

ent which had been reissued, and had been frequently adjudicated upon and sustained, *Held*, that the court would not, on such motion, entertain any questions as to the originality of the invention, or as to the validity of the reissued patent. *Gibson v. Betts*, 1 Blatchf., 164.—NELSON, J.; N. Y., 1846.

20. A court will not, on an application as to an injunction, examine critically the correctness or even sufficiency of the application for a patent, if it was made to all appearance in good faith, and was an attempt to make known and secure the claim. *Sparkman v. Higgins*, 1 Blatchf., 208.—BETTS, J.; N. Y., 1846.

21. Under the act of 1793, ch. 22, § 5, requiring "reasonable previous notice to the adverse party or his attorney of the time and place of moving for an injunction," it is usual to give a reasonable time for the preparation of the answer, and the taking of affidavits. *Wilson v. Stolley*, 4 McLean, 273.—MCLEAN, J.; Ohio, 1847.

22. Such notice was designed to enable the defendant to resist the application for the injunction; and this resistance can be most effectually made by permitting the defendant to file his answer. *Ibid.*, 273.

23. Affidavits may be heard in behalf of both parties, especially in patent cases. This enables the judge to act upon the motion with a better knowledge of the equitable rights of the parties. *Ibid.*, 273.

24. The defendant may be permitted to show, as preliminary to the motion for an injunction, that the bill upon its face is materially defective. *Ibid.*, 273.

25. But the court is not bound, on motions for injunctions, to decide doubtful and difficult questions of law, or dispute questions of fact, nor exercise this

high and dangerous power, if exercised rashly, in doubtful cases, before the offender shall have an opportunity of a full and fair hearing. *Parker v. Sears*, 1 Fisher, 96.—GRIER, J.; Pa., 1850.

26. The nature of an application for a preliminary injunction is peculiar. It is not a final settlement of the legal rights of the parties; nor do they come into court with what are strictly to be called legal proofs, but with affidavits alone, upon which neither party has the right of cross-examination. *Day v. Bos. Belt. Co.*, 6 Mo. Law Rep., 330.—SPRAGUE, J.; Mass., 1853.

27. In moving for a preliminary injunction, the practice is, that the complainant must file the affidavits upon which he relies by a certain day, and then the defendant files his affidavits in reply by another appointed day, and this closes the evidence. The complainant is not entitled, as a matter of right, to file further affidavits in answer to those of the defendants. *Ibid.*, 331.

28. Whether, in a case of entire surprise, the complainant might not have an opportunity to reply; *query*. *Ibid.*, 331.

29. A mere denial, by an answer, of the equity of the bill will not prevent the court—at least in the first circuit, since the decision of *Poor v. Carleton*, 5 Sumn., 70—from looking into the law and the facts of the case, on a motion for a special injunction, and granting or refusing it, according to its discretion. *Clum v. Brewer*, 2 Curt., 518.—CURTIS, J.; Mass., 1855.

30. If the right to a temporary injunction depends on the construction of a deed, the court will construe it and act accordingly, whatever view of the question the answer may have presented. *Ibid.*, 519.

## PRELIMINARY. CONTINUANCE, OR DISSOLUTION OF.

31. Under rule 107 in equity, and the amendatory rule of May, 1846, the court, or a judge out of court, has power to permit the plaintiff, on a motion for an injunction, where the defendants set up a license in defence, to put in proofs in rebuttal of the proofs put in by the defendant. *Day v. N.E. Car Spring Co.*, 3 Blatchf., 157.—BETTS, J.; N. Y., 1854.

32. But the defendant cannot reply to such rebutting proof by further proofs on his part. *Ibid.*, 159.

33. On a motion for a preliminary injunction to restrain the infringement of a patent, the court will not look further into the case than to ascertain whether or not, upon established principles of equity, to prevent an irreparable injury, the interference of the court is necessary, pending the litigation. *Sickles v. Yoings*, 3 Blatchf., 296.—NELSON, J.; N. Y., 1855.

34. Unless the right is clear upon the papers and proofs presented, in favor of the plaintiffs, the injunction will be refused. *Ibid.*, 296.

## e. Continuance, or Dissolution of.

1. Though doubt and uncertainty are fatal to a motion to grant an injunction, they are good cause for continuing it on a motion to dissolve; the burden of proof being on the plaintiff in one case and on the defendant in the other. *Cooper v. Matthews*, 8 Law Rep., 416.—BALDWIN, J.; Pa., 1842.

2. The continuance or dissolution of an injunction is entirely within the sound discretion of the court. Because the right of the patentee may be questioned and even appear doubtful to the court from the evidence offered, an injunction will not necessarily be dissolv-

ed. *Orr v. Badger*, 7 Law Rep., 467.—SPRAGUE, J.; Mass., 1844.

3. Where, therefore, a patentee had been in quiet possession for some years, and had received considerable sums for sales under his patent, and had obtained a judgment in a suit at law, though the affidavits offered by the defendant were sufficient to render the result of a trial doubtful, a temporary injunction was continued to the hearing, it also appearing to the court that the plaintiff would suffer great injury from a dissolution of it. *Ibid.*, 468.

4. An injunction granted on an original patent, will not be continued as to the amended patent, issued on the surrender of the original patent, without a supplemental bill. *Woodworth v. Stone*, 3 Story, 750.—STORY, J.; Mass., 1845.

5. Where an injunction had been granted on a bill filed for an infringement of an original patent, and pending the proceedings the patent had been surrendered and a new or reissued patent taken, to which proceedings the parties to the suit had consented, and it was moved upon a supplemental bill to continue the injunction as to the new patent, *Held*, that the injunction already granted (supposing both patents to be for the same invention) was *prima facie* evidence of an intended violation, if not of an actual violation, and the injunction was ordered to stand continued as to the new patent. *Ibid.*, 753, 755.

6. Where the bill or affidavits of the complainant did not state with certainty the infringement of the defendant, and the complainant did not swear at the time of the filing of the bill that he believed he was the original and true inventor of the thing patented to him, and the defendant denied on oath that

the patentee was the original inventor, and also denied the novelty and utility of the invention, the preliminary injunction was dissolved. *Wilson v. Curtius*, 2 West. Law Jour., 511.—McCaleb, J.; La., 1845.

7. But the injunction may be revived on further affidavits setting forth the particulars of the infringement complained of, and alleging priority of invention in the patentee. *Ibid.*, 511.

8. It is not a matter of course to dissolve an injunction on the coming in of an answer denying the equity of the bill, if the complainant has produced auxiliary presumptions in favor of his right. *Orr v. Littlefield*, 1 Wood. & Min., 19.—Woodbury, J.; N. H., 1845.

9. It is within the sound discretion of the court whether to issue an injunction or refuse it, or if issued, to dissolve or retain it. *Ibid.*, 19.

10. In order to obtain an injunction in advance of a trial at law, there must be proof not only of a patent, but also of some length of use under it, or some considerable sales under it, or some recovery establishing the validity of the patent, so as to impart to it weight or strength as valid beyond the mere issue of it. *Hovey v. Stevens*, 1 Wood. & Min., 303.—Woodbury, J.; Mass., 1846.

11. But where possession for some years has existed, or there have been numerous sales or recoveries, the court will not refuse an injunction, or dissolve it on a denial of the validity of the patent by the defendant, either through affidavits or an answer, or other pleadings. *Ibid.*, 304.

12. If none of these fortifying circumstances exist, courts will not only refuse an injunction, but will dissolve one previously allowed, if the validity

of the patent is denied or brought into doubt. *Ibid.*, 304.

13. An injunction issued on a bill filed to restrain the use of a patent, and alleging long possession and sales under the patent, and that the validity of the patent had been supported by several trials, will not be dissolved on an answer denying generally the originality of the patent, and the use of it by the respondent, unless the denial is justified by something else, or the claim strengthened by some evidence. *Orr v. Merrill*, 1 Wood. & Min., 376, 378.—Woodbury, J.; Me., 1846.

14. But such an answer is sufficient to justify the court to direct an action at law to test the patent, with instructions that if such action is not brought by the plaintiff within a given time, the injunction will be dissolved. *Ibid.*, 378, 379.

15. A common injunction will be dissolved on an answer denying title, &c., but a special one will not, unless the denial is justified by something else, or the claim is strengthened by something else. In special injunctions a motion to dissolve depends on the sound discretion of the court, after affidavits as to merits, if required, and on the nature of the case. *Ibid.*, 378.

16. Though it may be true to a certain extent, that doubts as to the validity of a patent, when such doubts relate to the merits, are to be favorably considered against granting an injunction; an injunction once granted should not be disturbed for such doubts, when they relate to some technicality of form, and not to any neglect or wrong of the patentee, and especially when the trial on the merits is near. *Woodworth v. Hall*, 1 Wood. & Min., 400.—Woodbury, J.; Mass., 1846.

17. On a motion to dissolve an injunction granted on a bill of complaint, unless the proof offered overcome the equity of the bill and the evidence supporting it, the motion will be denied. The motion must depend on what is then presented to the court. *Sparkman v. Higgins*, 1 Blatchf., 207, 208.—BETTS, J.; N. Y., 1846.

18. Where the defendants deny the validity of the plaintiff's patent, a temporary injunction, if granted, will only be till the validity of the patent can be tried at law, and will be dissolved if such suit at law is not brought before the next term. *Woodworth v. Edwards*, 3 Wood. & Min., 133.—WOODBURY, J.; Mass., 1847.

19. On a motion to dissolve a special injunction, the main point is not whether an injunction should be granted at all, but having been already granted, until the contrary is shown, it will be presumed that the injunction was rightly granted. *Woodworth v. Rogers*, 3 Wood. & Min., 143.—WOODBURY, J.; Mass., 1847.

20. Such presumption may be overcome by new matter or evidence, arising since the injunction was imposed, though generally not by matter then existing, which the party neglected to present to the consideration of the court. *Ibid.*, 143.

21. Such new matter is usually a subsequent answer, denying the originality of the patent, or its validity, and supported by *prima facie* proof, or by showing a trial at law and a judgment against the patent. *Ibid.*, 144.

22. The presumptions arising from the answer may be disproved by evidence on the part of the plaintiff, and then counter testimony is admissible by the respondent to sustain the answer. *Ibid.*, 144.

23. It is the duty of the court to balance these allegations and proofs, and decide how the weight of them is; and whether, in the exercise of a sound discretion, the injunction ought to be dissolved or not. *Ibid.*, 145.

24. If the preponderance is in favor of the plaintiff, the injunction will be retained until the legal right has been determined by a feigned issue, or a trial at law. And when the parties do not agree as to the issue to be tried, the court will direct a suit at law to be brought at the next term of the court, or the injunction will be dissolved. *Ibid.*, 146, 151.

25. A common injunction is usually dissolved, as a matter of course, on the coming in of an answer denying merits, or a legal title in the plaintiffs, and without any inquiring into the truth of the allegations—otherwise, in the case of a special injunction. *Ibid.*, 147.

26. An injunction is never issued in hostility to what seem to be the legal rights of parties, but in aid and protection of them. And whenever a trial is had, showing that the rights at law are with the party enjoined, the injunction, as a matter of course, will be dissolved. *Ibid.*, 150.

27. Nor does an injunction delay or retard a trial by jury, but only makes the *prima facie* title prevail till then. *Ibid.*, 150.

28. Where a bill was filed against K., and an injunction was granted against him, and afterward a supplemental bill was filed to bring in the assignee of K., and new charges were inserted in regard to K., so as to embrace transactions of his not covered by the injunction originally awarded against him, *Held*, that as the transactions of K. set forth in the supplemental bill, were of

the same character with those before enjoined, they came within the scope of the former injunction, and that it must be extended to include them. *Parkhurst v. Kinsman*, 2 Blatchf., 79.—BETTS, J.; N. Y., 1848.

29. It appearing also that G. had been clerk of K. and knew his transactions, in respect to the patent, and of the granting of the injunction against K., and that on the very day of the hearing for the injunction, he became the assignee of K., *Held*, on a motion for an injunction against G., that he stood before the court chargeable with the liabilities of K., and took the subject matter assigned to him with no other or higher rights as respected the plaintiff than K., and did not stand before the court as an independent infringer. *Ibid.*, 80, 81.

30. Where a bill was filed for an infringement of a patent, on which a preliminary injunction was allowed, and the answer, which was supported by affidavits, denied the infringement, and also set up that the acts of the defendant were done under a license from the plaintiff, the injunction was dissolved. *Goodyear v. Bourne*, 3 Blatchf., 268.—NELSON, J.; N. Y., 1856.

31. Where an injunction has been granted in a patent case by a circuit judge, a district judge, as a judge of the Circuit Court, will not review or set aside such action, by dissolving the injunction. At least the reasons that would justify such a course must be peculiar and stringent. *Hussey v. Whiteley*, 2 Fisher, 125.—LEAVITT, J.; Ohio, 1861.

### 3. *Final or Perpetual; when granted and when not.*

See also INJUNCTIONS, B. 1.

1. If a state grant to the possessor or

introducer of an invention an exclusive privilege to use the same for a limited period, such act or grant is constitutional, and the grantees are entitled to an injunction against those infringing such privileges. *Livingston & Fulton v. Van Ingen*, 9 John., 507, 562.—YATES, J.; 1812. *Ibid.*, 571.—THOMPSON, J. *Ibid.*, 585 to 589.—KENT, Ch. J., N. Y. [Overruled in fact by *Gibbons v. Ogden*, 9 Wheat. 1824, as interfering with the general laws regulating the coasting trade.—*Ed.*]

2. An acquiescence of a patentee in the known user by the public, without objection or qualification, of his invention, is sufficient ground to justify a court in refusing him an injunction against such user. *Wyeth v. Stone*, 1 Story, 284.—STORY, J.; Mass., 1840.

3. A court of equity will refuse an injunction, even where the legal right and title of the party are acknowledged, when his own conduct has led to the very act of application of the defendants of which he complains, and for which he seeks redress. *Ibid.*, 283.

4. If a patentee neglects to file a disclaimer, where he ought to take such proceedings, until after suit is brought, a court of equity will not interfere to grant a perpetual injunction, whatever may be his right and remedy at law. *Ibid.*, 295.

5. Where a party was the owner of a patent-right for a certain district, and articles under the same patent were manufactured in another district but sold in the first district, *Held*, that the court would not enjoin such sale, as the exclusive right was confined to the things patented, and not to the products. *Boyd v. Brown*, 3 McLean, 296, 297.—MCLEAN, J.; Ohio, 1843.

6. Whether, if the party manufacturing in the second district was actually engaged in selling within the district owned by the other, it would not be such a violation of the right of such person that an injunction would issue. *Ibid.*, 296.

7. The sale of the products of a patented machine by a person not connected with or interested in the manufacture is not such an infringement as will be enjoined; but if the person who sells is connected with the use of the machine, he is responsible for damages, and may be enjoined. *Boyd v. McAlpine*, 3 McLean, 429, 430.—McLEAN, J.; Ohio, 1844.

8. And though the structure and use of the machine may be beyond the jurisdiction of the court, if the court have jurisdiction of the person of the defendant, the court may restrain him from using the machine and selling the product. *Ibid.*, 430.

9. Where a party has a license under a patent, and the patentee reserves the power, upon default of payment of the agreed price for the privilege, to claim and take back the interest, and an action was brought to recover the arrears, the patentee may still have an injunction to restrain the licensee from further use of the privilege, the action for the arrears and a judgment thereon being no waiver of the forfeiture. *Armstrong v. Hanlenbeck*, 3 N. Y. Leg. Obs., 45.—BETTS, J.; N. Y., 1844.

10. Where a party has a license to use a patented machine, upon certain conditions, he may be enjoined from using it except upon those conditions; but a failure to perform such conditions is not necessarily a forfeiture of his license, so as to entitle the plaintiff to an absolute injunction against all use of the

machine. The defendant may be enjoined according to the conditions of his license. *Brooks v. Stolley*, 3 McLean, 529.—McLEAN, J.; Ohio, 1845.

11. A reference being ordered to a master to take testimony as to an infringement, and to report thereon, and the report of such master being in favor of the plaintiff, and that the defendant had infringed his patent, the court granted an injunction as prayed for. *Parker v. Hatfield*, 4 McLean, 64.—McLEAN, J.; Ohio, 1845.

12. A purchaser, for his own account, of articles manufactured by a patented machine, though purchased with a full knowledge that they were manufactured in violation of the patent, cannot be enjoined, or held liable in any other way. *Anon.*, 3 West. Law Jour., 144.—N. Y., 1845.

13. If, from the evidence in the case, it appears that the defendant has infringed the right of the complainant, an injunction will be granted restraining the defendant from further infringement. *Buck v. Gill*, 4 McLean, 174, 177.—McLEAN, J.; Ohio, 1846.

14. In particular cases, as where the patent is for a machine to make some article of manufacture, and a source of profit arises from the monopoly of such articles, a court would issue an injunction in the last month or week of the patent's life, to restrain the sale of articles piratically manufactured in violation of the patent while it was in force. But where the plaintiff can be compensated in damages, it seems an injunction will not, under ordinary circumstances, be granted during the last few weeks of a patent. *Parker v. Sears*, 1 Fisher, 102.—GRIER, J.; Pa., 1850.

15. The rule that a court of equity will, not grant a final and perpetual in-

junction in patent cases, when the answer denies the validity of the patent, without sending the parties to law to have that question decided, is not absolute or universal. It is a practice founded more on convenience than necessity, and always rests in the sound discretion of the court. *Goodyear v. Day*, 2 Wall, Jr., 296.—GRIER, J.; N. J., 1852.

16. In the courts of the United States the practice of sending the parties to an action at law is by no means as general as in England, and there are many cases in which a final injunction has been decreed without a verdict to establish the patents, thus showing that the courts of the United States do not always consider it a proper exercise of their discretion to order such issues to be tried at law, before granting a final injunction. *Ibid.*, 297, 298.

17. One of a number of joint tenants in a patent cannot come into a court of equity and assert a superior equity as against another. Nor can one tenant in common enjoin the other from the use or sale of the patent. *Clum v. Brewer*, 2 Curt., 524.—CURTIS, J.; Mass., 1855.

18. The plaintiff was the assignee of the Maynard patent for locks and primers, which the defendants, a company organized for the manufacture of Sharp's rifle, applied to their guns without the license or consent of the plaintiff, though with his knowledge; as to the compensation for such use some negotiations had also been had between the parties, but without any satisfactory result. The defendants had contracted to furnish the British government with six thousand of such rifles, fitted with the Maynard lock. The plaintiff now filed his bill for the infringement of his patent, asking an account, and that the defendants pay the damages the plaintiff had sustained,

and also that the defendants be enjoined from completing their contract with the British government, until they should pay a reasonable compensation for the use of the patent. The defendants, in their answer, did not deny the validity of the patent, or the plaintiff's title, but admitted the use, setting up the negotiations as to compensation, their willingness to pay a reasonable price, and the fact that the contract with the British government was entered into pending such negotiations, and offered to pay twenty-five cents per lock, used by them, or the profits which an accounting should show they actually made upon such locks; *Held* by the court, that the defendants should be enjoined from further use of the plaintiff's patent, without first paying for the use of the same, or obtaining the plaintiff's consent, except as to the contract with the British government, which they should be allowed to complete, and further that the defendants should not be permitted to withdraw their offer as to the amount they were willing to pay for their use of the plaintiff's patent. *Smith v. Sharp Rifle Co.*, 3 Blatchf., 548.—INGERSOLL, J.; Ct., 1857.

19. G., the inventor and patentee of a new process for vulcanizing india-rubber, in 1844, gave to the Naugatuck I. R. Co. a license to use, with a few exceptions, his whole right, granted by such patent, upon the payment of a stipulated tariff. G. also covenanted not to license any other person to use such patent, but reserved the privilege to sell the right, under such patent, for any particular subject of manufacture for a sum in gross, the said company, however, to have the refusal to become the purchasers of said right at the stipulated sum offered by others, and any

## VIOLATION OF, AND ATTACHMENT ON.

such sale could not be made to any other parties, except on the refusal or neglect of the company for sixty days after the offer had been made to them, to become the purchasers, nor then, except the one-fourth part of the stipulated sum should be paid to such company. The place of manufacture of such company was at Naugatuck, Connecticut, but they had a place of business in the city of New York, where their treasurer was to be found, and who was the agent of the company. There was no regular time or place prescribed for the meeting of the directors of such company, who met sometimes at Hartford, sometimes at Naugatuck, and sometimes at New York. Subsequently, in 1847, G. had an offer for the purchase of the right, under his patent, to manufacture car springs. He gave notice of such offer to the treasurer of the said company, at his office in New York, and after the expiration of sixty days from such notice, sold such right to E. & C., for the agreed price, one-quarter of which was paid to said company, through their said treasurer, who received the same, with a knowledge on what account paid, and carried it to the credit of such company. E. & C. afterward assigned their right to the plaintiffs. The Naugatuck I. R. Co., about the same time, assigned all their right under the patent to the defendants, who, under it, commenced to manufacture and sell car springs. The plaintiffs filed their bill, asking an injunction to restrain such manufacture. The defendants insisted that their grantors, the Naugatuck I. R. Co., had never assented to the sale of G. to E. & C., and that G. had not performed the conditions which entitled him to make such sale. *N. E. Car Spring Co. v. Union Rub.*

*Co.*, 4 Blatchf., 6.—INGERSOLL, J.; N. Y., 1857.

20. *Held*, 1st. That the payment to the treasurer of such company, of the one-fourth of the sum received by such sale, and the receipt of it by him, and his applying it to the benefit of such company, was a legal and sufficient payment thereof to the company. *Ibid.*, 7.

2d. That such treasurer or agent was the proper person to receive notice from G. of any intended sale, and that G. was not bound to give personal notice to the directors, and that the agreement not requiring written notice, a verbal notice was sufficient, and that such notice could be given at any time. *Ibid.*, 7.

3d. That it was the duty of the directors of such company to inform themselves of the transactions of said company and the acts of their agent, and that the defence could not be set up that the corporation had no knowledge of the purpose for which said money, the one-fourth of proceeds, was paid, and were not bound by it, or that their agent had neglected to inform them in respect thereto. *Ibid.*, 8.

4th. That the transfer to E. & C. by G., was a legal and valid license or assignment, and that from and after its date the Naugatuck I. R. Co. had no right to use the patent for the purposes for which conveyed to E. & C., and that the plaintiffs were entitled to an injunction, as prayed for, to restrain the defendants. *Ibid.*, 9, 14.

#### 4. *Violation of, and Attachment on.*

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 con-



## VIOLATION OF, AND ATTACHMENT ON.

science or law, justify an attachment, and that the plaintiff should be charged with the costs of the application. *Sparkman v. Higgins*, 2 Blatchf., 30, 31.—BETTS, 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 it, 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 a person had been enjoined not to use a machine substantially like the one mentioned in the complainant's bill, *Held*, that he was guilty of a contempt, by the purchase and use of a machine which had been enjoined against in a neighboring circuit as being also substantially like the plaintiff's. *Woodworth v. Rogers*, 3 Wood. & Min., 142.—WOODBURY, J.; Mass., 1847.

4. He may, however, purge himself of such contempt by showing that he was ignorant of such injunction against the machine so used by him. *Ibid.*, 143.

5. An injunction in a patent case does not extend beyond what is the right of the plaintiff; unless there has been a violation of the right held by the plaintiff under his patent, there can have been no disobedience of the injunction. *Byam v. Eddy*, 2 Blatchf., 524.—PRENTISS, J.; Vt., 1853.

6. Where a defendant some months before the service of an injunction upon him, had made his bond, acknowledging the validity of the plaintiff's patent, and

of his right to all that was granted by it, *Held*, that such bond was no evidence of a breach of such injunction, any further than the recital in it that the defendant had infringed the patent, might have a tendency to establish such breach, and that such inference or presumption arising from it could be overcome by credible positive testimony proving no infringement. *Ibid.*, 527.

7. An injunction after it has been once served continues its action until withdrawn by order of the court. *McCormick v. Jerome*, 3 Blatchf., 487.—BETTS, J.; N. Y., 1856.

8. 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. *Ibid.*

9. After such a lapse of time the plaintiff should, before using the writ, have applied to the court for authority to do so. *Ibid.*, 488.

10. 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.

11. 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.

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

## IN RESPECT TO TRADE-MARKS.

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

13. 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.*, 20, 21.

14. The operation or restraints of an injunction cannot be extended beyond the precise limits indicated by it. *Ibid.*, 17.

15. Whether an injunction will embrace the servants, agents, workmen, and employees of the defendant, unless specially named therein; *query*. *Ibid.*, 18.

16. 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.

17. 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.

18. 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.

19. 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. IN RESPECT TO TRADE-MARKS.

See also EQUITY, C.; TRADE-MARKS, A.

1. If there is any question whether the acts of the defendant are a fraudulent interference with the rights of the plaintiff as to the good-will of his business, it should be left to a trial by jury in the ordinary course of law. An injunction will not be allowed in such a case. *Snowden v. Noah*, Hopk. Ch., 353.—WALWORTH, Chan.; N. Y., 1825.

2. Where a person intentionally pirates a trade-mark of another for the fraudulent purpose of inducing the public, or those dealing in the article, to believe it was in fact the article manufactured by the one originally using such mark, and with the intention of supplanting him in the good-will of his trade and business, a perpetual injunction will issue, restraining such use, and the party so using will also be liable to damages. *Taylor v. Carpenter*, 11 Paige, 298.—WALWORTH, Chan.; N. Y., 1844.

3. And it is wholly immaterial whether the simulated article is or is not of equal goodness and value with the real article. *Ibid.*, 298.

4. Where the complainants, subjects of Great Britain, were manufacturers of a certain thread, labelled "Taylor's Persian Thread," and the defendants in America manufactured and sold thread stamped, labelled, and enclosed in envelopes resembling those made use of by the complainants, *Held*, that it was an infringement of the rights of the complainants, for which equity would give relief by a perpetual injunction. *Taylor v. Carpenter*, 3 Story, 459, 463.—STORY, J.; Mass., 1844.

5. Equity will decree a perpetual injunction to restrain the use of another's trade-marks, and will decree an account as to damages, with the costs of suit. *Coats v. Holbrook*, 2 Sand. Ch., 595, 596.—SANDFORD, V. Chan.; N. Y., 1845.

6. A commission merchant, who sells on commission an article which he knows to be an imitation, is liable to suit, and will be enjoined from a further sale of the imitated article, and will be subjected to the costs of suit. *Ibid.*, 597, 598.

7. A party has a right to call upon a court of equity to restrain a defendant from fraudulently using the words and devices which he has previously taken for the purpose of distinguishing his property. *Taylor v. Carpenter* (in Court of Errors), 2 Sand. Ch., 612.—BEARDSLEY, J.; N. Y., 1846.

8. In cases of doubt, whether the complainant's sign or trade-mark has been actually pirated in such a manner as to be likely to deceive and impose upon others, the court will not grant or sustain an injunction, until the cause is

heard upon pleadings and proofs, or the complainant has established his right by an action at law. *Partridge v. Menck*, 2 Barb., Ch., 103.—WALWORTH, Chan.; N. Y., 1847.

9. But where the court see that the complainant's trade-marks are simulated in such a manner as probably to deceive his customers, or patrons of his trade or business, the piracy will be stopped at once by injunction. *Ibid.*, 103.

10. A court of equity in refusing to restrain the wrongdoer by injunction, would violate the principles upon which a large portion of its jurisdiction is founded. *Amoskeag Manuf. Co. v. Spear*, 2 Sand., S. C., 605.—DUER, J.; N. Y., 1849.

11. Equity will restrain a wrongdoer by injunction, on the grounds of protecting a party in the exercise of a legal right, the suppression of fraud, and preventing a mischief which otherwise might prove irreparable. *Ibid.*, 606.

12. An injunction to restrain the unauthorized use of a trade-mark should be granted with great caution, and is not to be exercised where the legal right is disputed and doubtful, or so as to create a monopoly unjust toward others or injurious to the public. *Ibid.*, 606.

13. An injunction ought to be granted whenever the design—whether apparent or proved—of a person who imitates a trade-mark, is to impose his own goods upon the public as those of the owner of the mark, and the imitation is such that the success of the design is a probable or even possible circumstance, and must be granted whenever the public is in fact misled, whether intentionally or otherwise, by the imitation. *Ibid.*, 609.

14. But an injunction need not necessarily be granted whenever there exists

such a resemblance between trade-marks as may induce a belief that they belong to and designate the goods of the same trader or manufacturer. The resemblance must amount to a false representation, express or implied, designed or accidental. *Ibid.*, 609.

15. A complainant cannot claim the protection of a court of equity to restrain a fraudulent use of his trade-mark, on the ground either of having an exclusive right as an inventor in the thing manufactured by him, or an exclusive right, as author, in his label. *Coffeen v. Brunton*, 4 McLean, 517.—McLEAN, J.; Ind., 1849.

16. But relief by way of injunction is granted because of the use of a mark or label, which recommends an article to the public to the injury of the complainant; the fraud arises from the false representation that the article is the same. *Ibid.*, 517.

17. An intentional fraud is not necessary to entitle a plaintiff to protection for a wrongful use of his trade-mark; but where the same mark or label is used which recommends the article to the public by the established reputation of another, who sells a similar article, and the spurious cannot be detected from the genuine one, an injunction will be granted, although there was no intentional fraud. *Ibid.*, 519.

18. The plaintiff was a manufacturer of steel pens, which were put up for sale in boxes, the labels on which, and the number they bore, indicated the quality of the pens. The defendant removed from the boxes containing inferior pens the label properly belonging on such boxes, and put upon them the label and number designating a better and higher priced article, and sold them as the superior article; *Held*,

that such acts were a fraud upon the public and the plaintiff, and being a fraud coupled with damage, the court would restrain the defendant. *Gillott v. Kettle*, 3 Duer, 626, 627.—BOSWORTH, J.; N. Y., 1854.

19. The remedy by injunction is invariably granted when the nature of the injury is such that a preventive remedy is indispensable, and should be permanent. *Ibid.*, 627.

20. In such cases, if the injured party is obliged to seek redress by actions to recover damages, there will be no end to litigation, and certain and adequate relief would be unattainable. *Ibid.*, 627.

21. Courts of equity do not interfere by injunction in cases of violation of trade-marks, except in aid of a legal right; if the fact of the plaintiffs' right in a trade-mark, or the defendant's interference with it, be doubtful, the plaintiffs will be left to establish their title at law. *Merrimack Manuf. Co. v. Garner*, 4 E. D. Smith's Rep., 390.—DALY, J.; N. Y., 1855.

22. It may be that a party would not be permitted to manufacture and vend an inferior article, and put it forth to the public as of the same quality and kind as that of another; but whether he could be restrained by injunction is doubtful. *Ibid.*, 392.

23. Where the plaintiffs' trade-mark consisted of the words "Merrimack Prints, Fast Colors, Lowell, Mass.," enclosed in a floral wreath, and the defendants marked their goods "English Free Trade, Merrimack Style, warranted Fast Colors," and also enclosed in a floral wreath, but lighter and more open than in the other, *Held*, on a motion for an injunction, that though there was an undoubted resemblance between the

two, that the court could not say that the ordinary mass of purchasers would be deceived by the defendants' label, and that an injunction ought not to be granted in the first instance; but the parties should be left to try the question of actual imitation. *Ibid.*, 392, 393.

24. Where an injunction is asked to restrain a defendant from selling articles with a particular trade-mark, the right to use which is claimed by the plaintiff, it must appear that the defendant is seeking to sell the articles manufactured by *him* as those manufactured by the person who established the original trade-mark, and the plaintiff's right to use the trade-mark must be clear. *Samuel v. Berger*, 24 Barb., S. C., 164.—DAVIES, J.; N. Y., 1856.

25. An injunction is never to be granted in the first instance, if the exclusive title of the plaintiff is denied—unless upon grounds clearly frivolous—or if it is disputed. *Ibid.*, 165.

26. The plaintiff, a manufacturer of watches, claimed the right, as assignee, to stamp his watches with the name of one Iberson Brindle. The defendants sold watches manufactured by said Brindle himself, and stamped with his name, *Held*, that the plaintiff was not entitled to an injunction to restrain the defendants from selling the original article, and thus protect the plaintiffs in selling the simulated. *Ibid.*, 165.

27. Where the power of a court of equity has been invoked, it has been to restrain the defendant from making his goods and selling them as and for the goods manufactured by the plaintiff, on the ground that such a fraud was an injury to the plaintiff, and tending to mislead and deceive the public. *Ibid.*, 165.

28. It is well established that a court will grant an injunction against the use

by one tradesman of the trade-mark of another; and such protection will be extended to enterprises undertaken for the purpose of affording amusement or recreation to the public. *Christy v. Murphy*, 12 How. Pr., 77, 78.—CLERKE, J.; N. Y., 1856.

29. The plaintiff organized a band of performers of negro minstrelsy, and named them, after himself, "Christy's Minstrels;" *Held*, that he was entitled to the exclusive use of that name, and that the assumption and use of that name by others without a license would be perpetually restrained by injunction. *Ibid.*, 78, 79.

30. A tradesman, to bring his privilege of using a particular mark under the protection of equity, is not bound to prove that it has been copied in every particular by another. It is enough for him to show that the representations employed bear such resemblance to his as to be calculated to mislead the public generally, who are purchasers of the article, and to make it pass with them for the article sold by him. *Walton v. Crawley*, 3 Blatchf., 447.—BETTS, J.; N. Y., 1856.

31. If the *indicia* or signs used tend to that result, the party aggrieved will be allowed an injunction, staying the aggression until the merits of the case can be ascertained. *Ibid.*, 447.

32. The mere affidavit of the defendant, without a formal answer, denying that the trade-mark claimed was the original device of the plaintiff's assignor, or was first adopted by him, it seems will not be sufficient to bar the equity of the plaintiff, arising from long undisturbed possession and use of such trade-mark, and particularly if such right had been corroborated by after acts and declarations of the defendants. *Ibid.*, 447.

33. The principles of the rules upon which injunctions are granted, to suppress violations of trade-marks, and the extent to which the relief is carried, are discussed and settled in 2 *Kent. Com.*, 2d ed., 473 and notes—*Eden on Injunctions*, by Waterman, 271 and notes. 2 Story, Eq., 951. *Ibid.*, 448.

34. A label or trade-mark, which, from its general resemblance to that of the plaintiff, is calculated to mislead the public, by inducing the belief that the articles to which it is affixed are in reality prepared or manufactured by the plaintiff, and where the imitation is so close, minute, and exact, as to show that it was framed with such design, may, in a proper case, be restrained by injunction. *Petridge v. Wells*, 13 How. Pr., 386, 387.—DUER, J.; N. Y., 1857.

35. A variation must be regarded as immaterial which it requires a close inspection to detect, and which can scarcely be said to diminish the effect of the *fac-simile* which the simulated label in all other respects is found to exhibit. *Ibid.*, 387.

36. But if a plaintiff comes into a court of equity to claim relief against the fraud of another, he must be free himself from the imputation. *Ibid.*, 389.

37. Where the plaintiffs were engaged in manufacturing and selling an article called the "Balm of a Thousand Flowers," and which they represented as "the very balm and extract of healing blossoms," but which in fact was only a liquid soap, and sought to restrain the defendants from doing the same thing, *Held*, that the name was intended to deceive the public, and that the plaintiff could not be protected in such a privilege, and that the court would not enjoin the defendant. *Ibid.*, 390-393.

38. It is well settled that where a

party uses his trade-mark for the purpose of palming off upon the public articles of his own manufacture or composition for those of another, who has obtained celebrity or notoriety, the court will not protect him in such use. *Petridge v. Merchant*, 4 Abb. Pr., 157.—HOFFMAN, J.; N. Y., 1857.

39. But the conduct of the person infringing such a trade-mark, has a material influence. If he has deliberately, without any previous connection with the particular business, but simply to break in upon the trade and profit by the notoriety obtained by another, adopted his emblems and appellations, the question should be judged of solely as between the immediate parties, and the public should be left to its own guardianship; when such is the case, an injunction should be granted to restrain the violation. *Ibid.*, 157.

40. Where the title of the plaintiff to appropriate a particular name to himself is not clear, but considerable doubt exists respecting it, an injunction should not be granted in the first instance; but the defendants may be required to execute a bond to keep and render an account of their sales. *Ibid.*, 161.

41. An imitation of a trade-mark, which will be enjoined against, embraces not merely names, but the manner of putting up the articles; and even including the wrappers and envelopes employed by the person entitled to the trade-mark. *Williams v. Johnson*, 2 Bosworth, 7.—WOODRUFF, J.; N. Y., 1857.

42. Whether the name given to an article can or cannot be made the subject of protection as a trade-mark, the court will enjoin and restrain the use thereof in combination with labels, handbills, or devices, in imitation of

those used by another, and calculated to deceive the public, or create the belief that the simulated article sold is that made or sold by those entitled to such labels and devices. *Ibid.*, 9.

43. An injunction will be granted, at the suit of a former partner, against the other partner, restraining the continued use of the signs containing the old firm name, without removing the name of the retiring partner, or making alteration or addition, as to give notice of the change in the firm. *Peterson v. Humphrey*, 4 Abb. Pr., 395.—MITCHELL, J.; N. Y., 1857.

44. The old signs would be holding out to the world that the old partnership was continued, and might make the retired partner as a continuing partner, if he sanctioned its continuance. *Ibid.*, 395.

45. A party will be restrained from using a trade-mark which had been previously used by another, and from any imitation of it with only colorable differences. *Clark v. Clark*, 25 Barb., S. C., 79.—MITCHELL, J.; N. Y., 1857.

46. Any false name that is assumed in imitation of a prior true name, is in violation of the right of the holders of the latter, and the use of it should be restrained by injunction. *Brooklyn W. L. Co. v. Masury*, 25 Barb., S. C., 418.—MITCHELL, J.; N. Y., 1857.

47. The plaintiffs were, and had been for more than twenty years, manufacturers of white lead, and marked their kegs "Brooklyn White Lead Company," or "Co." The defendants subsequently established the same business, and marked their kegs "Brooklyn White Lead and Zinc Company." *Held*, that this was an imitation of plaintiffs' mark, with only a colorable difference, and was adopted to make

their paint pass as the plaintiffs'; and that the defendants should be restrained from using the words *Company* or *Co.*, but that they could continue to use the title "Brooklyn White Lead & Zinc." *Ibid.*, 418.

48. Where the defendants connected themselves with the plaintiffs in the business of manufacturing, advertising and selling pills by a particular name, "Dr. Morse's Indian Root Pills," and induced the plaintiffs to expend large sums of money in advertising, &c., such pills, and then, without notice, severed their connection with them, and set up the same business for themselves, *Held*, that such defendants would be restrained from using the same name or designation in selling such pills, as was used by the plaintiffs, and from using any labels or marks so much like those used by the plaintiffs, as to be likely to be easily mistaken for them. *Comstock v. Moore*, 18 How., Pr., 425, 426.—SUTHERLAND, J.; N. Y., 1860.

49. A court of equity will not interfere to protect a party in the use of trade-marks which are employed to deceive the public, and to deceive them by fraudulent representations contained in the labels and devices, which are claimed to constitute wholly or in part such trade-marks. *Hobbs v. Francais*, 19 How. Pr. Rep., 571.—BOSWORTH, J.; N. Y., 1860.

50. Where the plaintiff manufactured a skin powder called "Meen Fun," which was represented as made in London, and "Patronized by Her Majesty the Queen," when in fact it was made in New York; and the defendants manufactured a like article, representing it as "Patronized by Her Majesty the Empress," *Held*, that the court would not grant an injunction; not out of any

WHEN ORDERED.

BEARING OF, ON INFRINGEMENT, ETC.

regard for the defendant, but not to assist in deceiving the public. *Ibid.*, 571.

51. Where the plaintiff sold to the defendant's assignor his lease of the premises known as "Howe's Bakery," together with the stock-in-trade, and the "good-will of the business of baking, now or heretofore carried on by me, in the city of New York." *Held*, that the plaintiff was entitled to an injunction to restrain the defendant from designating his bakery establishment as "Howe's Bakery," and from otherwise using the name of *Howe* in his business, so as to induce the public to believe that the business carried on by him was carried on by the plaintiff. *Howe v. Searing*, 19 How. Pr. 25.—HOFFMAN, J.; Sup. Ct., N. Y., 1860.

### INSPECTION OF MACHINES.

1. On a bill filed for an infringement of a patent and for an injunction, if the defendants refuse to allow the plaintiffs to examine the machines used by them, the court will order an inspection of them as to whether they are an infringement upon the plaintiff's invention. *Sloat v. Patten*, 24 Jour. Fr. Inst., 3d Ser., 23.—KANE, J.; Pa., 1852.

2. In this case the court ordered the defendants to run their machines, in the presence of some expert, and that such expert be allowed to bring into court specimens of the work produced. *Ibid.*, 23.

### INTENT.

A. PATENTABILITY OF..... 415

B. BEARING OF, AS TO ABANDONMENT, INFRINGEMENT, ETC..... 415

#### A. PATENTABILITY OF.

See PURPOSE.

B. BEARING OF, AS TO ABANDONMENT, INFRINGEMENT, ETC.

1. The intent with which a work is reprinted, cannot be taken into consideration, as the act of reprinting is prohibited by the statute. *Nichols v. Ruggles*, 3 Day, 158.—CURIAM; Ct., 1808.

2. To constitute an infringement the making must be with an intent to infringe the patent-right, and deprive the owner of the lawful reward of his discovery. *Sawin v. Guild*, 1 Gall., 487.—STORY, J.; Mass., 1813.

3. No man is to be permitted to lie by for years, and then take out a patent. If he has been practising his invention with a view to improve it, that will not prejudice. But it should always be a question for the jury, what was the intent of the delay of the patent, and whether the allowing the invention to be used without a patent should not be considered an abandonment. *Morris v. Huntington*, 1 Paine, 354.—THOMPSON, J.; N. Y., 1824.

4. Though the inventor may not have intended to give the benefits of his discovery to the public, and may have supposed that by giving permission to a particular individual to manufacture the thing, he could not be presumed to have given his invention to the public, it matters not. It is not a question of intention, but of legal inference, resulting from the conduct of the inventor, and affecting the interests



of the public. *Pennock v. Dialogue*, 4 Wash., 544.—WASHINGTON, J.; Pa., 1825.

5. The question of abandonment does not turn upon the intention of the inventor. Whatever may be his intention, if he suffers his invention to go into public use, through any means whatever, without an immediate assertion of his right, he is not entitled to a patent, nor will a patent obtained under such circumstances protect his right. *Shaw v. Cooper*, 7 Pet., 323.—MCLEAN, J.; Sup. Ct., 1833.

6. Intention cannot be taken into view in reference to an infringement of a copyright; if a copyright has been invaded, whether the party knew it was copyrighted or not, he is liable to the penalty. *Millett v. Snowden*, 1 West. Law Jour., 240.—BERTS, J.; N. Y., 1843.

7. The intent not to be guilty of piracy is not material, if much has been actually copied, and the new work is a mere substitute. But if this be doubtful, the intent not to pilfer from another, colorably or otherwise, for the substantial parts of the new work, may be important. *Webb v. Powers*, 2 Wood. & Minn., 524.—WOODBURY, J.; Mass., 1847.

8. The intention with which extracts from a work are made, has no bearing upon the question of violation. The inquiry is, what effect must the extracts have upon the original work. If they render it less valuable by superseding its use, in any degree, the right of the author is infringed; and it can be of no importance to know with what intent this was done. *Story's Exrs. v. Holcombe*, 4 McLean, 310.—MCLEAN, J.; Ohio, 1847.

9. The question of infringement is

one irrespective of *motive*. The defendant may have infringed without intending, or even knowing it; but he is not on that account the less the infringer. *Parker v. Hulme*, 7 West. Law Jour., 426.—KANE, J.; Pa., 1849.

10. An intentional fraud is not necessary to entitle a plaintiff to protection for a wrongful use of his trade-mark. *Coffeen v. Brunton*, 4 McLean, 519.—MCLEAN, J.; Ind., 1849.

11. The intent not to injure in the infringement of a patent, as the making of a machine by a person ignorant of the existence of a patent, never exonerates from all damages for the actual injury or encroachment, though it may mitigate them. *Hogg v. Emerson*, 11 How., 608.—WOODBURY, J.; Sup. Ct., 1850.

12. The mere use or sale of the invention, however, within the two years, will not alone or of itself work an abandonment. The use or sale must be accompanied by some declarations or acts going to establish an intention on the part of the inventor to give to the public the benefit of the improvement. *Pitts v. Hall*, 2 Blatchf., 237.—NELSON, J.; N. Y., 1851.

13. The mere expression of an intention not to take out a patent, or the mere declaration of an intention to dedicate an invention to the public, cannot be regarded as equivalent to an actual dedication. *Ibid.*, 238.

14. The use by a defendant of a trade-mark belonging to the plaintiff, even without fraud, renders him liable; it matters not whether such use be by fraud or mistake. *Davis v. Kendall*, 2 Durfee, R. I., 570.—GREENE, Ch. J.; R. I., 1853.

15. If a machine is constructed so as to conform in *all* respects to the de-

WHEN ARISE; NATURE OF.

scription in a patent, except as to one particular, or as to one motion and effect, yet is so constructed and *intended* as to obtain that motion or effect in the usage of the machine by the action or wearing of the parts, and it is so obtained, it is a violation of the patent, a piracy of the principle. If the *principle* is worth any thing, no mere evasion should be countenanced. Perfect identity is not required to demonstrate an infringement of principle. *Page v. Ferry*, 1 Fisher, 311.—WILKINS, J.; Mich., 1857.

16. The right of a plaintiff to maintain an action for a violation of a trade-mark does not depend upon the intention of the defendant to appropriate such trade-mark (violate it), it is enough if it is made to appear that he has done so. *Dale v. Smithson*, 12 Abb. Pr., 238.—HILTON, J.; N. Y., 1861.

INTERFERENCES ON APPLICATIONS FOR PATENTS.

A. WHEN ARISE, AND GENERAL NATURE OF..... 417  
 B. PRACTICE IN CASES OF, AND EVIDENCE IN..... 418

A. WHEN ARISE, AND GENERAL NATURE OF.

See also, as bearing on this title, EQUIVALENTS; INVENTION, E.

1. A filed a description of an alleged invention in 1802, as required by § 3 of the act of 1793, and took no further step till 1814. In that year B made application for a patent for the same invention, without knowledge of A's invention; *Held*, that there was no limitation of time within which a patent

must be taken out, after specification filed, and that the facts made a case of interference, to be arbitrated under § 9 of the act of 1793. *Anon.*, 5 Opin., 701.—RUSH, Atty. Gen.; 1814.

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

3. The permission to withdraw an application in such a case, will be granted or not, as the Commissioner may be satisfied. The matter is in his discretion, to be exercised when in his opinion the spirit of the law demands it. *Ibid.*, 224.

4. The question of priority of right of invention necessarily implies *interference*. *Bain v. Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

5. 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.*

6. A patentable improvement is not an interference. *Ibid.*

7. There can be no interference between applications, unless there is a substantial identity of the things for which a patent is sought. If there are *material* and *substantial* differences between the two things, there can be no identity, and no interference. *Tyson v. Rankin*, MS. (App. Cas.)—MORSELL, J.; 1853.

## PRACTICE IN CASES OF.

8. Where two separate applications for patents for improvements upon the same thing were generally similar in form, and in some respects nearly identical in construction, but the principal object and design of each was unlike that of the other, and the end to be attained or effect intended was wholly different, *Held*, notwithstanding their general similarity, that the two inventions were not substantially the same, and that there was no interference between them. *O'Reilly v. Smith*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

9. An interference will lie between two applications, if the same invention is substantially described in the two applications or specifications, though the *claim* in one case may not be as broad as the specification. The oath as to invention is to be considered as extending to *all* described in the schedule. *King v. Gedney*, MS. (App. Cas.)—MORSELL, J.; D. C., 1856.

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

11. An interference will be declared, between an existing patent, and an application for a *reissue*, as well as an *original* application. *Snowden v. Pearce*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

**B. PRACTICE IN CASES OF.**

As to depositions in cases of interference, see EVIDENCE, C. 2.

As to declarations of parties as to invention, see EVIDENCE, D. and E.

As to competency of witnesses, and of assignor of invention, see EVIDENCE, G.

1. The rule established by the Commissioner of Patents, under § 12 of the act of 1839, to be used in contested cases, are as binding upon the Commissioner as upon the contesting parties, and while they remain unabrogated, are as binding as the law itself, and the Commissioner cannot dispense with them at pleasure. *Arnold v. Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. There is nothing in the laws relating to the Patent Office, or in the rules adopted by the Commissioner, to prevent him from postponing the hearing of an interference, if, in his opinion the justice of the case should require it, and especially for the correcting of an irregularity in matters of form. *Smith v. Flickenger*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1843.

3. Where, therefore, depositions in an interference had been correctly taken, but had not been transmitted in the form required, so that they could be *considered*, by the Commissioner, *Held*, that the Commissioner had a right to postpone the hearing to allow the parties to cure the informality, if he should deem such action necessary to further the ends of justice. *Ibid.*

4. Affidavits on which to move for an enlargement of the time to take testimony in an interference, on the ground that the moving party could not obtain the attendance of his witnesses at the time appointed to take their examination, should state the names, competency, and materiality of the witnesses to be examined. *O'Reilly v. Smith*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

5. Such an application is in the discretion of the Commissioner, and it will

be presumed that his decision on it has been soundly exercised. *Ibid.*

6. Where an interference has been declared between certain parties, and testimony taken, and then another application is made by another party and he is made a party to the interference, but the subject matter of all the applications is the same, the testimony taken on the first interference may be used on the second without being retaken. *Carter v. Carter*, MS. (App.) Cas.—MORSELL, J.; D. C., 1855.

7. In cases of interference it is not enough that the appellant shows that the opposite party is not entitled to a patent, but he must show that he himself has a right to it. *Lilly v. Kelsey*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

8. The proceedings in contested cases in the Patent Office, have no resemblance to trials at law—a party cannot be compelled to examine all his witnesses in chief before he closes his opening examination. *Spear v. Abbott*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859.

9. It seems that testimony taken on a former interference is admissible on a second one, and this though the second interference is declared after an assignment to another party. *Eames v. Richards*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

10. A second interference is only a rehearing of the same case. *Ibid.*

11. After the closing the time for taking testimony in an interference, the Commissioner of Patents may admit another party to the interference, and open the further taking of testimony. *Laidley v. James*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

## INTRODUCER OF INVENTION.

1. The power of Congress under § 8 of the constitution in securing to authors and inventors the exclusive right to their respective writings and discoveries, is limited to authors and inventors only. Such clause, therefore, never can admit of so extensive a construction as to prohibit the respective states from exercising the power of securing to persons introducing useful inventions (without being the authors and inventors), for exclusive benefit of such inventions for a limited period; a power no less instrumental in promoting the progress of science and the useful arts. *Livingston & Fulton v. Van Ingen*, 9 John., 560, 566, 582.—YATES, THOMPSON, KENT, JJ.; N. Y., 1812.

2. This power is not granted to Congress by the clause as to authors and inventors, and as it is not taken away by any other part of the constitution, it must of course be retained by the respective states, to be exercised by them until it interferes with the laws of the United States, passed to secure the author and inventor. *Ibid.*, 561, 566, 582.

3. *Held*, therefore, that the acts of 1798, 1803, 1807, and 1808, granting to *Livingston & Fulton as possessors* of a mode of applying the steam engine to propel boats, the exclusive right to navigate the waters of the state of New York, were constitutional; and that they were entitled to an injunction against those infringing those rights. *Ibid.*, 562, 566.

4. There cannot be any aid or encouragement, by means of an exclusive right, under the laws of the United States, to importers from abroad of any useful invention or improvement. Such

persons must resort to the patronage of the state governments in which the power to reward their expensive and hazardous exertions was originally vested, and in which it still remains. *Ibid.*, 583.

INVENTION.

A. WHAT IS; WHEN PATENTABLE. . . . . 420  
 B. PERFECTING, OR REDUCING TO PRACTICE 424  
 C. ORIGINALITY AND PRIORITY OF. . . . . 429  
 D. NOVELTY AND UTILITY OF. . . . . 429  
 E. IDENTITY OF. . . . . 435

A. WHAT IS; WHEN PATENTABLE.

See also, COLORABLE VARIATIONS; COMBINATION; COMPOSITION OF MATTER; DISCOVERY; DOUBLE USE; EFFECT; FORM; IMPROVEMENTS; INVENTOR, A.; MACHINES; MANUFACTURE, ARTICLE OF; MATERIAL; MECHANIC, SKILL OF; NEW APPLICATION; PATENT, D.; PRINCIPLE; PURPOSE; SUGGESTIONS.

As to evidence in respect to invention, see EVIDENCE, H. 4.

1. Whether the mere substitution of one material for another be an invention within the sense of the patent law, may well be questioned; but there being room for doubt, a patent was recommended. *Seely's Case*, 2 Opin., 52.—WIRT, Atty. Gen.; 1827.

2. 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.

3. 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.

4. A change in the position of the operating powers, or in the thing on which the effect is produced, is of no importance. Such a modification does not rise to the dignity of an invention. *Brooks v. Bicknell*, 3 McLean, 262.—MCLEAN, J.; Ohio, 1843.

5. The substitution of a known mechanical equivalent, is not an invention within the patent law. *Cochrane v. Waterman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1844.

6. The application of the endless screw and lever, which is a common mechanical power, to a machine to which it had never before been applied—as to the periphery of a quadrant to move and hold the rudder of a vessel—would not be an invention, although it might make the machine better. *Ibid.*

7. The substitution of one mechanical power for another, as a wheel and axle instead of a screw, is a mere formal alteration and not an invention. *Blanchard's Gun-Stock Turning Co. v. Warner*, 1 Blatchf., 278.—NELSON, J.; Ct., 1846.

8. The arranging a number of rollers,

acting in pairs, for a particular purpose, may be patentable, though a single pair could not be. *Knight v. Gavit*, Mir. Pat. Off., 132.—KANE, J.; Pa.; 1846. [Cited in *Parker v. Hulme*, 7 West. Law Jour., 422.]

9. In mechanics, inventions consist not in the discovery of new principles, but in new combinations 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.

10. A duplication of parts (as the arrangement of wheels in pairs on a horizontal shaft, in a water-wheel, a single wheel having before been used), if it produce a new and useful result, is invention and may be the subject of a patent. *Parker v. Hulme*, 7 West. Law Jour., 421.—KANE, J.; Pa., 1849.

11. Perfecting an invention by superior skill in the mechanical arrangement and construction of the parts, is but the skill of the mechanic, not the genius of an inventor. *Parkhurst v. Kinsman*, 1 Blatchf., 497.—NELSON, J.; N. Y., 1849.

12. Invention, as it respects machines, is any *new arrangement or combination* of machinery, whether of old or new parts or materials, producing in its arrangement and combination a useful result. *McCormick v. Seymour*, MS.—NELSON, J.; N. Y., 1851.

13. If the same general plan of a machine be taken and applied for the same purpose, although the mode of construction may be varied, it will be substantially the same; and is only what is called a mechanical equivalent, or an

other way of doing the same thing, by means of mechanical skill, which, however meritorious and creditable, is not an invention. *McCormick v. Seymour*, 2 Blatchf., 246, 248.—NELSON, J.; N. Y., 1851.

14. The doctrine of the use of mechanical equivalents is not confined to those elements which are strictly known as such in the science of mechanics. There are different well-known devices, any one of which may be adapted to effect a given result, according to the judgment of the constructor. The mere substitution of one of these for another does not belong to the subject of invention, but of construction. *Foster v. Moore*, 1 Curt., 291.—CURTIS, J.; Mass., 1852.

15. 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.

16. 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.

17. 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.

18. It is a well settled principle of law that the mere change in the form of machinery (unless a particular form is specified as the means by which the effect described is produced), or an alteration in some of its unessential parts, or in the use of known equivalent powers, not varying essentially the machine, or its mode of operation or organization, will not make the machine a new invention. *O'Rielly v. Morse*, 15 How., 123.—TANEY, Ch. J.; Sup. Ct., 1853.

19. The substitution of one mechanical equivalent, as a rod in place of an endless chain, to accomplish a like purpose and with like effect, is not the subject of a patent. *Spain v. Gamble*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

20. Where the utility of a change, and the consequences resulting therefrom (in a machine) are such as to show that the inventive faculty has been exercised, though in point of fact the change was the result of accident, the requisite test of a sufficient amount of invention may exist. *Everson & Ricard, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

21. Whether an invention is patentable is a mixed question of law and fact, and should not in ordinary cases be disposed of on demurrer, and without the intervention of a jury. *Teese v. Phelps*, 1 McAllis., 19.—MCALLISTER, J.; Cal., 1855.

22. If the invention required no more skill or ingenuity than that possessed by an ordinary mechanic skilled in the business, there is an absence of inventive faculty, and the patent is invalid. *Ibid.*, 52.

23. An accidental combination of parts, or invention, but under such circumstances that the public obtained no

knowledge of the principle or result or effect of such combination, and the parties themselves who made it not understanding such principle, does not make invention. The invention is not made until the parties contriving, or those observing, discovered how it could be made available for its particular purpose. *Ransom v. Mayor, &c.*, 1 Fisher, 265.—HALL, J.; N. Y., 1856.

24. Before a patent can issue, the thing patented must appear to be of such a character as to involve or require "invention" for its production, require the exercise of the genius of an inventor as contradistinguished from the ordinary skill of a mechanic in construction. *Ibid.*, 258.

25. If, with the knowledge had by the public, it required no invention, but simply the ordinary skill and ingenuity of the mechanic to produce the result effected; in other words, if the inventive faculty was not put into action, and was not needed to produce the alleged invention, then the patent is void, because there is no invention to be secured to the patentees. *Ibid.*, 264.

26. Invention, in the sense of the patent law, is the finding out, contriving, devising, or creating something new and useful, which did not exist before, by an operation of the intellect. *Ibid.*, 265.

27. The right to an invention dates from the time of discovery, and the patentee is secure with his patent, if his machine or manufacture was not in public use at the time he made his application. *Wintermute v. Redington*, 1 Fisher, 244.—WILSON, J.; Ohio, 1856.

28. 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.

29. 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.

30. It is not important whether an invention required much or little thought, study, or experiment to make it, or much or little expense to devise and execute it. If it is new and useful, it is not a legitimate subject of inquiry at what cost to the patentee it was made. *Forbush v. Cook*, 10 Mo. Law Rep., 667.—CURTIS, J.; Mass., 1857.

31. Whenever the change in the arrangement of a machine or invention, and its consequences taken together are considerable, there is sufficiency of invention to support a patent. When the change, *however minute*, leads to consequences and results of great practical utility, this condition is satisfied—but not when the *consequences* are inconsiderable, and the change also inconsiderable. *Walsh, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

32. 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.

33. The remedying of defects in a machine by practical men is the work of the mechanic, of the intelligent operator, and has no connection with invention or discovery. *Winans v. Danforth*, MS.—NELSON, J.; N. Y., 1860.

34. An experiment as to the production of a machine, which was unsatisfactory and had been abandoned, is not such an invention as entitles a person to the benefit of the patent laws, and such abandonment removes all impediment in the way of any future inventor who may follow in the same line. *Ibid.*

35. The enlargement of the organization of a machine, compared with a former one, does not afford any ground in the sense of the patent law for a patent. *Phillips v. Page*, 21 How., 167.—NELSON, J.; Sup. Ct., 1860.

36. The manner of folding and fastening the sides of an envelope to the back, or the back down to the sides, is not a patentable subject. There is no exercise of the inventive faculty—it is a mere matter of neatness and finish. *Arnold v. Potter*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

37. It is difficult to determine where ordinary mechanical skill ends, and invention begins. The best *practical principle* is, that where the combination of known elements produces new and useful results to the public, not before attained, then the person who discovers and applies the combination is an inventor, within the true intent and meaning of the patent laws. *Smith, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.



**B. PERFECTING, OR REDUCING TO PRACTICE; WHAT IS; NECESSITY OF; DUE DILIGENCE IN.**

1. The first inventor is entitled to the benefits of his invention if he reduce it to practice and obtain a patent therefor, and a subsequent inventor cannot, by obtaining a patent, oust the first inventor of his right, or maintain an action against him. *Woodcock v. Parker*, 1 Gall., 439.—STORY, J.; Mass., 1813.

2. Until an invention is perfected and adapted to use, it is not patentable. *Reed v. Cutter*, 1 Story, 599.—STORY, J.; Mass., 1841.

3. An imperfect and incomplete invention, resting in mere theory or in intellectual notion, or in uncertain experiments, and not actually reduced to practice, and embodied in some distinct machinery, apparatus, manufacture or composition of matter, is not, and indeed cannot be patentable under the patent laws. *Ibid.*, 599.

4. He is the first inventor in the sense of the patent act, and entitled to a patent for his invention, who has first perfected and adapted the same to use; and until the invention is so perfected and adapted to use, it is not patentable. *Ibid.*, 599.

5. In a race of diligence between two independent inventors, he who first reduces his invention to a fixed, positive, and practical form, would seem to be entitled to a priority of right to a patent therefor. *Ibid.*, 599, 600.

6. An inventor who has first actually perfected his invention, will not be deemed to have surreptitiously or unjustly obtained a patent for that which was, in fact, first invented by another, unless the latter was at the time using reason-

able diligence in adapting and perfecting the same. *Ibid.*, 599.

7. None of the patent laws require that an invention should be in use, or reduced to actual practice before the issuing of a patent, otherwise than by a model, drawings, and specification, containing a written description of the invention, and how made and used. *Hildreth v. Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

8. The right of a patentee or applicant does not depend upon the fact of the invention being reduced to actual practice, except in the case of an alien patentee failing to put within eighteen months his invention on sale. *Ibid.*

9. The expression "reduced to practice" does not import bringing an invention into use, but means reducing it into such form that it may be used, so as not to be a mere theory. *Ibid.*

10. The doctrine that he who first communicates an invention to the public, and puts it in practice, *and he only*, is entitled to a patent, is not supported to its fullest extent by the cases, and does not apply to a first inventor who is using reasonable diligence in adapting and perfecting his invention, whose right is saved by § 15 of the act of 1836. *Ibid.*

11. Whoever first perfects a machine and makes it capable of useful operation is entitled to a patent, and is the real inventor, though others may have previously had the idea, and made some experiments toward putting it in practice. *Washburn v. Gould*, 3 Story, 133.—STORY, J.; Mass., 1844.

12. *Semble*, that he would be entitled to a patent, although the antecedent experiments of others were known to and used by him in perfecting his machine. *Ibid.*, 133.

13. Reducing an invention to practice differs from bringing it into use. There is no law requiring an applicant to reduce his invention to actual use before he can obtain a patent. On the other hand, the use of an invention before obtaining a patent is one of the reasons for refusing it. *Perry v. Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

14. An inventor has reduced his invention to practice when he has so described it on paper, with such drawings and model as to enable any person *skilled in the art* to make and use it. *Ibid.*

15. He must show his invention to be practicable, and the manner in which it may be used, but he need not do this until his invention is perfected, and he is ready to apply for a patent. He may have conceived the idea years ago, but is not obliged to furnish drawings or model until he makes his application. *Ibid.*

16. Whoever finally perfects a machine, and renders it capable of useful operation, is entitled to a patent, though others may have had the idea and made experiments toward putting it into practice—and although all the component parts may have been known under a different combination, or used for a different purpose. *Ball v. Murry*, 10 Penn., 112.—ROGERS, J.; Sup. Ct., Pa., 1848.

17. It is not enough to conceive the idea of a new manufacture, or of a new and useful instrument. The new idea must be reduced to some practical use before it can become the subject of a patent, or be set up and relied on to defeat a patent. An abortive experiment is not sufficient. *Many v. Jagger*, 1 Blatchf., 383.—NELSON, J.; N. Y., 1848.

18. The idea or suggestion of an ap-

plication of a principle to produce an effect, is not sufficient to entitle a party to a patent; but the one who first reduces the idea to practical application and use is entitled to a patent. *Foote v. Silsby*, 1 Blatchf., 464.—NELSON, J.; N. Y., 1849.

19. To constitute a prior invention, the party alleged to have produced it must have proceeded so far as to have reduced his idea to practice, and embodied it in some distinct form. Crude and imperfect experiments, equivocal in their results, and then given up for years, cannot prevail against an original inventor, who has perfected his improvement and obtained a patent. *Parkhurst v. Kinsman*, 1 Blatchf., 494.—NELSON, J.; N. Y., 1849.

20. The law allows an inventor a reasonable time to perfect his invention, and ascertain its utility before, in order to secure to himself its exclusive use, it obliges him to take out a patent. It is the duty of the jury to take into consideration the nature of the invention and the circumstances of the case. *Winnans v. Schneck & Troy R.R.*, 2 Blatchf., 291, 300.—NELSON, CONKLING, JJ.; N. Y., 1851.

21. In the case of an improvement in the construction of cars for railroads, *Held*, that such experiments could not be made except by putting the car into the service of lines of railroads, and that the use of cars, for such purpose, from 1831 to 1834 did not render the patent obtained in 1834 void. *Ibid.*, 291.

22. But if an inventor unnecessarily defers his application for a patent, and suffers his invention to go into use, except for such purposes and beyond what he has reason to believe necessary for such purposes, his patent is void. *Ibid.*, 291, 300.

23. In order to entitle a person to the character of an inventor, and his invention to become the subject of a patent, he must not stop at unsuccessful experiments, but continue until he has brought out a machine producing a useful result, and without this his invention will be worthless to the community, and undeserving the protection of the law. *McCormick v. Seymour*, MS.—NELSON, J.; N. Y., 1851.

24. It is when speculation has been reduced to practice, when experiment has resulted in discovery, and when that discovery has been perfected by patient and continued experiments, when some new compound, art, manufacture, or machine, has been thus produced, which is useful to the public, that the party making it becomes a public benefactor, and entitled to a patent. *Goodyear v. Day*, 2 Wall, Jr., 299.—GRIER, J.; N. J., 1852.

25. Where an invention is not of a mere philosophical speculation, abstraction, or theory, but of something corporeal, to be manufactured, the applicant need not show that he has reduced it to practice, otherwise than by a description, and drawings, and a model, if the case admits of a drawing and models. *N. E. Screw Co. v. Sloan*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

26. The patent laws do not require that an invention should be reduced to actual practice before the issuing of the patent, otherwise than by a model, drawings, and specifications, so describing the invention that a skilful person could make and use it, and verified by the oath of the party. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

27. An imperfect and incomplete invention, resting in mere *theory*, or in *intellectual notion*, or in uncertain ex-

periment, and not actually reduced to practice, and embodied in some distinct machinery, apparatus, manufacture, or composition of matter, is not patentable under our laws. *Marshall v. Mee*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1853.

28. He is the first inventor in the sense of the patent acts, and entitled to a patent, who has first perfected and adapted the invention to use, and until the invention is so perfected and adapted to use, it is not patentable. *Ibid.*

29. But this position is subject to the qualification that he who *invents* first shall have the *prior* right, if he is using reasonable diligence in adapting and perfecting the same, although the *second inventor* has in fact *first perfected* the same and reduced it to practice in a positive form. *Ibid.*

30. Therefore if A first conceived an invention, and used reasonable diligence to perfect it, and did perfect it, though subsequent to B, A is entitled to a patent, even if B, a subsequent and original inventor, *first perfected* it, and reduced it to use. *Ibid.*

31. A long course of *mere fruitless* experiments to reduce a principle to practice, will not be sufficient to prevent a subsequent original inventor, who has perfected his invention, without knowledge of the prior invention, from receiving a patent. *McCormick v. Ketchum*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

32. But where a prior inventor has been using due diligence to perfect his invention and adapt it to practical use, his right will be preserved and protected, although his success may not be perfect. *Ibid.*

33. A machine in order to anticipate any subsequent discovery must be per-

fectured, that is, made so as to be of practical utility, and not be merely experimental, and end in experiment. *Howe v. Underwood*, 1 Fisher, 166.—SPRAGUE, J.; MASS., 1854.

34. The making of a drawing of an invention sufficiently plain to enable a skilful person to make the thing from the drawing, is sufficiently reducing the invention to practice. *Stephenson v. Hoyt*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

35. An invention is complete when it is capable of successful operation. It is not necessary that the best mode or manner of carrying out or applying the principle should have been determined, or that the inventor should be aware of the full value of his invention. *Burrows v. Wetherill*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

36. There is no express requirement in the statute that the applicant shall reduce his invention to actual use before he can obtain a patent. *Stephens v. Salisbury*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

37. It is not the person who has only produced the idea, that is entitled to protection as an inventor, but the person who has embodied the idea into a practical machine, and reduced it to practice. He who has first done that, is the inventor who is entitled to protection. *Winans v. N. Y. & H. R. R.*, 31 Jour. Fr. Inst., 322.—NELSON, J.; N. Y., 1855.

38. Where two persons are both inventors of the same thing, the one who perfected his invention first, is protected by the law. *Allen v. Hunter*, 6 McLean, 322.—MCLEAN, J.; Ohio, 1855.

39. If an inventor does not use reasonable diligence to perfect his invention, after the idea of it is conceived,

and in the mean time another conceives the idea, and perfects the invention, and practically applies it to use, the latter is the first and original inventor, and a patent granted to the former will be void, as not issued to the first inventor. *Ransom v. Mayor, &c.*, 1 Fisher, 272.—HALL, J.; N. Y., 1856.

40. Although an invention has not been reduced to actual practical use, yet if it appears to be capable of being so reduced, it will be sufficient (other things not opposing), to entitle a party to a patent. *Chandler v. Ladd*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

41. Although an inventor and patentee may not have reduced to practical use and operation his invention, before the time the same thing may have been invented by another, if at the time of such subsequent invention, the first inventor was using reasonable diligence (§ 15 of the act of 1836) in adapting and perfecting the same, and did afterward in a reasonable time adapt and perfect the same, such subsequent invention will not deprive him of the benefits secured by his patent. *Bartholomew v. Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

42. The person who is the first to conceive and give expression to the idea of an invention, in such clear and intelligible manner that a person skilled in the business could construct the thing, is entitled to a patent, provided he uses reasonable diligence in perfecting it. *Eames v. Richards*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

43. By being *perfected*, in the eye of the law, it is not meant that an invention should be carried to a point where there could not be any subsequent improvement, but that it should be completed

so as to be of some practical utility. It need not be of any high degree—if it is of *any* practical utility, although of a low degree—and has been completed so as to be of practical utility, then it may be said to be perfected in the eye of the law. *Johnson v. Root*, 1 Fisher, 366.—SPRAGUE, J.; Mass., 1858.

44. But it is not sufficient that some part incorporated into an invention should have been thus perfected, unless that part could be a machine, so as to be of some practical utility. It must be embodied and connected with a machine, which, as a whole, taking that part, must be of some practical utility, in order to prevent others coming afterward from having the benefit of an invention which embraces that. *Ib.*, 366.

45. To constitute a perfected machine, which will entitle a party to a patent, it is not necessary that he should have actually constructed the machine which is the subject of his invention. If having conceived a valuable idea, he has manifested it before the world in any form which evidences the completeness of the idea, and which is sufficient when communicated to others, to enable those skilful in the particular art to reproduce his invention, he has done enough to entitle himself to a patent, and this whether such evidence consists of written description, drawings, models, or a complete machine. *Farley v. Nat. Stm. Gauge Co.*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

46. And it will make no difference that the inventor was not fully aware of the extent of the value of his invention. *Ibid.*

47. Though drawings of a machine or invention are made, from which machines could be constructed, or even if models are made such as may be ca-

pable of operation for the purpose of experiments, yet, unless a machine, which is capable of being used and operated as an actual working machine, is constructed, then as matter of law, such invention is not completed. *Ca-hoon v. Ring*, 1 Fisher, 408.—CLIFFORD, J.; Me., 1859.

48. The making of drawings of conceived ideas is not such an embodiment of such conceived ideas, into practical and useful form, as will defeat a patent which has been granted. *Ellithorpe v. Robertson*, 4 Blatchf., 309.—INGERSOLL, J.; N. Y., 1859.

49. An invention is not patentable until it is perfected and adapted to use. In a race of diligence between two independent inventors, he who first reduces his invention to a fixed position, and practical form, has a priority of right to a patent. *Ibid.*, 309–310.

50. Where A conceived the idea of an invention in 1847, and made a drawing thereof, but did nothing further toward reducing his invention to a practical and useful form, and made no application for a patent until 1858; and in the mean time B had invented the same thing, and had obtained a patent therefor in 1854, but not in fraud of A, *Held*, that such alleged prior invention of A would not defeat B's patent. *Ibid.*, 308–310.

51. Where an inventor describes his invention to a mechanic, and directs him to construct it, he is entitled to a reasonable time for making experiments in order to perfect his invention, and such description and experiments, if successful, will be considered as sufficient evidence of an assertion of his right at the time he made them, although a subsequent inventor may first perfect the invention and obtain a pat-

ent therefor; and such prior inventor will be entitled to a patent. *Dietz v. Burnham*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859; *Gibbs v. Johnson*. *Ibid.*, 1860.

52. Such descriptions may be oral, and need not necessarily be in writing, or accompanied by a drawing. *Ibid.*

53. The leading rule is that a person who is entitled to a patent and to be protected in his property, must not only conceive the idea of an invention, but must embody it in a machine or in some working arrangement, by which it may be shown that his new idea is adapted to practical and successful use. *Winans v. Danforth*, MS.—NELSON, J.; N. Y., 1860.

54. The party who first conceives the idea or conception of an invention is entitled to a patent, provided he pursues his idea or conception and reduces it to practice within a reasonable time, though another may have first actually reduced the invention to practice. *Bev. Rub. Co. v. Wing*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

55. The first inventor is entitled to a reasonable time, to be judged of according to the circumstances of the particular case, in which to perfect his invention, without impairing his claim to priority. If he is using reasonable diligence, he will not lose his right, though another first making a working invention. *Appletons v. Chambers*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

56. An inventor who first perfects an invention, and applies for and obtains a patent for it, will not be deprived of his right to such patent by a more tardy and negligent inventor, who may have first conceived the idea of the invention, but did nothing toward reducing it to practice, or applying for a patent for it.

*Walker v. Forbes*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

57. Where A conceived the "idea" of an invention, but made no drawing of it for six or seven months, and in the mean time B had conceived the same invention, and had made a model of it, thus giving *physical form and shape* to his conception, *Held*, that B was to be considered as having first perfected his invention. *Ibid.*

58. If a person, after having the conception of an invention, is using due diligence to perfect it and reduce it to practice, he will still be deemed the first inventor, though another, who conceived the idea later, may have first perfected the idea by manufacturing the thing invented. *Hicks v. Shaver*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

### C. ORIGINALITY AND PRIORITY OF.

See also INVENTOR, B.; PRIOR KNOWLEDGE.

As to evidence in respect to originality, see EVIDENCE, H. 4.

### D. NOVELTY AND UTILITY OF.

As to evidence in respect to novelty and utility, see EVIDENCE, H. 5.

1. If the principles of a machine are new, either to produce a new or an old effect, the inventor is entitled to the exclusive right of the whole machine. *Whittemore v. Cutter*, 1 Gall., 480.—STORY, J.; Mass., 1813.

2. The intrinsic difficulty is to ascertain in complicated cases the exact boundaries between what was known and used before, and what is new in the *mode of operation*. *Ibid.*, 481.

3. The discovery must not only be useful but new, and must not have been known or used before in any part of the world. And the title of the patentee may be impeached by showing that he was not the first inventor, and this too whether the patentee was aware of such prior discovery or not. *Evans v. Eaton*, Pet., C. C., 342.—WASHINGTON, J.; Pa., 1816. [Affirmed, *post* 8.]

4. If an invention, in the form in which it came from the inventor's hands, was so inferior to other machines as to deprive it of all intrinsic value, yet if another person can superadd to it something which will remove its defects and render it useful, it becomes valuable, because of its capacity to receive such improvements; and the inventor of such improvements has no right to avail himself of the original discovery on which to engraft his own. *Gray v. James*, Pet., C. C., 480.—WASHINGTON, J.; Pa., 1817. [But see *post* 21.]

5. The patent law requires an invention to be new and useful, but all that the law requires is that the invention should not be frivolous or injurious to the well-being, good policy, or sound morals of society. The word "useful" is used in contradistinction to mischievous or immoral. Whether the invention be more or less useful is a circumstance of no importance to the public. *Lowell v. Lewis*, 1 Mas., 186.—STORY, J.; Mass., 1817.

6. By useful invention is meant such a one as may be applied to some beneficial use in society, in contradistinction to an invention which is injurious to the morals, the health, or the good order of society. But it need not be of such general utility as to supersede all other inventions in practice to accomplish the same purpose. The law does not look

to the degree of utility. *Bedford v. Hunt*, 1 Mas., 303.—STORY, J.; Mass., 1817.

7. An invention to entitle the inventor to a patent, must not only be useful, but it must also be new; it is a good defence in an action of infringement that the thing patented was not originally discovered by the patentee, but had been before discovered and put in actual use. *Ibid.*

8. If the thing patented had been in use, or described in a public work, anterior to the supposed discovery of the patentee, his patent is void; and this although the patentee had no knowledge of such previous use or previous description; the law supposes he may have known it. *Evans v. Eaton*, 3 Wheat., 514.—MARSHALL, Ch. J.; Sup. Ct., 1818.

9. In respect to the utility of an invention, the law only requires that an invention should not be frivolous or injurious to the well-being, good policy, and sound morals of society. The word *useful* in the act is used in contradistinction to mischievous or immoral. *Kneass v. Schuyl. Bank*, 4 Wash., 12.—WASHINGTON, J.; Pa., 1820.

10. An invention or improvement, for which a patent has been obtained, must be useful within the meaning of the patent law, or the patent will be void. *Langdon v. De Groot*. 1 Paine, 204-206.—LIVINGSTON, J.; N. Y., 1822.

11. To what extent an invention must be useful to render it the subject of a patent, will depend upon the particular circumstances of each case, and for which no general rule can be given, but it must in some small measure at least be beneficial to the community. *Ibid.*, 204.

12. An invention for folding thread or

cotton in a more ornamental manner, by which the article would sell quicker, and at a higher price, but which made no change in the article, is not a useful invention within the patent laws, though beneficial to the patentee. *Ibid.*, 205.

13. The thing patented must be new and not before known or used; that is, the party must have found out, created, or constructed some art, machine, &c., or improvement on some art, machine, &c., which had not been previously found out, created or constructed by any other person. *Earle v. Sawyer*, 4 Mas., 6.—STORY, J.; Mass., 1825.

14. It is of no consequence whether the thing be simple or complicated, whether it be by accident or by long laborious thought, or by an instantaneous flash of mind, that it is first done. The law looks to the fact, and not to the process by which it is accomplished. *Ibid.*, 6.

15. An invention must be useful, that is, not noxious or mischievous, but capable of being applied to good purposes; and perhaps it may also be a just interpretation of the law, that it meant to exclude things absolutely frivolous and foolish. *Ibid.*, 6.

16. The question is, whether the thing has been known before. In case of a machine, whether it has been substantially constructed before; in case of an improvement of a machine, whether that improvement has ever been applied to such a machine before, or whether it is substantially a new combination. *Ibid.*, 6, 7.

17. The word "useful" in the patent law is well settled as being used in contradistinction to frivolous inventions or improvements, or such as are injurious to the public. *Waitney v. Emmett*, Baldwin, 302.—BALDWIN, J.; Pa., 1831.

18. The want of utility may be a good reason for not issuing a patent, but is no cause for avoiding it. *Ibid.*, 309.

19. The novelty of an invention is either the manufacture produced, or the manner of producing an old one; if the patent is for the former, it must be for something substantially new, different from what was known before; if the latter, the mode of operation must be different, not a mere change of the form and proportions. If both are the same in principle, structure, mode of operation, and produce the same result, they are not new, though there may be a variance in some small matter for the purpose of evasion, or as a color for a patent. *Ibid.*, 311.

20. The invention must be new as to all the world, not the abstract discovery, but the thing invented, not the secret principle, but the manufacture resulting from it. *Ibid.*, 311.

21. The ingenious reasoning of the learned judge in *Gray v. James*, Pet., C. C., 480, is not satisfactory. It is not evident how the owner of a thing which is worthless, and which has been thrown away as useless, can sustain any damage by the use of such thing made useful only by being combined with something else, or so changed in its operation by an invention to which the owner of the worthless thing had no claim or title. *Ibid.*, 328.

22. An invention, in order to be the subject of a patent, must be useful for some beneficial purpose, in contradistinction to *pernicious* or *injurious*. *Dickinson v. Hall*, 14 Pick., 220.—SHAW, Ch. J.; Mass., 1833.

23. Under the provisions of §§ 6 and 7 of the act of 1836, a patent is to be issued only to a person who has discov-



ered or invented some *new* and useful art, &c., or some new and useful improvement on an art, &c. *Kemper, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

24. As to the utility of an invention, the question is not whether the invention is useful beyond all others for effecting the objects for which it was designed, but whether it is capable in some degree of beneficial use, or would in some degree subserve the purpose of its design; or whether, on the contrary, it was merely mischievous and injurious, or pernicious, or frivolous and worthless. *Dunbar v. Marden*, 13 N. Hamp., 319.—WOODS, J.; N. H., 1842.

25. A machine or apparatus, or other mechanical contrivance, in order to give a party a claim to a patent therefor, must in itself be substantially new. If it is old, and applied only to a new purpose, that does not make it patentable. The machine must be new, not merely the purpose to which applied. *Bean v. Smallwood*, 2 Story, 411.—STORY, J.; Mass., 1843.

26. A purpose is not patentable; but the machinery only, if new, by which it is to be accomplished. In other words, the thing itself which is patented must be new, and not the mere application of it to a new purpose or object. *Ibid.*, 411.

27. 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. *Hovey v. Henry*, 3 West. Law Jour., 155.—WOODBURY, J.; Mass., 1845.

28. A combination which has any new mode of operation, is to be considered as new; to determine this, it is better to look at results than to the opinions

of witnesses. If the results are different, it argues a substantial change in the mode of operation; the results could not be different if the means are the same. *Davoll v. Brown*, 3 West. Law Jour., 151.—WOODBURY, J.; Mass., 1845.

29. It is not necessary, to maintain a patent, or the right of the inventor, that the thing invented should be the very best article for the use to which it can be applied. If it is at all valuable, if its use for the purpose for which it is constructed is practicable, that is sufficient to sustain it as a useful invention. *Manny v. Jagger*, 1 Blatchf., 381.—NELSON, J.; N. Y., 1848.

30. A novelty in principle may consist in a new and valuable mode of applying an old power; affecting it not merely by a new instrument or form of the machine, or any mere equivalent, but by something giving it a new or greater advantage. *Hovey v. Stevens*, 1 Wood. & Min., 297, 298.—WOODBURY, J.; Mass., 1846.

31. To be patentable, an invention must be useful. But in ascertaining the usefulness of an invention, it is not important that it should be more valuable than any other modes of accomplishing the same result; but it must be a practicable method of doing the thing designed, in which its utility will more or less consist. *Roberts v. Ward*, 4 McLean, 566.—MCLEAN, J.; Mich., 1849.

32. The right of the inventor does not depend upon the question whether the machine is more or less perfect, or whether slight modifications in the arrangement of the machinery, or in the finishing of the parts composing it, may or may not better accomplish the end sought to be attained; but upon the question whether the machinery, con-

structed as described in the patent, will or will not accomplish the end practically and usefully in the way pointed out. *Parkhurst v. Kinsman*, 1 Blatchf., 497.—NELSON, J.; N. Y., 1849.

33. An invention, to be patentable, must not only be one that can be reduced to practice, but must be one of some utility. But as to the utility of an invention, the question is not whether it is the best one known to the public, nor whether it does its work better or faster than any other machine in the same department of labor, but if it be to a certain degree useful, it is sufficient. *Wilbur v. Beecher*, 2 Blatchf., 137.—NELSON, J.; N. Y., 1850.

34. 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.

35. 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*. *Aikens, Ex parte* (Car Wheels), MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

36. But the degree of usefulness or importance is not described or limited by the statute; nor is it material if the matter interferes with no prior right or

claim, and is in itself innocent. If good may be the result of granting a patent, and evil cannot, it ought to be granted. *Ibid.*

37. Novelty and utility in an invention are all that the statute requires as a condition for granting a patent. It is not, therefore, a good objection to a patent that the arrangement and combination claimed was so simple and obvious as not to be subject of a patent. *McCormick v. Seymour*, 2 Blatchf., 243, 244.—NELSON, J.; N. Y., 1851.

38. As to the question of novelty, the inquiry is, whether the alleged prior machines are identical with those of the plaintiff, or whether, he has made a different one, involving a new operation, and producing a new effect. *Ibid.*, 245.

39. Any degree of utility is sufficient to support a patent, the word *useful*, in the patent law being used in opposition to *frivolous or noxious*; it is not necessary that the thing invented should be the best of its kind—as that an improvement in the structure of railroad cars should render them entirely safe for passengers. *Winans v. Schenec. & Troy R. R.*, 2 Blatchf., 290, 291.—NELSON, CONKLING, JJ.; N. Y., 1851.

40. The degree of the utility of an invention is not a subject of consideration in determining whether an invention is patentable. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

41. A machine, in order to anticipate any subsequent discovery, must be perfected, that is, made so as to be of practical utility, and not be merely experimental, and end in experiment. Until of practical utility, the public attention is not called to the invention; it does not give to the public that which the

public lays hold of as beneficial. *Howe v. Underwood*, 1 Fisher, 166.—SPRAGUE, J.; Mass., 1854.

42. Where, in a patent for improvements in cooking stoves, the claim was "the placing the fire chamber in the middle of the oven, so that the latter may receive the heat on three sides at once;" but there was no peculiarity in the oven or fire chamber, and the invention appeared to be, that instead of forming three ovens or compartments around the fire chamber, as usual, the inventor removed the partitions behind the fire chambers, and made a single cooking space instead of three; *query*, Whether the change is a patentable discovery. *Wilson v. Jones*, 3 Blatchf., 229.—BETTS, J.; N. Y., 1854.

43. 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 McAllister, 50.—MCALLISTER, J.; Cal., 1855.

44. The patentees need not prove their discovery to be useful to any eminent or large degree. It is sufficient if it produces an improved article at less cost, or with more expedition than any other known methods; that renders the discovery useful, within the meaning of the patent laws. *Carr v. Rice*, 1 Fisher, 202.—BETTS, J.; N. Y., 1856.

45. The word "useful," in § 6 of the act of 1836, and as used in § 1 of the act of 1793, is not used for the purpose of establishing general utility as the test of a sufficiency of invention to support the patent. It is used merely in contradistinction to what is frivolous or mischievous to the public. It is sufficient if the invention has any utility.

*Wintermute v. Redington*, 1 Fisher, 245.—WILSON, J.; Ohio, 1856.

46. The utility of an invention is an essential requisite to the validity of the patent. A useless invention, even if patented, is not and will not be of any profit to the public. But a general utility is not prescribed by the statute as the test of the sufficiency of the invention. The word is used in contradistinction to what is frivolous, or what is mischievous to the public. *Page v. Ferry*, 1 Fisher, 305.—WILKINS, J.; Mich., 1857.

47. An invention not obnoxious to these objections, whether more or less useful, if it be of *any* use, is embraced within the spirit of the law. A slight improvement of an old machine is a useful improvement. *Ibid.*, 305-6.

48. It is not necessary that the utility of an invention should be great, it is sufficient if the invention is an improvement at all. If it is of a different construction from former articles of the same kind, and of any use, that is sufficient. *Chandler v. Ladd*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

49. In the allowance of a patent the question of novelty should not be too rigorously questioned, but the benefit of any doubt should be given to the applicant, as if his application is rejected, and his invention have real patentable novelty, irremediable injury would be produced, but if a patent is allowed, the novelty can still be inquired into by a jury. *Cole, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1857.

50. 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,

## IDENTITY OF.

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.

51. The degree of the utility of an invention, is not a matter of consideration. If it was useful at the time the patent was granted, the patent is valid. But if it has become useless since, by the discovery of some other thing, which dispenses with it, that gives no right to others to use it. *Poppenhausen v. N. Y. G. P. Comb Co.*, 2 Fisher, 72.—INGERSOLL, J.; N. Y., 1858.

52. It seems that where an alleged invention, upon received and well established principles, is in fact wholly incapable of answering, practically, the purpose for which intended, or claimed, that the Commissioner of Patents will be justified in refusing the application on the ground of want of utility. *Cushman, S. D., Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

53. An invention must be of some utility; a patent cannot be granted for a thing altogether frivolous, but the presumption on the face of the patent is that it is of some utility, for the applicant is obliged to swear that the invention is useful before the securing of the patent. *Coleman v. Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

54. The statute makes utility essential to the validity of a patent, but whether it exists in a given case is to be decided by the jury upon the evidence subject to the decision of the court upon the law. *Vance v. Campbell*, 1 Fisher, 485.—LEAVITT, J.; Ohio, 1859.

55. In regard to utility, it is well settled that the court will not be very rigid as to the degree of utility; it will not in-

quire into the precise quantum of value, but if the invention be useful in any degree, and not absolutely worthless, the patent will be sustained. *Ibid.*, 485.

56. The degree of utility in an invention is not important. If the invention is useful, though it does not require great inventive power, it will entitle the inventor to a patent. *Leach, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

57. If an invention be both new and useful, it cannot be impeached because it does not accomplish all that a sanguine inventor has claimed for it. *Eames v. Cook*, 2 Fisher, 151.—SPRAGUE, J.; Mass., 1860.

## E. IDENTITY OF.

See also COLORABLE VARIATIONS; EQUIVALENTS; FORM; INTERFERENCES.

1. If the same effects are produced by two machines, by the same mode of operation, the principles of each are the same. If the same effects are produced, but by combinations of machinery operating substantially in a different manner, the principles are different. *Whittemore v. Cutter*, 1 Gall, 481.—STORY, J.; Mass., 1813.

2. The same elements of motion, and the same powers, must be employed in almost all machines. The material question therefore is not whether the same elements of motion, or the same component parts are used, but whether the given effect is produced substantially by the same mode of operation, and the same combination of powers in both machines. Mere colorable differences, or slight improvements, cannot shake the right of the original inventor. *Odiorne v. Winkley*, 2 Gall, 54.—STORY, J.; Mass., 1814.

## IDENTITY OF.

3. What constitutes a difference in principle between two machines, is frequently a question of difficulty, more especially if the difference in form is considerable, and the machinery complicated. *Gray v. James*, Pet., C. C., 397.—WASHINGTON, J.; Pa., 1817.

4. As a general rule, where machines are substantially the same, and operate in the same manner, to produce the same result, they must in principle be the same; *substantially*, in order to exclude all formal differences; and by the same result is meant the same in kind, though it may differ in extent; the result is the same, if one machine produces more articles, as in machines for the manufacture of nails, in a given space of time than the other. *Ibid.*, 398.

5. In two machines for making nails, the one used a vice with two jaws, the lower one permanent and the upper one movable, and the two compressed by a lever of the first order, acting upon a toggle joint, connected with the moving jaw; the other also used a vice with two jaws, the upper one of which was fixed, and the two were compressed together by a lever of the second order, embracing the jaws with a friction roller fixed between the forks of the lever, and acting on an inclined surface of the moving jaw. But it was proved that the differences as to the lever and the friction roller were the necessary consequences of the machine being inverted. *Held*, that if their operation was the same, the difference in form did not amount to an invention. *Ibid.*, 398.

6. If two machines be substantially the same, and operate in the same manner, to produce the same result—though they may differ in form, proportions, and utility, they are the same in princi-

ple; and the one last discovered has no other merit than that of being an improved imitation of the one before discovered and in use, for which no valid patent can be granted to any one; because he cannot be considered as the original inventor of the machine. *Evans v. Eaton*, 3 Wash., 449.—WASHINGTON, J.; Pa., 1818.

7. The opinion of skilful persons is allowable in a patent case, as to whether the principles of two machines are the same. But care should be taken to distinguish what is meant by a principle, the true legal meaning of which is the peculiar structure or constituent parts of a machine. *Barrett v. Hall*, 1 Mas., 470.—STORY, J.; Mass., 1818.

8. The principles of two machines may be the same, although the form or proportion may be different. They may substantially employ the same power in the same way, though the external mechanism be different. On the other hand, the principles of two machines may be very different, although their external structure may have great similarity in many respects. *Ibid.*, 471.

9. The jury are to judge, by an inspection of the models, and from the evidence, whether two machines differ in principle. *Smith v. Pearce*, 2 McLean, 179.—MCLEAN, J.; Ohio, 1840.

10. If the principle on which the machinery works is the same, and the effect is similar in both, in contemplation of law the machines are identical. *Brooks v. Bicknell*, 3 McLean, 262.—MCLEAN, J.; Ohio, 1843.

11. There must be an essential difference in the application of the mechanical power, to make the machines dissimilar. *Ibid.*, 262.

12. Science alone is able to answer the question, whether or not a particu-

## IDENTITY OF.

lar machine is substantially in its mode of operation new, or identical with another, although with apparent differences of form and structure, which might mislead the unscientific mind. *Allen v. Blunt*, 3 Story, 748.—STORY, J.; Mass.; 1845.

13. The very highest witnesses to ascertain and verify the novelty of an invention, and the identity or diversity of mechanical apparatus and contrivances, and equivalents, are, beyond all question, all other circumstances being equal, scientific mechanics. *Ibid.*, 740.

14. It is the province of the jury to determine whether there is a substantial variation or difference between the machine used by the defendants, and that of the plaintiffs, or whether the difference is a mere formal alteration. *Blanch Gun-Stock Manuf. Co. v. Warner*, 1 Blatchf., 278, 279.—NELSON, J.; Ct., 1846.

15. The question of identity or difference of two articles—railroad car wheels—is, whether there is a substantial difference between the two in their mechanical structure, and whether the defendant's involved any thing which required mind and ingenuity over and beyond that of the plaintiff. The question of identity is one of fact. *Many v. Jagger*, 1 Blatchf., 386.—NELSON, J.; N. Y., 1848.

16. A change of form will not be sufficient, unless *form* is a part of the thing invented, and is essential to its value. There must be a substantial difference, and the one claimed to be different must embody a different principle from the other. *Ibid.*, 386.

17. It does not constitute an identity of invention between two machines, or make one an encroachment on the other, that their general object is the same.

*Smith v. Downing*, 1 Fisher, 84.—WOODBURY, J.; Mass., 1850.

18. In cases of reissue, the action of the Commissioner has more than *prima facie* influence in finally deciding the question of identity of invention. *French v. Rogers*, 1 Fisher, 139.—GRIER, KANE, JJ.; Pa., 1851.

19. In examining questions of identity or infringement, it is to be first ascertained wherein consists the substantial peculiarity which distinguishes the art or invention patented. Whoever adopts or appropriates such distinctive peculiarity or principle without license of the patentee, appropriates the invention, and infringes the patent, if the specification be correctly drawn. *Good-year v. Day*, MS.—GRIER, J.; N. J., 1852.

20. In examining a machine, to ascertain whether or not it is an infringement of another, the similarity or dissimilarity of the mechanical construction is not necessarily conclusive or controlling. *Blanchard v. Beers*, 2 Blatchf., 416, 418.—NELSON, J.; Ct., 1852.

21. Its structure may be apparently very similar in form, and yet its principle, operation, and result may be very different. So on the other hand, its structure and appearance may be very different to the eye, and in point of fact, and yet it may in reality and in principle be the same as the previous machine. *Ibid.*, 416.

22. The mere mechanical construction and form of a machine are not, therefore, always a test of its identity or want of identity with another. The principle embodied in a machine, and which gives it all its utility, may be put in successful operation by different mechanical contrivances, depending more on the skill of the mechanic than the

genius of the inventor. It is unsafe to rely upon the mere difference in the mechanical construction. *Ibid.*, 416.

23. The sure test, and the one the jury should be guided by in all cases, is whether or not the defendant's machine (whatever may be its form or mechanical construction), has incorporated within it the principle or the combination, or the novel ideas which constitute the improvement to be found in the plaintiff's machine. If it does, then, no matter what may be its mechanical construction, or its form, it is an infringement. *Ibid.*, 416.

24. No person can appropriate the benefit of the new ideas which another has originated and put into practical use, because he may have been enabled by superior mechanical skill to embody them in a form different in appearance, or different in reality. Although he may not have preserved the exterior appearance of the previous machine, he may have appropriated the ideas which give to it all its value. *Ibid.*, 418.

25. The questions of identity between two opposing machines are frequently exceedingly difficult, and often the most difficult questions involved in patent cases. They are ultimately questions of fact for the jury to determine. *Tatham v. Le Roy*, 2 Blatchf., 485.—NELSON, N. Y., 1852.

26. A change in form or proportions from the construction of an existing machine, is not a substantial change in the eye of the patent law. So also the substitution of a mechanical equivalent in the construction of a machine is not a substantial change. Formal and mechanical changes are nothing. *Ibid.*, 485, 486.

27. Any machine may be very considerably changed in its mechanical ar-

angement and construction, the description of it may be very much departed from in the construction, and yet it may accomplish the object and purpose for which it was designed. *Ibid.*, 487.

28. A difference in the mechanical arrangement and construction of two machines is not necessarily a test by which to determine that they are not identical. They may be apparently different externally, and still embrace the same substantial identity in principle and mode of operation. So, on the other hand, the converse of the proposition is equally true. They may be very similar externally, and still in principle and mode of operation be very different. *Ibid.*, 488.

29. The question is, whether the mechanical arrangement and construction of the two embrace the same set of ideas, the same leading features or ideas, which, in practical operation, produce the useful result. In other words, whether the arrangement and combination of the parts of machinery found in each are substantially the same, and operate in substantially the same way in producing the result. *Ibid.*, 488.

30. 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. *Ibid.*, 1852.

31. 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,

## IDENTITY OF.

or with a reduced amount of power, but the new effect must be different in kind. *Ibid.*, 492.

32. 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.

33. The jury are to determine whether two machines are identical, or are constructed and act upon different principles. *Battin v. Taggart*, 17 How., 85.—McLEAN, J.; Sup. Ct., 1854.

34. The identity that is to be looked to, in an action of infringement, respects that which constitutes the essence of the invention, namely, the application of the principle. If the mode of carrying the same principle into effect, adopted by the defendant shows that the principle admits of the same application in a variety of forms, or by a variety of apparatus, such mode is a piracy of the invention. *Wintermute v. Redington*, 1 Fisher, 251.—WILSON, J.; Ohio, 1856.

35. But if the defendant has adopted variations which show that the application of the principle is varied, that some other law or rule of practice or science is made to take the place of that which the patentee claims as the essence of his invention, then there is no infringement. *Ibid.*, 251.

36. The question of identity is one of fact to be determined by the jury upon the evidence, under the instructions of the court, as to what in law constitutes a substantial identity. *Smith v. Higgins*, MS.—BETTS, J.; N. Y., 1857.

37. One machine need not be a perfect transcript of the other, nor correspond exactly in arrangements, manner

of action, or results. But a patentee is protected against any use of his invention by the employment of means apparently dissimilar to his own, if they possess the same functions, are employed for the same purpose, and embody a common principle. *Ibid.*

38. A change in the forms or proportions of instrumentalities—a substitution of one motive power for another—a different position or gearing of the working apparatus—a superior finish in any other particular, resting in mere mechanical skill or taste, and not involving invention—does not render machines, appearing to the eye exceedingly unlike, substantially different in judgment of law. *Ibid.*

39. Nor is the substantial identity of two machines established by proof that they bring out the same products, and use the same mechanical powers, and have other resemblances. But, in such case the evidence must show that the two are of the same nature and character, and constructed and operated upon a common principle, and to the same purpose. *Ibid.*

40. "Substantial identity" excludes immaterial variations or fraudulent evasions. That is a substantial identity which comprehends the application of the *principle* of the invention. If a party adopts a different mode of carrying the *same* principle into effect, and the principle admits of a variety of forms, there is an identity of principle, though not an identity of mode. *Page v. Ferry*, 1 Fisher, 310.—WILKINS, J.; Mich., 1857.

41. The same principle may be used without an exact identity by mechanical equivalents or contrivances; and if so, there would be a substantial identity, or such an arrangement of mechanism



## IDENTITY OF.

which produces the same service, or produces the same effect in the same way, or *substantially* the same way. As a question of fact, it sufficeth if the principle has been violated. *Ibid.*, 311.

42. As to the question of identity, models are not a living, but a sure and true witness—dumb, but yet, like Balaam's beast, speaking eloquently, as you may interpret the language they employ. To each part a voice potential is given. *Ibid.*, 313.

43. Where, in two devices, the end to be accomplished is the same, and the substantial means to accomplish the end are the same, the two devices are identical, though one may accomplish the end more effectually than the other. *Imlay v. Nor. & Wor. R. R.*, 4 Blatchf., 237.—INGERSOLL, J.; Ct., 1858.

44. On the subject of the identity of two machines, we are not concluded by their mere form or appearance; the question is, are they the same in substance? Is the machine used by the defendant a mechanical equivalent for that patented by the plaintiff? *Morris v. Barrett*, 1 Fisher, 463.—LEAVITT, J.; Ohio, 1858.

45. Any machine got up by the patentee, or those claiming under him, whose construction, arrangement, principles, and mode of operation, are substantially the same as the one described in the specification, though differing in size and proportions, is as much within the protection of the patent as the structure therein described. *Cahoon v. Ring*, 1 Fisher, 411.—CLIFFORD, J.; Me., 1859.

46. In determining questions of infringement, the jury are not to judge about similarities or differences, by the names of things; but are to look to the machines, or their several devices or elements in the light of what they do,

or what office or function they perform, and how they perform it; and to find that a thing is substantially the same as another, if it perform substantially the same function or office in the same way to attain the same result; and that things are substantially different when they perform different duties, or in a different way, or produce a different result. *Ibid.*, 419.

47. For the same reason they are not to judge about similarities or differences, merely because things are apparently the same, or a different shape or form, but the true test of similarity or difference is the same in regard to shape or form as in regard to names; in both cases they are to look at the mode of operation, or the way the parts work, and at the result, as well as the means by which the result is attained. *Ibid.*, 419.

48. Although two machines may be similar in appearance and arrangement, if the conditions under which they are to act are not alike—if the same service is not to be performed—if their *purpose* is different, and there is no identity of object or effect, they are not identical. *Emery, Ex parte*, MS. (App. Cas.)—MORSELL, J., D. C., 1859.

49. On the question of identity the law regards substance and not form, and the real question is whether the machine used by the defendants is in *principle* the same as that patented to the plaintiff. *Latta v. Shark*, 1 Fisher, 470.—LEAVITT, J.; Ohio, 1859.

50. The identity of machines does not depend upon form or proportion, so much as upon the principle of action, and the operation of the two things. *Judson v. Moore*, 1 Fisher, 557.—LEAVITT, J.; Ohio, 1860.

51. As to identity it is not a question as to the precise form or size of two

machines; the point is whether the principle of the two things is the same. The patentee is protected against any other device which involves substantially the same principle. *Lee v. Blandy*, 2 Fisher, 94.—McLEAN, LEAVITT, JJ.; Ohio, 1860.

52. But if another party produces the same result by means different in principle and operation, there is no infringement, for it would be absurd to say that the granting of a patent covers all possible ways of producing the same result. *Ibid.*, 94.

53. If the jury find a substantial identity, the defendants cannot say that the machine they use is of no utility, as the mere fact that they have appropriated it is evidence that they regarded it as of utility. *Ibid.*, 95.

54. The object and purpose of two inventions may be taken into consideration in determining the question of identity between them. Where their object and purpose are entirely different, and material advantages result from one invention, it is patentable, though it has some resemblances to a former one. *Barstow, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

55. The purpose or object had in view by an invention may be considered in determining the question whether it is identical with another. *Hoyt, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C. 1860.

56. In determining the question of identity, the jury are not to inquire whether the two things are identical in structure, form, or dimensions, but whether they involve substantially the same principles. *Judson v. Cope*, 1 Fisher, 625.—LEAVITT, J.; Ohio, 1860.

57. In determining whether the mechanism of one machine is the same as that of another, we may not only look

at the mechanism itself, that is, the devices and the arrangement of them, but also at their mode of operation, and their effects or results. *Eames v. Cook*, 2 Fisher, 148.—SPRAGUE, J.; Mass., 1860.

58. If the mode of operation be different, it is evidence that the mechanism is different. If the result be different, reasoning from effects to causes, we may presume that some new instrumentality has been introduced, although the mechanism may apparently be substantially the same. *Ibid.*, 149.

INVENTOR.

A. WHO IS; AND RIGHTS OF, AS SUCH... 441  
 B. FIRST AND ORIGINAL; SUBSEQUENT:  
 RIGHTS OF..... 444

A. WHO IS; AND RIGHTS OF, AS SUCH.

1. The constitution and the law together give to the inventor, from the moment of discovery, an inchoate property therein, which is completed by suing out a patent. This inchoate right is exclusive. It can be invaded or impaired by no person, and no right can be acquired in it, without the consent of the inventor. *Evans v. Jordan*, 1 Brock., 252.—MARSHALL, Ch. J.; Va., 1813.

2. Whenever then any person, previous to a patent, constructs a machine discovered by another, he constructs it subject to the right of that other. His right to use it is qualified by the paramount right of the inventor to prescribe the conditions on which he shall use it. *Ibid.*, 252.

3. 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 im-

provements. *Smith v. Pearce*, 2 McLean, 178.—McLEAN, J.; Ohio, 1840.

4. Whoever first perfects a machine and makes it capable of useful operation, is entitled to a patent, and is the real inventor, though others may have previously had the idea and made some experiments toward putting it into practice. *Semble*, that he would be entitled to a patent, although the antecedent experiments of others were known to and used by him in perfecting his machine. *Washburn v. Gould*, 3 Story, 133.—STORY, J.; Mass., 1844.

5. At any rate, he is the inventor, and is entitled to a patent, who first brought the machine to perfection, and made it capable of useful operation. *Ibid.*, 133.

6. If a combination, the effect of which had been ascertained by A, is reduced to practice by a machine built by B, but at the request or by the order, and at the expense of B, it is in fact A and not B who reduced the combination or invention to practice. *Warner v. Goodyear*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1846.

7. To constitute an inventor, it is not necessary he should have the manual skill and dexterity to make the drafts of his invention. If the ideas are furnished by him for producing the result aimed at, he is entitled to avail himself of the mechanical skill of others to carry out practically his contrivance. *Sparkman v. Higgins*, 1 Blatchf., 209.—BETTS, J.; N. Y., 1846.

8. Where the plaintiffs devised designs for oilcloths, which were carried out by another, *Held*, that the plaintiffs, and not the pattern-maker, were the inventors. *Ibid.*, 209.

9. If a person *construct* a machine, in the absence of all evidence to the con-

trary, the presumption is, that he is also the *inventor*, and the burden of proof is thrown upon another claiming to be the inventor, to show that he suggested the idea, or made the invention. *Atkinson v. Boardman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

10. He who first discovers that a law of nature can be applied to produce a particular result, and having devised machinery to make it operative, introduces it to the knowledge of his fellow men, is a discoverer and inventor of the highest grade; and this title as a discoverer he may assert and secure by letters patent, not only in the formal device, but in the essential principle which his machine was the first to embody, to exemplify, to illustrate, to make operative, and to announce to mankind. *Parker v. Hulme*, 7 West. Law Jour., 423.—KANE, J.; Pa., 1849.

11. This is not to patent an abstraction, but is to patent the invention as the inventor has given it to the world, and to secure to the inventor the exclusive right to the discovery he imparted to the public. *Ibid.*, 423.

12. The right of an inventor does not depend upon the question whether the machine is more or less perfect, or whether slight modifications in the arrangement of the machinery, or in the finishing of the parts composing it, may or may not better accomplish the end sought to be attained; but upon the question whether the machinery constructed as described in the patent will or will not accomplish the end practically and usefully, in the way pointed out. If it will, the inventor is entitled to the protection granted by the government; and any one using the principle thus embodied is guilty of an infringement, however he may have perfected the ma-

chinery by superior skill in the mechanical arrangement and construction of the parts. Such perfecting is but the skill of the mechanic, not the genius of the inventor. *Parkhurst v. Kinsman*, 1 Blatchf., 497.—NELSON, J.; N. Y., 1849.

13. In order to entitle a person to the character of an inventor, he must not stop at unsuccessful experiments, but continue until he has brought out a machine producing a useful result. *McCormick v. Seymour*, MS.—NELSON, J.; N. Y., 1851.

14. A person to be entitled to the character of an inventor, must himself have conceived the idea embodied in his improvement. It must be the product of his own mind and genius, and not of another. *Pitts v. Hall*, 2 Blatchf., 234.—NELSON, J.; N. Y., 1851.

15. But in order to invalidate a patent on the ground that the patentee did not conceive the idea embodied in the improvement, it must appear that the suggestions, if any, made to him by others, would furnish *all* the information necessary to enable him to construct the improvement. In other words, the suggestions must have been sufficient to enable him to construct a complete and perfect machine. *Ibid.*, 234.

16. If they simply aided him in arriving at the useful result, and if, after all the suggestions, there was something left for him to devise and work out by his own skill and ingenuity, then he is, in contemplation of law, to be regarded as the first and original discoverer. *Ibid.*, 234.

17. On the contrary, if the suggestions and communications of another go to make up a complete and perfect machine, embodying all that is embraced in the patent subsequently is-

sued to the party to whom the suggestions were made, the patent is invalid, because the real discovery belongs to another. *Ibid.*, 234.

18. *Seem*, that improvements made by workmen, working under the pay of an inventor, and making experiments under his direction, are to be considered for the credit and benefit of such inventor. *Goodyear v. Day*, MS.—DICKERSON, J.; N. J., 1852.

19. It is when speculation has been reduced to practice—when experiment has resulted in discovery—and when that discovery has been perfected by patient and continued experiment—when some new compound, art, manufacture, or machine has been thus produced which is useful to the public, that the party making it becomes a public benefactor, and entitled to a patent. *Goodyear v. Day*, 2 Wall, Jr., 299.—GRIER, J.; N. J., 1852.

20. Where a person is engaged in producing some new and useful instrument or contrivance, and has embodied it into a machine and endeavored to reduce it to practice by experiment—if those trials fail—if he fail in success and abandon it, and give it up, that consideration affords no impediment to another person who has taken up the same idea or class of ideas, and who has gone on perseveringly in his studies, trials, and experiments, until he has perfected the new idea and brought it into practical and useful operation. He is the person—the meritorious inventor—who is entitled to the protection of the law. *Winans v. N. Y. & Har. R. R.*, 31 Jour. Fr. Inst., 3d. Ser., 322.—NELSON, J.; N. Y., 1855.

21. If a person having some vague idea of a principle make numerous trials and experiments, if those trials and

experiments do not result in such a knowledge upon his part as enables him to put in successful practice the idea of which he has such vague notion, he does not become an inventor in the sense of the patent law. *Ransom v. Mayor, &c.*, 1 Fisher, 270.—HALL, J.; N. Y., 1856.

22. Such a person has never embodied the principle so as to make it available for practical use; and the party who embodies the principle and makes it available for practical use, is the party who is entitled to a patent, and to protection. *Ibid.*, 270–271.

23. If a person conceives the result embraced in the invention, or the general idea of a machine upon a particular principle, and in order to carry his conception into effect, it is necessary to employ manual dexterity, or even inventive skill in the mechanical details and arrangements requisite for carrying out the original conception, in such cases, the first person will be the inventor, and the other the mere instrument through which he realizes the idea. *Wellman v. Blood; King v. Gedney*, MS. (App. Cas.)—MORSELL, J.; D. C., 1856.

24. In order to constitute a man an inventor, it is *generally* necessary that he must have exercised some inventive faculty or exertion of his own, though there may be cases in which an invention may be the result of pure accident. *Mathews v. Skates*, 1 Fisher, 607.—JONES, J.; Ala., 1860.

25. But the fact that an inventor may have received some ideas, hints or suggestions on the subject from others, will not prevent him from being considered an inventor, and entitled to a patent as such. To have that effect it must appear that the invention was substan-

tially communicated to him by some other person, so that without the exercise of any inventive power of his own he could have applied it to practice. *Ibid.*, 607.

26. Though others may have had similar ideas, and may have experimented upon them, the person who first perfected the idea and made it capable of practical use, is the inventor and entitled to a patent. *Ibid.*, 607.

#### B. FIRST AND ORIGINAL; SUBSEQUENT; RIGHTS OF.

1. The right to a patent belongs to him who is the first inventor, even before a patent is granted. *Evans v. Weiss*, 2 Wash., 345.—WASHINGTON, J.; Pa., 1809.

2. If an inventor suffer his invention to be used by the public, his patent will not be protected on the ground that he was the first inventor. *Whittemore v. Cutter*, 1 Gall., 482.—STORY, J.; Mass., 1813.

3. The first inventor is entitled to the benefit of his invention, if he reduce it to practice and obtain a patent therefor, and a subsequent inventor cannot, by obtaining a patent, oust the first inventor of his right, or maintain an action against him. *Woodcock v. Parker*, 1 Gall., 439.—STORY, J.; Mass., 1813.

4. The original inventor of a machine is exclusively entitled to a patent for it. *Odiorne v. Winkley*, 2 Gall., 53.—STORY, J.; Mass., 1814.

5. The first inventor is entitled exclusively to a patent-right, though a subsequent person may have also been an original inventor. The law gives the right, as among inventors, to him who is first in point of time. *Lowell v. Lewis*, 1 Mas., 190.—STORY, J.; Mass., 1817.

6. The first inventor who has put the invention in practice, and he only, is en-

itled to a patent. Every subsequent patentee, although an original inventor, may be defeated of his patent-right upon proof of such prior invention being put in use. The law adopts the maxim, *Qui prior est in tempore, potior est in jure*. *Bedford v. Hunt*, 1 Mas., 304. STORY, J.; Mass., 1817. (But see *post* 24, 25.)

7. To entitle a person to obtain a patent as a first inventor, it is not necessary for him to establish that he has put his invention into general use, or that he has made it generally known to artisans engaged in the same business. *Ibid.*, 305.

8. The intent of the statute, declaring it to be a good defence to an action for an 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 anterior to the supposed discovery of the patentee, was to guard against defeating patents by the setting up of a prior invention, which had never been reduced to practice. *Ibid.*, 304, 305.

9. If such prior invention was the mere speculation of a philosopher, a mechanic, which had never been tried by the test of experience, and never put in actual operation by him, the law would not deprive a subsequent inventor, who had employed his labor and his talents in putting it into practice, of the rewards due to his ingenuity and enterprise. *Ibid.*, 305.

10. But if a first inventor reduced his theory to practice, and put his machine or other invention into use, the greater or less use of it, or the more or less widely the knowledge of it might circulate, does not constitute a criterion by which to decide upon the validity

of any subsequent patent for the same invention. *Ibid.*, 305.

11. It is clearly immaterial whether experiments as to an invention are made by the inventor himself or by others; the question being, who is the original inventor? *Pennock v. Dialogue*, 4 Wash., 542.—WASHINGTON, J.; Pa., 1825.

12. Construing § 1 by § 6 of the act of 1793, the true meaning is, that the first inventor has a right to a patent, though there may have been a knowledge and use of the thing invented by others before his application for a patent, if such knowledge or use was not anterior to his discovery. *Mellus v. Silsbee*, 4 Mas., 111.—STORY, J.; Mass., 1825; *Treadwell v. Bladen*, 4 Wash., 708.—WASHINGTON, J.; Pa., 1827.

13. Under the language of § 6 of the patent law of 1793, a patentee can sustain his patent only on the ground of his being the original inventor. *Thomas v. Weeks*, 2 Paine, 99.—THOMPSON, J.; N. Y., 1827.

14. From an examination of the various provisions of the patent law, it clearly appears that it was the intention of the legislature, by a compliance with the requisites of the law, to vest an exclusive right in the inventor only, on condition that his invention was not known or used by the public. *Shaw v. Cooper*, 7 Pet., 319.—MCLEAN, J.; Sup. Ct., 1833.

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

16. A subsequent inventor, though an original inventor, is not entitled to

any patent, and no subsequent inventor has a right to deprive an original inventor of the right to use his own prior invention. *Ibid.*, 596, 597.

17. And if the invention is perfected and put into actual use by the first and original inventor, it is of no consequence, whether the invention is extensively known or used, or the knowledge and use thereof limited to a few persons, or even to the first inventor himself. *Ibid.*, 596, 598.

18. The decision in *Dolland's case*, (2 H. Black. R., 487), that he was entitled to a patent, as an inventor of the thing patented, though there was a prior invention thereof by another who kept it secret so that the public had no benefit thereof, though perhaps a correct exposition of the statute of monopolies, is not applicable to the patent laws of the United States. *Ibid.*, 598.

19. He is the first inventor in the sense of the patent law, and entitled to a patent for his invention, who has first perfected and adapted the same to use, and until the invention is so perfected and adapted to use, it is not patentable. *Ibid.*, 599.

20. In the race of diligence between two independent inventors, he who first reduces his invention to a fixed position and practical form, would seem to be entitled to a priority of right to a patent therefor. *Ibid.*, 599, 600.

21. But this right is qualified by § 15 of the act of 1836, which provides that in such cases the first inventor shall have the prior right, if he is using reasonable diligence in adapting and perfecting the same, although the second inventor has in fact first perfected the same and reduced the same to practice in a positive form. *Ibid.*, 600.

22. 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. *Hildreath v. Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

23. A patent issued to second inventor, before the application for a patent by the first inventor, which will bar the issuing of a subsequent patent to the first inventor, must be, comparing § 7 with §§ 6, 8, and 15 of the act of 1836, a patent issued prior to his *invention*, and not merely prior to his *application*. *Ibid.*

24. The dictum of STORY in *Bedford v. Hunt*, 1 Mas., 304, *ante* 6, that "the first inventor who has put the invention in practice, and he only is entitled to a patent," was founded on the words "*but had been in use*," in § 6 of the act of 1793, but these words have been carefully excluded from § 15 of the act of 1836. *Ibid.*

25. But the doctrine that he who first communicates an invention to the public and puts it in practice, and he only, is entitled to a patent, is not supported to its fullest extent by the cases, and does not apply to a first inventor who is using reasonable diligence in adapting and perfecting his invention, whose right is saved by § 15 of the act of 1836. *Ibid.*

26. If an invention be the mere speculation of a philosopher or mechanic in his closet, and he takes no step toward securing a patent, but keeps his invention a secret, and another person, who is also an original but subsequent inventor of the same thing, obtain

a patent for it and bring it into use, the patentee in a suit at law will be considered the first inventor. *Ibid.*

27. Whoever first perfects a machine and makes it capable of useful operation, is entitled to a patent, and is the real inventor, though others may have had the idea, and made some experiments toward putting it in practice. *Washburn v. Gould*, 3 Story, 133.—STORY, J.; Mass., 1844.

28. The fact that a party made a machine, is *prima facie* evidence that he was the first inventor of it. *Warner v. Goodyear*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1846.

29. Such an inference is however rebutted by the facts that in making the machine he was working in his trade as a machinist in the employ and for the benefit of another, for wages, and that he did not claim for some time to be the inventor of such machine, and stood by and saw his employer apply for and obtain a patent for it without objection. *Ibid.*

30. If A make a machine for B at B's request, for his benefit and at his expense, the presumption is that it was made according to B's directions, and the burden of proof is on A to show that it was not made according to B's directions. *Ibid.*

31. The first inventor is entitled to a patent, and will prevail over a subsequent one, though the subsequent invention may be made and used before letters patent are taken out for the first. *Allen v. Blunt*, 2 Wood. & Min., 140.—WOODBURY, J.; Mass., 1846.

32. If a patentee is not the first or original inventor, in reference to all the world, he is not entitled to a patent, even although he had no knowledge of the previous use or previous descrip-

tion of the invention. *Street v. Silver*, Brightly, 98.—ROGERS, J.; Pa., 1846.

33. The provisions of §§ 6 and 15 of the act of 1836, introduced an important modification into the law of patents, designed to protect the American inventor against the injustice of being thrown out of the fruits of his ingenuity, by the existence of a secret invention or discovery abroad—that is, a discovery not patented, and not described in any printed publication. *Anon.*, 5 Opin., 21.—TOUCEY, Atty. Gen., 1848.

34. A *bona fide* inventor in this country, and who believed himself to be the original and first inventor, at the time of his application, and did not know or believe his invention had before been known or used, is entitled to a patent for his invention, though the same invention may have been known and used in a foreign country, provided it had not been patented or described in any printed publication. *Ibid.*

35. In such a case the American inventor is, in contemplation of law, under the provisions of the act of Congress, the original and first inventor. The fact that an invention, not patented or described in any printed publication, has been before known and used in any foreign country, is immaterial, except so far as it may have come to the knowledge of the American inventor, and conflict with the oath he is required to take as an original inventor. *Ibid.*

36. If the applicant is an original inventor, and is in a condition to take the oath required, the act requires the Commissioner to issue the patent, the courts to declare it valid, and establish the American right, to the exclusion of the foreign discovery, which has not, in either of the modes indicated by the



act of Congress, been communicated to the public. *Ibid.*

37. Crude and imperfect experiments, equivocal in their results, and then given up for years, cannot be permitted to prevail against an original inventor, who has perfected his improvement and obtained his patent. *Parkhurst v. Kinsman*, 1 Blatchf., 494.—NELSON, J.; N. Y., 1849.

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

39. 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, 21.—SPRAGUE, J.; Mass., 1849.

40. The presumption of law is that a patentee is the first inventor of the thing patented to him, and the burden of proof is on the party denying it, to disprove the fact. *Pitts v. Hall*, 2 Blatchf., 231.—NELSON, J.; N. Y., 1851.

41. The question as to who is the first inventor, is, not who constructed the first machine, but who conceived, and gave practical form and effect to the arrangement which constitutes the improvement. *Ibid.*, 235.

42. It is not necessary, to protect a patentee as the first inventor, that he should have been the first one to suggest the possibility or probability of such discovery or invention. He may have profited by the experiments of others; but it gives them no right to claim a share of the honor or profits of the successful inventor. *Goodyear v. Day*, 2 Wall, Jr., 299.—GRIER, J.; N. J., 1852.

43. If A, claiming to be an inventor of a certain invention, stand by and hear another make claim to the same invention without asserting his own claim to such invention, the inference will be warranted that the principles of such invention were not, at that time, known to A. *Ruggles v. Young*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

44. He is the first inventor, who has first perfected and adapted the invention to use; but this position is subject to the qualification, that he who *invents* first shall have the *prior* right, if he is using reasonable diligence in perfecting and adapting the same, although the *second* inventor has in fact *first perfected* the same, and reduced it to practice in a positive form. *Marshall v. Mee*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1853.

45. A long course of mere fruitless experiments to reduce a principle to practice, will not be sufficient to prevent a subsequent original inventor, who has perfected his invention without knowledge of the prior invention, from receiving a patent. *McCormick v. Ketchum*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

46. But where a prior inventor has been using due diligence to perfect his invention and adapt it to practical use, his right will be preserved and protect-

ed, although his success may not be perfect. *Ibid.*

47. Under the proviso of § 15 of the act of 1836, an original inventor is entitled to receive a patent for his invention, even though he may not be a first discoverer in respect to such invention having been known in a foreign country, provided he believed himself to be the first inventor, and such foreign invention had not been patented, or described in any printed publication. *O'Rielly v. Morse*, 15 How., 110.—TANEY, Ch. J.; Sup. Ct., 1853.

48. The mere speculation of a philosopher or mechanic, never put into practice or operation, will not deprive a subsequent inventor, who has employed his labor and talents in putting it into practice, of the reward due to his ingenuity and enterprise. *Rich v. Lippincott*, 2 Fisher, 7.—GRIER, J.; Pa., 1853.

49. But if the first inventor reduced his theory to practice, and put his invention into use, the greater or less use of it, or the more or less widely the knowledge of its existence may circulate, will not constitute the criterion by which to decide upon the validity of any subsequent patent for the invention. *Ibid.*, 7.

50. The circumstance that a person has had an idea of improvement in his head, or has sketched it upon paper—and then gives it up—does not, in judgment of law, constitute or have the effect to constitute him the first and original inventor. *Winans v. N.Y. & Har. R. R.*, 31 Jour. Fr. Inst., 3d Ser., 322.—NELSON, J.; N. Y., 1855.

51. It is not the person who has only produced the idea that is entitled to protection as an inventor, but the person who has embodied the idea into a

practical machine, and reduced it to practice. He who has first done this, is the inventor who is entitled to protection. *Ibid.*, 322.

52. If the idea involved in the patented article had occurred to others, or had come to the patentee from others, still, if the patentee had been the first to give to that idea a useful and practical form, he will be considered the first inventor. *Teese v. Phelps*, 1 McAllis., 49.—MCALLISTER, J.; Cal., 1855.

53. When two persons are both inventors of the same thing, the one who perfected his invention first is protected by the law. *Allen v. Hunter*, 6 McLean, 322.—MCLEAN, J.; Ohio, 1855.

54. If an inventor does not use reasonable diligence to perfect his invention after the idea of it is conceived, and in the mean time another not only conceives the idea but perfects the invention, and practically applies it to public use, the latter is the first and original inventor, and a patent granted to the former will be void, as he is not the first and original inventor. *Ransom v. Mayor, &c.*, 1 Fisher, 272. HALL, J.; N. Y., 1856.

55. The cardinal principle upon which patent laws rest is, that an individual is only entitled to appropriate to his exclusive control that which he has by his original invention or discovery first made known and rendered useful. *Carr v. Rice*, 1 Fisher, 200.—BERTS, J.; N. Y., 1856.

56. To determine his exclusive title, it is necessary to ascertain what was before known to the public, and whether what he assumes to be his is really made so by being distinct from any thing before publicly used in that condition, and applicable to like purposes, and is rendered by means of his invention useful. *Ibid.*, 201.

57. He who first makes known sufficiently an invention, by describing it in words or drawings, will be considered the first inventor, and vested with an inchoate right to its exclusive use, which he may embody, perfect, and make absolute by proceeding to mature it in the manner which the law requires. *Hill v. Dunklee*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

58. In determining the question, under § 15 of the act of 1836, whether a patentee believed himself to be the first inventor of the thing patented, notwithstanding the actual existence of such thing in a foreign country, which however had not been patented or described, the defendant may give evidence that the patentee knew of the existence of the thing abroad, and in considering the fact whether he *believed* himself to be the first inventor, it is material to determine whether he was in fact the original inventor. *Forbush v. Cook*, 10 Mo. Law Rep., 664.—CURTIS, J.; Mass., 1857.

59. The first inventor is not he who made or perfected the first machine or instrument, but he who first conceived the idea, and so described it by words or drawings as to enable a skilful workman to bring it into useful, practical operation. *Davidson v. Lewis*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

60. Such a person will be protected against the claim of a subsequent inventor, who may have first made a machine or instrument, provided such first discoverer has been using due diligence in effecting the same end, and although he may have been unsuccessful in some of his experiments, if by following them up he at length succeeds. *Ibid.*

61. Although an inventor and patentee may not have reduced to practical

use and operation his invention, before the time the same thing may have been invented by another, if at the time of such subsequent invention, the first inventor was using reasonable diligence (§ 15 of the act of 1836) in adapting and perfecting the same, and did afterward in a reasonable time adapt and perfect the same, such subsequent invention will not deprive him of the benefits secured by his patent. *Bartholomew v. Sawyer*, MS.—INGERSOLL, J.; N. Y., Apr., 1859.

62. The true meaning of § 7 of the act of 1836 is, that a patent shall issue to an applicant and be valid, if he is the originator and author of a new invention or discovery, unless the thing invented by him has, prior to his alleged discovery or invention, been invented, or discovered, or used by some one else in this country; or unless the invention has been patented or described in some printed publication in this or some foreign country, prior to the alleged invention or discovery of the applicant; or unless said invention of the applicant had been in public use, or on sale with his consent and allowance, prior to his application for a patent, for more than two years. *Bartholomew v. Sawyer*, 4 Blatchf., 351.—INGERSOLL, J.; N. Y., Sept., 1859.

63. Though a machine is made and completed prior to the invention of another, and though such prior machine embodies the improvements or principles contained in the other, the inquiry for the jury is, whether the former was in point of fact a machine completed and reduced to practice in contradistinction to an experimental machine, or a machine made by the supposed inventor, in the prosecution of experiments and inquiries; and unless it appear that such machine was actually used as a

working machine, the jury are warranted in presuming that it is a mere experiment, and if so, it will not invalidate a patent, obtained by the other or subsequent inventor, provided such patentee was an original inventor, without knowledge of the former machine, and did not derive any of his invention from such other person. *Cahoon v. Ring*, 1 Fisher, 409.—CLIFFORD, J.; Me., 1859.

64. To entitle any person to an exclusive right, by virtue of a patent, he must be the first as well as the original inventor. *Johnson v. Root*, 1 Fisher, 364.—SPRAGUE, J.; Mass., 1859.

65. The person who clearly suggests an invention, or describes it, so that it can be practically applied, is entitled to a patent therefor, and not the one who first actually puts it in operation. *Stearnes v. Davis*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859.

66. The person who is the first to conceive and give expression to the idea of an invention, in such clear and intelligible manner that a person skilled in the business could construct the thing is entitled to a patent, provided he uses reasonable diligence in perfecting it. *Eames v. Richards*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

67. Where an inventor describes his invention to a mechanic, and directs him to construct it, he is entitled to a reasonable time for making experiments in order to perfect his invention, and such description and experiments, if successful, will be considered as sufficient evidence of an assertion of his right at the time he made them, although a subsequent inventor may first perfect the invention and obtain a patent therefor; and such prior inventor will be entitled to a patent. *Dietz v. Burnham*, MS. (App. Cas.)—MORSELL,

J.; D. C., 1859; *Gibbs v. Johnson*. *Ibid.*, 1860.

68. Mere conversations about the practicability of an improvement, or suggestions as to the manner in which it might be carried out or accomplished, will not of themselves defeat the claims to originality of him who perfects the idea and secures a patent. *Judson v. Moore*, 1 Fisher, 555.—LEAVITT, J.; Ohio, 1860.

69. Neither will experiments defeat, even if known to the patentee, if it appear that *he* has prosecuted such experiments to final success. *Ibid.*, 555.

70. But any information to a patentee sufficient to enable him to construct the thing itself, would destroy the originality of the invention. Such knowledge, however, must be definite and tangible, and sufficient of itself to enable the party to whom imparted to construct the thing. *Ibid.*, 555.

71. If an inventor who has obtained a patent is not the first to have conceived the ideas he claims, and to have adapted them to practical use, his patent is void. An invention belongs to the prior inventor, whether he has obtained a patent or not. *Winans v. Danforth*, MS.—NELSON, J.; N. Y., 1860.

72. The party who first conceives the idea or conception of an invention is entitled to a patent, provided he pursues his idea or conception and reduces it to practice within a reasonable time, though another may have first actually reduced the invention to practice. *Bev. Rub. Co. v. Wing*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

73. The first inventor is entitled to a reasonable time, to be judged of according to the circumstances of the particular case, in which to perfect his invention, without impairing his claim to priority. If he is using reasonable dili-

gence, he will not lose his right through another first making a working invention. *Appletons v. Chambers*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

74. An inventor who first perfects an invention, and applies for and obtains a patent for it, will not be deprived of his right to such patent by a more tardy and negligent inventor, who may have first conceived the idea of the invention, but did nothing toward reducing it to practice, or applying for a patent for it.

*Walker v. Forbes*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

75. Where A conceived the "idea" of an invention, but made no drawing of it for six or seven months, and in the mean time B had conceived the same invention, and had made a model of it, thus giving *physical form and shape* to his conception, *Held*, that B was to be considered as having first perfected his invention. *Ibid.*

76. If a person, after having the conception of an invention, is using due diligence to perfect it and reduce it to practice, he will still be deemed the first inventor, though another, who conceived the idea later, may have first perfected the idea by manufacturing the thing invented. *Hicks v. Shaver*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

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## JOINT INVENTION AND PATENT.

1. If, of two joint inventors of a machine, one of them, without the other relinquishing his interest to a joint interest in the patent right, obtains a patent in his own name, he will be deemed guilty of a fraud, and will in equity be considered as a trustee for the other.

*Reutgen v. Kanows*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

2. A joint patent may well be granted for a joint invention. An invention may be the result of the combined mental operations of two persons acting together. As neither could claim to be the sole inventor, the invention is joint, and they are jointly entitled to a patent.

*Barrett v. Hall*, 1 Mas., 472.—STORY, J.; Mass., 1818.

3. A joint patent cannot be sustained upon a sole invention of either of the patentees, for the patent act gives no right to a patent except to the inventor.

*Ibid.*, 473.

4. A joint patent for an invention is utterly inconsistent with several patents for the same invention by the same parties. No person can be at the same time the joint and sole inventor of the same invention. *Ibid.*, 473.

5. If several patents are taken out by several patentees for a several invention, and the same patentees afterward take out a joint patent for the same as a joint invention, the parties are not absolutely estopped by the former patents from asserting the invention to be joint; but the former patents are very strong evidence against the joint invention. *Ibid.*, 474.

6. Where two persons obtained several patents, and afterward obtained a joint patent for the invention patented in the several patents, and afterward covenanted together as to a division of their interests under such joint patent, *Held*, to an action of covenant brought by one of such joint patentees, that the other could not plead that neither was the inventor, or that separate patents had been issued to each. *Stearnes v. Barrett*, 1 Pick., 443, 447.—WILDE, J.; Mass., 1823.

7. And that after having obtained a joint patent, neither party could set up the prior separate patents, and neither was estopped by the separate patents from asserting that the invention was joint. *Ibid.*, 447.

8. If the circumstances are such as to show that two parties contributed to an invention, so as to make them joint inventors, a joint patent should be taken out. *Thomas v. Weeks*, 2 Paine, 103.—THOMPSON, J.; N. Y., 1827.

9. The man who reduces to practice the theory of another, who assists in the reduction of it to practice, cannot be considered as the sole inventor of the machine. *Arnold v. Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

10. If one suggest the mode of operation or the principle of a machine, and another reduces it to practice, neither can be considered as the sole inventor, but the invention is joint. *Ibid.*

11. One of two or more joint inventors is not *the* inventor, within the meaning of § 5 of the act of 1836, and if he applies for a patent, the Commissioner is bound to refuse it. *Ibid.*

12. Patents for inventions cannot, under § 6 of the act of 1837, issue jointly to the inventor as such, and to the assignee of a partial interest; but may issue to the assignee or assignees of the whole interest. *Anon.*, 4 Opin., 401.—MASON, Atty. Gen.; 1845.

13. A partial assignment before issue does not entitle the partial assignee to have the patent issued to him to the extent of his interest. *Ibid.*, 401.

14. If a patent is issued to two as their joint invention, such patent is *prima facie* evidence that the invention was joint, though the fact may be disproved at the trial. *Hotchkiss v. Green-*

*wood*, 4 McLean, 462.—McLEAN, J.; Ohio, 1848.

15. A joint interest in a patent does not make those interested partners. Some agreement becomes necessary to enable them to work the invention at their joint expense and for their joint benefit. *Parkhurst v. Kinsman*, 1 Blatchf., 496.—NELSON, J.; N. Y., 1849.

16. Proof of the declarations of a party claiming to be a joint inventor of an invention, and asserting such inventorship, made in the presence of the other joint inventor, and not denied, or impliedly admitted by him, will be sufficient to prevent the issuing of a patent to such other inventor, on an application without joining the former. *Yearsley v. Brookfield*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

17. The relation of copartners between joint patentees does not result from their connection as joint patentees, or between one of two joint patentees and the assignee of the other. The parties are simply joint owners or tenants in common, of the rights and property secured by the patent; and their rights, powers, and duties as respects each other are substantially those of the joint owners of a chattel. *Pitts v. Hall*, 3 Blatchf., 206.—HALL, J.; N. Y., 1854.

18. One joint owner of a patent can legally grant, assign, license, or sell only in respect to his own share or right; he cannot sell and give good title to his co-owner's right; and if he appropriates any portion of the exclusive right or common property to his separate use or benefit, either by a sale or use of the patented machine, it is in principle the same as a conversion, by destruction or sale, of the joint property by a tenant in common, and for which the other

## WHAT QUESTIONS DETERMINED BY.

tenant in common could maintain trover. *Ibid.*, 207, 208.

19. No satisfactory reason exists why the part owner of a patent-right cannot, like the part owner of a chattel, have his remedy by an action on the case against his coproprietor, for the exclusive appropriation of the joint property, in the same form as though the plaintiff were the sole owner and the defendant a stranger. *Ibid.*, 208.

20. In such an action against his co-owner for an infringement of the patent, he can recover his actual damages according to his interest in the patent, without regard to the amount which his coproprietor has received by means of the infringement. *Ibid.*, 208.

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

22. Neither can come into a court of equity and assert a superior equity, unless it has been created by some contract between them. None such existing, one tenant in common cannot enjoin the other from such use or sale. *Ibid.*, 524.

23. If the invention patented, as in a joint patent, is the sole invention of one of the patentees, and not the joint invention of both, the patent is void. *Ransom v. Mayor, &c.*, 1 Fisher, 269.—HALL, J.; N. Y., 1856.

24. A joint patent may be taken out by two persons for an improvement in a machine, the object of which is to produce a given effect, though such improvement may consist of two distinct and separate parts, and such parties may have separately invented such parts, the one inventing one part and

the other the other. *Wilson, Assignee of Aiken and Felthousen, v. Singer*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

25. But held by NELSON, J., in reference to this same patent, that of Aikens and Felthousen, that if each was an inventor of a distinct part, separate patents ought to have issued to each, and not a joint patent to the two; and that if so issued, the patent was void. *Potter v. Wilson*, 2 Fisher, 107.—NELSON, J.; N. Y., 1860.

## JURISDICTION

Of Courts, see COURTS; EQUITY.

Of Justices of Circuit Court of District of Columbia, see APPEALS, B. 3.

## JURY.

As to how far the jury may construe Patents, see PATENT, P. 4.

1. The jury are to determine whether the patentee is the first inventor; whether the defendants are using his invention; and whether improvements in a machine are in the principle, or form, or proportions of it. *Reutgen v. Kanows*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

2. Whether an invention is new and useful is a question for the jury. *Park v. Little*, 3 Wash., 197.—WASHINGTON, J.; Pa., 1813.

3. It is for the jury to decide whether there has been any dedication, by the inventor, of his invention to the public. *Whittemore v. Cutter*, 1 Gall., 482.—STORY, J.; Mass., 1813.

4. It is a question for the jury, whether the machine used by the defendant is substantially the same as that of the plaintiff; and whether the plaintiff's

## WHAT QUESTIONS DETERMINED BY.

patent has been surreptitiously obtained. *Odiorne v. Winkley*, 2 Gall., 55.—STORY, J.; Mass., 1814.

5. Where it becomes a matter of inquiry, whether the benefits of an invention are of sufficient consequence to be protected, it is proper to leave the question of utility to the jury. *Langdon v. De Groot*, 1 Paine, 204.—LIVINGSTON, J.; N. Y., 1822.

6. But if, on the plaintiff's own showing, the invention is useless, it may be doubted whether the court would transcend its limits, in deciding such question. *Ibid.*, 204.

7. The intent of the delay in applying for a patent, and whether the allowing an invention to be used without a patent, should not be considered an abandonment, is a question which should always be submitted to a jury. *Morris v. Huntington*, 1 Paine, 354.—THOMPSON, J.; N. Y., 1824.

8. In every case, it is a question for the jury, whether the change of form and proportion in an invention has produced a different effect, and is a new invention. *Davis v. Palmer*, 2 Brock., 310.—MARSHALL, Ch. J.; Va., 1827.

9. The question whether the acts or acquiescence of the party furnish, in the given case, satisfactory proof of an abandonment or dedication of the invention to the public, is one of fact rather than law. But when the facts are given, there does not seem any reason why the court may not state the legal conclusions deducible from them. *Pennock v. Dialogue*, 2 Pet., 16.—STORY, J.; Sup. Ct., 1829.

10. Priority of knowledge and use is a question of fact, which a jury may decide on the evidence of one witness. *Whitney v. Emmett*, Bald., 311.—BALDWIN, J.; Pa., 1831.

11. The knowledge of an inventor, or his acquiescence in the public use of his invention, may be presumed from circumstances; but this is a fact for the jury. *Shaw v. Cooper*, 7 Pet., 321.—MCLEAN, J.; Sup. Ct., 1833.

12. The jury are to judge, by an inspection of the models, and from the evidence, whether two machines differ in principle. *Smith v. Pearce*, 2 McLean, 179.—MCLEAN, J.; Ohio, 1840.

13. The question of the forfeiture or abandonment of an invention, is a question of fact for a jury on a trial at law. *Hildreth v. Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

14. Objections to a patent, that the specification does not sufficiently describe the invention—or that the invention is not new—that a renewed and the original patent are not for the same invention—or that the patent was obtained with a fraudulent intent—all involve matters of fact, which belong to the province of the jury, upon the evidence. *Carver v. Braintree Manuf. Co.*, 2 Story, 441.—STORY, J.; Mass., 1843.

15. Where witnesses differ as to the fact of infringement, the question will be submitted to a jury, either by an action at law, or an issue directed by chancery. *Brooks v. Bicknell*, 3 McLean, 262.—MCLEAN, J.; Ohio, 1843.

16. The question of the unreasonableness of the delay to enter a disclaimer, is a mixed question of law and fact, and must be decided by a jury, under the instruction of the court. *Brooks v. Bicknell*, 3 McLean, 449.—MCLEAN, J.; Ohio, 1844.

17. Whether a reissued patent is substantially for a different invention from the first patent, is a question of fact for a jury; but as by § 13 of the act of



## WHAT QUESTIONS DETERMINED BY.

1836, the Commissioner of Patents is authorized to issue a renewed patent, the inquiry afterward in regard to the surrender is limited to the fairness of the transaction—to the question of fraud in the surrender. *Stimpson v. West Chester R. R.*, 4 How., 404.—McLEAN, J.; Sup. Ct., 1845.

18. Whether the sale of an article before application for a patent will amount to an abandonment of invention, is a question for a jury in a trial at law. *Booth v. Garely*, 1 Blatchf., 249, 250.—NELSON, J.; N. Y., 1847.

19. It is a question of fact for the jury whether a departure, in a defendant's machine, from the arrangement of parts in a machine described in the plaintiff's patent, constitutes a material variation from the patentee's arrangement. *Blanch. Gun-Stock Co. v. Warner*, 1 Blatchf., 278, 279.—NELSON, J.; Ct., 1846.

20. It is for the court to decide whether the patent, in all substantial particulars, conforms to the requirements of the law; and it is for the jury to decide, whether, from the evidence, the description of an invention in a patent, is sufficiently full, clear, and exact to enable a skilful mechanic to construct the thing described. *Parker v. Stiles*, 5 McLean, 55.—LEAVITT, J.; Ohio, 1849.

21. It is the province of the court to decide what constitutes novelty, and of the jury to determine, from the evidence adduced, whether the patentee's invention is new. *Ibid.*, 60.

22. It is a question for the jury to determine, whether an alien patentee has put and continued on sale, the invention patented to him within eighteen months from the date of the patent. *Tatham v. Le Roy*, MS.—NELSON, J.; N. Y., 1849.

23. The question of identity between two opposing machines, is ultimately one of fact to be determined by the jury. *Tatham v. Le Roy*, 2 Blatchf., 485.—NELSON, J.; N. Y., 1852.

24. The question of fraud in the granting of a patent, will not be passed upon by the judge on appeal, but is to be tried by a jury. *Burlew v. O'Neil*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

25. Whether the defendant has constructed, used, or sold the thing patented to the plaintiffs, is a question of fact for the jury. *Winans v. Denmead*, 15 How., 338.—CURTIS, J.; Sup. Ct., 1853.

26. A question of infringement is one of fact, which it is the province of the jury to decide. *Rich v. Lippincott*, 2 Fisher, 5.—GRIER, J.; Pa., 1853.

27. The jury are to determine as to the novelty of the invention; and whether a renewed patent is for the same invention as the original patent; and whether an invention has been abandoned to the public; and whether two machines are identical, or are constructed and act on different principles. *Battin v. Taggart*, 17 How., 85.—McLEAN, J.; Sup. Ct., 1854.

28. It is the province of the jury, under the instruction of the court as to what the invention is, to determine whether such invention is new and useful. *Wintermute v. Redington*, 1 Fisher, 248.—WILSON, J.; Ohio, 1856.

29. Whether there is any novelty in an invention or arrangement of parts, is a question of fact for the jury to determine upon a view of all the evidence in the case. *Sickles v. Borden*, 3 Blatchf., 540.—NELSON, J.; N. Y., 1856.

30. Whether a reissued patent is for

the same invention as the original one, is a question of fact for a jury.—*Heilner v. Battin*, 27 Penn., 521, 524.—WOODWARD, J.; Pa., 1856.

31. The jury are to consider that the patent grants that which the court determines it to grant. *Serrell v. Collins*, MS.—INGERSOLL, J.; N. Y., 1857.

32. The question of identity is one of fact, to be determined by the jury upon the evidence before them, under the instructions of the court as to what in law constitutes a substantial identity. *Smith v. Higgins*, MS.—BETTS, J.; N. Y., 1857.

33. And it is exclusively the province of the jury to ascertain and determine whether the patentee is the original inventor of the invention described in the patent, and whether the patent embraces the thing used by the defendants. *Ibid.*

34. The question as to the materiality of any part of a combination is one for the determination of the jury upon the evidence. *Vance v. Campbell*, 1 Fisher, 485.—LEAVITT, J.; Ohio, 1859.

35. It is a question of fact for the jury whether the defendants have infringed the patent of the plaintiff. *Waterbury Brass Co. v. N. Y. & Brook. Brass Co.*, 3 Fisher, 52.—INGERSOLL, J.; N. Y., 1858.

36. The question of priority of invention is for the jury to determine. *Bartholomew v. Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

37. Whether an inventor has abandoned or surrendered his invention and whether this is sought to be proved from his declarations or acts, or from a forbearance or neglect to act or speak, is an inquiry or conclusion of fact for the jury to decide. *Kendall v. Winsor*, 21 How., 331.—DANIEL, J.; Sup. Ct., 1858.

38. The question of infringement is exclusively for the jury. *Judson v. Cope*, 1 Fisher, 625.—LEAVITT, J.; Ohio, 1860.

## LECTURES.

1. The author of lectures has a right of property therein, which is entitled to protection. Lectures may be taken down *verbatim*, and the person taking them down has a right to their use; but he may not print them. *Bartlett v. Crittenden*, 4 McLean, 304.—MCLEAN, J.; Ohio, 1847.

2. Any use of such lectures, which should operate injuriously to the lecturer would be a fraud upon him for which the law would give him redress. *Ibid.*, 304.

3. The author cannot claim any vested right in the ideas he communicates, but the words and sentences in which they are clothed belong to him. *Ibid.*, 304.

4. Lectures, oral or written, cannot be published without the consent of the author, though taken down when delivered. *Bartlett v. Crittenden*, 5 McLean, 42.—MCLEAN, J.; Ohio, 1849.

## LETTERS.

See also MANUSCRIPT.

1. The receiver of a letter has no right to publish it without the writer's consent. *Denis v. Le Clerc*, 1 Martin, 302.—MARTIN, J., La., 1811.

2. Unless there be a most unequivocal dedication of private letters and papers by the author, either to the public or some private person, the author has a

property therein and the copyright belongs exclusively to him. *Folsom v. Marsh*, 2 Story, 109.—STORY, J.; Mass., 1841.

3. *Semble*, that there is no distinction between letters of business, or of a mere private or domestic character, and letters which from their character and contents are to be treated as literary property. *Ibid.*, 109.

4. The author of any letters (and his representatives), whether literary compositions, or familiar letters, or letters of business, possess the sole and exclusive copyright therein; and no persons, neither those to whom they are addressed, nor other persons, have any right or authority to publish the same upon their own account or for their own benefit. *Ibid.*, 110.

5. But consistently with this right, the persons to whom they are addressed possess the right to publish such letters upon such occasions as require or justify the publication or public use of them—as to establish a personal right, or vindicate his character—but this right is strictly limited to such occasions. *Ibid.*, 110, 111.

6. In respect to official letters addressed to the government, or any of its departments, by public officers, the government may, perhaps, from principles of public policy, withhold them from publication, or give them publicity; but private persons have no right to publish them without the sanction of the government. *Ibid.*, 113.

7. 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 a copyright in literary productions, or of property in the paper on which they are written, similar to property in

stereotype or engraved plates. *Wetmore v. Scoville*, 3 Ed. Ch., 527.—McCOUN, V. Chan.; N. Y., 1842.

8. It will not exercise the power of preventing a 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.

9. Nor because they were written in confidence and their publication might wound the feelings. *Ibid.*, 529.

10. A court of equity will restrain the publication of letters written by the complainant, if such letters are in fact of any value to him as literary productions, or if his right to multiply copies is worth any thing to him. *Hoyt v. McKenzie*, 3 Barb. Ch., 324.—WALWORTH, Chan.; N. Y., 1848.

11. But otherwise as to such letters as have been written to him by other persons without any authority, express or implied, to publish them; as to such the right belongs to the writer. *Ibid.*, 324.

12. A letter cannot be considered of any value to the author, for the purpose of publication, which he would not consent to have published, either with or without a copyright. *Ibid.*, 324.

13. 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. *Ibid.*, 325.

14. The writer of private letters has a right of property in them, and their publication may be enjoined. They can only be used by the receiver for the purposes for which they were written, or in justification or defence. *Bartlett v. Crittenden*, 5 McLean, 42.—MCLEAN, J.; Ohio, 1849.

15. 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.

16. A court of equity cannot interfere by way of injunction to prevent the publication of private letters, *merely* 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.

17. Such an injunction cannot be granted, unless it appears that the personal legal rights of the party seeking the aid of the court are in danger of violation. *Ibid.*, 384.

18. The writer of letters, though written without any purpose of publication or profit, or any idea of literary property, possesses such a property in them that they can never be published without his consent, unless the purposes of justice, civil or criminal, require the publication. *Ibid.*, 390, 391.

19. The receiver of letters has only a special or qualified property, confined to the material on which they are written, and not extended to the letters as expressive of the mind of the writer. *Ibid.*, 393.

20. Neither the receiver of letters, nor any other person, has any right to publish such letters, without the consent of the writer. *Ibid.*, 393.

21. The property which the writer retains gives him an exclusive right to determine whether the letters shall be published or not; and when he forbids their publication, makes it the duty of

a court of equity to aid and protect him by an injunction. *Ibid.*, 393.

22. The receiver of a letter may publish it when its publication is shown to be necessary for the vindication of his rights or conduct; but this license has never been extended to a person whose possession of a letter, or of the copy of a letter, as acquired without the consent of the writer or receiver, is wholly unlawful. *Ibid.*, 406, 407.

23. But if a receiver attempts to publish such a letter, or any part thereof, against the wishes of the writer, and upon occasions not justifiable, a court of equity is bound to prevent such publication by an injunction. *Ibid.*, 406.

24. As against a stranger who has possessed himself of private letters, or copies thereof unlawfully, the right to restrain their publication is absolute—such person having no right to publish for any purpose whatever. *Ibid.*, 406.

25. Letters written by one person to another, either of business or friendship, and aside from the question whether they have any literary value, are property. *Eyre v. Higbee*, 22 How. Pr., 200.—MULLEN, J.; N. Y., 1861.

26. The property of the receiver of such letters is not absolute in them, but only special. Such letters will pass to the administrator of the person receiving them, but they are not assets, and cannot be made the subject of sale by him. *Ibid.*, 202, 202.

27. As regards private letters, the right of publication as one of literary property, remains for a reasonable length of time (to allow its assertion by publication) in the writer and his personal representatives. After such a period has elapsed, that there ceased to be a probability that such right to publish was treated as a legal right, any one

WHAT CONSTITUTES; RIGHTS UNDER; EFFECT OF.

may publish who can obtain copies. *Ibid.*, 207.—GOULD, J.

28. Whatever property there is in such letters rests in the writer, and not in the receiver. *Ibid.*, 208.—INGRAHAM, J.

29. The administrator of the receiver may however retain them, as he would a receipt or an account, to aid him in the settlement of the estate, if they had any bearing upon that subject. *Ibid.*, 208.

30. And if such letters are of such a character as in his opinion would be productive of injury (if published) to the writer or others, he may destroy them, and no one can call him to account therefor. *Ibid.*, 208.

LICENSE.

**A.** WHAT CONSTITUTES; RIGHTS UNDER; EFFECT OF TAKING..... 460  
**B.** RECORDING OF, AND TRANSFER OF... 464  
**C.** FORFEITURE OF; ACTIONS ON..... 466

**A.** WHAT CONSTITUTES; RIGHTS UNDER; EFFECT OF TAKING.

See also ASSIGNMENT, B.; EXTENSION OF PATENT, C.

1. Where A erected on his own premises and at his own expense a machine, the invention of B, and B then leased of A for a term of years the machine, covenanting to deliver the same to A at the end of the term, *Held*, that this amounted to a license or a consent in writing, under § 4 of the act of 1790, to use the machine after the end of such term. *Reutgen v. Kanows*, 1 Wash., 172.—WASHINGTON, J.; Pa., 1804.

2. An offer to take a license from a

patentee to use his invention, does not take away the right of the person making such offer to deny that the patentee was the original inventor. *Evans v. Eaton*, Pet. C. C., 347.—WASHINGTON, J.; Pa., 1816.

3. A patentee by an instrument agreed to “grant, bargain, sell, assign, and transfer to B., his executors, administrators, and assigns the right and privilege of making, using, and selling friction matches,” as patented, to have and to hold “the right and privilege of manufacturing the said matches, and to employ in and about the same six persons, and no more, and to vend said matches in any part of the United States.” A proviso followed that nothing therein contained should prevent or restrict the patentee from “making and vending the same, or of selling and conveying similar rights and privileges to others.” And B. was not to manufacture in certain places. *Held*, that such a conveyance was an authority or license coupled with an interest in its execution; but not so much a property or interest *in rem*, as a right of user for the benefit of the licensee. *Brooks v. Byam*, 2 Story, 543, 551.—STORY, J.; Mass., 1843.

4. Under the patent acts, if an inventor allow another to use his invention for a considerable time before applying for a patent therefor, and a patent is afterward obtained, such permission and allowance will justify the jury in presuming a license or grant from the patentee, and such person is not liable to an action of infringement for the continued use after the patent is granted. *McClurg v. Kingsland*, 1 How., 208.—BALDWIN, J.; Sup. Ct., 1843.

5. Under § 7 of the act of 1839, the person who has had the use of an in-

vention prior to the application of a patent therefor, is on the same footing as if he had a special license from the inventor, which, if given before the application for a patent, would justify the continued use after it issued, without liability. *Ibid.*, 209.

6. But the use of an invention before an application for a patent, must be the specific improvement then invented and used by the person who had purchased, constructed, and used the machine to which the invention is applied. *Ibid.*, 210.

7. Where a patentee assigned and released all his right, title, and interest in the letters patent, so far only as the exclusive right of manufacturing and vending for a term of years for a weekly consideration, and in case of default of payment, that the patentee was to have the right to claim and take back the interest, *Held*, that the agreement conveyed no interest in the patent-right, but that the grant amounted to a mere license, with a limitation or condition as to its continuance. *Armstrong v. Hanlenbeck*, 3 N. Y. Leg. Obs., 45.—BETTS, J.; N. Y., 1844.

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." *Washburn v. Gould*, 3 Story, 162.—STORY, J.; Mass., 1844.

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, 165, 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. The taking of a temporary license to use a patent-right cannot be considered as an acknowledgment of a right in the licensor beyond the termination of such license. *Rich v. Hotchkiss*, 16 Conn., 418.—WILLIAMS, Ch. J.; Ct., 1844.

12. Where it was stipulated between A and B that B should be entitled to use A's patent three days in a week until a given date, and that A would not prosecute any action against B for any former violation, provided B should not use such patent after the specified date, or by any other machine infringe A's right; *Held*, that such proviso, introduced by the plaintiff, and not placing any personal obligation on the defendant, did not operate as an estoppel against B to prevent him showing the truth in regard to the validity of the right of A. *Ibid.*, 419, 420.

13. If a licensee or grantee acknowledge, under his hand and seal, the validity of the grantor's title, *query*, is he not estopped from denying it? *Brooks v. Stolley*, 3 McLean, 526.—MCLEAN, J.; Ohio, 1845.

14. Where a party has an interest in only a part of a patent, as a license to use the invention patented, only in the manufacture of a particular kind of goods, he cannot maintain an action for

an infringement. *Suydam v. Day*, 2 Blatchf., 23.—NELSON, BETTS, JJ.; N. Y., 1846.

15. A license to run *one* machine will not be construed to mean an identical particular machine, unless it is so limited in express terms. *Wilson v. Stolley*, 4 McLean, 278.—MCLEAN, J.; Ohio, 1847.

16. A license or grant of an exclusive right to use a patented machine for a specified purpose, as a right to use Blanchard's patent for turning irregular forms, to turn lasts—does not convey any legal title to the patent. *Blanchard v. Eldridge*, 1 Wall, Jr., 339, 341.—GRIER, J.; Pa., 1849.

17. An agreement made by a patentee, and conveying to the grantee the exclusive right to make and vend the thing patented within a certain territory, but reserving to the grantor the right to make and sell within the same territory, is not an assignment of an exclusive interest in the patent, but is only a license. *Gayler v. Wilder*, 10 How., 495.—TANEY, Ch. J.; Sup. Ct., 1850.

18. The right to make a machine is distinct from that of using it. *Bicknell v. Todd*, 5 McLean, 238.—MCLEAN, J.; Ohio, 1851.

19. The right to use implies a right to repair, but not to construct. It also implies a right to purchase, when the one in use is worn out or destroyed. *Ibid.*, 239.

20. Declarations on the part of an inventor that he does not intend to take out a patent, but to let the public have his invention, are equivalent to a license, and such party or any one holding under him will be estopped from asserting his right as against a person acting on the faith of such declarations. *Pitts v.*

*Hall*, 2 Blatchf., 237, 238.—NELSON, J.; N. Y., 1851.

21. An agreement made between B. and C. and others, providing for the settlement of various matters, the discontinuance of certain suits, and also as to the manufacture of a certain article, as follows: "that the said parties may each hereafter manufacture and vend spike of such kind and character as they see fit, notwithstanding their conflicting claims to this time," must be construed with reference to the situations of the parties to it; and B. having claimed that he had the exclusive right, under his patent, to make such spikes, which right the defendant C. was infringing, but the defendant claiming that he did not infringe such patent, but made such spikes by an entirely different method; *Held*, that such agreement did not give C. a license to make such spikes after B.'s patent, but only a right to make them by the same process or machinery he had been before using. *Troy Iron and Nail Fac. v. Corning*, 14 How., 213.—WAYNE, J.; Sup. Ct., 1852. [Overruling same case below, 1849; 1 Blatchf., 470.]

22. 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. *Pitts v. Jameson*, 15 Barb., 315.—JOHNSON, J.; N. Y., 1853.

23. 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. It is, however, a chose in action, not in possession, and the grantee and his assigns can retain the right only so long as the business is prosecuted under it. *Ibid.*, 315.

24. Whenever the business is abandoned, the rights secured by the contract revert to the grantor. Then, but not till then, the grantor can sell rights to third persons to make, sell, and use the patented machine in such territory, without being responsible to the grantee or his representatives for damages. *Ibid.*, 316.

25. The reservation by the grantor is also a mere personal privilege, and not transferable to others. *Ibid.*, 316.

26. Upon the death of the grantee, the contract and the rights under it go to his administrators as assets. *Ibid.*, 316.

27. But though they had no right, as administrators, to carry on the business of making machines under the contract, they could sell and transfer the right, and the purchaser would acquire all the rights secured to the intestate during his lifetime, if the business is carried on. *Ibid.*, 316.

28. G. made an agreement with B. as follows: "In consideration of one dollar, I engage to grant to B. license to manufacture, under my patents and improvements, india-rubber hose, in general, except that made of pure gum. In the event of the right of said hose being disposed of, said B. is to receive one-half the bonus obtained therefor, it being optional with him to retain, if he prefers it instead, a half right to manufacture;" *Held*, that such agreement embraced a reissued patent; and that B. obtained an immediate right to manufacture, and not merely an obligation for a

future right; and that B. could recover of G. one-half of any sales made by G. of the right to make such hose, and that B. became entitled to such moiety, immediately upon any such disposal. *McBurney v. Goodyear*, 11 Cush., 571, 572.—MERRICK, J.; Mass., 1853.

29. Under § 14 of the act of 1836, an action at law is properly brought in the name of the patentee, in behalf of a licensee who is damaged by the infringement. *Goodyear v. McBurney*, 3 Blatchf., 33.—NELSON, J.; N. Y., 1853.

30. A party has no authority to grant licenses under a patent upon a mere agreement with the patentee to assign such patent. The patent must be actually assigned to such party before he can grant licenses. *Day v. Hartshorn*, MS.—PITMAN, J.; R. I., 1854.

31. One tenant in common in a patent has as good a right to use, and to license others to use the thing patented as the other tenant in common has. *Clum v. Brewer*, 2 Curt., 524.—CURTIS, J.; Mass., 1855.

32. A licensee under a patent is one who has transferred to him, in writing or orally, a less or different interest in such patent than either the interest in the whole patent, or an undivided part of such whole interest, or an exclusive sectional interest. *Potter v. Holland*, 4 Blatchf., 211.—INGERSOLL, J.; NELSON, J., concurring; Ct., 1858.

33. A licensee has no legal right, as an assignee, to surrender a patent, and a surrender without his concurrence is valid. *Ibid.*, 209.

34. Nor can a mere licensee bring an action at law for a violation of the patent. *Ibid.*, 211.

35. A licensee is, however, entitled to the same right under a reissued that he had under the old patent; but he can-



not be compelled to take under the new, and give up his right under the old one. *Ibid.*, 214.

36. A contract of license is like every other contract, and depends upon a fair construction of the acts of the parties. *Bell v. McCullough*, 1 Fisher, 381.—LEAVITT, J.; Ohio, 1858.

37. The sale of a machine, and the right to use a patented article with it, imports a license to use the article patented; and such license is not within the provisions of § 11 of the act of 1836, which require an assignment or grant to be in writing. *Buss v. Putney*, 11 Mo. Law Rep., 687.———, J.; N. H., 1858.

38. A licensee may bring, for his own benefit, an action in the name of the patentee, but the nominal plaintiff can require indemnity for costs. *Goodyear v. Bishop*, 4 Blatchf., 439.—NELSON, J.; N. Y., 1860.

39. The mere taking a license does not estop the licensee denying the validity of a patent. *Mitchell v. Barclay*, MS.—SHIPMAN, J.; N. Y., 1860.

40. Covenants in a license as to the use or disposal of the products of a patented machine or process, are binding only upon the parties to it, and the public, or a purchaser of the products, cannot be compelled to notice or regard such agreements, or the rights conferred or reserved by them. *The Washing Machine Co. v. Earle*, 2 Fisher, 205.—GRIER, J.; Pa., 1861.

41. A stranger purchasing the product from one licensed to use the process, need look no further, and may use it for his own purposes without inquiring for or regarding any private agreement of licensors not to compete with one another. *Ibid.*, 206.

42. Where a patentee granted to an-

other the exclusive right to make and sell his patented invention, within a certain territory, for which he was 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; and that an action was rightly brought in the name of the patentee, and not in the name of the grantee. *Hussey v. Whiteley*, 2 Fisher, 123.—LEAVITT, J.; Ohio, 1861.

## B. RECORDING, AND TRANSFER OF.

1. 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.

2. Under § 11 of the patent act of 1836, a mere license, or a grant of a right or privilege under a patent, to be used concurrently with the patentee, or any other grantees under him, and which is not an exclusive right, need not be recorded. *Brooks v. Byam*, 2 Story, 541, 542.—STORY, J.; Mass., 1843.

3. And it is not necessary that a subsequent purchaser of the patent should have notice of such a license. *Ibid.*, 543.

4. Whether the entirety of a license or privilege is capable of being assigned, even though the word "assigns" may be used, if it was intended as a personal privilege; *query*. *Ibid.*, 544. [And see *post* 15.]

5. But though a right or license may be transmissible, it seems not to be ap-

portionable, unless it is very clear from the instrument that such was the intent and meaning of the parties. *Ibid.*, 544, 551.

6. Every conveyance of such sort must, however, be decided upon its own terms and objects, according to the true intent and meaning of the parties to it. *Ibid.*, 550.

7. In this case, *Held*, that the license was an entirety, and incapable of division, or of being broken up into parts, in the possession of different persons. If assignable, the assignment must be of the entirety of the license to the assignee, and it cannot be apportioned among different persons in severalty. B. could not, therefore, sell to C. a right to manufacturing matches, to the amount of *one* right, embracing *one* person. *Ibid.*, 552.

8. The right or license to use a machine is assignable to a third person. *Woodworth v. Curtis*, 2 Wood. & Min., 527.—WOODBURY, J.; Mass., 1847.

9. A machine, and the right to use it, is personal property more particularly than a mere patent-right; and has all the incidents of personal property, making it subject to pass by sale. *Ibid.*, 527.

10. Where a machine, or right to use a machine, is sold before the original patent has expired, the use of such machine then in operation, may be continued until it is worn out or destroyed. *Ibid.*, 528.

11. The right to use such particular machine, and the machine, after the term expires, may pass by sale, devise, levy, or assignment of an insolvent's effects. *Ibid.*, 530.

12. Where one licensed to run a patented machine, sells such machine, the license to run does not necessarily pass

with such machine. *Wilson v. Stolley*, 4 McLean, 278.—McLEAN, J.; Ohio, 1847.

13. A license to use a patented machine may be assigned, it not being a mere personal privilege. *Wilson v. Stolley*, 5 McLean, 2.—McLEAN, J.; Ohio, 1849.

14. In such case the assignee is bound to perform the conditions of the license; and the same rule applies to the assignee of the licensor. *Ibid.*, 2.

15. The difference is well understood, between licenses which may be assigned or used for others, and those which the licensees could only personally use without being transmissible by them to others. *Troy Iron & Nail Factory v. Corning*, 14 How., 216.—WAYNE, J.; Sup. Ct., 1852.

16. A mere license to a party, without having his assigns, or equivalent words to them, showing that it was meant to be assignable, is only a grant of a personal power to the licensees, and is not transferable by him to another. *Ibid.*, 216.

17. When a license is granted to any one to use a patent, which license is accompanied with an obligation in favor of the patentee, on the part of the one to whom it is granted, to do or not to do a particular thing, which obligation is the consideration upon which the license is granted, the licensee or his assigns must perform such obligations, and if he will not, an injunction will be granted to restrain him from any further right to use the patent. *Goodyear v. Day & Congress Rub. Co.*, 3 Blatchf., 455.—INGERSOLL, J.; N. Y., 1856.

18. Where D. had an exclusive license to use the patent of G. for a particular purpose, covenanting not to use it for other purposes, and to pay a speci-

## FORFEITURE OF; ACTIONS RESPECTING.

fied tariff for such use, and C. took an assignment of such license, *Held*, 1. That C. took the license subject to the obligation to pay the specified tariff on what he should make under it; and 2. That the bill was sufficient to compel C. to pay to G. the tariff due for his use of the license, or be enjoined from its use. *Ibid.*, 455.

### C. FORFEITURE OF; ACTIONS RESPECTING.

1. A person agreed with a patentee to pay him a certain sum on every patented article manufactured by him. The patentee brought his action for money had and received; *Held*, that the jury might infer the receipt of money from the fact of the sale of the article. *Stanley v. Whipple*, 2 McLean, 43.—McLEAN, J.; Ohio, 1839.

2. And although the contract was special, yet if it appear to be executed, and not open and subsisting, it is a well settled principle that the plaintiff may recover on the general count for money had and received. *Ibid.*, 44.

3. The bringing of an action to recover the arrears due under a license to use a patent, does not reaffirm the license after default and notice of the termination of the license. *Armstrong v. Hanleinbeck*, 3 N. Y. Leg. Obs., 45.—BETTS, J.; N. Y., 1844.

4. And the patentee may have an injunction to restrain the further use of the privilege, notwithstanding such action and a judgment thereon, as it is not a waiver of the forfeiture. *Ibid.*, 445.

5. The non-payment of the agreed consideration, as stipulated, works a forfeiture of the license. *Ibid.*, 445.

6. Under the laws prior to 1836, a

license or assignment expired with the limitation of the original patent, unless it was expressly in terms so granted as to be applicable to any renewal of the patent afterward. *Washburn v. Gould*, 3 Story, 135.—STORY, J.; Mass., 1844.

7. If a license to use a patented machine be conditional, such conditions must be performed, or there is no right to the use. *Brooks v. Stolley*, 3 McLean, 526, 528.—McLEAN, J.; Ohio, 1845.

8. The use of the machine under such circumstances is an infringement, and may be enjoined. *Ibid.*, 528.

9. An alleged violation of the contract of license by the patentee or complainant does not give any right of use to the defendant. *Ibid.*, 527.

10. To entitle a licensee to the benefit of the license, it is incumbent on him to do all which he is bound to do; but if he fail in the strict performance by reason of the act of the licensor, he will be equally entitled to the use of the machine as if he had literally and fully performed his part of the contract. *Ibid.*, 528.

11. But if the licensee has failed to perform the conditions of the license, he has no pretence of right to the use of the thing, and has no claim in law or equity either to its use or for damages. *Ibid.*, 528.

12. Where a license was granted to construct and use a patented machine for the consideration of certain notes given by the licensee, with the agreement that in case such notes were not paid, the license should be void; *Held*, that it was optional with the grantor to enforce the collection of the notes, or treat the rights of the licensee as forfeited under the stipulation, and an injunction was granted to restrain the

further use, unless the notes were paid. *Woodworth v. Weed*, 1 Blatchf., 165, 166.—NELSON, J.; N. Y., 1846.

13. The stipulation is to be treated as a double security given by the licensee to the grantor for the payment of the consideration money. *Ibid.*, 166.

14. To an action of covenant upon an agreement which granted a license to make and vend a patented article, the licensee agreeing to keep an account of the articles manufactured, and to pay a fixed price per pound on those sold, it is no defence that the patent is invalid. *Wilder v. Adams*, 2 Wood. & Min., 331.—WOODBURY, J.; Mass., 1846.

15. But if the covenant was against public policy, or where the plaintiff had acted fraudulently in taking out the patent, it seems such a defence would be admissible. *Ibid.*, 332, 336.

16. A forfeiture of a license may be enforced according to its terms by reason of the abandonment or neglect of the licensee. *Wilson v. Stolley*, 5 McLean, 2.—MCLEAN, J.; Ohio, 1849.

17. Where the license contains a provision that a failure to act under it for a certain time should be an abandonment, a formal notice from the licensor is not necessary, that he considers such a failure an abandonment. *Ibid.*, 2.

18. A contract to use a patented machine during the continuance of the patent, and to pay therefor a fixed proportion of the value of the fuel saved thereby, will not support an action until the expiration of the patent. *Wash., Alex., &c., Steam Pack. Co. v. Sickles*, 10 How., 441.—GRIER, J.; Sup. Ct., 1850.

19. It is an entire contract; but if the defendants had agreed to pay by instalments at the end of certain times, an

action would lie for every breach, as occurring. *Ibid.*, 441.

20. If the conditions of a license are violated, strictly all right and title under it are forfeited, and an injunction will issue to restrain the further use of the thing granted, if such injunction is applied for during the violation. *Wilson v. Sherman*, 1 Blatchf., 538, 540.—NELSON, J.; N. Y., 1850.

21. But such an injunction will not be granted if the violation has been discontinued, and if it appears the licensee was guilty of the violation under misapprehension of his rights under the license. *Ibid.*, 540.

22. Upon the breach of the conditions of a license, the patentee or licensor has a right to avoid the contract and be remitted to his original rights, and prosecute the licensee for an infringement of the patent. *Woodworth v. Cook*, 2 Blatchf., 160.—NELSON, J.; N. Y., 1850.

23. In such case also the licensee is remitted to his original rights and position, as the contract must be avoided altogether, if at all. It cannot be obligatory upon one party and not upon the other. *Ibid.*, 160.

24. Where the party had the right to use two machines under a right acquired during the original term, and afterward took a license under an extended term, and upon an alleged non-performance of the conditions of such license, an action for an infringement was brought by the patentee, or his assignee, *Held*, that the licensee, under the decision on *Wilson v. Rosseau*, 4 How., 646, could set up a right to continue the use of such two machines, as having been in use when the first term of the patent expired. *Ibid.*, 161.

25. Where a patentee, G., gave to a person, D., an exclusive right or license

## FORFEITURE OF; ACTIONS RESPECTING.

to use his, G.'s, patented invention, for a certain consideration or tariff, G. agreeing, however, to take up and cancel all other licenses granted by him, and there being a covenant between G. and D., that in the event of others claiming grants and using such invention, and thereby impairing the profits which would accrue to D. that then such tariff should cease, *Held*, in an action of covenant for non-payment of such tariff, and other non-compliances, that it was a good defence that others used the invention and impaired the right of D., and that it was of no consequence whether G. was unable to restrain other parties from such use, or whether it was to his advantage or not to do so. *Goodyear v. Day*, MS.—GRIER, J.; N. J., 1850.

26. 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. Jameson*, 15 Barb., 317.—JOHNSON, J.; N. Y., 1853.

27. Where a licensee undertakes to use a patent without paying for it the amount specified in the license, equity will so far enjoin him—whether the license thereby becomes voidable at law or not—that unless he will pay he shall not be allowed to use. *Day v. Hartshorn*, 3 Fisher, 42.—PITMAN, J.; R. I., 1855.

28. G., a patentee gave an exclusive license to D., to use his patent for a specified purpose only, D. covenanting not

to use it for any other purpose, and to pay a specified tariff for such use. D. used the patent for other purposes. G. then sued D. in New Jersey to restrain such use, and obtained a decree and an order for an accounting. After such decree was rendered, C. with a knowledge of it took from D. an assignment of his license and went on making the article permitted by it, but refused to pay to G. what was due from D. on account of tariff fees under the license, or what was due by D. for violating the patent. G. then filed a bill against D. and C. to set aside the assignment of the license as void, or that it be permitted to stand only on the condition that C. pay to G. what D. owed for tariff fees, and for the breach of the covenants of the license. *Held*, on demurrer: 1. That G. had no lien on the agreement or license to secure the tariffs stipulated therein, and that therefore the bill set up no title or equity as against C. as respects the amount due from D. at the time of the assignment of the license. 2. That the unpaid tariffs due from D. to G. afforded no ground for enjoining C. from acting under the license, and that it was not material as respects G. whether the assignment was fraudulent or not, and that the bill could not be sustained as against C. to aid in enforcing the decree against D., or to collect from D. the amount of tariff which was due from him at the time of the assignment of the license to C. *Goodyear v. Day & Cong. Rub. Co.*, 3 Blatchf., 453.—INGERSOLL, J.; N. Y., 1856.

29. 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. *Ibid.*, 454.

30. The mere 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.*, 454.

31. If a licensee use the thing patented beyond the limits of the license or grant, or in a way not authorized thereby, then there is a violation of the rights secured to the patentee. *Ibid.*, 454.

## LIMITATIONS.

A. OF APPLICATIONS FOR PATENTS.....	469
B. OF APPEALS TO JUSTICES' CIRCUIT COURT.....	469
C. OF COMMENCING ACTIONS.....	469

### A. APPLICATIONS FOR PATENTS.

1. 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 amounts 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.

2. 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.—WOODBURY, J.; Mass., 1846.

3. 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.

4. 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. *Perry v. Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

5. 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. Schenec. & Troy R. R.*, 2 Blatchf., 291, 300.—NELSON, CONKLING, JJ.; N. Y., 1851.

6. 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.

### B. OF APPEALS TO JUSTICES' CIRCUIT COURT.

1. There is no limitation of time as to an appeal from a decision of the Commissioner of Patents to the justices of Circuit Court. *Janney's Appeal*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

### C. OF COMMENCING ACTIONS.

1. There is no act of Congress limiting the time in which a suit may be brought for an infringement of a patent-right. *Parker v. Hallock*, MS.—GRIER, J.; Pa., 1858.

2. The *two* years' limitation in which to bring suits for penalties, prescribed in the Crimes act of 1790, is repealed by implication by § 4 of the act of 1839, which enacts that suits for penalties or forfeitures must be brought within *five* years from the time when the penalty or forfeiture accrued. *Stimpson v. Pond*, 2 Curt., 503, 504.—CURTIS, J.; Mass., 1855.

LOST ARTS.

See ARTS, Lost.

MACHINE.

- A. WHEN PATENTABLE; PRINCIPLES OF; IDENTITY OF..... 470
- B. PRINCIPLES OF, AND MODES OF APPLICATION; HOW EXPLAINED AND DESCRIBED 472

A. PATENTABILITY OF; PRINCIPLES OF; IDENTITY OF.

See also FORM; IMPROVEMENT; INVENTION; A., E.

1. If the principles of a machine are new, either to produce a new or an old effect, the inventor is entitled to the exclusive right of the whole machine. The intrinsic difficulty is to ascertain in complicated cases, the exact boundary between what was known and used before, and what is new in the *mode of operation*. *Whittemore v. Cutter*, 1 Gall., 480, 481.—STORY, J.; Mass., 1813.

2. By the principles of a machine (as these words are used in the statute) is not meant the original, elementary principles of motion, which philosophy and

science have discovered, but the *modus operandi*, the peculiar manner or device of producing any given effect. *Ibid.*, 481.

3. The opinions of skilful witnesses, whether the principles of two machines are the same, are competent evidence in a patent cause. But care should be taken to distinguish what is meant by a principle, the true, legal meaning of which, in respect to a machine, is, the peculiar structure or constituent parts of such machine. And in this view the question may be very properly asked, in cases of doubt and complexity, of skilful persons, whether the principles of two machines be the same or different. *Barrett v. Hall*, 1 Mas., 470.—STORY, J.; Mass., 1818.

4. The principles of two machines may be the same, although the form or proportions may be different. They may substantially employ the same power in the same way, though the external mechanism be apparently different. On the other hand, the principles of two machines may be very different, although their external structure may have great similarity in many respects. *Ibid.*, 471.

5. The meaning of the terms "an improved machine," or "an improvement on a machine," is substantially the same. *Ibid.*, 476.

6. The distinction between a machine and an improvement on a machine, or an improved machine, is too clear for them to be confounded together. *Evans v. Eaton*, 3 Wheat., 516.—MARSHALL, Ch. J.; Sup. Ct., 1818.

7. There is no substantial difference between a patent for an improvement on a machine, or a patent for an improved machine. *Ibid.*, 517.

8. A machine, and an improvement

on a machine, or an improved machine, must not be confounded: a grant of the exclusive use of an improvement in a machine, principle, or process, is not a grant of the improvement only, but the improved machine: an improvement on a machine and an improved machine are the same. *Whitney v. Emmett*, Bald., 314.—BALDWIN, J.; Pa., 1831.

9. Principle, in machines, is not a new mechanical power—none such have been discovered for centuries. That is a principle, which applies, modifies, or combines mechanical powers to produce a certain result. *Smith v. Peurce*, 2 McLean, 178.—MCLEAN, J.; Ohio, 1840.

10. When a patent is obtained for *parts* of a machine involved with other parts which may have been used before, it is essential that the *new parts* should be so distinctly pointed out that the claim may not cover any parts that are old. *Blake v. Sperry*, 2 N. Y. Leg. Obs., 255.—JUDSON, J.; Ct, 1843.

11. A machine, in order to give a party a claim to a patent therefor, must be substantially new. The machine must be new, not merely the purpose to which it is applied. *Bean v. Smallwood*, 2 Story, 411.—STORY, J.; Mass., 1843.

12. The principle of a machine means the operative cause by which a certain effect is produced. If a machine is formed by a combination of certain mechanical powers, such combination of these powers is the principle of the machine. When a similar effect is produced by a combination of the same mechanical powers, though the machines may be somewhat different in their structure, in principle they are the same. *Brooks v. Bicknell*, 3 McLean, 451.—MCLEAN, J.; Ohio, 1844.

13. A machine is patentable only when it is substantially new. *Tyler v.*

*Deval*, 1 Code Rep., 30.—McCaleb, J.; La., 1848.

14. The mere application of an old machine to a new process is not patentable. *Ibid.*, 30.

15. The word *principle* means the operative cause, by which a certain effect is produced; the combination of certain mechanical powers; the mode of operation. Upon this question of principle we may arrive at a correct conclusion by ascertaining what is the result which the invention is designed to produce. Whatever is essential to produce the appropriate result of a machine, independent of its mere form, is a matter of principle. *Olcott v. Hawkins*, 2 Amer. Law Jour., N. S., 329.—MILLER, J.; Wis., 1849.

16. The word principle, as applied to mechanics, is where two machines or things are made to operate substantially in the same way, so as to produce the same result; as where any of the mechanical powers, the lever, screw, wheel, &c., are used to accomplish certain purposes, the same powers being used in a somewhat different form, to do the same thing, will not be a difference in principle. *Roberts v. Ward*, 4 McLean, 566.—MCLEAN, J.; Mich., 1849.

17. Whether the mechanical instruments be larger or smaller, whether their action be horizontal or vertical, the principle is the same. *Ibid.*, 566.

18. Machines may be regarded merely as devices, by the instrumentality of which the laws of nature are made applicable and operative to the production of a particular result. *Parker v. Hulme*, 7 West. Law Jour., 422.—KANE, J.; Pa., 1849.

19. The principle of a machine is the particular means of producing a given result by a mechanical contrivance.



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

20. Invention, as it respects machines, is any *new arrangement or combination* of machinery, whether of old or new parts or materials, producing in its arrangement and combination a useful result. *McCormick v. Seymour*, MS.—NELSON, J.; N. Y., 1851.

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

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

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

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

25. The word "machine" in the statute includes new combinations as well as new organizations of mechanism, and hence there may be a patent for new combinations of machinery to produce certain effects, whether the machines constituting the combination be new or old. In such a case, the patent is not for an abstract principle, but for the particular application of the principle which the patentee professes to have made. *Wintermute v. Redington*, 1 Fisher, 247.—WILSON, J.; Ohio, 1856.

26. By the term "principle" of a ma-

chine is understood its mode or manner of operation, and hence there may be two structures widely different in appearance or dimensions, and yet identically the same in principle. *Latta v. Shack*, 1 Fisher, 470.—LEAVITT, J.; Ohio, 1859.

27. Principle is often applied to a machine to describe its movements and effects. *Le Roy v. Tatham*, 22 How., 139.—MCLEAN, J.; Sup. Ct., 1859.

28. A new machine, which accomplishes the same end as a former one, but by substantially different means, is patentable. *Eames v. Cook*, 2 Fisher, 151.—SPRAGUE, J.; Mass., 1860.

29. The principle of a machine has reference to its mode of operation, not to any abstract principles involved in its proportions or motion. *Judson v. Cope*, 1 Fisher, 625.—LEAVITT, J.; Ohio, 1860.

## B. PRINCIPLES OF AND MODES OF APPLICATION, HOW EXPLAINED AND DESCRIBED.

1. The patent act of 1793 does not limit the inventor to one single mode or one single set of ingredients to carry into effect his invention. He may claim as many modes as he pleases, provided always that the claim is limited to such as he has invented, and as are substantially new. *Ryan v. Goodwin*, 3 Sumn., 521.—STORY, J.; Mass., 1839.

2. And § 3 of the act requires, in the case of a machine, that the inventor shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions. And the same enactment exists in § 6 of the act of 1836. *Ibid.*, 521.

3. This section seems clearly to show that a patentee may lawfully unite in

## ARTICLE OF; WHEN PATENTABLE.

one patent all the modes of applying his invention contemplated, and all the different sorts or modifications of machinery by which it may be applied, and if such were new, the patent would reach them all. *A fortiori*, this rule is applicable where each of the machines is but an improvement or invention conducing to the accomplishment of the same general end. *Wyeth v. Stone*, 1 Story, 292.—STORY, J.; Mass., 1840.

4. Under § 6 of the act of 1836, requiring the inventor "to explain the several modes in which he has contemplated the application of the distinguishing principle or character of his invention," it is not incumbent to suggest all the possible modes by which the invention may be varied and yet the effect produced. It is sufficient to state the modes which he contemplates to be the best, and to add, that other mere formal variations from these modes he does not deem to be unprotected by his patent. *Carver v. Braintree Manuf. Co.*, 2 Story, 440, 441.—STORY, J.; Mass., 1843.

5. Where, therefore, an inventor, in a patent for "a new and useful improvement in the ribs of the cotton gin," claimed "the increasing the depth or space between the upper and lower surface of the rib, whether this be done by making the ribs thicker at that part, or by a fork or division of the rib, or by any other variation of the form," *Held*, that there was no want of accuracy or sufficiency of description, nor any claim broader than the invention. *Ibid.*, 433, 435, 441.

6. The act of Congress (act of 1836, § 6) not only requires the patentee to "particularly specify and point out his invention and discovery," but also to explain the several modes of its applica-

tion. The court does not require as strict a compliance in these respects as was once the practice, but the claim to novelty must be clearly described somewhere in the specification, and it must be made in such plain terms that it can be readily understood with "reasonable certainty." *Hovey v. Stevens*, 3 Wood. & Min., 27, 28.—WOODBURY, J.; Mass., 1846.

7. Whether the discoverer of a new and important truth can secure to himself all the mechanical means of carrying it into effect, he can only do so in a case in which he clearly sets forth and claims such new truth to be his discovery and exclusive right. *Brooks v. Fiske*, MS.—SPRAGUE, J.; Mass., 1851.

8. When a patent is for a machine, the specification must explain the principle of it, and also the several modes in which the inventor has contemplated the application of that principle. *Sickles v. Glou. Manuf. Co.*, 1 Fisher, 238.—GRIER, J.; N. J., 1856.

9. Under § 6 of the act of 1836, it is the duty of an inventor to describe in his specification the several different modes, or devices, or modifications known to him of his invention. *Sargent v. Carter*, 11 Mo. Law Rep., 655.—CURTIS, J.; Mass., 1858.

## MANUFACTURE.

1. A new manufacture, as the use of a new composition, as porcelain to form knobs for doors, &c., and which results in a new and useful article, is the proper subject of a patent, though the means (the shank and spindle) employed to adapt the new composition to a useful purpose are old or well known. *Hatch-*

## ARTICLE OF; WHEN PATENTABLE.

*Kiss v. Greenwood*, 11 How., 265.—NELSON, J.; Sup. Ct., 1850.

2. But if porcelain knobs were not new, and the same kind of shanks and spindles had been used with other knobs, the use or substitution of porcelain instead of other material in a combination with such shanks, &c., will not entitle the manufacturer to a patent, even though such material may be better adapted for the purpose. *Ibid.*, 266.

3. A new property discovered in matter, when practically applied in the construction of a useful article of commerce or manufacture, is patentable; but the process through which the new property is developed and applied must be stated with such precision as to enable a mechanic to construct and apply the necessary process. *Le Roy v. Tatham*, 14 How., 175.—MCLEAN, J.; Sup. Ct., 1852.

4. Where the subject matter is a manufacture, the question as to infringement will be, whether in reality and substance the defendant has availed himself of the invention of the patentee; a mere colorable variation in the process or application should not be allowed to protect a defendant. *Rich v. Lippincott*, 2 Fisher, 5.—GRIER, J.; Pa., 1853.

5. 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, II. L., Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

6. In the result the usual test is, whether the production of the article is as good in quality at a cheaper rate,

or better in *quality* at the same rate or with both these consequences *partially combined*. *Ibid.*

7. 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 have before been used for the same purpose, is not a patentable invention. It is not a new manufacture. *Maule, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

8. 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.

9. 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.

10. 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.

11. 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.

12. 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.

13. Where a patent was claimed for an alleged combination of certain parts in a new article of manufacture, tinted envelopes, but there was no new principle in the combination itself, and it was admitted that there was nothing new in the means or process, and there was nothing in the results very valuable to commerce or trade, it was held that there was not sufficient evidence of invention to warrant the granting of a patent. *Orr, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

14. 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—or where the result is substantially different from what has been effected before, it may become the test of invention, and from which invention may be inferred. *Treadwell v. Fox*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

15. Where the claim was for a *method* of forming hoop-skirts by applying the hoops and tapes to each other while they are supported in the relative positions they are to occupy in the finished skirt, for which purpose a *former* for each shape of skirt was necessary, *Held*, that the claim was not for the *former*, or apparatus as such, but that the inventor had a right to claim the use of the apparatus as incidental and subsidiary to the practical purpose of

the idea constituting his invention, and that therefore it was immaterial that the apparatus or *former* was old. *Mann, R. J., Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

16. A party cannot claim a patent for a new manufacture, merely because he has applied an existing manufacture to a new use. He must have invented a *new* fabric or manufacture of merchantable value. *Pender, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

## MANUSCRIPTS.

See also LETTERS.

1. An author, at common law, has a property in his manuscript, and may obtain redress against any one who deprives him of it; or by improperly obtaining a copy, endeavors to realize a profit by its publication. *Wheaton v. Peters*, 8 Pet., 657.—MCLEAN, J.; Sup. Ct., 1834.

2. There can be no doubt that the rights of an assignee of a manuscript would be protected by a Court of Chancery. *Ibid.*, 661.

3. 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.

4. Congress, by the act of 1790, did not legislate in reference to existing rights. Instead of sanctioning an existing right, it created it. *Ibid.*, 661.

5. 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.

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. *Bartlette 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. Students or others who have been permitted to take copies of manuscripts, have no right to a use which was not in the contemplation of the author and themselves when such consent was given. Nor can they, by allowing others to copy them, give a greater license than was vested in themselves. *Ibid.*, 303.

9. They have therefore no right, either of themselves or by a sale to others, to print such manuscripts; and an injunction will lie to prevent such act. *Ibid.*, 303, 305.

10. An author's rights in a manuscript will be protected, though they may not be complete for publication. *Ibid.*, 305.

11. At common law, the author of a book or other literary property, as letters, has a right to property therein; at least until it has been published with his assent. *Hoyt v. McKenzie*, 3 Barb. Ch., 322, 323.—WALWORTH, Chan.; N. Y., 1848.

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

13. There is a difference in principle between the right to republish a printed

work, and the exclusive right of an author to publish his own manuscript. *Ibid.*, 37.

14. Manuscripts cannot, without the consent of the author, be seized by his creditors as property. *Ibid.*, 37.

15. The common law protects the right of an author to his manuscript only. *Ibid.*, 38.

16. § 9 of the copyright act of 1831, also protects such right. *Ibid.*, 38.

17. A surreptitious publication of an important part of a manuscript, is equally within the statute as if the manuscript was complete, and the whole of a manuscript need not be printed. *Ibid.*, 39, 40.

18. No length of time will authorize the publication of an author's original manuscript without his consent. *Ibid.*, 42.

19. An author may license the publication of his manuscript. But unless a copyright is secured, the first publication of it will abandon it to the public. *Pulte v. Derby*, 5 McLean, 332.—McLEAN, J.; Ohio, 1852.

20. 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. Before publication he has the exclusive possession of his invention. *Stowe v. Thomas*, 2 Amer. Law Reg., 228.—GRIER, J.; Pa., 1853.

21. When he has published his book and given his thoughts to the world, he can have no longer an exclusive possession of them. The author's conceptions have become the common property of the public. *Ibid.*, 228.

22. At common law, an author has a right to his unpublished manuscripts the same as to any other property he

may possess; and the act of February 3d, 1831, gives him a remedy by injunction, to protect this right. *Little v. Hall*, 18 How., 170.—McLEAN, J.; Sup. Ct., 1855.

23. The author of an unpublished manuscript has an exclusive property therein, at common law—a right which entitles him to determine for himself whether the manuscript shall be published at all; when this exclusive right is in danger of being violated, a court of equity is bound to prevent the wrong, by an injunction. *Woolsey v. Judd*, 4 Duer, 385.—DUER, J.; N. Y., 1855.

24. Such common law right has not been taken away or abridged by the statutes which have been passed for the protection of copyright. Its existence is prior to these statutes, and independent of their provisions. *Ibid.*, 385.

25. The exclusive right of an author in a manuscript yet unpublished, rests upon the same foundation as that which sustains every other species or description of property, as that of a manufacturer, or an artist. *Ibid.*, 386.

26. The exclusive right is a right of property in the words, thoughts, and sentiments, which in their connection, form the written composition which his manuscript embodies and preserves. *Ibid.*, 387.

27. The right to control the publication of a manuscript remains in the author and his representatives, even when the material property has, with his own consent, been vested in another. The gift of a manuscript, unless by express agreement, carries with it no license to publish. *Ibid.*, 387.

28. § 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.

29. 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.

30. The sole proprietorship of an author's manuscript and of its incorporeal contents, wherever copies exist, is, independently of legislation, in himself and his assigns until he publishes it.—*Ibid.*, 78.

## MATERIAL OF INVENTION.

1. Whether the mere substitution of one material for another be an invention within the sense of the patent law, may well be questioned; but there being room for doubt, a patent was recommended. *Seeley's Case*, 2 Opin., 52.—WIRT, Atty. Gen.; 1827.

2. The specification need not state of what material, whether wood or iron, every part of a machine should be made. *Brooks v. Bicknell*, 3 McLean, 261.—McLEAN, J.; Ohio, 1843.

3. It is a matter of doubt whether the use of an inferior material for a machine when the patent covers only a superior one, is a legal violation of it. *Aiken v. Bemis*, 3 Wood. & Min., 354.—WOODBURY, J.; Mass. 1847.

4. Where a patent extends only to the form or parts of the machine as set out, and made of any kind of materials, or saying nothing as to materials, the

right would be violated by a machine of like form. *Ibid.*, 354.

5. But if the patentee chooses to go further, and cover the material of which a part of his machine is made, he entirely endangers his right to prosecute when a different and inferior material is employed, and especially one rejected by himself. *Ibid.*, 354.

6. Where a patentee claimed a hammer, in a saw-set of wrought iron faced with steel, alleging that he found, upon experiment, that all steel hammers were much more liable to break, and wrought iron ones more durable, and therefore confined his specification to wrought iron ones with steel points, *Held*, in an action for infringement against a person using a hammer wholly of steel, that it was a matter of doubt whether the use of such a hammer was a violation of the patent. *Ibid.*, 354.

7. The use of a material not before used in the same structure or article, as the use of potter's clay in the making of door-knobs, similar knobs having been before made of metal, glass, wood, &c., gives no claim for a patent, even though the article be more valuable than any other of the kind. *Hotchkiss v. Greenwood*, 4 McLean, 461.—McLEAN, J.; Ohio, 1848.

8. But if the material be new, as a compound not before known, made of different ingredients, that may be the subject of a patent. *Ibid.*, 461.

9. The substitution of one material for another, as clay for wood, or metal, in the construction of door-knobs, the spindle and shank being the same as in common use, and the mode of connecting them requiring only ordinary mechanical skill, is not patentable. *Hotchkiss, v. Greenwood*, 11 How., 265, 267.—NELSON, J.; Sup. Ct., 1850.

10. The use or employment in an invention or machine, of materials better adapted to the purpose for which it is used than the materials of which before made, and thus producing merely a better and cheaper article, cannot entitle the manufacturer to a patent. *Maynard Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1857.

11. 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. *Forbush v. Cook*, 10 Law Rep., 664.—CURTIS, J.; Mass., 1857.

12. 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 entirely of hard rubber. Such an invention is not a double use. *Adams, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

## MECHANICS.

See also SUGGESTIONS.

1. The suggestions of the mechanic employed to make the machine, or of others, as to the form or proportions, are not inventions or improvements for which a patent could be obtained, nor can they invalidate the patent for the thing to which they are applied. *Pennock v. Dialogue*, 4 Wash., 544.—WASHINGTON, J.; Pa., 1825.

2. The suggestions of a mechanic of alterations in the form or proportions of a machine, as designed by the inventor, will not be sufficient to deprive the inventor of the merit of the invention, or affect the validity of the patent, if incorporated within it; nor would it be as to such alterations a discovery which would entitle the mechanic to take out a patent for them. *Watson v. Bladen*, 4 Wash., 582.—WASHINGTON, J.; Pa., 1826.

3. If a contrary doctrine were to be maintained, very few, if any patents could be upheld, unless in those cases where the inventor is also the mechanic who constructs the machine. *Ibid.*, 582.

4. To constitute an inventor, it is not necessary that he should have the manual skill and dexterity to make the invention. If the ideas are furnished by him, he is entitled to avail himself of the mechanical skill of others, to carry out practically his contrivance. *Sparkman v. Higgins*, 1 Blatchf., 209.—BETTS, J.; N. Y., 1846.

5. The exercise in the construction of any article of ingenuity and skill, which is no more than that of an ordinary mechanic acquainted with the business, is not the subject of a patent. *Hotchkiss v. Greenwood*, 4 McLean, 461.—MCLEAN, J.; Ohio, 1848.

6. The employment or substitution of one mechanical power in place of another, to accomplish a certain result, is the mere skill of the mechanic, and is not invention. *Blanch. Gun-Stock Fac. v. Warner*, 1 Blatchf., 278.—NELSON, J.; Ct., 1846.

7. Perfecting an invention by superior skill in the mechanical arrangement and construction of the parts, is but the skill of the mechanic, not the

genius of an inventor. *Parkhurst v. Kinsman*, 1 Blatchf., 497.—NELSON, J.; N. Y., 1849.

8. The substitution of a mechanical equivalent is not a substantial change. There are many devices in construction that can be made by a skilful mechanic, differing very much in appearance, but which are regarded as identical; as producing a result by the use of a lever, or a screw, or obtaining power by a spring, or a weight, or a pulley. *Tatham v. Le Roy*, 2 Blatchf., 486.—NELSON, J.; N. Y., 1852.

9. And any change or alteration which is suggested to the skilful operator from the working of a machine, and in the course of its operation—any useful change that may be the result of the practical working of the machine—is clearly a change that belongs not to the operator, but to the original inventor. *Ibid.*, 487.

10. In order to ascertain and determine whether a change in the arrangement and construction of a machine is to be considered as a substantial change or not, the jury must ascertain and determine whether the change is the result of mechanical skill, worked out by mechanical devices—of a knowledge that belongs to that department of labor—or whether the change is the result of mind, of genius, of invention, in which there is more than mere mechanical skill and ingenuity. *Ibid.*, 488.

11. A change in arrangement and construction is not substantial, unless there is embodied in it, over and beyond the skill of the mechanic, that inventive element of the mind which is to be found in every invention that is the proper subject of a patent. *Ibid.*, 488.

12. If the invention required no more



skill or ingenuity than that possessed by an ordinary mechanic skilled in the business, there is an absence of inventive faculty, and the patent is invalid. *Teese v. Phelps*, 1 McAllis., 52.—McALLISTER, J.; Cal., 1855.

13. Before a patent can issue, the thing patented must appear to be of such a character as to involve or require "invention" for its production—require the exercise of the genius of an inventor, as contradistinguished from the ordinary skill of a mechanic in construction. *Ransom v. Mayor, &c.*, 1 Fisher, 258.—HALL, J.; N. Y., 1853.

14. If, with the knowledge had by the public, it required no invention, but simply the ordinary skill and ingenuity of the mechanic to produce the result effected—in other words, if the inventive faculty was not put into action, and was not needed to produce the alleged invention, then the patent is void, because there is no invention to be secured to the patentees. *Ibid.*, 264.

15. If a person conceives the result embraced in the invention, or the general idea of a machine upon a particular principle, and in order to carry his conception into effect, it is necessary to employ manual dexterity, or even inventive skill in the mechanical details and arrangements requisite for carrying out the original conception, in such cases, the first person will be the inventor, and the other the mere instrument through which he realizes the idea. *Wellman v. Blood; King v. Gedney*, MS. (App. Cas.)—MORSELL, J.; D. C., 1856.

16. After a principle has been discovered, after a new set of ideas have been struck out by genius and thought, their embodiment in machinery, their adaptation to the working out of prac-

tical results contemplated by the inventor, is very much the work of the skilful mechanic. *Sickles v. Borden*, 3 Blatchf., 541.—NELSON, J.; N. Y., 1856.

17. In carrying out an invention, the exercise of some skill and judgment on the part of the mechanic called to construct it, will *always* be required. Something must necessarily be left to him. *Judson v. Moore*, 1 Fisher, 548.—LEAVITT, J.; Ohio, 1860.

18. It is difficult to determine where ordinary mechanical skill ends and invention begins. The best *practical principle* is, that where the combination of known elements produces new and useful results to the public not before attained, then the person who discovers and applies the combination is an inventor, within the true intent and meaning of the patent law. *Smith, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

19. The remedying of defects in a machine by practical men is the work of the mechanic, of the intelligent operator, and has no connection with invention or discovery. *Ibid.*

## MEDICINES.

1. An inventor of a newly patented medicine cannot give it the name of an already existing and popular article, but his patent will be withheld until he changes the name; so held, where the inventor of a new medicine desired to call it Anderson's Cough Drops, which was already well known. *Bacon's Case*, 2 Opin. 109.—WIRT, Atty. Gen.; 1328.

2. The fact that a party has a patent giving him the exclusive right to make, and use, and vend a particular medicine,

does not confer upon him the right to practise as a physician, and use such medicines in any particular state, except in conformity with the laws of such state. *Jordan v. Overseers Poor*, 4 Ohio, 310.—LANE, J.; Ohio, 1831.

3. A patent authorizing the patentee to make, construct, use, and vend a newly discovered compound of medicine, gives such patentee no right to practice as a physician, even though only administering such patented medicine, without complying with the regulations established by the laws of any state. *Thompson v. Staats*, 15 Wend., 396.—NELSON, J.; N. Y., 1836.

4. An inventor of a medicine is not entitled to the exclusive right of compounding and vending it, unless he has obtained a patent therefor; without a patent, the right to make and sell is common to all. *Thompson v. Winchester*, 19 Pick., 216.—SHAW, Ch. J.; Mass., 1837.

5. If another person makes such invention of an inferior quality, and sells it and by this means brings the thing into disrepute, the inventor can maintain no action, as there is no infringement of his right, nor recover damages unless the person so making and selling passes off the thing sold as made by the plaintiff. *Ibid.*, 217.

6. Imposition and fraud on the part of such person in passing off his medicines as those of the plaintiff, would be the only ground of action. *Ibid.*, 217.

7. An exclusive right, as an inventor, in a composition, as a medicine, can only be obtained under the patent law, by a compliance with its provisions. *Coffeen v. Brunton*, 4 McLean, 517.—MCLEAN, J.; Ind., 1849.

8. The inventor of an unpatented medicine has no exclusive right to make

and vend it; but if others make and vend it, they have no right to sell it as the manufacture of the inventor, nor to adopt his label or trade-mark. *Davis v. Kendall*, 2 R. I., 569.—GREENE, Ch. J.; R. I., 1853.

9. The discovery of a fact that a given natural substance will, in appropriate methods of administration, produce a particular physiological or pathological effect on the human body, is not a thing patentable under any existing statute. *Morton's Anæsthetic Patent*, 8 Opin., 272.—CUSHING, Atty. Gen.; 1856.

10. The capacity of chemical agents to act medically on the nerves, stomach, or other parts of the body, in such manner, is not patentable. *Ibid.*, 272.

11. The suggestion of the practicability of performing surgical operations under insensibility of the patient produced by anæsthetic agents, is not a patentable invention. *Ibid.*, 272.

12. A medicament capable of being administered in various forms and in different doses, which have to be measured and selected with professional skill, in reference as well to the quantity of the agent as the condition of the patient, so as to produce a particular physiological condition, without collateral injurious consequences, is not a thing patentable, either as a discovery or invention. *Ibid.*, 272.

13. Neither principles, nor abstract philosophical ideas, or the natural functions either of the human body or of matters of nature, are patentable. *Ibid.*, 272.

14. The classification of substances capable of producing insensibility to pain, under the head of *anæsthetic*, as distinguished from narcotic, is not a new discovery. *Ibid.*, 273.

15. The combination of agents of this

class with surgical operations, whether by inhalation or by any other form of administration, internal or external, is not a modern discovery, but is a universal fact, coeval with historic knowledge. *Ibid.*, 273.

16. The production of insensibility in the human system, by anæsthetic agency or otherwise, and the performance of surgical operations during such insensibility, cannot be considered patentable as an art, in contradistinction to a principle, function, or quality of matter. *Ibid.*, 274.

17. No one can have an exclusive right to the manufacture and sale of a medicine, without a patent from the government. *Comstock v. Moore*, 18 How., Pr., 422.—SUTHERLAND, J.; N. Y., 1860.

18. Chancery will not interfere by injunction in questions of trade-mark between the venders of patent medicines, being quack medicines; such questions having too little to commend them on either side. *Heath v. Wright*, 3 Wall., Jr.—GRIER, J.; Pa., 1861.

## MISTAKES IN PATENTS.

See also REISSUES OF PATENT.

1. An error of expression, apparent on the face both of the patent and specification, by which no person could be misled, will not invalidate a patent. *Kneass v. Schuylkill Bank*, 4 Wash., 14.—WASHINGTON, J.; Pa. 1820.

2. In issuing patents, the Secretary of State, under the act of 1793, 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; and he can exercise no powers but such as are expressly given him. But he must act, in construing the patent laws, in the spirit in which these are made. Hence, if a mistake should be committed in the department of state, it may be corrected, and a new patent be issued, correcting the error, even though such act is not expressly authorized by law. The emanation of the new patent is not founded on the words of the law, but is indispensably necessary to the faithful execution of the solemn promise made by the United States to the inventor. The same step may be taken for the same purpose, if a mistake has been innocently committed by the inventor, and he desires to surrender his patent and have a corrected one issued. *Grant v. Raymond*, 6 Pet., 241, 242.—MARSHALL, Ch. J.; Sup. Ct., 1832.

3. Where a mistake occurs in the copy of a patent, the Commissioner has the power, and ought to correct it so that it will conform to the patent itself, and the record. *Woodworth v. Hall*, 1 Wood. & Min., 260.—WOODBURY, J.; Mass., 1846.

4. It would be the duty of the Commissioner of Patents, to correct a mistake in the letters patent when applied to, and to minute the correction on them, but it is not necessary for him to resign and reseal them; as the signing and sealing are done by the same officer making the correction. *Ibid.*, 260.

5. But it would seem to be necessary to have the Secretary of State sign anew, or assent to the amendment, as he is a distinct officer, and without signing anew or assenting, does not authenticate the amended letters. *Ibid.*, 261.

6. *Seem*, that a patent amended in a

material mistake, cannot operate as to third persons against whom prosecutions were pending, but only for causes accruing after the correction. It may be different if the mistake is entirely clerical. *Ibid.*, 261.

7. If the new letters have been so altered as to become void, whether the surrender of the original letters, and the extensions of them, would not become also void? If so, perhaps the party might amend his bill, and recover on the former letters patent, if not too defective. *Ibid.*, 261.

8. It is not however absolutely necessary that the Secretary should assent to an amendment by actually resigning the patent, or by an entry on the patent itself. But his assent or ratification made afterward and in writing, as by letter, is sufficient. *Woodworth v. Hall*, 1 Wood. & Min., 398.—WOODBURY, J.; Mass., Oct., 1846.

9. If the corrections in a patent are merely clerical, it seems they will relate back to the date of the letters patent, unless as to third persons, who had acquired rights as the patent stood before it was corrected; but if new matter is inserted, not originally contemplated, or corrections made not merely clerical, it is questionable whether they could relate back to the date of the letters patent. *Ibid.*, 399.

10. If the correction is such as to render the patent void, the surrender of the former patents would be considered void also: *Query*, Whether in such case recoveries may not be had on the original patent. *Ibid.*, 399.

11. The power to correct mistakes in letters patent, does not belong to the courts, but is confided to the Commissioner of Patents, under § 13 of the act of 1836. The court can only construe

the specification and claim as they stand, and determine the legal effect of the claim. *Kittle v. Merriam*, 2 Curt., 478. CURTIS, J.; Mass., 1855.

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## MODE, METHOD, OR PROCESS.

See also EFFECT; PRINCIPLE.

1. A patent may be for a mode or method of doing a thing: mode, when referred to something permanent, means an engine or machine: when to something fugitive, a method, which may mean engine, contrivance, device, process, instrument, mode and manner of effecting the purpose. A patent for a method of producing a new thing may apply to the mechanism, a new method of operating with old machinery, or producing an old substance. A patent for a mode or method detached from all physical application, would not refer to an engine or machine, but when referred to the mode of operation, so as to produce the effect, would be considered as for an engine or machine. The words used as mode or method, are not the subject of the patent, it is the thing done by the invention. *Whitney v. Emmett*, Bald., 312.—BALDWIN, J.; Pa., 1831.

2. In a patent for an improvement in looms, the claim was for the "connection of the reed with the yard beam, and the communication of the motion from the one to the other, *which may be done as specified*," *Held*, that the invention was limited to the specific machinery and mode of communicating the motion specially described in the specification. If it included *all* modes of communicating the motion, it would be void, as being an attempt to patent an abstract princi-

## WHEN PATENTABLE.

ple, or for all possible and probable modes whatever of such communication, though invented by others, and substantially different from the mode described by the patentee. *Stone v. Sprague*, 1 Story, 271, 272.—STORY, J.; R. I., 1840.

3. He who produces an old result by a new mode or process, is entitled to a patent for the mode or process. But he cannot have a patent for a result merely, without using some new mode or process to produce it. *Howe v. Abbott*, 2 Story, 194.—STORY, J.; Mass., 1842.

4. But the application of an old process to the manufacture of an article to which it had never before been applied, is not a patentable invention. There must be some new process, or some new machinery used, to produce the result. *Ibid.*, 194.

5. A patent cannot be for a principle, but must be for the machine, mode, or manufacture to carry out the principle, and reduce it to practice. The principle thus becomes the *modus operandi*, and rests in the mode adopted to accomplish certain results. *Smith v. Downing*, 1 Fisher, 70.—WOODBURY, J.; Mass., 1850.

6. It is well settled that a patent cannot cover a new principle, without reference to any mode or method of enforcing it. *Ibid.*, 70.

7. The plaintiff's invention and patent was for a squeezer, so called, for converting puddler's balls into blooms, and rolled the balls between reciprocating tables or plates, or between a revolving cylinder and a stationary curved segmental trough with stationary flanges. The defendant's machine compressed the ball between a rotating cam, and two small rotating cylinders beneath it;

*Held*, that plaintiff's patent was for a new process, mode, or method of converting puddler's balls into blooms, by continuous pressure and rotation between converging surfaces, and that the defendant's machine was an infringement upon it, if it converted such balls into blooms by continuous pressure and rotation between converging surfaces, although its mechanical construction and action might be different. *Burden v. Corning*, MS.—CONKLING, J.; N. Y., 1850.

8. An exclusive right cannot exist in a new power, should one be discovered, as steam, electricity, or any other power of nature. In all such cases, the processes used to extract, modify, and concentrate natural agencies, constitute the invention. The elements of the power exist; the invention is not in discovering them, but in applying them to useful objects. The right of the inventor is secured against all who use the same mechanical power, or one substantially the same. *Le Roy v. Tatham*, 14 How., 175, 176.—MCLEAN, J.; Sup. Ct., 1852.

9. 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 of machines in order to produce a certain result or manufacture. *Corning v. Burden*, 15 How., 267.—GRIER, J.; Sup. Ct., 1853.

10. The term *machine* includes every mechanical device or combination of mechanical powers, or devices, to perform some function, and produce a certain effect or result. But where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes,

## WHEN PATENTABLE.

methods, or operations, are called *processes*. *Ibid.*, 267.

11. A new process is usually the result of discovery; a machine, of invention. *Ibid.*, 267.

12. The arts of tanning, dyeing, making water-proof cloth, vulcanizing india-rubber, smelting ores, &c., are usually carried on by processes, as distinguished from machines. *Ibid.*, 267.

13. One may discover a new and useful improvement in such a process, irrespective of any particular form of machinery, or mechanical device. And another may invent a labor-saving machine, by which the operation or process may be performed, and each be entitled to a patent. *Ibid.*, 268.

14. It is when the term process is used to represent some means or method of producing a result that it is patentable, and it will include all means or methods which are not effected by mechanism or mechanical combinations. *Ibid.*, 268.

15. The term process is often used, however, in a more vague sense, as when we say a board is undergoing the process of being planed, grain of being ground, iron of being hammered or cooled, in which it cannot be the subject of a patent. *Ibid.*, 268.

16. In this use of the term, it represents the function of a machine, or the effect produced by it on the material subjected to its action. *Ibid.*, 268.

17. It is by not distinguishing between the primary and secondary sense of the term "process" that error is likely to arise. *Ibid.*, 268.

18. A patentee cannot have a patent for an exclusive use of a process, as "the motive power of electro-magnetism, *however developed*, for marking characters at a distance." His patent

must be confined to the manner and process described and invented by him. *O'Reilly v. Morse*, 15 How., 112-120.—TANEY, Ch. J.; Sup. Ct., 1853.

19. A patent cannot be for an effect produced distinct from the process or machinery necessary to produce it. *Ibid.*, 120.

20. There is a wide difference between one who merely invents a new method or process by which a well known fabric, product, or manufacture is produced in a cheaper and better way, and the discovery of a new compound, substance, or manufacture. 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. *Goodyear v. Railroads*, 2 Wall, Jr., 360, 361.—GRIER, J.; N. J., 1853.

21. The question of infringement would depend also upon different conditions. Where only the process was protected, every other person would be at liberty to devise any different process for effecting the same purpose; where both process and product were protected, no one could, by varying or improving the mode or process of production, rob the patentee of his franchise. *Ibid.*, 361.

22. A patent for a discovery of a new and improved process, grants nothing but the exclusive right to use the process; and the sale or use of the product is no violation of such exclusive right. *Ibid.*, 362.

23. In order to constitute patentable novelty or utility in a *process*, it must appear that the result produced was an improvement in the trade and for the public good or advantage, by the manufacture either of a new article, or a better article, or a cheaper article to

the public, than that produced by the old method. *Jones v. Wetherill*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

24. The terms "*improvement in the trade*," as applicable to the law of patents, should be considered in a commercial sense, and as meaning, of the article, as good in quality, and at a cheaper rate, or better in quality at the same rate, or with both these consequences partially combined, leading to a cheaper production. *Ibid.*

25. In this class of cases, *result* is considered *all* important; there must, however, be evolved a principle such as will *regularly*, not merely *occasionally*, produce a like effect. *Ibid.*

26. A patent may be granted for a new method or means of producing an old result. *Heinrich v Luther*, 6 McLean, 348.—MCLEAN, J.; Ohio, 1855.

27. Where any new contrivances, combinations, or arrangements are made use of in machinery, although the chief agents are known, such contrivances, combinations, or arrangements may constitute a new principle, and then the application or practice will be new also. In such case the new and improved *method* of producing a useful result or effect is as much the subject of a patent as an entire new machine. *Wintermute v. Redington*, 1 Fisher, 246.—WILSON, J.; Ohio, 1856.

28. Under § 18 of the act of 1836, the assignees and grantees of a right to use a patented process are continued in the right to use it during an extension of the patent, equally with the assignees and grantees of a right to use a patented machine.—*Day v. Union Rub. Co.*, 3 Blatchf., 503.—HALL, J.; N. Y., 1856.

29. Where the claim was for a *method* of forming hoop-skirts by applying the hoops and tapes to each other, while they are supported in the relative posi-

tions they are to occupy in the finished skirt, for which purpose a *former* for each shape of skirt was necessary, *Held*, that the claim was not for the *former*, or apparatus, as such, but that the inventor had a right to claim the use of the apparatus as incidental and subsidiary to the practical purpose of the idea constituting his invention, and that therefore it was immaterial that the apparatus or *former* was old. *Mann. R. J., Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

## MODELS.

1. It seems a model cannot be referred to and used in connection with the specification and drawings, to make a machine, and thus determine the sufficiency of the patent. *Grant v. Mason*, 1 Law Int. & Rev., 23, 25.—THOMPSON, J.; N. Y., 1828.

2. Under the word patent, used in reference to the description of the thing patented, is included the patent, the specification attached to it, and the model and drawing, all of which are to be taken together, as making up the description. *Whitney v. Emmett*, Bald., 314.—BALDWIN, J.; Pa., 1831.

3. On a motion for an injunction, the exhibition of models like which the parties constructed their respective machines, will not suffice to turn the scale either way, without an examination into the detail of the construction, combination, and operation of all their parts by competent mechanics. *Cooper v. Matthews*, 8 Law Rep., 417.—BALDWIN, J.; Pa., 1842.

4. In an action of infringement, the plaintiff is not bound to produce models

of his patented articles. The defendant may, however, properly obtain them, and they are competent evidence. *Hathaway v. Roach*, 2 Wood. & Min., 73.—WOODBURY, J.; Mass., 1846.

5. 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.

6. 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.

7. Models are a species of evidence of all others best calculated to conduct to the truth—evidence superior to and unaffected by the interests or prejudices of partisans, or by the opinions (the reveries they may often be called) of experts. *McCormick v. Tulcott*, 20 How., 409.—DANIEL, J. (Dis. Opin.); Sup. Ct., 1857.

8. No witnesses can testify so clearly and so impartially as do the subjects (though mute) concerning which a controversy about identity or dissimilarity is pending. *Ibid.*, 409.

9. As to the question of identity, models are not a living, but a sure and true witness—dumb, but speaking eloquently, as you may interpret the language it employs. To each part a voice potential is given. *Page v. Ferry*, 1 Fisher, 313.—WILKINS, J.; Mich., 1857.

10. Experts may be examined to explain, if necessary, models and drawings. *Winans v. N. Y. & E. R. R.*, 21 How., 100.—GRIER, J.; Sup. Ct., 1858.

11. Models of machines, about which there is a question, is a kind of evidence which is entitled to the highest credi-

bility, and which, like figures, cannot lie. *Morris v. Barrett*, 1 Fisher, 463.—LEAVITT, J.; Ohio, 1858.

## MUSIC.

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., 411.—TANEY, Ch. J.; Md., 1845.

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

3. The composition of a new air or melody is entitled to protection; and the appropriation of the whole or of any substantial part of it, without the license of the author, is piracy. *Jollie v. Jaques*, 1 Blatchf., 625.—NELSON, J.; N. Y., 1850.

4. A musical composition, to be the subject of a copyright, must be substantially a new and original work, and not a copy of a piece already produced, with additions and variations, which a writer of music with experience and skill could readily make. *Ibid.*, 626.

5. In a copyright of a musical composition, the right secured is the property in the piece of music, and not in the mere name. In that there need be no novelty or originality, nor need it even be the production of the author.



The title or name is an appendage to the book or piece of music, and if the copyright of the latter fails to be protected, the title goes with it. *Ibid.*, 627.

6. In the case of a valid copyright of such work, and an infringement of the title, whether the court would not be required to secure the title from piracy to protect the work; *query*. *Ibid.*, 627, 628.

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### NAME, PROPERTY IN.

See TRADE-MARK.

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### NEW APPLICATION OR USE.

1. The application of an *old* thing to a *new* use, without any other invention, is not a patentable contrivance. *Ames v. Howard*, 1 Sumn., 487.—STORY, J.; Mass., 1833.

2. Where a patent was for an improvement in the application of palm-leaf to stuffing beds, &c., but the same process had been used in preparing hair for like uses, *Held*, that there was no invention of any new process, but only a new application of an old process, and that it was not a patentable invention. *Howe v. Abbott*, 2 Story, 194.—STORY, J.; Mass., 1842.

3. The application of an old thing to a new purpose is not patentable. A purpose is not patentable: but the machinery only, if new, by which it is to be accomplished. In other words, the thing itself which is patented must be new, and not the mere application of it to a

new purpose or object. *Bean v. Smallwood*, 2 Story, 411.—STORY, J.; Mass., 1843.

4. A new adaptation and *arrangement* of applying and using old articles for a certain purpose—as using old parts of a castor with and their adaptation to furniture, in a manner before unknown—may be the subject of letters patent. *Blake v. Sperry*, 2 N. Y. Leg. Obs., 255.—JUDSON, J.; Ct., 1843.

5. Where a patentee described his invention as an “improvement in the construction of the axles and bearings of railway and other wheeled carriages,” and it was shown that the invention had been before applied to other carriages, although not to railway carriages, *Held*, that the invention was only a new application of an old invention, and therefore the patent could not be maintained. *Winans v. Bos. & Prov. R. R.*, 2 Story, 412, 415.—STORY J.; Mass., 1843.

6. The application of a known mechanical equivalent, as the endless screw and lever to a machine to which it had never before been applied, as to the periphery of a quadrant, to move and hold the rudder of a vessel with more ease, is not invention, although it might make the machine better. *Cochrane v. Waterman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1844.

7. 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. *Hovey v. Henry*, 3 West. Law Jour., 155.—WOODBURY, J.; Mass., 1845.

8. The application of a known thing to a new purpose, as the use of rivets to fasten parts of a shoe instead of sewing, though such particular parts of the shoe had never before been so fast-

ened, is not the subject of a patent. *Hazard v. Green*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

9. The mere application of an old machine to a new purpose is not patentable. *Tyler v. Deval*, 1 Code Rep., 30.—MCCALEB, J.; La., 1848.

10. The use of a material not before used in the same structure or article, as the use of potter's clay in the making of door-knobs, similar knobs having been before made of metal, glass, wood, &c., gives no claim for a patent, even though the article be more valuable than any other of the kind. *Hotchkiss v. Greenwood*, 4 McLean, 461.—MCLEAN, J.; Ohio, 1848. [Affirmed, *post* 15.]

11. A new application of a known principle to a new and useful purpose, by new mechanical contrivances and apparatus, as the application of the principle of the expansive and contracting power of a metallic rod, by different degrees of heat, to regulate the action of the damper and the heat of a common stove, is the subject of a patent. *Foote v. Silsby*, 1 Blatchf., 463, 464.—NELSON, J.; N. Y., 1849.

12. Although the principle had before been applied to the regulation of heat, and the idea of the application of such principle to the regulation of stoves had been before suggested, without such application having been made, it is not material; the person who first reduces the idea to practical application and use is entitled to the patent. *Ibid.*, 464.

13. It is not a claim for a discovery of a natural property of the metallic rod, but for a new application of it by means of mechanical contrivances, which is always the subject of a patent. *Ibid.*, 464.

14. Though a combination of ma-

chinery is not new in the abstract, 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. *Tatham v. Le Roy*, MS.—NELSON, J.; N. Y., 1849.

15. The substitution of one material for another, as clay for wood or metal, in the construction of door-knobs, the spindle and shank being the same as in common use, and the mode of connecting them requiring only ordinary mechanical skill, is not the subject of a patent. *Hotchkiss v. Greenwood*, 11 How., 266.—NELSON, J.; Sup. Ct., 1850.

16. 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. *Ibid.*, 270.—WOODBURY, J.; Dis. Opin.

17. 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 adapted, 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.

18. 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. *Foot v. Silsby*, 2 Blatchf., 264.—NELSON, J.; N. Y., 1851.

19. But in order to entitle himself to a patent for a new application of a property of nature to a useful purpose, he must not only have conceived the idea, but must by some means, have successfully given application to the new property; but it is not necessary that the application should be made by the very best apparatus that can be devised. *Ibid.*, 273, 274.

20. The application of a thing already known, to a new and useful purpose, may be the subject of a patent, provided the new use is not analogous to the old, and requires the exercise of the inventive faculties. *Winans v. Schenec. & Troy R. Road*, 2 Blatchf., 293.—CONKLING, J.; N. Y., 1851.

21. 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 have before been used for the same purpose, is not a patentable invention. *Maule, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

22. 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 *economical* or *beneficially* enjoyed by the public. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

23. 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.

24. An invention or arrangement of parts, though already used for a particular purpose, if in the new use it performs any new function, or an old function in a better manner, or makes a better and cheaper manufacture, is patentable. *Newman, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

25. The mere use of a mechanical structure, before applied to a particular purpose (as a valve used on railway locomotives), for a different purpose, is not patentable; but if the valve be so changed as to be applicable to *all* engines, and producing a new and useful result, it is a patentable subject. *Judson v. Moore*, 1 Fisher, 556.—LEAVITT, J.; Ohio, 1860.

26. 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.

27. 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.

28. The mere new application of an old arrangement of parts to a new purpose, or in connection with a different machine, is not patentable. *Rawson, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

29. The application of an old contri-

WHEN WILL BE ORDERED; WHEN NOT.

vance to a new purpose, as making mirrors for hats self-adhesive, so that they can be placed in any hat, or removed from one hat to another, is not invention. *Wheeler, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

## NEW TRIALS IN PATENT CASES.

1. Where a verdict is void for repugnancy or uncertainty, a new trial must be ordered. *Stearns v. Barrett*, 1 Mas., 172.—STORY, J.; Mass., 1816.

2. In cases of surprise at the trial by new matters, forming a ground important to either party, and clearly made out, the cause will be postponed or continued. But if the party interested makes no such application, but elects to go on with the cause, he is understood to waive the matter of surprise; he cannot be permitted to take his chance with a jury; and, if unsuccessful, then to move the matter as a ground for a new trial. *Ames v. Howard*, 1 Sumn., 489, 490.—STORY, J.; Mass., 1833.

3. A new trial will not be granted upon mere cumulative evidence, where there is no other ground of objection to the verdict. *Ibid.*, 490.

4. A party moving on affidavits, for a new trial or the like, cannot put in new rebutting evidence to the affidavits of the other party, offered in reply to those first offered by the moving party. *Ibid.*, 491.

5. 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.

6. 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.

7. In an action for a violation of a patent, a new trial will not be ordered for surprise on account of new evidence, if by reasonable diligence the information might have been obtained beforehand. *Washburn v. Gould*, 3 Story, 157.—STORY, J.; Mass., 1844.

8. A verdict on an issue at law, in a patent case, directed by a court of equity, will not be set aside and a new trial ordered, on the ground that such verdict was against the weight of evidence, unless the preponderance of evidence is very clear. *Brooks v. Bicknell*, 4 McLean, 72, 74.—MCLEAN, J.; Ohio, 1845.

9. On a motion for a new trial, the fact that the same issues had been submitted to a former jury, who were discharged because they could not agree, cannot be entirely overlooked. *Ibid.*, 72, 73.

10. A new trial will not be granted for the reason that the court construed the specification, instead of leaving the jury to determine its meaning. Written instruments are to be construed from the language of such instruments themselves, and it is the duty of the court to construe the language used in the specification. *Davoll v. Brown*, 1 Wood. & Min., 55, 56.—WOODBURY, J.; Mass., 1845.

11. If the court refuse to decide upon the construction of the patent or specification, and leave such point to the jury, such ruling is erroneous, and is sufficient cause for a new trial. *Emer-*

WHEN WILL BE ORDERED; WHEN NOT.

*son v. Hogg*, 2 Blatchf., 6.—BETTS, J.; N. Y., 1845.

12. 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. *Stephens v. Felt*, 2 Blatchf., 38, 39.—BETTS, J.; N. Y., 1846.

13. A new trial will not be granted, because of the admission in evidence of a letter of the Commissioner of Patents, acknowledging the receipt of an application for a patent, and introduced to show plaintiff's invention at the time of its date, though doubts may be entertained of its admissibility, if other evidence is subsequently offered, proving plaintiff's invention earlier than the date of such letter. *Allen v. Blunt*, 2 Wood. & Min., 128, 129.—WOODBURY, J.; Mass., 1846.

14. Nor will a new trial be granted because parol evidence was refused, going to prove the contents of a letter, alleged to have been mailed to the opposite party, it not having been shown that such letter was lost, or had been actually received by such party. The affidavits of the parties may be received to prove or disprove such facts. *Ibid.*, 130, 132.

15. If one of the jury, before retiring, ask the clerk as to a fact appearing from the records, and no objection is made to the question at the time, nor

any pretence made that the answer did not correspond with the record, it cannot, after verdict, be taken advantage of on a motion for a new trial. *Ibid.*, 149.

16. A new trial should not be granted for a cause existing at the trial, but which was not stated or excepted to then. *Ibid.*, 149.

17. 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.

18. Where a motion for a new trial is not made until some weeks after the trial, and the counsel of the parties differ as to what was done or omitted, it is for the court to decide on these differences, and the court will not award a new trial if it is apparent that no injustice will be likely to happen from the verdict as rendered. *Ibid.*, 151.

19. Nor will the court order a new trial because of the neglect of the court to charge as to certain points, as requested, where the counsel furnished no written list of such points to the court, nor verbally called attention, before the jury went out, to any point omitted. *Ibid.*, 151, 152.

20. It is no ground for a new trial that the court omitted to charge on some points, unless the omission influenced or changed the verdict; but it is too late to remind the court of the omission after the jury have retired. *Ibid.*, 152.

21. It is the general rule not to disturb the verdict if it is according to the justice of the case, and the ruling is

only doubtful in point of law—though if the ruling be clearly wrong, it will be good ground for a new trial. *Ibid.*, 152.

22. Though generally it will be a ground for a new trial if illegal testimony is admitted—or there was any misdirection on the law to the jury—yet if the illegal testimony has not prejudiced the case, or the objection was merely technical, or the evidence became immaterial, or the verdict can be justified without it, or the rejection was right, though on different grounds, or the incompetent evidence was not material, or no injustice was done by it, or cumulative, or not controverted, or the fact was otherwise proved, or if the misdirection was on an immaterial point, or did not affect the verdict, and justice appears to have been done, or if the point was frivolous, a new trial will not be ordered. *Ibid.*, 152, 154.

23. On a motion for a new trial in an action for the infringement of a patent on the ground of excessive damages, the sum given must be plainly exorbitant, or what is sometimes called “outrageous,” to require the interference of the court. *Aiken v. Bemis*, 3 Wood. & Min., 352.—WOODBURY, J.; Mass., 1847.

24. Where a new trial is asked because the verdict is against the weight of evidence, the finding of the jury, where evidence existed on both sides and had to be compared and weighed, will not be disturbed, even though the court might have come to a different conclusion, unless the presumption is very strong that the jury either wantonly abused their powers, or made some inadvertent mistake. *Ibid.*, 353.

25. A new trial will not be granted on the ground of the admission of the

declarations of an agent in relation to the business in which he was engaged, and made while he was so engaged, as such declarations are a part of the *res gestæ*. *Ibid.*, 355.

26. A new trial will be granted on the ground of newly discovered evidence, if there is no ground for imputing negligence in not obtaining it for the former trial, and if it is material, and not merely cumulative. And evidence will not be deemed cumulative if it is as to some point or fact not before agitated or gone into. *Ibid.*, 355–358.

27. If a new trial is however granted on the ground of newly discovered evidence, it is only on payment of the costs of the former trial. *Ibid.*, 359.

28. 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. *Stimpson v. The Railroads*, 1 Wall., Jr., 166.—GRIER, J.; Pa., 1847.

29. The rule of law that a verdict of a jury will not be set aside where there has been evidence on both sides of a question of fraud, and no misdirection as to the law, applies with like strictness to all cases of tort, as to an infringement of a patent. *Blanch. Gun-Stock Turning Fac. v. Jacobs*, 2 Blatchf., 71.—BETTS, J.; N. Y., 1847.

30. Where, in such a case, it was submitted as a question of fact for the jury to find whether the defendant was concerned with another in using an infringing machine, or was merely a purchaser from such person of articles manufactured under it, and the court instructed the jury that the action could not be maintained against the defendant if he was no more than a purchaser, and the jury gave a verdict for the plaintiff; *Held*, there being evidence on both

sides of the question, and it not appearing that the verdict was clearly against the weight of the evidence, that it must stand. *Ibid.*, 70, 71.

31. A new trial will not be granted in any case, unless the verdict is clearly without evidence, or against the weight of evidence; nor for the purpose of introducing new evidence to points before in controversy. *Ibid.*, 71.

32. A new trial will be granted if a witness has been improperly rejected. *Buck v. Hermance*, 1 Blatchf., 322, 325.—NELSON, J.; N. Y., 1848.

33. A new trial will not be granted on account of surprise caused by the rejection of evidence, when insufficient or informal notice had been given of the intention of introducing such evidence, or when such evidence, if introduced, would not, in the judgment of the court, have constituted a defence, or varied the result. *Hoote v. Silsby*, 1 Blatchf., 466.—NELSON, J.; N. Y., 1849.

34. In the third circuit, where a jury cannot agree and are discharged, there cannot be a second trial at the same term of the court, by a new jury selected out of the same panel, except by the consent of parties. *Wilson v. Barnum*, 1 Wall., Jr., 353.—GRIER, J.; Pa., 1849.

35. It must be a very extreme case where a judgment will be reversed by the Supreme Court on account of excessive damages in actions *ex delicto*, when the instructions of the court suggested to the jury the true general rule, and the leaving ground for mitigation, as well as against excess, and when, if excessive, a new trial could have been moved in the Circuit Court. *Hogg v. Emerson*, 11 How., 608.—WOODBURY, J.; Sup. Ct., 1850.

## NEWSPAPER.

1. A newspaper establishment is a subject of property, and so far as the rights of such an establishment are private and exclusive, this species of property, like any other, is entitled to the protection of the laws. *Snowden v. Noah*, Hopk. Ch., 351.—WALWORTH, Chan., N. Y., 1825.

2. The good-will of an established trade, the custom of an inn, and the right of a publisher of books may be injured by acts of deception and piracy; but the injury for which redress is given in such cases, results from the imposture practised upon the customers of an existing establishment, or upon the public. *Ibid.*, 352.

3. The acts of Congress, in respect to copyright, are for the encouragement of learning, and were not intended for the encouragement of mere industry, unconnected with learning, and the sciences. *Clayton v. Stone*, 2 Paine, 392.—THOMPSON, J.; N. Y., 1828.

4. A newspaper or price current, is not such a publication as falls under the protection of the copyright laws. *Ibid.*, 293.

5. A court of equity has power to issue an injunction to restrain a defendant, if he has assumed the name of the complainant's newspaper, for the fraudulent purpose of imposing on the public, and supplanting him in the good-will of his established paper, by simulating its name and address. *Bell v. Locke*, 8 Paige, 76.—WALWORTH, Chan.; N. Y., 1840.

6. But the simulation must be such as to injure the circulation and patronage of the complainant's paper, by deceiving the public and inducing the be-

lief that it is in reality the same paper. *Ibid.*, 77.

NONSUIT.

1. It is not a foundation for a nonsuit that the declaration for an infringement of a patent, does not lay the act complained of to be *contra formam statuti*. This is matter of form, the want of which will be cured by verdict. *Tryon v. White*, Pet. C. C., 97.—WASHINGTON, J.; N. J., 1815.

2. But if the declaration in an action for the infringement of a patent, professes to set forth the specification as a part of the grant, according to its tenor, the slightest variation, as *wheel* for *whirl*, is fatal, for which a nonsuit will be granted. *Ibid.*, 97. [In this case the judge ordered a nonsuit, but the question does not appear to have been raised as to the power of the court to order it; and a rule was subsequently granted to show cause why the nonsuit should not be set aside. *Ed.*]

3. The courts of the United States have no authority to order a nonsuit, without the consent of the plaintiff, on the trial of a cause before a jury. *Footte v. Silsby*, 1 Blatchf., 450, 461.—NELSON, J.; N. Y., 1849.

4. It has been repeatedly decided that the courts of the United States have no power to order a peremptory nonsuit, against the will of the plaintiff. *Silsby v. Footte*, 14 How., 222.—CURTIS, J.; Sup. Ct., 1852.

5. The Supreme Court have also held to same effect, in *Elmore v. Grymes*, 1 Pet., 469, 1828; *De Wolf v. Raybaud*, 1 Pet., 476, 1828; *Crane v. Morris*, 6 Pet., 59, 1832.

OATH OF INVENTION.

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

2. Where the construction of the patent and specification, as to the subject of the grant, are doubtful, the affidavit, if more precise, may be resorted to to explain the ambiguity. It seems particularly proper to do so for restraining general expressions in the specification. *Pettibone v. Derringer*, 4 Wash., 217, 218.—WASHINGTON, J.; Pa., 1818.

3. Thus, where the patent recited the applicant to be the inventor of an improvement in boring muskets by a twisted screw-auger, and the specification described the manner of making the auger, its form, and how to be used, and the affidavit confined the invention to the improvement in *making augers* for boring musket-barrels, *Held*, that the patent extended only to the auger, and not to the method or peculiar manner, as described, of using it. *Ibid.*, 218.

4. The oath of originality of invention made by a patentee at the time of his application for a patent, cannot be considered or accepted, in an application for an injunction for infringing such patent. Such motion must be accompanied by an affidavit that he then believes himself to be such original inventor. *Sullivan v. Redfield*, 1 Paine, 445.—THOMPSON, J.; N. Y., 1825.

5. The taking of the oath in due form in an application for a patent, is not a



## OATH; NECESSITY OF; FORCE OF.

condition precedent to the validity of the patent. *Dyer v. Rich*, 1 Met., 191.—SHAW, Ch. J.; Mass., 1840.

6. The statute is directory to the officer superintending the issuing of letters patent, but is not a condition to the validity of the patent. *Ibid.*

7. The oath of first invention required by law of the patentee prior to the issue of a patent, is, in the case of an action for an infringement of the patent, and the jury are entitled to judge of its force, and may take it into consideration, or weigh it against the oath of a witness, that he, such witness, communicated the invention to the patentee—there is oath against oath. *Alden v. Dewey*, 1 Story, 339, 341.—STORY, J.; Mass., 1840.

8. Under § 6 of the act of 1836, the oath required in an application for a patent cannot be taken before a consul. Nor can the "declaration," admitted under the English patent act, be substituted in place of the oath. *Anon.* 3 Opin., 532.—GILPIN, Atty. Gen., 1840.

9. The oath of the patentee is to be considered as extending to all the schedule or specification, no less than the title of his invention. *Hogg v. Emerson*, 6 How., 482.—WOODBURY, J.; Sup. Ct., 1847.

10. The oath, forming a part of the letters patent, is in evidence to the jury, and forms a legal ground for the presumption of the novelty and originality of the patentee's claim, until the contrary is proved. *Parker v. Stiles*, 5 McLean, 60.—LEAVITT, J.; Ohio, 1849.

11. Under § 7 of the act of 1836, an applicant is required to make oath anew only when he persists in his application, after having been informed of the errors or defects of his specification. This

happens before his claim is rejected. *Crooker, Ex parte (Propeller)*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

12. Where the application is finally rejected, though upon a first examination, no new oath is necessary to enable a party to appeal to the judges of the Circuit Court of the District of Columbia. *Ibid.*

13. There is no act that requires the *jurat* to an application for a patent to be dated. *French v. Rogers*, 1 Fisher, 136.—GRIER, KANE, JJ.; Pa., 1851.

14. The oath of an applicant to his application, though not in itself sufficient, is some evidence of the novelty, invention, and usefulness of the thing for which patent is sought. *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

15. A patent issued, grounded on the oath of the patentee, is *prima facie* evidence, in an action of infringement of such patent. *Ibid.*

16. The oath accompanying an application for a patent is evidence on a trial of a *prima facie* character, and is the foundation of the *onus probandi* thrown upon the defendant. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

17. The oath of the inventor accompanying his application for a patent is to be considered as extending to all described in the specification. *King v. Gedney*, MS. (App. Cas.)—MORSELL, J.; D. C., 1856.

## OYER AND PROFERT.

See PLEADING, C.

## PARTIES.

## PARTIES TO ACTIONS.

See ACTIONS, B. 3; EQUITY, B. 2.

## PARTIES, DECLARATIONS OF.

See EVIDENCE, D.

## PARTIES, EXAMINATION OF.

SEE EVIDENCE, G. 1, b. 3.

## PARTNERSHIP IN PATENTS.

1. A joint interest in a patent, does not make the parties partners; some agreement is therefore necessary to enable such parties to work the invention at their joint expense, and for their joint benefit. *Parkhurst v. Kinsman*, 1 Blatchf., 496.—NELSON, J.; N. Y., 1849.

2. The assignment of all interest in a patent by one joint owner, is a dissolution of a partnership for working it. *Ibid.*, 498.

3. One partner in the manufacture and sale of a patented article, cannot acquire, as assignee, an outstanding right or claim of a third person, as an inventor of the same thing, and set it up against his joint partner, and particularly if he entered into such partnership with a knowledge of such alleged title. *Kinsman v. Parkhurst*, 18 How., 294.—CURTIS, J.; Sup. Ct., 1855.

4. The relation of copartners between joint patentees does not result from their connection as joint patentees,

or between one of two joint patentees and the assignee of the other. The parties are simply joint owners or tenants in common, of the rights and property secured by the patent; and their rights, powers, and duties as respects each other are substantially those of the joint owners of a chattel. *Pitts v. Hall*, 3 Blatchf., 206.—HALL, J.; N. Y., 1854.

5. One joint owner of a patent can legally grant, assign, license, or sell, only in respect to his own share or right; he cannot sell and give good title to his co-owner's right; and if he appropriates any portion of the exclusive right or common property to his separate use or benefit, either by a sale or use of the patented machine, it is in principle the same as a conversion, by destruction or sale, of the joint property by a tenant in common, and for which the other tenant in common could maintain trover. *Ibid.*, 207, 208.

## PATENTS.

<b>A.</b>	SUBJECT MATTER OF.....	498
<b>B.</b>	RIGHT TO, HOW LOST OR FORFEITED..	498
<b>C.</b>	GRANT, OR ISSUE OF; BY AND TO WHOM	498
<b>D.</b>	WHAT GRANTED OR SECURED BY.	
	1. <i>General Nature of the Grant</i> .....	498
	2. <i>Whether may include more than one Invention</i> .....	501
<b>E.</b>	WHAT EMBRACED IN THE "LETTERS PATENT".....	504
<b>F.</b>	APPLICATION FOR PATENT.....	504
<b>G.</b>	INTERFERING APPLICATIONS.....	504
<b>H.</b>	TERM OF; DATE OF; WHEN BEGINS TO RUN .....	505
<b>I.</b>	TERRITORIAL EXTENT OF.....	506
<b>K.</b>	NAME AND TITLE OF.....	506
<b>L.</b>	PRIOR AND SUBSEQUENT, FOR SAME INVENTION.....	507
<b>M.</b>	SURRENDER AND REISSUE OF.....	508

## GENERAL NATURE OF GRANT.

<b>N.</b>	RENEWAL AND EXTENSION OF...	508
<b>O.</b>	MISTAKES IN CORRECTION OF.....	508
<b>P.</b>	CONSTRUCTION OF	
1.	<i>General Principles of Construction</i> ....	508
2.	<i>Prima Facie Authority of</i> .....	513
3.	<i>How far construed by the Court</i> .....	517
4.	<i>How far construed by the Jury</i> .....	519
5.	<i>Claim in, Force and Construction of</i> ...	521
<b>Q.</b>	VIOLATION OF.....	525
<b>R.</b>	WHEN VOID.....	525
<b>S.</b>	TRANSFER OF.....	530

**A. SUBJECT MATTER OF.**

See ART; COLORABLE ALTERATIONS; COMBINATION, A.; COMPOSITION OF MATTER, A.; DISCOVERY; DOUBLE USE; EFFECT; EQUIVALENT; EXPERIMENTS; FORM; IMPROVEMENTS, A.; INTENT; INVENTION, A.; MACHINES, A.; MANUFACTURE, ARTICLE OF; MATERIAL; MEDICINE; MECHANIC, SKILL OF; MODE, METHOD, OR PROCESS; NEW APPLICATION; PRINCIPLE; PROCESS; PURPOSE; SUGGESTIONS; THEORY.

As to when an invention is reduced to practice, so as to be patentable, see INVENTION, B.

As to the necessary novelty and utility of a patentable subject, see INVENTION, D.

**B. RIGHT TO, HOW LOST OR FORFEITED.**

See titles ABANDONMENT, B.; APPLICATION FOR PATENT, A.; PRIOR USE BY INVENTOR.

See also in connection herewith, PRIOR KNOWLEDGE OR INVENTION.

**C. GRANT OR ISSUE OF; BY AND TO WHOM.**

See APPLICATION, B.; INTRODUCER; INVENTOR, A., B.; JOINT INVENTOR.

See also INVENTION, D.

**D. WHAT GRANTED OR SECURED BY.**1. *General Nature of the Grant.*

As to construction of Patents, see PATENT, P.

1. The general law declares that the right to a patent belongs to him who is the first inventor, even before a patent is granted; therefore any person, who, knowing that another is the first inventor, yet doubting whether that person will ever apply for a patent, proceeds to construct a machine so invented by another, acts at his peril, and with a full knowledge of the law, that a subsequent patent may cut him out of the use of the machine thus erected. *Evans v. Wiess*, 2 Wash., 345.—WASHINGTON, J.; Pa., 1809.

2. 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 such state. *Livingston v. Van Ingen*, 9 John., 581.—KENT, Ch. J.; N. Y., 1812.

3. The constitution and the law together give to the inventor, from the moment of discovery, an inchoate property therein, which is completed by suing out a patent. This inchoate right is exclusive. It can be invaded or impaired by no person, and no right can be acquired in it without the consent of the inventor. *Evans v. Jordan*, 1 Brock., 252.—MARSHALL, Ch. J.; Va., 1813.

4. A patent is a bargain with the pub-

## GENERAL NATURE OF GRANT.

lic in which the same rules of good faith prevail as in other contracts. *Whitney v. Emmett*, Baldwin, 319.—BALDWIN, J.; Pa., 1831.

5. If a patent is valid, it gives to the patentee a right of property in the thing patented, which is entitled to full protection in the courts. *Ibid.*, 322.

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

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

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

9. From an examination of the various provisions of the patent law, it clearly appears that it was the intention of the legislature, by a compliance with the requisites of the law, to vest an exclusive right in the inventor only—and that on condition that his invention was neither known nor used by the public before his application for a patent. *Shaw v. Cooper*, 7 Pet., 319.—MCLEAN, J.; Sup. Ct., 1833.

10. Every discoverer should realize the benefits resulting from his discovery for the period contemplated by law. But these can only be secured by a substantial compliance with every legal requisite. His exclusive right does not rest alone upon his discovery, but also upon the legal sanctions which have been given to it, and the forms of law with which it has been clothed. *Ibid.*, 320.

11. A patent authorizing the patentee to make, construct, and use a newly discovered compound of medicine, gives such patentee no right to practise as a physician, even though only administering such medicine, without complying with the regulations established by the laws of any state. *Thompson v. Staats*, 15 Wend., 395.—NELSON, J.; N. Y., 1836.

12. 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.

13. The exclusive grant of a patent is the construction and use of the thing patented. *Boyd v. Brown*, 3 McLean, 297.—MCLEAN, J.; Ohio, 1843.

14. Where the right was in certain instruments to make a particular kind of bedstead, the exclusive right of making, using, and selling such instruments is that which is secured, and not the bedstead, which is the product. *Ibid.*, 297.

15. 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.

16. At common law an inventor has no exclusive right to make and vend his

invention, after he has published it to the world. Such exclusive right is the creature of the statute, which also prescribes the remedy for its violation. *Dudley v. Mayhew*, 3 Coms., 13-17.—STRONG, J.; N. Y., 1849.

17. An exclusive right in a composition of matter, as a medicine, can only be obtained under the patent law by a compliance with its provisions. *Coffeen v. Brunton*, 4 McLean, 517.—MCLEAN, J.; Ind., 1849.

18. A patent-right is insusceptible of local subdivision. As a privilege or monopoly, it is an entire thing, and incapable of apportionment. *Blanchard v. Eldridge*, 1 Wall., Jr., 339.—GRIER, J.; Pa., 1849.

19. The monopoly is capable of subdivision in the category of its 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 in conflict. *Ibid.*, 340.

20. The contract of the public is not with him who has discovered, but him who also makes his discovery usefully known. If he has discovered much and discloses little, communicates to the world only one or more of the derivative and secondary truths of the principle he has discovered, he patents no more than he has proclaimed. *Detmold v. Reeves*, 4 Amer. Law Jour., N. S., 189.—KANE, J.; Pa., 1851.

21. He will not be allowed afterward, when the extent of his right shall be the subject of controversy, to expand into a general expression what was before limited in a particular form, and argue that he had described the whole by implication from the first. *Ibid.*, 189.

22. It is for the parts claimed as the

invention of the patentee, and as such particularly pointed out, that the patent issues. It covers no more; and the patentee is not bound to prove the originality of what is *not* in it to make it a protection for what is in it. *Holliday v. Rheem*, 18 Penn., 469.—BLACK, Ch. J.; Pa.; 1852.

23. 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.

24. It is a reasonable presumption that the intention of the inventor was to obtain, and of the government to concede to him the exclusive right of what he had invented. *Kittle v. Merriam*, 2 Curt., 479.—CURTIS, J.; Mass., 1855.

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

26. A patent when granted becomes to a certain extent a contract on the part of the government with the patentee, that they will, through their courts, and in the ordinary course of the administration of justice, protect him in the exercise of the exclusive privileges which his patent gives him. *Ransom v. Mayor, &c.*, 1 Fisher, 259.—HALL, J.; N. Y., 1856.

27. A patent is a compact—an executory contract—rather than a deed of property. Its vitality consists in the

making good by the patentee of certain provisions which are of the character of conditions subsequent, as that he is the first inventor; that the invention is useful; and that there is a sufficient description and representation of it in the specification and drawings. *Smith v. Higgins*, MS.—BETTS, J.; N. Y., 1857.

28. A patent may be considered in the light of a deed from the government, and the patentee is bound to communicate his invention in so full and clear a manner that it shall be within the comprehension of the public at the expiration of the term. The exclusive privilege granted by a patent is not merely as the reward of genius, and for the encouragement of useful inventions and improvements in arts and manufactures, but also embraces the public benefit. *Page v. Ferry*, 1 Fisher, 306, 307.—WILKINS, J.; Mich., 1857.

29. The limited and temporary monopoly granted to inventors was never designed for their exclusive profit or advantage; the benefit to the public or community at large was another and doubtless the primary object in granting and securing that monopoly. *Kendall v. Winsor*, 21 How., 327, 328.—DANIEL, J.; Sup. Ct., 1858.

30. This was at once the equivalent given by the public for benefits bestowed by the genius, and meditations, and skill of individuals, and the incentive to further efforts for the same important objects. *Ibid.*, 328.

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

32. An inventor has no legal rights or immunities under a patent, except such as are conferred by the statute.

With whatever solemnity or observance of legal form it may have issued, if wanting in any substantial statutory requisite it is a nullity. *Moffitt v. Garr*, 1 Fisher, 612.—LEAVITT, J.; Ohio, 1860.

33. A patentee 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.; N. J., 1861.

34. Goodyear, the patentee of vulcanized 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. *Whether may include more than one Invention.*

1. Whether, under the general patent laws, improvements on different machines can be comprehended in the same patent, so as to give a right to the exclusive use of the several machines separately, as well as a right to the exclusive use of these machines in combination, query. *Evans v. Eaton*, 3 Wheat., 506.—MARSHALL, Ch. J.; Sup. Ct., 1818.

## WHETHER MAY INCLUDE MORE THAN ONE INVENTION.

2. A patent cannot embrace various and distinct improvements or inventions; but in such case the party must take out separate patents. Nor can the same patent be for each one of several machines, each capable of a distinct operation, and for their combination, to produce a connected result. *Barrett v. Hall*, 1 Mas., 475.—STORY, J.; Mass., 1818.

3. Where a plaintiff claims several distinct and independent improvements in the *same* machine, and procures a patent for them in the aggregate, he is entitled to recover against any person who shall use any one of the improvements so patented, notwithstanding there has been no violation of the other improvements. *Moody v. Fiske*, 2 Mas., 115, 119.—STORY, J.; Mass., 1820.

4. But though several distinct improvements in one machine may be united in one patent, it does not follow that several improvements in *two different* machines, having distinct and independent operations, can be so included. *Ibid.*, 119.

5. Nor can the same patent be for a *combination* of different machines, and for distinct improvements in each. *Ibid.*, 119.

6. A single patent cannot embrace two machines which are wholly independent of each other, and distinct inventions for unconnected objects; nor for several distinct improvements upon different machines, having no common connection or common purpose. This was the meaning of the court in *Barrett v. Hall*, 1 Mas., 447, and *Moody v. Fiske*, 2 Mas., 115. *Wyeth v. Stone*, 1 Story, 288.—STORY, J.; Mass., 1840.

7. But a single patent may be taken for several inventions or improvements, though each is a distinct and indepen-

dent invention or improvement, and capable of a distinct use and application, if they conduce to the accomplishment of one and the same general end. *Ibid.*, 291, 292.

8. A patent may be maintained for a machine combining several distinct improvements, if each is the invention of the patentee, and also include a right to each of the several and distinct improvements. In other words, the patentee may in such a case take out a valid patent for the combination, and also include therein a right to each distinct improvement severally contained in the same machine. This doctrine was maintained in *Wyeth v. Stone*, 1 Story, 291 (Mass., 1840), and it is confirmed by the obvious intent of § 9 of the act of 1837, which gives to the patentee a right of action for the piratical use of any one of his invented improvements, which is distinctly stated in his patent, although he may have included something of which he was not the inventor. *Pitts v. Whitman*, 2 Story, 621.—STORY, J.; Me., 1843.

9. The doctrine intimated by the court in *Evans v. Eaton*, 3 Wheat., 506 (*ante* 1), whether improvements on different machines can be comprehended in the same patent, must be accepted as put hypothetically—as the special statute (6 *U.S. Stat. at Large*, 70) furnished a rule in that case—and as not being laid down as a settled principle to govern the construction of specifications. *Emerson v. Hogg*, 2 Blatchf., 7.—BETTS, J.; N. Y., 1845.

10. The case of *Barrett v. Hall*, 1 Mas., 475 (*ante* 2), attempts a generalization of the doctrines of the patent law; but in *Moody v. Fiske*, 2 Mas., 118 (*ante* 3), that case is explained. *Ibid.*, 8.

11. The suggestions in all these cases were by way of caution, and were designed to avoid the conclusion that the court had prejudged or was committed on that question. *Ibid.*, 8.

12. In *Wyeth v. Stone*, 1 Story, 288, the court reviews these cases, and holds that a patent for several machines, each being a distinct and independent invention, is valid where they have a common purpose, and are auxiliary to the same common end. *Ibid.*, 8.

13. The principle seems to be, that the inventions should be capable of being used in connection, and to subserve a common end. But their actual employment together is not required to sustain the validity of the patent in which they may be united. The wrongful use of either separate machine is a violation of the patent *pro tanto*. *Ibid.*, 8.

14. Where a patent contained three claims: (1) a mode of converting the reciprocating motion of a piston into a continuous rotary motion; (2) a spiral propelling wheel; and (3) the application of a revolving vertical shaft to the turning of a capstan on the deck of a vessel; and the specification showed that the three were contrived to be used conjointly and for a common end; *Held*, that they could be embraced in one patent, and that the fact that they were capable of being used separately and independently of each other, did not prevent them being so embraced in one patent. *Ibid.*, 8.

15. Two inventions cannot be united in the same patent when they relate to two distinct machines. *Root v. Ball*, 4 McLean, 179, 180.—McLEAN, J.; Ohio, 1846.

16. But the same patent may include a patent for a combination, and an in-

vention of some of the parts of which the combination consists. : *Ibid.*, 180.

17. As a general rule, two patents cannot be united in the same letters. But it is a well established exception, that patents may be united if two or more included in one set of letters relate to a like subject, or are in their nature and operation connected together. *Hogg v. Emerson*, 6 How., 483.—WOODBURY, J.; Sup. Ct., 1847.

18. A patent for more than one invention is not void if they are connected in their design and operation. *Hogg v. Emerson*, 11 How., 606.—WOODBURY, J.; Sup. Ct., 1850.

19. It is competent for a patentee to embrace two improvements on the same machine in the same patent; and if a person uses either or both of the improvements, he is an infringer. *Morris v. Barrett*, 1 Fisher, 463.—LEAVITT, J.; Ohio, 1858.

20. There may be a claim for two inventions in the same patent if they both relate to the same machine or structure; and an action can be sustained for the infringement of either one or the other of these separate inventions, where claimed as separate and distinct in their character. *Lee v. Blandy*, 2 Fisher, 92.—McLEAN, LEAVITT, JJ.; Ohio, 1860.

21. A party may unite as many improvements, having relation to the same thing, in one patent, as he pleases, but he may make each improvement the subject of a separate patent if he chooses. *Hayden, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

22. Where the features of novelty are numerous, prudence suggests that the danger of making a patent too broad by uniting questionable with plainly novel claims be avoided by taking separate patents. *Ibid.*



**E. WHAT EMBRACED IN THE "LETTERS PATENT."**

1. Under § 1 of the act of 1790, the allegations and suggestions of the petition must be substantially recited in the patent. *Evans v. Chambers*, 2 Wash., 126.—WASHINGTON, J.; Pa., 1807.

2. The schedule is to be considered as a part of the letters patent, so far as it is descriptive of the machines, but no farther. *Evans v. Eaton*, Pet. C. C., 341.—WASHINGTON, J.; Pa., 1816.

3. Merely describing in the specification the parts of a thing, or the *modus operandi*, and as to which no claim is made, does not make such things a part of the patent. *Kneass v. Schuyt. Bank*, 4 Wash., 14.—WASHINGTON, J.; Pa., 1820.

4. The patent and specification are connected together, and dependent on each other for support. The specification should maintain the title of the patent. The latter should not indicate one thing and the former describe another as the subject of the grant. *Sullivan v. Redfield*, 1 Paine, 450.—LIVINGSTON, J.; N. Y., 1825.

5. In using the word *patent*, in reference to the description of the thing patented, it is to be understood as including the patent, the specification attached to it, with the model and drawing in the Patent Office, all of which are to be taken together. *Whitney v. Emmett*, Bald., 314.—BALDWIN, J.; Pa., 1831.

6. The specification constitutes a part of the letters patent. *Pitts v. Whitman*, 2 Story, 614.—STORY, J.; Me., 1843.

7. The drawing is a part of the patent, and may be referred to in order to

help out the description. *Emerson v. Hogg*, 2 Blatchf., 9.—BETTS, J.; N. Y., 1845.

8. 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.

9. The schedule or specification annexed to the letters patent is, under our laws and practice, to be regarded as a component part of the letters patent, and may be referred to to explain or add to the title of the patent. *Hogg v. Emerson*, 6 How., 478, 482.—WOODBURY, J.; Sup. Ct., 1847.

10. Models and drawings are a part of the letters patent. *Ibid.*, 485.

11. 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. Railroads*, 2 Whart. Dig., 410.—KANE, J.; Pa., 1848.

12. Under the act of 1793, the specification was not necessarily made a part of the letters patent, but the inventor had a right, if he pleased, to advise the Patent Office to incorporate it into the letters as a part of them, by express terms of reference. *Hogg v. Emerson*, 11 How., 604.—WOODBURY, J.; Sup. Ct., 1850.

13. The specification, when thus voluntarily annexed, became a part of the patent by general principles, as clearly as it does since by the words of the law. *Ibid.*, 605.

**F. PATENT, APPLICATION FOR.**

See APPLICATION FOR PATENT.

**G. INTERFERING APPLICATIONS.**

See INTERFERENCES.

## TERM OF; DATE OF; WHEN BEGINS TO RUN.

**H. TERM OF; DATE OF; WHEN BEGINS TO RUN.**

As to extension of term, see **EXTENSION OF PATENT.**

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

2. Where two patents are issued to the same person, but on different specifications, their dates should conform to the times of the two applications. It is illegal to antedate the last patent to the time of the first application, as it might overreach intermediate improvements made by others. *Blanchard's Case*, 5 Opin., 722.—**WIRT**, Atty. Gen.; 1820.

3. The date of a patent may be altered to correspond with that of a foreign patent previously taken out by the inventor, where the mistake has not arisen from any fraudulent or deceptive intention. *Detmold's Case*, 4 Opin., 335.—**NELSON**, Atty. Gen.; 1844.

4. Under § 6 of the act of 1839, if a party apply for and obtain a patent for an invention, for which he has previously obtained a foreign patent, his home patent must be limited to fourteen years from the date of such foreign patent. *Smith v. Ely*, 5 McLean, 78.—**MCLEAN**, J.; Ohio, 1849.

5. If such domestic patent purports to give an exclusive right for fourteen years from its date, instead of from the date of the foreign patent, such patent is void, as issued in violation of law. *Ibid.*, 79. [But see *post* 10.]

6. The limitation of the exclusive

right, is a material part of the patent, and must be truly stated. *Ibid.*, 80.

7. But the error is not fatal to the rights of the patentee, and may be corrected on application to the Patent Office. *Ibid.*, 80.

8. The provisions of § 8 of the act of 1836, and of § 6 of the act of 1839, as to the obtaining of patents, after foreign patents have been secured, and as to the date of the home patent, in such case, relates only to such patents as are *applied for* here *after* the issue of the foreign patent. *French v. Rogers*, 1 Fisher, 136.—**GRIER**, **KANE**, JJ.; Pa., 1851.

9. Where therefore an application for a patent for an invention was made in April, 1838, and acted on in that month, but a patent was not actually issued until June 20, 1840, at which time it was dated, and a foreign patent was obtained in August, 1838. *Held*, as the application here was before the foreign patent, that the grant of the patent here was under the general enactments of the law of 1836, and its term runs properly from its date. *Ibid.*, 135, 136.

10. A patent is not void because, on its face, it does not bear the same date with a previous foreign patent, taken out by the patentee for the same invention; the monopoly however is limited to fourteen years from the date of the foreign patent. *O'Reilly v. Morse*, 15 How., 112.—**TANEY**, Ch. J.; Sup. Ct., 1853.

11. When a patent has expired, whatever of invention it contained belongs to the public, and may be used by any one. *McCormick v. Manny*, 4 Amer. Law Reg., 286.—**MCLEAN**, J.; Ill., 1855.

12. A patentee, under § 5 of the act of 1836, is not obliged to claim the whole fourteen years. He may waive his claim to a part of the term in favor

TERRITORIAL EXTENT OF.	NAME AND TITLE OF.
<p>of the public, by antedating it; or he may take a patent for a term less than fourteen years; or he may seek protection against strangers, for six months previous to the issue, if in that time he has made application and is seeking in good faith and with reasonable diligence to perfect his specifications. <i>Cushman, W. M. C., Ex parte</i>, MS. (App. Cas.)—DUNLOP, J.; D. C., 1858.</p>	<p>the United States. The patent acts do not, and were not intended to operate beyond the limits of the United States—and the patentee's right of property and exclusive use cannot extend beyond the limits to which the law itself is confined. <i>Brown v. Duchesne</i>, 19 How., 195.—TANEY, Ch. J.; Sup. Ct., 1856.</p>
<p><b>I. TERRITORIAL EXTENT OF.</b></p>	<p>6. The rights of property and exclusive use granted to a patentee, do not extend to a foreign vessel lawfully entering our ports; and the use on such vessel of an improvement, patented in this country, is not an infringement of the rights of an American patentee, provided it was placed upon her in a foreign port, and authorized by the laws of the country to which she belongs. <i>Ibid.</i>, 198.</p>
<p>1. The grant of the exclusive right conferred by letters patent, includes every use of the thing patented, by all persons within the territory of the United States. <i>Brown v. Duchesne</i>, 2 Curt., 371.—CURTIS, J.; Mass., 1855.</p>	<p><b>K. NAME AND TITLE OF.</b></p>
<p>2. Such grant however, and the exclusive rights conferred by it, are creatures of the municipal law of the country; and however comprehensive are its terms, cannot be construed to include either persons or things, not within the jurisdiction of the patent laws. <i>Ibid.</i>, 371.</p>	<p>1. An inventor has a right to call his invention or patented article what he pleases, provided he do not assume an already existing and popular name, to the prejudice of those who have preoccupied the name. <i>Bacon's Case</i>, 2 Opin., 109.—WIRT, Atty. Gen.; 1828.</p>
<p>3. Where a vessel was built and rigged in France, and had in use gaffs which had been patented in the United States, <i>Held</i>, as the gaffs were placed on the vessel when she was built, and as part of her original equipment, in a foreign country, by persons not within the jurisdiction of our patent laws, that such use was not within the application of our patent laws, but was exempted. <i>Ibid.</i>, 375, 377.</p>	<p>2. Where the inventor of a newly patented medicine, desired to give it the name of <i>Anderson's Cough Drops</i>, which was already well known, the patent was ordered to be withheld until he should assume for it another name. <i>Ibid.</i></p>
<p>4. The patent laws were not intended to apply to, and do not extend over foreign vessels visiting our ports, so as to effect the structure or equipment they bring hither. <i>Ibid.</i>, 376, 377.</p>	<p>3. The title or description given to an invention in the grant, is never expected to be specific, but only to indicate the nature and design of the invention. The specification must be searched for the exact description of what the patentee claims. <i>Sickles v. Glou. Man. Co.</i>, 1 Fisher, 229.—GRIER, J.; N. J., 1856.</p>
<p>5. The power granted by the patent laws is domestic in its character, and necessarily confined within the limits of</p>	<p>4. A patentee is not controlled by</p>

## PRIOR AND SUBSEQUENT.

the *title* of his patent, but by all the papers—the patent, the specification and drawings, taken together. *Bell v. Daniels*, 1 Fisher, 374.—LEAVITT, J.; Ohio, 1858.

**L. PRIOR AND SUBSEQUENT, FOR SAME INVENTION.**

1. It is a presumption of law that when a patent has been obtained, every man who subsequently takes out a patent for a similar machine, has a knowledge of the preceding fact. *Odiorne v. Winkley*, 2 Gall., 55.—STORY, J.; Mass., 1814.

2. It is also a presumption of fact that every man, having within his power the means of information, and desirous of securing to himself the benefit of a patent, will ascertain whether any one on the public records has acquired a prior right. *Ibid.*, 55.

3. A grant of a subsequent patent for an invention is an estoppel to the patentee to set up any prior grant for the same invention which is inconsistent with the terms of the last grant. *Barrett v. Hull*, 1 Mas., 473.—STORY, J.; Mass., 1818.

4. Whether, when a patent is once granted to any person for an invention, he can legally acquire any right under a subsequent patent for the same invention, unless his first patent be repealed for some original defect, so that it might truly be said to be a void patent; *query*. *Ibid.*, 473.

5. If several patents are taken out by several patentees for a several invention, and the same patentees afterward take out a joint patent for the same as a joint invention, the parties are not absolutely estopped by the former patents from asserting the invention to be joint, but the former patents are very strong evi-

dence against the joint invention. *Ibid.*, 474.

6. A patentee cannot have in use at the same time two valid patents for the same invention. The first, while it remains unrepealed, is an estoppel of any future patent for the same invention. *Odiorne v. Amesbury Nail Factory*, 2 Mas., 30, 31.—STORY, J.; Mass., 1819.

7. Where two parties obtained several patents for an invention, and afterward applied for and obtained a joint patent therefor, *Held*, that neither party could set up the prior separate patents, and that neither was estopped by the separate patents from asserting that the invention was joint. *Stearnes v. Barrett*, 1 Pick., 447.—WILDE, J.; Mass., 1823.

8. A prior patent must be got rid of before a second can be taken out. If a prior patent is not surrendered, repealed, or declared void, it is a good defence to an action on the second patent. *Morris v. Huntington*, 1 Paine, 354.—THOMPSON, J.; N. Y., 1824.

9. Nor will a verdict of a jury in an action on the second patent avoid the first one. *Ibid.*, 356.

10. A person cannot have two subsisting valid patents at the same time for the same invention. But where a patentee had taken out a patent for an *original* invention, and upon an action for an infringement thereof, it was proved that as to a part of the invention he was not the *first* inventor, and therefore the court held that his patent was void, as being too broad, and afterward he took out another patent for those parts of his invention not known before, *Held*, that the two patents were not for the same invention. *Treadwell v. Bladen*, 4 Wash., 709.—WASHINGTON, J.; Pa., 1827.

11. But if such patents were substantially for the same invention, *query*, whether a disclaimer of all title under the first patent to the material parts of the invention for which granted, would not operate as an estoppel to any remedy for a violation of that patent. *Ibid.*, 709.

12. If a person has obtained a patent for a thing which he claims to have invented, he cannot at any future time claim another patent for a substantial part of the same thing. *Smith v. Ely*, 5 McLean, 88.—McLEAN, J.; Ohio, 1849.

13. A patentee cannot take out a subsequent patent for a portion of his first invention, and thereby extend his monopoly beyond the period limited by law. *O'Reilly v. Morse*, 15 How., 114.—TANNEY, Ch. J.; Sup. Ct., 1853.

14. But the validity of a patent cannot be impeached upon the ground that it is an improvement upon a former invention, for which the patentee has already obtained a patent. *Ibid.*, 122.

15. No subsequent patent can take away rights secured by a prior patent. *Sickles v. Tileston*, 4 Blatchf., 110.—INGERSOLL, J.; N. Y., 1857.

16. Where an invention is substantially described and claimed in one patent, it cannot be made the subject of a claim in a subsequent one. *Sickles v. The Falls Co.*, 4 Blatchf., 509.—NELSON, J.; Ct., 1861.

### M. SURRENDER AND REISSUE OF.

See title REISSUE OF PATENT.

### N. RENEWAL AND EXTENSION OF.

See title EXTENSION OF PATENT.

### O. MISTAKES IN CORRECTION OF.

See title MISTAKES IN PATENT.

### P. CONSTRUCTION OF.

#### 1. General Principles of Construction.

See also AMBIGUITY; PATENT, D.; SPECIFICATION, A.

1. The patent determines the nature and extent of the thing granted and secured to the patentee, and the plaintiff can claim no right which is not included in the patent, even though the patent is issued under a special act of Congress, and is not as broad as the law under which it was issued. His right is under the patent, and not under the law. *Evans v. Eaton*, Pet. C. C., 340.—WASHINGTON, J.; Pa., 1816.

2. The grant can only be for the discovery as recited in the patent and specification. *Ibid.*, 342.

3. The doctrine of patents may truly be said to constitute the metaphysics of the law. The difficulty lies, not so much in the general principles, as in the minute and subtle distinctions which arise occasionally in the application of those principles. *Barrett v. Hall*, 1 Mas., 472.—STORY, J.; Mass., 1818.

4. Though the construction of the patent must certainly depend on the words of the instrument, where the words are ambiguous, there may be circumstances which ought to have great influence in expounding them. The intention of the parties, if that intention can be collected from sources which the principles of law permit us to explore, are entitled to great consideration. Therefore a special act may be referred

## CONSTRUCTION OF; GENERAL PRINCIPLES AS TO.

to, as well as the patentee's petition, and such a construction should be given to the grant as will make it, with such documents forming a part of it, not contradictory with itself. *Evans v. Eaton*, 3 Wheat., 506, 512.—MARSHALL, Ch. J.; Sup. Ct., 1818.

5. The patent and specification are connected together and dependent upon each other for support. The specification should maintain the title of the patent; the latter should not indicate one thing, and the former describe another, as the subject of the grant. *Sullivan v. Redfield*, 1 Paine, 450.—THOMPSON, J.; N. Y., 1825.

6. In deciding on the sufficiency of a patent, the court inspect the whole description as one paper, which they assume to be true in fact, and if found to be in conformity with the requisitions of the law, so that it appears with reasonable certainty, either from the words used or by necessary implication, in what the invention consists, though the description may be somewhat obscure, or imperfect, or defective, in form or mode of explanation, as claimed by the patentee, they will adjudge it sufficient.

*Whitney v. Emmett*, Bald. Rep., 315.—BALDWIN, J.; Pa., 1831.

7. Where the invention is substantially new, is useful to the public, and the disclosure by the specification and other papers is made in good faith, and fairly communicated in terms intelligible to men who understand the subject, juries ought to look favorably on the right of property, and to find against a patentee or plaintiff only for some substantial defect in his title papers or proof. *Ibid.*, 322.

8. Patents for inventions are not to be treated as mere monopolies, odious in the eyes of the law, and therefore not

to be favored; nor are they to be construed with the utmost rigor as *strictissimi juris*. *Ames v. Howard*, 1 Sumn., 485.—STORY, J.; Mass., 1833.

9. The Constitution of the United States, in giving authority to Congress to grant such patents for a limited period, declares the object to be to promote the progress of science and the useful arts, an object as truly national, and meritorious, and well founded in public policy, as any which can possibly be within the scope of national protection. Hence it has always been the course of the American courts—and latterly of the English—to construe patents fairly and liberally, and not subject them to any over-nice and critical refinements. *Ibid.*, 485.

10. If the court can clearly see what is the nature and extent of the claim, by a reasonable use of the means of interpretation of the language used, then the patentee is entitled to the benefit of it, however imperfectly and unartificially he may have expressed himself; and for this purpose particular phrases are not to be singled out, but the whole is to be taken in connection. *Ibid.*, 485.

11. It is a clear rule of our law in favor of inventors, and to carry into effect the obvious object of the constitution and laws, to give a liberal construction to the language of all patents and specifications, *ut res magis valeat quam pereat*, so as to protect, and not to destroy, the rights of real inventors. *Ryan v. Goodwin*, 3 Sumn., 520.—STORY, J.; Mass., 1839.

12. Under the laws of the United States, patents for inventions are treated as a just reward to ingenious men, and as highly beneficial to the public. They are therefore clearly entitled to a liberal construction, since they are not

granted as restrictions upon the rights of the community, but are granted "to promote science and the useful arts." *Blanchard v. Sprague*, 3 Sumn., 539, 540.—STORY, J.; Mass., 1839.

13. Every patent is a monopoly, and nothing can justify it but the natural right of property which a man has in the products of his own labor and ingenuity. It is in derogation of common right, and should be strictly confined to the case excepted. *Kemper, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

14. In "patents" the court looks through the whole patent and specification, in order to ascertain what is the thing claimed and patented in it. There is no artificial or universal rule of interpretation of such an instrument beyond that which common sense furnishes, which is to construe the instrument as a whole, and extract from the descriptive words and the claim what the invention is which is intended to be patented, and how far it is capable of exact ascertainment, and how far it is maintainable in point of law, supposing it clear from all ambiguity. *Carver v. Braintree Manuf. Co.*, 2 Story, 446, 447.—STORY, J.; Mass., 1843.

15. In construing a patent we are not to look alone to the descriptive words contained in the letters patent, but we are to construe those words in connection with the specification which is always annexed to and made part of the letters patent. *Pitts v. Whitman*, 2 Story, 621.—STORY, J.; Me., 1843.

16. Therefore, where in the specification the patentees began by saying that they "have invented a new and improved combination of machinery for separating grain from the straw and chaff as it proceeds from the threshing ma-

chine," *Held*. that this showed that the patentees claimed the entire combination of the machinery. *Ibid.*, 622.

17. In the summing up of their invention, they also claimed four distinct improvements in the machinery, *Held*, the two being construed together (as they should be), that the patentees not only claimed the entire machinery in combination, but also the four improvements enumerated. *Held*, also, that if they are their invention, there is no objection in point of law to their claim. *Ibid.*, 621, 622.

18. A patent must be construed and passed upon according to the laws in force at the time of the granting of it. The subsequent repeal of such acts cannot impair the right of property existing in a patentee. *McClurg v. Kingsland*, 1 How., 206.—BALDWIN, J.; Sup. Ct., 1843.

19. The patent law gives a monopoly, but not in an odious sense. It takes nothing from the community at large, but secures to them the greatest benefit. To remunerate inventors for "their time, ingenuity, and expense," the law gives them the exclusive right of selling their invention for a limited period; and to secure them this remuneration, a liberal construction should be given to the law. *Brooks v. Bicknell*, 3 McLean, 437.—MCLEAN, J.; Ohio, 1844.

20. A liberal construction is to be given to a patent, and inventors sustained, if practicable, without a departure from sound principles. *Davoll v. Brown*, 1 Wood. & Min., 57.—WOODBURY, J.; Mass., 1845.

21. Sometimes the preamble, even, may be resorted to for ascertaining the object of the specification, sometimes the body of the specification, sometimes the summing up, and sometimes

the formal clause at the end of the specification. Generally, all of them are examined together, unless the formal clause seems explicitly to exclude the rest. *Ibid.*, 59.

22. Matters described therein should be considered in a practical manner, and not be decided on mere metaphysical distinctions. *Ibid.*, 60.

23. One patent, though very useful and economical in the manufacture or use of another invention, before patented, cannot be treated as a part and parcel of such other patent, so as to render available in an action upon one of such patents, long possession under and recoveries upon such other patent, where the several patents and specifications do not refer to each other as being auxiliary to one another; but each patent must stand upon its own merits. *Hovey v. Stevens*, 1 Wood. & Min., 295, 296.—WOODBURY, J.; Mass., 1846.

24. A patent is to be construed or tested by the acts in force at the time of its issue. *Hogg v. Emerson*, 6 How., 479.—WOODBURY, J.; Sup. Ct., 1847.

25. The true rule of construction in respect to patents and specifications, is to apply to them plain and ordinary principles, and not to yield to subtleties and technicalities unsuited to the subject, and not in keeping with the liberal spirit of the age, and likely to prove ruinous to a class of the community so inconsiderate and unskilled in business as men of genius and inventors usually are. *Ibid.*, 485.

26. The description of an invention by the patentee in his own language, as contained in the specification, is the highest evidence of the thing or instrument which he claims to have discovered. *Many v. Jagger*, 1 Blatchf., 377.—NELSON, J.; N. Y., 1848.

27. Patents, securing to inventors the just reward of their labor and industry, are to be construed liberally. These exclusive rights are not to be viewed in the light of odious monopolies, but as the result of a policy at once beneficent and wise. *Parker v. Stiles*, 5 McLean, 54.—LEAVITT, J.; Ohio, 1849.

28. The whole instrument—that is, the patent, embracing the specification and drawings—is to be taken together; and if from these, the nature and extent of the claim can be perceived, the court is bound to adopt that interpretation, and give it full effect. *Ibid.*, 57.

29. A patent-right is not a monopoly in the general sense of that term. The inventor takes nothing from society,—he confers upon it a benefit by his labor and ingenuity, and the law designs to give him nothing more than a compensation therefor. *Bloomer v. Stolley*, 5 McLean, 162.—MCLEAN, J.; Ohio, 1850.

30. In construing a patent, regard may be had to what is contained in a caveat in the first specification, and in the original patent, and a broader construction should not be put on the language of the patentee than the whole subject matter, and description, and nature of the case seem to indicate as designed. No fancied construction travelling too far on a new and doubtful road, is to be adopted; but rather what is natural and clear, considering what already exists on the same subject. *Smith v. Downing*, 1 Fisher, 69.—WOODBURY, J.; Mass., 1850.

31. 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 cor-



rected. *Hogg v. Emerson*, 11 How., 606.—WOODBURY, J.; Sup. Ct., 1850.

32. The opinion of experts cannot be received as to the construction of a patent. Experts may be examined as to the meaning of terms of art, on the principle of *cuique in sua arte credendum*; but not as to the construction of written instruments. *Corning v. Burden*, 15 How., 270.—GRIER, J.; Sup. Ct., 1853.

33. 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. *Good-year v. Railroads*, 2 Wall., Jr., 363.—GRIER, J.; N. J., 1853.

34. The patent should be carefully examined to find the thing discovered, and if it be clearly set forth, the patentee should not suffer for the imperfection or vagueness of the language used. The description ought not to be repugnant to the specification, but if it honestly sets forth the *nature and design* of the patent, it is sufficient. *Ibid.*, 364.

35. 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 rights must be judged from the whole instrument taken together, and not from any one sentence. *Ibid.*, 364, 365.

36. The construction to be given to a specification should not be too strict and technical, but the proper inquiry is, has the inventor communicated to the public the manner of carrying his invention into effect, so that a skilful workman can carry it into execution. *Stephens v. Salisbury*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

37. A patent is not a monopoly. A monopoly takes from the public what belongs to it, and gives it to the grantee, whereas the right of a patentee rests entirely on his own invention or discovery of that which was useful, and which was not known before. The law gives him the exclusive right and use of the thing invented or discovered as a compensation for his ingenuity, labor, and expense in producing it. *Allen v. Hunter*, 6 McLean, 306.—MCLEAN, J.; Ohio, 1855.

38. The words of the specification are to be taken together, and they are to be so construed as to give effect to the meaning and intention of the persons using them. Words are not to be distorted, so as to affect what may be supposed to have been the intention of the one using them; but they are to have a reasonable construction, as connected with the sentence in which used. *Ibid.*, 307.

39. A specification as to a chemical compound, is not addressed to those who are not acquainted with chemistry. *Ibid.*, 307, 310.

40. Courts will always construe specifications favorably to the patentee, but they cannot make a new specification with more extensive claims than the original, or stop the course of inventors by a fanciful application of the doctrine of equivalents. *Sickles v. Glou. Man. Co.*, 1 Fisher, 238.—GRIER, J.; N. J., 1856.

41. It is a presumption of law that what a patentee does not distinctly assert to be his invention was known before. *Smith v. Higgins*; MS.—BERTS, J.; N. Y., 1857.

42. In the construction of a patent, the entire specification is to be taken together, as embracing the particular description which the law requires of

the discovery, the manner of construction, and the claim of the patentee. They emanate from the same pen—the one cannot contradict the other. *Page v. Ferry*, 1 Fisher, 302.—WILKINS, J.; Mich., 1857.

43. The intention of the inventor, so as to effect the object designed, is to govern the construction of the language employed. Courts look to the manifest design in order to remove any ambiguity arising from the terms employed; but this ambiguity must not be such as would perplex an ordinary mechanic in the art to which it applies. *Ibid.*, 302.

44. Patents are to be construed liberally—the rights secured are to be protected against any substantial violation. Formal and subtle differences are to be disregarded. *Imlay v. N. & W. R. R.*, 4 Blatchf., 237.—INGERSOLL, J.; Ct., 1858.

45. Patents are to be construed liberally, and not rigidly interpreted; and it is to be presumed that the Commissioner of Patents has done his duty, and not granted a patent when he ought not to have granted one. *Potter v. Holland*, MS.—INGERSOLL, J.; Ct., 1858.

46. A patentee is not controlled by the title of his patent, but by all the papers, the patent, the specification, and drawings taken together. *Bell v. Daniels*, 1 Fisher, 374.—LEAVITT, J.; Ohio, 1858.

47. In construing the patent—the specifications and drawings—the court will examine them with a liberal spirit, so as to give to the patentee all that, as an inventor, he is fairly entitled to, though nothing more. *Ibid.*, 374.

48. All exclusive rights in the nature of patents are created and must be controlled by statutory provisions, and therefore it must appear that all the essential requisites of the law have been complied with. In deciding this ques-

tion, the patent, specification, and drawings are to be looked to, and are to be construed in a liberal spirit. *Latta v. Shawk*, 1 Fisher, 488.—LEAVITT, J.; Ohio, 1859.

49. Specifications should be construed according to their spirit, and so that they shall receive an interpretation that will, if practicable, effect the end and object designed. *Judson v. Moore*, 1 Fisher, 550.—LEAVITT, J.; Ohio, 1860.

## 2. *Prima Facie Authority of.*

1. Of the novelty and utility of an invention, the patent is to be considered merely *prima facie* evidence of a very slight nature. *Lowell v. Lewis*, 1 Mas., 184.—STORY, J.; Mass., 1817.

2. Upon a trial at law, a patent is *prima facie* evidence of a right; but it is not a matter of course, to grant an injunction upon the mere exhibition of a patent, and an allegation that it has been infringed. *Sullivan v. Redfield*, 1 Paine, 447.—THOMPSON, J.; N. Y., 1825.

3. As a patentee is required to make oath that he is the true inventor of the thing patented, before he can obtain a patent, the patent is regarded by the courts of the United States as *prima facie* evidence that he has made the invention. *Phil. & Tren. R. R. v. Stimpson*, 14 Pet. 459.—STORY, J.; Sup. Ct., 1840.

4. In an action of infringement, the patent is *prima facie* evidence in the case—the patent recites and also includes the oath, and the oath throws the *onus probandi* on the defendants. *Alden v. Dewey*, 1 Story, 341.—STORY, J.; Mass., 1840.

5. A patent gives to the patentee a *prima facie* right, unless the defendants show it to be invalid, or that it can-

not operate against them. *Brooks v. Bicknell*, 3 McLean, 440.—McLEAN, J.; Ohio, 1844.

6. A patent issued under the patent acts (since 1836), requiring an examination of skilful persons into the specification and the subject of the claim, affords more evidence of the originality of the invention, than when granted as a matter of course, under the former acts, and only supported by the oath of the patentee. *Orr v. Badger*, 7 Law Rep., 467.—SPRAGUE, J.; Mass., 1844.

7. The patent itself is sufficient evidence that all the preliminary steps required by law in reference to the grant or issuing of it, were properly taken. *Wilder v. McCormick*, 2 Blatchf., 34.—BETTS, J.; N. Y., 1846.

8. A joint patent is *prima facie* evidence that the invention was joint, but such fact may be disproved at the trial. *Hotchkiss v. Greenwood*, 4 McLean, 462.—McLEAN, J.; Ohio, 1848.

9. The presumption of novelty and usefulness, arising from the *prima facie* character of the patent, may be rebutted by affidavits on the application for an injunction, where the patent is not ancient. Whether it may be when the patent has been renewed under the act of 1836; *query*. *Wickershaff v. Jones*, Whart. Dig., vol. 2, p. 413.—KANE, J.; Pa., 1848.

10. The provisions of the act of 1836, give a *quasi-judicial* character to the action of the Commissioner of Patents; and it has accordingly been generally and justly held, that the patent itself 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.

11. The patent is *prima facie* evidence that the patentee is the original

inventor or discoverer of the thing patented, and that the same is new and useful. *Goodyear v. Day*, MS.—GRIER, J.; N. J., 1852.

12. A patent issued, grounded on the oath of the patentee, is *prima facie* evidence in an action of infringement of such patent. *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

13. Under the act of 1790, a patent was made *prima facie* evidence; that act was repealed by the act of 1793, and that provision was not re-enacted in it. Hence a patent was not received in courts of justice as even *prima facie* evidence that the invention patented was new or useful, but the plaintiff was bound to prove these facts, in order to make out his case. But the act of 1836, introduced a new system, and under it—its inquisition and examination—a patent is received as *prima facie* evidence of the truth of the facts asserted in it. *Corning v. Burden*, 15 How., 270, 271.—GRIER, J.; Sup. Ct., 1853.

14. A defendant in a patent suit, using a machine patented to him, should have the benefit of a like presumption, in his favor, arising from an investigation of the originality of his invention, as the plaintiff has by reason of his patent. *Ibid.*, 271.

15. Though ordinarily a patent is *prima facie* evidence that the discovery claimed is new and useful, if it is apparent from the specification that the patent is for an invention which is manifestly frivolous, and which cannot be sustained, it is competent for the court to declare it to be inoperative for such cause. *Wilson v. Jones*, 3 or 4 Blatchf.—BETTS, J.; N. Y., 1854.

16. Under the patent laws, the claim of a patent, before a patent is issued, being subjected to a thorough examina-

## CONSTRUCTION OF; PRIMA FACIE AUTHORITY.

tion, made by examiners appointed for that purpose, gives to the patentee a *prima facie* right to the invention or discovery claimed. He who disputes such right, must produce evidence to counterbalance that legal presumption. *Allen v. Hunter*, 6 McLean, 304, 305.—McLEAN, J.; Ohio, 1855.

17. The *prima facie* right of a patentee in a patent is derived from the examination of the invention, before patent is issued, by one or more examiners, and a comparison of it with the patents issued in this and other countries; if found to be new and useful, and the applicant swears he is the first and original inventor, the patent issues. *Heinrich v. Luther*, 6 McLean, 346.—McLEAN, J.; Ohio, 1855.

18. The patent is *prima facie* evidence that the plaintiff was the first and original inventor of the improvement claimed, and of its utility. *Winans v. N. Y. & Har. R. R.*, 31 Jour. Fr. Inst., 3d Ser., 320.—NELSON, J.; N. Y., 1855.

19. The patent itself is *prima facie* evidence of novelty, and this *prima facie* evidence is strengthened by the fact of renewal of the patent. *Wintermute v. Humphrey*, MS.—WILSON, J.; Ohio, 1856.

20. The patent is *prima facie* evidence of the novelty of the thing patented. *Teese v. Phelps*, 1 McAllis., 49.—McALLISTER, J.; Cal., 1855.

21. A patent is *prima facie* evidence of the facts of first and original invention and utility, and must prevail, unless there is other evidence to overcome such *prima facie* presumption; and where there has been a renewal, such renewal is also *prima facie* evidence upon these questions, and of course adds weight to the *prima facie* evidence furnished by the original patent.

*Ransom v. Mayor, &c.*, 1 Fisher, 258.—HALL, J.; N. Y., 1856.

22. A patent when introduced in evidence, whether it be an original or re-issued one, is *prima facie* evidence that the thing granted was new and useful, and that the patentee was the inventor or discoverer thereof. *Serrell v. Collins*, MS.—INGERSOLL, J.; N. Y., 1857.

23. A foreign patent is only *prima facie* evidence as a patent granted by our own government, that the invention was of some probable value. *Gatling v. Newall*, 9 Ind., 582.—PERKINS, J.; Ind., 1857.

24. The patent is *prima facie* evidence that the thing patented was new, and the invention of the patentee at the time the patent was granted. *Gibberd v. Bagot*, MS.—INGERSOLL, J.; N. Y., 1857.

25. Since the act of 1836 patents stand upon a different footing from that upon which they stood formerly. Upon an application for a patent, the officers of the Patent Office give their judgment, and that judgment is *prima facie* a good one; when one party contests that, and offers another patent in opposition to it, both parties stand upon an equal footing. *Cong. Rub. Co. v. Amer. Elus. Cloth Co.*, MS.—GRIER, J.; Pa., 1857.

26. A patent when produced in evidence, is *prima facie* evidence that the patentee was the inventor, that the thing patented was new and useful, and that in the specification there is a description in such full, clear, and exact terms as will enable any one, skilled in the art to which it appertains, to put it in practice. And such *prima facie* evidence must control until it is rebutted by countervailing evidence. *Poppenhausen v. N. Y. G. P. Comb Co.*

## CONSTRUCTION OF; PRIMA FACIE AUTHORITY.

2 Fisher, 67.—INGERSOLL, J.; N. Y., 1858.

27. The patent itself is *prima facie* evidence of all facts upon which it is founded, and requires no support until it is impeached, or attempted to be impeached. *Sherman v. Champ. Trans. Co.*, 31 Verm., 176.—REDFIELD, J.; Vt., 1858.

28. A patent is *prima facie* evidence that the thing described in it is new, and must control the question unless countervailed by the defendant's evidence. *Waterbury Brass Co. v. N. Y. & Brooklyn Brass Co.*, 3 Fisher, 48.—INGERSOLL, J.; N. Y., 1858.

29. A patent is *prima facie* evidence that the grant of right in it is valid, that the things described in it are new and useful, that they required invention, and that they were the invention of the patentee; and such *prima facie* evidence must have full effect unless rebutted by sufficient countervailing evidence. *Potter v. Holland*, 4 Blatchf., 241.—INGERSOLL, J.; Ct., 1858.

30. The patent raises a presumption of the originality of the invention. *Bell v. Daniels*, 1 Fisher, 375.—LEAVITT, J.; Ohio, 1858.

31. The patent is *prima facie* evidence that the patentee is the first and original inventor of the improvements described. *Cahoon v. Ring*, 1 Fisher, 403.—CLIFFORD, J.; Me., 1859.

32. The patent is *prima facie* evidence that the patentee was the first inventor of the thing patented, which will control in determining the question of fact unless there is evidence to rebut this presumption. *Bartholomew v. Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

33. There is a presumption arising from the patent itself in favor of the novelty of the invention which it cov-

ers. But this presumption may be overcome by showing that the thing had been previously known. *Coleman v. Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

34. The patent itself affords *prima facie* evidence of utility; the defendant may rebut this presumption, and if it appear that the invention is utterly worthless, it is a good defence. *Vance v. Campbell*, 1 Fisher, 485.—LEAVITT, J.; Ohio, 1859.

35. The patent is *prima facie* evidence of the right of the plaintiff to all that is contained in it. *Johnson v. Root*, 1 Fisher, 354.—SPRAGUE, J.; Mass., 1859.

36. It is always presumed from the patent itself, that the invention is new, and if the party sued would avail himself of the want of such novelty, it is incumbent upon him to prove it by giving a proper notice to the plaintiff, to prevent surprise. *Latta v. Shawk*, 1 Fisher, 468.—LEAVITT, J.; Ohio, 1859.

37. There is a presumption arising from the patent itself, that an invention is of some degree of utility; but this is not conclusive, and the other party may show that it is useless and worthless. *Lee v. Blandy*, 2 Fisher, 95.—MCLEAN, LEAVITT, JJ.; Ohio, 1860.

38. The *prima facie* force of a patent, as to priority of invention, on the part of the patentee, when once destroyed by evidence of prior invention on the part of another, cannot be restored by the patent itself, but only by specific testimony from witnesses. *Barstow v. Swan*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

39. The granting of a patent affords *prima facie* evidence of the novelty, as well as utility of the invention. *Judson v. Moore*, 1 Fisher, 551.—LEAVITT, J.; Ohio, 1860.

### 3. *How far construed by the Court.*

1. Whether an invention be specifically described with reasonable certainty is a question of law upon the construction of the patent. *Lowell v. Lewis*, 1 Mas., 188.—STORY, J.; Mass., 1817.

2. Though the question as to the utility of an invention is one for the jury, if, on the plaintiff's own showing, the invention appears to be useless, and an imposition on the public, it may be doubtful whether the court would transcend its limits in deciding that the invention was not useful. *Langdon v. De Groot*, 1 Paine, 204.—LIVINGSTON, J.; N. Y., 1822.

3. It is the province of the court to construe every written instrument offered in evidence, and therefore to construe a patent and determine whether it is so uncertain in its terms as to have no meaning. *Davis v. Palmer*, 2 Brock., 308.—MARSHALL, Ch. J.; Va., 1827.

4. The court decides whether there is in the patent a substantial description of the thing patented; the papers will be looked at in the same light as a declaration in a suit at law. The court, looking at the specification as a statement of the patentee's right and title, will overlook all defects in the mode of setting it out, if it contains a substantial averment of such matter as suffices in law to make out a cause of action. The court does not look beyond the patent and papers. *Whitney v. Emmett*, Bald., 315.—BALDWIN, J.; Pa., 1831.

5. Whether the invention is sufficiently described in the patent is a question of law for the court, it being the construction of a written instrument.

*Brooks v. Bicknell*, 3 McLean, 442.—MCLEAN, J.; Ohio, 1844.

6. But if technical terms are used, evidence may be heard in explanation of those terms, and in such case a jury may be necessary. *Ibid.*, 442.

7. As a general rule, the court is to determine the invention claimed by the patentee, so far as the construction of the words of the patent and specification are concerned; but as to the meaning of words of art, and technical phrases in commerce and manufactures, which may materially affect, enlarge or control the meaning of the words of the patent and specification, the jury are to judge. *Washburn v. Gould*, 3 Story, 157, 158.—STORY, J.; Mass., 1844.

8. It is the duty of the court to give the legal construction of the specification of a patent, when such construction does not depend, which seldom is the case, on facts to be proved by parol, or when it does, if those facts are proved or admitted, and are without dispute. *Davoll v. Brown*, 1 Wood. & Min., 56.—WOODBURY, J.; Mass., 1845.

9. It is a question for the court, and not the jury, whether the specification can be read and construed intelligibly in a particular way. *Ibid.*, 60.

10. It is the province and duty of the court to settle the meaning of the patent, and if that cannot be satisfactorily ascertained upon the face of the specification, the law declares it insufficient for ambiguity and uncertainty. *Emerson v. Hogg*, 2 Blatchf., 6.—BERTS, J.; N. Y., 1845.

11. The specification is laid before the jury as defined and settled by the exposition of the court, and the matters of fact presented to support or defeat the patent are to be examined and applied as if the construction fixed by the

## CONSTRUCTION OF; BY THE COURT.

court had been incorporated in the specification. *Ibid.*, 6.

12. Where, therefore, the court held that the question of ambiguity was a mixed question of law and fact, and left a fact to be found by the jury, indicating the rule of law that would govern when that fact should be ascertained, *Held*, that such action or ruling of the court was erroneous, and was cause for ordering a new trial. *Ibid.*, 6.

13. The sufficiency of a description in a specification is, in general, in patents for a composition of matter, as well as in patents for machines, a question of fact for the jury; but when the specification of a new composition of matter gives only the names of the substances to be mixed together, without stating any relative proportion, it is the duty of the court to declare the patent void. *Wood v. Underhill*, 5 How., 5.—TANEY, Ch. J.; Sup. Ct., 1846.

14. The question whether the patent is sufficiently clear and certain in its description of the invention is one of law only in part, or so far as regards the construction of the written words used. *Hogg v. Emerson*, 6 How., 484.—WOODBURY, J.; Sup. Ct., 1847.

15. It is for the court to decide whether the patent, as to the description of the invention, conforms to the requirements of the law.—*Parker v. Stiles*, 5 McLean, 55.—LEAVITT, J.; Ohio, 1849.

16. What a patentee claims as his invention is a question of law, and one to be determined by the court, in order to give to the jury a guide to apply to the facts in the case. *Buck v. Hermance*, 1 Blatchf., 401.—NELSON, J.; N. Y., 1849.

17. The interpretation of the specification of a patent is a matter exclusive-

ly for the court, who must explain it. The import of the instrument is purely a question of law. *Parker v. Hulme*, 7 West. Law Jour., 419.—KANE, J.; Pa., 1849.

18. What is the thing patented, is a question of law, to be determined by the court from the letters patent, and the description of the invention and claim annexed to them. *Winans v. Denmead*, 15 How., 338.—CURTIS, J.; Sup. Ct., 1853.

19. The construction of the specification of a patent, so far as the language is concerned, is a question for the court. *Teese v. Phelps*, 1 McAllis., 49.—McALLISTER, J.; Cal., 1855.

20. It is the business and duty of the court to construe the patent and specifications for the purpose of determining what the claim of the discovery or invention is. *Winternute v. Redington*, 1 Fisher, 247.—WILSON, J.; Ohio, 1856.

21. The construction of the claims of a patent is a question of law, exclusively for the court, and not for the determination of a jury, unless there may be technical terms, or terms which need explanation by the evidence given before the jury. *Ransom v. Mayor, &c.*, 1 Fisher, 260.—HALL, J.; N. Y., 1856.

22. The question, what is the grant which a patent purports to make, is a question of law, and must be determined by the court; and the jury are to consider that the patent grants that which the court determines it to grant. *Serrall v. Collins*, MS.—INGERSOLL, J.; N. Y., 1857.

23. It belongs to the court to construe the patent, and declare what the discovery or invention is which the patentee describes and claims. *Smith v. Higgins*, MS.—BETTS, J.; N. Y., 1857.

## CONSTRUCTION OF; BY THE JURY.

24. So far as the patent and specification are concerned, the interpretation of the language employed by the patentee is with the court. *Page v. Ferry*, 1 Fisher, 301.—WILKINS, J.; Mich., 1857.

25. It is a question of law, to be decided by the court, what the patent purports to grant. *Waterbury Brass Co. v. N. Y. & Brooklyn Brass Co.*, 3 Fisher, 47.—INGERSOLL, J.; N. Y., 1858.

26. In the trial of a suit for the violation of a patent-right, the court cannot be compelled to receive the testimony of experts as to the proper or legal construction of the patent. A judge may, however, obtain information from them if he desire it, on matters which he does not clearly apprehend. *Winans v. N. Y. & E. R. R. Co.*, 21 How., 101.—GRIER, J.; Sup. Ct., 1858.

27. The court determines what the patent purports to grant. *Bartholomew v. Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

28. The construction of a patent falls to the court as a matter of law, depending sometimes, perhaps, upon the technical use of terms, if there be such, which have a use different from the usual and ordinary acceptation of them, and thus far may be matters of fact for the jury. *Johnson v. Root*, 1 Fisher, 354.—SPRAGUE, J.; Mass., 1858.

#### 4. How far construed by the Jury.

See also JURY.

1. Whether the specification contains the whole truth, and, if not, whether the concealment was with intent to deceive, and whether it is as to a material point, are questions for the decision of a jury. *Reutgen v. Kanows*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

2. Whether a concealment in a patent arose from any fraudulent intent, is a question for the jury. *Gray v. James*, Pct., C. C., 401.—WASHINGTON, J.; Pa., 1817.

3. It is for the jury to decide whether the specification is so uncertain as not to enable a skilful workman to understand the improvement, and carry into execution the plan of the inventor. In deciding such question, however, the jury will give a liberal, common sense construction of the directions contained in the specification. *Davis v. Palmer*, 2 Brock., 308.—MARSHALL, Ch. J.; Va., 1827.

4. The court decide, as to the sufficiency of a patent, whether the statements are sufficient in law; it is a question for the jury to decide whether the statements are true in fact. The court does not look beyond the patent and other papers, but the jury decide from the papers, the evidence of the witnesses, an inspection of the old and new machine, and the models, to ascertain whether in point of fact the specification, as made out at the trial, is sufficient. *Whitney v. Emmett*, Bald., 315.—BALDWIN, J.; Pa., 1831.

5. Objections to a patent, that the specification does not sufficiently describe the invention; or that the invention is not new; that a renewed and the original patent are not for the same invention; or that the patent was obtained with a fraudulent intent; all involve matters of fact which belong to the province of the jury, upon the evidence. *Carver v. Braintree Manuf. Co.*, 2 Story, 441.—STORY, J.; Mass., 1843.

6. It is a question of law for the court whether the invention is sufficiently described in the patent. But if technical



## CONSTRUCTION OF; BY THE JURY.

terms are used, evidence may be given in explanation of such terms, and in such a case a jury may be necessary. *Brooks v. Bicknell*, 3 McLean, 442.—McLEAN, J.; Ohio, 1844.

7. It is a question of fact for the jury, whether the description is so particular as to enable a mechanic to construct the thing in question. *Ibid.*, 442.

8. The court is bound to state what in law is the invention claimed, so far as the construction of the patent and the specification is concerned. But the jury are to judge of the meaning of words of art, and technical phrases in commerce and manufactures, and of the surrounding circumstances, which may affect, enlarge, or control the meaning of the words of the patent and specification. *Washburn v. Gould*, 3 Story, 157, 158.—STORY, J.; Mass., 1844.

9. The sufficiency of the description in a specification is, in general, in patents for a composition of matter, as well as in patents for machines, a question of fact for the jury. *Wood v. Underhill*, 5 How., 4.—TANEY, Ch. J.; Sup. Ct., 1846.

10. It is for the jury to decide, whether from the evidence, the description of an invention in a patent is sufficiently full, clear, and exact, to enable a skilful mechanic to construct the thing described. *Parker v. Stiles*, 5 McLean, 55.—LEAVITT, J.; Ohio, 1849.

11. Where the effect and operation of mechanical contrivances, which are matters of skill, and to be determined by experts, enter into the question of the extent of a patented combination, the question is a mixed one of law and fact, and proper to be determined by the jury under the instruction of the court. *Foote v. Silsby*, 1 Blatchf., 458, 465.—NELSON, J.; N. Y., 1849.

12. Where the question as to the extent of a combination as patented, was treated by the defendants as a question of fact, and was accordingly submitted as such to the jury, the defendant cannot afterward object to such action of the court, on the ground that the court should have determined the nature and extent of the combination, as a matter of law, from the specification. *Ibid.*, 465.

13. Where a claim was for a combination which did not point out and designate the particular elements which composed the combination, but only declared that the combination was made up of so much of the described machinery as effected a particular result, *Held*, it was a question of fact which of the described parts were 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.

14. The jury are to determine from the facts in a case, whether the specifications, including the claim, are so precise as to enable any skilful person to make the thing described. *Battin v. Tuggert*, 17 How., 85.—McLEAN, J.; Sup. Ct., 1854.

15. The application of the facts to the specification or patent, as construed by the court, is for the jury. *Teese v. Phelps*, 1 McAllis., 49.—McALLISTER, J.; Cal., 1855.

16. It is a question of fact for the jury, whether the description in the patent is so vague or uncertain that a competent workman, in the particular business covered by the patent, could not, from the specification and drawing, construct the machine. *Page v. Ferry*, 1 Fisher, 301, 302.—WILKINS, J.; Mich., 1857.

17. It is exclusively the province of the jury to ascertain and determine whether the patentee is the original inventor of the thing patented, and whether it embraces the thing used by the defendants. *Smith v. Higgins*, MS.—BERTS, J.; N. Y., 1857.

18. Whether the description in a specification is sufficiently full, clear, and exact, to enable a person skilled in the art to construct the invention, is a question of fact for the jury. *Judson v. Moore*, 1 Fisher, 547.—LEAVITT, J.; Ohio, 1860.

### 5. Force and Construction of Claim.

1. In all cases where the patentee claims any thing as his own invention, in his specification, courts of law cannot reject the claim; and if included in the patent, and found not to be new, the patent is void, however small and unimportant such asserted invention may be. *Moody v. Fiske*, 2 Mas., 118.—STORY, J.; Mass., 1820.

2. Where a patentee in his specification states and sums up the particulars of his invention, and his invention covers them, he is confined to such summary, and cannot afterward be permitted to sustain his patent by showing that some part which he claims in his summing up as his invention, though not in fact his invention, is of slight value, or importance in his patent. *Ibid.*, 118.

3. The summing up of the invention in a specification is a limitation to the thing patented. *Whitney v. Emmett*, Bald., 313.—BALDWIN, J.; Pa., 1831.

4. If the court, taking the whole patent together, can perceive the nature and extent of the claim, it is bound to adopt such interpretation, and give it

effect. *Ryan v. Goodwin*, 3 Sumn., 520.—STORY, J.; Mass., 1839.

5. Where a patentee disclaimed the mechanical powers by which the movements of his invention were obtained, and claimed "as his invention the method or mode of operation in the abstract explained in the second article," and in such second article described a machine of a particular structure, whose modes of operation were pointed out, to accomplish a particular purpose or end, *Held*, by the court, that the invention was of a particular machine, constituted in the way pointed out, for the accomplishment of a particular end or object, and that the patent was for a machine, not a function or principle detached from machinery. *Blanchard v. Sprague*, 3 Sumn., 536, 537, 540.—STORY, J.; Mass., 1839.

6. In order to ascertain the true construction of the specification, as to what is granted by the patent, we must look to the summing up of the invention, and the claim therefor asserted in the specification; for it is the duty of the patentee to sum up his invention in clear and determinate terms, and his summing up is conclusive upon his rights and title. *Wyeth v. Stone*, 1 Story, 285.—STORY, J.; Mass., 1840.

7. The patentee must describe, with reasonable certainty, in what his invention consists, and what his particular claim is. *Ibid.*, 286.

8. Resort can be had to the introduction of the specification, as well as the summing up at the close, to ascertain the true extent of the claim. *Hovey v. Stevens*, 1 Wood. & Min., 294.—WOODBURY, J.; Mass., 1846.

9. Where there is a summary setting out the claim to some particular novelty, that is to govern; but if it refers

to other parts of the specification and drawings, those parts are to be examined in connection with it, in order to ascertain what is claimed in the summary. *Hovey v. Stevens*, 3 Wood. & Min., 21.—WOODBURY, J.; Mass., 1846.

10. The claim in a specification was, that any irregular surface or form could be turned by the machine like the model, but in fact a square shoulder could not be turned; *Held*, that it was too remote and extreme a defect to vitiate the patent. *Blanchard's Gun-Stock Turning Co. v. Warner*, 1 Blatchf., 280.—NELSON, J.; Ct., 1846.

11. If a patentee chooses to cover the material of which a part of his machine is made, he entirely endangers his right to prosecute when a different and inferior material is employed, and especially one rejected by himself. *Aiken v. Bemis*, 3 Wood. & Min., 354.—WOODBURY, J.; Mass., 1847.

12. Where a patentee claimed a hammer in a saw-set, of wrought iron faced with steel, alleging that he found upon experiment that all steel hammers were much more liable to break, and wrought iron ones more durable, and therefore confined his specification to wrought iron ones with steel points, *Held*, in an action for infringement against a person using a hammer wholly of steel, that it was a matter of doubt, whether the use of such a hammer was a violation of the patent. *Ibid.*, 354.

13. The claim is the most material part of the specification. It is the attempt on the part of the inventor to describe the very thing which he supposes he has invented, and for which he asks a patent. *Manly v. Jagger*, 1 Blatchf., 378.—NELSON, J.; N. Y., 1848.

14. If an inventor sums up the par-

ticulars of his invention, he is confined and held to such summary, and his patent must stand or fall by it. *Parker v. Sears*, 1 Fisher, 99.—GRIER, J.; Pa., 1850.

15. The claim or summing up is not to be taken alone, but in connection with the specification and drawings. The whole instrument is to be construed together; but the other parts are to be looked to only for the purpose of correctly interpreting the claim. *Brooks v. Fiske*, MS.—SPRAGUE, J.; Mass., 1851.

16. Where the claim 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, 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.

17. The use of a known equivalent is an infringement; although the patentee has not expressly claimed equivalents, he is understood to embrace them, and in contemplation of law does embrace them, without any express mention. *Byam v. Furr*, 1 Curt., 263.—CURTIS, J.; Mass., 1852.

18. But the patentee is not obliged to embrace equivalents in his claim. He may, if he choose, confine himself to the specific ingredients or things, and expressly exclude all others; or expressly exclude some or one other. If he does so, the use of the thing disclaimed is no infringement. *Ibid.*, 263.

19. It is for the parts *claimed* as the invention of the patentee, and as such particularly pointed out, that the patent issues. It covers no more; and the

## CONSTRUCTION OF; CLAIM IN.

patentee is not bound to prove the originality of what is *not* in it to make it a protection for what is in it. *Holliday v. Rheem*, 18 Penn., 469.—BLACK, Ch. J.; Pa., 1852.

20. The claim, or summing up, is not to be taken alone, but in connection with the specification and drawings; the whole instrument is to be construed together. But the latter are to be looked to only for the purpose of enabling the court correctly to interpret the claim. *Brooks v. Fiske*, 15 How., 215.—CATRON, J.; Sup. Ct., 1853.

21. A patentee may so restrict his claim as to cover less than he invented, or may limit it to one particular form of machine, excluding all other forms, though they embody his invention, yet such an interpretation should not be put upon his claim if it can fairly be construed otherwise. *Winans v. Denmead*, 15 How., 341.—CURTIS, J.; Sup. Ct., 1853.

22. Patentees sometimes add to their claims an express declaration to the effect that the claim extends to the thing patented, however its form or proportions may be varied. But this is unnecessary. The law so interprets the claim without the addition of these words. *Ibid.*, 343.

23. A patentee may limit his claim in his specification to one particular form of machine, and exclude all others. In such a case he is secured only to the particular form claimed. The patent law was intended to secure to the inventor his whole invention or discovery, but not unless he claimed to be secured in the whole. If he claims only a part, such part is only secured to him. *Amer. Pin Co. v. Oakville Pin Co.*, 3 Blatchf., 193; 3 A. L. R., 138.—INGERSOLL, J.; NELSON, J., concurring; Ct., 1854.

24. No more can be secured by the patentee than he has invented or discovered; and no more can be secured than is claimed to be secured in the specification. *Ibid.*, 138.

25. The phrase "or the equivalent therefor," in machinery, extends to improvements substantially the same as those described involving the same principle, and embracing all alterations merely colorable, but does not include a claim to any other invention equivalent or equal to the one described—this would be to include all modifications or improvements in the machine. *Mc Cormick v. Manny*, 6 McLean, 557.—MCLEAN, J.; Ill., 1855.

26. In construing a claim we must look at the entire specification and drawings, and view each part by the light thrown on it by the whole; and though there is an erroneous description as to how a certain part enters into a combination, if there is enough left clearly and certainly to correct the mistake, the patent will be sustained. *Kittle v. Merriam*, 2 Curt., 479, 480.—CURTIS, J.; Mass., 1855.

27. Formerly a strict construction was given, in this country and in England, to the claims of a patentee, but a more favorable and liberal view is now taken of his claim. He must describe it within the law; but courts do not go beyond the law for technical objections to defeat it. *Allen v. Hunter*, 6 McLean, 311.—MCLEAN, J.; Ohio, 1855.

28. When a patentee claims several distinct improvements, he must establish his right to each, to sustain an action. *Heinrich v. Luther*, 6 McLean, 346.—MCLEAN, J.; Ohio, 1855.

29. Patentees should not, in their claim, confound *specific* with *generic* description, and so set up a claim to a

## CONSTRUCTION OF; CLAIM IN.

great class of things, when their true claim is only to a limited variety of the class. *Evans' Case*, 7 Opin., 134.—CUSHING, Atty. Gen.; 1855.

30. All such over-broad pretensions avail nothing against the public, and impair the strength of whatever there may truly be of original in the particular patent. *Ibid.*, 134.

31. When the exact nature and extent or essence of the claim can be perceived, the court is bound to adopt that interpretation of the patent, and to give it full effect. *Wintermute v. Redington*, 1 Fisher, 249.—WILSON, J.; Ohio, 1856.

32. In determining the construction of the claims of a patent, the court should refer to the whole specification, and consider the whole in connection, although the claim at the end of the specification is usually intended to define and limit the extent of the claim made by the patentee. *Ransom v. Mayor, &c.*, 1 Fisher, 260.—HALL, J.; N.Y., 1856.

33. The construction of the claims of a patent is a question of law exclusively for the court, and not for the determination of a jury, unless there may be technical terms or terms which need explanation by the evidence given before the jury. *Ibid.*, 260.

34. Where a claim may be open to objection of any kind, it is the duty of the court in construing it, to so construe it, if it can be done, without doing violence to the language used, as not to affect the claim of the patentee, but to give him what and all he has actually invented—in other words, to make the claim commensurate with the invention actually made. *Ibid.*, 262.

35. While it is true that the summing up is to be looked at to discover the parts of the machine the patentee

claims as his invention, still if any thing is needed to give the proper meaning of expressions used in the claim, the previous portions of the specification may be referred to for such explanations as may be necessary to understand the office and purpose of that which is claimed as new. *Morris v. Barrett*, 1 Fisher, 463.—LEAVITT, J.; Ohio, 1858.

36. If by an examination of the specification and applying it to the then existing state of the art, it can be learned what the invention was, then the claim, which is designed to be a condensed summary of the invention, is to be construed so as to be coextensive with the invention, if that can be done without doing violence to its language. *Whipple v. Middlesex Co.*, MS.—SPRAGUE, J.; Mass., 1859.

37. In construing the claim of a patent, the court take into view the whole of what precedes it in the patent, and also such extraneous facts presented by the evidence as may aid in giving the true construction to the patent, particularly documents from the Patent Office which preceded the granting of the patent itself. *Johnson v. Root*, 1 Fisher, 355.—SPRAGUE, J.; Mass., 1858.

38. Where there is any doubt as to the extent and meaning of the invention of an applicant, the whole specification should be taken together in construction, and not confined to the mere words of the claim. The phraseology of a claim "for the purposes set forth," embraces the whole specification. *Sprague, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

39. Where necessary to explain any ambiguity in the summing up or claim of a specification, resort should be had to the body of the specification, that the whole may be taken together, that

## CONSTRUCTION OF; WHEN VOID.

in support of the claim a liberal and not a strict construction should prevail. *Tillman, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860

40. But there should not be given any forced construction to the body of the specification, so as to *extend* the claim of the patentee; on the contrary, only such a construction ought to be made as, consistently with the fair import of language, will make the claim coextensive with the actual discovery. *Ibid.*

## Q. VIOLATION OF.

See ACTIONS, A.; COMBINATION, B.; COMPOSITION OF MATTER, B.; DESIGNS; FORM; INFRINGEMENT, B.

## R. WHEN VOID.

See also in connection herewith, ABANDONMENT, B.; DEFENCES; PRIOR KNOWLEDGE; PRIOR USE.

1. Under § 1 of the act of 1790, if the allegations and suggestions of the petition are not substantially recited in the patent, the patent is void. *Evans v. Chambers*, 2 Wash., 126.—WASHINGTON, J.; Pa., 1807.

2. If an inventor be not an inventor of the whole machine, but only of an improvement thereof, and the patent is for the whole machine, the patent is too broad and is utterly void. *Whittemore v. Cutter*, 1 Gall., 479.—STORY, J.; Mass., 1813.

3. If an inventor obtain a patent for an entire machine, when he is the inventor only of an improvement thereon, his patent is too broad, and therefore void. *Odiorne v. Winkley*, 2 Gall., 53.—STORY, J.; Mass., 1814.

4. If a patent be taken out for an en-

tire machine, when the invention consists only of an improvement on such machine, the whole patent is not void, but the patentee is not entitled to more than his improvement; nor can he make or use the original discovery, nor prosecute any person for using such original discovery without engrafting on it the improvement invented by the patentee. *Goodyear v. Matthews*, 1 Paine, 302.—LIVINGSTON, J.; Ct., 1814.

5. The grant can only be for the discovery as recited in the patent and specification. If the patent is for the whole of a machine, and the discovery was only of an improvement, the patent is void. *Evans v. Eaton*, Pet. C. C., 342.—WASHINGTON, J.; Pa., 1816.

6. If the description in the patent mixes up the old and the new, and does not distinctly ascertain for which in particular the patent is claimed, it is void. *Lowell v. Lewis*, 1 Mas., 187.—STORY, J.; Mass., 1817.

7. If a patentee include in his patent any thing already known, the patent will be broader than the invention, and consequently void. *Ibid.*, 188.

8. An invention, to entitle the inventor to a patent, must not only be useful, but it must also be new. It is a good defence in an action for infringement, that the thing patented was not originally discovered by the patentee. *Belford v. Hunt*, 1 Mas., 304.—STORY, J.; Mass., 1817.

9. If the terms of a patent are so obscure or doubtful that the court cannot say what is the particular improvement which the patentee claims, and to what it is limited, the patent is void for ambiguity. *Barrett v. Hall*, 1 Mas., 476.—STORY, J.; Mass., 1818.

10. And if it covers more than the improvement, it is void for the reason

## CONSTRUCTION OF; WHEN VOID.

that it is broader than the invention. *Ibid.*, 476.

11. The nature and extent of the improvement must be clearly and fully stated, or the patent will be void. *Evans v. Eaton*, 3 Wash., 452, 455.—WASHINGTON, J.; Pa., 1818.

12. 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.

13. A specification which mixes up the old and the new, but does not explain what is the nature or limit of the improvement which the party claims, cannot be sustained. *Evans v. Eaton*, 7 Wheat., 434.—STORY, J.; Sup. Ct., 1822.

14. Where the specification does not describe the invention so as to show in what respect the plaintiff's invention or improvement differs from what had been known or used before, the patent is void. *Langdon v. De Groot*, 1 Paine, 207.—LIVINGSTON, J.; N. Y., 1822.

15. If a patentee include in his patent an original patent known to have been previously patented to another person, with his own improvement for which he is entitled to a patent, the patent is void. *Turner v. Johnson*, 2 Cra. C. C., 287.—CRANCH, J.; D. C., 1822.

16. The specification described the invention "that it essentially consists in attaching the packet to the steamboat with ropes, chains, or spars, so as to communicate the power of the engine from the towing vessel to vessels taken in tow, and kept always at convenient

distance; the manner of applying the power varying in some measure with the circumstances;" *Held*, that the description of the invention, if any there was, was too vague and uncertain; the patent void. *Sullivan v. Redfield*, 1 Paine, 450, 451.—THOMPSON, J.; N. Y., 1825.

17. If a patent embraces the discovery of another person, besides or with the invention or discovery of the patentee, it is too broad, and is void. *Watson v. Bladen*, 4 Wash., 582, 583.—WASHINGTON, J.; Pa., 1826.

18. If a patent covers what was in use before, and what belonged to the public, it is void. *Davis v. Palmer*, 2 Brock., 310.—MARSHALL, Ch. J.; Va., 1827.

19. If a party suggest an idea as to an invention, which is indispensable to its operation, and which in reality constitutes its whole value, and another adopts such suggestion and takes out a patent therefor, the patent is void, as not being the invention of the patentee. *Thomas v. Weeks*, 2 Paine, 102.—THOMPSON, J.; N. Y., 1827.

20. A patent must not be broader than the invention, or it will be void, not only for so much as had been known or used before the application, but also for the improvement really invented. *Whitney v. Emmett*, Bald., 314.—BALDWIN, J.; Pa., 1831.

21. A patent can be declared void by a Circuit Court, in a civil suit, only for the reasons and causes mentioned in § 6 of the act of 1793. *Ibid.*, 316, 317.

22. It has been the uniform construction of the law in the Circuit Courts, that a patent can be declared void for no other defect in the specification than fraudulent concealment or addition. *Ibid.*, 321.

## CONSTRUCTION OF; WHEN VOID.

23. The expression "the patent is void," used by the courts in civil actions at common law, is to be understood not as meaning that it becomes void by a judgment in favor of the defendant, but only that it is voidable in chancery, and in a court of law, void as a legal foundation for an action of damages. *Ibid.*, 318.

24. If the specification is wholly ambiguous and uncertain, so loosely defined and so inaccurately expressed that the court cannot, upon a fair interpretation of the words, and without vague conjecture of intention, gather what it is, the patent is void for such defect. *Ames v. Howard*, 1 Sumn., 485.—STORY, J.; Mass., 1833.

25. But if the court can clearly see, by a reasonable use of the means of interpretation of the language used, taking the whole in connection, what is the nature and extent of the claim, then the plaintiff is entitled to the benefit of it, however imperfectly and inartificially he may have expressed himself. *Ibid.*, 485.

26. If a patent is for an entire machine, but the patentee is the inventor of only a part thereof, the patent is void, as a party cannot entitle himself to a patent for more than his own invention. *Cross v. Huntly*, 13 Wend., 386, 387.—NELSON, J.; N. Y., 1835.

27. In a patent for improvement in cider mills, the claim was for improvements in the box enclosing the cylinder, and the teeth or brads set in the cylinder, but the specification did not show any improvement in such teeth or brads; *Held*, that as the specification was defective in part, the patent was void, and not only *pro tanto*, but *in toto*. *Head v. Stevens*, 19 Wend., 412.—COWEN, J.; N. Y., 1838.

28. A patent is void and inoperative if the specification claims more than the patentee has invented. *Stanley v. Whipple*, 2 McLean, 36.—MCLEAN, J.; Ohio, 1839.

29. A claim broader than the actual invention of the patentee, is, for that very reason, utterly void, and the patent is a nullity. *Wyeth v. Stone*, 1 Story, 286.—STORY, J.; Mass., 1840.

30. Prior to the act of 1836, if a patentee claimed more than he had invented, his patent was void. But under § 9 of the act of 1837, the patent is not absolutely void because the patentee claims more than he has invented, but is valid for so much as is truly and *bonæ fide* his own; but in the specification he must state in what his improvement consists. *Peterson v. Wooden*, 3 McLean, 248, 249.—MCLEAN, J.; Ohio, 1843.

31. If the invention is not so described as to be known, in the language of the statute, from every other thing, the patent is void. *Brooks v. Bicknell*, 3 McLean, 442.—MCLEAN, J.; Ohio, 1844.

32. If an invention patented is the same in principle with one before in use, the patent is void. *Ibid.*, 451.

33. If a foreign patentee, or his assignees, do not put their invention on sale within eighteen months after the same is obtained, as required by § 15 of the act of 1836, the patent will be void. *Tatham v. Loring*, 5 N. Y. Leg. Obs., 208.—STORY, J.; Mass., 1845.

34. If the meaning of the patent cannot be satisfactorily ascertained upon the face of the specification, it is insufficient for uncertainty and ambiguity. *Emerson v. Hogg*, 2 Blatchf., 6.—BETTS, J.; So. N. Y., 1845.

35. When 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. *Wood v. Underhill*, 5 How., 45.—TANEY, Ch. J.; Sup. Ct., 1846.

36. 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.

37. If a specification includes as well the original discovery as the alleged improvement, and does not point out in what the improvement consists, the patent is void. *Street v. Silver*, Brightley, 101.—ROGERS, J.; Pa., 1846.

38. If the specification is so uncertain, as to whether a particular thing is claimed as a part of a new combination, or as a new invention, as to be unintelligible, it is void, but, *semble*, it may be surrendered and amended. *Hovey v. Stevens*, 1 Wood. & Min., 302.—WOODBURY, J.; Mass., 1846.

39. If a patent embraces and claims as a part of the improvements described in it, something which is not new, but was invented by another, it is void, the claim being broader than the invention. *Tyler v. Deval*, 1 Code Rep., 30.—MCCALEB, J.; La., 1848.

40. In order to render a patent valid, under § 9 of the act of 1837, which contains more than is the invention of the patentee, it must appear that the part really invented was "a material and substantial part of the thing patented, and was distinguishable from the

parts claimed without right." *Hotchkiss v. Oliver*, 5 Denio, 320.—McKISSOCK, J.; N. Y., 1848.

41. If an invention is not described with reasonable certainty and precision, the patentee can claim nothing under his patent. *Parker v. Stiles*, 5 McLean, 54.—McLEAN, J.; Ohio, 1849.

42. If a patentee claims any thing as a material part of his combination, as new and original with him, which is proved to have been discovered prior to the emanation of his patent, it is fatal to it. *Ibid.*, 55.

43. Where a foreign patent has been obtained for an invention previous to the issue of the home patent, the home patent must be limited to fourteen years from the date of the foreign one. If the domestic patent purports to give an exclusive right for fourteen years from its date, it is void; but the error is not fatal, it may be corrected. *Smith v. Ely*, 5 McLean, 78, 79, 80.—McLEAN, J.; Ohio, 1849.

44. Prior to the act of 1836, a patent was void if the claim extended beyond the invention. Under § 6 of that act, it was void if a substantial part had been patented or described in a printed publication. § 15 saved the patent from being void if the patentee believed himself to be the first inventor. § 9 of the act of 1837 enlarged the right of the patentee, providing, notwithstanding § 15 of the act of 1836, that the patent should not be void, where he had acted in good faith, if through mistake or inadvertence he had claimed more than he had invented, and that he might maintain suit on the part actually invented by him, provided he filed within a reasonable time a disclaimer of the parts not invented by him. *Ibid.*, 84, 85.

45. If a patentee claims something

## CONSTRUCTION OF; WHEN VOID.

which is not his invention, his patent claims too much, and its validity may be assailed on that ground, even though the part illegally claimed may be of slight value or importance. *Parker v. Sears*, 1 Fisher, 99.—GRIER, J.; Pa., 1850.

46. The avoidance of patents for claiming too much is of frequent occurrence, and needs no explanations as to the reasons of it, when an applicant is so improvident or unjust to others, as to claim for himself more than he invented, and the credit and profit of which belong to others. *Smith v. Downing*, 1 Fisher, 70.—WOODBURY, J.; Mass., 1850.

47. If the suggestions or communications of another go to make up a complete and perfect machine, embodying all that is embraced in a patent subsequently issued to the party to whom the suggestions were made, the patent is invalid, because the real discovery belongs to another. *Pitts v. Hull*, 2 Blatchf., 234.—NELSON, J.; N. Y., 1851.

48. If an inventor unnecessarily defers his application for a patent, and allows his invention to go into use, except for the purposes of perfecting his invention and testing its utility, and beyond what he has reason to believe necessary for such purposes, his patent is void. *Winans v. Schenec. & Troy R. R.*, 2 Blatchf., 291, 300.—NELSON, CONKLING, JJ.; N. Y., 1851.

49. If any thing is included in a patent which is not new, the patent is void. If what is new be mixed up with what is old, the patent is no protection for either. *Holliday v. Rheem*, 18 Penn., 469.—BLACK, Ch. J.; Pa., 1852.

50. A patent is not void because, on its face, it does not bear the same date with a previous foreign patent, obtained by the patentee for the same invention;

the monopoly however is limited to fourteen years from the date of the foreign patent. *O'Rielly v. Morse*, 15 How., 112.—TANEY, Ch. J.; Sup. Ct., 1853.

51. 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 Blatchf., 192; 3 A. L. R., 137.—INGERSOLL, J.; Ct., 1854.

52. If the invention required no more skill or ingenuity than that possessed by an ordinary mechanic, skilled in the business, there is an absence of inventive faculty, and the patent is invalid. *Teese v. Phelps*, 1 McAllis., 52.—McALLISTER, J.; Cal., 1855.

53. If, with the knowledge had by the public, it required no invention, but simply the ordinary skill and ingenuity of the mechanic, to produce the result effected; in other words, if the inventive faculty was not put into action, and was not needed to produce the alleged invention, then the patent is void, because there is no invention to be secured to the patentee. *Ransom v. Mayor, &c.*, 1 Fisher, 264.—HALL, J.; N. Y., 1856.

54. If an inventor, after his invention is perfected, knowingly allow it to be used in public for more than two years before application for letters patent, it is conclusive evidence of a dedication of

## CONSTRUCTION OF.

such invention to the public, and the patent is void. *Ibid.*, 273.

55. And if an inventor, after his invention is perfected, acquiesce in its use in public, for a less term than two years, without applying for a patent, and the jury are satisfied from this acquiescence and other facts in the case, that the inventor in fact abandoned his invention, concluding not to patent it, but to dedicate it to the public, he cannot recall such dedication, or defeat such abandonment by a subsequent application for a patent, and any such patent will be void. *Ibid.*, 273.

56. And if an inventor does not use reasonable diligence to perfect his invention after the idea of it is conceived, and in the mean time another conceives the idea and perfects the invention, and practically applies it to use, the latter is the first and original inventor, and a patent granted to the former will be void. *Ibid.*, 272.

57. If the invention patented as in a joint patent, is the sole invention of one of the patentees, and not the joint invention of both, the patent is void. *Ib.*, 269.

58. Where a specification endeavors to include an idea, or a function of the human system, or a quality of objects in nature, instead of a particular instrumentality, or concrete form of applying that idea, or function, or quality in use, such patent is void for being too general, unless that defect be cured by disclaimer in the manner of the statute. *Morton's Anæsthetic Patent*, 8 Opin., 276.—CUSHING, Atty. Gen.; 1856.

59. There is nothing to estop the government of the United States from showing a patent, which it has granted, to have been a nullity *ab initio*, owing to the non-existence of the condition precedent of novelty of the invention.

*King v. United States*, 10 Mo. Law Rep., 631; Ct. Claims, 1857.

60. An inventor has no legal rights or immunities under a patent, except such as are conferred by the statute. With whatever solemnity or observance of legal form it may have issued, if wanting in any substantial statutory requisite, it is a nullity. *Moffitt v. Garr*, 1 Fisher, 612.—LEAVITT, J.; Ohio, 1866.

## S. TRANSFER OF.

See ASSIGNMENT, B., C

## PARTICULAR PATENTS.

Apple-Paring Machine.....	531
Augers for boring Muskets.....	531
Bank-Note printing.....	531
Bark Mills.....	532
Bran Duster.....	532
Brass Kettles.....	533
Brick Machine.....	533
Burring Machine.....	533
Buttons, Designs for.....	534
Cars, supporting Bodies of.....	534
Cars for Coal.....	535
Carriages for Railways, &c.....	535
Cars, Eight-Wheeled.....	535
Car Wheels.....	536
Casters for Bedsteads.....	537
Cotton Gin, Ribs of.....	537
Cotton Speeder.....	537
Cultivators.....	538
Dyeing Parti-Colored Yarn.....	538
Dyeing and finishing Silk Goods.....	539
Electric Telegraph.....	539
Fire-Engines.....	542
Glass Knobs.....	542
Grain-cleaning Machine.....	543
Grinding Tools.....	543
Gun Locks.....	544
Harvesting Machines.....	544
Hat Bodies, making.....	546
Ice, cutting.....	547
India-rubber.....	547

APPLE-PARING MACHINE. AUGER TO BORE GUNS. BANK-NOTE PRINTING.

Irregular Form, turning.....	550
Lead Pipe Machinery.....	552
Locomotives, Variable Exhaust of. ....	553
Looms.....	554
Matches, Friction.....	554
Mili Stones, regulating, &c.....	555
Mouldings, making of. ....	555
Nails, Manufacture of.....	555
Palm-Leaf, preparing .....	556
Paper, Manufacture of.....	556
Planing Machines.....	557
Ploughs. ....	560
Puddle Balls, rolling.....	561
Rails for Railroad Carriages.....	561
Rocking Chairs.....	562
Saddles.....	562
Saw-Mills, Circular.....	562
Saw-Mills, Portable, Circular.....	563
Sewing Machines.....	563
Sowing Seed.....	568
Steam-Engines, Improvement in.....	568
Steam Generators.....	569
Stoves.....	569
Straw-Cutter.....	570
Tailors' Shears.....	571
Thread packing, &c.....	571
Valves.....	571
Water Closets .....	573
Water Wheels.....	573
Wheels, Horizontal.....	575
Wood-Bending Machine.....	575

APPLE-PARING MACHINE.

PRATT'S PATENT.

*Issued October 4th, 1853.*

1. The patent was for "a new and useful improvement in machines for paring apples."

*Held*, that the improvement patented consisted in so attaching the knife-block to the rod which moves it, as to allow it to rotate round the rod at right angles therewith, and thus the knife accommodates itself to any irregularity in the surface of the vegetable to be pared. *Sargent v. Larned*, 2 Curt., 349.—CURTIS, J.; Mass., 1855.

2. Making the rod movable in the socket instead of the knife on the rod, *Held* to be a mere change in form or mechanical structure, and an infringement, as the knife-block had the same motion; in the one it was around the rod, in the other it was with the rod. *Ibid.*, 349.

AUGER FOR BORING MUSKETS.

PETTIBONE'S PATENT.

*Issued February 12th, 1814.*

This patent was for "a new and useful improvement in boring muskets, pistols, and rifles, by an auger called the spiral groove or twisted screw auger." The specification described the manner of making the auger, its form, and how used, and the affidavit stated that the patentee "believed himself to be the first inventor of the improved method of making augers or bits for boring muskets, pistols, and rifle-barrels."

*Held*, that the patent extended only to the auger described in the specification, and not to the method of using it. *Pettibone v. Derringer*, 4 Wash., 215, 218.—WASHINGTON, J.; Pa., 1818.

BANK-NOTE PRINTING.

KNEASS' PATENT.

*Issued April 28th, 1815.*

The patent was for "a new and useful improvement in printing on the back or reverse side of bank-notes, as an additional security against counterfeiture."

*Held*, that the improvement was for printing copper-plate on both sides of the note or bill—or copper-plate on one side and letter-press on the other—or