

taking out a new patent for the improvement, if he prefers it. *O'Reilly v. Morse*, 15 How., 122.—TANEY, Ch. J.; Sup. Ct., 1853.

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

8. By this section, the sole right to surrender is given, 1st. To the patentee, if he is alive and has made no assignment of the original patent; 2d. To the executors and administrators of the patentee, after his decease, where there has been no such assignment; and, 3d. 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.; Ct., 1858.

9. Where, however, there has been an assignment of an undivided part of the whole patent, in such case the assignee and patentee become joint owners, and should join in the surrender, and if they do not, it will be invalid, unless the part owner not joining shall ratify it. *Ibid.*, 209.

10. This section gives to the patentee the right to correct his description or specification, when its imperfection has arisen from inadvertency, accident, or mistake. But the only condition on which this can be done is that the original patent is *inoperative* or invalid by reason of a failure to comply with the requirements of the statute. The proceeding is therefore equivalent to a distinct admission that the patent has no validity entitling a patentee to an action for its infringement. *Moffitt v.*

Garr, 1 Fisher, 613.—LEAVITT, J.; Ohio, 1860.

11. The words, "it shall be *lawful* for the Commissioner, &c., to cause a new patent to be issued," in § 13, act of 1836, are to be construed as *mandatory*, and to be of the same import as if the words had been, "it *shall be the duty* of the Commissioner," &c. The true meaning is, the Commissioner is to have no discretion in the case provided for in the section. *Dyson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

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

13. What the legislature designed to secure to patentees by this section was, to enable them to cure *honest mistakes*, and to get *substantially 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 shall be the same. *Ibid.*

14. To prove that his invention, claimed on the reissue, is the same made and intended to be patented, he is not limited to the specification, models, or drawings of his original patent, but he may go outside of these 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. *Ibid.*

Section 14.

See also ACTIONS, B. 1, 3; DAMAGES.

1. The assignees of an exclusive right in a patent, are the proper persons to maintain an action for a violation of it.

Washburn v. Gould, 3 Story, 131, 167.—STORY, J.; Mass., 1844.

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

3. Under this section, in connection with § 11 of the act of 1836, an action is given only to such party—composed of one or more persons—as possesses the whole interest in the patent. *Suydam v. Day*, 2 Blatchf., 23.—NELSON, BETTS, JJ.; N. Y., 1846.

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

5. *Actual damages*, according to this section, are the sum fixed by the verdict. The court may render judgment for three times the amount of the verdict. *Stephens v. Felt*, 2 Blatchf., 38.—BETTS, J.; N. Y., 1846.

6. Under this section, it rests in the discretion of the court whether the damages shall be trebled. Under the act of 1800, the amount of recovery was fixed at three times the actual damages sustained. *Guyon v. Serrell*, 1 Blatchf., 245.—NELSON, J.; N. Y., 1847.

7. But under this section the court may increase the damages, though the plaintiff is not entitled to recover costs under § 9 of the act of 1837, by reason of neglect in filing a disclaimer until after action was commenced. *Ibid.*, 246.

8. Previous to the act of 1836, the court were compelled to treble the damages. Since that act they are not compelled to do so, but may increase them or not, at their discretion. *Stimpson v. Railroads*, 1 Wall., Jr., 166.—GRIER, J.; Pa., 1847.

9. Actual damages does not mean exemplary, vindictive damages. *Ibid.*, 169.

10. The word "assignees," in this section, must be construed by reference to § 11 of the same act, as meaning the assignee of a whole interest, or an undivided one, or an exclusive local right. *Blanchard v. Eldridge*, 1 Wall., Jr., 340.—GRIER, J.; Pa., 1849.

11. To enable an assignee of a sectional interest in a patent to sue in his own name under this section, he must have the exclusive right, or entire and unqualified monopoly which the patentee held in the territory specified, excluding the patentee himself, as well as others. *Gayler v. Wilder*, 10 How., 494.—TANEY, Ch. J.; Sup. Ct., 1850.

12. § 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. The act of 1800 provided that an infringer should pay three times the actual damages sustained. § 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. *Seymour v. McCormick*, 16 How., 488.—GRIER, J.; Sup. Ct., 1853.

Section 15.

See also DEFENCES; GENERAL ISSUE; PRINTED PUBLICATION; PRIOR KNOWLEDGE AND INVENTION; PRIOR USE.

1. The public use of an invention, before application, referred to in this section, means a public use with the

PATENT ACTS; PUBLIC. ACT OF 1836, § 15.

consent of the inventor, either generally allowed or acquiesced in, or at least unlimited in time, or extent, or object, and not merely experimental or temporary, as an act of accommodation or kindness. *Wyeth v. Stone*, 1 Story, 281.—STORY, J.; Mass., 1840.

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

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

4. The provision in this section, requiring notice of prior knowledge and use, was intended to guard against surprise from such evidence as was given in Whitney's case. Though his invention was one of undoubted originality, two persons were brought forward, one of whom testified that he had seen such an invention in England seventeen years before, and the other that he had seen one in Ireland. *Wilton v. Railroads*, 1 Wall., Jr., 195.—GRIER, J.; Pa., 1847.

5. 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 inven-

tion or discovery abroad—that is, a discovery not patented, and not described in any printed publication. *Anon.*, 5 Opin., 21.—TOUCEY, Atty. Gen.; 1848.

6. 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.*

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

8. The defence that the patentee had "surreptitiously and unjustly obtained the patent, for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same," does not necessarily imply bad faith on the part of the patentee, against whose patent this defence is set up. The words were intended to be used, and are used, in their broadest sense. *Phelps, Dodge & Co. v. Brown Bros.*, 4 Blatchf., 364.—NELSON, J.; N. Y., 1859.

9. The meaning of the word *patented*, in the phrase "patented in any foreign country," is that the invention shall

have been made patent to the world. In England, therefore, an invention is not patented until the complete specification is filed, which need not be until six months after the date of the letters patent. *Howe v. Morton*, MS.—SPRAGUE, J.; Mass., 1860.

Section 16.

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

2. The assignee of an invention, by virtue of an assignment made before patent issued, may file a bill in his own name, under this section and § 10 of the act of 1839, against a patentee to whom a patent issued on the rejection of the assignor's application, for the purpose of annulling the patent issued, and having one granted to him as assignee. And such assignment need not have been recorded before suit brought; it will be sufficient, if it is recorded at any time before the issuing of the patent. *Gay v. Cornell*, 1 Blatchf., 509, 510.—NELSON, J.; N. Y., 1849.

3. Upon a bill filed to declare a patent, granted by the Commissioner, after an interference, invalid, or inoperative, under this section, and amended by § 10 of the act of 1839, the hearing is altogether independent of that before the Commissioner, and takes place upon such testimony as the parties may see fit to produce, agreeably to the rules and practice of a court of equity. The evi-

dence before the Commissioner is not evidence in such a suit, except by consent of parties; nor are the parties restricted to the testimony used before the Commissioner. Either party is at liberty to introduce additional evidence. *Atkinson v. Boardman*, MS.—NELSON, J.; N. Y., 1851.

Section 17.

See also COURTS, B. 1.

1. "Other reasonable cases," under this section, in which appeals and writs of error may be allowed to the Supreme Court, must be limited to cases which relate to the construction of the patent laws, and such as involve important and not trifling matters, connected with those laws, and questions really doubtful. *Allen v. Blunt*, 2 Wood. & Min., 157.—WOODBURY, J.; Mass., 1846.

2. Under this section, if a writ of error is allowed by the court as "reasonable," such writ must bring up the whole case for consideration, and the court below cannot decide as to what particular points shall be taken up. *Hogg v. Emerson*, 6 How., 478.—WOODBURY, J.; Sup. Ct., 1847.

3. The word "reasonable" applies to the cases, rather than to any discrimination between the different points in the cases. *Ibid.*, 478.

4. A judge at chambers may allow a writ of error under this section, in the "other cases" referred to, where the judgment is less than \$2,000. *Boote v. Silsby*, 1 Blatchf., 544.—NELSON, J.; N. Y., 1850.

5. The "other cases" in this section, does not include a suit in equity to set aside an assignment of a patent. *Wilson v. Sandford*, 10 How., 101, 102.—TANEY, Ch. J.: Sup. Ct., 1850.

PATENT ACTS; PUBLIC. ACT OF 1836, §§ 17, 18.

6. The discretionary power, as to granting writs of error in patent cases, vested in the Circuit Courts by this section, is confined to cases which involve the construction of the patent laws, and the rights of patentees under them. *Sizer v. Many*, 16 How., 103.—TANEY, Ch. J.; Sup. Ct., 1853.

7. Under this section the Circuit Courts have jurisdiction, irrespective of the right of the plaintiff to an injunction, or a demand for one. *Nevins v. Johnson*, 3 Blatchf., 83.—NELSON, BETTS, JJ.; N. Y., 1853.

8. The natural interpretation of the language of this section seems to be, that Congress has bestowed upon this court a common jurisdiction, both on its law and equity sides, over all cases under the patent laws, and that no suit of that character can be maintained at law which may not also be prosecuted in equity. *Ibid.*

Section 18.

See also EXTENSION OF PATENT.

1. The decision of the Board of Commissioners, under this section, is conclusive within the scope of its authority. *Brooks v. Bicknell*, 3 McLean, 258.—MCLEAN, J.; Ohio, 1843.

2. In this section the word *patentee* is used as equivalent to *inventor*. *Woodworth v. Sherman*, 3 Story, 176.—STORY, J.; Mass., 1844.

3. The right of renewal is not limited to future patents, but also applies to the past. *Ibid.*, 179, 180.

4. The object of the clause as to assignees is to preserve any previous contracts of assignment, in the sense in which both parties understood and intended at the time it was made, and

to secure to the purchaser the right he had intended to buy, and which the patentee intended to sell. *Wilson v. Turner*, 7 Law Rep., 530.—TANEY, Ch. J.; Md., 1845.

5. The extension of a patent, under this section, does not inure to the benefit of assignees or grantees under the original patent, so as to vest in them any exclusive right. But the benefit of such renewal is limited to those who were in the use of the patented article at the time of the renewal, and saves to such persons the right to use the machines held by them at the time of such renewal. *Wilson v. Rosseau*, 4 How., 682.—NELSON, J.; Sup. Ct., 1845.

6. The meaning of the words "thing patented" in the latter part of this section, when construed in connection with the simple right to *use*, without the right to *make* and *vend*, has reference to the machine patented. *Ibid.*, 683.

7. The phrase "to the extent of their interests therein," means their interests in the patented machines, be that interest in one or more at the time of the extension. *Ibid.*, 683.

8. This section authorizes the extension of a patent on the application of an administrator; and this though the patentee during his lifetime had disposed of all his interest in the existing patent, and having at the time of his death no interest in it. *Ibid.*, 686.

9. But one extension is provided for by this section. *Gibson v. Cook*, 2 Blatchf., 146.—NELSON, J.; N. Y., 1850.

10. The words of this section as to assignees and grantees, seem to convey the impression that something more than the mere ownership of existing machines was intended, and that they were intended to embrace all classes of

such assignees and grantees, and all inventions, whether of machines, processes, or compositions of matter, and to embrace rights and interests which were different in extent, either of time or territory, or both. *Day v. Union Rub. Co.*, 3 Blatchf., 497.—HALL, J.; N. Y., 1856.

11. But such right is limited to a right to use, although the person holding it may also have held, during the original term, an exclusive right to use, to make, and vend. And such right to use is secured only to the extent of the respective interests of the assignees or grantees therein. *Ibid.*

ACT OF 1837. CHAP. 45.

Section 2.

1. Where a patent was granted in 1834, to which no drawing was attached, nor any reference made thereto; and in June, 1837, such patent was recorded anew, which patent was also extended for seven years on the 20th of September, 1848, and in November, 1848, a drawing of the invention, with written references was filed, with an affidavit of the patentee that such drawing was a true delineation of his invention, *Held*, in an action of infringement, that under this section a certified copy of such drawing was admissible in evidence in connection with the patent and specification, and that the whole together made *prima facie* evidence of the particulars of such invention. *Winans v. Schenec. & Troy R. R.*, 2 Blatchf., 283, 285, 298.—NELSON, J.; N. Y., 1851.

2. Such a drawing, however, as a general rule will not be effectual to correct any material defect in the specifica-

tion, unless it should appear that it corresponded with drawings which accompanied the original application for a patent: otherwise, in case of discrepancy between the drawings and specification, the latter must prevail. Nor will such a drawing have the same effect as if it had been referred to in the specification. *Ibid.*, 299.

Section 3.

1. Where a patent was obtained in 1834, the original of which and the drawings were destroyed by fire in 1836, and the patentee, under the act of 1837, afterward in 1841 filed a copy of his patent, and deposited a drawing which, however, was not verified, but which he verified in February, 1844; and subsequently, in March, 1844, considering such copy imperfect, filed another and a fuller drawing, and commenced suit in May, 1844; *Held*, that a certified copy of such second drawing was properly received in evidence in such action. *Emerson v. Hogg*, 2 Blatchf., 9.—BERTS, J.; N. Y., 1845.

2. When such drawings are put on file they become public records, and copies of them must be received in evidence. If they are discordant, one may destroy the effect of the other. *Ibid.*, 12.

3. Under this section drawings, when burnt, may be restored, and if in some respects erroneous, they can be corrected. *Hogg v. Emerson*, 11 How., 606.—WOODBURY, J.; Sup. Ct., 1850.

4. But it would not be proper to leave the drawings so long not restored or corrected as to evince neglect, or a design to mislead the public. *Ibid.*, 606.

Section 5.

See also REISSUE OF PATENT.

With respect to reissues this section and § 13 of the act of 1836 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. If the patent be defective or insufficient, either in the specification or *claim*, the patentee has a right, in the absence of fraud and deception, to have a reissue for each separate and distinct part, effectually to cure the defect: and he has the right to *restrict* or *enlarge* his claim, so as to give it operation, and effectuate his invention. *Ball, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

Section 6.

See also ASSIGNEE, B. 3.

1. This is an enabling statute. Prior to its passage, letters patent could only issue to the inventor; and after they were issued they were assignable so as to give the assignee, in whole or in part, legal rights. The act of 1837 gave the right to the assignee or assignees to have the patent issued to him or them, and not to the inventor. *Anon.*, 4 Opin., 400.—MASON, Atty. Gen.; 1845.

2. Under this section patents cannot issue jointly to the inventor, as such, and to the assignee of a partial interest: but must issue to the assignee or assignees of the whole interest. *Ibid.*, 401.

3. After the assignment of the invention under this section, by which the inventor divests himself of all interest therein, and transfers it to the assignee, although the application for a patent must be in his name, still, for all substantial purposes, and in judgment of law, the assignee is the party making

the application. *Gay v. Cornell*, 1 Blatchf., 509.—NELSON, J.; N.Y., 1849.

4. The provision of this section requiring duplicate drawings, though directory in its terms, is not a condition and it has reference in point of time, to the issuing of the patent, and not to the filing of the petition for it. Duplicate drawings need not be filed at the time of the application, and such is the interpretation of the Patent Office. *French v. Rogers*, 1 Fisher, 136.—GRIER, KANE, JJ.; Pa., 1851; *O'Reilly v. Morse*, 15 How., 126.—GRIER, J.; Sup. Ct., 1853.

5. If an inventor assign all his right in an invention, the assignee may have the patent issued to himself. But if the assignment be only partial, though the part excepted is small, the assignee has no legal claim to the patent. It must be issued in the name of the inventor, and be held by him in trust for the use of the assignee to the extent of the equities he has by virtue of his contract. *Ager's Case*, MS., Opin.—BLACK, Atty. Gen.; 1859.

Section 7.

See also DISCLAIMER.

1. The disclaimer mentioned in this section applies solely to suits pending when the disclaimer is filed, and the disclaimer mentioned in § 9 applies solely to suits brought after the disclaimer is filed. *Wyeth v. Stone*, 1 Story, 294.—STORY, J.; Mass., 1840.

2. *Semble*, that a disclaimer, under this section should not only disclaim what is not claimed as new, but should also distinctly set forth what part of the invention is still claimed, as it is manifestly designed to act as a new specification. *Lippincott v. Kelly*, 1 West. Law Jour., 515.—IRVIN, J.; Pa., 1844.

3. A disclaimer of a part of an invention cannot affect a prior grantee under the patent, unless he accepts of it; he may refuse to be affected by it. *Smith v. Mercer*, 4 West. Law Jour., 52.—KANE, J.; Pa., 1848.

4. Where a disclaimer made by a patentee stated that "it was to operate to the extent of the interest in said letters patent vested" in the patentee; *Held*, that it fairly imported on its face, that the patentee was the owner of the entire interest in the patent, and if so, there was a substantial compliance with the statute, as to the disclaimer stating the interest of the party making it. *Foote v. Silsby*, 1 Blatchf., 449, 450, 461.—NELSON, J.; N. Y., 1849. [Affirmed, *Silsby v. Foote*, 14 How., 221.—CURTIS, J., Sup. Ct., 1852.]

5. Under this section the owner of a sectional interest may disclaim a part of the thing patented, which will be considered a part of the original patent, to the extent of his interest; but the patentee is not compelled to join in it, nor will it affect any one except him making it, and those claiming under him. *Potter v. Holland*, 4 Blatchf., 217.—INGER-SOLL, J.; Ct., 1858.

6. After such a disclaimer a different claim of right is secured to the disclaimant from what is purported to be secured to the patentee; different claims of right in the same invention are secured to different sectional owners. *Ibid.*, 217.

7. The disclaimer of part of an invention, provided such disclaimer arose from inadvertency, accident, or mistake, will not prevent the patent from embracing the part so disclaimed, on a re-issue of his patent. *Hayden, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

Section 8.

This section, so far as it provides for additions to existing patents, is repealed by act of March 4th, 1861. [*Ed.*]

Section 9.

See also DISCLAIMER.

1. § 9 of the act of 1837, contemplated the rule of the common law—that if a patent embraces different machines, and any one of them is not new, or was not the invention of the patentee, or the like, the whole patent would be void—as being then in full force, and therefore sought to mitigate it by providing that under the cases therein mentioned, the patent should be good to the extent of the patentee's invention. *Wyeth v. Stone*, 1 Story, 288, 289.—STORY, J.; Mass., 1840.

2. The disclaimer mentioned in this section applies solely to suits brought after the disclaimer is filed. *Ibid.*, 294.

3. This section is intended to cover "inadvertences and mistakes" of law, as well as inadvertences and mistakes of fact. *Ibid.*, 293, 295.

4. The doctrine that a patentee may take out a valid patent for a combination, and in it include a right to each distinct improvement, is confirmed by the obvious intent of this section, which gives a patentee a right of action for a piratical use of any of his invented improvements, which is distinctly stated in his patent, though he may by mistake, accident, or inadvertence, have claimed others of which he was not the inventor. *Pitts v. Whitman*, 2 Story, 621.—STORY, J.; Me., 1843.

5. Prior to the act of 1836, if the pat-

entee claimed more than he had invented, his patent was void. But under this section the patent is not absolutely void, because the patentee claims more than he has actually invented, but is valid for so much as is truly and *bona fide* his own; but to secure the benefits of this section, the specification must state in what the improvement consists. *Peterson v. Wooden*, 3 McLean, 249.—McLEAN, J.; Ohio, 1843.

6. Prior to the act of 1836, a patent was void if the claim extended beyond the invention. Under § 6 of the act of 1836, it was void if a substantial part had been patented, or described in a printed publication. § 15 of the same act, saved the patent from being void, if the patentee believed himself to be the first inventor. § 9 of the act of 1837 enlarged the rights of the patentee, providing, notwithstanding § 15 of the act of 1836, that the patent should not be void, where he had acted in good faith, if through mistake or inadvertence he had claimed more than he had invented, and that he might maintain suit on the part actually invented by him, provided he filed, within a reasonable time, a disclaimer of the parts not invented by him. *Smith v. Ely*, 5 McLean, 84, 85.—McLEAN, J.; Ohio, 1849.

7. Where a patent contains several claims, and the invention embraced in one is not new, or is useless, the patentee under this section and § 7 may still maintain an action for an infringement, although he did not, before action brought, make a disclaimer of the part claimed without right; but he will not be entitled to costs. *Hall v. Wiles*, 2 Blatchf., 198.—NELSON, J.; N. Y., 1851.

8. And if in the progress of a trial it turns out that a disclaimer ought to

have been made as to part claimed, the plaintiff may still recover, but will not be entitled to costs. *Ibid.*, 198.

ACT OF 1839. CHAP. 88.

Section 6.

1. The date of a patent may be altered to correspond with that of a foreign patent, previously taken out by the inventor, where the mistake has not arisen from any fraudulent or deceptive intention. *Detmold's Case*, 4 Opin., 335.—NELSON, Atty. Gen., 1844.

2. Under this section, if the domestic patent, in a case where a foreign patent has been previously obtained, purports to give an exclusive right for fourteen years from its date, instead of from the date of the foreign patent, it is void, as having been issued without authority of law; but the error is not fatal, and may be corrected on application to the Patent Office. *Smith v. Ely*, 5 McLean, 78, 80.—McLEAN, J.; Ohio, 1849.

3. The proviso of this section, as to when a home patent shall bear the date of a foreign patent, relates only to such patents as are *applied for* here after the issue of a foreign patent. *French v. Rogers*, 1 Fisher, 136.—GRIER, KANE, JJ.; Pa., 1851.

4. Where, therefore, an application for a patent was made in this country in April, 1838, and acted on in that month, but a patent was not actually issued until June 20th, 1840, at which time the patent was dated, and a foreign patent was obtained in August, 1838, *Held*, as the application here was before the foreign patent, that the grant of the patent here was under the general enactments of the act of 1836, and its term was properly from its date. *Ib.*, 136.

5. A patent is not void, because it does not, on its face, bear the same date with a foreign patent. If it is not, for any reason, exempt from the operation of the statute, on such subject, the only effect is to limit the monopoly to fourteen years from the date of the foreign patent. *O'Reilly v. Morse*, 15 How., 112.—TANEY, Ch. J.; Sup. Ct., 1853.

Section 7.

See also PRIOR USE.

1. The seventh section of the act of 1839 allows the use of an invention, even with leave of the inventor, for two years before application for a patent, without invalidating his right to a patent; *a fortiori*, the use by a third person, or a subsequent inventor, after the 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. *Hildreath v. Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. Under this section the purchaser must be a purchaser from the inventor himself, before his application for a patent, and not from a wrongdoer without his knowledge or against his will. *Pier-son v. Eagle Screw Co.*, 3 Story, 406, 407.—STORY, J.; R. I., 1844.

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

4. The object of this section is twofold: first, to protect the person who has used the thing patented, from any liability to the patentee or his assignee; and, second, to protect the rights granted

to the patentee against any infringement by any other persons. *McClurg v. Kingsland*, 1 How., 208, 209.—BALDWIN, J.; Sup. Ct., 1843.

5. This section relieved the patentee from the effects of the former laws and their construction by the court, while it puts the person who has had such prior use on the same footing as if he had a special license from the inventor, which, if given before the application for a patent, would justify a continued use of it after it issued, without liability. *Ibid.*, 209.

6. It is not limited to patents for machine manufactures and compositions of matter, but embraces inventions for modes of doing a thing, as a new improvement in the act of casting iron. *Ibid.*, 209.

7. Nor is it to be construed as confined to a specific machine as distinguished from an invention or thing patented, but the words, "newly invented machine, manufacture, or composition of matter," and, "such invention," mean the "invention patented," and the words "specific machine," refer to "the thing as originally patented," whereof the right is secured by patent, but not to any newly invented improvement on a thing once patented. *Ibid.*, 210.

8. This section has exclusive reference in respect to the use of a machine to an original patent, and not to a renewal or reissue of it. *Stimpson v. West Chester R. R.*, 4 How., 403.—MCLEAN, J.; Sup. Ct., 1845.

9. The sale of the product of an invention is not a sale of the thing invented, within this section. The sale there spoken of must be a sale of the invention, or patented article. *Booth v. Garelly*, 1 Blatchf., 250.—NELSON, J. N. Y., 1847.

10. This section virtually extends the patentee's privilege to sixteen years instead of fourteen. *McCormick v. Seymour*, 2 Blatchf., 254.—NELSON, J.; N. Y., 1851.

11. This section gives no protection to those who may have seized upon an invention or discovery disclosed in a patent, whose specification may happen to be defective or insufficient. *Goodyear v. Day*, MS.—GRIER, J.; N. J., 1852.

12. The provision in § 7, of the act 1839, as to the use of an invention, relates to the case of an use, sale or license to use, given or made and claimed under the inventor, who admits and claims the privilege. The clause should read thus: "The patent shall not be held invalid by reason that the inventor has sold or allowed his invention to be used prior to the application for a patent, unless he has abandoned it to the public, or that such sale or prior use has been for more than two years prior to such application for a patent." *Ellithorpe v. Robertson*, MS. (App. Cas.) D. C.—MORSELL, J.; 1858.

13. The privilege granted by § 7 of the act of 1839, is applicable only to the inventor, or those claiming under him, and this construction is sustained by *Peirson v. Eagle Screw Co.*, 3 Story, 402. The use of an invention by an independent inventor, or under a separate and independent patent, is not such a case as is contemplated by that section. *Beech v. Tucker*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

14. This section provided a remedy for cases where the conduct of the party as to the sale of his invention did not show an actual abandonment. It also secures the rights of those who may have purchased or constructed any newly-invented machine prior to the

application for a patent. *Sanders v. Logan*, 2 Fisher, 173.—GRIER, J.; Pa., 1861.

15. The obvious construction of it is, that a purchase, sale, or prior use shall not invalidate, unless it amounts to an abandonment to the public. *Ibid.*, 173.

Section 11.

See also APPEALS, B.

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

2. The officer of the Patent Office attending before the judge on an appeal is not to be considered as counsel for the Patent Office, or as an advocate for either of the parties litigant, but only attends to explain the decision of the commissioner. *Perry v. Cornell*, (App. Cas.) MS.—CRANCH, C. J.; D. C., 1847.

3. All the conditions prescribed by this section must be complied with as prerequisites, before the judge can take jurisdiction. His jurisdiction is special and limited, and no other power can be exercised except that expressly given. *Greenough v. Clarke*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

4. The provision of this section requiring the judge to hear and determine appeals "on the evidence produced before the commissioner," is to be construed with reference to § 7 of the act of 1836, providing that reasonable notice

shall be given, both to the party appealing and the commissioner, "so that they may have an opportunity of furnishing such facts and evidence as they may deem necessary to a just decision." There is nothing in the act of 1839 which takes away or impairs that right, but every reason to infer that it was intended to be saved to the fullest extent. *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

5. The restrictive part of this section applies to the trial of the cause by the judge on the merits. *Ibid.*

6. Where a party has been prevented from producing before the Commissioner his proofs to support his claim, it is the duty of the judge, by reasonable regulations, similar to those directed by § 12, of the act of 1839, to pursue such a course as will afford the party an opportunity to produce such proofs; and he may make an order authorizing the party to take and file his proofs as to his invention. *Ibid.*

7. The provisions of this section as to the examination, on appeals, of the Commissioner or examiners of the Patent Office must be considered in connection with the provision in § 7 of the act of 1836 as to the powers of the old board of examiners. The language of the statute means that the explanation, authorized to be required of the commissioner, may be so full and clear an explanation of the *principles* of the thing, as to enable the judge duly to apply and weigh the evidence offered to support the issue in the case, and is not to be limited to a mere exposition of the terms used; and such explanations so given the judge is bound to respect as a part of the case. *Richardson v. Hicks*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

8. Under this section the judge succeeds to all the authority conferred upon the board of examiners by § 7 of the act of 1836, to require of the commissioners and examiners information relative to the subject matter under consideration, and to the full extent. *Seeley's Appeal*, MS. (App. Cas.)—MORSELL J.; D. C., 1853.

Section 12.

See also RULES OF PATENT OFFICE.

1. The rules, as to evidence, made under this section by the Commissioner of Patents, in conformity with the law, while they remain unabrogated, are as binding as the law itself, and as well upon the Commissioner as on others. *Arnold v. Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. The rules of the Patent Office as to taking evidence, prescribed under this section must be *just and reasonable*, according to the established principles and precedents in like cases. *Nichols v. Harris*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

3. 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 benefit of them, and until abrogated, they are as binding upon the Commissioner himself as if enacted by the very statute. *O'Hara v. Hawes*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

4. The power granted to the Commissioner under this section to make rules as to the taking of evidence, gives no right to make new rules of evidence, or to make new rules of law so as to divest vested rights. *Dyson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

ACT OF 1842. CHAP. 263.

Section 5.

See also PENALTIES, B.

1. This section, though its phraseology, "a penalty of not less than one hundred dollars," is peculiar, authorizes the infliction of a penalty of just one hundred dollars for the offence therein described, and no more. *Stimpson v. Pond*, 2 Cur., 506.—CURTIS, J.; Mass., 1855.

2. The penalty may be recovered in an action of debt. *Ibid.*, 506.

3. The penalty mentioned in this section is incurred as to all articles made, and having the word "patent" affixed, with a guilty purpose. *Stephens v. Caldwell*, MS., SPRAGUE, J.; Mass., 1860.

Section 6.

See also PENALTIES, B.

1. Under this section the assignees of an interest in a patent are no more liable for articles purchased and sold by them, without the date of the patent stamped on them, than any other persons, unless the articles were manufactured with their connivance. *Palmer v. Allen*, MS.—BETTS, J.; N. Y., 1854.

2. 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. *Ibid.*

3. The penalty attaches for each separate article sold. *Ibid.*

4. 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. *Harley v. Bagley*, MS.—BETTS, J.; N. Y., 1855.

ACT OF 1848. CHAP. 47.

Section 1.

See also EXTENSION OF PATENT.

1. This act is not a repeal of § 18 of the act of 1836, providing for the extension of patents, and the enactment of a new system for that purpose; but simply a repeal of so much of it as related to the action of the Secretary of State and the solicitor of the treasury, leaving the Commissioner of Patents alone to go on in the execution of the duty. *Coll v. Young*, 2 Blatchf., 473.—NELSON, J.; N. Y., 1852.

2. Where an application for an extension of a patent, under § 18 of the act of 1836, was pending at the time of the passage of the act of 1848, which conferred upon the Commissioner of Patents alone, the same power in respect to extending patents, previously vested in the board created by the act of 1836, *Held*, that it was not necessary to renew the application, but that the Commissioner had the power to go on with the proceedings, as having been already properly instituted, and complete them by granting the extension. *Ibid.*

ACT OF 1861. CHAP.

Sections 2, 3.

See also EXAMINERS.

1. Previous to the act of March 2,

1861, all judicial acts done in the Patent Office by the primary examiners or the Board of Appeals were in intendment of law, the judicial acts of the Commissioner, and had no legal validity until sanctioned by him. They were the organs of the Commissioner to *inquire* and *enlighten* his judgment, and till the Commissioner gave validity to their judicial acts by his *fiat*, they had no legal evidence as judgment. *Snowden v. Pierce*, MS. (App. Cas.)—DUNLOP, J., D. C., 1861.

2. Under the act of 1861 the primary examiners and examiners in chief are recognized as *judicial officers*, acting independently of the Commissioner, who can *only control them*, when their judgment in due course comes before the Commissioner on appeal. *Ibid.*

3. Their acts are not the acts of the Commissioner, but their own acts. They are no longer *mere* organs of the Commissioner, but independent officers. He can only reach and overrule them when their judgments come regularly before him, *on appeal*. *Ibid.*

4. The Commissioner can give no judgment till an appeal to him, and this cannot be done till the judgment of the primary examiners has been submitted to the examiners in chief. *Ibid.*

4. *Special or Private Acts.*

a. Generally.

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

2. An act of Congress extending a patent, passed in general terms, ought to be so construed, if it may, as to be deemed a just exercise of constitutional authority. And it ought to be construed not to operate retrospectively, or *ex post facto*, unless that construction is unavoidable. *Blanchard v. Sprague*, 3 Sumn., 542.—STORY, J.; Mass., 1839.

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

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

5. Congress may exercise its constitutional power as to granting rights to inventors by special acts or otherwise, by a general system. *Bloomer v. Stolley*, 5 McLean, 161.—McLEAN, J.; Ohio, 1850.

6. And may extend a patent by special act, after such patent has been once extended, *Ibid.*, 162.

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

8. A special act in relation to any particular patent, is to be considered as engrafted upon the general acts relating to patents. They are statutes in *pari*

materia, and all relate to the same subject, and must be construed together. *Bloomer v. McQueen*, 14 How., 548, 551.—TANEY, Ch. J.; Sup. Ct., 1852.

b. Acts for relief of Thomas Blanchard.

ACT OF 1834., CH. 213. ACT OF 1839., CH. 14.

1. The act of Congress of 1834, chap. 213, renewing the patent of Thomas Blanchard, for his "machine for cutting or turning irregular forms," secures to patentees and purchasers their rights only upon the same conditions as they had before enjoyed them; *Held*, that the United States had no right to make and use his invention, except on the payment of the sum per musket or rifle secured by the terms of the former assignment to them. *Blanchard's Case*, Opin. Gilpin's Ed. 1841, 1125.—BUTLER, Atty. Gen.; 1837.

2. In construing an act of Congress, if there be a plain mistake, apparent upon the face of the act, which may be corrected by other language in the act itself, the mistake is not fatal. *Blanchard v. Sprague*, 3 Sumn., 282.—STORY, J.; Mass., 1838.

3. The mere misnomer of the name of a person or corporation named in the act, as of a person to whom a patent is granted by the act, if the person really intended can be collected from the terms of the act, is also not a fatal mistake. *Ibid.*, 282.

4. But when the descriptive words constitute the very essence of the thing, as the title or designation of the invention, unless the description is so clear and accurate as to refer to the particular thing, and are incapable of being applied to any other, the mistake is fatal. *Ibid.*, 283.

5. The act of Congress of 1834, granted a patent to B. for the term of fourteen years from the *twelfth* day of January, 1837, giving him "the exclusive right," &c., of making, using, &c., his invention of "a machine for turning or cutting irregular forms," and reference was made in such act to a description of such invention, contained in a specification annexed to letters patent granted said B., on the *twelfth* of January, 1820—and in point of fact B. never had granted to him any letters patent dated January *twelfth*, 1820, but had received on January *twentieth*, 1820, certain letters patent for "an engine for turning or cutting irregular forms out of wood, iron, brass, or other material or substance, which can be cut by ordinary tools, called B.'s self-directing machine;" *Held*, that the mistake was fatal, and that the court could not depart from the very words of the act to correct the mistake. *Ibid.*, 285.

6. The act of 1839, chap. 14, is not unconstitutional on the ground that it operates retrospectively, to give a patent for an invention, which, though made by the patentee, was in public use at the time of the passage of the act. The power of Congress as to granting patents is general, and it rests in the sound discretion of Congress to say when, and for what length of time, and under what circumstances, the patent for an invention shall be granted. There is no restriction which limits Congress to enact, where the invention has not been known or used by the public. All that is required is that the patentee should be the inventor. *Blanchard v. Sprague*, 5 Sumn., 541.—STORY, J.; Mass., 1839.

7. The act of Congress of 1839, chap. 14, extending to Thomas Blanchard a

PATENT ACTS; PRIVATE RELIEF OF OLIVER EVANS.

patent for "turning irregular forms," by the proviso of the first section, 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.

8. The reservation in such act as to assignees, does not make the act unconstitutional on the ground that Congress can only confer privileges on inventors. The power of Congress to reserve rights and privileges to assignees is incidental to the general power conferred to promote the progress of the useful arts by securing to inventors, for limited times, the exclusive right to their discoveries. *Ibid.*, 276.

9. This act of 1839 did not extend the mere legal right of the patentee, under his patent, but granted the exclusive right to the invention, and the specification of the patent was only referred to to identify the invention extended. *Ibid.*, 279.

c. Act for relief of Oliver Evans.

ACT OF 1808. CHAP. 13.

1. Under this act, and a patent taken out pursuant to it, *Held*, that Evans could recover damages for the use of a machine violating his patent, after notice of the patent, although the machine might have been constructed prior to the passing of the law. *Evans v. Weiss*, 2 Wash., 343.—WASHINGTON, J.; Pa., 1809.

2. This act, which was passed after a patent had expired, contained a proviso "that no person who shall have used the improvement" (secured by the patent), "or have erected the same for use before the issuing of the said (second) patent, shall be liable to damages

therefor." *Held*, that this proviso did not authorize the use of the improvement, subsequent to the date of the second patent; and that for such subsequent use, the parties using were liable to damages to the patentee. *Ibid.*, 248, 253.

3. The act for the relief of Oliver Evans, is not to be construed so as to exempt either from treble or single damages, the use, subsequent to the passage of such act, of the machinery mentioned therein, which was erected subsequent to the expiration of the original patent, and previous to the passage of such act. *Evans v. Jordon*, 9 Cra., 202, 204.—WASHINGTON, J.; Sup. Ct., 1815.

4. The right to recover damages for using his patent arises not under this law, but under the general patent law of 1793. *Ibid.*, 203.

5. Though this act gave to Evans the exclusive property not only in the *entire improvement*, but in the *several machines* employed to produce the specified results, yet as the patent actually issued was confined to the whole improvement, it contained no exclusive right to use severally the several machines. *Evans v. Eaton*, Pet., C. C., 340.—WASHINGTON, J.; Pa., 1816. [But see *post*, 9.]

6. The patent of Evans for his improved hopper-boy, granted under the special act of 1808, is not, either by force of such act, or of the decision of the Supreme Court in *Evans v. Eaton*, 3 Wheat., 454, an exception to the general rule; nor is it for the whole hopper-boy, whether he was the inventor of it or not. *Evans v. Hettick*, 3 Wash., 424-432.—WASHINGTON, J.; Pa., 1818.

7. His patent covers only that of which he was the first inventor, and his invention, if an improvement, must be

set forth so as to clearly distinguish it. This not having been done, he cannot recover. *Ibid.*, 428.

8. The patent of Oliver Evans is not, either by the special act passed for his relief, or by virtue of the decision of the Supreme Court (*Evans v. Eaton*, 3 Wheat., 1818), an exception to the general principles governing the issue of patents. If he is not the original inventor of the things patented to him, or if his invention is not properly set forth, he cannot recover. *Evans v. Eaton*, 3 Wash., 451, 455.—WASHINGTON, J.; Pa., 1818.

9. Though, under the general patent law, a doubt might arise whether improvements on different machines could regularly be comprehended in the same patent, so as to give a right to the exclusive use of the several machines separately, as well as a right to the exclusive use of those machines in combination; the "act for the relief of Oliver Evans," authorizes the issuing to him of a patent granting to him the full and exclusive right in his invention and improvements in the art of manufacturing flour, and in the several machines he has invented, discovered, improved, and applied to that purpose. *Evans v. Eaton*, 3 Wheat., 506.—MARSHALL, Ch. J.; Sup. Ct., 1818.

10. Taking the whole together, his patent under such act is to be construed as a grant of the general result of the whole machinery, and of the improvements in each machine; and he may claim, under his patent, the exclusive use of his inventions and improvements, in the art of manufacturing flour, and in the several machines which he has invented, and in his improvements on machines previously discovered. *Ibid.*, 517.

11. The decision of the court below in *Evans v. Eaton*, 3 Wash., 451, that if Evans' patent was for the hopper-boy, he could not recover unless he was the first inventor thereof, and that if it was a patent for an improvement on the hopper-boy, it was defective in not specifying the improvement, affirmed. *Evans v. Eaton*, 7 Wheat., 431, 435.—STORY, J.; Sup. Ct., 1822.

12. Decision of WASHINGTON, J., in *Evans v. Hettick*, 3 Wash., 424-432 (*ante* 6), as to the force and extent of Evans' patent, affirmed, *Evans v. Hettick*, 7 Wheat., 470.—STORY, J.; Sup. Ct., 1822.

13. Oliver Evans, for his invention in the art of manufacturing flour, received protection originally by means of an act of the legislature of Pennsylvania, passed March 29th, 1787—before any act of Congress had been passed—which secured to him the exclusive privilege in his invention for fourteen years. After the expiration of this time, in 1808, a special act of Congress was passed, authorizing an issue of a patent for another term of fourteen years, under which a patent was issued, bearing date January 22d, 1808. [Ed.]

d. Act for relief of William Woodworth.

ACT OF 1845. CHAP. 27.

1. There being in this act extending the Woodworth patent, no implied or expressed reservation in favor of assignees, *Held*, that an assignee under the original patent, or first extension, had no further right to use such patent. *Bloomer v. Stolley*, 5 McLean, 163.—MCLEAN, J.; Ohio, 1850.

2. There being, in the special act of February 26th, 1845, extending the

Woodworth patent for seven years from 1849, no reservation or proviso in favor of assignees under the first term, or the first extension under the act of 1836, they have no right in the term extended by Congress, and cannot even continue the use of machines held and in use by them at the expiration of the first extension. *Gibson v. Gifford*, 1 Blatchf., 530, 531.—NELSON, J.; N. Y., 1850.

3. So held also in *Mason v. Tallman*, MS.—WOODBURY, PITMAN, JJ.; R. I., 1850; *Bloomer v. Vaught*, MS.—MCKINLEY, MCCALEB, JJ.; La., 1850; *Woodworth v. Barbour*, MS.—WARE, J.; Me., 1850; and *Woodworth v. Curtis*, MS.—SPRAGUE, J.; Mass., 1850.

SUGGESTIONS, BEARING OF.

See also MECHANIC, SKILL OF.

1. The suggestions of the mechanic employed to make a machine, or of others, as to its form or proportions, are not inventions or improvements for which a patent could be obtained, nor can they invalidate the patent for the thing to which they are applied. *Penrock v. Dialogue*, 4 Wash., 544.—WASHINGTON, J.; Pa., 1825.

2. Except this was so, very few patents could be supported; as in most cases it might probably be shown that whilst the thing patented was constructing, or before it was brought to perfection, many such improvements were adopted in consequence of such suggestions. *Ibid*, 544.

3. The suggestions of a mechanic of alterations in the form or proportions of a machine, as designed by the in-

ventor, will not be sufficient to deprive the inventor of the merit of the invention, or affect the validity of his patent, if incorporated within it; nor would it be, as to such alterations, a discovery which would entitle the mechanic to take out a patent for them. *Watson v. Bladen*, 4 Wash., 582.—WASHINGTON, J.; Pa., 1828.

4. If a contrary doctrine were to be maintained, very few if any patents could be upheld, unless in those cases where the inventor is also the mechanic who constructs the machine. *Ibid*, 582.

5. If a party suggest an idea as to an invention which is indispensable to its operation, and which in reality constitutes its whole value, and another adopts such suggestion and takes out a patent therefor, the patent is void, as not being the invention of the patentee. *Thomas v. Weeks*, 2 Paine, 102.—THOMPSON, J.; N. Y., 1827.

6. And it is sufficient if such a suggestion was made by such other person, without being carried out or patented by him. *Ibid*. 103.

7. To show invention in another than the patentee, because of suggestions made by such other person, the question for the jury is, whether such person communicated substantially the invention, so that without more inventive power the other could have applied it. A mere hint is not sufficient, nor, on the other hand, need he communicate every minute thing about the invention; but he must have communicated the substance. *Alden v. Dewey*, 1 Story, 338, 339.—STORY, J.; Mass., 1840.

8. The testimony of a witness, however, that he gave such communication as to an invention, is in the nature of

a confession, and is always regarded as an uncertain kind of evidence. *Ibid.*, 339.

9. In order to invalidate a patent on the ground that the patentee did not conceive the idea embodied in the improvement, it must appear that the suggestions, if any, made to him by others, would furnish *all* the information necessary to enable him to construct the improvement. In other words, the suggestions must have been sufficient to enable him to construct a complete and perfect machine. *Pitts v. Hall*, 2 Blatchf., 234.—NELSON, J.; N. Y., 1851.

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

11. On the other hand, if the suggestions and communications of another go to make up a complete and perfect machine, embodying all that is embraced in the patent subsequently issued to the party to whom the suggestions were made, the patent is invalid, because the real discovery belongs to another. *Ibid.*, 234.

12. Inquiries made, or information or advice received from men of science, in the course of an inventor's researches, will not impair his right to the character of an inventor. It makes no difference whether an inventor derive his information from books, or from conversation with men skilled in science. *O'Reilly v. Morse*, 15 H., 111.—TANEY, Ch. J.; Sup. Ct., 1853.

13. If the idea involved in the patented article had occurred to others, or

had come to the patentee from others, still, if the patentee had been the first to give to that idea a useful and practical form, he will be considered the first inventor. *Teese v. Phelps* 1 McAllis., 49.—McALLISTER, J.; Cal., 1855.

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

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

TECHNICAL TERMS AND PHRASES.

1. "Lateral motion," in mechanics, does not mean, as the term ordinarily signifies, a side motion, but a longitudinal one. *Brooks v. Bicknell*, 3 McLean, 454.—MCLEAN, J.; Ohio, 1844.

2. The word "substantial," is not susceptible of an exact definition. But it is very generally used, and no word is more familiar in courts of justice and in the ordinary affairs of life. Beyond the exact sciences we do not look for precision. We look more to the *substance* of things than their forms. *Ibid.*, 456.

3. If technical terms are used peculiar to mechanics, in describing an invention,

MEANING OF; WHO MAY PROVE.

PATENTABILITY OF.

evidence may be heard in explanation of those terms, and in such case a jury may be necessary. *Ibid.*, 442.

4. As to the meaning of words of art and technical phrases in commerce and manufactures, which may materially affect, enlarge, or control the meaning of the words of the patent and specification, the jury are to judge. *Washburn v. Gould*, 3 Story, 158.—STORY, J.; Mass., 1844.

5. The patentee is not, in the description of his invention, to be confined to technical language; but may make use of that which is in popular use, and better understood by all. The fewer technical terms used the better, if the subject is intelligible without them. *Hovey v. Stevens*, 3 Wood. & Min., 28.—WOODBURY, J.; Mass., 1846.

6. A thing is *substantially* the same with another, when it is the same in all important particulars. It must be the same material, when material is important—of the same thickness, when thickness is important—be applied in the same way, condition, and extent, when either of these circumstances are important. *Adams v. Edwards*, MS. ———, J.; Mass., 1848.

7. Experts may be examined to explain terms of art, on the principle of *cuique in sua arte credendum*. *Corning v. Burden*, 15 How., 270.—GRIER, J.; Sup. Ct., 1853.

8. "End play" of a shaft is its lateral play within the boxes in which it runs. "Free play" is *its* unchecked action. "Free end play" is its unchecked lateral action in its revolutions. *Page v. Ferry*, 1 Fisher, 302.—WILKINS, J.; Mich., 1857.

9. "May, in fact," does not signify "shall be." *Ibid.*, 304.

10. Experts may be examined as wit-

nesses, to explain terms of art, and the state of the art at any given time. The maxim of *cuique in sua arte credendum* permits them to be examined as to questions of art or science peculiar to their trade or profession. *Winans v. N. Y. & E. R. R.*, 21 How., 100, 101.—GRIER, J.; Sup. Ct., 1858.

THEORY.

1. A patent cannot be legally obtained for a mere philosophical or abstract theory; it can only be for such a theory reduced to practice in a particular structure or combination of parts. *Lowell v. Lewis*, 1 Mas., 187.—STORY, J.; Mass., 1817.

2. The mere speculation of a philosopher or mechanic, which has never been tried by the test of experience, and never put into actual operation, will not deprive a subsequent inventor, who has employed his labor and his talents in putting it into practice, of the reward due to his ingenuity and enterprise. *Bedford v. Hunt*, 1 Mas., 305.—STORY, J.; Mass., 1817.

3. A discovery of some new principle, theory, elementary truth, or an improvement upon it, abstracted from its application, is not a new invention. *Whitney v. Emmett*, Bald., 311.—BALDWIN, J.; Pa., 1831.

4. But when such discovery is applied to any practical purpose, in the new construction, operation, or effects of machinery or composition of matter, producing a new substance, or an old one in a new way, by new machinery, or by a new combination of the parts of an old one, operating in a peculiar, better, cheaper, or quicker method, it is a "discovery," "invention," or "improvement."

ment," within the acts of Congress. *Ibid.*, 311, 312.

5. An imperfect and incomplete invention, resting in mere theory or in intellectual notion, or in uncertain experiments, and not actually reduced to practice, and embodied in some distinct machinery, apparatus, manufacture or composition of matter, is not, and, indeed, cannot be, patentable under the patent laws. *Reed v. Cutter*, 1 Story, 599.—STORY, J.; Mass., 1841.

6. 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.

7. It is not enough to conceive the idea of a new manufacture, or of a new and useful instrument. That alone is no benefit to mankind, and is not worthy the patronage of government. The new idea must be reduced to some practical use before it can become the subject of a patent, or be set up and relied upon to defeat one. *Many v. Jagger*, 1 Blatchf., 383.—NELSON, J.; N. Y., 1848.

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

9. The same position laid down in *Reed v. Cutter*, 1 Story, 599 (*ante* 5),

held also in the following case. *Marshall v. Mee*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1853.

TRADE-MARKS.

A. PROPERTY IN; IN WHAT MAY EXIST... 683
 B. WHO MAY ACQUIRE PROPERTY IN..... 687
 C. PROPERTY IN; HOW PROTECTED..... 691
 D. VIOLATION OF; WHAT IS..... 691
 E. WHEN VIOLATION OF WILL BE RESTRAINED..... 691

A. PROPERTY IN; IN WHAT MAY EXIST.

1. The right of a person in a trade-mark does not partake in any considerable, if in any degree, of the nature and character of a patent or copyright. *Taylor v. Carpenter*, 2 Sand. Ch., 617 (Ct. Errors).—SPENCER, Senator; N. Y., 1846.

2. Another is at full liberty to manufacture and vend the same article to any extent, and whenever he chooses. He is only required to depend for his success upon his own character and fame, and not to pirate upon the trade-marks, the rights of others. *Ibid.*, 617!

3. The assurance that a party can enjoy the exclusive benefit of his trade-marks is among the highest incentives to ingenuity, laborious exertion, and honorable and faithful conduct, and is one of the greatest securities to the public against imposition. *Ibid.*, 617.

4. A label or trade-mark, when it has become known, is a species of property; and the owner will be protected against the attempts of others to appropriate to themselves, by its use, the benefit which such owner is exclusively entitled to enjoy. *Partridge v. Menck*, How. App. Cas., 559.—WRIGHT, J.; N. Y., 1848.

5. The owner of an original trade-mark has a right to be protected in the exclusive use of all the marks, forms, or symbols appropriated as designating the origin and ownership of the thing to which affixed, but he cannot be protected in those which have no such relation. *Amoskeag Manuf. Co. v. Spear*, 2 Sand. S. C., 606.—DUEB, J.; N. Y., 1849.

6. He has no right to appropriate a sign or symbol which, from the nature of the fact which it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose. *Ibid.*, 606, 607.

7. The use of words, marks, or signs, indicating the name, mode, or process of manufacture, and its peculiar or relative quality as distinguished from those indicating origin or ownership, cannot be protected in any particular person, but are free to all when used as an expression of the facts which they really signify. *Ibid.*, 609, 610.

8. Where the plaintiffs used in their label the letters A. C. A., not as an indication of ownership, but only to indicate the relative quality of the goods, *Held*, that the defendants could not be restrained from using the same letters for a similar purpose. *Ibid.*, 609, 616, 619.

9. The right of a party to the exclusive enjoyment of a trade-mark does not depend upon any exclusive right of property in the article sold, or upon any exclusive right in the label—as that is not a book within the provisions of the statute—but upon the use and established reputation it has attained, and that its fraudulent use is an injury to third persons. *Coffeen v. Brunton*, 4 McLean, 517, 519.—McLEAN, J.; Ind., 1849.

10. The right which any person may

have to the protection of the court as to his trade-mark does not depend upon any exclusive right which he may be supposed to have to a particular name, or to a particular form of words; his right is to be protected against fraud, and this may be practised against him by means of a name, though the person practising it may have a perfect right to use that name, provided he does not accompany the use of it with such other circumstances as to effect a fraud upon others. *Stone v. Carlan*, 3 Mo. Law. Rep., 361.—CAMPBELL, J.; N. Y., 1850.

11. Trade-marks may be either the name of the maker; or symbolical; or the name of the compound. *Davis v. Kendall*, 2 R. I., 569.—GREENE, J.; R. I., 1853.

12. In all cases where names, signs, marks, brands, labels, words, or devices of any kind can be advantageously used to designate the goods or property, or particular place of business, of a person engaged in trade or manufactures, or any similar business, he may adopt and use such as he pleases, which are adapted to that end, and have not been before appropriated. *Stokes v. Landgraff*, 17 Barb. S. C., 609.—STRONG, J.; N. Y., 1853.

13. No other person can lawfully imitate them, and by that means sell his own goods or property, or carry on his business, as the goods, property, or business of the former. If any one does so, he is liable to an action at law for damages, or may be restrained by injunction. *Ibid.*, 609.

14. In respect to words, marks, or devices which do not denote the goods or property, or particular place of business of a person, but only the nature, kind, or quality of the articles in which he deals, a different rule prevails. *Ibid.*, 609.

PROPERTY IN; AND IN WHAT.

15. No property in such words, marks, or devices, can be acquired. They may be used by many different persons at the same time, with perfect truth and fairness. They signify nothing, when fairly interpreted, by which any dealer in a similar article can be defrauded. *Ibid.*, 609.

16. The credit and reputation which a man acquires by his care or skill in the manufacture of a particular article, is a species of property which the law recognizes and protects: and where, as a means of extending his reputation and guiding purchasers, he affixes some mark or symbol to designate that article as his manufacture, he is injured by the sale of an article manufactured by another, with his peculiar symbol or trade-mark affixed to it. *Lemoine v. Gaulton*, 2 E. D. Smith, 347, 348.—DALY, J.; N. Y., 1854.

17. There is no essential difference in kind in reference to the protection to be granted to trade-marks between establishments formed for the purpose of trade and those formed for the purpose of mere amusement. *Christy v. Murphy*, 12 How. Pr., 78.—CLERKE, J.; N. Y., 1856.

18. While neither exercises, or is calculated to exercise, any demoralizing influence, one is as well entitled to the protection of the law as the other. *Ibid.*, 78.

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

20. The privilege of a party to the

exclusive enjoyment of a trade-mark does not rest upon a right of property therein, but on its prior use and application in the manner in which it has been imitated and employed by the defendant. *Walton v. Crawley*, 3 Blatchf., 448.—BETTS, J.; N. Y., 1856.

21. A "name" may in some cases be rightfully used and protected as a trade-mark; but this is only when the name is used as indicating the true origin or ownership of the article offered for sale—never when it is used to designate the article itself, and has become, by adoption and use, its proper appellation. *Fetridge v. Wells*, 13 How. Pr., 387.—DUER, J.; N. Y., 1857.

22. All who have an equal right to manufacture and sell the article have an equal right to designate and sell it by its appropriate name, provided such person is careful to sell the article as prepared and manufactured by himself, and not by another. *Ibid.*, 387.

23. An exclusive right to use, on a label or other trade-mark, the appropriate name of a manufactured article, exists only in those who have an exclusive property in the article itself. *Ibid.*, 388.

24. There can be no exclusive property in a generic or specific name, unless as incident to an exclusive property in the article, composition, or process, which the name is used to designate. *Tomlinson v. Battel*, MS.—DUER, J.; N. Y., 1857.

25. A name or appellation may be appropriated as a trade-name; and this may be given to a compound or article every ingredient or portion of which is open to the use of every one, but the sale of which, under that appellation, is not lawful to any other person. *Fetridge v. Merchant*, 4 Abb. Pr., 158.—HOFFMAN, J.; N. Y., 1857.

26. The further removed such an appellation is from actually representing the article in question, the more decided and exclusive becomes the right to it. *Ibid.*, 158.

27. And even if the term used be common, yet it may be employed with such peculiar emblems, colors, and devices, as to give the person using an exclusive right. Strictly, the right of appropriation in such instances results from the peculiar emblems. *Ibid.*, 158, 159.

28. What will be protected embraces not merely names, but the manner of putting up the articles, and even including the wrappers or envelopes employed by the person entitled to the trade-mark. *Williams v. Johnson*, 2 Bosworth, 7.—WOODRUFF, J.; N. Y., 1857.

29. When a person forms a new word to designate an article made by him, which has never before been used, he may obtain such a right to that name as to entitle him to the sole use of it as against others, who attempt to use it for the sale of a similar article; but such an exclusive use can never be successfully claimed of words in common use previously as applicable to similar articles.

Wolfe v. Gourard, 18 How. Pr., 67.—INGRAHAM, J.; N. Y., 1859.

30. Words, as used in any language, cannot be appropriated by any one, to his exclusive use, to designate an article sold by him similar to that for which they were previously used. *Ibid.*, 67.

31. No person can acquire a right to the exclusive use of words, applied as the name of an article sold by him, if in their ordinary acceptation they designate the same or a similar article. *Ibid.*, 69.

32. Every man has a right to the reward of his skill, his energy, and his honest enterprise; and when he has ap-

propriated, as his trade-mark, letters combined into a word before unknown, and has used that word and published it to the world as his adopted "trade-mark," he has acquired rights in it which the courts will protect. *Burnett v. Phalon*, 12 Mo. Law, Rep., 223.—PIERREPONT, J.; N. Y., 1859.

33. But no one can appropriate a word in general use, as the words gin, wine, brandy, which designate things or the qualities of things, as his trademark, and restrain others from using that word. *Ibid.*, 223.

34. A manufacturer or vender of an article cannot acquire a right to an exclusive employment of a word or words, having an established meaning, to qualify the name of such article, so as to deprive every other person of the right of using such words to designate any other article, apparently similar, when the words are such as have no reference to the origin, ownership, or manufacture of such article. *Corwin v. Daly*, Upton on Trade-Marks, 191.—ROBERTSON, J.; N. Y., 1860.

35. The principle, that the mere use of a name to designate an article, would give to those employing it the exclusive right to designate such article by such name, would be giving a copyright of a most odious kind, without reference to the utility of the application, or the length of the title, and one that would be perpetual. *Ibid.*, 195, 196.

36. Where a person used the words "Club-House Gin," as a label, and another manufacturer of the same article, designated his as "Old London Club-House Gin," *Held*, that there could be no exclusive use of the words "Club-House," as these words had no reference to the origin, ownership, or manufacture of the article. *Ibid.*, 196.

WHO MAY ACQUIRE PROPERTY IN.

37. The exclusive use of known words in a language, in a trade-mark, is confined to those which indicate the origin or ownership of the article—otherwise, selling by the same title would not tend to represent them to be the same words. *Ibid.*, 197.

38. Such an epithet as “club-house” indicates no more than the words “hotel,” “royal,” “imperial,” or “princes,” or any other high-sounding title would do, and no one would be bound to suspect that there lurked beneath those words, the indication of a particular ownership or manufacture. *Ibid.*, 197.

39. The true rule is, that no words can be used by themselves without other devices, as a trade-mark, except such as point out ownership, or origin, and those which have no reference, in any possible way, to any other attribute of the article. *Ibid.*, 198.

40. Though an exclusive right to a trade-mark, or label, devised and intended to deceive the public, will not be protected by injunction, yet the fact that a trade-mark bears a fictitious name, as the name of the manufacturer of the article, does not affect the owner's right to protection, where it is shown that it is not used with any fraudulent intent, and does not in fact deceive the public. *Dale v. Smithson*, 12 Abb. Pr., 239, 241.—HILTON, J.; N. Y., 1861.

B. WHO MAY ACQUIRE PROPERTY IN.

See also ALIENS.

1. Where parties adopt certain trade-marks, and stamp them upon articles manufactured by them, they are entitled to such mark, and have an undoubted right to the assistance of a court of equity to enforce that title by a perpetual injunction. *Taylor v. Carpenter*, 11

Paige, 297.—WALWORTH, Chan.; N. Y., 1844.

2. The venders of an article of manufacture distinguished by a particular trade-mark, and to which they have given a reputation, although they may not be the manufacturers of the article, are entitled to be protected in such trade-mark. *Taylor v. Carpenter*, 2 Sand. Ch. 614 (Ct. Errors).—LOTT, Senator, N. Y.; 1846.

3. The maker and vender is only entitled to protection against a piracy of his trade-mark, not the person who buys to sell. *Ibid.*, 620.—WRIGHT, Senator, dissenting.

4. It is not necessary that a party should have a copyright, or be a citizen, in order to claim protection against counterfeits and forgeries of their labels and marks. *Ibid.*, 618.—BARLOW, J., Senator.

5. The question as to the protection of a trade-mark, is not whether the complainant was the original inventor or proprietor of the article made by him, and upon which he puts his trade-mark, nor whether the article made and sold by the defendant, under the complainant's trade-mark is an article of the same value or quality. *Partridge v. Menck*, 2 Barb. Ch. 103.—WALWORTH, Chan.; N. Y., 1847.

6. But the court proceeds upon the ground that the complainant has a valuable interest in the good-will of his trade, or business, and that having appropriated to himself a particular label, or sign, or trade-mark, indicating that the article is manufactured or sold by him, or under his authority, or that he carries on his business at a particular place, he is entitled to protection against any other person who attempts to pirate upon the good-will of his friends or

customers, or of the patrons of his trade or business, by sailing under his flag without his authority. *Ibid.*, 103.

7. A person having adopted and used a particular label or trade-mark, in his business, others, without his consent, have no right, with the view of deriving advantage from the same, to use such label or trade-mark, without change, or even with such colorable difference as is calculated to deceive. *Partridge v. Menck*, How. App. Cas., 559.—WRIGHT, J.; N. Y., 1848.

8. But where a person manufactures and sells an article under the name of the original manufacturer, although he may have purchased of such one the secret of his manner of preparing the article, and also the right to use his name, he is not entitled to be protected. *Ibid.*, 559, 561.—GARDINER, Senator.

9. And it makes no difference that the article manufactured by him is in all respects equal to that offered by the original manufacturer. *Ibid.*, 561.

10. The privilege of deceiving the public for their own benefit is not a legitimate subject of commerce, and therefore it makes no difference that the complainant has *purchased* the right to use the name of the first proprietor. A party asking equity, must come with clean hands. *Ibid.*, 561.

11. Every manufacturer, and merchant for whom goods are manufactured, has an unquestionable right to distinguish the goods that he manufactures or sells by a peculiar mark or device, in order that they may be known as his in the market, and that he may secure the profits that their superior repute may be the means of gaining. His trade-mark is an assurance to the public of the quality of his goods, and a pledge of his own integrity in their

manufacture and sale. *Amoskeag Manuf Co. v. Spear*, 2 Sand. S. C., 605.—DUEB, J.; N. Y., 1849.

12. An acquiescence of a manufacturer in the use or imitation of his trade-mark may be inferred from his knowledge and silence; but such consent, whether expressed or implied, when gratuitous, may be withdrawn: it is no more than a revocable license. *Ibid.*, 615.

13. Where the plaintiff had an agreement with the proprietors of a hotel—the Irving House—to use the name of such proprietors, and the name of their hotel upon the coaches and badges of their servants, and entered into bonds for the faithful performance of their duties in carrying passengers and baggage to and from the steamboats, &c., &c., *Held*, that the plaintiff had an exclusive right, as against third persons, in the use of the name of such hotel on his coaches and badges for such purpose, and that he was entitled to an injunction to restrain the use, by others, of the words “Irving House,” or “Irving Hotel,” to induce travellers to believe they were the servants of such hotel. *Stone v. Carlan*, 3 Mo. Law Rep., 360–362.—CAMPBELL, J.; N. Y., 1850.

14. The inventor of a medicine, though he can have no exclusive right to make and vend the same unless he obtain a patent therefor, is entitled to his trade-mark in the name of such medicine, and the law will recognize and protect this right. *Davis v. Kendall*, 2 R. I., 569.—GREENE, Ch. J., R. I., 1853.

15. A party will be protected in the use of a name which he has appropriated and rendered valuable, whether such name is upon articles of personal property which he may manufacture, or

applied to a hotel where he has built up a business. *Howard v. Henriques*, 3 Sand. S. C., 727.—CAMPBELL, J.; N. Y., 1851.

16. Where the proprietor of a hotel opened it as the "Irving House," and it became generally known also as the "Irving Hotel," and was designated by both names indiscriminately, *Held*, that he had an exclusive right to the use of such names, and that an injunction would lie against other persons setting up a hotel called also the "Irving Hotel." *Ibid.*, 726, 728.

17. The proprietor of a hotel—the Revere House—agreed with the plaintiff to keep coaches at a certain railroad depot, to convey passengers to such house, and authorized him to put on his coaches and on the caps of his drivers the words "Revere House." A similar agreement had existed between the said proprietor of the Revere House and the defendants, but had been terminated. The defendants, however, continued to use the same words on their coaches and drivers' caps, and held themselves out as connected with such house. *Marsh v. Billings*, 7 Cushing, 322.—FLETCHER, J.; Mass., 1851.

18. *Held*, that the plaintiff had an exclusive right to use the words "Revere House," as indicating and holding himself out as having the patronage of that establishment for the conveyance of passengers, and that the use by defendants of the same words for the purpose of falsely holding themselves out as having such patronage, was a fraud upon the plaintiff and a violation of his rights, for which he could maintain an action. *Ibid.*, 322.

19. The principle is well settled that a manufacturer may, by priority of appropriation of names, letters, marks, or

symbols of any kind to distinguish his manufactures, acquire a property therein as a trade-mark, for the invasion of which an action for damages will lie, and in the exclusive use of which he may have protection, when necessary, by injunction. *Stokes v. Janilgraff*, 17 Barb., 608.—STRONG, J.; N. Y., 1853.

20. There is no essential difference between establishments formed for the purpose of trade and those formed for the purpose of mere amusement. *Christy v. Murphy*, 12 How. Pr., 78.—CLERKE, J.; N. Y., 1856.

21. Where a person organized a band of performers of negro minstrelsy, and named them, after himself, "Christy's Minstrels," *Held*, that he was entitled to the exclusive use of such name, and that he would be protected in it. *Ibid.*, 78, 79.

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

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

24. A person cannot acquire a right in a trade-mark, in which he will be

protected, when such name was intended to deceive the public. An exclusive privilege for deceiving the public is not one that can be sanctioned. *Fetridge v. Wells*, 13 How. Pr., 389. CUER, J.; N. Y., 1857.

25. Where the plaintiffs were engaged in manufacturing and selling an article called the "Balm of a Thousand Flowers," and which they represented as "the very balm and extract of healing blossoms," but which in fact was only a liquid soap, *Held*, that the name was intended to deceive the public, and that the plaintiff could not be protected therein. *Ibid.*, 390, 393.

26. In determining the right of a person to a trade-mark, the invention of the article sold is not an element of decision. But the first use or appropriation of the designation or name is the material question. *Fetridge v. Merchant*, 4 Abb. Pr., 160.—HOFFMAN, J.; N. Y., 1857.

27. A manufacturer of goods who, in order to designate his own manufacture, has adopted names, marks or labels, which are peculiar and not before used, is entitled to be protected in a court of equity in their use. *Williams v. Johnson*, 2 Bosworth, 6.—WOODRUFF, J.; N. Y., 1857.

28. Though the mark has no other meaning than to distinguish their manufacture from others, if the party has given it out as his mark, and by it the article has acquired reputation and sale, he is entitled to protection in it. *Ibid.*, 6.

29. This is true, though the articles manufactured by him may be composed of well-known ingredients, which any person may combine and sell at his pleasure.—*Ibid.*, 6.

30. The courts will protect the title of the author or inventor of any names,

marks, letters, or other symbols which any manufacturer, trader, or other person has devised, or appropriated, or been accustomed to use in his trade or business, and will restrain by injunction any unauthorized use thereof to his prejudice. *Bloss v. Bloomer*, 23 Barb. S. C., 609.—SMITH, J.; N. Y., 1857.

31. But it would seem to be implied that such individuals should not themselves attempt or allow any imposition upon the public by the false and fraudulent use of such labels, devices, and names or inventions, for the sale of spurious or simulated articles. *Ibid.*, 609.

32. Where the plaintiffs, growers of garden seeds, agreed to sell defendants empty paper bags, with the plaintiffs' labels thereon, which they, defendants, were to fill with seeds and sell in certain counties, *Held*, that it was a contract against public policy, and therefore void. *Ibid.*, 605, 610.

33. The law of trade-marks is of recent origin, and may be comprehended in the proposition that a dealer "has a property in his trade-mark." *Clark v. Clark*, 25 Barb. S. C., 79.—MITCHELL, J.; N. Y., 1857.

34. The ownership is allowed to him, that he may have the exclusive benefit of the reputation which his skill has given to articles made by him, and that no other person may be able to sell to the public as his, that which is not his. *Ibid.*, 79.

35. It is to protect one's right of selling his own that the law of trade-marks has been introduced. It must include a right to sell to all—to the incautious as well as to the cautious. *Brooklyn W. L. Co. v. Masury*, 25 Barb., S. C., 418.—MITCHELL, J.; N. Y., 1857.

36. The right to a trade-mark does not become established until the trade-

COPYRIGHT IN.

mark be so often used, and so long employed, exclusively and uninterruptedly, as to create a presumption that every body would know and acknowledge it as a distinctive badge of ownership, and that the use of it by others must have been intended to deceive. *Corwin v. Daly*, Upton on Trade-Marks, 199.—ROBERTSON, J.; N. Y., 1860.

37. Even if others have used it previously—but its use had been discontinued so long as to give room for the inference that it had been abandoned, as an ordinary designation of any similar articles, and it is then taken up by a person dealing in the article, and used exclusively and uninterruptedly so long as to give rise to the presumption that it was universally recognized as the *indicia* of his ownership, his right should be protected as much as though it had then been used for the first time. *Ibid.*, 199.

38. A party cannot be protected in the use of trade-marks which are employed to deceive the public, and to deceive them by the fraudulent representations contained in the labels and devices which are claimed to constitute wholly or in part, such trade-marks. An intent to deceive the public is not favored. *Hobbs v. Francais*, 19 How. Pr. 571.—BOSWORTH, J; N. Y., 1860.

39. Where the plaintiff manufactured a skin powder, called "Meen Fun," which was represented as made in London, and "patronized by Her Majesty, the Queen," when, in fact, it was made in New York, and the defendant manufactured a like article, representing it as "patronized by Her Majesty, the Empress," *Held*, that the court would not grant an injunction; not out of any regard for the defendant, but not to assist in deceiving the public. *Ibid.*, 571.

40. The neglect of a party to carry on his business, under its well-known name, for a number of years, does not prevent him from resuming the same, or entitle another to use the name of his business. *Howe v. Searing*, 19 How. Pr., 25—HOFFMAN, J.; N. Y., 1860.

C. PROPERTY IN, HOW PROTECTED.

See ACTIONS, C.; EQUITY, C.

D. VIOLATION OF, WHAT AMOUNTS TO.

See INFRINGEMENT, C.

E. WHEN VIOLATION OF WILL BE RESTRAINED.

See INJUNCTION, C.

TRANSLATION.

1. One person may have a right to a copyright in a translation upon which he has bestowed time and labor; but another has an equal right to translate the original work, and publish his translation. *Emerson v. Davies*, 3 Story, 780.—STORY, J.; Mass., 1845.

2. A *copy* of a book must be a transcript of the *language* in which the conceptions of the author are clothed. The same conceptions, clothed in another language, cannot constitute the same composition; nor can it be called a transcript, or "*copy*," of the same "*book*." *Stowe v. Thomas*, 2 Amer. Law Reg., 229.—GRIER, J.; Pa., 1853.

3. Though the point was not directly in issue in the great case of *Miller v. Taylor*, 4 Burr., 2305, yet the inference that a translation is not an infringement

of a copyright is a logical result, and stated by the judges themselves as a necessary corollary from the principle of law then decided by the court. *Ibid.*, 230.

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

5. A translation can, in no just sense, be called a "copy" of a book. *Ibid.*, 231.

6. Where an exclusive privilege has been secured by statute in a book which is publicly circulated, a stranger who, in whole or in part, reproduces it in the new form of translation, or abridgement, or index, or table of contents, or analytical review, does not infringe the statutory privilege. But either of these acts 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.

UNITED STATES.

1. In an action under § 10 of the act of 1793, the court will not order the United States to be substituted as plaintiffs in the action of *scire facias*, in place of the petitioner. *Wood v. Williams*, Gilpin, 520, 524.—HOPKINSON, J.; Pa., 1834.

2. The United States cannot be brought in as a party to a litigation, respecting the validity of any rights claimed or derived under the United States laws. *Ibid.*, 520.

3. On the contrary, these rights are considered private rights. A controversy as to them is strictly between the parties concerned, although the public may have an eventual interest in it. *Ibid.*, 520, 521.

4. Where a patent was extended by special act of Congress, which secured to patentees and purchasers their rights only upon the same terms and conditions they had before enjoyed them, and under the former patent the United States had the right to use the invention at a stipulated price, *Held*, that under such extension the United States could not continue to use the invention except upon the terms before agreed upon; there was no exception in its favor. *Blanchard's Case*, Opin., Gilpin's ed., 1126.—BURTON, Atty. Gen.; 1837.

5. S. being an inventor of an improvement in dragoon and pack saddles, made application for a patent therefor before May, 1847. In November, 1847, before such application was acted on, G. made application for a patent for the same invention; but notice of interference was not given. In December, 1847, the Secretary of State addressed the Commissioner of Patents, that an early issue of a patent to G. would facilitate a supply of saddles to the government; G.'s application was taken up, and a patent issued December 11th, 1847—S.'s application remaining not acted upon and postponed. *Held*, that the wrong done to S. was not committed by the United States, or by any of its officers, so as to render them pecuniarily responsible therefor. *Thistle v. United States*

EFFECT OF.

Devereaux's Rep., 130.—SCARBURGH, J.; Ct. Claims, 1856.

6. There is nothing to estop the government of the United States from showing a patent, which it has granted, to have been a nullity *ab initio*, owing to the non-existence of the condition precedent of novelty of the invention. *King v. United States*, 10 Mo. Law Rep., 631.—Ct. Claims, 1857.

7. The United States are not precluded by the fact of granting a patent, from giving in evidence, or availing themselves of any legal objections that may be brought against any such patent. *Shreeve v. United States*, MS.—LORING, J.; Ct. Claims, 1859.

VERDICT IN PATENT CASES.

As to effect of verdict in feigned issues, see FEIGNED ISSUE, B.

As to what defects are cured by verdict, see PLEADING, D.

As to effect of former recoveries or verdicts upon the question of right to an injunction, see INJUNCTION, B. 2. b.

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

2. The verdict of a jury in an action on a second patent, cannot avoid a first patent. *Morris v. Huntington*, 1 Paine, 356.—THOMPSON, J.; N. Y., 1824.

3. Whether a verdict for a plaintiff

and the assessment of damages for a violation of his patent, entitles the defendant to use the machine subsequently, or transfers to him the right to use it; *query*. *Earle v. Sawyer*, 4 Mas., 13.—STORY, J.; Mass., 1825.

4. In an action for an infringement of a patent, where the declaration goes for a user during a limited period, and afterward the party sues for a user during another and subsequent period, a verdict and judgment in the former case, is not a legal bar to a recovery in the second action. The piracy is not the same, nor is the gravamen the same. *Ibid.*, 14.

5. Whether a verdict given in a suit at law is ever evidence of any thing, but the fact that it was rendered, unless a judgment has been duly rendered thereon; *query*. *Allen v. Blunt*, 3 Story, 746.—STORY, J.; Mass., 1845.

6. A former verdict of dismissal between the same parties, on an issue out of chancery, on a bill asking for an injunction, and upon an original specification, is not admissible in evidence in a suit at law for damages for violation of the patent, with corrected specifications, and in no case is such a verdict a bar to the second action, unless judgment was rendered on such verdict against the plaintiff, or such verdict of dismissal was on the merits. *Ibid.*, 132-134.

7. A verdict in a patent case, and sustaining a patent, can in no case be evidence at law or in equity, in another action brought by a witness called by the plaintiff on the trial in the former action, and who was interested in the same patent, for the purpose of establishing his title to the patent, as it is a proceeding *inter alios*. *Buck v. Hermance*, 1 Blatchf., 324.—NELSON, J.; N. Y., 1848.

8. But such verdict would be admissible on a motion for a provisional injunction, as affording strong evidence of the validity of the patent, and of his title. It is evidence, however, only in cases where his own deposition would be competent, cases in which the application is to the sound discretion of the court. *Ibid.*, 324, 325.

9. Where a patentee and his assignee brought a suit in equity in the Circuit Court in Louisiana, under section 16 of the act of 1836, against a junior patentee, to declare such junior patent void, on the ground of its interference with the plaintiff's patent; and afterward the same plaintiffs brought an action at law in another circuit, for an infringement of their patent, against a party who was not a party to the suit in Louisiana, but who had obtained an interest in the junior patent, sought to be set aside by that suit, after the commencement of that suit and before the judgment rendered therein; *Held*, that the parties to such suit at law were within the proviso of said § 16, and that their rights would be bound by a decision in the suit in Louisiana, declaring that such patents interfered, or that either of them was valid or invalid. *Tyler v. Hyde*, 2 Blatchf., 309, 312.—BETTS, J.; N. Y., 1851.

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

WARRANTY.

1. A conveyance or license "to build and use a patent machine," describing it "and such as I have a patent-right for," does not amount to a covenant on the part of the vender that he had a valid patent-right. *Bull v. Pratt*, 1 Conn., 343, 346.—SWIFT, Ch. J.; Ct., 1815.

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

3. There is no implied warranty in the sale of a patent-right. The vendor, selling in good faith, is not responsible for the goodness of his title beyond the extent of his covenants. *Hiatt v. Twomey*, 1 Dev. & Bat. Eq., 317, 318.—DANIEL, J.; N. C., 1836.

4. In sales of personal property, there is an implied warranty that the vendor has title to the property, and the same implications arise as to sales of patent-rights. *Darst v. Brockway*, 11 Ohio, 471.—BIRCHARD, J.; Ohio, 1842.

5. Where notes were given for the purchase of a patent which proved to be void, *Held*, that an injunction would be allowed against the collection of such notes outstanding, and in the hands

WHEN LIES, AND ALLOWANCE OF.

of the vendors of the patent. *Ibid.*, 471.

6. If a bill of sale of a patent contains no warranty, but a simple transfer of title, the vendee cannot set up a parol warranty, for it is to be presumed that the writing contains the entire contract. *Jolliffe v. Collins*, 2 Mo., 341.—SCOTT, J.; Mo., 1855.

7. Where a warranty is not included in the written contract, it cannot be proved by parol evidence, unless it is also alleged that it was false or fraudulent, and that thereby the vendee was deceived, and then parol proof is only evidence of such representation. *McClure v. Jeffries*, 8 Ind., 83.—DAVISON, J.; Ind., 1856.

8. An assignment contained a warranty that the invention was original, and that no other invention had been patented in the United States on the same principle. In an action of covenant in which breaches were assigned in the terms of the warranty; *Held*, that the patent was not conclusive that the invention was original, and upon a new principle, and that upon proof of the breaches assigned, the plaintiff could recover. *Wright v. Wilson*, 11 Rich. Law., 144, 152.—O'NEALL, J.; S. Car., 1857.

9. In contracts for the sale of interests in a patent where there is no fraud, the purchaser must depend, when they prove of no value, upon his covenants. If both parties are equally innocent, and there is no warranty of title, the loss must fall where the bargain leaves it. *Cansler v. Eaton*, 2 Jones Eq., 501.—NASH, Ch. J.; N. Car., 1856.

WITHDRAWAL.

See APPLICATION FOR PATENT, C.

WITNESSES.

See EVIDENCE, G.

WORKMEN, LIABILITY AS INFRINGERS.

See AGENT, EMPLOYEE.

WRIT OF ERROR IN PATENT CASES.

See also APPEALS, A.; BILLS OF EXCEPTION; COURTS, B. 1.

1. From a judgment in a proceeding under § 10 of the act of 1793, in a District Court, a writ of error lies to the Circuit Court, under § 22 of chap. 20 of the judiciary act of 1790, if the amount in controversy exceeds fifty dollars. *Stearns v. Barrett*, 1 Mas., 166, 167.—STORY, J.; Mass., 1816.

2. A refusal to amend a verdict is not the subject of a writ of error: it being but a mere exercise of discretion by the court below. *Ibid.*, 168.

3. Under § 17 of the act of 1836, if a writ of error is allowed by the court in cases where the amount in dispute does not reach \$2,000, and in such as are deemed "reasonable," it must bring up the whole case for consideration, and the court below cannot determine that only particular points shall be taken up.

WHEN LIES, AND ALLOWANCE OF.

Hogg v. Emerson, 6 How., 477, 478.—WOODBURY, J.; Sup. Ct., 1847.

4. The word "reasonable" applies to the cases rather than to any discrimination between the different points in the cases. *Ibid.*, 478.

5. Under § 17 of the act of 1836, an appeal or writ of error lies to the Supreme Court, under an order of the court, although the judgment is under the amount of \$2,000. *Footte v. Silsby*, 1 Blatchf., 544.—NELSON, J.; N. Y., 1850.

6. A judge of this court sitting at chambers is a court in the proper and usual sense of the term, and has the power to allow a writ of error, under § 17 of the act of 1836, in cases where the judgment is under \$2,000, and where the court shall deem such writ reasonable. *Ibid.*, 544.

7. There might be some reason for holding that the judge, when allowing such writ, must be sitting at a stated term of the court, and not at chambers, where the court at chambers and at the stated term were held by different persons. But where they are held by the same person the distinction is not well founded. *Ibid.*, 544.

8. On the allowance of such a writ of error, the judge made an order giving leave to the defendants to make a bill of exceptions. On the trial, two years before, no bill of exceptions had been settled in form, but a case had been made and settled, to move for a new trial. No reservation was contained in the case to turn it into a bill of exceptions; but it had first been drawn up in the form of a bill of exceptions, and changed by direction of the judge at the trial. *Held*, on a motion to set aside the order, that as the points and exceptions were taken in the required form

at the trial to entitle the party to the benefit of them on a writ of error, though the paper book was in the form of a case, which, however, was given it under the direction of the judge at the trial, without prejudice to the right of the defendants to make a bill of exceptions, that the order should stand. *Ibid.*, 544, 545.

9. The last clause of § 17 of the act of 1836 providing for appeals and writs of error "in all other cases in which the court shall deem reasonable," does not apply to a suit in equity to set aside an assignment of a patent. *Wilson v. Sandford*, 10 How., 101, 102.—TANEY, Ch. J.; Sup. Ct., 1850.

10. The right of appeal is confined to the cases mentioned in the first part of the section—"to actions, suits, controversies, and cases arising under any law of the United States granting or confirming to inventors the exclusive right to their inventions or discoveries"—and was intended to secure uniformity of decision in the construction of the acts of Congress in relation to patents. *Ibid.*, 101-313.

11. A judgment of a Circuit Court rendered upon an agreed statement of facts between the parties, may be re-examined by this court on a writ of error. *Stimpson v. Bal. & Sus. R. R. Co.*, 10 How., 346, 347.—DANIEL, J.; Sup. Ct., 1850.

12. A writ of error will not lie from an act done in the court below, the doing of which was a matter of discretion with the court. *Silsby v. Footte*, 14 How., 220.—CURTIS, J.; Sup. Ct., 1852.

13. A second writ of error brings up for revision nothing but the proceedings subsequent to the mandate. *Sizer v. Many*, 16 How., 103.—TANEY, Ch. J.; Sup. Ct., 1853.

WHEN LIES, AND ALLOWANCE OF.

14. Where, therefore, after the mandate, the court below did nothing but tax the costs, and these amounted to less than \$2,000, *Held*, that no writ of error would lie. *Ibid.*, 103.

15. The discretionary power as to granting writs of error in patent cases,

vested in the Circuit Court by § 17 of the act of 1836, is confined to cases which involve the construction of the patent laws, and the rights of patentees under them; and does not justify a writ of error merely to review a question of costs. *Ibid.*, 103.

STATUTE LAWS

OF THE

UNITED STATES OF AMERICA

RELATING TO

PATENTS FOR INVENTIONS

TRADE-MARKS

DESIGNS AND COPYRIGHTS

WITH

SECTIONAL HEAD NOTES AND INDEXES

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COPYRIGHT AND TRADE-MARK CASES"

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P R E F A C E

In the United States, property in Copyright and in Patents for Inventions, is created by, and depends solely upon, the laws passed by Congress. Previous to the adoption of the Federal Constitution, in 1789, the several states had granted exclusive rights to authors and inventors; but by that instrument such power was given to Congress, and the states can now perform no acts in respect thereto, or none not in harmony with, and in subordination to, the superior power of Congress. At its first session in 1790, Congress passed initiatory laws for the obtaining of copyrights and patents for inventions. In 1831, the several acts respecting copyright were revised and consolidated, and, in 1836, similar action was taken as to the acts respecting patents for inventions. Such laws of 1831, and of 1836, are still the basis of the present copyright and patent systems of this country, though additional acts have, from time to time, been passed for the better and more effectually protecting such property and its enjoyment.

The laws in respect to copyright, in their general features, are substantially like those of England and other countries, except, perhaps, as to the duration of the right conferred, and the formalities by which such right is to be acquired; but in respect to patents for inventions, the differences between our laws and those of other countries are marked and distinct. In England, and in most other countries, patents, originally, were grants proceeding directly from the sovereign, and were considered by the Courts in the light of monopolies, and as odious in the eyes of the law. In this country, however, it has been uniformly held that the design of our patent laws was to encourage genius in advancing the arts, by protecting its productions, and that such laws were to be construed favorably and beneficially for patentees; and that patents granted thereunder were to be considered, not as monopolies, but liberally, and as highly beneficial to the community—as well as rewards to ingenious men for the advantages derived by the public from their exertions.

The peculiar and distinctive feature of our patent system is that, which requires all applications for patents to be subjected to a preliminary examination, before a patent can be granted. In most, if not all other countries, patents issue, as of course, without examination, except merely to determine whether the alleged invention or discovery falls within any class, as to which patents cannot issue.

It is undoubtedly a matter of no little difficulty to select such persons as are fitly qualified to make such examination, and to determine in the first instance whether any invention is patentable, and such examiners may often err, sometimes granting patents inconsiderately, and again refusing them in cases where they ought to issue;

but it will scarcely be denied that the labors of such persons are highly useful, not only to the inventor, in bringing to his notice what is already known in the art to which his invention appertains, but also to the public, in interposing a salutary check to the issue of numerous trifling, worthless patents.

Further legislation, however, seems to be required to secure to the inventor, or patentee, such benefits as are due him by reason of such examination. Though he may be compelled, as he frequently is, to appeal from the decision of the primary examiners to the examiners in chief, and again to the Commissioner, and, perhaps, still again to the Justices of the Circuit Court of the District of Columbia, before he can obtain his patent, each step being attended with delay, and increased expense, yet when his patent is infringed, and he seeks protection in the Courts, all this preliminary examination and investigation, as the law now stands, avails him nothing, except to strengthen somewhat the *prima facie* character of his patent, the validity of which, if denied, he must, however, sustain as if no previous investigation had been had in respect to it. If the government requires such an examination, before a patent can issue, surely the patent, when granted, ought to have a higher character, and give a more complete protection, than if no condition had been imposed upon its issue. Such protection might be secured, by giving a patentee, in case of the infringement of his patent, the benefit of process in the nature of an attachment, against both the machinery used in such infringement, and the thing manufactured, the same to be forfeited should the patent be sustained: and the party infringing should not be allowed to continue his manufacture, except upon security to account for all proceeds received by him, and to pay all damage the patentee might sustain, and any expense he might be put to by reason of the infringement.

Further legislation seems also to be required with reference to the right of recovery, by patentees, of the costs and expenses attendant upon litigation made necessary by reason of the infringement of their patents. The nature of litigation in patent cases, the wide range of investigation embraced in such cases, and the peculiar character of the testimony required, demanding frequently great research and investigation in connection with varied scientific attainments, all combine to render the expense of litigation, in such cases, much greater than in other actions. All that a patentee can now recover, however, is the actual damages he may have sustained, with only such disbursements as are recoverable in ordinary actions, and no costs, except an insignificant record fee, and that only when a judgment is obtained. A provision, which should entitle a patentee to recover, in addition to the actual damage sustained by him by the infringement of his patent and the taxable costs so-called, such expenses, within just limits, as he may have been put to by reason of such infringement, would seem but simple justice to him, and no injustice toward those who have endeavored to deprive him of the benefit of his invention.

Considered, however, as a whole, the patent system of this country, as construed and interpreted by the Courts, is highly favorable to inventors and the progress of invention, and we may confidently anticipate increasing perfection in it; and in no country are the rights of authors and inventors more fully and willingly recognized, and nowhere are their rewards and remuneration more generous and munificent.

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

CONSTITUTION OF THE UNITED STATES.

ARTICLE I, SECTION 8.

THE Congress shall have power :

To promote the progress of science and useful arts, by securing for limited

POWER OF CONGRESS, AND OF THE SEVERAL STATES UNDER.

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

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

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

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

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

The laws of any state, however, granting exclusive rights and privileges in respect

times, to authors and inventors, the exclusive right to their respective writings and discoveries :

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

The laws of the state of New York, granting to Livingston & Fulton the exclusive right to navigate all the waters within its jurisdiction, with boats moved by steam, or fire, for a term of years, were held to be inoperative as against the laws of the United States regulating the coasting trade, and that they could not restrain vessels licensed under the laws of the United States, to carry on the coasting trade, from navigating such waters. *Ibid.*, 220.

A state cannot exercise its legislative authority in reference to patents and inventions, so as to restrain a free intercourse among the several states. *Ibid.*, 239.—JOHNSON, J.

Whether Congress can decide the fact that an individual is an inventor or author, without leaving the question of invention, &c., open for investigation, the courts will never presume Congress to have decided that question in a general act, the words of which do not render such a construction unavoidable. *Evans v. Eaton*, 3 Wheat., 513.—MARSHALL, Ch. J.; Sup. Ct., 1818.

The power of Congress, as to patents, is general, and it rests in its sound discretion to say, when and for what length of time, and under what circumstances, a patent for an invention shall be granted. There is no restriction which limits its power to enact, to cases where the invention has not been known or used by the public. All that is required is, that the patentee should be the inventor. *Blanchard v. Sprague*, 3 Sumn., 541.—STORY, J.; Mass., 1839.

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

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

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

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

Congress has the constitutional right to confer a new and further term on the patentee, and that even after the expiration of the first. *Blanchard v. Haynes*, 3 West. Law Jour., 83.—WOODBURY, J.; N. H., 1848.

A legislative act does not bind a subsequent legislature. There is no mode by which a legislative act can be made irrevocable, except it assume the form and substance of a contract. *Bloomer v. Stolley*, 5 McLean, 161.—MCLEAN, J.; Ohio, 1850.

And Congress may pass an act which shall act retrospectively. Such an act is not necessarily unconstitutional. Though no state can impair the obligations of a contract, this inhibition does not apply to the general government. *Ibid.*, 165.

Under the fifth amendment of the Constitution, declaring that no person shall be deprived of life, liberty, or property, without due process of law, Congress would have

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

no right to pass an act depriving purchasers of a patented article of the right to use such article. Such an act could not be regarded as due process of law. *Bloomer v. McQuewan*, 14 How., 553.—TANEY, Ch. J.; Sup. Ct., 1852.

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

See also DIGEST, titles CONGRESS; STATUTES, B. 1.

PRIVATE ACTS.

Congress may exercise its constitutional power, as to granting rights to inventors, either by special acts, or by a general system. *Bloomer v. Stolley*, 5 McLean, 161.—MCLEAN, J.; Ohio, 1850.

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

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

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

See also DIGEST, title STATUTES, B. 4.

LAWS

OF THE

UNITED STATES

RELATING TO

PATENTS FOR INVENTIONS

DESIGNS

TRADE-MARKS AND COPYRIGHTS

NOW IN FORCE

LAWS OF THE UNITED STATES

RELATING TO

PATENTS FOR INVENTIONS AND DESIGNS,

REGISTRATION OF TRADE-MARKS

AND COPYRIGHTS.

The laws of the United States now in force as to Patents, Trade-marks, and Copyrights are contained in the Revised Statutes of the United States, approved June 22, 1874 (which substantially re-enacted, with some additions, the provisions of the revised and consolidated Patent Act of July 8, 1870), and in Acts of Congress passed since the Revised Statutes. In this compilation, reference is made, for greater convenience, both to the Revised Statutes, and also to the Patent Act of 1870 or other acts: the **heavy type** at the beginning of each section indicating the section of the Revised Statutes, and the reference in *italics*, indicating the corresponding section of the Act of 1870 or of other Acts.

ORGANIZATION OF THE PATENT OFFICE.—GENERAL PROVISIONS AFFECTING PATENTS AND PATENT SUITS.

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| SEC. 440. Clerks and employees of the patent office. | SEC. 487. Patent agents may be refused recognition. |
| 475. Establishment of the patent office. | 488. Printing of papers filed. |
| 476. Officers, and appointment of. | 489. Printing copies of claims, laws, decisions, &c. |
| 477. Salaries of officers. | 490. Printing specifications and drawings. |
| 478. Seal of the patent office. | 491. Printing additional specifications and drawings. |
| 479. Bonds of commissioner and chief clerk. | 492. Lithographing and engraving. |
| 480. Restrictions upon officers and employees. | 493. Price of copies of specifications and drawings. |
| 481. Duties of the commissioner. | 494. Annual report of the commissioner. |
| 482. Duties of the examiners-in-chief. | 495. Custody of collections of exploring expeditions. |
| 483. Establishment of regulations. | 496. Disbursements for patent office. |
| 484. Arrangement and exhibition of models, &c. | |
| 485. Disposals of models on rejected applications. | |
| 486. Provisions for library | |

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| <p>Sec. 699. Jurisdiction of suits and actions under the patent laws.</p> <p>699. Writs of errors and appeals.</p> <p>711. Jurisdiction exclusive.</p> <p>718. Temporary restraining orders.</p> <p>719. Injunctions, who may grant; duration of.</p> <p>720. Jury in patent cases.</p> <p>892. Evidence—Copies of patents, records, &c., of patent office.</p> | <p>Sec. 893. Evidence—Copies of foreign letters patent.</p> <p>894. Evidence—Printed copies of specifications and drawings of patents.</p> <p>1587. Patented articles connected with marine engines, how purchased by U. S.</p> <p>1678. No royalty to be paid by the United States on certain patents.</p> |
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TITLE XI, CHAP. 1, p. 74.

Sec. 440. (*Act of 1870, § 3.*) [**Clerks, examiners, &c., of patent office.**] There shall be in the Department of the Interior—

In the Patent Office :

One chief clerk, at a salary of two thousand five hundred dollars a year.

One examiner in charge of interferences, at a salary of two thousand five hundred dollars a year.

One examiner in charge of trade-marks, at a salary of two thousand five hundred dollars a year.

Twenty-four principal examiners, at a salary of two thousand five hundred dollars a year each.

Twenty-four first assistant examiners, at a salary of one thousand eight hundred dollars a year each.

Twenty-four second assistant examiners, (two of whom may be women,) at a salary of one thousand six hundred dollars a year each.

Twenty-four third assistant examiners, at a salary of one thousand four hundred dollars a year each.*

One librarian, at a salary of two thousand dollars a year.

One machinist, at a salary of one thousand six hundred dollars a year.

Three skilled draughtsmen, at a salary of one thousand two hundred dollars a year each.

Thirty-five copyists of drawings, at a salary of one thousand dollars a year each.

One messenger and purchasing clerk, at a salary of one thousand dollars a year.

One skilled laborer, at a salary of one thousand two hundred dollars a year.

Eight attendants in the model-room, at a salary of one thousand dollars a year each.

Eight attendants in the model-room, at a salary of nine hundred dollars a year each.

* Grade of third assistant examiners abolished, Act of 1875, ch. 129.

TITLE XI, CHAP. 6, p. 79-81.

Sec. 475. (*Act of 1870, § 1.*) [**Establishment of the patent office.**] There shall be in the Department of the Interior an office known as the Patent Office, where all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved.

Sec. 476. (*Act of 1870, § 2.*) [**Officers and Employees.**] There shall be in the Patent Office a Commissioner of Patents, one Assistant Commissioner, and three examiners-in-chief, who shall be appointed by the President, by and with the advice and consent of the Senate. All other officers, clerks, and employees authorized by law for the Office shall be appointed by the Secretary of the Interior, upon the nomination of the Commissioner of Patents.

Sec. 477. (*Act of 1870, § 4.*) [**Salaries of officers.**] The salaries of the officers mentioned in the preceding section shall be as follows :

The Commissioner of Patents, four thousand five hundred dollars a year.

The Assistant Commissioner of Patents, three thousand dollars a year.

Three examiners-in-chief, three thousand dollars a year each.

Sec. 478. (*Act of 1870, § 12.*) [**Seal of patent office.**] The seal heretofore provided for the Patent Office shall be the seal of the Office, with which letters patent and papers issued from the Office shall be authenticated.

Sec. 479. (*Act of 1870, § 6.*) [**Bonds of commissioner and chief clerk.**] The Commissioner of Patents and the chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, conditioned for the faithful discharge of their respective duties, and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices.

Sec. 480. (*Act of 1870, § 16.*) [**Restrictions upon officers and employees.**] All officers and employees of the Patent Office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by the Office.

Sec. 481. (*Act of 1870, § 7.*) [**Duties of the commissioner.**] The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office.

Sec. 482. (*Act of 1870, § 10.*) [**Duties of the examiners-in-chief.**] The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them.

Sec. 483. (*Act of 1870, § 19.*) [**Establishment of regulations.**] The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

Sec. 484. (*Act of 1870, § 13.*) [**Models, arrangement of.**] The Commissioners of Patents shall cause to be classified and arranged in suitable cases, in the rooms and galleries provided for that purpose, the models, specimens of composition, fabrics, manufactures, works of art, and designs, which have been or shall be deposited in the Patent Office; and the rooms and galleries shall be kept open during suitable hours for public inspection.

Sec. 485. (*Act of 1870, § 14.*) [**Disposals of models on rejected applications.**] The Commissioner of Patents may restore to the respective applicants such of the models belonging to rejected applications as he shall not think necessary to be preserved, or he may sell or otherwise dispose of them after the application has been finally rejected for one year, paying the proceeds into the Treasury, as other patent moneys are directed to be paid.

Sec. 486. (*Act of 1870, § 15.*) [**Library.**] There shall be purchased for the use of the Patent Office a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated for that purpose.

Sec. 487. (*Act of 1870, § 17.*) [**Patent agents may be refused recognition.**] For gross misconduct the Commissioner of Patents may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons for such refusal shall be duly recorded, and be subject to the approval of the Secretary of the Interior.

Sec. 488. (*Act of 1870, § 18.*) [**Printing of papers filed.**] The Commissioner of Patents may require all papers filed in the Patent Office, if not correctly, legibly, and clearly written, to be printed at the cost of the party filing them.

Sec. 489. (*Act of 1870, § 20.*) [**Printing copies of claims, laws, decisions, &c.**] The Commissioner of Patents may print, or cause to be printed, copies of the claims of current issues, and copies of such laws, decisions, regulations, and circulars as may be necessary for the information of the public.

Sec. 490. (*Res. 1871, Jan. 11.*) [**Printing specifications and drawings.**] The Commissioner of Patents is authorized to have printed, from time to time, for gratuitous distribution, not to exceed one hundred and fifty copies of the complete specifications and drawings of each patent hereafter issued, together with suitable indexes, one copy to be placed for free public inspection in each capitol of every State and Territory, one for the like purpose in the clerk's office of the district court of each judicial district of the United States, except when such offices are located in State or territorial capitols, and one in the Library of Congress, which copies shall be certified under the hand of the Commissioner and seal of the Patent Office, and shall not be taken from the depositories for any other purpose than to be used as evidence.

* The Commissioner of Patents is also required to furnish a copy of the bound volumes of specifications and drawings to each of the Executive Departments of Government, when requested to do so. *Act of March 3, 1875, ch. 130, § 12.*

Sec. 491. (*Res. of 1871, Jan. 11.*) [**Additional specifications and drawings.**] The Commissioner of Patents is authorized to have printed such additional numbers of copies of specifications and drawings, certified as provided in the preceding section, at a price not to exceed the contract price for such drawings, for sale, as may be warranted by the actual demand for the same; and he is also authorized to furnish a complete set of such specifications and drawings to any public library which will pay for binding the same into volumes to correspond with those in the Patent Office, and for the transportation of the same, and which shall also provide for proper custody for the same, with convenient access for the public thereto, under such regulations as the Commissioner shall deem reasonable.

Sec. 492. (*Res. 1874, March 24, § 1.*) [**Lithographing and engraving.**]

The lithographing and engraving required by the two preceding sections shall be awarded to the lowest and best bidders for the interests of the Government, due regard being paid to the execution of the work, after due advertising by the Congressional Printer under the direction of the Joint Committee on Printing; but the Joint Committee on Printing may empower the Congressional Printer to make immediate contracts for engraving, whenever, in their opinion, the exigencies of the public service will not justify waiting for advertisement and award; or if, in the judgment of the Joint Committee on Printing, the work can be performed under the direction of the Commissioner of Patents more advantageously than in the manner above prescribed, it shall be so done, under such limitations and conditions as the Joint Committee on Printing may from time to time prescribe.

Sec. 493. (*Act of 1871, ch. 5, § 2.*) [**Specifications and drawings, price of.**] The price to be paid for uncertified printed copies of specifications and drawings of patents shall be determined by the Commissioner of Patents, within the limits of ten cents as the minimum and fifty cents as the maximum price.

Sec. 494. (*Act of 1870, § 16.*) [**Annual report of commissioner.**] The Commissioner of Patents shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys received for patents, for copies of records or drawings, or from any other source whatever; a detailed statement of all expenditures for contingent and miscellaneous expenses; a list of all patents which were granted during the preceding year, designating under proper heads the subjects of such patents; an alphabetical list of all the patentees, with their places of residence; a list of all patents which have been extended during the year; and such other information of the condition of the Patent Office as may be useful to Congress or the public. (See §§ 195, 196.)

Sec. 495. (*Act of 1854, ch. 242, § 8.*) [**Collections of Exploring Expeditions, custody of.**] The collections of the Exploring Expedition now in the Patent Office shall be under the care and management of the Commissioner of Patents.

Sec. 496. (*Act of 1870, § 69.*) [**Disbursements for Patent Office, by whom made.**] All disbursements for the Patent Office shall be made by the disbursing clerk of the Interior Department.

TITLE XIII, CHAP. 7, p. 109-111.

Sec. 629. (*Act of 1870, § 55.*) [**Actions, where cognizable.**] The Circuit Courts shall have original jurisdiction,

Of all suits at law or in equity arising under the patent or copyright laws of the United States.

TITLE XIII, CHAP. 2, p. 130.

Sec. 699. (*Act of 1870, § 56.*) [**Writs of Error and Appeals.**] A writ of error may be allowed to review any final judgment at law, and an appeal shall be allowed from any final decree in equity, without regard to the sum or value in dispute.

From any final judgment at law or final decree in equity of any Circuit Court, or of any District Court acting as a Circuit Court, or of the Supreme Court of the District of Columbia, or of any Territory, in any case touching patent-rights or copyrights.

TITLE XIII, CHAP. 12, p. 134-5.

Sec. 711. (*Act of 1870, § 55.*) [Jurisdiction exclusive.] The jurisdiction vested in the courts of the United States shall be exclusive of the courts of the several states ;

Of all cases arising under the Patent right or Copyright laws of the United States.

Sec. 718. (*Act of 1872, ch. 255, § 7.*) [Temporary restraining orders.] Whenever notice is given of a motion for an injunction out of a circuit or district court, the court or judge thereof may, if there appears to be danger of irreparable injury from delay, grant an order restraining the act sought to be enjoined until the decision upon the motion ; and such order may be granted with or without security, in the discretion of the court or judge.

Sec. 719. (*Act of 1793, ch. 22, § 5. 1807, ch. 13, § 2.*) [Injunctions, who may grant; duration of.] Writs of injunction may be granted by any Justice of the Supreme Court in cases where they might be granted by the Supreme Court ; and by any Judge of a Circuit Court, in cases where they might be granted by such Court. But no Justice of the Supreme Court shall hear or allow any application for an injunction or restraining order in any cause pending in the circuit to which he is allotted, elsewhere than within such circuit, or at such place outside of the same as the parties may stipulate in writing, except when it can not be heard by the Circuit Judge of the Circuit, or the District Judge of the District.

And an injunction shall not be issued by a District Judge, as one of the Judges of a Circuit Court, in any case where a party has had a reasonable time to apply to the Circuit Court for the writ ; nor shall any injunction so issued by a District Judge continue longer than to the Circuit Court next ensuing, unless so ordered by the Circuit Court.

Sec. 720. (*Act of 1875, ch. 77, § 2.*) [Jury in Patent cases.] The Circuit Courts of the United States, when sitting in equity for the trial of patent causes, may impanel a jury of not less than five, or more than twelve persons, subject to such general rules in the premises, as may, from time to time, be made by the Supreme Court, and submit to them such questions of fact arising in such cause as such Circuit Court shall deem expedient ; and the verdict of such jury shall be treated and proceeded upon in the same manner and with the same effect as in the case of issues sent from chancery to a court of Law and returned with such findings.

TITLE XIII, CHAP. 17, p. 168.

Sec. 892. (*Act of 1870, § 57.*) [Copies of records, &c., how made evidence.] Written or printed copies of any records, books, papers or drawings

belonging to the Patent Office, and of letters patent authenticated by the seal and certified by the Commissioner or Acting Commissioner thereof, shall be evidence in all cases wherein the originals could be evidence ; and any person making application therefor, and paying the fee required by law, shall have certified copies thereof.

Sec. 893. (*Act of 1870, § 57.*) [**Copies foreign letters patent, how made evidence.**] Copies of the specifications and drawings of foreign letters patent, certified as provided in the preceding section, shall be prima-facie evidence of the granting of such letters patent, and of the date and contents thereof.

Sec. 894. (*Res. of Jan. 11, 1871.*) [**Printed copies of specifications, &c., how made evidence.**] The printed copies of specifications and drawings of patents, which the Commissioner of Patents is authorized to print for gratuitous distribution, and to deposit in the capitols of the States and Territories, and in the clerk's offices of the district courts, shall, when certified by him and authenticated by the seal of his office, be received in all courts as evidence of all matters therein contained.

TITLE XV, CHAP. p. 261.

Sec. 1537. (*Act of 1861, ch. 8, § 3.*) [**Patented articles as to marine engines, purchase of.**] No patented article connected with marine engines shall hereafter be purchased or used in connection with any steam vessels of war until the same shall have been submitted to a competent board of naval engineers, and recommended by such board, in writing, for purchase and use.

TITLE XVII, CHAP. p. 292.

Sec. 1673. (*Act of 1872, ch. 316, § 17.*) [**Royalties not to be paid by U. S for certain articles.**] No royalty shall be paid by the United States to any one of its officers or employees for the use of any patent for the system, or any part thereof, mentioned in the preceding section, nor for any such patent in which said officers or employees may be directly or indirectly interested.

PATENTS FOR INVENTIONS AND DISCOVERIES.

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| <p>SEC. 4883. Patents, how issued and recorded.</p> <p>4884. Patents, contents and duration of.</p> <p>4885. Patents, date of.</p> <p>4886. What inventions patentable.</p> <p>4887. Patents for inventions previously patented abroad.</p> <p>4888. Requisites of applications. Description, specification, and claim.</p> <p>4889. Drawings, when requisite.</p> <p>4890. Specimens of ingredients, &c.</p> <p>4891. Model, when requisite.</p> | <p>SEC. 4892. Oath of applicant, before whom made.</p> <p>4893. Examination, and issuing Patent.</p> <p>4894. Applications, when to be completed.</p> <p>4895. Patents may issue to assignee.</p> <p>4896. Executors and administrators, when may obtain patent.</p> <p>4897. Renewal of application, on failure to pay fees in season.</p> <p>4898. Assignments of Patents.</p> <p>4899. Purchaser or user of invention, before application, rights of.</p> |
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| <p>Sec. 4900. Patented articles, to be marked as such.</p> <p>4901. Falsely marking or labeling articles as patented, penalty for.</p> <p>4902. Coveats, who may file.</p> <p>4903. Rejection of claim, applicant to be notified.</p> <p>4904. Interferences.</p> <p>4905. Affidavits and depositions, rules as to.</p> <p>4906. Subpœnas to witnesses.</p> <p>4907. Witness fees.</p> <p>4908. Penalty for refusing to attend or testify.</p> <p>4909. Appeals from primary examiners to examiners-in-chief.</p> <p>4910. Appeals from examiners-in-chief to commissioner.</p> <p>4911. Appeals from the Commissioner to the Sup. Ct., of Columbia.</p> <p>4912. Appeal to Sup. Ct., Dist. of Columbia. Notice.</p> | <p>Sec. 4913. Proceedings on appeal to Supreme Court.</p> <p>4914. Determination of such appeal and its effect.</p> <p>4915. Patents obtainable by bill in equity.</p> <p>4916. Re-issue of defective patents.</p> <p>4917. Disclaimer.</p> <p>4918. Suits as to interfering patents.</p> <p>4919. Suits for infringement ; damages.</p> <p>4920. Pleading and notice in actions for infringement.</p> <p>4921. Power of courts as to injunctions and damages.</p> <p>4922. Suits maintainable when specification is too broad.</p> <p>4923. Patent not void, because of prior use in foreign country.</p> <p>4928. Operation of extensions.</p> |
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TITLE LX, CHAP. 1, p. 953.

Sec. 4883. (*Act of 1870, § 21.*) [Patents, how issued and recorded.] All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior, and countersigned by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office, in books to be kept for that purpose.

Sec. 4884. (*Act of 1870, § 22.*) [Patents, contents and duration of.] Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery throughout the United States, and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

Sec. 4885. (*Act of 1870, § 23.*) [Patent, date of.] Every patent shall bear date as of a day not later than six months from the time at which it was passed and allowed and notice thereof was sent to the applicant or his agent ; and if the final fee is not paid within that period the patent shall be withheld.

Sec. 4886. (*Act of 1870, § 24.*) [What inventions patentable.] Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not known nor used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor.

Sec. 4887. (*Act of 1870, § 25.*) [Patents for inventions previously patented abroad.] No person shall be debarred from receiving a patent for his

invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited to expire at the same time with the foreign patent, or if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years.

Sec. 4888. (*Act of 1870, § 26.*) [**Requisites of applications—description, specification, and claim.**] Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor and attested by two witnesses.

Sec. 4889. (*Act of 1870, § 27.*) [**Drawings, when requisite.**] When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the Patent Office; and a copy of the drawing, to be furnished by the Patent Office, shall be attached to the patent as a part of the specification.

Sec. 4890. (*Act of 1870, § 28.*) [**Specimens of ingredients, etc.**] When the invention or discovery is of a composition of matter, the applicant, if required by the Commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment.

Sec. 4891. (*Act of 1870, § 29.*) [**Model, when requisite.**] In all cases which admit of representation by model, the applicant, if required by the Commissioner, shall furnish a model of convenient size to exhibit advantageously the several parts of his invention or discovery.

Sec. 4892. (*Act of 1870, § 30.*) [**Oath of applicants, before whom made.**] The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or when the applicant resides in a foreign country, before any minister, charge d'affaires, consul, or commercial agent, holding commission under the Government of the United States, or before any notary public of the foreign country in which the applicant may be.

Sec. 4893. (*Act of 1870, § 31.*) [**Examination, and issuing patent.**] On the filing of any such application and the payment of the fees required by

law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor.

Sec. 4894. (*Act of 1870, § 32.*) **Applications, when to be completed.]** All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.

Sec. 4895. (*Act of 1870, § 33.*) **[Patents may issue to assignee.]** Patents may be granted and issued or reissued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the Patent Office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer; and in all cases of an application for a reissue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living, unless the patent was issued and the assignment made before the eighth day of July 1870, eighteen hundred and seventy.

Sec. 4896. (*Act of 1870, § 34.*) **[Executors or administrators, when may obtain patent.]** When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs-at-law of the deceased, in case he shall have died intestate; or if he shall have left a will, disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his life-time; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them.

Sec. 4897. (*Act of 1870, § 35.*) **[Renewal of application; failure to pay fees in season.]** Any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who fails to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application. But such second application must be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent was ordered to issue under such renewed application prior to the issue of the patent. And upon the hearing of renewed applications preferred under this section, abandonment shall be considered as a question of fact.

Sec. 4898. (*Act of 1870, § 36.*) **[Assignments of Patents.]** Every patent or any interest therein shall be assignable in law by an instrument in writing;

and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof.

Sec. 4899. (*Act of 1870, § 37.*) [**Purchaser or user of inventions before application; rights of.**] Every person who purchases of the inventor, or discoverer, or with his knowledge and consent constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor.

Sec. 4900. (*Act of 1870, § 38.*) [**Patented articles to be marked as such.**] It shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them to give sufficient notice to the public that the same is patented; either by fixing thereon the word "patented," together with the day and year the patent was granted; or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is enclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the article so patented.

Sec. 4901. (*Act of 1870, § 39.*) [**Falsely marking or labeling articles as patented, penalty for.**] Every person who, in any manner, marks upon anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor, without the consent of such patentee, or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any such patented article the word "patent" or "patentee," or the words "letters patent," or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offense, to a penalty of not less than one hundred dollars, with costs; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed.

Sec. 4902. (*Act of 1870, § 40.*) [**Caveats, who may file.**] Any citizen of the United States who makes any new invention or discovery, and desires further time to mature the same, may, on payment of the fees required by law, file in the Patent Office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his right until he shall have matured his invention. Such caveat shall be filed in the confiden-

tial archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application is made within the year by any other person for a patent with which such caveat would in any manner interfere, the Commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail, to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his description, specifications, drawings, and model within three months from the time of placing the notice in the post office in Washington, with the usual time required for transmitting it to the caveator added thereto; which time shall be endorsed on the notice. An alien shall have the privilege herein granted, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen.

Sec. 4903. (*Act of 1870, § 41.*) [**Rejection of claim; applicant to be notified.**] Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice the applicant persists in his claim for a patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case.

Sec. 4904. (*Act of 1870, § 42.*) [**Interferences.**] Whenever an application is made for a patent which in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.

Sec. 4905. (*Act of 1870, § 43.*) [**Affidavits and depositions, rules as to.**] The Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the patent office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the state where the officer resides.

Sec. 4906. (*Act of 1870, §§ 44, 45.*) [**Subpœnas to witnesses.**] The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall upon application of any party thereto, or of his agent or attorney, issue a subpœna for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits, at any time and place in the subpœna stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpœna is served upon him.

Sec. 4907. (*Act of 1870, § 45.*) [**Witness fees.**] Every witness duly

subpœnaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States.

Sec. 4908. (*Act of 1870, §§ 44, 45.*) [**Penalty for refusal to attend or testify.**] Whenever any witness after being duly served with such subpœna, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpœna may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be guilty of contempt for disobeying such subpœna, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination are paid or tendered him at the time of the service of the subpœna; nor for refusing to disclose any secret invention or discovery made or owned by himself.

Sec. 4909. (*Act of 1870, § 46.*) [**Appeals from primary examiners to examiners-in-chief.**] Every applicant for a patent or for the reissue for a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal.

Sec. 4910. (*Act of 1870, § 47.*) [**Appeals from examiners-in-chief to commissioner.**] If such party is dissatisfied with the decision of the examiners-in-chief, he may on payment of the fee prescribed, appeal to the Commissioner in person.

Sec. 4911. (*Act of 1870, § 48.*) [**Appeals from the commissioner to the Supreme Court, District of Columbia.**] If such party, except a party to an interference, is dissatisfied with the decision of the commissioner, he may appeal to the Supreme Court of the District of Columbia sitting in banc.

Sec. 4912. (*Act of 1870, § 49.*) [**Appeal to Supreme Ct. Dist. of Columbia; notice.**] When an appeal is taken to the Supreme Court of the District of Columbia, the appellant shall give notice thereof to the commissioner, and file in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

Sec. 4913. (*Act of 1870, § 50.*) [**Proceedings on appeal to Supreme Court.**] The court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded.

Sec. 4914. (*Act of 1870, § 51.*) [**Determination of such appeal, and its effect.**] The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the

Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

Sec. 4915. (*Act of 1870, § 52.*) [**Patents obtainable by bill in equity.**] Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia, upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

Sec. 4916. (*Act of 1870, § 53.*) [**Re-issue of defective patents.**] Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a re-issue for each of such re-issued letters patent. The specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so re-issued, together with the corrected specification, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proofsatisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

Sec. 4917. (*Act of 1870, § 54.*) [**Disclaimer.**] Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which

is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs, or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

Sec. 4918. (*Act of 1870, § 58.*) [**Suits as to interfering patents.**] Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part; or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment

Sec. 4919. (*Act of 1870, § 59.*) [**Suits for infringement; damages.**] Damages for the infringement of any patent may be recovered by action on the case, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

Sec. 4920. (*Act of 1870, § 61.*) [**Pleading and notice in actions for infringement.**] In any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove, on trial, any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country for more

than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

Sec. 4921. (*Act of 1870, § 55.*) [**Power of courts as to injunctions and damages.**] The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; * and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case.

* See also Secs. 718, 719, *ante*, p. 6.

Sec. 4922. (*Act of 1870, § 60.*) [**Suits maintainable where specification is too broad.**] Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.

Sec. 4923. (*Act of 1870, § 62.*) [**Patent not void because of prior use in foreign country.**] Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof if it had not been patented or described in a printed publication.

Sec. 4924, 4925, 4926, and 4927. (*Act of 1870, §§ 63, 64, 65, and 66.*) These sections relate wholly to proceedings on applications for extensions; and are omitted, as extensions can now no longer be granted in any case.

Sec. 4928. [**Extensions.**] The benefit of the extension of a patent shall extend to the assignees and grantees of the right to use the thing patented, to the extent of their interest therein.

PATENTS FOR DESIGNS.

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| <p>SEC. 4929. Patents for designs authorized.</p> <p>4930. Models of designs.</p> <p>4931. Duration of patents for designs.</p> | <p>SEC. 4932. Extension of patents for designs.</p> <p>4933. Patents for designs subject to general rules of patent law.</p> |
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Sec. 4929. (*Act of 1870, § 71.*) [**Designs, what patentable.**] Any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, patent [pattern], print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication; may, upon payment of the fee prescribed, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor.

Sec. 4930. (*Act of 1870, § 72.*) [**Models of designs.**] The Commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs.

Sec. 4931. (*Act of 1870, § 73.*) [**Duration of patents for designs.**] Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect.

Sec. 4932. (*Act of 1870, § 74.*) [**Extension of patents for designs.**] Patentees of designs issued prior to the second day of March, eighteen hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries, issued prior to the second day of March, eighteen hundred and sixty-one.

Sec. 4933. (*Act of 1870, § 76.*) [**Patents for designs, subject to general rules of patent law.**] All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this Title, shall apply to patents for designs. [§§ 4919-4921.]

FEES FOR PATENTS AND DESIGNS.

SEC. 4984. Rates of fees.
 4985. How may be paid.
 4986. Refunding of.

Sec. 4934. (*Act of 1870, § 75.*) [Fees for patents, and on appeals, &c.]
 The following shall be the rates for patent fees :

On filing each original application for a patent, except in design cases, fifteen dollars.

On issuing each original patent, except in design cases, twenty dollars.

In design cases: For three years and six months, ten dollars; for seven years, fifteen dollars; for fourteen years, thirty dollars.

On filing each caveat, ten dollars.

On every application for the reissue of a patent, thirty dollars.

On filing each disclaimer, ten dollars.

On every application for the extension of a patent, fifty dollars.

On the granting of every extension of a patent, fifty dollars.

On an appeal for the first time from the primary examiners to the examiners-in-chief, ten dollars.

On every appeal from the examiners-in-chief to the Commissioner, twenty dollars.

For certified copies of patents and other papers, including certified printed copies, ten cents per hundred words.

For recording every assignment, agreement, power of attorney, or other paper, of three hundred words or under, one dollar; of over three hundred and under one thousand words, two dollars; of over one thousand words, three dollars.

For copies of drawings, the reasonable cost of making them.

Sec. 4935. (*Act of 1870, § 69.*) [Mode of payment.] Patent fees may be paid to the Commissioner of Patents, or to the Treasurer or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the Treasury as received, without any deduction whatever.

Sec. 4936. (*Act of 1870, § 70.*) [Refunding.] The treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the Treasury, or to any receiver or depositary, to the credit of the Treasury, as for fees accruing at the Patent Office, upon a certificate thereof being made to the Treasurer by the Commissioner of Patents.

REGISTRATION OF TRADE-MARKS.

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| <p>SEC. 4937. Registration of trade-marks authorized.</p> <p>4938. Accompanying declaration under oath.</p> <p>4939. Restriction on the registration of trade-marks.</p> <p>4940. Time or eipt of trade-mark for registration to be certified.</p> <p>4941. Duration of protection of registered trade-marks, and renewal.</p> <p>4942. Remedy for infringement of registered trade-marks.</p> | <p>SEC. 4943. Restriction upon action for infringement.</p> <p>4944. Penalty for false registration of trade-marks.</p> <p>4945. Former rights and remedies preserved.</p> <p>4946. Saving as to rights after expiration of term for which a trade-mark has been registered.</p> <p>4947. Regulations for transfer of rights to trade-marks.</p> <p>:</p> |
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TITLE LX, REV. STAT. CHAP. 2. p. 963.

Sec. 4937. (*Act of 1870, § 77.* [Trade-marks, registration of.] Any person or firm domiciled in the United States and any corporation created by the authority of the United States, or of any State or Territory thereof, and any person, firm, or corporation resident of or located in any foreign country which by treaty or convention affords similar privileges to citizens of the United States, and who are entitled to the exclusive use of any lawful trade-mark, or who intend to adopt and use any trade-mark for exclusive use within the United States, may obtain protection for such lawful trade-mark by complying with the following requirements:

First. By causing to be recorded in the Patent Office a statement specifying the names of the parties, and their residences and place of business, who desire the protection of the trade-mark; the class of merchandise, and the particular description of goods comprised in such class, by which the trade-mark has been or is intended to be appropriated; a description of the trade-mark itself, with fac-similies thereof, showing the mode in which it has been or is intended to be applied and used; and the length of time, if any, during which the trade-mark has been in use.

Second. By making payment of a fee of twenty-five dollars in the same manner and for the same purpose as the fee required for patents.

Third. By complying with such regulations as may be prescribed by the Commissioner of Patents.

Sec. 4938. (*Act of 1870, § 77.*) [Declaration required, what.] The certificate prescribed by the preceding section, must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified by the person, or by some member of the firm or officer of the corporation by whom it is filed, to the effect that the party claiming protection for the trade-mark has a right to the use of the same, and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated

to deceive ; and that the description' and fac-similes presented for record are true copies of the trade-mark sought to be protected.

Sec. 4939. (*Act of 1870, § 79.*) [**Restriction on registration of trade-marks.**] The Commissioner of Patents shall not receive and record any proposed trade-mark which is not and can not become a lawful trade-mark, or which is merely the name of a person, firm, or corporation unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons, or which is identical with a trade-mark appropriate to the same class of merchandise and belonging to a different owner, and already registered or received for registration, or which so nearly resembles such last-mentioned trade-mark as to be likely to deceive the public. But this section shall not prevent the registry of any lawful trade-mark rightfully in use on the eighth day of July, eighteen hundred and seventy.

Sec. 4940. (*Act of 1870, § 80.*) [**Trade-mark ; time of, receipt of noted ; copy of evidence.**] The time of the receipt of any trade-mark at the Patent Office for registration shall be noted and recorded. Copies of the trade-mark and of the date of the receipt thereof, and of the statement filed therewith, under the seal of the Patent Office, certified by the Commissioner shall be evidence in any suit in which such trade-mark shall be brought in controversy.

Sec. 4941. (*Act of 1870, § 78.*) [**Trade-mark ; duration of protection of, and renewal.**] A trade-mark registered as above prescribed shall remain in force for thirty years from the date of such registration ; except in cases where such trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of any foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act at the same time that it becomes of no effect elsewhere. Such trade-mark during the period that it remains in force shall entitle the person, firm, or corporation registering the same to the exclusive use thereof, so far as regards the description of goods to which it is appropriated in the statement filed under oath as aforesaid, and no other person shall lawfully use the same trade-mark, or substantially the same, or so nearly resembling it as to be calculated to deceive, upon substantially the same description of goods. And at any time during the six months prior to the expiration of the term for thirty years, application may be made for a renewal of such registration, under regulations to be prescribed by the Commissioner of Patents. The fee for such renewal shall be the same as for the original registration ; and a certificate of such renewal shall be issued in the same manner as for the original registration ; and such trade-mark shall remain in force for a further term of thirty years.

Sec. 4942. (*Act of 1870, § 79.*) [**Remedy for infringement of registered trade-mark.**] Any person who shall reproduce, counterfeit, copy, or imitate any recorded trade-mark, and affix the same to goods of substantially the same descriptive properties and qualities as those referred to in the registration, shall be liable to an action on the case for damages for such wrongful use of such trade-mark, at the suit of the owner thereof ; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of his trade-mark, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful use [§§ 4919-4921, note].

Sec. 4943. (*Act of 1870, § 84.*) [**Restrictions upon actions for infringement.**] No action shall be maintained under the provisions of this chapter by any such person claiming the exclusive right to any trade-mark which is used or claimed in any unlawful business, or upon any article which is injurious in itself, or upon any trade-mark which has been fraudulently obtained, or which has been formed and used with the design of deceiving the public in the purchase or use of any article of merchandise.

Sec. 4944. (*Act of 1870, § 82.*) [**Penalty for false registration of trade-mark.**] Any person who shall procure the registry of any trade-mark, or of himself as the owner of a trade-mark, or an entry respecting a trade-mark in the Patent Office, by making any false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such registry or entry, to the person injured thereby; to be recovered in an action on the case.

Sec. 4945. (*Act of 1870, § 83.*) [**Trade-marks; former rights and remedies reserved.**] Nothing in this chapter shall prevent, lessen, impeach, or avoid any remedy at law or in equity, which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this chapter had not been enacted.

Sec. 4946. (*Act of 1870, § 78.*) [**Trade-marks, expiration of terms for, effect of**] Nothing in this chapter shall be construed by any court as abridging or in any manner affecting unfavorably the claim of any person to any trade-mark after the expiration of the term for which such trade-mark was registered.

Sec. 4947. (*Act of 1870, § 81.*) [**Trade-marks, transfer of rights in.**] The Commissioner of Patents is authorized to make rules, regulations, and prescribe forms for the transfer of the right to the use of trade-marks, conforming as nearly as practicable to the requirements of law respecting the transfer and transmission of copyrights.

COPYRIGHTS.

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| <p>Sec. 4948. Librarian of congress to have charge of copyrights.</p> <p>4949. Seal: authentication by.</p> <p>4950. Bond of Librarian.</p> <p>4951. Annual report.</p> <p>4952. What may be copyrighted.</p> <p>4953. Term of copyrights.</p> <p>4954. Extension of term.</p> <p>4955. Assignments, and recording of.</p> <p>4956. Deposit of title and copies of work.</p> <p>4957. Recording copyright by librarian.</p> <p>4958. Fees of Librarian.</p> <p>4959. Copies of work to be sent to Librarian.</p> | <p>Sec. 4960. Penalty for not sending.</p> <p>4961. Postmasters to give receipts.</p> <p>4962. Notice of copyright, how to be made.</p> <p>4963. Penalty for false notice.</p> <p>4964. Damages for violating copyright of books.</p> <p>4965. Damages for violating copyright of maps.</p> <p>4966. Damages for violating copyright of dramatic compositions.</p> <p>4967. Damages for printing or publishing manuscripts.</p> <p>4968. Limitation of time of action.</p> <p>4969. Defenses to action in copyright cases.</p> |
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SEC. 4970. Injunctions in copyright cases.
 4971. Aliens and non-residents not privileged.
 4972.* Notice of copyright, how given.

SEC. 4973.* Fees of librarian.
 4974.* Construction of words "Engraving," "cut," "print," &c.
 4975.* Repeal of former laws.
 4976.* Act, when takes effect.

REVISED STATUTES, TITLE LX. CHAP. 3, p. 965.

Sec. 4948. (*Act of 1870, § 85.*) [**Librarian of congress to have charge of copyrights.**] All records and other things relating to copyrights and required by law to be preserved, shall be under the control of the Librarian of Congress, and kept and preserved in the Library of Congress; and the Librarian of Congress shall have the immediate care and supervision thereof, and under the supervision of the Joint Committee of Congress on the Library, shall perform all acts and duties required by law touching copyrights.

Sec. 4949. (*Act of 1870, § 85.*) [**Seal, authentication by.**] The seal provided for the office of the Librarian of Congress shall be the seal thereof, and by it all records and papers issued from the office, and to be used in evidence, shall be authenticated.

Sec. 4950. (*Act of 1870, § 85.*) [**Librarian to give bond.**] The Librarian of Congress shall give a bond, with sureties, to the Treasurer of the United States, in the sum of five thousand dollars, with the condition that he will render to the proper officers of the Treasury a true account of all moneys received by virtue of his office.

Sec. 4951. (*Act of 1870, § 85.*) [**Annual report.**] The Librarian of Congress shall make an annual report to Congress of the number and description of copyright publications for which entries have been made during the year.

Sec. 4952. (*Act of 1870, § 86.*) [**What may be copyrighted.**] Any citizen of the United States, or resident therein, who shall be the author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts, and the executors, administrators, or assigns of any such person, shall, upon complying with the provisions of this chapter, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending the same; and in the case of a dramatic composition, of publicly performing or representing it, or causing it to be performed or represented by others. And authors may reserve the right to dramatize or translate their own works.

Sec. 4953. (*Act of 1870, § 87.*) [**Term of copyrights.**] Copyrights shall be granted for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

Sec. 4954. (*Act of 1870, § 88.*) [**Extension of term.**] The author, inventor, or designer, if he be still living and a citizen of the United States or resident therein, or his widow and children if he be dead, shall have the same exclusive right continued for the further term of fourteen years, upon recording the title of the work or description of the article so secured a second time, and complying with all other regulations in regard to original copyrights,

within six months before the expiration of the first term. And such person shall within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more newspapers, printed in the United States, for the space of four weeks.

Sec. 4955. (*Act of 1870, § 89.*) [**Assignments, and recording of.**] Copyrights shall be assignable in law by any instrument of writing, and such assignment shall be recorded in the office of the Librarian of Congress within sixty days after its execution; in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice.

Sec. 4956. (*Act of 1870, § 90.*) [**Deposit of title and copies of work.**] No person shall be entitled to a copyright unless he shall, before publication, deliver at the office of the Librarian of Congress, or deposit in the mail addressed to the Librarian of Congress, at Washington, District of Columbia, a printed copy of the title of the book or other article or a description of the painting, drawing, chromo, statue, statuary, or model or design for a work of the fine arts for which he desires a copyright; nor unless he shall also, within ten days from the publication thereof, deliver at the office of the Librarian of Congress, or deposit in the mail addressed to the Librarian of Congress, at Washington, District of Columbia, two copies of such copyright book or other article, or in case of a painting, drawing, statue, statuary, model or design for a work of the fine arts, a photograph of the same.

Sec. 4957. (*Act of 1870, § 91.*) [**Recording title by Librarian.**] The Librarian of Congress shall record the name of such copyright book, or other article, forthwith in a book to be kept for that purpose, in the words following: "Library of Congress, to wit: Be it remembered that on the — day of —, —, A. B., of —, hath deposited in this office the title of a book (map, chart or otherwise, as the case may be, or description of the article), the title or description of which is in the following words, to wit: (here insert the title or description), the right whereof he claims as author (originator, or proprietor, as the case may be), in conformity with the laws of the United States respecting copyrights. C. D., Librarian of Congress." And he shall give a copy of the title or description, under the seal of the Librarian of Congress, to the proprietor whenever he shall require it.

Sec. 4958. (*Act of 1870, § 92.*) [**Fees of Librarian.**] The Librarian of Congress shall receive from the persons to whom the services designated are rendered, the following fees: 1. For recording the title or description of any copyright book or other article, fifty cents. 2. For every copy under seal of such record actually given to the person claiming the copyright or his assigns, fifty cents. 3. For recording any instrument of writing for the assignment of a copyright, fifteen cents for every one hundred words. 4. For every copy of an assignment, ten cents for every one hundred words. All fees so received shall be paid into the treasury of the United States. (a)

(a) Amended by act of 1874, § 2.

Sec. 4959. (*Act of 1870, § 93.*) [**Copies of work to be sent to Librarian.**] The proprietor of every copyright book or other article shall deliver at the office of the Librarian of Congress, or deposit in the mail addressed to the Librarian of Congress, at Washington, District of Columbia, within ten days after its publication, two complete printed copies thereof, of the best edition

issued, or description or photograph of such article as hereinbefore required, and a copy of every subsequent edition wherein any substantial changes shall be made.

Sec. 4960. (*Act of 1870, § 94.*) [**Penalty for not sending.**] For every failure on the part of the proprietor of any copyright to deliver, or deposit in the mail either of the published copies, or description, or photograph, required by Sections 4956 and 4959, the proprietor of the copyright shall be liable to a penalty of twenty-five dollars, to be recovered by the Librarian of Congress, in the name of the United States, in an action in the nature of an action of debt, in any district court of the United States within the jurisdiction of which the delinquent may reside or be found.

Sec. 4961. (*Act of 1870, § 96.*) [**Post-masters to give receipts.**] The post-master to whom such copyright book, title, or other article is delivered, shall, if requested, give a receipt therefor; and when so delivered he shall mail it to its destination.

Sec. 4962. (*Act of 1870, § 97.*) [**Notice of copyright, how to be made.**] No person shall maintain an action for the infringement of his copyright unless he shall give notice thereof by inserting in the several copies of every edition published, on the title-page or the page immediately following, if it be a book; or if a map, chart, musical composition, print, cut, engraving, photograph, painting, drawing, chromo, statue, statuary, or model or design intended to be perfected and completed as a work of the fine arts, by inscribing upon some portion of the face, or front thereof, or on the face of the substance on which the same shall be mounted, the following words: "Entered according to act of Congress, in the year ———, by A. B., in the office of the Librarian of Congress at Washington." (a)

(a) Amended by act of 1874, § 1.

Sec. 4963. (*Act of 1870, § 98.*) [**Penalty for false notice.**] Every person who shall insert or impress such notice or words of the same purport, in or upon any book, map, chart, musical composition, print, cut, engraving, or photograph, or other article for which he has not obtained a copyright, shall be liable to a penalty of one hundred dollars, recoverable one-half to the person who shall sue for such penalty, and one-half to the use of the United States.

Sec. 4964. (*Act of 1870, § 99.*) [**Damages for violating copyright of books.**] Every person who, after the recording of the title of any book as provided by this chapter, shall within the term limited, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses, print, publish, or import, or, knowing the same to be so printed, published, or imported, shall sell or expose to sale any copy of such book, shall forfeit every copy thereof to such proprietor, and shall also forfeit and pay such damages as may be recovered in a civil action by such proprietor in any court of competent jurisdiction.

Sec. 4965. (*Act of 1870, § 100.*) [**Damages for violating copyright of maps.**] If any person, after the recording of the title of any map, chart, musical composition, print, cut, engraving, or photograph or chromo, or of the description of any painting, drawing, statue, statuary, or model or design intended to be perfected and executed as a work of the fine arts, as provided by this chapter, shall, within the term limited, and without the consent of the pro-

prietor of the copyright first obtained in writing, signed in presence of two or more witnesses, engrave, etch, work, copy, print, publish, or import, either in whole or in part, or by varying the main design with intent to evade the law, or, knowing the same to be so printed, published, or imported, shall sell or expose to sale any copy of such map or other article, as aforesaid, he shall forfeit to the proprietor all the plates on which the same shall be copied, and every sheet thereof, either copied or printed, and shall further forfeit one dollar for every sheet of the same found in his possession, either printing, printed, copied, published, imported or exposed for sale; and in case of a painting, statue, or statuary, he shall forfeit ten dollars for every copy of the same in his possession, or by him sold or exposed for sale; one-half thereof to the proprietor and the other half to the use of the United States.

Sec. 4966. (*Act of 1870, § 101.*) [**Damages for violating copyright of dramatic compositions.**] Any person publicly performing or representing any dramatic composition for which a copyright has been obtained, without the consent of the proprietor thereof, or his heirs or assigns, shall be liable for damages therefor; such damages in all cases to be assessed at such sum, not less than one hundred dollars for the first, and fifty dollars for every subsequent performance, as to the court shall appear to be just.

Sec. 4967. (*Act of 1870, § 102.*) [**Damages for printing or publishing manuscripts.**] Every person who shall print or publish any manuscript whatever, without the consent of the author or proprietor first obtained (if such author or proprietor is a citizen of the United States, or resident therein), shall be liable to the author or proprietor for all damages occasioned by such injury.

Sec. 4968. (*Act of 1870, § 104.*) [**Limitation of time of action.**] No action shall be maintained in any case of forfeiture or penalty under the copyright laws, unless the same is commenced within two years after the cause of action has arisen.

Sec. 4969. (*Act of 1870, § 105.*) [**Defenses to action in copyright cases.**] In all actions arising under the laws respecting copyrights the defendant may plead the general issue, and give the special matter in evidence.

Sec. 4970. (*Act of 1870, § 106.*) [**Injunctions in copyright cases.**] The circuit courts and district courts having the jurisdiction of circuit courts, shall have power, upon bill in equity, filed by any party aggrieved, to grant injunctions to prevent the violation of any right secured by the laws respecting copyrights, according to the course and principles of courts of equity, on such terms as the court may deem reasonable.

Sec. 4971. (*Act of 1870, § 103.*) [**Aliens and non-residents not privileged.**] Nothing in this chapter shall be construed to prohibit the printing publishing, importation, or sale of any book, map, chart, dramatic or musical composition, print, cut, engraving, or photograph, written, composed or made by any person not a citizen of the United States nor resident therein.

ACT OF JUNE 18, 1874, CHAP. 301.

AN ACT TO AMEND THE LAW RELATING TO PATENTS, TRADE-MARKS, AND
COPYRIGHTS.

Sec. 4972.* (*Act of 1874, ch. 301, § 1.*) [**Notice of copyright, how given.**] No person shall maintain an action for the infringement of his copyright unless he shall give notice thereof by inserting in the several copies of every edition published, on the title-page or the page immediately following, if it be a book; or if a map, chart, musical composition, print, cut, engraving, photograph, painting, drawing, chromo, statue, statuary, or model or design intended to be perfected and completed as a work of the fine arts, by inscribing upon some visible portion thereof, or of the substance on which the same shall be mounted, the following words, viz.: "Entered according to act of Congress, in the year—, by A. B., in the office of the Librarian of Congress, at Washington;" or, at his option the word "Copyright," together with the year the copyright was entered, and the name of the party by whom it was taken out; thus—"Copyright, 18—, by A. B."

Sec. 4973.* (*Act of 1874, ch. 301, § 2.*) [**Fees of Librarian.**] For recording and certifying any instrument of writing for the assignment of a copyright, the Librarian of Congress shall receive from the persons to whom the service is rendered, one dollar; and for every copy of an assignment one dollar; said fee to cover, in either case, a certificate of the record, under seal of the Librarian of Congress; and all fees so received shall be paid into the Treasury of the United States.

Sec. 4974.* (*Act of 1874, ch. 301, § 3.*) [**Construction of words, "engraving," "cut," and "print."**] In the construction of this act, the words "engraving," "cut," and "print" shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the Patent Office. And the Commissioner of Patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law as to copyright of prints, except that there shall be paid for recording the title of any print or label not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record under the seal of the Commissioner of Patents, to the party entering the same.

Sec. 4975.* (*Act of 1874, ch. 301, § 4.*) [**Repeal.**] All laws and parts of laws inconsistent with the foregoing provisions be and the same are hereby repealed.

Sec. 4976.* (*Act of 1874, ch. 301, § 5.*) [**Act, when to take effect.**] This act shall take effect on and after the first day of August, eighteen hundred and seventy-four.

Approved, June 18, 1874.

INDEX.

	SEC.	PAGE		SEC.	PAGE
Actions, under patent and copyright laws—where cognizable.....	629	5	Assistant commissioner of patents, appointment of...	476	3
Jurisdiction, exclusive...	711	6	Salary of.....	477	3
Appeal in, to supreme court.....	699	5	Caveat, who entitled to file...	4902	11
Administrator, when may receive patent.....	4896	10	How filed, and how long operative.....	4902	11
Affidavits, in cases pending in Patent Office.....	4905	12	Action on, on interfering application.....	4902	11
Rules for taking—before whom may be taken...	4905	12	When alien may file.....	4902	11
Aliens, may obtain patent...	4886	8	Circuit courts, jurisdiction of in patent and copyright cases.....	629	5
When may file caveat...	4902	11	Jurisdiction of, exclusive	711	6
Resident, may have copyright.....	4952	22	Power to grant temporary restraining orders.....	718	6
Non-resident, not privileged.....	4971	25	May grant injunctions in Patent cases.....	4921	16
Appeal, in Patent and Copyright cases, to supreme court.....	699	5	May grant injunctions in copyright cases.....	4970	25
Appeals in patent proceedings from primary examiner to board of examiners-in-chief.....	4909	13	May impanel jury in Patent causes.....	720	6
From examiners-in-chief to commissioner of patents.....	4910	13	Clerks in Patent Office.....	440	2
From commissioner of patents to supreme court of district of Columbia	4911	13	Commissioner of Patents, how appointed.....	476	3
To supreme court of district of Columbia, notice on, and filing of reasons of appeal.....	4912	13	Power of, as to nomination of officers.....	476	3
To supreme court of district of Columbia, proceedings in.....	4913	13	Salary of.....	477	3
Action of supreme court of district of Columbia on appeal; effect of...	4914	13	Bond of.....	479	3
Assignment of patent, or interest in, how made; recording of.....	4895	10	Right of, as to holding patents.....	480	3
When void, against subsequent purchaser of copyrights, how made; recording of.....	4955	23	General duties of.....	481	3
Assignee of inventor, patent may issue to.....	4895	10	May make regulations as proceedings in Patent Office.....	483	3
			To classify and arrange models, &c.....	484	3
			Power of, as to models on rejected applications...	485	4
			Power of, as to Patent Agents guilty of gross misconduct.....	487	4
			May require papers to be printed at expense of party filing.....	488	4
			Authority of, to print copies of claims, laws, decisions, &c.....	489	4
			To print specifications and drawings, for distribution.....	490	4

	SEC.	PAGE		SEC.	PAGE
To print specifications, &c., for sale.....	491	4	Who may have bond, and for what.....	4952	22
To fix price of uncertified printed copies of specifications and drawings..	498	5	Rights secured by; rights as to dramatic compositions.....	4952	22
To make annual reports to congress.....	494	5	Term of.....	4953	22
To have charge of collections of exploring expeditions.....	495	5	Extension of the term of.	4954	22
All patents to be countersigned by.....	4888	8	Assignment of; and recording deposit of title and copies of work....	4956	23
Applications for patents to be made to.....	4888	9	Record of title of work; attested copy of same..	4957	23
May require specimens of ingredients, when.....	4890	9	Fees for recording title, assignments, and for copies.....	4958	23
To require applicant to furnish model.....	4891	9	Fees for recording title, assignments, and for copies.....	4973	26
To cause examination of alleged new invention, &c., and issue patent..	4893	9	Copies of work, to be delivered to Librarian of Congress.....	4959	23
Power of, as to question of abandonment of application.....	4894	10	Penalty for failure to deliver.....	4960	24
To notify applicant of rejection of application, with reasons.....	4903	12	Receipt of postmaster for title or copy mailed....	4961	24
When to order re-examination of.....	4903	12	Notice of copyright to be inserted in book; penalty on default.....	4962	24
To notify applicant of interfering application or patent.....	4904	12	Penalty on default.....	4972	26
To issue patent to prior inventor, unless appeal made, &c.....	4904	12	Penalty for falsely inserting notice of copyright	4963	24
To prescribe time for taking appeal.....	4904	12	Penalty for infringing copyright of book.....	4964	24
To prescribe rules for taking affidavits, cases pending in Patent Office.....	4905	12	Penalty for infringing copyright of map.....	4965	24
Appeal to, from board of examiners-in-chief....	4910	13	Damages for infringing copyright of dramatic composition.....	4966	25
Appeal from; to supreme court of district of Columbia.....	4911	13	Damages for printing or publishing manuscript.	4967	25
Duty of, as to granting reissues.....	4916	14	Limitation of action for infringement of copyright.....	4968	25
May re-issue several patents for separate parts of invention.....	4916	14	Defenses to action for infringement of copyright	4969	25
When to allow amendments by new matter...	4916	14	Injunctions to restrain violations.....	4970	25
To make regulations and prescribe forms for transfer of right to use trade-mark.....	4947	21	Provisions not applicable to aliens and non-residents....	4971	25
Copyright, custody of records &c., relating to, required by.....	4948	22	Meaning of words "engraving," "cut," "print.".....	4974	26
General duty of Librarian of Congress as to.....	4948	22	"Cut," meaning of, under copyright laws.....	4974	26
Seal for authenticating records, &c., relating to Librarian, to give bond..	4949	22	Damages, not recoverable for use; article purchased of inventor, or made with his consent, before application for patent....	4899	11
Annual report of Librarian of Congress as to..	4951	22	When not recoverable by patentee failing to mark or label patented article.....	4900	11
			For infringement of patent, and when may be increased.....	4919	15

INDEX.

29

	SEC.	PAGE		SEC.	PAGE
Assessment of, by the court, in suit in equity	4921	16	Damages, may be increased.....	4921	16
Infringement of trade-mark.....	4942	20	Remedy in, for infringement of trade-mark....	4942	20
Injuries suffered by reason of false registry of trade-mark....	4942	20	Remedy in, for violations of copyrights.....	4970	25
For violation of copyright of book.....	4964	24	Examiners, principal, how many.....	440	2
For violating copyright of maps, &c.....	4965	24	Principal, how appointed.	476	3
For violating copyright of dramatic composition..	4966	25	Appeal from, to board of examiners-in-chief..	4909	13
For printing any manuscript without consent of the author.....	4967	25	Examiners-in-chief, appointment of.....	476	3
Department of Interior, patent office attached to.....	475	2	Salary of.....	477	3
Disbursements for patent office, made by....	496	5	Duties of.....	482	3
Depositions, commissioner of patents may prescribe rules for taking.....	4905	12	Appeals from, to commissioner of Patents.....	4910	13
Before whom may be taken	4905	12	Executions, may take patent, when.....	4896	10
Designs, new and original, patentable.....	4929	17	Extension of patents, to whom benefit extends.....	4928	17
Models of, when may be dispensed with.....	4930	17	Fees, patent fees, rates of.....	4934	18
Term of patent for.....	4931	17	For registering trade-mark.....	4937	19
Extension of patents issued for.....	4932	17	Of librarian in copyright cases.....	4958	23
Patents for, governed by rules as to patents for inventions.....	4933	17	Of librarian in copyright cases.....	4973	26
Disclaimer, when patentee and assigns may make.....	4917	14	How payable.....	4935	18
How to be made, effect of in patent.....	4917	14	Refunding of.....	4936	18
Effect of in pending suits	4917	14	General issue, and notice with in actions for infringement of patents.....	4920	15
If not made before bringing suit, costs not recoverable.	4922	16	In actions arising under copyright laws.....	4969	25
Drawings of invention to be annexed to patent.....	4884	8	Infringement of patent, damages not recoverable, if patentee fails to mark patented article, except when..	4900	11
To be furnished by applicant; how signed and attested.....	4889	9	Action, for what sum judgment may be rendered....	4919	15
Copy attached to patent, to be furnished by patent office.....	4889	9	Pleading and proof in action for.....	4920	15
Drawing of design may dispense with model thereof.....	4930	17	Injunction to prevent....	4921	16
"Engraving," what word applies to.....	4974	26	Recovery for, when specification too broad.....	4922	16
Equity, suits in, cognizable by circuit courts....	629	5	Infringement of trade-mark, remedies for.....	4942	20
Jurisdiction exclusive....	711	6	No remedy for, of trade-mark used for unlawful purposes, or obtained by fraud.....	4943	21
Suit in, to obtain issue of patent on rejection of claim, &c.	4915	14	Infringement of copyright, no action maintainable unless notice of copyright given	4962	24
In case of interfering patents.....	4918	15	Of copyrights of books, forfeiture and damages	4964	24
Defenses, pleadable in suits in.....	4920	15	Of copyrights of maps, &c., damages for.....	4965	24
Recoveries in, extent of damages.....	4921	16	Of copyright of dramatic composition, damages for.....	4966	25
			Limitation of time for action, for	4968	25

	SEC.	PAGE		SEC.	PAGE
Pleading and evidence in actions for.....	4969	25	copy of title of book, before publication.....	4956	23
Power of circuit courts to enjoin.....	4970	25	To record name of copyright article ...	4957	23
Injunctions, Temporary, restraining orders, when grantable.....	718	6	Fees to be paid to, in respect of copyrights....	4958	23
By whom may be granted	719	6	Fees to be paid to in respect of copyrights....	4973	26
When may be issued by a district judge.....	719	6	Copies of copyright articles to be delivered to.....	4959	23
Issued by district judge, when expires.....	719	6	Penalty for not delivering copies of copyright article to.....	4960	24
In cases of infringement of patents for inventions	4921	16	Limitations—of time for bringing action under copyright laws.....	4968	25
In cases of infringement of designs.....	4933	17	Lithographing—for specifications and drawings, how done.....	492	4
In cases of wrongful use of trade-mark... ..	4942	20	Models—to be classified and arranged.....	484	3
In cases of violation of copyrights.....	4970	25	In cases of rejected application how disposed of.	485	4
Interference, notice of, to applicant.....	4904	12	Model of invention to be furnished by applicant.	4891	9
Priority, how determined	4904	12	Oath, of applicant for patent.	4892	9
Appeal in cases of, to board of examiners....	4909	13	Before whom may be taken	4892	9
From board of examiners to commissioner.....	4910	13	Patent agents, when commissioner of patents may refuse to recognize . . .	487	4
No appeal from commissioner to supreme court district of Columbia...	4911	13	Patented articles—how to be marked, &c.....	4900	11
Suit in equity to adjust in case of interfering patents.....	4918	15	Penalty for marking unpatented article as patented.....	4901	11
Inventions, short description of, to be contained in patent.....	4884	8	Patent office, establishment of	475	2
What patentable.....	4886	8	A part of the department of interior.....	475	2
Examination as to, to be made on application for patent.....	4893	9	Clerks and employees in..	440	2
Priority of invention, in cases of interference, how determined.....	4904	12	Appointment of commissioner assistant commissioner, and three examiners-in-chief in.....	476	3
Disclaimer of, formalities and effect of.....	4917	14	Appointment of other officers, clerks, &c., in....	476	3
Incorrectly claimed, when suits maintainable....	4922	16	Salaries of commissioner, assistant commissioner, and three commissioners-in-chief.....	477	3
When patent not void on account of prior invention in foreign country, when will not vitiate patent.....	4923	16	Seal of.....	478	3
Inventions of designs, what patentable.....	4929	17	Bond of commissioners and chief clerk.....	479	3
Labels, when may be registered in patent office	4974	26	Officers, &c., not to have interest in patents.....	480	3
Librarian of Congress—charge of records, &c., relating to copyrights....	4948	22	General duties of commissioner.....	481	3
Seal of office of, for what to be used.....	4949	22	Qualifications and duties of examiners-in-chief...	482	3
Bond of.....	4950	22	Regulations by whom prescribed.....	483	3
Annual report of.....	4951	22	Classification, arrangement, &c., of models, &c., in.....	484	3
Assignments of copyrights to be recorded in office of.....	4955	23	Library of.....	486	4
Deposit with of printed			Exclusion from, of patent agents.....	487	4

INDEX.

31

	SEC.	PAGE		SEC.	PAGE
Commissioner to print copies of claims, decisions, &c.....	489	4	Abandonment a question of fact on renewed application for....	4897	10
Commissioner to print specifications and drawings for distribution...	490	4	Assignment of to be recorded.....	4898	10
For sale.....	491	4	Purchaser a user of invention, before application for patent, rights of...	4899	11
Lithographing and engraving of specifications and drawings....	492	4	Rejection of claim for, notice of; re-examination of.....	4908	12
Price of uncertified copies of specifications and drawings.....	493	5	Interference, on application for....	4904	12
Annual report of commissioners.....	494	5	Patent to issue to prior inventor.....	4904	12
Custody of collections of exploring expedition to be under commissioner.	495	5	When may issue, by decree of court.....	4915	14
Disbursements for, by whom to be made.....	496	5	Re-issue of defective patents.....	4916	14
All patents to be issued under seal of, and recorded in.....	4883	8	Interfering patents, how may be declared void, in whole or in part....	4918	15
Drawings of inventions to be filed therein.....	4889	9	Infringement of, damages for.....	4919	15
Of assignments, &c., of patents to be recorded in	4898	10	Violation of injunctions to prevent.....	4921	16
Decisions of supreme Court of District of Columbia, to be recorded in.....	4914	13	How far valid, when claim is too broad.....	4922	16
Disclaimer to be recorded in.....	4917	14	Not void, because of pre-knowledge or use in foreign country.....	4923	16
Trade-marks to be registered in.....	4937	19	Extension of, to whom enures.....	4928	17
Patents, how issued, attested, and recorded.....	4883	8	For new and original designs, &c.....	4929	17
And duration of.....	4884	8	For designs, term of.....	4931	17
Date of.....	4885	8	For designs, extension of.....	4932	17
For what inventions and discoveries granted....	4886	8	For designs, subject to provisions as to patents for inventions.....	4933	17
Right to, not barred by previously obtaining foreign patent, unless, &c.....	4887	8	"Print," what is, under copyright laws.....	4974	26
Term of, to expire at same time with previously obtained foreign patent, not exceeding, &c.....	4887	9	When may be registered by patent office.....	4974	26
Application for, what to contain.....	4888	9	Re-issue of patents, may be granted to assignee...	4895	10
Copy of drawings to be attached to patent as part thereof.....	4889	9	Application to be signed by inventor.....	4895	10
To be granted upon examination.....	4893	9	Appeal on application for re-issue to board of examiners.....	4909	13
Time of completing and preparing application for.....	4894	10	Appeal to commissioner in person....	4910	13
May be issued or re-issued to assignee.....	4895	10	Appeal to supreme court of District of Columbia.....	4911	13
May be issued to executor or administrator.....	4896	10	When, and to whom allowed.....	4916	14
Renewal of application for in case of failure to pay fee.....	4897	10	May be granted for separate parts of thing patented.....	4916	14
			New matter, when not allowable.....	4916	14
			New matter, when allowable.....	4916	14
			Secretary of the Interior, to		

	SEC.	PAGE		SEC.	PAGE
appoint clerks in patent office on.....	476	8	Declaration, what to set forth.....	4988	19
To approve rules of Patent office.....	488	8	Declaration, to be verified.....	4889	19
Control over disbursements of patent office..	498	5	What can not be registered as.....	4939	20
To sign letters patent....	4888	8	Time of receipt, for registration to be recorded	4940	20
Specifications, to be recorded with patent in patent office.....	4888	8	Certified copies of, and of declaration to be evidence.....	4940	20
Copy of, to be annexed to patent.....	4884	8	Term of protection of; rights secured by, renewal of.....	4941	20
What to set forth.....	4888	9	Remedy for infringement of; damages.....	4942	20
To be signed by inventor, and by two witnesses..	4888	9	Wrongful use of, may be enjoined.....	4942	20*
By whom sworn to on application by assignee..	4895	10	When actions not maintainable for alleged infringement of.....	4943	21
On application for re-issue, who to sign.....	4895	10	Penalty for false or fraudulent registration.....	4944	21
In cases of re-issue.....	4916	14	Former remedies at law or in equity, preserved	4945	21
Specifications and drawings, printing of, for distribution.....	490	4	Claim to, not affected by expiration of term of registration.....	4946	21
Printing of, for sale.....	491	4	Rules and forms of transfer of right to use.....	4947	21
A copy to be annexed to patent.....	4884	8	Witnesses, in cases pending in patent office; may be subpoenaed, and by whom.....	4906	12
Supreme court of the District of Columbia, appeal to, from decision of Commissioner..	4911	13	Fees of.....	4907	12
Notice of, how and to whom given.....	4912	13	Attendance of, how compelled.....	4908	13
Proceedings on appeal...	4913	13	When not in contempt for disobeying subpoena	4908	13
Determination of appeal, and effect of.....	4914	13	What can not be compelled to disclose.....	4908	13
Surrender of Patent, when may be made for re-issue	4916	14			
Several re-issues may be granted.....	4916	14			
Trade-marks, protection for, who may have.....	4937	19			

STATUTE LAWS
OF THE
UNITED STATES OF AMERICA
RELATING TO
COPYRIGHT
AND
PATENTS FOR INVENTIONS
FROM
1790 TO 1874
NOT NOW IN FORCE
WITH
NOTES AND REFERENCES

EXPIRED
ACTS OF CONGRESS
IN RESPECT TO
COPYRIGHTS.

1790 TO 1874.

THE acts of Congress in respect to Copyrights, passed previous to 1819, are now obsolete, having been repealed by the act of 1831; but they are inserted in full for the purposes of reference and comparison, when desired, with the acts in force.

The notes of decisions inserted under the obsolete acts, are such as explain their construction, or have special reference to them. Decisions of a general nature, though made under such acts, are inserted under the acts now in force, as assisting to a proper understanding and interpretation of them.

It has not been intended to insert under the several acts, all the decisions explanatory of them, but only those of a mere general character, adding suitable references to appropriate titles of the DIGEST; nor has any special care been taken to arrange such notes in chronological order.

ACT OF 1790, CHAPTER 15.

(1 STAT. AT LARGE, 124.)

An Act for the Encouragement of Learning, by securing the Copies of Maps, Charts, and Books, to the Authors and Proprietors of such Copies, during the Times therein mentioned:

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

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

ACT OF 1790, CHAP. 15, §§ 1, 2.

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

SECTION 2. *And be it further enacted*, That if any other person or persons, from and after the recording the title of any map, chart, book or books, and publishing the same as aforesaid, and within the times limited and granted by this act, shall print, reprint, publish, or import, or cause to be printed, reprinted, published, or imported from any foreign kingdom or state, any copy or copies of such map, chart, book or books, without the consent of the author or proprietor thereof, first had and obtained in writing, signed in the presence of two or more credible witnesses; or knowing the same to be so printed, reprinted, or imported, shall publish, sell, or expose to sale, or cause to be published, sold, or exposed to sale, any copy of such map, chart, book or books, without such consent first had and obtained in writing as aforesaid, then such offender or offenders shall forfeit all and every copy and copies of such map, chart, book or books, and all and every sheet and sheets, being part of the same, or either of them, to the author or proprietor of such map, chart, book or books, who shall forthwith destroy the same: And every such offender and offenders shall also forfeit and pay the sum of fifty cents for every sheet which shall be found in his or their possession, either printed or printing, published, imported, or exposed to sale, contrary to the true intent and meaning of this act, the one moiety thereof to the author or proprietor of such map, chart, book or books, who shall sue for the same, and the other moiety thereof to and for the use of the United States, to be recovered by action of debt in any court of record in the United States, wherein the same is cognizable. *Provided always*, That such action be commenced within one year after the cause of action shall arise, and not afterward.

(b) Congress in passing the act of 1790, did not legislate in reference to existing rights. Instead of sanctioning an existing right, it created it. *Ibid.*, 661.

 ACT OF 1790, CHAP. 15, §§ 3, 4.

SECTION 3. *And be it further enacted*, That no person shall be entitled to the benefit of this act, in cases where any map, chart, book or books, hath or have been already printed and published, unless he shall first deposit, and in all other cases, unless he shall before publication deposit a printed copy of the title of such map, chart, book or books, in the clerk's office of the district court where the author or proprietor shall reside: (a) And the clerk of such court is hereby directed and required to record the same forthwith, in a book to be kept by him for that purpose, in the words following (giving a copy thereof to the said author or proprietor, under the seal of the court, if he shall require the same). "District of _____ to wit: *Be it remembered*, That on the day of _____ in the _____ year of the independence of the United States of America, A. B. of the said district, hath deposited in this office the title of a map, chart, book or books (as the case may be), the right whereof he claims as author or proprietor (as the case may be), in the words following, to wit: [here insert the title] in conformity to the act of the Congress of the United States, intituled, 'An act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the times therein mentioned.' C. D., clerk of the district of _____." For which the said clerk shall be entitled to receive sixty cents from the said author or proprietor, and sixty cents for every copy under seal actually given to such author or proprietor as aforesaid. And such author or proprietor shall, within two months from the date thereof, cause a copy of the said record to be published in one or more of the newspapers printed in the United States, for the space of four weeks. (b)

SECTION 4. *And be it further enacted*, That the author or proprietor of any such map, chart, book or books, shall, within six months after the publishing

(a) 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. *Ewer v. Core*, 4 Wash., 490. WASHINGTON, J.; Pa., 1824.

If the title of an author depended upon the act of 1799, it would be complete, provided he had deposited a printed copy of the title of the book in the clerk's office, as directed by this section. *Ibid.*, 490.

(b) The provision of this section requiring the author to publish the title of his book, in a newspaper, is merely directory, and constitutes no part of the essential requisites for securing the copyright. *Nichols v. Ruggles*, 3 Day, 158. CURIAM; Ct., 1808.

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.

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

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

ACT OF 1802, CHAP. 36, § 1.

thereof, deliver, or cause to be delivered to the Secretary of State a copy of the same, to be preserved in his office. (a)

SECTION 5. *And be it further enacted*, That nothing in this act shall be construed to extend to prohibit the importation or vending, reprinting or publishing within the United States, of any map, chart, book or books, written, printed, or published by any person not a citizen of the United States, in foreign parts or places without the jurisdiction of the United States.

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

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

Approved May 31st, 1790.

Repealed by act of 1831, § 14.

ACT OF 1802, CHAPTER 36.

(2 STAT. AT LARGE, 171.)

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

SECTION 1. *Be it enacted by the Senate and House of Representatives of the*

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

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.

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

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

SECTION 2. *And be it further enacted*, That from and after the first day of January next, every person, being a citizen of the United States or resident within the same, who shall invent and design, engrave, etch or work, or from his own works and inventions, shall cause to be designed and engraved, etched or worked, (b) any historical or other print or prints, shall have the sole right

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

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

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.

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

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

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

ACT OF 1802, CHAP. 36, §§ 3, 4.

and liberty of printing, reprinting, publishing and vending such print or prints, for the term of fourteen years from the recording the title thereof in the clerk's office, as prescribed by law for maps, charts, book or books: *Provided*, he shall perform all the requisites in relation to such print or prints, as are directed in relation to maps, charts, book or books, in the third and fourth sections of the act to which this is a supplement, and shall moreover cause the same entry to be duly engraved on such plate, with the name of the proprietor, and printed on every such print or prints as is hereinbefore required to be made on maps or charts.

SECTION 3. *And be it further enacted*, That if any printseller or other person whatsoever, from and after the said first day of January next, within the time limited by this act, shall engrave, etch or work, as aforesaid, or in any other manner copy or sell, or cause to be engraved, etched, copied or sold, in the whole or in part, by varying, adding to, or diminishing from the main design, or shall print, reprint, or import for sale, or cause to be printed, reprinted, or imported for sale, any such print or prints, or any parts thereof, without the consent of the proprietor or proprietors thereof, first had and obtained, in writing, signed by him or them respectively, in the presence of two or more credible witnesses; or knowing the same to be so printed or reprinted, without the consent of the proprietor or proprietors, shall publish, sell, or expose to sale or otherwise, or in any other manner dispose of any such print or prints, without such consent first had and obtained, as aforesaid, then such offender or offenders shall forfeit the plate or plates on which such print or prints are or shall be copied, and all and every sheet or sheets (being part of or whereon such print or prints are or shall be copied or printed) to the proprietor or proprietors of such original print or prints, who shall forthwith destroy the same; and further, that every such offender or offenders shall forfeit one dollar for every print which shall be found in his, her, or their custody; either printed, published, or exposed to sale, or otherwise disposed of, contrary to the true intent and meaning of this act, the one moiety thereof to any person who shall sue for the same, and the other moiety thereof to and for the use of the United States, to be recovered in any court having competent jurisdiction thereof.

SECTION 4. *And be it further enacted*, That if any person or persons from and after the passing of this act, shall print or publish any map, chart, book or books, print or prints, who have not legally acquired the copyright of such map

whom the right is vested, and the form and completion of the work are executed by another. *Ibid.*, 51.

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

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

ACT OF 1819, CHAP. 19.

chart, book or books, print or prints, and shall, contrary to the true intent and meaning of this act, insert therein or impress thereon that the same has been entered according to act of Congress, or words purporting the same, or purporting that the copyright thereof has been acquired; every person so offending shall forfeit and pay the sum of one hundred dollars, one moiety thereof to the person who shall sue for the same, and the other moiety thereof to and for the use of the United States, to be recovered by action of debt in any court of record in the United States, having cognizance thereof. *Provided always*, that in every case for forfeitures hereinbefore given, the action be commenced within two years from the time the cause of action may have arisen.

Approved April 29th, 1802.

Repealed by act of 1831, § 14.

ACT OF 1819, CHAPTER 19.

(3 STAT. AT LARGE, 481.)

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

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

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

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

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.

The act of 1819, so far as it gave cognizance to the courts of the United States in cases of copyrights, still remains in force, and is the only law conferring equitable

ACT OF 1831, CHAP. 16, § 1.

decrees of any Circuit Courts, rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner, and under the same circumstances, as is now provided by law in other judgments and decrees of such Circuit Courts. (b)

Approved, February 15th, 1819.

ACT OF 1831, CHAPTER 16.

(4 STAT. AT LARGE, 436.)

An Act to amend the several acts respecting copyrights. (a)

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That from and after the passing of this act, any person or persons, being a citizen or citizens of the United

jurisdiction on these courts in such cases: the 9th section of the act of 1831, protects manuscripts only. *Stephens v. Gladding*, 17 How., 455.—CURTIS, J.; Sup. Ct., 1854.

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

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.

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.

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

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

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

(a) OBJECT OF THE COPYRIGHT LAWS, AND FOUNDATION OF COPYRIGHT.

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

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

The term science cannot be applied to a work of so fluctuating and fugitive a character as a newspaper or price current. Such a publication is not a book, the copyright of which can be secured under the acts of Congress. *Ibid.*, 392, 393.

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.

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

See also DIGEST, title COPYRIGHT, A.

 ACT OF 1831, CHAP. 16, § 1.

States, or resident therein, who shall be the author or authors (b) of any book or books, map, chart, or musical composition, which may be now made or composed, and not printed and published, or shall hereafter be made or composed, or who shall invent, design, etch, engrave, work, or cause to be engraved, etched, or worked from his own design, any print or engraving (c), and the executors, administrators; or legal assigns of such person or persons, shall have the sole right

(b) WHO MAY HAVE COPYRIGHT.

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.—BETTS, J.; N. Y., 1839.

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

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.

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

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.

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

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

See also DIGEST, titles AUTHOR; COPYRIGHT, C.

(c.) WHAT SUBJECT OF COPYRIGHT.

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

A newspaper, or price current, is not such a publication as falls under the protection of the copyright laws. *Clayton v. Stone*, 2 Paine, 392.—THOMPSON, J.; N. Y., 1828.

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

Any new and original plan, arrangement or combination of materials, will entitle the author to a copyright, even though the materials are not new. *Emerson v. Davies*, 3 Story, 778.—STORY, J., Mass., 1845.

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

A person cannot have an exclusive right, or copyright in a label, as it is not a

ACT OF 1831, CHAP. 16, § 2.

and liberty of printing, reprinting, publishing, and vending (d) such book or books, map, chart, musical composition, print, cut, or engraving, in whole or in part, for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

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

book, within the provisions of the statute. *Coffeen v. Brunton*, 4 McLean, 517.—McLEAN, J.; Ind., 1849.

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

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

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

See also DIGEST, titles, COPYRIGHT, B.: ABRIDGEMENT; CHARTS; COMPILATIONS; DICTIONARIES; REVIEWS; TRANSLATION.

(d) COPYRIGHT, WHAT IS.

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

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

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

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

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

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

See also DIGEST, title COPYRIGHT, A.

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

SECTION 3. *And be it further enacted*, That in all cases of renewal of copyright under this act, such author or proprietor shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more of the newspapers printed in the United States, for the space of four weeks.

SECTION 4. *And be it further enacted*, (b) That no person shall be entitled to the benefit of this act, unless he shall, before publication, deposit a printed copy of the title of such book, or books, map, chart, musical composition, print, cut, or engraving, in the clerk's office of the District Court of the district wherein the author or proprietor shall reside, and the clerk of such court is hereby directed and required to record the same thereof forthwith, in a book to be kept for that purpose, in the words following, (giving a copy of the title, under the seal of the court, to the said author or proprietor, whenever he shall require the same):
 "District of _____ to wit: Be it remembered, that on the _____ day of
 Anno Domini, _____ A. B., of the said district, hath deposited in this office the
 title of a book, (map, chart, or otherwise, as the case may be), the title of which

(a) The extension of a copyright, by the copyright acts of 1790 and 1831, is given to the author alone, or to others only, who purchase it from him. *Pierpont v. Fowle*, 2 Wood. & Min., 44.—WOODBURY, J.; Mass., 1846.

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.

An assignment of a "copyright" is to be referred to what was then in existence, and not to any future contingency. *Ibid.*, 45.

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

See also DIGEST; title COPYRIGHT, E.

(b) NOTES TO §§ 4 AND 5.

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

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

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

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

is in the words following, to wit: (here insert the title); the right whereof he claims as author, (or proprietor, as the case may be), in conformity with an act of Congress, entitled 'An act to amend the several acts respecting copyrights.' C. D., Clerk of the district." For which record the clerk shall be entitled to receive, from the person claiming such right, as aforesaid, fifty cents, and the like sum for every copy under seal, actually given to such person or his assigns. And the author or proprietor of any such book, map, chart, musical composition, print, cut, or engraving, shall, within three months from the publication of said book, map, chart, musical composition, print, cut, or engraving, deliver, or cause to be delivered, a copy of the same to the clerk of said district. And it shall be the duty of the clerk of each District Court, at least once in every year, to transmit a certified list of all such records of copyright, including the titles so recorded, and the dates of record, and also all the several copies of books or other works deposited in his office according to this act, to the Secretary of State, to be preserved in his office.

SECTION 5. *And be it further enacted, (b)* That no person shall be entitled to the benefit of this act, unless he shall give information of copyright being secured, by causing to be inserted in the several copies of each and every edition published during the term secured on the title-page, or the page immediately following, if it be a book, or, if a map, chart, musical composition, print, cut, or engraving, by causing to be impressed on the face thereof, or if a volume of maps,

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

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

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.

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

Until all the things required by these sections 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.

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

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

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

After such title-page has been deposited, the author can maintain an action for an infringement or violation of his right, even though the work may not have been pub

ACT OF 1831, CHAP. 16, § 6.

charts, music, or engravings, upon the title or frontispiece thereof, the following words, viz.: "Entered according to act of Congress, in the year _____, by A. B., in the clerk's office of the District Court of _____," (as the case may be.)

SECTION 6. *And be it further enacted*, That if any other person or persons, from and after the recording the title of any book or books, according to this act, shall, within the term or terms herein limited, print, (a) publish, or import, or cause to be printed, published, or imported, any copy of such book, or books, without the consent of the person legally entitled to the copyright thereof, first had and obtained in writing, signed in presence of two or more credible witnesses, or

lished, or the printed copy deposited. *Roberts v. Meyers*, 13 Mo. Law Rep., 398.—SPRAGUE, J.; Mass., 1860. CONTRA, *Keene v. Wheatley*, 1 Amer. Law Reg., 44.—CADWALLADER, J.; Pa., 1860.

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

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

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

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.

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

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.

Nor does it necessarily depend upon the quantity taken, whether it is an infringement of a copyright or not. *Ibid.*, 116.

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

The infringement of a copyright does not depend so much upon the length of the extracts as upon their value. Nor has the intention with which extracts are made any bearing upon the question of violation. *Story's Exrs. v. Holcombe*, 4 McLean, 309, 310.—MCLEAN, J.; Ohio, 1847.

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. *Ibid.*, 315.

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.

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

See also DIGEST, title INFRINGEMENT, A.

ACT OF 1831, CHAP. 16, § 7.

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

SECTION 7. *And be it further enacted*, That if any person or persons, after the recording of the title of any print, cut, or engraving, map, chart, (b) or musical composition, according to the provisions of this act, shall, within the term or terms limited by this act, engrave, etch, or work, sell, or copy, or caused to be

(a) 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.—BERTS, J.; N. Y., 1846.

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.

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.

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.

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.

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

This question was not decided in *Backus v. Gould*, 7 How., 798, though raised in the court below and decided *pro forma* there. *Ibid.*, 342.

See also DIGEST, title PENALTIES, A.

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

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

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

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

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

 ACT OF 1831, CHAP. 16, §§ 8 9.

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

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

SECTION 9. *And be it further enacted*, That any person or persons who shall print or publish any manuscript whatever without the consent of the author or

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

See also DIGEST, title CHARTS.

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

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.

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.

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

See also DIGEST, title, PENALTIES, A.

ACT OF 1831, CHAP. 16, § 10.

legal proprietor first obtained as aforesaid, (if such author or proprietor be a citizen of the United States, or resident therein), shall be liable to suffer and pay to the author or proprietor, all damages occasioned by such injury, to be recovered by a special action on the case founded upon this act, in any court having cognizance thereof; (a) and the several courts of the United States empowered to grant injunctions to prevent the violation of the rights of authors and inventors, are hereby empowered to grant injunctions, in like manner, according to the principles of equity, to restrain such publication of any manuscript as aforesaid.

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

(a) An author, at common law, has a property in his manuscript, and may obtain redress against any one who deprives him of it, or by improperly obtaining a copy endeavors to realize a profit by its publication. *Wheaton v. Peters*, 8 Pet., 657.—McLEAN, J.; Sup. Ct., 1834.

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

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.

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

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.

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.

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

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

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

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

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

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.

But this section—and which is the only one—enabling a proprietor, who derives

 ACT OF 1831, CHAP. 16, §§ 11-16.

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

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

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

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

SECTION 15. *And be it further enacted*, That all and several the provisions of this act, intended for the protection and security of copyrights, and providing remedies, penalties, and forfeitures, in cases of violation thereof, shall be held and construed to extend to the benefit of the legal proprietor or proprietors of each and every copyright heretofore obtained, according to law, during the term thereof, in the same manner as if such copyright had been entered and secured according to the directions of this act.

SECTION 16. *And be it further enacted*, That, whenever a copyright has been heretofore obtained by an author or authors, inventor, designer, or engraver, of any book, map, chart, print, cut, or engraving, or by a proprietor of the same:

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

See also DIGEST, titles LETTERS; MANUSCRIPTS.

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

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

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

See also DIGEST, title PENALTIES, A.

ACT OF 1834, CHAP. 157.

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

Approved February 3d, 1831.

ACT OF 1834, CHAPTER 157.

(4 STAT. AT LARGE, 728.)

An Act supplementary to the Act to amend the several Acts respecting Copyrights.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America, in Congress assembled*, That all deeds or instruments in writing for the transfer or assignment of copyrights, (a) being proved or acknowledged in such manner as deeds for the conveyance of land are required by law

(a) 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.

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

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

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.

 ACT OF 1846, CHAP. 178.

to be proved or acknowledged in the same state or district, shall and may be recorded in the office where the original copyright is deposited and recorded; and every such deed or instrument that shall in any time hereafter be made and executed, and which shall not be proved or acknowledged and recorded as aforesaid, within sixty days after its execution, shall be judged fraudulent and void against any subsequent purchaser or mortgagee for valuable consideration without notice. (a)

SECTION 2. *And be it further enacted*, That the clerk of the district court shall be entitled to such fees for performing the services herein authorized and required, as he is entitled to for performing like services under existing laws of the United States.

Approved, June 30th, 1834.

ACT OF 1846, CHAPTER 178.

(9 STAT. AT LARGE, 106.)

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

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

Approved August 10, 1846.

Repealed by act of 1859, §6.

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

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

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

Where an assignment 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 it was valid under the statute. *Ibid.*, 400, 401.

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.

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.

ACT OF 1856, CHAPTER 169.

(11 STAT. AT LARGE, 138.)

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

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

Provided nevertheless, That nothing herein enacted shall impair any right to act, perform or represent a dramatic composition as aforesaid, which right may

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

(a) 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.

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

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

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.

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, next below.)

A legislative enactment securing generally to literary proprietors a copyright for a limited period, but containing no special provision as to theatrical representation, does not, in the case of a dramatic literary composition, include the sole right of

ACTS OF 1859, CHAP. 22; 1861, CHAP. 37.

have been acquired, or shall in future be acquired by any manager, actor or other person previous to the securing of the copyright for the said composition, or to restrict in any way the right of such author to process in equity in any court of the United States for the better and further enforcement of his rights.

Approved August 18th, 1856.

ACT OF 1859, CHAPTER 22.

(11 STAT. AT LARGE, 379.)

Extract from an Act passed February 5th, 1859, entitled, "An Act for keeping and distributing all Public Documents."

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

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

Approved, February 5th, 1859.

ACT OF 1861, CHAPTER 37.

(12 STAT. AT LARGE, 130.)

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

"Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That from all judgments and decrees

representing it. *Keene v. Wheatley*, 9 Amer. Law Reg., 44.—CADWALLADER, J.; Pa., 1860.

The only act which affords redress for unauthorized theatrical representations is the act of 18th August, 1856; but this only applies to cases in which copyright is effectually secured under the act of 1831. *Ibid.*, 46.

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

ACTS OF 1861, CHAP. 87; 1865, CHAP. 126; 1867, CHAP. 43.

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

Approved February 18th, 1861.

ACT OF 1865, CHAPTER 126.

(13 STAT. AT LARGE, 540.)

An Act supplemental to an Act entitled "An Act to amend the several Acts respecting copyrights," approved February third, eighteen hundred and thirty-one, and to the Acts in addition thereto and amendment thereof.

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

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

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

SECTION 4. *And be it further enacted,* That in the construction of this act, the word "book" shall be construed to mean every volume and part of a volume, together with all maps, prints, or other engravings belonging thereto; and shall include a copy of any second or subsequent edition which shall be published with any additions, whether the first edition of such book shall have been published before or after the passing of this act: *Provided, however,* That it shall not be requisite to deliver to the said library any copy of the second or any subsequent edition of any book, unless the same shall contain additions as aforesaid, nor of any book which is not the subject of copyright.

Approved March 3, 1865.

ACT OF 1867, CHAPTER 43.

(14 STAT. AT LARGE, 395.)

An Act amendatory of the several Acts respecting copyrights.

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

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

Approved February 18, 1867.

E X P I R E D
A C T S O F C O N G R E S S
I N R E S P E C T T O
P A T E N T S F O R I N V E N T I O N S.
1790 to 1874.

THE several acts of Congress, in respect to Patents, passed previous to 1836, are now obsolete, having all been repealed by that act, but they are inserted in full for the purpose of reference and comparison, when desired, with the acts now in force.

The notes of decisions, inserted under the obsolete acts, are such as have reference to the construction of such acts, or to some particular matter therein. Decisions of a general nature, though made under those acts, are inserted under the acts now in force, as assisting to a proper understanding and interpretation of them.

It is not intended, however, to repeat, under the several acts, all the decisions explanatory of them, but only those of a mere general character, adding suitable references to appropriate titles of the DIGEST. Nor has any effort been made to arrange the notes in strict chronological order.

A C T O F 1790, CHAPTER 7.

(1 STAT. AT LARGE, 109.)

An act to promote the progress of useful arts.

SECTION 1. *Be it enacted, by the Senate and House of Representatives of the United States of America, in Congress assembled,* That upon the petition of any person or persons to the Secretary of State, the Secretary for the department of war, and the Attorney-General of the United States, setting forth, that he, she, or they, hath or have invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used, and praying that a patent may be granted therefor, it shall and may be lawful to and for the said Secretary of State, the Secretary for the department of war, and the Attorney-General, or any two of them, if they shall deem the invention or discovery sufficiently useful and important, to cause letters patent to be made out in the name of the United States, (a) to bear teste by the President of the United

(a) 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.

ACT OF 1790, CHAP. 7, §§ 2, 3, 4.

States, reciting the allegations and suggestions of the said petition, and describing the said invention or discovery, clearly, truly, and fully, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns for any term not exceeding fourteen years, the sole and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery; which letters patent shall be delivered to the Attorney-General of the United States to be examined, who shall, within fifteen days next after the delivery to him, if he shall find the same conformable to this act, certify it to be so at the foot thereof, and present the letters patent so certified to the President, who shall cause the seal of the United States to be thereto affixed, and the same shall be good and available to the grantee or grantees by force of this act, to all and every intent and purpose herein contained, and shall be recorded in a book to be kept for that purpose in the office of the Secretary of State, and delivered to the patentee or his agent, and the delivery thereof shall be entered on the record and endorsed on the patent by the said Secretary at the time of granting the same.

SECTION 2. *And be it further enacted*, That the grantee or grantees of each patent shall, at the time of granting the same, deliver to the Secretary of State a specification in writing, containing a description, accompanied with drafts or models, and explanations and models (if the nature of the invention or discovery will admit of a model) of the thing or things, by him or them invented or discovered, and described as aforesaid, in the said patents; which specification shall be so particular, and said models so exact, as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman or other person skilled in the art or manufacture, whereof it is a branch, or wherewith it may be nearest connected, to make, construct, or use the same, to the end that the public may have the full benefit thereof, after the expiration of the patent term; (a) which specification shall be filed in the office of the said Secretary, and certified copies thereof shall be competent evidence in all courts and before all jurisdictions, where any matter or thing, touching or concerning such patent, right, or privilege, shall come in question.

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

SECTION 4. *And be it further enacted*, That if any person or persons shall devise, make, construct, use, employ, or vend, within these United States, any art, manufacture, engine, machine, or device, or any invention or improvement upon,

(a) As to how invention should be set forth or described, see DIGEST, titles COMPOSITION OF MATTER, B.; IMPROVEMENT, B.; SPECIFICATION, B.

(b) See DIGEST, title COPIES OF PAPERS, and also notes to act of 1836, § 4.

 CT OF 1790, CHAP. 7, §§ 5, 6.

or in any art, manufacture, engine, machine, or device, the sole and exclusive right of which shall be so as aforesaid granted by patent to any person or persons, by virtue and in pursuance of this act, without the consent of the patentee or patentees, their executors, administrators or assigns, first had and obtained in writing, every person so offending, shall forfeit and pay to the said patentee or patentees, his, her, or their executors, administrators or assigns, such damages as shall be assessed by a jury, and moreover shall forfeit to the person aggrieved the thing or things so devised, made, constructed, used, employed, or vended, contrary to the true intent of this act, which may be recovered in an action on the case founded on this act. (a)

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

SECTION 6. *And be it further enacted*, That in all actions to be brought by such patentee or patentees, his, her, or their executors, administrators, or assigns, for any penalty incurred by virtue of this act, the said patents or specifications shall be *prima facie* evidence, that the said patentee or patentees was or were the first and true inventor or inventors, discoverer or discoverers of the thing so specified, and that the same is truly specified; (c) but that nevertheless the defendant or defendants may plead the general issue, and give this act, and any special matter whereof notice in writing shall have been given to the plaintiff.

(a) See notes to act of 1793, § 5.

(b) See DIGEST, title COURTS, B. 3, and notes to act of 1793, § 10.

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

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 inven

ACT OF 1793, CHAP. 11, § 1.

or his attorney, thirty days before the trial, in evidence, tending to prove that the specification filed by the plaintiff does not contain the whole of the truth concerning his invention or discovery; (a) or that it contains more than is necessary to produce the effect described; and if the concealment of part, or the addition of more than is necessary, shall appear to have been intended to mislead, or shall actually mislead the public, so as the effect described cannot be produced by the means specified, then, and in such cases, the verdict and judgment shall be for the defendant.

SECTION 7. *And be it further enacted*, That such patentee as aforesaid, shall, before he receives his patent, pay the following fees to the several officers employed in making out and perfecting the same, to wit: For receiving and filing the petition, fifty cents; for filing specifications, per copy-sheet containing one hundred words, ten cents; for making out patent, two dollars; for affixing great seal, one dollar; for indorsing the day of delivering the same to the patentee, including all intermediate services, twenty cents.

Approved April 10th, 1790.

Repealed by act of 1793, § 12.

ACT OF 1793, CHAPTER 11.

(1 STAT. AT LARGE, 318.)

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

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

tion 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.

See also DIGEST, title PATENT, P. 2.

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

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

ACT OF 1793, CHAP. 11, § 1.

President of the United States, reciting the allegations and suggestions of the said petition, (a) and giving a short description of the said invention or discovery, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery, which letters patent shall be delivered to the Attorney-General of the United States, to be examined; who, within fifteen days after such delivery, if he finds the same conformable to this act, shall certify accordingly, at the foot thereof, and return the same to the Secretary of

This section of the act is to be construed with § 6 of the same act, and means that the first inventor has a right to a patent, though there may have been a knowledge of the thing invented before the *application* for a patent, if such use or knowledge was not anterior to the *discovery*. *Mellus v. Silsbee*, 4 Mas., 111.—STORY, J.; Mass., 1825. *Goodyear v. Matthews*, 1 Paine, 301.—LIVINGSTON, J.; Ct., 1814.

The true construction of the act of 1793, considering §§ 1 and 6 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.

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

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.

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. *Thompson v. Haight*, 1 U. S. Law Jour., 573.—VAN NEES, J.; N. Y., 1822.

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

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 inventor. *Shaw v. Cooper*, 7 Pet., 319.—MCLEAN, J.; Sup. Ct., 1833.

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

But the specification being filed at the same time and often on the same paper,

ACT OF 1793, CHAP. 11, §§ 2, 3.

State, who shall present the letters patent, thus certified, to be signed, and shall cause the seal of the United States to be thereto affixed: and the same shall be good and available to the grantee or grantees, by force of this act, and shall be recorded in a book, to be kept for that purpose, in the office of the Secretary of State, and delivered to the patentee or his order.

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

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

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.

(a) As to doctrine that the patentee of an improvement has no right to use the original discovery, nor the first inventor the right to use the improvement, see *Gray v. James*, Pet. C. C., 399.—WASHINGTON, J.; Pa., 1817; *Washburn v. Gould*, 3 Story, 150.—STORY, J.; Mass., 1844; *Woodworth v. Rogers*, 1 Wood. & Min., 141.—WOODBURY, J.; Mass., 1847; and generally DIGEST, title IMPROVEMENT, C.

(b) 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.

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.—CURRIE, J.; Sup. Ct., 1853.

See also DIGEST, titles FORM; IMPROVEMENT, A.

ACT OF 1793, CHAP. 11, §§ 4, 5.

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

SECTION 4. *And be it further enacted*, That it shall be lawful for any inventor, his executor or administrator, to assign the title and interest in the said invention, at any time, and the assignee having recorded the said assignment in the office of the Secretary of State, shall thereafter stand in the place of the original inventor, both as to right and responsibility, and so the assignees of assigns, to any degree. (c)

SECTION 5. *And be it further enacted*, That if any person shall make, devise,

(a) 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. *Brooks v. Bicknell*, 3 McLean, 261.—MCLEAN, J.; Ohio, 1843. *Washburn v. Gould*, 3 Story, 133.—STORY, J.; Mass., 1844.

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.—BERRIS, J.; N. Y., 1845.

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 the act requires, in the case of a machine, that the inventor shall explain the several modes in which he has contemplated the application of its principle. *Ryan v. Goodwin*, 3 Sumn., 521.—STORY, J.; Mass., 1839.

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

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

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

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.

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.

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

ACT OF 1793, CHAP. 11, §§ 5, 6.

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

SECTION 6. *Provided always, and be it further enacted,* That the defendant in such action shall be permitted to plead the general issue, and give this act, and any special matter, (c) of which notice in writing may have been given to the plaintiff or his attorney, thirty days before trial, in evidence, tending to prove, that the specification, filed by the plaintiff, does not contain the whole truth relative

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

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.

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

The patent act of 1790, § 4, made an infringer liable to pay such damages as the jury should find, and also forfeit the machine. The act of 1793, § 5, declared that an infringer should pay a sum equal to three times the price for which the patentee had sold licenses. The act of 1800, § 3, provided that an infringer should pay three times the actual damages sustained. *Scymour v. McCormick*, 16 How., 488.—GRIER, J.; Sup. Ct., 1853.

The patent act of 1836, § 14, confines the jury to the actual damages sustained by the patentee. The power to increase them, as punitive damages, is committed to the discretion and judgment of the court. *Ibid.*, 489.

(b) Under this section, it was held the assignee of a part of a patent could not maintain an action for a violation. *Tyler v. Tuel*, 6 Cra., 324.—CURIAM; Sup. Ct., 1810.

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

This section repealed by act of 1800, § 4.

(c) 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.

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

to his discovery, (a) or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made, for the purpose of deceiving the public, or that the thing, thus secured by patent, was not originally discovered by the patentee, but had been in use, (b) or had been described in some public work anterior to the supposed discovery of the patentee,

evidence matter which affects the patent. *Evans v. Eaton*, 3 Wheat., 503, 504.—MARSHALL, Ch. J.; Sup. Ct., 1818.

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

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

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

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

(b) Under this section a defect or concealment in a specification, in order to make the patent invalid, must appear to have been made for the purpose of deceiving the public. *Whitney v. Carter*, Fessenden on Pat., 2d ed., 139.—JOHNSON, J.; Geo., 1809. *Park v. Little*, 3 Wash., 198.—WASHINGTON, J.; Pa., 1813. *Whittemore v. Cutter*, 1 Gall., 437.—STORY, J.; Mass., 1813. *Gray v. James*, Pet. C. C., 401.—WASHINGTON, J.; Pa., 1817. *Lowell v. Lewis*, 1 Mas., 189.—STORY, J.; Mass., 1817.

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

The use of a machine, to test its value, as a cracker machine to the extent of half a barrel of flour, held to amount to a using of it within the meaning of this section. *Watson v. Bladen*, 4 Wash., 583.—WASHINGTON, J.; Pa., 1826.

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 3d. *Grant v. Raymond*, 6 Pet., 247.—MARSHALL, Ch. J.; Sup. Ct., 1832.

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

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.

Under this section, the Circuit Courts of the United States have exclusive jurisdiction in suits where the patent may be declared void. *Parsons v. Barnard*, 7 John.,

 ACT OF 1793, CHAP. 11, §§ 7-10.

or that he had surreptitiously obtained a patent for the discovery of another person; in either of which cases, judgment shall be rendered for the defendant, with costs, and the patent shall be declared void.

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

SECTION 8. *And be it further enacted*, That the persons, whose applications for patents, were, at the time of passing this act, depending before the Secretary of State, Secretary at War, and Attorney General, according to the act passed the second session of the first Congress, intituled "An act to promote the progress of useful arts," on complying with the conditions of this act, and paying the fees herein required, may pursue their respective claims to a patent under the same.

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

SECTION 10. *And be it further enacted*, That upon oath or affirmation being made before the judge of the District Court, where the patentee, his executors, administrators, or assigns reside, that any patent, which shall be issued in pursuance of this act, was obtained surreptitiously, or upon false suggestion, and motion made to the said court, within three years after issuing the said patent, but not afterwards, it shall and may be lawful for the judge of the said District

144.—CURIAM; N. Y., 1810. *Wilson v. Woodworth*, 8 Paige, 134.—WALWORTH, Chan.; N. Y., 1840.

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

(a) 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, when another person made application for a patent for the same invention; *Held*, that there was no limitation of time within which a patent must be taken out after specification filed, and that the facts made a case of interference, to be arbitrated under this section. *Anon.*, 5 Opin., 701.—RUSH, Atty. Gen.; 1814.

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 surreptitiously. *Stearnes v. Barrett*, 1 Mas., 174.—STORY, J.; Mass., 1816.

Court, if the matter alleged shall appear to him to be sufficient, to grant a rule, that the patentee, or his executor, administrator or assign show cause why process should not issue against him to repeal such patent. And if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued against such patentee, or his executors, administrators or assigns, with costs of suit. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent; and if the party, at whose complaint the process issued, shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in due course of law. (a)

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

(a) 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.

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

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

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; *Wood & Brundage, Ex parte*, 9 Wheat., 615.—STORY, J.; Sup. Ct., 1824; *Delano v. Scott*, Gilpin, 499.—HOPKINSON, J.; Pa., 1834. CONTRA, *McGaw v. Bryan*, 1 U. S. Law Jour., 98.—VAN NESS, J.; N. Y., 1822.

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

(b) 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.

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.

ACT OF 1794, CHAP. 58.

same, shall pay two dollars; of which payments, an account shall be rendered, annually, to the treasury of the United States, and they shall also pass to the account of clerk-hire in the office of the Secretary of State.

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

Approved February 21st, 1793.

Repealed by act of 1836, § 21.

ACT OF 1794, CHAPTER 58.

(1 STAT. AT LARGE, 393.)

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

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That all suits, actions, process and proceedings, heretofore had in any District Court of the United States, under an act passed the tenth day of April, in the year one thousand seven hundred and ninety, intituled "An Act to promote the progress of useful arts," which may have been set aside, suspended or abated, by reason of the repeal of the said act, may be restored, at the instance of the plaintiff or defendant, within one year from and after the passing of this act, in the said courts, to the same situation, in which they may have been, when they were so set aside, suspended or abated; and that the parties to the said suits, actions, process or proceedings, be, and are hereby entitled to proceed in such cases, as if no such repeal of the act aforesaid had taken place. *Provided always*, That before any order or proceeding, other than that for continuing the same suits, after the reinstating thereof, shall be entered or had, the defendant or plaintiff, as the case may be, against whom the same may have been reinstated, shall be brought into court by summons, attachment, or such other proceeding, as is used in other cases for compelling the appearance of a party.

Approved June 7th, 1794.

Repealed by Act of 1836, § 21.

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.

ACT OF 1800, CHAPTER 25.

(2 STAT. AT LARGE, 37.)

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

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That all and singular the rights and privileges given, intended or provided to citizens of the United States, respecting patents for new inventions, discoveries and improvements, by the act intituled "An Act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," shall be, and hereby are extended and given to all aliens who at the time of petitioning in the manner prescribed by the said act, shall have resided for two years within the United States, which privileges shall be obtained, used, and enjoyed, by such persons, in as full and ample manner, and under the same conditions, limitations and restrictions, as by the said act is provided and directed in the case of citizens of the United States. *Provided always,* That every person petitioning for a patent for any invention, art or discovery, pursuant to this act, shall make oath or affirmation before some person duly authorized to administer oaths before such patent shall be granted, that such invention, art or discovery hath not, to the best of his or her knowledge or belief, been known or used either in this or any foreign country, and that every patent which shall be obtained pursuant to this act, for any invention, art or discovery, which it shall afterward appear had been known or used previous to such application for a patent shall be utterly void (a).

SECTION 2. *And be it further enacted,* That where any person hath made, or shall have made, any new invention, discovery or improvement on account of

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

By the provisions of this act, taken in connection with those of the act of 1793, citizens and aliens are placed substantially upon the same ground as to a right to a patent when the invention has 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.

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

 ACT OF 1800, CHAP. 25, §§ 2, 3.

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

SECTION 3. *And be it further enacted,* That where any patent shall be, or shall have been granted pursuant to this or the above-mentioned act, and any person without the consent of the patentee, his or her executors, administrators or assigns first obtained in writing, shall make, devise, use, or sell (a) the thing whereof the exclusive right is secured to the said patentee by such patent, such person so offending shall forfeit and pay to the said patentee, his executors, administrators, or assigns, a sum equal to three times the actual damage (b) sustained by such patentee, his executors, administrators, or assigns, from or by reason of such offence, which sum shall and may be recovered by action (c) on the

(a) 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." 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.

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.

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.

(b) 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.

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.

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.

(c) This section gave jurisdiction only in actions *on the case*; *Held*, therefore, that a suit in equity, respecting a patent, in order to be cognizable by the Circuit Courts, must come within the provisions of the judiciary act of 1789, as to citizenship of parties, and that where the parties were all residents of the same state, such courts had

ACT OF 1819, CHAP. 19.

case founded on this and the above-mentioned act, in the circuit court of the United States, having jurisdiction thereof. (a)

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

Approved April 17th, 1800.

ACT OF 1819. CHAP. 19.

(3 STAT. AT LARGE, 481.)

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

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

Approved February 15th, 1819.

Repealed by act of 1836, § 21.

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, Chap. 19.

(d) Under this act, and the act of 1793, 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.

(a) This act removed the defect that existed under the act of 1800, by which the Circuit Courts did not have jurisdiction of suits in equity, except in actions on the case. *Livingston v. Van Ingen*, 1 Paine, 54 (note).—LIVINGSTON, J.; N. Y., 1811.

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

 ACT OF 1832, CHAP. 162, §§ 1, 2.

ACT OF 1832, CHAP. 162.

(4 STAT. AT LARGE, 559.)

An Act concerning patents for useful inventions.

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

SECTION 2. *And be it further enacted,* That application to Congress to prolong or renew the term of a patent, shall be made before its expiration, and shall be notified at least once a month, for three months before its presentation, in two newspapers printed in the city of Washington, and in one of the newspapers in which the laws of the United States shall be published in the state or territory in which the patentee shall reside. The petition shall set forth particularly the grounds of the application. It shall be verified by oath; the evidence in its support may be taken before any judge or justice of the peace; it shall be accompanied by a statement of the ascertained value of the discovery, invention, or improvement, and of the receipts and expenditures of the patentee, so as to exhibit the profit or loss arising therefrom. (a)

SECTION 3. *And be it further enacted,* That wherever any patent which has been heretofore, or shall be hereafter, granted to any inventor in pursuance of the act of Congress, entitled "An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," passed on the twenty-

of the same state. *Sullivan v. Redfield*, 1 Paine, 447, 448.—THOMPSON, J.; N. Y., 1825.

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.

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

(a) 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

 ACT OF 1832, CHAP. 162, § 3.

first day of February, in the year of our Lord, one thousand seven hundred and ninety-three, or of any of the acts supplementary thereto, shall be invalid or inoperative, by reason that any of the terms or conditions prescribed in the third section of the said first-mentioned act, have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, been complied with on the part of the said inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new patent to be granted to the said inventor for the same invention for the residue of the period then unexpired, for which the original patent was granted, upon his compliance with the terms and conditions prescribed in the said third section of the said act. And, in case of his death, or any assignment by him made of the same patent, the like right shall vest in his executors and administrators, or assignee or assignees: *Provided, however,* That such new patent, so granted, shall, in all respects, be liable to the same matters of objection and defence as any original patent granted under the said first-mentioned act. But no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be a free public use thereof, shall, in any manner, prejudice his right of recovery for any use or violation of his invention after the grant of such new patent as aforesaid. (a)

Approved July 3d, 1832.

Repealed by act of 1836, § 21.

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.

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.

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

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.

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

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

ACT OF 1832, CHAP. 203.

ACT OF 1832, CHAPTER 203.

(4 STAT. AT LARGE, 577.)

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

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the privileges granted to the aliens described in the first section of the act, to extend the privilege of obtaining patents for useful discoveries and inventions to certain persons therein mentioned, and to enlarge and define the penalties for violating the rights of patentees, approved April seventeenth, eighteen hundred, be extended, in like manner, to every alien, who, at the time of petitioning for a patent, shall be resident in the United States, and shall have declared his intention, according to law, to become a citizen thereof: *Provided,* That every patent granted by virtue of this act and the privileges thereto appertaining, shall cease and determine and become absolutely void without resort to any legal process to annul or cancel the same in case of a failure on the part of any patentee, for the space of one year from the issuing thereof, to introduce into public use in the United States the invention or improvement for which the patent shall be issued; or in case the same for any period of six months after such introduction shall not continue to be publicly used and applied in the United States, or in case of failure to become a citizen of the United States, agreeably to notice given at the earliest period within which he shall be entitled to become a citizen of the United States.

Approved July 13th, 1832.

Repealed by act of 1836, § 21.

ACT OF 1836, CHAPTER 357.

(5 STAT. AT LARGE, 117.)

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

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That there shall be estab-*

(a) POLICY OF THE PATENT LAWS.

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

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

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

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

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

ACT OF 1836, CHAP. 357, § 1.

lished and attached to the Department of State an office to be denominated the Patent Office, the chief officer of which shall be called the Commissioner of Patents, to be appointed by the President, by and with the advice and consent of the Senate, whose duty it shall be, under the direction of the Secretary of State, to superintend, execute, and perform all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions, and improvements, as are herein provided for, or shall hereafter be, by law, directed to be done and performed, and shall have the charge and cus-

The Constitution of the United States, in giving authority to Congress to grant patents for a limited period, declares the object to be to promote the progress of science and the useful arts, an object as truly national and meritorious, and well founded in public policy, as any which can possibly be within the scope of national protection. Hence it has always been the course of the American courts—and latterly of the English—to construe patents fairly and liberally, and not subject them to any overnice and critical refinements. *Ibid.*, 485.

Under the laws of the United States, patents for inventions are to be treated as a just reward to ingenious men, and as highly beneficial to the public. They are therefore clearly entitled to a liberal construction, since they are not granted as restrictions upon the rights of the community, but “to promote science and the useful arts.” *Blanchard v. Sprague*, 3 Sumn., 539, 540.—STORY, J.; Mass., 1839.

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

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.—WOOBURY, J.; Mass., 1845.

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

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

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.

 ACT OF 1836, CHAP. 357, § 2.

tody of all the books, records, papers, models, machines, and all other things belonging to said office. (a) And said Commissioner shall receive the same compensation (b) as is allowed by law to the Commissioner of the Indian Department, (c) and shall be entitled to send and receive letters and packages by mail, relating to the business of the office, free of postage.

SECTION 2. *And be it further enacted,* That there shall be, in said office, an inferior officer, to be appointed by the said principal officer, with the approval of the Secretary of State, to receive an annual salary of seventeen hundred dollars, (d) and to be called the Chief Clerk of the Patent Office; who, in all cases during the necessary absence of the Commissioner, or when the said principal office shall become vacant, shall have the charge and custody of the seal, and of the records, books, papers, machines, models, and all other things belonging to the said office, and shall perform the duties of Commissioner during such vacancy. (e) And the said Commissioner may also, with like approval, appoint an examining clerk, at an annual salary of fifteen hundred dollars; two other clerks, at twelve hundred dollars each, one of whom shall be a competent draughtsman; one other clerk, at one thousand dollars; a machinist at twelve hundred and fifty dollars; and a messenger, at seven hundred dollars. (f) And said Commissioner, clerks,

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.

See also DIGEST, titles PATENT, P. 1; STATUTES, B. 2.

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

(b) Salary fixed at \$4,500 by act of 1861, § 4.

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

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

(e) A patent is not invalid because it is certified by a person as "acting" Commissioner, instead of being certified by the Commissioner himself. *Wilson v. Rosseau*, 4 How., 663, 668.—NELSON, J.; Sup. Ct., 1845.

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

The appointment of an acting Commissioner will be presumed to have been duly made, where drawn in question, incidentally or collaterally, if it be shown that the person certifying is in the public discharge of those duties. *Woodworth v. Hall*, 1 Wood. & Min., 255.—WOODBURY, J.; Mass., 1846.

Under this section the chief clerk has been considered as the "acting Commissioner," whenever the Commissioner has been unable to discharge his duties from any necessary cause, as well as when a vacancy occurs from death or resignation. *S. C.*, 392.—WOODBURY, J.; Mass., 1846.

See also DIGEST, title COMMISSIONER OF PATENTS, G.

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

 ACT OF 1836, CHAP. 357, §§ 3, 4.

and every other person appointed and employed in said office, shall be disqualified and interdicted from acquiring or taking, except by inheritance, during the period for which they shall hold their appointments, respectively, any right or interest, directly or indirectly, in any patent for an invention or discovery which has been, or may hereafter be, granted.

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

SECTION 4. *And be it further enacted*, That the said Commissioner shall cause a seal to be made and provided for the said office, with such device as the President of the United States shall approve; and copies of any records, books, papers, or drawings, belonging to the said office, under the signature of the said Commissioner, or, when the office shall be vacant, under the signature of the Chief Clerk, with the said seal affixed, shall be competent evidence in all cases in which the original records, books, papers, or drawings could be evidence. (a) And any person making application therefor may have certified copies of the records, drawings, and other papers deposited in said office (b), on paying, for the

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

(a) 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.

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.

Certified copies of papers in the Patent Office are *prima facie* evidence of the genuineness of the original, on file, and absolute evidence of the correctness of the copies from the records. *Parker v. Haworth*, 4 McLean, 371.—McLEAN, J.; Ill., 1848.

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

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

(b) 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 in-

ACT OF 1836, CHAP. 357, § 5.

written copies, the sum of ten cents for every page of one hundred words; and for copies of drawings, the reasonable expense of making the same. (a)

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

sult is not a legal demand. *Boyden v. Burke*, 14 How., 583.—GRIER, J.; Sup. Ct., 1852.

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

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

See also DIGEST, title COPIES OF PAPERS.

(b) Now signed by the Secretary of the Interior.

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

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.

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

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

A patentee under this section is not obliged to claim the whole fourteen years. He may waive his claim to a part of the term, in favor of the public, by antedating it, or he may take a patent for a term less than fourteen years, or he may seek protection against strangers for six months previous to the issue, if in that time he has made application and is seeking in good faith and with reasonable diligence to perfect his specifications. *Cushman, Ex parte*. MS. (App. Cas.)—DUNLOP, J.; D. C., 1858.

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

It does not cover the products of the patented machine. *Ibid.*, 297. *Simpson v.*

ACT OF 1836, CHAP. 357, § 6.

SECTION 6. *And be it further enacted*, That any person or persons, having discovered or invented any new and useful art, (a) machine, (b) manufacture, or

Wilson, 4 How., 711.—NELSON, J.; Sup. Ct., 1845. *Goodyear v. The Railroads*, 2 Wall., Jr.—GRIER, J.; N. J., 1853.

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

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

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

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

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

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

As to what is embraced in the "letters patent," see DIGEST, title PATENT, E.

See also DIGEST, title PATENT, D. 1.

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

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

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

See also DIGEST, titles ART; PROCESS.

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

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

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

One may discover an improvement in a process, irrespective of any particular form of machinery; and another may invent a labor-saving machine, by which the

 ACT OF 1836, CHAP. 357, § 6.

composition of matter, (a) or any new and useful improvement (b) on any art, machine, manufacture, or composition of matter, not known or used by others (c) before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use or on sale, with his consent or allowance,

operation or process may be performed, and each may be entitled to a patent. *Ibid.*, 268.

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

See also DIGEST, title MACHINES, A.

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

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

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

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

It is no ground, for the rejection of an application for a patent for a composition of matter, that the thing invented is an imitation of a real existing substance or material—as an artificial honey. If the artificial is a good and wholesome substitute for the real, and can be made and supplied at a cheaper rate, there is no good reason why it should not be deemed a new and useful invention. *Corbin & Martlett, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

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

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

An improvement has essential reference to a subject matter to be improved. It is not an original, but embraces, and either adds to or alters, the original. *Page v. Ferry*, MS.—WILKINS, J.; Mich., 1857.

See also DIGEST, title IMPROVEMENTS.

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

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

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

ACT OF 1836, CHAP. 357, § 6.

as the inventor or discoverer; (a) and shall desire to obtain an exclusive property therein, may make application, in writing, to the Commissioner of Patents, expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor. But before any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; (b) and in case of any machine, he shall fully explain the principle and the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from

As to priority of invention, see also DIGEST, title INVENTION, C.; originality and priority of, and PRIOR KNOWLEDGE.

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

An invention resting in mere theory, or in intellectual notion, or imperfect experiments, and not reduced to practice, is not patentable. *Reed v. Cutter*, 1 Story, 599.—STORY, J.; Mass., 1841.

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

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

(b) 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.

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

The object of this provision 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 right. *Parker v. Stiles*, 5 McLean, 55.—LEAVITT, J.; Ohio, 1849. *Brooks v. Bicknell*, 3 McLean, 441.—MCLEAN, J.; Ohio, 1844. *Judson v. Moore*, MS.—LEAVITT, J.; Ohio, 1860.

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

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

See also DIGEST, titles COMPOSITION OF MATTER, B.; SPECIFICATION, B.; how invention should be set forth, IMPROVEMENT, B.

other inventions; (a) and shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery. (b) He shall, furthermore, accompany the whole with a drawing, or drawings (c) and written references, where the nature of the case admits of drawings, or with specimens of ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention or discovery is of a composition of matter; which descriptions and drawings, signed by the inventor and attested by two witnesses, shall be filed in the Patent Office; and he shall moreover furnish a model of his invention, in all cases which admit of a representation by model, of a convenient size to exhibit advantageously its several parts. (d) The applicant shall also make oath or affirmation (e) that he does verily believe that he is the original and first inventor or discoverer of the

(a) 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.

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

See also DIGEST, title MACHINES, B.

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

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

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

See also DIGEST, title PATENTS, P. 5.

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

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

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

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

See also DIGEST, title DRAWINGS; and act of 1837, § 6, and notes.

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

See also DIGEST, title MODELS.

(e) 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

ACT OF 1836, CHAP. 357, § 7.

art, machine, composition, or improvement, for which he solicits a patent, and that he does not know or believe that the same was ever before known or used; and also of what country he is a citizen; which oath or affirmation may be made before any person authorized by law to administer oaths. (a)

SECTION 7. *And be it further enacted*, That, on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make or cause to be made, an examination (b) of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, (c) if the

the statute it is no objection to the patent. *Whittemore v. Cutter*, 1 Gall., 433.—STORY, J.; Mass., 1813.

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

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

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

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

See also DIGEST, title OATH.

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

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

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

See also DIGEST, title APPLICATION FOR PATENT, A.

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

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.—TORCER, Atty. Gen.; 1848.

If the applicant is an original inventor, and in a condition to make the oath

ACT OF 1836, CHAP. 357, § 7.

Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. (a) But whenever, on such examination, it shall appear to the Commissioner that the applicant was not the original and first inventor or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented, or described in any

required, the act requires the Commissioner to issue the patent, and the courts declare it valid, and establish the American right to the exclusion of the foreign discovery, which has not, in either of the modes indicated by the act of Congress, been communicated to the public. *Ibid.* Also *Coleman v. Liesor*, MS.—LEAVITT, J.; Ohio, 1859. *Judson v. Cope*, MS.—LEAVITT, J.; Ohio, 1860.

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. *Parkurst v. Kinsman*, 1 Blatchf., 494.—NELSON, J.; N. Y., 1849. *Howe v. Underwood*, MS.—SPRAGUE, J.; Mass., 1854. *Allen v. Hunter*, 6 McLean, 321.—MCLEAN, J.; Ohio, 1855. *Poppenhausen v. N. Y. G. P. Comb Co.*, MS.—INGERSOLL, J.; N. Y., 1858. *Ellithorpe v. Robertson*, MS.—INGERSOLL, J.; N. Y., 1859.

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

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.*

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.*

See also DIGEST, titles PRIOR KNOWLEDGE; PRIOR USE.

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

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.

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

See also DIGEST, title APPLICATION FOR PATENTS, B.

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

The invention need not be the best for the use to which it can be applied. *Many v. Jagger*, 1 Blatchf., 381.—NELSON, J.; N. Y., 1848. *Roberts v. Ward*, 4 McLean,

ACT OF 1836, CHAP. 357, § 7.

printed publication in this or any foreign country, as aforesaid, or that the description is defective and insufficient, he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification to embrace only that part of the invention or discovery which is new. (a) In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars, part of the duty required by this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the Commissioner, shall be a sufficient warrant to the treasurer for paying back to the said applicant the said sum of twenty dollars. (b) But if the applicant in such case, shall persist in his claims for a patent, with or without any alteration of his specification, he shall be required to make oath or affirmation anew, (c) in manner as aforesaid. And if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners, (d) to be

566.—McLEAN, J.; Mich., 1849. *Wilbur v. Beecher*, 2 Blatchf., 137.—NELSON, J.; N. Y., 1850.

See also DIGEST, title INVENTION, D. 1.

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

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

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

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

See also DIGEST, title INVENTOR, B.; INVENTION, C.

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

(c) Right of withdrawal extended to foreigners by act of 1837, § 12.

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

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

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

(e) Board of Examiners abolished, and an appeal given to the chief-justice of the Circuit Court of the District of Columbia, by the act of 1839, § 11, and to either of the assistant justices of such court by act of 1852, § 1.

ACT OF 1836, CHAP. 357, §§ 7, 8.

composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, one of whom at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains; who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate in writing, of the opinion and decision of the Commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, (a) as well as to the Commissioner, of the time and place of their meeting, that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision; and it shall be the duty of the Commissioner to furnish to the board of examiners such information as he may possess relative to the matter under their consideration. And on an examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part, and their opinion being certified to the Commissioner, he shall be governed thereby in the further proceedings to be had on such application: *Provided, however,* That before a board shall be instituted in any such case, the applicant shall pay to the credit of the treasury, as provided in the ninth section of this act, the sum of twenty-five dollars, and each of said persons so appointed shall be entitled to receive for his services in each case a sum not exceeding ten dollars, to be determined and paid by the Commissioner out of any moneys in his hands, which shall be in full compensation to the persons who may be so appointed, for their examination and certificate as aforesaid.

SECTION 8. *And be it further enacted,* That whenever an application shall be made for a patent which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants, or patentees, as the case may be; (b) and if either shall be dissatisfied with the decision of the Commissioner

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

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

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

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

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

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

ACT OF 1836, CHAP. 357, § 8.

on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had, to determine which or whether either of the applicants is entitled to receive a patent as prayed for. (a) But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters patent therefor in a foreign country, and the same having been published, at any time within six months

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

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

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

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

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

See also DIGEST, title INTERFERENCE.

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

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

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.

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

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

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

 ACT OF 1836, CHAP, 357, §§ 9, 10.

next preceding the filing of his specification and drawings. (a) And whenever the applicant shall request it, the patent shall take date from the time of the filing of the specification and drawings, not however exceeding six months prior to the actual issuing of the patent; and on like request, and the payment of the duty herein required, by any applicant, his specification and drawings shall be filed in the secret archives of the office until he shall furnish the model and the patent be issued, not exceeding the term of one year, the applicant being entitled to notice of interfering applications.

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

SECTION 10. *And be it further enacted*, That where any person hath made, or shall have made, any new invention, discovery, or improvement, on account of which a patent might by virtue of this act be granted, and such person shall die before any patent shall be granted therefor, the right of applying for and obtain-

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

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

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

As to the requisites of the reasons of appeal, and the jurisdiction of the justices of the Circuit Court on appeal, and the effect of their decisions, see notes to § 11 of the act of 1839. See also DIGEST, title APPEALS, B.

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

(b) As to what officers' patent fees may now be paid, see § 15 of the act of 1846.

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

ACT OF 1836, CHAP. 357, §§ 11.

ing such patent shall devolve on the executor or administrator of such person, in trust for the heirs-at-law of the deceased, in case he shall have died intestate; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations, and restrictions as the same was held, or might have been claimed or enjoyed by such person in his or her lifetime; (a) and when application for a patent shall be made by such legal representatives, the oath or affirmation provided in the sixth section of this act shall be so varied as to be applicable to them.

SECTION 11. *And be it further enacted*, That every patent shall be assignable in law, either as to the whole interest, or any undivided part thereof, by any instrument in writing; which assignment, and also every grant and conveyance of the exclusive right under any patent, to make and use, and to grant to others to make and use (b) the thing patented within and throughout any specified part

(a) Under this section, if an inventor die before he has obtained a patent for his invention, no person other than his executor or administrator can apply for a patent for such invention, and the patent must be issued to such persons in trust for the heirs at law or devisees of the inventor. *Stimpson v. Rogers*, 3 or 4 Blatchf.—INGERSOLL, J.; Ct., 1859.

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.*

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

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.

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

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. *Rathbone v. Orr*, 5 McLean, 131, 132.—MCLEAN, J.; Mich., 1850. *Rich v. Lippincott*, 26 Jour. Fr. Inst., 3d Ser., 13.—GRIER, J.; Pa., 1853.

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

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

One tenant in common has as good right to use and sell to others to use, the thing