

NOTICE.

☞ Since this volume was printed, a new and general Act has been passed by Congress, approved July 8th, 1870, as to Patents, Copyrights, and Trademarks, and repealing the former existing laws as to Patents and Copyrights.

This new law, though substantially the same with the former existing laws as to Patents and Copyrights, may be found in full at the end of this volume, which thus contains *all* the laws, arranged in chronological order, as to Patents and Copyrights, which have ever been passed in this country, and which can be found in no other volume, except in "THE AMERICAN PATENT DIGEST," edited by the author of this volume.

COPYRIGHT

AND

PATENT LAWS

OF THE

UNITED STATES,

1790 TO 1870.

WITH

NOTES OF JUDICIAL DECISIONS THEREUNDER

AND

FORMS AND INDEXES.

By STEPHEN D. LAW,

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COPYRIGHT, AND TRADE-MARK CASES."

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PREFACE.

In the United States, property in Copyright and in Patents for Inventions is created by, and held solely under laws passed by the General Government. Previous to the adoption of the Federal Constitution, in 1789, the several States had granted exclusive rights to authors and inventors; but that instrument gave to Congress "power to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries;" and the States can now perform no act in respect thereto, or none not in harmony with, and subordinate to, the superior power of Congress.

In 1790, at the first session of Congress, and among its earliest acts, laws were passed "to promote the progress of useful arts," and "for encouragement of learning, by securing the copies of maps, charts, and

books to the authors and proprietors of such copies, during the times therein mentioned.”

The Copyright act of 1790 remained unchanged until 1802, when a supplementary act was passed, extending also its provisions, in which form it continued in force until 1831, when it was repealed, and a new and more complete act substituted in place of it. The act of 1831 is still in force, and is the basis of the existing copyright system of the country; but has been amended and enlarged by acts passed in 1834, 1846, 1856, 1859, 1861, and 1865.

The Patent act of 1790 was superseded by an act passed in 1793, and this latter act, amended and enlarged by acts passed in 1794, 1800, 1819, and 1832, continued in force until 1836, when the entire legislation in respect to patents for inventions was revised, and a new and more carefully drawn law enacted. The act of 1836 still remains in force, and is the basis of the existing patent system of the country; but has been enlarged and amended by acts passed in 1837, 1839, 1842, 1848, 1849, 1851, 1852, 1853, 1855, 1856, 1859, 1860, 1861, 1862, 1863, 1864, and 1865.

The duration of the term of a copyright was fixed, by the act of 1790, at fourteen years, with a right of renewal for fourteen years longer. By the act of 1831, the first term of a copyright was enlarged to twenty-eight years, with a right of renewal, as before,

for fourteen years; thus making the whole term forty-two years.

The duration of the term of patents for inventions was fixed, by the first act of 1790, at fourteen years. The act of 1836 fixed the same duration, but made provision for an extension, under certain circumstances, for seven years longer. By the act of 1861, the term of a patent was fixed at seventeen years—except as to patents for designs, which may be three and a half, or seven, or fourteen years, as desired; and the extension of all patents granted subsequent to the date of that act, March 2d, 1861, was prohibited—except as to patents for designs, which may be extended for seven years.

Congress, however, can grant such exclusive rights for any period, or extend existing terms, as it may see fit; and it has frequently exercised such power, by special acts, even after the expiration of terms secured under the general law.

The laws of this country, in respect to copyrights, except as to the duration of the term, and the formalities by which secured, are substantially like those of England and other countries; in respect, however, to patents for inventions, the differences between our laws and those of other countries are marked and distinct.

The great distinguishing feature of the patent sys-

tem of this country is that which requires all applications for patents to be subjected to a preliminary examination, as to originality and novelty of invention, before a patent can issue, and which forbids the issue of a patent to any one who is not the *first* as well as an *original inventor* of the thing sought to be patented. Though the practical operation of such a system is necessarily attended with difficulties, and the exercise of such power of rejection may sometimes work injustice to the deserving inventor, it can scarcely be questioned that it is highly useful, as well to the inventor, in bringing to his notice what is already known in the art to which his invention appertains, as to the public in interposing a salutary check to the issue of trifling or worthless patents.

In England, and in most other countries, patents, originally, were grants proceeding directly from the sovereign, and were considered by the courts as monopolies, odious in the eye of the law, and to be construed strictly. In this country, however, it has been uniformly held that the design of our patent laws was to encourage genius in advancing the arts, by protecting its productions, and that such laws were to be construed favorably and beneficially for patentees; and that patents granted thereunder were to be considered not as monopolies, but liberally, and as

highly beneficial to the community, as well as rewards to ingenious men for the advantages derived by the public from their exertions.

The copyright and patent systems of this country, as established by the legislature, and interpreted by the courts, may justly be considered as liberal and highly favorable to such interests; and in no country, probably, are the rights of authors and inventors more generally recognized, or their rewards and remuneration more ample and munificent.

In this compilation, the several laws, as to copyright and patents for inventions, which are obsolete, are inserted in full, as well as those laws which are now in force; this has been done for convenience of reference and comparison, and to help to a more perfect understanding and interpretation of those in force.

Notes of decisions, which have a more particular reference to the obsolete acts, are inserted under such acts; decisions of a general nature, though made under such acts, are inserted under the acts now in force. It has not been intended, however, to insert under the several acts all the decisions explanatory of them, but only those of a more general character; adding also suitable references to the appropriate titles of the "Digest of Patent Cases," a work published by the author of the present volume, and

being a Digested Abstract of all the Cases relating to Copyright, Patents for Inventions, and Trade-marks, decided in the American courts, from 1789 to the present time.

THE AUTHOR.

NEW YORK, *June*, 1866.

PROVISION
OF THE
CONSTITUTION OF THE UNITED STATES
AUTHORIZING THE GRANT OF
EXCLUSIVE RIGHTS TO AUTHORS AND INVENTORS.

CONSTITUTION OF THE UNITED STATES.

ARTICLE 1, SECTION 8.

THE Congress shall have power:

To promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries:

Also, to make all laws which shall be necessary and proper for carrying into execution the foregoing powers.

POWER OF CONGRESS, AND OF THE STATES UNDER.

1. The power of Congress, under this article and section, is limited to authors and inventors only, and does not embrace introducers, who are not authors and inventors. *Livingston v. Van Ingen*, 9 Johns., 560, 566, 582.—YATES, THOMPSON, and KENT, JJ.; (Ct. Errors;) N. Y., 1812.

2. But such clause does not prevent the several States from exercising the power of securing to introducers of useful inventions (without being the authors or inventors) the exclusive benefit of such inventions for a limited period. *Ibid.*, 560, 566, 582.

POWER OF CONGRESS, AND OF THE STATES UNDER.

3. Nor does it take away from the States the power to enlarge, within their jurisdiction, the privilege, by extending the term of the patent or monopoly, beyond the term allowed by the acts of Congress; nor operate as an exclusion of all State legislation to aid and protect the rights obtained under the general government, if the power is exercised in harmony with, and in subordination to, the superior power of Congress. *Ibid.*, 567, 581.

4. Though a State cannot take away from an individual his patent, yet if an author or inventor, instead of resorting to the act of Congress, should apply to the legislature of a State for an exclusive right to his production, there is nothing to hinder a State granting it, though the operation of the grant would be confined to the limits of the State. *Ibid.*, 581.

5. The power of Congress is only to ascertain and define the rights of property in the invention; it does not extend to regulating the use of it. This is exclusively of local cognizance; such property, like every other species, must be used and enjoyed within each State, according to the laws of such State. *Ibid.*, 581.

6. The laws of any State, granting exclusive rights and privileges in respect to patents and inventions, are inoperative as against the laws of the United States, with which they may come in collision. *Gibbons v. Ogden*, 9 Wheat., 186.—MARSHALL, Ch. J.; Sup. Ct., 1824.

7. If the author's book or print contains matter injurious to the public morals or peace, or if the inventor's machine or other production will have a pernicious effect upon the public health or safety, a competent authority remains with the States to restrain their use. *Livingston v. Van Ingen*, 9 Johns., 582.—KENT, J.; N. Y., 1812.

8. Such species of property is likewise subject to taxation, and to the payment of debts, as other personal property. *Ibid.*, 582.

9. The fact that a party has a patent giving him the exclusive right to make, use, and sell a particular medicine, does not confer upon him the right to practise as a physician, and use such medicine, in any particular State, except in conformity with the laws of such State. *Jordan v. Overseers of Poor*, 4 Ohio, 310.—LANE, J.; Ohio, 1831. *Thompson v. Staats*, 15 Wend., 395.—NELSON, J.; N. Y., 1836.

10. A party has not necessarily a right to use an invention in any State, merely because he has a patent for it. *Vannani v. Paine*, 1 Harrington, 68.—ROBINSON, J.; Del., 1833.

11. Where V. had invented a plan for constructing and drawing lotteries, and had obtained a patent therefor, but there was a State law prohibiting lotteries, except under certain conditions, which V. and his associates had not complied with, *Held*, that V. was not entitled to any relief, by way of injunction or otherwise, for any alleged use of his invention within such State. *Ibid.*, 69.

12. The power of Congress, as to patents, is general, and it rests in its sound discretion to say, when and for what length of time, and under what circumstances, a patent for an invention shall be granted.

POWER OF CONGRESS, AND OF THE STATES UNDER.

There is no restriction which limits its power to enact, to cases where the invention has not been known or used by the public. All that is required is, that the patentee should be the inventor. *Blanchard v. Sprague*, 3 Sumn., 541.—STORY, J.; Mass., 1839.

13. The power of Congress to legislate upon the subject of patents is plenary; and as there is no restraint upon its exercise, there can be no limitation to the right to modify at pleasure the laws respecting patents, so that they do not take away the rights of property in existing patents. *McClurg v. Kingsland*, 1 How., 206.—BALDWIN, J.; Sup. Ct., 1843.

14. It is no objection to the validity of the laws respecting patents, that such laws are retrospective in their operation. *Ibid.*, 206.

15. Congress may pass an act which shall act retrospectively. Such an act is not necessarily unconstitutional. Though no State can impair the obligations of a contract, this inhibition does not apply to the general government. *Bloomer v. Stolley*, 5 McLean, 165.—MOLEAN, J.; Ohio, 1850.

16. A reservation in favor of *assignees*, in an act extending a patent, will not make the act unconstitutional on the ground that Congress can only confer privileges on *inventors*. The power to reserve rights and privileges to assignees is incidental to the general power conferred to promote the progress of the useful arts. *Blanchard Gun-Stock Turning Fac. v. Warner*, 1 Blatchf., 271, 276.—NELSON, J.; Ct., 1846.

17. Congress has the constitutional right to confer a new and further term on the patentee, and that even after the expiration of the first. *Blanchard v. Haynes*, 6 West. Law Jour., 83.—WOODBURY, J.; N. H., 1848.

18. Alleged fraud and misrepresentation, in the passage of an act of Congress extending a patent, will not be presumed; but such an act will be regarded by the courts as the law of the land, until it is repealed. *Gibson v. Gifford*, 1 Blatchf., 531.—NELSON, J.; N. Y., 1850.

19. Under the fifth amendment of the Constitution, declaring that no person shall be deprived of life, liberty, or property, without due process of law, Congress would have no right to pass an act depriving purchasers of a patented article of the right to use such article. Such an act would not be regarded as due process of law. *Bloomer v. McQuewan*, 14 How., 553.—TANEY, Ch. J.; Sup. Ct., 1852.

20. Under the authority conferred by section 8th, article 1st, of the Constitution, it does not follow that Congress may authorize an inventor to recall rights which he has granted to others, or reinvest him with rights of property, which he has before conveyed for a valuable consideration. *Ibid.*, 553.

21. Congress may renew a patent or decline to do so. The grant of an exclusive privilege to an inventor for a limited time, does not imply a binding and irrevocable contract with the people, that at the expiration of the period the invention shall become their property. *Evans v. Eaton*, Pat. C. C., 337.—WASHINGTON, J.; Penn., 1816.

POWER OF CONGRESS, AND OF THE STATES UNDER.

22. Congress has the constitutional power to grant an extension of a patent even after it has been once extended under section 18 of the act of 1836. *Bloomer v. Stolley*, 5 McLean, 160-162.—MCLEAN, J.; Ohio, 1850.

23. The power of Congress was not exhausted in this respect by the act of 1836. A legislative act does not bind a subsequent legislature. *Ibid.*, 161.

24. Congress may exercise its constitutional power, as to granting rights to inventors, either by special acts, or by a general system. *Ibid.*, 161.

25. A private act of Congress, authorizing the issue of a patent to an inventor, is to be considered as engrafted on the general acts for the promotion of the useful arts, and such a patent is issued in pursuance of both. *Evans v. Eaton*, 3 Wheat., 518.—MARSHALL, Ch. J.; Sup. Ct., 1818.

26. They are all statutes in *pari materia*, and all relate to the same subject, and are to be construed together. *Bloomer v. McQuewan*, 14 How., 549, 551.—TANEY, Ch. J.; Sup. Ct., 1852.

See also DIGEST PAT. CASES, titles CONGRESS; STATUTES B. 1, 4.

ACTS OF CONGRESS
IN RESPECT TO
COPYRIGHTS.

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Those marked thus (*) are obsolete.
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COPYRIGHT LAWS.

ACT OF 1790, CHAPTER 15.

1 STATUTES AT LARGE, 124.

[*Obsolete: Repealed by Act of 1831, § 14.*]

AN Act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the times therein mentioned :

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That from and after the passing of this act, the author and authors of any map, chart, book or books already printed within these United States, being a citizen or citizens thereof or resident within the same, his or their executors, administrators or assigns, who hath or have not transferred to any other person the copyright of such map, chart, book or books, share or shares thereof; and any other person or persons, being a citizen or citizens of these United States, or residents therein, his or their executors, administrators or assigns, who hath or have purchased or legally acquired the copyright (a) of any such map, chart, book or books, in order to print, reprint, publish, or vend the same, shall have the sole right and liberty of printing, reprinting, publishing, and vending such map, chart, book or books, for the

term of fourteen years from the recording the title thereof in the clerk's office, as is hereinafter directed: And that the author and authors of any map, chart, book or books already made and composed, and not printed or published, or that shall hereafter be made and composed, being a citizen or citizens of these United States, or resident therein, and his or their executors, administrators or assigns, shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the like term of fourteen years from the time of recording the title thereof in the clerk's office as aforesaid. And if, at the expiration of the said term, the author or authors, or any of them, be living, and a citizen or citizens of these United States, or resident therein, the same exclusive right shall be continued to him or them, his or their executors, administrators or assigns, for the further term of fourteen years: *Provided*, he or they shall cause the title thereof to be a second time recorded and published in the same manner as is hereinafter directed, and that within six months before the expiration of the first term of fourteen years aforesaid.

(a) The "copyright" recognized by this act, and which is intended to be protected, is presumed to be the right of property which an author has at common law, in his manuscript. Such protection is given as well to books published, as to manuscript copies. *Wheaton v. Peters*, 8 Pet., 661.—MOLEAN, J.; Sup. Ct., 1834.

SECTION 2. *And be it further enacted*, That if any other person or persons, from and after the recording the title of any map, chart, book or books, and publishing the same as aforesaid, and within the times limited and granted by this act, shall print, reprint, publish, or import, or cause to be printed, reprinted, published, or

OBSOLETE.

ACT OF 1790, CHAP. 15, §§ 2, 3.

imported from any foreign kingdom or state, any copy or copies of such map, chart, book or books, without the consent of the author or proprietor thereof, first had and obtained in writing, signed in the presence of two or more credible witnesses; or, knowing the same to be so printed, reprinted, or imported, shall publish, sell, or expose to sale, or cause to be published, sold, or exposed to sale, any copy of such map, chart, book or books, without such consent first had and obtained in writing as aforesaid, then such offender or offenders shall forfeit all and every copy and copies of such map, chart, book or books, and all and every sheet and sheets, being part of the same, or either of them, to the author or proprietor of such map, chart, book or books, who shall forthwith destroy the same: And every such offender and offenders shall also forfeit and pay the sum of fifty cents for every sheet which shall be found in his or their possession, either printed or printing, published, imported, or exposed to sale, contrary to the true intent and meaning of this act, the one moiety thereof to the author or proprietor of such map, chart, book or books, who shall sue for the same, and the other moiety thereof to and for the use of the United States, to be recovered by action of debt in any court of record in the United States, wherein the same is cognizable. *Provided always*, That such action be commenced within one year after the cause of action shall arise, and not afterward.

SECTION 3. *And be it further enacted*, That no person shall be entitled to the benefit of this act, in cases where any map, chart, book or books, hath or have been already printed and published, unless he shall first deposit, and in all other cases, unless he shall before publication deposit

a printed copy of the title of such map, chart, book or books, in the clerk's office of the district court where the author or proprietor shall reside (a): And the clerk of such court is hereby directed and required to record the same forthwith, in a book to be kept by him for that purpose, in the words following (giving a copy thereof to the said author or proprietor, under the seal of the court, if he shall require the same.) "District of _____ to wit: *Be it remembered*, That on the _____ day of _____ in the _____ year of the independence of the United States of America, A. B., of the said district, hath deposited in this office the title of a map, chart, book or books (as the case may be), the right whereof he claims as author or proprietor (as the case may be), in the words following, to wit: [here insert the title] in conformity to the act of the Congress of the United States, intituled, 'An act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the times therein mentioned.' C. D., clerk of the district of _____."

"For which the said clerk shall be entitled to receive sixty cents from the said author or proprietor, and sixty cents for every copy under seal actually given to such author or proprietor as aforesaid. And such author or proprietor shall, within two months from the date thereof, cause a copy of the said record to be published in one or more of the newspapers printed in the United States, for the space of four weeks. (b)

(a) If the title of an author depended upon the act of 1790, it would be complete, provided he had deposited a printed copy of the title of the book in the clerk's office, as directed by this section. *Ewer v. Coxe*, 4 Wash., 490.—WASHINGTON, J.; Pa., 1824.

(b) 1. The provision of this section requiring the author to publish

OBSOLETE.

ACT OF 1790, CHAP. 15, §§ 3-5.

the title of his book, in a newspaper, is merely directory, and constitutes no part of the essential requisites for securing the copyright. *Nichols v. Ruggles*, 3 Day, 158.—CURIAM; Ct., 1808.

2. The publication in the newspaper is intended as legal notice of the rights secured to the author; but is not necessary where actual notice is brought home to the party. *Ibid.*, 158.

3. The condition upon which the proprietor is to be entitled to the benefit of the act cannot be extended to the requisition contained in the last sentence of that section, to publish a copy of the record of the title, as prescribed therein. *Ewer v. Coxe*, 4 Wash., 490.—WASHINGTON, J.; Pa., 1824.

4. The publication of a copy of such notice is only necessary to enable him to sue for the forfeitures created by that section. *Ibid.*, 490.

SECTION 4. *And be it further enacted,* That the author or proprietor of any such map, chart, book or books, shall, within six months after the publishing thereof, deliver, or cause to be delivered to the Secretary of State a copy of the same, to be preserved in his office.

1. The requirement of this section, as to delivering a copy of the book to the Secretary of State, is merely directory, and constitutes no part of the essential requisites for securing a copyright. The copy to be delivered to the Secretary of State appears to be designed for public purposes, and has no connection with the copyright. *Nichols v. Ruggles*, 3 Day, 158.—CURIAM; Ct., 1808.

2. Under this section a copy of a book may be deposited with the Department of State, after the expiration of six months from the time of its publication if not done before, and will avail from the time of its being deposited. *Daboll's Case*, 1 Opin., 532.—WIRT, Atty. Gen.; 1822.

3. Where a work consisted of a number of volumes, the delivery to the Secretary of State of the first volume of the work within six months after its publication and of the rest of the volumes, before the offence complained of is committed, or the action brought, is a sufficient compliance with the law. *Dwight v. Appletons*, 1 N. Y. Leg. Obs., 199.—THOMPSON, J.; N. Y., 1843.

SECTION 5. *And be it further enacted,* That nothing in this act shall be construed to extend to prohibit the importation or vending, reprinting or publishing, within the United States, of any map, chart, book or books, writ-

ten, printed, or published by any person not a citizen of the United States, in foreign parts or places without the jurisdiction of the United States.

SECTION 6. *And be it further enacted,* That any person or persons who shall print or publish any manuscript, without the consent and approbation of the author or proprietor thereof, first had and obtained as aforesaid (if such author or proprietor be a citizen of, or resident of these United States), shall be liable to suffer and pay to the said author or proprietor all damages occasioned by such injury, to be recovered by a special action on the case founded upon this act, in any court having cognizance thereof.

SECTION 7. *And be it further enacted,* That if any person or persons shall be sued or prosecuted for any matter, act, or thing done under or by virtue of this act, he or they may plead the general issue, and give the special matter in evidence.

Approved May 31st, 1790.

ACT OF 1802, CHAPTER 36.

2 STATUTES AT LARGE, 171.

[*Obsolete: Repealed by Act of 1881, § 14.*]

An Act supplementary to an act, intituled "An act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the time therein mentioned," and extending the benefits thereof to the arts of designing, engraving, and etching historical and other prints.

OBSOLETE.

ACT OF 1802, CHAP. 36, § 1.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That every person who shall, from and after the first day of January next, claim to be the author or proprietor of any maps, charts, book or books, and shall thereafter seek to obtain a copyright of the same agreeable to the rules prescribed by law, before he shall be entitled to the benefit of the act, intituled "An act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the time therein mentioned," he shall, in addition (a) to the requisites enjoined in the third and fourth sections of said act, if a book or books, give information by causing the copy of the record, which, by said act, he is required to publish in one or more of the newspapers, to be inserted at full length in the title-page, or in the page immediately following the title of every such book or books; and if a map or chart shall cause the following words to be impressed on the face thereof, viz.: "*Entered according to act of Congress, the* *day of* 18 [here insert the date when the same was deposited in the office] *by* A. B. *of the State of* [here insert the author's or proprietor's name and the State in which he resides].

(a) 1. By this section no person can be entitled to the benefit of the act of 1790, unless he shall, *in addition* to the requisites enjoined in sections 3 and 4 of that act, cause a copy of the record, required by that act to be published, to be inserted at full length in the title-page, or on the page immediately following the title of the book. *Ewer v. Cox*, 4 Wash., 490.—WASHINGTON, J.; Pa., 1824.

2. The person, therefore, claiming a copyright, before he can be entitled to the benefits of the act of 1790, must perform the requisites required by this act, *in addition* to those prescribed in sections 3 and 4 of the act of 1790, and must perform the whole. The act admits of no other construction. *Ibid.*, 491.

3. The meaning of the act is as if it read, "the proprietor, before he shall be entitled to the benefit of the act of 1790, shall cause a copy of the record of the title to be published, and shall deliver a copy of the book to the Secretary of State, as directed by the third and fourth sections of that act; and shall also cause a copy of the said record to be inserted at full length in the title-page," &c. *Ibid.*, 491.

4. The act of 1802 requires the requisites enjoined in sections 3 and 4 of the act of 1790, as to notice and the deposit of the book in the State Department, to be performed "in addition" to the one required by this act of 1802, before an author "shall be entitled to the benefit of the first act." *Wheaton v. Peters*, 8 Pet., 665.—MCLEAN, J.; Sup. Ct., 1834.

SECTION 2. *And be it further enacted*, That from and after the first day of January next, every person, being a citizen of the United States or resident within the same, who shall invent and design, engrave, etch or work, or from his own works and inventions, shall cause to be designed and engraved, etched or worked, any historical or other print or prints, shall have the sole right and liberty of printing, reprinting, publishing, and vending such print or prints, for the term of fourteen years from the recording the title thereof in the clerk's office, as prescribed by law for maps, charts, book or books: *Provided*, he shall perform all the requisites, in relation to such print or prints, as are directed in relation to maps, charts, book or books, in the third and fourth sections of the act to which this is a supplement, and shall moreover cause the same entry to be duly engraved on such plate, with the name of the proprietor, and printed on every such print or prints as is hereinbefore required to be made on maps or charts.

1. The person who, under this section, is intended and described as the proprietor of a copyright in a print, is one who shall not only invent *and* design, but who shall also engrave, etch, or work the print to which the right is claimed; or, who, *from his own works and inventions*, shall cause the print to be designed and engraved, etched, or worked. *Binns v. Woodruff*, 4 Wash., 51.—WASHINGTON, J.; Pa., 1821.

OBSOLETE.

ACT OF 1802, CHAP. 36, §§ 2, 3.

2. In the first case, the inventor and designer is identified with the engraver, or, in other words, the entire work, or subject of the copyright, is executed by the same person. In the latter, the invention is designed or embodied by the person in whom the right is vested, and the form and completion of the work are executed by another. *Ibid.*, 51.

3. But in neither case can a person claim a copyright for a mere invention, the work of his imagination locked up in his own mind, or existing in a form not visible to others. Neither is he so entitled, unless he has not only invented, but also designed or represented the subject in some visible form. *Ibid.*, 51.

4. Where neither the design nor the general arrangement of a print, nor the parts which composed it, was the invention of the plaintiff, but he had employed and paid the artists who had composed and executed it, *Held*, that under this section he was not entitled to a copyright. *Ibid.*, 53.

SECTION 3. *And be it further enacted*, That if any printseller or other person whatsoever, from and after the said first day of January next, within the time limited by this act, shall engrave, etch or work, as aforesaid, or in any other manner copy or sell, or cause to be engraved, etched, copied or sold, in the whole or in part, by varying, adding to, or diminishing from the main design, or shall print, reprint, or import for sale, or cause to be printed, reprinted, or imported for sale, any such print or prints, or any parts thereof, without the consent of the proprietor or proprietors thereof, first had and obtained, in writing, signed by him or them respectively, in the presence of two or more credible witnesses; or knowing the same to be so printed or reprinted, without the consent of the proprietor or proprietors, shall publish, sell, or expose to sale or otherwise, or in any other manner dispose of any such print or prints, without such consent first had and obtained, as aforesaid, then such offender or offenders shall forfeit the plate or plates on which such print or prints are or shall be copied, and all

and every sheet or sheets (being part of or whereon such print or prints are or shall be copied or printed) to the proprietor or proprietors of such original print or prints, who shall forthwith destroy the same; and further, that every such offender or offenders shall forfeit one dollar for every print which shall be found in his, her, or their custody; either printed, published, or exposed to sale, or otherwise disposed of, contrary to the true intent and meaning of this act, the one moiety thereof to any person who shall sue for the same, and the other moiety thereof to and for the use of the United States, to be recovered in any court having competent jurisdiction thereof.

SECTION 4. *And be it further enacted*, That if any person or persons, from and after the passing of this act, shall print or publish any map, chart, book or books, print or prints, who have not legally acquired the copyright of such map, chart, book or books, print or prints, and shall, contrary to the true intent and meaning of this act, insert therein or impress thereon that the same has been entered according to act of Congress, or words purporting the same, or purporting that the copyright thereof has been acquired; every person so offending shall forfeit and pay the sum of one hundred dollars, one moiety thereof to the person who shall sue for the same, and the other moiety thereof to and for the use of the United States, to be recovered by action of debt in any court of record in the United States, having cognizance thereof. *Provided always*, that in every case for forfeitures hereinbefore given, the action be commenced within two years from the time the cause of action may have arisen.

Approved April 29th, 1802.

ACT OF 1819, CHAPTER 19.

3 STATUTES AT LARGE, 481

[This Act still in Force.]

An act to extend the jurisdiction of the Circuit Courts of the United States to cases arising under the law relating to patents [and copyrights].

Be it enacted, by the Senate and House of Representatives of the United States of America, in Congress assembled, That the Circuit Courts of the United States shall have original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases, arising under any law of the United States, granting or confirming to authors or inventors the exclusive right to their respective writings, inventions, and discoveries; and upon any bill in equity, filed by any party aggrieved in any such cases, shall have authority to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any authors or inventors, secured to them by any laws of the United States, on such terms and conditions as the said courts may deem fit and reasonable (a); *Provided, however,* That from all judgments and decrees of any Circuit Courts, rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner, and under the same circumstances, as is now provided by law in other judgments and decrees of such Circuit Courts. (b)

(a) 1. The act of 1819, so far as it gave cognizance to the courts of

the United States in cases of copyrights, still remains in force, and is the only law conferring equitable jurisdiction on these courts in such cases; the ninth section of the act of 1831 protects manuscripts only. *Stephens v. Gladding*, 17 How., 455.—CURTIS, J.; Sup. Ct., 1854.

2. The equity jurisdiction of such courts, as to copyrights, does not extend to the adjudication of forfeitures: a decree, therefore, cannot be entered for the penalties incurred for a violation of a copyright. *Ibid.*, 455.

3. Under the acts of 1790 and 1819, as to patents and copyrights the owners of copyrights and patents do not have redress or relief in any cases where they could not before have had relief in some court, either of equity or law. *Pierpont v. Fowle*, 2 Wood. & Min., 27.—WOODBURY, J.; Mass., 1846.

4. These acts merely enable them to prosecute such claims in the Circuit Court of the United States, as they usually had done before, but without going to the State tribunals; the public interest required a uniform construction to be placed by one tribunal on all important questions connected with rights so held. *Ibid.*, 27.

5. The jurisdiction of the Federal courts, under the acts of Congress respecting copyrights, has not taken away or diminished the original jurisdiction, which, before such acts, the State courts exercised—except where the jurisdiction was made exclusive in express terms, or by the necessary construction of the Federal Constitution. *Woolsey v. Judd*, 4 Duer, 382.—DUER, J.; N. Y., 1855.

6. Under the act of Congress, giving to the Circuit Courts cognizance of cases arising under the laws of the United States, granting to authors the exclusive right to their writings, the citizenship of the parties litigant is immaterial. *Keene v. Wheatley*, 9 Amer. Law Reg., 44, 45.—CADWALLADER, J.; Pa., 1860.

7. The act of 1819 concerns remedies, and not rights. *Ibid.*, 45.

8. Where a wrong has been committed in respect to a literary work, but the bill does not ask for an injunction to protect the common law rights of the author, or the violation of any copyright secured, but only asks an account, redress cannot be sought in a court of equity, but the party must proceed at law for damages. *Monk v. Harper*, 3 Edw. Ch., 110, 111.—McCOUN, V. Chan.; N. Y., 1837.

See also DIGEST PAT. CASES, titles ACTIONS, A; EQUITY, A.

(b) A writ of error, or appeal, as the case may require, now lies to the Supreme Court, from all judgments or decrees of any Circuit Court, rendered in any action, at law or in equity, arising under any of the laws as to copyrights. Act of 1861, chap. 37.

IN FORCE.

ACT OF 1831, CHAP. 16, § 1.

ACT OF 1831, CHAPTER 16.

4 STATUTES AT LARGE, 436.

[This Act still in Force.]

An Act to amend the several acts respecting copyrights.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That from and after the passing of this act, any person or persons, being a citizen or citizens of the United States, or resident therein, who shall be the author or authors of any book or books, map, chart, or musical composition, which may be now made or composed, and not printed and published, or shall hereafter be made or composed, or who shall invent, design, etch, engrave, work, or cause to be engraved, etched, or worked from his own design, any print or engraving, and the executors, administrators, or legal assigns of such person or persons (a), shall have the sole right and liberty of printing, reprinting, publishing, and vending (b) such book or books, map, chart, musical composition, print, cut, or engraving, in whole or in part, for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed. (c)

(a) WHO MAY HAVE, AND WHAT SUBJECT OF COPYRIGHT.

1. Under this act a person, to be a "resident" so as to be entitled to a copyright, must be a permanent resident of the country. A person temporarily residing here, even though he has declared his intention of becoming a citizen, cannot take or hold a copyright. *Carey v. Collier*, 56 Niles's Reg., 262.—BETTS, J.; N. Y., 1839.

2. The legal assignee of the author may take out the copyright, and it will make no difference whether he holds it as trustee for the benefit

of another or not. *Little v. Gould*, 2 Blatchf., 366.—NELSON, J.; N. Y., 1852.

3. Under this act no person can obtain a copyright except authors who are citizens or residents of the United States, and proprietors under derivations of title from such authors. *Keene v. Wheatley*, 9 Amer. Law Reg., 45.—CADWALLADER, J.; Pa., 1860.

4. The assignee of a work composed by a *non-resident alien* cannot obtain a copyright for it. *Ibid.*, 45.

5. To constitute one an author, he must, by his own intellectual labor applied to the materials of his composition, produce an arrangement or compilation new in itself. *Atwill v. Ferrett*, 2 Blatchf., 46.—BETTS, J.; N. Y., 1846.

6. One who gets others to compile a work or engrave a print is not entitled to a copyright. *Pierpont v. Fowle*, 2 Wood. & Min., 46.—WOODBURY, J.; Mass., 1846. *Atwill v. Ferrett*, 2 Blatchf., 46.—BETTS, J.; N. Y., 1846. *De Witt v. Brooks*, MS.—NELSON, J.; N. Y., 1861.

7. A book, within the statute, need not be a volume made up of many sheets bound together; it may be a single sheet, as the words of a song, or the music accompanying it. *Clayton v. Stone*, 2 Paine, 383, 391.—THOMPSON, J.; N. Y., 1828.

8. A newspaper or price current cannot be considered a book within the sense and meaning of the act of Congress. *Ibid.*, 385.

9. A label used in the sale of any article is not a book, within the provisions of the statute respecting copyrights. *Coffeen v. Brunton*, 4 McLean, 517.—MCLEAN, J.; Ind., 1849.

10. The natural objects from which maps and charts are made are open to all, and therefore a copyright cannot subsist in a chart, as a general subject, but may in an individual work, and others may be restrained from copying it. *Blunt v. Patten*, 2 Paine, 400, 401.—THOMPSON, J.; N. Y., 1828.

11. A man has a right to a copyright of a map of a State or country which he has surveyed, or caused to be compiled from existing materials, at his own expense, or skill, or labor, or money. *Emerson v. Davies*, 3 Story, 781.—STORY, J.; Mass., 1845.

12. Another may publish another map of the same State or country, but cannot take it substantially and designedly from the map of the other person, without any such exercise of skill, labor, or expense. *Ibid.*, 781.

13. The author or compiler of a musical composition, made up of different parts copied from older compositions, without material change, and put together into one tune with only slight alterations or additions, is not entitled to a copyright for such therefor. *Reed v. Carusi*, 8 Law Rep., 411.—TANEY, Ch. J.; Md., 1845.

14. But the circumstances of its corresponding with older musical compositions, and belonging to the same style of music, does not constitute it a plagiarism, provided it is, in its main design and in its material and important parts, the effort of his own mind. *Ibid.*, 411.

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15. A musical composition, to be the subject of a copyright, 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 experience and skill could readily make. *Jollie v. Jaques*, 1 Blatchf., 626.—NELSON, J.; N. Y., 1850.

16. The phrase *design*, when used as a term of art, means the giving of a visible form to the conceptions of the mind; or, in other words, to the invention. *Binns v. Woodruff*, 4 Wash., 52.—WASHINGTON, J.; Pa., 1821.

17. A reporter cannot have any copyright in the written opinions of the judges of a court; nor can the judges confer any such right on the reporter. *Wheaton v. Peters*, 8 Pet., 668.—MCLEAN, J.; Sup. Ct., 1834. *Little v. Gould*, 2 Blatchf., 170.—CONKLING, J.; N. Y., 1851.

18. Such decisions are the property of the public, and are not the subject of copyright. *Little v. Gould*, 2 Blatchf., 362.—NELSON, J.; N. Y., 1852.

19. But a reporter may have a copyright in his own marginal notes, and in the arguments of counsel, as arranged and prepared by him. *Gray v. Russell*, 1 Story, 21.—STORY, J.; Mass., 1839.

20. A work may be the subject of a copyright, if the plan, arrangement, and combination of its materials are new, though the materials may be drawn from many sources, but are for the first time brought together in such plan, arrangement, and combination. *Gray v. Russell*, 1 Story, 17.—STORY, J.; Mass., 1839. *Emerson v. Davies*, 3 Story, 778. STORY, J.; Mass., 1845.

21. But there can be no copyright of a plan distinct from the work itself, any more than there can be of an idea. The words in which an idea is expressed, are a subject of property; and so is the classification of the subject discussed. *Story's Exrs. v. Holcombe*, 4 McLean, 316.—MCLEAN, J.; Ohio, 1847.

See also DIGEST PAT. CASES, titles AUTHOR; COPYRIGHT, B., C.; ABRIDGMENT; CHARTS; COMPILATIONS; DICTIONARIES; REVIEWS; TRANSLATION.

(b) COPYRIGHT, WHAT IS.

1. The privilege of an author to an exclusive sale of his works, for a limited number of years, although a monopoly, is not so in the odious meaning of the term; but is but a proper reward for his labor, and to which he is as much entitled as to the exclusive enjoyment of any other kind of property. *Blunt v. Patten*, 2 Paine, 395.—THOMPSON, J.; N. Y., 1828.

2. Copyright is an exclusive right to the multiplication of copies, for the benefit of the author or his assigns, disconnected from the plate, or any other physical existence. *Stephens v. Cady*, 14 How., 330.—NELSON, J.; Sup. Ct., 1852.

3. Before publication, an author has the exclusive possession of the ideas contained in his book, and the combination of words to represent

ACT OF 1831, CHAP. 16, §§ 1, 2.

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them. But when he has published his book, and given his thoughts, sentiments, knowledge, or information to the world, he can have no longer an exclusive possession in them. *Stowe v. Thomas*, 5 Amer. Law Reg., 228.—GRIER, J.; Pa., 1853.

4. When an author has sold his work, the only property which he reserves to himself, or which the law gives to him, is the exclusive right to multiply the copies of that particular combination of character which exhibits to the eyes of another the ideas intended to be conveyed. This is what the law terms copy, or copyright. *Ibid.*, 228.

5. An author's exclusive property in a literary composition, or copyright, consists only in a right to multiply copies of his book, and enjoy the profits therefrom, and not in an exclusive right to his conceptions. *Ibid.*, 228.

6. The case of *Millar v. Taylor*, 4 Burr, 311, has finally settled the question as to the nature of the property which an author has in his works; and it is, that, after publication, his property consists in the "right of copy," which signifies "the sole right of printing, publishing, and selling his literary composition or book;" not that he has such a property in his original conceptions, that he alone can use them in the composition of a new work, or clothe them in a different dress by translation. *Ibid.*, 230.

See also DIGEST PAT. CASES, title COPYRIGHT, A.

(c) FOUNDATION OF COPYRIGHT.

1. Congress, in passing the copyright act, did not legislate in reference to existing rights. Instead of sanctioning an existing right, it created it. *Whcat v. Peters*, 8 Pet., 661.—MCLEAN, J.; Sup. Ct., 1834.

2. In the United States an author can have no exclusive property or copyright in his published production except under the laws of Congress. *Ibid.*, 662.

3. The author of a literary composition has, at common law, no exclusive right to print and publish it. *Dudley v. Mayhew*, 3 Coms., 12.—STRONG, J.; N. Y., 1849.

4. Copyright, though formerly considered to be founded on common law, can now only be viewed as part of the statute law. *Clayton v. Stone*, 2 Paine, 383.—THOMPSON, J.; N. Y., 1828.

5. The object of the acts of Congress, securing to authors the exclusive right to their writings, was the promotion of science. *Ibid.*, 392.

See also DIGEST PAT. CASES, title COPYRIGHT, A.

SECTION 2. *And be it further enacted*, That if, at the expiration of the aforesaid term of years, such author, inventor, designer, engraver, or any of them, where the work had been originally composed and made by more

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than one person, be still living, and a citizen or citizens of the United States, or resident therein, or, being dead, shall have left a widow, or child, or children, either or all then living, the same exclusive right shall be continued to such author, designer, or engraver, or, if dead, then to such widow and child, or children, for the further term of fourteen years: *Provided*, That the title of the work so secured shall be a second time recorded, and all such other regulations as are herein required, in regard to original copyrights, be complied with in respect to such renewed copyright, and that within six months before the expiration of the first term.

1. The extension under this act looks entirely to the author and his family, and not to assignees. *Pierpont v. Fowle*, 2 Wood. & Min., 42.—WOODBURY, J.; Mass., 1846.

2. An assignment of a "copyright" should not, by construction, be extended beyond the first term, unless it seems to be actually meant by the author to be transferred forever, and including any future contingency. *Ibid.*, 44.

3. But where it is clear that the author intended to transfer all his interest in the copyright, as well in the extended as in the original term, and the assignment is not, in its terms, broad enough to cover the second term, a court of equity will direct the contract to be reformed, so as to embrace all the interest. *Cowen v. Banks*, MS.—NELSON, J.; N. Y., 1862.

4. An assignee alone cannot take out the second or extended term, unless he has paid for it, clearly contracted for it, and, in equity, rather than by any technical law, is to be protected in it. *Pierpont v. Fowle*, 2 Wood. & Min., 44.—WOODBURY, J.; Mass., 1846.

5. The taking out a second term of a copyright is not like the strengthening of a defective title, but rather like a new interest obtained after the general interest had expired. *Ibid.*, 46.

See also DIGEST PAT. CASES; title COPYRIGHT, E.

SECTION 3. *And be it further enacted*, That in all cases of renewal of copyright under this act, such author or proprietor shall, within two months from the date of said renewal, cause a copy of the record thereof to be pub-

lished in one or more of the newspapers printed in the United States, for the space of four weeks.

SECTION 4. *And be it further enacted,* That no person shall be entitled to the benefit of this act, unless he shall, before publication, deposit a printed copy of the title of such book, or books, map, chart, musical composition, print, cut, or engraving, in the clerk's office of the District Court of the district wherein the author or proprietor shall reside, and the clerk of such court is hereby directed and required to record the same thereof forthwith, in a book to be kept for that purpose, in the words following (giving a copy of the title, under the seal of the court, to the said author or proprietor, whenever he shall require the same): "District of _____ to wit: Be it remembered, that on the _____ day of _____ Anno Domini, _____ A. B., of the said district, hath deposited in this office the title of a book (map, chart, or otherwise, as the case may be), the title of which is in the words following, to wit: (here insert the title); the right whereof he claims as author, (or proprietor, as the case may be,) in conformity with an act of Congress, entitled 'An act to amend the several acts respecting copyrights.' C. D., Clerk of the district." For which record the clerk shall be entitled to receive, from the person claiming such right, as aforesaid, fifty cents, and the like sum for every copy under seal, actually given to such person or his assigns. And the author or proprietor of any such book, map, chart, musical composition, print, cut, or engraving, shall, within three months from the publication of said book, map, chart, musical composition, print, cut, or engraving, deliver, or cause to be delivered, a copy of the same to the clerk of said district. And it shall be the

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duty of the clerk of each District Court, at least once in every year, to transmit a certified list of all such records of copyright, including the titles so recorded, and the dates of record, and also all the several copies of books or other works deposited in his office according to this act, to the Secretary of State, to be preserved in his office. (a)

SECTION 5. *And be it further enacted*, That no person shall be entitled to the benefit of this act, unless he shall give information of copyright being secured, by causing to be inserted in the several copies of each and every edition published during the term secured on the title-page, or the page immediately following, if it be a book, or, if a map, chart, musical composition, print, cut, or engraving, by causing to be impressed on the face thereof, or if a volume of maps, charts, music, or engravings, upon the title or frontispiece thereof, the following words, viz.: "Entered according to act of Congress, in the year _____, by A. B., in the clerk's office of the District Court of _____," (as the case may be.) (a)

(a) NOTES TO §§ 4 AND 5.

1. The act of 1831 embodies the provisions of the acts of 1790 and 1802, and imposes on the persons claiming the privilege of copyright the same duties and liabilities which attended the right under the prior statutes. *Baker v. Taylor*, 2 Blatchf., 83.—BETTS, J.; N. Y., 1848.

2. Under sections 4 and 5 of this act, the depositing the title-page in the proper clerk's office, publishing a notice according to the act, and delivering a copy of the book, are conditions, the performance of which is essential to the title. *Ibid.*, 84.

3. And the notice must be published in the manner specified in the act. *Ibid.*, 84.

4. All the things required by these sections must be done to secure a copyright. *Jollie v. Jaques*, 1 Blatchf., 620.—NELSON, J.; N. Y., 1850. *Struve v. Schwedler*, 4 Blatchf.—NELSON, J.; N. Y., 1857.

5. Until all the things required by these sections are done, the copyright is not secured; but by taking the incipient step, a right is ac-

quired which chancery will protect, until the other acts may be done. *Pulte v. Derby*, 5 McLean, 332—MCLEAN, J.; Ohio, 1852.

6. Where a work consists of a number of volumes, the insertion of the record on the page next following the title-page of the *first volume* of the work is a sufficient compliance with the statute. *Dwight v. Appletons*, 1 N. Y. Leg. Obs., 198.—THOMPSON, J.; N. Y., 1843.

7. The author may insert the same record in another edition, published in a different number of volumes, without impairing the copyright. *Ibid.*, 199.

8. The number of volumes in which it was stated the work would be published, make no part of its title, and may be rejected as surplusage. *Ibid.*, 199.

9. After such title-page has been deposited, the author can maintain an action for an infringement or violation of his right, even though the work may not have been published, or the printed copy deposited. *Roberts v. Meyers*, 13 Mo. Law Rep., 398.—SPRAGUE, J.; Mass., 1860. CONTRA, *Keene v. Wheatley*, 1 Amer. Law Reg., 44.—CADWALLADER, J.; Pa., 1860.

10. The record from the clerk's office, made in the form prescribed by section 4, or of the depositing of a title-page, is *prima facie* evidence that a printed title was deposited. *Roberts v. Meyers*, 13 Mo. Law Rep., 398.—SPRAGUE, J.; Mass., 1860.

11. Where the title-page of a book was deposited in 1846, and the notice of the entry, inserted in the book, stated it to have been deposited in 1847, *Held*, that the error created a fatal defect in the plaintiff's title. *Baker v. Taylor*, 2 Blatchf., 84.—BERTS, J.; N. Y., 1848.

12. Even if the error arose from mistake, it will make no difference as to the result. *Ibid.*, 84.

13. Under section 4 a person is not entitled to any benefit, under the act, unless he deposits the title-page *before* the publication of his work. *Ibid.*, 85.

14. Where copies of a book were sold prior to the date of the deposit of a copy of the title-page, and a printed copy of the book was deposited in the clerk's office, at the same time the title-page was deposited, *Held*, that these facts warranted an inference of an actual publication of the book prior to the date of such deposit. *Ibid.*, 85.

See also DIGEST PAT. CASES, title COPYRIGHT, D.; and notes to section 3 of the act of 1790, and to section 1 of the act of 1802.

SECTION 6. *And be it further enacted*, That if any other person or persons, from and after the recording the title of any book or books, according to this act, shall, within the term or terms herein limited, print (a), publish, or import, or cause to be printed, published, or

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imported, any copy of such book or books (*b*), without the consent of the person legally entitled to the copyright thereof, first had and obtained in writing, signed in presence of two or more credible witnesses, or shall, knowing the same to be so printed or imported, publish, sell, or expose to sale, or cause to be published, sold, or exposed to sale, any copy of such book without such consent in writing; then such offender shall forfeit every copy of such book to the person legally, at the time, entitled to the copyright thereof; and shall also forfeit and pay fifty cents for every such sheet which may be found in his possession, either printed, or printing, published, imported, or exposed to sale, contrary to the intent of this act, the one moiety thereof to such legal owner of the copyright as aforesaid, and the other to the use of the United States, to be recovered by action of debt in any court having competent jurisdiction thereof. (*c*)

(*a*) 1. The intent with which a work is reprinted cannot be taken into consideration; it is the act of reprinting that is prohibited by the statute. *Nichols v. Ruggles*, 3 Day, 158.—CURIAM; Ct., 1808. *Story's Ex'rs v. Holcombe*, 4 McLean, 309, 310.—MCLEAN, J.; Ohio, 1847.

2. It is of no consequence in what form the works of another are used, whether it be a simple reprint or by incorporating it in some other work. If his copyright is violated, he can maintain an action therefor. *Gray v. Russell*, 1 Story, 19.—STORY, J.; Mass., 1839.

3. To entitle a party to an action for the infringement of a copyright, it is not necessary that the whole or a greater part of his work should be taken. If so much is taken as to impair the value of the original, or so that the labors of the original author are substantially appropriated, that is sufficient in point of law to constitute a piracy. *Folsom v. Marsh*, 2 Story, 115.—STORY, J.; Mass., 1841.

4. The entirety of the copyright is the property of the author; and it is no defence that another has appropriated only a part of such property and not the whole. *Ibid.*, 116.

5. Nor does it necessarily depend upon the quantity taken, whether it is an infringement of a copyright or not. *Ibid.*, 116. *Story's Ex'rs v. Holcombe*, 4 McLean, 309, 310.—MCLEAN, J.; Ohio, 1847.

6. Intention cannot be taken into account in reference to an infringement. If a copyright has been invaded, whether the party knew the work was copyrighted or not, he is liable to the penalty for violation. *Millett v. Snowden*, 1 West. L. Jour., 240.—BETTS, J.; N. Y., 1843.

(b) 1. A book may in one part of it infringe the copyright of another work; and in other parts be no infringement; in such a case, the remedy will not be extended beyond the injury. *Story's Exrs. v. Holcombe*, 4 McLean, 315.—MCLEAN, J., Ohio, 1847.

2. A book, within the meaning of the statute, does not include a translation of a work. *Stowe v. Thomas*, 2 Amer. Law Reg., 230.—GRIER, J.; Pa., 1853.

3. A translation may be called a transcript or copy of the author's thought or conception, but in no correct sense can it be called a copy of his book. *Ibid.*, 231.

See also DIGEST PAT. CASES, title INFRINGEMENT, A.

(c) 1. An *action on the case* is the proper form of action to recover damages for a violation of a copyright; *trespass* will not lie. *Atwill v. Ferrett*, 2 Blatchf., 48.—BETTS, J.; N. Y., 1846.

2. The penalty of fifty cents per sheet imposed by this section is incurred for every sheet found to have been in the defendants' possession, or which they had sold, or held for sale. *Dwight v. Appletons*, 1 N. Y. Leg. Obs., 198.—THOMPSON, J.; N. Y., 1843.

3. The penalty declared by this section can be adjudged only for the sheets found in the possession of the defendant. *Backus v. Gould*, 7 How., 811.—MCLEAN, J.; Sup. Ct., 1848.

4. The penalty imposed by this section is not incurred by printing and publishing so much of a book as to amount to an infringement of the copyright. *Rogers v. Jewett*, 12 Mo. Law Rep., 340.—CURTIS, J.; Mass., 1858.

5. The words "a copy of a book," found in section 6 of the act of 1831, import a transcript or copy of the entire book. *Ibid.*, 341.

6. Congress did not intend to inflict these penalties upon the unlawful printing or publication of less than an entire work. *Ibid.*, 341.

SECTION 7. *And be it further enacted*, That if any person or persons, after the recording of the title of any print, cut, or engraving, map, chart (a), or musical composition, according to the provisions of this act, shall, within the term or terms limited by this act, engrave, etch, or work, sell, or copy, or caused to be engraved, etched, worked, or sold, or copied, either on the whole, or by varying, adding to, or diminishing the main design, with intent to evade the law; or shall print or import

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ACT OF 1831, CHAP. 16, § 7.

for sale, or cause to be printed or imported for sale, any such map, chart, musical composition, print, cut, or engraving, or any parts thereof, without the consent of the proprietor or proprietors of the copyright thereof, first obtained in writing, signed in the presence of two credible witnesses; or knowing the same to be printed or imported without such consent, shall publish, sell, or expose to sale, or in any manner dispose of any such map, chart, musical composition, engraving, cut, or print without such consent, as aforesaid; then such offender or offenders shall forfeit the plate or plates on which such map, chart, musical composition, engraving, cut, or print, shall be copied, and also all and every sheet thereof so copied or printed as aforesaid, to the proprietor or proprietors of the copyright thereof; and shall further forfeit one dollar for every sheet of such map, chart, musical composition, print, cut, or engraving, which may be found in his or their possession, printed or published, or exposed to sale, contrary to the true intent and meaning of this act; the one moiety thereof to the proprietor or proprietors, and the other moiety to the use of the United States, to be recovered in any court having competent jurisdiction thereof. (b)

(a) 1. Though a party cannot have a copyright in the original elements or materials of his chart, he has a right to the result of his labors and surveys in making it. Another party may resort to the original materials of the chart, and survey for himself, but he cannot avail himself, either in whole or in part, of the surveys of the former. *Blunt v. Patten*, 2 Paine, 395, 396.—THOMPSON, J.; N. Y., 1828.

2. The natural objects from which charts are made, being, however, open to all, a copyright cannot subsist in a chart, as a general subject, but it may in an individual work, and others may be restrained from copying such work. *Ibid.*, 400, 401.

3. But a right in such a subject is violated only when another copies from the chart of him who has secured the copyright, and thereby availed himself of his labor and skill. *Ibid.*, 402.

ACT OF 1831, CHAP. 16, §§ 7-9.

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4. In all such cases, it is a proper question for a jury, whether the one is a copy of the other or not; if there was some small variance, it would be a proper subject of inquiry whether the alteration was not merely colorable. *Ibid.*, 402.

5. But a subsequent compiler has a right to avail himself of all prior publications which are not copyrighted, and if his chart is compiled from such publications, it is no infringement, although it may agree with another's chart. *Ibid.*, 403.

6. One person may publish a map of the same State or country for which another has a copyright, by using the like means or materials, and the like skill, labor, and expense, in its preparation. -But he has no right to publish a map, taken substantially and designedly from the map of such other person, without any such exercise of skill, labor, or expense. *Emerson v. Davies*, 3 Story, 781.—STORY, J.; Mass., 1845.

See also DIGEST PAT. CASES, title CHARTS.

(b) 1. The penalty for an infringement is, under this section, fixed by law. If the jury find there has been an infringement, they must ascertain the number of sheets proved to have been sold, or offered for sale (not the number printed), and return a verdict for one dollar for each sheet so sold, or offered to be sold. *Millett v. Snowden*, 1 West. Law Jour., 240.—BETTS, J.; N. Y., 1843.

2. A defendant is not liable to the penalty imposed by this section, unless he was guilty of the infraction of the copyright within two years before action was brought. *Keed v. Carusi*, 8 Law Rep., 412.—TANEY, Ch. J.; Md., 1845.

3. The engraving or preparation of plates, where the work is printed from plates, may have been more than two years, but every printing for sale would be a new infraction of the right, and, if such printing was within two years before suit brought, the defendant is liable. *Ibid.*, 412.

4. The penalty is at the rate of one dollar for each sheet the defendant may have caused to be printed for sale, within two years before suit brought. *Ibid.*, 412.

See also DIGEST PAT. CASES, title PENALTIES, A.

SECTION 8. *And be it further enacted*, That nothing in this act shall be construed to extend to prohibit the importation, or vending, printing, or publishing of any map, chart, book, musical composition, print, or engraving, written, composed, or made by any person not being a citizen of the United States, nor resident within the jurisdiction thereof.

SECTION 9. *And be it further enacted*, That any per-

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ACT OF 1831, CHAP. 16, § 9.

son or persons who shall print or publish any manuscript whatever without the consent of the author or legal proprietor first obtained as aforesaid, (if such author or proprietor be a citizen of the United States, or resident therein), shall be liable to suffer and pay to the author or proprietor all damages occasioned by such injury, to be recovered by a special action on the case founded upon this act, in any court having cognizance thereof; and the several courts of the United States empowered to grant injunctions to prevent the violation of the rights of authors and inventors, are hereby empowered to grant injunctions, in like manner, according to the principles of equity, to restrain such publication of any manuscript as aforesaid.

1. 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., 657.—MCLEAN, J.; Sup. Ct., 1834.

2. Notwithstanding the copyright by statute, there remains in an author a common law title to his works before publication. *Jones v. Thorne*, 1 N. Y. Leg. Obs., 409.—McCOUN, V. Ch.; N. Y., 1843.

3. At common law, independently of the statute, the author of a manuscript might obtain redress against one who had surreptitiously gained possession of it. *Bartlette v. Crittenden*, 4 McLean, 301.—MCLEAN, J.; Ohio, 1847.

4. On general equitable principles, relief may also be given, under like circumstances, by a court of chancery. *Ibid.*, 301.

5. The use, by an author, of his manuscript for the purpose of instruction, is not an abandonment of it to the public. Nor is it an abandonment, to allow his pupils to take copies. *Ibid.*, 303.

6. Those also who have been permitted to take copies, have no right to a use which was not in contemplation when the consent to take copies was given. *Ibid.*, 303.

7. An author has a common law right in his manuscript until he relinquishes it by contract or some equivocal act. *Bartlette v. Crittenden*, 5 McLean, 36, 38.—MCLEAN, J.; Ohio, 1849.

8. Such right is also protected by section 9 of the copyright act of 1831. *Ibid.*, 38.

9. A surreptitious publication of an important part of a manuscript

is equally within the statute as if the manuscript was complete; and the whole of a manuscript need not be printed. *Ibid.*, 39, 40.

10. This section protects manuscripts only. *Stephens v. Gladding*, 17 How., 455.—CURTIS, J.; Sup. Ct., 1854.

11. At common law an author has a right to his unpublished manuscripts the same as to any other property he may possess; and this act of the 3d of February, 1831, gives him a remedy by injunction to protect this right. *Little v. Hall*, 18 How., 170.—MCLEAN, J.; Sup. Ct., 1855.

12. The common law right of an author in his manuscript has not been taken away or abridged by the statutes which have been passed for the protection of copyright. Its existence is prior to these statutes, and independent of their provisions. *Woolsey v. Judd*, 4 Duor, 385.—DUER, J.; N. Y., 1855.

13. The act of 1831, section 9, giving redress for the unauthorized *printing or publishing of manuscripts*, operates in favor of a resident of the United States who has acquired the proprietorship of an *unprinted* literary composition from a non-resident alien author. *Keene v. Wheatley*, 9 Amer. Law Reg., 45.—CADWALLADER, J.; Pa., 1860.

14. But this section—and which is the only one—enabling a proprietor, who derives his title from such an author, to assert any right under the act—gives no redress for an unauthorized theatrical representation. *Ibid.*, 45.

See also DIGEST PAT. CASES, titles LETTERS; MANUSCRIPTS.

SECTION 10. *And be it further enacted*, That, if any person or persons shall be sued or prosecuted, for any matter, act, or thing done under or by virtue of this act, he or they may plead the general issue, and give the special matter in evidence.

SECTION 11. *And be it further enacted*, That, if any person or persons, from and after the passing of this act, shall print or publish any book, map, chart, musical composition, print, cut, or engraving, not having legally acquired the copyright thereof, and shall insert or impress that the same hath been entered according to act of Congress, or words purporting the same, every person so offending shall forfeit and pay one hundred dollars: one moiety thereof to the person who shall sue for the same, and the other to the use of the United States, to be re-

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ACT OF 1831, CHAP. 16, §§ 11-15.

covered by action of debt, in any court of record having cognizance thereof.

1. The penalty imposed by this section, and given "to the *person* who shall sue for the same," cannot be recovered in the name of more than one person. *Ferrett v. Atwill*, 1 Blatchf., 154, 155.—BETTS, J.; N. Y., 1846.

2. A declaration for such penalty in the name of *two* persons is bad, on general demurrer. *Ibid.*, 154.

3. There is a manifest difference between giving a penalty to a common informer, and imposing one for the benefit of the person aggrieved: in the latter case, the term person may be regarded as comprehending every one affected by the injury. *Ibid.*, 156.

See also DIGEST PAT. CASES, title PENALTIES, A.

SECTION 12. *And be it further enacted*, That, in all recoveries under this act, either for damages, forfeitures, or penalties, full costs shall be allowed thereon, any thing in any former act to the contrary notwithstanding.

SECTION 13. *And be it further enacted*, That no action or prosecution shall be maintained, in any case of forfeiture or penalty under this act, unless the same shall have been commenced within two years after the cause of action shall have arisen.

SECTION 14. *And be it further enacted*, That the "act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies during the times therein mentioned," passed May thirty-first, one thousand seven hundred and ninety, and the act supplementary thereto, passed April twenty-ninth, one thousand eight hundred and two, shall be, and the same are hereby, repealed: saving, always, such rights as may have been obtained in conformity to their provisions.

SECTION 15. *And be it further enacted*, That all and several the provisions of this act, intended for the protec-

tion and security of copyrights, and providing remedies, penalties, and forfeitures, in cases of violation thereof, shall be held and construed to extend to the benefit of the legal proprietor or proprietors of each and every copyright heretofore obtained, according to law, during the term thereof, in the same manner as if such copyright had been entered and secured according to the directions of this act.

SECTION 16. *And be it further enacted,* That whenever a copyright has been heretofore obtained by an author or authors, inventor, designer, or engraver, of any book, map, chart, print, cut, or engraving, or by a proprietor of the same: if such author or authors, or either of them, such inventor, designer, or engraver, be living at the passage of this act, then such author or authors, or the survivor of them, such inventor, engraver, or designer, shall continue to have the same exclusive right to his book, chart, map, print, cut, or engraving, with the benefit of each and all the provisions of this act, for the security thereof, for such additional period of time as will, together with the time which shall have elapsed from the first entry of such copyright, make up the term of twenty-eight years, with the same right to his widow, child, or children, to renew the copyright, at the expiration thereof, as is above provided in relation to copyrights originally secured under this act. And if such author or authors, inventor, designer, or engraver, shall not be living at the passage of this act, then his or their heirs, executors and administrators, shall be entitled to the like exclusive enjoyment of said copyright, with the benefit of each and all the provisions of this act for the security thereof, for the period of twenty-eight years

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ACT OF 1834, CHAP. 157, § 1.

from the first entry of said copyright, with the like privilege of renewal to the widow, child, or children, of author or authors, designer, inventor, or engraver, as is provided in relation to copyrights originally secured under this act: *Provided*, That this act shall not extend to any copyright heretofore secured, the term of which has already expired.

Approved February 3d, 1831.

ACT OF 1834, CHAPTER 157.

4 STATUTES AT LARGE, 728.

[*This Act still in Force.*]

An Act supplementary to the act to amend the several acts respecting copyrights.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That all deeds or instruments in writing for the transfer or assignment of copyrights, being proved or acknowledged in such manner as deeds for the conveyance of land are required by law to be proved or acknowledged in the same State or district, shall and may be recorded in the office where the original copyright is deposited and recorded; and every such deed or instrument that shall in any time hereafter be made and executed, and which shall not be proved or acknowledged and recorded as aforesaid, within sixty days after its execution, shall be judged fraudulent and void against any subsequent purchaser or mortgagee for valuable consideration without notice.

ACT OF 1834, CHAP. 157, §§ 1, 2.

IN FORCE.

1. An assignment of an interest in a copyright must be in writing, to be valid and operative; but an *agreement* to assign may be by parol. *Gould v. Banks*, 8 Wend., 565.—NELSON, J.; N. Y., 1832.

2. An assignment of a "copyright" in general terms is to be referred to what was then in existence, and not to any future contingency. It should not be by construction extended beyond the first term, unless it seems to be so actually meant by the author, and to include a future contingency. *Pierpont v. Rowle*, 2 Wood. & Min., 43-45.—WOODBURY, J.; Mass., 1846.

3. Otherwise, if the contract of sale or assignment uses language looking beyond the existing copyright, such as referring to all the *interest* in the matter, or to the *manuscript* or book itself, or using some other expression more comprehensive than the word "copyright." *Ibid.*, 45.

4. This statute prescribes only the instrument by which they may be assigned, and the mode of recording, but does not define what interest may be assigned. *Roberts v. Myers*, 13 Mo. Law Rep., 401.—SPRAGUE, J.; Mass., 1860.

5. There is no sufficient reason for preventing an author conveying a distinct portion of his right. *Ibid.*, 401.

6. Where an assignment was of the exclusive right of acting and representing a certain drama, within the United States except as to certain cities, for the term of one year, *Held*, that it was valid under the statute. *Ibid.*, 400, 401.

7. CONTRA.—The statutes of the United States for the protection of authors do not, like those for the benefit of inventors, sanction transfers of limited local proprietorships of exclusive privileges. *Keene v. Wheatley*, 9 Amer. Law Reg., 46.—CADWALLADER, J.; Pa., 1860.

8. A writing which is in form a transfer by an author of his exclusive right for a designated portion of the United States operates *at law* only as a mere *license*, and is ineffectual as an assignment. *Ibid.*, 46.

9. But in *equity*, a limited local or other partial assignment, if made for a valuable consideration, is carried into effect, whether it would be effectual in law or not. *Ibid.*, 47.

10. An assignment of a copyright, although not recorded, is still valid as between the parties, and as to all persons not claiming under the assignors. *Webb v. Powers*, 2 Wood. & Min., 510.—WOODBURY, J.; Mass., 1847.

11. A formal transfer of a copyright by this act is required to be proved and recorded as deeds for the conveyance of land, and such record operates as notice. *Little v. Hall*, 18 How., 171.—MCLEAN, J.; Sup. Ct., 1855.

SECTION 2. *And be it further enacted*, That the clerk of the district court shall be entitled to such fees, for per-

OBSOLETE.

ACT OF 1846, CHAP. 178, § 10.

forming the services herein authorized and required, as he is entitled to for performing like services under existing laws of the United States.

Approved June 30th, 1834.

ACT OF 1846, CHAPTER 178.

9 STATUTES AT LARGE, 106.

[*Obsolete: Repealed by Act of 1859, § 6.*]

Extract from an Act to establish the "Smithsonian Institution, for the Increase and Diffusion of Knowledge among Men."

SECTION 10. *And be it further enacted,* That the author or proprietor of any book, map, chart, musical composition, print, cut, or engraving, for which a copyright shall be secured under the existing acts of Congress, or those which shall hereafter be enacted respecting copyrights, shall, within three months from the publication of said book, map, chart, musical composition, print, cut, or engraving, deliver, or cause to be delivered, one copy of the same to the librarian of the Smithsonian Institution, and one copy to the librarian of Congress Library, for the use of the said libraries.

Approved August 10, 1846.

1. This act did not make the delivery of copies of a work to the librarian of the Smithsonian Institution, and to the librarian of the Congress Library, a pre-requisite to a title to a copyright for the work. *Jollie v. Jaynes*, 1 Blatchf., 620-622.—NELSON, J.; N. Y., 1850.

2. The duty was enjoined only upon those who have already acquired the right, and no forfeiture was declared in case of a non-compliance. *Ibid.*, 621

ACT OF 1856, CHAPTER 169.

11 STATUTES AT LARGE, 138.

[This Act still in Force.]

In Act supplemental to an act entitled "An act to amend the several acts respecting copyright," approved February third, eighteen hundred and thirty-one.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled: Any copyright hereafter granted under the laws of the United States to the author or proprietor of any dramatic composition, designed or suited for public representation, shall be deemed and taken to confer upon the said author or proprietor, his heirs or assigns, along with the sole right to print and publish the said composition, the sole right also to act, perform or represent the same, or cause it to be acted, performed or represented, on any stage or public place, during the whole period for which the copyright is obtained; and any manager, actor, or other person acting, performing or representing the said composition, without or against the consent of the said author or proprietor, his heirs or assigns, shall be liable for damages, to be sued for and recovered by action on the case or other equivalent remedy, with costs of suit in any court of the United States, such damages in all cases to be rated and assessed at such sum not less than one hundred dollars for the first, and fifty dollars for every subsequent performance, as to the court having cognizance thereof shall appear to be just:

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ACT OF 1856, CHAP. 169.

Provided nevertheless, That nothing herein enacted shall impair any right to act, perform or represent a dramatic composition as aforesaid, which right may have been acquired, or shall in future be acquired by any manager, actor or other person previous to the securing of the copyright for the said composition, or to restrict in any way the right of such author to process in equity in any court of the United States for the better and further enforcement of his rights.

Approved August 18th, 1856.

1. The act of 1856 was passed to give to the authors of dramatic compositions the exclusive right of acting and representing, which they did not enjoy under the previous statutes. *Roberts v. Meyers*, 13 Mo. Law Rep., 397.—SPRAGUE, J.; Mass., 1860.

2. It assumes the doctrine that representation is not publication. The prior acts secured to authors the exclusive right of printing and publication; and it was only because publication did not embrace acting or representation that this act was passed, superadding that exclusive right to those previously enjoyed. *Ibid.*, 397.

3. The previous acting or representing a play will not deprive the author of the right to afterward take out a copyright. *Ibid.*, 397.

4. An assignee of the exclusive right of acting and representing a drama in certain places, may maintain an action in his own name, even after a representation by him, for an injunction to prevent its being represented by another within such places. *Ibid.*, 400, 401.

5. And such action may be maintained although the author or assignee has only filed his title-page, and has not published the work or play. *Ibid.*, 401. (CONTRA, *post*, 8.)

6. A legislative enactment securing generally to literary proprietors a copyright for a limited period, but containing no special provision as to theatrical representation, does not, in the case of a dramatic literary composition, include the sole right of representing it. *Keene v. Wheatley*, 9 Amer. Law Reg., 44.—CADWALLADER, J.; Pa., 1860.

7. The only act which affords redress for unauthorized theatrical representations is the act of 18th August, 1856; but this only applies to cases in which copyright is effectually secured under the act of 1831. *Ibid.*, 45.

8. But under this act, an assignee of a dramatic composition cannot maintain an action for its unauthorized representation by others, unless he has performed *all* the acts required by law to secure a copyright, including the deposit of a *printed copy*. *Ibid.*, 45, 46.

ACT OF 1859, CHAPTER 22.

11 STATUTES AT LARGE, 380.

[This Act still in Force.]

Extract from an Act entitled, "An act for keeping and distributing all public documents."

SECTION 6. [Repealing act of 1846, § 10.] *And be it further enacted*, That the tenth section of an act entitled, "An act to establish the Smithsonian Institution for the increase and diffusion of knowledge among men," approved August 10th, 1846, is hereby repealed.

SECTION 8. *And be it further enacted*, That all books, maps, charts, and other publications of every nature whatever, heretofore deposited in the Department of State, according to the laws regulating copyrights, together with all the records of the Department of State, in regard to the same, shall be removed to, and be under the control of the Department of the Interior, which is hereby charged with all the duties connected with the same, and with all matters pertaining to copyright, in the same manner and to the same extent that the Department of State is now charged with the same; and hereafter all such publications of every nature whatever shall, under present laws and regulations, be left with and kept by him.

Approved February 5th, 1859.

IN FORCE.

ACT OF 1861, CHAP. 37.

ACT OF 1861, CHAPTER 37.

12 STATUTES AT LARGE, 130.

[This Act still in Force.]

An Act to extend the right of appeal from the decisions of circuit courts to the Supreme Court of the United States.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That from all judgments and decrees of any circuit court rendered in any action, suit, controversy, or case, at law or in equity, arising under any law of the United States granting or confirming authors the exclusive right to their respective writings, or to inventors the exclusive right to their inventions or discoveries, a writ of error or appeal, as the case may require, shall lie, at the instance of either party, to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of such circuit courts, without regard to the sum or value in controversy in the action.

Approved February 18th, 1861.

ACT OF 1865, CHAPTER 126.

13 STATUTES AT LARGE, 540.

[This Act still in Force.]

An Act supplemental to an act entitled "An act to amend the several acts respecting copyright," approved February 3d, 1831, and to the acts in addition thereto and amendment thereof.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That the provisions of said acts shall extend to and include photographs and negatives thereof which shall hereafter be made, and shall inure to the benefit of the authors of the same, in the same manner and to the same extent, and upon the same conditions, as to the authors of prints and engravings.

SECTION 2. *And be it further enacted,* That a printed copy of every book, pamphlet, map, chart, musical composition, print, engraving, or photograph, for which a copyright shall be secured under said acts, shall be transmitted free of postage or other expense, by the author or proprietor thereof, within one month of the date of publication, to the Library of Congress, at Washington, for the use of said library, and the Librarian of Congress is hereby required to give a receipt in writing for the same.

SECTION 3. *And be it further enacted,* That if any proprietor of a book, pamphlet, map, chart, musical composition, print, engraving, or photograph, for which a copyright shall be secured as aforesaid, shall neglect to deliver the same, pursuant to the requirements of this act, it shall be the duty of the Librarian of Congress to make demand thereof in writing at any time within twelve months after the publication thereof; and in default of a delivery thereof within one month after the demand shall have been made, the right of exclusive publication secured to such proprietor under the acts of Congress respecting copyright shall be forfeited.

SECTION 4. *And be it further enacted,* That in the construction of this act the word "book" shall be construed to mean every volume and part of a volume,

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ACT OF 1867, CHAP. 43.

together with all maps, prints, or other engravings belonging thereto; and shall include a copy of any second or subsequent edition which shall be published with any additions, whether the first edition of such book shall have been published before or after the passing of this act: *Provided, however,* That it shall not be requisite to deliver to the said library any copy of the second or any subsequent edition of any book, unless the same shall contain additions as aforesaid, nor of any book which is not the subject of copyright.

Approved March 3d, 1865.

ACT OF 1867, CHAPTER 43.

14 STATUTES AT LARGE, 395.

[*This Act still in Force.*]

An Act amendatory of the several acts respecting copyrights.

SECTION 1. [Amending Act of 1865, § 3.] *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That every proprietor of a book, pamphlet, map, chart, musical composition, print, engraving, or photograph, for which a copyright shall have been secured, who shall fail to deliver to the Library of Congress at Washington a printed copy of every such book, pamphlet, map, chart, musical composition, print, engraving, or photograph, within one month after publication thereof, shall, for every such default, be subject to a penalty of twenty-five dollars, to be collected, by the Librarian of Congress, in the name of the United States, in any District or Circuit Court of the United States, within the jurisdiction of which the delinquent may reside or be found.

ACT OF 1867, CHAP. 43.IN FORCE.

SECTION 2. *And be it further enacted,* That every such proprietor may transmit any book, pamphlet, map, chart, musical composition, print, engraving, or photograph, for which he may have secured a copyright, to the Librarian of Congress, by mail free of postage, provided the words "copyright matter" be plainly written or printed on the outside of the package containing the same; and it shall be the duty of the several postmasters and deputy postmasters to give a receipt for the same, if requested, and when such package shall be delivered to them, or any of them, to see that the same is safely forwarded to its destination by mail, without cost or charge to said proprietor.

Approved, February 18, 1867.

FORMS

UNDER THE COPYRIGHT ACTS.

1. AGREEMENT TO SELL MANUSCRIPT AND COPYRIGHT OF BOOK.
 2. AGREEMENT TO ENLARGE A SECOND EDITION OF A BOOK.
 3. ASSIGNMENT OF COPYRIGHT FOR ORIGINAL TERM.
 4. ASSIGNMENT OF COPYRIGHT FOR ORIGINAL AND RENEWED TERMS.
 5. LICENSE TO PRINT ONE EDITION OF A BOOK.
 6. ASSIGNMENT OF RIGHT TO PERFORM DRAMATIC COMPOSITION FOR SPECIFIED TIME AND PLACES.
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1. AGREEMENT TO SELL THE MANUSCRIPT AND COPYRIGHT OF A BOOK.

Agreement, made and entered into this first day of January, 1860, by and between James Smith, of Poughkeepsie, State of New York, of the one part, and Charles Scribner, of New York City, State aforesaid, of the other part:

Whereas, the said James Smith has composed or compiled a work called the "Flowers of Poesy,"

Now this agreement witnesseth that the said party of the first part, for and in consideration of the sum of five hundred dollars, to be paid as hereinafter mentioned, and other good and valuable considerations herein named, has agreed to sell, and does hereby sell, to the said party of the second part, his heirs, executors, administrators, and assigns, the manuscript copy of the said book, including a full and complete Index thereto. And the said party of the first part also agrees to examine and correct the proof-sheets of said work as they shall be furnished by said party of the second part.

The said party of the second part, for himself his heirs, executors, administrators, and assigns, agrees to pay to the said party of the first part, his executors, administrators, or assigns, the said sum of five hundred dollars in manner following: One hundred dollars on the execution of this contract; two hundred dollars when the Index shall be ready for the printer; and the

 AGREEMENT TO ENLARGE A SECOND EDITION OF A BOOK.

balance when the proof-sheets shall all have been examined and corrected and furnished to the printer. Said party of the second part also agrees to furnish the whole of said proof-sheets to said party of the first part within three months after the delivery of the manuscript; and further agrees to furnish and deliver to said party of the first part, free of cost, fifteen bound copies of said work within three months after he, said party of the first part, shall have completed his labors on said work.

The said party of the second part, his heirs and assigns, are to have the exclusive right to take out and own the copyright of such work, and any renewals of such copyright authorized by law.

It is further agreed, that in case said book shall not make three hundred pages of the size and style of the pages of a work known as "Pearls of Poetry," then and in such case said party of the first part is to receive, and the said party of the second part is to pay, a sum bearing such proportion to the sum of five hundred dollars as the number of pages furnished bears to three hundred; but in case the said work shall contain more than three hundred pages, the sum to be paid therefor shall not be increased.

In witness whereof, the said parties have hereunto set their hands and seals, the day and year first above written.

Sealed and delivered }
 in presence of }
 JOHN SMITH,
 JAMES BROWN.

JAMES SMITH. [L. S.]
 CHARLES SCRIBNER. [L. S.]



2. AGREEMENT TO ENLARGE A SECOND EDITION OF A BOOK, AND CORRECT PROOF OF THE SAME.

This agreement, made the eighth day of January, 1866, by and between James Smith, of Poughkeepsie, New York, of the first part, and Charles Scribner, of New York City, of the second part, witnesseth:

That the said James Smith, for and in consideration of three hundred dollars, and other consideration herein named, agrees to examine, correct, and enlarge the work known as "Flowers of Poesy," to furnish additional manuscript matter for the second edition of the work, and to enlarge the Index and make it full and complete.

ASSIGNMENT OF COPYRIGHT FOR ORIGINAL TERM.

It is understood and agreed that the new edition of the work shall be of the same sized page as the present work, and contain an equal amount of matter on each page, and that the additional matter furnished shall enlarge the work not less than one hundred pages, and shall be furnished to the said Charles Scribner at not less than twenty pages per day (one hundred and twenty pages per week), commencing on the twentieth instant.

And the said James Smith is to examine and to correct the proof-sheets as fast as they shall be furnished, and to complete the Index as soon as may be, after the whole signatures of the text shall be ready for him for that purpose.

And the said Charles Scribner, on his part, agrees to print the said work as the matter shall be furnished, to furnish the said James Smith a copy of the work, by signatures, as each signature shall be worked off, for the purpose of arranging the Index; to furnish the said James Smith fifty bound copies of the work, as soon as they can be conveniently finished, and to pay the said James Smith the sum of three hundred dollars on the day the last proof-sheet is corrected for the press.

The said Charles Scribner is to take out and secure a copyright of said work; and the said James Smith, on the completion of the work, is to execute and deliver to the said Charles Scribner, his heirs and assigns, forever, an assignment of all his right and title and interest in and to the said work.

In witness whereof, the said parties have hereunto set their hands and seals, the day and year above written.

JAMES SMITH. [L. S.]
CHARLES SCRIBNER. [L. S.]

In presence of
JOHN SMITH,
JAMES BROWN.

.....
5 CENT
INT. REV.
STAMP.
.....

3. ASSIGNMENT OF COPYRIGHT FOR ORIGINAL TERM.

Indenture, made this first day of January, 1860, between James Smith, of Poughkeepsie, State of New York, of the one part, and Charles Scribner, of the City of New York, State aforesaid, of the other part.

Whereas, the said James Smith has written and compiled a book, entitled "Flowers of Poesy," for which he took out copyright in the Southern District of New York, on the first day of August, A. D. 1859:

 ASSIGNMENT OF COPYRIGHT FOR ORIGINAL TERM.

Now this indenture witnesseth, that the said James Smith, for and in consideration of the sum of one thousand dollars, to him in hand paid by the said Charles Scribner, the receipt whereof is hereby acknowledged, has bargained, sold, and assigned, and by these presents does bargain, sell, and assign, unto the said Charles Scribner, all the said book, and all his copyright, title, interest, property, claim, and demand of, in, and to the same, to have and to hold the said book, copyright, and all the profit, benefit, and advantage that shall or may arise, by and from printing, reprinting, publishing, and vending the same: Provided, nevertheless, and these presents are upon this express condition, that the number of copies to be printed on the first, and each and every other edition or impression of the said book, shall not exceed one thousand; and that the said Charles Scribner shall and will pay unto the said James Smith the further sum and sums of one hundred dollars for, at, and upon the reprinting or making a second, and each and every other future and further edition or impression that shall or may be made of the said book, for and towards a further reward and satisfaction to the said James Smith, for his writing and compiling the same. The said payments shall be made before the publication of the said several impressions or editions (after the first) and sale of the same, or any part thereof, by the said Charles Scribner, or by any other person or persons, by, for, or under him. And the said Charles Scribner doth covenant, promise, and agree, to and with the said James Smith, that he, the said Charles Scribner, shall and will pay, or cause to be paid, to the said James Smith, the said respective sum and sums of one hundred dollars, at and upon the reprinting, and before the publication and sale of the said second and every other future and further edition and impression that shall and may be made of the said book, according to the proviso aforesaid, and the true intent and meaning of these presents. And to the fulfilment of the covenants herein contained, the parties bind their respective executors, administrators, and assigns, as well as themselves.

In witness whereof, the said parties have hereunto set their hands and seals, the day and year first above written.

Sealed and delivered }
 in presence of }
 JOHN SMITH,
 JAMES BROWN.

JAMES SMITH. [L. S.]
 CHARLES SCRIBNER. [L. S.]

ASSIGNMENT OF COPYRIGHT FOR ORIGINAL AND RENEWED TERMS.

STATE OF NEW YORK, }
 CITY AND COUNTY OF NEW YORK. } ss.

On this first day of January, 1860, personally appeared James Smith and Charles Scribner, to me known to be the individuals described in and who executed the foregoing instrument, and severally acknowledged that they executed the same for the purposes therein mentioned.

JAMES BROWN,
 Notary Public.

.....
 5 CENT
 INT. REV.
 STAMP.

4. ASSIGNMENT OF COPYRIGHT FOR ORIGINAL AND RENEWED TERMS.

Indenture, made this first day of May, 1864, between James Smith, of Poughkeepsie, State of New York, of the one part, and Charles Scribner, of the City and State of New York.

Whereas, the said James Smith has written and composed a book, entitled "Flowers of Poesy,"

Now this indenture witnesseth, that the said James Smith, for and in consideration of the sum of five hundred dollars, to him in hand paid by said Charles Scribner, the receipt of which is hereby acknowledged, has bargained, sold, and assigned, and by these presents does bargain, sell, and assign unto the said Charles Scribner, his heirs, executors, administrators, and assigns, all the said book, and the manuscript thereof, and all his right, title, and interest, property, claim, and demand, of every kind and nature whatsoever, of, in, and to the same, and in any and all copyrights, and any and all renewals thereof, which may or can be had, or secured, or taken, in respect to said book or manuscript, under and by virtue of any acts of Congress, with any and all profit, benefit, and advantage that shall or may arise by or from printing, publishing, or vending the same, during the original or renewed terms of any such copyright. To have and to hold the same to the said Charles Scribner, his heirs, executors, administrators, and assigns forever.

And the said James Smith agrees to examine and correct the proof-sheets of said work, as fast as they shall be furnished, and to make and complete a full and correct Index therefor, as soon as may be after all the signatures of the text shall be furnished for that purpose.

 LICENSE TO PRINT ONE EDITION OF A BOOK.

And the said Charles Scribner, for himself, his heirs, executors, administrators, and assigns, covenants and agrees to furnish and deliver, free of cost, to said James Smith, twenty-five bound copies of said work, within three months after the said Index shall or may be completed.

In witness whereof, the said parties have hereunto set their hands and seals, the day and year first above written.

Sealed and delivered } in presence of }	JAMES SMITH. [L. S.] CHARLES SCRIBNER. [L. S.]
JOHN DOE, RICHARD ROE.	

Acknowledgment, as in No. 3.

5. LICENSE TO PRINT ONE EDITION OF A BOOK.

Indenture, made this first day of January, 1860, by and between James Smith, of Poughkeepsie, New York, of the first part, and Charles Scribner, of the City of New York, State aforesaid, of the second part.

Whereas, the said James Smith has in preparation a work, to be called the "Flowers of Foesy,"

Now this indenture witnesseth, that the said James Smith, for the consideration hereinafter expressed, does hereby authorize and allow the said Charles Scribner to print, publish, and sell an edition of one thousand copies of said work, the said James Smith hereby reserving to himself the general copyright in said work.

And the said James Smith, in consideration of the payments hereinafter agreed and covenanted to be made by said Charles Scribner, doth hereby covenant and agree, to and with the said Charles Scribner, that he will furnish to the printer, to be employed by him, fair copy of the said work, and will superintend the printing, and correct the proofs thereof, in the usual manner; and that he will take out of the clerk's office of the District Court of the United States for the Southern District of New York the usual evidences of copyright, for the protection of said work, and will not authorize any person to print, publish, or sell, and will not print, publish, or sell himself, any other copies until the whole of said one thousand copies have been disposed of by said Charles Scribner; Provided, said one thousand copies are sold within five years from the date hereof.

ASSIGNMENT OF RIGHT TO PERFORM DRAMATIC COMPOSITION.

And the said Charles Scribner, in consideration of the aforesaid authority and agreement, does hereby covenant and agree, to and with said James Smith, that he will pay him, the said James Smith, the sum of twenty cents for each and every copy of the said one thousand copies, payable semi-annually, as fast as the said copies shall be sold or otherwise disposed of, he rendering to the said James Smith an account of sales of said work, at the expiration of six months from the day of the first publication, until the whole shall be sold, and that he will also give to the said James Smith fifty copies of said work, handsomely bound, free of charge, as soon as conveniently may be done, after the manuscript copy has been furnished by the said James Smith.

And the said Charles Scribner, in consideration, also, of the aforesaid authority and agreement, does further covenant and agree, to and with said James Smith, that he will not print, publish, or sell any more than the said one thousand copies, until authorized by said James Smith, or his legal representatives, in writing; it being understood that the license herein contained extends only to one edition of the number above specified.

In witness whereof, the said parties have hereunto set their hands and seals, the day and year first above written.

Sealed and delivered } in presence of }	JAMES SMITH. [L. S.] CHARLES SCRIBNER. [L. S.]
JOHN SMITH, JAMES BROWN.	

Acknowledgment, as in No. 3.

6. ASSIGNMENT OF RIGHT TO PERFORM DRAMATIC COMPOSITION FOR SPECIFIED TIME AND PLACES.

Know all men by these presents: That for and in consideration of the sum of one thousand dollars, to be paid as hereinafter mentioned, I, Dion Bourciquault, of the City and County of New York, have sold, assigned, transferred and set over, and by these presents do hereby sell, assign, transfer and set over, unto George Roberts, of the State of Connecticut, for the term of one year from the date hereof, the right, privilege, and license of acting, performing and representing, and of permitting to be acted, performed and represented, my play in five acts entitled

 ASSIGNMENT OF RIGHT TO PERFORM DRAMATIC COMPOSITION.

‘The Octoroon, or Life in Louisiana,’ in all cities in the United States and Canadas, excepting, however, the cities of Boston, New York, Philadelphia, Charleston, Mobile, and New Orleans. To have and to hold the same to said George Roberts, his executors and administrators, together with all the rights and privileges granted and secured to me under the acts of Congress for the protection of my copyright of said play for the period and places aforesaid. Said sum of one thousand dollars to be paid as follows, to wit: six hundred and fifty dollars at the date of these presents and delivery of the manuscript of said play to said Roberts; the further sum of one hundred and fifty dollars on the fifteenth day of February next, and the further sum of two hundred dollars on the thirtieth day of March next. But it is nevertheless expressly understood and agreed, inasmuch as I am in negotiation with the managers of the Cincinnati Theatre for the sale of the license to perform and represent said play in such City of Cincinnati, that I am at liberty to conclude said sale, and in such event I am to credit the amounts I shall receive therefor towards the two payments above mentioned to be made on the fifteenth day of February and thirtieth day of March next by said Roberts to me.

In witness whereof, I have hereunto set my hand and seal, this thirtieth day of December, in the year one thousand eight hundred and fifty-nine.

In presence of
 L. PITKIN,
 WM. DIXEY.

DION BOURCICAULT. [L. s.]

Acknowledgment, as in No. 3.

This assignment held valid in *Roberts v. Meyers*, 13 Mo. Law Rep., 396.—SPRAGUE, J.; Mass., 1860.

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IN RESPECT TO

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PATENT LAWS.

ACT OF 1790, CHAPTER 7.

1 STATUTES AT LARGE, 109.

[*Obsolete: Repealed by Act of 1793, § 12.*]

AN Act to promote the progress of useful arts.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That upon the petition of any person or persons to the Secretary of State, the Secretary for the department of war, and the Attorney-General of the United States, setting forth that he, she, or they, hath or have invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used, and praying that a patent may be granted therefor, it shall and may be lawful to and for the said Secretary of State, the Secretary for the department of war, and the Attorney-General, or any two of them, if they shall deem the invention or discovery sufficiently useful and important, to cause letters patent to be made out in the name of the United States, to bear teste by the President of the United States, reciting the allegations and suggestions of the said petition, and describing the said invention or discovery, clearly, truly, and fully, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns for any term not exceeding fourteen years, the sole and exclusive right and liberty of making,

OBSOLETE.

ACT OF 1790, CHAP. 7, §§ 1, 2.

constructing, using, and vending to others to be used, the said invention or discovery; which letters patent shall be delivered to the Attorney-General of the United States to be examined, who shall, within fifteen days next after the delivery to him, if he shall find the same conformable to this act, certify it to be so at the foot thereof, and present the letters patent so certified to the President, who shall cause the seal of the United States to be thereunto affixed, and the same shall be good and available to the grantee or grantees by force of this act, to all and every intent and purpose herein contained, and shall be recorded in a book to be kept for that purpose in the office of the Secretary of State, and delivered to the patentee or his agent, and the delivery thereof shall be entered on the record and indorsed on the patent by the said Secretary at the time of granting the same.

Under this section it was held, that the allegations and suggestions of the petition must be substantially recited in the patent, or the patent was void. *Evans v. Chambers*, 2 Wash., 126.—WASHINGTON, J.; Pa., 1807.

SECTION 2. *And be it further enacted*, That the grantee or grantees of each patent shall, at the time of granting the same, deliver to the Secretary of State a specification in writing, containing a description, accompanied with drafts or models, and explanations and models (if the nature of the invention or discovery will admit of a model) of the thing or things, by him or them invented or discovered, and described as aforesaid, in the said patents; which specification shall be so particular, and said models so exact, as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman or other person skilled in

ACT OF 1790, CHAP. 7, §§ 3, 4.OBSOLETE.

the art or manufacture, whereof it is a branch, or wherewith it may be nearest connected, to make, construct, or use the same, to the end that the public may have the full benefit thereof, after the expiration of the patent term; which specification shall be filed in the office of the said Secretary, and certified copies thereof shall be competent evidence in all courts and before all jurisdictions, where any matter or thing, touching or concerning such patent, right, or privilege shall come in question.

SECTION 3. *And be it further enacted,* That upon the application of any person to the Secretary of State, for a copy of any such specification, and for permission to have similar model or models made, it shall be the duty of the Secretary to give such copy, and to permit the person so applying for a similar model or models, to take, or make, or cause the same to be taken or made, at the expense of such applicant.

SECTION 4. *And be it further enacted,* That if any person or persons shall devise, make, construct, use, employ, or vend, within these United States, any art, manufacture, engine, machine, or device, or any invention or improvement upon, or in any art, manufacture, engine, machine, or device, the sole and exclusive right of which shall be so as aforesaid granted by patent to any person or persons, by virtue and in pursuance of this act, without the consent of the patentee or patentees, their executors, administrators or assigns, first had and obtained in writing, every person so offending shall forfeit and pay to the said patentee or patentees, his, her, or their executors, administrators or assigns, such damages as shall be assessed by a jury, and moreover shall forfeit to the person aggrieved the thing or things so devised, made, con

OBSOLETE.

ACT OF 1790, CHAP. 7, § 5.

structed, used, employed, or vended, contrary to the true intent of this act, which may be recovered in an action on the case founded on this act.

SECTION 5. *And be it further enacted,* That upon oath or affirmation made before the judge of the district court, where the defendant resides, that any patent which shall be issued in pursuance of this act, was obtained surreptitiously by, or upon false suggestion, and motion made to the said court, within one year after issuing the said patent, but not afterwards, it shall and may be lawful to and for the judge of the said district court, if the matter alleged shall appear to him to be sufficient, to grant a rule that the patentee or patentees, his, her, or their executors, administrators, or assigns, show cause why process should not issue against him, her, or them, to repeal such patents; and if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued as aforesaid, against such patentee or patentees, his, her, or their executors, administrators, or assigns. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the first and true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent or patents; and if the party at whose complaint the process issued shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in such manner as costs expended by defendants shall be recovered in due course of law.

See notes to act of 1793, § 10; and also DIGEST PAT. CASES, title COURTS, B. 3.

ACT OF 1790, CHAP. 7, §§ 6, 7.

OBSOLETE.

SECTION 6. *And be it further enacted,* That in all actions to be brought by such patentee or patentees, his, her, or their executors, administrators, or assigns, for any penalty incurred by virtue of this act, the said patents or specifications shall be *prima facie* evidence (a), that the said patentee or patentees was or were the first and true inventor or inventors, discoverer or discoverers of the thing so specified, and that the same is truly specified; but that nevertheless the defendant or defendants may plead the general issue, and give this act, and any special matter whereof notice in writing shall have been given to the plaintiff, or his attorney, thirty days before the trial, in evidence (b), tending to prove that the specification filed by the plaintiff does not contain the whole of the truth concerning his invention or discovery; or that it contains more than is necessary to produce the effect described; and if the concealment of part, or the addition of more than is necessary, shall appear to have been intended to mislead, or shall actually mislead the public, so as the effect described cannot be produced by the means specified, then, and in such cases, the verdict and judgment shall be for the defendant.

(a) Of the novelty and utility of an invention, the patent is *prima facie* evidence of a very slight character. *Lowell v. Lewis*, 1 Mass., 184.—STORY, J.; Mass., 1817.

See also DIGEST PAT. CASES, title PATENT, P. 2.

(b) As to General Issue, and notices with, see notes to act of 1793, § 6, and to act of 1836, § 15.

SECTION 7. *And be it further enacted,* That such patentee as aforesaid, shall, before he receives his patent, pay the following fees to the several officers employed in making out and perfecting the same, to wit: For receiving and filing the petition, fifty cents; for filing specifica-

OBSOLETE.

ACT OF 1793, CHAP. 11, § 1.

tions, per copy-sheet containing one hundred words, ten cents; for making out patent, two dollars; for affixing great seal, one dollar; for indorsing the day of delivering the same to the patentee, including all intermediate services, twenty cents.

Approved April 10th, 1790.

ACT OF 1793, CHAPTER 11.

1 STATUTES AT LARGE, 318.

[*Obsolete: Repealed by Act of 1836, § 21.*]

An Act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used before the application (*a*), and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State to cause letters patent to be made out in the name of the United States, bearing teste by the President of the United States, reciting the allegations and suggestions of the said petition (*b*), and giving a short description of the said invention or discovery,

and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery, which letters patent shall be delivered to the Attorney-General of the United States, to be examined; who, within fifteen days after such delivery, if he finds the same conformable to this act, shall certify accordingly, at the foot thereof, and return the same to the Secretary of State, who shall present the letters patent, thus certified, to be signed, and shall cause the seal of the United States to be thereto affixed: and the same shall be good and available to the grantee or grantees, by force of this act, and shall be recorded in a book, to be kept for that purpose, in the office of the Secretary of State, and delivered to the patentee or his order.

(a) 1. This section is to be construed with the other parts of the act to mean that the discovery should be unknown, and not used as the invention of any other than the patentee, before the application for a patent. *Morris v. Huntington*, 1 Paine, 353.—THOMPSON, J.; N. Y., 1824.

2. This section of the act is to be construed with section 6 of the same act, and means that the first inventor has a right to a patent, though there may have been a knowledge of the thing invented before the application for a patent, if such use or knowledge was not anterior to the discovery. *Mellus v. Silsbee*, 4 Mass., 111.—STORY, J.; Mass., 1825. *Goodyear v. Matthews*, 1 Paine, 301.—LIVINGSTON, J.; Ct., 1814. *Treadwell v. Bladen*, 4 Wash., 707, 708.—WASHINGTON, J.; Pa., 1827. CONTRA. *Whitney v. Emmett*, Bald, 309.—BALDWIN, J.; Pa., 1831. *Thompson v. Haight*, 1 U. S. Law Jour., 573.—VAN NESS, J.; N. Y., 1822.

3. The meaning of the words "not known or used," &c., in this section, is that the invention must not have been known or used BY THE PUBLIC before the application. *Pennock v. Dialogue*, 2 Pet., 19.—STORY, J.; Sup. Ct., 1829.

4. The patent act of 1790 used the words "not known or used before," without adding the words "the application:" in connection

OBSOLETE.

ACT OF 1793, CHAP. 11, §§ 1, 2.

with the structure of the sentence in which they stand, they might have been referred either to the time of the invention, or of the application. The addition of the latter words in the act of 1793 must have been *ex industria*, and with the cautious intention to clear away a doubt, and fix the original and deliberate meaning of the legislature. *Ibid.*, 22. *Shaw v. Cooper*, 7 Pet., 319.—MOLEAN, J.; Sup. Ct., 1833.

5. Within the spirit of this section, it was held that the Secretary of State, though not expressly authorized, might receive the surrender of letters patent, which were defective by reason of mistakes committed either by the department, or by the inventor, innocently, and reissue a new and corrected patent. *Grant v. Raymond*, 6 Pet., 242.—MARSHALL, Ch. J.; Sup. Ct., 1832. Same view had been before taken in *Sullivan's Case*, Opin., Gilpin's Ed., 158.—WIRT, Atty.-Gen., 1818. *Morris v. Huntington*, 1 Paine, 355.—THOMPSON, J.; N. Y., 1824. *Grant v. Mason*, 1 Law Int. and Rev., 22.—THOMPSON, J.; N. Y., 1828. *Anon.*, 2 Opin., 456.—TANEY, Atty.-Gen., 1831.

(b) 1. Though this act, like that of 1790, required a petition to be presented, and the patent, when issued, to recite the "allegations and suggestions of the petition," it seems that, after this act of 1790, the petition alone seldom contained any thing as to the patent beyond a mere title. *Hogg v. Emerson*, 6 How., 480, 481.—WOODBURY, J.; Sup. Ct., 1847.

2. But the specification, being filed at the same time and often on the same paper, seems to have been regarded, whether specially named in the petition or not, as a part of it. To avoid mistakes as to the extent of the inventor's claim, and to comply with the law, by inserting in the patent at least the substance of the petition, the officers inserted, by express reference, the whole descriptive portion of it as contained in the schedule. *Ibid.*, 41.

SECTION 2. *Provided always, and be it further enacted,* That any person, who shall have discovered an improvement in the principle of any machine, or in the process of any composition of matter, which shall have been patented, and shall have obtained a patent for such improvement, he shall not be at liberty to make, use, or vend the original discovery, nor shall the first inventor be at liberty to use the improvement: (a) And it is hereby enacted and declared, that simply changing the form or the proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery. (b)

(a) As to doctrine that the patentee of an improvement has no right

ACT OF 1793, CHAP. 11, §§ 2, 3.

OBSOLETE.

to use the original discovery, nor the first inventor the right to use the improvement. see *Gray v James*, Pat. C. C., 399.—WASHINGTON, J.; Pa., 1817. *Washburn v. Gould*, 3 Story, 150.—STORY, J.; Mass., 1844. *Woodworth v. Rogers*, 1 Wood. & Min., 141.—WOODBURY, J.; Mass., 1847; and generally DIGEST PAT. CASES, title IMPROVEMENT, C.

(b) 1. It is not every change of form and proportion which is declared by this act to be no discovery, but such as is *simply* a change of form and proportion, and nothing more. If by changing the form and proportion a new effect is produced, there is not simply a change of form and proportion, but a change of principle also. *Davis v. Palmer*, 2 Brock., 310.—MARSHALL, Ch. J.; Va., 1827.

2. Though this declaratory act, that a change in form is not a discovery, was not re-enacted in the law of 1836, it is a principle which necessarily makes part of every system of law granting patents for new inventions. *Winans v. Denmead*, 15 How., 341.—CURTIS, J.; Sup. Ct., 1853.

See also DIGEST PAT. CASES, titles FORM; IMPROVEMENT, A.

SECTION 3. *And be it further enacted*, That every inventor, before he can receive a patent, shall swear or affirm, that he does verily believe, that he is the true inventor or discoverer of the art, machine, or improvement, for which he solicits a patent, which oath or affirmation may be made before any person authorized to administer oaths, and shall deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms, as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions; and he shall accompany the whole with drawings and written references, where the nature of the case admits of drawings, (1) or

OBSOLETE.

ACT OF 1793, CHAP. 11, §§ 3, 4.

with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is of a composition of matter; which description, signed by himself and attested by two witnesses, shall be filed in the office of the Secretary of State, and certified copies thereof shall be competent evidence in all courts, where any matter or thing, touching such patent-right, shall come in question. (b) And such inventor shall, moreover, deliver a model of his machine, provided the Secretary shall deem such model to be necessary.

(a) 1. Under the provisions of this section requiring drawings with written references, if the specification refers to the drawings, they thereby become part of the written description of the invention. *Farle v. Sawyer*, 4 Mass., 10, 11.—STORY, J.; Mass., 1825. *Brooks v. Bicknell*, 3 McLean, 261.—MCLEAN, J.; Ohio, 1843. *Washburn v. Gould*, 3 Story, 133.—STORY, J.; Mass., 1844.

2. It is sufficient if drawings and written references are put on file with the specification; and if the references required are written on the drawings the statute is satisfied. *Emerson v. Hogg*, 2 Blatchf., 9, 10.—BETTS, J.; N. Y., 1845.

3. The patent act of 1793 does not limit the inventor to one single mode or one single set of ingredients to carry into effect his invention. He may claim as many modes as he pleases, provided always that the claim is limited to such as he has invented and as are substantially new. And section 3 of the act requires, in the case of a machine, that the inventor shall explain the several modes in which he has contemplated the application of its principle. *Ryan v. Goodwin*, 3 Sumn., 521.—STORY, J.; Mass., 1839.

4. Under the act of 1793, the specification was not required to be made a part of the letters patent, but the inventor could have it so incorporated with them if he desired. *Hogg v. Emerson*, 11 How., 604.—WOODBURY, J.; Sup. Ct., 1850.

(b) An exemplification of a specification of a patent is made evidence by this section of the act of Congress. The exemplification of the patent itself stands upon the common law, as being an exemplification of a record of a public document, and is always to be received as evidence. The drawing or model need not be exemplified. *Peck v. Farrington*, 9 Wend., 45.—SAVAGE, Ch. J.; N. Y., 1832.

SECTION 4. *And be it further enacted, That it shall be*

lawful for any inventor, his executor or administrator, to assign the title and interest in the said invention, at any time, and the assignee, having recorded the said assignment in the office of the Secretary of State, shall thereafter stand in the place of the original inventor, both as to right and responsibility, and so the assignees of assigns, to any degree.

1. It is the business of the assignee of a patent-right to see that the assignment is put on record. *Morrill v. Worthington*, 14 Mass., 392.—CURIAM; Mass., 1817.

2. Under this section, an assignment is not valid unless it has been recorded in the office of the Secretary of State. *Higgins v. Strong*, 4 Blackf., 183.—DEWEY, J.; Ind., 1836.

3. Under this section, until an assignment is recorded, the assignee is not substituted to the rights and responsibilities of the patentee so as to maintain a suit at law or in equity, founded thereon. *Wyeth v. Stone*, 1 Story, 296.—STORY, J.; Mass., 1840.

4. Under this section, the recording of an assignment is indispensable to convey the right. *Dobson v. Campbell*, 1 Sumn., 326.—STORY, J.; Me., 1833. *Boyd v. McAlpine*, 3 McLean, 428.—MCLEAN, J.; Ohio, 1844.

SECTION 5. *And be it further enacted*, That if any person shall make, devise, and use, or sell the thing so invented (*a*), the exclusive right of which shall, as aforesaid, have been secured to any person by patent, without the consent (*b*) of the patentee, his executors, administrators, or assigns, first obtained in writing, every person so offending shall forfeit and pay to the patentee a sum, that shall be at least equal to three times the price, for which the patentee has usually sold or licensed, to other persons, the use of the said invention, which may be recovered in an action on the case founded on this act, in the Circuit Court of the United States, or any other court having competent jurisdiction. (*c*)

(*a*) 1 Under the act of 1790, a patent was made *prima facie* evidence; that act was repealed by the act of 1793. and that provision

OBSOLETE.

ACT OF 1793, CHAP. 11, §§ 5, 6.

was not re-enacted in it. Hence a patent was not received in courts of justice as even *prima facie* evidence that the invention patented was new or useful, but the plaintiff was bound to prove these facts in order to make out his case. *Corning v. Burden*, 14 How., 270, 271.—GRIER, J.; Sup. Ct., 1853.

2. Under this section, subjecting to a penalty "any person who shall make, devise, and use, or sell the thing so invented," it might well be questioned whether any person would be subject to the penalty for using a machine which he had not also made and devised. Such doubt is removed by section 3 of the act of 1800, which subjects to damages "any person who shall make, devise, use, or sell" the invention of another. *Evans v. Jordan*, 1 Brock., 250, 251.—MARSHALL, Ch. J.; Va., 1813.

3. The maker and seller of a patented article, within the meaning of this section, is the person for whom, by whose direction, and for whose account the article is sold—and not the mere workman employed to sell. *Delano v. Scott*, Gilpin, 498.—HOPKINSON, J.; Pa., 1834.

(b) Where one erected, on his own premises and at his own expense, a machine which was claimed to be the invention of another; and afterwards such inventor took a lease of the machine for a term of years, covenanting to reconvey the same at the end of the term of years, *Held*, that such covenant amounted to license or consent in writing, within the meaning of this section. *Reutgen v. Kanours*, 1 Wash., 172.—WASHINGTON, J.; Pa., 1804.

(c) 1. Under this section, it was held the assignee of a *part* of a patent could not maintain an action for a violation. *Tyler v. Tuel, & Co.*, 321.—CURRIAM; Sup. Ct., 1810.

2. But the assignee of a moiety may join with the patentee in an action for a violation. *Whittemore v. Cutter*, 1 Gall., 430.—STORY, J.; Mass., 1813.

This section repealed by act of 1800, § 4.

SECTION 6. *Provided always, and be it further enacted*, That the defendant in such action shall be permitted to plead the general issue, and give this act, and any special matter (a), of which notice in writing may have been given to the plaintiff or his attorney, thirty days before trial, in evidence, tending to prove, that the specification, filed by the plaintiff, does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made,

for the purpose of deceiving the public (*b*), or that the thing, thus secured by patent, was not originally discovered by the patentee, but had been in use, or had been described in some public work anterior to the supposed discovery of the patentee (*c*), or that he had surreptitiously obtained a patent for the discovery of another person (*d*); in either of which cases, judgment shall be rendered for the defendant, with costs, and the patent shall be declared void (*e*).

(*a*) 1. The object of this section was to guard against defeating patents by the setting up of a prior invention which had never been reduced to practice. *Bedford v. Hunt*, 1 Mass., 305.—STORY, J.; Mass., 1817.

2. This section appears to have been drawn with the idea that the defendant would not be at liberty to contest the validity of the patent on the general issue, and intends to relieve the defendant from the difficulties of pleading, by allowing him to give in evidence matter which affects the patent. *Evans v. Eaton*, 3 Wheat., 503, 504.—MARSHALL, Ch. J.; Sup. Ct., 1818.

3. Such notice is, however, for the security of the plaintiff, to protect him against surprise. *Ibid.*, 504.

(*b*) Under this section a defect or concealment in a specification, in order to make the patent invalid, must appear to have been made for the purpose of deceiving the public. *Whitney v. Carter*, Fessenden on Pat., 2d ed., 139.—JOHNSON, J.; Geo., 1809. *Park v. Little*, 3 Wash., 113.—WASHINGTON, J.; Pa., 1813. *Whittemore v. Cutter*, 1 Gall., 437.—STORY, J.; Mass., 1813. *Gray v. James*, Pet. C. C., 401.—WASHINGTON, J.; Pa., 1817. *Lowell v. Lewis*, 1 Mass., 189.—STORY, J.; Mass., 1817.

(*c*) 1. Where a defence is made that the patentee is not the original discoverer of the thing patented, the patent will be considered as relating back to the original discovery. Construing sections 1 and 6 together, the patentee's right does not date from the time of his application for a patent, but from the time of his discovery. *Dixon v. Moyer*, 4 Wash., 72.—WASHINGTON, J.; Pa., 1821.

2. Under this section, if the thing had been in use or known anterior to the patentee's supposed discovery, his patent is void. Though the patentee had no knowledge of such previous discovery, still his patent is void, as the law supposes he may have known it. *Evans v. Eaton*, 3 Wheat., 514.—MARSHALL, Ch. J.; Sup. Ct., 1818.

3. The use of a machine to test its value, as a cracker machine to the extent of half a barrel of flour, held to amount to a using of it with-

OBSOLETE.

ACT OF 1793, CHAP. 11, §§ 6-3.

in the meaning of this section. *Watson v. Baulen*, 2 Wash., 583.—WASHINGTON, J.; Pa., 1826.

(d) 1. This section does not enumerate all the defences of which the defendant may legally avail himself; as he may give in evidence that he never did the thing attributed to him; that the patentee is an alien, and not entitled under the act; or that he has a license or authority under the patentee. *Whittemore v. Cutter*, 1 Gall., 435—STORY, J.; Mass., 1813. *Kneass v. Schuylkill Bank*, 4 Wash., 11.—WASHINGTON, J.; Pa., 1820. *Pennock v. Dialogue*, 2 Pet., 23.—STORY, J.; Sup. Ct., 1828.

2. This section only declares the defences available against a patentee; but no process or means are given by it for the examination of a patent, however false and fraudulent it may be, if the patentee will forbear to bring suit against those using it. *Delano v. Scott*, Gilpin, 499.—HOPKINSON, J.; Pa., 1834.

(e) 1. If a defendant seeks to annul a patent, he must proceed in precise conformity with section 6 of the act of 1793, and "fraudulent intent" must be found by the jury to justify a judgment of vacatur by the court. This section does not control the 3d. *Grant v. Raymond*, 6 Pet., 247.—MARSHALL, Ch. J.; Sup. Ct., 1832.

2. The Circuit Court, in a civil suit, cannot declare a patent void except for the causes specified in this section. If the patent is defective for any other cause, the verdict must be general for the defendant. *Whitney v. Emmett*, Bald., 321.—BALDWIN, J.; Pa., 1831.

3. Under this section, the Circuit Courts of the United States have exclusive jurisdiction in suits where the patent may be declared void. *Parsons v. Barnard*, 7 Johns., 144.—CURIAM; N. Y., 1810. *Wilson v. Woodworth*, 8 Paige, 134.—WALWORTH, Chan.; N. Y., 1840.

See also notes to act of 1836, § 15, and DIGEST PAT. CASES, title GENERAL ISSUE.

SECTION 7. *And be it further enacted*, That where any State, before its adoption of the present form of government, shall have granted an exclusive right to any invention, the party, claiming that right, shall not be capable of obtaining an exclusive right under this act, but on relinquishing his right under such particular State, and of such relinquishment, his obtaining an exclusive right under this act shall be sufficient evidence.

SECTION 8. *And be it further enacted*, That the persons, whose applications for patents, were, at the time of passing this act, depending before the Secretary of

ACT OF 1793, CHAP. 11, §§ 9, 10.

OBSOLETE

State, Secretary at War, and Attorney-General, according to the act passed the second session of the first Congress, intituled "An act to promote the progress of useful arts," on complying with the conditions of this act, and paying the fees herein required, may pursue their respective claims to a patent under the same.

SECTION 9. *And be it further enacted,* That in case of interfering applications, the same shall be submitted to the arbitration of three persons, one of whom shall be chosen by each of the applicants, and the third person shall be appointed by the Secretary of State (a); and the decision or award of such arbitrators, delivered to the Secretary of State in writing, and subscribed by them, or any two of them, shall be final, as far as respects the granting of the patent: And if either of the applicants shall refuse or fail to choose an arbitrator, the patent shall issue to the opposite party. (b) And where there shall be more than two interfering applications, and the parties applying shall not all unite in appointing three arbitrators, it shall be in the power of the Secretary of State to appoint three arbitrators for the purpose.

(a) An inventor filed a description of his alleged invention in 1802, as required by section 3 of the act of 1793, and took no further step until 1814, when another person made application for a patent for the same invention; *Held,* that there was no limitation of time within which a patent must be taken out after specification filed, and that the facts made a case of interference, to be arbitrated under this section. *Anon.*, 5 Opin., 701.—RUSH, Atty.-Gen.; 1814.

(b) The refusal of a defendant to submit his claim to arbitration under this section, and his subsequently obtaining a patent therefor, is not conclusive evidence, in a proceeding under section 10, that such patent was obtained surreptitiously. *Stearnes v. Barrett*, 1 Mass., 174.—STORY, J.; Mass., 1816.

SECTION 10. *And be it further enacted,* That upon oath or affirmation being made before the judge of the

OBSOLETE.

ACT OF 1793, CHAP. 11, § 10.

District Court, where the patentee, his executors, administrators, or assigns reside, that any patent, which shall be issued in pursuance of this act, was obtained surreptitiously, or upon false suggestion, and motion made to the said court, within three years after issuing the said patent, but not afterwards, it shall and may be lawful for the judge of the said District Court, if the matter alleged shall appear to him to be sufficient, to grant a rule, that the patentee, or his executor, administrator or assign show cause why process should not issue against him to repeal such patent. And if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued against such patentee, or his executors, administrators or assigns, with costs of suit. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent; and if the party, at whose complaint the process issued, shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in due course of law.

1. The jurisdiction given to the District Court, under this section, applies only to cases in which the patent has been obtained by fraud, surreptitiously, by false suggestion, or by some wilful misrepresentation and deception. *Delano v. Scott*, Gilpin, 493.—HOPKINSON, J.; Pa., 1834.

2. The summary proceeding under this section is given to protect the public from manifest fraud, in taking out patents (the fees of office being no check), for known and common things. *Ibid.*, 494.

3. It gives the power to any person to call upon a patentee for an examination of his right, and have it repealed, if it shall be found that he is not entitled to it. *Ibid.*, 500.

4. Proceedings under this section, upon the rule *nisi*, are not conclu-

ACT OF 1793, CHAP. 11, § 11.

OBSOLETE.

sive. The process awarded, upon making the rule absolute, is in the nature of a *scire facias*, and is not final. *Stearns v. Barrett*, 1 Mass., 165.—STORY, J.; Mass., 1816. *Wood & Brundage, Ex parte*, 9 Wheat., 615.—STORY, J.; Sup. Ct., 1824. *Delano v. Scott, Gilpin*, 499.—HOPKINSON, J.; Pa., 1834. CONTRA, *McGaw v. Bryan*, 1 U. S. Law Jour., 98.—VAN NESS, J.; N. Y., 1822.

5. In proceedings under this section, the United States will not be substituted as plaintiffs, in place of the patentee. *Wood v. Williams, Gilpin*, 520, 524.—HOPKINSON, J.; Pa., 1834.

See also DIGEST PAT. CASES, title COURTS, B. 3.

SECTION 11. *And be it further enacted*, That every inventor, before he presents his petition to the Secretary of State, signifying his desire of obtaining a patent, shall pay into the treasury thirty dollars, for which he shall take duplicate receipts; one of which receipts he shall deliver to the Secretary of State, when he presents his petition; and the money thus paid, shall be in full for the sundry services to be performed in the office of the Secretary of State, consequent on such petition, and shall pass to the account of clerk-hire in that office. *Provided nevertheless*, That for every copy, which may be required at the said office, of any paper respecting any patent that has been granted, the person, obtaining such copy, shall pay, at the rate of twenty cents, for every copy-sheet of one hundred words, and for every copy of a drawing, the party obtaining the same, shall pay two dollars, of which payments, an account shall be rendered, annually, to the treasury of the United States, and they shall also pass to the account of clerk-hire in the office of the Secretary of State.

1. A defendant, being permitted under section 6 of the act of 1793, to set up the defence that the plaintiff's specification does not contain the whole truth, he has, under this section, a right to call for and have a copy of the plaintiff's specification, and no conditions can be imposed upon the use of such copy. *Anon.*, 1 Opin., 376.—WIRT, Atty.-Gen. 1820.

OBSOLETE.

ACT OF 1794, CHAP. 58.

2. The proviso to this section cannot be considered as opening to all persons, indiscriminately, the right to demand copies of papers respecting patents granted to others. As to others than a defendant, as provided for in section 6, it rests in the discretion of the department whether copies shall be furnished or refused. *Anon.*, 1 Opin., 718.—WIRT, Atty.-Gen.; 1825.

SECTION 12. *And be it further enacted*, That the act, passed the tenth day of April, in the year one thousand seven hundred and ninety, intituled “An act to promote the progress of useful arts,” be, and the same is hereby repealed. *Provided always*, That nothing contained in this act, shall be construed to invalidate any patent that may have been granted under the authority of the said act; and all patentees under the said act, their executors, administrators, or assigns, shall be considered within the purview of this act, in respect to the violation of their rights; provided such violations shall be committed after the passing of this act.

Approved February 21st, 1793.

ACT OF 1794, CHAPTER 58.

(1 STATUTES AT LARGE, 393.)

[*Obsolete: Repealed by Act of 1836, § 21.*]

An Act supplementary to the act intituled “An act to promote the progress of useful arts.”

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That all suits, actions, process, and proceedings, heretofore had in any District Court of the United States, under an act passed the tenth day of April, in the year one thousand seven hundred and ninety, intituled “An

ACT OF 1800, CHAP. 25, § 1.

OBSOLETE.

act to promote the progress of useful arts," which may have been set aside, suspended, or abated, by reason of the repeal of the said act, may be restored, at the instance of the plaintiff or defendant, within one year from and after the passing of this act, in the said courts, to the same situation, in which they may have been, when they were so set aside, suspended, or abated; and that the parties to the said suits, actions, process, or proceedings, be, and are hereby entitled to proceed in such cases, as if no such repeal of the act aforesaid had taken place. *Provided always*, That before any order or proceeding, other than that for continuing the same suits, after the reinstating thereof, shall be entered or had, the defendant or plaintiff, as the case may be, against whom the same may have been reinstated, shall be brought into court by summons, attachment, or such other proceeding, as is used in other cases for compelling the appearance of a party.

Approved June 7th, 1794.

ACT OF 1800, CHAPTER 25.

2 STATUTES AT LARGE, 37.

[*Obsolete: Repealed by Act of 1836, § 21.*]

An Act to extend the privilege of obtaining patents for useful discoveries and inventions, to certain persons therein mentioned, and to enlarge and define the penalties for violating the rights of patentees.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That all and singular the rights, and

OBSOLETE.

ACT OF 1800, CHAP. 25, § 1.

privileges given, intended or provided to citizens of the United States, respecting patents for new inventions, discoveries and improvements, by the act intituled "An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," shall be, and hereby are extended and given to all aliens who at the time of petitioning in the manner prescribed by the said act, shall have resided for two years within the United States, which privileges shall be obtained, used, and enjoyed, by such persons, in as full and ample manner, and under the same conditions, limitations and restrictions, as by the said act is provided and directed in the case of citizens of the United States. *Provided always*, That every person petitioning for a patent for any invention, art or discovery, pursuant to this act, shall make oath or affirmation before some person duly authorized to administer oaths before such patent shall be granted, that such invention, art or discovery hath not, to the best of his or her knowledge or belief, been known or used either in this or any foreign country, and that every patent which shall be obtained pursuant to this act, for any invention, art or discovery, which it shall afterward appear had been known or used previous to such application for a patent shall be utterly void.

1. Under this act a foreigner, though having resided within the United States for more than two years, could not have a patent for an invention operated by him in another country before he came here, as he could not take the oath required by this statute. *Duplat's Case*, 1 Opin., 332.—WIRT, Atty.-Gen.; 1820.

2. By the provisions of this act, taken in connection with those of the act of 1793, citizens and aliens are placed substantially upon the same ground as to a right to a patent when the invention has not been known or used before it was patented. In both cases the right is to be tested by the same rule. *Shaw v. Cooper*, 7 Pet., 316.—MCLEAN J.; Sup. Ct., 1833.

ACT OF 1800, CHAP. 25, §§ 1-3.

OBSOLETE.

3. Where a person made an invention in England, in 1813 or 1814, and before coming to this country made known his invention to others, and shortly after coming here disclosed it, in 1817, to an individual here, and in 1817 or 1818, the invention was sold in England, and soon after went into use there and in France, and subsequently, in 1822, the inventor took out a patent here; *Held*, that there had been such a public use of the invention, without an assertion of right on the part of the inventor, as rendered the patent void. *Ibid.*, 318-323.

SECTION 2. *And be it further enacted*, That where any person hath made, or shall have made, any new invention, discovery or improvement on account of which a patent might, by virtue of this or the above-mentioned act, be granted to such person, and shall die before any patent shall be granted therefor, the right of applying for and obtaining such patent, shall devolve on the legal representatives of such person in trust for the heirs-at-law of the deceased, in case he shall have died intestate; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations and restrictions, as the same was held, or might have been claimed or enjoyed by such person, in his or her lifetime; and when application for a patent shall be made by such legal representatives, the oath or affirmation, provided in the third section of the before-mentioned act, shall be so varied as to be applicable to them.

SECTION 3. *And be it further enacted*, That where any patent shall be, or shall have been granted pursuant to this or the above-mentioned act, and any person without the consent of the patentee, his or her executors, administrators, or assigns, first obtained in writing, shall make, devise, use, or sell (a) the thing whereof the exclusive right is secured to the said patentee by such patent, such person so offending shall forfeit and pay to the said patentee, his executors, administrators, or assigns, a sum

OBSOLETE.

ACT OF 1800, CHAP. 25, §§ 3, 4.

equal to three times the actual damage (*b*) sustained by such patentee, his executors, administrators, or assigns, from or by reason of such offence, which sum shall and may be recovered by action (*c*) on the case founded on this and the above-mentioned act, in the circuit court of the United States, having jurisdiction thereof.

(*a*) This section gives an action against any one who shall "make, devise, use, or sell," the thing patented, and takes the place of section 5 of the act of 1793, which gave an action against any one who should "make, devise, and use, or sell." This change was made because of some doubt whether the language of section 5 of the act of 1793 did not couple the making and *using* together to constitute an offence, so that making without using, or using without making, was not an infringement. *Whittemore v. Cutler*, 1 Gall., 432.—STORY, J.; Mass., 1813. *Evans v. Jordan*, 1 Brock., 252.—MARSHALL, Ch. J.; Va., 1813.

(*b*) 1. Under this section the jury find single damages, and the court treble them in awarding judgment. *Lowell v. Lewis*, 1 Mass., 185.—STORY, J.; Mass., 1817.

2. Under this section, if the jury find for the plaintiff, they are to find the actual damages sustained by him. The court will treble them. *Gray v. James*, Pet. C. C., 403.—WASHINGTON, J.; Pa., 1817. *Evans v. Heltick*, 3 Wash., 422.—WASHINGTON, J.; Pa., 1818.

3. This section fixed the amount of recovery at three times the actual damage sustained. Trebling the damages, under the act of 1836, rests with the discretion of the court. *Guyon v. Serrell*, 1 Blatchf., 245.—NELSON, J.; N. Y., 1847.

(*c*) 1. This section gave jurisdiction only in actions *on the case*; *Held*, therefore, that a suit in equity, respecting a patent, in order to be cognizable by the circuit courts, must come within the provisions of the judiciary act of 1789, as to citizenship of parties, and that where the parties were all residents of the same State, such courts had not jurisdiction. *Livingston v. Van Ingen*, 1 Paine, 48, 54.—LIVINGSTON, J.; N. Y., 1811.

2. This defect was afterwards remedied by the act of 1819, chap. 19

SECTION 4. *And be it further enacted*, That the fifth section of the above-mentioned act, intituled "An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," shall be and hereby is repealed.

Approved April 17th, 1800.

ACT OF 1819, CHAPTER 19.

(3 STATUTES AT LARGE, 481.)

[*Obsolete: Repealed by Act of 1836, § 21.*]

An Act to extend the jurisdiction of the Circuit Courts of the United States to cases arising under the law relating to patents:

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the Circuit Courts of the United States shall have original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases, arising under any law of the United States, granting or confirming to authors or inventors the exclusive right to their respective writings, inventions, and discoveries: and upon any bill in equity, filed by any party aggrieved in any such cases, shall have authority to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any authors or inventors, secured to them by any laws of the United States, on such terms and conditions as the said courts may deem fit and reasonable: *Provided, however,* That from all judgments and decrees of any Circuit Courts, rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner, and under the same circumstances, as is now provided by law in other judgments and decrees of such Circuit Courts.

Approved February 15th, 1819.

1. This act removed the defect that existed under the act of 1800, by which the Circuit Courts did not have jurisdiction of suits in equity,

OBSOLETE.

ACT OF 1832, CHAP. 162, §§ 1, 2.

except in actions on the case. *Livingston v. Van Ingen*, 1 Paine, 54 (note).—LIVINGSTON, J.; N. Y., 1811.

2. This act does not enlarge or alter the powers of the court over the subject-matter of the cause of action. It only extends its jurisdiction to parties not before falling within it. It removed the objection, that prior to it, a citizen of one State could not obtain an injunction in the Circuit Court for a violation of a patent-right, against a citizen of the same State, and gave the jurisdiction, although the parties were citizens of the same State. *Sullivan v. Redfield*, 1 Paine, 447, 448.—THOMPSON, J.; N. Y., 1825.

3. This act extends the jurisdiction of the Circuit Courts to all cases at law and in equity, arising under the patent laws; but there is nothing in the act which, either in terms or by necessary implication, renders that jurisdiction exclusive. *Burrall v. Jewett*, 2 Paigo, 145.—WALWORTH, Chan.; N. Y., 1830.

4. The substance of this enactment, so far as it relates to the subject of patent-rights, is incorporated into section 17 of the act of 1836. *Stevens v. Gladding*, 17 How., 455.—CURTIS, J.; Sup. Ct., 1854.

ACT OF 1832, CHAPTER 162.

4 STATUTES AT LARGE, 559.

[*Obsolete: Repealed by Act of 1836, § 21.*]

An Act concerning patents for useful inventions.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That it shall be the duty of the Secretary of State, annually, in the month of January, to report to Congress, and to publish in two of the newspapers printed in the city of Washington, a list of all the patents for discoveries, inventions, and improvements, which shall have expired within the year immediately preceding, with the names of the patentees, alphabetically arranged.

SECTION 2. *And be it further enacted*, That application to Congress to prolong or renew the term of a patent, shall be made before its expiration, and shall be notified

at least once a month, for three months before its presentation, in two newspapers printed in the city of Washington, and in one of the newspapers in which the laws of the United States shall be published in the State or Territory in which the patentee shall reside. The petition shall set forth particularly the grounds of the application. It shall be verified by oath; the evidence in its support may be taken before any judge or justice of the peace; it shall be accompanied by a statement of the ascertained value of the discovery, invention, or improvement, and of the receipts and expenditures of the patentee, so as to exhibit the profit or loss arising therefrom.

1. Under the patent laws, prior to 1836, if a patent was renewed, it was a new grant, independent of the old, and the patentee was entitled to the sole and exclusive benefit thereof, unless the licensees or assignees had, by their original grant, secured to themselves by express covenant or grant, a right to the benefit of the renewed patent. *Washburn v. Gould*, 3 Story, 135.—STORY, J.; Mass., 1814.

2. Prior to this statute, the only mode of prolonging the term of a patent beyond the original grant, was by means of private acts of Congress upon individual applications. *Wilson v. Rosseau*, 4 How., 685.—NELSON, J.; Sup. Ct., 1845.

SECTION 3. *And be it further enacted*, That wherever any patent which has been heretofore, or shall be hereafter, granted to any inventor in pursuance of the act of Congress, entitled "An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," passed on the twenty-first day of February, in the year of our Lord, one thousand seven hundred and ninety-three, or of any of the acts supplementary thereto, shall be invalid or inoperative, by reason that any of the terms or conditions prescribed in the third section of the said first-mentioned act, have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive

OBSOLETE.

ACT OF 1832, CHAP. 162, § 3.

intention, been complied with on the part of the said inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new patent to be granted to the said inventor for the same invention for the residue of the period then unexpired, for which the original patent was granted, upon his compliance with the terms and conditions prescribed in the said third section of the said act. And, in case of his death, or any assignment by him made of the same patent, the like right shall vest in his executors and administrators, or assignee or assignees: *Provided, however,* That such new patent, so granted, shall, in all respects, be liable to the same matters of objection and defence as any original patent granted under the said first-mentioned act. But no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be a free public use thereof, shall, in any manner, prejudice his right of recovery for any use or violation of his invention after the grant of such new patent as aforesaid.

Approved July 3d, 1832.

1. The provision of this section is susceptible of but one construction, and that is, that the patentee may sustain an action for any use or violation of his invention, after the grant of the new patent. No prior use of a defective patent can authorize the use of the invention after the emanation of the renewed patent. *Stimpson v. Westchester R. R.*, 4 How., 402.—MCLEAN, J.; Sup. Ct., 1845.

2. To give to the patentee the fruits of his invention was its object, which would be defeated, if a right could be founded on a use subsequent to the original patent, and prior to the renewed one. *Ibid.*, 402.

3. The proviso of this section is in affirmance of the principles laid down by the Supreme Court in *Pennock v. Dialogue*, 2 Pet., 1 (1829); in *Grant v. Raymond*, 6 Pet., 241-245 (1832); and in *Shaw v. Cooper*, 7 Pet., 314, 315 (1833). *McClurg v. Kingsland*, 1 How., 207.—BALDWIN, J.; Sup. Ct., 1843.

ACT OF 1832, CHAP. 203.

OBSOLETE.

4. As the exception in the proviso is limited to the use of the invention under a special license after the grant of the original patent, it leaves the use prior to the application for such patent clearly obnoxious to the principle established in *Pennock v. Dialogue*, 2 Pet., 1; whereby the patent would become void. *Ibid.*, 207.

ACT OF 1832, CHAPTER 203.

4 STATUTES AT LARGE, 577.

[*Obsolete: Repealed by Act of 1836, § 21.*]

An Act concerning the issuing of patents to aliens, for useful discoveries and inventions.

Be it enacted, by the Senate and House of Representatives of the United States of America in Congress assembled, That the privileges granted to the aliens described in the first section of the act, to extend the privilege of obtaining patents for useful discoveries and inventions to certain persons therein mentioned, and to enlarge and define the penalties for violating the rights of patentees, approved April seventeenth, eighteen hundred, be extended, in like manner, to every alien, who, at the time of petitioning for a patent, shall be resident in the United States, and shall have declared his intention, according to law, to become a citizen thereof: *Provided,* That every patent granted by virtue of this act and the privileges thereto appertaining, shall cease and determine and become absolutely void without resort to any legal process to annul or cancel the same in case of a failure on the part of any patentee, for the space of one year from the issuing thereof, to introduce into public use in the United States the invention or improvement for which the patent shall be issued; or in case the same

IN FORCE.

ACT OF 1836, CHAP. 357, § 1.

for any period of six months after such introduction shall not continue to be publicly used and applied in the United States, or in case of failure to become a citizen of the United States, agreeably to notice given at the earliest period within which he shall be entitled to become a citizen of the United States.

Approved July 13th, 1832.

ACT OF 1836, CHAPTER 357.

5 STATUTES AT LARGE, 117.

[This Act still in Force.]

An Act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose. (a)

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be established and attached to the Department of State (b) an office to be denominated the Patent Office, the chief officer of which shall be called the Commissioner of Patents, to be appointed by the President, by and with the advice and consent of the Senate, whose duty it shall be, under the direction of the Secretary of State, to superintend, execute, and perform all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions, and improvements, as are herein provided for, or shall hereafter be, by law, directed to be done and performed, and shall have the charge and custody of all the books, records, papers, models, machines, and all other things belonging to said

ACT OF 1836, CHAP. 357, § 1.

IN FORCE.

office. And said Commissioner shall receive the same compensation (c) as is allowed by law to the Commissioner of the Indian Department, and shall be entitled to send and receive letters and packages by mail, relating to the business of the office, free of postage. (d)

(a) POLICY OF THE PATENT LAWS.

1. Many of the provisions of our patent acts are derived from the principles and practice which have prevailed in England. And though the known and settled construction of the English statute of Monopolies, by their courts of law, has not been received by our courts with all the weight of authority, yet the construction of that statute by the English courts, and the principles and practice which have regulated the grants of English patents, afford materials to illustrate our statute. *Pennock v. Dialogue*, 2 Pet., 18.—STORY, J.; Sup. Ct., 1829.

2. The intention of the patent laws is to promote the progress of the useful arts, by the benefits *granted to inventors*, not by those accruing to the public, after the patent has expired, as in England. Intended for their benefit and security, the law should be construed favorably and beneficially in favor of patentees. *Whitney v. Emmett*, Bald., 321-323.—BALDWIN, J.; Pa., 1831.

3. The settled purpose of the United States has ever been to confer on the authors of useful inventions an exclusive right in their inventions for the time mentioned in their patent. It is the reward stipulated for the advantages derived by the public from the exertions of the individual, and is intended as a stimulus to those exertions. The laws passed for such purpose should be construed in the spirit in which they have been passed, and should be fairly executed by the United States. *Grant v. Raymond*, 6 Pet., 241, 242.—MARSHALL, Ch. J.; Sup. Ct., 1832.

4. The great object and intention of the patent acts is to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals for the time and labor devoted to those discoveries, by the exclusive right to make, use, and sell the thing discovered for a limited time. *Ibid.*, 243.

5. The Constitution of the United States, in giving authority to Congress to grant patents for a limited period, declares the object to be to promote the progress of science and the useful arts, an object as truly national and meritorious, and well founded in public policy, as any which can possibly be within the scope of national protection. Hence it has always been the course of the American courts—and latterly of the English—to construe patents fairly and liberally, and not subject them to any overnice and critical refinements. *Ames v. Howard*, 1

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ACT OF 1836, CHAP. 357, § 1.

Sumn 485.—STORY, J.; Mass., 1833. *Blanchard v. Sprague*, 3 Sumn., 539, 540.—STORY, J.; Mass., 1839.

6. The patent law gives to inventors a monopoly, but not in an odious sense. It takes nothing from the community at large, but secures to them the greatest benefits. To secure to inventors the remuneration for their time, ingenuity, and expense, a liberal construction should be given to the law. *Brooks v. Bicknell*, 3 McLean, 437.—MCLEAN, J.; Ohio, 1844. *Parker v. Haworth*, 4 McLean, 372.—MCLEAN, J.; Ill., 1848. *Parker v. Stiles*, 5 McLean, 54, 56.—LEAVITT, J.; Ohio, 1849. *Bloomer v. Stolley*, 5 McLean, 162.—MCLEAN, J.; Ohio, 1850. *Parker v. Sears*, MS.—GRIER, J.; Pa., 1850. *Goodyear v. Railroads*, 2 Wall, Jr., 363.—GRIER, J.; N. J., 1853. *Allen v. Hunter*, 6 McLean, 306.—MCLEAN, J.; Ohio, 1855.

7. Patents are not to be treated as mere monopolies, odious in the eyes of the law, and therefore not to be favored; nor are they to be construed with the utmost rigor, as *strictissimi juris*. *Ames v. Howard*, 1 Sumn., 485.—STORY, J.; Mass., 1833.

8. The patent laws are not made to encourage monopolies of what before belonged to others, or to the public—which is the true idea of a monopoly—but the design is to encourage genius in advancing the arts, through science and ingenuity, by protecting its productions of what did not before exist, and of what never belonged to another person, or the public. *Davoll v. Brown*, 1 Wood. & Min., 57.—WOODBURY, J.; Mass., 1845.

9. The patent acts have been passed for the promotion of the useful arts—for the ultimate benefit of the republic, and not for the sole benefit of inventors and patentees. It is for the ultimate benefit of the public, that privileges are granted to inventors, allowed to operate, and protected for limited times for their direct benefits. *Day v. Union Rub. Co.*, 3 Blatchf., 500.—HALL, J.; N. Y., 1856. *Kendall v. Winsor*, 21 How., 327, 328.—DANIEL, J.; Sup. Ct., 1858.

10. The power granted by the patent laws is domestic in its character, and necessarily confined within the limits of the United States. The patent acts do not and were not intended to operate beyond the limits of the United States, and the patentee's right of property and exclusive use cannot extend beyond the limits to which the law itself is confined. *Brown v. Duchesne*, 19 How., 195.—TANEY, Ch. J.; Sup. Ct., 1856.

See also DIGEST PAT. CASES, title PATENT, P. 1; STATUTES, B. 2.

(b) The Patent Office is now attached to the Department of the Interior, and the Secretary of the Interior performs all the duties connected therewith formerly devolving upon the Secretary of State. Act of 1849, § 2.

(c) Salary now fixed at \$4,500. Act of 1861, § 4.

(d) The franking privilege was annulled by the "Act to reduce the rates of postage," approved March 3d, 1845; but was again restored by the "Act to establish certain post routes, and for other purposes," approved March 3d, 1847. See also act of 1848, § 4.

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SECTION 2. *And be it further enacted,* That there shall be, in said office, an inferior officer, to be appointed by the said principal officer, with the approval of the Secretary of State, to receive an annual salary of seventeen hundred dollars (a), and to be called the Chief Clerk of the Patent Office; who in all cases during the necessary absence of the Commissioner, or when the said principal office shall become vacant, shall have the charge and custody of the seal, and of the records, books, papers, machines, models, and all other things belonging to the said office, and shall perform the duties of Commissioner during such vacancy. (b) And the said Commissioner may also, with like approval, appoint an examining clerk, at an annual salary of fifteen hundred dollars; two other clerks, at twelve hundred dollars each, one of whom shall be a competent draughtsman; one other clerk, at one thousand dollars; a machinist at twelve hundred and fifty dollars; and a messenger, at seven hundred dollars. (c) And said Commissioner, clerks, and every other person appointed and employed in said office, shall be disqualified and interdicted from acquiring or taking, except by inheritance, during the period for which they shall hold their appointments, respectively, any right or interest, directly or indirectly, in any patent for an invention or discovery which has been, or may hereafter be, granted.

(a) Salary increased to \$2,500 by act of 1861, § 4.

(b) 1. Under this section the chief clerk has been considered as the "acting Commissioner," whenever the Commissioner has been unable to discharge his duties from any necessary cause, as well as when a vacancy occurs from death or resignation. *Woodworth v. Hall*, 1 Wood. & Min., 392.—WOODBURY, J.; Mass., 1846.

2. The appointment of an acting Commissioner will be presumed to have been duly made, where drawn in question, incidentally or collat-

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erally, if it be shown that the person certifying is in the public discharge of those duties. *Woodworth v. Hall*, 1 Wood. & Min., 255.—WOODBURY, J.; Mass., 1846.

3. The certificate to a patent made by a person as "acting Commissioner," is legal and sufficient. *Wilson v. Rosseau*, 4 How., 663, 668.—NELSON, J.; Sup. Ct., 1845. *Woodworth v. Hall*, 1 Wood. & Min., 254.—WOODBURY, J.; Mass., 1846. *York & Md. R. R. v. Winans*, 17 How., 41.—CAMPBELL, J.; Sup. Ct., 1854.

See also DIGEST PAT. CASES, title COMMISSIONER OF PATENTS, G.

(c) 1. As to the appointment of additional examiners, see act of 1837, § 11; act of 1839, § 1; act of 1856, §§ 9, 10; and act of 1860, § 5.

2. The Commissioner of Patents is now authorized to appoint additional examiners, not exceeding four in each class. Act of 1861, § 7.

SECTION 3. *And be it further enacted*, That the said principal officer, and every other person to be appointed in the said office, shall, before he enters upon the duties of his office or appointment, make oath or affirmation truly and faithfully to execute the trust committed to him. And the said Commissioner and the Chief Clerk shall also, before entering upon their duties, severally give bonds, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, with condition to render a true and faithful account to him or his successor in office, quarterly, of all moneys which shall be by them respectively received for duties on patents, and for copies of records and drawings, and all other moneys received by virtue of said office.

SECTION 4. *And be it further enacted*, That the said Commissioner shall cause a seal to be made and provided for the said office, with such device as the President of the United States shall approve; and copies of any records, books, papers, or drawings, belonging to the said office, under the signature of the said Commissioner, or, when the office shall be vacant, under the signature

of the Chief Clerk, with the said seal affixed, shall be competent evidence in all cases in which the original records, books, papers, or drawings could be evidence. (a) And any person making application therefor may have certified copies of the records, drawings, and other papers deposited in said office (b), on paying, for the written copies, the sum of ten cents for every page of one hundred words (c); and for copies of drawings, the reasonable expense of making the same.

(a) 1. A certified copy of an assignment is competent evidence, and the party cannot be required to produce the originals. *Brooks v. Bicknell*, 3 McLean, 436.—MCLEAN, J.; Ohio, 1844.

2. Certified copies of papers and drawings, on file in the Patent Office, must be received in evidence when offered. If they are discordant, they may destroy the effect of each other; but they need not concur in every particular. *Emerson v. Hogg*, 2 Blatchf., 12.—BETTS, J.; N. Y., 1846.

3. Certified copies of papers in the Patent Office are *prima facie* evidence of the genuineness of the original, on file, and absolute evidence of the correctness of the copies from the records. *Parker v. Haworth*, 4 McLean, 371.—MCLEAN, J.; Ill., 1843.

4. A certified copy of an assignment of a patent, from the Patent Office, is *prima facie* evidence of the genuineness of the original. *Lee v. Blandy*, MS.—MCLEAN, LEAVITT, JJ.; Ohio, 1860.

5. A former and defective certified copy of a patent may be corrected by a full and corrected certified copy. *Brooks v. Bicknell*, 3 McLean, 434.—MCLEAN, J.; Ohio, 1844. *Woodworth v. Hall*, 1 Wood. & Min., 260.—WOODBURY, J.; Mass., 1846.

(b) 1. The Commissioner of Patents having under his care and custody the records as to patents, it is his duty to give authenticated copies to any person demanding the same, on payment of the legal fees; but a demand accompanied by rudeness and insult is not a legal demand. *Boyden v. Burke*, 14 How., 583.—GRIER, J.; Sup. Ct., 1852.

2. The officer intrusted to give copies of papers or drawings, in patent cases, has no concern with the purpose for which asked. The policy of the law rather requires than forbids that copies should be given when asked for. *Anon.*, 1 Opin., 171.—PINCKNEY, Atty.-Gen.; 1812.

(c) Copies of papers cannot be taken by third persons. They must be made by the proper officer, and the fees paid therefor. *Anon.*, 2 Opin., 456.—TANEY, Atty.-Gen.; 1831.

See also DIGEST PAT. CASES, title COPIES OF PAPERS.

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SECTION 5. [Enlarged by act of 1837, § 6.] *And be it further enacted,* That all patents issued from said office shall be issued in the name of the United States, and under the seal of said office, and be signed by the Secretary of State (a), and countersigned by the Commissioner of the said office, and shall be recorded, together with the descriptions, specifications, and drawings, in the said office, in books to be kept for that purpose. Every such patent shall contain a short description or title of the invention or discovery, correctly indicating its nature and design (b), and in its terms grant to the applicant or applicants (c), his or their heirs, administrators, executors, or assigns, for a term not exceeding fourteen years (d), the full and exclusive right and liberty of making, using, and vending to others to be used, the said invention or discovery (e), referring to the specifications for the particulars thereof, a copy of which shall be annexed to the patent, specifying what the patentee claims as his invention or discovery. (f)

(a) Now signed by the Secretary of the Interior. Act of 1849, § 2.

(b) The phraseology of this act, in respect to what the patent shall contain, was changed from that contained in the acts of 1790 and 1793, in order to conform to the usage and construction under the act of 1793 (of inserting the whole descriptive portion of the petition in the patent), as such course sometimes was misunderstood, and led to misconstructions. *Hogg v. Emerson*, 6 How., 482.—WOODBURY, J.; Sup. Ct., 1847.

(c) Patents can now issue, by section 6 of the act of 1837, to the assignee or assignees of the inventor.

(d) 1. The term of the patent is now extended to seventeen years. Act of 1861, § 16.

2. A patent may be issued for a less term of years than fourteen. The restriction is on the *maximum* only, not on the *minimum*. *Sullivan's Case*, Opin., Gilpin's Ed., 1841, 168.—WIRT, Atty.-Gen.; 1818.

3. A patentee under this section is not obliged to claim the whole fourteen years. He may waive his claim to a part of the term, in favor of the public, by antedating it, or he may take a patent for a term less

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than fourteen years, or he may seek protection against strangers for six months previous to the issue, if in that time he has made application and is seeking in good faith and with reasonable diligence to perfect his specifications. *Cushman, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1858.

(e) 1. The exclusive grant of a patent is the construction and use of the thing patented. The patent law protects the thing patented, and not the product. *Boyd v. Brown*, 3 McLean, 297.—MOLEAN, J.; Ohio, 1843.

2. It does not cover the products of the patented machine. *Ibid.*, 297. *Simpson v. Wilson*, 4 How., 711.—NELSON, J.; Sup. Ct., 1845. *Goodyear v. The Railroads*, 2 Wall., Jr.—GRIER, J.; N. J., 1853.

3. At common law, an inventor has no exclusive right to make and vend his invention, after he has published it to the world. Such exclusive right is the creature of the statute, which also prescribes the remedy for its violation. *Dudley v. Mayhew*, 3 Comst., 13-17.—STRONG, J.; N. Y., 1849.

4. The fact that a party has a patent, giving him the exclusive right to make, use, and sell a particular medicine, does not confer upon him the right to practise as a physician, and use such medicine in any particular State, except in conformity with the laws of such State. *Jordan v. Overseers of Poor*, 4 Ohio, 310.—LANE, J.; Ohio, 1831. *Thompson v. Staats*, 15 Wend., 395.—NELSON, J.; N. Y., 1836.

5. A party has not necessarily a right to use an invention, in any State, merely because he has a patent for it under the United States. *Vannani v. Paine*, 1 Harrington, 68.—ROBINSON, J.; Del., 1833.

6. Where V. had a patent for a plan for constructing and drawing lotteries, and had obtained a patent therefor, but there was a State law prohibiting lotteries, except under certain conditions, which the plaintiff and his associates had not complied with, *Held*, that V. was not entitled to any relief by way of injunction or otherwise, for any alleged use of his invention in the State. *Ibid.*, 69.

7. The Commissioner of Patents, in issuing letters patent, does not warrant the same, nor does the patent bind the Government more than it does private persons; but the validity of such patent is open to inquiry, either in whole or in part, whether at the instance of private persons or of the Government. A patent does not conclude anybody. *Morton's Anæsthetic Patent*, 8 Opin., 276.—CUSHING, Atty.-Gen.; 1856.

8. Letters patent issue subject to all legal objections that may be brought against them. *Shreeve v. United States*, MS.—LORING, J.; Ct. Claims, 1859.

9. In using the word *patent*, it is to be understood as including the patent, the specification attached to it, with the model and drawings in the Patent Office. *Whitney v. Emmett*, Bald., 314.—BALDWIN, J.; Pa., 1831. *Hogg v. Emerson*, 6 How., 478, 482, 485.—WOODBURY, J.; Sup. Ct., 1847.

10. Under the act of 1790, a patent was made *prima facie* evidence

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that act was repealed by the act of 1793, and that provision was not re-enacted in it. Hence a patent was not received in courts of justice as even *prima facie* evidence that the invention patented was new or useful, but the plaintiff was bound to prove those facts in order to make out his case. But the act of 1836 introduced a new system, and under it—its inquisition and examination—a patent is received as *prima facie* evidence of the truth of the facts stated in it. *Corning v. Burden*, 15 How., 270, 271.—GRIER, J.; Sup. Ct., 1853. *Allen v. Hunter*, 6 McLean, 304, 305.—MCLEAN, J.; Ohio, 1855. *Teese v. Phelps*, 1 McAllister, 49.—MCALLISTER, J.; Cal., 1855. *Cahoon v. King*, MS.—CLIFFORD, J.; Me., 1859.

(*f*) Under the patent laws since 1836, the specification is always annexed to and forms a part of the letters patent. *Pitts v. Whitman*, 2 Story, 621.—STORY, J.; Mass., 1843.

See also DIGEST PAT. CASES, title PATENT, D. 1, 2; E., H., I., P., 1, 2.

SECTION 6. *And be it further enacted*, That any person or persons, having discovered or invented any new and useful art (*a*), machine (*b*), manufacture, or composition of matter (*c*), or any new and useful improvement (*d*) on any art, machine, manufacture, or composition of matter, not known or used by others (*e*) before his or their discovery or invention (*f*) thereof, and not, at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer; and shall desire to obtain an exclusive property therein, may make application, in writing, to the Commissioner of Patents, expressing such desire, (*g*) and the Commissioner, on due proceedings had, may grant a patent therefor. But before any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains or with which it is most nearly connected, to make, con

struct, compound and use the same (*h*); and in case of any machine, he shall fully explain the principle and the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions (*i*); and shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery. (*j*) He shall, furthermore, accompany the whole with a drawing, or drawings (*k*), and written references, where the nature of the case admits of drawings, or with specimens of ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention or discovery is of a composition of matter; which descriptions and drawings, signed by the inventor and attested by two witnesses, shall be filed in the Patent Office; and he shall moreover furnish a model of his invention, in all cases which admit of a representation by model, of a convenient size to exhibit advantageously its several parts. (*l*) The applicant shall also make oath or affirmation (*m*) that he does verily believe that he is the original and first inventor or discoverer of the art, machine, composition, or improvement, for which he solicits a patent, and that he does not know or believe that the same was ever before known or used; and also of what country he is a citizen; which oath or affirmation may be made before any person authorized by law to administer oaths. (*n*)

(*a*) 1. When art is spoken of as the subject of a patent, it is not an art in the abstract, but it is an art as explained in the specification, and illustrated by a machine, or model, or drawings, when of a character so to be. It means a useful art or manufacture, which must be described with exactness in its mode of operation, and which can be protected only in the mode and to the extent described. *Smith v. Downing*, MS.—WOODBURY, J.; Mass., 1850.

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2. In the English patent laws the word "art" is not used at all. In ours, as well as in our Constitution, the word art means a useful art, or a manufacture which is beneficial. *Ibid.*

3. A process, *eo nomine*, is not the subject of a patent, under our laws. It is included under the general term "useful art," and an art may require one or more processes or machines, in order to produce a certain result or manufacture. *Corning v. Burden*, 15 How., 267.—GRIER, J.; Sup. Ct., 1853.

See also DIGEST PAT. CASES, titles ART; PROCESS.

(b) 1. The term machine includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. *Corning v. Burden*, 15 How., 267.—GRIER, J.; Sup. Ct., 1853.

2. A patent cannot be for the function or abstract effect of a machine, but only for the machine itself. *Ibid.*, 268.

3. A new process is usually the result of discovery; a machine of invention. *Ibid.*, 268.

4. One may discover an improvement in a process, irrespective of any particular form of machinery; and another may invent a labor-saving machine, by which the operation or process may be performed, and each may be entitled to a patent. *Ibid.*, 268.

5. The word "machine" in the statute includes new combinations as well as new organizations of mechanism. *Wintermute v. Redington*, MS.—WILSON, J.; Ohio, 1856.

See also DIGEST PAT. CASES, title MACHINES, A.

(c) 1. It is not necessary that every ingredient, or that any one ingredient used by the patentee in his invention, should be new or unused before, for the purpose intended. The true question is whether the combination of materials used by the patentee is substantially new. *Ryan v. Goodwin*, 3 Sumn., 518.—STORY, J.; Mass., 1839.

2. There is a wide difference between the invention of a new method or process, by which a known fabric, product, or manufacture is produced in a better and cheaper way, and the discovery of a new compound, substance, or manufacture, having qualities never found to exist together in any other material. *Goodyear v. The Railroads*, 2 Wall., Jr., 360.—GRIER, J.; N. J., 1853.

3. In the first case the inventor can patent nothing but his process, and not his composition of matter; in the latter, both are new and original, and both patentable; not severally, but as one discovery or invention. *Ibid.*, 361.

See also DIGEST PAT. CASES, titles COMPOSITION OF MATTER; MANUFACTURE, ARTICLE OF.

(d) 1. An "improved machine," and "an improvement on a machine," are substantially the same. *Burgett v. Hall*, 1 Mass., 476.—STORY, J.; Mass., 1818. *Evans v. Eaton*, 3 Wheat., 517.—MARSHALL, Ch. J.; Sup. Ct., 1818.

2. An improvement has essential reference to a subject-matter to be

improved. It is not an original, but embraces, and either adds to or alters, the original. *Page v. Ferry*, MS.—WILKINSON, J.; Mich., 1857.

See also DIGEST PAT. CASES, title IMPROVEMENTS.

(e) 1. The words "by others," in this section, were probably added by way of explanation of the doubt formerly entertained on the subject, whether a use by the patentee himself of his invention before application, would deprive him of a right to a patent; and to confirm the decision in *Penuock v. Dialogue*, 2 Pet., 18-22, that a prior use, to invalidate a patent, must have been by others than the inventor. *Reed v. Cutter*, 1 Story, 597.—STORY, J.; Mass., 1841.

2. Such words do not denote a plurality of persons by whom the use should be known, but that the use should be known by some other person or persons than the patentee. *Ibid.*, 597, 598.

3. The words "not known or used" are qualified by section 15, and mean a knowledge or use existing in a manner accessible to the public. *Gayler v. Wilder*, 10 How., 497.—TANEY, Ch. J.; Sup. Ct., 1850.

As to priority of invention, see also DIGEST PAT. CASES, titles INVENTION, C; INVENTOR, B.; and PRIOR KNOWLEDGE.

(f) 1. Under the Constitution and laws of the United States respecting patents, *discovery* is synonymous with *invention*. *Kemper, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. An invention resting in mere theory, or in intellectual notion, or imperfect experiments, and not reduced to practice, is not patentable. *Reed v. Cutter*, 1 Story, 590.—STORY, J.; Mass., 1841.

3. Conceiving the idea of an improvement or machine is not invention. *Hildreath v. Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

As to what is invention, see DIGEST PAT. CASES, title INVENTION, A., and the several titles, ART; COMPOSITION OF MATTER, A.; COMBINATION; DISCOVERY; IMPROVEMENTS, A.; MACHINES, A.; MANUFACTURE, ARTICLE OF; NEW APPLICATION; PRINCIPLE.

(g) Under the present practice of the Patent Office, two distinct and separate inventions cannot be included in one application, except where they have a necessary and dependent connection with each other, and all co-operate in attaining the end sought.

(h) 1. The description should be accommodated to the comprehension of any practical mechanic, without taxing his genius or inventive powers. *Gray v. James*, Pet. C. C., 401.—WASHINGTON, J.; Pa., 1817.

2. It is not enough, however, if, from the description, some very skilful artisan could make and use it, but persons of ordinary skill must be able to do so; and must be able not only to construct but to use the machine for a useful purpose. *Lippincott v. Kelly*, 1 West. Law Jour., 514.—IRVIN, J.; Pa., 1844.

3. No description will fulfil the demands of the law but such as is of record, and of which all the world may have the benefit. *Dixon v. Moyer*, 4 Wash. 73.—WASHINGTON, J.; Pa., 1821.

4. The object of this provision is twofold: 1, that when the term has

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expired, and the invention becomes public property, such means of information may be accessible through the Patent Office as will enable others to avail themselves of its benefits; and 2, that while the patent is in force, others may be informed of the precise claim of the patentee, and not ignorantly infringe his exclusive right. *Parker v. Stiles*, 5 McLean, 55.—LEAVITT, J.; Ohio, 1849. *Brooks v. Bicknell*, 3 McLean, 441.—MCLEAN, J.; Ohio, 1844. *Judson v. Moore*, MS.—LEAVITT, J.; Ohio, 1860.

5. But the specification need not particularly describe the operation of mechanism which is well known by persons acquainted with the art. *Kneass v. Schuylkill Bank*, 4 Wash., 14.—WASHINGTON, J.; Pa., 1820. *Brooks v. Bicknell*, 3 McLean, 447, 448.—MCLEAN, J.; Ohio, 1844. *Emerson v. Hogg*, 2 Blatchf., 9.—BETTS, J.; N. Y., 1845.

See also DIGEST PAT. CASES, titles COMPOSITION OF MATTER, B.; SPECIFICATION, B.; IMPROVEMENT, B.

(i) 1. This section seems clearly to show that a patentee may lawfully unite in one patent all the modes of applying his invention contemplated, and all the different sorts or modifications of machinery, by which it may be applied, and if each were new the patent would cover them all. *Wyeth v. Stone*, 1 Story, 292.—STORY, J.; Mass., 1840.

2. It is the duty of an inventor to describe in his specification the several different modes or devices or modifications known to him of his invention. *Sargent v. Carter*, 11 Mo. Law Rep., 655.—CURTIS, J.; Mass., 1858.

See also DIGEST PAT. CASES, title MACHINES, B.

(j) 1. The summing up or claim is conclusive upon the right and title of the patentee. *Wyeth v. Stone*, 1 Story, 285.—STORY, J.; Mass., 1840.

2. The claim is the most material part of the specification. *Many v. Jagger*, 1 Blatchf., 378.—NELSON, J.; N. Y., 1848.

3. Although a patentee does not expressly claim equivalents, he is understood to embrace them, and in contemplation does embrace them. *Byam v. Farr*, 1 Curt., 263.—CURTIS, J.; Mass., 1852.

See also DIGEST PAT. CASES, title PATENTS, P. 5.

(k) 1. Drawings annexed, and referred to in the specification, constitute a part thereof; and they may be resorted to to aid the description, and to distinguish the thing patented from other things known before. *Earle v. Sawyer*, 4 Mass., 9.—STORY, J.; Mass., 1825.

2. References to the drawings in the specification are not requisite to the validity of a patent, unless they are necessary to an understanding of the invention. *Brooks v. Bicknell*, 3 McLean, 261.—MCLEAN, J.; Ohio, 1843. *Washburn v. Gould*, 3 Story, 133.—STORY, J.; Mass., 1844.

3. The description of a machine or improvement, accompanied by a drawing, may, in many cases, be understood without references. *Ibid.*, 262.

4. The drawings may be signed by the inventor, or by his attorney for him. *Anon.*, MS.—BLACK, Atty.-Gen.; 1859.

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5. Duplicate drawings are now required. Act of 1837, § 6.

6. Drawings should be in duplicate, twenty inches by fifteen in size; one on thick drawing-paper, colored and shaded, and the other on tracing-cloth, and should be in perspective, with detached sectional and plane views.

7. In the case of designs, photographs may be substituted for drawings, but the "negatives" must be sent to the Patent Office.

See also DIGEST PAT. CASES, title DRAWINGS.

(l) 1. Models and drawings are a part of the letters patent, and may be resorted to for clearer information respecting the invention described in the specification. *Hogg v. Emerson*, 6 How., 485.—WOODBURY, J.; Sup. Ct., 1847. *Stephens v. Salisbury*, MS.—MORSELL, J.; D. C., 1855.

2. Models should be made of durable material; and, if of wood, should be stained, painted, or varnished, and should not be more than one foot in length and height, unless a larger model is necessary to exhibit the invention.

3. In the case of a design, which can be sufficiently represented by a drawing, a model may be dispensed with.

See also DIGEST PAT. CASES, title MODELS.

(m) 1. The taking of the oath by the inventor is but a prerequisite to the granting of a patent, and in no degree essential to its validity. If, therefore, not conformable to the statute it is no objection to the patent. *Whittemore v. Cutter*, 1 Gall., 433.—STORY, J.; Mass., 1813.

2. The oath extends to all the schedule or specification no less than to the title of the invention. *Hogg v. Emerson*, 6 How., 482.—WOODBURY, J.; Sup. Ct., 1847.

3. The declaration admitted under the English law cannot be substituted in place of the oath. *Anon.*, 3 Opin., 532.—GILPIN, Atty.-Gen.; 1840.

4. Affirmation may be substituted in place of an oath, when the person of whom it is required is conscientiously scrupulous of taking an oath. Act of 1837, § 13.

5. As to the persons before whom the oath may be taken, when the applicant is not, for the time being, residing in the United States. Act of 1842, § 4.

See also DIGEST PAT. CASES, title OATH.

(n) 1. The act of 1836, sections 6 and 15, and the act of 1837, section 9, are to be construed, as to originality of invention, as though they were embodied in one act. *Smith v. Ely*, 5 McLean, 84.—MCLEAN, J.; Ohio, 1849.

2. The things specified in this section are prerequisites to the granting of a patent, and unless these prerequisites are complied with, a party sued for an infringement of the patent may show that they have not been complied with, and in that mode defeat the action of the supposed inventor. *Ransom v. Mayor, &c., of New York*, MS.—HALL, J.; N. Y., 1856.

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SECTION 7. [Amended by act of 1839, §§ 7-11: repealed in part by act of 1839, § 12; and act of 1863, § 1.] *And be it further enacted*, That, on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make or cause to be made, an examination (a) of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application (b), if the Commissioner shall deem it to be sufficiently useful (c) and important, it shall be his duty to issue a patent therefor. (d) But whenever, on such examination, it shall appear to the Commissioner that the applicant was not the original and first inventor or discoverer thereof (e), or that any part of that which is claimed as new had before been invented or discovered, or patented, or described in any printed publication in this or any foreign country, as aforesaid, or that the description is defective and insufficient, he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification to embrace only that part of the invention or discovery which is new. (f) In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars, part of the duty required by

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this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the Commissioner, shall be a sufficient warrant to the treasurer for paying back to the said applicant the said sum of twenty dollars. (g) But if the applicant in such case, shall persist in his claims for a patent, with or without any alteration of his specification, he shall be required to make oath or affirmation anew (h), in manner as aforesaid. And if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners (i), to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, one of whom at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains; who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate in writing, of the opinion and decision of the Commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, as well as to the Commissioner, of the time and place of their meeting, that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision; and it shall be the duty of the Commissioner to furnish to the board of examiners such information as he may

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possess relative to the matter under their consideration. And on an examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part, and their opinion being certified to the Commissioner, he shall be governed thereby in the further proceedings to be had on such application: *Provided, however,* That before a board shall be instituted in any such case, the applicant shall pay to the credit of the treasury, as provided in the ninth section of this act, the sum of twenty-five dollars, and each of said persons so appointed shall be entitled to receive for his services in each case a sum not exceeding ten dollars, to be determined and paid by the Commissioner out of any moneys in his hands, which shall be in full compensation to the persons who may be so appointed, for their examination and certificate as aforesaid.

(a) The proceedings before the Commissioner are initiatory—all relating to the question whether a patent shall issue. *Pomeroy v. Connison*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1842. *Perry v. Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

See also DIGEST PAT. CASES, title APPLICATION FOR PATENT, A.

(b) 1. An inventor will not be deprived of the benefit of his invention and a right to a patent, by a use of his invention before his application for a patent, without his consent and against his will, and without any *laches* or misconduct on his part. *Pierson v. Eagle Screw Co.*, 3 Story, 407.—STORY, J.; R. I., 1844. *Fry & Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

2. The provisions of sections 7 and 15 of the act of 1836, introduced an important modification into the law of patents, designed to protect the American inventor against the injustice of being thrown out of the fruits of his ingenuity by the existence of a secret invention or discovery abroad—that is, a discovery not patented, and not described in any printed publication. *Anon.*, 5 Opin., 21.—TOUCEY, Atty.-Gen.; 1848.

3. If the applicant is an original inventor, and in a condition to make the oath required, the act requires the Commissioner to issue the patent, and the courts declare it valid, and establish the American right

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to the exclusion of the foreign discovery, which has not, in either of the modes indicated by the act of Congress, been communicated to the public. *Ibid*, 21. Also *Coleman v. Liesor*, MS.—LEAVITT, J.; Ohio, 1859. *Judson v. Cope*, MS.—LEAVITT, J.; Ohio, 1860.

4. To constitute a prior invention, the party alleged to have produced it must have proceeded so far as to have reduced his idea to practice, and embodied it in some distinct form. *Parkhurst v. Kinsman*, 1 Blatchf., 494.—NELSON, J.; N. Y., 1849. *Howe v. Underwood*, MS.—SPRAGUE, J.; Mass., 1854. *Allen v. Hunter*, 6 McLean, 321.—MCLEAN, J.; Ohio, 1855. *Poppenhausen v. N. Y. G. P. Comb Co.*, MS.—INGERSOLL, J.; N. Y., 1858. *Ellithorpe v. Robertson*, MS.—INGERSOLL, J.; N. Y., 1859.

5. The words "prior to the application," refer only to the "public use or sale of the invention with the applicant's consent or allowance," and do not refer to any thing else. *Bartholomew v. Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

6. The words "prior to the alleged invention of the applicant," refer to an invention or discovery of some one, other than the applicant, in this country, and also to a patent or description in this or some foreign country. *Ibid*.

7. The true meaning of this section is, that a patent shall issue to the applicant and be valid, if he is the originator and author of a useful invention, unless the thing invented by him has, prior to his alleged invention or discovery, been invented, or discovered, or used by some one else in this country; or unless the invention of the applicant has been patented or described in some printed publication in this or some foreign country, prior to the alleged invention or discovery of the applicant; or has been on sale with the applicant's consent, prior to his application for a patent. *Ibid*.

8. The provision of this section as to the invention having been in use or on sale prior to the application, amended by the act of 1839, § 7.

See also DIGEST PAT. CASES, titles PRIOR KNOWLEDGE; PRIOR USE.

(c) 1. As to the utility of an invention, all that the law requires is, that the invention should not be frivolous or injurious. The word *useful* is used in contradistinction to mischievous or immoral. Whether the invention be more or less useful is unimportant. *Lowell v. Lewis*, 1 Mass., 186.—STORY, J.; Mass., 1817. *Bedford v. Hunt*, 1 Mass., 303.—STORY, J.; Mass., 1817. *Earle v. Sawyer*, 4 Mass., 6.—STORY, J.; Mass., 1825. *Whitney v. Emmett*, Bald., 309.—BALDWIN, J.; Pa., 1831. *Winans v. Schenec. & Troy R. R.*, 2 Blatchf., 290.—NELSON, J.; N. Y., 1851. *Page v. Ferry*, MS.—WILKINS, J.; Mich., 1857. *Leach, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

2. The invention need not be the best for the use to which it can be applied. *Many v. Jagger*, 1 Blatchf., 381.—NELSON, J.; N. Y., 1848. *Roberts v. Ward*, 4 McLean, 566.—MCLEAN, J.; Mich., 1849. *Wilbur v. Beecher*, 2 Blatchf., 137.—NELSON, J.; N. Y., 1850.

See also DIGEST PAT. CASES, title INVENTION, D. 1.

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(d) 1. The Commissioner is bound to issue a patent in the case and under the circumstances mentioned in this section. He has no discretion about it. *Hildreath v. Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841. *Aiken, Ex parte (Car-Wheels)*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

2. When a patent has issued, the jurisdiction of the Commissioner is exhausted, and he has no further control over it, except under section 13, upon application for a reissue. *Pomeroy v. Connison*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1842.

3. But his power exists in full force until the patent actually issues, and is not controlled by intervening opinions in proceedings during the examination. *Wade v. Matthews*, MS., 5 Opin., 222.—JOHNSON, Atty.-Gen.; 1849.

See also DIGEST PAT. CASES, title APPLICATION FOR PATENTS, B.

(e) 1. The inventor must be the original inventor as to all the world, to be entitled to a patent. *Reutgen v. Kanours*, 1 Wash., 188.—WASHINGTON, J.; Pa., 1804. *Dawson v. Follen*, 2 Wash., 311.—WASHINGTON, J.; Pa., 1808. *Lowell v. Lewis*, 1 Mass., 190.—STORY, J.; Mass., 1817.

2. No person, who is not at once the first as well as the original inventor, by whom the invention has been perfected and put into use, is entitled to a patent. *Reed v. Cutter*, 1 Story, 596, 598.—STORY, J.; Mass., 1841.

3. A subsequent inventor, though an original one, is not entitled to a patent. *Ibid.*, 596-598.

4. The invention must be original with the inventor, and not known to others. The only exception exists in the case of a party obtaining a patent, believing himself to be the original inventor, and his invention is shown to have been *known* in a *foreign* country, but not patented there, or described in any printed publication. *Parker v. Stiles*, 5 McLean, 61.—MCLEAN, J.; Ohio, 1849.

See also DIGEST PAT. CASES, titles INVENTOR, B.; INVENTION, C.

(f) An original application or specification cannot be amended, to conform the specification to the alterations suggested by the Commissioner, except under this section. *Dyson, Ex parte*, MS. (App. Cas.)—DUNLAP, J.; D. C., 1860.

(g) Right of withdrawal extended to foreigners by act of 1837, section 12.

Right of withdrawal, as to applications made after March 2d, 1861, abolished by act of 1861, section 9.

As to the effect of a withdrawal, see DIGEST PAT. CASES, title APPLICATION FOR PATENTS, C.

(h) The renewal oath required by this section, is required only when the applicant persists in his application, after having been informed of the defects of his specification. If the rejection is final, though upon a first examination, no new oath is necessary to enable him to appeal. *Crooker, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

So much of this section as requires the renewal of the oath, repealed by the act of 1863, section 1.

(*) 1. By section 11, of the act of 1839, an appeal was given to the Chief Justice of the Circuit Court of the United States for the District of Columbia; and by section 12 of the same act, the board of examiners was abolished. The right of appeal was afterwards extended, by the act of 1852, section 4, to either of the assistant justices of such court.

2. By the act of 1863, section 3, establishing the Supreme Court of the District of Columbia, and abolishing the Circuit Court, the powers theretofore exercised by the judges of the Circuit Court were conferred upon the justices of the said Supreme Court, severally. Under this act, appeals are now taken to the justices of said Supreme Court.

3. An appeal lies under this section to an applicant, upon the refusal of a patent to him when there is no opposing party. *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

4. There is nothing in the act of 1839 which takes away, or impairs such right. *Ibid.*

5. There is no limitation of time as to an appeal from the decision of the Commissioner of Patents. *Janney, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

As to right of appeal, duties of Commissioner of Patents in cases of, &c., see DIGEST PAT. CASES, title APPEALS, B.

See also notes to section 8 of this act, and notes to section 11 of the act of 1839.

SECTION 8. [Modified by act of 1839, § 6.] *And be it further enacted*, That whenever an application shall be made for a patent which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants, or patentees, as the case may be (a); and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had, to determine which or whether either of the

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applicants is entitled to receive a patent as prayed for. (b) But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings. (c) And whenever the applicant shall request it, the patent shall take date from the time of the filing of the specification and drawings, not however exceeding six months prior to the actual issuing of the patent; and on like request, and the payment of the duty herein required, by any applicant, his specification and drawings shall be filed in the secret archives of the office until he shall furnish the model and the patent be issued, not exceeding the term of one year, the applicant being entitled to notice of interfering applications.

(a) 1. The interference mentioned in this section must be an interference in respect to patentable matters, and the claims of the applicants must be limited to the matters specifically set forth as their respective inventions; and what is not claimed is to be considered, for the purpose of such interference, as disclaimed. A patentable improvement is not an interference. *Bain v. Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

2. There can be no interference between applications, unless there is a substantial identity of the things for which a patent is sought. *Tyson v. Rankin*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

3. An interference may be declared between a pending application and an application for a reissue of an existing patent, but the omission to do so at that time does not take away the right of the Patent Office to declare such an interference subsequently. *Hicks v. Shaver*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

4. The Commissioner has authority to permit one of two competing applicants for a patent for a similar invention to withdraw his application, after decision upon an interference, and refile his application, and to declare a second interference between such last application and the competing one. *Wade v. Matthews*, 5 Opin., 224.—JOHNSON, Atty.-Gen.; 1849.

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5. A second interference is only a rehearing of the same case. *Eames v. Richards*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

6. The proceedings in contested cases in the Patent Office have no resemblance to trials at law. *Spear v. Abbott*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859.

See also DIGEST PAT. CASES, title INTERFERENCE.

(b) 1. The scope of this section is broad enough to include the question of *interference* as well as that of *priority*, if it should arise, on an appeal to the judge. The question of priority necessarily includes that of interference. *Bain v. Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

2. An appeal is given by section 7 to an applicant where there is no opposing party; and by this section where there are interfering applications; and there is nothing in the repealing act of 1839 which takes away or impairs such right. *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

3. Under this section no appeal can be taken from the decision of the Commissioner of Patents, unless the *application* for a patent is rejected. In no case can an appeal be taken to the granting of a patent. *Pomroy v. Connison*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1842.

4. A patentee therefore has no right of appeal from the decision of the Commissioner granting a patent to another person, an applicant, in an interference between such applicant and patentee. *Ibid.*

5. The word "either" in this section—when speaking of the parties who may appeal—applies to the words "such applicants," *i. e.*, *either of such applicants*. This construction is sustained by the language below authorizing the judge, on appeal, "to determine which or whether *either of the applicants* is entitled to receive a patent as prayed for. *Ibid.*

6. This decision was followed in *Whipple v. Renton*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854. *Hopkins v. Barnum*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859. *Kingsley v. Herriet*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854. *Drake v. Cunningham*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

7. In a later case, it was held that a patentee has equal right of appeal from a decision of the Commissioner of Patents in favor of an applicant, and granting him a patent, that an applicant has from a decision in favor of a prior patentee, and refusing the applicant a patent. *Babcock v. Degener*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

8. This decision was followed in *Spear v. Abbott*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859; and *Beech v. Tucker*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

9. The right of appeal is now considered as established in accordance with these later decisions.

10. As to the requisites of the reasons of appeal, and the jurisdiction of the justices of the Circuit Court on appeal, and the effect of their decisions, see notes to section 11 of the act of 1839.

See also DIGEST PAT. CASES, title APPEALS, B.

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(c) 1. By the act of 1839, section 6, the obtaining a foreign patent more than six months prior to his application here will not debar a person from receiving a patent, provided the invention has not been introduced into public and common use in the United States prior to such application.

2. The provisions of this section, and of section 6 of the act of 1839, as to the obtaining of patents after foreign patents have been secured, and as to the date of the home patent in such case, relates only to such patents as are *applied for* here *after* the issue of the foreign patent. *French v. Rogers*, MS.—KANE, J.; Pa., 1851.

SECTION 9. [Amended by act of 1861, § 10.] *And be it further enacted*, That before any application for a patent shall be considered by the Commissioner as aforesaid, the applicant shall pay into the Treasury of the United States, or into the Patent Office, or into any of the deposit banks (a), to the credit of the Treasury, if he be a citizen of the United States, or an alien, and shall have been resident in the United States for one year next preceding, and shall have made oath of his intention to become a citizen thereof, the sum of thirty dollars; if a subject of the king of Great Britain, the sum of five hundred dollars; and all other persons the sum of three hundred dollars (b); for which payment duplicate receipts shall be taken, one of which to be filed in the office of the Treasurer. And the moneys received into the Treasury under this act shall constitute a fund for the payment of the salaries of the officers and clerks herein provided for, and all other expenses of the Patent Office, and to be called the Patent Fund.

(a) Fees may be sent to the Patent Office, or be paid to the Assistant Treasurers of the U. S. at New York City; Boston, Mass.; and St. Louis, Mo.; Treasurers of the Mint, Philadelphia, Pa.; and New Orleans, La.; Surveyor and Inspector of the Customs, Pittsburg, Pa.; Surveyor of the Customs, Cincinnati, O.; Collectors of the Customs at Baltimore, Md.; Buffalo Creek, N. Y.; and San Francisco, Cal.; Receivers of Public Moneys at Jeffersonville, Ind.; Chicago, Ill.; and Detroit, Mich.; and any National Bank which has been designated a depository of public money.

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(b) By a subsequent statute, all laws fixing the rates of the Patent Office fees to be paid, and discriminating between the inhabitants of the United States and those of other countries, which shall not discriminate against the inhabitants of the United States, are repealed, and a uniform rate of fees established for all. Act of 1861, section 10.

SECTION 10. *And be it further enacted,* That where any person hath made, or shall have made, any new invention, discovery, or improvement, on account of which a patent might by virtue of this act be granted, and such person shall die before any patent shall be granted therefor, the right of applying for and obtaining such patent shall devolve on the executor or administrator of such person, in trust for the heirs-at-law of the deceased, in case he shall have died intestate; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations, and restrictions as the same was held, or might have been claimed or enjoyed by such person in his or her lifetime (a); and when application for a patent shall be made by such legal representatives, the oath or affirmation provided in the sixth section of this act shall be so varied as to be applicable to them.

(a) 1. Under this section, if an inventor die before he has obtained a patent for his invention, no person other than his executor or administrator can apply for a patent for such invention, and the patent must be issued to such persons in trust for the heirs-at-law or devisees of the inventor. *Stimpson v. Rogers*, 4 Blatchf.—INGERSOLL, J.; Ct., 1859.

2. It need not, however, be expressed in the patent, that it is issued to such executor *in trust* for those entitled to it. It will be sufficient that the patent set forth that it was issued to the grantee as executor. What the executor does in relation to the property of the devisor, he does in trust for those to whom such property is given by the will. *Ibid.*

SECTION 11. *And be it further enacted,* That every patent shall be assignable in law, either as to the whole

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interest, or any undivided part thereof, by any instrument in writing; which assignment, and also every grant and conveyance of the exclusive right under any patent, to make and use, and to grant to others to make and use (a) the thing patented within and throughout any specified part or portion of the United States, shall be recorded in the Patent Office within three months from the execution thereof (b), for which the assignee or grantee shall pay to the Commissioner the sum of three dollars. (c)

(a) 1. This section provides for but three kinds of assignments: 1st, As to the whole interest; 2d, As to an undivided part; and 3d, An exclusive right in any district. *Blanchard v. Eldridge*, 1 Wall., Jr., 339.—GRIER, J.; Pa., 1849. *Potter v. Holland*, MS.—INGERSOLL, J.; Ct., 1858.

2. The term *exclusive* comprehends not only an exclusive right to the whole patent, but an exclusive right to the patent in a particular section of country. *Washburn v. Gould*, 3 Story, 131.—STORY, J.; Mass., 1841.

3. The monopoly is capable of subdivision as to locality, and in no other way. *Blanchard v. Eldridge*, 1 Wall., Jr., 340.—GRIER, J.; Pa., 1849. *Whittemore v. Cutter*, 1 Gall., 431.—STORY, J.; Mass., 1813. *Brooks v. Byam*, 2 Story, 525, 552.—STORY, J.; Mass., 1843. *Suydam v. Day*, 2 Blatchf., 23.—NELSON, J.; N. Y., 1846. *Ritter v. Serrell*, 2 Blatchf., 383.—BETTS, J.; N. Y., 1852. *Washing Mach. Co. v. Earle*, 3 Wall., Jr.—GRIER, J.; Pa., 1861.

4. An assignment of a patent may be made as well before the issuing of the patent as afterwards. The thing to be assigned is not the mere parchment, but the monopoly conferred—the right of property which it creates. And when the party has acquired an inchoate right, an assignment of it is legal. *Gayler v. Wilder*, 10 How., 493.—TANEY, Ch. J.; Sup. Ct., 1850. *Rathbone v. Orr*, 5 McLean, 131, 132.—MCLEAN, J.; Mich., 1850. *Rich v. Lippincott*, 26 Jour. Fr Inst., 3d Ser., 13.—GRIER, J.; Pa., 1853.

5. Future improvements may be sold, as well as those already made; and to include a second as well as a first patent. *Nesmith v. Calvert*, 1 Wood & Min., 41.—WOODBURY, J., Mass., 1845.

6. The inchoate right of an inventor to a renewal is the subject of sale. *Clum v. Brewer*, 2 Curt., 520.—CURTIS, J.; Mass., 1855.

7. One tenant in common has as good right to use and sell to others to use the thing patented, as the other tenant in common has; and neither can restrain the other from such use or sale. *Ibid.*, 524.

8. A paper purporting to be an assignment of an expired patent is void. *Bell v. McCulloch*, MS.—LEAVITT, J.; Ohio, 1858.

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(b) 1. The provision as to recording assignments within three months is merely directory, and except as to intermediate *bona fide* purchasers, without notice, any subsequent recording is sufficient. *Brooks v. Byam*, 2 Story, 542.—STORY, J.; Mass., 1843. *Pitts v. Whitman*, 2 Story, 615.—STORY, J.; Mass., 1843. *Blanch. Gun-Stock Fac. v. Warner*, 1 Blatchf., 271.—NELSON, J.; Ct., 1:46. *Holden v. Curtis*, 2 N. Hamp., 63.—WOODBURY, J.; N. H., 1819.

2. A mere license need not be recorded—it is not an exclusive right. *Brooks v. Byam*, 2 Story, 542, 543.—STORY, J.; Mass., 1843. *Stevens v. Head*, 9 Verm., 177.—WILLIAMS, Ch. J.; Vt., 1837.

3 Under this section an assignment must be recorded within three months to defeat the right of a subsequent purchaser without notice, and for a valuable consideration. In order to guard against an outstanding title of over three months' duration, the purchaser need only look to the records of the Patent Office. Within that period he must protect himself in the best way he can, as an unrecorded assignment would prevail; but it must be one in writing, that may be recorded. *Gibson v. Cook*, 2 Blatchf., 148.—NELSON, J.; N. Y., 1850.

See also DIGEST PAT. CASES, titles ASSIGNMENT, B. 2; LICENSE, B.

(c) For existing fees for recording assignments, see act of 1861, section 10.

SECTION 12. [Amended by act of 1861, §§ 9, 10.] *And be it further enacted*, That any citizen of the United States, or alien, who shall have been a resident of the United States one year next preceding, and shall have made oath of his intention to become a citizen thereof, who shall have invented any new art, machine, or improvement thereof, and shall desire further time to mature the same, may, on paying to the credit of the Treasury, in manner as provided in the ninth section of this act, the sum of twenty dollars (a), file in the Patent Office a caveat, setting forth the design and purpose thereof, and its principal and distinguishing characteristics, and praying protection of his right till he shall have matured his invention; which sum of twenty dollars, in case the person filing such caveat shall afterwards take out a patent for the invention therein mentioned, shall be considered a part of the sum herein required for the same.

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And such caveat shall be filed in the confidential archives of the office, and preserved in secrecy. And if application shall be made by any other person within one year from the time of filing such caveat, for a patent of any invention with which it may in any respect interfere, it shall be duty of the Commissioner to deposit the description, specifications, drawings, and model, in the confidential archives of the office, and to give notice, by mail, to the person filing the caveat, of such application (b), who shall, within three months after receiving the notice, if he would avail himself of the benefit of his caveat, file his description, specifications, drawings, and model; and if, in the opinion of the Commissioner, the specifications of claim interfere with each other, like proceedings may be had in all respects as are in this act provided in the case of interfering applications: *Provided, however,* That no opinion or decision of any board of examiners, under the provisions of this act, shall preclude any person interested in favor of or against the validity of any patent which has been or may hereafter be granted, from the right to contest the same in any judicial court in any action in which its validity may come in question.

(a) 1. The fee required on filing a caveat is now reduced to ten dollars, and such sum is no longer to be considered as a part of the sum required to be paid on filing a subsequent application for a patent for the same invention. Act of 1861, sections 9, 10.

2. A caveat may be renewed at the end of one year by paying a further fee of ten dollars, and so on from year to year.

(b) 1. This section is for the benefit of the inventor, but is not necessary for the preservation of his right, nor does the omission to file a caveat impair his title. *Hildreath v. Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. It only enables him to have notice of any interfering application. It, however, gives no notice to the world, nor even to the interfering applicant, and is notice to the Commissioner only. *Ibid.*

3. The caveat is to set forth the "design and purpose" of the inven-

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tion, and "its principal and distinguishing characteristics;" but it is not necessary that it should explain the principle involved, or the modes in which it can be applied, nor how it is distinguished from other inventions. *Anon.*, MS., Opin.—BLACK, Atty.-Gen.; 1857.

4. The Commissioner can perform no act upon it, but filing it, nor in consequence of it, except to give the caveator notice of a conflicting application. *Ibid.*

5. A caveat answers a double purpose: 1st, to give notice of the claim of the inventor; and 2d, to prevent a patent issuing to another for the same thing. *Allen v. Hunter*, 6 McLean, 304.—MCLEAN, J.; Ohio, 1855.

6. A caveat is evidence as to an invention, so far as it extends to the *description* of the invention and the machinery which was then constructed. *Jones v. Wetherell*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

7. A caveat is not conclusive evidence that an invention is not perfected. *Johnson v. Root*, MS.—SPRAGUE, J.; Mass., 1858.

8. The fact that a patent is granted to one person, while another has a caveat pending and in force, will not of itself vacate the patent granted, nor authorize the Commissioner to grant a patent to the caveator. *Cochrane v. Waterman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1844.

9. The purpose of a caveat is to save the discoverer of an invention from the effect of the rule of law that gives to the inventor who first adapts his invention to practical use the right to the grant of a patent; and if the Commissioner gives the caveator notice of any interfering application, it secures him against the effect of the rule. *Phelps, Dodge & Co. v. Brown Bros.*, 18 How. Pr., 9.—NELSON, J.; N. Y., 1859.

10. But if the Commissioner accidentally omits to give the caveator the notice required, his rights will not be prejudiced thereby. *Ibid.*, 9. See also DIGEST PAT. CASES, title CAVEAT.

SECTION 13. [Amended by act of 1837, §§ 5-8; Repealed in part by act of 1861, § 9.] *And be it further enacted*, That whenever any patent which has heretofore been granted, or which shall hereafter be granted, shall be inoperative, or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification as his own invention, more than he had or shall have a right to claim as new; if the error has, or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or

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deceptive intention, it shall be lawful for the Commissioner, upon the surrender to him of such patent, and the payment of the further duty of fifteen dollars, to cause a new patent to be issued to the said inventor, for the same invention, for the residue of the period then unexpired for which the original patent was granted, in accordance with the patentee's corrected description and specification. (a) And in case of his death, or any assignment by him made of the original patent, a similar right shall vest in his executors, administrators, or assignees. (b) And the patent, so reissued, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all actions hereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form, before the issuing out of the original patent. (c) And whenever the original patentee shall be desirous of adding the description and specification of any new improvement of the original invention or discovery which shall have been invented or discovered by him subsequent to the date of his patent, he may, like proceedings being had in all respects as in the case of original applications, and on the payment of fifteen dollars, as hereinbefore provided, have the same annexed to the original description and specification; and the Commissioner shall certify, on the margin of such annexed description and specification, the time of its being annexed and recorded; and the same shall hereafter have the same effect in law, to all intents and purposes, as though it had been embraced in the original description and specification. (d)

(a) 1. This section contemplates two classes of cases, where a patent is *invalid or inoperative*; 1st, by reason of a defective or insufficient

specification; and 2d, where the same objection arises because the patentee has claimed more than he had a right to claim. *Goodyear v. Day*, MS.—DICKERSON, J.; N. J., 1852.

2. This section may be regarded as affirming the propriety of the usage which had obtained under the former laws, and under which a second reissue was allowed as well as the first. *French v. Rogers*, MS.—KANE, J.; Pa., 1851.

3. There may be more than one reissue of the same patent. The surrender and reissue should be allowed to follow each other as often as the inventor is content to be more specific or more modest in his claims. *Ibid.* Also *Ball, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

4. The power to correct mistakes in a patent is confided to the Commissioner of Patents under this section, and does not belong to the courts. The courts can only construe the specification and claim as it stands. *Kittle v. Merriam*, 2 Curt., 478.—CURTIS, J.; Mass., 1855.

5. This section gives to the patentee the right to correct his description or specification, when its imperfection has arisen from inadvertency, accident, or mistake. But the only condition on which this can be done, is that the original patent is *inoperative* or invalid by reason of a failure to comply with the requirements of the statutes. The proceeding is therefore equivalent to a distinct admission, made in the most solemn form, that the patent has no validity in the sense of entitling a patentee to an action for its infringement. *Morfill v. Gaab*, MS.—LEAVITT, J.; Ohio, 1860.

6. The words in this section, "it shall be *lawful* for the Commissioner, &c., to cause a new patent to be issued," are to be construed as *mandatory*, and to be of the same import as if the words had been, "it shall be the *duty* of the Commissioner," &c. The true meaning is, the Commissioner is to have no discretion in the case provided for in the section. *Dyson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

7. When the case provided for arises, he is *commanded* to exercise the power, whether he thinks it just and right to exercise it or not; he has no discretion. *Ibid.*

8. The surrender and reissue of a patent extended by act of Congress, after an extension, under section 18 of the act of 1836, stands on the same footing as if such surrender and reissue were made under the extension by virtue of said section 18. *Gibson v. Harris*, 1 Blatchf., 169, 170.—NELSON, J.; N. Y., 1846.

9. It is not the meaning of this section that the patentee, in his reissue, must describe and claim in his new specification, either in words or idea, just what he described and claimed in his old one; but his specification must be of the same invention, and he cannot embrace a different subject-matter than that he sought to patent originally. *French v. Rogers*, MS.—KANE, J.; Pa., 1851. *Baltin v. Taggart*, 17 How., 83.—MCLEAN, J.; Sup. Ct., 1854.

10. Upon an application for a reissue, the applicant is not necessarily

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confined to the original *record, i. e.*, the patent and specification. but the original model may be referred to as evidence of the then invention. *Wilson v. Singer*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860. *Ball, Ex parte*, MS. (App. Cas.), and *Dietz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

11. Fee on reissue now thirty dollars. Act of 1861, § 10.

See also DIGEST PAT. CASES, title REISSUE OF PATENT, B., C.

(b) 1. Under this section the power to surrender a patent and take out a renewal thereof, is vested exclusively in the patentee, his executors, administrators, or assigns, and there is nothing restricting such right because of special or limited grants of licenses previously made. *Smith v. Mercer*, 4 West. Law Jour., 52.—KANE, J.; Pa., 1846.

2. By this section the sole right to surrender is given, 1st, to the patentee, if he is alive and has made no assignment of the original patent; 2, to the executors and administrators of the patentee, after his decease, where there has been no such assignment; and 3d, to the assignee, where there has been an assignment of the original patent. The right to surrender is given to no one else. *Potter v. Holland*, MS.—INGERSOLL, J.; Ct., 1858.

3. Where, however, there has been an assignment of an undivided part of the whole patent, in such case the assignee and patentee become joint owners, and should join in the surrender; and if they do not it will be invalid, unless the part owner not joining shall ratify it. *Ibid.*

4. A licensee has no authority to make a surrender, and one made without his consent is valid. But such a licensee may hold under the original or the reissued patent, as he prefers. *Ibid.*

5. There may be a claim of right in an invention, under one or the old patent, for one section of the country, and a different claim of right, under the reissued patent, for the same invention, for another section of country. *Ibid.*

See also DIGEST PAT. CASES, title REISSUE OF PATENT, A.

(c) 1. Under this section the second patent, with corrected specifications, has relation back to the emanation of the first patent, as fully for every legal purpose as to causes subsequently accruing, as if the second patent had been issued at the date of the first one. *Stanley v. Whipple*, 2 McLean, 37.—MCLEAN, J.; Ohio, 1839.

2. A reissued patent is only a continuation of the original one. *Ames v. Howard*, 1 Sumn., 488.—STORY, J.; Mass., 1833. *Stanley v. Whipple*, 2 McLean, 37.—MCLEAN, J.; Ohio, 1839. *Woodworth v. Hall*, 1 Wood. & Min., 257.—WOODBURY, J.; Mass., 1846.

3. The rights of the patentee are to be ascertained by the law under which the original application was made. *Shaw v. Cooper*, 7 Pet., 315.—MCLEAN, J.; Sup. Ct., 1833.

4. A patentee cannot by a surrender affect the rights of third persons to whom he had previously conveyed an interest. *Woodworth v. Stone*, 3 Story, 750.—STORY, J.; Mass., 1815. *McBurney v. Goodyear*, 11 Cush., 370.—MERRICK, J.; Mass., 1853.

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5. The grant of an amended patent is conclusive as to the existence of the facts necessary for a reissue; unless it is patent there is a clear excess of authority, or there has been fraud. *Allen v. Blunt*, 3 Story, 745.—STORY, J.; Mass., 1845. *S. C.*, 2 Wood. & Min., 139.—WOODBURY, J.; Mass., 1846. *Baltin v. Taggart*, 17 How., 84.—MCLEAN, J.; Sup. Ct., 1854.

(d) 1. Under this section an improvement may be annexed to the specification of the original patent, so as to make it form a part of the original patent; but there is nothing that forbids an inventor taking out a new patent for the improvement, if he prefers it. *O'Reilly v. Morse*, 15 How., 122.—TANEY, Ch. J.; Sup. Ct., 1853.

2. Nor is he bound in his new patent to refer specially to his former one. *Ibid.*, 122.

3. The provision of this section authorizing additions to patents for improvements, is now repealed, and patents of additions are no more granted. Act of 1861, § 9.

SECTION 14. *And be it further enacted*, That whenever, in any action for damages for making, using, or selling (a) the thing whereof the exclusive right is secured by any patent heretofore granted, or by any patent which may hereafter be granted, a verdict shall be rendered for the plaintiff in such action, it shall be in the power of the court to render judgment for any sum above the amount found by such verdict as the actual damages sustained by the plaintiff, not exceeding three times the amount thereof (b), according to the circumstances of the case, with costs; and such damages may be recovered by action on the case, in any court of competent jurisdiction, to be brought in the name or names of the person or persons interested, whether as patentees, assignees, or as grantees of the exclusive right within and throughout a specified part of the United States. (c)

(a) The sale, under execution, of the *materials* of patented articles is not such a sale as makes the sheriff liable to an infringement. *Savin v. Guild*, 1 Gall., 487.—STORY, J.; Mass., 1813.

(b) 1. The patent act of 1790, section 4, made the infringer liable to pay such damages as the jury should find, and also forfeit the machine. The act of 1793, section 5, declared that an infringer should pay a sum

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equal to three times the price for which the patentee had sold licenses. The act of 1800 provided that an infringer should pay three times the actual damages sustained. *Seymour v. McCormick*, 16 How., 488.—GRIER, J.; Sup. Ct., 1853.

2. This section confines the jury to the actual damages sustained by the patentee. The power to increase them as punitive damages is committed to the discretion and judgment of the court. *Ibid.*, 488.

3. *Actual damages*, according to this section, are the amount fixed by the verdict. *Stephens v. Feit*, 2 Blatchf., 38.—BETTS, J.; N. Y., 1846.

4. But such term cannot be construed to mean exemplary, vindictive, or punitive damages, inflicted by way of smart money. *Stimpson v. Railroads*, 1 Wall., Jr., 169.—GRIER, J.; Pa., 1847. *Luck v. Hermance*, 1 Blatchf., 406.—NELSON, J.; N. Y., 1849. *Pitts v. Hall*, 2 Blatchf., 238.—NELSON, J.; N. Y., 1851.

5. Damages are only to be compensatory: the criterion is indemnity. *Parker v. Hulme*, 7 West. Law Jour., 428.—KANE, J.; Pa., 1849.

6. Damages cannot include counsel fees, in addition to the taxable costs. *Stimpson v. Railroads*, 1 Wall., Jr., 166, 169.—GRIER, J.; Pa., 1847. *Blanch. Gun-Stock Fac. v. Warner*, 1 Blatchf., 272.—NELSON, J.; Ct., 1846. *Parker v. Hulme*, 7 West. Law Jour., 429.—KANE, J.; Pa., 1849. *Teese v. Huntington*, 23 How., 8.—CLIFFORD, J.; Sup. Ct., 1859.

7. It rests with the discretion of the court whether the damages shall be trebled. Previous to 1836, the court was compelled to treble them. *Guyon v. Serrell*, 1 Blatchf., 245.—NELSON, J.; N. Y., 1847. *Stimpson v. Railroads*, 1 Wall., Jr., 166.—GRIER, J.; Pa., 1847.

8. The court may increase the damages though the plaintiff is not entitled to costs, for neglect of filing a disclaimer, as required by section 9 of the act of 1837. *Guyon v. Serrell*, 1 Blatchf., 246.—NELSON, J.; N. Y., 1847.

9. The object of this section, as to trebling damages, is to remunerate patentees, who were compelled to sustain their patents against wanton and persistent infringers. *Seymour v. McCormick*, 16 How., 488.—GRIER, J.; Sup. Ct., 1853. *Bell v. McCulloch*, MS.—LEAVITT, J.; Ohio, 1858.

See also DIGEST PAT. CASES, titles DAMAGES; INFRINGEMENT.

(c) 1. The word "assignees" in this section, is to be construed by reference to section 11, of the same act, as meaning the assignees of a whole interest, or an undivided one, or an exclusive local right. *Blanchard v. Edridge*, 1 Wall., Jr., 340.—GRIER, J.; Pa., 1849. *Suydam v. Day*, 2 Blatchf., 23.—NELSON, BETTS, JJ.; N. Y., 1846.

2. To enable an assignee to sue in his own name, he must have the exclusive right, or entire, or unqualified monopoly, which the patentee had, excluding the patentee himself as well as others. *Gayler v. Wilder*, 10 How., 493.—TANEY, Ch. J.; Sup. Ct., 1850.

3. The assignees of an exclusive right in a patent, are the proper persons to maintain an action for a violation of it. *Washburn v. Gould*, 3 Story, 131, 167.—STORY, J.; Mass., 1816.

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4. The grantee of an exclusive right under a patent, even though such right is limited to a particular number of machines, may maintain an action for infringement. *Wilson v. Rosseau*, 4 How., 686, 688.—NELSON, J.; Sup. Ct., 1845.

5. Under this section, in connection with section 11, an action is given only to such party—composed of one or more persons—as possesses the whole interest in the patent. *Suydam v. Day*, 2 Blatchf., 23.—NELSON, BETTS, JJ.; N. Y., 1846.

6. Where a party has an interest in only a part of a patent, as a license to use the invention, he cannot maintain an action for an infringement. *Ibid.*, 23.

7. Under this section, an action is properly brought in the name of a patentee, in behalf of a licensee who is damaged by an infringement. *Goodyear v. McBurney*, 3 Blatchf., 33.—NELSON, J.; N. Y., 1853.

SECTION 15. [Enlarged by act of 1837, § 9; and by act of 1839, § 7.] *And be it further enacted*, That the defendant in any such action shall be permitted to plead the general issue, and to give this act and any special matter in evidence (a), of which notice in writing may have been given to the plaintiff or his attorney, thirty days before trial (b), tending to prove that the description and specification filed by the plaintiff does not contain the whole truth relative to his invention or discovery, or that it contains more than is necessary to produce the described effect; which concealment or addition shall fully appear to have been made for the purpose of deceiving the public (c), or that the patentee was not the original and first inventor or discoverer of the thing patented, or of a substantial and material part thereof claimed as new (d), or that it had been described in some public work anterior to the supposed discovery thereof by the patentee (e), or had been in public use or on sale with the consent and allowance of the patentee before his application for a patent (f), or that he had surreptitiously or unjustly obtained the patent for that which was in fact invented or discovered by another, who was

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using reasonable diligence in adapting and perfecting the same (*g*); or that the patentee, if an alien at the time the patent was granted, had failed and neglected for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reasonable terms, the invention or discovery for which the patent issued (*h*); in either of which cases judgment shall be rendered for the defendant with costs. And whenever the defendant relies in his defence on the fact of a previous invention, knowledge, or use of the thing patented, he shall state, in his notice of special matter the names and places of residence of those whom he intends to prove to have possessed a prior knowledge of the thing, and where the same had been used (*i*): *Provided, however,* That whenever it shall satisfactorily appear that the patentee, at the time of making his application for the patent, believed himself to be the 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 before known or used in any foreign country, it not appearing that the same or any substantial part thereof had before been patented or described in any printed publication. (*j*) *And provided, also,* That whenever the plaintiff shall fail to sustain his action on the ground that in his specification of claim is embraced more than that of which he was the first inventor, if it shall appear that the defendant had used or violated any part of the invention justly and truly specified and claimed as new, it shall be in the power of the court, to adjudge and award as to costs as may appear to be just and equitable. (*k*)

(a) 1. The right to plead the general issue and give notice, is an en-

largement of the defendant's mode of defence, but does not take away his right to plead specially. *Phillips v. Combstock*, 4 McLean, 525.—MCLEAN, J.; Ind., 1849.

2. The defendant need not plead the general issue, and give notice of the special matter. He may plead specially, and then the plea is the only notice. *Evans v. Euton*, 3 Wheat., 504.—MARSHALL, Ch. J.; Sup. Ct., 1818. *Grant v. Raymond*, 6 Pet., 247.—MARSHALL, Ch. J.; Sup. Ct., 1832. *Phillips v. Combstock*, 4 McLean, 525.—MCLEAN, J.; Ind., 1849. *Smith v. Ely*, 15 How., 141.—TANEY, Ch. J.; Sup. Ct., 1853. *Day v. N. E. Car-Spring Co.*, 4 Blatchf., 181.—BETTS, J.; N. Y., 1854.

3. But where notice of special matter is given under the general issue, special pleas containing the same matters cannot be filed. *Wilder v. Gayler*, 1 Blatchf., 597.—NELSON, J.; N. Y., 1850. *Brunswick v. Holzalb*, MS.—LEAVITT, J.; Ohio, 1858.

(b) 1. No order of court is necessary to entitle a defendant to file and serve notice of special matter. It is only necessary that it be in writing and be served thirty days before the trial. *Teese v. Huntington*, 23 How., 10.—CLIFFORD, J.; Sup. Ct., 1859.

2. If a first notice is defective or not sufficiently comprehensive, other notices may be given to remedy the defect or supply the deficiency. *Ibid.*, 10.

3. Under such notice, depositions taken before it was served, as well as those taken afterwards, are admissible. *Ibid.*, 10.

4. Notices may be served in term time, but must be thirty days before trial. *Latta v. Hawk*, MS.—LEAVITT, J.; Ohio, 1859.

5. Such notices cannot, however, be filed and served in suits in equity. *Doughty v. West*, MS.—NELSON, SHIPMAN, JJ.; N. Y., 1865.

(c) 1. It is a question for the jury whether the specification contains the whole truth relative to the discovery; and, if not, whether it has been concealed with a view to deceive. *Reutgen v. Kanows*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

2. A defect or concealment is not fatal, unless made with an intention to deceive. *Whittemore v. Cutter*, 1 Gall., 437.—STORY, J.; Mass., 1813. *Gray v. James*, Pet. O. C., 409.—WASHINGTON, J.; Pa., 1817. *Lowell v. Lewis*, 1 Mass., 188, 189.—STORY, J.; Mass., 1817.

3. The question as to the materiality of the thing concealed is, could an artist, after the expiration of the patent, construct a machine by looking at the specification. *Reutgen v. Kanows*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

(d) 1. The defence "that the patentee was not the original and first inventor or discoverer of the thing patented," is complete without showing that the first inventor had put his invention in practice. *Hildreath v. Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. No person who is not at once the first and original inventor, is entitled to a patent. A subsequent inventor, though an original one, is not. *Reed v. Cutter*, 1 Story, 596.—STORY, J.; Mass., 1841.

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(c) 1. The description in a public work must be sufficiently full and precise to enable a mechanic to construct the machine, and must be in all material respects like that covered by the plaintiff's patent. *Parker v. Stiles*, 5 McLean, 61.—MCLEAN, J.; Ohio, 1849.

2. The publication may be proved as to its contents, and the fact of publication by the production of the book, or by parol testimony. *Allen v. Hunter*, 6 McLean, 314.—MCLEAN, J.; Ohio, 1855.

3. The publication must have been prior to the *time of invention*. It is not sufficient that it was prior to the time of *application* for a patent. *Bartholomew v. Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859. *Allen v. Hunter*, 6 McLean, 314.—MCLEAN, J.; Ohio, 1855.

4. To render admissible in evidence a printed publication it is not necessary to make proof of the date of its publication. A book purporting on its title-page to be published in a certain year will be received without proof that it was then published. *Judson v. Cope*, MS.—LEAVITT, J.; Ohio, 1860.

5. A book of plates without any letter-press cannot be admitted in evidence. *Semble*, that it is not a "printed publication." *Ibid.*

6. Where reference is made to a public work, it should be to the particular part of the work intended to be relied upon. A reference merely to the title of the work is not sufficient. *Foote v. Silsby*, 1 Blatchf., 454, 462.—CONKLING, NELSON, JJ.; N. Y., 1849. *Silsby v. Foote*, 14 How., 222.—CURTIS, J.; Sup. Ct., 1852.

See also DIGEST PAT. CASES, title PUBLIC WORK.

(f) 1. The public use or sale, to defeat the inventor of a right to a patent, must be a public use or sale by others with his knowledge and consent before his application for a patent. *Ryan v. Goodwin*, 3 Sumn., 518.—STORY, J.; Mass., 1839. *Wyeth v. Stone*, 1 Story, 281.—STORY, J.; Mass., 1840. *Gayler v. Wilder*, 10 How., 496, 498.—TANEY, Ch. J.; Sup. Ct., 1850. *Pitts v. Hall*, 2 Blatchf., 235, 236.—NELSON, J.; N. Y., 1851. *Hunt v. Howe*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

2. A use without the inventor's knowledge or consent, or experimental to ascertain its value, utility, or success, or a use intermediate the application and grant, will not be sufficient. *Ryan v. Goodwin*, 3 Sumn., 518.—STORY, J.; Mass., 1839. *Wyeth v. Stone*, 1 Story, 281.—STORY, J.; Mass., 1840. *Pierson v. Eagle Screw Co.*, 3 Story, 407.—STORY, J.; R. I., 1844. *Winans v. N. Y. & Har. R. R.*, 31 Jour. Fr. Inst., 3d Ser., 322.—NELSON, J.; N. Y., 1855.

3. The right to use and sell an invention for two years previous to the application is now conferred by act of 1839, section 7.

See also DIGEST PAT. CASES, titles ABANDONMENT, A.; PUBLIC USE.

(g) 1. An inventor who has first actually perfected his invention will not be deemed to have surreptitiously or unjustly obtained a patent for that which was in fact first invented by another, unless the latter was at the time using due diligence in adapting and perfecting his invention. *Reed v. Cutter*, 1 Story, 599.—STORY, J.; Mass., 1841.

2. But the first inventor has the prior right if he is using due dili-

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gence, even though another may have first perfected the invention. *Ibid.*, 600.

3. The clause using "reasonable diligence in adapting and perfecting" an invention is applicable only to the case of a defence that the plaintiff's patent had been surreptitiously or unjustly obtained; and if pleaded, it may be necessary for the defendant to show, in order to vacate the patent, that he was using due diligence when the patent was obtained. *Perry v. Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

4. The words "unless such person was using reasonable diligence in adapting and perfecting the same," constitute a *qualification* of the preceding language of the section, so that an inventor who has actually perfected his invention will not be deemed to have surreptitiously or unjustly obtained a patent for that which was *in fact invented* by another, *unless the latter* was at the time *using reasonable diligence* in adapting and perfecting the same. *Marshall v. Mee*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1853.

5. The defence that the patentee had "surreptitiously and unjustly obtained a patent for that which was in fact invented or discovered by another, who was using reasonable diligence in perfecting and adapting the same," does not necessarily imply bad faith on the part of the patentee against whose patent this defence is set up. The words were intended to be used, and are used, in their broadest sense. *Phelps, Dodge & Co., v. Brown Bros.*, 18 How. Pr.—NELSON, J.; N. Y., 1859.

6. If a person does not use due diligence in perfecting his invention after he has conceived the idea, and another conceives the idea and perfects it, and applies it to use, the latter will be considered the first inventor, and a patent granted the former will be void. *Ransom v. Mayor, &c., of New York*, MS.—HALL, J.; N. Y., 1856.

(h) 1. An alien patentee must put and continue on sale his invention within eighteen months from the date of his patent. *Hildreath v. Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. The assignees of an alien patentee take their patent with all the privileges of American citizens. The alien clause in this section does not apply to such assignees. *Tatham v. Lowber*, 2 Blatchf., 50, 51.—NELSON, J.; N. Y., 1847.

3. But it is not necessary that an alien patentee, or his assignee, should take active measures for putting his patented invention in the market, and forcing a sale, but only that he should at all times be ready to sell at a fair price when a reasonable offer is made. *Ibid.*, 51. *Tatham v. Le Roy*, MS.—NELSON, J.; N. Y., 1849.

(i) 1. The provision in this section, requiring notice of prior knowledge and use, was intended to guard against surprise from such evidence as was given in Whitney's case. Though his invention was one of undoubted originality, two persons were brought forward, one of whom testified that he had seen such an invention in England seven-

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teen years before, and the other that he had seen one in Ireland. *Willon v. Railroads*, 1 Wall., Jr., 195.—GRIER, J.; Pa., 1847.

2. The provision of the statute requiring notice of the previous use, is designed to give the patentee the benefit of examining into the facts of the supposed prior use. *Coleman v. Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

3. This section requires only the names and residences of the persons who possessed the prior knowledge, and of the places where the invention had been used. The names and residences of the witnesses need not be given. *Willon v. Railroads*, 1 Wall., Jr., 195.—GRIER, J.; Pa., 1847. *Many v. Jagger*, 1 Blatchf., 376.—NELSON, J.; N. Y., 1848.

4. Notice of the *time* of the prior knowledge or use is not required. *Phillips v. Page*, 24 How., 168.—NELSON, J.; Sup. Ct., 1860.

5. In the seventh circuit, the notice must specify the street or factory where the prior structure was used, or the name of the person or owner using it. The name of the city, or town, or county, is not sufficiently definite as to place. *Latta v. Shawk*, MS.—LEAVITT, J.; Ohio, 1859. *Coleman v. Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

6. And also, the name of the person by whom the prior knowledge is to be proved. *Judson v. Cope*, MS.—LEAVITT, J.; Ohio, 1860.

See also DIGEST PAT. CASES, title GENERAL ISSUE, B.

(j) 1. The provision of section 7 and of this section introduced an important modification into the laws of patents, designed to protect the American inventor against the injustice of being thrown out of the fruits of his ingenuity by the existence of a secret invention or discovery abroad, that is a discovery not patented, and not described in any printed publication. *Anon.*, 5 Opin., 21.—TOUCEY, Atty.-Gen., 1848.

2. The only exception to the rule that a patentee must be the original and first inventor, exists in the case of a party obtaining a patent, believing himself to be the original inventor, and his invention is shown to have been *known in a foreign country*, but not patented there, or described in a printed publication. *Parker v. Stiles*, 5 McLean, 61.—MCLEAN, J.; Ohio, 1849.

3. In determining whether the patentee *believed* himself to be the first inventor, the defendant may give evidence that the patentee knew of the existence of the thing abroad; and in considering the fact whether he so *believed* himself to be the first inventor, it is material to determine whether he was in fact the original inventor. *Forbush v. Cook*, 10 Mo. Law Rep., 664.—CURTIS, J.; Mass., 1857.

4. A prior use of a thing in a foreign country will not invalidate a patent subsequently taken out here, where the inventor believed himself to be the first inventor, unless the prior invention had been patented, or described in some printed publication. *Coleman v. Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

5. Evidence cannot be received of an actual use and knowledge of an invention in a foreign country, prior to the time of the invention

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here, but the defendants must be confined to the description of the invention as found in printed publications or patents; they cannot go beyond such publications or patents. *Judson v. Cope*, MS.—LEAVITT, J.; Ohio, 1860.

6. The time referred to in this section by the terms "having been before known and used in any foreign country," or "had been patented or described in a printed publication," is the time when the original discovery or invention of a patentee was made, and not the time when he presented his application for a patent. *Bartholomew v. Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

7. A foreign patent, in order to defeat an American patent for the same invention, must have been before the discovery or invention here; it is not sufficient that it is before the application. *Howe v. Morton*, MS.—SPRAGUE, J.; Mass., 1860.

8. An invention is not "patented" in England within the meaning of this section, until the complete specification has been enrolled—until the invention shall have been made patent to the world, which is usually six months after the date of the patent. *Ibid.*

(*b*) The second proviso of this section virtually superseded by the act of 1837, section 9.

SECTION 16. [Enlarged by act of 1839, § 10.] *And be it further enacted*, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners (*a*), on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise (*b*), in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive

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a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. (c) And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided, however,* That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment.

(a) Of the justices of the Supreme Court of the District of Columbia, appeals now lying to them under section 3 of the act of 1863, establishing that court. Previous to that act appeals lay, by the act of 1839, section 11, to the chief-justice, and, by the act of 1852, section 1, to the assistant justices of the Circuit Court of the District of Columbia.

(b) The provisions of this section are now extended "to all cases where patents are refused for any reason whatever." Act of 1839, section 10.

(c) 1. Proceedings, under this section and section 10 of the act of 1839, in equity, against the Commissioner of Patents, to compel him to issue a patent, must be commenced in the Circuit Court of the United States for the District of Columbia, and the Circuit Courts in the various States have no jurisdiction. *Prentiss v. Ellsworth*, Mir. Pat. Off., 35, 36.—RANDALL, J.; Pa., 1846.

2. Upon a bill filed under this section and section 10 of the act of 1839, to declare a patent granted by the Commissioner invalid or inoperative, the hearing is altogether independent of that before the Commissioner, and takes place upon such testimony as the parties may see fit to produce, agreeably to the rules and practice of a court of equity. The evidence before the Commissioner is not evidence in such a suit except by consent of parties; nor are the parties restricted to the testimony used before the Commissioner. Either party is at liberty to introduce additional evidence. *Atkinson v. Boardman*, MS.—NELSON, J.; N. Y., 1851.

3. The assignee of an invention, by virtue of an assignment made before patent issued, may file a bill in his own name under this section and section 10 of the act of 1839, against a patentee to whom a patent issued on the rejection of his assignor's application, for the purpose of annulling the patent so issued, and having one granted to him as assignee. And such assignment need not have been recorded before

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suit brought; it will be sufficient if it is recorded at any time before the issuing of the patent. *Gay v. Cornell*, 1 Blatchf., 509, 510.—NELSON, J.; N. Y., 1849.

4. The Circuit Courts of the United States have exclusive jurisdiction under this section. *Gibson v. Woodworth*, 8 Paige, 134.—WALWORTH, Chan.; N. Y., 1840.

SECTION 17. [Enlarged by act of 1861, chap. 37.] *And be it further enacted*, That all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions or discoveries, shall be originally cognizable, as well in equity as at law, by the Circuit Courts of the United States, or any District Court having the power and jurisdiction of a Circuit Court; which courts shall have power, upon a bill in equity filed by any party aggrieved, in any such case, to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any inventor as secured to him by any law of the United States, on such terms and conditions as said courts may deem reasonable (a): *Provided, however*, That from all judgments and decrees from any such court rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of Circuit Courts, and in all other cases in which the court shall deem it reasonable to allow the same. (b)

(a) 1. Under this section the Circuit Courts of the United States have not only original, but exclusive cognizance of all actions arising under the patent laws. *Dudley v. Mayhew*, 3 Comst., 14.—STRONG, J.; N. Y., 1849. *Elmer v. Pennel*, 40 Maine, 434.—RICE, J.; Me., 1855. *Parsons v. Barnard*, 7 John., 144.—CURIAM; N. Y., 1810.

2. The jurisdiction conferred upon the Circuit Courts by this section is the same in its nature and extent as the equity jurisdiction in Eng-

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land, from which it is derived. *Allen v. Blunt*, 1 Blatchf., 486.—NELSON, J.; N. Y., 1849.

3. Under this section the Circuit Courts have jurisdiction irrespective of the right of the plaintiff to an injunction or a demand for one. *Nevins v. Johnson*, 3 Blatchf., 33.—NELSON, BETTS, JJ.; N. Y., 1853.

4. The natural interpretation of the language of this section seems to be, that Congress has betowed upon this court a common jurisdiction, both on its law and equity sides, over all cases under the patent laws, and that no suit of that character can be maintained at law which may not also be prosecuted in equity. *Ibid.*, 83.

5. In cases arising under the patent law, the jurisdiction of the Circuit Courts does not depend upon the citizenship of the parties to the action, or the amount in controversy, but upon the subject-matter. *Allen v. Blunt*, 1 Blatchf., 486.—NELSON, J.; N. Y., 1849. *Goodyear v. Union Rub Co.*, MS.—INGERSOLL, J.; N. Y., 1857.

6. The jurisdiction as to subject-matter does not extend to a bill in equity filed for the specific performance of a contract respecting patents. *Nesmith v. Calvert*, 1 Wood. & Min., 37.—WOODBURY, J.; Mass., 1845. *Brooks v. Stolley*, 3 McLean, 525.—MCLEAN, J.; Ohio, 1845. *Burr v. Gregory*, 2 Paine, 426, 429.—THOMPSON, J.; N. Y., 1828.

7. Nor to a suit brought to enforce the covenants of a license granted under a patent. *Goodyear v. Union Rub. Co.*, MS.—INGERSOLL, J.; N. Y., 1857.

8. Section 11 of the judiciary act of 1789 requiring one of the parties, plaintiff or defendant, to be an inhabitant of the State where the suit is brought, does not apply to actions arising under the patent laws. *Allen v. Blunt*, 1 Blatchf., 486.—NELSON, J.; N. Y., 1849.

9. To give the courts jurisdiction, the party defendant must be an inhabitant of the district in which the suit is brought, or he must be found within it at the time of the service of the original process. The provisions of section 11 of the act of 1789, in this respect, apply to patent actions. *Day v. Newark Ind. Rub. Co.*, 1 Blatchf., 631, 632.—NELSON, J.; N. Y., 1850. *Allen v. Blunt*, 1 Blatchf., 486.—NELSON, J.; N. Y., 1849. *Wilson v. Sherman*, 1 Blatchf., 541.—NELSON, J.; N. Y., 1850. *Brown v. Shannon*, 20 How., 56.—TANEY, Ch. J.; Sup. Ct., 1857. *Chaffee v. Hayward*, 20 How., 215.—CATRON, J.; Sup. Ct., 1857.

See also DIGEST PAT. CASES, title COURTS, B. 2.

(b) 1. Other reasonable cases under this section in which appeals and writs of error may be allowed to the Supreme Court, must be limited to cases which relate to the construction of the patent laws, and such as involve important and not trifling matters connected with those laws, and questions really doubtful. *Allen v. Blunt*, 2 Wood. & Min., 157.—WOODBURY, J.; Mass., 1846. *Sizer v. Munny*, 16 How., 103.—TANEY, Ch. J.; Sup. Ct., 1853.

2. Under this section, if a writ of error is allowed by the court as "reasonable," such writ must bring up the whole case for consideration, and the court below cannot decide as to what particular points

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shall be taken up. *Hogg v. Emerson*, 6 How., 478.—WOODBURY, J.; Sup. Ct., 1847.

3. An appeal or writ of error now lies to the Supreme Court from all judgments and decrees of any Circuit Court rendered in any action arising under the patent laws, without regard to the value or amount in controversy. Act of 1861, chap. 37.

See also DIGEST PAT. CASES, titles APPEALS, A.; WRIT OF ERROR.

SECTION 18. [Amended by act of 1848, § 1; act of 1861, §§ 12, 16.] *And be it further enacted*, That whenever any patentee of an invention or discovery shall desire an extension of his patent beyond the term of its limitation, he may make application therefor, in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof (a); and the Commissioner shall, on the applicant's paying the sum of forty dollars to the credit of the treasury (b), as in the case of an original application for a patent, cause to be published in one or more of the principal newspapers in the city of Washington, and in such other paper or papers as he may deem proper, published in the section of country most interested adversely to the extension of the patent, 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. (c) And the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury, shall constitute a board (d) to hear and decide upon the evidence produced before them both for and against the extension, and shall sit for that purpose at the time and place designated in the published notice thereof. The patentee shall furnish to said board a statement, in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss

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and profit in any manner accruing to him from and by reason of said invention. And if, upon a hearing of the matter, it shall appear to the full and entire satisfaction of said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the Commissioner to renew and extend the patent, by making a certificate thereon of such extension, for the term of seven years from and after the expiration of the first term; which certificate, with a certificate of said board of their judgment and opinion as aforesaid, shall be entered on record in the Patent Office; and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years. (e) And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein (f): *Provided, however,* That no extension of a patent shall be granted after the expiration of the term for which it was originally issued. (g)

(a) 1. In this section the word *patentee* is used as equivalent to *inventor*. *Woodworth v. Sherman*, 3 Story, 176.—STORY, J.; Mass., 1844.

2. This section authorizes the extension of a patent on the application of an administrator. *Nyman's Case*, 3 Opin., 446.—GRUNDY, Atty.-Gen.; 1839. *Van Hook v. Scudder* (cited 3 Story, 132; 3 McLean, 438).—THOMPSON, J.; N. Y., 1843. *Brooks v. Bicknell*, 3 McLean, 258.—MCLEAN, J.; Ohio, 1843. *Brooks v. Bicknell*, 3 McLean, 436.—MCLEAN, J.; Ohio, 1844. *Woodworth v. Sherman*, 3 Story, 172.—STORY, J.; Mass., 1844. *Woodworth v. Wilson*, 4 How., 716.—NELSON, J.; Sup. Ct., 1845.

3. And this, though the patentee during his lifetime had disposed of all his interest in the existing patent, and having at the time of his death no interest in it. *Wilson v. Rosseau*, 4 How., 675, 686, 688.—NELSON, J.; Sup. Ct., 1845.

See also DIGEST PAT. CASES, title EXTENSION OF PATENT, A.

(b) The fee is now fifty dollars on the application for an extension, and fifty dollars when the extension is granted. Act of 1861, § 10.

(c) 1. The notice of application for an extension is intended to protect the public, and give all an opportunity to appear and oppose. *Gale's Case*, 3 Opin., 594.—GILPIN, Atty.-Gen.; 1840.

2. Application must now be made at least ninety days before the expiration of the patent, and the notice must be published at least sixty days before such expiration. Act of 1861, § 12.

(d) Commissioner of Patents substituted for this board by act of 1848, section 1.

(e) 1. The right of renewal is not limited to future patents, but applies to the past. *Woodworth v. Sherman*, 3 Story, 176.—STORY, J.; Mass., 1844. *Wilson v. Turner*, 7 Law Rep., 529.—TANEY, Ch. J.; Md., 1845.

2. This section provides for but one extension. *Gibson v. Cook*, 2 Blatchf., 146.—NELSON, J.; N. Y., 1850.

3. The decision of the Board of Commissioners, under this section, is conclusive within the scope of its authority. *Brooks v. Bicknell*, 3 McLean, 258.—MCLEAN, J.; Ohio, 1843. *Wilson v. Rosseau*, 4 How., 688.—NELSON, J.; Sup. Ct., 1845. *Woodworth v. Stone*, 3 Story, 753.—STORY, J.; Mass., 1845. *Colt v. Young*, 2 Blatchf., 473, 474.—NELSON, J.; N. Y., 1852. *Battin v. Taggart*, 17 How., 84.—MCLEAN, J.; Sup. Ct., 1854. *Clum v. Brewer*, 2 Curt., 518.—CURTIS, J.; Mass., 1855.

4. A renewed patent confers the same rights with an original patent *Evans v. Jordan*, 1 Brock., 254.—MARSHALL, Ch. J.; Va., 1813.

5. After an extension, the original patent becomes one virtually for twenty-one years. *Gibson v. Harris*, 1 Blatchf., 169.—NELSON, J.; N. Y., 1846.

6. If extended again by act of Congress, it becomes one for twenty eight years. *Woodworth v. Edwards*, 3 Wood. & Min., 125.—WOODBURY, J.; Mass., 1847.

7. Patents may also be extended by act of Congress, after having been once extended, under this section. *Evans v. Eaton*, Pet. C. C., 337.—WASHINGTON, J.; Pa., 1816. *Evans v. Eaton*, 3 Wheat., 528.—MARSHALL, Ch. J.; Sup. Ct., 1818. *Blanchard v. Haynes*, 6 West. Law Jour., 83.—WOODBURY, J.; N. H., 1848. *Bloomer v. Stolley*, 5 McLean, 160, 161.—MCLEAN, J.; Ohio, 1850.

See also DIGEST PAT. CASES, title EXTENSION OF PATENT, B., D., E.

(f) 1. The extension of a patent, under this section, does not inure to the benefit of assignees or grantees under the original patent, so as to vest in them any exclusive right. But the benefit of such renewal

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is limited to those who were in the use of the patented article at the time of the renewal, and saves to such persons the right to use the machines held by them at the time of such renewal. *Wilson v. Roseau*, 4 How., 682.—NELSON, J.; Sup. Ct., 1845.

2. The meaning of the words "thing patented," in the latter part of this section, when construed in connection with the simple right to use, without the right to *make* and *vend*, has reference to the machine patented. *Ibid.*, 683.

3. The phrase "to the extent of their interests therein," means their interests in the patented machines, be that interest in one or more at the time of the extension. *Ibid.*, 683.

4. The object of the clause as to assignees, is to preserve any previous contract of assignment in the sense in which both parties understood and intended it at the time it was made, and to secure to the purchaser the right he had intended to buy, and which the patentee intended to sell. *Wilson v. Turner*, 7 Law Rep., 530.—TANEY, Ch. J.; Md., 1845.

5. The words of this section as to assignees and grantees, seem to convey the impression that something more than the mere ownership of existing machines was intended, and that they were intended to embrace all classes of such assignees and grantees, and all inventions, whether of machines, processes, or compositions of matter, and to embrace rights and interests which were different in extent, either of time or territory, or both. *Day v. Union Rub. Co.*, 3 Blatchf., 497.—HALL, J.; N. Y., 1856.

6. But such right is limited to a right to use, although the person holding it may also have held, during the original term, an exclusive right to use, to make, and vend. And such right to use is secured only to the extent of the respective interests of the assignees or grantees therein. *Ibid.*, 502.

See also DIGEST PAT. CASES, title EXTENSION OF PATENT, C.

(g) The extension of all patents, except for designs, granted subsequently to March 2d, 1861, is now prohibited. Act of 1861, § 16.

SECTION 19. *And be it further enacted*, That there shall be provided for the use of said office, a library of scientific works and periodical publications, both foreign and American, calculated to facilitate the discharge of the duties hereby required of the chief officers therein, to be purchased under the direction of the Committee of the Library of Congress. And the sum of fifteen hundred dollars is hereby appropriated for that purpose, to be paid out of the patent fund.

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SECTION 20. *And be it further enacted,* That it shall be the duty of the Commissioner to cause to be classified and arranged, in such rooms or galleries as may be provided for that purpose, in suitable cases, when necessary for their preservation, and in such manner as shall be conducive to a beneficial and favorable display thereof, the models and specimens of compositions and of fabrics and other manufactures and works of art, patented or unpatented, which have been, or shall hereafter be, deposited in said office. And said rooms or galleries shall be kept open during suitable hours for public inspection.

The Commissioner of Patents may now restore to applicants, models of rejected applications, or of applications for designs, or otherwise dispose of them, in cases where he shall not think it necessary to preserve them. Act of 1861, § 5.

SECTION 21. *And be it further enacted,* That all acts and parts of acts heretofore passed on this subject be, and the same are hereby repealed: *Provided, however,* That all actions and processes in law or equity sued out prior to the passage of this act, may be prosecuted to final judgment and execution, in the same manner as though this act had not been passed, excepting and saving the application to any such action of the provisions of the fourteenth and fifteenth sections of this act, so far as they may be applicable thereto: *And provided, also,* That all applications or petitions for patents, pending at the time of the passage of this act, in cases where the duty has been paid, shall be proceeded with and acted on in the same manner as though filed after the passage hereof.

Approved July 4th, 1836.

ACT OF 1837, CHAPTER 45.

5 STATUTES AT LARGE. 191.

[This Act still in Force.]

An Act in addition to the act to promote the progress of science and useful arts.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That any person who may be in possession of, or in any way interested in, any patent for an invention, discovery, or improvement, issued prior to the fifteenth day of December, in the year of our Lord one thousand eight hundred and thirty-six, or in an assignment of any patent, or interest therein, executed and recorded prior to the said fifteenth day of December, may, without charge, on presentation or transmission thereof to the Commissioner of Patents, have the same recorded anew in the Patent Office, together with the descriptions, specifications of claim and drawings annexed or belonging to the same; and it shall be the duty of the Commissioner to cause the same, or any authenticated copy of the original record, specification, or drawing which he may obtain, to be transcribed and copied into books of record to be kept for that purpose; and wherever a drawing was not originally annexed to the patent and referred to in the specification, any drawing produced as a delineation of the invention, being verified by oath in such manner as the Commissioner shall require, may be transmitted and placed on file or copied as aforesaid, together with certificate of the oath; or such drawings may

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be made in the office, under the direction of the Commissioner, in conformity with the specification. And it shall be the duty of the Commissioner to take such measures as may be advised and determined by the Board of Commissioners provided for in the fourth section of this act, to obtain the patents, specifications, and copies aforesaid, for the purpose of being so transcribed and recorded. And it shall be the duty of each of the several clerks of the judicial courts of the United States, to transmit as soon as may be, to the Commissioner of the Patent Office, a statement of all the authenticated copies of patents, descriptions, specifications, and drawings of inventions and discoveries made and executed prior to the aforesaid fifteenth day of December, which may be found on the files of his office; and also to make out and transmit to said Commissioner, for record as aforesaid, a certified copy of every such patent, description, specification, or drawing, which shall be specially required by said Commissioner.

SECTION 2. *And be it further enacted,* That copies of such record and drawings, certified by the Commissioner, or, in his absence, by the chief clerk, shall be *prima facie* evidence of the particulars of the invention and of the patent granted therefor in any judicial court of the United States, in all cases where copies of the original record or specification and drawings would be evidence, without proof of the loss of such originals; and no patent issued prior to the aforesaid fifteenth day of December, shall, after the first day of June next, be received in evidence in any of the said courts in behalf of the patentee or other person who shall be in possession of the same, unless it shall have been so recorded anew, and a draw-

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ing of the invention, if separate from the patent, verified as aforesaid, deposited in the Patent Office; nor shall any written assignment of any such patent, executed and recorded prior to the said fifteenth day of December, be received in evidence in any of the said courts in behalf of the assignee or other person in possession thereof, until it shall have been so recorded anew.

1. Under this section it was held, where a patent was granted in 1834, but no drawing was attached thereto, and in June, 1837, such patent was recorded anew, and was also extended for seven years on the 25th of September, 1848, and in November, 1848, a drawing with written references was filed, with an affidavit of the patentee of the correctness of such drawing, that a certified copy of such drawing was admissible in evidence in connection with the patent and specification, and that the whole together made *prima facie* evidence of the particulars of such invention. *Winans v. Schenec. & Troy R. R.*, 2 Blatchf., 283, 285, 298 —NELSON, J.; N. Y., 1851.

2. Such a drawing, however, as a general rule will not be effectual to correct any material defect in the specification. In case of discrepancy between the drawings and specification, the latter must prevail. Nor will such a drawing have the same effect as if it had been referred to in the specification. *Ibid.*, 299.

SECTION 3. [Extended by act of 1842, § 2.] *And be it further enacted*, That whenever it shall appear to the Commissioner that any patent was destroyed by the burning of the Patent Office building on the aforesaid fifteenth day of December, or was otherwise lost prior thereto, it shall be his duty, on application therefor by the patentee or other person interested therein, to issue a new patent for the same invention or discovery, bearing the date of the original patent, with his certificate thereon that it was made and issued pursuant to the provisions of the third section of this act, and shall enter the same of record: *Provided, however*, That before such patent shall be issued, the applicant therefor shall deposit in the Patent Office a duplicate, as near as may be, of the origi-