

14. Under §§ 7, 8, of the act of 1836, two classes of cases are provided for. An appeal is given by § 7 to an applicant where there is no opposing party; and by § 8, 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.

15. If competent and material evidence is not admitted by the Commissioner, or inadmissible or incompetent evidence is received, objection being made to its reception, such action may be assigned as a reason of appeal, and the Commissioner is bound to answer it, and the judge to decide upon it, and afford relief. *Ibid.*

16. The refusal of the Commissioner of Patents to grant a rehearing, or second interference, is not the subject of appeal. *Rouse, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1854.

17. An appeal lies from a decision of the Commissioner of Patents denying a patent to both applicants, as well as when he denies it to one, and grants it to the other. It is from the decision refusing to grant a patent as applied for that the law allows an appeal. *Carter v. Carter*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

18. Under § 8 of the act of 1836, a patentee has equal right of appeal from a decision of the Commissioner of Patents in favor of an applicant, that an applicant has from a decision in favor of a prior patentee. *Babcock v. Degener*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

19. This decision followed in *Spear v. Abbott*, DUNLOP, J., 1859; and *Beech v. Tucker*, MORSELL, J., 1860.

20. The language of the statute is

broad enough to embrace, and does embrace, "a patentee" who is dissatisfied with the decision of the Commissioner of Patents on the question of priority of right or invention. *Ibid.*

21. It cannot be limited to the case of contending applicants. *Ibid.*

22. The phrase "to determine which or whether either of the applicants," &c., was introduced for the purpose of insuring the examination of the question, in the case of contending applicants, by the judge, whether either of the applicants had brought forward a patentable claim. *Ibid.*

23. Within § 11 of the act of 1839, as to the Commissioner regulating the time of appeals, he may extend the time of appeal; it is a matter within his discretion. *Justice v. Jones*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

24. No appeal lies from matters which are within the discretion of the Commissioner of Patents, as extending time to take testimony, &c., unless perhaps for a plain abuse of discretion. *Hopkins v. Lewis*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

25. It is not proper matter for the appellate tribunal that the Commissioner of Patents has not given a party such reasons for his decision and made such suggestions as enabled him to judge of the expediency of abandoning or modifying his application. *Spencer, Ex parte; Munson, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

26. Though the law requires the Commissioner to aid the inventor by information and suitable references to remedy a defective specification or claim, and to assist his judgment in determining whether he should withdraw or persist in a rejected application

## DUTY OF COMMISSIONER IN CASES OF.

—the manner of doing so, how often, and to what extent, is left to the discretion of the Commissioner, and it is not the subject of review whether this duty is well and sufficiently performed in a given instance. *Chambers, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

27. An appeal cannot be made after the time limited in the notice of appeal. *Linton, W., Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

28. Upon an application for a reissue under § 5 of the act of 1837, asking for several reissued patents, each division or separate patent asked for is not such a separate case, as to require the payment of \$25 on an appeal to the judges; but one appeal carries up the whole case, not a part; and, notwithstanding that separate reissued patents may be granted. *Selden, assignee, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1861.

## 2. Duty of Commissioner of Patents, in cases of.

1. The Commissioner is bound under § 11 of the act of 1839, to furnish to the judges on appeal the grounds of his decision touching the reasons of appeal. *Kemper, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. On an appeal to the judge under § 11 of the act of 1839, the Commissioner of Patents is required to lay before such judge all the original papers and evidence in the case, together with the grounds of his decision fully set forth in writing touching all the points involved in the reasons of appeal, to which reasons of appeal the revision of the judge is to be confined. *Cundell*

*v. Parkhurst*, MS. (App. Case.)—CRANCH, Ch. J.; D. C., 1847.

3. When the Commissioner has laid before the judge the papers, evidence, &c., with “the grounds of his decision,” the case is no longer before the Commissioner, and the litigation is closed as between the appellant and the office. *Aiken, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

4. When a party has given notice of an intention to appeal from the decision of the Commissioner of Patents, by presenting his petition, it is the duty of the Commissioner, and exclusively his duty, to fix a reasonable time for filing the reasons of appeal, within which time all further action is suspended. *Greenough v. Clark*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

5. The Commissioner may enlarge the time to file such reasons, and rehear the case, and this he may do at any time, not only until the patent issues, but until it is actually delivered. *Ibid.*

6. Under the act of 1839, allowing appeals to the chief justice of the Circuit Court of the District of Columbia, and the act of 1852, authorizing like appeals to the assistant justices of the same court, the Commissioner of Patents had no power to make an order, that on account of the infirmity of the chief justice, appeals should be taken to the assistant justices alone, or in default thereof that a patent should issue to the other party. *Anon.*, 6 Opin. 39.—CUSHING, Atty. Gen., 1853.

7. The Commissioner of Patents is to send to the appellate tribunal the reasons of his decision, in answer to the reasons of appeal, in the case of a single application as well as where there are contesting applications. *Henry, Ex*

*parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1856.

### 3. Jurisdiction of Justices on Appeal.

1. The power of the justices of the Circuit Court on appeal from the decision of the Commissioner of Patents, under § 11 of the act of 1839, is confined to the points involved in the "reasons of appeal." *Kemper, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. The revision of the judge on appeal is confined to the points involved in the reasons of appeal, and he is to revise the decision of the Commissioner only in respect to the points involved in the reasons of appeal. *Arnold v. Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

3. If the Commissioner did not err in those points, his decision must be affirmed, even though the judge should be of opinion upon the evidence and merits of the whole case that such decision was wrong. *Ibid.*

4. The provision of the statute that "the decision of the judge shall govern the further proceedings of the Commissioner in the case" applies only to so much of the case as is involved in the reasons of appeal; and the appeal itself can only be considered as an appeal to so much of the decision as is affected by such reasons. *Arnold v. Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

5. If therefore after the judge shall have decided in favor of an applicant upon the points involved in his reasons of appeal, other sufficient reasons remain for rejecting the claim for a patent, untouched by the decision of the judge,

it would seem that the Commissioner might still reject it. *Ibid.*

6. The proceedings before the Commissioner of Patents, and before the judges on appeal, are all initiatory; all relating to the question whether a patent shall issue, and cannot affect a patent already issued. *Pomeroy v. Connison*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1842.

7. The powers and jurisdiction given by the patent law to the judges on appeal are special and limited, and must be construed and exercised strictly. He can only decide such questions and render such judgment as he is expressly authorized by the statutes to decide and render. *Ibid.*

8. The revision of the judge is to be confined to the reasons of appeal, and the grounds of the Commissioner's decision, required by § 11 of the act of 1839, are to be confined to the points involved in the reasons of appeal. *Smith v. Flickinger*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1843.

9. The revision of the decision of the Commissioner is to be "confined to the grounds of his decision, touching the points involved in the reasons of appeal." *Cochrane v. Waterman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1844.

10. The revision of the judge on appeal is limited to the points involved in the reasons of appeal, and the questions must be decided according to the evidence produced before the Commissioner. *Warner v. Goodyear*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1846. *Perry v. Cornell. Ibid.*—CRANCH, Ch. J.; 1847.

11. The jurisdiction given to the judge under § 8 of the act of 1836, is broad enough to include the question

of *interference*, as well as that of *priority*. And the question of *priority* of right of invention necessarily implies *interference*. *Bain v. Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

12. But the interference mentioned in § 8 of the act of 1836, 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. *Ibid.*

13. The decision of the judges on appeal is confined "to the points involved in the reasons of appeal." *Winslow, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

14. The supervision of the judge is limited to the points involved in the reasons of appeal. *Aiken, Ex parte (Propellers)*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

15. It is immaterial what reasons the Commissioner assigns for his decision; his reasons may be insufficient, and yet his decision be correct. *Ibid.*

16. The insufficiency of the Commissioner's reasons for rejecting an application is not in itself evidence that his decision is wrong, and is no cause for reversing it. *Aiken, Ex parte (R. R. Car Wheels)*.—MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

17. The filing of reasons of appeal in the office of the Commissioner of Patents is a proceeding over which the judge on appeal has no control. *Wade v. Matthews*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

18. If the Commissioner has received and filed the reasons of appeal, the judge cannot order him to strike them

out. They must be heard and decided. *Ibid.*

19. The jurisdiction of the judge on appeal is confined to the reasons of appeal, and however worthy of consideration a proposition or argument may be, if not within such reasons, it must be disregarded. *Burlew v. O'Neil*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

20. The question of fraud in granting a patent, will not be passed upon by the judge on appeal, but is to be tried by a jury. *Ibid.*

21. All the conditions prescribed in § 11 of the act of 1839 must be complied with, as prerequisites, before the judge can take jurisdiction by way of appeal from the decision of the Commissioner of Patents. *Greenough v. Clark*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

22. His jurisdiction is very special and limited, and all the previous circumstances under which it is given must exist, before it can attach, and no other power or authority can be exercised, except that expressly given, or fairly to be inferred. *Ibid.*

23. The judge can judicially know nothing of the case, until the appealing party presents his petition for a revision, which cannot be done until after a decision has been made against him, and he has declared his intention of appealing, and filed his reasons of appeal. *Ibid.*

24. The provision of § 11 of the act of 1839, requiring the judge to hear and determine appeals from the decisions of the Commissioner, "on the evidence produced before the Commissioner," is to be construed in connection with § 7 of the act of 1836, which provides that reasonable notice shall be given both to the party appealing and

the Commissioner, so "that they may have an opportunity of furnishing them, *i. e.* the board of examiners, with such facts and evidence as they may deem necessary to a just decision." *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

25. There is nothing in the repealing act of 1839—which substituted the judge for the board of examiners—which takes away or impairs that right, but every reason to infer that it was intended to be saved to the fullest extent. *Ibid.*

26. Where in a case, a party has been prevented from producing before the Commissioner his proofs to support his claim, it is the duty of the judge to pursue, by reasonable regulations, similar to those directed by § 12 of the act of 1839, such a course as will afford the party an opportunity to produce such proofs. *Ibid.*

27. In such a case, the judge will make an order authorizing the party to take and file with his appeal, evidence as to the originality and utility of his invention. *Ibid.*

28. By § 11 of the act of 1839, substituting the judge in place of the board of examiners created by § 7 of the act of 1836, the judge succeeded to the same authority that such board possessed to require of the Commissioner of Patents and examiners, "information relative to the subject matter under consideration," and to the full extent. *Seeley's App.*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

29. An examiner may therefore be inquired of as to the nature and features of the invention under consideration, and essential to the right claimed, and which may not be sufficiently set forth in the report of the Commissioner. *Ibid.*

30. If *new references*, as grounds for

the rejection of an application for a patent, are made at the trial of an appeal, before the judge, and are such as are material, they will be considered as having deprived the applicant of his right of amendment secured by § 7 of the act of 1836, and in such case the decision of the Commissioner will be reversed, and he will be directed to proceed with the case anew. *Jewett & Root, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

31. The provisions of § 11 of the act of 1839, as to the examination, on appeal, of the Commissioner or examiners of the Patent Office on appeals, must be considered in connection with the provision in § 7 of the act of 1836, as to the powers of the old board of examiners. *Richardson v. Hicks*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

32. The language of the statute means that the explanation authorized to be required of the Commissioner and examiners, may be so full and clear an explanation of the *principles* of the thing, as to enable the judge duly to apply and weigh the evidence offered to support the issue in the case, and is not to be limited to a mere exposition of the terms used, and such explanations so given, the judge is bound to respect as a part of the case. *Ibid.*

33. The judge on appeals is only required to examine the *conclusions* which the Commissioner of Patents may have arrived at in any given case, and not the *processes* or reasons by which such conclusions may have been attained. *Spencer, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859. [*Eames v. Richards*.—MERRICK, J.; 1859.]

34. On appeal, the judge is not at liberty to look into every error of fact or law which may have been committed

## REASONS OF APPEAL, SUFFICIENCY OF.

in the case, but only to such as have been *specifically pointed out* by the reasons of appeal. *Laidley v. James*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

35. The judge on appeal has no power to send a case back to the Patent Office to take proof by competent experts, as to the alleged utility of the invention, or to receive or hear such proof on the appeal. *Sanders, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

36. He is limited by law to the papers and evidence which were before the Commissioner.

37. Neither judge on appeal can review a former decision of another judge, or entertain another appeal, in the same case; the former decision is final and conclusive, upon either of the other judges. *Raymond, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

38. Under § 8 of the act of 1836, the judge on appeal is not confined to the question of priority of invention, but he is to determine whether either party is entitled to a patent. His duty is to inquire into all the facts and circumstances given in evidence, which go to invalidate the claim of either applicant. *Loveridge v. Dutcher*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861. *Dyson v. Gumbriel*, MS. (App. Cas.)—DUNLOP J.; D. C., 1861.

39. The judges of the Circuit Court by law can entertain no appeal except from the decisions of the Commissioner. Under the laws prior to 1861, all the decisions of the office, whether by examiners or the old board of appeals, were *in law* the decisions of the Commissioner, when sanctioned by him. Under that system, when a primary examiner refused a patent, or decided

an interference, and the Commissioner approved such decision, an appeal lay directly to one of the judges. *Snowden v. Pierce*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

40. But under the new law of 1861, the primary examiners and the examiners in chief, are all treated as judicial officers, having power without control, within the sphere of their duty, to the exercise of their independent judgment. Their acts are not the acts of the Commissioner, but their own acts. They are no longer mere organs of the Commissioner, but independent officers. He can only reach and overrule them when their judgments come regularly before him *on appeal*. *Ibid.*

41. The appeal to the judges still exists, but it can now only be exercised after the applicant has gone the rounds of all the tribunals erected by the new law, and after the final decision by the Commissioner. *Ibid.*

42. An applicant must go from the primary examiners by appeal to the examiners in chief, and from them by appeal to the Commissioner, and lastly, from the Commissioner to the judges of the Circuit Court. *Ibid.*

#### 4. "Reasons of Appeal," sufficiency, &c.

1. A reason of appeal should not be vague and unsatisfactory, but should involve some point affecting the decision of the Commissioner. The reason that the decision of the Commissioner was in opposition to a clear apprehension of the merits of the case, is insufficient. *Winslow, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

2. An alleged reason of appeal, "that the decision of the Commissioner was

inconsistent, as opposed to precedents which have governed before, is also insufficient." *Ibid.*

3. Another reason of appeal was, "that the decision of the Commissioner was adverse to the opinions of skilful and competent, practical, and scientific men, who were peculiarly qualified to judge as to the merits of the particular invention." *Held*, that none of these reasons involved the question of novelty, and that the opinion of such experts could not affect the question of novelty. *Ibid.*

4. A reason of appeal "that there was no evidence of any device or arrangement like that of the applicant," *Held*, to be no ground for reversing the decision of the Commissioner, as the Commissioner might have had other grounds than the evidence offered for the rejection. *Crooker Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

5. An objection to the *opinion* of the Commissioner as to the intention of an invention cited as cause of rejection, is not a good "reason of appeal." Whatever may have been his opinion, his decision may be correct. *Ibid.*

6. A reason of appeal, "that the reasons assigned by the Commissioner for rejecting an application, are irrelevant and do not apply to the subject matter," involves no point material to the case. *Aiken, Ex parte (Propeller)*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

7. It is immaterial what reasons the Commissioner assigns for his decision; his reasoning may be insufficient, and yet his decision be correct. *Ibid.*

8. Insufficient reasons furnish no grounds for reversing his decision. *Ibid.*

9. The insufficiency of the Commissioner's reasons for rejecting an application for a patent, is not in itself evi-

dence that his decision is wrong, and is no cause for reversing it. *Aiken Ex parte (R. R. Car Wheel)*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

10. The filing of the reasons of appeal in the office of the Commissioner of Patents, is a proceeding over which the judge on appeal has no control. If the Commissioner has received and filed the reasons of appeal, the judge cannot order him to strike them out. They must be heard, and decided. *Wade v. Matthews*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

11. No reason of appeal can be considered as valid, which would not justify the Commissioner in refusing a patent. *Ibid.*

12. If competent and material evidence is not admitted by the Commissioner, or inadmissible or incompetent evidence is received, objection being made to its reception, such action may be assigned as a reason of appeal, and the Commissioner is bound to answer it, and the judge to decide upon it. *Fultz Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

13. A reason of appeal, "that the decision of the Commissioner is against evidence and the weight of evidence," is entirely too vague and indefinite, within the provisions of § 11 of the act of 1839, as a substantive reason of appeal, "specifically set forth in writing." *Douglas v. Blakinton*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

14. No assignment is sufficiently specific which does not, with reasonable certainty, point out the precise matter of alleged error. *Ibid.*

15. The reasons of appeal should be so expressed that the judge may gather from their language what is meant by

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them, but they need not be according to any technical formula. *Laidley v. James*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

5. *Practice in cases of Appeal.*

1 An objection not taken at the hearing or trial before the Commissioner, cannot be made on appeal from the decision of the Commissioner to the judge. *Smith v. Flickenger*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1843.

2. The officer of the Patent Office, who may attend before the judge, on an appeal, under the provisions of § 11 of the act of 1839, is not considered as counsel for the Patent Office, or as an advocate of either of the parties litigant. He only attends for the purpose of explaining the decision of the Commissioner. *Perry v. Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

3. When an application is finally rejected, no new oath is necessary to enable a party to appeal. *Crooker, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

4. No reply can be admitted before the judge on appeal, to the "grounds of the Commissioner's decision," laid before the judge; and no reply can be filed in the office of the Commissioner to be recorded with the proceedings." *Aiken's Appeal (R. R. Car Wheels)*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

5. If contesting applicants, in their proceedings before the Commissioner of Patents, or by stipulation in such proceedings, have admitted any statement of facts, as identity of inventions, they cannot deny such identity by their reasons of appeal, and seek a decision of

the judge of appeal thereon. *Wade v. Matthews*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

6. Whether the decision of the Commissioner is correct or erroneous must depend upon the evidence and proofs before him. *Ruggles v. Young*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

7. The filing of the arguments on appeal, by the respective parties, within the time prescribed, may be dispensed with or excused on reasonable cause shown for the omission. *N. E. Scream Co. v. Sloan*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

8. On appeal, affidavits cannot be considered which were not taken by the authority of the Commissioner, nor acted upon by him in forming his decision. *Jackson, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1856.

9. If objection is not made to the competency of a witness on his examination, and both parties examine him, it will be too late to raise the objection as to his competency, on appeal. *Allen v. Alter*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

APPLICATION FOR PATENT.

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A. WHEN AND BY WHOM MADE; EFFECT OF; EFFECT OF DELAY IN MAKING OR PROSECUTING.

1. Even without a general use of an



invention, with the knowledge and consent of the inventor, an unreasonable and causeless, or faulty delay in taking out a patent, may justly and upon legal principles be considered as amounting to an abandonment. *Treadwell v. Bladen*, 4 Wash., 708.—WASHINGTON, J.; Pa., 1827.

2. Though the discovery of a patentee is new, yet if he is guilty of negligence in procuring his patent, by which the invention has become publicly known and used by any persons, he can have no right of action for its infringement. *Whitney v. Emmett*, Bald., 311.—BALDWIN, J.; Pa., 1831.

3. An application cannot be made by one joint inventor upon the assignment of the other, but all concerned in the invention must join in the application. *Newton's Case*, 2 Opin., 571.—TANEY, Atty. Gen.; 1833.

4. Vigilance is necessary to entitle an individual to the privileges secured under the patent law. He must show his right to invention, and secure it in the mode required by law. And if the invention, by fraudulent means, shall be made known to the public, he should assert his right immediately, and take the necessary steps to legalize it. *Shaw v. Cooper*, 7 Pet., 319.—MCLEAN, J.; Sup. Ct., 1833.

5. The statute does not limit any time in which the inventor must apply for a patent, nor does it declare a forfeiture by reason of any delay. Delay, therefore, is unimportant, unless it amount to evidence of abandonment of the claim, and that is proper matter for the consideration of a jury. *Hildreth v. Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

6. The right of the first inventor is not lost merely by lapse of time between

the invention and application for a patent, unless there has been some intermediate public use by the applicant, or by his consent; and especially, where he has been *bona fide* taking measures to improve or perfect his invention, and to prepare for applying for taking a patent. *Ibid.*

7. There is no act of Congress that makes delay in taking out a patent fatal to the first inventor, unless he abandons his discovery to the public, or by his "consent" allows it to be put in "public use or on sale," for two years before taking out a patent. *Allen v. Blunt*, 2 Wood. & Min., 141, 143.—WOODBURY, J.; Mass., 1846.

8. An inventor should notify the public of his claim, by a caveat or application filed in the Patent Office. But if such claim, though informal, is followed up with reasonable diligence, and eventually the patent granted, it will prevent any right being acquired by strangers in the mean time. *Sparkman v. Higgins*, 1 Blatchf., 208.—BETTS, J.; N. Y., 1846.

9. An applicant for a patent will not be defeated of his right to a patent by reason of the Commissioner or officers of the Patent Office, neglecting or mistaking to give correct information to any one respecting the condition of such application. *Ibid.*, 209.

10. It is wholly immaterial to the validity of the patent, whether an invention was long antecedent to the application for a patent, or directly preceding it. *Wilder v. McCormick*, 2 Blatchf., 33.—BETTS, J.; N. Y., 1846.

11. The right of the inventor is protected from the time of his application. The delay which may occur in the Patent Office, in making out a patent, cannot operate to the injury of the appli

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cant. *Root v. Ball*, 4 McLean, 179.—McLEAN, J.; Ohio, 1846.

12. Priority of application for a patent does not decide priority of invention. *Perry v. Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

13. Before a patent is granted, there is no law that requires the first inventor to disclose his invention within any limited time, nor is there any limitation unless the lapse of time is sufficient to show an abandonment, which is a question for a jury. *Ibid.*

14. The application may be renewed from time to time, on the same or additional evidence, the previous hearings and decisions creating no bar to a farther investigation. *Gay v. Cornell*, 1 Blatchf., 509.—NELSON, J.; N. Y., 1849.

15. If an inventor unnecessarily defer his application for a patent, and suffer his invention to go into use, except for the purpose of perfecting it, and testing its utility by proper experiments, and beyond what he has reason to believe necessary for these purposes, his patent is void. *Winans v. Schen. and Troy R. Road*, 2 Blatchf., 291, 300.—NELSON, CONKLING, JJ.; N. Y., 1851.

16. If a party, who claims to be the first inventor of a machine, neglect to apply for a patent therefor, with a knowledge that another is making application for a patent for the same invention, such conduct will tend to discredit his testimony, as to priority of invention by him. *McCormick v. Ketchum*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

17. Pecuniary inability is a sufficient excuse to an inventor for not prosecuting his invention, or carrying out an intention to secure letters patent therefor. *Yearsley v. Brookfield*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

18. The pecuniary embarrassments of an inventor will excuse, to some extent, his laches in not applying for a patent. *N. E. Screw Co. v. Sloan*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

19. Mere lapse of time between the making of an invention and the application for a patent, is not an abandonment. *Stephenson v. Hoyt*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

20. Slight circumstances are sufficient to rebut any presumption of abandonment. *Ibid.*

21. Parol evidence is not admissible to show when a patent was applied for. *Wayne v. Winter*, 6 McLean, 345.—McLEAN, J.; Ohio, 1853.

22. The Patent Office contains written evidence of the fact, and it must be proved by such evidence. *Ibid.*

23. Mere lapse of time in applying for a patent does not evince that positive abandonment of which the Patent Office can take notice. *Hunt v. Howe*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

24. There is no time limited within which an inventor is to disclose his invention before application for a patent. His right can be affected by no lapse of time short of that which will be sufficient to show an abandonment of his claim, during which time no subsequent inventor, however original or *bona fide*, can deprive him of his priority. *Stephens v. Salisbury*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

25. If an inventor after his invention is perfected unreasonably delay his application for a patent, and others, before such application, actually perfect and apply to practical use the same invention, and give the knowledge thereof to the public, and the former, after a knowledge of such subsequent inven

tion and use fail to make objection and apply without unreasonable delay for a patent, he cannot sustain the patent he may afterward obtain, because he has failed to give to the public that consideration for the grant of exclusive privileges, upon which all valid patents must be based. *Ransom v. Mayor, &c.*, 1 Fisher, 272.—HALL, J.; N. Y., 1856.

26. The object of the patent laws being not only to benefit the inventor, but also the public or community at large by the use of the invention, after the monopoly has terminated, it follows that an inventor who designedly and with the view of applying it indefinitely and exclusively for his own profits, withholds his invention from the public, comes not within the policy or objects of the constitution or acts of Congress, and is not entitled to favor if during such concealment another person should find out and bring into use the same invention. *Kendall v. Winsor*, 21 How., 328.—DANIEL, J.; Sup. Ct., 1858.

27. But this does not forbid a delay requisite for completing an invention or testing its value or success; nor forbid a discreet and reasonable forbearance to proclaim the theory or operation of an invention during its progress to completion, and preceding an application for protection in such discovery. *Ibid.*, 328, 329.

28. An inventor may also forfeit his rights by a wilful or negligent postponement of his claims, or by an attempt to withhold the benefit of his improvement from the public until a similar or the same improvement should have been made and introduced by others. *Ibid.*, 329.

29. No particular time is limited by the statute within which an inventor must make application for a patent, yet

it ought to be done within a *reasonable time*; what is or what is not a reasonable time depends on the circumstances of each case. *Ellithorpe v. Robertson*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

30. Where a person made an invention in 1847 and did not apply for a patent until eleven years after, and a patent had been granted more than four years before to another residing in the same place, *Held*, that the first inventor must suffer from his laches. *Ibid.*

31. A party has a right to keep his inchoate right to an invention concealed as long as he pleases, but when he desires to perfect his right to a patent, he must proceed with vigilance. *Ibid.*

32. Under § 7 of the act of 1839, if an inventor, though he may be the first and original one, neglect to apply for a patent within two years after he knows that another has publicly used and claimed his invention, and interposes no objection or warning, he thereby loses his right to a patent. *Justice v. Jones*, MS. (App. Cas.)—MERRICK, J. D. C., 1859.

33. A made application for a patent in 1855, and obtained a patent early in 1856. B, who claimed to be the first inventor, and who had knowledge of A's proceedings, remained quiet until 1858 or 1859, when he assigned his invention, and application was made for a patent therefor. *Held*, that it was a clear case of disability to prosecute, under § 7 of the act of 1839, even though B was the first inventor. *Ibid.*

34. Merely withholding an invention from the public can never amount to an abandonment, however it may, in connection with other circumstances, pile up difficulties, if too long continued, in the way of asserting and proving priority over another inventor who applies for

WHEN TO BE MADE. EFFECT OF; EFFECT OF DELAY IN MAKING.

a patent. *Babcock v. Degener*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

35. When one inventor has knowledge that another has made application for, and has received a patent for the same invention which has also been re-issued, and makes no further claim until after such reissues have been obtained, his want of diligence in prosecuting his application will work a forfeiture of his right to a patent. *Wickersham v. Singer*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

36. W. made application for a patent in 1851, and in the same year withdrew his application and received the return fee, and took no further steps till 1858. S. had made application for a patent for the same invention in 1850, and obtained a patent therefor in 1851, which had been re-issued in 1854 and 1856. Of all this W. had knowledge. *Held*, that W. had not pursued due diligence in applying for and prosecuting his application for a patent, and had forfeited his right to a patent. *Ibid.*

37. By an application filed in the Patent Office, the inventor makes a full disclosure of his invention, and gives public notice of his claim for a patent. It is conclusive evidence that he does not intend to abandon it to the public. *Adams v. Jones*, 1 Fisher, 530.—GRIER, J.; Pa., 1859.

38. Where a person has made an application for a patent for his invention, the delay interposed either by the mistakes of the public officers, or the delays of courts, and not by any laches of the applicant, cannot affect his rights. *Ibid.*, 530.

39. Where A made an application for a patent in 1850, which was refused, and an appeal taken to the Circuit Court, which was not decided until 1856, when

the decision was affirmed, but the original application was not withdrawn, and the applicant continued to insist upon his right to a patent, and a new Commissioner of Patents perceived his novelty and granted him a patent, *Held*, that by such delay he had not lost his right to a patent. *Ibid.*, 529.

40. Though an applicant may be treated as having abandoned his application, if it be not prosecuted with reasonable diligence, involuntary delays, not caused by his laches, will not work a forfeiture of his patent. *Ibid.*, 530.

41. B. made an invention in 1853, but took no steps to obtain a patent until 1859. In 1858, S. patented the same improvement. *Held*, that B., by his delay, had forfeited his right to a patent. *Spear v. Stuart*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859.

42. The statutory bar (§ 7 of the act of 1839) to the inventor who sells, would seem by analogy properly applicable to the inventor who *secretes*. *Ibid.*

43. If an inventor keep his invention a secret, until another has discovered the same thing, and lie by while such other inventor makes application for a patent, and manufactures and sells the article invented, and neglects to give notice of his claim, or make application for a patent, such first inventor will lose his right to a patent. *Savory v. Louth*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

44. S. made an invention in 1854, but did not make application for a patent until September, 1858. L. invented the same thing in January, 1858, and made application for a patent therefor in August, 1858, and had manufactured the articles, and put them in market. An interference was declared between such applicants.

*Held*, that S. had forfeited his right to a patent. *Ibid.*

45. If an inventor suffers his invention to go into public use, through any means whatever, without an immediate assertion of his right, he forfeits his right to a patent. *Ibid.*

46. The concealment by an inventor of his invention for more than two years, works a forfeiture of his right to a patent, the same as if he had sold it for more than two years before applying for a patent. *Ibid.*

47. There can be no doubt that where a party has made an invention, and buried the secret in his own bosom, he may, after the lapse of years, come forward, and upon making a secret known by an application for a patent, obtain a monopoly. *Berg v. Thistle*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

48. But if in the mean time another has made the same invention, and has obtained a patent, and the public has thereby become possessed of the discovery, when the first inventor applies, he will be met with the inquiry whether he has used due diligence in communicating his discovery. In such case the first inventor forfeits his claims. *Ibid.*

49. The doctrine of abandonment by suffering an invention to go into public use for more than two years, is wholly distinct from the doctrine of forfeiture in favor of a junior discoverer, who is a prior patentee. *Ibid.*

50. The policy of the patent laws favors diligence and condemns neglect. It is the duty of an inventor, *without delay*, to patent his perfected invention. He has no right to use it himself, or permit others to use it, for any length of time, and then expect a monopoly from the public. *Marcy v. Trotter*,

MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

51. Where a party made an invention, and made no application for a patent, and the same thing was patented to another, and used under such patent for eight years, and then such inventor asked for a patent, *Held*, that by reason of his laches he was not entitled to a patent. *Ibid.*

52. Where a patent was granted to A, and the same had been publicly and openly used under circumstances that showed that B must have known it, and without objection from B, and B afterward, and just before the expiration of two years from the time of the granting of the patent to A, applied for a patent for the same thing, *Held*, that B must be presumed to have acquiesced in the use by A, and that such acquiescence was a statutory bar to the claim of B, and notwithstanding B had filed a caveat in 1848, and had renewed it within a year before he made application for a patent. *Beech v. Tucker*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

53. Decisions in *Ellithorpe v. Robertson*, MORSELL, J., 1858, and *Wickersham v. Singer*, MERRICK, J., 1859, and *Spear v. Stuart*, DUNLOP, J., 1859, as to forfeiture of right to a patent approved. *Sturtevant v. Greenough*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

54. Long delay and gross neglect on the part of an inventor to give the public the benefit of his invention, by promptly presenting it, after it is perfected, to the Patent Office, will work a forfeiture of his right to a patent. *Loveridge v. Dutcher*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

55. Where an inventor suffered his claim to remain before the office for

more than five years, as a rejected application, without any attempt in the interval to protect his rights, *Held*, that he had forfeited his right to a patent. *Raymond, L. Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1861.

56. A negligence in secreting and failing to patent an invention for more than two years after its discovery, forfeits all right to claim a patent. Even the filing a caveat, if filed more than two years after such discovery, will not save the rights of the inventor. *Snowden v. Pierce*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

57. And it seems that a neglect to continue experiments, or to use any means to perfect an invention during that period, would be equally fatal, or would not stand in the way of a subsequent original inventor, who had conceived and diligently pursued the same invention and obtained a patent therefor. *Ibid.*

58. Where an inventor, who first conceived the idea of an invention, did not apply for a patent until about a year and a half after another had conceived the same idea, and made application for and obtained a patent for the same invention, *Held*, that the former one by his delay had forfeited all right to a patent. *Walker v. Forbes*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

## B. DUTIES OF COMMISSIONER ON APPLICATIONS FOR, AND IN GRANTING PATENTS.

1. Under the patent laws patents cannot be withheld on moral considerations, under the act of 1793, if the required allegation and oath have been made, a suitable specification filed, and a

model deposited. *McDonald's Case*, 1 Opin., 170.—PINCKNEY, Atty. Gen.; 1812.

2. There is no limitation of time within which a patent must be taken out, after specification filed. *Anon.*, 5 Opin., 701.—RUSH, Atty. Gen.; 1814.

3. The duty of the Patent Office, and of the secretary of state, is confined to issuing patents in the cases and with the forms prescribed by law, and having done this, their duty is at an end. It is not their duty, nor that of the Attorney-General, as their law adviser, to determine what rights are conferred by the patents granted, or what will amount to a violation of those rights. These are questions to be settled by the courts and juries. *Nourse's Case*, 1 Opin., 575.—WIRT, Atty. Gen.; 1822.

4. The authority to issue patents is a limited one, and the party must bring himself within the terms before he can derive any title to demand or hold a patent. *Pennock v. Dialogue*, 2 Pet., 18.—STORY, J.; Sup. Ct., 1829.

5. The department acts rather ministerially than judicially in granting patents. A patent issues upon the representation of the party, without entering into an examination of the question of rights conferred by the patent. All the proceedings are *ex parte*, except in the case of interfering applications. *Anon.*, 2 Opin., 455.—TANEY, Atty. Gen.; 1831.

6. A patent may lawfully issue, when all the forms prescribed by law have been complied with, without inquiring whether it will confer any right on the patentee; that is for the decision of the courts. *Ibid.*, 455.

7. The act of Congress directs patents to be issued on certain conditions; these must be complied with in order to give

action to the special proceedings. *Whitney v. Emmett*, Bald., 316.—BALDWIN, J.; Pa., 1831.

8. A patent is a matter of right, on complying with the conditions prescribed by law. *Ibid.*, 318.

9. The party applying for a patent must prove either that he is a citizen of the United States, or that he has resided in the United States for two years. Patents cannot be granted to every applicant, but only to certain applicants, and the party applying must prove that he is within the description specified. *Anon.*, 2 Opin., 511.—TANEY, Atty. Gen.; 1832.

10. Patents cannot be granted to every applicant, but only to such as show themselves to be within the description of the statute, as entitled to receive a patent. *Ibid.*

11. Under the act of 1793, the secretary of state, in issuing patents, may be considered as a ministerial officer. If the prerequisites of the law are complied with, he can exercise no judgment on the question, whether the patent shall be issued. He can exercise no powers but such as are given him. *Grant v. Raymond*, 6 Pet., 241, 242.—MARSHALL, Ch. J.; Sup. Ct., 1832.

12. The Commissioner is bound to issue a patent in the case, and in the circumstances stated in § 7 of the act of 1836. He has in such a case no discretion. *Hildreth v. Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

13. The dictum of STORY, J., in *Bedford v. Hunt*, 1 Mas., 304 (1817), that "the first inventor who has put the invention in practice, and he only, is entitled to a patent," is wholly inapplicable to the question whether the Commissioner of Patents should issue a patent; Mr. Justice Story was not consid-

ering the question whether a patent *should be issued*, but whether it should be invalidated by prior use. *Ibid.*

14. Any matter of defence, which it is the peculiar province of a jury to decide, and which is not in § 7 of the act of 1836 made a ground for the refusal of a patent by the Commissioner, should be left by him to be decided by a jury in an action at law. *Ibid.*

15. § 7 of the act of 1836 refers to § 6, and a patent is to be issued only to the discoverer of some new and useful art or improvement; therefore, upon an application for a patent, the Commissioner is to decide in the first place, whether the invention is new and the proper subject of a patent; if not, he is bound to refuse it, although it may not be liable to the particular objections specified in § 7 of the act of 1836. *Kemper, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

16. The Commissioner of Patents may reject a claim for a patent, even after a decision by the judge, on appeal in favor of the applicant, upon the points involved in his reasons of appeal, if other sufficient reasons for such rejection remain, and which are untouched by the decision of the judge. *Arnold v. Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

17. The proceedings before the Commissioner of Patents, and before the judges on appeal, are all *initiatory*—all relating to the question whether a patent shall issue: they cannot affect a patent already issued. *Pomeroy v. Connison*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1842.

18. When a patent has issued, the jurisdiction of the Commissioner is exhausted. He has no further control over it, except under § 13 of the act of 1836,

when it is inoperative by reason of a defective or insufficient specification. *Ibid.*

19. The authority of the Commissioner of Patents to issue patents is not of the nature of *jurisdiction*, in its common law and technical acceptation. The doctrine appertaining to acts or judgments of inferior tribunals, that he who sets up such judgment must aver and prove that the tribunal had jurisdiction in the matter, does not apply to his acts. *Wilder v. McCormick*, 2 Blatchf., 34.—BERTS, J.; N. Y., 1846.

20. Proceedings before the Commissioner of Patents are initiatory. The question is, "whether the patent shall be granted," not "whether it shall be vacated;" and a patent may be granted or refused upon less evidence than would be required to sustain or amend it. *Perry v. Cornell*, MS. (App. Cas.)—CRANCH, Ch., J.; D. C., 1847.

21. Some of the provisions of the act of 1836, give a *quasi* judicial character to the action of the Commissioner of Patents in granting a patent; and it has accordingly been generally held, that a patent is to be taken as *prima facie* evidence of the novelty and usefulness of the invention specified in it. *Wilson v. Barnum*, 1 Wall, Jr., 349.—KANE, J.; Pa., 1849.

22. The hearing before the Commissioner of Patents, on an application for a patent, is informal and summary, and not final. *Gay v. Cornell*, 1 Blatchf., 509.—NELSON, J.; N. Y., 1849.

23. The power vested in the Commissioner of Patents, to issue patents for inventions, exists in full force for examination and final decision, until the patent shall have actually issued; and is not controlled or concluded by intervening or interlocutory opinions given in proceedings, as in cases of interfe-

rence, &c., had or taken during the examination and prior to the final determination and issuance of the patent. *Wade v. Matthews*, 5 Opin., 222.—JOHNSON, Atty. Gen., 1849.

24. In deciding upon an application for a patent, the question is not, whether the invention is more useful than others, but whether it is new and sufficiently useful to justify a patent. *Aiken, Ex parte (Propellers)*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

25. Under § 7 of the act of 1836, upon an examination of an application for a patent, if it appears that the matter for which the patent is claimed, had not been invented or discovered by any person in this country prior to the invention or discovery by the applicant, or had not been patented or described in any printed publication, or had not been in public use, or on sale, with the consent and allowance of the applicant, it is *the duty* of the Commissioner to grant a patent, if, in his opinion, the thing is *sufficiently useful or important*. *Aiken, Ex parte (Car Wheels)*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

26. Since the act of 1836, the Commissioner of Patents acts *quasi* judicially on the subjects of originality and novelty and utility of invention. He is bound to inquire and decide these questions before granting a patent. Such action, however, being *ex parte*, is not conclusive on those who are not parties to the proceeding. *Goodyear v. Day*, MS.—GRIER, J.; N. J., 1852.

27. Upon an application for a patent, the question for the Commissioner to determine is, whether the applicant is the first inventor of the thing for which a patent is sought; and testimony showing that another is the first inventor, is properly received, though such testi-



mony might invalidate the rights of such other party to a patent, if an application by him for a patent was under consideration. *Burlew v. O'Neil*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

28. There is nothing in the acts of Congress which requires that a patent should be issued within any given time, after the application is filed, or which forbids the postponement of it for a time, at the suggestion either of the applicant or the office. *O'Reilly v. Morse*, 15 How., 126.—GRIER, J.; Sup. Ct., 1853.

29. It has always been the practice, when a foreign patent is desired, to delay the issuing of a patent here, after application filed, for fear of injuring such foreign application. *Ibid.*, 126.

30. Upon an application for a patent, the applicant is entitled to notice of such information and *references*, as may go to show, that for any of the causes stated in § 7 of the act of 1836, he is not entitled to a patent, so that he may be able to amend his specification so as to include only what is new. *Jewett & Root, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

31. If new references, which are material, are made on the trial of an appeal, they will be considered as having deprived the applicant of his right of amendment secured by § 7 of the act of 1836, and in such case the decision of the Commissioner will be reversed, and he will be directed to proceed with the case anew. *Ibid.*

32. The proceedings before the Commissioner are initiatory, and from the nature of the case, not unlike the practice in the incipient stages of many other allowed cases. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

33. The Commissioner of Patents, up to the moment of issuing a patent, has a discretion to rehear a case, before decided by him, and ought to do so, until he is convinced as to the true inventor, to whom alone the patent ought to be issued. *Rouse, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1854.

34. § 8 of the act of 1836 is, however, satisfied by giving one trial between the same parties, on the same subject. *Ibid.*

35. The jurisdiction of the Commissioner of Patents in determining as to the issuing of a patent is a limited one, but is to be understood, not only from what is expressly stated in the statute, but also from what ought necessarily to be inferred, as absolute within its proper limits as that of a tribunal of general jurisdiction. *Hunt v. Howe*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

36. 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 patents is open to inquiry, either in whole or in part, whether at the instance of private persons or of the United States. A patent does not conclude any body. *Morton's Case*, 8 Opin., 277.—CUSHING, Atty. Gen.; 1856.

37. On an application for the issue of a patent, it is the duty of the Commissioner to decide all questions, both of law and fact, which go to establish the right, or the absence of right, in the applicant to a patent. *Marcy v. Trotter*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

38. A Commissioner must abide by the decision of his predecessor as to any matter adjudicated upon, while that

## WITHDRAWAL OF, AND EFFECT THEREOF.

decision is unreversed by any competent court. *Larowe, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

39. Where a former decision of a Commissioner as to a particular matter is unappealed from and remains unreversed, and the application is not withdrawn, such decision is binding upon a subsequent Commissioner, and he cannot collaterally review and reverse it. *Simpson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

### C. WITHDRAWAL OF APPLICATION; EFFECT OF.

1. A caveator having proceeded to file his description, specifications, drawings, and model, having paid the ten dollars required by statute, in addition to the twenty required on the caveat, is entitled, upon a rejection of his application for a patent, to demand a return of twenty dollars. *Anon.*, 6 Opin., 37.—CUSHING, Atty. Gen.; 1853.

2. The provisions of § 7 of the act of 1836, as to withdrawals, apply to all persons, whether applicants by specification, &c., complete at the outset, or applicants by application incomplete and with caveat, and whether citizens of the United States, aliens having resided one year, and made the oath of intention to become a citizen, or others the subjects of any foreign government. *Ibid.*, 38.

3. Every applicant for a patent has a right to withdraw his application, and demand the restoration of two-thirds of the patent fee, after his application is complete, and as well before an examination has been had on his application, as after it has taken place. *Farrish & Keeler's Case*, 7 Opin., 394.—CUSHING, Atty. Gen.; 1855.

4. There is no law allowing a caveator to withdraw any portion of the fee required in filing his caveat. *Anon.*, MS.—BLACK, Atty. Gen.; 1857.

5. The withdrawing an application and receiving back the allowed part of the patent fee will be considered as a final abandonment of the further prosecution of the claim, and effects an entire extinction of all protection (saving any privileges under § 7 of the act of 1839), and which cannot be revived by any new application. It is not a mere relinquishment of any claim to the model. *Mowry v. Barber*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

6. The withdrawal of an application after return of part of the patent fee is not itself an abandonment or dedication of one's invention to the public, but is an equivocal act to be interpreted by surrounding circumstances, and to be affected upon a second application by the subsequent conduct of the party, his diligence or his neglect and delay, in the same manner as his conduct is to be weighed in regard to an original application. *Wickersham v. Singer*, MS (App. Cas.)—MERRICK, J.; D. C., 1859.

7. The withdrawal of an application and receiving the fee returnable thereon, and allowing the case then to stand a number of years before further action, will be considered an abandonment of the invention: a subsequent application for a patent for the same invention will be refused on the ground of such abandonment. *Dederick, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

8. If a party, upon a mistaken rejection of his claim by the Patent Office, withdraw his application, and receive the return fee of \$20, and acting under such mistake of his rights, occasioned by the error of the Patent Office, suffer

his invention to go into public use, even for several years, and afterward, upon discovering his mistake, apply for and obtain a patent, the withdrawal under such circumstances will not be an abandonment of his right; but the second application, by operation of law, relates back to the date of the first application, so as to cut off the forfeiture which otherwise would have happened by the long intermediate public use. *Hayden, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

9. Where an inventor made an application for a patent for his invention, through an attorney, to whom he gave power to withdraw such application, and the attorney, after a rejection of the application, withdrew such application; and afterward, about two years thereafter, the applicant made a second application for a patent for the same invention, which was rejected on the ground of abandonment, produced by the withdrawal of such first application, *Held*, that the applicant could not overcome such presumption of abandonment, and reinstate his case, on his affidavit that he did not know what authority he gave his attorney, and did not intend to withdraw such application, as such proceeding arose from carelessness. *O'Hara, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

10. A rejected applicant, who has withdrawn his application, may renew it, provided the renewed application is made in a *reasonable* time after withdrawal and return of the fee. *Simpson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

11. If the office has been in error, the *reasonable* time is to be computed, not from the date of the perfected invention, but from the date of the with-

drawal, so that the rejected application may be put, *as to time*, upon as good a footing as if the error had not been committed. But such an error does not give an unlimited license as to time.

*Ibid.*

12. § 7 of the act of 1839 fixes what is a reasonable time. There is no reason why a renewed application should have more than two years allowed it, computing the time from the date of the withdrawal. Both classes of applications, original and renewed, are applications for patents, and come within the letter and spirit of the statute.

*Ibid.*

13. But such renewed application must be made to the Patent Office within such time. Assertions of claim to third persons, or in other ways, will not be sufficient. No one can prevent the bar of limitation attaching by outside continuous claims; he must assert his rights in court, within the prescribed time. *Ibid*

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## ART.

See also EFFECT; PRINCIPLE; PROCESS.

1. A patent may be for a new and useful art; but it must be practical,—it must be applicable and referable to something which may prove it to be useful. *Evans v. Euton*, Pet. C. C., 341.—WASHINGTON, J.; Pa., 1816.

2. Where a patent was for an improvement in the art of making nails, by means of a machine, which cut and headed the nails by one operation, *Held*, that it was not merely a patent for the machine, and therefore that it was of no importance that the machine was composed of parts which had before

been used, but that the patent was for an improvement applied to a practical use, effected by a combination of various mechanical powers to produce a new result. *Gray v. James*, Pet. C. C., 400, 401.—WASHINGTON, J.; Pa., 1817.

3. Printing, by copper-plate or letter-press, on both sides of bank-notes, to prevent their counterfeiting, is an art for which a patent will be granted. *Kneass v. Schuylkill Bank*, 4 Wash., 12.—WASHINGTON, J.; Pa., 1820.

4. Under § 7 of the act of 1839 are embraced not only patents for machines, manufactures, and composition of matter, but also an invention of a new improvement in an art, as of casting iron, by giving an angular direction to the tube which conducts the metal to the mould, so that the flog or drop will be thrown into the centre, instead of the surface. *McClurgh v. Kingsland*, 1 How., 209, 210.—BALDWIN, J.; Sup. Ct., 1843.

5. 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*, 1 Fisher, 70, 71.—WOODBURY, J.; Mass., 1850.

6. There is no reason of policy which should deny protection to an art, while extending it to the machinery or processes which the art teaches, employs, and makes useful. *French v. Rogers*, 1 Fisher, 143.—GRIER, KANE, JJ.; Ea. Pa., 1851.

7. 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.

8. The application of a certain combination and composition of ruled columns in sections to accounts, to show a constant balance thereof, with statements of assets and liabilities on every page of the journal without reference to the ledger, is not an invention of an art, machine, manufacture, or composition of matter, within § 6 of the act of 1836; it is nothing more than a mode of presenting the journal entries of a regular business in a tabular form, and therefore not patentable. *Dixon, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

## ARTS, LOST.

1. It can hardly be doubted, if any one discovered an art which had been long lost, and it was a useful improvement, that upon a fair construction of the patent laws he would be entitled to a patent. *Gayler v. Wilder*, 10 How., 497.—TANEY, Ch. J.; Sup. Ct., 1850.

2. Though not literally the first and original inventor, he would be the first to confer on the public the benefit of the invention. He would discover what is unknown, and communicate knowledge which the public had not the means of obtaining without his invention. *Ibid.*, 497.

3. Upon this principle, where an invention—an iron and fireproof safe—had been invented and used by the in-

ventor for years, but no test had been applied to it, and its capacity for resisting heat was not known, and there was nothing to show that any particular value had been placed upon it, and the inventor never made a second one, but used a different one, and the safe itself had disappeared, it was held that it had passed away from the memory of the inventor himself, and of those who had seen it, and that the knowledge of the improvement was as completely lost as if it had never been discovered, and that a subsequent inventor of the same thing, without any knowledge of the former one, was entitled to a patent. *Ibid.*, 498.—(McLEAN, DANIEL, GRIER, J.J.; dissenting.)

4. The term lost art is applicable peculiarly to certain monuments of antiquity still remaining, the process of whose accomplishment has been lost for centuries, with all vestige of the archives or records of the nations with whom those arts existed, and the origin or even the identity of which process none can certainly establish. *Ibid.*, 508.—DANIEL, J.

5. If a means of producing the effect we see and have among us be discovered, and none can, either by history or tradition, refer to a similar or to the identical process, the inventor of that means may claim the merit of originality, though the work itself may have been produced possibly by the same means. *Ibid.*, 508.

## ARTICLE OF MANUFACTURE.

See MANUFACTURE.

## ASSIGNEE.

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### A. OF COPYRIGHT AND MANUSCRIPT.

1. There can be no doubt but that the rights of an assignee of a manuscript would be protected by a court of equity. *Wheaton v. Peters*, 8 Pet., 661.—McLEAN, J.; Sup. Ct., 1834.

2. An assignee of the exclusive right of acting and representing a drama in certain places, may maintain an action in his own name under the statute, even after a representation by him, for an injunction to prevent its being represented by another within such places. *Roberts v. Myers*, 13 Mo. Law Rep., 400, 401.—SPRAGUE, J.; Mass., 1860.

3. 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, 7 *post.*]

4. § 9 of the act of 1831, 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.

5. But this section—and which is the only one enabling a proprietor who de-

rives his title from such an author, to assert any right under the act—gives no redress for an unauthorized theatrical representation. *Ibid.*, 45.

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

7. The 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. The observance and performance of *all* the statutory requirements except the deposit of a *printed* copy, will give no right of action under the statute. *Ibid.*, 45, 46.

## B. OF PATENT.

### 1. *Who is, under the Statute.*

1. There are three classes of persons in whom a patentee can invest an interest in the patent. They are an *assignee*, a *grantee* of an exclusive sectional right, and a *licensee*. *Potter v. Holland*, 4 Blatchf., 211.—INGERSOLL, J.; NELSON, J., concurring; Ct., 1858.

2. An *assignee* is one who has transferred to him in writing the whole interest of the original patent, or any undivided part of such whole interest in every portion of the U. S.; and no one unless he has such an interest transferred to him is an assignee. *Ibid.*, 211.

3. A *grantee* is one who has transferred to him in writing the *exclusive* right under the patent, to make and use, and to grant to others to make and use, the thing patented within and throughout some specified portion or part of the

United States; and such right must be an *exclusive* sectional right, *excluding* the patentee therefrom. *Ibid.*, 211.

4. A *licensee* is one who has transferred to him in writing, or orally, a less or different interest than either the interest in the whole patent, or an undivided part of such whole interest, or an exclusive sectional interest. *Ib.*, 211.

5. The terms *assignee* and *grantee*, as used in the patent law, are not synonymous, but have the separate and distinct meanings above given. *Ib.*, 212.

### 2. *General Rights of.*

1. By § 11 of the act of 1836, a patentee may assign any part of his patent, and the assignment will vest in the assignee the legal right to such part. *Boyd v. McAlpine*, 3 McLean, 428.—McLEAN, J.; Ohio, 1844.

2. An assignee of an invention, takes by his assignment, only the right of the inventor and no more. *Tatham v. Loring*, 5 N. Y. Leg. Obs., 208.—STORY, J.; Mass., 1845.

3. Where, therefore, the inventors of a certain invention were aliens, but had assigned their invention to citizens of the United States, in whose names the patent was issued, and the invention had not been put on sale as required by § 15 of the act of 1836, *Held*, that the assignees had no title to the invention, because the invention had not been put on sale within eighteen months, and that the patent was also, for that reason, void. *Ibid.*, 209, 210. [Contra, *post* 4.]

4. Assignees of alien inventors, take and hold the patent, which may be issued to them, with all the privileges belonging to American patentees. The alien clause in § 15 of the act

of 1836, as to putting the invention on sale in a certain time, does not apply to such assignees and patentees. *Tatham v. Lowber*, 2 Blatchf., 50, 51.—NELSON, J.; N. Y., 1847.

5. But even if such condition attached, they need not prove that they have hawked the patented improvement to obtain a market for it, or that they have endeavored to sell it to any person. *Ibid.*, 51.

6. It rests upon those seeking to defeat the patent to prove that such patentees neglected or refused to sell for reasonable prices, when application was made to purchase. *Ibid.*, 51.

7. As between the right of a person holding a contract for an interest in a future term of a patent not yet *in esse*, and that of a subsequent *bona fide* purchaser, for a valuable consideration, and without notice, of the same interest, the latter must prevail. *Gibson v. Cooke*, 2 Blatchf., 150.—NELSON, J.; N. Y., 1850.

8. Where an assignment of a patent is made before application, and a patent is afterward obtained, such a contract will secure to the assignee the right thereby conveyed to him. *Rathbone v. Orr*, 5 McLean, 132.—MCLEAN, J.; Ohio, 1850.

9. If, after the assignment of a patent, the patent issue to the inventor, a new assignment is not necessary; the legal right to the monopoly and the property it created is vested by operation of the assignment in the assignee. *Gayler v. Wilder*, 10 How., 494.—TANEY, Ch. J.; Sup. Ct., 1850.

10. The purchaser of an exclusive privilege of *making* and *vending* a thing patented buys a portion of the franchise conferred by the patent. He obtains a share in the monopoly which

is derived from, and exercised under the protection of the United States, and the interest he acquires necessarily terminates at the time limited for its continuance by the law which created it. *Bloomer v. McQuewan*, 14 How., 549.—TANEY, Ch. J.; Sup. Ct., 1852.

11. But the purchaser of the thing for the purpose of *using* it in the ordinary pursuits of life stands on different ground. He exercises no right created by the acts of Congress, nor does he derive title by virtue of the franchise, or exclusive privilege granted to the patentee. *Ibid.*, 549.

12. An assignee of a contract, taking *perdente lite*, or with a knowledge of the state of things existing between the original parties to the contract, is bound by the same equities that existed between such parties. *Kinsman v. Parkhurst*, 18 How., 294.—CURTIS, J.; Sup. Ct., 1855.

13. An assignor cannot, after assignment, impeach the title of his assignee. *Wilson, Assignee, v. Singer*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

### 3. When Patent may issue to.

1. Previous to the act of 1837, § 6, patents could only issue to the inventor, and after they were issued, they were assignable so as to give the assignee, in whole or in part, his legal rights. That act gave the right to the assignee or assignees, to have the patent issued to him or them, and not to the inventor. *Anon.*, 4 Opin., 400.—MASON, Atty. Gen.; 1845.

2. An assignment of an invention before patent issued, is valid under § 6 of the act of 1837, although it is made after the rejection of the assignor's application by the Commissioner, and

after his appeal to the Chief Justice of the Circuit Court of the District of Columbia from such decision. *Gay v. Cornell*, 1 Blatchf., 509.—NELSON, J.; N. Y., 1849.

3. If an inventor assign all his right in an invention, the assignee may have the patent issued to himself. *Ager's Case*, MS., Opin.—BLACK, Atty. Gen.; 1859.

4. But if the assignment be only partial, though the part excepted is small, the assignee has no legal claim to the patent. It must be issued in the name of the inventor, and be held by him in trust for the use of the assignee, to the extent of the equities he has by virtue of his contract. *Ibid.*

#### 4. When may maintain Action.

1. Under § 5 of the act of 1793, an assignee of a part of a patent-right cannot maintain an action for a violation of it. *Tyler v. Tuel*, 6 Cra., 327.—CURIAM; Sup. Ct., 1810.

2. But if a patentee has sold a moiety of his invention to another, a joint action lies under such § 5 by himself and such assignee, for a violation of the patent. The action is brought by those who have the whole patent in themselves which distinguishes it from the case of *Tyler v. Tuel*. *Whittemore v. Cutter*, 1 Gallis., 430.—STORY, J.; Mass., 1813.

3. A patentee cannot maintain an action for an infringement after he has made an assignment of his invention; but the suit must be brought by the assignee. *Herbert v. Adams*, 4 Mas., 15.—STORY, J.; Mass., 1825.

4. And it will make no difference that the assignment was made before patent issued, and the patent afterward taken

out in the name of the inventor. *Ibid.*, 15.

5. Whether an assignee of part of a patent, circumscribed as to the interest by local limits, can, in his own name, or with the patentee, maintain a suit at law or not, there can exist no doubt but that he may support a suit in equity to enjoin third persons from infringing the patent, and for an account. *Ogle v. Ege*, 4 Wash., 584.—WASHINGTON, J.; Pa., 1826.

6. An assignee of a part interest, which is exclusive, in a patent, may, at law or in equity, maintain a suit for infringement, without joining the patentee. *Brooks v. Bicknell*, 3 McLean, 250.—MCLEAN, J.; Ohio, 1843.

7. The assignees of an exclusive right in a patent are the proper persons to maintain an action for a violation of such right. *Washburn v. Gould*, 3 Story, 131, 167.—STORY, J.; Mass., 1844.

8. The grantee of an exclusive right under a patent, though such right may be limited to the use of a certain number of machines within a certain territory or district, has such an exclusive right as will enable him to maintain an action for an infringement of the patent within that district, under § 14 of the act of 1836. *Wilson v. Rosseau*, 4 How., 686, 688.—NELSON, J.; Sup. Ct., 1845.

9. An exclusive right of action exists in favor of a sole assignee only in two cases, namely, where he acquires by assignment the whole interest in the patent, or a grant or conveyance of the whole interest within some particular district or territory. *Suydam v. Day*, 2 Blatchf., 23. NELSON, BETTS, JJ.; N. Y., 1846.

10. An assignee of an invention, by virtue of an assignment made before



patent issued, may file a bill in his own name, under § 10 of the act of 1839, amending § 16 of the act of 1836, against a patentee to whom a patent issued, upon the interfering application of his assignor and such patentee, for the purpose of annulling the patent issued, and having one granted to himself as assignee. *Gay v. Cornell*, 1 Blatchf., 507, 509.—NELSON, J.; N. Y., 1849.

11. And such assignment need not be recorded before suit brought; it will be sufficient if it is recorded at any time before the issuing of the patent. *Ibid.*, 510.

12. In an action of infringement, founded upon the non-performance of the conditions of a license, the original patentee and licensee are properly joined as parties plaintiff with the assignee, notwithstanding the whole beneficial interest is in the assignee, inasmuch as he was a party to the agreement or license, and may be interested in the patent and interested in upholding it.

*Woodworth v. Cook*, 2 Blatchf., 161.—NELSON, J.; N. Y., 1850.

13. An assignee under § 6 of the act of 1837, by an assignment executed before patent issued, even though the patent is issued to the inventor, has the legal title so as to enable him to maintain an action for an infringement. *Gayler v. Wilder*, 10 How., 494.—TANEY, Ch. J.; Sup. Ct., 1850.

14. But to enable an assignee of a sectional interest in a patent to sue in his own name, under § 14 of the act of 1836, he must have the exclusive right, or entire and unqualified monopoly, which the patentee held in the territory specified, excluding the patentee himself, as well as others. *Ibid.*, 494.

15. A patentee or his assignee, in assigning the use of a patent within a particular district, may reserve the

right to sue for infringements. But if he afterward assigns all his right in such district, the owner of the patent may sue. *Bicknell v. Todd*, 5 McLean, 240.—McLEAN, J.; Ohio, 1851.

16. The assignees of a patent, though their title accrues to them by several deeds, may all join with the holders of the title in an action for the recovery of damages for an infringement of a patent. *Stein v. Goddard*, 1 McAllis 84.—McALLISTER, J.; Cal., 1856.

#### 5. *Right of, as to Disclaimer.*

See DISCLAIMER, C.

#### 6. *Right of, in cases of Reissue.*

See REISSUE OF PATENT, E.

#### 7. *Right of, in Extensions.*

See EXTENSION, C.

### C. TRADE-MARKS. RIGHTS OF.

1. Where a person has purchased of another the secret of preparing an article, and also the right to use his name, and continued to manufacture and sell such article, under the name of the original manufacturer, whether, under such circumstances, a court of equity would be bound to protect him. *Partridge v. Menck*, How. App. Cas., 559, 560.—WRIGHT, J.; N. Y., 1848.

2. Is not such a proceeding a deception upon the public, inducing others to believe they are purchasing an article manufactured by the original manufacturer, when in truth he has no concern in it? *Ibid.*, 559, 560.

3. It is no answer that the complainant obtained the secret from the original manufacturer, or that the article

sold is in all respects equal to that offered by the former proprietor. *Ibid.*, 559.

4. The privilege of deceiving the public, even for its own benefit, is not a subject of commerce. *Ibid.*, 559.

5. The acquiescence of a manufacturer in the use or imitation of his trade-mark by another, may be withdrawn; it is no more than a revocable license. *Amoskeug Manuf. Co. v. Spear*, 2 Sand., S. C., 615.—DUEB, J.; Sup. Ct., N. Y., 1849.

6. The owner of goods, which he exposes to sale in market in his own right, is entitled to the exclusive use of any trade-mark devised and applied by him to the goods, to distinguish them as being of a particular manufacture or quality, although he is not himself the manufacturer, and although the name of the real manufacturer is used as a part of the trade-mark. *Walton v. Crawley*, 3 Blatchf., 448.—BETTS, J.; N. Y., 1856.

7. The assignee of the whole right in such trade-mark, and of the property in the goods to which it is attached, is entitled to the enjoyment of the exclusive right thereto, and may maintain an action in his own name for any wrongful use by others of such trade-mark, to the like extent as the originator thereof. *Ibid.* 448.

ASSIGNMENT.

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**A.** OF COPYRIGHT AND MANUSCRIPT.

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. Where the assignment of a copyright is a precedent performance, the assignment, which is to be made and tendered, must be in writing. *Ibid.*, 566.

3. Where A employed B to compile a school book, and agreed to pay him \$500, and B conveyed to A the "copyright," *Held*, that only the usual copyright of fourteen years, then existing or taken out, passed under the contract. *Pierpont v. Fowle*, 2 Wood. & Min., 42, 43.—WOODBURY, J.; Mass., 1846.

4. Such an assignment is to be referred to what was then in existence, and not to any future contingency. *Ibid.*, 43, 45.

5. A usage among booksellers to regard the renewed term as passing with the first one does not control the rights of those unacquainted with the usage, or not belonging to the fraternity of booksellers. *Ibid.*, 43.

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

7. 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.

8. 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.

9. The right of property in a manuscript may be transferred or abandoned, the same as any other right of property. *Bartlett v. Crittenden*, 5 McLean, 41.—MCLEAN, J.; Ohio, 1849.

10. An acquiescence in the publication of a manuscript or in the republication of a printed book, authorizes a presumption of assignment or abandonment. *Ibid.*, 41.

11. But a gift of a copy of a manuscript is not a transfer of the right or an abandonment of it, any more than the gift of a copy of a printed book is a transfer or abandonment of the exclusive right to republish it. *Ibid.*, 41.

12. The statute of 1834, sanctioning assignments of copyrights, 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.

13. There is no sufficient reason for preventing an author conveying a distinct portion of his right. Divisibility as well as assignability enhances the value of his property. *Ibid.*, 401. [But see *post* 15.]

14. In this case the assignment under which suit was brought was of the exclusive right of acting and representing a certain drama, within the United States, except as to five cities, for the term of one year, *Held*, by the court, that such an assignment was valid under the statute. *Ibid.*, 400, 401.

15. 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.

16. 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.

17. 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.

## B. OF INVENTION OR PATENT.

### 1. *What may be made; by whom; kinds of.*

1. A patent-right itself is insusceptible of local subdivision. *Whittemore v. Cutter*, 1 Gall., 431.—STORY, J.; Mass., 1813.

2. An assignment of an invention is not void by being executed before the invention is patented. It is a good transfer of the right of the patentee immediately upon his obtaining the patent, and he would be estopped to set up any adverse title. *Herbert v. Adams*, 4 Mas., 15.—STORY, J.; Mass., 1825.

3. As a privilege or monopoly, a patent is an entire thing, indivisible, and incapable of apportionment. *Brooks v. Byam*, 2 Story, 525, 552.—STORY, J.; Mass., 1843.

4. By § 11 of the act of 1836, a patentee may assign any part of his invention, and the assignment vests in the assignee the legal right to such part. *Boyd v*

*McAlpine*, 3 McLean, 428.—McLEAN, J.; Ohio, 1844.

5. An administrator, in whose name a patent has been renewed, may grant an assignment of an interest in such patent. *Brooks v. Bicknell*, 3 McLean, 441.—McLEAN, J.; Ohio, 1844.

6. An inventor may sell future improvements as well as those already made, and a second as well as a first patent for them. *Nesmith v. Calvert*, 1 Wood. & Min., 41.—WOODBURY, J.; Mass., 1845.

7. The subject matter of a patent is not partible, except in respect to territorial assignments. *Suydam v. Day*, 2 Blatchf., 23.—NELSON, BETTS, JJ.; N. Y., 1846.

8. An assignment of an invention before patent issued, is valid under § 6 of the act of 1837, though made after a rejection by the Commissioner, and after an appeal to the justices of the Circuit Court of the District of Columbia. *Gay v. Cornell*, 1 Blatchf., 509.—NELSON, J.; N. Y., 1849.

9. And an assignment of the whole or any part of the interest in a patent, will be valid, although it is at the time the subject of litigation. *Ibid.*, 510.

10. The act of Congress (§ 11, act of 1836), provides but three kinds of assignment: 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.

11. This statute renders the monopoly capable of subdivision as to locality, and in no other way. The patentee cannot carve out his monopoly, which is a unity, into a hundred or more, all acting in the same place, and liable to come into conflict. *Ibid.*, 340.

12. An interest in a grant of a future

term of a patent, not yet *in esse*, is not the subject of assignment or grant at common law, or within the meaning of § 11 of the act of 1836, and the right for such interest rests only in contract. *Gibson v. Cook*, 2 Blatchf., 149.—NELSON, J.; N. Y., 1850.

13. An invention may as well be sold before as after the application for a patent. *Rathbone v. Orr*, 5 McLean, 132.—McLEAN, J.; Mich., 1850.

14. The provision of the law requiring the application for a patent to be made in the name of the inventor, becomes necessarily a part of the contract—the inventor sells his right, and obligates himself to obtain a patent. *Ibid.*, 132.

15. Under the act of 1836, § 11, an assignment of a patent may be made as well before the issuing of the patent as afterward. 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.

16. Mere delay in actually making an assignment of a patent for some years after an agreement to sell, is not of itself evidence of fraud. *Troy Iron & Nail Fac. v. Corning*, 14 How., 209.—WAYNE, J.; Sup. Ct., 1852.

17. Whether a patented discovery is partible in its nature, so as to enable the patentee to make separate grants of the various particulars included in it; *query*. *Ritter v. Serrell*, 2 Blatchf., 383.—BETTS, J.; N. Y., 1852.

18. Congress cannot authorize an inventor to recall rights which he has granted to others; or reinvest him with rights of property which he had before

conveyed for a valuable consideration. *Bloomer v. McQuowan*, 17 How., 553.—TANEY, Ch. J.; Sup. Ct., 1852.

19. An assignment, though antecedent to the patent, is a valid legal assignment of the invention afterward patented in the name of the inventor. *Rich v. Lippincott*, 2 Fisher, 4.—GRIER, J.; Pa., 1853.

20. One tenant in common has as good right to make, use, and sell to third persons to use the thing patented, as the other tenant in common has. *Ibid. Clum v. Brewer*, 2 Curt., 524.—CURTIS, J.; Mass., 1855.

21. A paper purporting to be an assignment of an expired patent is void as an assignment. *Bell v. McCullough*, 1 Fisher, 381.—LEAVITT, J.; Ohio, 1858.

22. It is not to be presumed that a grantor intends to grant more than he has a right to grant, or that a grantee intends to receive by way of grant that to which he has a full right without a grant. *Day v. Cary*, 4 Blatchf., 277.—INGERSOLL, J.; N. Y., 1859.

23. A patent gives the patentee no power to parcel out his one monopoly into a thousand sub-monopolies. He may hold a close monopoly of his right, or he may grant out his entire right. But he cannot divide his right into parts, and grant to one man the right to use it in its connection with or application to one thing, and to another in connection with a different thing, to such an extent as that *purchasers* from any of these persons may not use the fabric purchased exactly as they like; and if they please, in violation of what he has supposed were rights not granted by him. *The Washing Machine Co. v. Earle*, 2 Fisher, 205.—GRIER, J.; Pa., 1861.

24. Goodyear, the patentee of vul-

canized india-rubber, might have prevented any person from using his fabric for any purpose. But if he grants to A the exclusive right to use it to make "wringers" only, and to B the right to make "tubes" only, A cannot restrain C, who has bought tubes, from converting them into wringers by any process whatever that he, C, pleases. Neither can Goodyear. *Ibid.*, 206.

## 2. Recording of.

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., 393.—CURIAM, J.; Mass., 1817.

2. An assignment of a patent, though not recorded in the office of the secretary of state, is still valid, except as against creditors and subsequent purchasers. *Holden v. Curtis*, 2 N. Hamp., 63.—WOODBURY, J.; N. H., 1819.

3. The exclusive right of property in an invention is the creature of statutory law, and must be strictly regulated by its provisions. *Higgins v. Strong*, 4 Blatchf., 183.—DEWEY, J.; Ind., 1836.

4. Under § 4 of the act of 1793, an assignment is not valid unless it has been recorded in the office of the secretary of state of the United States. *Ibid.*, 183.

5. And a note given to an assignee, whose assignment had not been so recorded, is without consideration and void. *Ibid.*, 183.

6. An assignment of a particular interest in a patent-right, or a conveyance of a right to use an invention within a limited territory, is not required to be recorded. *Stevens v. Head*, 9 Verm., 177.—WILLIAMS, Ch. J.; Vt., 1837.

7. Under § 4 of the act of 1793, until an assignment is recorded, the assignee

was not substituted to the rights and responsibilities of the patentee, so as to maintain any suit at law or in equity, founded thereon. *Wyeth v. Stone*, 1 Story, 296.—STORY, J.; Mass., 1840.

8. If the assignment of a patent-right be not recorded in the office of the secretary of state, a note given to the assignee for such right is invalid for the want of consideration. *McFall v. Wilson*, 6 Blachf. 260.—CURIAM, J.; Ind., 1842.

9. The statute (§ 11, act of 1836), requiring the recording of an assignment within three months, is merely *directory*, and, except as to intermediate *bona fide* purchasers, without notice, any subsequent recording of an assignment will be sufficient to pass the title to the assignee. *Brooks v. Byam*, 2 Story, 542.—STORY, J.; Mass., 1843.

10. Three cases only of the recording of assignments are provided for by the statute: 1st, an assignment of the whole patent; 2d, an assignment of an undivided part thereof; and 3d, a grant or conveyance of an exclusive right under the patent, within any specified part or portion of the United States. *Ibid.*, 542.

11. A grant of a right not being exclusive, need not to be recorded. *Ibid.*, 542.

12. The provision of the statute (§ 11 act of 1836), as to the recording of assignments within three months, is merely directory, for the protection of *bona fide* purchasers, without notice, and is not a prerequisite indispensable to the validity of the assignment. *Pitts v. Whitman*, 2 Story, 615, 618.—STORY, J.; Me., 1843.

13. And it is immaterial whether the assignment is recorded before or not till after suit is brought. It is like the

common case of a deed required to be registered, where it is sufficient if it be registered before the trial, though after the suit is brought. *Ibid.*, 618.

14. The act of 1836 affixes no penalty or condition, on a failure to have an assignment recorded in three months. The assignment takes effect from its date; but if not recorded within three months, the act imposes no forfeiture. *Boyd v. McAlpine*, 3 McLean, 429.—MCLEAN, J.; Ohio, 1844.

15. But after the expiration of three months, if no record has been made of the assignment, and another assignment of the same right is made, the last assignment would be valid, and whether he had or had not notice of the previous assignment. *Ibid.*, 429.

16. The act prescribing the time for recording of assignments is only directory. The recording is not necessary to make the transfer operative, but is only essential to enable the assignee to sue in his own name. *Blanchard's Gun-Stock Turn. Co. v. Warner*, 1 Blachf., 271.—NELSON, J.; Ct., 1846.

17. A patent may be assigned in whole or in part, and such assignments are required to be recorded. *Parker v. Haworth*, 4 McLean, 371.—MCLEAN, J.; Ill., 1848.

18. The failure to record an assignment of a patent is not essential to its validity as between the parties, and against strangers. *Case v. Redfield*, 4 McLean, 527.—HUNTINGTON, J.; Ind., 1849.

19. The recording of an assignment is only necessary by way of notice to purchasers. *Ibid.*, 527.

20. The recording of an assignment of a patent-right, under § 11 of the act of 1836, is no constituent part of the conveyance, and is required only to give

notice. *Peck v. Bacon*, 18 Conn., 388.—ELLSWORTH, J.; Ct., 1847.

21. Where A assigned to B certain parts of a patent-right, stipulating they were free from incumbrance, and it appeared that before the assignment of B was recorded, the same interest had been assigned to others, of which A had actual notice, but such assignment was not recorded until after B's, *Held*, that such notice precluded A from availing himself of such want of recording as a defence against an action by B for fraud in the assignment to him. *Ibid.*, 384, 388.

22. An assignment of an invention before patent issued, made under the provisions of § 6 of the act of 1837, need not be recorded before bill filed under § 16 of the act of 1836, and § 10 of the act of 1837, to set aside or annul a patent granted to another upon an interference with the application of such assignor; it is sufficient if it be recorded at any time before the issuing of the patent. *Gay v. Cornell*, 1 Blatchf., 510.—NELSON, J.; N. Y., 1849.

23. The act of Congress requiring assignments to be recorded is merely directory; and except as to intermediate *bona fide* purchasers without notice, any subsequent recording of such assignments is sufficient to pass the title to the assignee. *Olcott v. Hawkins*, 2 Amer. Law Jour., N. S., 319.—MILLER, J.; Wis., 1849.

24. By § 11 of the act of 1836, the assignment or grant of an exclusive right in a patent must not only be in writing, but must be recorded within three months, to defeat the right of a subsequent purchaser without notice and for a valuable consideration. *Gibson v. Cook*, 2 Blatchf., 148.—NELSON, J.; N. Y., 1850.

25. 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 as best he can, as an *unrecorded* assignment would prevail; but it must be an assignment in writing, that *may* be recorded within the time limited. *Ibid.*, 148.

26. The chief object of the requiring assignments to be recorded is manifestly the protection of *bona fide* purchasers, though not specially so declared. *Ibid.*, 148.

27. The patent act of 1836, as to the recording of assignments, is merely directory for the protection of *bona fide* purchasers without notice, and the recording is not a prerequisite to the validity of the assignment. *Louden v. Birt*, 4 Ind., 568.—PERKINS, J.; Ind., 1853.

28. To render the assignment of a patent valid under § 11 of the act of 1836, it is not essential that it should be recorded. *McKernan v. Hite*, 6 Ind., 430.—GOOKINS, J.; Ind., 1855.

29. The act of Congress requiring assignments of patents to be recorded is merely directory, and designed for the benefit of subsequent *bona fide* purchasers. *Hildreth v. Turner*, 17 Ill., 185.—CATRON, J.; Ill., 1855.

30. It is not essential to the validity of an assignment of a patent that it should be recorded in the Patent Office. *Sone v. Palmer*, 28 Mo. (7 Jones), 539.———, J.; Mo., 1859.

### 3. *What amounts to; Construction of.*

1. A variance, merely nominal, or not calculated to mislead—between the description of a patent in the specification, and in an assignment, does not indicate fraud, or prevent the right from

passing. *Case v. Morey*, 1 N. Hamp., 349.—WOODBURY, J.; N. H., 1818.

2. Mere circumstantial differences between the description in the patent and that contained in an assignment, will not render the assignment invalid. *Holden v. Curtis*, 2 N. Hamp., 63.—WOODBURY, J.; N. H., 1819.

3. The deed of assignment conveyed "a new and useful improvement called a *threshing machine*," when the patent was for an "improvement in the threshing machine." The assignment also gave the date of the patent and the patentee. *Held*, that the misnomer of the invention in the assignment did not render it void, as the deed furnished sufficient means to correct the mistake, and identify the thing conveyed. *Harmon v. Bird*, 22 Wend., 115.—BRONSON, J.; N. Y., 1839.

4. But if otherwise, the deed was not a nullity—it might be reformed in equity. *Ibid.*, 115.

5. An assignment may be exclusive, though limited to a certain number of machines. *Washburn v. Gould*, 3 Story, 131, 167.—STORY, J.; Mass., 1844.

6. The term *exclusive*, in § 11 of the act of 1836, comprehends not only an exclusive right to a whole patent, but an exclusive right to the patent in a particular section of country. *Ibid.*, 131.

7. In interpreting an assignment, we must look to all the provisions of the instrument, and give such effect to it as its obvious objects and designs require, without nicely weighing the precise force of single words. *Ibid.*, 162.

8. The words "license and empower," need not import any thing different from "grant." In their broad and general sense they are used indiscriminately. A mere "license," strictly

speaking, passes no interest, but only makes an action lawful, which, without it would have been unlawful; but if the instrument passes an interest then it becomes a "grant." *Ibid.*, 162.

9. Where a grant to license and empower parties to construct and use fifty patented machines within certain territory, with a covenant that the patentee would not license any other persons to use any such machines in such territory for a given period, and reserving, however, the right to the patentee to construct and license such machines elsewhere, *Held*, that the grant was of an exclusive right under the patent. *Ibid.*, 160, 161, 166.

10. The limitation of the number of machines, to be made or used under a patent, is not inconsistent with the grant of an exclusive right in the patent, within such territory. *Ibid.*, 167, 168.

11. A surrender of letters patent renders void all assignments under such patent, so far as those are concerned who assent to such surrender. *Gibson v. Richards*, Index Pat. Dec., No. 376.—NELSON, J.; N. Y., 1845.

12. An assignment of an exclusive right to make, use, and vend to others, a patented machine within a certain territory only, does not prohibit the assignee from selling elsewhere, out of the said territory, the products of such machines. *Simpson v. Wilson*, 4 How., 711.—NELSON, J.; Sup. Ct., 1845.

13. The restriction in the assignment applies solely to the using of the machine, and is no restriction as to place, of the sale of the product. *Ibid.*, 711.

14. An assignment of all interest in a patent is a dissolution of a partnership for working it. *Parkhurst v. Kinsman*, 1 Blatchf., 498.—NELSON, J.; N. Y., 1849.



15. Where a patentee granted to V. the exclusive right to construct and use and vend within a certain territory, ten *planing, tongueing, and grooving* machines, and the grant declared that V. was to enjoy an exclusive use of the patent within said territory, limited to said ten machines; and afterward the patentee granted to K. the exclusive right under the patent of making, using, and vending, within the same territory, *moulding and planing machines*, Held, that the grant first made to V. conveyed the entire interest of the patentee, and that the subsequent grant to K. was void. *Ritter v. Serrell*, 2 Blatchf., 381, 382.—BETTS, J.; N. Y., 1852.

16. An assignment of an interest in a patent, but reserving to the grantor the whole and sole power of disposal, conveys no legal title, but the assignee is only a *cestui que trust*, to the extent of his interest, in the profits. *Goodyear v. Day*, MS.—GRIER, DICKERSON, JJ.; N. J., 1852.

17. An agreement made by the owner of a patent, securing to the grantee the exclusive right to make, use, and sell to others to be used, the machine patented within a certain territory, but reserving to the grantor the right to sell within such territory, machines of his own manufacture, does not operate as an assignment or transfer to the grantee of the right and title secured by the patent within such territory. It is an agreement in the nature of a license to manufacture and sell, but more than a mere technical license. It is a fixed contract right, vested in the grantee, and assignable by him. *Pitts v. Jameson*, 15 Barb., S. C., 315.—JOHNSON, J.; N. Y., 1853.

18. Where an agreement was entered into between a patentee and another

person, that in case of an extension of the patent such person should have and be entitled to an equal undivided one-fourth part of the rights and benefits that should be secured thereby, on paying a proportional part of the expenses of obtaining such extension; *query*, whether the terms of such an agreement are not words of grant and conveyance, and whether such an agreement would not be a sufficient assignment of the interest, if the condition was performed. *Pitts v. Hall*, 3 Blatchf., 204.—HALL, J.; N. Y., 1854.

19. But the offer to pay the proportional part of such expenses will not vest in such person the interest in such extension, although it may entitle him to bring his action and recover damages for the non-performance of the agreement. *Ibid.* 205.

20. If a bill of sale of a patent contains no warranty, but a simple transfer of title, the vendee cannot set up a parol warranty, for it is to be presumed that the writing contains the entire contract. *Jolliffe v. Collins*, 21 Mo., 341.—SCOTT, J.; Mo., 1855.

21. Where an assignment is in writing, the presumption is that the writing contains the whole contract. All oral negotiations or stipulations between the parties which preceded or accompanied the execution of the instrument, are to be regarded as merged in it. *McClure v. Jeffrey*, 8 Ind., 83.—DAVISON, J.; Ind., 1856.

22. Where a warranty is not included in the written contract, it cannot be proved by parol evidence, unless it is also alleged that it was false or fraudulent, and that thereby the vendee was deceived; and then parol proof is only evidence of such representation. *Ibid.*, 83.

23. An agreement made between a patentee and a third person as trustee, that the latter should hold the patent, and have the control thereof for the benefit of those who had a right to use the same, under contracts with the patentee, transfers the entire interest and ownership, legal and equitable, of the patentee in the patent, to such trustee, for the benefit of those interested. *Hartshorn v. Day*, 19 How., 221.—NELSON, J.; Sup. Ct., 1856.

24. The conveyance of a patent by A with the written consent of B, in whom the title then was, is equally effective with a conveyance directly from B. *Sherman v. Champ. Trans. Co.*, 31 Verm., 175.—REDFIELD, J.; Vt., 1858.

25. A paper purporting to be an assignment of an expired patent is void as an assignment. *Bell v. McCullough*, 1 Fisher, 381.—LEAVITT, J.; Ohio, 1858.

26. An assignment of a patent described the improvement as "a patent for an improvement in burning lime, for which letters patent were granted, May 6, 1851." *Held*, that it was a sufficient description of the thing sold, and that the deed need not contain the specifications of the patent. If the purchaser wanted a copy of the specifications, he could get them. *Hill v. Thuermer*, 13 Ind., 351, 352.—PERKINS, J.; Ind., 1859.

27. Where a patentee granted to another the exclusive right to make and sell his patented invention, within a certain territory, he to pay a certain sum for each machine so made and sold, but the patentee reserved the right of sending machines of his own manufacture into such territory, *Held*, that such contract was not an assignment of the patentee's interest in the patent in such

territory, but a mere grant or license to make and sell the article therein. *Hussey v. Whiteley*, 2 Fisher, 123.—LEAVITT, J.; Ohio, 1861.

### C. OF PATENT OR COPYRIGHT, BY OPERATION OF LAW.

1. The recovery of a verdict by the plaintiff, in an action for the infringement of a patent, does not pass any legal right to the defendant to use the machine made by him. Every future use will be an infringement of the plaintiff's patent. *Whittemore v. Cutter*, 1 Gall., 484.—STORY, J.; Mass., 1813.

2. The levy and sale, under an execution, of the *materials* of a patented machine does not convey to the purchaser any right to use the machine in the manner pointed out in the patent. *Sawin v. Guild*, 1 Gall., 487.—STORY, J.; Mass., 1813.

3. The capture from an enemy of a patented machine does not operate as an assignment of a right to use such machine. *Lamb's Case*, 5 Opin., 725.—WIRT, Atty. Gen., 1820.

4. L., an American citizen, obtained a patent in the United States for an invention for producing fresh water from salt. He afterward went to England, and took out a patent there, and one of his machines was put on board the frigate *Boxer*, which was captured by an American brig in the war of 1812, *Held*, that the United States by such capture acquired no right to use the invention, without the consent of the inventor. *Ibid.*

5. Whether a verdict for a plaintiff, and the assessment of damages for a violation of his patent, entitles the de-

fendant to use the machine subsequently, or transfers to him the right to use it; *query*. *Earle v. Sawyer*, 4 Mas., 13.—STORY, J.; Mass., 1825.

6. Such a construction of the law would enable any person to acquire that right, by a forced sale, against the patentee, and compel him to sell, as to persons and places, when it might interfere essentially with his permanent interest; the very attempt of the patentee to enforce his exclusive privilege would involve the necessity of parting with it. *Ibid.*, 13.

7. The court cannot force the defendant to purchase, any more than it can the plaintiff to sell, the patent-right, for the whole period it has to run. *Ibid.*, 14.

8. But where a declaration goes for a user during a limited period, and afterward the party sues for a user during a subsequent period, it seems that a verdict and judgment in the former case would not be a legal bar to a recovery in the second action. The piracy is not the same, nor is the gravamen the same. *Ibid.*, 14.

9. An author who has obtained a copyright under the act of Congress cannot be deprived, against his will, and in favor of his creditors, of any of the rights secured to him by such acts; and possibly they cannot, against his will, seize and sell the books themselves, the exclusive right of vending which is vested in him. *Cooper v. Gunn*, 4 B. Mon. 596.—MARSHALL, J.; Ky., 1844.

10. But this protection does not extend to the proceeds of the sale of his copyright, whether existing in his own hands, or held by another for his use. *Ibid.*, 596.

11. A patented machine, and the right of use attached to it, may pass by

sale, devise, or levy of execution, or assignment of an insolvent's effects. *Woodworth v. Curtis*, 2 Wood. & Min., 530.—WOODBURY, J.; Mass., 1847.

12. The property acquired by the sale of an engraved plate or stereotype plates, and the copyright of a map, or book secured to the author under the acts of Congress, are altogether different and independent of each other, and have no necessary connection. *Stephens v. Cady*, 14 How., 530.—NELSON, J.; Sup. Ct., 1852.

13. The incorporeal right—copyright—secured by the statute to the author, being intangible and secured by grant, is not the subject of seizure or sale by execution—at least at common law. But it may be reached by a creditor's bill, and be applied to the payment of the debts of the author. *Ibid.*, 531.

14. It may, however, be doubted whether a transfer by a sale under a decree of court, would pass the title so as to protect the purchaser, unless by a conveyance in conformity with the requirements of the statute. *Ibid.*, 532.

15. The sale of a copper-plate of a map, on an execution against the owner of the copyright, does not carry with it or pass to the purchaser the right to print and publish the map engraved upon it. *Ibid.*, 532.

16. It may well be doubted whether patents and copyrights, held under the laws of the United States are subject to seizure and sale on execution; such incorporeal rights do not exist in any particular state or district, but are co-extensive with the United States. *Stevens v. Gladding*, 17 How., 451.—CURTIS, J.; Sup. Ct., 1854.

17. The mere ownership of a copper-plate of a map, by the owner of the

## COMMENCEMENT OF SUITS BY.

copyright, does not attach to the plate the exclusive right of printing and publishing the map, or any part thereof, held under the act of Congress; but the incorporeal right subsists wholly independent of and separate from the plate, and does not pass with it by a sale of such plate or execution. *Ibid.*, 453.

18. In an action for the infringement of a patent, if the jury adopt as the measure of damages the price of the patent fee, proved in the case, such verdict will operate to vest the title of the patent, to the extent of its use by the defendant complained of, throughout its term. *Sickles v. Borden*, 3 Blatchf., 545.—NELSON, J.; N. Y., 1856.

## ATTACHMENTS IN PATENT CASES.

### A. COMMENCEMENT OF SUITS BY.

1. The right to attach property to compel the appearance of persons can properly be used only in cases in which such persons are amenable to process *in personam*, and in such case also, such an attachment cannot be issued except as part of, or together with process to be served upon his person. *Day v. Newark I. R. Co.*, 1 Blatchf., 630, 631.—NELSON, J.; N. Y., 1850.

2. The attachment of the property of a foreign corporation will not confer jurisdiction upon the Circuit Court as against such corporation. *Ibid.*, 633.

3. Where a corporation was created by the laws of New Jersey, and had its place of business in that state, but also had a store in New York, where its goods were sold, and a suit was commenced against it in New York by attach-

ment of its goods, and by service of process on its president, who happened to be in New York, *Held*, that the corporation was not an inhabitant of New York, or found within it at the time of the service of the process, and that the court had no jurisdiction of the action. *Ibid.*, 633.

4. A process of attachment, whether direct or foreign, by which the property of a defendant is attached by virtue of state laws, cannot give the Circuit Court jurisdiction over a person not an inhabitant of, and not found within the district. *Saddler v. Hudson*, 2 Curt., 7.—CURTIS, J.; Me., 1854.

5. Process of attachment against the property of a non-resident defendant cannot issue from a Circuit Court, except as part of, or together with process to be served on his person; and no judgment can be rendered against a non-resident defendant who has not been personally served with process, unless he has entered an appearance. *Ibid.*, 7.

6. The attachment of the property of a non-resident defendant cannot confer jurisdiction upon the Circuit Courts of the United States; jurisdiction can only be acquired by service of process upon the defendant personally within the district, if a non-resident. *Chaffee v. Hayward*, 20 How., 215, 216.—CATRON, J.; Sup. Ct., 1857.

### B. TO ENFORCE OBEDIENCE TO PROCESS, &c.

1. Where a plaintiff in an injunction suit endeavored to entrap the defendant into a violation of an injunction, *Held*, that the proceeding on the part of plaintiff would not, either in conscience or law, justify an attachment, and that

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the plaintiff should be charged with the costs of the application. *Sparkman v. Higgins*, 2 Blatchf., 30, 31.—BERTS, J.; N. Y., 1846.

2. Where an injunction was issued against a defendant, restraining him from using a certain machine, and afterward such defendant leased the machine to others, who continued to use, but it had never been in the legal possession of such defendant since he was enjoined, *Held*, on a motion for an attachment, that the defendant could not be regarded as in contempt, and that an attachment would not issue. *Sloat v. Patten*, 6 Penn. Law Jour., 189, 190.—KANE, J.; Pa., 1846.

3. Where an order granting an injunction was made, and the writ of injunction issued thereon was not tested till more than six weeks after, and was not served till within a few days of one year after the day of its test, *Held*, that a disobedience of the writ would not be punishable by attachment. *McCormick v. Jerome*, 3 Blatchf., 487.—BERTS, J.; N. Y., 1856.

4. In order to warrant an attachment for a breach of an injunction the party to be proceeded against must be a party to the suit, and have had notice of the application for the injunction. *Sickles v. Borden*, 4 Blatchf., 18.—HALL, J.; N. Y., 1857.

5. On a motion for an attachment for a violation of an injunction the objection cannot be taken, that the injunction is broader than the order authorizing it; if the injunction served is too broad, the defendants, when served with it, should immediately take means to set it aside for that reason. *Ibid.*, 20.

6. An attachment for a violation of an injunction may issue against the agent and acting officer of the defend-

ant, a foreign corporation, and he is not exempted therefrom on the ground that he is a mere servant of the defendant. *Ibid.*, 20.

7. Where the violation of the injunction was the use of the thing patented on a steamboat, *Held*, that the engineer was properly made a party to the proceeding, and that an attachment would issue against him. *Ibid.*, 21.

8. To warrant an attachment for a violation of an injunction, the service of the writs should not be left in doubt. Where the plaintiff gave evidence of the service of the writs, but the party proceeded against swore positively that he had never been served with any such writs, but only with a copy of the order of the court granting an injunction, *Held*, that there was so much uncertainty as to service, that the writ of attachment should not be granted. *Whipple v. Hutchinson*, 4 Blatchf., 191.—NELSON, J.; N. Y., 1858.

9. Where the use complained of was under an agreement with the patentee, made subsequent to the allowance of the injunction, an attachment should not issue. *Ibid.*, 192.

10. An attachment as for a contempt, for disobeying an injunction, issued after verdict, to restrain a defendant from infringing the plaintiff's patent, will not be granted, unless the alleged violation is a use of that actually patented to the plaintiff, or its evident equivalent; the injunction issued can only be as broad as the patent. *Poppenhausen v. N. Y. G. P. Comb Co.*, 4 Blatchf., 254.—INGERSOLL, J.; N. Y., 1859.

11. Where, therefore, the plaintiff's patent was for the use of *tin foil* or its *equivalent*, in the vulcanization of india-rubber and other gums, and an injunction issued against the defendants to

restrain their infringing such patent, and they afterward used *sheets of brass and tin* in a similar way to that in which *tin foil* was used by plaintiff's patent, *Held*, on a motion for an attachment for violating the injunction, that such plates, though somewhat flexible, could not be considered an equivalent for tin foil, and that the attachment must be denied. *Ibid.*, 255.

### C. PRACTICE IN CASES OF.

1. The proper mode of proof, on issues made under interrogations filed on an attachment for a contempt in not obeying an injunction, is by testimony taken orally before a master. *Parkhurst v. Kinsman*, 2 Blatchf., 77.—BETTS, J.; N. Y., 1848.

2. A plaintiff, in moving for an attachment against a defendant in such a case, must state, in the proofs on which the application is founded, the specific acts of omission or commission on the part of the defendant which constitute the alleged contempt. *Ibid.*, 77.

3. Where, in such a proceeding, the defendant is ordered to answer interrogatories to be filed, such interrogatories must be limited to the particular offences so alleged against him; and it is not competent for the plaintiff to inquire in regard to matters not charged specifically against the defendant in the proofs furnished on the application for the attachment. *Ibid.*, 78.

4. Nor can the plaintiff require the defendant to answer as to particulars charged on the information and belief of the plaintiff or others, and not established by direct evidence. *Ibid.*, 78.

5. Interrogatories unauthorized by law are demurrable, and the defendant is exonerated from answering them;

and as to such the defendant will be entitled to costs on the demurrers—but the enforcement of such costs will be stayed until the matters at issue on any interrogatories answered shall be disposed of. *Ibid.*, 78.

6. On a motion for an attachment, affidavits that the patentee is not the first and original inventor of the thing patented, are not admissible, as that question, so far as the injunction is concerned, is settled when the writ was granted. *Whipple v. Hutchinson*, 4 Blatchf., 192.—NELSON, J.; N. Y., 1858.

### AUTHOR.

See also CHARTS, &c.; COPYRIGHT, C.

1. If a musical composition is borrowed from a former one, or is made up of different parts copied from older compositions without material change, and put together into one tune, with only slight alterations or additions, the person so combining is not an author within the meaning of the statute. *Reed v. Carusi*, 8 Law Rep., O. S., 411.—TANEY, Ch. J.; Md., 1845.

2. It is for the jury to decide upon the whole evidence whether a plaintiff is or is not the author of the thing copyrighted by him. *Ibid.*, 411.

3. A copyright is *prima facie* evidence that the person taking it is the author, and the burden of proof is on the defendant to show the contrary. *Ibid.*, 412.

4. To constitute one an author, he must by his own intellectual labor applied to the materials of his composi-

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tion, produce an arrangement or compilation new in itself. *Atwill v. Ferrert*, 2 Blatchf., 46.—BETTS, J.; N. Y., 1846.

5. He may compile or arrange a new production from materials before known, or obtained by others for him, but cannot appropriate by copyright those materials in the state in which they are furnished. *Ibid.*, 46.

6. An author may be said to be the creator or inventor, both of the ideas contained in his book, and the combination of words to represent them. *Stowe v. Thomas*, 2 Amer. Law Reg., 228.—GRIER, J.; Pa., 1853.

7. An author and his assigns are included in the meaning of the general phrase, *literary proprietor*. *Keene v. Wheatley*, 9 Amer. Law Reg., 61.—CADWALLADER, J.; Pa., 1860.

8. An author who has obtained a copyright under the statute, cannot be deprived against his will, and in favor of his creditors, of any of the rights secured to him; possibly they cannot, against his will, seize and sell the books themselves, the exclusive right of vending which is vested in him. *Cooper v. Gunn*, 4 B. Mon., 596.—MARSHALL, J.; Ky., 1844.

9. The incorporeal right—copyright—being intangible and secured by grant, is not the subject of seizure and sale on execution; but it may be reached by creditor's bill, and be applied to the debts of the author. *Stephens v. Cady*, 14 How., 531.—NELSON, J.; Sup. Ct., 1852.

10. It may well be doubted whether patents and copyrights held under the laws of the United States are subject to seizure and sale on execution; such incorporeal rights do not exist in any particular state or district, but are co-

extensive with the United States. *Stephens v. Gladding*, 17 How., 451.—CURTIS, J.; Sup. Ct., 1854.

11. A person who hires another to write a book, and gives him the description and scope of the work, is not the author. The literary man who writes the book and prepares it for publication is the author, and the copyright is intended to protect him, and not the person who employed him. *De Witt v. Brooks*, MS.—NELSON, J.; N. Y., 1861.

12. Where the incidents and events of a person's life were furnished by such person to another, who prepared them for publication, and the copyright was taken out in the name of the person so furnishing such facts, *Held*, that he was not the author, and that a party claiming as his assignee could not maintain an action for infringement. *Ibid.*

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## BILL IN EQUITY.

See EQUITY; B. 2, 3.

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## BILLS OF EXCEPTIONS, IN PATENT CASES.

1. The practice of spreading *in extenso* the judge's charge upon the record, is unnecessary and inconvenient. The substance only of the charge is to be examined; and if it appears upon the whole, that the law was justly expounded to the jury, general expressions, which might need qualification, if they were the direct point in judgment, are

to be understood in such restricted sense. *Evans v. Eaton*, 7 Wheat., 427. STORY, J.; Sup. Ct., 1822.

2. Where no exception is taken to the competency or sufficiency of the evidence, it is not properly before the Court, and the putting it on the record is an expensive and unnecessary burden. *Pennock v. Dialogue*, 2 Pet., 14, 15.—STORY, J.; Sup. Ct., 1829.

3. Where the charge of the court presented only a general principle of law, and the application of the evidence to it was left to the jury, it is not necessary in a bill of exceptions, to put any part of the evidence upon the record.—*Ibid.*, 15.

4. Exceptions taken to a judge's charge to a jury, should not be to the charge at length, but to the points ruled by the court. *Stimpson v. West Chester R. R. Co.*, 4 How., 401.—MCLEAN, J.; Sup. Ct., 1845.

5. Where prayers for instructions to the jury are not complied with by the court, they are to be considered as refused. *Emerson v. Hogg*, 2 Blatchf., 7.—BETTS, J.; N. Y., 1845.

6. Exceptions lie to the refusals of the court to give instructions when requested, in like manner as to the instructions actually given. *Ibid.*, 7.

7. Exceptions to the charge of the judge, not taken at the trial, cannot be taken afterward. The point should have been brought to the notice of the court when the mistake, if any, could have been corrected. *Ibid.*, 13.

8. A bill of exceptions, under § 17 of the act of 1836, in order to take a cause to the Supreme Court, where the amount in issue does not exceed the sum of \$2,000, and "in cases where the court shall deem it reasonable," should not be allowed, unless the exceptions relate to constructions of the patent laws,

and involve important and not trifling matters connected with these laws, and questions really doubtful. *Allen v. Blunt*, 2 Wood. & Min., 157.—WOODBURY, J.; Mass., 1846.

9. Points must be made and the exceptions taken in the usual way at the trial, in order to entitle the party to the benefit of them on writ of error. *Footte v. Silsby*, 1 Blatchf., 544.—NELSON, J.; N. Y., 1850.

10. Where, at the trial, the points and exceptions were taken in the required form to entitle the party to the benefit of them on a writ of error, but no bill of exceptions was settled in form, but the paper book was made up under the direction of the judge at the trial, in the form of a case, to move for a new trial, but without prejudice to the right of the party to make a bill of exceptions, *Held*, that an order in the case, afterward made by the judge, or an allowance of a writ of error, giving leave to make a bill of exceptions, was proper. *Ibid.*, 544.

11. A judgment will not be opened to enable the plaintiff in error to amend the bill of exceptions. After judgment has been pronounced, it is too late to assert that the statements contained in the bill of exceptions were imperfect or erroneous, or to make a new case by the introduction of new evidence, and a new exception. *Gayler v. Wilder*, 10 How., 510.—TANEY, Ch. J.; Sup. Ct., 1850.

12. It must appear by the transcript or record, that an exception to instructions was taken while the jury were at the bar, or error cannot be assigned thereon. *Phelps v. Mayer*, 15 H., 161.—TANEY, Ch. J.; Sup. Ct., 1852.

13. An objection not taken in the court below, cannot be taken before the Supreme Court on appeal. *Kinsman*



v. *Parkhurst*, 18 How., 295.—CURTIS, J.; Sup. Ct., 1855.

14. In considering the questions raised in the court below, the Supreme Court is confined to the evidence reported in the bill of exceptions; it cannot be known in the appellate court whether the report of the evidence may or may not be incomplete or imperfectly stated. Bills of exception, when properly taken, and duly allowed, become a part of the record, and as such cannot be contradicted. *Chaffee v. Bos. Belt Co.*, 22 How., 222.—CLIFFORD, J.; Sup. Ct., 1859.

### BOOK, AND COPY OF.

1. A book within the statute need not be a book in the ordinary and common acceptation of the word, viz.: a volume made up of many sheets bound together; it may be printed only on one sheet, as the words of a song, or the music accompanying it. *Clayton v. Stone*, 2 Paine, 383.—THOMPSON, J.; N. Y., 1828.

2. The literary property intended to be protected by the act is not determined by the size, form, or shape in which it makes its appearance, but by the subject matter of the work. *Ibid.*, 386, 387.

3. The preliminary steps required by law to secure a copyright cannot be reasonably applied to a work of so ephemeral a character as that of a newspaper. *Ibid.*, 392.

4. It cannot reasonably be presumed that Congress intended to include newspapers under the term book. *Ibid.*, 393.

5. A label, used in the sale of any article is not a book within the provisions of the statute respecting copy-

rights. *Coffeen v. Brunton*, 4 McLean, 517.—MCLEAN, J.; Ind, 1849.

6. A *book* necessarily conveys the idea of thought or conceptions clothed in language, or in characters written, printed or published. Its identity does not consist merely in the ideas, knowledge, or information communicated, but in the same conceptions clothed in the same words, which make it the same composition. *Stowe v. Thomas*, 2 Amer. Law Reg., 229.—GRIER, J.; Pa., 1853.

7. A *copy* of a book must be a transcript of the *language* in which the conceptions of the author are clothed. The same conceptions clothed in another language cannot constitute the same composition; nor can it be called a transcript or "*copy*" of the same "*book*." *Ibid.*, 229.

8. A book, within the meaning of the statute, does not include a translation of a work. *Ibid.*, 230.

9. After publication of a book, those only can be called infringers of the author's rights, or pirates of his property, who are guilty of printing, publishing, importing, or vending without his license, "*copies* of his *book*." *Ibid.*, 231.

10. 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.

11. The words, "a copy of a book," found in § 6 of the act of 1831, import a transcript or copy of the entire book. *Rogers v. Jewett*, 12 Mo. Law Rep., 340.—CURTIS, J.; Mass., 1858.

12. A book may exist without printing; and such book when made or composed is entitled to copyright. *Roberts v. Myers*, 13 Mo. Law Rep., 399.—SPRAGUE, J.; Mass., 1860.

## PURPOSE AND EFFECT OF CAVEAT.

13. Any composition, large or small, which includes results of successive mental processes, rationally combined, whether it fill a great volume, or be contained in a single small sheet, is within the legal denomination of a book. *Keene v. Wheatley*, 9 Amer. Law Reg., 68, 69.—CADWALLADER, J.; Pa., 1860.

14. But statements, propositions, or sentences, having no connection or mutual dependence would not, by being written or printed in motiveless juxtaposition, be brought within the definition of a book or literary composition. Much less would an isolated statement, proposition, or sentence, though written, be within the definition, as it has been understood for thousands of years. *Ibid.*, 69.

## BURDEN OF PROOF.

See EVIDENCE, A.

## CAVEAT.

1. § 12 of the act of 1836, providing for a caveat, was introduced for the benefit of the inventor, but it is not necessary for the preservation of his right; nor does the omission of it impair his title. *Hildreth v. Heath*, MS., (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. The caveat only enables the inventor to have notice of any interfering application, but gives no notice to the world, or even to the interfering applicant. It is notice to the Commissioner only. *Ibid.*

3. 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.

4. An inventor is bound to notify the public of his claim, by a caveat or application filed in the Patent Office, designating his discovery, and what he means to secure to himself. *Sparkman v. Higgins*, 1 Blatchf., 208.—BETTS, J.; N. Y., 1846.

5. A caveat may be resorted to, to assist in construing a patent. *Smith v. Downing*, 1 Fisher, 69.—WOODBURY, J.; Mass., 1850.

6. A caveat answers a double purpose; first, to give notice of the inventor's claim, and, second, to prevent a patent from issuing to another for the same thing. *Allen v. Hunter*, 6 McLean, 304.—MCLEAN, J.; Ohio, 1855.

7. 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.

8. There is no law allowing a caveator, as such, to withdraw any portion of the fee required on filing his caveat. *Anon.*, MS.—BLACK, Atty. Gen.; 1857.

9. The caveat is to set forth the "design and purpose" of the invention, 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. *Ibid.*

10. Nor is it necessary to accompany

the caveat with specimens of ingredients or compounds, or models or drawings, or with an oath of invention or discovery. *Ibid.*

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

12. A caveat is not conclusive evidence that an invention is not perfected. *Johnson v. Root*, 1 Fisher, 367.—SPRAGUE, J.; Mass., 1858.

13. 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 complies with the terms of § 12 of the act of 1836, as to giving the caveator notice of any interfering application, it is to secure him against the effect of the rule. *Phelps, Dodge & Co. v. Brown Bros.*, 4 Blatchf., 364.—NELSON, J.; N. Y., 1859.

14. But if the Commissioner accidentally omits to give the caveator the notice required, his rights will not be prejudiced thereby. *Ibid.*, 364.

15. A caveat will directly protect only one of several distinct patentable subjects, falling within its general scope, at the election of the party inventing them. *Woodruff & Cobb*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

16. But connected with other circumstances, it may furnish strong *administrative* proof in favor of his claim to priority as to another invention in the same line. And when such other invention is very similar to the first, but small additional proof will be necessary in determining the contemporaneous date of the second invention. *Ibid.*

17. A caveat is not required to be specific in its terms, nor is it presumed to describe the whole invention of the party, but is filed in the office rather as a warning that the inventor is in the exercise of due diligence in the pursuit and perfection of his discovery. *Collins v. White*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

### CHARGE OF JUDGE, IN PATENT ACTIONS.

1. If either party deems any point presented by the evidence to be omitted in the charge, it is competent for such party to require an opinion of the court upon that point. If he does not it is a waiver of it. The court cannot be presumed to do more, in ordinary cases, than to express its opinion upon the questions which the parties themselves have raised at the trial. *Pennock v. Dialogue*, 2 Pet., 15.—STORY, J.; Sup. Ct., 1829.

2. It is no part of the duty of the court to give an instruction as to abstract points, not actually presented by the state of the cause. *Pitts v. Whitman*, 2 Story, 619.—STORY, J.; Me., 1843.

3. The court is never bound to give an instruction to the jury, even when pertinent and relevant, precisely in the form and manner in which it is put by counsel. It is only the duty of the court to give such instructions in point of law, as clearly arise upon the evidence, and are proper for the consideration of the jury, in such terms and in such manner as shall comport with the real merits and justice of the case, and

## EXTENT OF COPYRIGHT IN.

enable the jury to give a proper verdict in point of law. *Ibid.*, 620.

4. The court, though seasonably requested, is not bound to instruct the jury on points not arising in the case, or on abstract or irrelevant propositions, points not raised by the evidence. *Allen v. Blunt*, 2 Wood. & Min., 143.—WOODBURY, J.; Mass., 1846.

5. Instructions should always arise out of, and be limited to the facts, or the evidence in the cause; and instructions, which are general, abstract, or not springing from, and pertinent to the facts of the case, are calculated to mislead the jury, and are therefore improper. *Gayler v. Wilder*, 10 How., 505.—DANIEL, J. (Dis. Opin.); Sup. Ct., 1850.

## CHARTS, MAPS, PRINTS, &amp;c.

1. Under the act of 1802, the person intended and described as the proprietor of a copyright in a print is one who shall not only invent *and* design, but who shall 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.

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. *Ibid.*, 51.

4. Neither is he so entitled, unless he has not only invented, but also designed or represented the subject in some visible form. *Ibid.*, 51.

5. 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. *Ibid.*, 52.

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

7. Where a person, at his own expense, has caused a survey to be made of a particular locality, as Nantucket Shoals, which corrected errors in former charts, and made a chart of such survey, *Held*, that though he could not have a copyright in the shoal itself, nor in the original elements of his charts, that he had a right to the result of his labors and surveys. *Blunt v. Patten*, 2 Paine, 395.—THOMPSON, J.; N. Y., 1828.

8. Another party might resort to the original materials of the chart and survey for himself, but he could not avail himself, either in whole or in part, of the surveys of the plaintiff. *Ibid.*, 396.

9. And though the plaintiff had deposited one of such charts in the Navy Department, it did not thereby become a public document, which any one had a right to copy. *Ibid.*, 396.

10. The natural objects from which charts are made being, however, open

to all, a copyright cannot subsist in a chart, as a general subject, although it may in an individual work, and others may be restrained from copying such work. *Ibid.*, 400, 401.

11. 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.

12. 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.

13. A subsequent compiler has a right to avail himself of all prior publications, the copyright of which is not secured; and if he compiles his chart from some other publications, it is no infringement of another's copyright, although it may agree with such prior chart. *Ibid.*, 403.

14. 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.

15. Another may, however, publish another map of the same state or country by using the like means or materials, and the like skill, labor, and expense. But he has no right to publish a map taken substantially and designedly from the map of the other person, without any such exercise of skill, labor, or expense. *Ibid.*, 781.

16. Where, on a bill filed for an alleged violation of a copyright, and an injunction, the alleged infringement consisted in making use of the complain-

ant's map by the defendant; but the answer denied that the defendant had made any use of such map, and alleged that he had obtained his materials from original sources, and also denied any intention or desire to make any reference to complainant's map, *Held*, that an injunction would not be granted, as there was no infringement. *Smith v. Johnson*, 4 Blatchf., 252.—INGERSOLL, J.; N. Y., 1858.

### COLORABLE ALTERATIONS AND VARIATIONS.

See also DOUBLE USE; EQUIVALENT; FORM; INVENTION, E.

1. Mere colorable differences or slight improvements cannot shake the right of an original inventor, or protect an infringer. *Odiorne v. Winkley*, 2 Gall., 54.—STORY, J.; Mass., 1814.

2. The right secured to the inventor is founded on considerations of public policy, and is not to be destroyed by open infraction, or mere colorable improvements. *Smith v. Pearce*, 2 McLean, 178.—McLEAN, J.; Ohio, 1840.

3. A mere colorable or slight alteration of a machine, or a change in its proportions, gives no ground for a patent; nor can it shelter from the consequences of an infringement. The inquiry always is, whether the principle of the two machines is the same. *Brooks v. Bicknell*, 3 McLean, 262.—McLEAN, J.; Ohio, 1843.

4. Mere colorable differences in form and structure do not make a difference in principle. *Parker v. Stiles*, 5 McLean, 63.—LEAVITT, J.; Ohio, 1849.

5. An unsubstantial or colorable al-

teration in a machine or a compound, as where they are formed on the same principle, though varied in form; or where the ingredients are the same, but combined in a different mode, or there is a substitute of one ingredient having the same qualities, and producing the same result, is an infringement. *Allen v. Hunter*, 6 McLean, 313.—McLEAN, J.; Ohio, 1855.

6. Mere colorable alterations, substantially the same as other inventions, and involving the same principle, afford no ground for a patent. *McCormick v. Manny*, 6 McLean, 557.—McLEAN, J.; Ill., 1855.

7. If the change in a machine consists merely in the employment of an obvious substitute, the discovery and application of which could not have involved the exercise of the inventive faculty in any considerable degree, the change will be treated as merely an unsubstantial, colorable variation, or a double use, and not patentable. *Everson & Ricard, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

COMBINATION.

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**A.** WHAT IS; WHAT PATENTABLE; CONSTRUCTION OF PATENTS FOR.

1. If to an old machine, some new combinations be added to produce new effects, the right to a patent is limited to the new combinations. *Whittemore v. Cutter*, 1 Gall., 480. STORY, J.; Mass., 1813.

2. If different effects have been produced by the *same application* of machinery in several parts, and a person merely combines them together, or adds a new effect, he is not entitled to a patent for the whole machine. *Ibid.*, 482.

3. A machine, or an improvement may be new, and the proper subject of a patent, although the parts of it were before known, and in use. The combination, therefore, of old machines to produce a new and useful result, is a discovery for which a patent may be granted. *Evans v. Eaton*, Pet., C. C., 343.—WASHINGTON, J.; Pa., 1816.

4. A patent may be for a new combination of machines to produce certain effects, and this whether the machines, constituting the combination, be new or old. *Barrett v. Hall*, 1 Mas., 474.—STORY, J.; Mass., 1818.

5. If an invention consist in a new combination of machinery, or in improvements upon an old machine, to produce an old effect, the patent should be for the combined machinery, or improvements on the old machine, and not for a mere mode or device for producing such effects detached from the machine. *Ibid.*, 476.

6. If a combination be not wholly new, but up to a certain point has existed before, and the patentee claims the whole as new, instead of his own improvements only, and takes out a patent for the whole machine, his patent is void, for it exceeds his invention. *Moody v. Fiske*, 2 Mas., 118.—STORY, J.; Mass., 1820.

7. The same patent cannot be for a *combination* of different machines, and for distinct improvements in each. *Ibid.*, 119.

8. If old materials, and old principles

in mechanics or otherwise, are used in a state of combination, so as to produce a new result, the inventor of the article so produced is entitled to apply for, and may obtain a valid patent. *Pennock v. Dialogue*, 4 Wash., 543.—WASHINGTON, J.; Pa., 1825.

9. A combination though simple and obvious, if new, is nevertheless patentable; and it is no objection, that up to a certain point, it makes use of old machinery. *Earle v. Sawyer*, 4 Mas., 11.—STORY, J.; Mass., 1825.

10. A patent for a machine, consisting of an entire new combination of all its parts, though each part has been used in former machines, is good if the machine is substantially new in its structure and mode of operation; but if the same combination existed before up to a certain point, and the invention consists in adding some new machinery in some improved mode of operation, or some new combination, the patent must be limited to the improvement. *Whitney v. Emmett*, Bald., 314.—BALDWIN, J.; Pa., 1831.

11. Where a patent was for the construction and use of a peculiar cylinder described, and the several parts thereof in combination for the purpose set forth, *i. e.*, making paper, *Held*, that it was not the cylinder alone, or its several parts, which were claimed *per se*, but that they were claimed in their actual combination with the other machinery to make paper. *Ames v. Howard*, 1 Sumn., 486, 487.—STORY, J.; Mass., 1833.

12. That is a combination which requires different things, or different contrivances, or different arrangements, to be brought together to accomplish a given purpose. It does not follow, however, that a combination is not, and may not be treated as an entirety.

*Carver v. Braintree Manuf. Co.*, 2 Story, 446.—STORY, J.; Mass., 1843.

13. Where in a patent for improvements in the ribs of cotton gins, the claim was for increasing the depth between the upper and lower surface of the rib, and also as a part of the same improvement, the sloping up of the under surface so as to leave no shoulder between the two, *Held*, that it was not a claim for two distinct improvements, but for parts of the same improvement—but neither alone as constituting it—as making an entirety. *Ibid.*, 446.

14. If a combination is new, it is patentable, although a part of the apparatus may have been applied to similar purposes in other and different machines. *Pitts v. Whitman*, 2 Story, 618, 619.—STORY, J.; Me., 1843.

15. A patent may be taken for a combination of old parts. *Devoll v. Brown*, 3 West. Law Jour., 152.—WOODBURY, J.; Mass., 1845.

16. A combination, to be patentable, must be substantially new, not a copy; the parts may have been used before; it is the bringing of them together that constitutes the invention. *Ibid.*, 152.

17. It is not necessary to have any new power or substance; but it is necessary that the combination operate in a new mode or manner; this constitutes the new principle. *Ibid.*, 152.

18. If the new mode is merely a change in equivalents, and there are no new results, it is not enough; but if there is any new mode of operating, then it was new. *Ibid.*, 152.

19. If results are different, it argues a substantial change in the mode, results cannot be different, if the means are the same. *Ibid.*, 153.

20. A new combination, or invention,

may be the result of accident, as well as labor, and is to be alike protected in either case. *Ibid.*, 153.

21. In order to support a claim for a combination, it must differ materially and substantially from former combinations. *Hovey v. Henry*, 3 West. Law Jour., 154.—WOODBURY, J.; Mass., 1845.

22. To defeat such a claim, it is not sufficient to show that each part or element of the combination has been known and used before, but that all the parts had been known and used in combination. *Ibid.*, 154.

23. It is not a new invention, if all the parts of a combination had been applied to a different object before, and they were now only applied to a new object. *Ibid.*, 155.

24. Where a patent is for a new combination, there is no claim to invention except in regard to the combination, and no parts of the machine need be proved to be new. *Hovey v. Stevens*, 1 Wood. & Min., 302.—WOODBURY, J.; Mass., 1846.

25. When a certain particular combination of known mechanical powers or principles produces a new and useful effect in a manufacture, that combination becomes the lawful subject of a patent. *Warner v. Goodyear*, MS., (App. Cas.)—CRANCH, Ch. J.; D. C., 1846.

26. In mechanics, inventions consist, not in the discovery of new principles, but in new combination of old ones. The principles of mechanics are few, simple, and well understood; their combinations are various and inexhaustible. Any new combination, which is of substantial advantage in the arts, comes within the policy and protection of the patent law. *Tyler v. Deval*, 1 Code Rep., 31.—MCCALEB, J.; La., 1848.

27. A patent for a combination cannot be supported by evidence of novelty of one of its parts. *Batten v. Clayton*, 2 Whart. Dig., 408.—KANE, J.; Pa., 1848.

28. A combination to be patentable must effect a new result, or an old result by a new mode of action; there must be novelty either of product or process. *Ibid.*

29. A combination, in order to be patentable, must bring some new features into the combination, and produce new and beneficial results. If it does that, it is of no matter how slight the change. *Adams v. Edwards*, MS.—SPRAGUE J.; Mass., 1848.

30. If there is a novelty in the application and in the machine, and if it produces new and valuable results, it is patentable, whether only the combination is new, or only an important part of it. *Ibid.*

31. If a combination is new, and produces a new and useful result, it is the proper subject of a patent. *Tatham v. Le Roy*, MS.—NELSON, J.; N. Y., 1849.

32. Though a mere combination of machinery in the abstract may not be new, yet if used and applied in connection with the practical development of a newly discovered principle, producing a new and useful result, the subject is patentable. *Ibid.* [But see *post* 43, 54.]

33. In a patent for a combination, where the novelty of the invention consists in the combination, it is altogether immaterial whether the elements forming the combination are new or old. *Buck v. Hermance*, 1 Blatchf., 404.—NELSON, J.; N. Y., 1849.

34. In order that a new combination may be patentable, the change between



it and any previous combination must be substantial, and not formal; must require mind, ingenuity, labor, time, and expense. The new article must be different from the one on which it is an improvement, not only in its mechanical contrivance and construction, but in its practical operation and effect in producing the useful result. *Ibid.*, 405.

35. If a combination includes new patentable matter with old matter not patentable, it makes a new patentable combination. *Bain v. Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

36. And it is not the less patentable because it includes new matter in connection with the old. The old may not in itself be patentable; but joined to the new, a combination may be formed which may be patented. *Ibid.*

37. Nor is the inventor obliged to take separate patents for each new patentable matter; he may be willing to ask only for a limited use of the new matters, *to wit, in combination*, and not for an exclusive use of them for every purpose for which they may be applicable. *Ibid.*

38. Although all the parts going to constitute the plaintiff's invention—a car wheel—may have been known before and developed in prior wheels, if the patentee first brought them together into a whole, and that whole is materially different from any whole that existed before, he is the original and first inventor, and entitled to a patent therefor. *Many v. Sizer*; 1 Fisher, 24.—SPRAGUE, J.; Mass., 1849.

39. Where the effect and operation of mechanical contrivances, which are to be determined by experts, enter into the question of the extent of a combination, it is a mixed question of law

and fact, and a proper one to be determined by the jury, under instructions from the court. *Foote v. Silsby*, 1 Blatchf., 458, 465.—NELSON, J.; N. Y., 1849.

40. One part of a combination being old does not necessarily prevent the combination, itself being new. *Hall v. Wiles*, 2 Blatchf., 199.—NELSON, J.; N. Y., 1851.

41. It is immaterial whether the patentee is the inventor of any one or more of the elements of a combination. These may all be old; but if the patentee was the first to combine them, for the purpose specified in his patent, his patent will be good. *Foote v. Silsby*, 2 Blatchf., 270.—NELSON, J.; N. Y., 1851.

42. To defeat a claim for a combination, by the existence of a prior combination, such prior combination must have been one of practical utility, and must have embraced all the elements embraced in the plaintiff's combination. *Ibid.*, 275.

43. Where a patentee claims a certain combination of machinery as his invention, his claim can only be sustained by establishing its novelty—not as to its parts, but as to the combination. It will not support the patent to show that a new result is produced. *Le Roy v. Tatham*, 14 How., 177.—MCLEAN, J.; Sup. Ct., 1852.

44. A claim for a combination which does not point out and designate the particular elements which compose a combination, but only declares that the combination is made up of so much of the described machinery as effects a particular result, may be sufficient. It is a question of fact, which of the described parts are essential to that result; and to this extent not the construction,

but the application of the claim should be left to the jury. *Silsby v. Foote*, 14 How., 226.—CURTIS, J.; Sup. Ct., 1852.

45. The use of a blast in connection with a lime-kiln, being new, as also the feature of generating heat in the same furnace to burn the stone, and produce steam in the boiler to work the blowers, and the arrangement effecting a saving of fuel, *Held*, that such arrangement or combination was patentable. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

46. If the specification, taken as a whole, leaves no reasonable doubt concerning the intention of the patentee to include in his claim a certain part of a combination, though there may be an error in describing it, it will be considered as included. *Kittle v. Merriam*, 2 Curt., 479.—CURTIS, J.; Mass., 1855.

47. To make a valid claim for a combination, it is not necessary that the several elementary parts of the combination should act simultaneously. If such parts are so arranged that the successive action of each contributes to produce one result—which result is the product of the simultaneous or successive action of all such parts—a valid claim for combining such elementary parts may be made. *Forbush v. Cook*, 10 Mo. Law Rep., 665.—CURTIS, J.; Mass., 1857.

48. Nor is it necessary to include in the claim for the combination, as elements thereof, *all* parts of the machine which are necessary to its action. *Ibid.*, 665.

49. If a combination is new and useful within the meaning of the patent laws, it is the subject of a patent, and it is not important whether it required much or little thought, study, or experi-

ment to make it, or whether it costs much or little expense to devise and execute it. *Ibid.*, 667.

50. The use of new materials in a combination, or a change of form, or the use of one equivalent for another, does not render it new in the sense of the patent law, but some new mode of operation must be introduced. *Ibid.*, 667.

51. And it is decisive, though not the only evidence, that a new mode of operation has been introduced, if either a new effect, or a better effect, or as good an effect more economically attained, is produced by the change. *Ibid.*, 668.

52. If a person invent a new mechanical device or arrangement, to be used in the place of a former device or arrangement which was a part of a certain combination, and which new device is independent of all other similar devices, and is not to be used in conjunction with, or in aid of, or in addition to such old device, which made one of the elements of the old combination, he may have a patent for a combination containing his new device or arrangement, in connection with the remaining parts of the old combination, as such combination constitutes a new machine, and not an improvement merely on the machine, containing the combination of the old elements. *Potter v. Holland*, 4 Blatchf., 244.—INGERSOLL, J.; Ct., 1858.

53. But if such new mechanical device is but an improvement on the old or former one, and is to be used in conjunction with, or in aid of, or in addition to, the old one, then, it seems, he could only have a patent for his improvement and not for the whole combination. *Ibid.*, 245.

54. Though a combination of machinery, or a part of it may not be new, when used to produce a new product,

if it is so combined and modified as to produce new results, there is novelty within the patent law. *Le Roy v. Tatham*, 22 How., 139.—McLEAN, J.; Sup. Ct., 1859.

55. One new and operative agency in the production of the desired result gives novelty to the entire combination. *Ibid.*, 139.

56. Although the *elements* of a combination may not be new, yet if the combination and arrangement of parts are new, and produce useful and valuable results, the invention is patentable. *Larowe, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

57. In order to make a combination patentable, its constituent parts should be *co-active*, and not dead parts. The connection of a thousand dead parts in one machine having but a single operation, can never be considered a combination. *Berry, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

58. Though the combination of parts in a machine may be old, yet if the parts differ in construction, and are so made for a specific purpose, and the effect or result produced by such change in construction is valuable, and the combination has never before been applied to such purpose, the arrangement or combination is new and patentable. *Mackay, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

59. Though all the primary elements of a combination, or all its sub-combinations have existed before in different machines, if they have never before been brought together to constitute one machine, and co-operate to produce one result, the person who so brings them together is entitled to a patent for such combination and arrangement. *Howe v. Morton*, MS.—SPRAGUE, J.; Mass., 1860.

60. There are two classes or kinds of combinations which are properly the subject of a patent. *First*, in which all the parts were before known, and where the sole merit of the invention consists in such an arrangement of them as to produce a new and useful result, or where an inventor has succeeded in making such an arrangement of known parts, that they produce a result never before obtained. *Second*, where *some* of the parts or elements of the combination are new, and their invention claimed, but where they are used in combination with parts or elements that were known before. *Lee v. Blandy*, 2 Fisher, 93.—McLEAN, LEAVITT, JJ.; Ohio, 1860.

61. Parts of a machine which do not perform any distinctive valuable function, or confer any utility upon the combination, and are in fact useless in their operation, will not make the combination patentable. *Thomas, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

## B. INFRINGEMENT OF PATENT FOR.

1. An action will not lie by a patentee of an improvement, consisting of a combination of several machines, against a person who has made or used one of the machines, which in part constitutes the discovery. *Evans v. Eaton*, Pet., C. C., 343, 344.—WASHINGTON, J.; Pa., 1816.

2. The separate parts of a combination may be used without any infringement of the patent, but they cannot be used in their combined state to produce by the same operation the same result. *Gray v. James*, Pet., C. C., 401.—WASHINGTON, J.; Pa., 1817.

3. If a patent is for a combination of several machines, it is no infringement

of the patent to use any of the machines separately, if the whole combination is not used. *Barrett v. Hall*, 1 Mas., 474, 477.—STORY, J.; Mass., 1818.

4. Where a patent is for a *new combination* of existing machinery or machines, and does not specify or claim any improvement or invention, except the combination, unless that combination is substantially violated, the patentee is not entitled to any remedy, although parts of the machinery are used by another. *Moody v. Fiske*, 2 Mas., 117.—STORY, J.; Mass., 1820.

5. In such a case, proof that the machines, or any part of their structure, existed before, forms no objection to the patent, unless the combination had existed before. *Ibid.*, 117.

6. Where a patentee, in his patent, claimed three things, not separately, but in combination, and the defendants made use of but two of the three parts, *Held*, that unless the whole combination was substantially used by the defendants, it was not an infringement of the plaintiff's patent, although one or more of the parts may be used by the defendants. *Prouty v. Ruggles*, 1 Story, 571.—STORY, J.; Mass., 1841. [Affirmed 1842, *post* 9.]

7. A patent for a combination of A, B, and C cannot be technically or legally deemed at once a combination of A, B, and C, and of A and B alone. *Ibid.*, 572.

8. Where a patent is for an entire process or combination, and not for the several parts of it, and a party does not use the entire process or combination, but only a part, it is not a violation of the thing patented. *Howe v. Abbott*, 2 Story, 194.—STORY, J.; Mass., 1842.

9. If a combination, as claimed and patented, consists of several (three)

parts, arranged in a particular manner, with reference to each other and to other parts of the machine or thing, the use of any two of such parts only, or of the two combined with a third which is substantially different in form, or in the manner of its arrangement, or connection with the others, is not an infringement of the thing patented. *Prouty v. Ruggles*, 16 Pet., 341.—TANNEY, Ch. J.; Sup. Ct., 1842.

10. One combination is not the same with another, if it substantially differs from it in any of its parts. *Ibid.*, 340.

11. A patentee of an improvement in the cotton-gin described and claimed his invention as consisting in a particular form of the rib, for separating the fibre from the seed, and so connecting the lower and upper surfaces of the rib, that *when the rib was inserted in the frame*, there should be no break or shoulder, but a smooth uninterrupted passage upward between the ribs. *Held*, that his patent was for the combination of the form of the rib, of the manner of connecting its upper and lower surfaces, and the manner of fixing or fastening it to the frame as stated; and that if the defendants did not fix or fasten the ribs of their machine against the framework substantially in the manner described in the plaintiff's patent, they were not guilty of any violation of the plaintiff's patent. *Carver v. Hyde*, 16 Pet., 518, 520.—TANNEY, Ch. J.; Sup. Ct., 1842.

12. The use of any one of certain specified improvements of a combination, included in a patent, of which the patentee was the inventor, without any violations of the others, is sufficient to entitle the patentee or his assigns to an action of infringement. *Pitts v. Whit-*

man, 2 Story, 621.—STORY, J.; Me., 1843.

13. Where an invention consists in the combination of certain known mechanical structures, the use of any parts essential to such combination, less than the whole, is no infringement. *Brooks v. Bicknell*, 3 McLean, 453, 454.—MCLEAN, J.; Ohio, 1844.

14. By a change in position in a combined machine, its mechanical action is not affected. *Ibid.*, 455.

15. There is no infringement of a combined machine, unless every part is used. *Brooks v. Bicknell*, 4 McLean, 73.—MCLEAN, J.; Ohio, 1845.

16. A patent for a combination is not infringed by the use of any part less than the whole of the combination. *Root v. Ball*, 4 McLean, 180.—MCLEAN, J.; Ohio, 1846.

17. Where a patent is for a new combination, and not for newly invented parts, a violation must extend to the whole. *Aiken v. Bemis*, 3 Wood. & Min., 353.—WOODBURY, J.; Mass., 1847.

18. Where an invention consists of a combination of known mechanical powers, the use of a part less than the whole combination, is no infringement. *Parker v. Haworth*, 4 McLean, 373.—MCLEAN, J.; Ill., 1848.

19. But where the invention consists not only in the combination, but in the improvement of several of the parts of the combination, the violation of one of them is an infringement for which an action will lie. *Ibid.*, 374.

20. Where a patent is for a combination, constructed and operating in a particular way, to constitute an infringement, the defendant must have used the same combination, constructed and operating substantially in the same

way. *Gorham v. Mixer*, 1 Amer. Law Jour.; N. S., 543.—SPRAGUE, J.; Mass., 1849.

21. If but two of the three elements of combination are used, there is no infringement. Nor is it any infringement if any one or all the elements of combination were constructed and operated substantially different from the plaintiff's. *Ibid.*, 543.

22. Nor do additions or improvements to a combination, or any element thereof, though meritorious, give any right to use or appropriate the original combination. *Ibid.*, 543.

23. In a patent for a new and useful improvement in the mode of forming rails for railroad carriages, for use in cities, &c., "where it is desirable that the wheels of ordinary carriages should not be subjected to injury or obstruction," the patentee claimed the employment of plates or rails having narrow grooves on each side of the track for the flanges of the car wheels to run in, by which they were adapted to the unobstructed passing over them of the various kinds of common carriages, such rails being also sunk to a level with the surface of the street. *Held*, that such patent consisted of the combinations of such grooves with the rail, on both sides of a railroad track, and such combination being depressed to a plane corresponding with the street, and that the use by the defendant, of a double iron rail, with a groove or interval between, large enough for the flange of the wheel, placed on the inner side of a curve, the ordinary flat iron rail being used on the exterior line of the same curve, and the whole constructed on the same plane with the general track of the road, without regard to the convenience of carriages to pass over it, was not an infringement

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of such combination, having used but one element of the plaintiff's combination. *Stimpson v. B. & Sus. R. R. Co.*, 10 How., 343-346.—DANIEL, J.; Sup. Ct., 1850.

24. Where in an action for an infringement of a mill for grinding bark, the novelty of the plaintiff's invention which consisted in the formation of grinding chambers, by the combination of movable conical rings, with stationary cylinders arranged concentrically, and in the consequent multiplication of the grinding chambers, so as to increase the grinding surfaces in a machine of a given size, *Held*, that no one had a right, without the authority of the patentees, to use the combination of such two parts that formed the grinding chambers, and that a change in the shape of the chambers, or the form of the teeth, though the machine might thereby be improved, was only a difference in degree, and not in the thing itself. *Wilbur v. Beecher*, 2 Blatchf., 140, 142.—NELSON, J.; N. Y., 1850.

25. A combination, when the patent is for that, is not violated when only parts of it are used, and not all of them, which are material. *Smith v. Downing*, 1 Fisher, 83.—WOODBURY, J.; Mass., 1850.

26. If a combination, properly so called, consists of two or more distinct things, and the patent is for combining them in one whole, if all are not used the patent is not infringed. *Foster v. Moore*, 1 Curt., 292.—CURTIS, J.; Mass., 1852.

27. A combination may be improved, and a patent taken for such improvement, but at the same time the improvement cannot be used without the consent of the original patentee. *Ibid.*, 292.

28. But even where a strict combi-

nation is claimed, if one of the elements of that combination is complex enough to admit of an improvement, without destroying its identity, such improved combination would be an infringement. Though one element is thus improved, the whole combination in the sense of the patent laws would be used. *Ibid.*, 293.

29. The patent was for sawing matches in sheets, so as to leave them united at one end, and then wrapping them in paper in a particular manner, *Held*, that the patent was for the entire and complete mode described, and was not infringed by putting up matches attached at one end, but not wrapped in strips of paper. *Byam v. Farr*, 1 Curt., 265.—CURTIS, J.; Mass., 1852.

30. If a combination has three different known parts, and the result is accomplished by the union of all these parts, arranged with reference to each other, the use of two of these parts only, combined with a third, substantially different from the former, is not the same combination, and no interference. *Brooks v. Fiske*, 15 How., 219.—CATRON, J.; Sup. Ct., 1853.

31. A patent which claims mechanical powers or things in combination, is not infringed by using a part of the combination. To this rule there is no exception. *McCormick v. Many*, 6 McLean, 547.—MCLEAN, J.; Ill., 1855.

32. Where the invention consists of a combination of known mechanical powers, the use of less than the whole will be no infringement. *Pitts v. Wemple*, 6 McLean, 561.—MCLEAN, J.; Ill., 1855.

33. If the whole of the combination be taken, though something be added, still it is an infringement. *Ibid.*, 561.

34. Where the right of recovery rests

on a combination, the plaintiff must prove that all those parts substantial to their combination have been used by the defendants. The employment of one or more of those parts less than the whole will not constitute an infringement. *Smith v. Higgins*, MS.—BERTS, J.; N. Y., 1857.

35. If an invention is an improvement on a known machine by a mere change of form or combination of parts, the patentee cannot treat another as an infringer who has improved the original machine by use of a different form or combination performing the same functions. The inventor of the first improvements cannot invoke the doctrine of equivalents to suppress all other improvements which are not merely colorable invasions of the first. *McCormick v. Talcott*, 20 How., 405.—GRIER, J.; Sup. Ct., 1857.

36. A claim for a combination of mechanical devices or parts is not infringed by one who uses a part of the combination. *Ibid.*, 406.

37. In a patent for a combination there is no infringement, unless all the essential parts of the combination are substantially imitated. *Bell v. Daniels*, 1 Fisher, 379.—LEAVITT, J.; Ohio, 1858.

38. It is familiar law that there is no infringement of a combination, unless the defendant uses all the parts of which that combination is composed. *Latta v. Sharok*, 1 Fisher, 470.—LEAVITT, J.; Ohio, 1859.

39. But there is another kind of combination to which this doctrine does not apply, and that is where the combination is of old and new parts of a machine. In such a case, if a defendant takes the new part only, he infringes. *Ibid.*, 470.

40. Where a patentee claims a part

of his mechanical contrivance as an essential element of a combination, but which is really not material to his invention, he may still recover against those who dispense with it while using the rest of the combination. *Vance v. Campbell*, 1 Fisher, 485.—LEAVITT, J.; Ohio, 1859.

41. Where a patent was for a certain combination of machinery designed or intended to effect a certain purpose (dyeing parti-colored skeins of yarn by immersion in a dye, and at the same time gauging or measuring the extent of coloring of the skein), which was not new, *Held*, that in order to establish an infringement, the patentee must show that the defendant is employing substantially the same description of machinery. If the defendant employs machinery of a different description, a different mode of accomplishing the same result, the patentee has no ground of complaint. *Smith v. Higgins*, 2 Fisher, 100.—NELSON, J.; N. Y., 1860.

42. In a combination where all the parts have before been known, and the invention consists in a new arrangement of them to produce a useful result, there is no infringement unless a party has used all the elements of such a combination. *Lee v. Blandy*, 2 Fisher, 93.—LEAVITT, J.; Ohio, 1860.

43. In a combination where some of the elements are new, and their invention claimed, but they are used in combination with old parts, there will be an infringement by the use of that part which is new, and the invention of the patentee. *Ibid.*, 93.

44. A patent for a combination of old things applied to produce a new and useful result, is not violated, unless all its parts or elements are used. *Dodge v. Card*, 2 Fisher, 119.—LEAVITT, J.; Ohio, 1860.

**COMMISSIONER OF PATENTS.**

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**F.** ACTION OF; WHEN CONCLUSIVE.

1. The necessary consequence of the ministerial character in which the secretary of state (now Commissioner of Patents) acts, is, that the performance of the prerequisites of the patent—as whether a correct specification and description of the invention has been made, and in such full terms as is required by law—is re-examinable in any action

brought upon the patent. *Grant v. Raymond*, 6 Pet., 241, 242.—MARSHALL, Ch. J.; Sup. Ct., 1832.

2. Though the decision of the Board of Commissioners (their power is now vested in the Commissioner of Patents), constituted by § 18 of the act of 1836, to determine as to the extension of a patent, is conclusive within the scope of its authority; it is not, however, conclusive upon the question of law, as to the right of renewal. *Brooks v. Bicknell*, 3 McLean, 258.—MCLEAN, J.; Ohio, 1843.

3. Such decision is however entitled to regard, as a practical construction of the law that the heirs of a patentee may procure a renewal of a patent; and such a construction is in accordance with the principle and policy of the law. *Ibid.*, 258, 259.

4. The decision of the Commissioner of Patents upon a reissue is conclusive, unless impeached on account of fraud or connivance between him and the patentee, or unless an excess of authority is manifest upon the very face of the papers. *Allen v. Blunt*, 3 Story, 744.—STORY, J.; Mass., 1845.

5. Where a particular authority is confided to a public officer, to be exercised by him in his discretion, upon an examination of facts, of which he is made the appropriate judge, his decision upon these facts, is, in the absence of any controlling provisions, absolutely conclusive as to the existence of those facts. *Ibid.*, 745.

6. The decision of the Commissioner of Patents, in accepting the surrender of an old and granting a new patent, is not re-examinable elsewhere, unless it is apparent from the face of the patent, that he has exceeded his authority, or there is a clear repugnancy between the



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old and new patent, or the new one has been obtained by collusion between the Commissioner and the patentee. *Woodworth v. Stone*, 3 Story, 753, 754.—STORY, J.; Mass., 1845.

7. The decision of the officers of the government in granting a renewed patent, by reason of a defective or insufficient specification, &c., is *prima facie* evidence that the claim for a renewal was within the statute; and conclusive, except as to fraud. The inquiry as to the surrender, is limited to the fairness of the transaction. *Stimpson v. West. R. R.*, 4 How., 404.—MCLEAN, J.; Sup. Ct., 1845.

8. The decision of the Board of Commissioners (or the Commissioner of Patents), upon an application for the extension of a patent under § 18 of the act of 1836, is not conclusive upon the question of their jurisdiction. *Wilson v. Rosseau*, 4 How., 688.—NELSON, J.; Sup. Ct., 1845.

9. The decision of the Commissioner of Patents as to the character of an administrator, when applying for a renewal of a patent, is conclusive, and the letters of administration need not be produced in an action on such renewed patent. *Woodworth v. Hall*, 1 Wood. & Min., 254.—WOODBURY, J.; Mass., 1846.

10. There is no method of pleading by which the courts can be called upon to settle the regularity of the preliminary proceedings in the Patent Office. The question of the regularity of the proceedings in petitioning for, and obtaining the patent, and the correctness of the judgment of the officer in awarding it, cannot be inquired into. *Wilder v. McCormick*, 2 Blatchf., 35.—BERTS, J.; N. Y., 1846.

11. The Commissioner is presumed,

in issuing new letters patent, to have discharged his duty faithfully and correctly. *Allen v. Blunt*, 2 Wood. & Min., 138.—WOODBURY, J.; Mass., 1846.

12. Whether the decision of the Commissioner is binding and conclusive, so as not to be overturned, except for fraud, or error apparent on the patent; *query*. *Ibid.*, 139.

13. The action of the Commissioner of Patents in the reissue of letters patent is not re-examinable elsewhere, unless a clear case of fraud is made out. *Day v. Goodyear*, MS.—GRIER, J.; N. J., 1850.

14. The decision of the Commissioner of Patents, upon an application for an extension, where he has jurisdiction, is conclusive, as to the regularity of the proceedings, and cannot be the subject of examination and review elsewhere, except perhaps in the case of fraud, which is an exception to the general rule. *Colt v. Young*, 2 Blatchf., 473, 474.—NELSON, J.; N. Y., 1852.

15. The proceedings before the Commissioner of Patents, in the surrender and reissue of a patent, are not open for consideration, except on the ground of fraud. *Battin v. Taggart*, 17 How., 84.—MCLEAN, J.; Sup. Ct., 1854.

16. In respect to an extension, the law makes the Commissioner the judge of the entire merits of the patentee, and the existence of the legal grounds for an extension, and in the absence of fraud, his adjudication is conclusive. *Clum v. Brewer*, 2 Curt., 518.—CURTIS, J.; Mass., 1855.

17. The power and duty of granting a new patent for the original invention, upon a lawful surrender of the old patent, is confided to the Commissioner of Patents. His decision is not re-examinable by the courts, unless it is apparent

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upon the face of the patent, that the Commissioner has exceeded his authority, or unless there is a clear repugnancy between the old and the new patent, or unless the new one has been obtained by collusion between the Commissioner and the patentee. *Potter v. Holland*, 4 Blatchf., 242.—INGERSOLL, J.; Ct., 1858.

18. The decision of a former Commissioner of Patents, while unreversed, is binding upon a subsequent Commissioner. *Larowe, Ex parte*, MS.—(App. Cas.) DUNLOP, J.; D. C., 1860; *Simpson, Ex parte*. *Ibid.*, 1861.

G. “ACTING COMMISSIONER,” POWERS OF.

1. A patent is not invalid because it is certified by a person as “acting” Commissioner, instead of being certified by the Commissioner himself. *Wilson v. Rosseau*, 4 How., 663, 688.—NELSON, J.; Sup. Ct., 1845.

2. The certificate to a patent, made by a person as “acting Commissioner,” is legal and sufficient. *Woodworth v. Hall*, 1 Wood. & Min., 254.—WOODBURY, J.; Mass., 1846.

3. The appointment of an acting Commissioner will be presumed to have been duly made, where drawn in question incidentally or collaterally, if it be shown that the person certifying is in the public discharge of those duties. *Ibid.*, 255.

4. The signatures of acting Commissioners carry as much verity and legality on the face of certificates themselves, as those of the Commissioner himself. *Ibid.*, 256.

5. It is questionable whether evidence is admissible in an action between third parties, where the Commissioner is not a party, that an acting Commissioner

has not been duly appointed; it is to be presumed he was duly appointed. *Woodworth v. Hall*, 1 Wood. & Min., 397, 398.—WOODBURY, J.; Mass., 1846.

6. Under § 2 of the act of 1836, 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. *Ibid.*, 392.

7. A patent signed by “an acting Commissioner of Patents,” is valid upon its face. The courts will judicially take notice of the persons who preside over the Patent Office, whether permanently or transiently. *The York & Mary. R. R. Co. v. Winans*, 17 How., 41.—CAMPBELL, J.; Sup. Ct., 1854.

COMPILATION OF A BOOK.

1. To compile is to copy from various authors into one work. *Story's Exrs. v. Holcombe*, 4 McLean, 313.—MCLEAN, J.; Ohio, 1847.

2. Such a work entitles the compiler, under the statute, to a right of property; which right may be compared to that of a patentee, who, by a combination of known mechanical structures, has produced a new result. *Ibid.*, 314.

3. Between a compilation and an abridgment there is a clear distinction. A compilation consists of selected extracts from different authors; an abridgment is a condensation of the views of the author. *Ibid.*, 314.

4. The former cannot be so extended as to convey the same knowledge as the original work; the latter contains an epitome of the work abridged, and

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consequently conveys substantially the same knowledge. The former cannot adopt the arrangement of the works cited; the latter must adopt the arrangement of the work abridged. *Ibid.*, 314.

5. The former infringes the copyright, if matter transcribed, when published, shall impair the value of the original book; a fair abridgment, though it may injure the original, is lawful. *Ibid.*, 314.

6. And while a prior compiler cannot monopolize what was not original with himself, and what must be nearly identical in all such works as dictionaries, gazetteers, &c., in a like subject, a subsequent compiler cannot employ so much of a prior arrangement and materials as to show a substantial invasion of the other, and not characterized by enough new or improved to indicate new toil and talent. *Webb v. Powers*, 2 Wood. & Min., 513, 514.—WOODBURY, J.; Mass., 1847.

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A. WHAT PATENTABLE.

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. Each of the ingredients may have been in extensive and common use, and some may have been used for the same purpose, but if they have never been combined together in the manner stated in the patent, but the combination is new, the invention of the combination is patentable. *Ibid.*, 518.

3. The patentee is not limited to the same precise ingredients in making his compound. If the same purpose can be accomplished by the substitution in part of other ingredients, he can extend his patent so as to embrace them also, subject to the risk of having his patent defeated if either of the original or substituted combinations have been known or used in the combination. *Ibid.*, 521.

4. It is not every alteration or change in the quantity or quality of a composition which will entitle a person to a patent. The question is not whether the compositions are identical, but, are they substantially the same? *Street v. Silver*, Brightly, 100.—ROGERS, J.; Pa., 1846.

5. If a compound is made, not before known, of different ingredients, it is ground for a patent, not for the thing constructed, but for the compounds of which made. *Hotchkiss, Exrs. v. Greenwood*, 4 McLean, 461.—MCLEAN, J.; Ohio, 1848.

6. 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.

7. 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.

8. If a patentee be the inventor or discoverer of a new manufacture or composition of matter not known or used by others before his discovery thereof, his franchise, or sole right to use and vend to others to be used, is the new composition or substance itself. The product and the process constitute one discovery. *Ibid.*, 362.

9. Patents are granted "to promote science and useful arts." They are not odious monopolies, or restrictions on the rights of the public; and courts are bound to give the specification a liberal construction, and not annul its benefits by formal or subtle objections. In a patent for a composition of matter, if the patentee has set forth fully the materials, their various proportions and the processes necessary to its production, he has done all that the law requires, and should be entitled to its protection. *Ibid.*, 363, 364.

10. Where an invention was described as a "process," but the description of the "manner and process of making the same" showed clearly that the invention was not merely an improved method or process, but a new product, fabric, or manufacture, it was held in an action for infringement, by using the product, that the patentee had a right to prohibit the sale or use of the composition, as the product and process were both new. *Ibid.*, 365.

11. It is no ground for the rejection of an application for a patent for a composition of matter that the thing invented is an imitation of a real existing substance or material—as an artificial

honey. If the artificial is a good and wholesome substitute for the real, and can be made and supplied at a cheaper rate, there is no good reason why it should not be deemed a new and useful invention. *Corbin & Martlett, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

## B. HOW TO BE SET FORTH IN SPECIFICATION.

1. In a patent for a composition of matter, the specification must be so full and clear as to enable one skilled in the art to which it appertains to compound and use the invention without making any experiments of his own. *Wood v. Underhill*, 5 How., 5.—TANEY, Ch. J.; Sup. Ct., 1846.

2. Where the specification of a new composition of matter gives only the names of the substances to be mixed together, without stating any relative proportion, or where the proportions are stated ambiguously or vaguely, the patent is void, as it would not enable any one to compound and use the invention without experiment. *Ibid.*, 5.

3. But where the patentee gives a certain proportion as a general rule, which on the face of the specification seems generally applicable, the patent will be valid, though some small difference in the proportions may be occasionally required, according to the quality of the materials made use of. *Ibid.*, 5.

4. In most compositions of matter, some small difference in the proportions must occasionally be required, since the ingredients proposed to be compounded must sometimes be in some degree superior or inferior to those most commonly used. *Ibid.*, 5.

5. When the specification of a patent honestly sets forth the process and mode of compounding a new and valuable composition of matter, courts should give it a liberal construction. If the patentee has set forth fully the materials, their various proportions, and the processes necessary to the production of such composition, he has done all that the law requires. *Goodyear v. Railroad*, 2 Wall, Jr., 363, 364.—GRIER, J.; N. J., 1853.

6. If the specification honestly sets forth the *nature and design* of the invention, it is sufficient. *Ibid.*, 364.

7. The specification must be looked to for the full disclosure of the discovery, and the extent of the inventor's claims. The extent of the patentee's right must be judged from the whole instrument taken together, and not from any one sentence. *Ibid.*, 364, 365.

8. In patents for complicated machines, it is essentially proper that the specification should clearly set forth what the patentee admits to be old, and what he claims to be of his invention. But in anomalous cases, when a product has been discovered, and the process of compounding it or obtaining it is disclosed, the patentee by stating his discovery and revealing his process has done all that he is required to do or can do. The careful separation of new from old, the limitation of claims to particular parts or combinations, cannot be required as a substantial part of the specification. *Ibid.*, 365.

### C. INFRINGEMENT OF PATENT FOR.

1. The using or vending of a patented composition of matter is a violation of the right of the proprietor. *Whitte-*

*more v. Cutter*, 1 Gall., 433.—STORY, J.; Mass., 1813.

2. The substitution in place of one element in a composition of matter of a mere known equivalent is an infringement, but the patentee is not obliged to embrace equivalents in his claim, and if the specification and claim expressly declare that such equivalent is excluded from the patentee's invention, then its use is not an infringement. *Byam v. Farr*, 1 Curt., 263.—CURRIS, J.; Mass., 1852.

3. Where the old method of making friction matches was, to use a composition of phosphorus, chlorate of potash, sulphuret of antimony and glue, and the invention of a patentee consisted in rejecting the chlorate of potash and sulphuret of antimony, and substituting in their place chalk or some earthy matter, and his claim was "the using a composition of phosphorus and earthy material and a glutinous substance, without the addition of chlorate of potash or of any highly combustible material," and the defendant used a composition consisting of phosphorus, sulphuret of antimony and glue, omitting only the chlorate of potash, *Held*, that the composition used by the defendant was not an infringement of the plaintiff's patent, as his claim expressly excluded the composition used by the defendant. *Ibid.*, 362-364.

4. Where a patent was for an improvement in making friction matches, and the invention was not for a compound of new ingredients, but simply and only a new combination of old materials before in use for that purpose, consisting of a composition formed of phosphorus with the earthy material and glutinous substance only, without chlorate of potash or other like objec-

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tionable ingredient, *Held*, that any person might use any one, or all the materials forming the composition, provided he does not use them in the combination patented, or that any one might use them in combination with chlorate of potash as they were formerly used. *Byam v. Eddy*, 2 Blatchf., 523, 524.—PRENTISS, J.; Vt., 1853.

5. But a mere colorable difference or slight variation of the combination would not exempt a person from the charge of infringement. *Ibid.*, 524.

6. An infringement consists in making a compound substantially in the same mode as that for which the patent has been obtained. *Allen v. Hunter*, 6 McLean, 311.—MCLEAN, J.; Ohio, 1855.

7. Where the ingredients in a compound are the same, and the change is merely in the mode of combining them, or there is a substitute of one ingredient having the same qualities and producing the same result, there is an infringement. *Ibid.*, 313.

8. Where a patent is granted for a composition of several ingredients, it covers and embraces known equivalents of each of the ingredients. *Matthews v. Skates*, 1 Fisher, 609.—JONES, J.; Ala., 1860.

9. An equivalent of any substance is another substance having similar properties, and producing substantially the same effect. Whether one substance is an equivalent of another is a question for the jury from the evidence. *Ibid.*, 609.

## CONGRESS.

1. The power of Congress, under the 8th section of the Constitution, "in securing to authors and inventors the ex-

clusive right to their respective writings and discoveries" is limited to authors and inventors only, and does not embrace *introducers* who are not the authors and inventors. *Livingston v. Van Ingen*, 9 John., 560, 566, 582.—YATES, THOMPSON, and KENT, JJ.; N. Y., 1812.

2. But such clause does not prevent the several states from exercising the power of securing to persons introducing useful inventions the exclusive benefits of such inventions for a limited period. *Ibid.*, 560, 566, 582.

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

4. 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*, Pet., C. C., 337. WASHINGTON, J.; Pa., 1816.

5. But even if such was the case, there is nothing in the Constitution of the United States which forbids Congress to pass laws violating the obligations of contracts, though such a power is denied to the states individually. *Ibid.*, 337.

6. Whether Congress can decide the fact that an individual is an inventor or author, without leaving the question of invention, &c., open to investigation, the courts will never presume Congress to have decided that question in a gen-

eral act, the words of which do not render such a construction unavoidable. *Evans v. Eaton*, 3 Wheat., 513.—MARSHALL, Ch. J.; Sup. Ct., 1818.

7. 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. *Ibid.*, 518.

8. The power of Congress as to granting patents is general, and it rests in the sound discretion of Congress to say when and for what length of time and under what circumstances a patent for an invention shall be granted. There is no restriction which limits the power of Congress 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.

9. Therefore the act of Congress (act of 1839, ch. 14), granting a patent to Thomas Blanchard, is not unconstitutional because it operates retrospectively to give a patent for an invention, which, though made by the patentee, was in public use and enjoyed by the community at the time of the passage of the act. *Ibid.*, 541.

10. An act of Congress passed in general terms ought to be so construed, if it may, as to be deemed a just exercise of constitutional authority, and not only so, but it ought to be construed not to operate retrospectively, or *ex post facto*, unless that construction is unavoidable. *Ibid.*, 542.

11. The power of Congress to legislate upon the subject of patents is plenary by the terms of the Constitution, and as there are no restraints on its exercise, there can be no limitation of their

right to modify, at their 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.

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

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

14. Congress may, by special act, extend a patent even after the expiration of the original patent. *Ibid.*, 274, 276.

15. 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.

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

17. 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.

18. Congress may exercise its constitutional power as to granting rights to inventors by special grants, or otherwise by a general system. *Ibid.*, 161.

19. There is no mode by which a legislative act can be made irrevocable, except it assume the form and substance of a contract. But, though no state can impair the obligations of a contract, this inhibition does not apply to the general government. *Ibid.*, 161, 165.

20. A special act in relation to any particular patent, is to be considered as engrafted upon the general acts relating to patents; they are statutes in *pari materia*, and all relate to the same subject, and must be construed together. *Bloomer v. McQueen*, 14 How., 548, 550.—TANEY, Ch. J.; Sup. Ct., 1852.

21. Under the fifth amendment of the constitution, declaring that no person shall be deprived of life, liberty, and 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 could not be regarded as due process of law. *Ibid.*, 553.

22. Under the authority conferred upon Congress, by article first, § 8th of the constitution, to promote the progress of science and the useful arts, by securing to inventors the exclusive right to their inventions, 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 had before conveyed for a valuable consideration. *Ibid.*, 553.

## CONSIDERATION ON SALE OF PATENTS.

1. A promissory note given for an interest in a patent-right, which was not

valid, and had been fraudulently obtained, the patentee knowing at the time of his application that he was not the true inventor, is void as being without consideration, and even though certain things had been furnished by the assignor, and he had given instruction in the art described in the patent. *Bliss v. Negus*, 8 Mass., 51.—SEDGWICK, J.; Mass., 1811.

2. Where the title to a patent passes, the consideration money, if paid, cannot be recovered back, unless the contract has been rescinded, or was accompanied by fraud, or with an express warranty, not fulfilled. *Case v. Morey*, 1 N. Hamp., 350.—WOODBURY, J.; N. H., 1818.

3. Though the title to a patent fails, the purchaser cannot recover back the consideration paid, if any benefits have been derived from the use of the patent, provided such benefits were equivalent, and the purchaser was not liable for them to any prior patentee. *Holden v. Curtis*, 2 N. Hamp., 65.—WOODBURY, J.; N. H., 1819.

4. It seems a party would not be bound by the purchase of a patent-right, which he had supposed to be valid, when in fact it was invalid; but such misconception cannot be taken advantage of on a plea of want of consideration coupled with fraud, but the equity should be spread upon the record. *Bellas v. Hays*, 5 Serg. & Rawle, 439-442.—GIBSON, J.; Pa., 1819.

5. If a patentee include in his patent, along with his own invention, the invention of another person previously patented, and sell the whole to a person ignorant of these facts and who supposed he was buying an exclusive right to the whole, the sale is a fraud upon such person, and the vendor cannot recover



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a note given for the consideration of the purchase. *Turner v. Johnson*, 2 Cra., C. C., 287.—CRANCH, J.; D. C., 1822.

6. If a party sell an interest in a patent-right, making representations that are equivalent to a warranty that the invention is of value, but the title is passed by an ordinary bill of sale or assignment, which contains no words of guaranty, the purchaser cannot go behind such assignment, and prove representations and assertions previous to the execution of the assignment, and thus avoid payment; the presumption of law being that the writing contains the whole contract. *Van Ostrand v. Reid*, 1 Wend., 432.—SAVAGE, Ch. J.; N. Y., 1828.

7. It may be made a defence to an action on a note given in consideration of the sale of a patent, that the invention, if not useless, is of far less value than it was represented to be by the vendor at the time of sale. *Burnham v. Brewster*, 1 Verm., 90.—HUTCHINSON, J.; Vt., 1828.

8. In an action on a promissory note, given for the purchase of a patent-right, it is not a good defence under the plea of *non assumpsit*, that the invention was of less value than it had been represented, or that the vendor had falsely represented that another party had offered large sums for the right to use the patent. *Williams v. Hicks*, 2 Verm., 40, 42.—PADDOCK, J.; Vt., 1829.

9. An assignee of a patent sold the same, and at the time exhibited a machine which he supposed was made according to such patent, but which was afterward found to be different from that patented and described in the specification. *Held*, as the whole transaction was one founded on a mistake, that the deed of assignment, the notes given,

and the agreement made between the parties, should be delivered up and cancelled; and that the purchaser was not entitled to recover any damage which he had sustained in consequence of the purchase; but if the vendor had received anything under the agreement, he might be called upon to refund that so received. *Burrall v. Jewett*, 2 Paige, 146, 147.—WALWORTH, Chan.; N. Y., 1830.

10. Where a party sold and conveyed certain machines, a clapboard and shingle machine, and also the "patent-right" for a certain territory, *Held*, that such agreement must be construed to mean a conveyance of the patents for both such machines, and that as such party did not own any patent for the clapboard machine, that nothing passed by the conveyance, and that the venter was liable to refund the consideration paid. *Judkins v. Earl*, 7 Greenl., 13,—PARRIS, J.; Me., 1830.

11. In an action to recover on certain notes given in consideration for a patented machine, which was shown to be worthless, and an infringement upon a patent-right granted to another. *Held*, that no recovery could be had on such notes, as there was no good consideration therefor. *Peck v. Farrington*, 9 Wend., 44.—SAVAGE, Ch. J.; N. Y., 1832.

12. A promissory note given for the purchase of an interest in a patent, is without consideration if the patent is void, and notwithstanding the seller covenanted that he had good right to sell and convey, and that he would warrant the same against all parties, such covenant will not constitute a valid consideration. *Dickinson v. Hall*, 14 Pick., 220.—SHAW, Ch. J.; Mass., 1833.

13. Nor will it make any difference

that the seller, at the time of sale, believed that the patent was valid. *Ibid.*, 220.

14. A *useless* patent-right is no consideration for a promise to pay. *Fallis v. Griffith*, Wright, 303.—WRIGHT, J.; Ohio, 1833.

15. But it is no defence to a note given for the purchase of a patent, that the purchaser has not realized as much therefrom as he expected. *Ibid.*, 303.

16. The maker of a negotiable note, appearing on its face to have been given in consideration of a transfer of a patent-right, which proved to be of no value, cannot set up the defence of a want of consideration to an action by a *bona fide* indorser. *Goddard v. Lyman*, 14 Pick., 270.—WILDE, J.; Mass., 1833.

17. And the fact that it was indorsed "at the risk and costs" of the indorsee makes no difference in this respect. Such indorsement will be considered as having reference to the possible insolvency of the maker, and will not authorize a jury to infer that the indorsee had any prior knowledge that the patent-right was void, or that there was any reason to suspect such fact. *Ibid.*, 270, 271.

18. Where a note was given in payment for the exclusive right to use a patent within a certain district, it is a good defence to an action on such note, on the ground of failure of consideration, that the patent was void, by reason of non-compliance with the provisions of the acts of Congress authorizing the granting of patents. *Earl v. Page*, 6 N. Hamp., 480.—UPHAM, J.; N. H., 1834.

19. To enable a vendor of a patent-right to recover the agreed price, he must have a title in himself, and assign

the right or tender it, before he can sue for it. *Edwards v. Richards*, Wright, 597.—LANE, J.; Ohio, 1834.

20. In an action to recover on a note given in purchase for an alleged patent-right, *Held*, the thing patented not being new, and the specification also not clearly distinguishing what was new, that the patent was void, and that nothing passed to the purchaser, and therefore that there was no consideration for the note. *Cross v. Huntley*, 13 Wend., 386.—NELSON, J.; N. Y., 1835.

21. A plea, that the consideration of certain notes was the sale and conveyance of a certain patent-right, which the payee represented and warranted he was the true and lawful owner thereof, when in fact he was not, sets up a good defence to a suit to recover such notes. *Kernodle v. Grant*, 4 Blackf., 61.—STEPHENS, J.; Ind., 1835.

22. There is no implied warranty in the sale of a patent. The vendor, selling in good faith, is not responsible for the goodness of his title, beyond the extent of his covenants. *Hiatt v. Toomey*, 1 Dev. & Bat. Eq., 317.—DANIEL, J.; N. C., 1836.

23. Under the act of 1793 an assignment of a patent is not valid, and conveys no title until it has been recorded. And a note given to an assignee, whose assignment has not been so recorded, is without consideration and void. *Higgins v. Strong*, 4 Blackf., 183.—DEWEY, J.; Ind., 1836.

24. It is a good defence to an action brought to recover an amount agreed to be paid for an interest in a patent, that the patent is void by reason of its not stating clearly the character and extent of the patentee's invention. *Davis v. Bell*, 8 N. Hamp., 503.—RICHARDSON, Ch. J.; N. H., 1837.

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25. Where notes had been given for the purchase of a patent-right, and had been paid after the purchaser had full knowledge or means of knowledge of all the facts in relation to the transaction, *Held*, that such payment was voluntary, and that there could not be a recovery back of the sum paid; although the purchaser might have avoided payment of the notes for want of consideration. *Stevens v. Head*, 9 Verm., 177.—WILLIAMS, Ch. J.; Vt., 1837.

26. In an action of assumpsit to recover certain notes which were the consideration of the sale of a patent-right, *Held*, as the specification did not particularly describe the whole improvement claimed, but only a part, that the patent was void, not *pro tanto* as to the part not described, but *in toto*, and formed no consideration for the notes, and therefore no recovery could be had. *Head v. Stevens*, 19 Wend., 413.—COWEN, J.; N. Y., 1838.

27. A sold to B the right to use and vend a certain machine for two years, and took his note payable at the end of that time. It was agreed that if B could not make the machine profitable, he should return it at the end of the two years, with any avails he might have received, and give up the assignment, and A should give up his note. B made a machine, and did not find it profitable, and sold it to a third party, but never offered to return it, or gave notice of his want of success, or offered to surrender the assignment. *Held*, in an action on the note, that the question of consideration was one for the court, and that B not having complied with the terms of his agreement, could not avoid the note. *Pottle v. Thomas*, 12 Conn., 565, 569, 572, 575.—WILLIAMS, Ch. J.; Ct., 1838.

28. In an action of debt on a bond, *Held*, that it was admissible with a plea of *non est factum* to show that it was without consideration, as being given for the assignment of a right to use and sell a certain patent-right, when the vender had no such patent-right, and had no power to sell it. *McDowell v. Meredith*, 4 Wharton, 314.—GIBSON, Ch. J.; Pa., 1839.

29. If an improvement is new and valuable at the time of sale, the consideration of a note given for the same cannot be impeached by showing that subsequent improvements have rendered such invention useless. The purchaser takes the risk of any new discovery destroying its value. *Harmon v. Bird*, 22 Wend., 115.—BRONSON, J.; N. Y., 1839.

30. Relief in equity will be afforded against the payment of notes given for the purchase of a patent, which is void; and money paid thereon may be recovered back. *Durst v. Brockway*, 11 Ohio, 471.—BUCHARD, J.; Ohio, 1842.

31. A note given for a patent-right for a machine that is not new or useful, is without consideration, and void. *Dunbar v. Marden*, 13 N. Hamp., 317.—WOODS, J.; N. H., 1842.

32. In an action on a note given for a patent-right, the plaintiff cannot recover if the invention was not new or useful, or if the patent conveyed no right and was of no value, although both parties acted in good faith in giving and receiving the note. *Geiger v. Cook*, 3 Watts & Serg., 270.—SERGEANT, J.; Pa., 1842.

33. And the defendant may show these facts though the note is a sealed note, and has been given for a balance due on a former note. *Ibid.*, 270.

34. It is a good defence to an action

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to recover on notes given on the sale and conveyance of a patent, and as to which the seller claimed to be the inventor and owner, that such seller was not the first and true inventor. *Mulliken v. Latchem*, 7 Blackf., 138.—SULLIVAN, J.; Ind., 1844.

35. In an action for the price of a patent-right sold without warranty or fraud, the plaintiff is entitled to recover if the patent be of any value. *Vaughan v. Porter*, 16 Verm., 267, 270.—REDFIELD, J.; Vt., 1844.

36. Where an action is on a promise to pay a certain sum for the assignment of a patent, and such assignment was the consideration of the promise, the validity of the patent may be impeached, as a want of consideration in defence of the claim; but such a defence cannot be resorted to when the action is on a sealed instrument, or when another implied covenant of the plaintiff was the real consideration, upon which implied covenant the defendant would have a remedy if he has sustained any damage, or when the defendants have received the proceeds from the articles sold, to recover the agreed proportion of which the action is brought. *Wilder v. Adams*, 2 Wood. & Min., 331, 332.—WOODBURY, J.; Mass., 1846.

37. A patentee assigned his patent and received in payment certain bonds, and gave a covenant by which he guaranteed that he had good right and title to his letters patent, and that if any one should establish a lawful right to the invention then the said bonds should be null and void. *Held*, in a suit on the bonds, that the obligors could not set up the validity of the patent until that question had been settled elsewhere. *Ball v. Murry*, 10 Penn., 113. ROGERS, J.; Pa., 1848.

38. It is not a good defence to an action on promissory notes given for the purchase of a patent, that the consideration exceeds the value of the article. The consideration may indefinitely exceed the value of the thing for which it is promised, and still the bargain stand. *Hardesty v. Smith*, 3 Ind., 41.—PERKINS, J.; Ind., 1851.

39. If the patent, however, was represented of greater value than it is, this may perhaps be set up in mitigation of damages. *Ibid.*, 41.

40. Where, on the sale of an interest in letters patent, the purchaser had the privilege after the trial of the improvement patented for a specified time, if it proved useless or of no value to him, to reassign such interest and receive back the consideration; and after the expiration of the time so specified a reassignment was made and accepted by the vendees, *Held*, that such acceptance was a waiver of the condition requiring a trial of the patent, and entitled the purchaser to a return of the consideration. *Young v. Hunter*, 2 Seld., 208.—WATSON, J.; N. Y., 1852.

41. In an action on a bond given on the purchase of a patent, in which bond the party does not admit the existence of the patent, or of the right of the party to sell it, which would estop him to deny those facts, it may be shown that there was no such patent, or that it was invalid, or that the party had no right to sell it. *Nye v. Raymond*, 16 Ill., 154.—CATON, J.; Ill., 1854.

42. And where the bond was given for the patent and other property, and does not show at what sum the patent was estimated, the contract is not indivisible, and partial failure of consideration may be shown. *Ibid.*, 155.

43. If the assignee of a patent has

derived advantages from it, and then seeks to have the contract of assignment rescinded for fraud, he should aver that the profits received by him were so received prior to his discovery of the fraud, and he should return or offer to return the consideration received by him. *Edmunds v. Myers*, 16 Ill., 212.—SCATES, J.; Ill., 1854.

44. The patent was for a "design and configuration of ornaments, forming an ornamental design for a Horological cradle," and the deed of sale was for a Horological cradle, *Held*, that the phraseology did not import that there was machinery about it, and did not imply that the principle, machinery, or mode of operation was the subject of the patent. *Myers v. Turner*, 17 Ill., 181, 182.—CATON, J.; Ill., 1855.

45. In an action brought upon a promissory note given for the purchase of a patent, the purchaser is precluded from setting up the want of value in the invention if he has sold the right transferred to him to another for value. *Thomas v. Quintard*, 5 Duer., 82.—HOFFMAN, J.; N. Y., 1855.

46. By parting with the patent he has disabled himself from placing the plaintiff, by restoring the thing transferred, in the same situation he was in at the formation of the contract. *Ibid.*, 82.

47. The assignment of an interest in a patent granted for a "design for a Horological cradle" is a sufficient consideration to enable a party to recover on notes given therefor, although the invention may be practically of little or no value. *Myers v. Turner*, 17 Ill., 181. *Hildreth v. Turner*, 17 Ill., 184.—CATON, J.; Ill., 1855.

48. Where the patent assigned is referred to by date, it may be presumed

the purchaser examined it for himself. The maxim *caveat emptor* would apply. *Ibid.*, 181, 183.

49. In a suit on a note given for the conveyance of a patent-right, proof that such patent was void for being an infringement of a prior patent is not admissible, without that fact having been determined by a court of competent jurisdiction. *Elmer v. Pennel*, 40 Maine, 434.—RICE, J.; Me., 1855.

50. A note given for a patent that is void by reason of its being useless, is without consideration. *Jolliffe v. Collins*, 21 Mo., 343.—SCOTT, J.; Mo., 1855.

51. Where the consideration of a bond was the sale of a patent-right to make, use, and vend a certain medicine, represented to be patented, and no patent had been ever issued for such medicine, *Held*, that the plea of no consideration was sustained by such proof, and that there could be no recovery on the bond. *Bronon v. Wright*, 17 Ark., 34.—HANLY, J.; Ark., 1856.

52. H. purchased of B. the right to construct and use an alleged patented machine, and covenanted "to receive the said right as good and available to all intents and purposes, and that the same and the transfer shall not be liable to any objection for any supposed defect in, or objection to the said letters patent, if such supposed defect or objection should at any time arise." *Held*, that the vendor in an action for the price was estopped from alleging the invalidity of the patent. *Hielner v. Batten*, 27 Penn., 517, 519, 521, 524.—WOODWARD, J., Pa., 1856.

53. And such estoppel applies as well to the objection that the reissued patent was not for the same invention as the original, as to that against the

originality of the invention. *Ibid.*, 524.

54. In an action on a note given as consideration for a patent, the plaintiff cannot recover, if the invention for which patent was granted was not new and useful, or if the patent and specification do not describe the invention so that it can be known in what the improvement consists. *McClure v. Jeffrey*, 8 Ind., 82, 83.—DAVISON, J.; Ind., 1856.

55. In contracts in the sale of interests in a patent where there is no fraud, the purchaser must depend, where they prove of no value, upon his covenants. If both parties are equally innocent, and there is no warrant of title, the loss must fall wherever the bargain leaves it. *Cunsler v. Eaton*, 2 Jones, Eq., 501.—NASH, Ch. J.; N. C., 1856.

56. The defendant sold an interest in a certain patent to the plaintiff, who gave his bonds for the payment of the consideration. The plaintiff afterward found out the same invention had been patented previously to another, and filed his bill praying for an injunction to stay the collection of such bonds and for their surrender to be cancelled. The court refused to interfere, but left the plaintiffs to their remedy at law. *Ibid.*, 502.

57. An assignment contained a warranty that the invention was original, and that no other invention had been patented in the United States on the same principle. In an action of covenant in which breaches were assigned in the terms of the warranty, *Held*, that the patent was not conclusive that the invention was original and upon a new principle, and that upon proof of the breaches assigned the plaintiff could recover. *Wright v. Wilson*, 11 Rich. Law, 152.—O'NEALL, J.; S. C., 1857.

58. To enable a vendor of a machine and of the right to use a patented article therewith, to recover the price agreed to be paid, it is not necessary for him to produce evidence of his right under the patent, unless the vendee has been interrupted in the use of the patented article by one whose right is *prima facie* violated by its use. *Buss v. Putney*, 11 Mo. Law Rep., 687. N. H., 1858.

59. Where the plaintiff covenanted to improve machinery for manufacturing gas and to obtain a patent therefor and assign defendant the one-half for an agreed sum, and a patent having been obtained or assigned on an action brought to recover the agreed price, *Held*, that the defendant could show that the invention was worthless and had never been reduced to practice, and had been tried and abandoned as worthless before the patent was obtained, and that the patent was not for improved machinery, and that the plaintiff had not performed the conditions on his part. *McDougall v. Fogg*, 2 Bosw., 387, 391.—PIERREPONT, J.; N. Y., 1858.

60. A party who seeks to recover upon a contract containing mutual and dependent covenants must show that he has performed his part of the agreement. *Ibid.*, 390.

61. Defendant sold to plaintiff the right to make a certain horse-shoe, alleged to be secured by letters patent. In an action to recover back the money paid, the jury found that the shoe was worthless and was not covered by the patent. *Held*, that the contract was void *ab initio* for want of consideration, and that the money paid could be recovered back, and that the rules as to offer of rescission, notice, demand and

waiver did not apply. *Hoss v. Richardson*, 11 Mo. Law Rep., 670.—HUNTINGTON, J.; Mass., 1859.

### CONSPIRACY AGAINST PATENT.

1. What would be the legal effect of an actual combination to resist a patent is a question of much importance. *Woodworth v. Sherman*, 3 Story, 172.—STORY, J.; Mass., 1844.

2. It would seem that a combination of a number of persons to resist a patent approaches very near, if it does not actually reach, a criminal conspiracy. *Ibid.*, 173.

3. In many cases, it is lawful for individuals to do what cannot lawfully be done by a combination. *Ibid.*, 173.

4. An individual patentee may successfully resist an individual when it may be much more difficult to resist the combined force of a great number of persons united to oppose his patent. *Ibid.*, 173.

### CONSTRUCTION OF PATENT.

See PATENT, P.

### CONTRACTS AS TO PATENTS.

See AGREEMENTS.

### COPIES OF PAPERS IN PATENT OFFICE.

1. 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 applied for. *Anon.*, 1 Opin., 171.—PINCKNEY, Atty. Gen., 1812.

2. Under § 11 of the act of 1793, a defendant in a patent suit has a right to a copy of the plaintiff's specification, from the State Department, upon the payment of the legal fees, and use it the same way as any evidence, and no conditions can be imposed upon the use of such copy. *Anon.*, 1 Opin., 376.—WIRT, Atty. Gen., 1820.

3. Under § 11 of the act of 1793, all persons indiscriminately cannot demand copies of papers respecting patents granted to others. By § 6 a defendant must be considered as having a right to demand such copies, but as to others, it rests in the discretion of the department whether copies shall be furnished or refused. *Anon.*, 1 Opin., 718.—WIRT, Atty. Gen., 1825.

4. But no copies can be furnished at less than the statutory fee, per folio. *Ibid.*, 718.

5. Copies of papers cannot be taken from the Patent Office by third parties. They must be made by the proper officer, and the fees paid therefor. *Anon.*, 2 Opin., 456.—TANEY, Atty. Gen., 1831.

6. An exemplification of a specification of a patent is made evidence by § 8 of the act of 1793. 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. *Peck v. Farrington*, 9 Wend., 44.—SAVAGE, Ch. J.; N. Y., 1832.

7. A certified copy of a patent, surrendered and cancelled, is admissible in

evidence, to show that an improvement subsequently patented, is not original, though it does not specify when it was cancelled, or how, or for what defect. *Delano v. Scott*, Gilpin, 496.—HOPKINSON, J.; Pa., 1834.

8. A former and defective certified copy of a patent may be corrected by another full and corrected certified copy, and the defective one cannot affect the one that is complete. *Brooks v. Bicknell*, 3 McLean, 434.—McLEAN, J.; Ohio, 1844.

9. A transcript as to a renewal of a patent need not set forth all the steps of proceedings connected therewith. *Ibid.*, 435.

10. It will be sufficient, if it appear that the subject was before the proper tribunal, and that a decision was made in favor of a renewal. *Ibid.*, 435.

11. Certified copies of assignments of patents on record are competent evidence of the originals, and the production of the originals cannot be compelled. *Ibid.*, 436.

12. Papers or drawings on file in the Patent Office are public records, and certified copies of them must be received in evidence when offered. If they are discordant, one may destroy the effect of another; but they need not concur in every particular. *Emerson v. Hogg*, 2 Blatchf., 12.—BETTS, J.; N. Y., 1845.

13. If copies of a patent are erroneous, the Commissioner of Patents has the power and ought to make them conform to the patent itself and to the record. *Woodworth v. Hall*, 1 Wood. & Min., 260.—WOODBURY, J.; Mass., 1846.

14. Certified copies of papers in the Patent Office must be received as *prima facie* evidence of the genuineness of

the originals on file, and absolute evidence of the correctness of the copies from the record. *Parker v. Haworth*, 4 McLean, 371.—McLEAN, J.; Ill., 1848.

15. The Commissioner of Patents, having in 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; and for his refusal, an action will lie against him. *Boyden v. Burke*, 14 How., 583.—GRIER, J.; Sup. Ct., 1852.

16. But a demand accompanied by rudeness and insult, is not a legal demand. *Ibid.*, 583.

17. A subsequent and proper demand cannot however be refused on account of prior misconduct, or to enforce an apology. *Ibid.*, 583.

18. A certified copy from the Patent Office of an assignment recorded therein will be received as *prima facie* evidence of the genuineness of the original assignment, and the production of the original may be dispensed with. *Parker v. Bigler*, MS.—GRIER, J.; Pa., 1857.

19. A certified copy of an assignment of a patent, from the Patent Office of the United States, is *prima facie* evidence of the genuineness of the original. *Lee v. Blandy*, 2 Fisher, 91.—McLEAN, LEAVITT, JJ.; Ohio, 1860.

COPYRIGHT.

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**A.** ON WHAT FOUNDED; NATURE OF PROPERTY IN; WHAT INCLUDES.

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

2. 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 provided by law, 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.

3. In the United States, an author can have no exclusive property or copyright in his published production except under the laws of Congress. *Wheaton v. Peters*, 8 Pet., 662.—MCLEAN, J.; Sup. Ct., 1834.

4. 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.

5. 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., 530.—NELSON, J.; Sup. Ct., 1852.

6. Before publication, an author has the exclusive possession of the ideas

contained in his book, and the combination of words to represent 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*, 2 Amer. Law Reg., 228.—GRIER, J.; Pa., 1853.

7. 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 characters which exhibits to the eyes of another the ideas intended to be conveyed. This is what the law terms copy or copyright. *Ibid.*, 228.

8. There is no difference, as respects the character and quality of the right, between the right and property of an author at common law, and under the acts of Congress respecting copyrights, or what is an infringement of them. *Ibid.*, 228, 229.

9. A "copy" of a book must be a transcript of the *language* in which the conceptions of the author are clothed; of something printed and embodied in a tangible shape. The same conceptions clothed in another language cannot constitute the same composition. A translation in no just sense is a copy or transcript of a book. *Ibid.*, 229, 231.

10. 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.*, 229.

11. In questions of infringement of copyright, the inquiry is not whether the defendant has used the thoughts, conceptions, information, and discoveries promulgated by the original, but whether his composition may be con-

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sidered a *new work*, requiring invention, learning, and judgment, or only a mere transcript of the whole or parts of the original, with mere colorable variations. *Ibid.*, 229.

12. The case of *Miller v. Taylor*, 4 Burr, 2311, 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.

13. The distinction taken between works which are *publici juris* and those which are the subject of copyright, has no foundation in fact; if the doctrine of the established cases be true, and the author's property in a published book consists only in a right of copy. *Ibid.*, 231.

14. The words *copyright* and *literary property* are not synonymous. The latter phrase has a more general signification than *copyright*, which signifies the exclusive right of an author and his assigns to print his literary composition, and publish and republish it in print. *Keene v. Wheatley*, 9 Amer. Law Reg., 44.—CADWALLADER, J.; Pa., 1860.

15. The ordinary definition of literary property as the exclusive right to *multiply copies* is, for general purposes, too narrow, because the circulation of copies is not the only specific method in which the subject may be profitably used. *Ibid.*, 63.

16. Literary property may be described as the right which entitles an

author and his assigns to all the use and profit of his composition, to which no independent right is, through any act or omission on his or their part, vested in another person. *Ibid.*, 63.

## B. SUBJECT MATTER OF.

See also ABRIDGEMENT; CHARTS; COMPILATION; DICTIONARIES; DRAMATIC COMPOSITIONS; ENGRAVINGS; MAPS; MUSIC; PLAN; REPORTS; REVIEWS; TRANSLATION.

1. The object of the acts of Congress securing to authors the exclusive right to their writings, was the promotion of science. *Clayton v. Stone*, 2 Paine, 392.—THOMPSON, J.; N. Y., 1828.

2. But the term science cannot with any propriety be applied to a work of so fluctuating and fugitive a character as a newspaper or price current. Such a publication is not a book, the copyright of which can be secured under the acts of Congress. *Ibid.*, 392, 393.

3. 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.

4. The editor of an edition of Adam's Latin Grammar made alterations in, and additions to such work, and collected notes from various sources; *Held*, that as the collection and preparation of such notes required labor and intellectual exertion, and the plan and arrangement and combination of them were new, that he was to be deemed the author of

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<p>them in their form and arrangement, and entitled to a copyright accordingly. <i>Ibid.</i>, 17.</p>	<p>classification of the subject discussed. <i>Story's Exrs. v. Holcombe</i>, 4 McLean, 316.—McLEAN, J.; Ohio, 1847.</p>
<p>5. Any new and original plan, arrangement, or combination of materials will entitle the author to a copyright, even though the materials are not new. <i>Emerson v. Davies</i>, 3 Story, 778.—STORY, J.; Mass., 1845.</p>	<p>11. A person cannot have an exclusive right or copyright in a label, as it is not a book within the provisions of the statute. <i>Coffeen v. Brunton</i>, 4 McLean, 517.—McLEAN, J.; Ind., 1849.</p>
<p>6. Every author of a book has a copyright in the plan, arrangement, and combination of his materials, and in his mode of illustrating his subject, if it be new and original in its substance. <i>Ibid.</i>, 780.</p>	<p><b>C. WHO ENTITLED TO TAKE AND HOLD.</b></p>
<p>7. He who by his own skill, judgment, and labor writes a new work, and does not merely copy that of another, is entitled to a copyright therein, if the variations are not merely formal and shadowy from existing works. <i>Ibid.</i>, 781.</p>	<p>1. A person who employs others to design and engrave a composition, as an historical print, and who does not design and invent himself, or cause it to be done from his invention, is not entitled to a copyright for such composition. <i>Binns v. Woodruff</i>, 4 Wash., 53.—WASHINGTON, J.; Pa., 1821.</p>
<p>8. And he who constructs a book by a new plan and arrangement and combination of old materials, has a title to a copyright, which cannot be displaced by showing that some part of his plan, or arrangement, or combination, has been used before. <i>Ibid.</i>, 781.</p>	<p>2. A "resident" under the copyright act of 1831, 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. <i>Grey v. Collier</i>, 56 Niles Reg., 262.—BETTS, J.; N. Y., 1839.</p>
<p>9. And though all the materials of a work, or some parts of its plan and arrangement and modes of illustration may be found separately, or in a different form, or different arrangement in other distinct works, if the plan, arrangement, or combination of these materials in another work is new, or for the first time made, the author, or compiler, or framer of it, will be entitled to a copyright. <i>Ibid.</i>, 782.</p>	<p>3. Captain Marryatt, a subject of Great Britain, and an officer under that government, being temporarily in this country, took the required oath of his intention to become a citizen, and then took out a copyright for one of his books, and assigned the same to the plaintiff, <i>Held</i>, that he was not a "resident" within the meaning of the act of 1831, so as to be entitled to a copyright for his book. <i>Ibid.</i></p>
<p>10. 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</p>	<p>4. Whether an author who gives his work, not yet protected by copyright, to the public, by printing and publishing it in a newspaper, can have a copyright in the same work by afterward publishing it in a different form, as in</p>

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a volume or book; *query*. *Miller v. McElroy*, 1 Amer. Law Reg., 204.—HOPKINSON, J.; Pa., 1839.

5. Whether an author by depositing a title-page in the clerk's office, when the work it is intended for is not printed, nor written, nor the manuscript prepared for printing and publication, although the notes or materials from which the work or book is to be, and afterward actually is composed, are then in the hands of the author, may have a copyright of the work afterward prepared and composed, by affixing it to the title-page so deposited; *query*. *Ibid.*, 204.

6. Whether a notice given in some of the newspapers so publishing such matter that the author had secured a copyright, will help him as to his title; *query*. *Ibid.*, 205.

7. 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., O. S., 411.—TANEY, Ch. J.; Md., 1845.

8. 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.

9. A person cannot secure a copyright for alterations and improvements in a musical composition made by others for him and at his expense. *Atwill v. Ferrett*, 2 Blatchf., 46.—BETTS, J.; N. Y., 1846.

10. Under the copyright act of 1831, 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.

11. An artist who is employed by the United States to engrave a chart, of which the original manuscript was the property of and furnished by the government, has no pretence of right of copyright in the engraved plates or impressions therefrom. *Siebert's Case*, 7 Opin., 656.—CUSHING, Atty. Gen.; 1856.

12. Where an artist was attached to an expedition sent out by the government, as a master's mate, and as such agreed to perform such duties as should be required of him, but his chief duty was to make sketches and drawings for the government, and he was informed that all the sketches and drawings which should be made by any one were to be the exclusive property of the government, and that no one could appropriate them to his own use, and afterward such artist took out a copyright in his own name for the sketches made by him, *Held*, that he was not such an author and proprietor as to be entitled to an exclusive right in the sketches so made by him. *Heine v. Appletons*, 4 Blatchf., 128.—INGERSOLL, J.; N. Y., 1857.

13. Where a person, employed by another as a performer and stage-manager, agreed to write a play, which was to be performed in his, the employer's, theatre as long as it should continue to draw good audiences, *Held*, that the person writing the drama was the proper person to take out the copyright, and that the employer had no right or interest in it, except the privilege of having it performed at his theatre. *Roberts v. Myers*, 13 Mo. Law Rep., 400.—SPRAGUE, J.; Mass., 1860.

14. Under the act of 1831, no person

## HOW ACQUIRED; HOW LOST.

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.

15. The assignee of a work composed by a *non-resident alien*, cannot take a copyright for it. *Ibid.*

**D. HOW ACQUIRED; RIGHT TO; HOW LOST.**

1. The provisions of the act of 1790, which require the author to publish the title of his book in a newspaper, and to deliver a copy of the work itself to the secretary of state, are merely directory, and constitute no part of the essential requisites for securing the copyright. *Nichols v. Ruggles*, 3 Day, 158; 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 copy to be delivered to the secretary of state, appears to be designed for public purposes, and has no connection with the copyright. *Ibid.*, 158.

4. Under the copyright act of 1790, 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.

5. Under § 3 of the act of 1790, a proprietor can acquire no title to a copyright for the term of the first fourteen years, unless he shall deposit in the clerk's office a printed copy of the title

of the book. *Ewer v. Coxe*, 4 Wash., 490.—WASHINGTON, J.; Pa., 1824.

6. Under such act 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. *Ibid.*, 490.

7. 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 § 3; and the publication of a copy of the same would only be necessary to enable him to sue for the forfeitures created by that section. *Ibid.*, 490.

8. But by the supplemental act of 1802, no person can be entitled to the benefit of the act of 1790, unless he shall, *in addition* to the requisites enjoined by that act, cause a copy of the record required by that act to be published, to be inserted in the title-page, or in the next page. *Ibid.*, 490.

9. 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 the act of 1802 *in addition* to those prescribed in §§ 3 and 4 of the act of 1790, and must perform the whole. The act admits of no other construction. *Ibid.*, 491.

10. 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 §§ 3 and 4 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.

## HOW ACQUIRED; HOW LOST.

11. Under the act of 1790, and particularly when considered in connection with the act of 1802, an author can obtain no exclusive right in his work unless he complies with the requirements of §§ 3 and 4 of the act of 1790, by causing a copy of the record of his copyright to be printed in the newspapers, and delivering a copy of his work to the secretary of state. *Wheaton v. Peters*, 8 Pet., 664, 665.—McLEAN, J.; Sup. Ct., 1834.

12. 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.

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

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

15. 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. *Ibid.*, 199.

16. This case distinguished from *Wheaton v. Peters*, 8 Pet., 591, as in that case it did not appear that the volumes had been delivered to the secretary of state, at any time. *Ibid.*, 199.

17. The act of Congress of 1831, respecting copyrights, embodies the provisions of the acts of 1790 and 1802 on the subject, and imposes on 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.

18. Under such act, 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.

19. 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. *Ibid.*, 84.

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

21. Under § 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.

22. The publication of a work, without having secured a copyright, is a dedication of it to the public; that having been done, any one may republish it. *Bartlett v. Crittenden*, 5 McLean, 37.—McLEAN, J.; Ohio, 1849.

23. By the provisions of the copyright act of 1831, there are three preliminary steps requisite to the securing a valid copyright. 1. The deposit of a printed copy of the title before publication with the clerk of the district court; 2. Notice to the public, by printing in the place designated the fact of the entry, in the form prescribed by the statute; and 3. The deposit with the clerk of a copy of the book, &c., or musical composition, within three months from the date of publication. *Jollie v. Jacques*, 1 Blatchf., 620.—NELSON, J; N. Y., 1850.

## HOW ACQUIRED; HOW LOST.

## SECOND TERM OF; TO WHOM BELONGS.

24. § 10 of the act of 1846, establishing the Smithsonian Institution, required that authors should within three months from publication deliver one copy of their books, &c., to the librarian of that institution, and to the Congress library; but such delivery is not a pre-requisite to a title to the copyright. *Ibid.*, 620, 622.

25. The provision of the above act as to the delivery of a copy of a book to the librarian of the Smithsonian Institution and of Congress, is now repealed by § 6 of the act of 1859, chap. 22. [En.]

26. Until all the things required by § 4, 5, of the act of 1831 are done, the copyright is not secured; but by taking the incipient step, a right is acquired, which chancery will protect, until the other acts may be done. *Pulte v. Derby*, 5 McLean, 332.—McLEAN, J.; Ohio, 1852.

27. The publication of an official report under the direction of Congress, and for the benefit of the public, is a dedication of it, and of what is contained in it, to the public, and any one may reprint it. *Heine v. Appletons*, 4 Blatchf., 128.—INGERSOLL, J.; N. Y., 1857.

28. The provisions of § 5 of the copyright act of 1831, as to the deposit of the title-page of the book to be copyrighted before publication, and the deposit of a printed volume of the book within three months after publication, must be complied with, in order to enable a party to avail himself of the provisions secured by that act. *Struve v. Schwedler*, 4 Blatchf., 24.—NELSON, J.; N. Y., 1857.

29. Where neither of these steps had been taken until nearly two years after the work had been published, *Held*, that the author could not have an injunction to protect his alleged copyright. *Ib.*, 24.

30. The record from the clerk's office, made in the form prescribed by § 4 of the act of 1831, or of the depositing of a title-page, is *prima facie* evidence that a printed title was deposited. *Roberts v. Myers*, 13 Mo. Law Rep., 398.—SPRAGUE, J.; Mass., 1860.

31. 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. *Ibid.*, 398.

32. Under the statute, a copy of the book must be deposited within three months after its publication; but the acting or representing a play is not such a publication as is meant by the statute. *Ibid.*, 398.

33. The mere adoption of the measures, as depositing a title-page, by which a copyright may be secured, has no such effect, unless their adoption has been followed or attended by an actual publication in print. *Keene v. Wheatley*, 9 Amer. Law Reg., 44.—CADWALLADER, J.; Pa., 1860.

#### E. RENEWED OR SECOND TERM OF; TO WHOM BELONGS.

1. Where A employed B to compile a school book, and agreed to pay him \$500, and B conveyed to A the "copyright," *Held*, that only the usual copyright of fourteen years, then existing or taken out, passed under the contract. *Pierpont v. Fowle*, 2 Wood. & Min., 42, 43.—WOODBURY, J.; Mass., 1846.

2. Such an assignment is to be referred to what was then in existence, and not to any future contingency. *Ibid.*, 43, 45.

3. The extension of a copyright, by the copyright acts of 1790 and 1831,

is given to the author alone, or to others only who purchase it from him. *Ibid.*, 44.

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

5. 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.

6. 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.

7. A claim under a renewal term necessarily involves the validity of the right under the first as well as the second term. *Wheaton v. Peters*, 8 Pet., 663.—McLEAN, J.; Sup. Ct., 1834.

#### F. ABANDONMENT OF.

See ABANDONMENT, A.

#### G. ACTIONS RESPECTING.

See ACTIONS, A.

#### H. AGREEMENTS, AS TO.

See AGREEMENTS, A.

#### I. ASSIGNMENT AND TRANSFER OF.

See ASSIGNEE, A.; ASSIGNMENT, A, C.

#### J. AUTHOR, WHO IS.

See AUTHOR.

#### K. BOOK, WHAT IS.

See BOOK.

#### L. COURTS, JURISDICTION IN CASES OF.

See COURTS, A.

#### M. INJUNCTIONS, IN RESPECT TO.

See INJUNCTIONS, A.

#### N. PUBLICATION, WHAT IS.

See PUBLICATION.

#### O. TRANSLATION, COPYRIGHT IN.

See TRANSLATION.

#### P. VIOLATION OF.

See INFRINGEMENT, A.

### CORPORATIONS.

1. Though, as a general rule, corporations are not liable to be sued in actions of tort, it does not follow that they may not be sued in actions on the case for injuries done to the rights of others, notwithstanding the plea is, not guilty. *Kneass v. Schuylkill Bank*, 4 Wash., 14.—WASHINGTON, J.; Pa., 1820.

2. Therefore, when a corporate body, acting in its corporate character, directs an act to be done which infringes the rights of another, as the using of his invention, they may be sued in an ac-



tion on the case for such infringement. *Ibid.*, 14.

3. A corporation chartered under the laws of a state, for the purpose of carrying on manufactures by means of a particular invention, has, independently of any general act giving to corporations the right to hold personal estate, power to purchase the patent for the invention, for the working of which it was chartered. *Blanch. Gun-Stock Turn. Fac. v. Warner*, 1 Blatchf., 277. —NELSON, J.; Ct., 1846

4. By the common law, corporations have a right to purchase and hold property so far as may be necessary to carry into execution the purposes and objects for which they are created. *Ibid.*, 277.

5. A corporate body created by the laws of one state, has no corporate existence beyond the limits of the territory within which the law creating it can operate, and is not such a person as can be considered an inhabitant of any district, so as to be served with process. *Day v. Newark I. R. Co.*, 1 Blatchf., 632.—NELSON, J.; N. Y., 1850.

6. Where, therefore, the defendants were a corporation created by the laws of New Jersey, but had a store in the city of New York, and a process of attachment under the laws of New York was commenced against and levied upon its property in New York, and the summons was also served upon the president of the company who was casually in New York, *Held*, that the Circuit Court had no jurisdiction of the action. *Ibid.*, 633, 634.

7. Under § 11 of the judiciary act of 1789, the Circuit Courts have no jurisdiction in suits instituted against foreign corporations, even in cases where the state practice, if adopted by them, would authorize the institution of such

suits by attachment of their goods found within their jurisdiction. *Ibid.*, 634.

8. The directors of a manufacturing corporation, who manage and superintend its business, and under whose direction it manufactures and sells articles which are an infringement of a patent, and its agents who conduct its business of selling such articles, are responsible for such infringement, and will be restrained by injunction. *Goodyear and N. E. Car-Spring Co. v. Phelps*, 3 Blatchf., 92.—NELSON, J.; N. Y., 1853.

9. A railroad corporation, created by one state, and owning a road within that state, is liable to an action for the use of a patented improvement on cars run on that road, though another corporation, created by another state, held the stock, furnished and worked the road, but charged to the first corporation the expense of such outlays, and credited it with the earnings. *York & Md. R. R. Co. v. Winans*, 17 How., 40.—CAMPBELL, J.; Sup. Ct., 1854.

10. A corporation is liable in damages for infringing a patent, if the patented machines are procured by such corporation, and are used by those employed or paid by it. *Ransom v. Mayor, &c.*, 1 Fisher, 274.—HALL, J.; N. Y., 1856.

11. A corporation acts only by those who are in its employ. Where one in the employ of a corporation, in the business of his employment, does an act for their benefit, and which they adopt and approve and take advantage of, the corporation will be deemed to have authorized the act, and will be bound by it as if expressly authorized. *Poppenheusen v. N. Y. G. P. Comb Co.*, 2 Fisher, 72.—INGERSOLL, J.; N. Y., 1858.

12. The manufacture of articles in violation of a patent, by an agent of a

corporation, and the sale of such articles by and for the benefit of such corporation, makes them liable for the infringement. *Ibid.* 72, 73.

13. The fact that as between themselves parties are connected together as the stockholders, managers, and servants of a corporation, will not exempt them from being enjoined, or being liable to an action for infringement. *Poppenhausen v. Fulke*, 4 Blatchf., 494.—SHIPMAN, J.; N. Y., 1861.

### COSTS IN PATENT SUITS.

1. At common law a plaintiff was not entitled to costs in any case; and the statute of Gloucester giving costs gave them only in cases where damages were recoverable at common law. *Kneiss v. Schuylkill Bank*, 4 Wash., 107.—WASHINGTON, J.; Pa., 1821.

2. It is the act of Congress alone which gives an inventor a right of property in the subject of his invention, consequently an action for an infringement of a patent is not a case in which damages could have been recovered at common law. *Ibid.*, 107.

3. Under § 20 of the judiciary act of 1789, if a plaintiff recovers less than five hundred dollars, he cannot recover costs; but at the discretion of the court may be adjudged to pay them. *Ibid.*, 107.

4. In an action for an infringement of a patent the plaintiff recovered *three cents damages*, and at a subsequent term of the court obtained a rule upon the defendants to show cause why the costs should not be trebled. The defendants retorted by a rule on the plaintiffs to show cause why the judgment

should not be entered without costs. The court discharged the first rule and made the second absolute. *Ibid.*, 107.

5. A plaintiff is not entitled to recover costs for an infringement of a patent, as to which a disclaimer is filed, unless such disclaimer is filed before suit brought, even if he proves an infringement of a part of the invention not disclaimed. *Reed v. Cutter*, 1 Story, 600.—STORY, J.; Mass., 1841.

6. Though the deposition of a witness residing more than one hundred miles from the place of trial has been taken, the witness may be produced on the trial, and if so produced full costs of his personal travel and attendance will be allowed in the costs. *Prouty v. Ruggles*, 2 Story, 200.—STORY, J.; Mass., 1842.

7. Postage paid for the transmission of a commission to take testimony should be allowed as part of the costs. *Ibid.*, 202.

8. Where a demurrer could have been taken to a bill in equity, but the defendants instead of demurring filed an answer, and testimony was taken and the bill was dismissed upon the merits, because the plaintiff did not show a sufficient title, *Held*, that the defendants were not entitled to costs. *Brooks v. Byam*, 2 Story, 553.—STORY, J.; Mass., 1843.

9. Costs in equity are altogether in the discretion of the court, but this discretion is to be a sound one, exercised on principle, and with a reference to the general rules of practice. *Ibid.*, 553, 554.

10. Where a bill was dismissed on the merits, each party to bear his own costs, but a record had been printed under the order of the court, *Held*, that the costs of the printing such record

was to be equally divided between the parties. *Ibid.*, 554.

11. In the first circuit the plaintiff in patent cases is not required to give security for costs. *Woodworth v. Sherman*, 3 Story, 173.—STORY, J.; Mass., 1844.

12. Where neither the laws of a state nor the acts of Congress provide for the allowance of any particular item of costs, it is to be taxed only when relating to the competent evidence in the case, and connected with what is appropriately a matter of cost rather than damages and expenses in preparing a cause. *Hathaway v. Roach*, 2 Wood. & Min., 71.—WOODBURY, J.; Mass., 1846.

13. If a case is suspended or postponed by agreement, and not by order of court, except to carry such agreement into effect, the witnesses will not be allowed another travel fee, unless such is the agreement, but their continued attendance until discharged will be allowed. *Ibid.*, 72.

14. In the courts of the United States witnesses are entitled to travel "from the places of their abode" by the act of Congress (act of 1799, ch. 9, § 6, vol. 1 Stat. at Large, p. 626), though beyond the line of the state. *Ibid.*, 73.

15. Copies of assignments, showing plaintiff's interest, and produced and obtained by the defendant, are taxable in defendant's costs, as they are competent and proper evidence, and the plaintiff is not bound to produce them, nor is the defendant bound to ask plaintiff's admission to such assignment. *Ibid.*, 74.

16. But a copy of the plaintiff's patent, procured by the defendant, is not taxable, as the plaintiff is bound by law to offer it in evidence. *Ibid.*, 74.

17. In equity, as a general rule, costs are allowed to the prevailing party. What prevails by law is presumed to be moral, and conscientious, and equitable. But if peculiar circumstances, of an equitable character, exist against a party, they may be withheld; but the burden to show these peculiar circumstances is on the party asserting them. *Hovey v. Stevens*, 3 Wood. & Min., 32, 33.—WOODBURY, J.; Mass., 1846.

18. If a long defence is put in by a respondent and fails, and the bill is dismissed on other grounds, he will not be allowed costs. And if the action was not for any wrong of the defendant, but to settle the title of the plaintiff, and he has a decree, he will have no costs as against the defendant. *Ibid.*, 33.

19. The fact that a bill for an injunction failed, on account of a defective specification, is not a failure for any fault of the defendant; nor is it from the want of form in the bill or pleadings, and hence not to be visited by large costs against the plaintiff. But it was a defect in the plaintiff's title. *Ibid.*, 34.

20. Where the course of the defendant was not wholly favorable to his claims in equity, only disbursements and the usual counsel fee were allowed, and he was not permitted to tax the travel and attendance of witnesses, who were in attendance in an action at law, at the same term, between the same parties. *Ibid.*, 36, 37.

21. Where a patent is too broad, the plaintiff in an action for infringement, though he may recover judgment, is not entitled to costs against the defendant, unless a disclaimer shall have been filed before the commencement of the suit. But the question of damages, and

the power of the court to increase the verdict, remain the same as if costs were allowed. *Guyon v. Serrell*, 1 Blatchf., 245, 246.—NELSON, J.; N. Y., 1847.

22. Where a patent contains several claims, and the invention embraced by one is not new, or is useless, the patentee under §§ 7 and 9 of the act of 1837 may still maintain an action for an infringement, although he did not, before the commencement of the suit, make a disclaimer of that part of the invention claimed without right; but he will not be entitled to costs. *Hall v. Wiles*, 2 Blatchf., 198.—NELSON, J.; N. Y., 1851.

23. If, in the progress of the trial, it turns out that a disclaimer ought to have been made as to part of what is claimed, the plaintiff may still recover, but will not be entitled to costs. *Ibid.*, 198.

24. Where a judgment is entered up without the costs having been taxed and inserted in it, it is proper for the court, at a subsequent term, to have the costs taxed and entered *nunc pro tunc* as a part of the original judgment. *Sizer v. Many*, 16 How., 103.—TANEY, Ch. J.; Sup. Ct., 1853.

25. Under § 9 of the act of 1837, in an action for infringement, the plaintiff is not entitled to recover costs upon a judgment in his favor, if he has claimed any thing in his patent, of which he was not the first and original inventor, unless before suit brought he has disclaimed such part; and it makes no difference, in this respect, whether the infringement alleged was in respect to the part claimed, but not new, or of some other part claimed in the patent. *Seymour v. McCormick*, 19 How., 105.—NELSON, J.; Sup. Ct., 1856.

26. Under the act of Feb. 26, 1853, (10 U. S. Stat., at Large, 162), the item of \$2.50 allowed as costs to a solicitor

for each deposition taken and admitted in evidence in a cause, is not taxable in an equity suit, except for the deposition when admitted on a final hearing. *Stimpson v. Brooks*, 3 Blatchf., 458.—BETTS, J.; N. Y., 1856.

27. The whole provision of that statute, covering taxable proceedings, has direct relation to those which are final in the cause, and not to interlocutory or incidental ones, however necessary they may be in its progress. *Ibid.* 457.

28. In an action at law for the infringement of a patent, the expense of models of the defendant's machines cannot be taxed against him. *Parker v. Bigler*, 1 Fisher, 286.—GRIER, J.; Pa., 1857.

#### COUNSEL FEES IN PATENT SUITS.

1. Counsel fees and expenses of witnesses, beyond the taxable costs, are not to be considered as items of actual damage. (So held on the authority of *Arcambal v. Wiseman*, 3 Dall., 306.) *Whittemore v. Cutter*, 1 Gall., 431, 433.—STORY, J.; Mass., 1813.

2. The jury are at liberty, if they see fit, to allow a plaintiff as part of his "actual damages," any expenditure for counsel fees, or other charges, which were necessarily incurred to vindicate the rights derived under his patent, and which are not taxable in the bill of costs. *Boston Manuf. Co. v. Fiske*, 2 Mas., 122.—STORY, J.; Mass., 1820. (So held after a fuller and more careful examination of the case of *Arcambal v. Wiseman*, and overruling the decision in *Whittemore v. Cutter*.) [But see *post* 3, 5, 8-11.]

3. In an action of infringement, the jury may allow the plaintiff in damages,

his actual costs, which include reasonable counsel fees, as well as any taxable costs he had paid in consequence of the violation of defendant. *Allen v. Blunt*, 2 Wood. & Min., 146.—WOODBURY, J.; Mass., 1846.

4. The "actual damages" sustained include all necessary and proper expenses in protecting one's violated rights. Though they should not include "smart-money," they may well embrace every thing really suffered by the wrong. *Ibid.*, 146, 147.

5. Counsel fees, and other expenditures, beyond or in addition to those taxable, cannot be allowed by the jury as a part of the *actual* damages sustained by a plaintiff in an action for an infringement of a patent. *Stimpson v. The Railroads*, 1 Wall, Jr., 166, 169.—GRIER, J.; Pa., 1847.

6. In no case is the degree of the defendant's delinquency to be measured by the expenses of the plaintiff in prosecuting his suit. *Ibid.*, 170.

7. Where the circumstances of infringement are of an aggravated character, what are sometimes called vindictive damages, which would include counsel fees, and something more by way of example, to deter others from doing the same thing, may be given. *Parker v. Corbin*, 4 McLean, 463.—McLEAN, J.; Ohio, 1848.

8. In the second circuit the jury are confined to the actual damages sustained by the plaintiff, and cannot include as a part of his damages his expenses and counsel fees. *Blanch. Gun-Stock Manuf. Co. v. Warner*, 1 Blatchf., 272 (note).—NELSON, J.; Ct., 1846.

9. Expenses and counsel fees are not to be included in the verdict as actual damages. *Simpson v. Leiper*, 2 Whar. Dig., 414.—GRIER, J.; Pa., 1848.

10. The jury are to give compensatory damages, such as will indemnify the plaintiff for the injuries he has directly sustained, but they cannot include the expenses of litigation in their verdict. *Parker v. Hulme*, 7 West. Law Jour., 429.—KANE, J.; Pa., 1849.

11. Counsel fees are not a proper element for the consideration of the jury in the estimation of damages, in actions for the infringement of a patent. *Teese v. Huntington*, 23 How., 8.—CLIFFORD, J.; Sup. Ct., 1859.

## COURTS, JURISDICTION OF.

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## A. IN RESPECT TO COPYRIGHTS AND MANUSCRIPTS.

See also ACTIONS, A.; EQUITY, A.; INJUNCTIONS, A.; LETTERS; MANUSCRIPTS.

1. At common law, the author of a manuscript may obtain redress against any one who deprives him of it, or who by improperly obtaining a copy endeavors to realize a profit from its publication. *Wheaton v. Peters*, 8 Pet., 657.—McLEAN, J.; Sup. Ct., 1834.

2. And there can be no doubt that the rights of an assignee of such manuscript would be protected by a Court of Chancery. *Ibid.*, 661.

3. Where a wrong has been commit-

ted in respect to a literary work, but the bill does not ask an injunction to protect the common law right 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. Ch.; N. Y., 1837.

4. 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.

5. These acts merely enabled them to prosecute such claims in the Circuit Court of the United States as they legally 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, questions connected with rights so held. *Ibid.*, 27.

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

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

8. At common law, an author may maintain an action for the damages which he might sustain by his manuscript being surreptitiously printed by others. *Hoyt v. McKenzie*, 3 Barb. Ch., 323.—WALWORTH, Chan.; N. Y., 1848.

9. The common law protects the right

of an author to his manuscript only. *Bartlett v. Crittenden*, 5 McLean, 38.—MCLEAN, J.; Ohio, 1849.

10. But § 9 of the copyright act of 1831 also protects such right. *Ibid.*, 38.

11. In a suit under the copyright acts, the plaintiff must make out a title to sue under his copyright. The court cannot interfere to prevent the use of a work in fraud of the plaintiff, upon principles relating to the good-will of trades. *Jollie v. Jaques*, 1 Blatchf., 627.—NELSON, J.; N. Y., 1850.

12. A suit arising out of an agreement as to the publication of a manuscript, and to determine the rights of the parties under it, is not a suit under the copyright laws, of which the Circuit Court has jurisdiction by reason of subject matter. *Pulte v. Derby*, 5 McLean, 336.—MCLEAN, J.; Ohio, 1852.

13. The act of February 15, 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; § 9 of the act of 1831 protects manuscripts only. *Stephens v. Gladding*, 17 How., 455.—CURTIS, J.; Sup. Ct., 1854.

14. 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.

15. 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.

16. Where an assignment of a play gave to the assignee the exclusive right to represent the same within a certain territory for a fixed period of time, and only the title-page of such play had been filed, but no printed copy had been deposited, on bill filed by the assignee to protect his right, *Held*, that the court had jurisdiction. *Roberts v. Myers*, 13 Mo. Law Rep., 400, 401.—SPRAGUE, J.; Mass., 1860. [But see *post* 21.]

17. 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.—CADWALLADER, J.; Pa., 1860.

18. And under the statutes which confer and regulate *rights* of literary proprietorship, the citizenship of such parties is also unimportant. It is sufficient if the complainant is a resident of the United States. *Ibid.*, 45.

19. The act of 1831, § 9, giving redress for the unauthorized *printing* or *publishing* of *manuscripts*, gives no redress for an unauthorized theatrical representation of a play. The word *publish* means publish in *print*. *Ibid.*, 45.

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

21. Where a play had never been printed, and consequently a copy there-

of could not be deposited with the clerk within the time prescribed after its *publication*, but all the other statutory requirements had been complied with, *Held*, that jurisdiction for an unauthorized publication could not be maintained under such act of 1856. *Ibid.*, 45.

22. But jurisdiction of such a case may be maintained if the parties, plaintiff and defendant, are residents of different states, or if the plaintiff is an alien. *Ibid.*, 45, 46.

## B. IN RESPECT TO PATENTS.

### 1. Supreme Court United States.

See also APPEALS, A.; BILL OF EXCEPTIONS; WRIT OF ERROR.

1. The question whether one machine is substantially like another is one of fact, and cannot be certified to the Supreme Court under § 6 of the act of 1802, ch. 31. Such act applies only to questions of law. *Wilson v. Barnum*, 8 How., 262.—TANEY, Ch. J.; Sup. Ct., 1849.

2. Where the principles governing a patent cause have been settled by this court, it will decline to hear an argument upon technical questions of pleading arising in another case, under the same patent, and the ruling in respect to which would have no influence upon the ultimate decision of the case. *Smith v. Ely*, 15 How., 142.—TANEY, Ch. J.; Sup. Ct., 1853.

3. An objection not taken before the court below cannot be taken before the Supreme Court on appeal. *Kinsman v. Parkhurst*, 18 How., 295.—CURTIS, J.; Sup. Ct., 1855.

4. Where a bill is filed to enforce the specific performance of a contract in re-

lation to a patent, the Supreme Court has no appellate jurisdiction, unless the matter in controversy exceeds the value of two thousand dollars. *Brown v. Shannon*, 20 How., 56, 57.—TANEY, Ch. J.; Sup. Ct., 1857.

5. The court may, however, lawfully exercise its jurisdiction when a far less amount is in dispute, if a party is proceeding in law or equity for the infringement of a patent-right to which he claims to be entitled. *Ibid.*, 56.

6. The amount of the penalty in a bond taken on an injunction in the court below cannot be referred to to give jurisdiction. *Ibid.*, 58.

## 2. Circuit Courts United States.

See also ACCOUNT; EQUITY, B.; INJUNCTION, B.

1. The Circuit Courts, if not inferior in the technical sense of the books, are so considered by the constitution, and are in fact subordinate to the Supreme Court, and their jurisdiction is special and limited, both in regard to the nature of the cases on which they can decide, and the character of the parties who can come into them. *Livingston v. Van Ingen*, 1 Paine, 48.—LIVINGSTON, J.; N. Y., 1811.

2. If jurisdiction of cases "arising under the laws of the United States" be not conferred on these courts by an act of Congress, they cannot take cognizance of them. *Ibid.*, 50.

3. By the judiciary act of 1789 the Circuit Courts were not clothed with equity powers in actions between citizens of the same state; and under the act of 1800 they were given jurisdiction in patent cases only in actions on the case. On a bill filed to restrain the in-

fringement of a patent, where all the parties were citizens of the same state, *Held*, that the court could not take cognizance of such a case, and that the bill must be dismissed. *Ibid.*, 52, 54.

4. If, however, under the act of 1800 it became necessary in an action at law regularly before such court, for either party to appeal to its equity side in aid or defence of such action, such application might not be improper. *Ibid.*, 53.

5. A Circuit Court must not only confine itself to the cases defined by Congress, but if by a particular law it is authorized to proceed in a given case as a court of law only, a party must come into it on that side to bring himself within the provisions of it. *Ibid.*, 54.

6. The fact that the subject matter of a contract sought to be enforced is a patent-right, does not *per se* give the courts of the United States jurisdiction; a bill filed for the specific performance of such a contract must contain the proper averments to give such jurisdiction. *Burr v. Gregory*, 2 Paine, 426, 429.—THOMPSON, J.; N. Y., 1828.

7. Under the acts of 1793 and 1800, the Circuit Courts of the United States alone have jurisdiction of actions brought for damages *for the infringement of a patent-right*; as by those acts *in such actions* the court can declare the patent void. *Burrall v. Jewett*, 2 Paige, 145.—WALWORTH, Ch.; N. Y., 1830.

8. But the jurisdiction conferred upon such courts by the act of 1819, "in suits both at law and equity arising under the patent laws," is not, either in terms or by necessary implication, rendered exclusive as to all actions in reference to patents. *Ibid.*, 145, 146.

9. A Circuit Court in a civil suit cannot declare a patent void except for the



cause specified in § 6 of the act of 1793. If the patent is defective for any other cause the verdict must be general for the defendant. *Whitney v. Emmett*, Bald., 316, 317, 321.—BALDWIN, J.; Pa., 1831.

10. Under §§ 16 and 17 of the act of 1836, the Circuit Courts of the United States have exclusive cognizance of suits in equity, relative to interfering patents in cases where the court is authorized to adjudge and declare a patent inoperative or void, either wholly or in part, or in any particular portion of the United States. *Gibson v. Woodworth*, 8 Paige, 134.—WALWORTH, Ch.; N.Y., 1840.

11. Whether such courts have exclusive jurisdiction of every case in which a right under the patent laws might come in question collaterally; or in cases except where from the nature of the relief, their jurisdiction must necessarily be exclusive; *query*. *Ibid.*, 134.

12. The Circuit Courts have no jurisdiction of an action, as to enforce the specific execution of a contract respecting a patent, where the parties are all citizens of the same state; but where the plaintiffs set up a right under a patent, and allege that the defendants are infringing, citizenship will not oust jurisdiction. *Brooks v. Stalley*, 3 McLean, 525.—MCLEAN, J.; Ohio, 1845.

13. But where the court has obtained jurisdiction on the ground of infringement, it may then decide other matters which of themselves would not afford ground for the original exercise of jurisdiction. *Ibid.*, 529.

14. Under § 17 of the act of 1836, the jurisdiction as to subject matter of the Circuit Court does not extend to a bill in equity filed for the specific performance of a contract to transfer a

patent, the jurisdiction of such courts being confined to actions under the patent laws granting or confirming rights to inventors. *Nesmith v. Calvert*, 1 Wood. & Min., 37.—WOODBURY, J.; Mass., 1845.

15. If such a bill is filed against several defendants, some of whom are residents of the same state with the complainants, the bill may still be maintained against the defendants who are residents of another state. *Ibid.*, 37.

16. And if such bill contain a prayer for an injunction against the use of the patent by all, this would be ground, it seems, of jurisdiction over all the defendants as to subject matter. *Ibid.*, 38.

17. Objections to the jurisdiction on account of parties or subject matter, if not made until after answers are put to the merits, replications filed, and the evidence published, will be too late. *Ibid.*, 38.

18. Proceedings by bill in equity, under § 16 of the act of 1836, and § 10 of the act of 1839, 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 cannot be brought elsewhere. No tribunal out of the district has jurisdiction over the person of the Commissioner of Patents, as such, and the Patent Office. *Prentiss v. Ellsworth*, Mir. Pat. Off., 36.—RANDALL, J.; Pa., 1846.

19. Where an owner of an undivided interest in a patent filed a bill against the other joint owner to compel the specific performance of a contract in respect to manufacturing under such patent, and the defendant among other things denied that he was manufacturing under the patent, and set up that

the article manufactured by him was different from that patent, *Held*, that the question raised was one of infringement of a patent-right, of which a state court had no jurisdiction. *Parkhurst v. Kinsman*, 2 Halst., Ch., 600-609.—HALSTEAD, Chan.; N. J., 1847.

20. In cases arising under the patent laws, the jurisdiction of the Circuit Courts does not depend upon the citizenship of the parties to the action, or the amount in dispute, but upon the subject matter. The parties may be citizens of the same state, and the amount may be large or small. *Allen v. Blunt*, 1 Blatchf., 486.—NELSON, J.; N. Y., 1849.

21. The judiciary act of 1789, § 11, 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. *Ibid.*, 486.

22. It is only necessary to give jurisdiction in patent cases, that the process is served personally upon the defendant in the district where the suit is brought, as provided by the latter clause of § 11 of the act of 1789, above referred to. *Ibid.*, 486.

23. To confer jurisdiction, the return of the marshal upon the writ or subpoena should state that the service of such writ or subpoena was made within the district where suit was brought. *Ibid.*, 487.

24. Under § 17 of the act of 1836, the Circuit Courts of the United States have not only *original*, but also *exclusive* jurisdiction of all actions arising under the patent laws. *Dudley v. Mayhew*, 3 Coms., 14.—STRONG, J.; N. Y., 1849.

25. Although the jurisdiction of the Circuit Court embraces all cases, both

at law and in equity, arising under the patent laws for infringements of letters patent, without regard to the citizenship of the parties or the amount in controversy, the provisions of § 11 of the judiciary act of 1789, as to the commencement of suits, applies to these cases as well as to others—and hence such a suit cannot be brought in any other district than that whereof the defendant is an inhabitant, or in which he shall be found at the time of serving the writ. *Day v. Newark I. R. Co.*, 1 Blatchf., 630, 631.—NELSON, J.; N. Y., 1850.

26. A corporate body created by the laws of one state has no corporate existence beyond the limits of the territory within which the law creating it can operate, and is not such a person as can be considered an inhabitant of any district so as to be served with process. *Ibid.*, 632.

27. Where, therefore, the defendants were a corporation created by the laws of New Jersey, but had a store in the city of New York, and a process of attachment under the laws of New York was commenced against and levied upon its property in New York, and the summons was also served upon the president of the company, who was casually in New York, *Held*, that the court had no jurisdiction of the action. *Ibid.*, 633, 634.

28. Under § 11 of the judiciary act, the Circuit Courts have no jurisdiction in suits instituted against foreign corporations, even in cases where the state practice, if adopted by them, would authorize the institution of such suits by attachment of their goods found within their jurisdiction. *Ibid.*, 634.

29. The acts of Congress adopting the state process, adopt the forms and modes of service only so far as the persons are rightfully within the reach of

such process, and do not intend to enlarge the sphere of the jurisdiction of the Circuit Courts. *Ibid.*, 630.

30. A citizen of the state of Connecticut brought suit in New York against a citizen of the state of New Jersey, for the violation of an agreement, the subject matter of which was a patent, and prayed an account. *Held*, that under § 11 of the judiciary act of 1789, the Circuit Court of the United States had no jurisdiction, as neither of the parties was a citizen of the state of New York, and that jurisdiction could not be sustained under the patent acts, as the action was not respecting a patent. *Goodyear v. Day*, 1 Blatchf., 566.—NELSON, J.; N. Y., 1850.

31. The purchaser of a patented article for the purpose of *using* it, exercises no rights created by the acts of Congress, nor does he derive title by virtue of the franchise or privilege granted to the patentee. When the machine passes to the hands of the purchaser, it is no longer under the protection of the acts of Congress, but becomes private property, protected by the laws of the state where it is situated. If the right to it is infringed, redress is to be sought in the courts of the state, according to the laws of the state, and not in the courts of the United States, nor under the laws of Congress. *Bloomer v. McQueenan*, 14 How., 549.—TANNEY, Ch. J.; Sup. Ct., 1852.

32. Under § 17 of the act of 1836, the Circuit Courts have jurisdiction irrespective of the right of the plaintiff to an injunction, or a demand for one. *Nevius v. Johnson*, 3 Blatchf., 83.—NELSON, BETTS, JJ.; N. Y., 1853.

33. Accordingly, where the plaintiff's patent had expired, and a bill in equity filed by him alleged an infringement of

the patent, and prayed for a discovery and an account, but not for an injunction, *Held*, on a demurrer to the bill, that the court had jurisdiction. *Ibid.*, 83.

34. A process of attachment, whether direct or foreign, by which the property of the defendant is attached, by virtue of state laws, cannot give the Circuit Court jurisdiction over a person not an inhabitant of, and not found within the district. *Saddler v. Hudson*, 2 Curt., 7.—CURTIS, J.; Me., 1854.

35. The proper place to file a bill for an injunction, is the state where the defendant resides. An injunction will not issue out of a court in a state different from that where such defendant resides and carries on his business, on the ground that they would be beyond the process of the injunction, and the issuing of it would be inoperative and useless. *Goodyear v. Chaffee*, 3 Blatchf., 270.—NELSON, J.; N. Y., 1855.

36. The power of determining the validity of a patent, is *exclusively* confined to the Circuit Courts of the United States, and the state courts cannot entertain a suit for an infringement, or to declare a patent void. *Elmer v. Pennel*, 40 Maine, 434.—RICE, J.; Me., 1855.

37. If a defendant is sued out of his district, he must plead his personal privilege. *Teese v. Phelps*, 1 McAllis., 17.—MCALLISTER, J.; Cal., 1855.

38. Where a person brought an action in a state court, to restrain the use of the word *ambrotype*, as applicable to photographic pictures, and claimed the exclusive right to use such word under an assignment of a patent for a process, in connection with which said word was claimed to have been invented, *Held*, as the right of the plaintiff to use such word depended upon his exclusive right to the process patented, that the exist-

ence and validity of such patent lay at the foundation of his claim, and that the action was therefore founded upon an exclusive right under a patent, of which, under § 17 of the act of 1836, the Circuit Courts of the United States alone had jurisdiction, and that a state court could not take cognizance of it. *Tomlinson v. Battel*, MS.—DUER, J.; N. Y., 1857.

39. Questions as to the validity and construction of patents belong to that class which the courts of the United States are alone competent to determine. The act of 1836, § 17, has put an end to any doubts that may formerly have existed on this subject. *Ibid.*

40. The jurisdiction of the Circuit Court is materially different, whether a party is seeking to enforce the specific performance of a contract in relation to a patent, or to prohibit the infringement of a patent belonging to him. *Brown v. Shannon*, 20 How., 56.—TANEY, Ch. J.; Sup. Ct., 1857.

41. Under § 11 of the judiciary act of 1789, jurisdiction of the person of a defendant (who is an inhabitant of another state), can only be obtained, in a civil action, by service of process on his person, within the district where the suit is instituted. *Chaffee v. Hayward*, 20 How., 215.—CATRON, J.; Sup. Ct., 1857.

42. And this provision is not changed by any of the process acts, or by the act of Congress conferring jurisdiction on the Circuit Courts in patent cases, without regard to citizenship. § 11 of the judiciary act is not affected by the subsequent process acts, and it applies to all civil suits. *Ibid.*, 216.

43. A suit brought to enforce the covenants of a license granted under a patent, is not a case arising under a law

of the United States, so as to confer jurisdiction upon the Circuit Courts to take cognizance of it. *Judson & Goodyear v. Union Rubber Co.*, 4 Blatchf., 66.—INGERSOLL, J.; N. Y., 1857.

44. The non-performance of such covenants would be a violation of the rights of a patentee, as secured by the covenants, but not as secured by any law of the United States. *Ibid.*, 66

45. Nor is an action for fraud in the sale of a patent a case arising under such laws, so as to give jurisdiction thereof to the Circuit Courts. *Ib.*, 70.

46. Under § 17 of the act of 1836, the jurisdiction of the Circuit Courts in patent cases does not depend upon the citizenship of the parties before it. *Ibid.*

47. The Circuit Courts of the United States have equity jurisdiction under the patent laws, by direct grant from Congress; they do not however merely act as auxiliary to a court of law, and therefore do not require the patentee to establish his legal right in a court of law and by a verdict of a jury. *Sanders v. Logan*, 2 Fisher, 171.—GRIER, J.; Pa., 1861.

### 3. District Courts U. S., under acts 1790 and 1793.

1. The proceedings in a District Court, under § 10 of the act of 1793, upon the rule *nisi*, are not conclusive; and the process, to be awarded upon making the rule absolute, is not final. But the proceedings under such section are in the nature of a *Scire Facias* at the common law to repeal a patent. *Stearns v. Barrett*, 1 Mason, 164, 165.—STORY, J.; Mass., 1816.

2. From a judgment in such a pro-

ceeding by the District Court, a writ of error lies to the Circuit Court, if the amount in controversy exceeded fifty dollars. *Ibid.*, 166.

3. The judicial authority intended to be given by § 10 of the act of 1793, is vested exclusively in the district judge, and the proceeding under it was intended to be summary; and neither a *Scire Facias*, or process in the nature of a *Scire Facias*, according to the forms of the common law, were anticipated by Congress. The making of the rule absolute, if sufficient cause is not shown to the contrary, on the return of the rule to show cause, works a repeal of the patent without further proceedings. *Thompson v. Haight*, 1 U. S. Law Jour., 85; *McGaw v. Bryan*, *ibid.*, 98.—VAN NESS, J.; N. Y., 1822.

4. Under § 10 of the act of 1793, if the judge of the District Court grant a rule to show cause why process should not issue to repeal a patent, and such rule is made absolute, the making of such rule absolute does not *de facto* work a repeal of the patent; but the process to be issued upon making such rule absolute is in the nature of a *Scire Facias* to the patentee to show cause why the patent should not be repealed; and upon such process being returned, the judge is to proceed to try the cause upon the pleadings and the issue joined therein. *Wood & Brundage, Ex parte*, 9 Wheat., 604-615.—STORY, J.; Sup. Ct., 1824.

5. The jurisdiction given to the District Court under § 10 of the act of 1793 applies only to cases in which the patent has been obtained by fraud, surreptitiously, by false suggestions, by some wilful misrepresentation and deception. *Delano v. Scott*, Gilpin, 493.—HOPKINSON, J.; Pa., 1834.

6. The hearing, on the return of the rule to show cause, is only initial, and the order of the judge on such hearing cannot be that the patent is invalid, but only that process shall issue for a trial of its validity. It is on such trial that the question of validity is to be determined, and judgment of repeal, if the issue is decided against the patentee. *Ibid.*, 494.

7. A decision against a patentee will repeal and vacate his letters patent, but a decision in his favor gives no strength or confirmation to them, to prevent his right from being contested and tried in any suit he may bring for a violation. *Ibid.*, 494.

8. The summary proceeding under § 10 is given to protect the public from manifest frauds, in taking out patents (the fees of office being no check) for known and common things. *Ibid.*, 494.

9. 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.

10. In a proceeding under § 10 of the act of 1793, the court will not order the United States to be substituted as plaintiffs in the action of *Scire Facias* in the place of the petitioner. *Wood v. Williams*, Gilpin, 520-524.—HOPKINSON, J.; Pa., 1834.

#### 4. State Courts.

1. The courts of a state have no jurisdiction of actions brought for the infringement of patents granted under the laws of the United States. Such cases are only cognizable in the Circuit Courts of the United States. *Parsons v. Barnard*, 7 John, 144.—CURIAM; N. Y., 1810.

2. The state courts have no jurisdiction to settle conflicting claims of parties under interfering patents granted by the United States. *Gibson v. Woodworth*, 8 Paige, 134.—WALWORTH, Ch.; N. Y., 1840.

3. Though the validity of patents when directly adjudicated upon is exclusively within the jurisdiction of the courts of the United States, yet when they come into question collaterally their validity must become a subject of inquiry in the state courts. *Rich v. Hotchkiss*, 16 Conn., 414.—WILLIAMS, Ch. J.; Ct., 1844.

4. Where an owner of an undivided interest in a patent filed a bill against the other joint owner to compel the specific performance of a contract in respect to manufacturing under such patent, and the defendant among other things denied that he was manufacturing under the patent, and set up that the article manufactured by him was different from that patent, *Held*, that the question raised was one of infringement of a patent-right, of which a state court had no jurisdiction. *Parkhurst v. Kinsman*, 2 Halst., Ch., 600-609.—HALSTEAD, Chan.; N. J., 1847.

5. Consent of parties cannot confer jurisdiction, or render the judgment of a tribunal in a matter over which it has not by law any cognizance effectual. *Dudley v. Mayhew*, 3 Coms., 12.—STRONG, J.; N. Y., 1849.

6. Where therefore an action for an infringement of a patent was brought in a state court, and the defendant stipulated not to raise the question of jurisdiction, *Held*, that such consent could not confer any authority, and that the bill must be dismissed on the ground that the state courts had no jurisdiction of actions in patent cases. *Ibid.*, 10, 14.

7. The state courts have no jurisdiction of actions respecting patents. *Ibid.*, 14.

8. The purchaser of a patented article, for the purpose of *using* it, exercises no rights created by the acts of Congress, nor does he derive title by virtue of the franchise or privilege granted to the patentee. When the machine passes to the hands of the purchaser, it is no longer under the protection of the acts of Congress, but becomes private property, protected by the laws of the state where it is situated. If the right to it is infringed, redress is to be sought in the courts of the state, according to the laws of the state, and not in the courts of the United States, nor under the laws of Congress. *Bloomer v. McQueen*, 14 How., 549.—TANEY, Ch. J.; Sup. Ct., 1852.

9. The power of determining the validity of a patent is *exclusively* confined to the Circuit Courts of the United States, and the state courts cannot entertain a suit for an infringement, or to declare a patent void. *Elmer v. Pennel*, 40 Maine, 434.—RICE, J.; Me., 1855.

10. The state courts have jurisdiction in an action of covenant brought for breaches of covenants in an assignment of a patent. *Wright v. Wilson*, 11 Rich. Law, 152.—O'NEALL, J.; S. Car., 1857.

11. When a question as to the construction, and perhaps as to the validity of a patent arises, collaterally, in the progress and upon the trial of a cause, the necessity of its determination will not oust a state court of the jurisdiction which it may have derived from the nature of the action and the state of the pleadings. *Tomlinson v. Battel*, MS.—DUER, J.; N. Y., 1857.

12. But where the existence and

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validity of a patent lie at the very foundation of the action, a state court cannot entertain jurisdiction. *Tomlinson v. Battel*, MS.—DUER, J.; N. Y., 1857.

13. Where a person brought an action in a state court to restrain the use of the word *ambrotype* as applicable to photographic pictures, and claimed the exclusive right to use such word under an assignment of a patent for a process, in connection with which said word was claimed to have been invented, *Held*, as the right of the plaintiff to use such word depended upon his exclusive right to the process patented, that the existence and validity of such patent lay at the foundation of his claim, and that the action was therefore founded upon an exclusive right under a patent, of which, under § 17 of the act of 1836, the Circuit Courts of the United States alone had jurisdiction, and that a state court could not take cognizance of it. *Ibid.*

14. The jurisdiction of a state court is not defeated because the subject matter of the action concerns the use of a patent-right, and the action does not necessarily involve any question in regard to the *validity* of the patent. *Sherman v. Champ. Trans. Co.*, 31 Verm., 174.—REDFIELD, J.; Vt., 1858.

### C. AUTHORITY OF DECISIONS OF, IN OTHER COURTS.

1. The rule of comity observed by the justices of the Supreme Court in cases which admit of being carried before the whole court, is to conform to the opinions of each other, if any have been given. Such decisions amount to authority, which although not conclusive, are operative, whenever the question should be carried up. *Washburn*

*v. Gould*, 3 Story, 132, 133.—STORY, J.; Mass., 1844.

2. This rule established by the judges of the Supreme Court, applies to trials at common law before a jury, but has no application either by its terms or the reason on which it is founded, to motions for injunctions where error may be followed by irremediable mischief. *Many v. Sizer*, 1 Fisher, 33.—SPRAGUE, J.; Mass., 1849.

### DAMAGES, IN PATENT CASES.

See also COUNSEL FEES.

1. In an action for a violation of a patent-right, the plaintiff may recover against one defendant, though no proof is given against the other; for all torts are joint as well as several, and a verdict may be had against one, though the other be acquitted; *aliter*, in contract. *Reutgen v. Kanowers*, 1 Wash., 172.—WASHINGTON, J.; Pa., 1804.

2. The mere making of a machine fit for use, and with a design to use it for profit, is an infringement; but if there is no user, or no actual damage proved, the law allows only nominal damage. *Whittmore v. Cutter*, 1 Gall., 431, 433, 483.—STORY, J.; Mass., 1813.

3. Only the *actual damages* sustained can be given. By *actual damages* are meant such damages as the plaintiff can actually prove, and have *in fact* sustained, as contradistinguished to mere imaginary or exemplary damages, which in personal torts are sometimes given. *Ibid.*, 483.

4. In the case of the user of a ma-

chine, the rule of damages should be the value of the use of such a machine during the time of the illegal user. If a *making* of the machine and no *user* is proved, nominal damages should be awarded; but the value of the expense of making such a machine, or the price at which it might be sold, is not a rule for such damages. *Ibid.*, 483.

5. The rule of damages under § 3 of the act of 1800 is the amount of the profits actually received by the defendant, in consequence of his using the plaintiff's invention. *Lowell v. Lewis*, 1 Mas., 185.—STORY, J.; Mass., 1817.

6. When treble damages are allowed, the jury find single damages, and the court treble them in awarding judgment. *Ibid.*, 185.

7. Under the act of 1800, if the jury find for the plaintiff, they find the actual damages sustained by the plaintiff, by reason of the use by the defendants of the invention of the plaintiff's. The court will treble the damages. *Gray v. James*, Pet. C. C., 403.—WASHINGTON, J.; Pa., 1817; *Evans v. Hettick*, 3 Wash., 422.—WASHINGTON, J.; Pa., 1818.

8. Though a patented machine may be so far inferior to other machines of the same kind as to deprive it of all intrinsic value, if another superadds to it something which will remove its defects, it becomes valuable, and it seems that the person so rendering it valuable will be liable in damages for the use of it. *Gray v. James*, Pet. C. C., 480.—WASHINGTON, J.; Pa., 1817. [But see *post* 13, 14.]

9. The plaintiff is entitled to be compensated for the *damages he has sustained* by the infringement of his right. *Kneass v. Schuylkill Bank*, 4 Wash., 14.—WASHINGTON, J.; Pa., 1820.

10. It is difficult to establish any gen-

eral rule as to damages. The better course is not to lay down any particular rule of damages, but to leave the jury at large to estimate the actual damages according to the circumstances of each particular case. *Earle v. Sawyer*, 4 Mas., 14.—STORY, J.; Mass., 1825.

11. The price of the machine, the nature, actual state, and extent of the use of the plaintiff's invention, and the particular losses to which he may have been subjected by the piracy, are all proper ingredients to be weighed by the jury in estimating the damages. *Ibid.*, 14.

12. A considerable latitude is necessarily given to the jury in estimating what they shall consider to be the actual damage sustained by a patentee by the violation of his right, and the courts have shown no disposition to draw the power of the jury, in this respect, within close and narrow limits. The estimate of a jury must be very extravagant to enable the court to say that they have so disregarded the rule of the law, and so clearly exceeded the limits of their authority, that their verdict cannot be supported. *Whitney v. Emmett*, Bald., 325, 326.—HOPKINSON, J.; Pa., 1831.

13. If an invention, which is useless in itself, has been made useful by being combined with something else, or has been so changed in its operation by an invention to which the owner of the worthless machine had no title or claim, the patentee of such worthless machine is not entitled to damages for the use of it. *Ibid.*, 328.

14. A patentee is entitled to recover for the use of his invention only the damages he has actually sustained, and not the value that has been imparted to his invention by a subsequent inventor, nor for the use such inventor has made



of his invention, provided by such use he has not inflicted any loss, injury, or damage upon the patentee. *Ibid.*, 329.

15. A verdict, though giving large damages, if not against evidence, or not supported by the evidence, is not sufficient reason for granting a new trial. *Stanley v. Whipple*, 2 McLean, 40.—McLEAN, J.; Ohio, 1839.

16. Where the evidence sustains the verdict, the court cannot say that the jury should have given greater weight to other parts of the testimony, which would have lessened damages. *Ibid.*, 40.

17. The awarding by the jury greater damages than were anticipated, is not such a gross mistake in the jury as would authorize setting aside their verdict. The question of damages is submitted to their fair judgment. *Alden v. Dewey*, 1 Story, 341.—STORY, J.; Mass., 1840.

18. In an action for an infringement of a patent, it is the duty of the jury, if they find for the plaintiff, to give him reasonable damages, such as are not covered by any of the costs he will recover, to indemnify him for the necessary and unavoidable expenses of establishing his right. *Washburn v. Gould*, 3 Story, 136.—STORY, J.; Mass., 1844.

19. Where, however, a patentee fraudulently leads a party to infringe on his right, and then brings an action against him merely to gratify revenge or malice, only nominal damages should be given. *Ibid.*, 137.

20. But no valid patent should go out of court without the jury indemnifying the owner for his reasonable and necessary charges in establishing his right. *Ibid.*, 137.

21. In an action for an infringement of a patent, if the plaintiff establishes the validity of his patent, and that the

defendants have violated it, he is entitled to such reasonable damages as shall vindicate his right, and reimburse him for all such expenditures as have been necessarily incurred by him beyond what the taxable costs will repay, in order to establish that right. *Pier-son v. Eagle Screw Co.*, 3 Story, 410.—STORY, J.; R. I., 1844.

22. The jury are at liberty, in the exercise of a sound discretion, to give a plaintiff such damages, not in their nature vindictive, as shall compensate him fully for all his actual losses and injuries occasioned by the violation of the patent by the defendants. *Ibid.*, 410.

23. Where persons, in the employ of another, were guilty of an infringement by making the thing patented, but such persons acted without a knowledge that it had been patented only nominal damages were given for such infringement. *Bryce v. Dorr*, 3 McLean, 583.—McLEAN, J.; Mich., 1845.

24. In cases of wanton and persevering encroachments on the rights of inventors, the court will be justified in trebling the damages, if required for the full indemnity and protection of any wronged patentee. *Allen v. Blunt*, 2 Wood. & Min., 147.—WOODBURY, J.; Mass., 1846.

25. Damages, in a case submitted to the "fair judgment" of the jury, will not be deemed excessive, because they are more than a witness may have testified to, or slightly more than the court deem proper; the verdict will not be set aside, and a new trial ordered, unless the damages are very excessive and unreasonable. *Ibid.*, 149.

26. *Actual damages*, according to § 14 of the act of 1836, are the sum fixed by the verdict. *Stephens v. Felt*, 2 Blatchf., 38.—BETTS, J.; N. Y., 1846.

27. A new trial will not be granted because the jury find liberal damages, except in a case of palpable extravagance. Where, in an action for an infringement, it was proved by the plaintiff that sales were highly profitable, and that the defendant had manufactured and sold the article in large quantities, and the defendant offered no proof, limiting the evidence of the plaintiff, or as to the cost or value of the article, *Held*, that the jury were warranted in exercising a liberal discretion, and that a verdict of \$2,000 would not be interfered with. *Ibid.*, 38, 39.

28. In such a case, a plaintiff ought not to be held to the most explicit and exact proof of the amount of damages sustained, and the jury are warranted in exercising a liberal discretion. *Ibid.*, 39.

29. If a defendant prefers to leave the matter to general inference and the estimate of a jury, when he might make it reasonably certain by evidence on his part, the finding of the jury should not be interfered with, except in cases of palpable extravagance. *Ibid.*, 39.

30. Damages should be compensatory, not vindictive. The object is not punishment, but full indemnity. The amount of profit which the defendant has derived is one of the elements to be regarded, but the amount of loss and injury which the plaintiff has sustained should be regarded also. *Knight v. Gavit*, Mir. Pat. Off., 135.—KANE, J.; Pa., 1846.

31. If the machine made was never used, the damages should be merely nominal, as against the maker; if it has been sold by him and used by others, the verdict should be for the damages actually sustained by the plaintiff, without exclusive reference to the profita-

bleness of the use by the wrong-doer, or the length of time such use may have continued. *Ibid.*, 135.

32. Damages must be plainly exorbitant, or what is sometimes called "outrageous," to require the interference of the court, by way of a new trial. *Aiken v. Bemis*, 3 Wood. & Min., 352.—WOODBURY, J.; Mass., 1847.

33. Under § 13 of the act of 1836, it rests in the discretion of the court, whether the damages shall be trebled. Under the act of 1800, the amount of recovery was fixed at three times the actual damages sustained. *Guyon v. Serrell*, 1 Blatchf., 245.—NELSON, J.; N. Y., 1847.

34. Where a plaintiff filed a disclaimer under § 7 of the act of 1837, after the commencement of his suit, *Held*, that though he was not entitled to costs against the defendant, by § 9 of the same act, that the court nevertheless, under § 14 of the act of 1836, had the power to increase the verdict, in the way of damages. *Ibid.*, 245, 246.

35. Actual damages for an infringement are, however, as a general rule, all that can be claimed. Where the circumstances are aggravated, and such as to repel altogether the *bona fides* of the infringement, the power to increase the verdict, under § 14 of the act of 1836, may be exercised. Each case must, however, stand upon its own circumstances. *Ibid.*, 246.

36. Previous to the act of 1836, the court were compelled to treble the damages. Since that act they are not compelled to do so, but may increase them or not at their discretion, within that limit. In the exercise of that discretion, the court will not increase them if, in their opinion, the jury have already exceeded their proper measure. *Stimp-*

son v. *The Railroads*, 1 Wall, Jr., 166.  
—GRIER, J., Pa., 1847.

37. The court will not grant a new trial on the ground of excessive damages, if the verdict was in accordance with the direction of the court. *Ibid.*, 166.

38. The term "actual damages" cannot be construed to mean exemplary, vindictive or punitive damages, inflicted by way of smart-money, or punishment of the defendant for fraudulent, malicious, or outrageous wrongs. *Ibid.*, 169.

39. The defendant is to suffer the infliction of treble damages only when the court are of the opinion he has acted unreasonably or oppressively. *Ibid.*, 170.

40. The standard for estimating damages for the infringement of a patented machine, is the actual *profits* from the making, using, or selling of the invention by the defendant. The reasonable cost of the labor and materials must be deducted, as the plaintiff himself, if he had made the machines, would have had to pay such expenses. *Parker v. Perkins*, MS.—GRIER, KANE, JJ.; Pa., 1848.

41. Where a patent has been infringed without a knowledge of the plaintiff's right, and under such circumstances as to warrant the inference that the defendant was not aware that he was violating the rights of any one, the jury should only give such damages as would compensate the injury done to the plaintiff. *Parker v. Corbin*, 4 McLean, 463.—MCLEAN, J.; Ohio, 1848.

42. But where the circumstances of infringement are of an aggravated character, vindictive damages, which would include counsel fees, and something more by way of example to deter others from doing the same thing, may be given. *Ibid.*, 463.

43. The rule which governs on the question of damages is, to give actual damages—not vindictive or exemplary damages, but the actual loss sustained, which will be the ordinary profits the patentee derives from the sale of his invention. *Buck v. Hermance*, 1 Blatchf., 406.—NELSON, J.; N. Y., 1849.

44. Damages are only to be compensatory; the criterion is indemnity. The jury may take into consideration the loss sustained by the plaintiff, and likewise the profits made by the defendant. *Parker v. Hulme*, 7 West. Law Jour., 428.—KANE, J.; Pa., 1849.

45. The question of damages is exclusively with the jury, and if they are of the opinion that the defendant has unlawfully infringed the plaintiff's patent, they ought to award him such sum, as in their judgment, founded upon the evidence, would fully indemnify him for the actual damages he has suffered by reason of such infringement, beyond the taxable costs. *Boote v. Silsby*, 1 Blatchf., 459, 466.—CONKLING, NELSON, JJ.; N. Y., 1849.

46. Where the defendants entered upon the violation of the plaintiff's patent, after having been warned of the consequences, and went on with their eyes open, disregarding the claims of the patent, and showing a willingness to avail themselves of the profits of his discovery, and to deprive him of the fruits of his genius, time and expense, *Held*, that the defendants did not stand in a position to entitle themselves to a favorable consideration, and that the jury were warranted in giving liberal damages. *Ibid.*, 467.

47. The jury must find the issues as presented, and assess the damages for the breach, if any, of the thing alleged. It makes no difference that it is an im-

material issue. *Goodyear v. Day*, MS.—GRIER, J.; N. J., 1850.

48. In an action for making and selling a machine which is an infringement upon the plaintiff's patent, the plaintiff is entitled as damages, to all the actual profits which the defendant has made, which is the same thing with the damages he has sustained by reason of the use by the defendant; for the law presumes that if the defendant had not put his machines into the market, the demand would have been for the plaintiff, and he would have received the profits.

*Wilbur v. Beecher*, 2 Blatchf., 143.—NELSON, J.; N. Y., 1850.

49. The difference between the cost and selling price is not, however, all profit. The interest on the capital, the risk of bad debts, and the expenses of selling, must all be taken into the account in arriving at the profits. *Ibid.*, 143.

50. It is the making and selling to be used, and not the selling, or buying, or making alone, for which full damages are usually given. *Hogg v. Emerson*, 11 How., 607.—WOODBURY, J.; Sup. Ct., 1850.

51. The price paid for a license to use a thing patented, may be submitted to the jury as a suitable guide in estimating damages for an infringement, and is the customary one followed for making and selling patent stoves, spokes, lasts, &c., and seems once to have been treated by law as the chief guide in all patent cases. *Ibid.*, 607.

52. But that sum may be mitigated, if the maker of the machine was ignorant of the existence of the patent-right, and did not intend any infringement. *Ibid.*, 607.

53. That however furnishes no reason for allowing no damages when making

the machine to be used, and not merely for a model, or for fancy, or philosophical illustration. *Ibid.*, 607.

54. The intent not to injure never exonerates from all damages for the actual injury or encroachment, though it may mitigate them. *Ibid.*, 608.

55. It must be a very extreme case where a judgment will be reversed on account of excessive damages in actions *ex delicto*, when the instructions of the court suggested to the jury the true general rule as to damages, and when, if excessive, a new trial could have been moved in the Circuit Court. *Ibid.*, 608.

56. The rule of law as to damages, when an infringement is made out, is to give to the plaintiff the actual loss which he has sustained, and nothing more. Exemplary or vindictive damages cannot be given. If the damages are insufficient, the court may treble them. *Held*, in this case, that the plaintiff was entitled to the profits on all the machines sold by the defendant. *Hull v. Wiles*, 2 Blatchf., 201.—NELSON, J.; N. Y., 1851.

57. The plaintiff in a patent case, when he has established a right to recover, is entitled to all the *actual* damages he has sustained, as contradistinguished from exemplary, vindictive, and punitive damages. These are not to be taken in consideration in a patent case. *Pitts v. Hull*, 2 Blatchf., 238.—NELSON, J.; N. Y., 1851.

58. One mode of arriving at such actual damages, is to ascertain the profits which the plaintiff derives from the machines which he manufactures and sells, and which have been made and sold by the defendant. *Ibid.*, 238.

59. Another mode is to ascertain the profits which the party infringing has derived from the use of the invention. This measure of damages is not, how-

ever, controlling; because a party infringing stands in a different position from the patentee, not having been previously subjected to the expense and labor to which the latter is frequently exposed in the process of invention and experiment. Hence the party infringing may well afford to sell at less profits than the patentee. *Ibid.*, 239.

60. The plaintiff is therefore entitled to recover such profits as he would have realized if he had not been interfered with. *Ibid.*, 239.

61. And the plaintiff is also entitled to recover interest on such damages, from the commencement of the suit. *Ibid.*, 239.

62. The general rule of damages is, that the plaintiff, if he has made out his right to recover, is entitled to the actual damages he has sustained by reason of the infringement, and those damages may be determined by ascertaining the profits which in judgment of law he would have made provided the defendant had not interfered with his rights. *McCormick v. Seymour*, 2 Blatchf., 256.—NELSON, J.; N. Y., June, 1851. [Overruled, 1853, *post* 76.]

63. This view proceeds upon the principle that if the defendant had not interfered with the patentee, all persons who bought the defendant's machine would necessarily have been obliged to go to the patentee and purchase his machine. *Ibid.*, 256. [Overruled, *post* 76.]

64. There is no distinction, in regard to the rule of damages, between an infringement of an entire machine and an infringement of a mere improvement on a machine. The rule which is to govern is the same, whether a patent covers an entire machine or an improvement on a machine. *Ibid.*, 257. [Overruled, *post* 77.]

65. And the plaintiff will also be en-

titled to interest on the actual damages as found by the jury, from the commencement of the suit. *Ibid.*, 259.

66. In an action for an infringement of a patent, the rule is to give the actual damage or loss incurred by reason of the infringement, and that is the profits which the plaintiffs would have made if they had not been embarrassed by the interference of the defendants; because the law presumes that the plaintiffs would have had the patronage diverted by the defendants. *Tatham v. Le Roy*, 2 Blatchf., 494.—NELSON, J.; N. Y., 1852.

67. The profits which the plaintiffs have lost in consequence of the infringement affords, therefore, a criterion by which to determine the amount of damages they have sustained. *Ibid.*, 494.

68. The jury, also, in estimating the damages, may take into account the interest on the damages, from the time sustained, if they choose, and give it by way of damages. *Ibid.*, 494.

69. In an action for an account of profits which had accrued to the defendant from the use of the machines which were an infringement upon the plaintiff's patent, the defendant is accountable for such profits as he has actually made, and not for such as "with due diligence and prudence" might have been made. *Livingston v. Woodworth*, 15 How., 559.—DANIEL, J.; Sup. Ct., 1853.

70. The patent act of 1790, § 4, made an infringer liable to pay such damages as the jury should find, and also forfeit the machine. The act of 1793, § 5, declared that an infringer should pay a sum equal to three times the price for which the patentee had sold licenses. The act of 1800, § 3, provided that an infringer should pay three times the actual damages sustained. *Seymour v.*

*McCormick*, 16 How., 488.—GRIER, J.; Sup. Ct., 1853.

71. The patent act of 1836, § 14, 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.*, 489.

72. There cannot be one rule of damages which will equally apply to all cases. The mode of ascertaining these actual damages must necessarily depend upon the peculiar nature of the monopoly granted. *Ibid.*, 489.

73. If a patentee considers or finds it for his interest to retain the entire monopoly of his invention, and competition would destroy its value, the profits of the infringer may be the only criterion of the actual damage of the patentee. *Ibid.*, 489.

74. Where an inventor has found it profitable to exercise his monopoly by selling licenses, he has himself fixed the average of his actual damage, and the price of such licenses may afford a proper measure of damages. *Ibid.*, 490.

75. It is only where from the peculiar circumstances of the case no other rule can be found, that the defendant's profits become the criterion of the plaintiff's loss. *Ibid.*, 490.

76. *Actual* damages must be proved: what a patentee *would have made* if an infringer had not interfered with his rights, is a question of fact, not a judgment of law. It is not a legal inference that third persons would have bought of the patentee what they bought of an infringer, if the latter had not made and sold the thing patented. *Ibid.*, 490.

77. Nor is it proper to instruct the jury that as to the measure of damages the same rule is to govern, whether the

patent covers an entire machine or an improvement on a machine. *Ibid.*, 491.

78. Where a patentee avails himself of his invention, by putting it into market and selling rights under it, in such cases the customary charge for the right to use the invention is the measure of damages which the patentee is entitled to recover, with interest upon the same from the time of the infringement. *McCormick v. Seymour*, 3 Blatchf., 224.—NELSON, J.; N. Y., 1854.

79. But if the patentee does not sell rights to others, but uses his invention exclusively himself, and furnishes the products to the community himself out of his own manufactory, in such cases the measure of damages is different. *Ibid.* 225.

80. If the patent is for an entire machine, the patentee is entitled, as damages in case of infringement, to the profits he could have made in constructing and vending his machine over and above the mere profits arising out of its manufacture. The profits that grow out of the exclusive right to manufacturing the invention under the patent belong to the patentee, while the mere mechanical profits are excluded from the damages. *Ibid.* 225.

81. If the invention is for an improvement of a machine, then the patentee is entitled, as a measure of damages, to all the advantages of the use of his patented improvement, excluding the profits of the manufacture, and excluding also the value, if any, of the use of the old machine. *Ibid.* 225.

82. The fact of the use of a patented machine is evidence of utility, and should subject the party using to damages. *Simpson v. Mad River R. R.*, 6 McLean, 604.—MCLEAN, J.; Ohio, 1855.

83. In an action of infringement, no plea being filed, and a default entered, one-fourth of the proceeds being estimated as the profits of the machine, the damages were assessed at that amount. *Parker v. Bamker*, 6 McLean, 632.—McLEAN, J.; Ohio, 1855.

84. In estimating the amount of damages, the jury cannot go beyond the sum mentioned in the declaration. *Winans v. N. Y. & Har. R. R.*, 31 Jour. Fr. Inst., 323 (3d Ser.).—NELSON, J.; N. Y., 1855.

85. In estimating the actual damages the rule is to give the value of the use of the patented thing during the illegal user, or in other words, the amount of profits. *Wintermute v. Redington*, 1 Fisher, 251.—WILSON, J.; Ohio, 1856.

86. No fixed and certain rule for damages can be established applicable to all cases, but the statute has fixed the general rule that a patentee is entitled to recover such damages as he has shown by his proofs have actually been sustained in consequence of the use of his invention, without his license and consent. *Ransom v. Mayor, &c.*, 1 Fisher, 275.—HALL, J.; N. Y., 1856.

87. In an action against the city of New York for an infringement for the use of an invention in the improvement of fire-engines, *Held*, that the jury might take into consideration the benefits accruing to the corporation, as to damages—as if fifty engines with the improvement were equal to seventy-five without it—and infer that the corporation had saved the cost of the additional number, and would have paid the amount of such cost, or a large portion of it, as the consideration for a license to use the improvement, and that the plaintiff has lost by the infringement what the defendants would have so paid

to secure such license. *Ibid.*, 275. [But see *post*, 107.]

88. The general rule is, that the patentee or his assignee in case of an infringement or appropriation of his invention by another without his license, is entitled to the actual damages he has sustained by reason of such infringement. *Smith v. Higgins*, 1 Fisher, 543.—NELSON, J.; N. Y., 1856.

89. The theory or principle in respect to damages is, that a third person who adopts, appropriates, or uses the improvement of another, interferes with his custom, his monopoly, or rather, property, and affects the benefits which he would otherwise be entitled to. *Ibid.*, 543.

90. The rule excludes any exaggerated or vindictive damages which are sometimes allowed in cases of wilful trespass. *Ibid.*, 543.

91. If the patentee has an established price in the market for a patent-right, or what is called a patent fee, that sum with the interest constitutes the measure of damages. If there is no such established price for a patent fee, then the jury are to inquire of the loss or injury he has sustained, and the profits which the infringer has made by the use of the invention may be taken as the measure of damages. *Sickles v. Borden*, 3 Blatchf., 543.—NELSON, J.; N. Y., 1856.

92. If the jury adopt the price of the patent fee, as the measure of damages, it will operate to vest the title of its patent to the extent of its use by the defendant complained of throughout its term. *Ibid.*

93. If, however, they adopt the profits from the use as the measure of damages, the title does not pass. *Ibid.*, 545.

94. In an action for the infringement

of a patent, the rule of damages is the amount of profits received by the unlawful use of the thing patented, not what he might have made by reasonable diligence. The true rule of damages is that laid down in *Livingston v. Woodworth*. *Dean v. Mason*, 20 How., 203.—McLEAN, J.; Sup. Ct., 1857. [See *ante*, 69.]

95. But where the wrong has been done under aggravated circumstances, the court has the power, under the statute, to punish it adequately, by an increase of the damages. *Ibid.*, 203.

96. The rule of damages is the profits which have been derived to the defendants from the use of the plaintiff's machine, over any other mode which the defendants had a right to adopt. *Serrell v. Collins*, 4 Blatchf.—INGERSOLL, J.; N. Y., 1857.

97. No precise standard by which damages are to be measured is supplied by the law. The statute gives the patentee his actual damages, but these must be proved—they cannot be presumed. If he fails to give evidence to the point, the jury can award no other than nominal damages. *Smith v. Higgins*, MS.—BERTS, J.; N. Y., 1857.

98. It is exceedingly difficult to give direct evidence of the real amount of damages. Facts, which imply damages, may be regarded as proof of damages, under the restriction that they do not warrant giving presumptive or speculative damages. There must be either positive proof of damages, or facts proved which import the amount proper to be awarded. *Ibid.*

99. The plaintiff is entitled to the actual damage sustained by the use of his improvement, during the term of the illegal user, or the amount of the profits actually received by the defendant, dur-

ing the time he used the plaintiff's improvement. *Page v. Ferry*, 1 Fisher, 316.—WILKINS, J.; Mich., 1857.

100. As to the question of damages, the jury may take into consideration the difference between the cost of manufacturing the article, by the old process and by the new, and also the difference in the value of the articles manufactured. *Waterbury Brass Co., v. N. Y. & B. Brass Co.*, 3 Fisher, 59.—INGERSOLL, J.; N. Y., 1858.

101. The object of § 14 of the act of 1836 as to trebling damages, is to remunerate patentees who were compelled to sustain their patents against wanton and persistent infringers. *Bell v. McCullough*, 1 Fisher, 382.—LEAVITT, J.; Ohio, 1858.

102. But the spirit of the act will not include suits brought upon an expired patent, where the sole object was the recovery of damages. *Ibid.*, 382.

103. When a patent has been violated, it necessarily follows that the plaintiff is entitled to some damages. When the amount of damages is not proved, the rule is that the jury give only nominal damages; if the plaintiff intends to claim more than nominal damages, he must satisfy the jury what his *actual* damages are. *Poppenhausen v. N. Y. G. P. Comb Co.*, 2 Fisher, 73.—INGERSOLL, J.; N. Y., 1858.

104. There is no unbending or unyielding rule as to damages, but the rule generally recognized as the true one is to give as damages the amount of profits saved by the defendants, by the unlawful use of the plaintiff's invention. *Bell v. Daniels*, 1 Fisher, 379.—LEAVITT, J.; Ohio, 1858.

105. Where a patent was for heating boilers with the waste heat of a blast furnace, *Held*, in the case of an infringe-



ment by the use of a machine which was the same in principle, that the rule of damages was the price of the coal saved by the use of the improvement. *Bell v. Phillips*, MS.—LEAVITT, J.; Ohio, 1858.

106. When ascertainable, the defendant's profits are the proper rule of damages. *Coleman v. Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

107. In an action for damages for an infringement of a patent, the plaintiffs must furnish evidence by which the jury may estimate actual damages. Actual damages must be *calculated*, not imagined, and an arithmetical calculation cannot be made without *certain* data on which to make it. If the plaintiff rest his case after merely proving an infringement, he is only entitled to nominal damages. *Mayor, &c., of New York, v. Ransom*, 23 How., 488.—GRIER, J.; Sup. Ct., 1859.

108. The theory or principle in respect to damages is, that a third person who adopts, appropriates, or uses the improvement of another, interferes with his property, and affects the benefits which he would otherwise be entitled to, and the jury are to look into the case with a view to ascertain the actual damage which the patentee under such circumstances has sustained. The rule excludes any exaggerated or vindictive damage, which is sometimes allowed in cases of wilful trespass. *Smith v. Higgins*, MS.—NELSON, J.; N. Y., 1859.

109. Where the injury done to a patentee by infringement of his patent is not in the use of his invention, but in making use of it without compensating the patentee therefor, it being the interest of the patentee that his invention should be used and adopted by all, the measure of "actual damage" is the

price or value of a license to use it. *Sanders v. Logan*, 2 Fisher, 170.—GRIER, J.; Pa., 1861.

110. In such cases, the measure of damage being a certain sum, an account of profits is not required, and the jurisdiction of a chancellor need not be invoked. *Ibid.*, 170.

111. A court at law may treble a verdict for "actual damage" where the defendant has acted wantonly or vexatiously; but a court of equity can inflict no exemplary or punitive damages as a court of law may. *Ibid.*, 170.

112. If an inventor's profit consist neither in the exclusive use of the thing invented, or in the monopoly of making it for others to use, but in a general use by all who will pay the price of his license, the non-payment of the license fee by an infringer is the only wrong done him. He has fixed his own measure of compensation. *Livingston v. Jones*, 2 Fisher, 209.—GRIER, J.; Pa., 1861.

113. The only cases in which the measure of damages is the amount of the infringer's profit, are where the invention is of some new machine, or a new form of any kind of known machine, which, as itself—a distinct species of machine or manufacture—is more valuable, or can be put into market cheaper, so as to supersede or exclude other machines or manufactures of the same genus; and where the profit of the patentee consists in a complete monopoly of the right to make and vend the new machine or manufacture as a unit, and in the exclusion of all other competition. *Ibid.*, 209.

114. Where a patentee's invention has such peculiar characteristics, he has a right to demand that those who have infringed his exclusive right to make

and sell his peculiar invention should refund all the net profits made by such infringement. *Ibid.*, 211.

115. Although a patentee may describe his invention as an improvement of some known machine, yet if the machine constitute a distinct species of machine or scientific article known in the market and having a peculiar value on account of its peculiar form or functions, the measure of damages for infringing the patent is the amount of profit on the *whole* machine. The case of *Seymour v. McCormick*, 16 How., 480, distinguished from this. *Ib.*, 212.

116. But if the patent is for some addition or improvement on an old and well-known implement, or some separate part or device thereof of small importance compared with the whole—if the license to use the addition or improvement was sold as separate and distinct from the whole machine, the measure of damage would be the price of a license, and not the profit made by the exclusive right to make and sell the whole machine. *Ibid.*, 211.

117. The federal courts sitting in equity, cannot, under the act of July 4th, 1836, § 14, treble the damages found by them for violating a patent-right, as they may when sitting at law, and on a verdict and judgment. *Ibid.* 210.

### DECLARATION.

As to declarations of parties and others, see EVIDENCE, D.

As to declaration in pleading, see PLEADING, A.

### DEFENCES IN ACTIONS AND SUITS RESPECTING PATENTS.

See also GENERAL ISSUE; PLEADING, B.; PRIOR USE.

1. § 6 of the act of 1793 does not enumerate all the defences of which the defendant may legally avail himself; he may give in evidence that he never did the act attributed to him, that the patentee is an alien not entitled under the act, or that he has a license or authority from the patentee. *Whittemore v. Cutter*, 1 Gall., 435.—STORY, J.; Mass., 1813.

2. The title of a patentee may be impeached by showing that he was not the first inventor, and this, whether the patentee was aware of such prior discovery or not. *Evans v. Eaton*, Pet. C. C., 342.—WASHINGTON, J.; Pa., 1816.

3. An offer to take a license of a patentee does not take away the right of the person making such offer to deny that the patentee was the original inventor. *Ibid.*, 347.

4. All matters of defence or of objection to a patent are not enumerated in §§ 6 and 10 of the act of 1793. *Lowell v. Lewis*, 1 Mas., 186.—STORY, J.; Mass., 1817.

5. But it is not a matter of defence that the invention of the patentee is not of such general utility as to supersede others of the same kind in use. *Ibid.*, 186.

6. It is a good defence to an action for the infringement of a patent-right that the thing secured by the patent was not originally discovered by the patentee, but had been in use, or had been described in some public work an-

terior to the supposed discovery of the patentee. *Bedford v. Hunt*, 1 Mas., 304.—STORY, J.; Mass., 1817.

7. It is perfectly immaterial whether the first inventor has taken out a patent or has dedicated the invention to the public or not; for the defendant may stand upon the defence that the plaintiff is not the first inventor who put the invention in use. *Ibid.*, 304.

8. Where two persons as joint inventors of a machine, covenanted with each other that each should have certain states, and that neither should use or sell the machine in the territories of the other, *Held*, in an action for covenant broken, that the defendant could not plead that neither was the inventor, or that separate patents had been granted to each. *Stearns v. Barrett*, 1 Pick., 443, 447.—WILDE, J.; Mass., 1823.

9. In an action for an infringement of a patent, where the declaration goes for a user during a limited period, and afterward the party sues for a user during another and subsequent period, a verdict and judgment in the former case is not a legal bar to a recovery in the second action. The piracy is not the same, nor is the gravamen the same. *Earle v. Sawyer*, 4 Mas., 14.—STORY, J.; Mass., 1825.

10. § 6 of the act of 1793 does not enumerate all the defences which a party may make in a suit brought against him for violating a patent. One obvious omission is where he uses it under a license or grant from the inventor. *Pennock v. Dialogue*, 2 Pet., 23.—STORY, J.; Sup. Ct., 1829.

11. It is not inconsistent with the principle or meaning of such section, that a defence may be made, that although the patentee is the first as well as the true inventor, he has abandoned

or dedicated his invention to the public. *Ibid.*, 23.

12. The distinction is well settled between defences, which authorize a verdict and judgment in favor of the defendant in the particular action, leaving the plaintiff free to use his patent, and to bring other suits for its infringement, and those which, if successful, would require the court to enter a judgment not only for the defendant in the particular case, but one which declares the patent to be void. *Grant v. Raymond*, 6 Pet., 246.—MARSHALL, Ch. J.; Sup. Ct., 1832.

13. If a party is content with defending himself, he may either plead specially or plead the general issue, and give the notice required by § 6 of the act of 1793, of any special matter he means to use at the trial. If he shows that the patentee has failed in any of those prerequisites on which the authority to issue the patent is made to depend, his defence is complete, and he is entitled to the verdict of the jury, and the judgment of the court. *Ibid.*, 246.

14. But if not content with defending himself, he seeks to annul the patent, he must proceed in precise conformity to § 6 of the act of 1793, and "fraudulent intent" must be found by the jury to justify a judgment of *vocatur* by the court; § 6 does not control § 3. *Ibid.*, 247.

15. The defendant is permitted to proceed according to § 6, but is not prohibited from proceeding in the usual manner, so far as respects his defence, except that special matter may not be given in evidence on the general issue, unaccompanied by the notice which § 6 requires. *Ibid.*, 247.

16. It is a good defence to an action for an infringement of a patent, that the

specification does not contain a written description of the invention in such full, clear, and exact terms as to distinguish the same from all things before known, and so as to enable any person skilled in the art to make and use the same. *Ibid.*, 245-248.

17. The case of *Pennock v. Dialogue* (2 Pet., 1), affirms the principle that the failure on the part of a patentee in those prerequisites of the act authorizing a patent, is a bar to a recovery in an action of infringement, and the validity of this defence does not depend on the intention of the inventor, but is a legal inference upon his conduct. *Ibid.*, 249.

18. § 6 of the act of 1793 declares the defences that shall be available for a party against whom a patentee has brought suit for the invasion of his right; but no process or means are given for the examination of a patent-right, 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.

19. In an action for an infringement of a patent, it is no defence that defendant's invention worked better, or was more elegant than the plaintiff's. It does not follow because the defendant has improved the plaintiff's invention, that he can use it. *Alden v. Dewey*, 1 Story, 337, 338.—STORY, J.; Mass., 1840.

20. It is a good defence to a bill in equity for an injunction on account of an alleged violation of a patent, that the inventor, before application for letters patent, had allowed his invention to go into public use; but such use must have been with the consent of the inventor, and have been generally allowed or acquiesced in, and not have been merely

experimental or temporary. *Wyeth v. Stone*, 1 Story, 281.—STORY, J.; Mass., 1840.

21. It is also a good defence to such an action that the patentee, after obtaining a patent, has countenanced or silently acquiesced in the use of his invention by others, such conduct being strong presumption of an abandonment or surrender of his right. *Ibid.*, 282.

22. Under § 9 of the act of 1837, it is a good defence, both at law and in equity, in every suit brought upon a patent, that there has been an unreasonable neglect or delay to file a disclaimer when one is necessary. *Ibid.*, 295.

23. The defence, provided by § 15 of the act of 1836, "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. *Hildreth v. Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

24. The use of the thing patented prior to the granting of a reissued patent, and during the interval between the original and renewed patent, will not defeat an action for an infringement under the reissued patent. *Stimpson v. West Ches. R. R.*, 4 How., 402.—MCLEAN, J.; Sup. Ct., 1845.

25. A former verdict or dismissal, on a bill filed for an injunction to restrain the use of a patent, is not a bar to a subsequent suit, unless a judgment was rendered on such verdict against the plaintiff, or the dismissal was on the merits. *Allen v. Blunt*, 2 Wood. & Min., 132, 133.—WOODBURY, J.; Mass., 1846.

26. In an action for an infringement, a plea of prior use or sale, under § 7 of the act of 1839, to constitute a bar to the plaintiff's action, must allege such use to have been more than two years

before the application, or an abandonment, so as to show that the patent is invalid, by abandonment or otherwise. *Root v. Bull*, 4 McLean, 179.—McLEAN, J.; Ohio, 1846.

27. Where an action is on a promise to pay a certain sum for the assignment of a patent, and such assignment was the consideration of the promise, the validity of the patent may be impeached, as a want of consideration, in defence of the claim. *Wilder v. Adams*, 2 Wood. & Min., 331.—WOODBURY, J.; Mass., 1846.

28. But such a defence cannot be resorted to when the action is on a sealed instrument, or when another implied covenant to the plaintiff was the real consideration, upon which implied covenant the defendant would have a remedy, or when the defendants have received the proceeds from the articles sold, to recover the agreed proportion of which the action is brought. *Ibid.*, 332.

29. The defence, authorized by § 15 of the act of 1836, that the patentee had "surreptitiously or unjustly obtained his patent for that which was in fact invented or discovered by another," is only applicable in the case of a patent so obtained while the "first inventor was using reasonable diligence in adapting and perfecting his invention;" and if pleaded, it may be necessary for the defendant to show, in order to vacate the patent, that he was using reasonable diligence when the patent was obtained. *Perry v. Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

30. Under § 15 of the act of 1836, providing, in the case of a patent granted to an alien patentee, that it should be a good defence that such patentee had omitted to put and continue his invention on sale upon reasonable terms,

within eighteen months after the patent was granted, it is not essential that such patentee should take active means for the purpose of putting his invention in market, and forcing a sale; but it is a sufficient compliance with the law that he should at all times be ready to sell at a fair price, when a reasonable offer is made. *Tatham v. Le Roy*, MS.—NELSON, J.; N. Y., 1849.

31. Where the defence is set up that a prior machine was essentially similar to that of the plaintiff, and the proof relied on is a description of such machine contained in a printed publication, such description must be sufficiently full and precise to enable a mechanic to construct it, and must be, in all material respects, like that covered by or described in the plaintiff's patent. Proof of a previous structure, bearing some resemblance, in some respects, to the plaintiff's improvements, and which might have been suggestive of ideas, or led to experiments in the discovery and completion of his improvement, will not invalidate the patent. *Parker v. Stiles*, 5 McLean, 61, 62.—LEAVITT, J.; Ohio, 1849.

32. A party setting up a right under a contract for an interest in a future term of a patent, as an equitable defence against an action brought by one having the legal title, must deny that the plaintiff is a *bona fide* purchaser without notice, and the burden of proof is on him, so impeaching the legal title. *Gibson v. Cook*, 2 Blatchf., 150, 151.—NELSON, J.; N. Y., 1850.

33. It is a well established rule in equity, that the matter entitling a party to an amendment of his contract may be set up by way of equitable defence against a proceeding involving the rights of the parties under the instrument.

*Woodworth v. Cook*, 2 Blatchf., 158, 159.—NELSON, J.; N. Y., 1850.

34. But such defence cannot be set up where the rights of *bona fide* purchasers have intervened, which would or might be seriously prejudiced by allowing the contract to be so reformed. *Ibid.*, 159.

35. Where an action was brought in Louisiana under § 16 of the act of 1836, by the owners of a prior patent against a subsequent patentee, to set aside and have declared inoperative the subsequent patent, and on the hearing the bill was dismissed on its merits, *Held*, that the dismissal of the bill did not necessarily import that the two patents interfered, or that the prior patent was void and inoperative, and that such judgment could not be pleaded in bar to an action on such prior patent in another state against an assignee of an interest in a subsequent patent. *Tyler v. Hyde*, 2 Blatchf., 312.—BETTS, J.; N. Y., 1851.

36. To constitute such a judgment a bar to such subsequent action, it should have been direct and affirmative in its terms, and have asserted the interference of the patents, and have declared the patent void in whole or in part, or inoperative and invalid in some part of the United States. *Ibid.*, 313.

37. It is no justification of the infringement of a renewed patent that the infringer had stolen and used the invention with impunity before the patent was amended. *Goodyear v. Day*, MS.—GRIER, J.; N. J., 1852.

38. § 7 of the act of 1839 gives no protection to those who may have seized upon an invention or discovery disclosed in a patent, whose specification may happen to be defective or insufficient. *Ibid.*

39. The granting of a new license by the owner of a patent to a second person to make and vend a patented article within a certain territory, after he had granted a prior and exclusive license to another person for the same territory, is no bar to an action brought on the first contract or license, to recover the amount agreed by it to be paid for machines manufactured under such contract, but may be available by way of recoupment of damages. *Pitts v. Jamson*, 15 Barb., 317.—JOHNSON, J.; N. Y., 1853.

40. In an action for an infringement, if a patent has been granted to the defendant for what he uses, he may put such patent in evidence in justification or defence of such action. *Corning v. Burden*, 15 How., 271.—GRIER, J.; Sup. Ct., 1853.

41. If to an action brought in the name of a patentee for the benefit of a licensee, a release from the patentee is set up, the plaintiff may file a replication setting up the license, the bringing of suit for the benefit of the licensee, notice to the defendants of such license and its recording prior to the release, want of power to give the release, and that it was given without the consent and authority of the licensee. *Goodyear v. McBurney*, 3 Blatchf., 33.—NELSON, J.; N. Y., 1853.

42. In an action for infringement on a reissued patent, proof of use of the thing patented during the interval between the original and reissued patents will not defeat the action. *Battin v. Taggart*, 17 How., 84.—MCLEAN, J.; Sup. Ct., 1854.

43. The question of diligence, under § 15 of the act of 1836, has application to the case of a prior inventor by way of defence, where a subsequent inventor

has obtained a patent for the same invention surreptitiously, and directly only in such a case, or where it has appeared that analogous principles were involved, and then by an equitable construction of the rule. *Stephens v. Salisbury*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

44. The things specified in § 6 of the act of 1836 are prerequisites to the granting of a patent, and unless these prerequisites are complied with, a party sued for an infringement of a 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.*, 1 Fisher, 257.—HALL, J.; N. Y., 1859.

45. It is no defence to an action for an infringement of a patent that the machine used by the defendant is a better mode than that invented by the plaintiff; nor does the use of such better mode form any objection to the validity of the plaintiff's patent. *Bell v. Daniels*, 1 Fisher, 379.—LEAVITT, J.; Ohio, 1858.

46. If an invention is useless as to the particular thing used by the defendants, they are not liable in damages for its use. *Poppenhausen v. N. Y. G. P. Comb Co.*, 2 Fisher, 72.—INGERSOLL, J.; N. Y., 1858.

47. The defence that an invention is wanting in novelty or originality goes to the validity of the patent. *Coleman v. Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

48. The defence that the patentee had surreptitiously and unjustly obtained the patent for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting 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.*, 4 Blatchf., 364.—NELSON, J.; N. Y., 1859.

49. Where therefore A filed a caveat for an invention, and B subsequently filed an application for the same invention and obtained a patent therefor, the Commissioner neglecting to give notice of such application to the caveator, *Held*, that such defence could be set up against B's patent, though there was nothing in the case implicating his good faith. *Ibid.*, 364.

50. It is a good defence to an action for the infringement of a patent that the invention is worthless. *Vance v. Campbell*, 1 Fisher, 485.—LEAVITT, J.; Ohio, 1859.

51. The United States are not precluded by the fact of granting a patent from giving in evidence, or availing themselves of any legal objections that may be brought against any such patent. *Shreeve v. U. States*, MS.—LORING, J.; Ct. Claims, 1859.

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## DEMURRER.

See EQUITY, B. 4; PLEADING, E.

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## DEPOSITIONS.

See EVIDENCE, C.

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## DESIGN.

PATENT FOR, AND INFRINGEMENT OF.

1. 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.

2. It is an infringement of a patent for a design to adopt the design so as to produce substantially the same appearance. It is not necessary to adopt the design in every particular. *Root v. Ball*, 4 McLean, 180, 181.—MCLEAN, J.; Ohio, 1846.

3. Where letters patent were issued under the act of 1842, for a "new and ornamental design for figured silk buttons"—the design consisting, 1st, of the configuration of the mould or block, it having radial indentations, and forming the foundation of the button, and capable of being varied in figure as desired; and 2d, of winding such block with silk, in the manner described, so as to make buttons of different hues and combinations of colors; and the claim was for "the radially formed ornaments on the face of the mould of the button, combined with the mode of winding the covering of the same, substantially as set forth," *Held*, that the invention was for "a new and original design for a manufacture," under § 1 of such act—a design for the manufacture of an ornamental button. *Booth v. Garely*, 1 Blatchf., 248, 249.—NELSON, J.; N. Y., 1847.

4. *Held also*, that as the specification did not describe the *process* of winding the silk, that the patent did not cover or embrace such *process*, but was for the arrangement of the different colored threads in the process, so as to produce the radially formed ornaments on the face of the button. *Ibid.*, 249.

5. Whether the sale of such buttons, before the application for a patent,

would amount to an abandonment, was held to be a question of fact to be settled by a jury. *Ibid.*, 249.

6. Whether the sale of the manufactured button, before application, amounts to a sale of "the thing invented," within the meaning of § 7 of the act of 1839; *query*. *Ibid.*, 250.

7. If the button be regarded simply as the product of the invention, the sale of it would not be a sale of the invention, for a sale within § 7, must be a sale of the invention or patented article. The "design," however, being worked on the face of the button, might perhaps be said to be sold with it, and a sale of the button would then be a sale of the "design," the thing patented. *Ibid.*, 250.

8. In this case, on a motion for a provisional injunction, the novelty of the invention being denied, and it being admitted that the plaintiffs had sold before his application for a patent, large quantities of the article, in packages marked as imported from Paris, the injunction was denied until the plaintiff should establish his right by a suit at law. *Ibid.*, 250.

## DISCLAIMER.

<b>A.</b> WHEN PROPER; WHAT TO SET FORTH; EFFECT OF.....	247
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<b>C.</b> ASSIGNEE; RIGHT OF UNDER, AND TO MAKE.....	251
<b>A.</b> WHEN PROPER; WHAT TO SET FORTH; EFFECT OF.	

1. Where two patents are substantially for the same invention, whether a dis-



claimer of all title under the first patent to the material parts of the invention for which it was granted, would not operate as an estoppel to any remedy which might be prosecuted for a violation of that patent; *query*. *Treadwell v. Bladen*, 4 Wash, 709.—WASHINGTON, J.; Pa., 1827

2. A disclaimer at the close of a specification, estops the patentee from setting up any privilege to the part disclaimed. *Whitney v. Emmett*, Bald., 313.—BALDWIN, J.; Pa., 1831.

3. The disclaimer mentioned in § 7 of the act of 1837, applies solely to suits pending when the disclaimer is filed; and the disclaimer mentioned in § 9 of the same act, applies solely to suits brought after such disclaimer is filed. *Wyeth v. Stone*, 1 Story, 294.—STORY, J.; Mass., 1840.

4. *Seemle*, That a disclaimer, under § 7 of the act of 1837, should not only disclaim what is not claimed as new, but should also distinctly set forth what part of the invention is still claimed, as it is manifestly designed to act as a new specification. *Lippincott v. Kelly*, 1 West. Law Jour., 515.—IRWIN, J.; Pa., 1844.

5. Under § 7 of the act of 1837, the disclaimer must state the interest of the person disclaiming. But where an administrator, in whose name a patent had been extended, entered a disclaimer, stating that he was the patentee, and referring to the patent as showing his interest, it was held sufficient. *Brooks v. Bicknell*, 3 McLean, 439.—MCLEAN, J.; Ohio, 1844.

6. §§ 7 and 9 of the act of 1837, authorizing a disclaimer, do not apply where a patent is for a combination of parts. *Batten v. Clayton*, 2 Whar. Dig., 413.—KANE, J.; Pa., 1848.

7. A disclaimer must be properly proved before it can be admitted in evidence, either as an original paper or by a certified copy. And if admitted in evidence, it must have given to it the full effect of a disclaimer, under § 7 of the act of 1837. *Foot v. Silsby*, 1 Blatchf., 450, 461.—NELSON, CONKLIN, JJ.; N. Y., 1849.

8. Where, therefore, a copy of a disclaimer, indorsed on a patent, but not proved to have been executed by the patentee, was offered in evidence by the defendant, not as a disclaimer, but as a confession that the plaintiff's invention was not new, and that he was not the original inventor of all claimed in his specification, *Held*, that it must be proved, before it could be admitted in evidence; and must be read as a disclaimer, if at all. *Ibid.*, 450, 461.

9. Where a disclaimer was filed by the patentee himself, setting out that it was "to operate to the extent of the interest in said letters patent vested in the patentee," *Held*, that it fairly enough imported on its face that the patentee was the owner of the entire interest in the patent, and if so, there was a substantial compliance with the statute, as to the statement of interest. *Ibid.*, 449, 461. [Affirmed, *post* 12.]

10. A patentee has a right to disclaim any thing which has been claimed through "inadvertence or mistake;" but when a patentee claims any thing as his own, courts cannot reject the claim, though the inventor himself may disclaim it. *Parker v. Sears*, 1 Fisher, 99.—GRIER, J.; Pa., 1850.

11. But a disclaimer is necessary only where the thing claimed without right is a material and substantial part of the thing invented. If the part not new is not essential to the machine, and

was not introduced into the patent through wilful default or intent to defraud or mislead the public, the want of a disclaimer affords no ground for invalidating the patent. *Hall v. Wiles*, 2 Blatchf. 199.—NELSON, J.; N. Y., 1851.

12. Where, in a disclaimer, the party stated that he was the patentee, and nothing said in respect to a transfer of any part of it, the fair presumption is, that he still owns the whole; and it is a sufficient compliance with the statute as to stating his interest, to say "that such disclaimer is to operate to the extent of his interest therein." *Silsby v. Foote*, 14 How., 221.—CURTIS, J.; Sup. Ct., 1852.

13. The law requiring and permitting a patentee to disclaim is not penal but remedial. It is intended for the protection of the patentee as well as the public, and should not receive a construction that would restrict its operation within narrower limits than the words of the law fairly import. *O'Reilly v. Morse*, 15 How., 121.—TANEY, Ch. J.; Sup. Ct., 1853.

14. Whether, therefore, a patent is illegal in part because of claiming more than the inventor has described, or more than he has invented, the patentee must in either case disclaim in order to save the portion to which he is entitled; and he is allowed to do this when the error was committed by mistake. *Ibid.*, 122.

15. The disclaimer of part of an invention, provided such disclaimer arose from inadvertency, accident, or mistake, will not prevent the patentee from embracing the part so disclaimed in a re-issue of his patent. *Hayden, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

16. Inadvertence and error may oc-

cur as well in a disclaimer as in a claim, and whenever such a mistake occurs, it may be cured by a reissue. *Poppenheusen v. Fulke*, 4 Blatchf., 499.—SHIPMAN, J.; N. Y., 1861.

## B. EFFECT OF DELAY OR NEGLECT IN FILING.

1. Under § 9 of the act of 1837, it is a good defence, both at law and in equity, in every suit brought upon a patent, to secure the rights granted thereby, that there has been unreasonable neglect or delay to file a disclaimer, where one is necessary. *Wyeth v. Stone*, 1 Story, 295.—STORY, J.; Mass., 1840.

2. *Seem*, that a court of equity will not interfere to grant a perpetual injunction, whatever may be the patentee's rights and remedy at law, unless the disclaimer, where one is necessary, is filed before suit brought. *Ibid.*, 295.

3. The disclaimer, to be effectual under §§ 7 and 9 of the act of 1837, must be filed before suit brought. If it is filed during the pendency of the suit, the plaintiff will not be entitled to the benefit thereof in that suit. *Reed v. Cutter*, 1 Story, 600.—STORY, J.; Mass., 1841.

4. If filed before suit is brought, the plaintiff will be entitled to recover costs, if he establish at the trial that a part of the invention, not disclaimed, has been infringed by the defendant. *Ibid.*, 600.

5. But whether filed before or after suit brought, the plaintiff will not be entitled to the benefit thereof, if he has unreasonably neglected and delayed to file it. Such neglect or delay is a good defence to the suit. *Ibid.*, 600.

6. An unreasonable neglect or delay

to enter a disclaimer, under § 9 of the act of 1837, cuts off the patentee from all the benefits of that section, not only that he shall not recover costs, but that he shall have no right of action. *Brooks v. Bicknell*, 3 McLean, 449.—McLEAN, J.; Ohio, 1844.

7. What is an unreasonable delay to enter a disclaimer, is a mixed question of law and fact, to be decided by the jury, under the instruction of the court. *Ibid.*, 449.

8. Less vigilance will be required from an administrator than from the original patentee. *Ibid.*, 450.

9. The filing of the disclaimer authorized by § 7 of the act of 1837, will not affect any action pending at the time of the filing of such disclaimer, except in respect to the question of unreasonable neglect or delay in filing it. *Guyon v. Serrell*, 1 Blatchf., 245.—NELSON, J.; N. Y., 1847.

10. But where a disclaimer was filed under such section, after the commencement of the action, *Held*, although under § 9 of the same act the plaintiff was not entitled to costs, yet, that under § 14 of the act of 1836, the court had power to increase the verdict. *Ibid.*, 245, 246.

11. Under § 9 of the act of 1837, the filing of a disclaimer by a patentee who has by mistake, &c., claimed something of which he was not the inventor, is not a condition precedent to obtaining the benefits of such act. He loses that only by an *unreasonable* delay in filing such disclaimer. *Hotchkiss v. Oliver*, 5 Denio, 318.—McKISSOCK, J.; N. Y., 1848.

12. Where a patentee has unintentionally and without fraud claimed as a part of his invention something which was not original, but has unreasonably neglected to file a disclaimer of such

part, he cannot recover under § 7 of the act of 1837, in an action for infringement, even if the defendant has infringed the parts of his invention which are new. *Parker v. Stiles*, 5 McLean, 56.—LEAVITT, J.; Ohio, 1849.

13. If a disclaimer is entered before suit instituted, the plaintiff recovers costs in the usual way, independent of any question of disclaimer. But if in the progress of the trial it turns out that a disclaimer ought to have been made as to a part of what is claimed, the plaintiff may recover, but will not be entitled to costs. *Hull v. Wiles*, 2 Blatchf., 198.—NELSON, J.; N. Y., 1851.

14. Under § 9 of the act of 1837, the question whether there has been unreasonable negligence or delay in entering a disclaimer, goes to the right of the action; and if the delay shows great negligence, the jury may find the patent void. *Ibid.*, 198, 199.

15. Where a claim has been sanctioned by the Patent Office, and has been held valid by a Circuit Court, the patentee has a right to insist upon it, and not disclaim it, until it has been passed upon by the highest court, and the omission to disclaim will not render the patent void. The delay in entering the disclaimer, under such circumstances, until the decision of such highest court, is not unreasonable. *O'Reilly v. Morse*, 15 How., 122.—TANEY, Ch. J.; Sup. Ct., 1853.

16. If a patentee makes a claim which is not well founded, in the same patent with other claims which are well founded, he may disclaim within a reasonable time that which he had no right to claim, and then his patent will be good for the residue, as good as if it had originally issued only for the claims which are valid. *McCormick v. Sey-*

## EFFECT OF DELAY IN FILING.

*mour*, 3 Blatchf., 222.—NELSON, J.; N.Y., 1854.

17. If he omits to disclaim, and brings suit for the violation of his patent, and it appears at the trial that he is entitled to be protected in a portion of his claims, but not in respect to another portion, he is still entitled to damages for the violation of the valid portion of his claims, but he recovers no costs. *Ibid.*, 222.

18. But if the jury are satisfied that there has been unreasonable negligence and delay on the part of the patentee in making a disclaimer as respects the invalid part of his patent, then the whole patent is inoperative. *Ibid.* 222.

19. Where a patentee obtained his patent in 1845, and brought suit for an infringement of it, and there were numerous trials, the last of which was in 1854, upon which a question arose as to the true construction of one of the claims, whether the same was new, but such claim was not one of the issues in controversy, and such claim was held, on error, not to be new, *Held*, that under the circumstances of the case, the patentee was not guilty of unreasonable delay in making the disclaimer, and that such delay was a question of law for the court to decide. *Seymour v. McCormick*, 19 How., 106.—NELSON, J.; Sup. Ct., 1856.

20. The granting of a patent for an alleged improvement, and an opinion or decision of a court below maintaining the validity of such patent, will repel any inference of an unreasonable delay in correcting the claim for such improvement, which was in fact not new, by entering a disclaimer thereof, until the highest court to which it could be carried had pronounced its judgment. *Ibid.*, 106.

21. Under the circumstances, the

## ASSIGNEE, RIGHT OF UNDER.

question of unreasonable delay in filing a disclaimer was held to be one of law, for the court to decide. *Ibid.*, 106.

22. Under § 9 of the act of 1837, where a patentee claims more than he has invented or is entitled to, his patent will still be good for what he has invented, provided he enters a disclaimer of what he has included in his patent which he has not invented, without unreasonable neglect or delay. *Silsby v. Foote*, 20 How., 387.—NELSON, J.; Sup. Ct., 1857.

23. Where the evidence going to show that the invention was not new was introduced on the trial of a feigned issue in 1851, and the question of novelty had been in controversy from that time to 1857, and no disclaimer had been entered, *Held*, that under the circumstances, there had not been such an unreasonable delay in entering the disclaimer as to bar a recovery, and the plaintiff was allowed to recover damages but not costs. *Ibid.*, 387. (GRIER, J. and DANIEL, J., dissenting.)

24. What is "unreasonable delay" in filing a disclaimer is a question of law for the court. The time, in reference to the question of delay commences from the time when knowledge is brought home to the party that he is not the first inventor, or a court of competent jurisdiction has declared him not to be one. *Singer v. Walmsley*, 1 Fisher, 575.—GILES, J.; Md., 1859.

### C. ASSIGNEE, RIGHT OF UNDER, AND TO MAKE.

1. If a patent has been previously assigned in part, and a disclaimer has been filed by the patentee alone, such disclaimer will not operate in favor of the assignee, in any suit, either at law or

equity, unless he has joined in it. *Wyeth v. Stone*, 1 Story, 294.—STORY, J.; Mass., 1840.

2. A disclaimer of part of an invention cannot affect a prior grantee under the patent, unless he accepts of it; he may refuse to be affected by it. *Smith v. Mercer*, 5 Penn. Law Jour., 531.—KANE, J.; Pa., 1846.

3. Under § 7 of the act of 1837, the owner of a sectional interest in a patent may make a disclaimer of part of the thing patented, which will be considered as a part of the original patent, to the extent of his interest; but the patentee is not compelled to join in such disclaimer, nor will it affect any one except him making it, and those claiming under him. *Potter v. Holland*, 4 Blatchf., 216.—NELSON, INGERSOLL, JJ.; Ct., 1858.

### DICTIONARIES, GAZETTEERS, &c.

1. Some similarities, and some use of prior works, even to the copying of small parts, are tolerated in such books as dictionaries, gazetteers, grammars, maps, arithmetics, almanacs, concordances, cyclopædias, itineraries, guide books, and similar publications, if the main design and execution are in reality novel and improved, and not a mere cover for important piracies. *Webb v. Powers*, 2 Wood. & Min., 512.—WOODBURY, J.; Mass., 1847.

2. In compiling such works, the materials of all, to a considerable extent, must be the same, and to such extent are allowable; and the novelty or improvement can be substantial in scarcely any case, unless the matter is abridged, or a material change made in the arrangement, or more modern information

added, or errors corrected, or omissions supplied. *Ibid.*, 513.

3. While a prior compiler cannot monopolize what was not original with himself, and what must be nearly identical in all such works, as dictionaries, gazetteers, &c., on a like subject, a subsequent compiler cannot employ so much of a prior arrangement and materials as to show a substantial invasion of the former, and not characterized by enough new or improved to indicate new toil and talent, and new property and rights in the last compiler. *Ibid.*, 514.

4. Thus a material addition is made to a common dictionary, which shall add definitions of a large number of words before omitted; or quotations from authors, who have employed words in the sense adopted; or rules for the proper pronunciation of each word; or the roots from which the word has been derived. *Ibid.*, 514.

### DISCOVERY.

1. A discovery of some new principle, theory, elementary truth, or an improvement upon it, abstracted from its application, is not a new invention. *Whitney v. Emmett*, Bald., 311.—BALDWIN, J.; Pa., 1831.

2. But when such discovery is applied to any practical purpose, in the new construction, operation, or effects of machinery or composition of matter, producing a new substance; or an old one in a new way, by new machinery, or by a new combination of the parts of an old one operating in a peculiar, better, cheaper, or quicker method; a new mechanical employment of principle already known; the organization of a machine embodied and reduced to

practice on something visible, tangible, vendible, and capable of enjoyment; some new mode of practically employing human art and skill—it is a “discovery,” “invention,” or “improvement,” within the acts of Congress. *Ibid.*, 311, 312.

3. If a patent is for a discovery, it must be for something new, not for an improvement only; each item must be a new invention, and the discovery must not fail in a material part. *Ibid.*, 314.

4. 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.

5. No discovery will entitle the discoverer to a patent which does not in effect amount to the contrivance or production of something which did not exist before; or, in other words, to an invention. *Ibid.*

6. The discovery of a new effect of that which existed before, is not the subject of a patent. *Ibid.*

7. The discovery of a fact which existed long before is a mere naked discovery, without any invention, for which a patent cannot be granted. There is no invention—nothing contrived or produced. *Ibid.*

8. He who has discovered some new element or property of matter may secure to himself the ownership of his discovery, so soon as he has been able to illustrate it practically and to demonstrate its value. His patent in such case will be commensurate with the principle which it announces to the world, and may be as broad as the mental conception itself. *Detmold v. Reeves*, 4 Amer. Law Jour., N. S., 185. —KANE, J.; Pa., 1851.

9. But the mental conception must have been embodied in some mechanical device or some process of art. The patent must be for a thing, not for an idea merely. *Ibid.*, 188.

10. A new process is usually the result of discovery; a machine of invention. *Corning v. Burden*, 15 How., 267.—GRIER, J.; Sup. Ct., 1853.

11. 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.*, 267.

12. The discovery that a refuse or worthless material can be advantageously applied to a new purpose, if that result is owing to the presence in such refuse material of certain ingredients or substances which had before been used, but in a different way, for the same purpose, is not a patentable invention. *Maule, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

13. The mere discovery of a fact, as, in Sickles' invention, deriving power for the tripping of the valve from the eccentric strap, or from any other moving part of the engine not controlled by the lifting rod, does not constitute the subject of a patent, though the idea may be new. The new set of ideas, in order to become patentable, must be embodied into working machinery, and adapted to practical use. *Sickles v. Borden*, 3 Blatchf., 538.—NELSON, J.; N. Y., 1856.

14. It is this embodiment and operation of machinery for practical purposes which furnish beneficial results to the public, and render the discovery patentable. *Ibid.* 538

## DOUBLE USE.

See also **NEW APPLICATION.**

1. The meaning of the rule laid down in *Howe v. Abbott*, 2 Story, 194, and in *Winans v. Bos. & Prov. R. R.*, 2 Story, 416, that a new application is not entitled to protection, is, that the application of an old machine or old composition of matter, before patented, to a new object, or what is termed a double use, does not entitle one to a patent connected with the new object, because there is no new machinery, or new combination of old parts. *Hotchkiss v. Greenwood*, 11 How., 270.—WOODBURY, J.; (Dis. Opin.), Sup. Ct., 1850.

2. But it is entirely different if one apply an old earth, or old mechanical power, or old principle in physics, to a new object. There is then a new form adopted, or a new combination for the purpose—a new shape, consistency, and use given, or a new *modus operandi*, which, if cheaper and better, benefits the world and deserves protection. *Ibid.*, 270.

3. If these are the effects, however small the skill or ingenuity to imitate them, they are not excluded from the aid of the laws. They are not mere double uses of a previous composition or machine, but a double or additional form or composition of an article for a new purpose. *Ibid.*, 270.

4. A mere analogous use is not patentable; but where a new or improved manufacture is produced, by new contrivances, combinations, or arrangements, a new principle may be constituted, and the application or practice of old things will be new also. *Smith, H.*

*L., Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

5. Where the change in a machine consists in the employment of an obvious substitute, the discovery and application of which could not have involved the exercise of the inventive faculty in any considerable degree, the change will be treated merely as an unsubstantial, colorable variation, or double use, and not patentable. *Everson & Ricard, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

6. Though there may be in a new application some degree of novelty, something may have been discovered or found out that was not known before, yet unless the new occasion on which the principle is applied leads to some kind of new manufacture, or some new result, it will be but a double use. *Blandy, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

7. Where the principle of the alleged invention has been discovered and applied before, the application will be what is called a double use. *Ibid.*

8. Where there is nothing new in the principles involved in an invention, and nothing new in the form or character of the instrumentalities by which it is applied, the new application is but an analogous use, and is not the subject of a patent. *Allen, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

9. The application of substantially the same means to produce the same result, in a different form, as tubes and double walls in a grain bin, the same having been before used in cribs and kilns, is only a double use, and not patentable. *Marsh, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

10. The substitution of a jewel in place of glass in a sewing machine, to

prevent friction in the passage of the thread, is not patentable; it is but the double use of an old contrivance, with no new effect or result. *Berry, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

11. The making of an instrument of two different substances, as an hydrometer of india-rubber and silver—the bulb being of hard rubber and the graduated scale of silver or metal—if a useful result or effect is secured thereby, may be the subject of a patent, though such article may have before been made entirely of metal, and also of entirely hard rubber. Such an invention is not a double use. *Adams, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

12. The double use to which an article of manufacture is applied or applicable is not a ground for a patent. *Penders, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

### DRAMATIC COMPOSITION.

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

2. To carry off a manuscript, as a drama, with intent to perform the piece on the stage against the author's will, is an infringement of his common law rights. *Ibid.*, 409.

3. Acting or representing a play is not publication within the meaning of the copyright laws. *Roberts v. Myers*, 15 Mo. Law Rep., 397—SPRAGUE, J.; Mass., 1860.

4. 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. *Ibid.*, 397.

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

6. Where a person employed by another as a performer and stage manager, agreed to write a play, which was to be performed in his, the employer's, theatre as long as it should continue to draw good audiences, *Held*, that the person writing the drama was the proper person to take out the copyright, and that the employer had no right or interest in it except the privilege of having it performed at his theatre. *Ibid.*, 400.

7. 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.

8. 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* 14.]

9. 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.

10. In the absence of any legislation for the special protection of dramatic literary property, an authorized public circulation of a printed copy of a drama, for which there is no legislative



copyright, is a publication which legalizes a subsequent theatrical representation by any body from such copy. *Keene v. Wheatley*, 9 Amer. Law Reg., 44.—CADWALLADER, J.; Pa., 1860.

11. § 9 of the act of 1831, 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. *Ibid.*, 45.

12. 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.

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

14. The 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. The observance and performance of *all* the statutory requirements except the deposit of a *printed* copy, will give no right of action under the statute. *Ibid.*, 45, 46.

## DRAWINGS.

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 Mas. 9.—STORY, J.; Mass., 1825.

2. If the explanations of the specification call for the drawings, and refer to them as a component part in the description, they are just as much a part of the specification as if they were placed in the body of the specification *Ibid.*, 10.

3. Under the patent law of 1793, § 3 requiring drawings with *written references*, drawings when so annexed to the specification become part of the *written* description of the invention. *Ibid.*, 11.

4. The drawings may be referred to and used with the specification to make a machine, but the model cannot be referred to for such purpose. *Grant v. Mason*, 1 Law Int. & Rev., 23.—THOMSON, J.; N. Y., 1828.

5. The drawings of a patent may not only be referred to for the purpose of aiding a specification which would otherwise be imperfect, to support the patent, but may also be resorted to by the opposite party to explain any thing doubtful or ambiguous in the written description, or for the purpose of showing that the machine in question is not the same as that for which the patent was granted. *Burrall v. Jewett*, 2 Paige, 143.—WALWORTH, Chan.; N. Y., 1830.

6. References to the drawings, mentioned in § 6 of the act of 1836, 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.

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

8. It is not necessary that drawings should be referred to in the specification, and without such references they will be treated as a part of it, and may be referred to to show the nature, character, and extent of the claim, as well as to make a part of the description. *Washburn v. Gould*, 3 Story, 133, 138.—STORY, J.; Mass., 1844.

9. Drawings may also be referred to for the purpose of adding something to the specification or claim not specifically contained or mentioned therein—as to describe or show the existence of rollers in a machine, when they are not described in the specification. *Ibid.*, 139.

10. The drawing is a part of the patent, and may be referred to in order to help out the description. But it need not delineate old machinery connected with the new invention, when no change in such old machinery enters into the new invention. *Emerson v. Hogg*, 2 Blatchf., 9.—BETTS, J.; N. Y., 1845.

11. It is questionable whether under § 3 of the act of 1793, the *specification* must contain *written references* to the drawings. It is sufficient if the patentee puts on file with his specification drawings and written references, without their being mentioned in the specification, and if the references required are written on the drawings, the statute is satisfied. *Ibid.*, 9, 10.

12. Where a patent was obtained in 1834, the original of which and the drawings were destroyed by fire in 1836, and the patentee, under the act of 1837, in 1841 filed a copy of his patent and deposited a drawing, which, however, was not verified, but which he verified in February, 1844, and subsequently in March, 1844, considering such copy imperfect, filed another and

a fuller drawing, and commenced suit in May, 1844, *Held*, that a certified copy of such second copy was properly received in evidence in such action. *Ibid.*, 11.

13. The drawing performs in part the office of a model, that may at any time be constructed for the purpose of illustrating and giving application to contrivances which may be obscure or difficult to understand, as described in the specification. *Ibid.*, 12.

14. When such drawings are put on file they become public records, and copies of them must be received in evidence. If they are discordant, one may destroy the effect of the other. But if they concur in essential particulars, they will conduce to prove the original one. *Ibid.*, 12.

15. The drawing forms a part of the specification of a patent, and is to be taken with it, in interpreting the patent. *Knight v. Gavit*, Mir. Pat. Off., 133.—KANE, J.; Pa., 1846.

16. 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.

17. Drawings annexed to a patent issued under the act of 1837 form no part of the patent, where no drawing was annexed to the original patent. *Wilton v. R. Roads*, 2 Whart. Dig. 410.—KANE, J.; Pa., 1848.

18. The drawings, as well as the whole specifications, may be looked to for explanation of any thing obscure in the patent. And the drawings may be restored when burnt, and if appearing in some respects erroneous, may be corrected. *Hogg v. Emerson*, 11 How., 606.—WOODBURY, J.; Sup. Ct., 1850.

19. Where a patent was granted in 1834, to which no drawing was attached, nor any reference made to any drawings, and afterward, on the 7th of June, 1837, such patent was recorded anew, under the provisions of § 1 of the act of 1837, which patent was also extended for seven years on the 25th of September, 1848, and on the 19th day of November, 1838, a drawing of the patentee's invention, accompanied by written references, was filed, with an affidavit of the patentee that such drawing was a true delineation of his invention, *Held*, in an action of infringement, that under § 3 of the act of 1837, 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. Schen. & Troy R. R.*, 2 Blatchf., 284, 298, 299.—NELSON, J.; N. Y., 1851.

20. But such a drawing, as a general rule, will not be effectual to correct any material defect in the specification, unless it should appear that it corresponded with drawings which accompanied the original application for a patent; if none was so filed, in case of discrepancy between the drawings and specifications, the latter must prevail. *Ibid.*, 299.

21. Nor will such a drawing have the same force or effect as if it had been referred to in the specification, or be deemed and taken as a part of it. *Ibid.*, 299.

22. Drawings, however, accompanying an original application for a patent, have the same force and effect as if they are referred to in the specification, and are to be deemed and taken as a part of it. *Ibid.*, 299.

23. The provision of § 6 of the act of 1837, requiring duplicate drawings, has reference, in point of time, to the issuing of the patent, and not to the filing of the petition for it. Duplicate drawings, need not, therefore, be filed at the time of the application; and such is the interpretation of the Patent Office. *French v. Rogers*, 1 Fisher, 136.—GRIER, KANE, JJ.; Pa., 1851.

24. The second set of drawings required by § 6 of the act of 1837, are unnecessary until the patent issues, and are not required by law to accompany the application when first made. *O'Reilly v. Morse*, 15 How., 126.—GRIER, J.; Sup. Ct., 1853.

25. Models and drawings are to be considered and taken together, in explanation of the specification of a patent. *Stephens v. Salisbury*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

26. The drawings are a part of the specification. Where, therefore, the specification did not set out that the thing invented, as a part of a pair of shears, was cast with the handle of the shears, but there was a reference to the drawing which showed how such part was made, and that it was in fact cast with the handle, *Held*, that the drawings could be referred to to determine such fact. *Hierrich v. Luther*, 6 McLean, 348.—MCLEAN, J.; Ohio, 1855.

27. Experts may be examined to explain, if necessary, models and drawings. *Winans v. N. Y. & E. R. R.*, 21 How., 101.—GRIER, J.; Sup. Ct., 1858.

28. In giving a construction to a patent, the drawings are to be regarded as part and parcel of it. *Judson v. Moore*, 1 Fisher, 549.—LEAVITT, J.; Ohio, 1860.

29. The drawings accompanying an application for a patent, may be signed

either by the inventor, or by any person he may authorize to sign them. *Anon.*, MS., Opin.—BLACK, Atty. Gen., 1859.

## EFFECT.

See also PRINCIPLE; PROCESS.

1. A patent can in no case be for an effect only, but for an effect produced in a given manner, or by a peculiar operation. No patent can be obtained for the admeasurement of time, or the expansive operations of steam; but only for a new mode or new application of machinery to produce these effects; and therefore if new effects are produced by an old machine in its unaltered state, no patent can be legally supported, for it is a patent for an effect only. *Whittemore v. Cutter*, 1 Gall., 480.—STORY, J.; Mass., 1813.

2. A patent for copper-plate printing on the back of bank-notes for the purpose of securing a particular end, viz.: security against counterfeiting, is not a patent for an *effect*, but for the kind of printing by which that effect is produced. *Kneass v. Schuylkill Bank*, 4 Wash., 12.—WASHINGTON, J.; Pa., 1820.

3. A discovery of a new effect of that which existed before is not the subject of a patent. *Kemper, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

4. A mere effect from old means will not justify a patent. *Ibid.*

5. An end to be accomplished is not the subject of a patent; only the new and useful means to accomplish it. *Carver v. Hyde*, 16 Pet., 519.—TANEY, Ch. J.; Sup. Ct., 1842.

6. There cannot be a patent for a principle, nor for the application of a principle, nor for an effect. *Bain v. Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

7. Two persons may use the same principle, and produce the same effect, by *different means*, without interference or infringement, and each would be entitled to a patent for his own invention. *Ibid.*

8. In determining whether an improvement is the subject of a patent, the jury have a right to take into consideration in connection with the change the result which has been produced; because the result, if greatly more beneficial, reflects back and tends to characterize in some degree the importance of the change. *Hull v. Wiles*, 2 Blatchf., 200.—NELSON, J.; N. Y., 1851.

9. Where a party has discovered a new application of some property in nature never before known or in use, by which he has produced a new and useful result, the discovery is the subject of a patent, independently of any peculiar or new arrangement of machinery for the purpose of applying such new property. *Foote v. Silsby*, 2 Blatchf., 264.—NELSON, J.; N. Y., 1851.

10. Hence, the inventor has a right to use any means, old or new, in the application of the new property to produce the new and useful result to the exclusion of all other means. *Ibid.*, 264.

11. Where a change from a patented machine produces an effect, different in kind and highly beneficial, such effect reflects back upon the mechanical arrangement and construction, and may authorize an inference of a substantial change, which the arrangement, disconnected from the new and different effect, would not; and when, without

connecting the new effect with the change, the change might be only formal and unsubstantial. *Tatham v. Le Roy*, 2 Blatchf., 492.—NELSON, J.; N. Y., 1852.

12. Such new effect, however, to give materiality and importance to the apparently formal change, must not consist in doing more work in a given time, or with a reduced amount of power, but the new effect must be different in kind. *Ibid.*, 492.

13. The mere fact that a machine constructed and arranged apparently or externally like a previous one, produces a result more beneficial, does not determine that the two are substantially different. The new result must be one derived from a different mechanical operation and effect. *Ibid.*, 493.

14. A patent is not good for an effect, or the result of a certain process, as that would prohibit all other persons from making the same thing by any means whatsoever, and would discourage arts and manufactures, and is against the policy of the patent laws. *Le Roy, v. Tatham*, 14 How., 175.—MCLEAN, J.; Sup. Ct., 1852.

15. Whoever discovers that a certain useful result will be produced in any art, machine, manufacture, or composition of matter, by the use of certain means, is entitled to a patent for it, provided he specifies the means used so fully and exactly that a skilful person can, by using the means specified, without addition or subtraction, produce the result described. *O'Reilly v. Morse*, 15 How., 119.—TANEY, Ch. J.; Sup. Ct., 1853.

16. But a patent cannot be for an effect produced distinct from the process or machinery necessary to produce it. *Ibid.*, 120.

17. It is for the discovery of some practical method or means of producing a beneficial result or effect that a patent is granted, and not for the result or effect itself. *Corning v. Burden*, 15 H., 268.—GRIER, J.; Sup. Ct., 1853.

18. A patent may be granted for the use of a known thing, in a known manner, to produce effects already known, but producing those effects so as to be more *economically* or *beneficially* enjoyed by the public. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

19. He who discovers that a certain useful result will be produced in any art, machine, manufacture, or composition of matter, by the use of certain means is entitled to a patent for such discovery, provided he sets forth in his specification the means he uses to produce such useful result, so that any one skilled in the art, &c., can, by using the means specified, without any addition or subtraction from them, produce precisely the result he describes. If this cannot be done by the means he describes, the patent is void. *Amer. Pin Co. v. Oakville Pin Co.*, 3 A. L. R., 137; 3 Blatchf., 192.—INGERSOLL, J.; Ct., 1854.

20. And it makes no difference whether the effect is produced by chemical agency or combination, or by the application of discoveries or principles in natural philosophy, known or unknown, before his invention; or by machinery acting together upon mechanical principles. *Ibid.*, 137, 192.

21. But every one may lawfully accomplish the same end, and without infringing the patent, if he uses means substantially different from those described. *Ibid.*, 137, 192.

22. The patent does not secure to the

patentee the result or effect produced, only the means described, by which such result or effect is produced. All other means to produce the same effect, and not patented to any one, are open to the public. *Ibid.*, 138, 192.

23. If a patentee is the original inventor of a device to accomplish a particular result, he may claim an exclusive right to the use of it; but otherwise, if he is not such original inventor, but only of a combination of such device with others. *Corr v. Rice*, 4 Blatchf., 202.—NELSON, J.; N. Y., 1858.

24. If a new and useful result is produced, neither the simplicity of the structure nor the greater or less amount of invention or intellect employed as an element, are of importance in determining the validity of the patent. *Teese v. Phelps*, 1 McAllis., 49.—MCALLISTER, J.; Cal., 1855.

25. An end or result produced is not secured by the patent, but only the substantial means used and specified to produce the end or result; these, and nothing more. The same end or result may be produced by means other than those substantially described in the specification, without infringing the patent. *Burr v. Corperthwaite*, 4 Blatchf., 167.—INGERSOLL, J.; Ct., 1858.

26. If the result of two machines is the same, and if the essential means to produce a like result are the same, or substantially the same, then the one is a violation of the other. If they are not the same there is no violation, for a defendant may lawfully produce the like result, if he uses means substantially different: results are not patented, but only means used to produce results. *Ibid.*, 170.

27. Where a result is a new and valuable article of manufacture, this will

afford ground to presume invention. *Woodruff, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

28. A result or effect is not patentable, but where a result is in a greatly improved manufacture, or development of some new and useful principle, it may become the test of invention, and from which invention may be inferred, or where the result is substantially different from what has been effected before. *Treadwell v. Fox*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

29. A purpose is not patentable, yet if the arrangement or thing made effect a beneficial and new result, it is patentable. *Jacobs, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

30. A claim for an effect or function is not patentable. *Sickles v. The Falls Co.*, 4 Blatchf., 509.—NELSON, J.; Ct., 1861.

## ENGRAVINGS.

See title "CHARTS."

## EQUITY, JURISDICTION OF AND PLEADINGS IN.

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**A. AS TO COPYRIGHTS AND MANUSCRIPTS.**

See also **ACTIONS, A.; DRAMATIC COMPOSITIONS; INJUNCTIONS, A.**

1. At common law the rights of an assignee of a manuscript would be protected by a Court of Chancery. *Wheaton v. Peters*, 8 Pet., 661.—McLEAN, J.; Sup. Ct., 1834.

2. This is presumed to be the "copyright" recognized in § 1 of the act of 1790, and which was intended to be protected by its provisions, and this protection was given as well to books published under such circumstances, as to manuscript copies. *Ibid.*, 661.

3. 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. Ch., N. Y., 1837.

4. A Court of Chancery assumes jurisdiction to restrain the publication of private letters on no other principle and upon no broader ground than that of copyright in literary productions, or a property in the paper on which they are written, similar to property in stereotype or engraved plates. *Wetmore v. Scoville*, 3 Edw. Ch., 527.—McCOUN, V. Ch.; N. Y., 1842.

5. It will not exercise the power of preventing the publication of private letters of business on the ground of copyright or literary property, when they possess none of the attributes of literary composition. *Ibid.*, 528.

6. On general equitable principles, relief may be given by a Court of Chancery against one who has surreptitiously gained possession of a manuscript. *Bartlett v. Crittenden*, 4 McLean, 301.—McLEAN, J.; Ohio, 1847.

7. A court of equity will not attempt to restrain the publication of private letters on the ground of protecting literary property, when they possess no attribute of literary composition. *Hoyt v. McKenzie*, 3 Barb. Ch.; 325.—WALWORTH, Chan.; N. Y., 1848.

8. In a suit under the copyright acts, the complainant must make out a title to sue under his copyright. The court cannot interfere to prevent the use of the title of a work in fraud of the plaintiff, upon principles relating to the good-will of trades. *Jollie v. Jaques*, 1 Blatchf., 627.—NELSON, J.; N. Y., 1850.

9. The act of February 15, 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; § 9 of the act of 1831 protects manuscripts only. *Stevens v. Gladding*, 17 How., 455.—CURTIS, J.; Sup. Ct., 1854.

10. 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 the violation of a copyright. *Ibid.*, 455.

11. It is doubtful whether, under the act of 1831, as to copyrights, the courts of the United States can exercise jurisdiction, by way of injunction, to prevent the publication of private letters, contrary to the wishes of the writer. *Woolsey v. Judd*, 4 Duer, 382.—DUER, J.; N. Y., 1855.

12. A court of equity cannot inter-

fere to prevent the publication of private letters, on the ground that such a publication, without the consent of the writer, is a breach of confidence and honorable feeling, and is dangerous to the peace and morals of the community. *Ibid.*, 383, 384.

13. But the author has such an exclusive right in his manuscript at common law as entitles him to determine for himself whether it shall be published at all; and when this exclusive right is in danger of being violated, a court of equity is bound to prevent the wrong by injunction. *Ibid.*, 385, 393.

14. In equity, a limited local or other partial assignment of a copyright, if made for a valuable consideration, will be carried into effect, whether it would be effectual in law or not. *Keene v. Wheatley*, 9 Amer. Law Reg., 47.—CADWALLADER, J.; Pa., 1860.

## B. AS TO PATENTS.

### 1. General Jurisdiction.

See also, FEIGNED ISSUE; INJUNCTION, B.

1. Under the act of 1800, jurisdiction was given to the Circuit Courts of the United States in patent cases, only "in actions on the case." By the judiciary act of 1789, such courts had no equity powers conferred on them, between citizens of the same state. *Livingston v. Van Ingen*, 1 Paine, 48, 52.—LIVINGSTON, J.; N. Y., 1811.

2. Where, therefore, a bill was filed for the infringement of a patent, and the parties were all residents of the same state, *Held*, that the court could not take cognizance of such a case, and that the bill must be dismissed. *Ibid.*, 52, 54.

3. But whether, under such acts, if it became necessary in an action at law to appeal to their equity side in aid or defence of such action, those courts would not have the necessary jurisdiction; *query*. *Ibid.*, 53.

4. The equity jurisdiction exercised by the courts over patents for inventions, is merely in aid of the common law, and in order to give more complete effect to the provisions of the statutes under which the patent is granted. *Sullivan v. Redfield*, 1 Paine, 446.—THOMPSON, J.; N. Y., 1825.

5. Whether the complainant's patent is good and valid, so as ultimately to secure to him the rights he claims, is not a question for decision upon the equity side of the court. But the equity jurisdiction should never be exercised but upon the supposition that the applicant for the aid of the court, has a right which has been infringed by the other party. *Ibid.*, 446, 447.

6. The fact that the subject matter of a contract sought to be enforced, is a patent-right, does not of itself give the courts of the United States jurisdiction. A bill filed for a specific performance of such a contract, must contain the proper averments to show that the court has jurisdiction. *Burr v. Gregory*, 2 Paine, 426, 429.—THOMPSON, J.; N. Y., 1828.

7. If, in an assignment of a patent, the invention or improvement conveyed is misnamed, the deed is not a nullity, if it furnish sufficient means for correcting the mistake, and identifying the thing about which the parties intended to contract. The deed may be reformed in a court of equity. *Harmon v. Bird*, 22 Wend., 115.—BRONSON, J.; N. Y., 1839.

8. A court of equity will not inter-



fere in behalf of a patentee, either to grant an injunction, or give him any relief, in respect to an alleged violation of his patent, if after having obtained his patent, he has surrendered or dedicated it to the public, or acquiesced for a long period in the public use thereof, without objection—as his own conduct may be considered as having led to such use or application, or acts of the defendants.

*Wyeth v. Stone*, 1 Story, 282, 284.—STORY, J.; Mass., 1840.

9. Under §§ 16 and 17 of the act of 1836, the Circuit Courts of the United States have exclusive cognizance of suits in equity, relative to interfering patents, in cases where the court is authorized to adjudge and declare a patent inoperative or void, either wholly or in part, or in any particular portion of the United States. *Gibson v. Woodworth*, 8 Paige, 134. WALWORTH, Chan., N. Y.; 1840.

10. Whether such courts have exclusive jurisdiction of every case in which a right under the patent laws might come in question collaterally; or in cases except where, from the nature of the relief, their jurisdiction must necessarily be exclusive; *query*. *Ibid.*, 134.

11. In an action at law, for a breach of a patent, it is indispensable to establish a breach before suit brought. But in equity, a bill will lie for an injunction, if the patent-right is admitted, or has been established upon well-grounded proof of an apprehended intention of the defendant to violate the patent-right. A bill *quia timet* is an ordinary remedial process in equity. *Woodworth v. Stone*, 3 Story, 752.—STORY, J.; Mass., 1845.

12. The Circuit Courts have no jurisdiction of an action, as to enforce the specific execution of a contract respect-

ing a patent, where the parties are all citizens of the same state; but where the plaintiffs set up a right under a patent and allege that the defendants are infringing, citizenship will not oust jurisdiction. *Brooks v. Stolley*, 3 McLean, 525.—McLEAN, J.; Ohio, 1845.

13. But where the court has obtained jurisdiction on the ground of infringement, it may then decide other matters, which, of themselves, would not afford ground for the original exercise of jurisdiction. *Ibid.*, 529.

14. Under § 17 of the act of 1836, the jurisdiction, as to subject matter, of the Circuit Courts does not extend to a bill in equity, filed for the specific performance of a contract to transfer a patent—the jurisdiction of such courts being confined to actions under the patent laws granting or confirming rights to inventors. *Nesmith v. Culvert*, 1 Wood. & Min., 37.—WOODBURY, J.; Mass., 1845.

15. If such a bill is filed against several defendants, some of whom are residents of the same state with the complainants, the bill may still be maintained against the defendants who are residents of another state. *Ibid.*, 37.

16. And if such bill contain a prayer for an injunction against the use of the patent by all, this would be ground, it seems, of jurisdiction over all the defendants as to subject matter. *Ibid.*, 38.

17. Proceedings by bill in equity, under § 16 of the act of 1836, and § 10 of the act of 1839, 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 cannot be brought elsewhere. No tribunal out of the district has jurisdiction

over the person of the Commissioner of Patents, as such, and the Patent Office. *Prentiss v. Ellsworth*, Mir. Pat. Off., 36.—RANDALL, J.; Pa., 1846.

18. The jurisdiction conferred upon the Circuit Courts, in patent cases, by § 4 of the act of 1836, is the same, in its nature and extent, as the equity jurisdiction in England, from which it is derived. On an injunction bill filed by a patentee, where there is no dispute as to title, the bill having been taken as confessed, such courts have the power to refer the case to a master to take and state an account of the profits made by the defendant by the use of the plaintiff's invention, instead of sending it to a court at law to assess the damages. *Allen v. Blunt*, 1 Blatchf., 486, 487.—NELSON, J.; N. Y., 1849.

19. Where it is evident that the legal effect of a contract, as to a patent, according to the terms of it, is different from the actual agreement made at the time, between the parties, a court of equity would probably, upon a proper application, direct the contract to be reformed by the insertion of a clause to the effect claimed. *Woodworth v. Cook*, 2 Blatchf., 158.—NELSON, J.; N. Y., 1850.

20. It is a well established rule in equity, that the matter entitling a party to an amendment of his contract, may be set up by way of equitable defence against a proceeding, as to enforce a specific performance, involving the rights of the parties under the instrument, and which would not have been maintainable had the agreement been as was intended. *Ibid.*, 158, 159.

21. But such contract cannot be reformed where rights of a *bona fide* purchaser have intervened, which would or might be seriously prejudiced by allow-

ing such contract to be reformed, or defence set up. *Ibid.*, 159.

22. A suit in equity to obtain an injunction to restrain proceedings in an action at law, will not be sustained when the allegations set up a defence, as fraud, which is a proper case for the consideration of a jury, and when the facts charged are met and denied by the defendant, such denial being sufficient to prevent the issuing of an injunction. *Day v. Goodyear*, MS.—GRIER, J.; N. J., 1850.

23. If from the number and character of the assignments and reassignments of a patent, it may be doubtful whether an action at law can be brought so as to obtain relief for an injury complained of, it will afford ground for the exercise of an equity jurisdiction. *Bicknell v. Todd*, 5 McLean, 240.—MCLEAN, J.; Ohio, 1851.

24. Upon a bill filed to declare a patent granted by the Commissioner invalid or inoperative, under § 16 of the act of 1836, amended by § 10 of the act of 1839, 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. *Atkinson v. Boardman*, MS.—NELSON, J.; N. Y., 1851.

25. The evidence before the Commissioner is not evidence in such a suit, except by consent of parties; nor are the parties to the suit restricted to the testimony used before the Commissioner. Either party is at liberty to introduce additional evidence. *Ibid.*

26. A court of equity will not, in a decree intended to put an end to litigation as to patent interests, attempt to undo what has been done, and set aside what has already been adjudicated between

the parties. *Goodyear v. Day*, MS.—GRIER, J.; N. J., 1852.

27. The patent act of 1836, § 17, confers jurisdiction in equity upon the Circuit Courts irrespective of the right of the plaintiff to an injunction, or of his demand for one. *Nevins v. Johnson*, 3 Blatchf., 83.—NELSON, BETTS, JJ.; N. Y., 1853.

28. Accordingly, where the plaintiff's patent had expired, and a bill in equity filed by him alleged an infringement of the patent before it expired, and prayed for a discovery and an account, but not for an injunction, *Held*, on a demurrer to the bill, that the court had jurisdiction. *Ibid*, 83.

29. A court of equity will not proceed against the principles and sureties of an injunction-bond to enforce payment of the damages sustained by reason of the injunction. The defendant must resort to an action at law on the bond. *Merryfield v. Jones*, 2 Curt., 306.—CURTIS, J.; Mass., 1855.

30. A mutual and reciprocal covenant of an agreement respecting a patent, having been broken by one party, he cannot obtain the aid of a court of equity to restrain the other covenantor from its violation. *Clum v. Brewer*, 11 Mo. Law. Rep., 391.—CURTIS, J.; Mass., 1856.

31. Otherwise, where the covenants are independent, or only collaterally connected, though in the same instrument; or where the breach is of such a nature that it may be fully repaired, and one of the conditions precedent for obtaining relief may be such reparation. *Ibid.*, 392.

32. Where the covenant was, by the owners of a patent, that no right to use the invention should be conveyed without the assent and concurrence of all

those interested, *Held*, that a party who had been guilty of a breach thereof, though through a misapprehension of the construction of the agreement, cannot maintain a bill for an injunction to restrain the other covenantor from a similar violation. *Ibid.*, 392.

33. The Circuit Courts of the United States, having jurisdiction in equity of controversies arising under the United States patent laws, do not act as ancillary to a court of law, and therefore do not require the patentee first to establish his legal right in a court of law, and by the verdict of a jury. *Sanders v. Logan*, 2 Fisher, 171.—GRIER, J.; Pa., 1861.

34. A court of law may treble a verdict for "actual damage" in a patent suit, where the defendant has acted wantonly or vexatiously, but a court of equity can inflict no exemplary or punitive damages as a court of law may. *Ibid.*, 170.

35. A patentee whose invention is only valuable because used by all who pay a license fee, and who suffers no other wrong than the detention of such fee, needs none of the remedies which it is the duty of the chancellor to give for such protection. *Livingston v. Jones*, 2 Fisher, 210.—GRIER, J.; Pa., 1861.

36. A court of law is his proper resort; the only remedy to which he is entitled being a judgment for a given sum of money, with interest; and there he may recover a penalty to the extent of treble damages, if the judge sees fit to inflict it. Penalties and punitive damages can be recovered only in courts of law. *Ibid.*, 210.

37. Although the statute gives original cognizance of patent controversies, equally to courts of equity as to courts

of law, all distinction as to the remedies granted by each tribunal is not abolished; each court will give the remedy peculiar to its own functions. The remedies of a Court of Chancery are by injunction and account, and a court of equity cannot take jurisdiction to enforce a penalty, or merely punitive damages. A court of law cannot issue an injunction, but enforce penalties and punitive damages. *Ibid.*, 210.

2. *Original Bill; parties to; what to set forth; multifariousness of; amendment and dismissal of.*

1. A bill filed for an injunction should set forth that, after the issuing of the patent, the complainant had put his invention into use, or had sold the same for a valuable consideration, and is, at the time of the filing of the bill, in the exclusive possession of such patent. *Isaacs v. Cooper*, 4 Wash., 260, 261.—WASHINGTON, J.; Pa., 1821.

2. A bill for an injunction should be verified by the oath of the party filing it, as to the truth of the allegations contained in it, and that the patentee was, to the best of his knowledge, the true and first inventor of the thing patented, and that the same had not, to his knowledge and belief, been in use or been described before his invention or discovery thereof. *Rogers v. Abbot*, 4 Wash., 514.—WASHINGTON, J.; Pa., 1825.

3. Whether an assignee of part of a patent, circumscribed as to the interest by local limits, can, in his own name, or with the patentee, maintain a suit at law or not, there can exist no doubt but that he may support a suit in equity to enjoin third persons from infringing

the patent, and for an account. *Ogle v. Ege*, 4 Wash., 584.—WASHINGTON, J.; Pa., 1826.

4. A bill filed for the specific performance of a contract respecting a patent-right must contain the proper averments to give jurisdiction to the court, by reason of the *character* of the parties. The fact of the subject matter of the contract being a patent does not give the Circuit Courts jurisdiction. *Burr v Gregory*, 2 Paine, 426, 429.—THOMPSON, J.; N. Y., 1828.

5. An assignee of a part interest which is exclusive in a patent, may, at law or in equity, maintain a suit for infringement, without joining the patentee. So held, in fact, the bill being filed by the assignee alone. *Brooks v. Bicknell*, 3 McLean, 250.—MCLEAN, J.; Ohio, 1843.

6. An assignor who retains an interest in a patent, may be joined as a party complainant with an assignee of the exclusive interest in a certain territory in which such assignor has no interest, in a bill for an injunction to restrain the violation of the patent in that territory. *Woodworth v. Wilson*, 4 How., 716.—NELSON, J.; Sup. Ct., 1845.

7. It is not necessary that the bill should allege or specifically describe all the evidence which is to be put in in the case; but the bill must contain allegations broad enough to cover any evidence, before it becomes admissible. *Nesmith v. Calvert*, 1 Wood. & Min., 44.—WOODBURY, J.; Mass., 1845.

8. A person interested in a patent but not *within* the particular district where the suit is brought, may be made a party complainant in a bill to restrain an infringement *within* such district, as he is interested in protecting himself against an infringement out of that dis-