copy of every subsequent edition wherein any substantial changes shall be made.

*Statute Revised*—July 8, 1870, ch. 230, § 93, 16 Stat. 213.

*Prior Statutes*—May 31, 1790, ch. 15, § 4, 1 Stat. 125.—Feb. 3, 1831, ch. 16, § 4, 4 Stat. 437.—Aug. 10, 1846, ch. 178, § 10, 9 Stat. 106.—March 3, 1865, ch. 126, §§ 2, 4, 13 Stat. 540.—Feb. 18, 1867, ch. 43, § 2, 14 Stat. 395.

### Construction.

Although the librarian gives a certificate of the record of the title to the book, yet a memorandum appended to the certificate that two copies of the book have been deposited in his office is not evidence of that fact. *Merrell v. Tice*, 104 U. S. 557; s. c. 28 I. R. R. 120.



SEC. 4960. For every failure on the part of the proprietor of any copyright to deliver or deposit in the mail either of the published copies, or description or photograph, required by sections four thousand nine hundred and fifty-six, and four thousand nine hundred and fifty-nine, the proprietor of the copyright shall be liable to a penalty of twenty-five dollars, to be recovered by the librarian of Congress, in the name of the United States, in an action in the nature of an action of debt, in any district court of the United States, within the jurisdiction of which the delinquent may reside or be found.

*Statute Revised*—July 8, 1870, ch. 230, § 94, 16 Stat. 213.

*Prior Statutes*—March 3, 1865, ch. 126, § 3, 13 Stat. 540.—Feb. 18, 1867, ch. 43, § 1, 14 Stat. 395.

SEC. 4961. The postmaster to whom such copyright book, title or other article is delivered, shall, if requested, give a receipt therefor; and when so delivered he shall mail it to its destination.

*Statute Revised*—July 8, 1870, ch. 230, § 96, 16 Stat. 214.

*Prior Statute*—Feb. 18, 1867, ch. 43, § 2, 14 Stat. 395.

SEC. 4962 (Act of June 18, 1874, ch. 301, § 1, 18 Stat. 78). That no person shall maintain an action for the infringement of his copyright unless he shall give notice thereof by inserting in the several copies of every edition published, on the title-page or the page immediately following, if it be a book; or if a map, chart, musical composition, print, cut, engraving, photograph, painting, drawing, chromo, statue, statuary, or model or design, intended to be perfected and completed as a work of the fine arts, by inscribing upon some visible portion thereof, or of the substance on which the same shall be mounted, the following words, viz: "Entered according to act of Congress, in the year ———, by A. B., in the office of the librarian of Congress"; or at his option, the word "copyright,"

together with the year the copyright was entered, and the name of the party by whom it was taken out; thus—  
 “Copyright, 18—, by A. B.”

*Statute Revised*—July 8, 1870, ch. 230, § 97, 16 Stat. 214.

*Prior Statutes*—April 29, 1802, ch. 36, § 1, 2 Stat. 171.—Feb. 3, 1831, ch. 16, § 5, 4 Stat. 437.

Instead of this section being a limitation of the acts to be performed or alleged in order to entitle a party to maintain an action, it imposes an additional duty upon him as a prerequisite to its maintenance. He must first acquire a copyright under the other provisions of the act, and then in order to enforce his rights against infringers he must also give notice of his right by the means prescribed by this section. *Parkinson v. Lasalle*, 3 Saw. 331.

The number of volumes in which it is stated that a work will be published forms no part of the title, and may be rejected as surplusage. Another edition may be published in a different number of volumes, with the same entry, without impairing the copyright. *Dwight v. Appleton*, 1 N. Y. Leg. Obs. 195.

If an entire work, embracing a complete system, is composed of several volumes, it is sufficient if the entry is made on the first volume. *Dwight v. Appleton*, 1 N. Y. Leg. Obs. 195.

The omission to cause the date of the entry of a map to be engraved on some visible portion thereof will prevent a recovery. *King v. Force*, 2 Cranch C. C. 208.

A notice is valid although the initial of the author is used instead of the full Christian name. *Sarony v. Burrow G. L. Co.*, 17 Fed. Rep. 591.

When the required notice is plainly engraved on the plate of an engraving from which the print is taken within the line of a reasonable margin, and where it will not be covered when properly framed, it is impressed on the face within the meaning of the statute. *Rossiter v. Hall*, 5 Blatch. 362.

If a second edition of a map has the proper notice engraved on the face thereof, the use of a different year in the title will not vitiate the copyright. *Farmer v. Calvert Publishing Co.*, 1 Flippin 228; s. c. 5 A. L. T. 168.

Notice that copyright is secured is full protection for the original edition throughout its term, but is no protection to a second edition with notes, nor to any succeeding edition with improvements. *Lawrence v. Dana*, 7 O. G. 81; s. c. 4 Cliff. 1; s. c. 2 A. L. T. (N. S.) 402.

Neglect to give notice that copyright is secured in a second edition will not vitiate the copyright of the original edition, if that was regularly secured. *Lawrence v. Dana*, 7 O. G. 81; s. c. 4 Cliff. 81; s. c. 2 A. L. T. (N. S.) 402.

Subsequent editions, without alterations or additions, should give the same notice that the copyright is secured as the original edition. *Lawrence v. Dana*, 7 O. G. 81; s. c. 4 Cliff. 81; s. c. 2 A. L. T. (N. S.) 402.



Successive editions, with additions or alterations, need not specify the date of the original copyright. *Lawrence v. Dana*, 7 O. G. 81 ; s. c. Cliff. 81 ; s. c. 2 A. L. T. (N. S.) 402.

A copyright of a second edition will not cure material defects in the copyright of the original edition. *Lawrence v. Dana*, 7 O. G. 81 ; s. c. 4 Cliff. 81 ; s. c. 2 A. L. T. (N. S.) 402.

A mere mistake as to the year in which the book was entered will not deprive the author of the benefit of the statute. *Myers v. Callaghan*, 5 Fed. Rep. 726 ; s. c. 10 Biss. 139 ; *contra*, *Baker v. Taylor*, 2 Blatch. 82.

SEC. 4962 A (Act of Aug. 1, 1882, ch. 366, 23 Stat. 181). That manufacturers of designs for molded decorative articles, tiles, plaques, or articles of pottery or metal subject to copyright, may put the copyright mark prescribed by section forty-nine hundred and sixty-two of the Revised Statutes, and acts additional thereto, upon the back or bottom of such articles, or in such other place upon them as it has heretofore been usual for manufacturers of such articles to employ for the placing of manufacturers, merchants, and trade marks thereon.

SEC. 4963. Every person who shall insert or impress such notice, or words of the same purport, in or upon any book, map, chart, musical composition, print, cut, engraving, or photograph, or other article, for which he has not obtained a copyright, shall be liable to a penalty of one hundred dollars, recoverable one-half for the person who shall sue for such penalty, and one-half to the use of the United States.

*Statute Revised*—July 8, 1870, ch. 230, § 98, 16 Stat. 214.

*Prior Statutes*—April 29, 1802, ch. 36, § 4, 2 Stat. 172.—Feb. 3, 1831, ch. 16, § 11, 4 Stat. 438.

This section does not authorize an action in the name of several persons and the United States for the recovery of the penalties incurred by its violation. The plain language and sense of the statute restricts the right of action to a single person. *Ferrett v. Atwill*, 1 Blatch. 151.

If the plaintiff brings several actions, and the defendant files a demurrer in each, the court will not, on the motion of the plaintiff, order an argument of the demurrer in one of the cases and stay all proceedings in the meantime in the other cases, to abide the event of the one to be argued. *Ferrett v. Atwill*, 1 Blatch. 151.

The penalty imposed by this section is imposed only in case of articles that are subject to copyright. *Rosenbach v. Dreyfuss*, 17 O. G. 1153; s. c. 2 Fed. Rep. 217.

If the article mentioned in the declaration may or may not be within the statute, then it is necessary to aver that the article is subject to copyright. *Rosenbach v. Dreyfuss*, 17 O. G. 1153; s. c. 2 Fed. Rep. 217.

SEC. 4964. Every person who, after the recording of the title of any book as provided by this chapter, shall within the term limited, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses, print, publish, or import, or knowing the same to be so printed, published, or imported, shall sell or expose to sale any copy of such book, shall forfeit every copy thereof to such proprietor, and shall also forfeit and pay such damages as may be recovered in a civil action by such proprietor in any court of competent jurisdiction.

*Statute Revised*—July 8, 1870, ch. 230, § 99, 16 Stat. 214.

*Prior Statutes*—May 31, 1790, ch. 15, §§ 2, 6, 1 Stat. 124, 125.—Feb. 3, 1831, ch. 16, § 6, 4 Stat. 437.

The mere recording of the title does not entitle the party to protection for a book not yet made, for the act says a book, but not an intended book. *Centennial Catalogue Co. v. Porter*, 2 W. N. 601.

An action on the case is the appropriate remedy. *Atwill v. Ferrett*, 2 Blatch. 39.

The words “a copy of a book,” naturally import a transcript or copy of the entire book. They do not include cases of copying parts of a book, but only the republication of the whole. *Rogers v. Jewett*, 22 Law Rep. 339.

SEC. 4965. If any person, after the recording of the title of any map, chart, musical composition, print, cut, engraving, or photograph, or chromo, or of the description of any painting, drawing, statue, statuary, or model or design intended to be perfected and executed as a work of the fine arts, as provided by this chapter, shall, within the term limited, and without the consent of the proprietor of the copyright first obtained in writing, signed



in the presence of two or more witnesses, engrave, etch, work, copy, print, publish, or import, either in whole or in part, or by varying the main design with intent to evade the law, or, knowing the same to be so printed, published or imported, shall sell or expose to sale any copy of such map or other article, as aforesaid, he shall forfeit to the proprietor all the plates on which the same shall be copied, and every sheet thereof, either copied or printed, and shall further forfeit one dollar for every sheet of the same found in his possession, either printing, printed, copied, published, imported, or exposed for sale; and in case of a painting, statue, or statuary, he shall forfeit ten dollars for every copy of the same in his possession, or by him sold or exposed for sale; one-half thereof to the proprietor and the other half to the use of the United States.

*Statute Revised*—July 8, 1870, ch. 230, § 100, 16 Stat. 214.

*Prior Statutes*—May 31, 1790, ch. 15, § 2, 1 Stat. 124.—April 29, 1802, ch. 36, § 3, 2 Stat. 171.—Feb, 3, 1831, ch. 16, § 7, 4 Stat. 438.

As the penalty accrues one-half to the proprietor and one-half to the United States, it is a proper subject only of a *qui tam* action. *Stevens v. Cady*, 2 Curt. 200.

A photograph is an infringement of a copyrighted engraving. The word "copy" is a general term added to the more specific terms before used for the very purpose of covering methods of reproduction not included in the words engrave, etch, or work. *Rossiter v. Hall*, 5 Blatch. 362.

The penalty of one dollar for every sheet, whether printed, or being printed or published, or exposed to sale, is limited to sheets in the possession of the defendant. *Backus v. Gould*, 7 How. Pr. 798.

Although an agent in the course of his employment copies and publishes a photograph, yet if he does it without the knowledge of his principal, the latter is not liable under this section. *Schreiber v. Sharpless*, 6 Fed. Rep. 175; s. c. 38 Leg. Int. 73.

A person who has infringed a copyright can not be compelled to discover the number of copies he has sold or has on hand, for this would subject him to a penalty. *Chapman v. Ferry*, 12 Fed. Rep. 693; s. c. 8 Saw. 191.

A bill in equity can not be maintained for the purpose of enforcing a surrender of the plates. *Chapman v. Ferry*, 12 Fed. Rep. 693; s. c. 8 Saw. 191.

SEC. 4966. Any person publicly performing or representing any dramatic composition for which a copyright has been obtained, without the consent of the proprietor thereof, or his heirs or assigns, shall be liable for damages therefor, such damages in all cases to be assessed at such sum, not less than one hundred dollars for the first, and fifty dollars for every subsequent performance, as to the court shall appear to be just.

*Statute Revised*—July 8, 1870, ch. 230, § 101, 16 Stat. 214.

*Prior Statute*—Aug. 18, 1856, ch. 169, § 1, 11 Stat. 138.

The object of this section is to secure to the author of a copyrighted play the sole right to its performance after it is printed. While it is in manuscript he needs no protection. *Boucicault v. Fox*, 5 Blatch. 87; *Roberts v. Myers*, 23 Law Rep. 396; s. c. 17 Leg. Int. 405.

A publication of a dramatic composition after the filing of the title is a violation of this section. *Boucicault v. Hart*, 13 Blatch. 47.

The exclusive right to perform a dramatic composition under the statute depends upon a copyright. There is no such right if there is no copyright. *Boucicault v. Hart*, 13 Blatch. 47.

A composition is a written or literary work invented and set in order. A dramatic composition is such a work in which the narrative is not related, but is represented by dialogue and action. When a dramatic composition is represented in dialogue and action by persons who represent it as real by performing or going through with the various parts or characters assigned to them severally, the composition is performed, acted or represented, and if the representation is in public, it is a public representation. *Daly v. Palmer*, 6 Blatch. 256.

To act is to represent as real by countenance, voice or gesture that which is not real. A character in a play who goes through with a series of events on the stage without speaking, if such be his part in the play, is none the less an actor in it than one who, in addition to motions and gestures, uses his voice. *Daly v. Palmer*, 6 Blatch. 256.

An action may be maintained for a representation after the recording of the title but before publication as well as after publication. *Boucicault v. Wood*, 2 Biss. 34; s. c. 16 A. L. Reg. 539.

If an author receives compensation for permitting the representation of a play after the deposit of the title, he will not lose his right of action merely in consequence of the non-publication of the play. *Boucicault v. Wood*, 2 Biss. 34; s. c. 16 A. L. Reg. 539.

If an author, after depositing the title of a play with the librarian of Congress, consents to its publication in a foreign country prior to the publication here, any manager has the right to import the play and use it on the stage, for this is an abandonment of his rights under our laws. *Boucicault v. Wood*, 2 Biss. 34; s. c. 16 A. L. Reg. 539.



Whenever the identity, resemblance, or dissimilarity of written or printed documents is sought to be established, the documents themselves must be produced. *Boucicault v. Fox*, 5 Blatch. 87.

If the alleged prior book alone is produced without the play, a witness can not be asked whether the scenery, incidents and language are not substantially the same as those in the play. *Boucicault v. Fox*, 5 Blatch. 87.

If neither the play nor the book from which it is alleged to have been dramatized are put in evidence, no evidence can be given of a part of the book, nor can a witness be asked whether such a part is identical with or resembles passages in the play. *Boucicault v. Fox*, 5 Blatch. 87.

If evidence has been taken, the court can not direct a nonsuit. *Boucicault v. Fox*, 5 Blatch. 87.

In determining whether an author assented to the representation of his play, his silence while the piece was being performed may be considered in connection with the other evidence. *Boucicault v. Fox*, 5 Blatch. 87.

**SEC. 4967.** Every person who shall print or publish any manuscript whatever, without the consent of the author or proprietor first obtained, if such author or proprietor is a citizen of the United States, or resident therein, shall be liable to the author or proprietor for all damages occasioned by such injury.

*Statute Revised*—July 8, 1870, ch. 230, § 102, 16 Stat. 215.

*Prior Statute*—February 3, 1831, ch. 16, § 9, 4 Stat. 438.

The word "manuscript" does not include a picture. A picture is the thing itself, but a manuscript is only a description of it in language, and leaves the mind of the reader to make the picture. *Parton v. Prang*, 2 O. G. 619; s. c. 3 Cliff. 537; s. c. 6 A. L. T. 105.

A surreptitious publication of a substantial part of a manuscript is within the principle of the statute. *Bartlett v. Crittenden*, 5 McLean 32.

If the author is a non-resident alien, his assignee is not entitled to protection under the statute. *Keene v. Wheatley*, 4 Phila. 157; s. c. 9 A. L. Reg. 331.

The jurisdiction of the Federal courts is confined to cases of threatened or actual printing and publication, and probably does not include the public performance of a manuscript play. *Boucicault v. Fox*, 5 Blatch. 87.

### **Right at Common Law.**

The right of an author in his manuscript at common law has not been taken away or abridged by the statute relating to copyright. *Woolsey v. Judd*, 4 Duer 379; *Crowe v. Aiken*, 2 Biss. 208; s. c. 4 A. L. Rev. 450 *Jones v. Thorne*, 1 N. Y. Leg. Obs. 408.

An author at common law has a property in his manuscript, and may obtain redress against any one who deprives him of it, or by improperly obtaining a copy endeavors to realize a profit by its publication. *Wheaton v. Peters*, 8 Pet. 591; *Bartlett v. Crittenden*, 5 McLean 32; *Paige v. Banks*, 13 Wall. 608; s. c. 7 Blatch. 152.

The exclusive right of an author in a manuscript yet unpublished rests solely upon the right which every man has to the exclusive possession and control of the products of his own labor. *Woolsey v. Judd*, 4 Duer 379; *Grigsby v. Breckenridge*, 2 Bush. 480.

The right of the author is not confined to the material on which his manuscript is written. The exclusive right is the right of property in the words, thoughts and sentiments which in their connection form the written composition which his manuscript embodies and preserves. *Woolsey v. Judd*, 4 Duer 379.

The right of property in the author of a manuscript is absolute and unlimited. As owner he has an absolute right to suppress as well as to publish. *Woolsey v. Judd*, 4 Duer 379.

An author of a literary work or composition has a right to the first publication of it. He has a right to determine whether it shall be published at all, and if published, when, where, by whom, and in what form. *Palmer v. De Witt*, 47 N. Y. 532; s. c. 36 How. Pr. 222; 40 How. Pr. 293; 5 Abb. Pr. (N. S.) 13; 2 Sweeny 530.

An author's property in his manuscript is not distinguishable from any other personal property. It is governed by the same rules of transfer and succession. It is personal like other movable property, following the person of the owner, and is governed by the law of his domicile. *Palmer v. De Witt*, 47 N. Y. 532; s. c. 36 How. Pr. 222; 40 How. Pr. 293; 5 Abb. Pr. (N. S.) 13; 2 Sweeny 530.

After publication an author's exclusive right to his manuscript ceases at common law. Such publication may be either by words, writing, printing, lectures, sermons, or dramatic representation. If in any of these modes the public become possessed of the contents of a manuscript, without restrictions express or implied, it is such a publication as divests the author of an exclusive property in the work. *Palmer v. De Witt*, 5 Abb. Pr. (N. S.) 130; s. c. 36 How. Pr. 222; s. c. 40 How. Pr. 293; s. c. 2 Sweeny 530; s. c. 47 N. Y. 532.

A publication may be limited or general. It is general, whenever the communication effecting it is not restricted, both as to the persons to whom, and the purpose for which it is made. When general, it is a dedication to the public for such unlimited uses, including all modes of publishing and republishing, as it may be the means of directly or secondarily enabling any person to make. *Keene v. Wheatley*, 4 Phila. 157; s. c. 9 A. L. Reg. 331.

Publication is circulation before the public eye by printing or multiplied copies in writing. *Grigsby v. Breckinbridge*, 2 Bush 480.

An author retains his right in his manuscript until he relinquishes it by contract or some unequivocal act indicating an intent to dedicate it to the



public. *Palmer v. De Witt*, 47 N. Y. 532; s. c. 36 How. Pr. 222; 40 How. Pr. 293; 5 Abb. Pr. (N. S.) 130; s. c. 2 Sweeny 530.

When a literary work is exhibited for a particular purpose, or to a limited number of persons, it will not be construed as a general gift or authority for any purpose of profit or publication by others. *Palmer v. De Witt*, 47 N. Y. 532; s. c. 36 How. Pr. 222; 40 How. Pr. 293; 5 Abb. Pr. (N. S.) 130; s. c. 2 Sweeny 530.

If an author permits copies of his manuscript to be taken for the gratification of his friends, he does not authorize them to print it for general use. *Bartlett v. Crittenden*, 4 McLean 300.

The mere use of a manuscript for the purpose of imparting instruction to pupils does not constitute an abandonment of it, although they were required or permitted to make copies for that purpose. *Bartlett v. Crittenden*, 5 McLean 32; *Bartlett v. Crittenden*, 4 McLean 300.

The right of property in a manuscript may be abandoned the same as any other right of property. *Bartlett v. Crittenden*, 5 McLean 32.

The intention to publish is only material on the question of abandonment. *Bartlett v. Crittenden*, 5 McLean 32.

An unqualified publication by printing and offering for sale is a dedication to the public. *Palmer v. DeWitt*, 47 N. Y. 532; s. c. 36 How. Pr. 222; s. c. 40 How. Pr. 293; s. c. 5 Abb. Pr. (N. S.) 130; s. c. 2 Sweeny 530.

A person who has been employed by the State to make surveys and explorations, or to act as draughtsman for a party doing such work, has no right to publish a map from materials so collected. *Comm. v. Desilver*, 3 Phila. 31.

The owner of a manuscript copy of a map which has been dedicated to the public, can not interfere by injunction or otherwise with the right of others to make a copy from manuscripts owned by them, or to put them to any use desired. *Rees v. Peltzer*, 75 Ill. 475.

If the manuscript contains the framework of a system, it will be protected, although it is incomplete. *Bartlett v. Crittenden*, 4 McLean 300.

An abstract book which contains a complete history of the title and incumbrances to land in a certain locality, can not be published without the consent of the compiler. *Banker v. Caldwell*, 3 Minn. 94.

If the author of a map gives a copy of it to a municipal corporation for public use, and sells copies to others for their use without restriction, this is such a publication as to deprive him of his proprietorship in the literary property. *Rees v. Peltzer*, 75 Ill. 475.

If the bill alleges that the defendant wrongfully obtained possession of the complainant's manuscript and stereotype plates and published the work, it will be dismissed, for there is ample remedy at law. *Monk v. Harper*, 3 Edw. Ch. 109.

A manuscript, however valuable, can not be seized by the author's creditors as property. *Bartlett v. Crittenden*, 5 McLean 32.

A sheriff who has levied an execution upon an unpublished work has no right to make copies thereof in the interval between the levy and the