

BARK MILLS.

BRAN DUSTER.

letter-press on both sides, and that the patent was not for an effect, but for the kind of printing by which that effect is produced; and that the printing on the back of such notes with *steel plates*, was an infringement. *Kneass v. Schuylkill Bank*, 4 Wash., 12, 14.—WASHINGTON, J.; Pa., 1820.

BARK MILLS.

MONTGOMERY & HARRIS' PATENT.

Issued August 12th, 1840.

1. The patent was for "an improvement in the mill for breaking and grinding bark," and the claim was for combining together the stationary cylinders and the movable conical rings, concentrically, there being teeth on the sides of both, and sustaining that combination by the cross bars, to which the movable and stationary parts are severally attached.

Held, that the invention covered by the patent was the multiplication of the grinding chambers, and apparatus or machinery in a mill of a given size, and which may still be driven by the same power as heretofore. *Wilbur v. Beecher*, 2 Blatchf., 136.—NELSON, J.; N. Y., 1850.

2. And that there was evidence enough of utility, if the new machine would do double the work of the old mill in a given time. *Ibid.*, 137.

3. Though the claim was for the combination of *one or more* movable conical nuts with the stationary cylinders, *Held*, also, that the description was sufficiently particular to enable a mechanic to construct a mill with more chambers than three, the number mentioned in the specification. *Ibid.*, 137, 138.

4. And that a mill with six grinding chambers and twelve grinding surfaces, but produced by the multiplication of stationary cylinders and movable conical nuts, was an infringement. *Ibid.*, 139, 140.

5. The particular shape of the grinding chambers and the form of the teeth, is, however, no part of the patented combination; where, therefore, a machine by a change in these points ground better and faster than the patented mill, yet if it contained the combination of the movable conical nuts with the stationary cylinders, *Held*, it was an infringement. *Ibid.*, 140, 142.

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FROST & MONROE'S PATENT.

Issued February 27th, 1849.

Reissued March 13th, 1855.

1. The patent was for "an improvement in machinery for separating flour from bran," and the claim was for the external case, with the internal stationary scourer, and the revolving cylindrical scourer and blower, constructed, arranged, and operating in the manner and for the purpose set forth.

Held, that the patentee did not claim any of the component parts as original or new, but that the claims were limited to certain combinations of the several parts making up the entire machine. *Carr v. Rice*, 4 Blatchf., 202.—NELSON, J.; N. Y., 1858.

2. The *third* claim is not valid on account of its uncertainty. *Ibid.*, 202.

3. The *fourth* claim is for a legal result, and is not maintainable, the plaintiffs not claiming to be the original inventors of mechanism to produce such

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a result, but only of a new combination of parts. *Ibid.*, 202.

BRICK OR TILES, MAKING.

WOOD'S PATENT.

Issued November 9th, 1836.

"The patent was for a new and useful improvement in the art of manufacturing bricks and tiles;" and the claim was for using fine anthracite coal, or coal-dust with clay for such purpose. The general proportion mentioned was three-fourths of a bushel of coal-dust to one thousand brick; but it was stated that some clay might require more dust, and some less—the clay which required the most burning would require the greatest proportion of coal dust.

Held, that the specification was not so vague and uncertain on its face as to avoid the patent. *Wood v. Underhill*, 5 How., 46.—TANEY, Ch. J.; Sup. Ct., 1846.

BRASS KETTLES.

HAYDEN'S PATENT.

Issued December 16th, 1851.

1. The patent was for "machinery for making kettles and articles of a like character from disks of metal," and the invention claimed was for improvements in machinery for making such articles, by stretching a flat disk of metal on a proper form or forms, by the compression of a proper tool operating on the disk while rotating with and against the form.

Held, that the patent did not grant the several parts, or any part of the machinery, by which the combination

claimed is called into action, and made to perform its office; but the grant was the application of a rotary form or mould, or forms and moulds, in combination with proper tools, moved or directed by competent means, for the purpose of operating upon a blank, so as to reduce it gradually from the centre to the edge, at the same time forming it with straight sides by successive stages, into a complete kettle. *Waterbury Brass Co. v. N. Y. & Brook. Brass Co.*, 3 Fisher, 43.—INGERSOLL, J.; N. Y., 1858.

2. The patent described, at the side of the form, a movable slide-rest, running parallel with the side of the kettle, and carrying a small fixed tool, which is brought up against the revolving blank, to roll the disk into the proper shape; *Held*, that an invention subsequently patented to Mary Cannon, which dispensed with such movable slide-rest, and provided for holding the tool against the form by a workman holding firmly one arm of a lever, was an infringement upon the Hayden patent. *Ibid.*

BRRING MACHINES.

WHIPPLE'S PATENT.

Issued October 28th, 1840.

Extended October 28th, 1854.

1. The patent was for "improvements in machines for cleansing wool from burs, &c.," and the suit was founded upon the second clause, which was, "forming and arranging the teeth of cylinders for burring wool in such a manner that their outer convex sides shall be substantially concentric with the axis of the cylinder, for the purpose of seizing and holding the fibres, and presenting a surface against which the guard can act in removing burs, &c."

BUTTONS, DESIGNS FOR.

Held, that the invention, so far as such claim was concerned, was to form and arrange the teeth with points which would seize and hold the fibre, with a smooth surface in the rear of the points, firm and non-elastic, to support or float the burs, so that the guard could remove them; and such teeth to be in such succession around the cylinder that their points should be protected by the heels or smooth surface in the rear of the preceding teeth, so as to prevent burs from being taken hold of by the points of the teeth, and also so as to prevent too many fibres of the wool being seized. *Whipple v. Middlesex Co.*, MS.—SPRAGUE, J.; Mass., 1860.

2. The claim regards the smooth surface as a part of the teeth, or an essential ingredient in the arrangement of the teeth, and of the invention. *Ibid.*

BUTTONS, DESIGNS FOR.

BOOTH'S PATENT.

Issued July 24th, 1847.

The patent was for "a new and ornamental design for figured silk buttons," and the claim was for the radially formed ornaments on the face of the mould of the button, combined with the mode of winding the covering of the same, substantially as set forth, and the specification described the configuration of the mould, and the winding it with various colored threads, but did not describe the process of winding.

Held, that the patent did not cover the *process*, but was for the arrangement of the different colored threads in the process, so as to produce the radially formed ornaments on the face of the button. *Booth v. Garelly*, 1 Blatchf., 248, 249.—NELSON, J.; N. Y., 1847.

CARS, SUPPORTING BODIES OF.

CARS, SUPPORTING BODIES OF.

IMLAY'S PATENT.

Issued September 21st, 1837.
Extended September 21st, 1851.

The patent was for "a new and useful improvement in the mode or means of supporting the bodies of railroad cars and carriages, and connecting them with the truck," and the object of the invention of the patent was to furnish a support for the carriage body, while the cars were in motion, which was both longitudinal and lateral, and also give a vertical support; and the means used were two cylindrical plates, male and female, one above and within the other; the upper one slightly convex on its lower surface, so that it rested only on the centre of the bed-plate, which could thus turn and vibrate under the top plate—one confined to the carriage and the other to the truck—and one entering within the other a sufficient depth to afford the desired support, without the aid of any other instrumentality, such as the ordinary king-bolt.

Held, that the patent secured the use and application of the two cylinder-plates, male and female, one within the other, and acting in combination, whereby the truck and carriage are combined to give support to all kinds of railroad carriages. *Imlay v. Nor. & Wor. R. R. Co.*, 4 Blatchf., 233.—INGERSOLL, J.; Ct., 1858.

2. *Held*, also, that the use, for the purpose of connecting the cars with the trucks, of similar male and female cylindrical plates, though neither of them were convex, and though used in combination with the ordinary king-bolt, was an infringement. *Ibid.*, 236.

CARS FOR COAL.

WINAN'S PATENT.

Issued June 26th, 1846.

The patent was for "an improvement in cars for the transportation of coal." The invention described and claimed was the making the body of the car in the form of the frustum of a cone, whereby the force of the weight of the load presses equally in all directions, and does not tend to change the form thereof, so that every part resists its equal proportion, by which the lower part is so reduced as to pass down within the truck, to lower the centre of gravity of the load, without diminishing the capacity of the car.

2. *Held*, that though the patentee had described no form, except the frustum of a cone, his patent covered also such variations of form as substantially embodied his mode of operation, and attained the same kind of result, and that the use of an octagonal, instead of a circular car, was an infringement.

Winans v. Denmead, 15 How., 344.—CURTIS, J.; Sup. Ct., 1853.

CARRIAGES FOR RAILWAYS.

WINANS' PATENT.

Issued July 30th, 1831.

The patent was for "a new and useful improvement of railway and other wheeled carriages," and the claim was for extending the axles each way outside of a pair of wheels far enough to form external gudgeons to receive the bearing box of the body load. It ap-

peared, however, that the invention had been before applied to other carriages, though not to railway carriages.

Held, that therefore the patent was void. *Winans v. Bos. & Prov. R. R. Co.*, 2 Story, 415.—STORY, J.; Mass 1843.

CARS, EIGHT-WHEELED.

WINANS' PATENT.

Issued October 1st, 1831.

1. The patent was for "a new and useful improvement in the construction of carriages intended to travel on railroads," and the improvement consisted in placing two bearing carriages, each with four wheels, at or near each end of the car, and the two wheels on either side of these carriages to be placed very near to each other, the spaces between their flanges being not greater than is necessary to prevent their contact with each other; and the claim was for "the described manner of arranging and connecting the eight wheels, which constitute the two bearing carriages, with a railroad car, so as to accomplish the end proposed by the means set forth, or by any others which are analogous and dependent upon the same principles."

Held, that the claim was for the car itself, constructed and arranged as described in the patent, complete and fit for use, and not for the separate parts which enter into his arrangement, or for the particular arrangement or combination. *Winans v. Schenec. & Troy R. R. Co.*, 2 Blatchf., 284, 293, 294.—NELSON, J.; N. Y., 1851.

2. The location of the trucks relatively to each other under the body of the car, as well as the near proximity of the

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two axles of each truck to each other, form a most essential part of the arrangement of the patentee in the construction of the car; the trucks to be placed as remotely from each other as can conveniently be done, for the support of the carriage, and the spaces between the two axles to be no greater than is necessary to prevent the flanges of the wheels coming in contact with each other. But the improvement does not consist in placing the axles of the two trucks at any precise distance apart, or at any precise distance from each end of the body. And the specification is sufficiently definite without specifying the exact distance, in feet and inches, from the ends of the car body at which it would be best to arrange the trucks, or the exact distance between the axles. *Ibid.*, 295, 297.

3. Winans' patent is for the manner of arranging and connecting the eight wheels, which constitute the two bearing carriages, with a railroad carriage, as shall enable a car with a long body to pass curves with greater facility and safety and less friction, and at the same time cause the body of the car to pursue a more smooth, even, direct, and safe course over the curvatures and irregularities of the road. *Winans v. N. Y. & E. R. R. Co.*, 21 How., 102.—GRIER, J.; Sup. Ct., 1858.

4. Carriages with eight wheels, arranged and connected substantially in the same manner, and upon the same mechanical principles, with those described in Winans' patent, having been known before his invention;

Held, that he was not entitled to recover. *Ibid.*, 103.

CAR WHEELS.

WOLF'S PATENT.

Issued March 17th, 1838.

1. The patent was for "a new and useful improvement in the mode of making cast-iron wheels to be used on railroads, and applicable to other purposes," and the claim was for "the manner of constructing railroad car wheels with double convex plates, one convex outward and the other inward, and an undivided hub, the whole cast in one piece."

Held, that the patent was not for the mode or method of constructing the wheel, as distinct from the instrument itself; but that it was the thing, the instrument or wheel after it was made, which they claimed to have discovered. *Many v. Jagger*, 1 Blatchf., 378.—NELSON, J.; N. Y., 1848.

2. *Held*, also, that the claim was not for any of the parts of the wheel taken separately, but for the entire wheel as constructed—a cast iron-wheel, with double plates, a solid hub, and a chilled rim, all cast in one piece. *Ibid.*, 378, 379.

3. *Held*, also, that the peculiar form of the double plates being nearly parallel—one convex inward, and the other convex outward—so that in consequence of such curvature they would contract without danger of fracture, was not essential, any further than as respects a form that would allow for the contraction of the plates in cooling, the allowance being made for the purpose of procuring a chilled rim. *Ibid.*, 379.

4. The correctness of the ruling of

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the court in this case questioned in *Many v. Sizer*, 1 Fisher, 43.—SPRAGUE, J.; Mass., 1849.

CASTERS FOR BEDSTEADS.

BLAKE'S PATENT.

Issued June 30th, 1838.

The patent was for "an improved caster for bedsteads."

Held, that the invention was the old *wheel and pintle*, so adapted to and arranged with the leg of the bedstead by inserting it in the centre, that the top of the pintle may be received in the conical cavity of the upper metallic bearing, to sustain the weight, while the lower metallic bearing constitutes a back to the lower end of the hold, to secure the pintle against lateral motion. *Blake v. Sperry*, 2 N. Y. Leg. Obs., 255.—INGERSOLL, J.; Ct., 1843.

It dispenses with the *plate and screws* of the *plate caster*, the *iron frame* of the *French caster*, the *clasps and staples* of the *safe caster*, the *wood frame and braces* of the *invalid caster*, and the *sheath* of the *socket caster*; and that the patent was a valid patent. *Ibid.*

COTTON GIN, RIBS OF.

CARVER'S PATENT.

Issued June 12th, 1838.

Reissued Nov. 16th, 1839.

1. This patent was for "a new and useful improvement in the ribs of the cotton gin," and the patentee claimed as his invention, the increasing the depth or space between the upper or outer, and the lower or inner surfaces of the rib, so that it should be equal

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to the length of the fibre of the cotton to be ginned; and also, as part of the same improvement, sloping up the lower or inner surface of the rib so as to meet the upper or outer surface, leaving no break or shoulder between the two surfaces.

Held, That the patent was for one entire thing, that is, for an improved rib, or a specified improvement upon the common rib, and not for two distinct and independent improvements—the thickness or depth of the rib, and the sloping up of the surfaces thereof. *Carver v. Braintree Manuf. Co.*, 2 Story, 445, 446.—STORY, J.; Mass., 1843.

2. *Held*, also, that the same thing was patented in both the original and renewed patents. *Ibid.*, 438, 445.

3. The true construction of this patent is, that it claims not only the increasing the depth or space between the upper or outer, and the lower or inner surface of the rib, at the part where the cotton is drawn through the grate; but also, the sloping up of the lower or inner surface so as to meet the upper or outer surface above the saws, leaving no break or shoulder between the two surfaces, but a smooth and uninterrupted passage upward between them. *Carver v. Hyde*, 16 Pet., 517.—TANEY, Ch. J.; Sup. Ct., 1842.

COTTON SPEEDER.

DAVOLL'S PATENT.

Issued May 19th, 1843.

This invention was for "improvements in the machine known as the speeder, double speeder, or fly-frame, for roving cotton." The specification described the spindles as arranged in two rows, and

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that the flyers were made in one continuous piece, instead of being open at the bottom. The claim was for the arrangement of the spindles and flyers in two rows, in combination with the described arrangement of gearing, or substantially such arrangement.

Held, that this improvement was confined to the use of the bow-flyer, that is, the flyer in one continuous piece. *Davoll v. Brown*, 1 Wood. & Min., 55, 60.—WOODBURY, J.; Mass., 1845.

CULTIVATORS.

IDE'S PATENT.

Issued April 18th, 1846.

1. The patent was for "an improvement in cultivators," and the claim was for the arrangement of the teeth in two rows, in combination with a pair of wheels, the treads of which are in a line midway between the points of the two rows of teeth, substantially as described. The specification described the teeth as seven in number, arranged in two straight rows, three in one row and four in another, the points of the three being in front of the line of the wheels, and the points of the four behind such line, and the tread of the wheels being placed midway between the rows of the teeth, to resist any tendency of either row of teeth to cut too deep, and the tread of the wheels between them acting as a fulcrum, so as to relieve the team of any strain arising from either row of the teeth running too low or too shallow, and by which arrangement also the use of guiding handles or of four wheels, could be dispensed with; and the defendant's machine used but two wheels, and no guiding handles, and had also

DYEING PARTI-COLORED YARN.

seven teeth, three in front of the wheels and four behind, but the middle tooth of the forward three was moved forward of the others, and the two middle teeth of the back row were placed behind the others, so that the two rows were not straight, and the axle of the wheels was thrown forward so that the tread of the wheels was not midway between the rows of the teeth, by which strain on the team was further reduced.

Held, that the defendant's machine was an infringement upon the plaintiff's as it used the principle and substance of plaintiff's invention, and was not even an improvement, as it was only the result of practical experience in the use of plaintiff's machine, and involved no invention. *Tracy v. Torrey*, 2 Blatchf., 277, 278.—NELSON, J.; N. Y., 1851.

2. In an action for an infringement of the same patent, referred to last above, where the defendant's machine was like that of Torrey, except that the middle tooth of the forward three was set back, so that two teeth were forward of the wheels, and five were back, *Held*, that defendant's machine was an infringement. *Chamberlin v. Ganson*, 2 Blatchf., 279 (note).—NELSON, J.; N. Y., 1851.

DYEING PARTI-COLORED YARN

SMITH'S PATENT.

Issued June 18th, 1850.

Reissued January 11th, 1852.

1. The patent was for "an improvement in apparatus for parti-coloring yarn," and the claim was for the method described of parti-coloring yarns, by winding them on reels in frames, so as to admit of immersing such portions as

are desired to be dyed, and shifting the same for dyeing other parts in like manner.

Held, that the patent was for the apparatus, and not for a process or method. *Smith v. Higgins*, MS.—BETTS, J.; N. Y., 1857.

2. The essential, if not the only novelty of the combination, is the movable frame and its appurtenances; and a material particularity in its construction and specialty is, that the yarn, to the length of the skein, is required to be wound or rolled upon the frame over the reels rotating at its two ends. The yarn must be in a reeled and measured state when placed upon the frame, and prepared to be immersed in the dye to a measured distance. *Ibid*.

3. The combination claimed consists of the construction and arrangement of the movable frames, reels, and yarns, and their conjoint operation in dyeing, and without including the measuring scale. *Ibid*.

4. The thing invented is: the horizontal frame carrying the reeled yarns combined with the dyeing vat by machinery adapted to let down and draw up this frame, and measure the extent of the immersion, or the extent of the line of dyeing upon the yarn. *Smith v. Higgins*, MS.—NELSON, J.; N. Y., 1859.

5. In other words, the thing discovered is the combination of the horizontal frame, carrying the reeled yarns with the dyeing vat by machinery—which must always be kept in view as very important—which lets down the frame carrying the yarn, and draws it up, and at the same time measures the line of yarn to be dyed. *Ibid*.

6. It is not a patent for the discovery of the idea of coloring parti-colored

yarns by immersion in the dye, but for an arrangement or combination of machinery, as a means to be used in dyeing parti-colored yarns by immersion in the dye. *Ibid*.

DYEING AND FINISHING SILK GOODS.

STEARNES & BARRETT'S PATENT.

Issued May 12th, 1818.

This patent was for "a new and useful improvement, being a mode for dyeing and finishing all kinds of silk woven goods," and the specification described two machines, one a reel, on which spirally to wind and secure the silk, and put it into the dye; the other a frame for the purpose of extending and finishing the silk after it is dyed.

Held, that the patent was for dyeing and finishing such goods by means of the reel and frame in combination, and not for each of the machines severally, as well as in combination. *Barrett v. Hall*, 1 Mas., 448, 477.—STORY, J.; Mass., 1818.

ELECTRIC TELEGRAPH.

BAIN'S PATENT.

Issued April 17th, 1849.

The invention of Bain, for which application for a patent was made April 18th, 1848, and being for his chemical telegraph, so called, being the application of chemically prepared paper to receive and record signs by means of the pulsations of an electric current transmitted from a distance, and operating directly and without the intervention of any secondary current, or me-

chanical contrivance, through a metal marking style, in contact with such prepared paper, is not the same invention as that of Morse, for which application for a patent was made January 20th, 1848, and in which he claimed the use of a single circuit of conductors for marking signs by means of the decomposing effects of electricity on prepared paper, and by means of the machinery described for such purpose. Each was entitled to a patent for the particular combination he had invented. *Bain v. Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

MORSE'S PATENTS.

"MAGNETIC."—Issued June 20th, 1840.

Reissued January 25th, 1846.

Reissued June 13th, 1848.

"Local Circuit."—Issued April 11th, 1846.

Reissued June 13th, 1848.

"CHEMICAL."—Issued May 1st, 1849.

House Instrument.

Columbian Instrument.

1. The patent of Morse, of June 20th, 1840, for improvements in the electro-magnetic telegraph, should be limited to the term of fourteen years from the date of his French patent, August 18th, 1838, and not being so limited, but purporting to give an exclusive right for fourteen years from *its* date, is void. *Smith v. Ely*, 5 McLean, 79, 82.—MCLEAN, J.; Ohio, 1849.

2. But such error is not fatal to the right of the patentee, and may be corrected at the Patent Office. *Ibid.*, 80.

3. The motive power of the galvanic current, however developed to produce a given result, can be no more patented than the motive power of steam to propel boats, however applied. *Ibid.*, 91.

4. The essence of Morse's method,

beyond what before had existed, or been practised, was to make electro-magnetism, when excited, not merely exhibit some evanescent sign at the other end, but a sign which the machine is made to trace, and thus record them permanently. *Smith v. Downing*, 1 Fisher, 72.—WOODBURY, J.; Mass., 1850.

5. The chief principle or characteristic of Morse's telegraphic invention, is that by its type-rule, or knob-spring at the starting place, it is able to make dots and lines by breaking the circuit, for a shorter or longer time, and then being felt along the wires to the other end, trace there on paper, passing under or over the needle or pin at the end of the lever, like dots and lines, which remain on it permanently written, to be afterward, by the stenographic alphabet, translated into Roman letters and words. *Ibid.*, 86.

6. Before his invention, there were already known the wires and circuit, the galvanic battery, the use of posts, and the ground for a part of the circuit, the breaking of the circuit by various devices, the making of signals and marks, the paper and clock-work, and the deflected needle, if not the lever. *Ib.*, 88.

7. The lever of Morse's instrument seems to be but the old needle, depressed at one end by the magnet, and of course elevated at the other, and a pin or pen inserted in it to make dots or strokes on the paper. *Ibid.*, 90.

8. The novelties in Morse's patents are 1st, local circuits; 2d, recording or writing at a distance by electro-magnetism, and 3d, doing this by a regular stenographic alphabet on rolling paper. *Ibid.*, 90.

9. House's telegraphic machine is more complicated than Morse's, moves much faster, at the rate of 60 to 70

breaks in a second, and at once records the information by its own machinery, in Roman letters. It gives "letters to lightning," as well as "lightning to letters." *Ibid.*, 85.

10. It makes no tracing at either end of the circuit, but acts at both ends by means of signals, and traces nothing. Morse's is a tracing or writing telegraph, House's a signal and printing telegraph. *Ibid.*, 86.

11. House uses no local circuits, makes no tracing, but records by printing and by means of two additional powers in axial magnetism and air, and uses no stenographic alphabet. *Ib.*, 88.

12. The use of electro-magnetism generally for communicating intelligence at a distance and there recording it, is not new to either Morse or House. *Ibid.*, 89.

13. By the assertion and claim found in Morse's patent of 1848, of "the essence of his invention being the use of the motive power of the electric or galvanic current, *however developed*, for marking and printing intelligible characters at any distance," he must be considered as claiming it in the form of his application—according to his machinery—rather than as intending to cover the application itself of electro-magnetism to telegraphic purposes, in every possible form. Otherwise, his renewed patent of 1848, must be regarded as void, for claiming too much, and for wishing to protect a mere principle or effect, "however developed," and without reference to any method described by him, and to cover a principle, also before known. *Ibid.*, 67, 68.

14. The original patent of Morse—commonly known as his Magnetic patent, of June 20th, 1840; and its re-issue of January 25th, 1846, and its

second reissue of June 13th, 1848, in all their changes, contain no flagrant diversity of claim. They all claim the same thing essentially; and in them all, he claims, and renews his claim of property in the same invention—he declares the existence of a new art, and asserts his right in it as its inventor and owner; and his title was vested as patentee of the art. *French v. Rogers*, 1 Fisher, 140, 141.—KANE, J.; Pa., 1851.

15. Morse's Local Circuit patent, granted April 11th, 1846, and reissued June 13th, 1848, are also both for the same invention. *Ibid.*, 149.

16. The subject or leading principle of his Chemical patent of May 1st, 1849, is also clearly within his original patent, and was appropriated and secured by the magnetic patent of 1840. *Ibid.*, 151.

17. Morse was the first and original inventor of the electro-magnetic telegraph. *O'Rielly v. Morse*, 15 How., 109, 125.—TANEY, Ch. J.; GRIER, J.; Sup. Ct., 1853.

18. There is nothing in the reissued patents of 1846 and 1848 that may not be regarded as a more careful description than the patent of 1840. *Ibid.*, 112.

19. His patent is not void, because it does not on its face bear the same date with his French patent, previously obtained for the same invention, but its monopoly is limited to the term of fourteen years from the date of the foreign patent. *Ibid.*, 112.

20. Morse's eighth claim in his reissued patent of 1848, which is as follows: "I do not propose to limit myself to the specific machinery or parts of machinery in the foregoing specifications and claims; the essence of my invention being the use of the motive power of the electric or galvanic cur-

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rent, which I call electro-magnetism however developed for marking or printing intelligible characters, signs, or letters, at any distances, being a new application of that power of which I claim to be the first inventor or discoverer," is illegal and void, as claiming the *exclusive* right to the use or effect of such power for such purpose, without respect to the process or machinery by which accomplished—but he is entitled to a patent only for the particular method or process discovered by him. *Ibid.*, 112, 120.

21. The delay of Morse to enter a disclaimer for such claim, it having received the sanction of the head of the Patent Office, and been sustained by a Circuit Court, until such claim was passed upon by the Supreme Court, was not unreasonable, and the omission does not render his patent void. *Ibid.*, 122.

22. Morse's patent of 1846, reissued in 1848, for the local circuits, is for an invention not embraced in his former patents, and was properly issued. *Ibid.*, 123.

23. The Columbian telegraph, so-called, uses substantially the same means embraced in Morse's patent, and is an infringement upon it. *Ibid.*, 123, 124.

24. As to the construction of agreements respecting the electric telegraph, see AGREEMENTS, B., 17, 18, 19, 20, 35, 48, 49, 50.

FIRE-ENGINES.

RANSOM & WENMAN'S PATENT.

Issued February 13th, 1841.

1. The patent was for "an improvement in fire-engines," and described as

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connecting the receiving tubes or pumps of the engine, by means of hose, to hydrants, in which the water was under pressure, and claimed "the employment of a column of falling water, or the tendency of the hydrostatic pressure upon water at rest, to act in the working of fire-engines, by combining a hose or tube, conducting said water into the receiving tube of an engine or pump operated by manual or mechanical power."

Held, that the invention patented was "the combination of the pumps or receiving tubes of the fire-engine with a connecting-pipe or hose, forming a connection between such engine and a hydrant or water pipe from which water is forced by the hydrostatic pressure existing in the hydrant into the pumps of the engine, and applied so as to combine the power of this hydraulic pressure with the power applied to the brakes of the engine," substantially as set forth. *Ransom v. Mayor, &c.*, 1 Fisher, 261.—HALL, J.; N. Y., 1856.

2. *Held*, also, that the patent was not for a principle, and did not grant to the patentee the exclusive privilege of using such hydrostatic pressure in all forms and modes in which it could be applied to the production of the purposes of the character intended by him, but that the patent was only for the means and devices by which the patentee proposed to make such pressure available for the purpose indicated in the specification. *Ibid.*, 262.

GLASS KNOBS.

WHITNEY & ROBINSON'S PATENT.

Issued August 22d, 1826.

The patent was for "a new and useful

GRAIN-CLEANING MACHINES.

GRINDING TOOLS.

improvement in the mode of manufacturing glass knobs," by machinery, at one operation, in such a manner as, without any blowing, to produce a finished knob, with a hole perforated through it, and a neck or enlargement.

Held, that the description in the specification was sufficient in law, and that the patent was not broader than the invention. *Whitney v. Emmett*, Bald., 304, 315.—BALDWIN, J.; Pa., 1831.

GRAIN-CLEANING MACHINES.

PITTS' PATENT.

Issued December 29th, 1837.

1. The patent was for "a new and useful improvement in the machine for threshing and cleaning grain." The claim was for "the construction and use of an endless apron, divided into troughs or cells, in a machine for cleaning grain, operating substantially as described."

Held, that the patent was not for the endless apron of troughs or cells, but of an endless apron of troughs or cells combined with a particular threshing machine described, and that if the combination was new, it was patentable, although a part might have been applied to similar purposes in other machines. *Pitts v. Whitman*, 2 Story, 618, 619.—STORY, J.; Me., 1843.

2. And though the patentee described his invention as "a new and useful improvement," and it in fact consisted of a combination of several improvements, *Held*, that the patent was good not only for the whole combination, but also for each distinct improvement, so far as it was his invention. *Ibid.*, 620, 621.

3. The four claims in this patent each

consist of combinations of mechanical powers, which produce a given result. *Pitts v. Wemple*, 6 McLean, 561.—MCLEAN, J.; Ill., 1855.

SANDERS' PATENT.

Issued June 19th, 1849.

Reissued April 10th, 1855.

1. This patent was for an "improvement in winnowing machines," and the claim was, the trunk gradually enlarged from below upward, and communicating with the atmospheric current through the grain-screen, in combination with the hopper, and the fan placed at the end of an opposite vertical trunk, to separate the chaff and other impurities from the grain, in the manner substantially as described.

Held, that the claim in the original patent is a correct description of the whole invention. *Sanders v. Logan*, 3 Wall., Jr.—GRIER, J.; Pa., 1861.

2. The third claim of the reissued patent is too broad. The use of a vertical blast-spout, so arranged that grain is cleaned from impurities within said spout, was not new. *Ibid.*

GRINDING TOOLS.

HOVEY'S PATENT.

Issued September 23d, 1845.

This patent was for "a new and useful improvement in the machinery for grinding tools." *Held*, that the uncertainty and obscurity in the specification of this patent as to what the patentee claims as his invention, or what is in fact the novelty of it, is so great as to render the patent invalid. *Hovey v.*

GUN LOCKS.

Stevens, 3 Wood. & Min., 19, 30, 31.—
WOODBURY, J.; Mass., 1846.

GUN LOCKS.

ALLEN'S PATENT.

Issued November 11th, 1837.

Reissued August 3d, 1844.

The patent was for "an improvement in the method of constructing fire-arms."

Held, that the reissued patent of August 3d, 1844, is for the same invention as that described in the patent of November 11th, 1837. *Allen v. Sprague*, 1 Blatchf., 567.—NELSON, J.; N. Y., 1850.

HARVESTING MACHINES.

McCORMICK'S PATENTS.

Issued June 21st, 1834.

Issued January 31st, 1845.

Issued October 23d, 1847.

Reissued May 24th, 1853.

1. The claim of McCormick, in his patent of October 23d, 1847, for improvement in reaping machines, was as follows: "The arrangement of the seat of the raker over the end of the finger pieces, and just back of the driving wheel as described, in combination with and placed at the end of the reel, whereby the raker can sit with his back toward the team, and thus have free access to the cut grain laid on the platform and back of the reel, and rake it from thence on to the ground by a natural sweep of his body, and lay it in a range at right angles with his swarth as described, thereby avoiding unevenness and scattering in the discharge of the wheat, as

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well as accomplishing the same with a great saving of labor."

Held, that it was the seat as thus described, by which the raker may sit or stand on the frame, and rake the wheat from the platform with convenience, that was claimed. *McCormick v. Seymour*, 2 Blatchf., 248, 251.—NELSON, J.; N. Y., June, 1851.

2. But the claim is not for the seat *as a seat*, or for its particular mode and form of construction, but for the arrangement and combination described, by which the benefit of a seat or position for the raker is obtained, by which the raker is placed where he is placed, standing or sitting, and do his work. *Ibid.*, 250, 253.

3. The improvement was not simply putting a seat on the machine for the raker, but was the arrangement and combination of the parts of the machine, so that the patentee was enabled to obtain room on the machine for the raker, and that he might have the free use of his body and limbs in raking off the grain, avoiding the labor and fatigue and inconvenience of walking. The seat or position of the raker on the machine was the object had in view, and was the result of his new arrangement and combination of the different parts of the machine. *McCormick v. Seymour*, MS.—NELSON, J.; N. Y., Oct., 1851.

4. The second claim in McCormick's patent, which is as follows: "I claim the reversed angle of the teeth of the blade, in manner described," is not simply for the reversed angles of the sickle teeth of the blade, but for reversing the angles of the teeth *in the manner previously described in his patent*—it is a claim for the angles formed by the peculiar shape of the fingers, in connec-

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tion with the cutter, having the angles of the teeth reversed. *McCormick v. Seymour*, 3 Blatchf., 223.—NELSON, J. N. Y., 1854. [Reversed, *post* 11.]

5. McCormick's patent of June 21st, 1834, having expired, whatever of invention is contained in it belongs to the public, and may be used by any one. *McCormick v. Manny*, 6 McLean, 543, 544.—McLEAN, J.; Ill., 1855.

6. In McCormick's patent of 1847, reissued in 1853, he claimed "the combination of the bow L and dividing iron M, for separating the wheat to be cut from that to be left standing." This claim being for a combination, the use of a wooden divider, as used and patented by Manny, is no infringement. *Ibid.*, 547, 549.

7. The reel part of McCormick, placed behind the sickles, and leaning forward, so as to bring the part of it supporting the reel perpendicular, also extending forward, so as to admit of being braced directly to the tongue, in combination with which it was claimed, is not infringed by the reel part of Manny, which connects with the hindmost post of the machine, and is sustained by braces. *Ibid.*, 550.

8. The improvement of McCormick, as to the seat, consists in the peculiar organization of advancing the reel in front of the cutters, and shortening it and putting the driving wheel back and the gearing forward, so as to balance the machine with the weight of the raker on the extended finger piece. It is adapted to no other part of the machine, and his improvement is limited to his specification. *Ibid.*, 552.

9. McCormick's invention was not the seat for the raker, but the change of the machinery to make a place for it. If a raker can be seated on a different part

of the machine, and where he can rake without balancing the machine, and without interruption from the reel, or on any part of the machine which does not require substantially the same invention and improvement as McCormick's, it is no infringement of his right. *Ibid.*, 556, 557.

10. The patent of John H. Manny of March 6th, 1855, does not infringe upon McCormick's patent of 1847, reissued, 1853. *Ibid.*, 556.

11. McCormick's patent of 1845, among its claims had the following: "2. I claim the reversed angle of the teeth of the blade, in manner described. 3. I claim the arrangement and construction of the fingers or teeth for supporting the grain, so as to form the angular spaces in front of the blade, as and for the purpose described." *Held*, that the two were not to be construed together, as a claim for the reversed angle of the teeth of the blade, in combination with the peculiar form of the fingers; but that each claim was to be construed and considered separately. *Seymour v. McCormick*, 19 How., 99, 106.—NELSON, J.; Sup. Ct., 1856.

12. And that the former, the second, not being new, costs could not be recovered in an action for infringement, without a disclaimer being made of such claim. *Ibid.*, 106.

13. McCormick was not the original inventor of the contrivance called the divider, for separating the grain in advance of the cutting apparatus. *McCormick v. Talcott*, 20 How., 406.—GRIER, J.; Sup. Ct., 1857.

14. His fourth claim in his patent of 1845, for "the combination of the bow L and dividing iron M, for separating the wheat in the way described" is the proper subject of a patent, but is not

HAT BODIES.

infringed by one who uses only a part of the combination; nor can it challenge other improvements on the same machine, different in form or combination, as infringements, because they perform the same functions, by calling them equivalents. It is a claim for the combination of the bow with a dividing iron of a certain form, and for nothing more. *Ibid.*, 406.

15. The divider described in Manny's patent of 1847, is not an infringement on the invention of McCormick. *Ibid.*, 406, 407. [DANIEL, J.; dissenting.]

16. The manner of supporting the reel, as used in Manny's machine, is not the same as the invention of McCormick, and it had been in use before McCormick's patent. *Ibid.*, 407, 408.

17. As to the raker's seat, McCormick's claim was for the combination of the reel with a seat, arranged and located according to his description. Manny's arrangement is substantially different, both in form and combination, and is no infringement upon McCormick's patent. *Ibid.*, 408.

HUSSEY'S PATENT.

Issued August 7th, 1847
Reissued April 14th, 1857, in three.

The patent was for certain "new and useful improvements in reaping machines," and the claim was for the combination of vibrating scalloped cutter, the indentations of whose edge act as a series of moving shear blades, with slotted guard fingers, the sides of which act as a corresponding series of fixed shear blades; the parts of such fingers forming the slot being connected at the front ends only, leaving the rear of the slot open and free for the escape of ma-

terial that would otherwise clog the cutter.

Held, that his invention was not confined to a guard finger with a slot open at the *top*, but included a guard finger with a slot open below the cutter, and that it was not required that the scallop should be of any particular depth, or that the angle they make should be greater or less, or that the cutter should be sickle-edged; any combination of the open slotted finger with vibrating scalloped cutters is embraced in the patent. *Hussey v. McCormick*, 1 Fisher, 513.—McLEAN, J.; Ohio, 1859.

HAT BODIES.

WELLS' PATENT.

Issued April 25th, 1846.
Reissued September 30th, 1856.
Reissued October 7th, 1856.

1. In an action for an infringement upon Well's patent for making hat bodies, the defendants in their machine divided the tunnel or chamber into which the fibres of the fur were thrown, and used a perforated cone of wire gauze, of larger opening than Wells, and put a finer one of grass cloth over it, and used a metallic picker instead of the hair brush to throw the fibres of the fur into the chamber, and also, instead of immersing the bat formed on the cone, into warm water, to harden it, so that it could be removed, discharged jets of steam upon the bat during the process of formation.

Held, on an application for an injunction, that the machine of the defendants, and their process of making the hat body, was substantially like that of the complainants, the assignees of

ICE, CUTTING. INDIA RUBBER.

Wells, and that they were entitled to an injunction. *St. John v. Prentiss*, MS.—NELSON, J.; N. Y., 1853.

2. The nature of this invention is the formation of hat bodies by throwing the fibres of wool or fur, in proper proportions, on a perforated cone, exhausted by a fan or other contrivance, to hold the fibres on the cone by the currents of air rushing through the perforated cone, and to harden sufficiently the bat of wool or fur. Previous to the discovery and invention of Wells, no devices were known to accomplish such desired object in a satisfactory way. *Burr v. Cowperthwaite*, 4 Blatchf., 165.—INGERSOLL, J.; Ct., 1858.

3. The devices or essential means used, are a fur table, upon which the fur is distributed, a suitable feeding apparatus to bring the fur to the table and present it to rotary brushes, or other suitable device for disintegrating and casting the fur into a current of air induced by the brushes or otherwise, a trunk or other device between the brushes and cone extending some distance from the brushes and in the direction of a perforated exhausted rotary cone to control and give direction to the current of air, and a hood, or some analogous device, to further modify the current of air for the proper distribution of the fur upon the cone. *Ibid.*, 167.

4. Before the discovery of Wells, no machine was known or used that did, by any means, *direct* a sheet of fur on a section of a perforated exhausted rotary cone, or other form, so as to make a bat of fur on the cone or other form, of the desired shape and thickness, in properly regulated quantities, at the will of the operator. By the machines before known no sheet of fur was *directed* by the or-

ganization of the machine on to the perforated cone, but the fur was deposited on the exhausted cone by the power of gravity, or the power of the exhaust, or both, and not by the power of the machine, *directing* how and in what manner the fur should be distributed on the cone. *Ibid.*, 168.

5. This mode (by directing the fur) of forming the bats distinguished the Wells' machines from all others known or used before his discovery. *Ib.*, 169.

ICE, CUTTING.

WYETH'S PATENT.

Issued March 18th, 1829.

The patent was for "a new and useful improvement in the manner of cutting ice, together with the machinery and apparatus therefor," and it was claimed as new, to cut ice of a uniform size, by means of an apparatus worked by any power other than human. The invention of the art described, as well as the particular method of the application of the principle, were both claimed.

Held, that so far as the patentee claimed the art of cutting ice by means of any power other than human, it was a claim for an art or principle in the abstract, and void; but so far as it claimed the machines described, it might be good, if a disclaimer was properly entered under §§ 7 and 9 of the act of 1837. *Wyeth v. Stone*, 274, 285, 287, 294.—STORY, J.; Mass., 1840.

INDIA-RUBBER.

CHAFFEE'S PATENT.

Issued August 31st, 1846

The patent was for "a new improve-

ment in the application of caoutchouc to cloths, &c."

Held, that the patent covered both the process described in the specification, and the machinery described as that to be used in carrying on the process. *Day v. Union India-rubber Co.*, 3 Blatchf., 490.—HALL, J.; N. Y., 1856.

GOODYEAR'S PATENTS.

SHIRRED GOODS PATENT, issued March 9, 1844.

SOFT RUBBER PATENT, issued June 15, 1844.

Reissued December 25, 1849.

1. Goodyear's invention for combining with calendar rollers, an elastic endless apron, for manufacturing corrugated, or shirred, india-rubber goods, does not consist either in the whole machine, or in any particular part of it, but consists in a new combination of known mechanical principles or powers to produce a new and useful effect. *Warner v. Goodyear*, MS.—CRANCH, Ch. J.; D. C., 1846.

2. The surrender of Goodyear's original patent for vulcanized rubber, of June 15th, 1844, and the reissued patent, December 25th, 1849, was legal, and the reissued patent is not void upon its face. *Day v. Goodyear*, MS.—GRIER, J.; N. J., 1850.

3. Charles Goodyear must be considered as the first and original inventor of the process of vulcanizing india-rubber. *Ibid.*

4. His reissued patent of December 25th, 1849, is not void because of the publication of the invention, in his original and defective patent, in the interval between the original and reissued patent, on the ground that such publication amounts to an abandonment or dedication to the public. *Ibid.*

5. Goodyear's invention did not consist merely in the use of sulphur, or lead, or both, or the application of heat to rubber in connection with both, either or neither of them; all these things had been done before. The essential and distinctive peculiarity of his discovery is, that by using a certain degree of heat in the treatment of rubber, in connection with those materials, it can be made to assume new and valuable qualities, distinguishing it from any other substance heretofore known. *Ibid.*

6. By the agreements of October 29th, 1846, November 5th, 1846, and December 5th, 1846, making one agreement, made by and between H. H. Day and Charles Goodyear, and the acts under them, and in perfecting the same, Day is estopped thereafter from denying the validity of Goodyear's patents. *Ibid.*

7. Goodyear's invention of vulcanizing rubber, is a discovery of a new compound, substance, or manufacture, and both the process and composition of matter are new, and both are protected or included in the patent. *Goodyear v. the Railroads*, 2 Wall., Jr., 361.—GRIER, J.; N. J., 1853.

8. His claim is for the vulcanizing of rubber and sulphur by artificial heat, however produced; the method of communicating heat is not the thing patented; therefore, the use of steam instead of heated air, is an infringement upon his invention. *Ibid.*, 362.

9. His patent is for a new product as well as a new process, and being both for the process and the product, the use and sale of the composition, unless when purchased from persons licensed by him to use the process and vend the product, is an infringement of his franchise, and may be prohibited by him. *Ibid.*, 365.

INDIA-RUBBER.

10. Under the agreement of September 5th, 1850, made between Chaffee, the patentee, and William Judson, as trustee, that the latter should hold the patent, and have the control thereof for the benefit of Goodyear and those holding rights under him, the entire ownership of the patent, legal and equitable, passed to Judson. *Hartshorn v. Day*, 19 How., 220.—NELSON, J.; Sup. Ct., 1856. The same decision made in *Day v. Union I. R. Co.*, 20 How., 217.—NELSON, J.; Sup. Ct., 1857.

11. The agreement of October 29th, 1846, the two supplemental agreements of November 5th, 1846, and the further one of December 5th, 1846, made between Goodyear and Day, and by which Goodyear sold and assigned to Day the full, absolute, and exclusive right, license, and privilege to make, use, and vend *shirred or corrugated goods*, and to use certain machinery and compounds in connection therewith, granted to Day only the right to make and vend such shirred or corrugated goods as are described in, and were patented to Goodyear, by what is called the shirred goods patent, issued March 9th, 1844, and did not confer upon Day any right to use Goodyear's preparations, and improvements in india-rubber, or to use vulcanized rubber in the manufacture of any elastic articles, or elastic goods, or elastic cloths, except the *shirred or corrugated goods* made according to such patent of March 9th, 1844. *Day v. Carey*, 4 Blatchf., 278.—INGERSOLL, J.; N. Y., 1859.

12. The meaning of the words "shirred or corrugated goods," as understood and used by the parties to such deeds, was the elastic rubber goods manufactured according to the patent of March 9th, 1844, and no other kind of elastic

goods was meant by the use of these terms. *Ibid.*, 279.

13. The opposite of the above view, however, taken in Maryland, by GILES, J.; who held that by the contract of October, 29th, 1846, the term *shirred or corrugated goods*, means all kinds of shirred or corrugated goods, whether cemented, woven, or sewed, and is not limited to the goods made under the patent of March 9th, 1844; and that if such contract did not confer upon Day such right, the agreement of May 24th, 1858, made between Goodyear and said Day, conveyed such interest to him. *Day v. Stellman*, 1 Fisher, 501.—GILES, J.; Md., 1859.

14. The same view taken in *Day v. Stellman*, was also taken in *Day v. Lyons*, MS.—MCCALEB, J.; La., 1860.

MEYER'S GREASE PATENT.

Issued December 20th, 1853.

1. The patent was for an "improvement in the manufacture of caoutchouc and other vulcanizable gums," and the claim was for the producing of smooth and glossy surfaces upon the hard compounds of caoutchouc and other vulcanizable gums, by means of the use of oil, or other equivalent substance, applied to the surface of the prepared gum, and between the gum and the plates of metal, or the moulds.

Held, that the patent granted the exclusive use of oil, or other equivalent substances, applied to the surface of the prepared gum, and between the gum and plates of metal, or tin-foil, placed on each side of it, or the moulds, substantially as described in the patent. *Poppenhausen v. N. Y. Gutta-Percha Comb Co.*, 4 Blatchf., 190.—INGERSOLL, J.; N. Y., 1858.

IRREGULAR FORMS, TURNING.

Held also, on a motion for an injunction, in respect to an alleged infringement of this same patent, that the use of turpentine with india-rubber dissolved in it, was an equivalent of oil, and its use an infringement. *Poppenheusen v. Falke*, 2 Fisher, 217.—SHIPMAN, J.; N. Y., 1862.

MEYER'S TIN-FOIL PATENT.

Issued April 4th, 1854.

Reissued August 16th, 1859.

1. This patent was for an "improvement in treating caoutchouc and other vulcanizable gums," and the invention consisted in covering the surface of the hard compound of caoutchouc during the process of vulcanization with tin-foil or other equivalent substance, to preserve the form previously given by embossing or moulding.

Held, the patent did not grant the exclusive right to vulcanize the hard compound, in contact with metallic surfaces, or vulcanize such compound when a series of sheets are piled upon one another with interposed sheets of flexible material, when the pile is confined between iron plates; or generally to give form or shape to such compound by pressure; or to preserve, during the progress of vulcanization, the form previously imparted by pressure to the hard compound. *Poppenheusen v. N. Y. G. P. Comb Co.*, 2 Fisher, 78.—INGERSOLL, J.; N. Y., 1858.

2. But this patent granted the exclusive right to the use and application of tin-foil, or its equivalents, to the hard compound of india-rubber and gutta-percha, during the process of vulcanization, to preserve and retain, during

the process of heating and hardening, the forms and shapes given to the material, before the heating process commences, without any other pressure or moulds. *Ibid.*, 78.

3. And though tin-foil or any other flexible or pliable metal may have before been used in some way, in connection with such gums, if they were not substantially performing the same office in substantially the same way, they would not make this patent inoperative, or deprive the inventor of the right granted by it. *Ibid.*, 78.

4. On a motion for an attachment for violating an injunction restraining the use of the invention described in this patent, *Held*, that sheets of brass and tin, like roofing tin, were not the equivalent of tin-foil. *Poppenheusen v. N. Y. G. P. Comb Co.*, 2 Fisher, 83.—INGERSOLL, J.; N. Y., 1859.

5. But the reissued patent embraces the use and application of all metal plates that are sufficiently flexible to be used substantially in the manner described in the patent, and with substantially the same results that tin-foil could be used. *Poppenheusen v. Falke*, MS.—SHIPMAN, J.; N. Y., 1862.

IRREGULAR FORMS, TURNING.

BLANCHARD'S PATENT.

Issued September 6th, 1819.

Issued January 20th, 1820.

1. The patent was for a "machine for turning and cutting irregular forms," and the patentee in his specification declared that, "as to the mechanical powers by which the movements are obtained, he claims none of them as his invention. These movements may be effected by

application of various powers indifferently. Neither does he claim as his invention the cutter wheel or cutters, or friction wheel as such, nor the use of a model to guide the cutting instrument, as his invention. But he claims as his invention, the method or mode of operation in the abstract, explained in the second article, whereby the infinite variety of forms described in general terms, may be turned or wrought." In the second article was described not a mere function, but a machine of a particular structure, whose modes of operation are pointed out, to accomplish a particular purpose, function, or end.

Held, that his invention was for 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, and not for a principle or function detached from machinery. *Blanchard v. Sprague*, 3 Sumn., 536, 540; 2 Story, 166, 170.—STORY, J.; Mass., 1839.

2. It is immaterial whether the lateral motion was produced, as in Blanchard's machine, by a screw, or whether by a wheel or axle. *Blanchard's Gun-Stock Turning Fac. v. Warner*, 1 Blatchf., 278.—NELSON, J.; Ct., 1846.

3. It is also immaterial whether the cutter and friction wheels have the lateral motion, or the pattern and rough material, as the relative effect of the parts acting on each other is the same. *Ibid.*, 278.

4. The particular manner or process for throwing the machine out of gear, also formed no part of the invention. *Ibid.*, 278.

5. The objection that the specification claims that any article can be turned from a model, by the machine, whether larger or smaller, preserving the same

proportions, is not tenable, though the capacity of the machine may be limited. *Ibid.*, 279.

6. Though it was claimed that the machine would turn any irregular surface, but could not in fact turn a square shoulder, *Held*, the defect was too remote and extreme to affect the validity of the patent. *Ibid.*, 280.

7. The principle or inventive element to be found in Blanchard's machine, is the cutting or turning of any given article of an irregular form longitudinally and transversely, by one joint operation, by the combination of four instruments, the model, the rough material, the tracer or friction wheel, and the rotary cutter. *Blanchard v. Beers*, 2 Blatchf., 413.—NELSON, J.; Ct., 1852.

8. It embraces in its scope and operation the cutting of almost every species of irregular form, embracing any given extent of irregularity of form, by means of the application of the combination or principle which he has discovered. *Ibid.*, 415.

9. A person who uses Blanchard's machine, though only for the performance of one of its functions, as turning wagon spokes, is guilty of an infringement. *Ibid.*, 416.

Renewed Patent, under Act of June 30th, 1834.

The act was "an act to renew the patent of Thomas Blanchard," but the references in this act to the patent of Blanchard intended to be extended, did not agree with any of his previously existing patents.

Held, that the variances were such that the court could not correct them, or give validity to the patent issued under such act. *Blanchard v. Sprague*,

LEAD PIPE MACHINES.

3 Sumn., 279, 285, 286.—STORY, J.; Mass., 1838.

Renewed patent, under Act of February 6th, 1839.

1. The title of this act was as follows: "an act to amend and carry into effect the intention of an act entitled an act to renew the patent of Thomas Blanchard, approved June 30, 1834."

Held, that it was not unconstitutional, but could be sustained upon ordinary principles of construction. *Blanchard v. Sprague*, 2 Story, 171.—STORY, J.; Mass., 1839.

2. § 1 of the act of 1839 intended to give to assignees of the old patent an equally exclusive privilege in the extended term. *Blanchard's Gun-Stock Turning Factory v. Warner*, 1 Blatchf., 275.—NELSON, J.; Ct., 1846.

3. The act of 1839, extending Blanchard's patent, did not extend the mere legal right under the patent, but the exclusive right to the invention, and the specification was referred to only to identify the invention. *Ibid.*, 279.

LEAD PIPE MACHINES.

TATHAM'S PATENT.

Issued October 11th, 1844.

1. The patent was for an "improvement in the machinery for making pipes or tubes of lead, tin, and other metallic substances;" and the claims were 1st, "the long core or core-holder, formed and held stationary with relation to the dies, as described," and 2d, "the constructing the piston B, hollow, in the manner described, and the combination of the same with the long core or core holder, upon which the piston slides."

The *second* claim was the one in dispute.

Held, that the patent was for an improvement on the Burr machine, and that the improvement of the patentee enabled him to use a long core or core-holder, extending through the ram, and held stationary with relation to the dies by fixing it firmly at the crosshead of the frame, and by means of the hollow piston sliding upon the core-holder, the defect in the Burr machine of the unsteadiness of the core was got rid of, as was also the defect in the Hanson machine, of an imperfect union of the metal, because of the use of a bridge near the bottom of the cylinder, holding a short core—this bridge being dispensed with in the Tatham machine. *Tatham v. Le Roy*, 2 Blatchf., 482, 484.—NELSON, J.; N. Y., 1852.

2. The invention does not, however, consist in the combination of the hollow ram and the core or core-holder alone—cylinders sliding upon rods having previously existed in mechanical constructions and in practical use—but in adapting or applying this peculiar combination to producing a useful and practical result—the making lead pipe by pressure. *Ibid.*, 490, 491.

HANSON'S PATENT.—TATHAM, ASSIGNEE.

Issued March 29th, 1841.

Antedated August 31st, 1837.

Reissued March 14th, 1846.

1. The patent was for "improvements in machinery for making pipes or tubes of lead, etc.," and the claim was the combination of the core and bridge or guide-piece, the chamber and die, when used to form pipes of metal under heat and pressure in the manner set

LOCOMOTIVES, EXHAUST OF.

forth, or substantially the same; *Held*, that the invention did not consist in the novelty of the machinery employed, but in bringing a newly discovered principle into practical operation, by which a useful article of manufacture is produced, and wrought pipe made, as distinguished from cast pipe. *Le Roy v. Tatham*, MS.—NELSON, J.; N. Y., 1849.

2. The reissued patent of 1846, is for the same invention as the original patent. *Ibid.*

3. Decision in the case above, overruled, and held, that the claim was for the combination of machinery through which the new property of lead is developed, as a part of the process in the structure of lead pipe, and that the claim could not be sustained without establishing the novelty of the combination. *Le Roy v. Tatham*, 14 How., 177.—MCLEAN, J.; Sup. Ct., 1852.

4. The question, whether the newly developed property of lead—that while under heat and pressure in a close vessel, it would, after a separation of its parts, reunite perfectly—as used in the formation of pipes, might have been patented, if claimed as developed, without the invention of machinery, was not in the case. *Ibid.*, 177.

5. This patent further examined, and explained, and sustained. *Le Roy v. Tatham*, 22 How., 141.—MCLEAN, J.; Sup. Ct., 1859.

CORNELL'S PATENT.

Issued August 21st, 1847.

The patent was for an "improvement in lead pipe machinery," and the machine was also an improvement upon the Burr machine.

Held, the invention consists in boring the solid ram of Burr, and placing the die in the face of it, at the same time closing the bottom of Burr's cylinder, and fixing the core firmly at the bottom, where Burr's die was placed. The core extends through the cylinder and into the die thus fixed in the face of the ram. In the operation of the machine the core passes through the die and into the hollow ram nearly the length of it, the pipe passing through the same aperture above. *Tatham v. Le Roy*, 2 Blatchf., 484, 485.—NELSON, J.; N. Y., 1852.

LOCOMOTIVES, VARIABLE EXHAUST OF.

WINANS' PATENT.

Issued November 26th, 1840.

Extended November 26th, 1854.

1. The patent was for "an improvement in regulating the waste steam of locomotive engines," and the claim was for increasing or diminishing the force with which the waste steam enters the chimney at the pleasure of the engineer, by enlarging or contracting the orifices of the escape pipes, and thereby increasing or diminishing the draught of the chimney.

Held, that the idea conceived by the patentee and reduced to practical use, is the regulation of the exhaust steam, turned into the smoke chimney to increase the draught of the fire, according to the necessities of the operation of the locomotive—increasing the current of the steam and thereby the draught, when it is necessary to generate steam rapidly, and again diminishing it when so great a quantity is not necessary to accomplish the carrying of the load.

LOOMS.

Winans v. Danforth, MS.—NELSON, J.; N. Y., 1860.

2. And it makes no difference what may be the location of the machinery for regulation, whether at the bottom or midway in the smoke-stack, or in the chimney; the idea, operation, or effect being the same and the difference only in degree. *Ibid.*

LOOMS.

STONE'S PATENT.

Issued April 30th, 1829.

1. The patent was for "a new and useful improvement in looms," and the specification declared the improvement as consisting in the communication of motion from the reed to the yarn-beam, and in the connection of the one with the other, which is produced and described as follows: the claim was "the connection of the reed with the yarn-beam, and the communication of the motion from the one to the other, which may be done as specified."

Held, that the patentee's invention was limited to the specific machinery and mode of communication of the motion from the reed to the yarn-beam, set forth and specifically described. *Stone v. Sprague*, 1 Story, 270, 272.—STORY, J.; R. I., 1840.

2. If the patent included all other modes of communication of motion from the reed to the yarn-beam, and for the connection of the one to the other generally, it would be void, as being an attempt to maintain a patent for an abstract principle, or for all possible and probable modes whatsoever of such communication, though invented by others, and substantially differing from

MATCHES.

the mode described by the patentee. *Ibid.*, 272.

MATCHES, FRICTION.

PHILLIPS' PATENT.

Issued October 24th, 1836.

Extended September 11th, 1850.

1. The patent was for "a new and useful improvement in the manufacture of friction matches for the instantaneous production of light," and the specification set forth the making of friction matches by the use of phosphorus, chalk, and glue, without chlorate of potash and sulphuret of antimony, and stated that the proportion of the ingredients could be varied, and that gums could be used in place of glue, and other absorbent earths or materials instead of the carbonate of lime. The claim was for the use of a paste or composition, consisting of phosphorus, an earthy material, and a glutinous substance, without chlorate of potash, or sulphuret of antimony. *Held*, that the patent was not void, from vagueness, generality, or uncertainty. *Ryan v. Goodwin*, 3 Sumn., 517, 522.—STORY, J.; Mass., 1839.

2. The invention claimed by the patentee, consists in rejecting the two elements, chlorate of potash and sulphuret of antimony, and substituting in their place, chalk or some earthy matter. *Byam v. Farr*, 1 Curt., 262.—CURTIS, J.; Mass., 1852.

3. *Held* also, that the other claim, which consisted in sawing the matches in sheets, so as to leave them united at one end, and wrapping them in strips of paper, must be construed to embrace only the entire and complete mode de-

MILLSTONES, REGULATING. MOULDINGS, MAKING. NAILS, MAKING.

scribed, and that the use of a part of it, as sawing the matches as described, but without wrapping them in paper, was no infringement. *Ibid.*, 265.

3. The invention is not a compound of new ingredients, before unused in making matches, but simply and only a new combination of old materials before in use for that purpose. *Byam v. Eddy*, 2 Blatchf., 523.—PRENTISS, J.; Vt., 1853.

MILLSTONES, REGULATING, &c.

SMITH'S PATENT.

Issued September 25th, 1837.

1. The patent was for a "new, improved mode of grinding, holding, and accommodating millstones." The part claimed as new, was "connecting the bridge-tree with the top of the frame, or its substitute, in the manner described, and the mode or manner of elevating or depressing the running stone by the application of the screw to the bridge-tree in the manner described, or any other producing the effect." The improvement of the defendant consisted in the manner in which he constructed the part called the pressure rod, which is intended to elevate the bridge-tree, and consequently the running stone, and to regulate the action of the mill in that particular part.

Held, that the principle of elevating and lowering the upper stone, or runner, was that which was new, and which gave value to the machine, and that defendant's machine, though different in form, was the same in principle as to elevating and lowering the stone, and therefore an infringement.

Smith v. Pearce, 2 McLean, 179.—McLEAN, J.; Ohio, 1840.

MOULDINGS, MAKING.

SERRELL'S PATENT.

Issued May 16th, 1846.

Reissued January 7th, 1851

Reissued June 21st, 1853.

1. The patent was for "an improvement in machinery for making mouldings," and the object of the invention was to make mouldings on an angular piece of wood, effecting a great saving of material.

Held, that what was granted, among others, is the combination of the ring or rings, with a cutter or cutters, for operating on an angular strip for making mouldings, whether such angular strip be a *bevel* or an *angular* strip, whether the cutter or cutters be stationary or rotary, or both, and whether the cutter or cutters operate upon the face or the edge of the strip, or on both the face and edge, substantially as described. *Serrell v. Collins*, MS.—INGERSOLL, J.; N. Y., 1857.

2. This patent is not for yielding and fixed pressure, and feed rollers in combination with rotary and fixed cutters; but it is for the combination described for operating on an angular strip for making mouldings. *Ibid.*

NAILS, MANUFACTURE OF.

PERKINS' PATENT.

Issued February 14th, 1799.

1. The patent was for "an improvement in machinery for making nails," and the machine consisted of an upright and permanent jaw and a movable one, united by a pivot at the top; in each

PALM-LEAF, PREPARING. PAPER, MANUFACTURE OF.

jaw a cutter was fixed to nip the bar of iron to the size of the nail, and a gripping die to hold it until the head is made by a heading die, the power used being a lever of the first order.

Held, that the patent was not for the machine itself, which is composed of parts which have long become public property, but for an improvement in the art of making nails by means of a machine which cuts and heads the nails at one operation. It is not the grant of an abstract principle, nor of the different parts of any machine, but of an improvement applied to a particular use, effected by a combination of various mechanical powers to produce a new result. *Gray v. James*, Pet. C. C., 400.—WASHINGTON, J.; Pa., 1817.

2. And that a machine having two jaws pivoted below, and worked by a friction roller and a lever of the second order, the differences as to such roller and lever being the necessary consequences of the machine being invented, was an infringement on it. *Ibid.*, 399, 401.

PALM-LEAF, PREPARING.

SMITH'S PATENT.

Issued March 18th, 1841.

The patent was for a "new and useful improvement in the application of a material called palm-leaf, or brub grass, to the stuffing of beds, mattresses, sofas, cushions, and all other uses for which hair, feathers, moss, or other soft and elastic substances are used." The specification described preparing palm-leaf by a certain process and machinery for stuffing beds, mattresses, &c., but the same process and machinery had been used in preparing hair for similar purposes.

Held, that the patent was not for any new process, but merely applying an old process to a new material, and was not valid. *Howe v. Abbott*, 2 Story, 191, 192, 194.—STORY, J.; 1842.

PAPER, MANUFACTURE OF.

KNIGHT'S PATENT.

Issued September 25th, 1839.

The patent was for an "improvement in machinery for making paper," and the object of this machine was the completion of the process of manufacture by dyeing, consolidating, and *finishing*. It did this by employing a series of heated metallic cylinders, of which the heat is susceptible of graduation, and which were so arranged as that some of them shall be pressed upon by the others, with regulated degrees of pressure. The naked moist paper is made to pass alternately around and between these cylinders, and is thus progressively dried and consolidated by the heat and pressure which it derives from them through the successive stages of the process.

Held, that the principle of the combined machine is the repeated action of heat and pressure applied alternately and directly upon the material, in degrees adapted to its progressive character. The number of the cylinders, their exact relative position, their precise dimensions, and the fact that some of them may be made to revolve without actual contact, and the arrangement for graduating the heat and pressure are not essential. *Knight v. Gavit*, Mir. Pat. Off., 131.—KANE, J.; Pa., 1846.

PLANING MACHINES.

AMES' PATENT.

The patent was for a "new and useful improvement in machinery for making paper." The summary was as follows: "I do not claim the felting, vats, rollers, presses, wire-cloth, or *any separate* parts of the above-described machinery or apparatus, as my invention. What I claim is, the construction and use of the peculiar kind of cylinder described, and the several parts thereof in combination for the purposes aforesaid."

Held, that the patent was not for the cylinder and the several parts thereof, but its construction and use, in combination with the other parts of the machinery, for the purpose of making paper. *Ames v. Howard*, 1 Sumn., 483, 487.—STORY, J.; Mass., 1833.

PLANING MACHINES.

WOODWORTH'S PATENT.

Issued December 27th, 1828.

Extended November 16th, 1842.

Reissued July 8th, 1845.

Disclaimer as to the application of the circular saw, filed January 2d, 1843.

1. The patent was for a "new and useful improvement in the method of planing, tonguing, grooving, and cutting into mouldings, or either, plank, boards, or any other material, and for reducing the same to an equal width and thickness; and also for facing and dressing brick, and cutting mouldings, or facing metallic, mineral, or other substances;" and the claim was for the improvement and application of cutting or planing wheels to planing boards, &c.; also his improved method of cutters for grooving,

tonguing, and cutting mouldings, or facing brick, &c.; also the application of the circular saw in the manner described.

2. *Held*, that the extension to the administrator of the patentee was legally granted. *Brooks v. Bicknell*, 3 McLean, 259, 260.—McLEAN, J.; Ohio, 1843. [This view sustained in *Van Hook v. Scudder*, MS., N. Y., 1843; *Brooks v. Bicknell*, 3 McLean, 436, 1844; *Washburn v. Gould*, 3 Story, 133, 1844; *Woodworth v. Wilson*, 4 How., 716, 1845.]

3. The specifications of this patent describe the machine so as to enable a skilful mechanic to construct it. It contains nothing which an intelligent mind, though but little versed in mechanics, may not fully comprehend. The facts that the moving power is described in some of its parts in the alternative, and that the material, whether wood or iron, of construction is not stated, are not material. *Ibid.*, 260, 261.

4. The specifications show with reasonable certainty the combination of which the invention consists. *Brooks v. Bicknell*, 3 McLean, 445.—McLEAN, J.; Ohio, 1844.

5. The invention of Woodworth consists in the combination of certain known mechanical structures, by which boards are planed, tongued, and grooved in the same operation. *Ibid.*, 453.

6. The use of "pressure rollers" instead of a carriage to move the plank to the cutters, and the placing the plane irons on a wheel or arms of a shaft, and inclined so that the cutting edges generate a cone, instead of having the cutters on a cylinder, do not change the principle of the machine. *Ibid.*, 455.

7. The patent is for a mode of accomplishing a particular end by certain

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means; for an aggregate or improved machine. *Washburn v. Gould*, 3 Story, 146, 151, 158.—STORY, J.; Mass., 1844.

8. The renewed letters patent granted to William W. Woodworth, administrator, on the 8th of July, 1845, are good and valid in law, and are not void for uncertainty, ambiguity, or multiplicity of claim, or any other cause. *Wilson v. Rosseau*, 4 How., 688.—NELSON, J.; Sup. Ct., 1845.

9. William Woodworth is to be considered the original and first inventor of the planing machine, patented to him December 27th, 1828. *Woodworth v. Wilson*, 4 How., 716.—NELSON, J.; Sup. Ct., 1845.

10. Woodworth's specifications can only be sustained for a combination of known mechanical powers, and not for an improved machine. *Brooks v. Bicknell*, 4 McLean, 73, 74.—MCLEAN, J.; Ohio, 1845.

11. The *Andrews* machine, so called, which used a planing cylinder, but no tonguing or grooving wheels, and used a carriage instead of friction rollers to move the planks forward, such carriage being moved by an endless chain, and the planks being kept down on the carriage by springs adjusted on frame-work near the planing cylinder, was held, on a motion for an injunction, to be an infringement on Woodworth's patent. *Gibson v. Betts*, 1 Blatchf., 164.—NELSON, J.; N. Y., 1846.

12. The substitution in a planing machine of two smooth plates of iron, operated by a screw and a spring, to press down the board upon the moving platform, in the place of the pressure rollers used by Woodworth, is not a substantial departure from Woodworth's contrivance. *Gibson v. Harris*, 1

Blatchf., 170, 171.—NELSON, J.; N. Y., 1846.

13. The cone or disk-shaped wheel of the MacGregor machine is an equivalent for the planing cylinder used by Woodworth. *Sloat v. Plympton*, 4 West. Law Jour., 60.—KANE, J.; Pa., 1846.

14. The *MacGregor* machine, which has, in place of the cylinder carrying the knives, an obtuse or flattened cone or conically shaped wheel, the knives being in a plane inclined to the axis or shaft of the wheel, the change in action of the knives consisting simply in the knives passing over more of the surface to be planed, and cutting a part of the distance crosswise of the board, is an infringement of the Woodworth patent. *Van Hook v. Pendleton*, 1 Blatchf., 191.—BETTS, J.; N. Y., 1846.

15. The *Bicknell* machine, which had a planing wheel similar to that of the MacGregor machine, in he points in which the latter is claimed to be different from the Woodworth machine, was also held to be an infringement of Woodworth's patent. *Ibid.*, 192.

16. *Gay's* machine, which in construction was like the MacGregor machine, was also held to be an infringement of Woodworth's patent, on a motion for an injunction, by KANE, J.; Pa., *Ibid.*, 192.

17. The case of *Wilson v. Rosseau*, 4 How., 644, was founded on the amended specification of 1845 of Woodworth's patent, and it was held by the Supreme Court that the patents of 1828 and 1845 were both for the same invention. *Ibid.*, 194, 195.—NELSON, J.

18. The Supreme Court, in *Wilson v. Rosseau*, 4 How., 646, 1845, proceeded on the ground that the reissued patent of Woodworth, upon the surrender after the second extension, that by act of

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Congress was valid. *Woodworth v. Edwards*, 3 Wood. & Min., 127.—WOODBURY, J.; Mass., 1847.

19. The planing machine patented to Brown, of Vermont, in November, 1845, was held, in a suit brought against the patentee in Vermont, to be substantially like Woodworth's, and its use restrained by injunction. *Woodworth v. Rogers*, 3 Wood. & Min., 142.—WOODBURY, J.; Mass., 1847.

20. The former decisions as to the Woodworth patent, in respect to the novelty of the invention, and whether Woodworth was the first and original inventor; and as to the surrender of the patent and its reissue of the 8th July, 1845, with an amended specification; and as to the identity of the invention covered by the original and reissued patents approved and reaffirmed. *Gibson v. Gifford*, 1 Blatchf., 530.—NELSON, J.; N. Y., 1850.

21. Rotary guides, so arranged and adjusted as to press, by means of weights against the edges of the board while it is undergoing the operation of the plane or cutter, and such guides being placed obliquely somewhat to the motion of the board, so that their position produces, as they revolve against the edges, a constant tendency to keep the board to its bed (as patented in 1849 to Levy, assignee of Knowles), are but an *analogous device* for the *pressure* rollers of Woodworth's patent, which act upon the face of the board. Both are used for the same purpose, and lead to the same result, though arranged and adjusted by a somewhat different mechanical contrivance—the only difference being the application of the pressure to a different part of the board. *Gibson v. Van Dressar*, 1 Blatchf., 534, 535.—NELSON, J.; N. Y., 1850.

22. The use of a revolving cutter-wheel—as also patented to said Levy—having offsets or bevels near its outer periphery, to allow a board thicker than the finished work is intended to be to enter between the edge of the wheel and the face of the bench, is only a colorable imitation of the rotary cutters of Woodworth. *Ibid.*, 535, 536.

23. Woodworth's patent is not for an organized machine, containing parts performing certain functions, and producing certain results, irrespective of the particular instrumentalities so operating, but it is clearly for a combination only. *Brooks v. Fiske*, MS.—SPRAGUE, J.; Mass., 1851.

24. Woodworth's machine is an improvement on the Hill machine, and the only change made by Woodworth consists in placing the rotating cylinder, which, in Hill's machine, was in a fixed position below the bed, in a fixed position above the bed. This arrangement gave to the pressure roller, in addition to its function of keeping the board down upon the bed, the function, performed by the bed in Hill's machine, of keeping the board from being drawn into the axis of the cutter. The effect of such arrangement is to plane the board on the upper instead of the under side, and the result is, that the board comes out of an uniform thickness, which was not accomplished by Hill. *Ibid.*

25. In the Norcross machine, the arrangement of the pressure roller, bed-piece, and cutter, is the same as Hill's; his improvement consists in making the cutting cylinder move vertically, and connecting it with his rest or pressure roller, so that the distance between them is always the same, and the board thereby reduced to a uniform thickness. *Ibid.*

26. The Hill machine did not reduce the board to a uniform thickness. Woodworth attained such a result by his improvement. Norcross accomplished the same purpose, but by a different arrangement than that invented by Woodworth. *Ibid.*

27. Norcross' machine is not an infringement of Woodworth's patent. *Ibid.*

28. The planing machines of Ashton & Winslow, and of Ashton & Beers, are essentially the same as Woodworth's—and the tonguing and grooving apparatus of those machines, and of the Snowden machine, are the same as those used by Woodworth. *Sloat v. Patton*, 24 Jour. Fr. Inst., 3d Ser., 26, 27.—KANE, J.; Pa., 1852.

29. The invention relied on in Woodworth's patent, is a new combination of three elements to produce the result of planing a plank against its motion through the machine; the claim of monopoly is the employment of rotary planes in combination with the face of a bench and pressure rollers, to prevent the board from being drawn up by the planes when cutting upward, or from the reduced or planed to the unplaned surface. *Brooks v. Fiske*, 15 How., 217.—CATRON, J.; Sup. Ct., 1853.

30. Norcross' planing machine, patented February 12th, 1840, for an improvement on the Hill machine, cannot be considered an infringement on Woodworth's machine, but is an independent invention. *Ibid.*, 222. McLEAN, WAYNE, and NELSON, JJ., dissenting.

31. The machine patented July 16th, 1839, to James H. Hutchinson, is an infringement upon Woodworth's patent. *Livingston v. Woodworth*, 15 How., 555.—DANIEL, J.; Sup. Ct., 1853.

PLOUGHS.

DAVIS' PATENT.

Issued October 1st, 1825.

This patent was for certain "improvements in the construction of mould-boards of ploughs." The specification set forth, that instead of working the moulding part or face of the mould-board to straight lines, the improvement was to work it to circular or spheric lines, and that the circle or segment extending from the points of the share and inclining to the back part of the mould-board, should have *about* three times the radius of certain described smaller segments, and then proceeded: "This being thus worked off uniformly, forms a section of a loxodromic or spiral curve, and when applied to practice is found to fit or embrace every part of the furrow slice far more than any other shaped plough."

Held, that the patent must be construed, not as extending to every mould-board worked by circular or spheric lines, however those lines may cross each other, and whatever may be their relative proportions, and whose face forms a section of a loxodromic or spiral curve, but as applying only to mould-boards, conforming to the particular description contained in the specification, and of the precise and definite shape prescribed, and worked out by segments of circles of the exact form and proportions mentioned; and that in construing the specification, the word *about* must be disregarded, and the patent be restricted to the mould-board as described, independent of that word. *Davis v. Palmer*, 2 Brock., 305-308.—MARSHALL, Ch. J.; Va., 1827.

PROUTY & MEAR'S PATENT.

Issued March 4th, 1836.

1. The patent was for "a new and useful improvement in the construction of the plough," and the claim was for a combination of three things: 1st. The inclining the standard, and land-side, so as to form an acute angle with the plane of the share; 2d. The placing the beam on a line parallel to the land-side within the body of the plough, and its centre nearly in the perpendicular of the centre of resistance; and 3d. The forming the top of the standard for brace and draught.

Held, that the patent was for a combination, and a combination only. The use of one or more of the parts less than the whole, is no infringement. *Prouty v. Draper*, 1 Story, 571.—STORY, J.; Mass., 1841.

2. The extension of the standard, and the jogging it into the beam, are claimed as material parts of the plaintiff's improvement; in forming the top of the standard for brace and draught. *Prouty v. Ruggles*, 16 Pet., 340.—TANEY, Ch. J.; Sup. Ct., 1842.

PUDDLE BALLS, ROLLING.

BURDEN'S PATENT.

Issued December 10th, 1840.

1. The patent was for "a machine used in the manufacture of iron, commonly called a squeezer, and used for converting puddler's balls into blooms, in rolling mills, and rolled the balls between reciprocating plates or tables, or between a revolving cylinder and a sta-

tionary segmental trough, with stationary flanges."

Held, that the patent was for a new process, mode, or method, of converting puddler's balls into blooms, by continuous pressure and rotation between converging surfaces. *Burden v. Corning*, MS.—NELSON, J.; N. Y., 1850. [Contra, *post* 2.]

2. The letters patent are not for a new process, mode, or method of converting puddler's balls into blooms, but for the machine described by him. The patent does not secure the exclusive right to construct, use, and vend, any machine adapted to accomplish the objects of his invention, by the process, mode, or method described. *Corning v. Burden*, 15 How., 267, 270.—GRIER, J.; Sup. Ct., 1853.

RAILS FOR RAILROAD CARRIAGES.

STIMPSON'S PATENT.

Issued August 23d, 1831.

The patent was for "a new and useful improvement in the mode of forming and using cast or wrought iron plates or rails for railroad carriage wheels to run upon, more especially for those to be used on the streets of cities, on wharves and elsewhere," and the claim was for the employment of plates or rails having narrow grooves on each side of the track for the flanges of the car-wheels to run in, so as to be adapted to the unobstructed passing over them of the various kinds of common carriages.

Held, the combination claimed by the patentee as his improvement, consists of the use of grooves on both sides of a railway track, in which grooves only the flanges of car-wheels are to run, and

ROCKING CHAIRS. SADDLES. SAW MILLS, CIRCULAR.

which are to be too narrow to admit the wheels of carriages having the most slender rims or felloes; and the whole of this combination or mechanism, is to be depressed to a plane exactly corresponding with that of the street in which it may be introduced. *Stimpson v. Balt. & Sus. R. R. Co.*, 10 How., 344.—WAYNE, J.; Sup. Ct., 1850.

ROCKING CHAIRS.

BEAN'S PATENT.

Issued March 30th, 1840.

The patent was for "a new and useful improvement in the rocking chair," and the specification set forth that the principal features of the invention consisted in making the stool and seat of the chair in two parts, and causing the seat to rock on the top of the stool, thus doing away with long rockers, and rendering the back of the chair susceptible of being fixed in a reclining position at any desired angle; but it was shown that the same apparatus had been before applied, if not to chairs, at least in other machines, to purposes of a similar nature.

Held, that the invention, at most, was an old invention, apparatus or machinery applied to a new purpose, and that the patent was invalid. *Bean v. Smallwood*, 2 Story, 411.—STORY, J.; Mass., 1843.

SADDLES.

DIXON'S PATENT.

Issued July 16th, 1849.

The patent was for "an improvement in manufacturing men and women's saddles without saddletrees," but the pat-

entee did not distinguish what was new from what was old and before in use, nor point out in what particulars his improvement consisted; *Held*, that the patent was therefore void. *Dixon v. Moyer*, 4 Wash., 69, 73.—WASHINGTON, J.; Pa., 1821.

SAW-MILLS, CIRCULAR.

NORCROSS' PATENT.

Issued January 15th, 1850.

The patent was for an "improvement in circular saw-mills." The invention was for suspending the saw, so it could have lateral vibration, which was accomplished by supporting the boxes in which the journals of the arbor run, upon standards, to which the boxes were jointed, and being themselves jointed to their foundation, so that the arbor was kept horizontal, while it was allowed sufficient lateral play, and when thrown out of line it would recover itself by the action of the driving belt, which was effected by passing the belt up over a driving pulley above, thus holding the frame up to the proper point, so that the saw was actually suspended by the belt, while it was kept steady and made to move properly by the frame below.

Held by the court, that the patent was not for the two improvements—1st, permitting the lateral motion of the saw mandril or arbor, by the device of the rocker boxes, and swing frame; and 2d, restoring the saw to line by the elasticity of the belt acting as a reacting agent—separately, but for the combination of the two, and that the use of a metallic spring instead of the swing

SAW MILLS, PORTABLE.

frame, to deflect the saw into line, was not an infringement. *Lee v. Blandy*, 2 Fisher, 93.—LEAVITT, J.; Ohio, 1860.

SAW-MILLS, PORTABLE, CIRCULAR.

PAGE'S PATENT.

Issued July 16th, 1841.
Extended July 17th, 1855.

1. The invention was for an "improvement in portable, circular saw-mills," combining free end play of the saw mandril with guide rollers at the periphery.

Held, that the patent was for the combination of end play of the saw shaft with guide rollers at the periphery, and covered the use of guide pins instead of rollers, if they were used for the same purpose. And that it did not evade the patent to employ a collar or shoulder on the shaft, if there was still sufficient free end play or lateral action of the saw arbor to accomplish the sawing successfully. *Page v. Georgia*, MS.—HALL, J.; N. Y., 1856.

2. The patent is for a manner of affixing and guiding a circular saw by allowing end play to its shaft, in combination with the means of guiding it by friction rollers near its periphery, so as to leave its centre entirely unchecked laterally; *Held*, that the improvement comprehended by the patent was the freedom of revolution of the saw, at its centre, entirely unchecked laterally, used in combination with the friction rollers, embracing the periphery of the saw. *Page v. Ferry*, 1 Fisher, 303.—WILKINS, J.; Mich., 1857.

3. Or, the patent of the plaintiff covers merely a combination of the use of rollers, or their equivalents, with a saw

SEWING MACHINES.

that has no check to its lateral motion, at the centre, but has free end play, so as not in any case to have an end bearing against a shoulder in its ordinary revolutions. *Ibid.*, 303.

4. The claim is for the precise organization described, the manner of affixing and guiding the circular saw by allowing end play to the shaft, in combination with the means of guiding it by friction rollers, embracing it near to its periphery, so as to leave its centre entirely unchecked laterally. *Phillips v. Page*, 24 How., 167.—NELSON, J.; Sup. Ct., 1860.

5. It having been shown that mills of like construction had been used for sawing shingles; *Held*, that the patent could not be sustained, because of its application to the sawing of ordinary logs in a saw-mill. *Ibid.*, 166, 167.

SEWING MACHINES.

HOWE'S PATENT.

Issued September 10th, 1846.
Extended September 16th, 1860.

1. The original patent embraced five claims. The first claim of this patent was for "the forming of the seam by carrying a thread through the cloth by means of a curved needle on the end of a vibrating arm, and the passing of a shuttle furnished with a bobbin, in the manner set forth, between the needle and its thread, under a combination and arrangement of parts substantially the same with that described."

Held by the court, that the real claim is for the means by which the result, the forming of a seam, is reached, namely, by carrying a thread through the cloth, by means of the needle at the end of

a vibrating arm, and then carrying the shuttle with its bobbin between the needle and its thread, under a combination and arrangement of parts substantially as described. *Howe v. Morton*, 13 Mo. Law Rep.—SPRAGUE, J.; Mass., 1860.

2. The claim may be considered as for the general combination and arrangement of the parts described in the specification, embracing the mechanism for forming the stitch; the mechanism consisting of two stationary holding surfaces, for holding the material to be sewed; and a mechanism for feeding the cloth—which consists of a piece of metal with points projecting, which take hold of the cloth and then by mechanism carries the cloth with it between the two stationary surfaces, and which surfaces aid in keeping the cloth in place while it is fed. *Ibid.*

3. These holding surfaces also aid in making the stitch, by successively resisting the thrust and retraction of the needle, and keeping the cloth in position, and exactly in the line where it should be, so that the stitch is sure to be made in the proper place. *Ibid.*

4. The eye-pointed needle was not Howe's invention, having been described before his invention. *Ibid.*

5. Fisher & Gibbon's machine, patented in England in December, 1844—the specification of which was enrolled in June, 1845—contained a mechanism by which one thread was carried by a needle through the material, and then another thread was carried by a shuttle between the needle and its thread; but as Howe's invention was as early as the middle of May, 1845, before the enrolling of their specification in June, 1845, their invention was not patented, within the meaning of §§ 7 and 15 of

the act of 1836, until *after* Howe's invention, and Howe became entitled to a patent under § 9 of the act of 1839. *Ibid.*

JOHNSON'S PATENT.

Issued March 7th, 1854.

The patent was for an "improvement in sewing machines," and the part of the patent under consideration was the third claim:—the feeding of the material to be sewed by means of a vibrating piercing instrument—either the needle itself, or some other instrument in the immediate vicinity thereof—substantially as described.

Held by the court, that the patent was not for a result, or for an abstract idea or principle, but was for a means or mechanism to accomplish a certain end. The use of the piercing instrument to feed the cloth, and its use substantially in the manner described—both go to constitute the invention of the patentee. The use of either of the two, and not the other, is no infringement. *Johnson v. Root*, 1 Fisher, 355, 356.—SPRAGUE, J.; Mass., 1858.

SINGER'S PATENT.

Issued August 12th, 1851.

Reissued October 3d, 1854.

1. The first claim was for giving the shuttle an additional forward movement, after it had been stopped to close the loop, for the purpose of drawing the stitch tight, when such additional movement is given at and in combination with the feed motion in the reverse direction, and the final upward movement of the needle, so that the threads shall be drawn tight at the same time.

Held, that this claim was for the com-

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bination of the mechanism described, by means of which three pulls are given simultaneously to tighten the stitch; and that the patent did not cover the result attained, but the particular combination of mechanism producing the result. *Singer v. Walmsley*, 1 Fisher, 579.—GILES, J.; Md., 1859.

2. The second claim of such patent is for the invention of a friction pad placed between the seam and the bobbin, to make a slight pressure on the thread to prevent the formation of a loop above the cloth, but not sufficient to prevent the needle drawing the thread through the cloth to make the loop below it. *Ibid.*, 579.

3. The third claim is for the combination of an adjustable arm carrying the bobbin or spool, with an eye or guide, attached to and moving with the needle carrier, and through which the thread passes, so that by changing the angle of such arm any desired length of thread can be given for the formation of the loop. *Ibid.*, 579.

4. The fourth claim is for the combination (for feeding the cloth) of the friction of the surface of the periphery of the feed wheel with the spring pressure plate or pad, which grips the thing to be sewed, against the feeding surface; the surface of the feed wheel having a fine thread or parallel groove cut therein, to enable it to perform its office in combination with the pressure plate, instead of being armed with pins. *Ibid.*, 579, 580.

5. The sewing machines of Ladd, Webster & Co., of Boston, are not an infringement on this patent. *Ibid.*, 586.

SINGER'S PATENT.

Issued April 13th, 1852.

This patent is for the invention of an

improvement in the friction pad, where by the thread is saved from the chafing it would otherwise be liable to, by substituting for it a cut-off friction pad, which alternately seizes and releases the thread at proper intervals, so as to cause the pad to press upon the thread when required, and then to be released, while the needle is passing through the cloth. *Singer v. Walmsley*, 1 Fisher, 580.—GILES, J.; Md., 1859.

SINGER'S PATENT.

Issued May 30th, 1854.

This patent is for the combination of the following mechanical devices: *First*, A spring arm guide, through which the thread passes from the tension to the needle. *Second*, The needle carrier, forcing up the spring arm guide to the limit fixed for it. *Third*, A fixed bridle, limiting the upward movement of the spring arm guide. And *Fourth*, A movable bridle to force down the guide to give the required amount of slack thread for the formation of the loop; the carrier forcing up the spring arm guide to the limit governed by the fixed bridle, and the movable bridle forcing it down again, to make the slack thread, these motions being independent of the thread or any contingency affecting it. *Singer v. Walmsley*, 1 Fisher, 580.—GILES, J.; Md., 1859.

SINGER'S PATENT.

Issued November 4th, 1856.

1. The second claim of this patent is for the combination of a horizontal table with the feed apparatus—the operative part of the feed wheel projecting through the table, and acting on the

under surface of the material to be sewed, while the table answers the purpose of stripping the material from the feed wheel and to cover and protect the mechanism which operates it. *Singer v. Walmsley*, 1 Fisher, 580, 581.—GILES, J.; Md., 1859.

2. The third claim is for imparting the feeding motion to the feed wheel, for spacing the stitches, by gripping the periphery by a gripping lever, in contradistinction to the action of a pawl on a ratchet, whereby the extent of the feeding motion may be adjusted and varied to any degree, instead of being restricted by the size of the ratchet teeth. *Ib.*, 581.

3. The fourth claim is for a combination of a feeder with a presser attached to a slide, which keeps the plane of its under surface always in the same relation to the plane of the table, thereby avoiding the inequality of pressure which takes place when the presser is on an arm working on a fulcrum or hinge joint. *Ibid.*, 581.

A. B. WILSON'S PATENTS.

Issued November 12th, 1850.

Reissued January 22d, 1856, and divided into two patents known as Reissues Nos. 345, 346.

No. 345 reissued December 9th, 1856, and known as Reissue No. 414.

Reissue No. 346.

1. This patent embraces four claims. 1. For the method described of causing the cloth to progress regularly by the joint action of the surfaces between which it is clasped, and which act in conjunction in the manner and for the purposes mentioned, that is, in a regular intermittent progress of the cloth, by the means described, so that the cloth, while grasped by the surfaces, could be turned as it had before been turned when

it had been advanced by the hand of the operator, and the purpose was to secure a regularity of stitch and also that the seams might be sewed of any considerable degree of curvature. 2. For the method of holding the cloth at rest by the needle, as described, in combination with the method described of causing it to progress regularly. 3. So arranging the feeding surfaces that they, or one of them, should also perform the office of stripping the cloth from the needle as it rises. And 4. For mounting or attaching one of the feeding surfaces, so that it could be removed or drawn away from the other at pleasure, to effect the objects set forth. The second claim was admitted to be valid, but the others were disputed. *Potter v. Holland*, 4 Blatchf., 241.—INGERSOLL, J.; Ct., 1858.

2. *Held*, that the devices or means specified in the first claim were sufficient to cause the cloth to progress regularly, merely by the joint instrumentality of the two feeding surfaces, between which it is clasped, and without the aid of the needle or any other instrumentality, and that the patent was not invalid, because a useful result was not produced by the means specified. *Potter v. Holland*, *Ibid.*, 246, 247.

3. The third claim was for giving one of the feeding surfaces the additional function of a stripper; *Held*, as to this, that the mode of arranging the feeding surfaces, as pointed out, so that they, or one of them, in addition to the office which they performed as acting as a feeder, should also perform the office of a stripper, was new, and was not known before such invention, and therefore the grant of right in that patent for such arrangement was valid. *Ibid.*, 248.

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4. But such grant will not prevent any one from using any stripper which was known and in use prior to the invention of Wilson. *Ibid.*, 248.

5. The fourth claim was claimed to be invalid for the reason that it required no invention; *Held*, that the device mentioned in the fourth claim was new, as well as useful, and had a sufficient amount of invention to authorize a patent. *Ibid.*, 249.

6. The leading original idea of Wilson is the substitution of the two surfaces between which the cloth is clasped or held, for the baster-plate of previous machines, and so arranging these two surfaces that one of them, by an automatic intermittent motion of one or both, would advance the cloth to the needle, and at the same time admit of its being turned by the hand, so as to sew curved seams. *Potter v. Wilson*, 2 Fisher, 111.—NELSON, J.; N. Y., 1860.

7. This conception is capable of being embodied in a working machine in various modes and forms; but so long as the inventor's ideas are found in the construction and arrangement, no matter what may be its form or shape or appearance, the party using it is appropriating his invention, and is an infringer. *Ibid.*, 111, 112.

8. All the several claims rest upon and grow out of the main improvement in the feeding apparatus, and this device being novel, these dependent combinations and devices may well be maintained. *Ibid.*, 111.

Reissue No. 414.

1. What is patented by the patent No. 414 is a sewing machine, having in combination the three elements of a table or platform to support the material

to be sewed; a sewing mechanism proper; and a mechanical automatic feed. The only element claimed as new is the mechanical feed automatic, by which the cloth is made to progress regularly to be sewed, and to which the cloth is not attached. *Potter v. Holland*, 4 Blatchf., 243.—INGERSOLL, J.; Ct., 1858.

2. There had before been known and in use a sewing machine having in combination the three elements of a table or platform, a sewing apparatus, and a feed motion. It was claimed that although the patentee had invented a new feed motion, that he could not patent the combination in a single machine, of the elements of the table and sewing mechanism, which constituted two of the elements of the old combination, and his new mechanical feed, but that he could only patent his improvement on the feed motion;

Held, that as the mechanical automatic feed of Wilson was a new invention, never having before been known, was a new mechanical automatic feed, and was an improvement on the old feed only in the sense that any new and useful mechanical device to accomplish a given purpose is an improvement on other known mechanical devices to accomplish the same object. *Ibid.*, 244.

3. And that as such new mechanical automatic feed of the patentee was not to be used in conjunction with, or in aid of, or in addition to the old feed, but was independent of it, and dispensed with it, and discarded it, that it was an entire new device, and was a new and independent element in the combination patented to him, and that therefore it must be held that the machine containing the combination of elements patented to him was a new and different machine from the machine containing

SOWING SEED.

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the combination of old elements known before his invention. *Ibid.*, 245.

A. B. WILSON'S PATENT.

(Fitzgerald Patent.)

Issued December 19th, 1854.

This patent is an improvement on the feed motion embraced in reissues Nos. 346, 414. The surface, moving the cloth to the needle, is caused to drop from the cloth, on its return to again seize it, and advance it for another stitch. The effect is, to free the cloth from the surface in its return, with a view again to advance it. The novelty of the invention was disputed. *Held*, from the evidence, that Wilson was the first inventor of the improvement described. *Grover & Baker Sew. Mach. Co. v. Sloat*, 2 Fisher, 114.—NELSON, J.; N. Y., 1860.

SOWING SEED.

CAHOON'S PATENT.

Issued September 1st, 1857.

Reissued May 17th, 1858.

1. The patent was for an "improvement in seeding machines," and the object of the invention was to sow seed broadcast as the machine was drawn along. The reissued patent had four claims.

Held, that the improvements covered by the first claim of the patent are, 1st. A tubular chamber or discharger rotating rapidly on a horizontal axis, having its edge in a plane, vertical, or nearly so, to the horizon, and operating by centrifugal force generated by the revolution of the chamber, to throw out the seed in a plane of discharge, vertical or nearly so to the horizon, and perpendic-

ular to the line of travel of the machine. *Cahoon v. Ring*, 1 Fisher, 403.—CLIFFORD, J.; Me., 1859.

2. The improvement described in the second claim consists of a funnel or conical-shaped discharging chamber, having flanches to arrest the seed and prevent its dropping upon the ground, and assist to carry it round the axis of revolution and accelerate its centrifugal force. *Ibid.*, 404.

3. The third improvement consists of a disk or plate of metal, or its equivalent, placed in front of and combined with the centrifugal discharger, to prevent the entrance of currents of air into the discharger, which might interfere with the proper distribution of the seed, by blowing it out of its proper position while it is still in the chamber. *Id.*, 405.

4. The improvement covered by the fourth claim consists of a hopper to hold a supply of seed, and deliver it to the discharger, such hopper being combined with the discharger, and having a stirrer to stir the grain, and a gate at its mouth to regulate the quantity of grain that will pass out and be sown. *Ibid.*, 406.

5. *Held*, also, that the seeding machine patented to Aaron Ring, March 2d, 1857, was an infringement on the patent of Cahoon. *Ibid.*, 423.

STEAM-ENGINES.

SICKLES' PATENT.

Issued September 19th, 1846.

1. The patent was for an "improvement in steam-engines, in connecting the cylinder and steam-chest." The claim was not simply for casting the steam-chest with the cylinder, or with the cylinder bottom and condenser, but for the

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method of casting them together as described.

Held, that what was secured to the patentee by this patent was, *first*, the casting the steam-chest with the cylinder, by making the sides of the steam-chests the sides of the cylinder, in combination with the manner of fitting the cylinder head and the lower end of the cylinder to the chests as described, and the mode of making the attachments without the continuation of the flanches, when the condenser is not on a line of the cylinder and distinct therefrom. *Sickles v. The Pacific Mail Steamship Company*, MS.—INGERSOLL, J.; N. Y., 1857.

2. And *second*, when the condenser is on a line with the cylinder, and near to it, the casting one steam-chest with the cylinder, and the other with the cylinder bottom and condenser, by making the side of one steam-chest the side of the cylinder, and the side of the other steam-chest the side of the condenser, in combination with the manner of fitting the cylinder head and the lower end of the cylinder to the chests as described, and the mode of making the attachments as described, when one steam-chest is so cast on the cylinder and the other on the condenser. *Ibid.*

STEAM GENERATORS.

LATTA'S PATENT.

Issued April 10th, 1855.

1. The patent was for an "improvement in steam generators," and the invention claimed was for a mode of feeding a coiled tubular boiler, by means of a hand pump, so as to throw water upon pipes already heated, and thus generate

steam suddenly. In connection with the hand pump was described a "water box," or open water vessel, so as to enable the engineer to see the water going in, though its place could be supplied by any thing that will give motion to some mechanical contrivance. This water box the defendant did not use, and claimed that the plaintiff's patent was for a combination, which was not infringed by a use of less than all its parts.

Held, by the court, that the patent was for a combination, but that it was a question for the jury whether the water box was an essential element of the combination, and that the defendant could not evade the patent by not using a part not material. *Latta v. Shawk*, 1 Fisher, 471.—LEAVITT, J.; Ohio, 1859.

2. The jury found it was not a material part of the combination, and judgment was for the plaintiff. *Ibid.*, 472.

STOVES, COOKING.

BUCK'S PATENT.

Issued May 20th, 1839.

1. This patent was for "improvements in the construction of stoves, for cooking," and the claim was "the extending of the oven under the apron or open hearth of the stove, and in the combination thereof with the flues constructed as specified," that is, reverberating flues, so called, and a front flue, between the front plate of the stove and the front plate of the oven.

Held, that the invention was the combination of the extension of the oven under the hearth of the stove, and the reverberating flues, with the flue in front, formed by the front plates. *Buck v. Hermance*, 1 Blatchf., 400, 402.—NELSON, J.; N. Y., 1849.

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Held, also, that though the combination of the extended oven and the reverberating flues, that is, the side and centre flues, was old, the bringing into connection with such old combination the flue in front, made a new and a patentable combination. *Ibid.*, 403. .

2. The claim of Buck is for the flues described—reverberating flues—in combination with the extended oven. *Buck v. Gill*, 4 McLean, 176.—McLEAN, J.; Ohio, 1846.

FOOTE'S PATENT.

Issued May 26th, 1842.

1. The patent was for "a new and useful mode of regulating the heat of stoves and other structures for fires," and the claim was for the application of the expansive and contracting power of a metallic rod by different degrees of heat, to open and close a damper which governs the admission of air into a stove or other structure, by which a more perfect control over the heat is obtained than can be by a damper in a flue; and also the mode described of setting the heat of a stove at any requisite degree, by which different degrees of expansion are requisite to open or close the damper.

Held, that the substance of the discovery as claimed by the patentee and secured to him by his patent, is the application of the principle of the contraction and expansion of a metallic rod, by the use of certain mechanical contrivances described and set forth, to the cast or sheet-iron stove in common use, by which means he produces a self-regulating power over the heat of the same, at any given degree of heat that may be desired within the capacity of

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the stove. *Foote v. Silsby*, 1 Blatchf., 463.—NELSON, J.; N. Y., 1849.

2. The first claim, "the application of the expansive and contracting power of a metallic rod, by different degrees of heat, to open and close a damper which governs the admission of air into a stove," is not for a discovery of a natural property of the metallic rod, which of itself, is not a patentable subject, but for a new application of it by means of mechanical contrivances, which is one of the commonest subjects of a patent. *Ibid.*, 464.

3. The claim in this patent in reference to regulating the heat of a stove by the expansive and contracting power of a metallic rod, is one independent of any particular arrangement or combination of machinery; and the inventor has a right to use any means, old or new, in the application of the new property to produce the new and useful result. *Foote v. Silsby*, 2 Blatchf., 263, 264.—NELSON, J.; N. Y., 1851.

4. This patent, on appeal to the Supreme Court held to be valid. *Silsby v. Foote*, 20 How., 385.—NELSON, J.; Sup. Ct., 1857.

STRAW-CUTTER.

HOVEY'S PATENT.

Issued February 12th, 1844.

This patent was for an "improvement in straw-cutters," and the claim was for a cylinder "having any number of arms around it, to which adjustable knives are affixed, constructed as described, in combination with the roller against which they cut, in the manner and for the purpose set forth."

Held, that the patent was for a new

combination, which was good, unless all the parts had been known in such combination. *Hovey v. Henry*, 3 West. Law Jour., 154.—WOODBURY, J.; Mass., 1845.

TAILORS' SHEARS.

HEINRICH'S PATENT.

Issued February 27th, 1839.

The patent was for "an improvement in tailor's shears," and the invention claimed consisted of three things. 1st, the projection at the point of the beak, on the upper bow. 2d, the addition of a convex protuberance or swelling on the right side of the upper and lower bows to fill the palm of the hands; and 3d, a concave lip on the left side of the upper bow, for the thumb to rest upon. The improvement enabled a person to hold the shears with a firmer grasp.

Held, that the invention did not consist in a resting point for the handles so as to avoid a strain upon the joint of the shears, as that had been done in many ways. But the invention consists in the beak, by which such old result is produced by new means. *Heinrich v. Luther*, 6 McLean, 346, 348.—MCLEAN, J.; Ohio, 1855.

THREAD, PACKING, &c.

LANGDON'S PATENT.

Issued June 20th, 1821.

The patent was "for an improvement in preparing and packing cotton and other threads, and floss cotton for retailing," and the specification set forth the improvement as consisting "in folding the thread and floss cotton into

skeins or hanks of a convenient quantity for retailing, with a sealed wrapper round the same, and a label containing the number and description of the article."

Held, that the patent was void because the invention was not a useful one within the meaning of the patent law. *Langdon v. De Groot*, 1 Paine, 204, 206.—LIVINGSTON, J.; N. Y., 1822.

VALVES FOR GOVERNORS.

JUDSON'S PATENT.

Issued November 5th, 1850.

Reissued January 10th, 1854.

1. This patent was for an "improved valve for governors," and the object of the invention was an improvement in the valve, by which an increase or decrease in the motion of an engine is effected, without any disturbance, or as little as practicable.

Held, that the invention was for an improvement and was not for a combination, and that the right secured by the patent was for the making an opening or openings controlled by the governor valves of steam-engines of gradually increasing capacities from the closed to the open position: but such openings, while gradual or regular, are not necessarily in geometrical or arithmetical progression. *Judson v. Moore*, 1 Fisher, 549, 550.—LEAVELL, J.; Ohio, 1860.

2. The principle of a gradual opening, through all the range of motion, is the distinct characteristic of Judson's invention. *Ibid.*, 556.

3. The patent is for a distinct and independent improvement, and not for a combination. The claim is for an improved valve, and that valve to operate

VALVES, LIFTING, AND TRIPPING.

in connection with a governor; and there is no claim of an invention disconnected from the governor. The distinguishing characteristic of the valve is, that the openings should be produced upon the principle of graduation, controlled by the governor, so that the engine shall be governed with uniformity in any state of steam in the boiler, and accommodate itself to any degree of pressure or labor that can be thrown upon it. *Judson v. Cope*, 1 Fisher, 622.—LEAVITT, J.; Ohio, 1860.

VALVES, LIFTING, AND TRIPPING.

SICKLES' PATENT.

Issued May 20th, 1842.

1. This patent was for "apparatus for lifting and regulating the closing of the valves of steam-engines," and the subject matter of his improvement was the puppet valve acted on in the usual way, connected with a valve stem, and raised by a lifter.

Held, that the patentee was the first inventor of the improved machinery described in his patent, for effecting a cut-off in steam-engines. *Sickles v. Glou. Manuf. Co.*, 1 Fisher, 225.—GRIER, J.; N. J., 1856.

2. The specification sets forth two separate improvements, not claimed jointly as one *machine*, but as distinct improvements of two several parts of a known machine. *Ibid.*, 229.

3. The first claim is not for the scheme of tripping valves, but for a combination of certain devices as an improvement, in the manner of tripping valves, and the combination and ar-

angement of parts have all reference to a peculiar sort of valve—the puppet valve. *Ibid.*, 231.

4. The second claim is for the regulating the closing of the valves and preventing them from slamming, by means of a *water reservoir*, or a reservoir of *water, oil, or other fluid*. The word *fluid* is used in its popular sense as a synonym for *liquid*. There is no intimation that an elastic fluid, as air, could be used for the same purpose. *Ibid.*, 236.

5. But the apparatus described in the first and second claims must be combined to effect the purpose intended. The two things constitute one whole invention. *Ibid.*, 236.

6. The invention of Corlies for tripping *sliding* valves, and breaking the shock of the weight used to close such valve by cushioning it on an *air cushion*, is no infringement of Sickles' patent. *Ibid.*, 236-8.

7. The claims of the patent of Sickles of May 20th, 1842, for regulating the closing of the valves of steam-engines, and preventing their slamming, "by means of a water reservoir," are not infringed by the patent of Corlies of July 29th, 1851, in which the weights which close the valves are prevented from slamming by being cushioned on air. *Sickles v. Youngs*, 3 Blatchf., 301.—NELSON, J.; N. Y., 1855.

8. The term *fluid* in Sickles' patent means a fluid that is tangible, that can be seen or handled like water or oil, and with which a vessel can be filled in part or in whole at the option of the patentee. It does not embrace *air*, though the term *fluid* in its generic and technical scientific sense includes air and the gases. *Ibid.*, 302.

VALVES, LIFTING.

SICKLES' PATENT.

Issued September 19th, 1845.
Extended September 19th, 1859.
Reissued February 21st, 1860.

This patent was for an "improvement in cut-off valves of steam-engines;" *Held*, the novelty of the invention consisted in the new set of ideas by which the patentee saw the possibility of dispensing with the lifting motion as a means of detaching the valve and allowing it to drop, and in deriving power from some other part of the engine *Sickles v. Borden*, 3 Blatchf., 538.—NELSON, J.; N. Y., 1856.

2. The improvement, however, does not limit the patentee to the motion or power derived from the eccentric strap, but it may be taken from any other moving part of the engine, always excluding, however, the motion from the lifting rod. *Ibid.*, 538.

3. Such independent motion may be used to trip the valve at *any* desirable point, at the discretion of the engineer, or constructor. *Ibid.*, 539.

4. The claim in the reissued patent for "imparting a coexisting movement to two reciprocating catch pieces, in the operation of the trip cut-off valves," is for an effect or function, and is not patentable. *Sickles v. The Falls Co.*, 4 Blatchf., 509.—NELSON, J.; Ct., 1861.

WATER-CLOSET VALVES, GOVERNORS FOR.

BARTHOLOMEW'S PATENT.

Issued June 20th, 1854.

1. This patent was for "a method of

governing the action of valve cocks," adapted to the purposes of water-closets, and the nature of the invention consisted in providing and applying a governor to the valve or valves of a cock, adapted to the purposes of a water-closet, &c., by which the valve could be made to open or close gradually, and while opening or closing to admit a limited supply of water to pass through, and thus avoid the necessity of employing any cistern or reservoir of water between the main supply and basin. The variable chamber could be filled with air or water.

Held, that the patent covered the combining such variable chamber and valves by the means specified, so that the variable chamber, by the discharge of the air or water, or the drawing in of air or water should control the closing of the valve, the valve being self-closed by a spring or its equivalent. *Bartholomew v. Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

2. The object of the variable chamber is to resist the action of the spring or weight that closes the valve, so that the closing, instead of being sudden, shall be gradual, to allow the required flow of water. *Ibid.*

WATER-WHEELS.

PARKER'S PATENT.

Issued October 19th, 1829.
Extended October 19th, 1843.

1. This patent was for an "improvement in percussion and reaction water-wheels." The invention consists not only in the combination, but in the improvement of several of the parts of which that combination is composed.

WATER-WHEELS.

The violation of one of them is therefore an infringement. *Parker v. Harworth*, 4 McLean, 474.—McLEAN, J.; Ill., 1848.

2. The claim intended to be made in this patent, is that of the wheel called the compound vertical, percussion, and reaction wheel; the concentric cylinders enclosing the shaft, and the manner of supporting them; and the spouts which conduct the water to the wheel. *Parker v. Stiles*, 5 McLean, 58.—LEAVITT, J.; Ohio, 1849.

3. But it does not embrace the arrangement or duplication of wheels, on a horizontal shaft, as a part of the invention of the patentee. *Ibid.*, 58, 59.

4. The concentric cylinders enclosing the shaft, and the spiral conductors for leading the water to the wheels, are also within the claims of the patent. *Ibid.*, 60.

5. The patentee claims to have been the first to discover, devise, and apply to use, 1. The propulsive effect of vortical motion of water in a reaction wheel, operating by its centrifugal force, and so directed by mechanism as to operate in the appropriate direction. *Parker v. Hulme*, 7 West. Law Jour., 421.—KANE, J.; Pa., 1849.

6. And 2. The mechanical arrangements for making, guiding, and controlling the vortical motion, as set forth in their specification, both as new mechanical devices, considered separately in their application to these objects, and as new in their combination to produce and effectuate, or perfect the same objects. *Ibid.*, 421.

7. *Held*, that the mechanical arrangements and devices, separately or in combination, are patentable. In regard to the arrangement of vertical wheels in pairs on a horizontal shaft,

the mere fact that this was a duplication of the single wheel did not, of itself, invalidate the patent. Duplication, producing a new and useful result, may be patentable. It is often the material part of a discovery, because it may be that which renders useful what was previously useless. *Ibid.*, 421.

8. *Held*, also, that the more general subject of the claim—the propulsive effect of vortical motion of water in a reaction wheel operating by its centrifugal force, and so directed by mechanism as to operate in a given direction—was also a valid subject of claim, and properly to be secured by letters patent. *Ibid.*, 422.

9. *Held* as matters of law—1. That the letters patent vested in the patentees an exclusive right to construct and use mechanical devices, whether such as are described in their specification, or equivalent therefor, for producing, directing, and applying, as a motive power, in reaction wheels, the centrifugal force of water revolving vortically round the shaft, and passing into and acting upon the wheels in the direction of their revolution. *Ibid.*, 422.

10. And 2. A similar exclusive right to employ vortical reaction wheels, having two or more wheels arranged in pairs on the same horizontal shaft. *Ibid.*, 423.

11. In *Parker v. Hulme*, Pa., the jury found specially that the patentees “were the first to invent and apply to use two or more reaction wheels arranged in pairs on an horizontal shaft.” *Parker v. Sears*, 1 Fisher, 98.—GRIEB, J.; Pa., 1850.

12. In *Parker v. Stiles*, Ohio, it was so fully proven that the patentees were not the first inventors of such arrangement that the plaintiffs admitted the

WHEELS, HORIZONTAL.

fact and denied that the patent claimed such a machine, and the court held "that the plaintiff's patent did not claim the duplication of wheels on a horizontal shaft." *Ibid.*, 98.

13. In *Parker v. Ferguson*, N. Y., the court instructed the jury the wheel claimed was "one constructed by placing two or more of the wheels on a horizontal shaft, with the inner and outer cylinders supplied with water by a spiral spout." *Ibid.*, 101.

14. This patent is not for the vertical or horizontal arrangement of the wheels upon the shaft, or the putting them in pairs; neither does it embrace as a distinct discovery, the concentric cylinder enclosing the shaft, nor the spout, the gate, the outer cylinder, or the buckets on the wheel. *Wintermute v. Redington*, 1 Fisher, 248.—WILSON, J.; Ohio, 1856.

15. The purpose or aim is to obtain an increase of power with a given quantity of water; and the secret of the invention of the wheel is the vortical motion of the water on the wheel, which operates as a coefficient to the reactive power of the water in the buckets. *Ibid.*, 248, 249.

16. The essence of the invention is, the producing a vortical motion on a *reaction* wheel, in the line of its motion, and the invention of producing a vortical motion upon a percussion or impact water-wheel, is not within the claim. *Ibid.*, 250.

WHEELS, HORIZONTAL, FOR BOATS.

ISAACS' PATENT.

Issued November 17th, 1819.

The patent was for "an improvement on the horizontal circular plane or

WOOD-BENDING MACHINE.

wheel," invented by the patentee for the purpose of gaining power by applying animal weight to the propelling of boats on water, or to machinery on land; but it was not stated what was the nature of the invention upon which it was alleged to be an improvement, nor whether patented or not.

Held, that the nature of the improvement was altogether unintelligible, and the patent void. *Isaacs v. Cooper*, 4 Wash., 259, 261.—WASHINGTON, J.; 1821.

WOOD-BENDING MACHINE.

MORRIS' PATENT.

Issued March 11th, 1856.

1. This patent was for an "improved method of bending wood," and the improvement was for working the levers that bent the wood, on "fixed fulcrums," to prevent the wood twisting while being bent, and also in attaching clamps to the levers, which should abut against the end of the wood, thus upsetting the fibre and preventing breakage on the outside of the curve, and the claim was, 1st, for the clamps, to prevent end expansion; and 2d, the levers working on fixed fulcrums, for the purposes set forth.

Held, that the claim was not for a combination, but for two distinct improvements in the art of bending wood, and that the use of both or either was an infringement. *Morris v. Barrett*, 1 Fisher, 463.—LEAVITT, J.; Ohio, 1853.

2. *Held* also, that the use of radiating arms with rollers for the plaintiff's fulcrums, and clamps permitting a partial relaxation, was an infringement on the patent. *Ibid.*, 462-465.

PATENTED ARTICLES OR MACHINES.

- A.** RIGHT OF PURCHASERS TO USE, REPAIR, &c..... 576
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A. RIGHT OF PURCHASERS TO USE, REPAIR, &c.

1. If one has a right to a machine, and to the use of it, he has a right to work it himself, or by his servants, or to lease it out to any other person. *Rutgen v. Kanows*, 1 Wash., 178.—WASHINGTON, J.; Pa., 1804.

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 sale of a patented machine by a sheriff, under an execution, does not in and of itself convey to the purchaser any right to use the machine in the manner pointed out in the patent-right. The purchaser acts at his own peril. *Sawin v. Guild*, 1 Gall., 487.—STORY, J.; Mass., 1813.

4. To entitle a purchaser of a machine to the benefits of § 7 of the act of 1839, he must be one who has used the invention before the application for a patent by license from the inventor himself, and not a fraudulent purchaser, or a purchaser from a wrongdoer, without the knowledge or against the will of the inventor. *Piersen v. Eagle Screw Co.*,

3 Story, 406, 407.—STORY, J.; R. I., 1844.

5. Under § 18 of the act of 1836, these who are in the use of the patented article at the time of the renewal, are entitled to the benefit of a renewal, of a patent, and such persons have the right to continue to use, during such extension, the machines held by them at the time of such renewal "to the extent of their interests," be that interest in one or more machines. *Wilson v. Rosseau*, 4 How., 682, 683.—NELSON, J.; Sup. Ct., 1845.

6. The right to use a machine to be constructed according to a certain specification, involves the right to make, or cause to be made, the machine thus permitted to be used. *Woodworth v. Curtis*, 2 Wood. & Min., 526.—WOODBURY, J.; Mass., 1847.

7. In respect to some patents, the right to make, vend, or use, may be separated. The circumstances, nature, and words of each grant must decide the construction which is just and legal. *Ibid.*, 526.

8. Where A owned the right to an invention—Woodworth's planing machine—for a certain district, and conveyed to B the authority to use one machine in that district, *Held*, that B could build as well as use such machine, and that he might build and use another instead of it, but not both at one time. *Ibid.*, 526, 527.

9. The right or license to use one machine during the term of the patent, does not mean any particular machine then sold, but has reference to what must be considered one machine in number at one time. A second machine may therefore be run if the first one wears out, or is destroyed by fire, or is constructed erroneously, or is dis-

used entirely for want of repair. *Ibid.*, 527.

10. The right to use such a machine may be assigned to a third person. A machine and a right to use it is personal property rather than a mere patent-right, and has all the incidents of personal property, making it subject to pass by sale. *Ibid.*, 527.

11. Under § 18 of the act of 1836, the use of such a machine may be continued, notwithstanding the extension of the patent, until it is worn out, or destroyed. *Ibid.*, 528.

12. The assignees and grantees having such right to use, are those holding that right at the time of the renewal of the patent. *Ibid.*, 530.

13. Their right is not, however, a mere personal privilege, but a right of property in and attached to the machine used, when it is the last one used at the time the term expires. *Ibid.*, 530.

14. The machine and the right attached to it may pass by sale, devise, or levy of execution, or assignment of an insolvent's effects. *Ibid.*, 530.

15. The right to use a machine cannot be made to depend upon or be affected by the fact of the sale of one machine or the purchase of another. Where, therefore, a party had the right to use one machine, his right was not affected by selling that particular machine and purchasing another. *Wilson v. Stolley*, 4 McLean, 277.—McLEAN, J.; Ohio, 1847.

16. A license to use one machine will always be construed to run a machine, whether the particular one existing at the time of the license or not, unless the license in express terms is limited to one identical machine. *Ibid.*, 278.

17. The sale of a patented machine does not necessarily carry the right to use it. A sale by the patentee gives an

implied right of use; but such an inference does not necessarily follow where the sale of the machine is made by one who has no exclusive right, but only a license to use. *Ibid.*, 278.

18. Under the rule laid down in *Wilson v. Rosseau*, 4 How., 646, 1845, where the material of a combination ceases to exist, in whatever way that may occur, the right to renew depends upon the right to make the invention. If the right to make does not exist, there is no right to rebuild. *Wilson v. Simpson*, 9 How., 123.—WAYNE, J. Sup. Ct., 1849.

19. But it does not follow, when one of the elements of the combination has become so much worn as to be inoperative, or has been broken, that the machine no longer exists for restoration to its original use, by the owner who has bought its use. When the wearing or injury is partial, then repair is restoration and not reconstruction. *Ibid.*, 123.

20. Repairing partial injuries, whether they occur from accident or wear, is only refitting a machine for use. And it is no more than that, though it shall be a replacement of an essential part of a combination. *Ibid.*, 123.

21. But if a patented machine as a whole should happen to be broken, so that its parts could not be readjusted, or be so much worn as to be useless, a purchaser cannot make or replace it by another, but must buy a new one. The doing of either would be a reconstruction. *Ibid.*, 124.

22. If, however, it is a part of an original combination, essential to its use, then the right to repair and replace occurs. *Ibid.*, 124.

23. The right to replace the cutters in Woodworth's planing machine is a

part of the invention transferred to an assignee, as the use of the machine depends upon the replacement of such cutters; as a machine will last several years, whereas the cutters must be replaced every sixty or ninety days. *Ibid.*, 125.

24. And an assignee of a right to use such a planing machine, who has, under the decision in *Wilson v. Rosseau*, 4 How., 646, the right to continue the use of a particular machine after the extension of the patent, may replace the knives or cutters when worn out, without destroying the identity of the machine; the right to replace is a part of the invention transferred. *Ibid.*, 125, 126.

25. A replacement of temporary parts does not alter the identity of a machine, but preserves it, though there may not be in it every part of its original material. *Ibid.*, 126.

26. Under § 18 of the act of 1836, as construed by the Supreme Court in *Wilson v. Rosseau*, 4 How., 682, a licensee may continue to use an invention actually in use by him at the time of an extension, during the term of such extension; but no such right exists under an extension by act of Congress, unless specially provided for. *Bloomer v. Stolley*, 5 McLean, 163.—McLEAN, J.; Ohio, 1850.

27. Contracts in relation to a patented machine or implement are regulated by the laws of the several states, and are subject to state jurisdiction. *Wilson v. Sandford*, 10 How., 99.—TANEY, Ch. J.; Sup. Ct., 1850.

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

29. 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.

30. The purchase of an implement or machine for the purpose of use in the ordinary pursuits of life, does not become possessed of a portion of the franchise or monopoly conferred by the patent, derived from and under the United States, and which is the right to exclude every one from making, using, or vending the thing patented. *Bloomer v. McQuewan*, 14 How., 549.—TANEY, Ch. J.; Sup. Ct., 1852.

31. Such a purchaser, in using the thing purchased, exercises no right conferred by the acts of Congress, nor does he derive title to it by virtue of the franchise granted to the patentee; when the machine passes into his hands, it is no longer within the limits of the monopoly, or under the protection of the act of Congress. *Ibid.*, 549.

32. If his right to it is infringed, he must seek redress in the courts of the state, and according to its laws, and not in the courts of the United States, or under the acts of Congress. The implement becomes his private property, not protected by the laws of the United States, but by those of the state in which it is situated. *Ibid.*, 549, 550.

33. Like other individual property, it is then subject to state taxation. *Ibid.*, 550.

34. The value of the implement or machine in the hands of a purchaser for use does not depend on the time for which the exclusive possession is granted to the patentee, nor upon the exclusion of others from its use. He does not look to the duration of the exclusive privilege, but to the usefulness of the thing he buys, and the advantages

he will derive from its use. *Ibid.*, 550.

35. Under the decision of *Wilson v. Rosseau*, 4 How., 688, one in the lawful use and ownership of a patented machine, under a purchase made during the original term of the patent, may continue to use such a machine during an extension of the patent, under the provisions of § 18 of the act of 1836, and is also entitled, within the spirit and intention of the patent laws, to continue to use such machine during an after extension made by special act of Congress, unless there is something in the language of the act requiring a different construction. *Ibid.*

36. Where a patentee under his original patent, prior to the commencement of an extended term, had sold a machine made by himself under his patent, *Held*, that the vendee had a right to continue to use such machine during the extended term: and that this right existed, though such extension was by special act of Congress, without any saving clause in favor of assignees, or of persons who had acquired rights under the previous term of the patent. *Blanchard v. Whitney*, 3 Blatchf., 309.—NELSON, J.; Ct., 1855.

37. There is a manifest distinction between a case where the title to a machine is derived from a person who has purchased simply a right or license to manufacture it under the patent, and a case where the purchase of the article is made directly from the patentee. In one case the patentee has parted only with his interest in the term of the patent, which is limited: in the other, he has sold the machine itself, with all the rights appertaining to his title as vendor; and of course without any limitation of its use or enjoyment. *Ibid.*, 309.

38. Under the provisions of § 18 of the act of 1836, an assignee or person in use of the invention at the time of the expiration of the original patent, has a right to continue, under an extension of such patent, the use of "the thing patented," whether the patent be for a process, and a machine to be used in such process—or for a process alone—or for a machine alone, and whether the identical machinery in use by such person under the extended patent was or was not in existence prior to the renewal of the patent. *Day v. Union Rub. Co.*, 3 Blatchf., 49, 504.—HALL, J.; N. Y., 1856.

39. Where at the expiration of the original term of the patent, A had a right to use the patented invention for the manufacture of certain articles, and continued, during an extension of the patent granted under § 18 of the act of 1836, the use of the invention to the extent he was entitled at the time the original expired, *Held*, that A had the right to continue such use during the extended patent as against B, an assignee of the original patentee. *Ibid.*, 497.

40. The language of § 18 of the act of 1836, as to the rights of assignees and grantees of an original patent, under an extended term thereof, is broad enough to cover and protect, and was intended to cover and protect, the right to use the patented invention during the extension, whether such right arose from a direct assignment or grant (from the patentee) of a limited or unlimited right to use, or from the purchase of the machine. *Ibid.*, 497.

41. 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,

PRODUCTS OF, RIGHT TO SELL AND USE.

which require an assignment or grant to be in writing. *Buss v. Putney*, 11 Mo. Law Rep., 687.— J.; N. H., 1858.

42. When a patented machine rightfully passes to the hands of a purchaser from the patentee, or any person authorized to convey it, such machine is no longer within the monopoly, or under the peculiar protection granted to patented rights: it is no longer protected by the laws of the United States, but by the laws of the state in which it is situated. *Chaffee v. Boston Belt. Co.*, 22 How., 223.—CLIFFORD, J.; Sup. Ct., 1859.

43. By a valid sale and purchase, the patented machine becomes the private individual property of the purchaser, and it is no longer protected by the laws of the United States, but by the laws of the state in which it is situated. *Ibid.*, 223.

44. The person acquiring title may continue to use the machine until worn out, or may repair it, or improve it, in the same manner as if dealing with property of any other kind. *Ibid.*, 223.

45. The fact that certain machines were a patented article cannot affect a contract of insurance against loss by fire, to measure the damages by its value when the loss occurred. What they were worth, patented or unpatented, is the measure of their value. *Com. Ins. Co. v. Sennett*, 37 Penn., 209.—THOMPSON, J.; Pa., 1860.

B. PRODUCTS OF, RIGHT TO SELL AND USE.

1. A contract to buy all the product of a patented machine, during a certain period, does not render the purchaser liable to an action of infringement for

the use of the machine, upon which made. *Keplinger v. De Young*, 10 Wheat., 364.—WASHINGTON, J.; Sup. Ct., 1825.

2. Otherwise, if such contract is only a colorable purchase of the products, but is in reality a hiring of the machine. *Ibid.*, 364.

3. Articles manufactured under a patent may be sold at any and every place, by any one who has purchased for speculation or otherwise. The patent law protects the thing patented and not the products. *Boyd v. Brown*, 3 McLean, 296.—MCLEAN, J.; Ohio, 1843.

4. The right of an assignee of a patent-right, for a particular district, is not infringed upon by the sale within such district, of the product of the same patent-right, manufactured by a party holding an interest in the same patent, in another district. *Ibid.*, 296.

5. Whether, if the manufacturer in the second district was actually engaged in selling such articles within the district held by the other, it would not be a violation of the right of such other person; *query*. *Ibid.*, 296.

6. The exclusive grant in a patent is the construction and use of the thing patented. The patent law protects the thing patented, and not the product. *Ibid.*, 297.

7. The sale of a thing manufactured by a patented machine, is no violation of the exclusive right to use, construct, or sell, the machine itself. The product cannot be reached except in the hands of some one in some manner connected with the use of the patented machine. *Boyd v. McAlpine*, 3 McLean, 429.—MCLEAN, J.; Ohio, 1844.

8. But if the sale of the product is by some one connected with the illegal use of the machine, he is responsible in

damages, and the court will restrain him from selling the product. *Ibid.*, 430.

9. And this may be done, if the court have jurisdiction of the person, though the use of the machine is beyond the jurisdiction of the court. *Ibid.*, 430.

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

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

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.—BETTS, J.; N. Y., 1845.

13. The sale of an article, if the *product* of an invention, is not a "sale of the invention," within the meaning of § 7 of the act of 1839. A sale within that section, must be a sale of the invention, or patented article. But where a patent was for a *design*, an ornamental design for figured silk buttons—and such design was worked on the face of the button, whether a sale of the button would not be a sale of the *design*, the thing patented: *Booth v. Garelly*, 1 Blatchf., 250.—NELSON, J.; N. Y., 1847.

14. An action of infringement cannot be maintained against a mere purchaser of articles, manufactured in violation of a patent, after they have been manufactured, unless he is concerned in the

manufacture. *Blanch. Gun-Stock Tur. Co. v. Jacobs*, 2 Blatchf., 70, 71.—BETTS, J.; N. Y., 1847.

15. Where A and B agreed with C, to purchase of the latter, all of a certain article, lead pipe, which he should make, A and B agreeing to furnish the lead, and pay C a given price for manufacturing, and C used in such manufacture a machine patented to plaintiff's assignor. *Held*, in an action for infringement against A, B, and C, that if A and B had no connection with the manufacture except to furnish the lead and pay a given price, that they were not liable for infringement. *Tatham v. Le Roy*, MS.—NELSON, J.; N. Y., 1849.

16. But if the agreement was only colorable, and entered into for the purpose of securing the profits of the business without assuming the responsibility for the use of the invention, then they would be liable. Aiding and assisting a person in carrying on such a business, and in operating the machinery, will implicate the parties so engaged. *Ibid.*

17. Where a license to run a planing machine contained a condition that the licensees should not sell dressed lumber out of the limits of the territory assigned, nor dress lumber for other persons to be carried out of such territory, and sold as an article of merchandise, *Held*, the true meaning of the condition was, that under no circumstances, could the planed article, with the privity or consent of the licensees, be sold out of their territory, or be sold within such territory to be carried out and resold, and that such use would be enjoined as in violation of the license. *Wilson v. Sherman*, 1 Blatchf., 539, 540.—NELSON, J.; N. Y., 1850.

18. Where a license to use a patented machine contained a clause restricting

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the sale of the product, except in the territory within which such machine could be used, but the actual agreement was, that the licensee was to have the right to vend the products without any restriction as to place; *Held*, that a court of equity would reform the contract to make it as the parties understood it at the time it was made; but if, in the mean time, the rights of *bona fide* purchasers intervened, which might be prejudiced, then the contract could not be reformed. *Woodworth v. Cook*, 2 Blatchf., 154, 159.—NELSON, J.; N. Y., 1850.

19. The sale or use of the product of a patented machine, is no violation of the exclusive right to use, construct, or sell the machine itself. *Goodyear v. The Railroads*, 2 Wall., Jr., 362.—GRIER, J.; N. J., 1853.

20. Where a known manufacture or product is in the market, purchasers are not bound to inquire whether it was made on a patented machine, or by a patented process. *Ibid.*, 362.

21. But 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, the exclusive right to vend which is secured to the inventor or discoverer. *Ibid.*, 362, 363.

22. The purchaser of the product of a patented process, may use such product for any purpose he may see fit; and cannot be compelled to use it in subservience to any arrangement made between the patentee and any of his licensees. He may use it for his own purposes, without inquiring for or regarding any

private agreement between licensees not to compete with one another. *The Washing Machine Co. v. Earle*, 2 Fisher, 206.—GRIER, J.; Pa., 1861.

23. And every person who purchases the right to use a patented machine or process, may sell the manufacture or product to whom they please, without inquiring the purpose of the purchaser, or imposing any condition on him, as to how he shall use it, unless he binds himself by covenants to restrict such right. *Ibid.*, 206.

24. A patentee, Goodyear, sold the plaintiffs the exclusive right to use his vulcanized rubber in its application to, and in combination with all wringing, washing, and starching machines. He had previously sold a like right to the Boston Belting Co., for "hose, pipe, and tubes." The defendants purchased india-rubber tubing of the Boston Belting Co., and used it to make wringers. *Held*, that the defendants had the right to apply such article, purchased by them, to making rollers for wringing machines without infringing the rights of the plaintiffs, and that the arrangements of the plaintiffs to create a monopoly could not affect defendants' rights to do as they pleased with their own property. *Ibid.*, 206.

25. 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 the patentee has supposed were rights not granted by him. *Ibid.*, 205.

UNDER THE COPYRIGHT LAWS.

26. An agreement between licensees, that one shall make a certain article, and the other another article, gives neither a right to an interference of chancery, to compel a purchaser from them to use the article purchased for any particular use or purpose; and if any covenants are made between the patentee and his licensees, the public are not compelled to notice or regard them, or the right conferred or reserved by them. *Ibid.*

PENALTIES, AND ACTIONS FOR.

- A. UNDER THE COPYRIGHT LAWS..... 583
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A. UNDER THE COPYRIGHT LAWS.

1. Where a copyright of a work had been taken out in this country, and the defendants had imported a number of copies of the same work published in England, and sold the same, *Held*, that the penalty of fifty cents was incurred for every sheet contained in the whole number of volumes found to have been in the defendant's possession, or which they had imported for sale, or sold, or held for sale. *Dwight v. Appletons*, 1 N. Y. Leg. Obs., 198.—THOMPSON, J.; N. Y., 1843.

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

3. A defendant is not liable to the

penalty under § 7 of the act of 1831, unless he was guilty of the infraction of the copyright within two years before action was brought. *Reed v. Carusi*, 8 Law Rep., 412.—TANEY, Ch. J.; Md., 1845.

4. But though the plates of a piece of music were engraved more than two years before, yet every printing for sale would be a new infraction of the right, and if such printing was within two years before suit brought, the defendant is liable. *Ibid.*, 412.

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

6. The penalty imposed by § 11 of the copyright act of 1831, for putting the imprint of copyright upon a work not legally copyrighted, and given by such act "to the person who shall sue for the same," cannot be recovered in the name of more than one person. *Ferrett v. Atwill*, 1 Blatchf., 154, 155.—BETTS, J.; N. Y., 1846.

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

8. In actions upon a statute, the party prosecuting must allege and prove every fact necessary to make out his title to the thing demanded, and his competency to sue for it. *Ibid.*, 155.

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

10. The language of the statute is to be particularly adhered to in the construction of penal laws. *Ibid.*, 156

UNDER THE PATENT LAWS.

11. Under § 6 of the copyright act of 1831, the penalty of fifty cents on each sheet (whether printed or being printed, or published, or exposed to sale), is limited to the sheets in possession of the defendant, and does not embrace every sheet which the defendant has published or procured to be published. *Backus v. Gould*, 7 How., 811.—McLEAN, J.; Sup. Ct., 1848.

12. A penal statute must be construed strictly. *Ibid.*, 811.

13. The statute penalty imposed by § 6 of the act of 1831, is not incurred by printing and publishing so much of a book as to amount to an infringement of its copyright. *Rogers v. Jewett*, 12 Mo. Law Rep., 340.—CURTIS, J.; Mass., 1858.

14. Congress did not intend to inflict these penalties upon the unlawful printing or publication of less than an entire work. *Ibid.*, 34.

15. This question was not decided in *Backus v. Gould*, 4 How., 798, though raised in the court below, and ruled *pro forma*, there. *Ibid.*, 342.

B. UNDER THE PATENT LAWS.

1. When an action is brought on a penal statute, as the statute is the only foundation of the action, the declaration must aver that the act complained of was done contrary to the statute. *Parker v. Haworth*, 4 McLean, 373.—McLEAN, J.; Ill., 1848.

2. Under § 6 of the act of 1842, the assignees of an interest in a patent-right are no more liable to the penalty prescribed by the act for selling patented articles not having the date of the patent stamped on them, than any other persons, unless it appeared that the articles were manufactured by

them or with their connivance. *Palmer v. Allen*, MS.—BETTS, J.; N. Y., 1854.

3. It is not the selling of the articles so unstamped that makes them liable to the penalty, but the omitting to put the stamp on. If the articles were manufactured before coming to the possession of the assignees, or vendors, they are not bound to put on the stamp. *Ibid.*

4. The penalty attaches for each separate article sold, and not for all sold at each time in the aggregate. *Ibid.*

5. 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 may be brought at any time within *five* years from the time when the same accrued. *Stimpson v. Pond*, 2 Curt., 503, 504.—CURTIS, J.; Mass., 1855.

6. § 5 of the act of 1842 authorizes the infliction of a penalty of just one hundred dollars for the offence described therein, and no more. *Ibid.*, 506.

7. The penalties prescribed by the patent acts may be recovered in an action of debt. *Ibid.*, 506.

8. It is necessary that each article should be stamped with the day of the month as well as the year, but if this is done it is sufficient, even if the word "patented" is abbreviated. *Hawley v. Bagley*, MS.—BETTS, J.; N. Y., 1855.

9. To entitle the plaintiff to recover, he must allege and prove facts showing that he has a title to recover, and the proof must correspond with the allegations. Where the declaration charged the defendant with having sold an "extension pen holder," while the proof showed the patent to be for an "im-

provement in pens and pencil cases." *Held*, that the plaintiff could not recover. *Ibid.*

10. The penalty specified in § 5 of the act of 1842, for affixing the word "patent" to an unpatented article, is incurred as to all articles made and having such word affixed, with a guilty purpose: and this is not changed by the party making application for a patent during such manufacture, at least as to such as were made or ordered to be made, and so stamped before his application. *Stephens v. Caldwell*, MS. —SPRAGUE, J.; Mass., 1860.

PERFECTING AN INVENTION.

See title INVENTION, B.

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PLEADING.

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A. DECLARATION.

1. In general, in an action for the violation of a patent, it is sufficient to state in the declaration, the substance of the grant or specification to which the grant refers. *Tryon v. White*, Pet. C. C., 97. —WASHINGTON, J.; N. J., 1815.

2. But if the declaration professes to set forth the specification as part of the

grant, *verbatim*, or according to its tenor, the slightest variation is fatal, and for such variance a nonsuit will be granted. *Ibid.*, 97.

3. It is not a ground for a nonsuit in an action for violating a patent-right, that the declaration does not lay the act complained of to be "against the form of the statute," but merely claims damages. *Contra formam statuti* is matter of form, and the want of it would be cured by verdict. *Ibid.*, 97.

4. The declaration ought always to show a title in the plaintiff, and that with convenient certainty. It ought to state all matters that are of the essence of the action, without which the plaintiff fails to show a right in point of law to ask for the judgment of the court in his favor. *Gray v. James*, Pet. C. C., 482.—WASHINGTON, J.; Pa., 1817.

5. If his title depends upon the performance of certain acts, he must affirm the performance of such acts. *Ibid.*, 482.

6. But if enough is stated to show title in the plaintiff, and with sufficient certainty to enable the court to give judgment, but the declaration is less explicit than might have been required, the defect will be cured by verdict. *Ibid.*, 482.

7. Where the declaration designates the patent by the terms used in the patent, it is not necessary that the specification should be set out in the declaration. It is a matter of evidence to be used at the trial, and the defendant may have it placed on the record by asking oyer of it. *Ibid.*, 482, 483.

8. The declaration must show a title in the plaintiff; but if it aver that the grant or patent, in the form prescribed by law, was issued, this shows the very title on which the action is founded.

DECLARATION; WHAT TO SET FORTH.

Cutting v. Meyers, 4 Wash., 221.—WASHINGTON, J.; Pa., 1818.

9. It is not necessary to aver that the preliminary steps, such as presentation of petition, &c., were taken, without which a valid grant could not issue, because the court will presume in favor of the grant, that every thing was rightly done which the law required, in order to authorize the issuing of the grant. *Ibid.*, 221.

10. The declaration must, however, allege not only that a patent was made out in due form of law, by which there was granted to the plaintiff certain privileges, but must also allege a *delivery* of such patent to the plaintiff, and that the patent was attested by the president, or proper officer, as such attestation is necessary to the form and validity of the patent, and cannot be implied from the allegation that a patent was made out. The want of these allegations is cause for general demurrer. *Ibid.*, 222.

11. The declaration need not, however, state in what the plaintiff's improvement consists, or set out the patent or specification either verbatim or substantially. If the defendant desires its production he can pray *oyer* of it. *Ibid.*, 223.

12. Where the declaration laid the breach that the defendants, without the leave or license, &c., used the improvement invented by the patentee contrary to the form of the acts of Congress and against the privileges so granted, *Held*, sufficient—the breach assigned being as broad as the right granted. *Ibid.*, 223, 224.

13. Where a plaintiff claims as an assignee under a patent, the declaration should set out the fact, and that such assignments had been recorded; but if the declaration omit to state that such

assignments were recorded, and a verdict is given in favor of the plaintiff, the defect will be cured by verdict. *Dobson v. Campbell*, 1 Sumn., 326.—STORY, J.; Me., 1833.

14. A declaration is a statement of facts, which in law gives the plaintiff a right to recover. It is materially defective if, to lay the foundation of a recovery, the proof must go further than the allegations it contains. *Stanley v. Whipple*, 2 McLean, 41.—MCLEAN, J.; Ohio, 1839.

15. In an action of infringement of a patent, the declaration must aver that the plaintiff had obtained a patent, or that the exclusive right was vested in him. *Ibid.*, 43.

16. Where the declaration stated that the plaintiff claimed a patent, and that the defendant possessed and enjoyed the right, *Held*, that it would be bad on general demurrer. *Ibid.*, 43.

17. But in such case after verdict, a motion in arrest of judgment will not be granted, as the court will presume that the facts showing the right were proved at the trial. *Ibid.*, 43.

18. The declaration in an action for the infringement of a patent need not set out the specification. *Pitts v. Whitman*, 2 Story, 614.—STORY, J.; Me., 1843.

19. It would be more formal to annex a copy of the letters patent and specification to the declaration, and to refer thereto in the declaration, but there is no substantial objection to a *profert*. *Ibid.*, 614.

20. In an action at law for an infringement of a patent for an improvement, the declaration must set out in what the improvement of the patentee consists—this being an essential part of the plaintiff's case—or else it will be demurrable

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Leave was, however, given to amend. *Peterson v. Wooden*, 3 McLean, 249.—McLEAN, J.; Ohio, 1843.

21. If a declaration in a patent suit shows that the plaintiff has an interest in only a part of a patent, as a license to use, in the manufacture of a particular kind of goods, the invention described in it, it is bad on its face, and judgment will be rendered for the defendant. *Suydam v. Day*, 2 Blatchf., 23.—NELSON, BETTS, JJ.; N. Y., 1846.

22. The declaration for an infringement of a patent need not aver the specific time of the invention. It need only be before the application for a patent. It is wholly immaterial as to the pleadings, whether the invention was long antecedent to the application or directly preceded it. *Wilder v. McCormick*, 2 Blatchf., 33.—BETTS, J.; N. Y., 1846.

23. The declaration need not set forth any of the steps taken in securing the patent. The grant of the patent itself is sufficient evidence that all the preliminary steps required by law were properly taken. It is sufficient to set forth the patent in substance. *Ibid.*, 34.

24. The declaration must tender an issue upon the novelty and utility of the discovery patented; but it need not aver the regularity of the preliminary proceedings in its issue. *Ibid.*, 35.

25. A declaration which avers the patent and specification to be "in language of the *import* and to the effect following," and which sets forth the letters patent according to their words and figures, is sufficient; and it is not a good exception that the word "import" is used instead of "tenor," even if the words are not identical in signification, because the language is that of recital, and not of grant. *Ibid.*, 35.

26. A recital in a declaration that "the letters patent, in due form of law, are ready in court to be produced," is equivalent to *profert* in the most formal and ample terms. *Ibid.*, 35.

27. A reiteration of infringements of a patent, like a repetition of torts of any other kind, may be sued for and recompensed in one action. A declaration is not bad or demurrable, for duplicity, because it sets forth different and distinct infringements. *Ibid.*, 36.

28. A declaration which commences in *case* and concludes in the form of an action of debt by demanding actual damages in gross in compensation of the wrong, is good. *Ibid.*, 36, 37.

29. Though a declaration is not formal in its frame, if it embodies all that is essential to enable the plaintiff to give evidence of his right, and of its violation by the defendant, and affords the defendant the opportunity to interpose the defences allowed by law, the court will not encourage objections merely critical, and will seek, even on special demurrer, to sustain pleadings substantially sufficient. *Ibid.*, 37.

30. In an action for an infringement of a patent bearing date the 19th of October, 1829, and which has been extended, the declaration averred "that before the expiration of the term for which the original patent was granted, to wit, the 4th of October, 1843, such patent was in due form of law extended for the term of seven years from and after the 19th of October, 1843." On demurrer that the mode of extension should be set out at large, *Held*, that the general averment was sufficient. *Phelps v. Comstock*, 4 McLean, 353.—McLEAN, J.; Ind., 1848.

31. If the declaration aver that the defendant has made the thing "in imi-

tation of the plaintiff's patent," it will be sufficient to maintain the action. *Parker v. Haworth*, 4 McLean, 371, 373.—McLEAN, J.; Ill., 1848.

32. In an action for damages for an infringement of a patent, it is not necessary that the declaration should set forth the act complained of as contrary to the statute. This is only necessary when the action is brought on a penal statute. *Ibid.*, 373.

33. Where an original patent and the improvement on it are united in the same person, they constitute a whole, an entire right, and they must be asserted as such in the declaration in an action of an infringement of them. *Case v. Redfield*, 4 McLean, 529.—HUNTINGTON, J.; Ind., 1849.

34. If the declaration claims damages for the infringement of the original patent, and also separately for the infringement of the improvement, the action cannot be sustained. *Ibid.*, 529.

35. The declaration need not set out in what or by what means the defendants have infringed: it need only aver that the defendant has made, constructed, used, and sold the thing patented. *Ibid.*, 530.

36. Letters patent are not necessarily a part of the declaration. *Smith v. Ely*, 5 McLean, 90.—McLEAN, J.; Ohio, 1849.

37. The declaration, in a patent suit, averring an assignment of the invention before the issuing of the patent, such being the facts of the case, and claiming title under such an assignment, is not demurrable, such assignment being sufficient in law. *Rathbone v. Orr*, 5 McLean, 133.—McLEAN, J.; Mich., 1850.

38. In an action *qui tam*, under § 6 of the act of 1842, for a penalty, the

proof must correspond with the allegations of the declaration. Where the declaration charged the defendant with having sold an "extension pen-holder" without stamping on it the date of the patent, while the proof showed the patent to be for an "improvement in pens and pencil cases," *Held*, that the plaintiff could not recover. *Hawley v. Bagley*, MS.—BETTS, J.; N. Y., 1855.

B. PLEAS IN BAR.

See also DEFENCES; GENERAL ISSUE.

1. The recovery of a verdict by the plaintiff in an action for the infringement of a patent will not prevent him from bringing another action of infringement for a future use of the defendant's machine: every future use is an infringement. *Whittemore v. Cutter*, 1 Gall., 484.—STORY, J.; Mass., 1813.

2. Where a declaration goes for the user of a machine during a limited period, a verdict and judgment in such action is no bar to a subsequent action for a user during another and subsequent period. *Earle v. Sawyer*, 4 Mas., 14.—STORY, J.; Mass., 1825.

3. If the matter alleged in a plea is not a bar to the action, the plaintiffs may demand and have submitted the question of law to the court. Or they may deny the facts alleged in the plea, and take issue thereon, and go to the jury. *Grant v. Raymond*, 6 Pet., 245.—MARSHALL, J.; Sup. Ct., 1832.

4. A plea admitting the existence of a patent but denying its validity, is bad, as the plea refers a matter of law to the jury. *Bennett v. Martin*, 6 Mo., 461.—TOMPKINS, J.; Mo., 1840.

5. A plea of prior use or sale, under § 7 of the act of 1839, to be a bar to the

plaintiff's action, must state that it was more than two years before the application for a patent, or equivalent to an abandonment, to constitute a bar to the action—if it does not, it is demurrable. *Root v. Ball*, 4 McLean, 179.—McLEAN, J.; Ohio, 1846.

6. A plea in bar must contain a full defence against the rights of the plaintiff—that the plaintiff has no right to recover—or it is bad on demurrer. If the truth of the pleas may be admitted, and the action be still maintainable, such pleas are essentially defective. *Smith v. Ely*, 5 McLean, 85, 89.—McLEAN, J.; Ohio, 1849.

7. Where, therefore, the pleas alleged that the patentee was not the inventor of the thing claimed, and certain others were named as the first inventors, but such pleas did not allege a knowledge of the part of the patentee of such prior invention, and that such prior invention had been patented or described in some written publication, *Held*, that such pleas were defective and demurrable, not containing a full defence to the plaintiff's action. *Ibid.*, 85, 86, 89.

8. And a plea alleging the use of an invention with the consent and allowance of the patentee, should aver also an abandonment, or that the sale or prior use had been for more than two years before the application of the patentee. *Ibid.*, 86, 87.

9. Craving oyer of letters patent does not make them a part of a plea. *Ibid.*, 90.

10. If a party, by his pleading, tender an immaterial issue, the jury must find the issue as presented, and assess damages for the breach, if any, of the thing alleged. It makes no difference that it is an immaterial issue. *Good-year v. Day*, MS.—GRIER, J.; N. J., 1850

11. A plea of a defendant setting up an agreement, and justifying under the same, should aver the performance on the part of the defendant of the conditions precedent provided thereby, or aver that the defendant belongs to the class of persons who are provided for by such agreement: if it does not, it is ground for demurrer. *Day v. Harts-horn*, MS.—PITMAN, J.; R. I., 1854.

C. OYER AND PROFERT.

1. If the declaration designates the patent by the terms used in the patent, it is not necessary that the specification should be set out in the declaration. That is matter of evidence to be used at the trial. If the defendant wishes it to be put on the record, he can have it put there by asking oyer of it. *Gray v. James*, Pet. C. C., 482, 483.—WASHINGTON, J.; Pa., 1817.

2. The declaration need not set out the patent or specification either verbatim or substantially. If the defendant desires its production, he can pray oyer of it. *Cutting v. Myers*, 4 Wash., 223.—WASHINGTON, J.; Pa., 1818.

3. The *profert* of letters patent makes them, when produced, a part of the declaration, and gives all the certainty as to the invention patented which is required by law. It is therefore not good cause of objection that the declaration does not set them out. *Pitts v. Whitman*, 2 Story, 614.—STORY, J.; Me., 1843.

4. It would be more formal to annex a copy of the letters patent and specification to the declaration, but there is no substantial objection to a *profert*. *Ibid.*, 614.

5. A recital in a declaration that the letters patent, in due form of law, are

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ready in court to be produced, is equivalent to *profert* in the most formal and ample terms. *Wilder v. McCormick*, 2 Blatchf., 35.—BETTS, J.; N. Y., 1846.

6. Oyer of letters patent is not demandable as of a deed; but being matter of record, it is accessible to the defendant. *Smith v. Ely*, 5 McLean, 90.—McLEAN, J.; Ohio, 1849.

7. Letters patent are not necessarily a part of the declaration, and therefore where a plea alleges any thing respecting them, they should be stated in the plea. *Ibid.*, 90.

8. Craving oyer does not make the specification of letters patent part of a plea. *Ibid.*, 90.

9. Oyer of letters patent referred to in the declaration is not demandable as of right; being matter of record, the defendant can obtain them if he desires them. *Singer v. Wilson*, MS.—INGER-SOLL, J.; N. Y., 1858.

D. DEFECTS IN, CURED BY VERDICT.

1. Want of form in a declaration for an infringement of a patent, as not laying the act complained of as being "against the form of the statute," will be cured by verdict. *Tryon v. White*, Pet. C. C., 97.—WASHINGTON, J.; N. J., 1815.

2. If the declaration show title in the plaintiff, and with sufficient certainty to enable the court to give judgment, but the declaration is not as explicit as might have been required, the defect will be cured by verdict. *Gray v. James*, Pet. C. C., 482.—WASHINGTON, J.; Pa., 1817.

3. In an action for infringement of a patent brought by an assignee, the declaration omitted to state that the assignments had been recorded, as requir-

ed by § 4 of the act of 1793, but judgment was rendered for plaintiff; *Held*, that the defect was cured by the verdict, as a verdict could not have been rendered for the plaintiff if the assignment had not been recorded, as nothing would pass by the deed unless recorded. *Dobson v. Campbell*, 1 Sumn., 326.—STORY, J.; Me., 1838.

4. Where a matter is so essentially necessary to be proved to establish a plaintiff's right to recovery, that the jury could not be presumed to have found a verdict for him, unless it had been proved at the trial, the omission to state the matter in express terms in the declaration is cured by the verdict, if the general terms of the declaration are otherwise sufficient to comprehend it. *Ibid.*, 326.

5. After verdict, defects in substance in the declaration are cured if the issue joined be such as necessarily required on the trial, proof of the facts defectively or imperfectly stated or omitted; after verdict, the court will presume that the facts showing the right were proved. *Stanley v. Whipple*, 2 McLean, 42, 43.—McLEAN, J.; Ohio, 1839.

E. DEMURRER.

As to necessary substance in pleading, see PLEADING, A., B.

1. Where a plaintiff brought eleven *qui tam* actions for penalties against the same defendant, who demurred specially to each declaration, and the plaintiff joined in demurrer, a motion that one demurrer be argued, and that proceedings in the other cases be stayed, to abide the event of the one argued, was denied. A party bringing a multiplicity of suits must take the responsibility

of meeting them in the usual way. *Ferrett v. Atwill*, 1 Blatchf., 152, 153.—BERTS, J.; N. Y., 1846.

2. Where it is alleged as cause of demurrer that the declaration is not properly entitled, but the defect is not pointed out until on the argument, and consisted in a variance between the writ and the declaration, the court will not act upon it upon such suggestion. *Wilder v. McCormick*, 2 Blatchf., 32.—BERTS, J.; N. Y., 1846.

3. But if the objection had been properly raised, the court would have allowed an amendment of the error, under § 32 of the act of 1789. (1 *U. S. Stat. at Large*, 91.) *Ibid.*, 32.

4. Variances between the writ and declaration cannot be taken advantage of on general demurrer. *Ibid.*, 33.

5. Courts will not encourage objections merely critical, and will seek, even on special demurrer, to sustain pleadings substantially sufficient. *Ibid.*, 37.

6. If a demurrer is taken to all the pleas, and any one is found good, the demurrer will be overruled. *Brown v. Duchesne*, 2 Curt., 97.—CURTIS, J.; Mass., 1854.

7. Where in an action for the violation of a patent, the defendant pleaded the general issue and two special pleas, and the plaintiff demurred, alleging that the several pleas were insufficient," *Held*, that as one of the pleas, the general issue was good, the demurrer must be overruled. *Ibid.*, 97.

8. Where a demurrer does not restrict itself to the usual form of replying to one or more pleas, which is, as to the said pleas by the defendant secondly, or secondly and thirdly pleaded, the legal intendment is, that it applies to all. *Ibid.*, 97.

PRINCIPLE.

See also ART; DISCOVERY; EFFECT; MODE OR METHOD; PURPOSE.

1. The legal title to a patent consists not in a principle merely, but in an application of a principle, whether previously in existence or not, to some new and useful purpose. *Whitney v. Carter*, Fessenden on Pat., 2d Ed., 139.—JOHNSON, J.; Geo., 1809.

2. A mere abstract principle is unsusceptible of appropriation by patent. The applicant for a patent must show how the principle is to be used and applied to some useful purpose. *Evans v. Eaton*, Pet. C. C., 341, 342.—WASHINGTON, J.; Pa., 1816.

3. A principle, in the sense of an elementary truth or power, is not the subject of a patent. The true legal meaning of the principle of a machine, with reference to the patent act, is the peculiar structure or constituent parts of such machine. *Barrett v. Hall*, 1 Mas., 470, 471.—STORY, J.; Mass., 1818.

4. The word "principles," as used in the act of Congress, does not mean merely the elementary principles of bodies, as earths, alkalies, &c.; or of mechanic power, as the lever, screw, wheel, &c.; or of power obtained by water, air, fire, &c. Because scarcely any machine, medicine, or utensil could be constructed or operate without the aid of some such principles. It means not only elementary principles, but the application of them. *Holden v. Curtis*, 2 N. Hamp., 64.—WOODBURY, J.; N. H., 1819.

5. There must be the discovery of new principles, or the employment of old ones in a new proportion, or in a

new process, or to a new purpose. In the language of Lord Bacon, there must be "an invention of further means to endow the condition and life of man with new powers or works." *Ibid.*, 64.

6. The thing to be patented is not a mere elementary principle or intellectual discovery, but a principle put in practice and applied to some art, machine, manufacture, or composition of matter. *Earle v. Sawyer*, 4 Mas., 6.—STORY, J.; Mass., 1825.

7. What constitutes form, and what principle, is often a nice question to decide. The safest guide to accuracy in making the distinction, is to ascertain what is the result to be obtained by the discovery; and whatever is essential to that object, independent of the mere form and proportions of the thing used for the purpose, may generally, if not universally, be considered as the principles of the invention. *Treadwell v. Bladen*, 4 Wash., 706.—WASHINGTON, J.; Pa., 1827.

8. A patent cannot be for a principle or function of a machine, detached from machinery. *Blanchard v. Sprague*, 3 Sumn., 540.—STORY, J.; Mass., 1839.

9. A patent cannot be maintained for an abstract principle, or for all possible and probable modes of doing a thing; but such a patent would be utterly void. *Stone v. Sprague*, 1 Story, 272.—STORY, J.; R. I., 1840.

10. A patent for an abstract principle is void. *Wyeth v. Stone*, 1 Story, 285.—STORY, J.; Mass., 1840.

11. Where, therefore, in a patent for an improvement in the manner of cutting ice, the patentee claimed "as new, to cut ice of a uniform size by means of an apparatus worked by any other power than human," *Held*, that such a claim was utterly unobtainable in point of

law, as it was a claim for an art or principle in the abstract, and not for any particular method or machinery by which ice was to be cut. No man can have a right to cut ice by all means or methods, or by all or any sort of apparatus, although he is not the inventor of any or all of such means, methods, or apparatus. *Ibid.*, 285.

12. There cannot be a patent for a principle, nor for the application of a principle, nor for an effect. *Bain v. Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

13. Two persons may use the same principle and produce the same effect by different means, without interference or infringement, and each would be entitled to a patent for his own invention. *Ibid.*

14. A mere difference in form or size is not a difference in principle; but a new application of known mechanical power is, in regard to invention, a new principle. *Hoote v. Silsby*, 1 Blatchf., 459, 466.—NELSON, J.; N. Y., 1849.

15. A principle is not patentable. "The motive power of the galvanic current, however developed to produce a given result," can be no more patented than the motive power of steam to propel boats, however applied. *Smith v. Ely*, 5 McLean, 91.—MCLEAN, J.; Ohio, 1849.

16. The discovery of a new principle is not patentable, but it must be embodied and brought into operation by machinery so as to produce a new and useful result. *Tatham v. Le Roy*, MS.—NELSON, J.; N. Y., 1849.

17. He who first discovers that a law of nature can be applied, and having devised machinery to make it operative, introduces it in a practical form to the knowledge of his fellow-men, is a dis-

coverer and inventor of the highest grade—not merely of the mechanism, but of the force which operates through the mechanical medium, the principle, or, to use the synonym given for this term in the act of 1793, the *character* of the machine. *Parker v. Hulme*, 7 West. Law Jour., 422.—KANE, J.; Pa., 1849.

18. He may assert and establish his property, not only in the formal device for which mechanical ingenuity can at once, as soon as the principle is known, imagine a thousand substitutes—some as good, others better, perhaps all dissimilar, yet all illustrative of the same principle, and depending on it—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. *Ibid.*, 422.

19. This is not to patent an abstraction, but rather the invention, as the inventor has given it to the world, in its full dimensions and extent—nothing less, but nothing more. It is to patent the invention in the broad and general terms that properly express it, and to secure to the party the exclusive right, for a limited time, to precisely that discovery which he has imparted to the public, and which the public, when that limited time expires, will enjoy. *Ibid.*, 422, 423.

20. What is to be protected, is not an abstract or isolated principle, but the embodiment of a principle into a machine or manufacture, as described in the specification; and it is the invention in conformity with that embodiment or representation of its working, which the act of Congress protects. *Smith v. Downing*, MS.—WOODBURY, J.; Mass., 1850.

21. It is well settled that a patent cannot cover a new principle, without reference to any mode or method of enforcing it. *Ibid.*

22. The impropriety of granting a patent for the invention or discovery of a principle, however important it may be *per se*, rests on the idea that the exclusive use of the invention is given to the patentee to reward his genius and expense in making the invention, and pointing out how it can be used beneficially. The patent is, and must be, in order to possess validity, not for the principle—but 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 new mode adopted to accomplish certain results. *Ibid.*

23. Though some expressions may have been used by some of the judges, which look like a sanction to patenting a principle, yet they are used in the sense of a principle in operation, in the manner set out in the specification, or are used too loosely from haste and inadvertence. *Ibid.*

24. A patent cannot be for a principle or a result, but must be for the mechanical means by which the principle is carried into effect, or the result attained. *Brooks v. Fiske*, MS.—SPRAGUE, J.; Mass., 1851.

25. Although a mere abstract conception of the application of a principle is not the subject matter of a patent, yet when it is reduced to practice by any means, old or new, resulting usefully, it is the subject of a patent, independent of the machinery by which the application is made. *Foot v. Silsby*, 2 Blatchf., 265.—NELSON, J.; N. Y., 1851.

26. And it is immaterial whether the means used be new or old, for though

old means be used for giving application to the new conception, yet the patent excludes all persons other than the patentee from the use of those means, and of all other means, in a similar application. *Ibid.*, 265.

27. A principle in the abstract is a fundamental truth—an original cause—a motive; these cannot be patented, as no one can claim in either of them an exclusive right. Nor can an exclusive right exist to a new power, should one be discovered, as steam, electricity, or any other power of nature. *Le Roy v. Tatham*, 14 How., 175.—McLEAN, J.; Sup. Ct., 1852.

28. 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. *Ibid.*, 176.

29. In this case the patentees claim the combination of machinery described, as their invention, which can only be sustained by establishing its novelty. The question whether a newly discovered property of lead might be patented is not in the case. *Ibid.*, 177.

30. A patent cannot be for an effect produced, distinct from the process or machinery necessary to produce it. *O'Rielly v. Morse*, 15 How., 120.—TANEY, Ch. J.; Sup. Ct., 1853.

31. Morse's claim for "the use of the motive power of the electric or galvanic current, however developed, for marking or printing intelligible characters, at a distance;" *Held*, to be a claim for a principle, and therefore not patentable. *Ibid.*, 120.

32. A new principle or idea, until it becomes properly and practically clothed, is not patentable. *McCormick v. Ketchum*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

33. Neither principles, nor abstract philosophical ideas, nor the natural functions either of the human body, or of matters of nature, are patentable. *Morton's Case*, 8 Opin., 272.—CUSHING, Atty. Gen.; 1856.

34. A patent cannot be sustained for a mere principle; but a principle may be embodied and applied, so as to afford some result of practical utility in the arts and manufactures, and under such circumstances a principle may be the subject of a patent. It is, however, the embodiment and the application of the principle which constitutes the grant of the patent. *Wintermute v. Redington*, 1 Fisher, 247.—WILSON, J.; Ohio, 1856.

35. The principle so embodied and applied, and the principle of such embodiment and application, are essentially different: the former being a truth of exact science, or a law of natural science, or a rule of practice; the latter a practice founded upon such truth, law, or rule. *Ibid.*, 247.

36. A patentee claimed the application of the expansive and contractive power of a metallic rod by different degrees of heat, to open and close a damper which governs the admission of air into a stove. *Held*, that it was a valid claim, not being for a principle, and that the patent was good. *Silsby v. Foote*, 20 How., 385.—NELSON, J.; Sup. Ct., 1857. GRIER, DANIEL, JJ., dissenting, 1857.

37. The true doctrine is, that there cannot be a patent for a principle, for a result, or the function of a machine: but there may be a patent for a machine or manufacture, and when we come to

BY THIRD PERSONS; WHICH WILL DEFEAT A PATENT.

test the question of infringement, the question of principle comes up in this light, What is the mode of operation of the machine invented? *Singer v. Walmsley*, 1 Fisher, 563.—GILES, J.; Md., 1859.

38. A principle is not patentable; but if one discovers a principle, and a mode of operation, he has a right to have a patent for the mode of carrying the principle into effect; and if anybody takes his principle and his mode of operation, substantially, though he varies the form, he is an infringer. *Ibid.*, 563.

39. However brilliant the discovery of a new principle may be, to make it useful it must be applied to some practical purpose. Short of this no patent can be granted. *Le Roy v. Tatham*, 22 How., 137.—McLEAN, J.; Sup. Ct., 1859.

40. The principle may be the new and valuable discovery, but the practical application of it to some useful purpose is the test of its value. *Ibid.*, 137.

PRINCIPLE OF A MACHINE.

See MACHINES, A.

PRINTED PUBLICATION.

See PUBLIC WORK.

PRIOR KNOWLEDGE AND INVENTION.

See also, as bearing on this title, INVENTION, B.; INVENTOR, A., B.; PUBLIC WORK.

1. In this country, if it appears that the plaintiff was not the original in-

ventor, in reference to other parts of the world as well as America, he is not entitled to a patent. *Aliter*, in England, in consequence of the statute of James I., which speaks of new manufactures, *within the realm*. *Reutgen v. Kanows*, 1 Wash., 170.—WASHINGTON, J.; Pa., 1804.

2. In an action for a violation of a patent, to entitle the plaintiff to recover, the jury must be satisfied that he was the original inventor, not only in relation to the United States, but to other parts of the world. Even if there was no proof that the plaintiff knew that the discovery had been before made, still he could not recover, if in truth he was not the original inventor. *Dawson v. Follen*, 2 Wash., 311.—WASHINGTON, J.; Pa., 1808.

3. It is not necessary, to defeat a patent, that a machine should have previously existed in every respect similar: a mere change of former proportions will not entitle a party to a patent. *Woodcock v. Parker*, 1 Gall., 340.—STORY, J.; Mass., 1813.

4. The title of a patentee may be impeached by showing that his invention had been known and used before in any part of the world, although he was ignorant, at the time he received his patent, that the invention had been in use before his discovery. *Evans v. Eaton*, Pet. C. C., 342.—WASHINGTON, J.; Pa., 1816. [Affirmed, *post* 9.]

5. Any patent may be defeated, by showing that the thing secured by the patent had been discovered and put in actual use prior to the discovery of the patentee, however limited the use or the knowledge of the prior discovery may have been. *Bedford v. Hunt*, 1 Mas., 305.—STORY, J.; Mass., 1817.

6. If the first inventor reduced his

theory to practice, and put his machine or other invention into use, the law could never intend that the greater or less use in which it might be, or the more or less widely the knowledge of its existence might circulate, should constitute the criterion by which to decide upon the validity of any subsequent patent for the same invention. *Ibid.*, 305.

7. It makes no difference as to the patentee's rights, whether the prior machine or invention has fallen into disuse or not: if it was used before his discovery he cannot obtain a patent for it. *Evans v. Hettick*, 3 Wash., 443.—WASHINGTON, J.; Pa., 1818.

8. And it is immaterial whether the patentee had notice of a prior invention or not. If it was in use in any part of the world, however unlikely or impossible that the fact should come to the knowledge of the patentee, his patent for the same machine cannot be supported. *Ibid.*, 443.

9. Under § 6 of the act of 1793, if the thing had been in use or known anterior to the patentee's supposed discovery, his patent is void. Though the patentee had no knowledge of such previous use, still his patent is void, as the law supposes he may have known it. *Evans v. Eaton*, 3 Wheat., 514.—MARSHALL, Ch. J.; Sup. Ct., 1818.

10. If a defendant attempts to avoid a patent, by showing that the patentee was not the original inventor, the patent will be considered as relating back to the original *discovery*, and not to the time of *application* for a patent. *Dixon v. Moyer*, 4 Wash., 72.—WASHINGTON, J.; Pa., 1821.

11. Under the act of 1793, the invention must be new as to all the world, and must not have been "known or used before the application" either by

the inventor or others; and must be useful. The time of the discovery referred to in § 6, refers to the date of the application, and does not go back of it. *Thompson v. Haight*, 1 U. S. Law Jour., 573.—VAN NESS, J.; N. Y., 1822.

12. § 1 of the act of 1793 is to be construed with § 6, and means that the improvement or discovery should be unknown and not used as the invention of any other person than the patentee, before the application for a patent. *Morris v. Huntington*, 1 Paine, 352.—THOMPSON, J.; N. Y., 1824.

13. The use of an invention by another, while the inventor is practising and experimenting with it for the sake of perfecting his invention, will not invalidate the patent afterward granted the inventor. *Ibid.*, 354.

14. Under the act of 1793 the prior existence of an article the same in principle with an article patented, would not be regarded as impeaching the validity of such patent, if such article had never been in use before the patentee's invention. *Pennock v. Dialogue*, 4 Wash., 543.—WASHINGTON, J.; Pa., 1825.

15. The use of a machine even to a limited extent—as of a biscuit machine to the extent of perhaps half a barrel of flour—amounts to a using of it within the true meaning of § 6 of the patent act of 1793, and such as will invalidate a patent granted for a subsequent invention. *Watson v. Bluden*, 4 Wash., 583.—WASHINGTON, J.; Pa., 1826.

16. And it will make no difference that such use may have been for the purpose of testing its practical utility. *Ibid.*, 583.

17. The testimony of a witness that he had seen, before plaintiff's invention, articles resembling those produced by it, but of which he had no knowledge

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how they were made, is not sufficient evidence to invalidate plaintiff's patent, on the ground that he was not the first inventor, or that the same thing had been in use before his invention, unless the jury can safely conclude from the appearance of such articles, that they were made by a machine embodying the principles of plaintiff's patent. *Treadwell v. Bladen*, 4 Wash., 706.—WASHINGTON, J.; Pa., 1827.

18. The true construction of the act of 1793 is, that to invalidate a patent, the thing patented, where a prior patent is relied on, must have been used prior to the alleged *discovery* of the patentee, and that it is not sufficient to show that it was so used prior to the application. *Ibid.*, 708.

19. The rule, that if an invention has been in use, or described in a public work before the supposed discovery, the patent is void, whether the patentee knew of such previous use or publication or not, holds if the machines are the same in principle, though they may differ in proportions or form. *Brooks v. Bicknell*, 3 McLean, 263.—MCLEAN, J.; Ohio, 1843.

20. An inventor will not be deprived of the benefits of his invention and a right to a patent, by a use of his invention before his application for a patent, without his consent and against his will, and without any *laches* or misconduct on his part. *Pierson v. Eagle Screw Co.*, 3 Story, 407.—STORY, J.; R. I., 1844.

21. If a patentee is not the first or original inventor, in reference to all the world, he is not entitled to a patent, though he had no knowledge of any previous use or description of the invention. *Street v. Silver*, Brightly, 98.—ROGERS, J.; Pa., 1846.

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

23. 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.*

24. 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.*

25. 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, and the courts to declare it valid, and establishes 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.*

26. Where a prior invention is set up

to defeat a patent, such invention must be shown to be more than an idea, and must have been reduced to some practical use. An abortive experiment will not be sufficient. *Many v. Jagger*, 1 Blatchf., 383.—NELSON, J.; N. Y., 1848.

27. Where a prior invention was claimed to be substantially like a subsequent one, *Held*, the jury could take into consideration, in determining the question of identity, that such prior invention was known to persons who experimented to produce the subsequent one, but failed to do so. *Ibid.*, 386.

28. It is not enough to defeat a patent already issued, that another conceived the idea or possibility of effecting what the patentee accomplished. *Parkhurst v. Kinsman*, 1 Blatchf., 494.—NELSON, J.; N. Y., 1849.

29. 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. *Ibid.*, 494.

30. 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. *Ibid.*, 494.

31. Where a dispute arises as to priority of invention, a patentee is allowed to show the real date of it, and to have his rights as fully secured as if he had taken out his patent. *Parker v. Hulme*, 7 West. Law Jour., 424.—KANE, J.; Pa., 1849.

32. It is not enough in order to defeat a patentee's right, to show that a machine like that patented had been made, but it must also be shown that it was used before the plaintiff's in-

vention. This is the test of what is required, to defeat the title of the patentee of an improved machine. *Ibid.*, 425.

33. In order to confer any exclusive right on the patentee, the thing patented must have been original with the inventor, and not known to others. The only exception to this rule, is where an individual obtains a patent, believing the invention to be original, and it is made to appear it had been known in a foreign country, but not patented there, nor described in any printed publication. *Parker v. Stiles*, 5 McLean, 61.—MCLEAN, J.; Ohio, 1849.

34. Proof of a previous structure, bearing some resemblance in some respects to the plaintiff's improvements, and which might have been suggestive of ideas, or led to experiments resulting in the discovery and completion of his improvement, will not invalidate his patent. *Ibid.*, 62.

35. The prior construction and use of a thing, in one instance only, for private use, and which had never been brought to the knowledge of the public, and which had been finally forgotten or abandoned, before the invention of the same thing by another, who obtained a patent for it, will not invalidate such patent. *Gayler v. Wilder*, 10 How., 496, 498.—TANEY, Ch. J.; Sup. Ct. 1850.

36. Where a person, F., invented an improvement in safes, consisting of the use of a double iron chest, the space between which was filled with plaster of Paris, for which improvement letters patent were secured in 1843, and on an action for an infringement, brought by his assignee, G., it was proved that C., between the years 1829 and 1832, had constructed for his own use a safe substantially the same, and used the same

until 1838, when it passed out of his hands, and no other trace of it was shown; and C. himself also purchased another safe for his own use, and there was no evidence that F. even had any knowledge of the invention and use by C.; *Held*, that F. was to be considered as a first and original inventor within the meaning of the patent laws of the United States, notwithstanding the prior use by C., F. being in reality the first to confer on the public the benefit of the invention, the safe of C. having passed from his memory and those who had seen it, and having disappeared, and the knowledge of the improvement being as completely lost as if it had never been discovered. *Ibid.*, 496, 498.

37. By the knowledge and use, referred to in § 6 of the act of 1836, is meant knowledge and use existing in a manner accessible to the public. *Ibid.*, 497.

38. The same rule holds also in respect to the lost arts. If any one should discover a lost art, and it was a useful improvement, he would be entitled to a patent, though he would not literally be the first and original inventor. But he would be the first to confer on the public the benefit of the invention. He would discover what is unknown, and communicate knowledge which the public had not the means of obtaining without his invention. *Ibid.*, 497.

39. The patentee must be the original inventor of the machine or improvement, or he can receive no patent. The original inventor, means the first inventor, subject only to the provision of § 15 of the act of 1836. The law authorizes no presumption of forgetfulness. The question is, was C.'s invention prior to F.'s. It is of no importance that C.'s invention was used only for his *private*

purpose. The invention is the question, and not the manner of its use. If F. was not the original and first inventor, he is not entitled to a patent. *Ibid.*, 499-502, 506, 507.—McLEAN, J.; DANIEL, J., Dissenting.

40. The illustration of a lost art is not apposite to the case. That term is applicable to certain monuments of antiquity still remaining, but the process of whose accomplishment has been lost for centuries. If a means of producing the effect we see and know be discovered and none can by history or tradition refer to a similar, or the identical process, the inventor may claim the merit of originality, though the work may have been produced possibly by the same means. *Ibid.*, 508.

41. To defeat a patent on the ground of prior invention, the question is whether anterior to such patent, any person had discovered the application of the principle involved in such patent, and applied it by some apparatus which operated to effect the object secured by such patent. *Foote v. Silsby*, 2 Blatchf., 266.—NELSON, J.; N. Y., 1851.

42. In order to overthrow the claim of a patentee, the thing set up in defence, tending to disprove the novelty of the patentee's invention, must be of practical utility, and must have embraced all the elements of the patentee's combination. *Ibid.*, 274.

43. To the general rule laid down in *Evans v. Euton*, Pet., C. C., 349, that if an inventor abandons his invention, no other person can take out a patent for it, there are exceptions, as in the case of the lost arts, where the knowledge of the invention has been as completely lost as if it had never been discovered. *Rich v. Lippincott*, 2 Fisher, 7.—GRIER, J.; Pa., 1853.

44. But if the original invention remained in existence and use, and has not been entirely lost and forgotten, the omission of the original inventor to bring it into public use or notice does not give a subsequent inventor a right to a patent. *Ibid.*, 7.

45. And though the first inventor may have abandoned its use, and been ignorant of the extent of its value, a subsequent inventor of the same thing would not be entitled to a patent therefor, provided the original invention, and the mode of its construction, were still in the memory of the original inventor, or in the knowledge of others, before they were recalled by the subsequent inventor. *Ibid.*, 7-8.

46. If the first inventor reduced his theory to practice, and put his invention into use, the law never would intend that the greater or less use in which it might be, or the more or less widely the knowledge of its existence might circulate, should constitute the criterion by which to decide upon the validity of any subsequent patent for the invention. *Ibid.*, 6.

47. Though a prior inventor has gone to a certain extent, if he fall short of making a complete machine, practically useful, those who come after him may secure to themselves the advantages of his invention. The first inventor gave nothing to the public; it was only an idea, never carried out in a machine that could anticipate one subsequently invented. *Howe v. Underwood*, 1 Fisher, 166.—SPRAGUE, J.; Mass., 1854.

48. It is not the law, that if a prior inventor has gone to a certain extent, although he fall short of making a complete machine, practically useful, those who come after him have no right to secure to themselves the advantage of his invention. *Ibid.*, 167.

49. If the thing invented or discovered has been described in any foreign publication, before the invention of the patentee, it will be fatal to his right. This goes upon the presumption, if such foreign publication has been made, the patentee may have acquired a knowledge of it; and this presumption is not rebutted by proving, so far as a negative can be proved, that the inventor had no knowledge of it. *Allen v. Hunter*, 6 McLean, 313, 314.—MCLEAN, J.; Ohio, 1855.

50. To defeat a patent on the ground of prior invention, it is not sufficient that another person has conceived the possibility of effecting what the patentee has accomplished. To constitute a prior invention, the party alleged to have made it must have proceeded so far as to have entitled himself to a patent, in case he had made an application. *Ibid.*, 321.

51. A prior accidental combination or invention, similar in character to that which the plaintiff has patented, but under circumstances such that the public obtained no knowledge of the invention, will not defeat a patent. *Ransom v. Mayor, &c.*, 1 Fisher, 265.—HALL, J.; N. Y., 1856.

52. As to the question of infringement, it is a standing principle of law, that every person is entitled to the free use of whatever was known and used, prior to the patent which attempts to appropriate it as a new discovery, and it is unimportant whether the character and capacities of machinery open to general use are understood or not by the public at large, or had been used by many; it is sufficient to show that the public had free means of access to it, and to employ it, and the law then presumes it was well known and in public

use. *Smith v. Higgins*, MS.—BETTS, J.; N. Y., 1857.

53. A previous description of a thing in a patent or work is like notice, and of the same effect against a patentee, as a public use of the thing itself. Such prior use or notice must, however, have been prior to the date of the patentee's discovery, or at least before the filing of his application for a patent. *Ibid.*

54. It is to be assumed, that persons obtaining patents have acquainted themselves with the state of the art in which they are interested, as made known in books or by machines built and put in use; and evidence is not admissible to prove the contrary; nor is it matter of inquiry whether machines described in printed works were ever practically put to use or not. *Ibid.*

55. Under § 15 of the act of 1836, providing that the prior knowledge or use of a thing in a foreign country—it not appearing that the same had been before patented or described in a printed publication—should not invalidate a patent granted here, the patentee believing, at the time of his application, that he was the first discoverer or inventor. If the jury find that the patentee, when he made application for a patent, believed himself to be the first inventor of the thing patented, his patent will not be invalidated by the prior existence of the thing abroad. *Forbush v. Cook*, 10 Mo. Law Rep., 664.—CURTIS, J.; Mass., 1857.

56. 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. *Ibid.*, 664.

57. To constitute a prior invention or knowledge, which will deprive a patentee of the right granted to him, it is not enough that the person conceived the idea that the thing could be done; but he must have put his idea into practice. *Poppenhausen v. N. Y. G. I. Comb Co.*, 2 Fisher, 68.—INGERSOLL, J.; N. Y., 1858.

58. To defeat a patent which has been issued, it is not enough that some one, before the patent, conceived the idea of effecting what the patentee accomplished. To constitute such a prior invention as will avoid a patent that has been granted, it must be made to appear that some one, before the patentee, not only conceived the idea of doing what the patentee has done, but also that he reduced his idea to practice, and embodied it in some useful and practical form. The idea must have been carried into practical operation. *Ellithorpe v. Robertson*, 4 Blatchf., 309.—INGERSOLL, J.; N. Y., 1859.

59. Experiments made, equivocal in their results, and given up for years, will not be permitted to prevail against an original inventor who has reduced his invention to practice, and has without fraud obtained a patent. *Ibid.*, 309.

60. The decision in *Gayler v. Wilder*, 10 How., 496, 1850, is only that if the discovery of the first inventor had been so far laid aside, that it was in point of fact absolutely and irrevocably forgotten by him and by the world, but for its recall to his memory by the second invention, then the second inventor must

be held equally meritorious as the one who discovers a long lost art, or an unpatented and unpublished foreign invention, and like him entitled to a patent. *Babcock v. Degener*, MS.—(App. Cas.)—MERRICK, J.; D. C., 1859.

61. The first proviso of § 15 of the act of 1836 qualifies the language of § 6 of the same act; by knowledge and use the legislature meant knowledge and use accessible to the public. *Cahoon v. Ring*, 1 Fisher, 410.—CLIFFORD, J.; Me., 1859.

62. Where, therefore, a person invented a machine, but did not make it public, and had used it for no purpose except simply for his own private experiments, and it had been broken up, and the materials used for other purposes, and its essential parts had been lost, prior to the invention of the same thing by another person, who had obtained a patent for his invention, *Held*, that such prior invention and use was no obstacle to the subsequent inventor taking out a patent, and would not invalidate his patent. *Ibid.*, 411.

63. And if a single specimen only of such machine was made, whether capable of use, or whether actually used or not by the party making it, for the purpose of testing its operation, if such machine was kept in the maker's own possession, from the knowledge of the public, and was subsequently broken up, and its substantial parts lost, so that the public could not derive the knowledge of it from the machine itself, but only from the memory of the alleged inventor, the existence of such prior machine will not invalidate the patent of a subsequent inventor, though such prior machine may have embodied all the improvements of the subsequent one, if the subsequent inventor was an original

inventor, without knowledge of the prior one. *Ibid.*

64. The prior use of an invention in England, from 1855 to 1859, but not with the consent of the inventor, is no bar to his receiving a patent therefor. *Fry & Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

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

66. A patent will not be avoided, by the mere fact that the invention or discovery patented had been known and used in a foreign country before the discovery of the patentee, provided the patentee, at the time of his application for a patent (act of 1836, § 15), believed himself to be the first and original inventor of the thing patented. *Bartholomew v. Sawyer*, 4 Blatchf., 350.—INGERSOLL, J.; N. Y., 1859.

67. No description in any printed publication, of the thing patented will avoid a patent, unless such publication was prior in point of time to the *invention* of the patentee. It is not sufficient that such publication was prior to the *application* of the patentee for his patent. *Ibid.*, 351.

68. The time referred to in § 15 of the act of 1836, by the terms "having been before known and used in any foreign country," or "had been patented or described in any printed publication," is the time when the original discovery or invention of a patentee was made, and not the time when he presented his application for a patent. *Ibid.*, 352.

69. It is not proof of the want of

BY INVENTOR; TO FORFEIT RIGHT TO A PATENT.

originality or novelty in an invention for which an American citizen has obtained a patent, that it may have been known or used in a foreign country, unless it appears that the invention or improvement was patented in such foreign country, or there described in some public work. *Judson v. Cope*, 1 Fisher, 623.—LEAVITT, J.; Ohio, 1860.

70. But to make such a defence available, it must appear that the improvement which has been known in a foreign country has been so clearly and intelligibly described, that the invention could be made or constructed by a competent mechanic. A mere suggestion or imperfect description of an invention would not be sufficient to defeat the American patent. *Ibid.*

71. To defeat a patent by reason of prior use or knowledge, such prior use or knowledge must be shown to have been anterior not merely to the date of the patent, but to the time when the invention was actually made. *Ibid.*

72. Evidence cannot be received of actual use and knowledge of an invention in a foreign country, prior to the time of the invention here, in order to defeat the American patent, but the defendants must be confined to the description of the invention as found in printed publications or patents; they cannot go beyond such publication or patents, because no prior use abroad, unless the invention has been described in a printed publication or has been patented, will affect the validity of the patent in this country. *Ibid.*

73. It is not necessary to show that a prior invention had ever been put in use; it is enough to bar a right to a patent to show that the thing had been described. *Sceley, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

74. If an invention is completed, it is wholly immaterial as to the question of priority of invention, how limited was the use or knowledge of the prior discovery. *Sturtevant v. Greenough*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

75. To constitute a prior invention, which will avoid a patent, it is necessary that there should have been not only an idea of the machine, but it should have been embodied in a working machine. Mere experiments, which were unsatisfactory and have been abandoned, are not enough. *Winans v. Danforth*, MS.—NELSON, J.; N. Y., 1860.

PRIOR USE.

See also ABANDONMENT, B. 1.

1. If an inventor had gratuitously imparted, or negligently suffered his invention to become public before his application, he is not entitled to a patent therefor. *Thompson v. Haight*, 1 U. S. Law Jour., 575.—VAN NESS, J.; N. Y., 1822.

2. The meaning of the words "not known or used," in § 1 of the act of 1793, is that the invention for which a patent is sought must not have been known or used by others before the application. If it were necessary for the inventor to employ others to assist him in the original structure or use by himself, or if, before his application, his invention should be pirated by another, or used without his consent, such knowledge or use will not invalidate the patent. *Pennock v. Dialogue*, 2 Pet., 18, 19.—STORY, J.; Sup. Ct., 1829.

3. But although he is the first as well as the true inventor, yet if he puts his

invention into public use, or sells it for public use before he makes an application for a patent, such use can be set up as a bar to his patent under § 6 of the act of 1793. *Ibid.*, 23.

4. The true construction of the patent act of 1793, is that the first inventor cannot acquire a good title to a patent, if he suffers the thing invented to go into public use, or to be publicly sold for use before he makes application for a patent. His voluntary act or acquiescence in the public sale and use, creates a disability to comply with the terms and conditions on which alone a patent can issue to him. *Ibid.*, 23, 24.

5. The previous use, to avoid a patent, must not be a private or surreptitious use, in fraud of the patentee, but a public use by his consent, by a sale by himself, or by others with his acquiescence, by which he abandons his right, or disables himself from complying with the law. *Whitney v. Emmett*, Bald., 309, 310.—BALDWIN, J.; Pa., 1831.

6. But unless the invention has been more or less used by others, or publicly communicated by the patentee, his patent will be sustained. *Ibid.*, 310.

7. The time during which the thing patented had been known and used, is not material, the criterion is its public, not its private or surreptitious use, the use with the consent of the inventor, express or implied, from circumstances. *Ibid.*, 310.

8. The patentee may make experiments with his invention, or disclose it to those he may wish to consult, or employ others to assist him in making and using it, or may explain it to those using it, so as to give notice of an infringement, without impairing his patent, unless he is guilty of negligence in procuring his patent. *Ibid.*, 310, 311.

9. The prior knowledge and use spoken of in the act of 1793, has reference to the public only, but there may be cases in which a knowledge of the invention may be surreptitiously obtained, and communicated to the public, that do not affect the right of the inventor. Under such circumstances, no presumption can arise in favor of an abandonment of the right to the public by the inventor, though an acquiescence on his part will lay the foundation for such a presumption. *Shaw v. Cooper*, 7 Pet., 319.—MCLEAN, J.; Sup. Ct., 1833.

10. Under §§ 3 and 6 of the act of 1793, and §§ 6 and 15 of the act of 1836, the public use or sale of an invention, in order to deprive the inventor of his right to a patent, must be a public use or sale by others with his knowledge and consent, before his application for a patent. *Ryan v. Goodwin*, 3 Sumn., 518.—STORY, J.; Mass., 1839.

11. If the use or sale is without such knowledge or consent, or if the use be merely experimental, to ascertain its value, or utility, or the success of the invention, by putting it in practice, that is not such a use as will deprive the inventor of his title. *Ibid.*, 518.

12. Such use or sale must also be before application. A sale or use with his knowledge and consent, intermediate between his application for a patent and the grant thereof, has no such effect. *Ibid.*, 519.

13. The use of an invention before application for a patent, to be sufficient to defeat a patent, under § 15 of the act of 1836, must be a public use of the invention substantially as patented—with the consent of the inventor—and must be either generally allowed or acquiesced in, or at least be unlimited in time, or extent, or object. *Wyeth v*

Stone, 1 Story, 281.—STORY, J.; Mass., 1840.

14. A mere occasional use by the inventor, in trying experiments, or a temporary use by a few persons, as an act of personal accommodation or kindness for a short and limited period, will not take away a right to a patent. *Ibid.*, 281.

15. On the other hand, a user without the inventor's consent, and adverse to his patent, is a clear violation of his rights, and cannot deprive him of his patent. *Ibid.*, 281.

16. The circumstances ought to be very clear and cogent, which will justify a court in adopting a conclusion so subversive of private rights—that a user of an invention before application for a patent, destroys the right to a patent—when the party has subsequently taken out a patent. *Ibid.*, 281.

17. § 7 of the act of 1839 allows the use of an invention, even by leave of the inventor, for two years before application, without invalidating his right to a patent; *a fortiori*, the use by a third person, or a subsequent inventor, after the first invention and before the issuing of a patent to the first inventor, without his consent, is no bar to the issuing of a patent to the first inventor. *Hildreth v. Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

18. The use of an invention by the patentee himself, before his application for a patent, will not deprive him of his right to a patent. *Reed v. Cutter*, 1 Story, 597.—STORY, J.; Mass., 1841.

19. It would be a fair construction of § 15 of the act of 1836, that if an inventor allow another, without objection, to use his invention for a time, before making an application for a patent, but afterward obtain a patent, that such

public use would make the subsequently obtained patent void. But if such use is regarded as under an assumed license, the patent might still be regarded valid. *McClurg v. Kingsland*, 1 How., 208.—BALDWIN, J.; Sup. Ct., 1843.

20. § 7 of the act of 1839, allowing the use and sale of an invention, for two years before the application for a patent, is in the nature of a statute of limitations; and the defendant setting up a sale more than two years before, must establish the fact of such a sale, in a manner that will justify a jury in taking away the property of the plaintiff. *Hovey v. Henry*, 3 West. Law Jour., 155.—WOODBURY, J.; Mass., 1845.

21. The prior use or sale of an invention, referred to in § 7 of the act of 1839, has exclusive reference to an original application for a patent, and not to a renewal or reissue of it. *Stimpson v. West Chest. R. R.*, 4 How., 403.—MCLEAN, J.; Sup. Ct., 1845.

22. It is clear that under the act of 1836, and the act of 1839, a use, in order to defeat a prior invention, must be public, and with the consent of the inventor, and continue two years. *Allen v. Blunt*, 2 Wood. & Min., 143.—STORY, J.; Mass., 1846.

23. Neither a stipulation for the sale of an invention before it is completed, nor a sale of such invention during the application for a patent, is such a use as will defeat a patent. *Sparkman v. Higgins*, 1 Blatchf., 209.—BETTS, J.; N. Y., 1846.

24. An inventor may *forfeit* his right to a patent, if he constructs and vends his invention to others for use, or uses it publicly at any time prior to two years before he makes application for a patent. That is, he is not allowed to derive any benefit from the sale or use of

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his machine without forfeiting his right, except within two years prior to the time of his application. *Pitts v. Hall*, 2 Blatchf., 235.—NELSON, J.; N. Y., 1851.

25. Such use however must be by the inventor himself publicly, in the ordinary way of a public use of the machine, and not by way of experiment, and with a view to further improvements, or of ascertaining its defects. *Ibid.*, 235, 236.

26. This ground of forfeiture is not favored in law; the evidence must be quite clear that the use was not by way of experiment, or for the purpose of perfecting a machine, in order to justify the conclusion that the patentee had forfeited his right to the improvement. *Ibid.*, 237.

27. Under the act of 1839, an inventor may use his improvement, by making and using his machines, and by vending and taking pay for them, for two years previous to his application for a patent, without forfeiting the benefits conferred upon him by his patent. But if an inventor either sells a machine or uses one, or puts one into public use, at any time more than two years before his application, it works a forfeiture of his right to a patent. *McCormick v. Seymour*, 2 Blatchf., 254.—NELSON, J.; N. Y., June, 1851.

28. How far the use of an invention for a time, so long as it could be kept a secret, and securing a patent only when there was danger of discovery, would invalidate a patent granted; *query*. *Goodyear v. Day*, MS.—GRIER, J.; N. J., 1852.

29. The use of an invention which will operate as a forfeiture, must be the use of the perfected invention—the invention complete. If the use be ex-

perimental, to ascertain the value, or the utility, or the success, of the thing invented, by putting it into practice by trial, such use will not deprive the patentee of his right to the product of his genius. *Winans v. N. Y. & Har. R. R.*, 31 Jour. Fr. Inst.; 3d Ser., 322.—NELSON, J.; N. Y., 1855.

30. An absolute sale by an inventor of his invention to another, is equivalent to a public use of his invention with his consent, and the inventor cannot, by a repurchase of his invention, resume any rights he may have lost by such a sale. *Hunt v. Howe*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

31. Unless the use of an invention exceeds two years before an application for a patent, there is no abandonment. *Heinrich v. Luther*, 6 McLean, 347.—MCLEAN, J.; Ohio, 1855.

32. The sale of an invention for more than two years before an application for a patent, bars the applicant under § 7 of the act of 1839, of his right to a patent. *Rugg v. Haines*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

33. Both before and since the act of 1839, an inventor might exercise and put in use his invention, or his claim to an inchoate right to an invention, which was capable of being perfected to an exclusive right, by obtaining letters patent. *Sargent v. Seagrave*, 2 Curt., 555.—CURTIS, J.; R. I., 1855.

34. Before the act of 1839, he could, by way of experiment, bring the knowledge of his invention before the public, at the same time making known that he was about to apply for a patent. Since the act of 1839, he may sell any number of his machines to the public, during any period less than two years, accompanied by a claim to the inchoate right sufficient to show an intention not

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to abandon it to the public. *Ibid.*, 555.

35. No knowledge or use of an invention, by any one, will deprive the first and original inventor thereof of the exclusive right to make and use the same, unless such knowledge and use was for more than two years prior to the application for a patent. *Sickles v. Mitchell*, 3 Blatchf., 550.—INGERSOLL, J.; N. Y., 1857.

36. As to the use of an invention under § 7 of the act of 1839, for more than two years before the application for the patent, where there has been more than one application, the two years must date from the time of the filing of the first application, at least if such first application has not been withdrawn. *Bell v. Daniels*, 1 Fisher, 377.—LEAVITT, J.; Ohio, 1858.

37. Where an application was made in January, 1838, to which objection was made, and afterward an amended specification was filed, upon which a patent was issued in March, 1840, *Held*, that the two years dated from the first filing. *Ibid.*, 377.

38. Where a party filed a caveat in 1847, made his application in 1851, which was rejected, and withdrew his application in 1852, and in 1857 made a new application for a patent, for the same invention; but it appeared that he had been manufacturing and selling his invention for more than two years before his last application, *Held*, that he had abandoned his invention, and could not receive a patent. *Mowry v. Barber*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

39. § 7 of the act of 1839, gives to inventors the privilege of a prior use for two years; but it thereby limits such use to two years, and precludes a pub-

lic use for a longer period. *Shreeve v. United States*, MS.—LORING, J.; Ct. Claims, 1859.

40. Under the act of 1839, the right to a patent is forfeited only where the invention has been in use more than two years before the *application*, and not before the granting of his patent. *Adams v. Jones*, 1 Fisher, 530.—GRIER, J.; Pa., 1859.

41. If a party allow his invention to go into public use, or sell it, for more than two years before he makes application for a patent, he is not entitled to receive a patent. *Cowperthwaite v. Gill*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

42. The putting on sale—out of the possession or control of the inventor—without limit or restraint as to public or private use, an invention more than two years before application for a patent, though some of the articles may have been sold on condition, with the right to return them; *Held*, such a sale as bars the inventor under § 7 of the act of 1837, to a right to a patent. *Seeley v. Bean*, MS. (App. Cas.)—MORSELL, J.; D. C., 1861.

43. Under the act of 1836, the use of an invention, by a single person, or a sale of the thing invented to a single person, might amount to such a public use, with the consent or allowance of the patentee, as would forfeit his right to a patent. § 7 of the act of 1839, provided a remedy for cases where the conduct of the party did not show an actual abandonment. *Sanders v. Logan*, 2 Fisher, 173.—GRIER, J.; Pa., 1861.

44. The use of several machines in public, for more than two years prior to applying for a patent, although slightly varying in form and arrangement, yet substantially the same as afterward patented, cannot be alleged to be ex-

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perimental, so as to avoid the legal consequences of such prior use. *Ib.*, 173.

45. The obvious construction of § 7 of the patent act of 1839, is that a purchase, sale or prior use, within two years before applying for a patent, shall not invalidate, unless it amounts to an abandonment to the public. *Ibid.*, 173.

PROFERT.

See PLEADING, C.

PUBLIC USE.

1. Public use is opposed to private use. If a man has an invention and uses it privately, and nobody knows of it, then the use of it cannot debar another person from an invention or patent of it. *Adams v. Edwards*, MS.—J.; Mass., 1848.

2. A public use need not be a general use by the community. It must be used, however, and used openly, so that the structure and *modus operandi* are apparent. *Ibid.*

3. A public use, as meant by the statute, is a use in public—it need not be generally adopted by the public. Public is not equivalent to general, but distinguished from secret use—used in a public manner. *Hunt v. Howe*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

4. An absolute sale by an inventor of his invention to another, is equivalent to a public use of his invention with his consent, and the inventor cannot, by a repurchase of his invention, resume any rights he may have lost by such a sale. *Ibid.*

5. The *public use* referred to in § 7

of the act of 1836, means *public* as opposed to *secret*, a use *in public* and not *by* the public. *Ellithorpe v. Robertson*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

PUBLIC WORK, OR PRINTED PUBLICATION.

See also PRIOR KNOWLEDGE AND INVENTION.

1. A report of a company describing a thing patented cannot be read in evidence, under the provisions of the patent law, § 6 of the act of 1793, as it is a private not a public work. *Pennock & Sellers v. Dialogue*, 4 Wash., 545.—WASHINGTON, J.; Pa., 1825.

2. Where the defence that a machine claimed to be essentially similar to that of the plaintiff is set up, and the proof relied on is a description of such machine contained in a written publication, such description must be sufficiently full and precise to enable a mechanic to construct it, and must be in all material respects like that covered by or described in the plaintiff's patent. *Parker v. Stiles*, 5 McLean, 61, 62.—MCLEAN, J.; Ohio, 1849.

3. If the thing invented or discovered has been described in any foreign publication before the invention of the patentee, it will be fatal to his right. This goes upon the presumption, if such foreign publication has been made, the patentee may have acquired a knowledge of it. And this presumption is not rebutted by proving, so far as a negative can be proved, that the inventor had no knowledge of it. *Allen v. Hunter*, 6 McLean, 314.—MCLEAN, J.; Ohio, 1855.

4. A public work or printed publica-

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tion may be proved, as to its contents, and the fact of publication, by the production of the book, or by parol testimony. *Ibid.*, 314.

5. A book introduced in evidence under § 15 of the act of 1836, to prove that the invention of the plaintiff had been described, before the discovery thereof by the patentee, is not evidence of any other facts or matter contained in it, beyond the description of the invention referred to. *Seymour v. McCormick*, 19 How., 107.—NELSON, J.; Sup. Ct., 1856.

6. A patent will not be avoided, by the mere fact that the invention or discovery patented had been known and used in a foreign country, before the discovery of the patentee, provided the patentee at the time of his application for a patent (act of 1836, § 15) believed himself to be the first and original inventor of the thing patented. *Bartholomew v. Sawyer*, 4 Blatchf., 350.—INGERSOLL, J.; N. Y., 1859.

7. The description of an invention in any public work, to invalidate a patent, should be, to some degree, in the nature of a specification, so far as to enable a mechanic skilled in the art to construct the machine; they should not be vague references to or suggestions of the thing described. *Coleman v. Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

8. To render admissible in evidence under § 15 of the act of 1836 a printed publication, it is not necessary to make proof of the date of its publication. A book purporting on its title-page to be published in "London in 1840," was admitted without other proof of publication being required. *Judson v. Cope*, MS.—LEAVITT, J.; Ohio, 1860.

9. A book of plates, unaccompanied by any description whatever, cannot be

received in evidence under § 15 of the act of 1836. *Semble*, that it is not a "printed publication." 1 Fisher, 19.

10. Under the laws concerning patents for inventions, a previous description of the alleged invention in a "public work," which means a printed book, defeats a patent. But such a description in an *unprinted* book has no such effect. *Keene v. Wheatley*, 9 Amer. Law Reg., 65.—CADWALLADER, J.; Pa., 1860.

PUBLICATION OF BOOK OR MANUSCRIPT.

1. A sale of a book imports publication. It is to be presumed that the purchaser exercised his right to know the contents of the book, and make them known to others, or that an actual publication followed the sale. *Baker v. Taylor*, 2 Blatchf., 85.—BETTS, J.; N. Y., 1848.

2. Where copies of a book were sold prior to the deposit of the title-page in the clerk's office, *Held*, that such sale was evidence of the publication of the book at the time of sale. *Ibid.*, 85.

3. And where a printed copy of a book, then complete, was deposited in the clerk's office at the same time the title-page was deposited there, *Held*, that this fact warranted the inference of actual publication before the deposit of the title-page. *Ibid.*, 85.

4. The first publication of a work, without having secured a copyright, is a dedication of it to the public; that having been done, any one may republish it. *Bartlett v. Crittenden*, 5 McLean, 37.—MCLEAN, J.; Ohio, 1849.

5. An acquiescence in the publication

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

6. 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.

7. 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.

8. But 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.

9. The acting or representation of a play is not a publication within the meaning of the statute. *Roberts v. Myers*, 13 Mo. Law Rep., 398.—SPRAGUE, J.; Mass., 1860.

10. In the absence of any legislation for the special protection of dramatic literary property, an authorized public circulation of a printed copy of a drama, for which there is no legislative copyright, is a publication which legalizes a subsequent theatrical representation by anybody from such copy. *Keene v. Wheatley*, 9 Amer. Law Reg., 44.—CADWALLADER, J.; Pa., 1860.

11. The intended meaning of the word *publication*, in the acts respecting copyrights, is publication *in print*. *Ibid.*, 44, 45, 65.

12. A publication of a composition is an act which renders its contents, in

any mode or degree, an addition to the store of human knowledge. *Ibid.*, 77.

13. An *unqualified* publication dedicates it to the public. *Ibid.*, 78.

14. A *limited* publication of it is an act which communicates a knowledge of the contents to a *select few*, upon conditions expressly or impliedly precluding its rightful ulterior communication, except in restricted private intercourse. *Ibid.*, 80.

15. Any publication which is not restricted, both as to persons and purpose, is *general*. When the word *publication* is used without any express qualification, a *general publication* is meant. *Ibid.*, 80, 99.

16. A publication is not directly affected by printing, but follows it. *Ibid.*, 82.

17. The sale of a single copy only, of a first edition of a book, is a general publication. But in such a case, if its literary proprietor has possession of all the other copies, and of the manuscript from which they were printed, and wishing to suppress the publication, buys back the copy sold before it has been read, he must stand on the same footing as if he had never parted with it. That before he got it back the purchaser may have read it, can make no rational difference, unless the impression on the latter's memory may enable him to make ulterior publication. *Ibid.*, 93.

PURPOSE.

See also EFFECT; NEW APPLICATION.

1. Intent is no ground of a patent. *Kemper, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. If the thing done be not new, the

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intent with which the act is done, cannot entitle it to a patent. *Ibid.*

3. 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. 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 fastened, is not the subject of a patent. *Hazard v. Green*, MS. (App. Cas.)—CRANCH, Ch., J.; D. C., 1847.

5. 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.

6. 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 of and the heat of a common stove, is the subject of a patent. *Boote v. Silsby*, 1 Blatchf., 464.—NELSON, J.; N. Y., 1849.

7. 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. R.*, 2 Blatchf., 293.—CONKLING, J.; N. Y., 1851.

8. 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.

9. The object and purpose of two inventions may be referred to and 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 will be patentable, though it may have some resemblances to the other. *Barstow, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

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

11. 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.

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A. WHEN MAY BE HAD; BY WHOM; FOR WHAT.

See also REISSUE, B.

1. A defective patent may be surrendered and a new patent taken for the unexpired part of the original term—for a term less than fourteen years. The restriction of time is on the *maximum* only, not on the *minimum*. *Sullivan's case*. Opin.; Gilpin's Ed., 1841, 168.—WIRT, Atty. Gen.; 1818.

2. Even under the patent laws of 1793, *Held*, that there was no good reason why on an *ex parte* application a patent could not be surrendered and cancelled of record in the department of state, if no misconduct be imputable to the patentee in taking it out: but the second patent should only be for the unexpired balance of the fourteen years. *Morris v. Huntington*, 1 Paine, 355, 356.—THOMPSON, J.; N. Y., 1824.

3. Previous to the act of 1836, a patentee had the right to surrender his patent and take out a new one, and on a trial the new patent was to be considered in the same light as if no other had been issued. *Grant v. Mason*, 1 Law & Int. Rev., 22.—THOMPSON, J.; N. Y., 1828.

4. A patent may be surrendered and a new one taken, including an additional improvement, and bearing the same date with the original patent. *Anon.*, 2 Opin., 456.—TANEY, Atty. Gen., 1831.

5. Under the patent act of 1793, the Secretary of State had power to receive a surrender of a patent, cancel the record thereof, and issue a new patent for

the unexpired portion of the term, when the defect in the specification arose from mistake, without fraud or misconduct of the patentee. *Grant v. Raymond*, 6 Pet., 242.—MARSHALL, Ch. J.; Sup. Ct., 1832.

6. Its emanation, though not founded on the words of the law, is indispensably necessary to the faithful execution of the promise made by the government to reward the inventor. *Ibid.*, 242.

7. The holder of a defective patent may surrender it to the department of state and obtain a new one. The new patent has relation to the original transaction, and the application may be considered as appended to the original application. *Shaw v. Cooper*, 7 Pet., 314, 315.—MCLEAN, J.; Sup. Ct., 1833.

8. In regard to the right of a patentee to surrender a defective patent and take out a new one, there is no difference between a citizen and alien. *Ibid.*, 314.

9. An assignee of a patent cannot make a surrender of the patent and obtain a reissue without the co-operation of the original patentee. The assignee cannot swear to the invention, as specified in the new specification: no one but the inventor himself can make the oath required. *Goulding's Case*, 2 Opin., 572.—TANEY, Atty. Gen.; 1833.

10. Unless there be some error in the specification arising from inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, a patentee cannot surrender a patent which includes several distinct improvements and take out several new ones. *Anon.*, 3 Opin., 164.—BUTLER, Atty. Gen.; 1836.

11. An effort on the part of an inventor to include several distinct improvements in his first patent, and then to surrender it and take out several new

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ones, so as to pay but one fee on the surrender, and thereby defraud the revenue, would be such a fraudulent design as to be within the law and destroy the right to surrender. *Ibid.*, 164.

12. There is nothing in the provisions of § 13 of the act of 1836, and § 8 of the act of 1837, as to the reissue of a patent, which requires the patentee to claim all things in the renewed patent which were claimed as his original invention, or part of his invention, in his original patent. *Carver v. Braintree Manuf. Co.*, 2 Story, 439.—STORY, J.; Mass., 1843.

13. A specification may be defective and unmaintainable under the patent act, as well by an excess of claim as by a defect in the mode of stating it. *Ibid.*, 439.

14. But the inventor is always at liberty, in a renewed patent, to omit a part of his original invention if he deems it expedient, and to retain that part only of his original invention which he deems it fit to retain. *Ibid.*, 439.

15. A specification may be defective, not only in omitting to give a full description of the mode of constructing a machine, but also in omitting to describe fully in the claim the nature and extent and character of the invention. This latter is the common defect for which most renewed patents are granted. *Ibid.*, 440.

16. Under the acts of 1832 and 1836, no prior use of an invention under a defective patent can take away the right to surrender such patent and take out a new and amended one, or authorize a use under the renewed patent. *Stimpson v. West. R. Road*, 4 How., 402.—MCLEAN, J.; Sup. Ct., 1845.

17. A specification may be insufficient or defective under § 13 of the act of 1836, so as to allow a reissue, either by a mis-

take of law, as to what is required to be stated therein in respect to the claim of the inventor, or by a mistake of fact, in omitting things which are indispensable to the completeness and exactness of the description of the invention, or of the mode of constructing, or making, or using the same. *Allen v. Blunt*, 3 Story, 744.—STORY, J.; Mass., 1845.

18. The Commissioner of Patents can lawfully receive a surrender of letters patent for a defective specification, and reissue letters on an amended specification, after the expiration of the original patent, and during the existence of an extended term, and at any time during such term. *Wilson v. Rosseau*, 4 How., 688.—NELSON, J.; Sup. Ct., 1845.

19. The mode of issuing one set of new letters patent, for two or more different terms before existing, is of doubtful legality. The better mode would be to renew each separately, or renew only the old letters and their specification, and let the others be cured or aided by relation back to the original one. *Woodworth v. Hull*, 1 Wood. & Min., 262.—WOODBURY, J.; Mass., 1846.

20. 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 it may be surrendered and amended. *Hovey v. Stevens*, 1 Wood. & Min., 302.—WOODBURY, J.; Mass., 1846.

21. The power to surrender a patent and take a renewal thereof is vested exclusively by § 13 of the act of 1836 in the patentee, his executors or administrators, their assignees, and the grantees of an exclusive right for a specified part of the United States; and there is nothing in the act restricting such right because of special or limited grants or li-

censes previously made. *Smith v. Mercer*, 4 West. Law Jour., 51, 52.—KANE, J.; Pa., 1846.

22. On the surrender and reissue under § 13 of the act of 1836, of a patent which has been extended, "the residue of the period then unexpired for which the original patent was granted," is the residue of the twenty-one years. The extended patent of twenty-one years is, in such case, to be regarded as the "original patent" within the meaning of § 13. *Gibson v. Harris*, 1 Blatchf., 169.—NELSON, J.; N. Y., 1846.

23. The surrender and reissue of a patent, extended by act of Congress to twenty-eight years, after it had been previously extended under § 18 of the act of 1836 to twenty-one years, stands on the same footing, as if such surrender and reissue were made in the case of the patent for twenty-one years, or as extended under § 18. There is no difference in principle. *Ibid.*, 169, 170.

24. Where a patent, which had been once extended under § 18 of the act of 1836, was afterward extended by act of Congress, and the patent was issued, in form, for the whole term of twenty-eight years from the date of the original patent, *Held*, that it was not invalid, but that in legal effect, it was a patent for the residue only of the period unexpired at the time it was issued. *Ibid.*, 170.

25. If a patent which has been twice extended is surrendered for a defective specification, and new letters taken with an amended specification, they may be taken for the whole twenty-eight years. *Woodworth v. Edwards*, 3 Wood. & Min., 126.—WOODBURY, J.; Mass., 1847.

26. Though the old specification had been adjudged good, yet if defective so as to be open to litigation, and thus

somewhat "inoperative," the Commissioner may renew it, and the renewal will be of all for the twenty-eight years; and the granting of the reissued patent will be *prima facie* proof that the state of things justified the reissue, and that the specification relates to the same patent. *Ibid.*, 127-129.

27. There may be more than one surrender and reissue of the same patent. There is nothing in the patent acts, or in their policy, that limits the correction of errors to such as may have been the first discovered. *French v. Rogers*, 1 Fisher, 137.—GRIER, KANE, JJ.; Pa., 1851.

28. A reissue is granted in consideration of some more full or accurate disclosure, than that which had been made in the original specification, or some renunciation of an apparently secured right, and it is for the public interest that the surrender and reissue should be allowed to follow each other as often as the patentee is content to be more specific, or more modest in his claims. *Ibid.*, 137.

29. The surrender and the reissue, no matter how often they recur, are reciprocal—each in consideration of the other—and form together but a single act. If a reissue is invalid for want of authority to make it, the surrender is ineffective for want of authority to accept it. *Ibid.* 138.

30. The fact that things described in an original patent had been in public use, in the interval between the issue of the original and the reissue, does not prevent an inventor of the right to resume them in a reissue. *Goodyear v. Day*, MS.—GRIER, J.; N. J., 1852.

31. The mistake of claiming too little, in the original patent, has an equal claim to correction with that of claiming too much. *Ibid.*

WHEN; BY WHOM; FOR WHAT.

32. If an original patent include two inventions, and its validity on that account is doubted, a separate renewal is just and proper. *Ibid.*

33. § 13 of the act of 1836 contemplates two classes of cases, in which reissues may be granted. First, where a patent shall be *inoperative* and *invalid* by reason of a defective or insufficient description or specification: Second, where that objection arises, by reason of the patentee claiming in his own specification, as his own invention, more than he had or shall have a right to claim as new. *Ibid.*—DICKERSON, J.; N. J., 1852.

34. As to the first case, although the description or specification be clear and distinct to describe some improvement or invention, yet if it does not describe the particular invention intended to be described, it is inoperative and invalid, according to the sense of the law, and will justify a surrender and reissue. *Ibid.*

35. The right to surrender an old patent, and receive another in its place, was given for the purpose of enabling the patentee to give a more perfect description of his invention, when any mistake or oversight was committed in his first. *O'Rielly v. Morse*, 15 How., 112.—TANEY, Ch. J.; Sup. Ct., 1853.

36. Whether the defect be in the specification or claim, under § 13 of the act of 1836, the patentee may surrender his patent, and by an amended specification or claim, cure the defect. When the specification or claim are so vague as to be inoperative and invalid, an amendment may give it validity, and protect the rights of the patentee against subsequent infringements. *Battin v. Taggart*, 17 How., 83.—MCLEAN, J.; Sup. Ct., 1854.

37. The sole right to surrender under § 13 of the act of 1836, is given: 1. To the patentee, if he is alive, and has made no assignment of the original patent: 2. To the executors and administrators of the patentee after his decease, when there has been no such assignment: 3. To the assignee, when there has been an assignment of the original patent. The right to surrender is given to no one else. *Potter v. Holland*, 4 Blatchf., 209.—INGERSOLL, J.; NELSON, J., concurring; Ct., 1858.

38. Where, however, there has been an assignment of an undivided part of the whole original patent, in such a case the assignee of such a part and the patentee become joint owners of the patent, and should join in the surrender, and if they do not, it will be invalid, unless the part owner not joining shall ratify it. *Ibid.*, 209.

39. But a licensee, or one who has had transferred to him a less or different interest than either the interest in the whole patent, or an undivided part of such interest, or an exclusive sectional interest, has no legal right as assignee to surrender, and a surrender without his concurrence is valid. *Ibid.*, 210.

40. Under § 13 of the act of 1836, as to reissue, the Commissioner has no power to grant a reissue to alter the date of a previously granted antedated patent. *Cushman, W. M. C., Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1858.

41. The right to amend or correct the defects, either in the description of the schedule, or in the matter of the summary of the claim, by a surrender of an old patent, in order to a reissue, has its existence upon the broad principles of reason and justice, coeval with the authority to grant the protective, exclu-

sive right itself. *Ball, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

42. The real question is between the inventor and the public—with the limitation or exception of fraud and deception toward the public—and as to the fair and equitable limits of the original invention, embracing all combinations, new and valuable, with their functions, so as in the best and most effectual manner to guard and protect this right from invasion by pretended inventors and pirates, and from the effect of subtle, refined distinctions. *Ibid.*

43. If to do this, it should become necessary to divide and subdivide the invention, the reason is very sufficient and within the provision of the law allowing the reissue of separate patents. *Ibid.*

44. It is not necessary to justify a reissue, that there should have been any adjudication upon the patent: the oath of the party as to the existence of the facts required for a reissue is enough. *Ibid.*

45. The statutes as to reissues are not to be considered as restraining, but as confirmatory of the principles laid down by the Supreme Court in *Battin v. Taggart*, 17 How., 83. *Ibid.*

46. Upon a reissue a party may claim that which in his original application he had disclaimed, provided the error arose from inadvertency, accident, or mistake. *Hayden, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

47. A statement in an original patent that a part is old, or a disclaimer of a part, does not necessarily prevent such part being claimed in a reissued patent, though it seems it would have that effect if made advisedly, and not by inadvertence, accident, or mistake. *Laid-*

ley v. James, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

48. § 13 of the act of 1836, gives to the patentee a right to correct his description or specification, when its imperfection has arisen from inadvertency, accident, or mistake. *Moffitt v. Garr*, 1 Fisher, 613.—LEAVITT, J.; Ohio, 1860.

49. But the only condition on which this can be done is, that the original patent is *inoperative or invalid* by reason of a failure to comply with the requirements of the statute. The proceeding is therefore equivalent to a distinct admission, made in the most solemn form, that the patent has no validity in the sense of entitling a patentee to an action for its infringement. *Ibid.*, 613.

50. An application for a reissue may be made by the assignee of an original inventor. *Selden, Assignee*, MS. (App. Cas.)—MORSELL, J.; D. C., 1861.

51. Upon an application for a reissue, under § 5 of the act of 1837, asking for several reissued patents, each division or separate patent asked for, is not such a separate case as to require the payment of \$25.00 on an appeal to the judges; but one appeal carries up the *whole* case, not a part; and notwithstanding that separate reissued patents may be granted. *Ibid.*

52. Under § 13 of the act of 1836, but one reissued patent was allowable, but the party obtaining such reissue had the right of division of the subject, in his specification, that he now has. *Ibid.*

53. The disclaimer of part of an invention, provided such disclaimer arose from inadvertency, accident, or mistake, will not prevent the patentee from embracing the part so disclaimed in a reissue of his patent. *Hayden, Ex parte*,

POWERS OF COMMISSIONER IN CASES OF.

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

54. Inadvertence and error may occur, as well in a disclaimer as in a claim, and whenever such a mistake occurs, it may be cured by a reissue. *Poppenheusen v. Falke*, 4 Blatchf., 499.—INGERSOLL, J.; N. Y., 1861.

55. A patent obtained by an alien, upon an oath, ignorantly or inadvertently made, that he is a citizen of the United States, is void and not voidable only. The true representation of citizenship, is a condition precedent to the issue of the patent. *Mini's Assignee, v. Adams*, 3 Wall., Jr.—GRIER, J.; Pa., 1861.

56. Such a mistake does not fall within such "defective or insufficient description or specification" as will allow the Commissioner, under § 13 of the patent act of July 4th, 1836, to receive a surrender of the old patent and grant a reissue. *Ibid.*

57. Neither has that officer any such inherent or judicial power as will, independently of the act, enable him to grant a reissue in correction of the applicant's mistake. *Ibid.*

B. ACTION OF COMMISSIONER IN CASES OF.

1. In the case of the surrender of a patent for a defective or insufficient specification, under the provisions of § 13 of the act of 1836, the Commissioner of Patents is to decide whether the invention claimed in the original patent and that claimed in the amended one are substantially the same. He is to inquire and ascertain whether the specification is definite or insufficient in point of law or fact, and whether the inventor has claimed more than he has invented, and

in each case, whether the error has arisen from inadvertency, accident, or mistake, or with a deceptive or fraudulent intention. *Allen v. Blunt*, 3 Story, 744.—STORY, J.; Mass., 1845.

2. *Prima facie*, it must be presumed that the amended patent has been properly and rightfully granted by him. It may be doubted whether his decision is re-examinable elsewhere unless impeached on account of fraud or connivance between him and the patentee, or unless his excess of authority is manifest upon the very face of the papers. *Ibid.*, 744.

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

4. The issuing of new letters patent by the Commissioner of Patents, with an amended specification, is to be presumed to have been done correctly, on account of mistake or inadvertence in the description or specification for the same invention. *Ibid.*, 139.

5. But such inference or presumption in respect to identity is open to be contradicted by proper evidence, which should be submitted to the jury. *Ibid.*, 139.

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

7. It is the duty of the Commissioner of Patents to see that a reissued patent does not cover more than the original one. And it is to be presumed that it does not until the contrary appears. *O'Reilly v. Morse*, 15 How., 112.—TANNEY, Ch. J.; Sup. Ct., 1853.

TO BE FOR SAME INVENTION AS THE ORIGINAL.

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

9. The power and duty of granting a new patent for the original invention, upon a lawful surrender of the old patent, is confided to the Commissioner of Patents. His decision is not re-examinable by the courts unless it is apparent upon the face of the patent that the Commissioner has exceeded his authority, or unless there is a clear repugnancy between the old and the new patent, or unless the new one has been obtained by collusion between the Commissioner and the patentee. *Potter v. Holland*, 4 Blatchf., 242.—INGERSOLL, J.; Ct., 1858.

10. Under § 8 of the act of 1837, on an application for a reissue the question of joint or sole invention is open, as also priority of invention, laches, or any other legal cause which, on an original application, would lead the Commissioner to refuse a patent. *Wilson v. Singer*, MS. (App. Cas.).—DUNLOP, J.; D. C., 1860.

C. TO BE FOR SAME INVENTION AS THE ORIGINAL.

1. Evidence is admissible to show that there are material differences between an original and a reissued patent, and to explain these differences. *Phil. & Tren. R. R. Co. v. Stimpson*, 14 Pet., 462.—STORY, J.; Sup. Ct., 1840.

2. The question whether the original patent and the reissued one are or are not identical, for the same invention, is one which belongs to the province of a jury to decide, and with which the court will not meddle. *Carver v. Brain-*

tree Manuf. Co., 2 Story, 441, 442.—STORY, J.; Mass., 1843.

3. 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 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. Westchester R. R.*, 4 How., 404.—McLEAN, J., Sup. Ct., 1845.

4. If an amended specification describes a different improvement from that which was embraced in the original patent, the new patent will not thereby be invalidated. For the purpose of an injunction, if no more, the invention must be taken to be the same in both patents, after the Commissioner of Patents has so decided by granting a new patent. *Smith v. Mercer*, 4 West. Law Jour., 56.—KANE, J.; Pa., 1846.

5. A reissued patent is presumed to be for the same invention as that included in the original patent. But such inference or presumption in respect to identity is open to be contradicted by proper evidence, which should be submitted to a jury. *Allen v. Blunt*, 2 Wood. & Min., 139.—WOODBURY, J.; Mass., 1846.

6. A patentee can legally take out a reissued patent for more than is described in the surrendered patent, if it does not exceed the actual discovery when the first patent was taken out. *Tatham v. Lowber*, Mir. Pat. Off., 146.—NELSON, BETTS, JJ.; N. Y., 1847.

7. A reissued patent, granted upon the surrender of a former patent, can only be for the same invention claimed in the original patent. *Battin v. Tag-*

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ger, 2 Wall., Jr., 102.—KANE, J.; Pa., 1851.

8. Where, therefore, a patentee in his patent granted in 1843, specified his invention to be for the manner in which he had *arranged and combined certain parts*, but did not specify that he had *invented* any of such parts, though in fact such was the case, and afterward, in 1849, surrendered his patent and took out a new one, in which he claimed a particular part, *Held*, that the part claimed in the reissued patent, having been in use for six years before it was claimed, had become public, and could not be reclaimed by the reissued patent of 1849. *Ibid.*, 102. [Reversed, *post* 15.]

9. § 13 of the act of 1836, allowing the patentee to make his specification more accurate, and § 7 of the act of 1837, providing for restricting a claim too broad, do not apply to and help such a case. *Ibid.*, 102.

10. It is not the meaning of the law that the patentee, in his reissue, must describe and claim just what was described and claimed in his original patent. His new specification must be of the same invention, and his claim cannot embrace a different subject matter from that which he sought to patent originally; but unless the correction contemplated by the statute is narrowed down to a mere disclaimer, the corrected specification must be broader than the original one. *French v. Rogers*, 1 Fisher, 138.—GRIER, KANE, JJ.; Pa., 1851.

11. An applicant for the reissuing of a patent is not bound to describe or claim all that he described or claimed in his original patent; but he may not describe or claim any new or other improvement. *Goodyear v. Day*, MS.—DICKERSON, J.; N. J., 1852.

12. It is to be presumed that the reissued patent does not cover more than the original one. *O'Reilly v. Morse*, 15 How., 112.—TANEY, Ch. J.; Sup. Ct., 1853.

13. Variations from the description given in the former specification do not necessarily imply that it is for a different discovery, as the right to surrender is given for the purpose of enabling the patentee to give a more perfect description of his invention, where any mistake or oversight was committed in the first. It necessarily varies from it. *Ibid.*, 112.

14. The reissued patent must be for the same invention substantially, though it be described in terms more precise and accurate than in the former patent. But a new and different invention cannot be claimed. *Battin v. Tuggert*, 15 How., 32.—MCLEAN, J.; Sup. Ct., 1854.

15. By the defects provided for in the statute, nothing passes to the public from the specifications and claims within the scope of the patentee's invention. The describing a part of a machine in the first patent, but without making any claim to it, does not deprive the inventor of a right to a patent for such part. *Ibid.*, 84.

16. The jury are to judge whether the renewed patent is for the same invention as the original one. *Ibid.*, 85.

17. 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.

18. Though an action is founded on a reissued patent, the rights of the plaintiff must rest upon the discovery described in the original patent. Whatever may be the language of the reissued patent, it imparts no right not contained in the first grant. The

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privilege the law gives by means of the reissue is 'to rectify any errors or deficiencies in the first specification. *Smith v. Higgins*, MS.—BETTS, J.; N. Y., 1857.

19. The legal presumption is, from the action of the Patent Office, that a reissued patent is for the same invention as the original patent. *Hussey v. McCormick*, 1 Fisher, 515.—MCLEAN, J.; Ill., 1859.

20. With respect to reissues, § 13 of the act of 1836 and § 5 of the act of 1837 are to be taken together in construction, and the most just and equitable extent to which the terms of the law in its true spirit will admit of ought to be adopted. *Ball, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

21. If the patent is defective or insufficient, either in the specification or claim, the patentee has a right, if he desires it, in the absence of fraud and deception, on complying with the other requisites, to have a reissue of patents for each distinct and separate part, effectually to cure the defect in the mode of stating it. *Ibid.*

22. And he has a right to *restrict* or enlarge his claim so as to give it operation and to effectuate his invention. *Ibid.*

23. The patentee, in his reissue, is entitled to every advantage within the full scope of his invention. *Ibid.*

24. And on an application for a reissue, a new function developed by the combination of different elements of the invention, will not be considered new matter. *Ibid.*

25. Upon an application for a reissue, the original model may be referred to as evidence of the extent of the true invention, and the patentee is not necessarily confined to the original *record*,

i. e., the patent and specification, of his first patent, as would seem to have been the practice of the Patent Office, under its rule 44. *Ibid.*

26. If there is a defect in the *original patent* and its specification, as to the nature and extent of the invention, the applicant may go outside of these and resort to the next highest evidence—the model—to show the defects complained of. *Ibid.*

27. A reissue is prohibited, both by the law and the rules of the Patent Office, for any thing save the same invention which was described or shown in the original patent—that is, described in the specification or shown in the model or drawing. *Dietz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

28. What the legislature designed to secure to patentees by § 13 of the act of 1836, was to enable them to *cure honest mistakes*, and to get *substantial protection* for the same invention they had made and *intended* to be patented when the original patent was granted. The only limitation in the statute is, that the invention should be the same. *Dyson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

29. The legislature has not said by what proof the applicant shall show that his invention, claimed on reissue, is the same invention made and intended to be patented on his original application. He is not limited by the statute to prove it by the specification, models, or drawings; any legal proof to show it to be the same invention, whether found in the record or *aliunde*, ought to be received and weighed by the Patent Office. *Ibid.*

30. No authority is given to the Patent Office to limit the range of the applicant's proof, if it is such as upon the

law of evidence is held sufficient to prove facts before other legal tribunals. *Ibid.*

31. An original applicant has no right, by law, to an amendment of his specification, except by § 7 of the act of 1836, to conform his specification to the alterations suggested by the Commissioner. But an amendment in the case of a reissue is different; it is not of *grace*, but of *right*. *Ibid.*

32. § 13 does not point to the model and drawings as the *sole* means of proof, or to any means of proof; the whole matter of proof is left at large. It requires that the invention sought to be introduced in the amended specification, should be the *same invention* originally intended to be patented, and is silent as to *how* that is to be ascertained. *Ibid.*

33. The applicant is to prove the invention sought to be covered by his reissue, to be the same intended to be originally patented, but the *quo modo* of proof is not defined, and of course it is open to the patentee to offer any *sufficient legal proof*, record or otherwise. *Ibid.*

34. The gist of the applicant's invention was to give a differential motion or variable speed to the stripper so called, by which at one time, the stripper, by having a motion faster than the main cylinder, cleaned the main cylinder of the cotton imbedded in it, in the process of carding, and then when the stripper was filled with the cotton, its movement was rendered slower than that of the main cylinder, by which such main cylinder became the stripper of the stripper, and these changes were made without stopping the machine; but the original specification described only the *fast* movement of the stripper, and not the slow motion; *Held*, on an

application for a reissue, that the applicant could go outside of his original specification and the drawings and model of his patent, and show by other proof that his invention, at the time of the original patent, was such as he sought to protect by his reissue, and that he could cover in his reissue what was his original invention. *Ibid.*

35. Rule 45 of the Patent Office as to reissues, is general in its terms, and properly so. It does not profess to be without an exception. It states what may be the subject of a reissue, not what shall not be. It does not prescribe that the mode mentioned therein shall be the sole and only mode of showing the invention to be the same invention. *Ibid.*

36. The presumption arising from the matured specification of a patent is that the patentee has described his invention in clear and unequivocal language, though such presumption may be overcome by evidence in favor of the party, upon the allegation of mistake or inadvertence, upon a claim for a reissue. *Collins v. White*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

37. A patentee on an application for a reissue, may claim all those devices which were clearly exhibited in his original specification, drawings, and model, and which he might have legally claimed at the time of taking out his original patent. *Wilson, Assignee of Aiken & Felthousen, v. Singer*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

38. There can be embraced in a reissue, only what was invented *before* or *at the time* of the grant of the original patent; what was then invented and *omitted* to be put in the original patent by accident or mistake, and without any fraudulent or deceptive intention, and *only* such *invention* is, by law,

the subject of a reissue. *Dyson v. Gambriel & Burgee*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

39. The cases of *Battin v. Taggart*, 17 How., 85 (1854), and *Carver v. Braintree Manuf. Co.*, 2 Story, 441 (1843), do not sustain the position that the question whether a reissued patent is for the same invention as the original patent, is one of fact, which can only be determined by a jury. The power of a court of equity to pass upon such fact is not touched by them. *Poppenheusen v. Falke*, 4 Blatchf., 496.—SHIPMAN, J.; N. Y., 1861.

40. If, however, such question is involved in considerable doubt, that might be a reason why it should be sent to a jury. *Ibid.*, 497.

41. Though the decision of the Commissioner of Patents that the reissued patent is for the same invention as the original, is, as a general rule, at least *prima facie* evidence of its truth, it is not conclusive when doubts are raised in the minds of the court by an examination of the instruments themselves. *Ibid.*, 497.

D. VALIDITY AND FORCE OF, AND RIGHTS CONFERRED BY.

See also REISSUE, B.

1. Whether a reissued patent confers any right is a question for judicial decision. *Anon.*, 2 Opin., 456.—TANEY, Atty. Gen.; 1831.

2. In the case of a surrender of a patent for a defect arising from inadvertence and mistake, and a reissue, the new patent and the proceedings on which its issues have relation to the original transaction. The time of the privilege still runs from the date of the original patent. The application may be con-

sidered as appended to the original application. The second patent cannot in any respect be considered as independent of the first. *Grant v. Raymond*, 6 Pet., 244.—MARSHALL, Ch. J.; Sup. Ct., 1832.

3. A reissued patent granted upon the surrender of the first one is only a continuation of the original patent. *Ames v. Howard*, 1 Sumn., 488.—STORY, J.; Mass., 1833.

4. A reissued patent has relation to the original transaction of the issuing of the first patent; and being only a continuation of the first one, the rights of the patentee are to be ascertained by the law under which the original application was made. *Shaw v. Cooper*, 7 Pet., 315.—MCLEAN, J.; Sup. Ct., 1833.

5. Under § 13 of the act of 1836, a second patent with corrected specifications has relation back to the emanation of the first patent, as fully for every legal purpose, as to causes subsequently accruing, as if the second patent had been issued at the date of the first one. *Stanley v. Whipple*, 2 McLean, 37.—MCLEAN, J.; Ohio, 1839.

6. The second patent legalizes the rights of the patentee from the date of the first patent. *Ibid.*, 38.

7. If a patent which was invalid by reason of a defective specification, is surrendered, and a new one taken out, the second patent relates back to the date of the original patent. *Smith v. Pearce*, 2 McLean, 176.—MCLEAN, J.; Ohio, 1840.

8. It is not necessary that a reissued patent should contain any recitals that the prerequisites to the grant of it—as that it was reissued for errors arising not from inadvertency, accident, or mistake—have been duly complied with, for the law makes the presumption that

they have been. *Phil. & Tren. R. R. v. Stimpson*, 14 Pet., 458.—STORY, J.; Sup. Ct., 1840.

9. The presumption of right in a patentee, because of the acquiescence of the public in his claim, is not changed in consequence of the original patent being surrendered on account of its informality. The original patent was not void, but was efficacious to preserve the right of the patentee, which would have been lost had the invention been used without a patent. *Orr v. Badger*, 7 Law Rep., 468.—SPRAGUE, J.; Mass., 1844.

10. The grant of an amended patent by the Commissioner of Patents, is conclusive as to the existence of all the facts necessary for a reissue, unless it is apparent on the face of the patent itself, without any auxiliary evidence, that he was guilty of a clear excess of authority, or that the patent was procured by fraud between him and the patentee. *Allen v. Blunt*, 3 Story, 745.—STORY, J.; Mass., 1845.

11. The decision of the Commissioner of Patents, in accepting the surrender of an old and granting a new patent, is not re-examinable elsewhere, unless it is apparent from the face of the patent, that he has exceeded his authority, or there is a clear repugnancy between the old or new patent, or the new one has been obtained by collusion between the Commissioner and the patentee. *Woodworth v. Stone*, 3 Story, 753, 754.—STORY, J.; Mass., 1845.

12. No prior use of a defective patent can authorize the use of the invention after the emanation of a renewed patent. Any person using an invention protected by a renewed patent, subsequently to the date, is guilty of an infringement, however long he may have

used the same after the date of the defective and surrendered patent. *Stimpson v. West-Chester R. R.*, 4 How., 402, 403.—MCLEAN, J.; Sup. Ct., 1845.

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

14. In whatever manner the mistake or inadvertence may have occurred is immaterial. The action of the government in renewing the patent must be considered as closing this point, and as leaving open for inquiry the question of fraud only. *Ibid.*, 404.

15. A reissued patent, with an amended specification, operates, except as to suits for violations commenced before the amendment, from the commencement of the original term. *Woodworth v. Hall*, 1 Wood. & Min., 257.—WOODBURY, J.; Mass., 1846.

16. It is a patent for the same invention. It can by law include no new one, and it covers only the same term of time which the former patent did. *Ibid.*, 257.

17. Recoveries under the original patent are evidence after the new letters and new specification, to strengthen the title of the patentee so as to obtain an injunction, thus regarding the patent as one and the same. *Ibid.*, 257.

18. A renewal of a patent with an amended specification, is presumed to have been made legally, that is to correct a mistake, or inadvertence, and for the same invention; but this presump-

tion may be rebutted by evidence. *Allen v. Blunt*, 2 Wood. & Min., 139.—WOODBURY, J.; Mass., 1846.

19. But whether the decision of the Commissioner is conclusive to the extent laid down in *Allen v. Blunt*, 3 Story, 745 (*ante* 10); *query. Ibid.*, 139.

20. Whether a reissued patent may unite several before existing terms—as terms of fourteen and seven, and seven years, in one patent, for twenty-eight years; *query. Woodworth v. Hall*, 1 Wood. & Min., 400.—WOODBURY, J.; 1846.

21. If such a renewal is void, the surrender of the former patents is likewise void, but perhaps recoveries may be had on the original patents, as if never attempted to be consolidated. *Ibid.*, 400.

22. Such a consolidated reissue was upheld by the Supreme Court, 4 Howard, 646, *Wilson v. Rosseau*, but no objection was there raised to such a practice. *Ibid.*, 400.

23. If a renewal is not valid, the surrender which led to it will also be invalid, and the old letters will be considered in full force, and violators may be prosecuted under such old patent, with the old specification. *Woodworth v. Edwards*, 3 Wood. & Min., 127.—WOODBURY, J.; Mass., 1847.

24. Whenever the power of reissue has been fraudulently or corruptly abused, the renewal will be avoided. *Ibid.*, 129.

25. Upon the surrender and reissue of a patent, the corrected patent is made to all cases of infringement subsequently accruing, as though it had been so issued originally, and even though the original patent was invalid. *Bloomer v. Stolley*, 5 McLean, 166.—MCLEAN, J.; Ohio, 1850.

26. In ordinary cases of reissue, the Commissioner's action has more than *prima facie* influence in deciding the question of identity of invention. *French v. Rogers*, 1 Fisher, 139.—KANE, J.; Pa., 1851.

27. A reissued patent is not void, because the things claimed in the original had been in public use in the interval between the original and reissued patent. Such a publication is not an abandonment or dedication. *Goodyear v. Day*, MS.—DICKERSON, J.; N. J., 1852.

28. The fact of procuring a patent for a new and useful machine, under the assumption of a reissue, which was not useful as patented in the surrendered patent, for want of some parts, used in the reissued patent, would present a question of fraud, committed on the public by the patentee, by giving his reissued patent date as an original discovery; made at the time of the original patent, and thereby over-reaching similar inventions made between the time of the original patent and the time of the reissued patent. *Brookes v. Fiske*, 13 How., 220.—CATRON, J.; Sup. Ct., 1853.

29. A reissued patent, which has been obtained upon the surrender of the former patent, under § 13 of the act of 1836, is not a new patent, nor does it confer any new and distinct right; and an existing contract concerning the patent, made before the surrender, applies equally to the reissued patent. *McBurney v. Goodyear*, 11 Cush., 571.—MERRICK, J.; Mass., 1853.

30. There is a marked and well recognized difference between a *renewed* and a *reissued* patent. The former grants a wholly new term, the latter legalizes and confers the right during the continuance of the original term. *Ibid.*, 571.

EFFECT OF, AS TO ASSIGNEES, AND THEIR RIGHTS UNDER.

31. A contract concerning a patent, made before its surrender, applies equally to the reissued patent. A reissued patent is not a new patent. *Ibid.*, 571.

32. In an action for infringement on a reissued patent, proof of use of the thing patented, during the interval between the original and reissued patents, will not defeat the action. *Battin v. Taggart*, 17 How., 84.—McLEAN, J.; Sup. Ct., 1854.

33. A reissued patent is considered as if granted at the date of the original one. It is no defence to an action upon the reissued patent, that the defendant's machine was made and put up during the original patent, under which he was not liable to an action for an infringement. *Carr v. Rice*, 1 Fisher, 211.—BETTS, J.; N. Y., 1856.

34. After a patent has been surrendered, an action cannot be maintained for damages for an infringement occurring under the old patent, before the surrender. *Moffitt v. Garr*, 1 Fisher, 613.—LEAVITT, J.; Ohio, 1860.

E. EFFECT OF, AS TO ASSIGNEES AND OTHERS; AND THEIR RIGHTS UNDER.

1. A patentee cannot, by a surrender of his patent, affect the rights of third persons to whom he had previously, by assignment, passed his interest in the whole or a part of the patent, without the consent of such assignee. *Woodworth v. Stone*, 3 Story, 750.—STORY, J.; Mass., 1845.

2. A surrender of letters patent renders void all assignments under such patent, so far as those are concerned who assent to such surrender. It is necessary that a prior assignee should have a new assignment, before he can main-

tain an action for an invasion of the patent. *Gibson v. Richards*, Index Pat. Dec., No. 376.—NELSON, J.; N. Y., 1845.

3. Amendments to a patent made on a reissue thereof, will inure to the benefit of the assignees and grantees under the patent as it stood before such reissue. *Smith v. Mercer*, 4 West. Law Jour. 52.—KANE, J.; Pa., 1846.

4. But such grantees may, if they prefer, rest their claims upon the specification as it stood when they purchased their right. *Ibid.*, 52.

5. A patentee cannot, by a surrender of his patent, affect injuriously the rights of third parties, to whom he has already passed an interest in his patent. They will share with him the benefits conferred by the reissue. *McBurney v. Goodyear*, 11 Cush. 571.—MERRICK, J.; Mass., 1853.

6. It is not in the power of a patentee, by a surrender of his patent, to affect the rights of third persons, to whom he had previously passed his interest in the whole or a part of the patent, without their consent. Such consent may be manifested by joining in the surrender, or previously authorizing it, or subsequently ratifying, or approving it; and taking advantage and benefit of it would be a ratification. And when so consented to, the rights of the party consenting, in and to the old patent, are forever gone. *Potter v. Holland*, 4 Blatchf., 214.—INGERSOLL, J.; NELSON, J., concurring; Ct., 1858.

7. Such third parties, though *entitled* to the same right in the reissued patent, that they had in the old, are not however *compelled* to take under the reissued patent and give up the right had under the old one, but may hold under the old patent, if they choose the same

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rights they had before the surrender. *Ibid.*, 214.

8. There may be one claim of right under one or the old patent, for one section of country, and a different claim of right under the reissued patent, to the same invention, for another section of country. *Ibid.*, 216.

REPAIRS OF PATENTED MACHINES.

See PATENTED MACHINES, A.

REPORTS.

1. No reporter has or can have any copyright in the written opinions of the judges of a court; nor can the judges confer on any reporter any such right. *Wheaton v. Peters*, 8 Pet., 668.—McLEAN, J.; Sup. Ct., 1834.

2. Though there cannot be any copyright in the opinions of the court, published under authority of law, a reporter may have a copyright in his own marginal notes, and in the arguments of counsel, as prepared and arranged by him. *Gray v. Russell*, 1 Story, 21.—STORY, J.; Mass., 1839.

3. The right of copyright belongs to the reporters of judicial decisions, in common with other authors, to the extent of their authorship in the composition of their works. *Little v. Gould*, 2 Blatchf., 170.—CONKLING, J.; N. Y., 1851.

4. But this does not comprise the written opinions of the judges, because of these the reporter is not the author, and the judges of a court cannot confer

WHAT HELD NOT TO BE.

on him any copyright in the written opinions delivered by them. *Ibid.*, 170.

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

RESTRAINT OF TRADE.

1. An agreement between two partners in the manufacture of a patented article, that one would discontinue such manufacture, is not void as being in restraint of trade, and against the principles of public policy, but is simply an ordinary business arrangement. *Parkhurst v. Kinsman*, 1 Blatchf., 495.—NELSON, J.; N. Y., 1849. [Affirmed, *post* 3.]

2. A bond given to a patentee by one who has infringed on a patent, conditioned that he will not, during the continuance of the patent, manufacture or vend the patented article, is not void as being in restraint of trade. *Barry v. Clirhugh*, 12 Law Rep., 367.—JONES, Ch. J.; N. Y., 1849.

3. An agreement stipulating, that under certain conditions, one party shall cease the manufacture of a patented article, is not void as being in restraint of trade; such clause is but a provision for the prosecution of the business in a particular manner, and not for its restraint. *Kinsman v. Parkhurst*, 19 How., 293.—CURTIS, J.; Sup. Ct., 1855.

RESULT.

See "EFFECT;" PURPOSE.

WHEN PIRACY, WHEN NOT.

AUTHORITY OF.

REVIEWS.

1. A reviewer may fairly cite largely from the original work, if his design be really and truly to use the passages for the purpose of fair and reasonable criticism. But if he thus cites the most important parts of the work, with a view, not to criticize, but to supersede the use of the original work, and substitute the review for it, such a use will be deemed, in law, a piracy. *Folsom v. Marsh*, 2 Story, 106.—STORY, J.; Mass., 1841.

2. Extracts, representing or embodying the spirit and force of a work, may be taken therefrom to a reasonable extent by a reviewer, for the purpose of showing the merit or demerit of the work. But this privilege cannot be so exercised as to supersede the original book. *Story v. Holcombe*, 4 McLean, 309.—McLEAN, J.; Ohio, 1847.

3. Sufficient may be taken to form a correct idea of the whole; but no one is allowed, under the pretence of quoting, to publish either the whole or a principal part of another man's composition. A review must not, therefore, serve as a substitute for the book reviewed. *Ibid.*, 309.

4. If so much is extracted, that the article communicates the same knowledge as the original work, it is an actionable violation of literary property. *Ibid.*, 309, 310.

5. The abridgement of a work, for which a copyright has been secured, and which has been publicly circulated, is not an infringement of the statutory privilege; but such an abridgement would violate the right of the literary proprietor of a book of which the circulation had been private only. *Keene*

v. Wheatley, 9 Amer. Law Reg., 82.—CADWALLADER, J.; Pa., 1860.

RULES OF PATENT OFFICE.

1. The rules of the Patent Office as to taking evidence in contested cases, made by the Commissioner of Patents, under § 12 of the act of 1839, while they remain unabrogated, are as binding as the law itself; and upon the Commissioner himself, as upon others. *Arnold v. Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. After a deposition has been taken, while the rules were in force, a revocation of them cannot affect that deposition. A revocation only affects subsequent proceedings. *Ibid.*, 27.

3. The rule of the Patent Office, as to taking and transmitting testimony, and providing that no evidence, unless taken and filed in compliance with such rules, will be *considered* on the hearing of the case, in which taken, does not prohibit the Commissioner from *looking into* the deposition informally transmitted, or reading it, and ascertaining its contents, but only prohibits him from *considering* it as evidence touching the matter in issue. *Smith v. Flickenger*, MS. (App. Cas.)—CRANCH, Ch. J.: D. C., 1843.

4. If found informal, on such inspection, the Commissioner may, if he see fit, allow further time to correct the informality. *Ibid.*

5. The object of notice, required by the rules of the Patent Office, in the examination of witnesses, is to bring the adverse party before the examining officer, to give him an opportunity to cross-examine. But if the adverse party

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comes, and is present, and cross-examines, notice and proof of service of it are of no account. *Gibbs v. Ellithorpe*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859.

6. The rules and regulations of the Patent Office, as to taking testimony in cases of interference, are binding upon the parties, and each is entitled to the benefits of them, and until abrogated, are as binding upon the Commissioner himself, as if enacted by the statute itself. *O'Hara v. Hawes*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

7. The rules of the Patent Office, as to the taking of depositions, give to either of the litigant parties, the right to take depositions, *without restraint*, up to the day of hearing fixed by the Patent Office, or to a day near enough to give time for the transmission of the evidence to the Patent Office. *Spear v. Abbott*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859.

8. The power granted to the Patent Office, under § 12 of the act of 1839, to make rules in respect to the taking of evidence, gives no right to make new rules of evidence, or to make new rules of law, or to divert vested rights, by its rules of practice. *Dyson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

9. The 26th rule of the Patent Office, providing that amendments of the model, drawings, or specification, must relate to the subject matter originally embraced in at least one of them, applies only to *original* applications, and not to cases of reissue. If it did, it would be void. *Ibid.*

10. The rule of the Patent Office confining reissues to the invention described or shown in the original patent is, cautious and general in its terms. It

does not profess to be without an exception. It states what may be the subject of a reissue; not, what shall not be; and does not prescribe, that the mode mentioned therein shall be the sole and only mode of showing the invention to be the same invention. *Ibid.*

11. The practice of the Patent Office, under its rules, as to reissue, of confining the applicant to his original patent and specification, as the evidence of what was his original invention, is not correct, but reference may also be made to the model for a like purpose. *Ball, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

SECRET USE OF INVENTION.

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

2. How far the use by the discoverer of his invention or monopoly so long as it could be kept a secret, and seeking a patent only when it was in danger of discovery, would invalidate the patent, *query*. *Goodyear v. Day*, MS.—GRIER, J.; N. J., 1852.

3. The object of the patent laws being not only to benefit the inventor but also the public or community at large, by the use of the invention after the mo-

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nopoly has terminated, it follows that an inventor who designedly and with the view of applying it indefinitely and exclusively for his own profit, withholds his invention from the public, comes not within the policy or objects of the constitution or acts of Congress, and is not entitled to favor if during such concealment another person should find out and bring into use the same invention. *Kendall v. Winsor*, 21 How., 328.—DANIEL, J.; Sup. Ct., 1858.

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

5. A party has a right to keep his inchoate right to an invention concealed as long as he pleases—but when he desires to perfect his right to a patent, he must proceed with vigilance. *Ellithorpe v. Robertson*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

6. The statutory bar, § 7 of the act of 1839, imposed upon the inventor who sells his invention for more than two years before his application for a patent, would seem by analogy properly applicable to the inventor who *secretes*. *Spear v. Stuart*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859.

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

public. *Marcy v. Trotter*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

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

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

10. If an inventor *conceals* his invention after it is complete, even though he never sold it for profit or introduced it to public use, he cannot claim a patent. *Loveridge v. Dutcher*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

11. An inventor who *designedly*, and with the view of applying it indefinitely and exclusively for his own profits, withholds his invention from the *public*, comes not within the policy or the objects of the constitution or acts of Congress. He does not promote but impedes the progress of science and the useful arts. *Ibid.*

12. The decision in *Spear v. Stuart* (*ante* 6), that the concealment of an invention for more than two years stands on no better footing than the sale of such invention before two years, considered and approved. *Ibid.*

13. A negligence, in secreting and failing to patent an invention for more than two years after its discovery, forfeits all right to claim a patent. Even the filing a caveat, if filed more than two years

after such discovery, will not save the rights of the inventor. *Snowden v. Pierce*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

SPECIFIC PERFORMANCE.

1. The fact, that the subject matter of a contract sought to be enforced is a patent right, does not of itself give the courts of the United States jurisdiction. A bill filed for the specific performance of such a contract must contain the proper averments as to the *character* of the parties, to show that the court has jurisdiction. *Burr v. Gregory*, 2 Paine, 426, 429.—THOMPSON, J.; N. Y., 1828.

2. The Circuit Courts have no jurisdiction of an action as to enforce the specific execution of a contract respecting a patent, where the parties are all citizens of the same state: but where the plaintiffs set up a right under a patent, and allege that the defendants are infringing, citizenship will not oust jurisdiction. *Brooks v. Stolley*, 3 McLean, 525.—MCLEAN, J.; Ohio, 1845.

3. But where the court has obtained jurisdiction on the ground of infringement, it may then decide other matters which of themselves would not afford ground for the original exercise of jurisdiction. *Ibid.*, 529.

4. Under § 17 of the act of 1836, the jurisdiction of the Circuit Courts as to subject matter does not extend to a bill in equity filed for the specific performance of a contract to transfer a patent—the jurisdiction of such courts being confined to actions under the patent *laws* granting or confirming rights to inventors. *Nesmith v. Calvert*, 1 Wood. & Mir, 37.—WOODBURY, J.; Mass., 1845.

5. But if such a bill is filed against several defendants, some of whom are residents of the same state with the complainants, the bill may still be maintained against the defendants who are residents of another state. *Ibid.*, 37.

6. And if the bill prays for an injunction against the use of a patent, that may be a ground for exercising jurisdiction against all the defendants. *Ibid.*, 38.

7. Where a bill is filed to enforce the specific performance of a contract in relation to a patent, the Supreme Court has no appellate jurisdiction, unless the matter in controversy exceeds the value of two thousand dollars. *Brown v. Shannon*, 20 How., 56, 57.—TANEY, Ch. J.; Sup. Ct., 1857.

SPECIFICATION.

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A. GENERAL PRINCIPLES OF CONSTRUCTION.

See PATENT, P. 1.

B. HOW INVENTION TO BE DESCRIBED IN.

See also COMPOSITION OF MATTER, B.; IMPROVEMENT, B.; MACHINE, B.

1. Under the patent act of 1793, before a patent can issue, the inventor should so explain his invention, that others beside himself may understand and use it; more especially when the in-

vention is to relieve human misery, care should be taken to have a plain and thorough exposition of the art. A thing capable of doing good, if judiciously used, may be very pernicious if misapplied. *Perkins' Case*, 1 Opin., 64.—LEE, Atty. Gen.; 1796.

2. The thing for which a patent is granted, should be truly and fully described in the specification; but if this be done so as clearly to distinguish it from other things, and enable any person skilled in the art of which it is a branch, or with which it is most nearly connected, to make and use the same, it will be sufficient. The matters not disclosed, must appear to have been concealed for the purpose of deceiving the public, to invalidate the patent. *Park v. Little*, 3 Wash., 198.—WASHINGTON, J.; Pa., 1813.

3. The description of the invention must be full, clear, and explicit, so as to distinguish it from all others of the same kind, and to enable any person skilled in the art, of which it is a branch, to make and use it. The description should be accommodated to the comprehension of any practical mechanic, without taxing his genius or inventive powers. *Gray v. James*, Pet. C. C., 401.—WASHINGTON, J.; Pa., 1817.

4. Whether a specification is defective within the interpretation of the law, must depend upon the evidence of those skilled in the science or art of the invention. *Ibid.*, 401.

5. The patentee must describe, in full and exact terms, in what his invention consists. If the description 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.

6. The inventor must deliver a written description of his invention, in such full, clear, and exact terms, that any person acquainted with the art, may know how to construct and use it. The reasons for this requirement are, to guard the public against unintentional infringement of the patent, during its continuance, and to enable an artist to make the improvement, by a reference to some known and certain recorded authority, after the patent has run out. *Evans v. Eaton*, 3 Wash., 453.—WASHINGTON, J.; Pa., 1818.

7. Whether a patent be valid or not, must materially depend upon the accuracy and distinctness with which the invention is stated. *Moody v. Fiske*, 2 Mas., 118.—STORY, J.; Mass., 1820.

8. A specification need not particularly describe the operation of mechanism which is well known by persons acquainted with the art. *Kneass v. Schuylkill Bank*, 4 Wash., 14.—WASHINGTON, J.; Pa., 1820.

9. 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. *Ibid.*, 14.

10. The specification should distinguish the new from the old, and point out in what the invention consists. The invention cannot be shown by testimony, nor can the jury infer it from examining the thing patented, and comparing it with others before in use. No description of the discovery secured by a patent, will fulfil the demands of justice and of law, but such as is of record, and of which all the world may have the benefit. *Dixon v. Moyer*, 4 Wash., 73.—WASHINGTON, J.; Pa., 1821.

11. Where the specification does not describe the invention, so as to show in

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what respects the plaintiff's invention or improvement differs from what had been before known or used, the patent is void. *Langdon v. De Groot*, 1 Paine, 207.—LIVINGSTON, J.; N. Y., 1822.

12. The act of 1793, § 3, requires that the specification must describe the invention "in such full, clear, and exact terms," as to distinguish the same from all things before known. The specification has two objects: one, to make known the manner of constructing the invention, so as to enable artisans to make and use it, and thus to give the public the full benefit of the discovery after the expiration of the patent. The other object is, to put the public in possession of what the party claims as his own invention, so as to ascertain if he claim any thing that is in common use, or already known, and to guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented. *Evans v. Eaton*, 7 Wheat., 434.—STORY, J.; Sup. Ct., 1822.

13. A specification which mixes up the new and the old, but does not explain what is the nature or limit of the invention claimed, cannot be sustained. *Ibid.*, 434.

14. The invention cannot be made out and shown at the trial, or be established by comparing the invention specified in the patent with former ones in use. *Ibid.*, 434, 435.

15. Both the language and policy of the act of Congress require, that the specification should be clear, plain, and intelligible, so that others may be taught by it to make or do the thing for which the patent is granted. The object of the specification is to inform the public, after the expiration of the term for which the patented is granted, what the inven-

tion is; and it ought therefore to put the public in possession of whatever is necessary to the use and enjoyment thereof. *Sullivan v. Redfield*, 1 Paine, 450.—THOMPSON, J.; N. Y., 1825.

16. It is a correct rule as to patents, that if the specification is sufficiently explicit in its details to enable a skilful machinist to construct the patented improvement or invention, without any other aid, it is not to be considered void because some of the minor details of the machine are not set forth at large. *Burrall v. Jewett*, 2 Paige, 142.—WALWORTH, Chan.; N. Y., 1830.

17. A patent is a bargain with the public, in which the same rules of good faith prevail as in other contracts, and if the disclosure communicates the invention to the public, the statute is satisfied. *Whitney v. Emmett*, Bald., 319.—BALDWIN, J.; Pa., 1831.

18. As the English statute does not require any specification, these rules and principles are matters of judicial construction, on which the English courts act without any statutory direction. But in the United States it is different, and the law is more explicit. As to the specification, nothing is left to construction, as to its requisites or purposes, both being so clearly defined, and in such a manner, as to leave no discretion in the courts to presume what was intended, to alter, or diminish. *Ibid.* 319, 320.

19. If from the patent, specification, drawings, model, and old machine, clear ideas are conveyed to men of mechanical skill in the subject matter, by which they could make, or direct the making of the machine, by following the directions given, the specification is good within the act of Congress. *Ibid.*, 322.

20. The patentee is bound to describe

with reasonable certainty, in what his invention consists, and what his particular claim is. But he is not bound to use any precise form of words. It is sufficient if the court can clearly ascertain, by fair interpretation, what he intends to claim, and what his language truly imports, even though the expressions are inaccurately or imperfectly drawn. *Wyeth v. Stone*, 1 Story, 286, 287.—STORY, J.; Mass., 1840.

21. The specification must contain reasonable certainty—must describe the machine so as to enable a person skilled in the construction of machines, to build it—but it need not be so clear as to be understood by a person wholly unskilled in the art. *Brooks v. Bicknell*, 3 McLean, 260.—MCLEAN, J.; Ohio, 1843.

22. But the patentee need not state of what material every part of the machine should be made. The principle is the same, whether the parts are composed of wood or metal. *Ibid.*, 261.

23. The object of the law in requiring a full, clear, and exact description of the thing patented, is twofold: 1st, as the grant gives an exclusive right, that the nature and extent of it may be understood; and 2d, that when the exclusive right ceases, from the description the machine may be constructed. *Brooks v. Bicknell*, 3 McLean, 441, 442.—MCLEAN, J.; Ohio, 1844.

24. 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. *Ibid.*, 443.

25. The specification must be complete. No defects can be obviated by extraneous evidence at the trial. *Ibid.*, 444.

26. The utmost precision in the description of a machine is not essential. Parts of machinery, and processes generally known, need not be described.

Nor is it essential to state the proportionate parts of a machine, nor the velocity of its operations. The size or velocity makes no difference in the principle. *Ibid.*, 447, 448.

27. The specification and drawing of a patent, must be so clear, full, and exact, as to enable one skilled in the art to which it pertains, to make and use the invention. It is not enough, if some very skilful artisan could make and use it, but persons of ordinary skill must be able to do so; must be able not only to construct, but to use the machine for a useful purpose. *Lippincott v. Kelly*, 1 West. Law Jour., 514.—IRVIN, J.; Pa., 1844.

28. Old and well-known machinery, with which the new contrivance is to be connected, need not be described in the specification, or delineated in the drawing, when no change in their forms or proportions enters into the new invention. *Emerson v. Hogg*, 2 Blatchf., 9.—BETTS, J.; N. Y., 1845.

29. If, however, the description is uncertain and obscure, as to what was meant, and what is in fact the novelty, that it cannot be determined whether the improvement consists in the combination of the whole, or of all the parts, or only of some of them, and of which—or of an invention of some, and if so, of which—the uncertainty will be fatal, and the patentee will be under the necessity of making a new specification, setting forth his claim with greater certainty, accuracy and clearness, and disclaiming all not new. *Hovey v. Stevens*, 3 Wood. & Min., 30-32.—WOODBURY, J.; Mass., 1846.

30. The patentee must describe his invention with reasonable certainty. Unless this is done, the public are unable to know whether they violate the patent or

not, and are also unable, when the term expires, to make machines correctly, and derive the proper advantages from the patent. *Davoll v. Brown*, 1 Wood. & Min., 56, 57.—WOODBURY, J.; Mass., 1845.

31. But a patent will be held valid, if the invention is described with so much clearness and certainty, that other machines could readily be made from it by mechanics acquainted with the subject. *Ibid.*, 57.

32. The object of the provisions of the statute requiring an inventor to describe his invention in as full, clear, and exact terms as to enable a skilful person to construct it, is twofold: 1, that when the term has expired, and the invention becomes public property, such means of information may be accessible through the Patent Office as will enable others to avail themselves of its benefits; and 2, that while the patent is in force others may be informed of the precise claim of the patentee, and not ignorantly infringe his exclusive rights. *Parker v. Stiles*, 5 McLean, 55.—LEAVITT, J.; Ohio, 1849.

33. By the patent laws the inventor is not to be protected unless he describes plainly and fully what he has done, so that the public may copy or imitate, and use the invention, after his patent expires. This is the consideration for the exclusive use during the period of the patent, and having this prevents the patentee from claiming afterward more than he had invented when his patent issued. *Smith v. Downing*, MS.—WOODBURY, J.; Mass., 1850.

34. And what he does not, or certainly what in the misty future he cannot describe, he must be presumed not to have invented. *Ibid.*

35. All that the law requires in respect to clearness in the specification is,

that it should be clear enough to be understood by ordinary mechanics, and that the thing described could be made from it, considering the specification as a whole, and adverting to the drawings on file. *Hogg v. Emerson*, 11 How., 606.—WOODBURY, J.; Sup. Ct., 1850.

36. As a previous condition to the granting or issuing of every patent, the applicant must set forth in his specification a true, full, and clear account and description of his invention, showing the contrivances, mode, method, manner, or means by which the result is to be produced, and what his *invention is*, what he claims to be *new*, and what he admits to be *old*. *Yearsley v. Brookfield*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

37. Whoever discovers that a certain useful result will be produced in any art, machine, manufacture, or composition of matter, by the use of certain means, is entitled to a patent for it, provided he specifies the means used so fully and exactly that a skilful person can, by using the means specified, without addition or subtraction, produce the result described. If this cannot be done, the patent is void; if it can be, the patent gives the exclusive right to use the means specified, and nothing more. *O'Reilly v. Morse*, 15 How., 119.—TANNEY, Ch. J.; Sup. Ct., 1853.

38. 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.

39. The clearness the law requires in a specification must be such as will distinguish the thing patented from all others previously known, and which will enable a person skilled in the art or science of which it is a branch, or with which it is nearly connected, to construct the thing specified. *Teese v. Phelps*, 1 McAllis., 49.—MCALLISTER, J.; Cal., 1855.

40. As the patent laws of the United States grant the patentee a monopoly, and not only award damages but inflict penalties for the violation of exclusive privileges, it requires the invention to be so described in the specifications, that one acquainted with the art or manufacture to which it relates may not only understand the invention, but be able by following the specification, with the aid of the drawing, to make the thing which is the subject of the patent. *Wintermute v. Redington*, 1 Fisher, 243.—WILSON, J.; Ohio, 1856.

41. The patentee may be regarded as a purchaser from the public, being bound to so communicate his secret by specification, drawings, and models, that it shall be successfully available to the whole community at the expiration of the patent. *Ibid.*, 243.

42. The patentees, to make their title good, must describe fully and clearly their whole invention, and the method of using it. If any thing material in respect to its construction or working is omitted in their specification, they lose all claim to the exclusive use of their discovery. *Carr v. Rice*, 1 Fisher, 204.—BETTS, J.; N. Y., 1856.

43. It is a settled rule of law that the specification need not describe that which is within the *ordinary knowledge* of any workman having a competent knowledge of the work, who may be employed to put up the apparatus, or construct the machine. *Page v. Ferry*, 1 Fisher, 304.—WILKINS, J.; Mich., 1857.

44. A patent may be considered in the light of a deed from the government, the consideration of which is the invention specified; and the patentee is bound to communicate it by so full, clear, and exact a description, that it shall be within the comprehension of the public at the expiration of the patent, for at that period his invention becomes public property. *Ibid.*, 306-7.

45. The specification is intended to teach the public the improvement patented: it must fully disclose the secret; must give the *best* mode known to the inventor; and contain nothing defective, or that would mislead artists of competent skill in the particular manufacture. *Ibid.*, 309.

46. A witness, in order to be competent to testify as to whether a specification contains a sufficient description of the invention, must be one *skilled in the art*: one not so skilled is not a fit person to determine as to the sufficiency of the description. *Poppenhausen v. N. Y. G. P. Comb Co.*, 2 Fisher, 70.—INGERSOLL, J.; N. Y., 1858.

47. If the specification does not clearly specify and point out the improvement or combination which is claimed as the invention of the applicant, a patent cannot be granted. *Davis, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

48. The object and design of the law requiring the description of the invention to be full, clear, and exact, is,

 AMBIGUITY AND CONCEALMENT IN; EFFECT OF.

that the public may be admonished of precisely what the patentee claims, so that it may not be ignorantly infringed, and also that when the exclusive right has expired, the public may be at no loss to know what the nature of the invention was, so as to make it valuable and practical. *Judson v. Moore*, 1 Fisher, 547.—LEAVITT, J.; Ohio, 1860.

49. Whether there is a sufficient specification or not for such purpose, is a question of fact for the jury. *Ibid.*, 547.

50. The description need not, however, be so particular as to dispense with the exercise of skill and judgment on the part of the mechanic. 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. *Ibid.*, 548.

51. In deciding whether the subject of an invention is set forth in a clear and intelligible manner, so that one can understand its precise character, it is necessary to take the whole specification together, not simply the summary at the conclusion, but the entire paper. The single point is whether, taking the whole specification together, there is a subject set forth and described which in itself is patentable, and whether it is so clearly described that it can be understood, and the precise character of the invention known. *Judson v. Cope*, 1 Fisher, 622.—LEAVITT, J.; Ohio, 1860.

C. AMBIGUITY IN, AND EFFECT OF.

See AMBIGUITY.

D. CONCEALMENT IN, AND EFFECT OF.

1. It is a question for a jury whether the specification contain the whole truth

relative to the discovery, and if not, whether it has been concealed with a view to deceive. *Reutgen v. Kanowrs*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

2. As to the materiality of the thing concealed, the question is, could an artist, after the patentee's right is expired, construct a machine by looking at the specification. This is a question for the jury. *Ibid.*, 171.

3. Under § 6 of the act of 1793, a defect or concealment in a specification, in order to make the patent invalid, must appear to have been made for the purpose of deceiving the public. *Whitney v. Carter*, Fessenden on Pat., 2d ed., 139.—JOHNSON, J.; Geo., 1809.

4. Any matters not disclosed in a patent, to invalidate it must appear to have been concealed for the purpose of deceiving the public. *Park v. Little*, 3 Wash., 198.—WASHINGTON, J.; Pa., 1813.

5. Under § 6 of the act of 1793, a defect or concealment in a specification, to avoid a patent, must arise from an intention to deceive the public. *Whittemore v. Cutter*, 1 Gall., 437.—STORY, J.; Mass., 1813.

6. Under the act of 1793, though the specification is materially defective, it will not invalidate the patent, unless the jury are satisfied that the concealment of the circumstances not described was intended to deceive the public. *Gray v. James*, Pet., C. C., 401.—WASHINGTON, J.; Pa., 1817.

7. The degree of evidence required to prove such fraudulent intention, rests with the jury. Positive evidence is not necessary. The intention may be presumed from circumstances, as if the parts concealed are so essential and so obviously necessary to be disclosed, that no

mechanic skilled in the art could reasonably be expected to understand the subject so as from the description given to make the machine. But such a presumption would be weakened by the testimony of such skilful persons, that they could not hesitate in supplying the omissions. *Ibid.*, 402.

8. If the specification is not so full, clear, and exact, as to enable a skilful person to compound and make the same, this, under § 6 of the act of 1793, does not avoid the patent, unless the defective concealment or description has been made for the purpose of deceiving the public. *Lowell v. Lewis*, 1 Mas., 189, 190.—STORY, J.; Mass., 1817.

E. DEFECTS IN, HOW REMEDIED.

See MISTAKES; REISSUE OF PATENT.

STATES, POWERS OF.

1. The power of Congress under article 1, § 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, and does not embrace introducers, who are not the authors or inventors. *Livingston v. Van Ingen*, 9 John., 560, 566, 582.—YATES, THOMPSON, and KENT, JJ.; N. Y., 1812.

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

3. Nor does it take away from the states the power to enlarge within their jurisdiction the privilege, by extending the term of the patent or monopoly,

beyond the term allowed by the acts of Congress. *Ibid.*, 581.

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

5. So a patentee may have the time of his monopoly extended by the legislature of any state beyond the term granted under the acts of Congress. *Ibid.*, 581.

6. Nor does that clause of the constitution operate as an exclusion of all state legislative authority and interference to aid and protect the rights obtained under the general government, if the power is exercised in harmony with and in subordination to the superior power of Congress. Such power is not granted by exclusive words to the United States, nor prohibited to the individual states; it is therefore a concurrent power, which may be exercised by the states, in a variety of cases, without any infringement of the congressional power. *Ibid.*, 567, 581.—(THOMPSON, KENT, JJ.)

7. 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, must be used and enjoyed within each state according to the laws of such state. *Ibid.*, 581.

8. The grant by the legislature of a state of an exclusive privilege to an invention for a limited time, does not imply that at the expiration of the period

COPYRIGHT ACTS. ACT OF 1790, § 1.

the invention shall become public property. The state may renew the grant at the end of the period, or refuse to do so. *Evans v. Eaton*, Pet., C. C., 337.—WASHINGTON, J.; Pa., 1816.

9. Contracts in relation to patented machines, are regulated by the laws of the several states. *Wilson v. Sandford*, 10 How., 99.—TANEY, Ch. J.; Sup. Ct., 1850.

10. If the right of the purchaser of a patented machine is infringed, he must seek redress in the courts of the states, and according to their laws. The machine is personal property, and is not protected by the laws of the United States, but by the laws of the state in which it is situated. *Bloomer v. McQuewan*, 14 How., 550.—TANEY, Ch. J.; Sup. Ct., 1852. *Chaffee v. Bost. Belting Co.*, 22 How., 223.—CLIFFORD, J.; Sup. Ct., 1859.

11. Previous to the acts of Congress, many of the states had exercised the power of granting exclusive privileges, within their respective territories, to inventors and introducers of inventions. Provision was made in the act of 1793, § 7, for such cases. [Ed.]

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A. COPYRIGHT ACTS.

The notes here inserted under the dif-

ferent sections of the several acts, are of a general character, or have more particular reference to the *construction* of the statutes themselves than to their *application*; and such notes are confined to those sections as to which there have been direct adjudications.

For the several copyright acts in full, and with more extended notes thereto, see APPENDIX. [Ed.]

ACT OF 1790. CHAP. 15.

Section 1.

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

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

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

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

5. Congress, in passing the act of 1790, did not legislate in reference to existing rights. Instead of sanctioning

COPYRIGHT ACTS. ACT OF 1790, §§ 3, 4. ACT OF 1802, § 1.

an existing right; it created it. *Ibid.*, 661.

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

7. A person cannot have an exclusive right or copyright in a label, as it is not a book, within the provisions of the statute. *Coffeen v. Brunton*, 4 McLean, 517.—McLEAN, J.; Ind., 1849.

Section 3.

1. The provisions of this section, which require the author to publish the title of his book in a newspaper, and to deliver a copy of the work itself to the Secretary of State, are merely directory, and constitute no part of the essential requisites for securing the copyright. *Nichols v. Ruggles*, 3 Day, 158.—CURRIAM, Ct., 1808.

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

3. Under this section a proprietor can acquire no title to a copyright for the term of the first fourteen years, unless he shall deposit in the clerk's office a printed copy of the title of the book. *Ever v. Coxe*, 4 Wash., 490.—WASHINGTON, J.; Pa., 1824.

4. But the condition upon which the proprietor is to be entitled to the benefit of the act cannot be extended to the requisition contained in the last sentence of that section, to publish a copy of the record of the title, as prescribed therein.—*Ibid.*, 490.

5. If the title of an author depended upon the act of 1790, it would be complete, provided he had deposited a

printed copy of the title of the book in the clerk's office, as directed by § 3; and the publication of a copy of the same would only be necessary to enable him to sue for the forfeitures created by that section. *Ibid.*, 490.

Section 4.

1. The copy of a book to be delivered to the Secretary of State within six months after publishing thereof, appears to be designed for public purposes, and has no connection with the copyright. A neglect to deliver such copy will not invalidate the copyright, and is not a condition precedent thereto. *Nichols v. Ruggles*, 3 Day, 158.—CURRIAM, Ct., 1808.

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

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

ACT OF 1802. CHAP. 36.

Section 1.

1. The act of 1802, § 1, provides that no person can be entitled to the benefits of the act of 1790, unless he shall, in

addition to the requisites enjoined in §§ 3 and 4 of that act, cause a copy of the record, required by that act to be published, to be inserted, at full length, in the title-page, or on the page immediately following the title. *Ewer v. Coxe*, 4 Wash., 490.—WASHINGTON, J.; Pa., 1824.

2. The person, therefore, claiming a copyright, before he can be entitled to the benefits of the act of 1790, must perform the requisites required by the act of 1802, *in addition* to those prescribed in §§ 3 and 4 of the act of 1790, and must perform the whole. The act admits of no other construction. *Ibid.*, 491.

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

4. Under the act of 1790, when considered in connection with § 1 of the act of 1802, an author can obtain no exclusive right in his work, unless he complies with the requirements of §§ 3 and 4 of the act of 1790, by causing a copy of the record of his copyright to be printed in the newspapers, and delivering a copy of his work to the Secretary of State. *Wheaton v. Peters*, 8 Pet., 665.—MCLEAN, J.; Sup. Ct., 1834.

Section 2.

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

who shall also engrave, etch, or work the print to which the right is claimed; or, who, *from his own works and inventions*, shall cause the print to be designed and engraved, etched or worked. *Binns v. Woodruff*, 4 Wash., 51.—WASHINGTON, J.; Pa., 1821.

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

3. But in neither case can a person claim a copyright for a mere invention, the work of his imagination locked up in his own mind, or existing in a form not visible to others. *Ibid.*, 51.

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

5. The phrase *design*, when used as a term of art, means the giving of a visible form to the conceptions of the mind, or, in other words, to the invention. *Ibid.*, 52.

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

ACT OF 1819. CHAP. 19.

1. Under the act of 1790 and 1819, as to patents and copyrights, the owners of copyrights and patents, do not

have redress or relief in any cases where they could not before have had relief in some court either of equity or law. *Pierpont v. Fowle*, 2 Wood. & Min., 27.—WOODBURY, J.; Mass., 1846.

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

3. The act of 1819, so far as it gave cognizance to the courts of the United States, in cases of copyright, still remains in force, and is the only law conferring equitable jurisdiction on these courts in such cases; § 9 of the act of 1831, protects manuscripts only. *Stephens v. Gladding*, 17 How., 455.—CURTIS, J.; Sup. Ct.; 1854.

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

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

6. Under the act of Congress giving to the Circuit Courts cognizance of cases arising under the laws of the United States, granting to authors the exclusive right to their writings, the

citizenship of the parties litigant is immaterial. *Keene v. Wheatley*, 9 Amer. Law Reg., 44, 45.—CADWALLADER, J.; Pa., 1860.

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

8. Under the statutes, which confer and regulate *rights* of literary proprietorship, the citizenship of such parties is also unimportant. It is sufficient if the complainant is a *resident* of the United States. *Ibid.*, 45.

ACT OF 1831. CHAP. 16.

Section 1.

See also COPYRIGHT, A., B., C.

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

2. Capt. Maryatt, a subject of Great Britain, and an officer under that government, being temporarily in this country, took the required oath of his intention to become a citizen, and then took out a copyright for one of his books, and assigned the same to the plaintiff; *Held*, that he was not a "resident" within the meaning of the act of 1831, so as to be entitled to a copyright for his book. *Ibid.* •

3. The author or compiler of a musical composition, made up of different parts, copied from older compositions without material change, and put together into one tune, with only slight alterations or additions, is not entitled

COPYRIGHT ACTS. ACT OF 1831, §§ 2, 4, 5.

to a copyright for such therefor. *Reed v. Carasi*, 8 Law Rep., 411.—TANEY, Ch. J.; Md., 1845.

4. One who gets others to compile a work, or engrave a print, is not entitled to a copyright. *Pierpont v. Fowle*, 2 Wood. & Min., 46.—WOODBURY, J.; Mass., 1846.

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

6. A person cannot secure a copyright for alterations and improvements in a musical composition, made by others for him, and at his expense. *Ibid.*, 46.

7. Under the copyright act of 1831, the legal assignee of the author may take out the copyright, and it will make no difference whether he holds it as trustee, for the benefit of another, or not. *Little v. Gould*, 2 Blatchf., 366.—NELSON, J.; N. Y., 1852.

8. An artist, who is employed by the United States to engrave a chart, of which the original manuscript was the property of, and furnished by the government, has no pretence of right of copyright in the engraved plates, or impressions therefrom. *Seibert's Case*, 7 Opin., 656.—CUSHING, Atty. Gen.; 1856.

9. Under the act of 1831, no person can obtain a copyright, except authors who are citizens or residents of the United States, and proprietors under derivations of title from *such* authors. *Keene v. Wheatley*, 9 Amer. Law Reg., 45.—CADWALLADER, J.; Pa., 1860.

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

11. A person who hires another to

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

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

Section 2.

See also COPYRIGHT, E.

1. An assignment of a "copyright" is to be referred to what was then in existence, and not to any future contingency. *Pierpont v. Fowle*, 2 Wood. & Min., 43, 45.—WOODBURY, J.; Mass., 1846.

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

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

Sections 4 & 5.

See also COPYRIGHT, D

1. Where a work consists of a number

COPYRIGHT ACTS. ACT OF 1831, §§ 4, 5, 6.

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

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

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

4. Under §§ 4 and 5 of the act of 1831, depositing the title-page in the proper clerk's office, publishing a notice according to the act, and delivering a copy of the book, are conditions the performance of which is essential to the title. *Baker v. Taylor*, 2 Blatchf., 84.—BETTS, J.; N. Y., 1848.

5. Where the title-page of a book was deposited in 1846, and the notice of the entry inserted in the book stated it to have been deposited in 1847, *Held*, that the error created a fatal defect in the plaintiff's title. *Ibid.*, 84.

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

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

8. By the provisions of the copyright act of 1831, there are three preliminary steps requisite to the securing a valid copyright: 1. The deposit of a printed copy of the title before publication, with the clerk of the District Court. 2. Notice to the public, by printing in the place designated, the fact of the entry, in the form prescribed by the statute,

and, 3. The deposit with the clerk of a copy of the book, &c., or musical composition, within three months from the date of publication. *Jollie v. Jaques*, 1 Blatchf., 620.—NELSON, J.; N. Y., 1850.

9. Until all the things required by §§ 4 and 5, act of 1831, are done, the copyright is not secured; but by taking the incipient step, a right is acquired, which chancery will protect until the other acts may be done. *Pulte v. Derby*, 5 McLean, 332.—MCLEAN, J.; Ohio, 1852.

10. The provisions of § 4 of the copyright act of 1831, as to the deposit of the title-page of the book to be copyrighted, before publication, and the deposit of a printed volume of the book within three months after publication, must be complied with in order to enable a party to avail himself of the provisions secured by that act. *Struve v. Schwedler*, 4 Blatchf., 24.—NELSON, J.; N. Y., 1857.

Section 6.

See also INFRINGEMENT, A.

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

2. To entitle a party to an action for the infringement of a copyright, it is not necessary that the whole, or a greater part of his work should be taken. If so much is taken as to impair the value of the original, or so that the labors of the original author are substantially appropriated, an action will lie. *Folsom v.*

Marsh, 2 Story, 115.—STORY, J.; Mass., 1841.

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

4. Nor does it necessarily depend upon the quantity taken, whether it is an infringement of a copyright or not. *Ibid.*, 116.

5. If a copyright has been invaded, whether the party knew the work was copyrighted or not, he is liable to the penalty for violation. *Millett v. Snowden*, 1 West. Law Jour., 240.—BETTS, J.; N. Y., 1843.

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

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

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

Penalties under.

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

2. An *action on the case* is the proper form of action to recover damages for a violation of a copyright: *trespass* will

not lie. *Atwill v. Ferrett*, 2 Blatchf., 48.—BETTS, J.; N. Y., 1847.

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

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

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

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

Section 7.

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

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

3. The engraving or preparation of plates, where the work is printed from plates, may have been more than two years; but every printing for sale would

be a new infraction of the right, and if such printing was within two years before suit brought, the defendant is liable. *Ibid.*, 412.

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

Section 9.

See also LETTERS; MANUSCRIPTS.

1. There remains in an author, notwithstanding the copyright by statute, a common law title to his works before publication. *Jones v. Thorne*, 1 N. Y. Leg. Obs., 400.—McCOUN, V. Chan.; N. Y., 1843.

2. 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.

3. On general, equitable principles, relief may also be given, under like circumstances, by a Court of Chancery. *Ibid.*, 301.

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

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

6. The common law protects the right of an author to his manuscript only. *Bartlette v. Crittenden*, 5 McLean, 38.—McLEAN, J.; Ohio, 1849.

7. § 9 of the copyright act of 1831, also protects such right. *Ibid.*, 38.

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

9. 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.

Section 11.

The penalties referred to in this section, cannot be recovered in an action brought in the name of more than one person. *Ferrett v. Atwill*, 1 Blatchf., 155.—NELSON, J.; N. Y., 1846.

ACT OF 1834. CHAP. 157.

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

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

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

4. The statute of 1834, sanctioning

COPYRIGHT ACTS. ACT OF 1856.

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

5. There is no sufficient reason for preventing an author conveying a distinct portion of his right. Divisibility, as well as assignability, enhances the value of his property. *Ibid.*, 401. [Contra, 75, *post.*]

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

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

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

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

ACT OF 1856. CHAP. 169.

1. The act of 1856 was passed to give to the authors of dramatic compositions

the exclusive right of acting and representing, which they did not enjoy under the previous statutes. *Roberts v. Meyers*, 13 Mo. Law Rep., 397.—SPRAGUE, J.; Mass., 1860.

2. This act assumes the doctrine that representation is not publication. The prior acts secured to authors the exclusive right of printing and publication; and it was only because publication did not embrace acting or representation, that this statute of 1856 was passed, superadding that exclusive right to those previously enjoyed. *Ibid.*, 397.

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

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

5. And such action may be maintained, although the author or assignee has only filed his title-page, and has not published the work or play. *Ibid.*, 401. [Contra, 15 *post.*]

6. The only act which affords redress for unauthorized theatrical representations, is the act of August 18th, 1856; but this only applies to cases in which copyright is effectually secured under the act of 1831. *Keene v. Wheatley*, 9 Amer. Law Reg., 45.—CADWALLADER, J.; Pa., 1860.

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

B. PATENT ACTS.1. *Power of Congress to enact.*

See CONGRESS.

2. *Policy and Intent of.*

See also PATENTS, P. 1.

1. Many of the provisions of our patent acts are derived from the principles and practice which have prevailed in the construction of those of England; and though it is not strictly the case in respect to the English statute of monopolies, as in respect to the statute of frauds and of limitations, which have been adopted into our own legislation, that the known and settled construction of those statutes by courts of law has been considered as silently incorporated into our acts, or has been received with all the weight of authority, yet the construction of the statute of monopolies adopted by the English courts, and the principles and practice which have long regulated the grants of their patents, as they must have been known and are tacitly referred to in some of the provisions of our own statute, afford materials to illustrate it. *Pennock v. Dialogue*, 2 Pet., 18.—STORY, J.; Sup. Ct., 1829.

2. The intention of the patent law, as declared by Congress, is to promote the progress of the useful arts, by the benefits *granted to inventors*; not by those accruing to the public after the patent has expired, as in England. *Whitney v. Emmett*, Bald., 321.—BALDWIN, J.; Pa., 1831.

3. Intended for their protection and security, the law should be construed favorably and benignly in favor of pat-

entees. When the invention is substantially new and useful, and the specification is intelligible to men who understand the subject, juries ought to look favorably on the right of property, and find against a patentee only for some substantial defect in his title papers or proof. *Ibid.*, 322.

4. To promote the progress of the useful arts is the interest and policy of every enlightened government. It cannot be doubted that the settled purpose of the United States has even been to confer on the authors of useful inventions an exclusive right in their inventions for the time mentioned in their patent. It is the reward stipulated for the advantages derived by the public for the exertions of the individual, and is intended as a stimulus to those exertions. The laws which are passed to give effect to this purpose ought to be construed in the spirit in which they have been made; and should be executed fairly on the part of the United States, if this can be done without transcending the statute, or countenancing acts which are fraudulent or may prove mischievous. *Grant v. Raymond*, 6 Pet., 241, 242.—MARSHALL, Ch. J.; Sup. Ct., 1832.

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

6. 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 con-

PATENT ACTS; POLICY AND INTENT OF.

strued with the utmost rigor, as *strictissimi juris*. *Ames v. Howard*, 1 Sumn., 485.—STORY, J.; Mass., 1833.

7. The constitution of the United States, in giving authority to Congress to grant patents for a limited period, declares the object to be to promote the progress of science and useful arts, an object as truly national, and meritorious, and well founded in public policy, as any which can possibly be within the scope of national protection. Hence it has always been the course of the American courts—and latterly of the English—to construe patents fairly and liberally, and not subject them to any overnice and critical refinements. *Ibid.*, 485.

8. It is no objection to the validity of laws respecting patents, that they are retrospective in their operation. The powers of Congress to legislate upon the subject of patents is plenary by the constitution, and as there are no restraints on its exercise, there can be no limitation of its right to modify them at pleasure, so that they do not take away the rights of property in existing patents. *McClurgh v. Kingsland*, 1 How., 206.—BALDWIN, J.; Sup. Ct., 1843.

9. The patent law gives to Inventors an exclusive right in their inventions, but it is not a monopoly in an odious sense. It takes nothing from the community at large, but secures to them the greatest benefits. And to secure them the remuneration the law provides, a liberal construction should be given to it. *Brooks v. Bicknell*, 3 McLean, 437.—MCLEAN, J.; Ohio, 1844.

10. The patent laws are not made to encourage monopolies of what before belonged to others, or to the public—which is the true idea of a monopoly—but the design is to encourage genius

in advancing the arts, through science and ingenuity, by protecting its productions of what did not before exist, and of what never belonged to another person, or the public. *Davoll v. Brown*, 1 Wood. & Min., 57.—WOODBURY, J.; Mass., 1845.

11. Under the patent laws the inventor receives no monopoly. Instead of receiving any thing from the public, he confers on it the greatest benefits; and all he asks, and all he receives, is that for a few years he shall realize some advantage from his own creation. *Parker v. Harworth*, 4 McLean, 372.—MCLEAN, J.; Ill., 1848.

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

13. The patent acts have been passed for the promotion of the useful arts—for the ultimate benefit of the republic, and not for the sole benefit of inventors and patentees. It is for the ultimate benefit of the public that privileges are granted to inventors, allowed to operate, and protected for limited times for their direct benefit. *Day v. Union Rub. Co.*, 3 or 4 Blatchf.—HALL, J.; N. Y., 1856.

14. Patents are granted to inventors not for their benefit simply, but for the purpose of benefiting the public by encouraging inventors to make inventions which may be useful to the public when placed at their disposal. *Ransom v.*

Mayor, &c., 1 Fisher, 255.—HALL, J.; N. Y., 1856.

15. 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.

16. 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.

3. General or Public Acts.

The notes here inserted under the different sections of the several acts, are of a general character, or have more particular reference to the *construction* of the statutes, than to their *application*; and such notes are confined to those sections as to which there have been direct adjudications.

For the several patent acts in full, and with more extended notes thereto, see APPENDIX. [*Ed.*]

ACT OF 1790. CHAP. 7.

Section 1.

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

2. The Secretary of State cannot issue a patent unless the prerequisites required by law are complied with; as he cannot

issue a patent without a specification, or with a specification altogether ambiguous and unintelligible. *Kneass v. Schuylkill Bank*, 4 Wash., 13.—WASHINGTON, J.; Pa., 1820.

Section 3.

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

Section 4.

A erected on his own premises, and at his own expense, a machine, which was the invention of B. B then took of A a lease of the machine for a term of years, covenanting to reconvey the same, at the end of the term of years to A. B afterward brought an action against A for the use under such reconveyance. *Held*, that this amounted to a license or consent to use, in writing, within the meaning of this section. *Reutgen v. Kanows*, 1 Wash., 172.—WASHINGTON, J.; Pa., 1804.

Section b.

See act of 1793, § 10.

Section 6.

As to General Issue and notice, see notes to act of 1793, § 6, and act of 1836, § 15.

See also PATENT, P. 2.

PATENT ACTS; PUBLIC. ACT OF 1793, § 1.

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

ACT OF 1793. CHAP. 9.

Section 1.

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

2. The first section of the act of 1793 is to be construed with the sixth section of the same act, and means that the first inventor has a right to a patent, though there may have been a knowledge of the thing invented before the *application* for a patent, if such use or knowledge was not anterior to the *discovery*. *Mel-lus v. Silsbee*, 4 Mas., 111.—STORY, J.; Mass., 1825.

3. The true construction of the act of 1793, considering the first and sixth sections together, is that to invalidate a patent because of a prior use or knowledge, the thing patented must have been used prior to the alleged *discovery* of the patentee, and not merely prior to the

application. *Treadwell v. Bladen*, 4 Wash., 707, 708.—WASHINGTON, J.; Pa., 1827.

4. The meaning of the words "not known," &c., in § 1 of the act of 1793, is that the invention must not have been known or used *by the public* before the application. *Pennock, v. Dialogue*, 2 Pet., 19.—STORY, J.; Sup. Ct., 1829.

5. The patent act of 1790 used the words "not known or used before," without adding the words "the application," in connection with the structure of the sentence in which they stand; they might have been referred either to the time of the invention, or of the application. The addition of the latter words in the act of 1793 must have been *ex industria*, and with the cautious intention to clear away a doubt and fix the original and deliberate meaning of the legislature. *Ibid.*, 22.

6. The words "not known or used before the application," refer to the application for the patent, and not to the discovery referred to in the sixth section; but the previous use to invalidate a patent must be a public use by the consent or acquiescence of the patentee. *Whitney v. Emmett*, Bald., 309.—BALDWIN, J.; Pa., 1831.

7. Within the spirit of this section it was held that the Secretary of State, though not expressly authorized, might receive the surrender of letters patent which were defective by reason of mistakes innocently committed, either by the department, or by the inventor, and reissue a new and corrected patent. *Grant v. Raymond*, 6 Pet., 242.—MARSHALL, Ch. J.; Sup. Ct., 1832.

8. The knowledge and use spoken of in this act has reference to the public only. A surreptitious knowledge and use will not affect the right of the in-

ventor. *Shaw v. Cooper*, 7 Pet., 319.—McLEAN, J.; Sup. Ct., 1833.

9. Though this act, like that of 1790, requires a petition to be presented, and the patent, when issued, to recite the "allegations and suggestions of the petition," it appears on investigation that after the act of 1790, the petition alone seldom contained any thing as to the patent beyond a mere title; sometimes fuller, and again very imperfect and general, with no other allegations or suggestions, or descriptions whatever, except those in the schedule or specification. *Hogg v. Emerson*, 6 How., 480, 481.—WOODBURY, J.; Sup. Ct., 1847.

10. But the specification being filed at the same time, and often on the same paper, seems to have been regarded, whether specially named in the petition or not, as a part of it. To avoid mistakes as to the extent of the inventor's claim, and to comply with the law, by inserting in the patent at least the substance of the petition, the officers inserted, by express reference, the whole descriptive portion of it as contained in the schedule. *Ibid.*, 481.

Section 2.

See also FORM.

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

2. Though this declaratory act, that

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

Section 3.

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. Under the provisions of this section requiring drawings with written references, if the specification refers to the drawings, they thereby become part of the written description of the invention. *Earle v. Sawyer*, 4 Mas., 10, 11.—STORY, J.; Mass., 1825.

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

4. The patent act of 1793 does not limit the inventor to one single mode or one single set of ingredients to carry into effect his invention. He may claim as many modes as he pleases, provided always that the claim is limited to such as he has invented, and as are substantially new, and § 3 of this act requires in the case of a machine, that the inven-

PATENT ACTS; PUBLIC. ACT OF 1793, §§ 4, 5.

tor shall explain the several modes in which he has contemplated the application of its principle. *Ryan v. Goodwin*, 3 Sumn., 521.—STORY, J.; Mass., 1839.

5. Under this section, the omission of written references in the specification to the drawings, unless such references are necessary to an understanding of the invention, will not vitiate the patent. *Brooks v. Bicknell*, 3 McLean, 261.—MCLEAN, J.; Ohio, 1843; *Washburn v. Gould*, 3 Story, 133.—STORY, J.; Mass., 1844.

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

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

Section 4.

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

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

3. Under this section an assignment is not valid unless it has been recorded

in the office of the Secretary of State. *Higgins v. Strong*, 4 Blackf., 183.—DEWEY, J.; Ind., 1836.

4. An assignment of a particular interest in a patent-right, as 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.

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

Section 5.

1. Actions brought for an infringement of a patent are not cognizable in a state court, but are only cognizable in the Circuit Courts of the United States. *Parsons v. Barnard*, 7 John., 144.—CURIAM; N. Y., 1810.

2. Under this section the assignee of a *part* of a patent cannot maintain an action at law for a violation of the patent. *Tyler v. Tuel*, 6 Cra., 324.—CURIAM; Sup. Ct., 1810.

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

4. Under this section, subjecting to a penalty "any person who shall make, devise, *and* use, or sell, the thing so invented," it might well be questioned whether any person would be subject to the penalty for using a machine, which he had not also made and devised. But this doubt is removed by § 3 of the act of 1800, which repeals this § 5, and subjects to damages "any person who shall make, devise, use, or sell" the in-

vention of another. *Evans v. Jordan*, 1 Brock., 250, 251.—MARSHALL, Ch. J.; Va., 1813.

5. Where an inventor assigned his invention before patent taken out, *Held*, that the action for infringement could not be maintained by the patentee, but should be brought by the assignee. *Herbert v. Adams*, 4 Mas., 15.—STORY, J.; Mass., 1825.

6. Whether the assignee of a part interest in a patent, circumscribed by local limits, may maintain a suit at law; *query*. But he may in equity. *Ogle v. Ege*, 4 Wash., 584.—WASHINGTON, J.; Pa., 1826.

7. Under the acts of 1793 and 1800, the Circuit Courts of the United States alone have jurisdiction of actions brought for damages for an infringement of a patent. *Burrall v. Jewett*, 2 Paige, 145.—WALWORTH, Chan.; N. Y., 1830.

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

9. § 4 of the patent act of 1790, made an infringer liable to pay such damages as the jury should find, and also forfeit the machine. § 5 of the act of 1793, declared that an infringer should pay a sum equal to three times the price for which the patentee had sold licenses. § 3 of the act of 1800, provided that an infringer should pay three times the actual damages sustained. *Seymour v. McCormick*, 16 How., 488.—GRIER, J.; Sup. Ct., 1853.

10. § 14 of the patent act of 1836, confines the jury to the actual damages sustained by the patentee. The power

to increase them, as punitive damages, is committed to the discretion and judgment of the court. *Ibid.*, 489.

Section 6.

1. This section does not enumerate all the defences of which the defendant may legally avail himself: as he may give in evidence that he never did the thing attributed to him; that the patentee is an alien, and not entitled under the act; or that he has a license or authority under the patentee. *Whittemore v. Cutter*, 1 Gall., 435.—STORY, J.; Mass., 1813.

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

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

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

5. The provisions of this section do not apply to enable a plaintiff to treat his patent as void. The proceedings under this section are the acts of the defendant only, and the plaintiff has no right to set up a defect in his own patent. *Morris v. Huntington*, 1 Paine, 355.—THOMPSON, J.; N. Y., 1824.

6. This section does not enumerate all the defences which a party may

make in a suit brought against him for violating a patent. One obvious omission is where he uses it under a license or grant from the inventor. *Pennock v. Dialogue*, 2 Pet., 23.—STORY, J.; Sup. Ct., 1829.

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

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

Section 9.

1. An inventor filed a description of his alleged invention, in 1802, as required by § 3 of the act of 1793, and took no further step until 1814. In that year another person made application for a patent for the same invention, without knowledge of the first invention. *Held*, that there was no limitation of time within which a patent must be taken out after the specification filed, and that the facts made a case of interference to be arbitrated under this section. *Anon.*, 5 Opin., 701.—RUSH, Atty. Gen.; 1814.

2. The refusal of a defendant to submit his claim to arbitration under this section, and his subsequently obtaining a patent therefor, is not conclusive evidence, in a proceeding under § 10, that such patent was obtained surreptitious-

ly. *Stearnes v. Barrett*, 1 Mas., 174.—STORY, J.; Mass., 1816.

Section 10.

1. Proceedings under this section upon the rule *nisi* are not conclusive. The process awarded upon making the rule absolute, is in the nature of a *scire facias*, and is not final. *Stearnes v. Barrett*, 1 Mas., 165.—STORY, J.; Mass., 1816.

2. The authority intended to be given by this section is vested exclusively in the District Courts, and proceedings under it are summary, and not in the nature of a *scire facias*. The making the rule *nisi* absolute works a repeal of the patent without further proceedings. *McGaw v. Bryan*, 1 U. S. Law Jour., 98.—VAN NESS, J.; N. Y., 1822.

3. Under this section the making the rule *nisi* absolute does not *de facto* work a repeal of the patent: but the process to be issued is in the nature of a *scire facias* to the patentee to show cause why the patent should not be repealed. *Wood & Brundage, Ex parte*, 9 Wheat., 604, 615.—STORY, J.; Sup. Ct., 1824.

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

5. The hearing on the return of the rule to show cause is only initial, and the order of the judge is not that the patent is invalid, but only that process shall issue for a trial of its validity. *Ibid.*, 494.

6. The summary proceeding under this section is given to protect the pub-

lic from manifest fraud in taking out patents (the fees of office being no check) for known and common things. *Ibid.*, 494.

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

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

Section 11.

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

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

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

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

ACT OF 1800. CHAP. 25.

Section 1.

1. Under this act a foreigner, though having resided within the United States for more than two years, could not have a patent for an invention operated by him in another country, before he came here, as he could not take the oath required by this statute. *Duplat's Case*, 1 Opin., 322.—WIRT, Atty. Gen.; 1820.

2. By the provisions of this act, taken in connection with those of the act of 1793, citizens and aliens, as to patent-rights, are placed substantially upon the same ground, as to a right to a patent when the invention has been known or used before it was patented. In both cases the right is to be tested by the same rule. *Shaw v. Cooper*, 7 Pet., 316.—MCLEAN, J.; Sup. Ct., 1833.

Section 3.

1. This section gave jurisdiction only in actions *on the case*; *Held*, before, that a suit in equity, respecting patent, in order to be cognizable by the Circuit Courts, must come within the provisions of the judiciary act of 1789, and that where the parties were all residents of the same state, such courts had not jurisdiction. *Livingston v. Van Ingen*, 1 Paine, 48, 54.—LIVINGSTON, J.; N. Y., 1811. [This defect was afterward remedied by the act of 1819. *Ed.*]

2. This section gives an action against any one who shall "make, devise, use,

or sell," the thing patented, and takes the place of § 5 of the act of 1793, which gave an action against any one who should "make, devise, and use, or sell," and which is repealed by § 4 of the act of 1800. This change was made because of some doubt whether the language of § 5 of the act of 1793, did not couple the making and *using* together, to constitute an offence, so that making, without using, or using without making, was not an infringement. *Whittemore v. Cutter*, 1 Gall., 432.—STORY, J.; Mass., 1813.

3. The doubt which arose under § 5 of the act of 1793, whether any person would be subject to the penalty therein mentioned, for *using* a machine which he had not also *made* and devised, is removed by this section, which repeals § 5 of the act of 1793, and subjects to damages any person who shall "make, devise, use, or sell," the thing patented. *Evans v. Jordan*, 1 Brock., 252.—MARSHALL, Ch. J.; Va., 1813.

4. Under this section, the sale, under execution, of the *materials* of patented articles, is not such a sale as makes the sheriff liable to an infringement. *Sawin v. Guild*, 1 Gall., 487.—STORY, J.; Mass., 1813.

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

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

7. This section fixed the amount of the recovery at three times the actual

damage sustained. Trebling the damages, under the act of 1836, rests with the discretion of the court. *Guyon v. Serrell*, 1 Blatchf., 245.—NELSON, J.; N. Y., 1847.

ACT OF 1819. CHAP. 19.

1. This act removes the defect that existed under the act of 1800, by which the Circuit Courts did not have jurisdiction of suits in equity, but only of actions on the case, where the parties were all residents of the same state. *Livingston v. Van Ingen*, 1 Paine, 54, N. Y., 1811 (note).

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

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

4. Though the substance of this enactment, so far as it relates to the subject of patent-rights, is incorporated into § 17 of the act of 1836, and is no longer in force, *proprio vigore*, yet so far as it gave cognizance to the courts

PATENT ACTS; PUBLIC. ACT OF 1832, §§ 2, 3. ACT OF 1836, § 2.

of the United States of cases of copyright, it still remains in force, and is the only law conferring equitable jurisdiction on those courts in such cases. *Stevens v. Gladding*, 17 How., 455.—CURTIS, J.; Sup. Ct., 1854.

5. There is nothing in this act which extends the equity powers of the courts to the adjudication of forfeitures. *Ibid.*, 455.

ACT OF 1832. CHAP. 162.

Section 2.

1. Under the patent laws, prior to 1836, if a patent was renewed, it was a new grant, independent of the old, and the patentee was entitled to the sole and exclusive benefit thereof, unless the licensees, or assignees, had by their original grant secured to themselves, by express covenant or grant, a right to the benefit of the renewed patent. *Washburn v. Gould*, 3 Story, 135.—STORY, J.; Mass., 1844.

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

Section 3.

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

2. As the exception in the proviso is

limited to the use of the invention, under a special license, after the grant of the original patent, it leaves the use prior to the application for such patent clearly obnoxious to the principle established in *Pennock v. Dialogue*, 2 Pet., 1, 1829, whereby the patent would become void. *Ibid.*, 207.

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

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

ACT OF 1836. CHAP. 357.

Section 2.

See also COMMISSIONER, G.

1. Under this section the chief clerk is the acting Commissioner whenever for any reason, the Commissioner is unable to discharge his duties. *Woodworth v. Hall*, 1 Wood. & Min., 256, 392.—WOODBURY, J.; Mass., 1846.

2. The courts will take notice, judicially, of the persons who, from time to time, preside over the Patent Office, whether permanently or transiently. *York & Maryland R. R. v. Winans*, 17 How., 41.—CAMPBELL, J.; Sup. Ct., 1854.

Section 4.

See also COPIES OF PAPERS.

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

2. Certified copies of papers and drawings, on file in the Patent Office, must be received in evidence when offered. If they are discordant, they may destroy the effect of each other; but they need not concur in every particular. *Emerson v. Hogg*, 2 Blatchf., 12.—BETTS, J.; N. Y., 1845.

3. If copies of a patent are erroneous, the Commissioner of Patents has the power, and ought to make them conform to the patent itself, and to the record. *Woodworth v. Hall*, 1 Wood. & Min., 260.—WOODBURY, J.; Mass., 1846.

4. Certified copies of papers, in the Patent Office, are *prima facie* evidence of the genuineness of the original on file, and absolute evidence of the correctness of the copies from the record. *Parker v. Haworth*, 4 McLean, 371.—McLEAN, J.; Ill., 1848.

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

6. A certified copy of an assignment of a patent, from the Patent Office, is *prima facie* evidence of the genuineness of the original. *Lee v. Blandy*, 2 Fisher, 91.—LEAVITT, J.; Ohio, 1860.

Section 5.

See also PATENT, D. 1, E.

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

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

Section 6.

As to subject matter of patent, see PATENT, A.

As to how invention should be described, see SPECIFICATION, B.

As to patent including more than one invention, see PATENT, D. 2.

See also DRAWINGS; MACHINE, B.; OATH.

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

2. The words "by others," in this section, were probably added by way of

PATENT ACTS; PUBLIC. ACT OF 1836, § 7.

explanation of the doubt formerly entertained on the subject, whether a use by the patentee himself of his invention, before application, would deprive him of a right to a patent; and to confirm the decision in *Pennock v. Dialogue*, 2 Pet., 18-22. *Reed v. Cutter*, 1 Story, 597.—STORY, J.; Mass., 1841.

3. The words "not known or used by others before his discovery or invention," do not denote a plurality of persons, by whom the use should be known, but that the use should be by some other person or persons than the patentee. *Ibid.*, 597, 598.

4. §§ 6 and 15 of the act of 1836, and § 9 of the act of 1837, are to be construed, as to originality of invention, as though they were embodied in one act. *Smith v. Ely*, 5 McLean, 84.—MCLEAN, J.; Ohio, 1849.

5. The second set of drawings required by this act, are unnecessary until the patent issues, and need not accompany the application. *French v. Rogers*, 1 Fisher, 136.—KANE, J.; Pa., 1851; *O'Reilly v. Morse*, 15 How., 126.—GRIER, J.; Sup. Ct., 1853.

6. The things specified in this section are prerequisites to the granting of a patent, and unless these prerequisites are complied with, a party sued for an infringement of the patent, may show that they have not been complied with, and in that mode defeat the action of the supposed inventor. *Ransom v. Mayor, &c.*, 1 Fisher, 257.—HALL, J.; N. Y., 1856.

Section 7.

As to withdrawal, see APPLICATION, C. See also PRIOR KNOWLEDGE AND INVENTION.

1. The Commissioner is bound to issue

a patent in the case and under the circumstances mentioned in this section. He has no discretion about it. *Milbreath v. Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

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

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

4. The words "prior to the application," in § 7 of the act of 1836, refer only to the "public use or sale (of the invention, with the applicant's consent or allowance," and do not refer to any thing else. *Bartholomew v. Sawyer*, 4 Blatchf., 350.—INGERSOLL, J.; N. Y., 1859.

5. The words "prior to the alleged invention of the applicant," refer to an invention or discovery of some one, other than the applicant, in this country, and also to a patent or description in this or some foreign country. *Ibid.*, 351.

6. The true meaning of this section is, that a patent shall issue to the applicant, and be valid, if he is the originator and author of a useful invention, unless the thing invented by him has, prior to his alleged invention or discovery, been invented, or discovered, or used, by some one else in this country; or unless the invention of the applicant has been patented, or described in some printed

publication, in this or some foreign country, prior to the alleged invention or discovery of the applicant; or has been on sale with the applicant's consent, prior to his application for a patent. *Ibid.*

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

Section 8.

See also APPEALS, B.

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

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

3. 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, Ex parte, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.*

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

and by § 8, where there are interfering applications. And there is nothing in the repealing act of 1839 which takes away or impairs such right. *Fultz, Ex parte, MS. (App. Cas.)—MORSELL, J.; D. C.; 1853.*

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

6. The right of appeal is now considered as established in accordance with this last decision. [*Ed.*]

7. Appeals are now taken to the justices of the Circuit Court of the District of Columbia, instead of to the board of examiners created by this section. See act of 1839, § 11, and act of 1852, § 1.

Section 9.

By § 10 of the act of March 2, 1861, all laws discriminating between the inhabitants of the United States and those of other countries, which shall not discriminate against the inhabitants of the United States, are repealed; and a new rate of fees enacted, uniform for all. [*Ed.*]

Section 10.

1. Under this section, if an inventor die before he has obtained a patent for his invention, no person other than his executor or administrator can apply for a patent for such invention, and the patent must be issued to such person in trust for the heirs at law or devisees of the inventor. *Stimpson v. Rogers, 4 Blatchf., 335.—INGERSOLL, J.; Ct., 1859.*

PATENT ACTS; PUBLIC. ACT OF 1836, §§ 11, 12.

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

Section 11.

See also ASSIGNMENT, A., B., C.

1. The provision as to recording assignments within three months is merely directory, and except as to intermediate *bona fide* purchasers, without notice, any subsequent recording is sufficient. *Brooks v. Byam*, 2 Story, 542.—STORY, J.; Mass., 1843; *Pitts v. Whitman*, 2 Story, 615.—STORY, J.; Maine., 1843; *Blanch. Gun-Stock Fac. v. Warner*, 1 Blatchf., 271.—NELSON, J.; Ct., 1846.

2. A mere license need not be recorded; it is not an exclusive right. *Brooks v. Byam*, 2 Story, 542, 543.—STORY, J.; Mass., 1843.

3. This section refers to the grant of an exclusive right in a patent, and the term *exclusive* comprehends not only an exclusive right to the whole patent, but an exclusive right to the patent in a particular section of country. *Washburn v. Gould*, 3 Story, 131.—STORY, J.; Mass., 1844.

4. This section provides for but three kinds of assignments: 1st, As to the whole interest; 2d, As to an undivided part; and 3d, An exclusive right in any district. *Blanchard v. Eldridge*, 1 Wall., Jr., 339, 340.—GRIER, J.; Pa., 1849.

5. This statute renders the monopoly

capable of subdivision as to locality, and in no other way. *Ibid.*, 340.

6. Under this section an assignment of a patent may be made as well before the issuing of the patent as afterward. The thing to be assigned is not the mere parchment, but the monopoly conferred—the right of property which it creates; and when the party has acquired an inchoate right, an assignment of it is legal. *Gayler v. Wilder*, 10 How., 493.—TANEY, Ch. J.; Sup. Ct., 1850.

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

Section 12.

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

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

3. The caveat is to set "forth the de-

PATENT ACTS; PUBLIC ACT OF 1836, §§ 12, 13.

sign and purpose" of the invention, and "its principal and distinguishing characteristics," but it is not necessary that it should explain the principle involved, or the modes in which it can be applied, nor how it is distinguished from other inventions. Nor is it necessary to accompany it with specimens of ingredients, or compounds, or models, or drawings, or with an oath of invention or discovery. *Anon.*, MS., Opin.—BLACK, Atty. Gen.; 1857.

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

5. The purpose of a caveat is to save the discoverer of an invention from the effect of the rule of law that gives to the inventor who first adapts his invention to practical use the right to the grant of a patent: and if the Commissioner complies with the terms of § 12 of the act of 1836 as to giving the caveator notice of any interfering application, it is to secure him against the effect of the rule. *Phelps, Dodge & Co. v. Brown Bros.*, 4 Blatchf., 364.—NELSON, J.; N. Y., 1859.

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

Section 13.

See also REISSUE OF PATENT.

1. This section made no material change from § 3 of the act of 1832, in respect to the use of an invention, under a defective patent, conferring any right to continue such use under the reissued

patent; but any person using an invention protected by a renewed patent, subsequently to the date of the act of 1836 (July 4), is guilty of an infringement, however long he may have used the same, after the date of the defective and surrendered patent. *Stimpson v. West Chester R. R.*, 4 How., 402.—MCLEAN, J.; Sup. Ct., 1845.

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

3. It is not the meaning of this section that the patentee, in his reissue, must describe and claim, in his new specification, either in words or idea, just what he described and claimed in his old one; but his specification must be of the same invention, and he cannot embrace a different subject matter than that he sought to patent originally. *French v. Rogers*, 1 Fisher, 138.—GRIER, KANE, JJ.; Pa., 1851.

4. There may be more than one reissue of the same patent; the surrender and reissue should be allowed to follow each other as often as the inventor is content to be more specific or more modest in his claims. *Ibid.*, 137.

5. This section may be regarded as affirming the propriety of the usage which had obtained under the former laws, and under which a second reissue was allowed, as well as the first. *Ibid.*, 137.

6. An improvement may be annexed, under this section, to the specification of the original patent, so as to make it form a part of the original patent: but there is nothing that forbids an inventor