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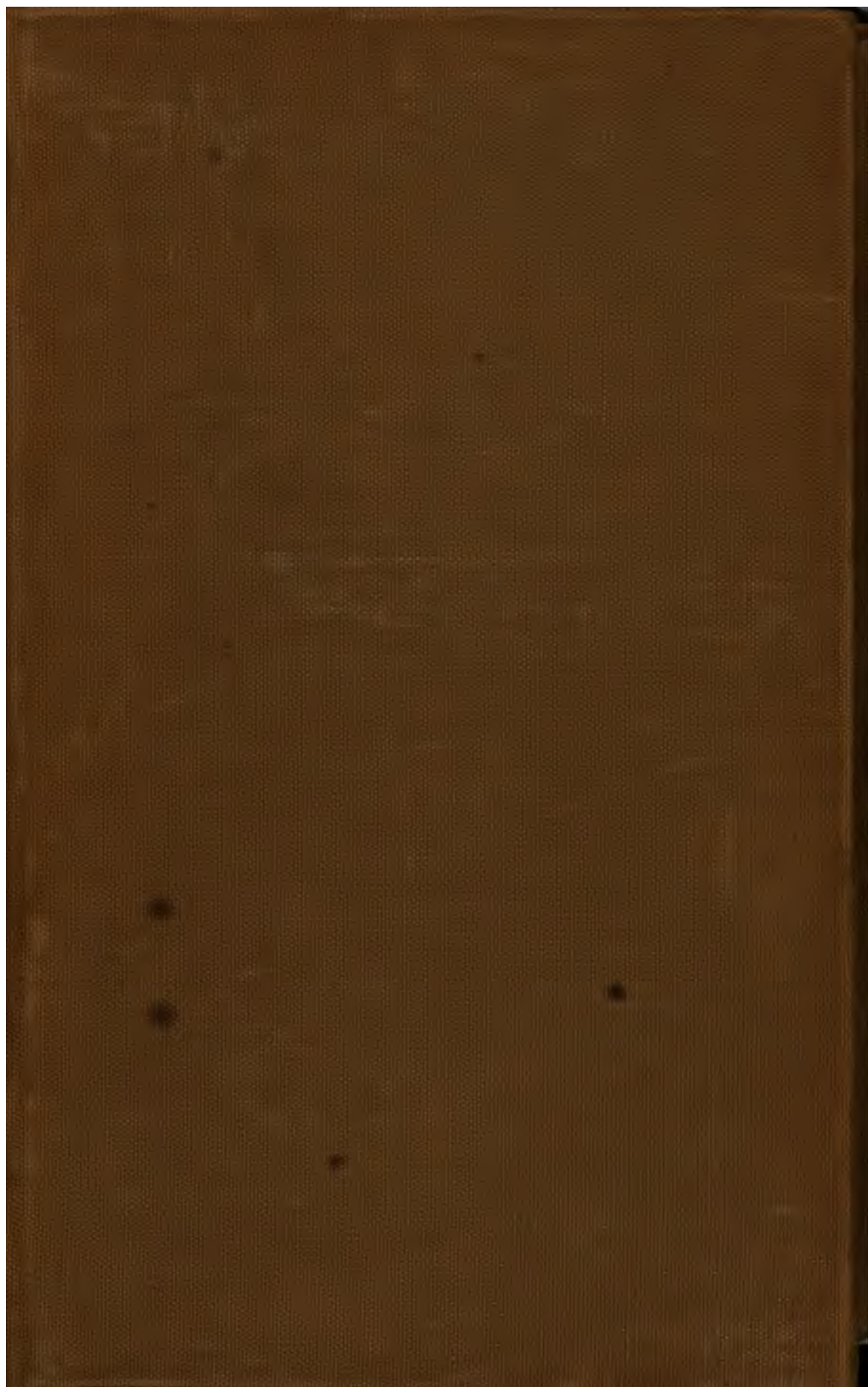
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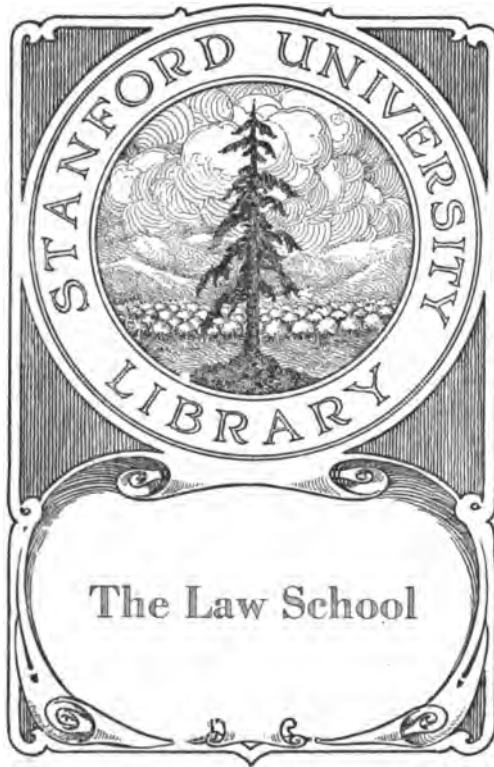
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A COLLECTION
OF
PATENT CASES,
DECIDED IN THE
SUPREME AND CIRCUIT COURTS
OF THE
UNITED STATES,

FROM THEIR ORGANIZATION TO THE YEAR 1850.

WITH
NOTES, AND A COPIOUS INDEX TO THE SUBJECT-MATTER.

BY JAMES B. ROBB,
COUNSELLOR AT LAW.

VOL. II.

BOSTON:
LITTLE, BROWN AND COMPANY.

M DCCC LIV.

Entered according to Act of Congress, in the year 1864, by LITTLE, BROWN
AND COMPANY, in the Clerk's Office of the District Court of the District of Massa-
chusetts.

323619

RIVERSIDE, CAMBRIDGE:
PRINTED BY H. O. HOUGHTON AND COMPANY.

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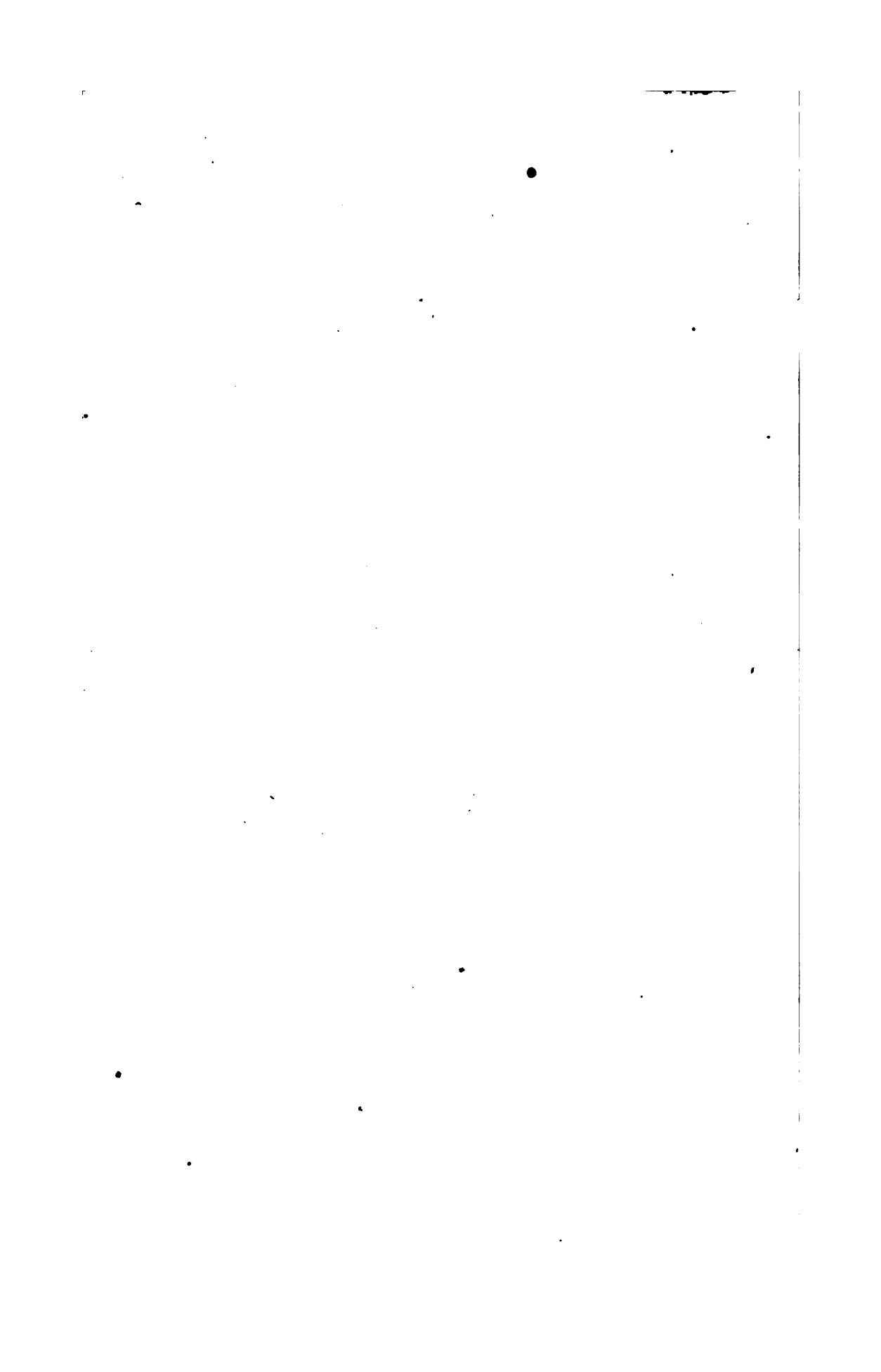
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A COLLECTION
OF
PATENT CASES
DECIDED IN THE
CIRCUIT AND SUPREME COURTS
OF
THE UNITED STATES.

HENRY STANLEY v. EMOR WHIPPLE.

[2 McLean, 35. December T. 1839.]

To entitle an individual to an exclusive right, under the Patent Law, his invention must be substantially different from any machine or thing in use.

A patent is void where, in his specifications, the patentee claims more than he has invented.

Under the Patent Law of 1836, a patent which contains corrected specifications, has relation back, and, for all legal purposes, covers the whole time, from the emanation of the first patent, which, for defective specifications, had been declared void.

In such case a contract to sell the right is made good by the second patent.

A patent to be valid, must be of some utility.

The books of a party are not evidence, unless made so by a call to produce them, &c.

A verdict will not be set aside where the evidence conflicts. It was for the jury to weigh the evidence. A declaration must contain a statement of facts, which, in law, gives the plaintiff a right to recover.

This is the question to be answered on a demurrer. But after verdict, defects, in substance, are cured, if, from the issue in the case, the facts omitted, or defectively stated, may fairly be presumed to have been proved on the trial.

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Where a contract binds the defendant to pay five dollars for each stove sold, as in this case, the special contract need not be declared on; the amount received may be recovered on the general count for money had and received.

MR. CHASE appeared for the plaintiff, and Messrs. *Storer* and *Eells* for the defendant.

OPINION OF THE COURT.

The defendant's counsel moved the Court for a new trial on the following grounds:—

[* 36] * First: That the verdict of the jury is against law and evidence;

Second: The damages given by the verdict are excessive;

Third: Because the Court erred in its instruction to the jury to exclude the evidence from the defendant's books;

Fourth: Because the Court erred in its instruction to the jury, that the second patent, if valid, had relation back to the time when the first patent was obtained.

The Court will consider the first and fourth grounds in connection.

The contract, on which this action is brought, is dated the 3d of October, 1832, in which Stanley agrees to sell to the defendant the right of making and vending a stove, for which he claims a patent, (which patent is not yet obtained,) in the city of Cincinnati, Ohio, &c., for which the defendant agrees to pay five dollars for each stove that he shall make and sell, &c.

The plaintiff, after proving the contract, and giving it in evidence, introduced his patent, dated the 28th November, 1836.

This patent is objected to, on the ground that its date is long subsequent to the date of the contract; and, it is contended, that it does not make good the right of the plaintiff

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from the time he originally applied for a patent and obtained one, which proved to be inoperative and void.

It appears the first patent of the plaintiff, for his invention, was obtained the 17th December, 1832; and which was declared to be void and inoperative by the Circuit Court of the United States, for the Southern District of New York, on the ground that the specifications claimed more than the patentee had invented. And, particularly, that he claimed, as his invention, a rotary top, &c., which was in use before he set up any right to it.

*The plaintiff, after this decision, obtained another patent, on different specifications, dated as above.

It is insisted that the specifications of the second patent are defective, and that the plaintiff cannot sustain an exclusive right under it.

The Court think that, on this ground, the second patent is not objectionable.

The specifications show clearly what parts of the stove the patentee claims to have invented; and the stove is so clearly described, in its structure, as to enable a person, possessing ordinary skill in the construction of stoves, to build one; and this is all the certainty which the law requires.

Under the thirteenth section of the Patent Law, passed the 4th July, 1836, the second patent has relation back to the emanation of the first patent, as fully for every legal purpose, as to causes subsequently accruing, as if the second patent had been issued at the date of the first one.

It is under this patent, then, that the right of the plaintiff must be examined.

In the defence it is strongly insisted, that the contract was made with a reference to the stove for which the first patent was obtained, and that the specifications used in the first patent, were supposed, by the defendant, to be the improve-

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ments of the plaintiff, and constituted the consideration of the contract ; and that, as these specifications were limited to the parts of the stove invented by the plaintiff, by reason of which the first patent was void, there was a failure of the consideration of the contract.

The contract was respecting "a stove for which the plaintiff claims a patent." There was no description of the constituent parts of the stove, or of the parts which the plaintiff claimed as his invention, in the contract.

[* 38] * Whatever remarks may have been made by either of the parties, while negotiating respecting the contract, it is very clear that such remark cannot be given in evidence. The contract was reduced to writing, and there is nothing ambiguous on its face ; the parties, therefore, cannot, by parol evidence, change, in any respect, the clear import of the written agreement.

The defendant, in his advertisements respecting the stove, calls it "Stanley's patent stove."

The second patent legalizes the rights of the patentee, from the date of the first patent ; and, if this effect be given to it, it must sustain the contract made in this case. Stanley having an exclusive right, could convey it in whole, or in part. And it must be immaterial to the defendant whether the right of the plaintiff was made good by the first patent, or, by relation, under the second patent.

It appears a stove was invented by Towns and Gould, in 1824, which had a rotary top, but it seems not to have had any of the improvements which the plaintiff claims to have invented in his second specifications. Nor is it proved that there was any stove in use, prior to that of the plaintiff's, with a rotary top, moved by a cog and pinion, and put in motion by a crank ; or which contained a combination of parts, or application of principles, similar to those in the plaintiff's second and corrected specifications.

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The lever applied on the top part of the stove, which several of the witnesses speak of, as an improvement on Stanley's invention, was subsequently applied, and was done to evade Stanley's patent, as some of the witnesses expressly state. If it was, in the language of the witnesses, an improvement upon Stanley's plan, of course, it must have been subsequent to it.

The jury were instructed that a mere formal difference can not be protected by a patent. That the difference must be *substantial; and that, if they shall find [* 39] that a stove was in use prior to the plaintiff's invention, substantially like his, he can claim no exclusive right under his patent.

There was, however, no such evidence before the jury; and, on this part of their verdict, there is no ground of complaint.

But, it is contended, that the invention must be shown to be of some utility; and that, in this respect, the plaintiff has failed.

It was wholly unnecessary for the plaintiff to introduce any evidence to prove that which the defendant so repeatedly and publicly admitted.

In his advertisement of his stove, he speaks of it as one of the most useful inventions; and that, in the parts of the country where it had been introduced, it had superseded all others. And, in addition to this, he states, that he has evidences of the great utility of the stove, from gentlemen of great respectability in our eastern cities; and he publishes the certificates of more than twenty citizens of respectability in Cincinnati to the same effect.

We are satisfied, therefore, that the verdict of the jury should not be set aside on any of the arguments urged, under the first and fourth grounds assigned.

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The ground that the Court erred in excluding the copy from the books, as evidence, will be next considered.

The counsel do not contend that the books are, in themselves, evidence; but they insist that the copy from them, attached to the deposition of the bookkeeper, which he swears is a true copy, is made evidence by the counsel of the plaintiff.

The counsel for the plaintiff did not call for the books, or ask a single question in regard to their contents. How, then, has he made the book evidence?

[* 40] * He admonished the bookkeeper, sometime before his deposition was taken, to be cautious in his statements, as there was some discrepancy in a deposition or depositions, which he had formerly given on the subject; and the counsel had advised him to refresh his memory by a reference to the books.

This does not make the books, or their contents, evidence in this cause; and, consequently, the Court, very properly, excluded the above copy from the jury.

The counsel insist that the damages are excessive, and that, on this ground, a new trial should be granted. The damages assessed by the jury, being fifteen thousand dollars, are large; and it is a subject of regret, that a less sum had not been found. But we must look into the evidence, and see whether the verdict is sustained by it.

The depositions of Snyder, Woodruff, and Roff, go the whole length of the verdict. And although the defendant's witnesses place a lower estimate on the number of stoves sold, yet they do not speak positively; and, if they did, it was the province of the jury to weigh the evidence. Where the evidence sustains the verdict, the Court cannot say that the jury should have given greater weight to other parts of the testimony, which would have limited the damages assessed to a less sum.

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This verdict, though large, we cannot say is against evidence, or, that it is not supported by the evidence; and the motion for a new trial is overruled.

A motion, in arrest of judgment, has also been made and argued; and the ground is, that the plaintiff does not aver in his declaration that he ever obtained a patent, or had an exclusive right to the stove, which was the subject-matter of the contract.

In the first count is stated, in the words of the agreement, that the plaintiff sold to the defendant the right of making and vending a stove, for which he claims a patent (which patent is * not yet obtained) in the city of [* 41] Cincinnati, &c., for which the defendant agreed to pay five dollars for each stove that he should make and sell.

The allegations in the second and third counts, are substantially the same. The fourth count is for money had and received. A declaration is a statement of facts, which, in law, gives the plaintiff a right to recover. And, if a demurrer had been filed in this case, the only question would have been, does the statement of facts, in this declaration, give the plaintiff, in law, a right to recover. And we will first consider the question as if raised by demurrer.

Suppose the plaintiff, on the trial, had, after proving the contract, introduced evidence that, at the time the contract was entered into, he did claim a patent-right for the stove, and had here closed his evidence. Could he have recovered? If he could not recover on this evidence, can the declaration be sustained? It is materially defective, if, to lay the foundation of a recovery, the proof must go farther than the allegations it contains.

This is, therefore, a safe and sure test of the goodness of the declaration.

The plaintiff, on the trial, did not stop, on showing that

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he claimed the patent-right. This was, in fact, shown by the contract itself. But he gave his patent in evidence, and proved that he not only claimed a patent, but that he had obtained one, which was the evidence of his exclusive right.

The declaration does not aver that a patent had been obtained, nor that the exclusive right was vested in him. And if he did not possess the exclusive right, there was no sufficient consideration to support the contract. It is an instrument not under seal, and does not, on its face, purport a consideration.

[* 42] *We think the declaration is defective in not containing the necessary averments; and if the question had been raised by general demurrer, the objection must have been fatal. But the point is brought to our consideration after verdict, on a motion in arrest of judgment; and it is important to inquire, whether the defect is cured by the verdict.

The statute of jeofaile cures all defects of form, but a verdict often cures matters of substance. This is done by a legal intendment after verdict. Mr. Chitty, 1 vol. Plead. 712, says, that where there is any defect, imperfection, or omission, in any pleading, whether in substance or form, which would have been a fatal objection upon demurrer, yet if the issue joined be such as necessarily required, on the trial, proof of the facts defectively, or imperfectly stated, or omitted, and without which it is not to be presumed that either the judge would direct the jury to give, or the jury would have given, the verdict, such defect, imperfection, or omission, is cured by the verdict. 1 Saund. 228, n. 1.

And again, he remarks, the expression, cured by verdict, signifies that the Court will, after a verdict, presume, or intend, that the particular thing which appears to be defectively, or imperfectly stated, or omitted, in the pleading, was duly

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proved at the trial. And such intendment must arise, not merely from the verdict, but from the united effect of the verdict, and the issue upon which such verdict was given. On the one hand, the particular thing which is presumed to have been proved, must always be such as can be implied from the allegations on the record, by fair and reasonable intendment.

In illustration of this rule several cases are referred to, and, among others, one from 2 Bing. 464. The plaintiff in an action of assumpsit stated, that he had retained the defendant, (who was an attorney,) to lay out seven hundred pounds in the purchase of an annuity, and that the defendant promised * to lay it out securely ; that the plaintiff [* 43] delivered the money to the defendant accordingly, but that the defendant laid it out on a bad and insufficient security. After verdict, it was objected, on a writ of error, that no consideration appeared in the declaration ; that it was not averred that the promise was in consideration of the retainer, nor that the retainer was for reward ; but the Court held that it was absolutely necessary, under the declaration, that the plaintiff should have proved, at the trial, that he had actually delivered the money to the defendant, and that the latter had engaged to lay it out ; that the delivery of the money, for this purpose, was a sufficient consideration to support the promise ; and that, although it was not expressly alleged in the declaration, was, in fact, the consideration for the promise, the Court would intend, after verdict, that such was the consideration.

And so in the case under consideration. The declaration does not aver that the plaintiff had obtained a patent, or that the exclusive right was vested in him ; but he states that he claimed a patent, and that the defendant possessed and enjoyed the right under the contract ; and from these statements, and the issue that was made up, the Court must presume

Stone v. Sprague. 1 Story.

that, on the trial, the exclusive right was proved to be in the plaintiff. The plaintiff's title was defectively set out, and, in such cases, after verdict, the Court will presume that the facts showing the right were proved on the trial. This intendment, we think, is fairly presumed from the allegations on the record.

As, in our opinion, the defect in the declaration is cured by the verdict, it is unnecessary to say any thing on the general count for money had and received. To recover, under that count, it is necessary to show that money has been received; but a jury might well infer the receipt of the money from the fact of the sale of the stoves. And, although the [* 44] contract was *special, yet, if it appear to be executed, and not open and subsisting, it is a well-settled principle that the plaintiff may recover on the general count, for money had and received.

If the action be brought for a breach of the contract, and it has not been put an end to, by the act of the party, the remedy is on the contract, and not on the general count. In this case the plaintiff claims a right to recover only five dollars for each stove which the defendant has made and sold. He, therefore, goes for the money received, and not for damages for any other violation of the contract.

The motion in arrest of judgment is overruled.

AMASA STONE v. WILLIAM AND AMASA SPRAGUE.

[1 Story, 270. June T. 1840.]

Where a patent for an improvement on looms set forth, as the invention claimed, "The communication of motion from the reed to the yarn beam, in the connection of the one with the other, which is produced as follows," de-

Stone v. Sprague. 1 Story.

scribing the mode; it was held, that the invention was limited to the specific machinery and mode of communicating the motion, &c., specially described in the specification. If it were otherwise construed, as including *all* modes of communicating the motion, &c., it would be utterly void, as being an attempt to patent an abstract principle, or for all possible and practicable modes of communicating motion whatsoever, though invented by others, and substantially different from the mode stated in the patent.

CASE for an infringement of a patent-right for a new and useful improvement on looms, not known or used before, Plea, not guilty, with notice of special defence. At the trial it appeared, that the patent was dated on the 30th of April, 1829, and the specification was as follows. "Be it known that I, Amasa Stone, of, &c., have invented a new and useful improvement in looms, not known or used before my discovery, which consists in the communication of motion from the reed to the yarn beam, and in the connection of the one with the * other, which is produced and [* 271] described as follows." Then follows a minute description of the particular machinery. The specification then concluded as follows, after setting forth the advantages of the invention: "I claim as my invention the connection of the reed with the yarn beam, and the communication of the motion from the one to the other, *which may be done as above specified.*"

Several points were made at the trial, upon which a good deal of evidence was offered. The defendants contended, (1.) That the invention was known before. (2.) That the loom used by them was not identical with the invention and machinery used by the plaintiff; but was a substantially different invention. (3.) That the patent was in fact a patent for an abstract principle, or all modes by which motion could be communicated from the reed to the yarn beam, and the connection of the one with the other, and not merely for the particular mode of communication specified in the machinery

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described in the specification ; and that it was therefore void. On the other hand the plaintiff contended, (1.) That he was the first and original inventor. (2.) That the machines used by the defendants were substantially the same invention as his, and an infringement of it. (3.) That the patent, if it embraced all modes of communication of motion from the reed to the yarn beam, and in the connection of the one to the other, (as the plaintiff insisted it did,) was still good and maintainable in point of law. (4.) That if the specification did not justify this interpretation of the plaintiff's claim, it was still good, and clearly supported the claim to the particular machinery described in the specification, which the defendants had patented, and his patent had been infringed by the defendants.

The case was argued by *Atwell* and *Staples*, of New York, for the plaintiff, and by *Pratt* and *R. W. Greene*, [*272] for the *defendants; and finally, the parties consented to a verdict for the defendants, upon the points of law ruled by the Court, and took a bill of exceptions thereto.

STORY, J. Upon the question of the true interpretation of the specification, the Court entertains some doubt. But, on the whole, *ut res valeat, quam pereat*, we decide, that, although the language is not without some ambiguity, the true interpretation of it is, that the patentee limits his invention to the specific machinery and mode of communication of the motion from the reed to the yarn beam, set forth and specially described in the specification. We hold this opinion the more readily, because we are of opinion that, if it be construed to include all other modes of communication of motion from the reed to the yarn beam, and for the con-

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nection of the one to the other generally, it is utterly void, as being an attempt to maintain a patent for an abstract principle, or for all possible and probable modes whatsoever of such communication, although they may be invented by others, and substantially differ from the mode described by the plaintiff in his specification. A man might just as well claim a title to all possible or practicable modes of communicating motion from a steam-engine to a steamboat, although he had invented but one mode; or, indeed, of communicating motion from any one thing to all or any other things, simply because he had invented one mode of communicating motion from one machine to another in a particular case. This is our decided opinion; and if the counsel are dissatisfied, it will be easy to take the case by a bill of exceptions to the Supreme Court.

Verdict for defendants; and a bill of exceptions was taken by the plaintiff accordingly.

JESSE C. SMITH v. JOHN PEARCE AND H. PEARCE.

[2 McLean, 176. July T. 1840.]

Where the specifications of a patent are defective, under the late Act of Congress, a new patent may be obtained with corrected specifications, which relates back to the date of the original patent.

A patent for an improvement in a machine, which had been previously patented to another person, cannot protect the right of the patentee, unless the improvement be substantially different in principle from the original invention.

An alteration merely formal, or a slight improvement, will give no right.

The jury will determine, from the models exhibited, and the other evidence, whether there is a difference in principle between the two machines. That

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is called principle in a machine which applies, modifies, or combines mechanical powers to produce a certain result.

THIS cause was argued by *Mr. Fox* for the plaintiff, and by *Mr. Green*, for the defendants.

OPINION OF THE COURT.

This action is brought for the infringement of a patent-right, by the defendants, claimed by the plaintiff.

The plaintiff's patent is dated 25th September, 1837, and, under the late Act of Congress, relates back to the 9th of January, 1830, the date of his first patent, for the same invention, which was invalid by reason of a defective specification.

[* 177] * In the specification, or schedule, the plaintiff claimed to have invented a "new improved mode of grinding, holding, and accommodating millstones," for grinding grain, &c.

"The nature of the invention consists in the peculiar construction of the husk or frame, to be used for the purpose of accommodating and securing millstones for grinding grain into meal or flour, or any other business calculated to be done under the operation of grinding. The husk or frame is made of iron, compact and firmly secured together by bolts. The mills are calculated to be transported with safety, all finished in a perfect and workmanlike manner ready for grinding. They are to be put in motion either by straps or cog-gearing, whichever the purchaser shall choose." A drawing with a particular description accompanied the application for a patent.

The defendants pleaded not guilty, and gave in evidence a patent to Henry Pearce, one of the defendants, for an improvement upon the plaintiff's patent. In the specification the improvement is stated to "consist in the manner in which the patentee constructs the part which he denominates the

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pressure rod, which is intended to elevate the bridgetree, and, consequently the running stone, and to regulate the action of the mill in that particular part." This specification was, also, accompanied by a drawing.

Several machinists, and other witnesses, testified that the invention of the plaintiff was of great utility. That each run of stones would make thirteen barrels of flour in twenty-four hours, and that the flour is of a better quality than that which is manufactured in the ordinary way, and sells higher. That a steam-engine of fourteen horse-power, which will consume a small amount of fuel, will be sufficient to turn five pairs of stone.

* The plaintiff, also, proved that for some years [* 178] the defendants had been engaged in making mills on the same principle at the plaintiff's patent, for sale ; and that he had sent great numbers of them to Mississippi and Louisiana ; also, some evidence as to the profit on the mills thus constructed and sold.

The principal question in the case is, whether Pearce's improvement on the plaintiff's patent is such as protects him in the right which he has exercised.

That part of the plaintiff's patent which he claims to be new, and of his own invention, is "connecting the bridgetree with the top part of the frame, or whatever may be used as a substitute, in the manner herein described, or any other manner, embracing the same principles and producing the same effect. And the mode or manner of depressing, as well as elevating, the running stone by application of the screw to the bridgetree, in the manner here described, or any other producing the same effect."

A slight alteration in the structure of a machine, or in the improvement of it, will not entitle an individual to a patent. There must be a substantial difference in the principle, and the application of it, to constitute such an improvement as the law will protect.

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The principle here spoken of is not a new mechanical power. For centuries no new power in mechanics has been discovered. But the powers known have been so modified and combined as to produce results the most extraordinary. Results which have distinguished the present age. The principle consists in the mode of applying or combining mechanical powers which produce a certain result. The law which secures to the inventor the exclusive benefit of disposing of his invention, for a term of years, is founded upon considerations of sound policy. And the right, thus secured, [* 179] is not to * be destroyed by open infraction, or a mere colorable improvement.

The jury are to judge by an inspection of the models and from the evidence, whether the two machines differ in principle.

Nothing is more common than for persons skilled in the structure of machines, to disagree in regard to the principles of them. As it respects their form there can be but little difference of opinion among those who examine the machines. In this case machinists, who have been sworn as witnesses, do not agree, but the greater number seem to think that there is no substantial difference, in principle, between the two structures.

In their form the machines are alike. Indeed, it would seem to require a nice observer to point out the difference.

The principle of elevating and lowering the upper stone seems to be that which is new, and which gives value to the machine. And it will be for the jury to say, whether the rod with screws at both ends of it, by which the bridgetree, and, consequently, the upper stone is elevated or lowered, is not in principle the same; whether it rests by a shoulder on the middle or lower part of the frame, or whether, in fact, there be one rod or two.

The main question is, whether the principle, by which the

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upper stone is elevated and lowered, is substantially the same in both machines. If this be the case, your verdict must be for the plaintiff, with such damages as you shall think him entitled to. There are some cases of violation of patent-rights more aggravated than others. And the Court would remark to the jury, that, in the present case, there do not seem to be any circumstances which should much, if any, increase the damages beyond what may be supposed the reasonable profit of the defendants in manufacturing and selling the machine in question. The defendants may have supposed they were *protected under their patent. But if [* 180] the jury shall think, on a full view of the case, that there is not a mere formal difference, but a substantial one, in the principles of the machines, they will find for the defendants. 4 Wash. C. C. 706; Phil. on Patents, 372; 2 Brock. 310; 3 Wash. C. C. Rep. 449; 3 Car. and Payne, 502; 1 Peters, C. C. Rep. 342, 398, 399; 1 Gall. 429.

The jury found for the plaintiff, and assessed his damages at \$2,150, on which judgment was entered.

CYRUS ALDEN AND OTHERS v. TIMOTHY M. DEWEY AND ANOTHER.

[1 Story, 336. October T. 1840.]

In an action for an infringement of a patent-right, evidence that the invention of the defendant is better than that of the plaintiff, is improper, except to show a substantial difference between the two inventions.

Where the defendant offered evidence to show that the invention was not original with the plaintiff, but that the improvement, for which he had taken out letters-patent, had been suggested to him, although the precise mode of carrying it into operation had not been suggested, the Court instructed the jury, that the true question was, whether the improvement was *substantially* communicated to the plaintiff, so that *without more inventive power*, he could have applied it, or not.

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In considering the question of the originality of an invention, the oath of the inventor made prior to the issue of the letters-patent, that he was the true and first inventor of the improvement, may be opposed to the oath of a witness in the case, whose testimony is offered to show, that the invention was not original.

THIS was an action for an infringement of a patent-right for an improvement in scythe snathes. The original patentee was Dexter Peirce, who took out letters-patent, March 11th, 1837. He afterwards assigned his right and interest under these letters-patent to several persons, who again assigned to the plaintiffs in the present case. The special improvement, which formed the subject-matter of the present suit, was described in the claim as follows: "What I claim as my own invention, and not previously known, and desire to secure by letters-patent, is my constructing the nib or thole irons and woods, so as by the extension of the iron beyond the wood, with a screw and nut to regulate and fasten the nibs or tholes in any situation desirable on the snead."

Before the patent of Peirce, the nibs of scythes had been clumsily fastened to the snathe by means of an iron [* 337] ring, *tightened by wedges. These wedges were easily loosened by the use of the scythe. The defendants manufactured and sold a large number of nibs, which were secured to the snathe by a ring at the end of an iron stem. This stem passed through the wood of the nib, was threaded at the top, and fitted into a nut, which was adjusted in the end of the wood. The wood moved in a brass cellar, which was at the bottom, and being turned by the hand, operated as a wrench upon the nut, and was pressed upon the scythe snathe; and in this way the nib was secured and regulated in any situation desirable on the snead. The nib used by the defendants, is usually known as Clapp's method or improvement. It was contended, by the plaintiffs' counsel, that this was substantially the same with the improvement of the plaintiffs. Several witnesses were exam-

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ined, as experts, who testified, that the two differed in certain particulars and details, but that they were the same in principle.

For the defence it was urged, that the plaintiffs could not have an exclusive right to the use of the screw for purposes of fastening. But it was answered, that the claim was not for this element, but simply for a combination, into which it entered; and this view was sustained by the Court. It was also urged, that the two nibs were unlike; and that the nib of the defendants was not an infringement of the right of the plaintiffs. No witnesses were called to this point by the defendants. Evidence was given to show, that the nib of the defendants was better than that of the plaintiffs, and that it found a readier market. But the Court instructed the jury to disregard this consideration, except so far as it went to show a substantial difference between the two nibs. It was no matter if the defendants' nib was more polished, or even worked better than the plaintiffs', provided it embodied the principle of the plaintiffs'. It did not follow, because the defendants *improved the machine of the [* 338] plaintiffs, that therefore, they could use it.

Another defence was set up, which received particular attention from the Court. Daniel Draper testified, that, in conversation with Dexter Peirce, the patentee, sometime at the end of the winter, or beginning of the spring of 1835, he remarked, that he found great difficulty in suiting his customers, in respect to the nibs of scythe snathes; and that he thought they might be improved by the application of the nut and screw to the nib or thole. He did not suggest any mode of doing this. He never reduced his idea to practice. The witness said, that Peirce treated the idea as impracticable, and laughed at it. It appeared on cross-examination, that the witness had been, in the early part of his life, a tanner, and then went into the patent wood-ware business, in which

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he continued till January 1, 1835, when he formed a copartnership with another person for the manufacture of hammers and scythe snathes; but that he did not continue to make snathes more than six months. The witness knew that Peirce took out a patent, in March, 1837, for his improvement in the scythe snathe, and that he had assigned the same for a valuable consideration; but he never spoke to him on the subject, or reminded him of the suggestion he had made, though he was in the habit of seeing him from time to time.

Fletcher and Charles Sumner, for the plaintiffs. *B. Rand and B. R. Curtis*, for the defendants.

STORY, J., on these facts, submitted to the jury this question: Did Draper communicate to Peirce substantially the improvement, for which he took out his patent, so that without more inventive power, Peirce could have applied it? It was not enough that Draper gave a hint; nor, on the other hand was it necessary, that he should communicate [*339] every *minute thing about the invention; but he must have communicated the substance. He further instructed the jury, that the original patentee had sworn that he was the true and first inventor of the improvement, for which he had taken out letters-patent; that this oath was required by law, prior to the issue of the letters-patent; so that, supposing the jury should be of opinion that the asserted communication of Draper covered the substance of Peirce's invention, then there would be oath against oath. If they should be of opinion that Draper simply gave a hint, which Peirce afterwards reduced to practice, then the two oaths would not conflict. If Peirce swore falsely that he was the first and true inventor, then he was liable to indictment for perjury. The testimony of Draper with regard to Peirce was in the nature of confessions, and this was always regarded as

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an uncertain kind of evidence. The conversation was in private, and nobody could contradict the witness. The judge stated, that this was the first time, within his long experience on the bench, that such a conversation had been set up as a ground for destroying the title of a patentee to his invention.

The judge further instructed the jury, that it was not necessary that the two nibs should be identical, in order to make one an infringement of the other. The true question was, Are the means used substantially the same, although not in every minute particular? With regard to damages, the jury were told not to give extravagant or vindictive damages; but such as would establish the right of the plaintiffs, and indemnify them against all the expenses of litigating their right. If the defendants were sued a second time for violating the right of the plaintiffs, then it might be proper to give vindictive damages. The jury thereupon found a verdict for the plaintiffs, for \$1,167.66.

* At a subsequent day of the term, (December [* 340] 21,) the case came on again, on a motion for a new trial. The motion was grounded upon the following reasons. (1.) That the judge ruled in the course of the trial, that one Peirce, who was offered as a witness, was interested and could not be examined as a witness. (2.) That the judge further ruled, that an affidavit made by the said Peirce, before he took out his patent and in order to obtain the same, was evidence in the cause, although it appeared that the said Peirce was interested at the time he made the said affidavit. (3.) That the judge instructed the jury that they were to take into consideration the said oath of Peirce, and that only one witness having sworn that he communicated to Peirce the substance of the invention, and Peirce having sworn by his said affidavit that he believed himself to be the original

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inventor, the jury had oath against oath, and that the jury must decide whether the solemn oath of Peirce had been thus overcome by the testimony of one witness. (4.) That the damages assessed by the jury were excessive.

B. R. Curtis urged, in support of the first three grounds of the motion, that the ruling of the Court was inconsistent with the general principles of the law of evidence; that it conflicted with the rule, requiring an opportunity to cross-examine a witness; also with the other rule, excluding the testimony of an interested witness. In support of his views, he cited the English cases in actions on the case for a malicious suit. He also relied upon the proceedings of courts of justice under the registry laws and bankrupt laws. He further urged that the statute, requiring the oath of the patentee, was intended to secure the public against fraud. But that if the construction of the Court was to prevail, it would operate as a security to the patentee, and would be, not a shield to the public, but a sword against it. He also urged in [* 341] support of *the last ground of the motion for a new trial that the damages were excessive.

STORY, J., without hearing the other side, ruled, as at the trial that the patent was *prima facie* evidence in the case; that the patent recited the oath, and that the jury had cognizance of it; in short, that the oath was in the case, and the jury were entitled to judge of its force. This was the foundation of the *onus probandi*, that was thrown upon the defendants in a patent cause. The Courts of the United States had constantly acted upon this view. With regard to the question of damages, the judge confessed that the damages awarded by the jury were greater than were anticipated. But still there did not seem to be any such gross mistake in the jury as would authorize setting aside their verdict. It was a matter submitted to their fair judgment.

Judgment according to the verdict.

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NATHANIEL J. WYETH AND FREDERICK TUDOR v. STONE
AND OTHERS.

[1 Story, 273. October T. 1840.]

In a bill in equity for a perpetual injunction of the defendants, on account of an asserted violation of a patent-right for an invention, it is a good defence that, prior to the granting of the patent, the inventor had allowed the invention to go into public use, without objection. But it should be clearly established by proof, that such public use was with the knowledge and consent of the inventor. The mere user by the inventor of his invention, in trying experiments, or by his neighbors, with his consent, as an act of kindness for temporary and occasional purposes only, will not destroy his right to a patent therefor.

If the defendants use a substantial part of the invention patented, although with some modifications of form or apparatus, it is a violation of the patent-right. So, if the patent be of two machines, and each is a new invention, and the defendant use only one of the machines.

If the patentee, after obtaining his patent, dedicates or surrenders it to public use, or acquiesces for a long period in the public use thereof, without objection, he is not entitled to the aid of a court of equity to protect his patent; and such acquiescence may amount to complete proof of a dedication or surrender thereof to the public.

* But to entitle the defendants to the benefit of such a defence, [* 274] the facts must be explicitly relied on, and put in issue by their answer; otherwise the Court cannot notice it.

In the present case, the patent and specification claimed for the patentee, as his invention, the cutting of ice of a uniform size by means of an apparatus worked by any other power than human. It claimed, also, not only the invention of this art but also the particular method of the application of the principle stated in the specification, which was by two machines described therein, called the saw and the cutter. It was held by the Court, that the specification, so far as it claimed the art of cutting ice by means of an apparatus worked by any other power than human, was the claim of an abstract principle, and void; but so far as it claimed the two machines described in the specification, it might be good, if a disclaimer were made of the other parts, according to the Patent Act of 1837, ch. 45, § 7 and § 9, within a reasonable time, and before the suit were brought. But a disclaimer, after the suit brought, would not be sufficient to entitle the party to a perpetual injunction in equity, whatever might be his right to maintain a suit at law on the patent.

If the patentee has assigned his patent in part, and a joint suit is brought in

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equity for a perpetual injunction, a disclaimer by the patentee alone, without the assignee's uniting in it, will not entitle the parties to the benefit of the 7th and 9th sections of the Act of 1837, ch. 45.

A single patent may be taken for several improvements on one and the same machine, or for two machines, which are invented by the patentee, and conduce to the same common purpose and object, although they are each capable of a distinct use and application, without being united together. But a single patent cannot be taken for two distinct machines, not conducting to the same common purpose or object, but designed for totally different and independent objects.

An inventor is bound to describe in his specification, in what his invention consists, and what his particular claim is. But he is not bound to any precise form of words, provided their import can be clearly ascertained by fair interpretation, even though the expression may be inaccurate.

The assignee of a patent-right, in part or in whole, cannot maintain any suit at law, or in equity, either as sole or as a joint plaintiff thereon, at least as against third persons, until his patent has been recorded in the proper department, according to the requisitions of the Patent Acts.

BILL in equity for a perpetual injunction, and for other relief, founded upon allegations of the violation, by the defendants, of a patent-right granted originally to the plaintiff, Wyeth, as the inventor, by letters-patent, dated the 18th of March, A. D. 1829, "for a new and useful improvement in the manner of cutting ice, together with the ma-
[* 275] chinery and * apparatus therefor," as set forth in the schedule to the letters-patent; and afterwards with a small reservation assigned to the other plaintiff, Tudor, on the 9th of February, 1832, by a deed of assignment of that date, but which had never been recorded. The schedule set forth two different apparatuses or machines for cutting ice, the one called the saw, the other the cutter, which are capable of being used separately or in combination, and described in their structure, and the mode of applying them, as follows:

(1.) Two bars of iron, or other material, secured to each other by cross bars: the two first mentioned to be of such distance apart as the dimension of the ice is required to be.

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(2.) On each outside bar is bolted a plate of iron as long as the bar, and at right angles with the cross bars. These plates to be so bolted to the bars as to project three inches each on one side of the bars to which they are bolted, and one of them to project on the other side of the bar two inches; the other, one inch. These projections may be varied, according to the desired depth of the cut. (3.) These plates, both on the upper side and on the under side of the bars, are to be cut at four equidistant points each, at an angle of forty-five degrees, or thereabouts, to the bar, thereby forming a cutting point of forty-five degrees, or thereabouts; to this point is welded a piece of steel, to form the chisel. The rear end of the plates to be of the before specified width from the bar, but to diminish towards the front end one fourth of an inch at each point, thereby giving each succeeding point a clear cut of one fourth of an inch deeper than its precursor. (4.) The mouths, by which the chips cut from the ice by the chisels are discharged, are made similar to that of a carpenter's plough. (5.) To the middle of the front cross-bar is fixed a ring, for the purpose of attaching a draught chain, to which the horse that draws the cutter is to be harnessed. (6.) This *first part of the apparatus for [*276] cutting ice is called the cutter, and is used as follows: The cutter is laid on the ice, with the three-inch side plates downward, and drawn forward in a straight line as far as is required, thus making two grooves of an inch deep. The horse is then turned about, and the cutter turned over, so that the two inch-side of the plate shall be in one of the first grooves cut, and the one-inch side on the ice; and as the cutter is drawn-forward, the two-inch side makes one of the first grooves an inch deeper, and the one-inch side forms a new groove of an inch deep. Proceed in this manner until as many grooves are cut as are wanted; then turn the cutter over upon the three-inch side, go over the whole again with

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this side, and they are finished. Repeat the same process at right angles with the first grooves, and the operation with this part of the apparatus is finished.

Part Second of Apparatus for Cutting Ice. (1.) Two spur-wheels, about three feet six inches, more or less, in diameter, connected together by an axletree of iron, or other material, from the centre of each to the other, fixed immovable in each. (2.) A pair of fills, proceeding from the axletree, and secured to it by a pair of composition boxes, admitting the axletree to turn in them. (3.) A cog-wheel, about three feet two inches in diameter, more or less, fixed in the centre of the axletree, so as to be incapable of turning except with the axletree. (4.) A pair of handles attached to the axletree, in the same manner as the fills, so as to admit of the motion of an axletree in them; these handles to be placed one on each side of the cog-wheel in the centre of the axletree, and to be connected together by a permanent bar, at a suitable distance from the axletree. (5.) Two cog-wheels, about four inches diameter more or less, one of which to work on the large cog-wheel, and the other to work on the one so working, and both to be secured by pintles passing [* 277] through * the handles; the small cog-wheel not working on the large cog-wheel to have secured beside it a circular saw about two and a half feet diameter, more or less. (6.) The proportion between the large and small cog-wheels is varied, to obtain greater or less velocity for the saw, as may be wanted. This part of the apparatus for cutting ice is called the saw, and is used as follows: Put the saw into one of the outside grooves made by the cutter; drive the horse forward, following the groove made by the cutter; at the same time a man who manages the handles presses them down as much as the strength of the horse will admit of. This operation is followed back and forth until the ice is cut through. The same is done with the outer parallel

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groove on the opposite side of the work, and also on one of the end grooves, running at right angles with these. By this process the ice on the three sides of the plat or work marked by the cutter is cut through. When this is done, take an iron bar, (one end of which is wide and fitted to the groove, and the other end of which is sharpened as a chisel,) and insert the end which is fitted to the groove into the groove next to and parallel with the end groove which is cut through; pry lightly in several places, then more strongly until the ice is broken off; then strike lightly with the chisel end of the bar into the cross grooves of the piece split off, and it easily separates into square pieces. Thus proceed with the whole plat marked out by the cutter. It is claimed *as new* to cut ice of uniform size, by means of an apparatus worked by any other power than human. The invention of this art, as well as of the particular method of the application of the principle, are claimed by the subscriber.

The answer insisted upon various grounds of defence, which are fully stated in the argument and in the opinion of the Court.

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W. H. Gardiner, for the plaintiffs, contended, that the right *acquired by the patent had not been [* 278] lost by any act of the plaintiffs, the evidence not disclosing any abandonment or dedication to the public; *Pennock v. Dialogue*, 2 Peters, R. 16; *Shaw v. Cooper*, 7 Peters, R. 292; *Mellus v. Silsbee*, 4 Mason, 108; *Good-year v. Matthews*, 1 Paine, 301; *Phillips on Patents*, 184, 186. That the specification was sufficient on its face; and if not, that the fault was cured by the disclaimer; *Ames v. Howard*, 1 Sumner, 48; *Phillips on Patents*, 93; *Whittemore v. Cutter*, 1 Gal. 437; *Lowell v. Lewis*, 1 Mason, 182. That superfluous matter in the specification did not vitiate it; *Lewis v. Mayling*, 1 Lloyd & Welsb. 28; *Moody v. Fiske*, 2 Ma-

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son, 112; Phillips on Patents, 286. And that the several matters were well embraced in it; Evans v. Eaton, 3 Wheat. 454; Stearns v. Barrett, 1 Pick. 448; Barrett v. Hall, 1 Mason, 216; Phillips on Patents, 216, 219, 229, 246, 274.

S. Greenleaf and *G. T. Bigelow*, for the defendants, contended that the invention was not new and original, being merely the common carpenter's plough; that the specification was bad, as it contained not only more than the plaintiff, Wyeth, invented, but also, as it included two distinct machines, and a combination of different machines; Barrett v. Hall, 1 Mason, 447, 475; Moody v. Fiske, 2 Mason, 112, 119; Evans v. Eaton, 3 Wheat. 454, 506; 4 Barn. & Ald. 540; Whittemore v. Cutter, 1 Gall. 438; Cochrane v. Smethurst, 1 Stark. R. 205; Phillips on Patents, 102, 104, 275; that if it could be upheld at all, it was only for cutting two grooves by one operation, which the defendants had not invaded; that the case was not within the relief of the Patent Act of 1837, sec. 7, 9; that the invention had been published previous to the issuing of the patent; (Phillips on Patents, 184;) and that after the patent was issued, the plaintiffs abandoned [* 279] the use to the public, and thereby *betrayed the defendants into the use of the machine; which, in equity was a good bar to the claim of damages, and entitled the defendants to costs. Walcott v. Walker, 7 Ves. 1; Pratt v. Button, 19 Ves. 447.

STORY, J., delivered the opinion of the Court, as follows: I have considered this cause upon the various points suggested at the argument by the counsel on both sides, with as much care as I could, in the short time which I have been able to command, since it was argued; and I will now state the results, with as much brevity as the importance of the cause will permit.

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The first point is, whether the invention claimed by the patentee is new, that is, substantially new. The patent is dated on the 18th of March, 1829, and is for "a new and useful improvement in the manner of cutting ice, together with the machinery and apparatus therefor." Assuming the patent to be for the machinery described in the specification, and the description of the invention in the specification to be, in point of law, certain and correctly summed up, (points which will be hereafter considered,) I am of opinion that the invention is substantially new. No such machinery is, in my judgment, established, by the evidence, to have been known or used before. The argument is, that the principal machine, described as the cutter, is well known, and has been often used before for other purposes, and that this is but an application of an old invention to a new purpose; and it is not, therefore, patentable. It is said, that it is in substance identical with the common carpenter's plough. I do not think so. In the common carpenter's plough there is no series of chisels fixed in one plane, and the guide is below the level, and the plough is a movable chisel. In the present machine, there are a series of chisels, and they are all fixed.

The successive chisels * are each below the other, [* 280] and this is essential to their operation. Such a combination is not shown ever to have been known or used before. It is not, therefore, a new use or application of an old machine. This opinion does not rest upon my own skill and comparison of the machine with the carpenter's plough; but it is fortified and sustained by the testimony of witnesses of great skill, experience, and knowledge in this department of science, namely, by Mr. Treadwell, Mr. Darracott, and Mr. Borden, who all speak most positively and conclusively on the point.

The next point is, whether the ice machine used by the defendants is an infringement of the patent; or in other

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words, does it incorporate in its structure and operation the substance of Wyeth's invention? I am of opinion, that it does include the substance of Wyeth's invention of the ice-cutter. It is substantially, in its mode of operation, the same as Wyeth's machine; and it copies his entire cutter. The only important difference seems to be, that Wyeth's machine has a double series of cutters, on parallel planes; and the machine of the defendants has a single series of chisels in one plane. Both machines have a succession of chisels, each of which is progressively below the other, with a proper guide placed at such distance as the party may choose to regulate the movement; and in this succession of chisels, one below the other, on one plate or frame, consists the substance of Wyeth's invention. The guide in Wyeth's machine is the duplicate of his chisel plate or frame; the guide in the defendants' machine is simply a smooth iron, on a level with the cutting single chisel frame or plate. Each performs the same service, substantially in the same way.

X In the next place, as to the supposed public use of Wyeth's machine before his application for a patent. To defeat his right to a patent, under such circumstances, it is [* 281] essential, * that there should have been a public use of his machine, substantially as it was patented, with his consent. If it was merely used occasionally by himself in trying experiments, or if he allowed only a temporary use thereof by a few persons, as an act of personal accommodation or neighborly kindness, for a short and limited period, that would not take away his right to a patent. To produce such an effect, the public use must be either generally allowed or acquiesced in, or at least be unlimited in time, or extent, or object. On the other hand, if the user were without Wyeth's consent, and adverse to his patent, it was a clear violation of his rights, and could not deprive him of his patent.

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Now, I gather from the evidence, (which, however, is somewhat indeterminate on this point,) that Wyeth's machine, as originally invented by him, was not exactly like that for which he afterwards procured the patent. On the contrary, he seems to have made alterations and improvements therein. Pratt (the witness) says that he made the iron part of the *first* machine of Wyeth, which was partly of wood and partly of iron, in December, 1825, or in January, 1826; and that he afterwards, in December, 1827, made the machine which was patented for Wyeth; and it was not patented until March, 1829. So that the latter seems to have been more perfect than the former. But, at all events, I cannot but think that the evidence of the user, as a public user, of the invention before the patent was granted, is far too loose and general to found any just conclusion that Wyeth meant to dedicate it to the public, or had abandoned it to the public before the patent. It appears to me, that the circumstances ought to be very clear and cogent, before the Court would be justified in adopting any conclusion so subversive of private rights, when the party has subsequently taken out a patent. X

In the next place, as to Wyeth's supposed abandonment of *his invention to the public, since he [* 282] obtained his patent. I agree, that it is quite competent for a patentee at any time, by overt acts, or by express dedication, to abandon or surrender to the public, for their use, all the rights secured by his patent, if such is his pleasure, clearly and deliberately expressed. So, if, for a series of years, the patentee acquiesces without objection in the known public use by others of his invention, or stands by and encourages such use, such conduct will afford a very strong presumption of such an actual abandonment or surrender. *A fortiori*, the doctrine will apply to a case, where the patentee has openly encouraged or silently acquiesced in such use by the very defendants whom he afterwards seeks to pro-

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hibit, by injunction, from any further use; for in this way, he may not only mislead them into expenses, or acts, or contracts against which they might otherwise have guarded themselves; but his conduct operates as a surprise, if not as a fraud upon them. At all events, if such a defence were not a complete defence at law, in a suit for any infringement of the patent, it would certainly furnish a clear and satisfactory ground why a court of equity should not interfere either to grant an injunction, or to protect the patentee, or to give any other relief. This doctrine is fully recognized in *Rundell v. Murray*, Jacob's R. 311, 316, and *Saunders v. Smith*, 3 Mylne & Craig, 711, 728, 730, 735. But if there were no authority on the point, I should not have the slightest difficulty in asserting the doctrine, as found in the very nature and character of the jurisdiction exercised by courts of equity on this and other analogous subjects.

There is certainly very strong evidence in the present case, affirmative of such an abandonment or surrender, or at least of a deliberate acquiescence by the patentee in the public use of his invention by some or all of the defendants, without objection, for several years. The patent was obtained [* 283] in 1829; * and no objection was made, and no suit was brought against the defendants for any infringement until 1839, although their use of the invention was, during a very considerable portion of the intermediate period, notorious and constant, and brought home directly to the knowledge of the patentee. Upon this point, I need hardly do more than to refer to the testimony of Stedman and Barker, who assert such knowledge and acquiescence for a long period, on the part of the patentee, in the use of these ice-cutters by different persons (and among others by the defendants) on Fresh Pond, where the patentee himself cut his own ice. It is no just answer to the facts so stated, that until 1839, the business of Wyeth, or rather of his assignee, the

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plaintiff, Tudor, was altogether limited to shipments in the foreign ice trade, and that the defendants' business, being confined to the domestic ice trade, did not interfere practically with his interest under the patent. The violation of the patent was the same, and the acquiescence the same, when the ice was cut by Wyeth's invention, whether the ice was afterwards sold abroad, or sold at home. Nor does it appear that the defendants have as yet engaged at all in the foreign ice trade. It is the acquiescence in the known user by the public, without objection or qualification, and not the extent of the actual user, which constitutes the ground upon which courts of equity refuse an injunction in cases of this sort. The acquiescence in the public use, for the domestic trade, of the plaintiff's invention for cutting ice, admits that the plaintiff no longer claims or insists upon an exclusive right in the domestic trade under the patent; and then he has no right to ask a court of equity to restrain the public from extending the use to foreign trade, or for foreign purposes. If he means to surrender his exclusive right in a qualified manner, or for a qualified trade, he should at the very time give public notice of the nature and extent of his allowance of the * public use, so that all persons [* 284] may be put upon their guard, and not expose themselves to losses or perils, which they have no means of knowing or averting during his general silence and acquiescence.

The cases which have been already cited, fully establish the doctrine, that courts of equity constantly refuse injunctions, even where the legal right and title of the party are acknowledged, when his own conduct has led to the very act or application of the defendants, of which he complains, and for which he seeks redress. And this doctrine is applied, not only to the case of the particular conduct of the party towards the persons with whom the controversy now exists, but also to cases where his conduct with others may influence the

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Court in the exercise of its equitable jurisdiction.¹ Under such circumstances, the Court will leave the party to assert his rights, and to get what redress he may at law, without giving him any extraordinary aid or assistance of its own.

X But the difficulty in the present case arises not so much from the doctrine considered in itself, as from the utter impracticability of applying it on account of the state of the pleadings. The point is not raised, or even suggested in the answer, in any manner whatsoever, as a matter of defence; and, of course, it is not in issue between the parties; and the whole evidence taken on the point is irrelevant, and cannot be looked to, as a matter in judgment. This defect in the pleadings, therefore, puts the question entirely beyond the reach of the Court.

In the next place, as to the objections taken to the specification. The question here necessarily arises, for what is the patent granted? Is it for the combination of the two machines described in the specification, (the cutter [* 285] and the saw,) * to cut ice? Or for the two machines separately? Or for the two machines, as well separately as in combination? Or for any mode whatsoever of cutting ice by means of an apparatus, worked by power, not human, in the abstract, whatever it may be? If it be the latter, it is plain that the patent is void, as it is for an abstract principle, and broader than the invention, which is only cutting ice by one particular mode, or by a particular apparatus or machinery. In order to ascertain the true construction of the specification in this respect, we must look to the summing up of the invention, and the claim therefor, asserted in the specification; for it is the duty of the patentee to sum up his invention in clear and determinate terms; and

¹ *Rundell v. Marray*, Jacob's R. 311, 316: *Saunders v. Smith*, 3 Mylne & Craig, 711, 728, 730, 735.

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his summing up is conclusive upon his right and title. This was the doctrine maintained in *Moody v. Fiske*,¹ 2 Mason, R. 112, 118, 119; and I see no reason to doubt it, or to depart from it.

Now, what is the language in which the patentee has summed up his claim and invention? The specification states: "It is claimed as new, to cut ice of a uniform size, by means of an apparatus worked by any other power than human. The invention of this art, as well as the particular method of the application of the principle, are claimed by the subscriber," (Wyeth.) It is plain, then, that here the patentee claims an exclusive title to the art of cutting ice by means of any power, other than human power. Such a claim is utterly unobtainable in point of law. It is a claim for an art or principle in the abstract, and not for any particular method or machinery, by which ice is to be cut. No man can have a right to cut ice by all means or methods, or by all or any sort of apparatus, although he is not the inventor of any or all of such means, methods, or apparatus. A claim broader than * the actual invention of the patentee [* 286] is, for that very reason, upon the principles of the common law, utterly void, and the patent is a nullity.² Unless, then, the case is saved by the provisions of the Patent Act of 1836, ch. 357, or of the Act of 1837, ch. 45, which will hereafter be considered, the present suit cannot be sustained.

But, besides this general claim, there is another claim in the specification for the particular apparatus and machinery to cut ice, described in the specification. The language of

¹ See also *Hill v. Thompson*, 8 Taunt. R. 375.

² *Moody v. Fiske*, 2 Mason, R. 112, *ante*, 312; *Brunton v. Hawkes*, 4 Barn. & Ald. 541; *Hill v. Thompson*, 8 Taunt. R. 375, 399, 400; *Evans v. Eaton*, 7 Wheat. R. 356, *ante*, 336; Phillips on Patents, ch. 11, s. 7, p. 268 to 282.

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the specification here is: "The invention of this art," (the general claim already considered,) "as well as the particular method of the application of the principle," (omitting the words of reference, as above described,) "are claimed by the subscriber." Now, assuming the former objection, that the claim for a general or abstract principle is not a fatal objection in the present case, it has been argued, that the specification is too ambiguous to be maintainable in point of law; for it does not assert what is claimed as the patentee's invention; whether it be the two machines separately and distinctly, as several inventions, or the combination of them, or both the one and the other.

It appears to me, that the language of the summary may be, and indeed ought to be construed, *ut res magis valeat, quam pereat*, to mean by the words "the particular method of the application," the particular apparatus and machinery described in the specification to effect the purpose of cutting ice. I agree, that the patentee is bound to describe, with reasonable certainty, in what his invention consists, [* 287] and what * his particular claim is. But it does not seem to me that he is to be bound down to any precise form of words; and that it is sufficient, if the Court can clearly ascertain, by fair interpretation, what he intends to claim, and what his language truly imports, even though the expressions are inaccurately or imperfectly drawn.

Is the patent, then, a patent for the combination of the two machines, namely: the saw and the cutter? If it be, then the defendants clearly have not violated the patent-right; for they use the cutter only; and the saw-machine has been abandoned in practice by the patentee himself, as useless, or unnecessary. It appears to me, that the patent is not for the combination of the machines, but for each machine separately and distinctly, as adapted to further and produce the same general result, and capable of a separate and independent

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use. In short, the one may be auxiliary, but is not indispensable to the use of the other. I deduce this conclusion from the descriptive words of the specification, which show, that each machine is independent of the other in its operations, and from the silence of the patentee as to any claim for a combination. This claim, then, for "the particular method of the application of the principle," although inartificial, may be reasonably interpreted, as used distributively, and as expressive of a distinct claim of each particular method set forth in the specification. I deem the patent, then, to be a claim for each distinct machine, as a separate invention, but conducting to the same common end. Of course, if either machine is new, and is the invention of Wyeth, and it has been actually pirated by the defendants, the plaintiff is entitled to maintain a suit therefor, under the Acts of 1836 and 1837, although not at the common law. *A fortiori*, the same doctrine will apply, if both machines are new, upon the principles of the common law.

But it has been said, that if each of the machines patented *is independent of the other, then separate [* 288] patents should have been taken out for each; and that they cannot both be joined in one and the same patent; and so there is a fatal defect in the plaintiff's title. And for this position the doctrine stated in *Barrett v. Hall*, 1 Mason, R. 473, and *Evans v. Eaton*, 3 Wheat. R. 454, 506,¹ is relied on. I agree, that under the general Patent Acts, if two machines are patented, which are wholly independent of each other, and distinct inventions, for unconnected objects, then the objection will lie in its full force and be fatal. The same rule would apply to a patent for several distinct improvements upon different machines, having no

¹ See also Phillips on Patents, pp. 214, 215, 216.

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common object or connected operation. For, if different inventions might be joined in the same patent for entirely different purposes and objects, the patentee would be at liberty to join as many as he might choose, at his own mere pleasure, in one patent, which seems to be inconsistent with the language of the Patent Acts, which speak of the thing patented, and not of the things patented, and of a patent for an invention, and not of a patent for inventions; and they direct a specific sum to be paid for each patent. Besides, there would arise great difficulty in applying the doctrines of the common law to such cases. Suppose one or more of the supposed inventions was not new, would the patent at the common law be void *in toto*, or only as to that invention, and good for the rest? Take the case of a patent for ten different machines, each applicable to an entirely different object, one to saw wood, another to spin cotton, another to print goods, another to make paper, and so on; if any one of these machines were not the invention of the patentee, or were in public use, or were dedicated to the public before the patent was granted, upon the doctrines of the common [* 289] law the patent * would be broader than the invention, and then the consideration therefor would fail, and the patent be void for the whole. But if such distinct inventions could be lawfully united in one patent, the doctrine would lead to consequences most perilous and injurious to the patentee; for, if any one of them were known before, or the patent as to one was void, by innocent mistake or by priority of invention, that would take away from him the title to all the others, which were unquestionably his own exclusive inventions. On the other hand, if the doctrine were relaxed, great inconvenience and even confusion might arise to the public, not only from the difficulty of distinguishing between the different inventions stated in the patent and specification, but also of guarding themselves against fraud

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and imposition by the patentee, in including doubtful claims under cover of others, which were entirely well founded. In construing statutes upon such a subject, these considerations are entitled to no small weight. At least, they show that there is no ground, founded in public policy, or in private right, which calls for any expanded meaning of the very words of the statute; and that to construe them literally is to construe them wisely. It is plain, also, that the Act of 1837, ch. 45, in the ninth section, contemplated the rule of the common law as being then in full force; and, therefore, it seeks to mitigate it, and provides, "that whenever, by mistake, accident, or inadvertence, and without any intent to defraud or mislead the public, any patentee shall have, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing invented" (not of different things invented) "of which he was not the first and original inventor, and shall have no legal or just right to claim the same, in every such case the patent shall be good and valid for so much of the invention or discovery" (not inventions or discoveries) "as shall be truly and *bonâ fide*, his own; * provided it shall be a [* 290] material and substantial part of the thing patented, and be definitely distinguishable from the other parts so claimed without right as aforesaid." This language manifestly points throughout to a definite and single invention, as the "thing patented," and does not even suppose that one patent could lawfully include divers distinct and independent inventions, having no common connection with each other, nor any common purpose. It may, therefore, fairly be deemed a legislative recognition and adoption of the general rule of law in cases not within the exceptive provision of the Act of 1837.

And this is what I understand to have been intended by the Court in the language used in *Barrett v. Hall*, 1 Mason,

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447, 475, 478. It was there said, (p. 475,) that "a patent under the general Patent Act cannot embrace various distinct improvements and inventions; but in such a case the party must take out separate patents. If the patentee has invented certain improved machines, which are capable of a distinct operation, and has also invented a combination of these machines to produce a connected result, the same patent cannot at once be for the combination and for each of the improved machines; for the inventions are as distinct as if the subjects were entirely different." And again, (p. 478,) "if the patent could be construed as a patent for each of the machines severally, as well as for the combination, then it would be void, because two separate inventions cannot be patented in one patent." It is obvious, construing this language with reference to the case actually before the Court, that the Court were treating of a case where each of the patented machines might singly have a distinct and appropriate use and purpose, unconnected with any common purpose, and therefore each was a different invention. In *Moody v. Fiske*, 2 Mason, 112, 119, the judge alluded still more closely to this distinction, and * said: "I wish it to be understood, in this opinion, that though several distinct improvements in one machine may be united in one patent, [yet] it does not follow, that several improvements in two different machines, *having distinct* and independent operations, can be so included; much less, that the same patent may be for a combination of different machines, and for distinct improvements in each." It is perhaps impossible to use any general language in cases of this sort, standing almost upon the metaphysics of the law, without some danger of its being found susceptible of an interpretation beyond that which was then in the mind of the Court. The case intended to be put in each of these cases, was of two different machines, each applicable to a distinct object and purpose, and not connected

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together for any common object or purpose. And, understood in this way, it seems to me, that no reasonable objection lies against the doctrine.

Construing, then, the present patent to be a patent for each machine, as a distinct and independent invention, but for the same common purpose and auxiliary to the same common end, I do not perceive any just foundation for the objection made to it. If one patent may be taken for different and distinct improvements made in a single machine, which cannot well be doubted or denied,¹ how is that case distinguishable in principle from the present? Here, there are two machines, each of which is or may be justly auxiliary to produce the same general result, and each is applied to the same common purpose. Why then may not each be deemed a part or improvement of the same invention? Suppose the patentee had invented two distinct and different machines, each of which would accomplish the same end, why may he not unite both in one patent, and say, I deem each equally useful and equally new, but, under certain circumstances, * the one may, in a given case, be preferable to the other? There is a clause in the Patent Acts, which requires, that the inventor, in his specification or description of his invention, should "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." Now, this would seem clearly to show, that he might lawfully unite in one patent all the modes in which he has contemplated the application of his invention, and all the different sorts of machinery, or modifications of machinery, by which or to which it might be applied; and if each were new, there would seem to be no

¹ See *Moody v. Fiske*, 2 *Mason*, R. 112, 117, 118, *ante*, Vol. I. 312.

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just ground of objection to his patent reaching them all.¹ *A fortiori*, this rule would seem to be applicable, where each of the machines is but an improvement or invention conducing to the accomplishment of one and the same general end.

But let us take the case in another view, (of which it is certainly susceptible,) and consider the patent as a patent, not for each machine separately, but for them conjointly, or in the aggregate, as conducing to the same common end; if each machine is new, why may they not both be united in one patent, as distinct improvements? I profess not to see any good reason to the contrary. If they may be so united and were both new, then, upon the principles established in *Moody v. Fiske*, (2 Mason, R. 112, 117, 118, 119,) it is not necessary, in order to maintain a suit, that there should be a violation of the patent throughout. It is sufficient, if any one of the invented machines or improvements is wrongfully used; for that, *pro tanto*, violates the patent. In this view, therefore, the use of the cutter of the inventor, without any use of the saw, would be a sufficient ground to support the present bill, if it were not otherwise open to objection.

[* 293] * We come, then, to the remaining point, whether, although under the Patent Act of 1793, ch. 55, the patent is absolutely void, because the claim includes an abstract principle, and is broader than the invention; or whether that objection is cured by the disclaimer made by the patentee, (Wyeth,) under the Act of 1837, ch. 45. The seventh section of that act provides, "That whenever any patentee shall have, through inadvertence, accident, or mistake, made his specification too broad, claiming more than that of which he was the original or first inventor, some material and substantial part of the thing patented being truly

¹ Act of 1793, ch. 55, s. 8. Act of 1836, ch. 357.

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or justly his own, any such patentee, his administrators, executors, or assigns, whether of the whole or a sectional part thereof, may make disclaimer of such parts of the thing patented, as the disclaimant shall not claim to hold by virtue of the patent or assignment, &c., &c. And such disclaimer shall be thereafter taken and considered as a part of the original specification, to the extent of the interest which shall be possessed in the patent or right secured thereby by the disclaimant, &c. Then follows a proviso, that "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 the same." The ninth section provides, "That whenever, by mistake, accident, or inadvertence, and without any wilful default or intent to defraud or mislead the public, any patentee shall have, in his specification, claimed to be the first and original inventor or discoverer of any material or substantial part of the thing patented, of which he was not the first and original inventor, and shall have no legal or just right to claim the same, in every such case the patent shall be deemed good and valid for so much of the invention or discovery as shall be truly and *bonâ fide* his own; provided it shall be a material and substantial part of the thing patented, and shall be definitely distinguishable * from the other parts so claimed without [* 294] right as aforesaid." Then follows a clause, that in every such case, if the plaintiff recovers in any suit, he shall not be entitled to costs, "unless he shall have entered at the Patent-Office, prior to the commencement of the suit, a disclaimer of all that part of the thing patented, which was so claimed without right; with a proviso, "That no person bringing any such suit shall be entitled to the benefits of the provisions contained in this section, who shall have unreasonably neglected or delayed to enter at the Patent-Office a disclaimer as aforesaid."

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Now, it seems to me that, upon the true construction of this statute, the disclaimer mentioned in the seventh section must be interpreted to apply solely to suits pending, when the disclaimer is filed in the Patent-Office; and the disclaimer mentioned in the ninth section to apply solely to suits brought after the disclaimer is so filed. In this way, the provisions harmonize with each other; upon any other construction they would seem, to some extent, to clash with each other, so far as the legal effect and operation of the disclaimer is concerned.

In the present case, the suit was brought on the first of January, 1840, and the disclaimer was not filed until the twenty-fourth of October, of the same year. The proviso then, of the seventh section, would seem to prevent the disclaimer from affecting the present suit in any manner whatsoever. The disclaimer, for another reason, is also utterly without effect in the present case; for it is not a joint disclaimer by the patentee and his assignee, Tudor, who are both plaintiffs in this suit; but by Wyeth alone. The disclaimer cannot, therefore, operate in favor of Tudor, without his having joined in it, in any suit, either at law or in equity. The case, then, must stand upon the other clauses of the ninth section, independent of the disclaimer.

[* 295] * This leads me to say that I cannot but consider that the claim made in the patent for the abstract principle or art of cutting ice by means of an apparatus worked by any other power than human, is a claim founded in inadvertence and mistake of the law, and without any wilful default or intent to defraud or mislead the public within the proviso of the ninth section. That section, it appears to me, was intended to cover inadvertences and mistakes of the law, as well as inadvertences and mistakes of fact; and, therefore, without any disclaimer, the plaintiffs might avail themselves of this part of the section to the extent of main-

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taining the present suit for the other parts of the invention claimed, that is, for the saw and for the cutter, and thereby protect themselves against any violation of their rights, unless there has been an unreasonable neglect or delay to file the disclaimer in the office. Still, however, it does not seem to me that a court of equity ought to interfere to grant a perpetual injunction in a case of this sort, whatever might be the right and remedy at law, unless a disclaimer has been in fact filed at the Patent-Office before the suit is brought. The granting of such an injunction is a matter resting in the sound discretion of the Court; and if the Court should grant a perpetual injunction before any disclaimer is filed, it may be that the patentee may never afterwards, within a reasonable time, file any disclaimer, although the act certainly contemplates the neglect or delay to do so to be a good defence both at law and in equity, in every suit brought upon the patent, to secure the rights granted thereby. However, it is not indispensable in this case to dispose of this point, or of the question of unreasonable neglect or delay, as there is another objection, which in my judgment is fatal, in every view, to the maintenance of the suit in its present form.

The objection which I deem fatal, is, that the bill states and admits that the assignment to the plaintiff, Tudor, (made *in February, 1832,) has never yet [* 296] been recorded in the State Department, according to the provisions of the Patent Act of 1793, ch. 55, § 4. That act provides, "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." It seems a necessary, or, at least, a just inference from this language, that until the assignee has so recorded the assignment, he is not

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substituted to the right and responsibility of the patentee, so as to maintain any suit at law or in equity, founded thereon. It is true that no objection is taken in the pleadings on account of this defect; but it is spread upon the face of the bill, and therefore the Court is bound to take notice of it. It is not the case of a title defectively set forth, but of a title defective in itself, and brought before the Court with a fatal infirmity, acknowledged to be attached to it. As between the plaintiffs and the defendants, standing upon adverse titles and rights, (whatever might be the case between privies in title and right,) Tudor has shown no joint interest sufficient to maintain the present bill; and, therefore, it must be dismissed with costs.

THE PHILADELPHIA AND TRENTON RAILROAD COMPANY,
PLAINTIFFS IN ERROR, v. JAMES STIMPSON, DEFENDANT IN
ERROR.

[14 Peters, 448. January T. 1840.]

Action for the violation of a patent-right, granted to the patentee for "a new and useful improvement in turning short curves on railroads."

On the 26th September, 1835, a second patent was granted, the original patent, granted in 1831, having been surrendered and cancelled on account of a defective specification; the second patent being for fourteen years from the date of the original patent. The second patent was in the precise form of the original, except the recital of the fact, that the former patent was cancelled "on account of a defective specification," and the statement of the time the second patent was to begin to run. It was objected that the second patent should not be admitted in evidence on the trial of the case, because it did not contain any recitals that the prerequisites of the Act of Congress of 1836, authorizing the renewal of patents, had been complied with. *Held*: that this objection cannot, in point of law, be maintained. The patent was issued under the great seal of the United States, and is signed by the Presi-

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dent, and countersigned by the Secretary of State. It is a presumption of law, that all public officers, and especially such high functionaries, perform their proper official duties, until the contrary is proved. Where an act is to be done, or patent granted upon evidence and proofs to be laid before a public officer, upon which he is to decide, the fact that he has done the act, in granting the patent is *prima facie* evidence that the proofs have been regularly made, and were satisfactory. No other tribunal is at liberty to reëxamine or controvert the sufficiency of such proofs, when the law has made the officer the proper judge of their sufficiency and competency.

Patents for lands, equally with patents for inventions, have, in Courts of justice, been deemed *prima facie* evidence that they have been regularly granted, whenever they have been produced under the great seal of the government, without any recitals or proofs that the prerequisites of the acts under which they have been issued have been duly observed. In cases of patents, the United States have gone one step further; and as the patentee is required to make oath that he is the true inventor, before he can obtain a patent, the patent has been deemed *prima facie* evidence that he has made the invention.

It is incumbent on those who seek to show that the examination of a witness has been improperly rejected, to establish their right to have the evidence admitted; for the Court will be presumed to have acted correctly, until the contrary is established.

To entitle a party to examine a witness in a patent cause, the purpose of whose testimony is to disprove the right of the patentee to the invention, by showing its use prior to the patent by others, the provisions of the Patent Act of 1836, relative to notice, must be strictly complied with.

It is incumbent on those who insist upon the right to put particular questions to a witness, to establish that right beyond any reasonable doubt, for the very purpose stated by them; and they are not afterwards at liberty to desert that purpose, and to show the pertinency or relevancy of the evidence for any other purpose not then suggested to the Court.

A party has no right to cross-examine any witness, except as to facts and circumstances connected with the matters stated in his direct examination. If he wishes to examine him on other matters, he must do so by making the witness his own; and calling him as such, in the subsequent progress of the cause. A party cannot, by his own omission to take an objection to the admission of improper evidence, brought out on a cross-examination, found a right to introduce testimony in chief, to rebut it or explain it.

Parol evidence, bearing upon written contracts and papers, ought not to be admitted in evidence, without the production of such written contracts or papers; so as to enable both the Court and the jury to see whether or not the admission of the parol evidence in any manner, will trench upon the rule that parol evidence is not admissible to vary or contradict written contracts or papers.

As a general rule, and upon general principles, the declarations and conversa-

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tions of the plaintiff are not admissible evidence in favor of his own rights. This is, however, but a general rule, and admits and requires various exceptions. There are many cases in which a party may show his declarations [*449] comport with acts in his own favor, as a part of the *res gesta*. There are other cases in which his material declarations have been admitted.

In an action for an assault and battery and wounding, the declarations of the plaintiff to his internal pains, aches, injuries, and symptoms, to the physician attending him, are admissible for the purpose of showing the nature and extent of the injuries done to him. In many cases of inventions, it is hardly possible in any other manner to ascertain the precise time and exact origin of the invention.

The conversation and declarations of a patentee, merely affirming that at some former period he had invented a particular machine, may well be objected to. But his conversations and declarations, stating that he had made an invention, and describing its details, and explaining its operations, are properly deemed an assertion of his right at that time, as an inventor, to the extent of the facts and details which he then makes known, although not of their existence at an anterior time. Such declarations, coupled with a description of the nature and objects of the invention, are to be deemed a part of the *res gesta*, and legitimate evidence that the invention was then known and claimed by him; and thus its origin may be fixed at least as early as that period.

If the rejection of evidence is a matter of resting in the sound discretion of the Court, this cannot be assigned as error.

The mode of conducting trials, the order of introducing evidence, and the times when it is to be introduced, are properly matters belonging to the practice of the Circuit Courts, with which the Supreme Court ought not to interfere; unless it shall choose to prescribe some fixed general rules on the subject, under the authority of the Act of Congress. The Circuit Courts possess this discretion in as ample a manner as other judicial tribunals.

Testimony was not offered by a defendant, or stated by him as matter of defence, in the stage of the cause when it is usually introduced according to the practice of the Court. It was offered after the defendant's counsel had stated in open Court, that they had closed their evidence, and after the plaintiff, in consequence of that declaration, had discharged his own witness. The Circuit Court refused to admit the testimony. *Held*, that this decision was proper.

In error from the Circuit Court of the United States for the Eastern District of Pennsylvania.

At the April session of the Circuit Court, James Stimpson

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instituted an action against the plaintiffs in error, for the recovery of damages, for the violation of a patent granted to him by the United States, on the 26th day of September, 1835, for "a new and useful improvement in the mode of turning short curves on railroads."

The case was tried on the 16th day of February, 1839; and a verdict was rendered for the plaintiff, for the sum of four thousand two hundred and fifty dollars. On the 6th of May, 1839, a remittiter was entered on the docket of the Court, for the sum of one thousand dollars; and a judgment was entered for the plaintiff for three thousand two hundred and fifty dollars.

On the trial of the cause, the defendants tendered a bill of exceptions to the decision of the Court, on their admitting the patent to the plaintiff in evidence; and to other rulings of the Court in the course of the trial. The defendants prosecuted this writ of error.

The patent granted by the United States to James Stimpson was as follows:

"The United States of America; to all to whom these letters-patent shall come.

"Whereas, James Stimpson, a citizen of the United States, hath alleged that he has invented a new and useful improvement in the * mode of turning short curves [*450] on railroads, for which letters-patent were granted the twenty-third day of August, 1831; which letters being hereby cancelled on account of a defective specification; which improvement, he states, has not been known or used before his application, hath made oath that he does verily believe that he is the true inventor or discoverer of the said improvement, hath paid into the treasury of the United States the sum of thirty dollars, delivered a receipt for the same, and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said improve-

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ment, and praying that a patent may be granted for that purpose. These are, therefore, to grant, according to law, to the said James Stimpson, his heirs, administrators, or assigns, for the term of fourteen years from the twenty-third day of August, 1831, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said James Stimpson himself, in the schedule hereto annexed."

Tested at Washington, under the seal of the United States, on the 26th day of September, 1836, by the President of the United States; and certified in the usual form by the Attorney-General of the United States.

"The schedule referred to in these letters-patent, and making a part of the same," contained "a description in the words of the said James Stimpson himself, of his improvement in the mode of turning short curves on railroads, for which letters-patent were granted, dated the twenty-third day August, 1831, which letters-patent being hereby cancelled, on account of a defective specification."

The specification describes the invention with minute particularity, and concludes: "What I claim as my invention or improvement, is the application of the flanches of the wheels on one side of railroad carriages, and of the treads of the wheels on the other side, to turn curves upon railways, particularly such as turning the corners of streets, wharves, &c., in cities and elsewhere, operating upon the principle herein set forth."

The bill of exceptions stated, that the counsel for the plaintiff offered in evidence the patent and specification, to the admission of which in evidence, the counsel for the defendant objected; but the objection was overruled by the Court, and the evidence was admitted.

2. The defendants offered to give in evidence, by Josiah

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White, the description of a flange upon one side of the railroad cars, and the running upon the tread of the wheel upon the other side, with the flange in a groove, for the turning of curves, which he had seen in use before the date of plaintiff's patent; which was objected to by the counsel for the plaintiff, and the objection sustained by the Court. The objection of the counsel for the plaintiff to the introduction of the testimony of Josiah White, was founded on the absence * of the notice required by the Act of Congress of [* 451] the use of the machine at Mauch Chunk; at which place, it was said, his testimony would show it had been used.

3. The third exception was to the refusal of the Court to allow the defendants to introduce proof of the conversation between the patentee and the counsel of the Baltimore and Ohio Railroad Company, while an arrangement of a suit against the company was made, as to the character and effects of the arrangements.

4. The counsel for the plaintiff, by rebutting evidence, to extend his claim to the invention prior to the time at which the defendants had proved the reduction of the same into use and practice by others, offered to give evidence by witnesses of the conversations of the patentee on the subject of his invention at an anterior period; which conversations were intended to show the making of the invention by the patentee, before and at the period when the same took place. The counsel for the defendants objected to the admission of this testimony; but the Court overruled the objection.

5. The fifth exception was to the refusal of the Court to admit the examination of Dr. Thomas P. Jones. The plaintiff had discharged his witnesses on the declaration of the defendants' counsel that they had closed their evidence. The testimony asked from Dr. Jones, was to new facts. The Court refused to admit the testimony, on the ground that

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the testimony was improper, and that it was offered too late.

The case was argued by *Mr. Cox*, and *Mr. Southard*, for the plaintiffs in error; and by *Mr. J. R. Ingersoll*, for the defendant.

Mr. Cox and *Mr. Southard*, on the first exception.

The patent should not have been admitted in evidence. On its face it is inoperative, and invalid. It is not a patent under the Act of Congress of 1793; but it purports to be a substituted patent for one which had been surrendered. It gives to the patentee the same privileges as those which were given by the first patent. It, therefore, should be in strict and exact conformity with the law of 1793, as well as with the subsequent Act of Congress, authorizing the surrender of a patent for an imperfect specification, and the issue of another.

The Act of 21st February, 1793, requires, by its third section, that the applicant shall be the true inventor of the machine, &c. This is made a *sine qua non* to the granting the patent, and the oath of the claimant is required to this fact. This provision makes the oath necessary, before the Secretary of State has authority to grant the patent. There is no remedy, if this has been omitted.

There was no decision before the case of *Morris v. Huntington*, Paine's Reports, 348, which affirmed the right of a patentee to surrender his patent for an erroneous or imperfect specification. After this case, Congress [* 452] authorized such a surrender. Act of Congress * of July 3d, 1832. By this act the cause of the surrender must be made out to the satisfaction of the Secretary of State, when a second patent is asked for. It has been decided, that a patent is *primâ facie* evidence of the statements on the face of the patent. This does not give any

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other validity to those statements ; and it is not sufficient that some of the requirements of the Act of Congress are stated. All must be set forth, and an averment must be made that every thing has been done. There is no halting point. Those requirements exist as to any patent granted after the surrender of a patent. The errors or imperfections in the specification, on which the surrender has been made, should be stated. *Grant v. Raymond*, 6 Peters, 218. In the case cited, there was a recital of the surrender of the patent, and the cause of its surrender.

There is in the patent, which was before the Circuit Court, no recital of the imperfections of the first specification ; no allegation that there was no fraud in the transaction. There is nothing shown but the gratuitous act of the officer in granting the second patent. And yet all the prerequisites to the granting of a second patent should appear in it, as well as be of record in the Patent-Office.

Without these essential features in a patent given on the surrender of a previous one for the same invention, it cannot be read in evidence to a jury. The requirements in both the Acts of Congress of 1792, and 1832, must appear in it. If all those matters are not shown, the second patent stands as a new patent ; and by allowing it to be given in evidence, the Court altogether disregard the law. If the patent, in this imperfect form, is admitted as *prima facie* proof, all the burden of contradicting it is thrown on the opposite party. Cited, on these points, *Shaw v. Cooper*, 7 Peters, 245.

In support of the second exception, the counsel contended that the notice given was sufficient to authorize the introduction of the testimony of Josiah White. Cited, on this point, *Evans v. Eaton*, Peters, C. C. R. 322. *Wheat. Rep. S. C.* The notice would have been sufficient under the Act of Congress of 1793, and why not under the Act of July 3d, 1836 ?

The objection to the introduction of the evidence by the

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counsel for the defendants, which was sustained by the Court, and which is the subject of the defendant's third exception, was well taken. It was in the power of the plaintiff to have produced his contract with the Baltimore and Ohio Railroad Company, and have rendered this evidence unnecessary. He did not do so.

As to the fourth exception. It is admitted, that it was the right of the plaintiff to prove, by legal rebutting evidence, that the invention made by him, and for which he held the patent, was in use before the period in which the defendant had proved the invention by him. But this evidence could not be given, by showing the conversations of the plaintiff on the subject of the invention before the date of the first patent.

Conversations on the subject of an invention are [* 453] not the * invention; nor are the ideas of the invention its actual development. There must be an application of the thought, in the construction of the machine.

This is an attempt to give the declarations of a party in evidence, after the actual occurrence of the transaction. No declaration of a person that he intended to take out a patent, could be given in evidence. Cited, on this point, 1 Wheat. Rep. 313; 10 Serg. & Rawle, 27; 5 Serg. & Rawle, 295; Roscoe on Evidence, 21; 4 Wash. C. C. R. 58; 5 Mason, 6; 1 Gallis. C. C. R. 438.

As to the 5th exception, the counsel contended, that the evidence of Dr. Jones was rebutting evidence and was regular; as it was offered to meet and disprove the plaintiff's declarations, which the Court had admitted as testimony.

Mr. Ingersoll, for the defendants in error.

1. The objection to the certificate of the Secretary of State should apply rather to the effect than the admissibility of the document. That officer is authorized by law to issue

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patents, and the presumption is, that he has done so rightfully. Possession of the document does not affect the intrinsic rights of any one. Every question of merit is still open. It enables the patentee to sue; but it neither secures him in the enjoyment of the alleged invention, nor precludes others from contesting the validity of his claims. In the different cases cited, the patent appears to have been received in evidence exactly in the form now exhibited, although it may have availed nothing to the plaintiff afterwards.

Sullivan v. Redfield, 1 Paine, 447: "The patent is *prima facie* evidence of the right." The Margareta, 2 Gall. 519; Remission, though not valid was given in evidence. See also Bingham v. Cabot, 3 Dall. 19; Bell v. Morrison, 1 Peters, 355; Keene v. Meade, 3 Peters, 6; The United States v. Liddle, 2 Wash. C. C. Rep. 205.

2. The testimony of Josiah White would have been admitted under the sixth section of the law of 1793. But the fifteenth (or corresponding section, of the law of 1836, requires notice of place, person, and residence. As the law previously stood, great injustice might have been done, unless the Court had construed it so as to invest the judge with power to prevent the plaintiff from being taken by surprise. Evans v. Eaton; 3 Wheat. 505. The law now wisely anticipates the necessity for an exercise of judicial discretion and possible delay; and requires notice of the place where the improvement is supposed by a defendant to have been previously used. This was not given, and the testimony was necessarily rejected.

3. Although, in truth, the offer to examine Mr. Latrobe upon certain points was not rejected by the Court, but withdrawn by the counsel, yet as it appears by the record to have been a point decided, I will submit to treat it accordingly. The testimony would no doubt have been rejected if the offer had been persisted in, and the *delay [* 454]

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that would be requisite to put the record right would be deeply injurious to my client.

(1.) The inquires suggested for the witness are impracticable, and they lead to impracticable results. The inquiry refers to a "negotiation," "arrangement," and "settlement." It asserts the fact that a "grant" or "contract," was made. Negotiation is the necessary preliminary to a contract, is absorbed in it, and forms a part of it. How can you separate them? Out of one identified existence, two things are to be made, essentially distinct from each other. That is impossible.

(2.) The inquiries are irrelative. The arrangement contemplated was *res inter alios acta*. The plaintiffs in error were altogether strangers to it. Many inducements may lead to a settlement with one person which would not render it desirable with another. If it were not that Ross Winans had previously been cross-examined by the counsel for the plaintiffs in the Circuit Court, to the point of settlement with the Baltimore and Ohio Company, no pretence for the inquiry would exist. If that was wrong, this will not make it right. It was not objected to. If not strictly cross-examination, we had no right to resort to it. *Ellmaker v. Buckley*, 16 Serg. & Rawle. If it was regular cross-examination, it cannot justify the proposed irregularity. But we were bound to put the witness on his guard as to a collateral fact which might impeach his testimony. Rule in the Queen's case.

(3.) The object attempted to be proved was a mere entity; an abstraction; nothing actually done, but at best something omitted or avoided; a conclusion or construction; a contingency without a substantial thing to support it.

(4.) It was an attempt to prove by parol some known written arrangement, which was susceptible of being produced.

4. Explanations of the patentee himself were good evidence

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to prove the genuineness of his claims to originality. It is necessary to understand the manner in which this testimony was produced. Plaintiff at first simply produced his patent, and called a witness who proved its utility and infringement by the defendants. Then the defendants went at large into proof of alleged priority of the invention by other persons. All of this went to show a use before the date of the plaintiff's patent. A necessity was therefore thrown upon him of proving that his invention existed, and was communicated by him to different persons at a still earlier period. No doubt of the importance of such proof. It consisted of evidence of plaintiff's invention prior to the defendant's knowledge, or the knowledge of those persons on whom they relied. To meet this particular exigency, that is, to show invention, it is difficult to conceive what can be authentic except what comes from the inventor himself. He therefore produced several individuals, who stated that he described the improvement to them at a period considerably earlier than defendants had fixed for its earliest use. If he described it, he must have known it. If he knew it before any other person, he must have *invented it. That prior knowledge [*455] was invention ; and that was the very thing to be proved:

Two objections were taken to the character of the proof ; 1st. That it was derived from the plaintiff himself ; 2. That the alleged improvement was not then brought into practical use by him.

Answer 1st. It was an invention ; else not patentable ; in other words, it must spring from himself. An exhibition of it must necessarily in some shape or other be his act. Whatever might be said or done by others could not be available to him. The exhibition might be effected by deed, signs, or words. It matters not in what particular manner the effect is produced, but the discovery must make manifest its pater-

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nity ; and it can do so only through the medium of its proper parent.

This may be done by his works — a machine constructed. Let it be produced ; original, practical, perfect in all its parts. Nothing is gained by the author unless something more than all this appears, namely, authorship. However eloquent the machine may be as to its uses, it cannot speak for itself as to its author. The nearest it can come to speech would be an inscription or label on its front : “ J. S. fecit,” for example.

That would at best be a written declaration. What difference would it make that the writing, or stamping, or printing, should be in a book ? That description of evidence in a sister department of the law, is conclusive of important rights. In maintaining copyrights, the writing of the party is the essence of the discovery, and the sole proof of invention or originality. If, instead of writing with his own hand, the same author dictates to another person, cannot the amanuensis prove the dictation, and hence the authorship ? A blind author has often given to the world the result of his genius, through the pen of another. On a question of authorship, surely the testimony of the scribe would be received as competent.

Another species of proof of invention remains, namely, oral explanation alone. Why may it not be received ? It is the very thing itself. To speak it, was to create it, if it did not already exist in thought ; and if it did, it must prove it. The proof was given to counteract the allegation of earlier discovery. It produces the effect by showing that the earlier discoverers, as they are regarded, received from the plaintiff the information which enabled them to put the invention in use, and then attempt to deny the right of showing how the information was communicated and obtained. One of the very pieces of testimony objected to, consisted of a conversa-

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tion with the person who claimed to be an inventor in preference to the plaintiff.

The declarations did not stand alone; they were accompanied by two drawings and a model. The date of the existence of these monuments is clearly proved. The conversations became but a part of the *res gestæ*.

There are many occasions on which one's own sayings and doings are good evidence; in some instances the best, and in others the only * evidence. The present [* 456] is an anomaly unless it concurs. It does not follow that the expressions of an individual are the illegal creation of testimony for himself. Such are, 1. Various kinds of declarations *ante litem motam*; 2. When the sayings are the doings, as in cases of notice; 3. Where the expressions of an individual are the test of a given state of things, as intellect; 4. Proof of a contract, as marriage, by words *de presenti*; 5. Almost any other discovery or invention, not connected with the useful arts. A reward is offered for lost property; the finder informs of the finding of it; the declarations can be proved.

Answer 2d. As to the objection that the explanations were not reduced to practice. Here, too, the objection loses sight of the fact that our evidence was not original, but merely designed to meet a collateral issue as to the period of invention, and not exactly as to invention itself. On any ground, however, the question of invention does not depend upon whether the thing has been reduced to practice, but whether it can be. Not whether it is actually practised, but practicable. Drawings, descriptions, and models are sent to the Patent-Office. These are miniature likenesses, not the thing itself. Any other course would, in many instances, be quite impracticable. A ship, a house, a town, are often the recipients of an improvement which cannot be practically exhibited, except in connection with the vast object to which it is

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applied. Sometimes the reducing to practice might be destructive of life or property. A guillotine need not be rehearsed in order to prove its power.

Besides, it might destroy the very intention, to insist on practical exercise. It might be regarded as giving the invention to the public, and then the patent-right is gone forever.

5. Thomas P. Jones was called by the defendants after all the testimony in chief, on both sides; and the plaintiff's rebutting testimony also had been given, and his witnesses dismissed; and much time had been occupied in giving rebutting testimony for the defendants. The declared object was to prove that the invention described in the plaintiff's patent of 1835, was different from the invention described by him in his patent of 1831; in other words, that the patent which purported to be a mere correction of form, was in substance a totally different thing. We are struck at once with an inconsistency between this point, and the whole tenor of the defendant's case. The notice which they gave, the aim of their evidence, their great design, is to show that the thing relied on by the plaintiff, which was patented by him in 1835, was well known and used in 1831; known to everybody, publicly, notoriously. Yet we are now told that it was not known even to the plaintiff himself; but that he found it necessary four years afterwards to desert the alleged invention of 1831, and surreptitiously to foist in a different thing, which then became known to him for the first time. Unless this is the true meaning of the point, it has none.

The evidence offered was original and direct. It contradicted nothing already asserted in evidence. It [* 457] was directed to a point in * no way collateral. It went immediately to the essential merits of the case. It was of great importance undoubtedly. Nothing could be more conclusive against the plaintiff. Not only would it be

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destructive of his claim to originality ; but it would prove a most audacious fraud, abortively attempted, and calculated, when detected, to deprive him of all standing in or out of Court, and to render his defeat as disgraceful as it was inevitable.

Notice of all this ought to have been given, perhaps. It is not urged, however, as an argument, that none was received ; although it might have been calculated to take the plaintiff by surprise. But it was a fact, above all others, requiring, and in its nature admitting, of countervailing proof. Not a clerk in the office, probably, could have failed to give material testimony in reply. These persons were at a distance ; and we should have been left to the question of probability, whether a man, in any extremity of impudent fraud, would have ventured to place two totally different patents side by side in the office, asserting that they were in substance identical.

The evidence offered was not the best the nature of the case admitted of. Contradiction was to be proved between two written instruments, with, perhaps, a model accompanying each of them. Copies would be the proper sources of illustration. Were copies not accessible ? We do not know. No inquiry was made. A thousand copies may have been made before the Patent-Office was destroyed. Plaintiff himself, no doubt, had such copies in his possession. No notice was given to him to produce them, before this violent attempt was made to introduce the secondary evidence.

To get rid of all this, the argument was that the difference was only to be inferred between the patents from a difference between the conversation and one of them. But that would rebut nothing. No person denied that plaintiff's conversations with the witnesses he produced, were as they were sworn to be. Other conversations with other persons might show descriptions of other inventions ; but they could not possibly show that the first conversations did not take place. The

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judge gave two reasons for rejecting the testimony. One was, that it was offered at too late a stage of the cause. That was ruled in his sound discretion. From the exercise of that discretion there is no appeal. No attempt was made to take one. On both of his grounds he was right. But one was sufficient to cover the whole question, and it is inaccessible to review here.

Mr. Justice STORY delivered the opinion of the Court.

This is a writ of error to the judgment of the Circuit Court for the Eastern District of Pennsylvania, rendered in an action brought by Stimpson, the defendant in error, against the plaintiffs in error, for a violation of a patent-right granted to him for a new and useful improvement in the mode of turning short curves on railroads.

A patent was originally granted to Stimpson, for the same invention, on the 23d day of August, 1831; and the renewed patent, upon which the present suit is brought, was [* 458] granted on the 26th of * September, 1835, upon the former letters-patent "being cancelled on account of a defective specification;" and the renewed patent was for the term of fourteen years from the date of the original patent. With the exception of the recital of the fact that the former letters-patent were cancelled "on account of a defective specification," and the statement of the prior date from which the renewed patent was to begin to run, the renewed patent is in the precise form in which the original patents are granted.

At the trial upon the general issue, a bill of exceptions was taken to certain rulings of the Court upon points of evidence, to the consideration of which we shall at once proceed without any further preface.

The first exception taken is to the admission of the renewed patent as evidence in the cause to the jury. The Patent

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Act of 1832, ch. 162, sec. 3, under which this patent was obtained, provides, that whenever any patent shall be inoperative or invalid, by reason that any of the terms or conditions prescribed by the prior Acts of Congress, have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, being complied with on the part of the 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 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 by the third section of the Act of the 21st of February, 1792, ch. 55.

Now, the objection is, that the present patent does not contain any recitals that the prerequisites thus stated in the act have been complied with, namely, that the error in the former patent has arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention; and that without such recitals, as it is the case of a special authority, the patent is a mere nullity, and inoperative. We are of opinion that the objection cannot, in point of law, be maintained. The patent was issued under the great seal of the United States, and is signed by the President, and countersigned by the Secretary of State. It is a presumption of law, that all public officers, and especially such high functionaries, perform their proper official duties until the contrary is proved. And where, as in the present case, an act is to be done, or patent granted upon evidence and proofs to be laid before a public officer, upon which he is to decide, the fact that he has done the act or granted the patent, is *prima facie* evidence that the proofs have been regularly made, and were satisfactory. No other tribunal is at liberty to reëxamine or controvert the sufficiency of such proofs, if laid before him, when the law has made such officer the proper judge of their sufficiency and competency. It is not, then, necessary for the patent to con-

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tain any recitals that the prerequisites to the grant of it have been duly complied with, for the law makes the presumption ; and if, indeed, it were otherwise, the recitals would [* 459] not help the case without the * auxiliary proof that these prerequisites had been, *de facto*, complied with. This has been the uniform construction, as far as we know, in all our Courts of justice upon matters of this sort. Patents for lands, equally with patents for inventions, have been deemed *prima facie* evidence that they were regularly granted, whenever they have been produced under the great seal of the government ; without any recitals or proofs that the prerequisites of the acts under which they have been issued have been duly observed. In cases of patents, the Courts of the United States have gone one step further, and as the patentee is required to make oath that he is the true inventor, before he can obtain a patent, the patent has been deemed *prima facie* evidence that he has made the invention. This objection, then, is overruled ; and there was no error in the Circuit Court in the admission of the patent.

The next exception is to the refusal of the Court to allow a witness, Josiah White, to give a description of an invention which he had seen on the Mauch Chunk Railroad, in 1827, which had a groove on one side, and run on the other on a flange for crossing, for the purpose of showing that the supposed invention of the plaintiff was known and in use by others, before the date of his patent. By the Patent Act of 1836, (which was applicable to the present point,) it is provided, in the fifteenth section, that whenever the defendant relies in his defence on the fact of a previous invention, knowledge, or use of the thing patented, he shall state in his notice of special matter to be used in his defence, the names and places of residence of those whom he intends to prove to have possessed a prior knowledge of the thing, and where the same had been used. The object of this most salutary provision is to prevent patentees being surprised at the trial of the cause,

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by evidence of a nature which they could not be presumed to know, or be prepared to meet, and thereby to subject them either to most extensive delays, or to a loss of their cause. It is incumbent on those who seek to show that the examination of a witness has been improperly rejected, to establish their right to have the evidence admitted; for the Court will be presumed to have acted correctly, until the contrary is established.

In the present case, there is no proof on the record that notice had been given according to the requirements of the the statute, that White was to be a witness for the purpose above stated. Unless such notice was given, it is plain that the examination could not be rightfully had. The *onus probandi* is on the defendants to show it, and unless they produce the notice, the objection must fail. In point of fact, it was admitted by counsel, at the argument, that no such notice was given. In either view, then, from the admission, or from the defect of the preliminary proof of notice in the record, the exception is not maintainable.

The next exception is to the refusal of the Court to allow certain questions to be put by the defendants to John H. B. Latrobe, a witness introduced by the defendants to maintain the issue on their part. Latrobe, on his examination, stated, "I know Mr. Stimpson * by sight and cha- [* 460] racter. He granted to the Baltimore and Ohio Railroad Company the privilege of using the curved ways on their railroad, and all lateral roads connected therewith. I fix the date of the contract in the early part of October, 1834, because I have then a receipt of Mr. Stimpson's counsel, for two thousand five hundred dollars. Mr. Stimpson laid his claim against the Baltimore Company for an infringement of his patent, in 1832. It was referred to me by the company, and I advised them." The counsel for the defendants then offered to prove by the same witness, the declarations of the

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plaintiff and his agent, to the witness, that the settlement made with the Baltimore and Ohio Railroad Company with the plaintiff, was not an admission by the said company of the plaintiff's right in the alleged invention, but a mere compromise of a pending suit, disconnected with a grant, in writing, made by the plaintiff to the said company; and to that end proposed to put the following questions, respectively, and in order, to the witness: "1. Do you know who was the agent or attorney of James Stimpson, in negotiating the arrangement and settlement between him and the company referred to? Who was he? 2. State if any conversations occurred between James Stimpson, or his agent, or counsel, at any time, during the negotiations, regarding the rights claimed by him in the patent for curved ways, without reference to the existence of a written contract, or its contents? 3. What were they?" The Court refused to allow these questions to be put, for the purpose aforesaid.

Now, (as has been already intimated,) it is incumbent upon those who insist upon the right to put particular questions to a witness, to establish that right beyond any reasonable doubt, for the very purpose stated by them; and they are not afterwards at liberty to desert that purpose, and to show the pertinency or relevancy of the evidence for any other purpose, not then suggested to the Court. It was not pretended at the argument, that the evidence so offered was good evidence in chief, in behalf of the defendants upon the issue in the cause. It was *res inter alios acta*, and had no tendency to disprove the defendant's title to the invention, or to support any title set up by the defendants; for no privity was shown between the defendants and the Baltimore Company. As evidence in chief, therefore, it was irrelevant and inadmissible. The sole purpose for which it was offered, so far as it was then declared to the Court, was to show, that the compromise with the Baltimore Company was

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not founded on any admission of the plaintiff's right in the invention. Be it so; it was then inconsequential; for it certainly had no just tendency to disprove his right. If the compromise had been offered on the part of the plaintiff, for the purpose of establishing his right to the invention, there is no pretence to say that it would have been admissible against the defendants. In the converse case, it is equally inadmissible for the defendants.

But it is now said that the evidence was in fact offered for the purpose of rebutting or explaining certain statements made by one * Ross Winans, a witness called [* 461] by the defendants, in his answers upon his cross-examination by the plaintiff's counsel. Now, this purpose is not necessarily, or even naturally, suggested by the purpose avowed in the record. Upon his cross-examination, Winans stated: "I understood there were arrangements made with the Baltimore Company. I heard the Company paid five thousand dollars." Now, certainly these statements, if objected to by the defendants, would have been inadmissible upon two distinct grounds. 1. First, as mere hearsay; 2. And, secondly, upon the broader principle, now well established, although sometimes lost sight of in our loose practice at trials, that a party has no right to cross-examine any witness except as to facts and circumstances connected with the matters stated in his direct examination. If he wishes to examine him to other matters, he must do so by making the witness his own, and calling him, as such, in the subsequent progress of the cause. The question then is presented, whether a party can, by his own omission to take an objection to the admission of improper evidence brought out on a cross-examination, found a right to introduce testimony in chief to rebut it or explain it. If, upon the cross-examination, Winans's answer had been such as was unfavorable to the plaintiff, upon the collateral matters thus asked, which were not founded in

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the issue, he would have been bound by it, and not permitted to introduce evidence to contradict it. There is great difficulty in saying that the defendants ought to be in a more favored predicament, and to acquire rights founded upon the like evidence to which they did not choose to make any objection, although otherwise it could not have been in the cause. But waiving this consideration, the grounds on which we think the refusal of the Court was right, are : first, that it was not distinctly propounded to the Court, that the evidence was offered to rebut or explain Winans's testimony ; and, secondly, that in the form in which it was put, it proposed to separate the written contract of compromise from the conversations and the negotiations which led to it, and to introduce the latter without the former, although it might turn out that the written paper might most materially affect or control the presumptions deducible from those conversations, and negotiations. We think that, upon the settled principles of law, parol evidence, bearing upon written contracts and papers, ought not to be admitted without the production of such written contracts or papers, so as to enable both the Court and the jury to see whether or not the admission of the parol evidence in any manner will trench upon the rule, that parol evidence is not admissible to vary or contradict written contracts or papers.

The next exception is to the admission of the evidence of William A. Stimpson, Richard Caton, and George Neilson, as to certain declarations, and statements, and conversations of the plaintiff, as to his invention prior to the date of his original patent ; in order to rebut the evidence of the defendants, as to the invention or use by other persons of the [* 462] same contrivance, before that date. The * objection is, that upon general principles, the declarations and conversations of a plaintiff, are not admissible evidence in favor of his own rights. As a general rule, this is undoubt-

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edly true. It is, however, but a general rule, and admits and requires various exceptions. There are many cases in which a party may show his declarations conflict with acts in his own favor, as a part of the *res gestæ*. There are other cases, again, in which his material declarations have been admitted. Thus, for example, in the case of an action for an assault and battery, and wounding, it has been held, that the declarations of the plaintiff, as to his internal pains, aches, injuries, and symptoms, to the physician called to prescribe for him, are admissible for the purpose of showing the nature and extent of the injuries done to him. See 1 Phillips on Evidence, ch. 12, sec. 1, p. 200 – 202, eighth ed., 1838. In many cases of inventions, it is hardly possible in any other manner to ascertain the precise time and exact origin of the particular invention. The invention itself is an intellectual process or operation; and, like all other expressions of thought, can in many cases scarcely be made known, except by speech. The invention may be consummated and perfect, and may be susceptible of complete description in words, a month, or even a year before it can be embodied in any visible form, machine, or composition of matter. It might take a year to construct a steamboat, after the inventor had completely mastered all the details of his invention, and had fully explained them to all the various artisans whom he might employ to construct the different parts of the machinery. And yet from those very details and explanations, another ingenious mechanic might be able to construct the whole apparatus, and assume to himself the priority of the invention. The conversations and declarations of a patentee, merely affirming that at some former period he invented that particular machine, might well be objected to. But his conversations and declarations, stating that he had made an invention, and describing its details and explaining its operations, are properly to be deemed an assertion of his right, at that time, as an inventor, to the extent of

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the facts and details which he then makes known ; although not of their existence at an antecedent time. In short, such conversations and declarations, coupled with a description of the nature and objects of the invention, are to be deemed a part of the *res gestæ* ; and legitimate evidence that the invention was then known to and claimed by him, and thus its origin may be fixed at least as early as that period. This view of the subject covers all the parts of the testimony of the witnesses objected to in the Circuit Court ; and we are of opinion, that the Court were right in admitting the evidence.

The next and the last exception is, to the rejection of the evidence of Dr. Jones, who was offered to prove that there were material differences between the patent of 1831 and the renewed patent of 1835, and to explain these differences.

No doubt can be entertained that the testimony thus [* 463] offered was, or might be, most material to * the merits of the defence. And the question is not as to the competency or relevancy of the evidence, but as to the propriety of its being admitted at the time when it was offered. It appears that the testimony was not offered by the defendants, or stated by them as a matter of defence, in the stage of the cause when it is usually introduced according to the practice of the Court. It was offered after the defendants' counsel had stated in open Court, that they had closed their evidence, and after the plaintiff, in consequence of that declaration, had discharged his own witnesses. The question, then, is, whether it was at that time admissible on the part of the defendants as a matter of right, or whether its admission was a matter resting in the sound discretion of the Court. If the latter, then it is manifest that the rejection of it cannot be assigned as error.

The mode of conducting trials, the order of introducing evidence, and the times when it is to be introduced, are, pro-

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perly, matters belonging to the practice of the Circuit Courts, with which this Court ought not to interfere ; unless it shall choose to prescribe some fixed, general rules on the subject, under the authority of the Act of Congress. Probably the practice in no two States in the Union is exactly the same ; and therefore, in each State, the Circuit Courts must necessarily be vested with a large discretion, in the regulation of their practice. If every party had a right to introduce evidence at any time, at his own election, without reference to the stage of the trial on which it is offered, it is obvious that the proceedings of the Court would often be greatly embarrassed, the purposes of justice be obstructed, and the parties themselves be surprised by evidence destructive of their rights, which they could not have foreseen, or in any manner have guarded against. It seems to us, therefore, that all Courts ought to be, as indeed they generally are, invested with a large discretion on this subject, to prevent the most mischievous consequences in the administration of justice to suitors ; and we think that the Circuit Courts possess this discretion in as ample a manner as other judicial tribunals. We do not feel at liberty, therefore, to interfere with the exercise of this discretion ; and, indeed, if we were called upon to say upon the present record, whether this discretion was, in fact, misapplied or not, we should be prepared to say, that we see no reason to doubt that it was, under all the circumstances, wisely and properly exercised. It is sufficient for us, however, that it was a matter of discretion and practice, in respect to which we possess no authority to revise the decision of the Circuit Court.

Upon the whole, we are of opinion, that the judgment of the Circuit Court ought to be affirmed with costs.

Eastman v. Bodfish. 1 Story.

ROBERT EASTMAN v. WILLIAM H. BODFISH.

[1 Story, 528. May T. 1841.]

Where a patent for the circular saw clapboard machine expired by lapse of time on the 15th of March, 1834, and Congress, by the Act of 3d of March, 1835, ch. 86, renewed it to A for the space of seven years, from the time when it expired, and the declaration in the writ, which was dated on the 13th of January, 1838, recited the original patent and the subsequent Act of Congress, and then stated generally a violation of the patent-right for a long time, to wit, for the space of three years and eight months, next preceding the date of the writ: It was *held*, that if the plaintiff intended to claim under the old patent, he should have filed a distinct and independent count; and that he had restricted himself to proof of a violation of the patent-right during the space of the said three years and eight months, specified in the declaration.

Whenever time is material, whether in matters of contract, or of tort, the plaintiff is strictly bound by the time specified in the declaration.

CASE for infringement of a patent-right "for a new and useful invention called the Circular Saw Clapboard Machine." The cause was tried upon the general issue. The original patent was granted to the plaintiff, Eastman, and one Josiah Jaquith, as the original inventors, on the 16th of March, 1820. The patent expired by lapse of time; and Congress by the Act of 3d of March, 1835, ch. 86, Jaquith being then dead, granted to the plaintiff, as survivor, the full and exclusive right and liberty of making, constructing, and vending to others to be used, the same invention for the term of seven years, from the 15th of March, 1834, when the original patent expired.

The declaration was founded upon the Act of 1835, ch. 86, and after reciting the original patent and the Act of Congress of 1835, and the new patent granted under the same, alleged as a breach, that the defendant "unlawfully, against the will of the plaintiff, and without any permission or license

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of the plaintiff, in infringement of the right and privilege secured to the plaintiff by the letters-patent, &c., did make, construct, and use, and vend to others to be used, the said saw and useful *iavention and continue [* 529] the use thereof for a long time previous to the date of the writ, to wit, for the space of three years and eight months next preceding the date thereof." The writ was dated the 13th of January, 1838.

Deblois, for the plaintiff, contended that he was entitled under the allegations in the declaration, to go into evidence to establish a violation of the patent by the defendant, under the original patent, which had expired, as well as under that of the Act of 1835.

Fox and Codman, a contra, insisted, that the plaintiff could not go into evidence of any such violation of the original patent; but was confined to the time, since the grant of the patent under the Act of 1835; and at all events, that the breach itself tied up the inquiry to the period of three years and eight months before the date of the writ.

STORY, J. I have no doubt whatsoever in the present case. By the frame of the declaration, the right of action is exclusively founded upon the Act of 1835; and there is nothing in the declaration, which points to any breach under the old patent, which expired on the 15th of March, 1834. In short, I cannot understand that the declaration purports to found any claim under the old patent, but the latter is merely recited as introductory to the right and title under the Act of 1835, and the violation thereof. If the plaintiff intended to have made any claim under the old patent, he should have filed a distinct and independent count.

Moreover, I am of opinion, in this case, that the plaintiff

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has by the breach, as stated in the declaration, tied himself up to a violation of the patent-right within three years and eight months before the date of the writ; that is, before the 13th of January, 1838. In cases under the patent laws, I conceive, that the plaintiff is confined to giving evidence [* 530] of the making, constructing, or using the invention in violation of his patent-right during the period which he specifies in his declaration. If it were otherwise, the recovery in the suit would be no bar to another action for any anterior breach, since it could not judicially appear, that any damages had been recovered for any such anterior breach; and the form of the declaration itself, specifying the term, would repel any presumption to the contrary. Besides, the length of time of the use is, or at least may be, a very material ingredient in the ascertainment and assessment of the damages by the jury, and the plaintiff ought to give notice by his declaration of the term of the user, for which he seeks damages. It is by no means true, that the specification of time is in all cases immaterial to be proved, as laid in the declaration. Wherever time is material, not only in matters of contract, but in matters of tort, the plaintiff is strictly bound by that time. Now, in trespass with an allegation of a *continuando*, or *diversis diebus*, if the plaintiff insists upon proving repeated acts of trespass, he will not be allowed to give evidence thereof, unless committed within the time specified.¹ In truth, the usual mode of declaring in actions for an infringement of a patent is, to allege, that the defendant on such a day (naming it) "and on divers other days and times between that day and the day of the commencement of the suit (or exhibiting the bill) did unlawfully,

¹ Chitty on Plead. 3d edit. p. 258; 1 Saund. Rep. by Williams, p. 24, note 1; Brook v. Bishop, 2 Ld. Raym. 823; Monkton v. Pashley, Id. 974, 976; Com. Dig. Pleader, C. 19; 2 Starkie on Evid. 210, 2d Lond. edit.

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&c., make and sell and use, &c.”¹ The district judge concurred in this opinion.

Mem. The cause afterwards proceeded before the jury, who found a verdict for the defendant.

DAVID PROUTY AND ANOTHER v. DRAPER, RUGGLES, & Co.

[1 Story, 568. October T. 1841.]

Where the plaintiff claimed the combination of three things, as his invention, in a patent for an improvement in the construction of ploughs; it was *held*, that the patent was for the entire combination of the three, and not for a combination of any two of them; and, therefore, it was no infringement of the patent to construct ploughs containing two of them.

THIS was an action on the case for an infringement, by the defendants, of a patent of the plaintiffs, for “a new and useful improvement in the construction of the plough.” The defendants pleaded the general issue, and also filed a specification of special matters of defence under the Patent Act of 4th of July, 1836, ch. 357.

At the trial, various questions, both of law and fact, were made by the defendants, under their different specifications of matters of defence; but the cause finally went off upon a question of law, arising upon the construction of the specification of the patent. The patent was dated the 4th of March, 1836. The specification was as follows:

Be it known, that we, the said Prouty and Mears, have jointly invented, made, and applied to use a new and useful improvement in the construction of the plough, which inven-

¹ 2 Chitty, Pl. 3d ed. p. 356, 357; Phillips on Patents, p. 522, ed. 1837.

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tion and improvement we describe and specify as follows, namely :

Heretofore, the standard and landside of the plough has been placed perpendicular to, and at right angles with, the plane of the share. On this standard the beam has been placed in such a manner, as to form an acute angle with the landside, of such extent as to place that part of the beam, to which the moving power is applied, at the distance of three or more inches from an extended line of the land- [* 569] side to the right, * while the after part of the beam extends one or more inches to the left of the perpendicular of the landside near the handle. The object has been to cause the plough "to run to land," or hold its width of furrow; the effect produced has been an uneasy, struggling motion, as it meets resistance at the point, wing, or heel.

We make our ploughs with the standard and landside forming an acute angle with the plane of the share, the standard inclining to the right or furrow side, in such manner as to enable us to place the centre of the beam on a line parallel with the landside, the forepart thereof at such distance from the extended line aforesaid, as to cause the plough to hold its width of furrow, and the after part falling within the perpendicular of the landside of the plough, the centre of it being nearly perpendicular to the centre of resistance on the mould-board; which we conceive to be at about one fourth part of the lateral distance from the landside to the wing of the share, and at about one third part of the perpendicular height from the plane of the share to the upper edge of the mould-board. This location of the centre of resistance, we base on the fact, that many ploughs, which have been used in sharp, sandy soils, have been worn quite through at that point. The result of this formation of the plough, is a steady, well-balanced motion, requiring less power of draft, and less effort in directing the plough in its course.

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The inclination of the standard and landside, causes the plough to cut under and take up the furrow in the form of an oblique-angled parallelogram, or like a board feather-edged, which, being turned over, falls in level with the last furrow more readily than the right angled or square-edged work.

The coulter or knife, having a similar inclination, cuts the roots of the grass, &c., and leaves all vegetable matter on the surface, at a greater distance from the under edge of the *furrow, which, being turned over, more [* 570] readily falls in, and is far better covered than with square-edged work. The top of the standard, through which the bolt passes to secure the beam, is transversely parallel to the plane of the share, and extends back from the bolt to such a distance, as to form a brace to the beam, where the after part is pressed down by lifting at the forepart, the share being fast under a rock, or other obstruction. The after part of this extension is squared in such manner, that, being jogged into the beam, it relieves the bolt in heavy draft.

The bolts, which we use to fasten the pieces of cast iron (of which our ploughs are made) together and to the wood-work, are round, with inverted convex heads, or like the woodscrew, with a projection on the under side of the head of semicircular form, which fits into a groove in the counter-sink part of the bolthole, as it is cast to receive it, which not only prevents its turning, but also diminishes the liability of breakage at the corners of square holes; all which will more fully appear by reference to the drawing annexed to and forming part of this specification.

We hereby declare, that what we claim as new, and of our invention, is the construction of such ploughs as aforesaid, and the several parts thereof, not separately, but in combination for the purposes aforesaid, namely: 1st. The inclining the standard and landside so as to form an acute angle with the plane of the share. 2d. The placing the beam on a line

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parallel to the landside within the body of the plough, and its centre nearly in the perpendicular of the centre of resistance. 3d. The forming the top of the standard for brace and draft.

We do not intend to confine our claim to any particular form or construction, excepting such form as may be necessary to place the beam in the perpendicular of the centre of resistance, and parallel to the landside; and also, to [* 571] such * form of the top of the standard, as shall serve for brace and draft, but have given such form, as we deem to be most convenient, which may be varied, as is obvious.

It was admitted at the trial, that the defendants' ploughs were exactly in all respects like those of the plaintiffs, except that the defendants did not in their ploughs extend back the top of the standard, or jog, in the manner stated in the specification, and described in the third part of the summing up of the invention.

It was contended by the counsel for the defendants, *Dexter*, *Ruggles*, and *Allen*, that as the defendants' plough did not embrace the whole combination, which the plaintiffs' plough did, and as the patent was for a combination only, there was no infringement of the plaintiffs' patent. On the other hand, it was contended by the plaintiffs' counsel, *Charles G. Loring*, and *Grey*, and *Gleason*, that the use of two parts of the combination, without embracing the third, was an infringement of the patent.

STORY, J. I am entirely satisfied, that the true construction of the present patent is that it is a patent for a combination and for a combination only. The combination, as stated in the summing up, consists of three things; and it is as follows: "1st. The inclining the standard and landside so as to form an acute angle with the plane of the share. 2d. The

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placing the beam on a line parallel to the landside within the body of the plough, and its centre nearly in the perpendicular of the centre of resistance. 3d. The forming the top of the standard for brace and draft." Unless, then, it is proved, that the whole combination is substantially used in the ploughs of the defendants, it is not an infringement of the plaintiffs' patent, although one or more of the parts, as above specified, in the summing up in the patent, may be

* used in combination by the defendants. The [* 572] plaintiffs' patent is for an entire combination of all the three things, and not for a combination of any two of them. A patent for a combination of A, B, and C, cannot be technically or legally deemed at once a combination of A, B, and C, and of A and B alone. I think, also, that the plaintiff, by the summing up in his patent, has treated the jogging of the standard behind, as well as the extension thereof to be essential parts of his combination, for the purpose of brace and draft; and not deemed either of them separately, and alone, and independent of the other. I deduce this from the language used in the third part of the summing up, which has a necessary reference to, and is explicable only by the antecedent descriptive part of the specification, as to the forming of the standard "for brace and draft." The language there used is as follows:—"The top of the standard, through which the bolt passes to secure the beam, is transversely parallel to the plane of the share, and extends back from the bolt to such a distance as to form a brace to the beam, where the after part is pressed down by lifting at the forepart, the share being fast under a rock or other obstruction. The after part of this extension is squared in such a manner, that, being jogged into the beam, it relieves the bolt in heavy draft." If the reference had been direct and positive to the descriptive part of the specification in the summing up, as by adding after the words "for brace and

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draft," the words "in the manner above mentioned," or "by the extension and jogging as aforementioned," there could be no doubt, in my judgment, that both were treated by the plaintiff in his patent as essential parts of his combination for the very purposes stated, namely, "for brace and draft." Now, it seems to me, that this is the necessary interpretation of the summing up, precisely as if the words had been actually used; and that it would not be intelligible without them.

[* 573] * I regret that this is the conclusion to which my mind has arrived; but I cannot avoid it. I shall still more regret, that the cause should be decided upon this mere technical point, when, if the other points of defence, taken by the defendants' counsel, are made out by the proofs, there is an end of the cause, independently of this technical construction. For example, if it is established in proof, as the defendants' counsel insist, that they can establish, that the inclining of the standard and landside, so as to form an acute angle with the plane of the share has been long known before, (for the defendants certainly have a right to use what was common before, and as far as it was common,) it will then amount only to this, that, as the defendants have not used the whole combination, but a part or parts only thereof, there has been no infringement of the plaintiffs' patent. So, if there is, in fact, no such centre of resistance, as stated in the specification, or if the formulary for placing the beam will not place it parallel to that centre of resistance within the plough, the same difficulty in maintaining the patent may arise. However, it is for the parties to say, whether they will proceed in the cause on these and the other points in controversy.

Mem. The defendants declined to proceed; and a verdict was taken for the defendants, with the understanding, that a bill of exceptions would be taken to the decision of the Court

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for the purpose of a final decision in the Supreme Court. The cause was accordingly carried to the Supreme Court upon a bill of exceptions, and at January term, 1842, the judgment of the Circuit Court was affirmed.

JESSE REED v. ELISHA P. CUTTER AND OTHERS.

[1 Story, 590. October T. 1841.]

Under the Patent Laws of the United States, the applicant for a patent must be the first, as well as the original inventor; and a subsequent inventor, although an original inventor, is not entitled to a patent, if the invention is perfected and put into actual use by the first and original inventor; and if it is of no consequence, whether the invention is extensively known or used, or whether the knowledge or use thereof is limited to a few persons, or even to the first inventor himself, or is kept a secret by the first inventor.

The decision in Dolland's case, that a first and original inventor, who had kept his invention a secret so that the public had no benefit thereof, could not defeat the patent of a subsequent original inventor, may be a correct exposition of the Statute of Monopolies, (Stat. of 21 James I. ch. 3, § 6); but it is not applicable to the Patent Law of the United States.

The language of the Patent Act of 1836, ch. 357, § 6, "not known or used by others before his or their discovery thereof," does not require that the invention should be known or used by more than one person, but merely indicates that the use should be by some other person or persons than the patentee.

Under the Patent Act of 1836, (ch. 357, § 15,) an inventor, who has first actually perfected his invention, will not be deemed to have surreptitiously or unjustly obtained a patent for that which was in fact first invented by another, unless the latter was, at the time, using reasonable diligence in adapting and perfecting the same. But he who invents first is entitled to the prior right, if he is using reasonable diligence in adapting and perfecting the same, although the second inventor has in fact first perfected the same, and first reduced the same to practice in a positive form.

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 patentable under the laws of the United States. He is the first inventor in the sense of the Patent Act of the United States,

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and entitled to a patent for his invention, who has first perfected and adapted the same to use; and, until the invention is so perfected and adapted to use, it is not patentable.

It seems that in a race of diligence between two independent inventors, he who first reduces his invention to a fixed and positive form, is entitled to a priority of a right to a patent therefor.

[* 591] * A disclaimer, to be effectual for all intents and purposes, under the Act of 1837, ch. 45, (§§ 7 and 9,) must be filed in the Patent-Office before the suit is brought. Unless it is so filed before the suit, the plaintiff will not be entitled to recover costs in such suit, even if he should establish at the trial, that a part of the invention, not disclaimed, has been infringed by the defendant. Where a disclaimer has been filed, either before or after the suit is brought, the plaintiff will not be entitled to the benefit thereof, if he has unreasonably neglected or delayed to enter the same at the Patent-Office; for an unreasonable neglect or delay will constitute a good defence and objection to the suit.

CASE for infringement of two patent-rights; one for "A new and useful improvement in the pump;" the second for "A new and useful improvement in the cast-iron pump." The declaration contained two counts, one applicable to each patent.

The first patent was to Jesse Reed, the plaintiff, and was dated August 5th, 1831. The improvement claimed by this, and which it was alleged the defendants had infringed, was described in the specification as follows: "Under the flange is a plate about twelve inches in diameter, of suitable thickness for the strength required; near the circumference of the plate are a sufficient number of holes for wood screws or bolts, that said plate may be attached to any board or plank in whatever place said pump may be used." . . . "The lower valve is attached to the lower plate by copper screws or rivets, so that the pump may be taken off to come at the lower valve without disturbing the lower plate or pipe." The words of the claim of that part alleged to have been infringed by the defendants, were as follows: "The bottom plate in a horizontal manner with a valve attached to it, and playing upon said elevation, and the manner of connecting it with the plate, as set forth in the specification."

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The second patent was to Jesse Reed and Josiah Reed, and was dated 19th November, 1833. Subsequently, Josiah assigned his interest to Jesse. Among other improvements * claimed by this last patent is that, [* 592] which is now in so general use in metal pumps, of letting off the water from the cylinder of the pump, by throwing up the handle. The lower valve is armed with a projection, which, when the handle is thrown up to its greatest extent, opens the valve of the piston, at the same time that the lower valve itself is opened by means of the pressure of this projection against the internal sides of the piston. In this way water in the cylinder may be let off readily, and the important object attained of guarding effectually against the effect of frost in the cold season of the year. It was alleged, that the defendants had infringed this part of the plaintiff's patent. Plea, the general issue, with special matters of defence filed.

At the trial, evidence was offered tending to show, that the improvement of letting off the water, claimed, in the second patent, had been invented and reduced to practice by Anthony D. Richmond, of New Bedford, some time in 1828, and that he had made several pumps containing this improvement, before the date of the plaintiff's patent. It was suggested by the counsel for the plaintiff, that there was evidence tending to rebut this evidence; and a question was raised, as to the degree of use and publicity of a prior invention, which would operate, in point of law, to defeat a *bonâ fide* original invention, which had been patented.

Charles Sumner, for the plaintiff. (1.) The object of the exclusive privilege of a patent is to secure to the public the communication of a species or mode of industry, which it did not before possess. Therefore, the patent of a *bonâ fide* original inventor will be valid, unless an invention be shown,

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which, anterior to the invention of the patentee, was reduced to practice in such a way and to such an extent, as to give the public knowledge of its existence.

The statute of the United States of 1836, cap. [* 593] 357, § 6, * provides, that "any person or persons having invented any new and useful art, machine, &c., not known or used by others, before his or their discovery or invention thereof," and who makes oath, that he verily believes, that "he is the original and first inventor or discoverer," &c., shall be entitled to a patent. In another section of the same statute, § 15, it is provided, that the defendant may give in evidence, "that the patentee was not the original and first inventor or discoverer of the thing patented," &c. If we were to consider the first clause by itself, without reference to that in the 16th section, it would seem clear, that an invention must have been known and used by others, before the discovery of the patentee, in order to defeat the patent. The term "others" would seem to imply general and plural knowledge, in contradistinction to knowledge by an individual. Unless this effect is given to this word, it loses much of its significance. The word, however, is borrowed from the English Statute of Monopolies, out of which the English Patent Law is carved, which secures a patent to the first and true inventor of an art, "which others at the time of making such letters-patent and grants shall not use." These words have received repeated constructions in England. It has there been decided, that a prior invention, in order to defeat the patent of a subsequent true and original inventor, must have been "generally known;" that it must have been in "public use and operation;" "used openly in public," and not abandoned as useless by the first inventor. See *Lewis v. Marling*, 10 Barn. & Cress. 22; *S. C. Godson's Supplement*, 6, 7, 8; *Jones v. Pearce*, *Id.* 10, 12. Mr Godson's own language (p. 4, of the Supplement) admits the above cases to be law.

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The statute of the United States of 1793, cap. 65, § 1, says, "not known or used before the application," &c. These words have received a construction from the Supreme Court * of the United States. Story, J., in [* 594] delivering the opinion of the Court, in *Pennock v. Dialogue*, (2 Peters, S. C. R. 19,) said: "We think, then, the true meaning must be, not known or used by the public before the application. McLean, J., in delivering the opinion of the Court, in *Shaw v. Cooper*, (7 Peters, 319,) said: "The knowledge or use spoken of in the Act of 1793 could have referred to the public only." The words used by the Court are broad, explicitly declaring, that the knowledge and use must be by the public. It appears, that in the cases actually before them, the knowledge and use had been derived from and under the patentee, having crept abroad before he had secured his invention by letters-patent. But, it is submitted, that in view of the language employed by the Court, and afterwards in the statute, the difference between those cases and the present does not authorize a different construction. How can the Court restrain the word "others" to mean only those, who have derived their knowledge from the patentee? Particularly when this word is employed in the English statute, and has there received the construction now contended for?

The clause in the 16th section can hardly throw doubt upon this construction. The clause in the 1st section is the granting part of the statute, which is to be construed amply for the citizen, particularly in an act of the present nature. The whole act must be construed, so as to give each clause its fullest effect; and no word or phrase is to be curtailed of its proportions, unless it is essential to a reasonable construction of the whole statute. If, in the present case, it is necessary to abate from any clause of the statute any of the just effect, which such clause would have, if taken by itself, we must

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restrain the clause in the 16th section ; or in other words, it must be construed by reference to the granting clause in the 1st section. He must be considered the first and [* 595] original inventor, * who has invented an art or machine, not known or used by others before his discovery thereof.

In confirmation of this view is Dolland's case, (2 H. Black. R. 487 ; Phillip's Patents, 165,) where the first inventor reduced his invention to use, but kept it secret, and showed an intention not to give the public the benefit of it. It was the case of an improvement in the object-glass of telescopes, invented by Mr. Hall, but suppressed by him until Mr. Dolland had subsequently made the same invention, and procured a patent for it, the validity of which was disputed on the ground that he was not the first inventor. But the patent was held to be valid. Mr. Phillips (Patents, 165) says this case must stand on the ground that the first inventor did not give the public that advantage which it was the intention of the Patent Laws to secure ; he should not stand in the way of a subsequent inventor, who should be ready to give the public such advantage at the end of the period provided for by the Patent Laws. This doctrine was recognized in a subsequent case. Forsyth v. Reviere, (Chitty, Jr. Prerog. of the Crown, 182, n.)

The object of the Patent Law is to promote the progress of useful arts: 1st, by stimulating ingenious minds to make inventions: 2d, to secure to the public the benefit of the inventions, by having the secret fully divulged on the expiration of the patent. It is said, indeed, that the future divulging of the secret is the consideration of the grant of exclusive privileges. Let us bear this in mind in construing these words " known and used." If the thing be known and used, the public good does not require the interference of the Patent Law, either to stimulate inventors or to secure the

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divulging of the secret, for the invention is already made, and the secret is divulged. If the thing, however, be not so known and used that the public will eventually have it, as if it be kept an entire secret, like Dolland's glass, or if it be thrown by as *useless, or if it be used in private [* 596] and in a corner, then it will justify the protection of the Patent Law : — *Dignus vindice nodus*. It is effectually reached by its spirit, and is not discharged by its letter. The original inventor, who afterwards *bonâ fide* hits upon it, and matures it into something useful, deserves well.

The Patent Laws of Austria, (§ 27, (a.) (d.) Phillips on Patents, 516, 517,) provide that every discovery, invention, improvement, or change, shall be held as new, if it is not known in the monarchy, either in practice or by a description of it contained in a work publicly printed."

(2.) The counsel for the plaintiffs submitted another point, in the words of Mr. Phillips, in his work on Patents, (p. 395,) being a construction which this acute and learned author has put upon two clauses of the 15th section of the Patent Law of 1836. It was as follows: "If the patentee is the original inventor of the thing patented, his patent shall not be defeated by proof that another person had anticipated him in making the invention, unless it also be shown that such person was adapting and perfecting his invention."

Benjamin Rand, for the defendants, *e contrâ*.

STORY, J., overruled both points, and said: Under our Patent Laws, no person, who is not at once the first, as well as the original inventor, by whom the invention has been perfected and put into actual use, is entitled to a patent. A subsequent inventor, although an original inventor, is not entitled to any patent. If the invention is perfected and put into actual use by the first and original inventor, it is of no

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consequence, whether the invention is extensively known or used, or whether the knowledge or use thereof is limited to a few persons, or even to the first inventor himself. It is sufficient that he is the first inventor, to entitle him to [* 597] a patent; and no subsequent *inventor has a right to deprive him of the right to use his own prior invention. The language of the Patent Act of 1836, ch. 357, §§ 6, 15, and of the Patent Act of 1837, ch. 45, § 9, fully establishes this construction; and, indeed, this has been the habitual, if not invariable interpretation of all our Patent Acts from the origin of the government.¹ The language of the Act of 1836, ch. 357, § 6, "not known or used by others before his or their discovery thereof," has never been supposed to vary this construction, or to require that the invention should be known to more than one person, if it has been put into actual, practical use. The Patent Act of 1790, used the language, "not before known or used," without any adjunct, (Act of 1790, ch. 34, § 1); and the Act of 1793, used the language "not known or used before the application," (Act of 1793, ch. 55, § 1); and the latter act (§ 6,) also made it a good matter of defence that the thing patented "had been in use" anterior to the supposed discovery of the patentee. It early became a question in our courts, whether a use by the patentee himself before his application for a patent would not deprive him of his right to a patent. That question was settled in the negative; and the language of the first section of the Act of 1793, ch. 55, was construed to be qualified and limited in its meaning by that of the sixth section;

¹ See Phillips on Patents, ch. 6, § 4, p. 65, 66, edit. 1837. Woodcock v. Parker, 1 Gallis. R. 488, *ante*, Vol. I. 37; Gray v. James, Peters, Cir. R. 394, *ante*, Vol. I. 120; Rutgen v. Kanows, 1 Wash. Cir. R. 168, *ante*, Vol. I. 1; Evans v. Eaton, 3 Wheat. R. 454, *ante*, Vol. I. 243; Pennock v. Dialogue, 2 Peters, R. 1, 16, 20, 21, 22, *ante*, Vol. I. 542.

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and the words "not known or used before the application," in the first section, were held to mean, not known or used by the public before the application.¹ The case of *Pennock v. Dialogue*, (2 Peters, R. 1, 18 to 22,) is a direct authority to this *effect. And it was probably in [* 598] reference to that very decision, that the words "by others" were added in the Act of 1836, ch. 357, § 6, by way of explanation of the doubt formerly entertained on the subject. The words "by others" were not designed to denote a plurality of persons, by whom the use should be, but to show that the use should be by some other person or persons than the patentee. It would be strange, indeed, if, because the first inventor would not permit other persons to know his invention, or to use it, he should thereby be deprived of his right to obtain a patent, and it should devolve upon a subsequent inventor merely from his ignorance of any prior invention or prior use; or that a subsequent inventor should be entitled to a patent, notwithstanding a prior knowledge or use of the invention by one person, and yet should be deprived of it by a like knowledge or use of it by two persons. In *Pennock v. Dialogue*, (2 Peters, R. 1, 23,) the Supreme Court expressly held, that the sixth section of the Patent Act of 1793, ch. 55, then in force, (and on this point the law has not undergone any alteration,) "gives the right to the first and true inventor, and to him only; if known or used before his supposed discovery, he is not the first, although he may be the true inventor; and that is the case to which the clause looks."

I am aware of *Dolland's* case; but I do not consider it to be a just exposition of the Patent Law of this country, how-

¹ See *Morris v. Huntington*, Paine, Cir. R. 348, *ante*, Vol. I. 448; *Pennock v. Dialogue*, 2 Peters, R. 1, 18, 19, 21, 22, *ante*, Vol. I. 542; *Mellus v. Silsbee*, 4 Mason, R. 108, *ante*, Vol. I. 506.

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ever correctly it may have been decided under that of England. In that case, it seems to have been held, that Dolland was entitled to his patent, because he was an inventor of the thing patented, although there was a prior invention thereof by another person, who, however, had kept it a secret, so that the public had no benefit thereof. And, perhaps, this was not an unjustifiable exposition of the Statute of Monopolies, (Stat. of 21 James I. ch. 3, § 6,) under which pa- [* 599] tents are * granted in England. But the language of our Patent Acts is different. The Patent Act of 1836, (ch. 257, §§ 7, 8, 13, 15, 66,) expressly declares that the applicant for a patent must be the first as well as an original inventor.

The passage cited from Mr. Phillips's work on Patents, (p. 395,) in the sense in which I understand it, is perfectly accurate. He there expressly states, that the party claiming a patent must be the original and first inventor; and that his right to a patent will not be defeated by proof, that another person had anticipated him in making the invention, unless such person "was using reasonable diligence in adapting and perfecting the same." These latter words are copied from the fifteenth section of the Act of 1836, (chapter 357,) and constitute a qualification of the preceding language of that 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 first invented by another, unless the latter was at the time using reasonable diligence in adapting and perfecting the same. And this I take to be clearly law; for he is the first inventor in the sense of the Act, and entitled to a patent for his invention, who has first perfected and adapted the same to use; and until the invention is so perfected and adapted to use, it is not patentable. An imperfect and incomplete invention, resting in mere theory or in intellectual notion, or in uncer-

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tain 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 our Patent Acts ; since it is utterly impossible, under such circumstances, to comply with the fundamental requisites of those acts. In a race of diligence between two independent inventors, he who first reduces his invention to a fixed, positive, and practical form, would seem to be entitled * to a priority of right to a patent there- [* 600] for.¹ The clause of the fifteenth section, now under consideration, seems to qualify that right, by providing that in such cases, he who invents first shall have the prior right, if he is using reasonable diligence in adapting and perfecting the same, although the second inventor has, in fact, first perfected the same, and reduced the same to practice in a positive form. It thus gives full effect to the well known maxim, that he has the better right who is prior in point of time, namely, in making the discovery or invention. But if, as the argument of the learned counsel insists, the text of Mr. Phillips means to affirm, (what I think it does not,) that he, who is the original and first inventor of an invention, so perfected and reduced to practice, will be deprived of his right to a patent, in favor of a second and subsequent inventor, simply because the first invention was not then known or used, other persons, than the inventor, or not known or used to such an extent as to give the public full knowledge of its existence, I cannot agree to the doctrine ; for, in my judgment, our Patent Acts justify no such construction.

In respect to another point stated at the argument, I am of opinion that a disclaimer, to be effectual for all intents and purposes, under the Act of 1837, ch. 45, § 7 and 9, must be

¹ Woodcock v. Parker, 1 Gallis. R. 438 ; ante, Vol. I. 37.

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filed in the Patent-Office before the suit is brought. If filed during the pendency of the suit, the plaintiff will not be entitled to the benefit thereof in that suit. But if filed before the suit is brought, the plaintiff will be entitled to recover costs in such suit, if he should establish, at the trial, that a part of the invention, not disclaimed, has been infringed by the defendant. Where a disclaimer has been filed, either before or after the suit is brought, the plaintiff will [* 601] not be *entitled to the benefit thereof, if he has unreasonably neglected or delayed to enter the same at the Patent-Office. But such an unreasonable neglect or delay will constitute a good defence and objection to the suit.

Mem. The cause was then continued on the motion of the plaintiffs.

DAVID PROUTY AND JOHN MEARS, PLAINTIFFS IN ERROR, v
DRAPER RUGGLES ET AL., DEFENDANTS IN ERROR.

[16 Peters, 336. January T. 1842.]

The plaintiffs, in the Circuit Court, claimed damages for the infringement of their patent for "a new and useful improvement in the construction of a plough." The claim of the patentee was for the combination of certain parts of the plough, not for the parts separately. The Circuit Court charged the jury, that unless it is proved that the whole combination is substantially used in the defendant's plough, it is not a violation of the plaintiff's patent; although one more of the parts specified in the letters-patent may be used in combination by the defendant. The plaintiffs, by their specification and summing up, treated the parts described as essential parts of their combination, for the purpose of brace and draft; and the use of either alone by the defendant would not be an infringement of the combination patented. *Held*, that the instructions of the Circuit Court were correct.

The patent is for a combination, and the improvement consists in arranging different portions of the plough, and combining them together in the manner stated in the specification, for the purpose of producing a certain effect.

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None of the parts referred to are new, and none are claimed as new; nor is any portion of the combination less than the whole claimed as new, or stated to produce any given result. The end in view is proposed to be accomplished by the union of all, arranged and combined together in the manner described; and this combination, composed of all the parts mentioned in the specification, and arranged with reference to each other, and to other parts of the plough in the manner therein described, is stated to be the improvement, and is the thing patented. The use of any two of these parts only, or of two combined with a third, which is substantially different in the form, or in the manner of its arrangement and connection with the others, is, therefore, not the thing patented. It is not the same combination, if it substantially differs from it in any of its parts.

IN error to the Circuit Court of the United States, for the district of Massachusetts.

The plaintiffs in error instituted a suit in the Circuit Court of Massachusetts, for the recovery of damages for the violation of a patent granted to them by the United States, for a new and useful improvement in the construction of a plough.

The cause was tried before a jury, at October Sessions of the Circuit Court, in 1841, and a verdict and judgment were rendered for the defendant. The plaintiffs took exceptions to the charge of the Court, and prosecuted this writ of error.

The case was submitted to the Court on printed arguments by *Mr. Choate, for the plaintiffs in [*337] error; and by Mr. Dexter, for the defendants. The case was fully stated in the opinion of the Court.

Mr. Chief Justice TANEY delivered the opinion of the Court.

This case is brought here by a writ of error to the Circuit Court of the United States, for the district of Massachusetts.

The action was instituted for the purpose of recovering damages for an infringement of a patent, which the plaintiffs

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had obtained for an improvement in the construction of the plough.

The invention is described in the specification, as follows :

“ Be it known, that we, the said Prouty and Mears, have jointly invented, made, and applied to use, a new and useful improvement in the construction of the plough, which invention and improvement we describe and specify as follows, namely :

Heretofore, the standard and landside of the plough has been placed perpendicular to, and at right angles with the plane of the share ; on this standard the beam has been placed in such manner as to form an acute angle with the landside, of such extent as to place that part of the beam to which the moving power is applied at a distance of three or more inches from an extended line of the landside, to the right ; while the after-part of the beam extends one or more inches to the left of the perpendicular of the landside, near the handle ; the object has been to cause the plough ‘ to run to land,’ or hold its width of furrow. The effect produced has been an uneasy, struggling motion, as it meets resistance at the point, wing, or heel.

We make our plough with the standard and landside forming an acute angle with the plane of the share, the standard inclining to the right or furrow side, in such manner as to enable us to place the centre of the beam on a line parallel with the landside, the forepart thereof at such a distance from the extended line aforesaid, as to cause the plough to hold its width of furrow, and the after-part falling within the perpendicular of the landside of the plough, the centre of it being nearly perpendicular to the centre of resistance, on the mould-board, which we conceive to be at about one fourth part of the lateral distance from the landside to the wing of the [* 338] share, and at about one third part of the * perpendicular height from the plane of the share to the upper edge of the mould-board.

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This location of the centre of resistance, we base on the fact, that many ploughs which have been used in sharp, sandy soils have been worn quite through at that point. The result of this formation of the plough, is a steady, well-balanced motion, requiring less power of draft, and less effort in directing the plough in its course.

The inclination of the standard and landside causes the plough to cut under, and take up the furrow in the form of an oblique-angled parallelogram, or like a board, feather-edged, which, being turned over, falls on a level with the last furrow more readily than right-angled or square-edged work.

The coulter or knife, having a similar inclination, cuts the roots of the grass, &c., and leaves all vegetable matter on the surface, at a greater distance from the under edge of the furrow, which, being turned over, more readily falls in, and is far better covered than with the square-edged work.

The top of the standard, through which the bolt passes to secure the beam, is transversely parallel to the plane of the share, and extends back from the bolt to such a distance as to form a brace to the beam, when the after-part is passed down by lifting at the forepart; the share being fast under a rock, or other obstruction, the after-part of this extension is squared in such manner, that being jogged into the beam, it relieves the bolt in heavy draft.

The bolts which we use to fasten the pieces of cast iron, of which our ploughs are made, together, and the wood-work, are round, with inverted convex heads, like the wood-screw, with a projection on the under side of the head, of semicircular form which fits into a groove in the counter-sink part of the bolt hole, as it is cast to receive it, which not only prevents its turning, but also diminishes the liability of breakage at the corners of square holes; all which will more fully appear by reference to the drawing annexed to, and forming part of this specification.

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We hereby declare, that what we claim as new, and of our invention, is the construction of such ploughs as aforesaid, and the several parts thereof, not separately, but in combination, for the purposes aforesaid, namely :

[*339] * 1. The inclining the standard and landside so as to form an acute angle with the plane of the share.

2. The placing the beam on a line parallel to the landside, within the body of the plough and its centre, nearly in the perpendicular of the centre of resistance.

3. The forming the top of the standard for brace and draft. We do not intend to confine our claim to any particular form or construction, excepting such form as may be necessary to place the beam in the perpendicular of the centre of resistance, and parallel to the landside, and also to such form of the top of the standard, as shall serve for brace and draft, but have given such form as we deem to be most convenient, which may be varied, as is obvious."

The plaintiffs offered to prove the utility of the alleged improvement, which proof was dispensed with by the defendants. Certain ploughs alleged by the plaintiffs to be made in conformity with their letters-patent, and certain ploughs made by the defendants, which were the alleged infringement of the plaintiff's patent, were produced in Court; and no substantial difference between them was shown by the defendants to exist, unless the fact, that the top of the standard in the defendant's plough was not jogged into the beam, and did not extend so far back upon the beam, was to be so considered.

And the plaintiffs offered evidence to show that the top of the standard formed, as stated in the specification, would serve for both purposes of brace and draft, although not jogged into the beam.

The defendants introduced no evidence. The counsel for

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the plaintiffs requested the Court to instruct the jury as follows, to wit:

The counsel of plaintiffs respectfully move the Court to instruct the jury, that if the defendants have used, in combination with the other two parts, a standard of the description set forth in the specification, and it is proved to serve both for brace and draft, such use was an infringement of the plaintiffs' claim in that particular, although the defendants may not have inserted it into a jog in the beam.

Also, that if any two of the three parts described, as composing the construction claimed in the specification, had been used in *combination by the defendants, [* 340] it was an infringement of the patent, although the third had not been used with them.

The Court refused to give the instructions so prayed, or either of them, in manner and form as prayed by the plaintiffs; but did instruct the jury as follows, to wit:

That upon the true construction of the patent, it is for a combination, and for a combination only. That the combination, as stated in the summing up, consists of three things, namely:

1. The inclining the standard and landside so as to form an acute angle with the plane of the share.
2. The placing the beam on a line parallel to the landside, within the body of the plough and its centre, nearly in the perpendicular of the centre of resistance.
3. The forming the top of the standard for brace and draft.

That unless it is proved, that the whole combination is substantially used in the defendant's ploughs, it is not a violation of the plaintiffs' patent, although one or more of the parts specified, as aforesaid, may be used in combination by the defendants. And that the plaintiffs, by their specification and summing up, have treated the jogging of the standard behind,

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as well as the extension, to be essential parts of their combination for the purpose of brace and draft; and that the use of either alone by the defendants would not be an infringement of the combination patented.

And thereupon the jury rendered their verdict for the defendants.

The first question presented by the exception is, whether the extension of the standard, and the joggling of it into the beam, are claimed as material parts of the plaintiff's improvement. We think they are. In the paragraph in which it is described, he states that it "extends back from the bolt to such a distance as to form a brace to the beam;" and also, that being jogged into the beam it relieves the bolt in a heavy draft." And in their summing up, they declare that they claim as new, and of their invention, the construction of such ploughs as aforesaid, and the several parts thereof, not separately but in combination; and proceeding then to specify the parts so claimed, they mention, "the forming of the top of the standard for brace and draft." They indeed say that they do not mean to confine their claim to any particular form of construction, *except "to such form of the top as shall serve for brace and draft." That is to say, the top is to be so formed and so connected with the beam as to answer both purposes. And as those purposes, according to the preceding part of the specification, are to be accomplished by its extension back from the bolt, and by joggling it into the beam, these two things are essential to it, whatever variation may be made in its shape or size. They are, therefore, material parts of the improvement they claim.

The remaining question may be disposed of in a few words. The patent is for a combination, and the improvement consists in arranging different portions of the plough, and combining them together in the manner stated in the specification

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for the purpose of producing a certain effect. None of the parts referred to are new, and none are claimed as new ; nor is any portion of the combination less than the whole claimed as new, or stated to produce any given result. The end in view is proposed to be accomplished by the union of all, arranged and combined together in the manner described. And this combination, composed of all the parts mentioned in the specification, and arranged with reference to each other, and to other parts of the plough in the manner therein described, is stated to be the improvement, and is the thing patented. The use of any two of these parts only, or of two combined with a third, which is substantially different, in form or manner of its arrangement and connection with the others, is therefore not the thing patented. It is not the same combination if it substantially differs from it in any of its parts. The jogging of the standard into the beam, and its extension backward from the bolt, are both treated by the plaintiffs as essential parts of their combination for the purpose of brace and draft. Consequently the use of either alone, by the defendants, would not be the same improvement, nor infringe the patent of the plaintiffs.

The judgment of the Circuit Court must therefore be affirmed.

ELIAS HOWE v. EBENEZER E. ABBOTT.

[2 Story, 190. May T. 1842.]

The application of an old process to produce a new result, is not a patentable invention ; there must be, also, some new process or mode. But the production of an old result by a new process is patentable.

Where a patent was taken out for a combination and an entire process ; *It was*

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held, that the use of a part of the process and combination was not an infringement thereof.

CASE for the infringement of a patent. The suit was brought on a patent granted on the 18th day of March, 1841, to the plaintiff, Elias Howe, assignee of Joseph C. Smith (the asserted original inventor). The invention was described in the letters-patent, to be "a new and useful improvement [* 191] * in the application of a material called palm leaf, or brub grass, to the stuffing of beds, mattresses, sofas, cushions, and all other uses for which hair, feathers, moss, or other soft and elastic substances are used." The letters-patent stated, that the invention was originally secured by letters-patent, dated on the 3d of March, 1833, to Joseph C. Smith, and that these latter letters-patent had been cancelled on account of a defective specification, and the present letters granted to Howe, as his assignee, upon such cancellation. The breach alleged was an unlawful making and using of the invention.

The defendant pleaded the general issue, with notice of special matters of defence.

The specification annexed to the letters-patent was as follows :

"To enable others skilled in the art to which this appertains, to make and use my invention, I shall now proceed to describe the method of preparing or manufacturing the same.

"The first operation is to reduce the palm leaf, or brub grass, to filaments or fibres, sufficiently fine to be spun, which filaments or fibres I then spin, and form into a rope; which should be twisted as hard as possible, so as to kink, or cause the rope to form in balls or coils. This spinning and twisting should be done upon machines similar to those used for spinning and twisting hemp. After the aforesaid process of

twisting is completed, the coils, balls, or twisted hanks, should be placed in a steam, or any other kind of oven, where they should be baked to such a degree, as to permanently fix the curl or twist in the fibres or filaments. When this effect is properly produced, the coils should be untwisted; which operation may be effected by a reverse motion of the same machinery by which it was twisted.

“After passing through these several preparative processes, the fibres of palm leaf or brub grass are left in a light, and * durably elastic, and curly state, and are [* 192] suitable for stuffing any of the various articles herein above enumerated.

“I shall claim as my invention the process of preparing or durably curling palm leaf, or brub grass, by reducing the leaf to small filaments, or fibres, and likewise spinning, baking, of steaming, and untwisting the same; the whole operation being substantially as herein above described, and for the purpose above specified.

ELIAS HOWE.”

Witnesses:

R. H. EDDY,

EZRA LINCOLN, JR.

At the trial it appeared in evidence, that the mode stated in the specification for spinning and curling the palm leaf, after it was reduced to filaments or fibres, was precisely the same process, by the same machinery, as had long before been, and now was used to spin, and twist, and curl, hair stuffing for beds, mattresses, sofas, cushions, &c. But it did not appear, that the palm leaf was ever actually spun or curled in this way, for the purpose of stuffing beds, &c., until about the time when the original patent to Smith was granted.

There was also evidence to show, that, in point of fact, Smith did not invent the application. But that, a short time

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before the original patent was granted, Smith carried some of the palm leaf, cut into strips and filaments, to the shop of one Jonathan D. Bosson, a manufacturer of curled hair for beds, &c., in Roxbury; and Bosson showed him how it might be spun and curled for beds, &c., and actually did spin and curl some of it in Smith's presence by his own hair machinery; and that Smith immediately returned home, put the same process in operation, and obtained his original patent. Smith (who was examined as a witness for the defendant) admitted that he had carried the palm leaf to Bosson's shop; but he denied that Bosson told him how to spin and curl it, or [* 193] that he spun or * curled it on his machinery as Bosson had stated. There was other evidence to show, that long before Smith's supposed invention, and at least ten or twelve years ago, the same process had been applied by other manufacturers of curled hair to other grasses and vegetable substances, namely, to Manilla grass, to common sedge, to Sisal grass, and to a substance called coir, of which sofas are made.

It was also proved, that the defendant did not bake or steam his palm leaf, after it was stripped, and spun, and curled; but stopped his process with the mere spinning and twisting. All the witnesses concurred in opinion, that the process was far more sure and perfect, so far as the curling was concerned, by baking or steaming the palm leaf after it was spun; and they thought it so essential, that the defendant's process would be defective in attaining the object, and that the curls would not be permanent without it.

B. R. Curtis, for the defendant, insisted, (1) That the patent was not valid, because it was not for any new process, but merely for preparing palm leaf, to produce certain results by an old method. (2) That the patent, according to the spe-

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cification, was for a combination and an entire process ; and that the defendant did not use the whole combination or entire process, but a part only, which was well known and in use before.

H. Fuller and Russell, for the plaintiff, contended, *a contra*, that the objections were not well taken.

STORY, J. I shall not interfere to stop the cause from going to the jury. But it strikes me, that both of the objections are well founded. In the first place, it is admitted on all sides, that there is no novelty in the process, by which the stripping, or twisting, or curling, the palm leaf, is accomplished. The * same process of twisting, and curling, and bak- [* 194] ing, and steaming, has been long known and used in respect to hair used for beds, mattresses, sofas, and cushions. It is, therefore, the mere application of an old process and old machinery to a new use. It is precisely the same, as if a coffee mill were now, for the first time, used to grind corn. The application of an old process to manufacture an article, to which it had never before been applied, is not a patentable invention. There must be some new process, or some new machinery used, to produce the result. If the old spinning machine to spin flax were now first applied to spin cotton, no man could hold a new patent to spin cotton in that mode ; much less the right to spin cotton in all modes, although he had invented none. As, therefore, Smith has invented no new process or machinery ; but has only applied to palm leaf the old process, and the old machinery used to curl hair, it does not strike me that the patent is maintainable. He, who produces an old result by a new mode or process, is entitled to a patent for that mode or process. But he cannot have a patent for a result merely, without using some new mode or process to produce it.

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The other objection strikes me upon the evidence, which is not controverted, to be equally fatal. The specification in the summing up is manifestly for the entire process or combination, and not for the several parts thereof. Now, the defendant does not use the entire process or combination, but a part thereof only, which certainly, therefore, is not a violation of the thing patented, which is the entire combination. Besides; the parts used were well known before; and, indeed, the entire process was well known before, as the evidence clearly shows. It may be, and it strikes me, that the defendant's process is, probably, far less perfect in accomplishing its purposes, than that used by the plaintiff. But that constitutes no ground for a recovery. The question [* 195] is not, * which is best, or is most perfect; but whether the one mode or combination is an infringement of the rights secured by the other mode or combination.

There are other difficulties upon the evidence; but I venture to suggest, that unless these objections can be overcome or the evidence controlled, they seem to be fatal.

MEM. The plaintiff, upon these suggestions, consented to have a verdict taken for the defendant, with liberty to move for a new trial, if he should, upon further examination, think that he could change the posture of the case.

Verdict for defendant, accordingly.

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WILLIAM T. McCLURG, JOHN C. PARRY, AND ENOCH J. HIGBY, PARTNERS, DOING BUSINESS UNDER THE FIRM OF McCLURG, PARRY, AND HIGBY, ASSIGNEES OF JAMES HARLEY, PLAINTIFFS IN ERROR, v. LAWRENCE KINGSLAND, ISAAC LIGHTNER, AND JAMES CUDDY, PARTNERS, DOING BUSINESS UNDER THE FIRM OF KINGSLAND, LIGHTNER, AND CUDDY, DEFENDANTS.

[1 Howard, 202. January T. 1843.]

If a person employed in the manufactory of another, while receiving wages, makes experiments at the expense and in the manufactory of his employer; has his wages increased in consequence of the useful result of the experiments; makes the article invented and permits his employer to use it, no compensation for its use being paid or demanded; and then obtains a patent, these facts will justify the presumption of a license to use the invention.

Such an unmolested and notorious use of the invention prior to the application for a patent, will bring the case within the provisions of the 7th section of the Act of 1839, ch. 89.

The assignees of a patent-right take it subject to the legal consequences of the previous acts of the patentee.

The 14th and 15th sections of the Act of 1836, ch. 357, prescribe the rules which must govern on the trial of actions for the violation of patent-rights; and these sections are operative, so far as they are applicable, notwithstanding the patent may have been granted before the passage of the Act of 1836.

The words, "any newly invented machine, manufacture, or composition of matter," in the 7th section of the Act of 1839, have the same meaning as "invention," or "thing patented."

THIS case was brought up by writ of error from the Circuit Court of the United States for the western district of Pennsylvania.

The facts are sufficiently stated in the opinion of the Court.

The bill of exceptions which was taken on the trial below was as follows:

And the plaintiff thereupon excepted to certain parts of

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the instructions so given by the Court to the jury, which instructions so excepted to are hereinafter set forth, to wit:

“It has, however, been urged by the plaintiff’s counsel that the right to the continued use is restricted to the ‘specific machine, manufacture, or composition of matter so made or purchased,’ so that a defendant is protected no farther than in the case of the invention (for which this patent was granted) prior to the application, and is liable to damages if he makes any rolls by Harley’s plan afterwards.

[* 203] * “We, therefore, feel bound to take the words, ‘newly invented machine,’ in the Act of 1839, manufacture, or composition of matter and such invention, to mean the invention patented, and the words ‘specific machine,’ to refer to the thing originally invented, whereof the exclusive right is procured by patent, but not to any newly-discovered improvement to an existing patent.

“The use of the patent must be of the same specific improvement originally invented, as was, before the application, used by any person who had purchased or constructed the machinery on which he operated to produce the effect described in the specification; but when such person confines the future case to the specific mode, method, manner, and process of producing the described effect, it is, by the words and true meaning of the law, without liability to the inventor or other person interested in the invention, so construed; and by thus protecting the person who has engaged the use of an invention before the application for a patent, the great object of the Patent Laws, as declared in the fourth section of the Act of 1837, will be consummated; that is, to protect the rights of the public and ‘of patentees in patented inventions and improvements.’ 4 Story, 2547. A different construction would make it necessary to carry into all the former laws the same literal exposition of the various terms used to express the same thing, and thereby changing the law accord-

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ing to every change of phraseology, make it a labyrinth of inextricable confusion.

“Our opinion, therefore, is, that the defendants have a right to the continued use of the improvement patented to Harley; the facts of the case, which are not controverted, have equal effect with a license, and the evidence brings the defendant under the protection of the Act of 1839, by the unmolested notorious use of the invention before the application for a patent. Nothing has been shown on the part of the plaintiffs to counteract the effect of this prior use; as the assignees of Harley, they stand in his place as to right and responsibility; they took the patent, subject to the legal consequences of his previous acts, and connecting these with the want of an assertion of a right, to the use by the defendants of the invention patented, till this suit was brought in September, 1835, protects them from liability.

* “In our opinion, your verdict ought to be for the [* 204] defendants. Verdict accordingly, and judgment for defendants.”

Dunlap, on behalf of the plaintiffs in error, contended that the Court below had erred in charging the jury.

1. That the facts justified the presumption of a license or grant to use the invention, and that defendants were protected thereby, independent of any Act of Congress.

2. That the words, “specific machine,” in the 4th section of the Act of 1839, referred to the invention itself, and that the authority to use it before the patent carried the right to continue to make and use it after the patent had issued.

Mr. Justice BALDWIN delivered the opinion of the Court.

This case comes here on a writ of error to the Circuit Court for the Western District of Pennsylvania, in an action brought by the plaintiffs, assignees of James Harley, against

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the defendants, for the infringement of a patent granted to Harley for an improvement in the mode of casting chilled rollers and other metallic cylinders and cones, in which judgment was rendered for the defendants. On the trial it appeared in evidence that it had long been a desideratum to find out some mode by which iron rollers or cylinders could be so cast that when the metal was introduced into the mould it should cause a swyrl or rotatory motion, by which the flog or dross would be thrown into the centre instead of the surface of the cylinder. By the old mode, the metal was conveyed from the furnace to the mould through a gate, or pipe, placed in a horizontal or perpendicular direction. The mode alleged to have been invented by Harley is thus described in the specification annexed to the patent: "The tube or tubes, or passages called gates, through which the metal to be conveyed into the moulds, shall not enter the mould perpendicularly at the bottom, but slanting, or in a direction approaching to a tangent of the cylinder, or if the gates enter the moulds horizontally or nearly so, shall not enter in the direction of the axis of the cylinder, but in a tangent form, or inclining towards a tangent of the cylinder."

This was the thing patented, consisting solely in changing the direction of the tube, which conveyed the metal [* 205] to the mould, * from a horizontal or perpendicular position to an angular one ; it produced the desired effect and was highly useful.

The novelty of the invention was much contested at the trial, but as the case turned on other points, that became an immaterial question ; as the case comes before us, on exceptions to the charge of the Court, which assumed that Harley was the original and true inventor of the improvement, and put the case to the jury on the following facts, which were in full proof, in nowise contradicted, and admitted to be true.

That Harley was employed by the defendants at their

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foundry in Pittsburg, receiving wages from them by the week ; while so employed, he claimed to have invented the improvements patented, and after several unsuccessful experiments made a successful one in October, 1834 ; the experiments were made in the defendants' foundry, and wholly at their expense, while Harley was receiving his wages, which were increased on account of the useful result. Harley continued in their employment on wages until January or February, 1835, during all which time he had made rollers for them ; he often spoke about procuring a patent, and prepared more than one set of papers for the purpose ; made his application the 17th February, 1835, for a patent ; it was granted on the 3d of March, assigned to the plaintiffs on the 16th of March, pursuant to an agreement made in January.

While Harley continued in the defendants' employment, he proposed that they should take out a patent and purchase his right, which they declined ; he made no demand on them for any compensation for using his improvement, nor gave them any notice not to use it, till, on some misunderstanding on another subject, he gave them such notice, about the time of his leaving their foundry, and after making the agreement with the plaintiffs, who owned a foundry in Pittsburg, for an assignment to them of his right. The defendants continued to make rollers on Harley's plan ; the present action was brought in October, 1835, without any previous notice by them. The Court left it to the jury to decide what the facts of the case were ; but if they were as testified, charged that they would fully justify the presumption of a license, a special privilege, or grant to the defendants to use the invention ; that the facts amounted to " a consent and allowance of such use," and show such a consideration as would support * an express license or grant, or call for the [* 206] presumption of one to meet the justice of the case, by exempting them from liability ; having equal effect with a

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license, and giving the defendants a right to the continued use of the invention. The Court also charged the jury, that the facts of the case, which were not controverted, brought it within the provisions of the 7th section of the Act of 1839, by the unmolested, notorious use of the invention, before the application for a patent by Harley, and that nothing had been shown by the plaintiffs to counteract the effect of this prior use. That as assignees of Harley, the plaintiffs stand in his place, as to right and responsibility; they took the assignment of the patent, subject to the legal consequences of his previous acts, and connecting these with the absence of an assertion of a right adverse to the defendants' use till this suit was brought, protected the defendants from liability for any damages therefor.

The exceptions to the charge were confined to these two points, which constitute the only subject for our consideration. Whether these exceptions are well taken or not, must depend on the law as it stood at the emanation of the patent, together with such changes as have been since made; for though they may be retrospective in their operation, that is not a sound objection to their validity; the powers of Congress to legislate upon the subject of patents is plenary by the terms of the Constitution, and as there are no restraints on its exercise, there can be no limitation of their right to modify them at their pleasure, so that they do not take away the rights of property in existing patents.

When the patent to Harley was granted and this suit brought, the Acts of 1793 and 1800 were the tests of its validity, but the 21st section of the Act of 1836 repealed all existing laws on the subject of patents, with a proviso, that all suits brought before may be prosecuted in the same manner as if that act had not been passed, "excepting and saving the application to any such action, of the provision of the 14th and 15th sections of this act, so far as they may be applicable

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thereto." This repeal, however, can have no effect to impair the right of property then existing in a patentee, or his assignee, according to the well-established principles of this Court in (8 Wheat. 493); the patent must therefore stand as if the Acts of 1793 and 1800 remained in force; in other respects the 14th and 15th sections of the Act of * 1836 prescribe the rules which must govern on [* 207] the trial of actions for the violation of patented rights, whether granted before or after its passage.

In *Pennock v. Dialogue*, this Court held, in 1829, "That if an inventor makes his discovery public, looks on, and permits others freely to use it, without objection or assertion of claim to the invention, of which the public might take notice; he abandons the inchoate right to the exclusive use of the invention, to which a patent would have entitled him, had it been applied for, before such use, and that it makes no difference in the principle, that the article so publicly used, and afterwards patented, was made by a particular individual who did so by the private permission of the inventor." 2 Peters, 14, 15; *S. P. Grant v. Raymond*, 6 Peters, 248, 249; *Shaw v. Cooper*, 7 Peters, 313 - 323.

On this construction of the Acts of 1793 and 1800, Harley's patent would have been void, on the evidence in this case. Such seems to have been the sense of Congress, as expressed in the Act of 1832, which authorized the issuing a new patent, when an original one was invalid by accident, inadvertence, or mistake, and without any fraudulent intent, by reason of the terms of the 3d section of the Act of 1793 not having been complied with, "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. That no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any

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special license of the inventor, or without the consent of the patentee that there shall be free public use thereof, shall in any manner prejudice the right of recovery for any use or violation of his invention after the grant of such new patent, as aforesaid." 4 Story, 2301.

This act is an affirmation of the principles laid down by this Court in the three cases before referred to, and as the exception to the proviso is limited to an use of the invention under a special license of the inventor 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 2 Peters, 14, 15, whereby the patent would become void.

The same conclusion follows from the 15th section [* 208] of the Act * of 1836, which declares, that if the thing patented "had been in public use, or on sale, with the consent and allowance of the patentee, before the application for a patent," judgment shall be rendered for the defendant with costs. 4 Story, 2511. The case before us is one of this description: the defendants use the invention of Harley for four months before his application for a patent; this use was public, and not only with his express consent and allowance, but he himself made the rollers on the plan he invented during those months, from the time when he had ascertained the utility of his invention.

It would, therefore, be no strained, if not the fair construction of this act, if under such and the other circumstances in evidence in the cause, the Court had charged the jury, that if they believed the witnesses, the patent subsequently obtained was void. The Circuit Court, however, did not go so far: they held that the defendants might continue to use the invention, without saying that the public might use it without liability to the plaintiffs, in which we think there was no error in their direction to the jury; that they might presume a license or grant from Harley, or on the legal effect of the

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uncontroverted evidence as to the right of recovery, by the plaintiffs, or on the construction of the Acts of 1793, 1800, 1832, and 1836.

The remaining exception is to the charge of the Court below, on the effect of the 7th section of the Act of 1839, which is in these words: "That every person or corporation who has, or shall have purchased or constructed any newly-invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer of a patent, shall be held to possess the right to use and vend to others to be used, the specific machine, manufacture, or composition of matter, so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held invalid by reason of such purchase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public, or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent." Pamphlet Laws, 1839, 74, 75.

The object of this provision is evidently twofold; first, to protect the person who has used the thing patented, by having purchased, * constructed, or made the [* 209] machine, &c., to which the invention is applied, from any liability to the patentee or his assignee. Second, to protect the rights, granted to the patentee, against any infringement by any other persons. This relieved him from the effects of former laws and their construction by this Court, unless in case of abandonment of the invention, or a continued prior use for more than two years before the application for a patent, 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 to use his invention; which, if given before the application for a patent, would justify the continued use after it issued without liability.

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At the trial below, and here, the plaintiff's counsel have contended, that this act cannot apply to the present case, inasmuch as the protection it affords to the person who had the prior use, is confined to the specific machine, &c., and does not extend to such use of the invention, or thing patented, if it does not consist of a machine, &c., as contradistinguished from the new mode or manner in which an old machine or its parts operates, so as to produce the desired effect; but we think that the law does not admit of such construction, whether we look at its words or its manifest objects, when taken in connection with former laws, and the decisions of this Court in analogous cases.

The words "such invention" must be referred back to the preceding part of the sentence, in order to ascertain the subject-matter to which it relates, which is none other than the newly-invented machine, manufacture, or composition of matter constituting the thing patented; otherwise these words become senseless when the invention is not strictly of a machine, &c. Now, in the present case, we find the invention consists solely in the angular direction given to the tube through which the metal is conducted into the cylinder in which the roller is cast. Every part of the machinery is old; the roller itself is no part of the invention, and cannot be the machine, manufacture, or composition of matter contemplated by Congress; nor can the word "specific" have any practical effect unless it is applied to the thing patented, whatever it may be, without making a distinction between a machine, &c., and the mode of producing a useful result by the mere direction given to one of the parts of an old machine. Such a construction * is not justified by the language of the law, and would defeat both of its objects. If it does not embrace the case before us, the consequence would be that the use of the invention, under the circumstances in evidence, would, according to the deci-

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sion in 2 Peters, 14, 15, invalidate the patent; for if the act operates to save the avoidance of the patent, it must, of consequence, protect the person who uses the invention before the application for a patent. Both objects must be effected, or both must fail, as both parts of the act refer to the same thing, and the same state of things, as affecting the person using the newly-invented machine, or the thing patented, as well as the inventor. Had the words "invention," or "thing patented," been used instead of machine, &c., there could have been no room for doubt of the application of the act to the present case; and by referring to the phraseology of the different Acts of Congress denoting the invention, it is apparent that, though there is a difference in the words used, there is none as to their meaning or reference to the same thing. Thus we find in the 14th section of the Act of 1836, relating to suits for using "the thing whereof the exclusive right is secured by any patent," in the 15th, "his invention, his discovery, the thing patented," "that which was in fact invented or discovered," "the invention or discovery for which the patent issued," "that of which he was the first inventor." In the first section of the Act of 1837, "any patent for any invention, discovery, or improvement," "inventions and discoveries;" in the 2d section, "the invention;" in the 3d, "invention or discovery;" in the 4th, "patented inventions and improvements;" in the 5th, "the thing as originally invented." 4 Story, 2510, 2511, 2546.

We, therefore, feel bound to take the words "newly-invented machine, manufacture, or composition of matter" and "such invention," in the Act of 1839, to mean the "invention patented," and the words "specific machine," to refer to "the thing as originally invented," whereof the right is secured by patent; but not to any newly-invented improvement on a thing once patented. The use of the invention before an application for a patent must be the specific improvement

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then invented and used by the person who had purchased, constructed, or used the machine to which the invention is applied: so construed, the objects of the Act of 1839 are accomplished; a different construction would make [* 211] * it necessary to carry into all former laws the same literal exposition of the various terms used to express the same thing, and thereby changing the law according to every change of mere phraseology, make it a labyrinth of inextricable confusion.

We are, therefore, of opinion that there is no error in the charge of the Court below, and that its judgment be affirmed.

Order.

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Western District of Pennsylvania, and was argued by counsel. On consideration whereof, it is now here ordered and adjudged by this Court, that the judgment of the said Circuit Court in this cause be and the same is hereby affirmed, with costs.

PETERSON & PETERSON V. WOODEN.

[3 McLean, 248. July T. 1843.]

If the patentee claims more than he has invented, his patent is not void, as under the former law; but, so far as his invention goes, he is protected. But where the claim is for an improvement of a machine, the patentee must show in what the improvement consists. In a declaration, the improvement must be stated as an essential part of the plaintiff's right; and if this be not done the declaration is demurrable.

Storer, appeared for the plaintiffs.

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Fox, for the defendants.

OPINION OF THE COURT.

THIS is an action for the violation of a patent-right. In their declaration, the plaintiffs state, that they have invented a "new and useful improvement in the cooking-stove," which improvement, they state, has not been known or used. The schedule which is set out in the declaration, describes the structure of the stove in all its parts, but nowhere describes in what the improvement consists. And on that ground the defendants demurred to the declaration.

Prior to the Act of the 4th of July, 1836, if the patentee claimed more than he had invented, his patent was void. But, under the decision of the Supreme Court, he was permitted to surrender his patent and take out a corrected one. The 13th section of the above act provides, that "where a patent is invalid by a defective or insufficient description or specification, or by reason of the patentee claiming in his specification, as his own invention, more than he had invented, if done through inadvertence, or in surrendering the patent, the patentee may obtain a new patent for the residue * of the period unexpired of the original patent." [* 249] And in all cases of infringement subsequent to the date of the amended patent, it is declared to be valid. The fifteenth section of the same act provides, that, under the general issue and notice, the defendant may controvert the truth of the specification.

The ninth section of the Act of 3d March, 1837, provides, that, where the patentee has claimed more than he has invented, "the patent shall still be deemed good and valid for so much of the invention as shall be truly and *bonâ fide* his own, provided it shall be a material and substantial part of the thing patented, and be definitely distinguishable from the other parts so claimed without right as aforesaid."

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Now although the patent is not void when the patentee claims more than he has invented, yet, in his specification, he must state in what his improvement consists. He does not claim in this case the invention of a cooking-stove, but an improvement on such stove ; but in no part of the declaration is it stated what this improvement is. Had he claimed the invention of the stove, under the above statute of 1837, the invention would have been good, so far as it extended.

This is an essential part of the plaintiff's case, and should be set out in the declaration. And as this has not been done, the declaration is demurrable.

Leave is given to the plaintiffs to amend their declaration.

BROOKS AND MORRIS v. BICKNELL AND JENKINS.

[3 McLean, 250. July T. 1843.]

An answer to an injunction bill, though filed without a rule, will be treated as an answer on a motion to grant, or continue, an injunction.

Affidavits may be read, on both sides, as to facts unconnected with the title.

If a patentee be dead, his administrator may renew the patent.

The Board, on whose judgment a renewal is granted, may be said to act judicially. Their judgment is not conclusive as to the right ; but of certain facts, it must be considered conclusive.

The specifications of an improvement of a machine, must be so clear as to enable a person acquainted with the structure of such a machine, to build one.

In such description it is sufficient to refer generally to the machine improved, without giving a particular description of it.

It is not material, in the description, to say, whether certain parts of the machine should be made of wood or metal.

Where witnesses differ on the fact of an infringement, the matter should be submitted to a jury, either by an action at law, or an issue directed by chancery.

A difference in form, or proportions only, makes no difference in the principles

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of the machines. If they operate on the same principle, in the application of the power, in law, the machines are considered identical. A patent is invalid, if the thing claimed to have been invented, has been made in a foreign country, or described in some public work. But in this, as on the fact of infringement, the machine, or thing invented, must in principle, be the same:

The assignee of a patent-right, in part, can, in law, or equity, sustain a suit, for a violation of the patent, without uniting the name of the patentee.

Wright, Coffin, and Minor, for complainants.

Walker, for defendants.

OPINION OF THE COURT.

THE complainants represent in their bill, that on or about the 4th of December, 1828, William Woodworth, now deceased, was the inventor of a certain improvement, or machine, for planing, grooving, and tonguing boards, and * other materials, and for which, after having com- [* 251] plied with every legal requisite, he obtained a patent, dated the 27th of December, 1828, to him, his heirs, executors, administrators, or assigns, for the term of fourteen years. That the patent, after the 15th day of December, 1836, was duly recorded anew, in the Patent-Office, as required by law. That the patentee having departed this life on the 14th day of February, 1839, letters of administration were granted on his estate, by the surrogate of the county of New York, to William W. Woodworth. That afterwards he presented to the proper department of the government, a petition for an extension of the patent, and having in all things complied with the law, on the 16th day of November, 1842, a renewal and extension of the patent, for seven years, were granted. That during the original patent, the patentee assigned one half of his interest in the same to James Strong, and afterwards, on the 29th day of July, 1830, Strong and Woodworth, by deed, transferred to Isaac Collins and Bar-

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zillai C. Smith, all their right under the patent, in the State of Ohio, and other territory therein named ; and on the 12th day of April, 1831, Collins and Smith conveyed to Lewis Sanders the exclusive right to make, construct, use, and vend, one hundred machines, above patented, for the county of Hamilton, Ohio, as well as other territory. That said Sanders, on the 18th of August, 1831, transferred to Thomas D. Carneal and Charles Neave, one equal undivided half of his right. That Carneal and Neave, on the 9th of July, 1834, transferred all their interest in the patent to the complainants ; and on the same day Sanders conveyed to them all his interest. That all the above assignments have been duly recorded in the Patent-Office, except the assignment to Sanders, which has been lost, or mislaid. That on the 2d of January, 1843, Collins and Smith transferred to Wil- [* 252] liam W. Woodworth their interest in the *renewal of the patent, which has been duly recorded. That Woodworth, while in possession of the right, on the 2d of January, 1843, executed a certain instrument of disclaimer, as to the exclusive right, or interest, in circular saws for reducing floor planks, or other materials, to the same width, which was also recorded. That afterwards Woodworth assigned his interest in the renewed patent, for the county of Hamilton and other territory specified, to Wilson, and Wilson assigned the same to the complainants, which assignments are of record. That the complainants have been in the use of their right, which was well known to the defendants, but in disregard of such right, defendants are making, or causing to be made, setting up, and about to put in operation, in the city of Cincinnati, one or more machines, for planing boards and other materials, or have made, set up, and put in operation, such machines, in said city ; which machines, and all the material parts thereof, are substantially like, and upon the plan of Woodworth's. And they represent that

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defendants have little or no property, and in a pecuniary point of view are wholly irresponsible. An injunction is therefore prayed, &c.

The answer admits the emanation of the patent, the death of the patentee, the appointment of administrator, the several assignments, with some exceptions, and the disclaimer of the administrator — denies that the defendants are not pecuniarily responsible — admits the possession and use, under the patent, of a certain machine, but denies that it is the machine patented, and points out six substantial differences — denies that the invention was Woodworth's, and points out similar machines, used and patented before — denies the validity of the patent, on account of defects in the specifications, and points out seven — denies the validity of the renewal to the administrator — admits the construction * of a [* 253] machine, by the defendants, and gives the specifications and drawings ; but denies that it is an infringement, and points out what is claimed as new.

On the hearing plaintiffs insisted, that the answer was nothing more than an affidavit, until time for answering expired ; and cited 1 Cond. Eng. Chanc. R. 66 ; 1 Smith's Chanc. Prac. 595.

Defendants, objected to the reading of affidavits. Plaintiffs cited 3 P. Wms. 255 ; 3 Merivale, 622 ; 1 Vesey, 427 ; 1 Baldwin, 206.

As to the practice in granting injunctions, plaintiffs insisted, that though there might be doubts about the validity of the patent, if there had been an exclusive use for a length of time, the injunction would be granted. 6 Vesey, 707 ; Phillips on Patents, 461 ; 4 Wash. 534 ; 9 Johns. 470 ; 3 Merivale, 622 ; 1 Mad. Chanc. Prac. 113 ; 14 Vesey, 131. Defendants admitted this to be the law ; but denied any use of the machine patented, insisting that it was substantially different.

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Defendants for the present admitted plaintiffs' title as set out; but opposed the injunction on three grounds:

1. The patent is invalid for defects in the specifications; there are no written references to drawings, as required by law; and the description is too general and ambiguous to enable a practical machinist to construct a machine. 2 McLean's R. 37. This question is a matter for the Court. 2 Brock. 298. But the affidavits of men of skill may assist.

2. The administrator cannot renew, but only the patentee. Act of 1836, sec. 18. Where the right is to extend to representatives and assigns, it is specially provided for, as in sections 5, 10, 13, and the latter part of 18. The design is to reward the inventor, and not speculators. Plaintiffs cited *Van Hook v. Scudder et al.* (reported in *New York Herald* of June 20, 1843); and also claimed that the opinion of the board was entitled to weight.

[* 254] *3. There was no infringement. Plaintiffs claimed a particular application, or combination, of known principles. Defendants had made a different one — cited 1 Peters's C. C. R. 398; 4 Wash. 706; 2 Kent, 370; 7 Wheat. 361, to show what amounts to an infringement.

Two preliminary points are made, which it may be proper to settle, before the main questions are considered.

1. The effect of the answer. As it has been voluntarily and prematurely filed, it is contended, it can have no other effect than the affidavit of the defendants, in regard to the motion now made. It is true there has been no rule for answer, but this seems to be no satisfactory reason why it should not be treated as an answer. The complainants call upon the defendants to answer, and, on many points, the answer is responsive to the bill.

By the fortieth rule of practice, "a defendant is not bound to answer any statement or charge in the bill, unless specially and particularly interrogated thereto." And the same rule

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declares, that if "a defendant shall answer any statement or charge in the bill, to which he is not interrogated, only by stating his ignorance of the matter so stated or charged, such answer shall be deemed impertinent."

From this rule it is clear that the defendant is in no default, by refusing to answer any part of the bill to which he is not specially interrogated. And if he expresses "ignorance of the matter, his answer shall be deemed impertinent;" but the rule does not say that if the answer respond to the charges in the bill, it shall be held impertinent.

By the fifth section of the Act of the 2d of March, 1793, it is declared, that "no writ of injunction shall be granted in any case, without reasonable previous notice to the adverse party, or his attorney, of the time of moving for the same." And by the fifty-fifth rule it is declared, that "special injunctions shall be grantable only upon due notice to the other party, by the Court in term, or by a judge * thereof [* 255] in vacation, after a hearing, which may be *ex parte*, if the adverse party does not appear at the time and place ordered."

Both from the statute, and the rule of practice, it is clear, a hearing of both parties is contemplated on an application for an injunction. And there can be no objection, it would seem to me, if time be given, to an answer of the allegations in the bill.

2. An objection is made to the affidavits offered in support of the bill, and in contradiction of the answer. That affidavits are read to support the injunction, on a motion to dissolve it, on the coming in of the answer, is a well-established rule in England. *Gibbs v. Cole*, 3 P. Wms. 255; 2 Eq. Cases Ab. 14 pl. 2; *Isaacs v. Hampage*, 3 Bro. Ch. 463; 1 Ves. Jr. 427. In *Morphet v. Jones*, 19 Ves. 350, it is said, "there are many cases of injunction where you may reply to the answer by affidavits, not on the question of title, but on mere

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facts, as in the instance of waste, on such questions of fact though not on the title, affidavits in reply to the answer may be read."

It is said, in 1 Smith's Ch. Pr. 595, that "if the plaintiff, instead of applying for the injunction upon affidavit, waits until the defendant has answered, he must rest his case upon the disclosures made by the answer, and he is not entitled, either for the purpose of obtaining or continuing an injunction, to read any affidavits in support of his motion, in opposition to the answer." But cases of waste, or of mischief analogous to waste, are an exception to this rule, where the affidavits do not refer to title.

The illegality of the extension of the patent, is the principal ground of objection to the complainant's right.

The eighteenth section of the Patent Law of July the 4th, 1836, provides, "that whenever any patentee of an invention or discovery, shall desire an extension of his patent, he may make application therefor, in writing, to the com-
[* 256] missioner * of the Patent Office," &c. The Secretary of State, the commissioner of the Patent Office, and the solicitor of the treasury, constitute a board to determine on the right of the applicant to an extension; and if their judgment shall be in his favor, the patent is extended seven years beyond the original grant of fourteen years.

This privilege, or right, it is contended, is given to the patentee, and to no other person. And that as the above extension was granted, after the decease of the patentee, and to his administrator, it was unauthorized, and is consequently void.

To William W. Woodworth, the administrator of the patentee, Collins and Smith, on the 2d of January, 1843, transferred all their interest in the renewal of the patent. So that in fact when the administrator applied for a renewal of the patent, he held, as assignee, an interest in it. But the appli-

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cation for a renewal was made by Woodworth in his capacity as administrator of the patentee, and on that ground the question must be considered.

There is no express statutory provision, authorizing the administrator of the patentee to apply for a renewal of the patent.

By the tenth section of the above act, it is provided, that when the inventor or discoverer dies before a patent is obtained, his executor or administrator shall have the right to apply for and obtain the patent, in trust, for the heirs or devisees of the deceased. And in the thirteenth section, where the specification has claimed more than the patentee has invented, and he is dead, his executor, administrator, or assignee, has a right to surrender the patent, and have the specification corrected.

To entitle a patentee to an extension of his patent, he must make application in writing to the commissioner of the Patent Office, setting forth the grounds thereof, "and, on the applicant's paying forty dollars, the commissioner * causes a notice to be published in one or more of [* 257] the principal newspapers in the city of Washington," &c., stating "the time and place where the same will be considered, that any person may appear and show cause why the extension should not be granted." And the board, constituted for this purpose, are required to meet at the time and place specified; before whom the applicant is required to state, under oath, the value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of said invention." "And if, upon hearing, it shall appear to the entire satisfaction of the board that the term should be extended by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable

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remuneration for the time, ingenuity, and expense bestowed upon the same and the introduction thereof into use, it shall be the duty of the commissioner to renew the patent, &c., and the judgment of the board shall be entered on record in the Patent Office," &c.

Now this language would seem to limit the right of renewal to the patentee, not only from the use of his name in the first part of the section, but from the object of the grant of renewal, it being "to secure to him a reasonable remuneration, for his time, ingenuity, and expense." But still, "the benefit of the renewal extends to the assignee of the right, to the extent of his interest." And where the assignment of the whole right has been made by the patentee, it is difficult to perceive how a renewal could operate beneficially to him. There are cases, no doubt, in which the principal expense has been incurred by the assignee, who has constructed and introduced the machine into use.

In the case under consideration, however, the [* 258] heirs of the *patentee, at the time of the renewal, held a principal interest in the patent, and its renewal was for their benefit.

It is intimated that the decision of the board, as to the extension of the patent is conclusive, both as to the right granted, and the mode of granting it.

There can be no doubt that where a special tribunal is constituted, with full powers to act in certain cases, its decisions, within the scope of its authority are conclusive, if there be no superior supervising tribunal. And in this case the matter of expense, the payment of the money required, and the notice, are conclusively settled by the decision. But the question of law, as to the right of renewal, by the administrator, is not concluded.

The board seem not to have acted inconsiderately in the case. Having met on the day designated in the public notice,

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they adjourned to the 16th day of November, 1842, when they "heard the evidence produced before them, both for and against the extension of the patent," and they, in the very words of the law granted the extension.

Now, although this decision is not conclusive as to the legal right of the administrator, yet it cannot be wholly disregarded. It shows, at least, a practical construction, by the executive branch of the government, that the heirs of the patentee may, through their trustee, procure a renewal of a patent. There is nothing in the spirit or policy of the Patent Law, against this construction. On the contrary, it is in accordance with the principle and policy of that law. The same reason that would give a renewal to the patentee, would be equally strong in behalf of his heirs. If the term of the original grant had not given an adequate remuneration for "the time, ingenuity, and expense," of the patentee; on every principle of public policy, in the event of his decease, there should be a renewal for the benefit of his heirs.

* That a man should be secured in the fruits of [* 259] his ingenuity and labor, is a sound maxim of the common law. And it seems difficult to draw a distinction between the fruits of mental and physical labor. But, it must be admitted, that as the right asserted by the complainants arises under a statute, a substantial compliance with the requisitions of such statute must be shown. This seems to have been done, as regards the renewal of the patent in all the essential requirements of the law. If the law does not, in terms, give the right of extension to the administrator of the patentee, in behalf of his heirs, it recognizes the right of an assignee for a patent, on its extension; and in other cases the rights of the administrator and heir of the patentee, are recognized and protected. From the principle of the law, its policy, and every consideration connected with the subject, it would seem that the construction of the act, in this

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respect, has been rightfully settled by the executive department. In this matter the board may be said to have acted judicially.

But this view does not rest alone on the consideration of the policy and principle of the law, but it has been judicially sanctioned by the Circuit Court of the second circuit. Judge Thompson, it seems, on this very patent, and subsequently to the extension of it, treated it, in granting an injunction, as a valid patent. No new patent was issued to the administrator, but a certificate of the extension of the original patent, in pursuance of the judgment of the board, was recorded. The rights under this patent, before its extension, remain, in every respect, the same, after its extension. The administrator acts as the trustee of the heirs; he represents the deceased. And it would seem to be a convenient and fit mode of securing that remuneration, "for the time, ingenuity, and expense," of the patentee, which is given by law, for the administrator to apply for the renewal of the patent. He can pay [* 260] the money and make the exhibits * required. In this duty he does nothing more than the law requires him to do, in regard to other interests of the deceased. Upon the whole, and for the purposes of this motion, I shall consider the extension of the patent, as having been legally granted. It is argued that the specifications in this patent, are essentially defective. If this be so, the right asserted by the complainants must fail.

The specifications must contain reasonable certainty. They must so describe the parts of a machine as to enable a person, skilled in the construction of machines, to build one. And if the patent be for an improvement, the improvement must be described with the same precision. This description need not be so clear as to be understood by an individual wholly unskilled in the structure of machines.

On the 2d day of January, 1843, the administrator dis-

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claimed "all and any exclusive right, title, property, or interest, of, in, or to, the application of circular saws for reducing floor plank, or other materials, to a width," &c., as stated in the specifications.

To a person unacquainted with the structure and operation of machinery, the specifications which constitute a part of the above patent, may not be easily and correctly understood. But taking them in connection with the drawing by which they were accompanied, if the affidavits of intelligent machinists can be relied on, they describe the machine so as to enable a skilful mechanic to construct it. It is true that several affidavits were presented by the defendants, of persons who think the specifications are defective. Some of the persons are represented to be mechanics, and well acquainted with the structure of machinery. But the majority are on the side of the plaintiffs. And in addition to this it would seem, that the opinions of several of the affiants, from their opportunities and experience, are entitled to greater weight than some * of the defendants' witnesses. Judging, [* 261] however, from the schedule itself, it seems to contain nothing which an intelligent mind, though but little versed in mechanics, may not fully comprehend. The moving power of the machine, as described in the schedule, in some of its parts are stated in the alternative ; but this creates neither doubt nor difficulty. The effect is the same, whether produced by one mode or the other. Nor does the patentee state of what material every part of the machine should be made ; but this cannot be material. The principle is the same, whether such part be composed of wood or metal.

In *Turner v. Winter*, 1 Term Rep. 606, it is said, "the patent and specification should be liberally construed." And in 3 Sumn. 374, Mr. Justice Story states it "as a clear rule of law in favor of inventions, and to carry into effect the obvious object of the constitution and law, to give a liberal con-

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struction to the language of patents, so as to protect and not destroy the rights of real inventors." The Court, he says, "will in all cases adopt that interpretation of a specification which will give the fullest effect to the nature and extent of the claim made by the inventor.

In describing the improvement of a machine in use and well known, it is not necessary to state in detail the structure of the entire and improved machine. It is only necessary to describe the improvement, by showing the parts of which it consists, and the effects which it produces. Such a description in reference to the machine improved is sufficient.

An objection is made, that it does not appear there were written references to the drawings, which accompanied the specifications. The act does provide that the applicant for a patent, "shall accompany the whole with drawings and written references, where the nature of the case admits of drawings," &c. Now unless these references were necessary

to an understanding of the improvement, according [* 262] to * the authorities above cited, their omission cannot vitiate the patent. The description of the machine or improvement, accompanied by a drawing, may be, in many cases, perfectly understood without references.

It is further contended, that the machine set up by the defendants, does not infringe the patent under which the plaintiffs claim. There is a conflict in the affidavits presented by the parties on this point. The weight of the evidence produced seems to be with the plaintiffs. But as this question will be submitted to a jury, either by an action at law or an issue directed by this Court, it may not be proper to express a decided opinion on the subject. It may be proper, however, to remark, that a mere colorable or slight alteration of a machine, or a change in its proportions, gives no ground for a patent; nor can it shelter an individual from the consequences of an infringement. In such cases the inquiry always is whe-

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ther the principle of the two machines is the same. If the principle on which the machinery works is the same, and the effect is similar in both, in contemplation of law the machines are identical. A change in the position of the operating powers, or in the thing on which the effect is produced, is of no importance. Such a modification does not rise to the dignity of an invention. There must be an essential difference in the application of the mechanical power, to make the machines dissimilar.

Making, using, or selling a patented machine, is an infringement. 1 Gall. Rep. 429; *Whittemore v. Cutter*, Phillips on Pat. 361, 371.

Is this a case for an injunction ?

In most cases the Court will not enjoin, until the right of complainant has been established at law. But where the injury would be irreparable, an injunction will be granted. A case of waste constitutes an exception to the general rule, and also the infringement of a patent. This is clearly *the English rule, and that is the rule of this Court, [*263] unless a different one has been adopted. It is insisted that as this is an exception to the general rule in the English Chancery, that it is not binding on this Court.

The rule of the Supreme Court adopts the mode of proceeding in the High Court of Chancery in England, in cases where no special rule has been provided. Now the rule applicable in England to suits for waste and on patents, is as applicable here as any other rule. The exception constitutes the rule.

The complainants state that the defendants have little or no property, and could not pay the damages which might be recovered against them for an infringement of the patent. On this ground, as well as on the ground that the complainants' right is clear, an injunction is prayed. For fifteen years, the claimants, under Woodworth's patent, have enjoyed all

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the rights secured by it. This is an important fact, and it cannot be disregarded in his application. 6 Vesey, 707; Phillips, 401; 4 Wash. C. C. Rep. 584; Livingston v. Van Ingen, 9 Johns. Rep. 570; *ib.* 585; 1 Mad. Ch. Pr. 113; 14 Ves. 131.

The suggestion that the improvement for which Woodworth received a patent, was not an original invention, seems to be sustained.

“If the thing secured by patent had been in use, or had been described in a public work, anterior to the supposed discovery, the patent is void, whether the patentee had a knowledge of the previous use or description or not.” *Evans v. Eaton*, 1 Peters’s Rep. 322. And this rule holds if the machines are the same in principle, though they may differ in proportions and form. *Woodward v. Parker et al.* 1 Gall. 438.

In Rees’ *Encyclopedia*, under the head of “Planing Machines,” it appeared that Bentham obtained a patent in England, for such a machine in 1791; and Bfamah, [*264] for *a different one in 1802. But these machines were in principle, structure, and effect, essentially different from Woodworth’s. At least my mind has been brought to this result, from an examination of the evidence before me.

The injunction heretofore granted in this case will be dissolved, on the defendants giving bond and security, within five days, in the sum of fifteen hundred dollars, to account to the plaintiffs, &c., should their right be finally established.

Should the defendants fail to give the above security, the injunction will be continued, on the plaintiffs giving bond and security in the like sum of fifteen hundred dollars, &c.

Bean v. Smallwood. 2 Story.

SAMUEL BEAN v. THOMAS SMALLWOOD.

[2 Story, 408. October T. 1843.]

A machine is only patentable, when it is substantially new; but the application of an old machine to a new purpose is not patentable. In the present case the invention was held not to be patentable, because it was merely the application of an old apparatus to a new purpose.

CASE for infringement of a patent, dated 30th of March, 1840, for "a new and useful improvement in the rocking-chair." The specification annexed to the patent stated as follows: "The principal feature of this invention and improvement consists in making the seat and stool of the chair in two parts, so that whilst the stool remains stationary, the seat is made to rock on the top of it; thus doing away with the long and cumbersome rockers on the common chair, which occupy a great deal of room, and are very destructive to carpets, and which also renders the back of this improved chair susceptible of being fixed in a reclining position at any angle to suit the wishes of the sitter, and at the same time rendered perfectly secure from being thrown off the stool.

* Plea, the general issue, with a notification of [* 409] special matters of defence, (1). That the invention was not new, but is described in certain books, naming them, and invented and used before by certain persons, naming them.

B. R. Curtis, for the defendant, at the trial, cited London Journal of Arts and Sciences, (of the conjoint series,) vol. 7, 1836, p. 161, describing an easy-chair, patented in 1833. The chair is in two parts, on curved surfaces; he also cited Phillips on Patents, 102, 106.

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He also read the specification of Simmons's patent for "an improvement in rockers for chairs, cradles, or other things intended to be rocked," granted in 1819.

Sewall, for the plaintiff, admitted, that the two first parts in the claim in the plaintiff's specification of his invention were similar to those in Simmons's patent; but he insisted, that the third part in his claim in the specification was the plaintiff's invention, and under the Patent Act of 3d March, 1837, ch. 812, sec. 9, he was entitled to maintain his present suit for an improvement thereof, as the patent was by the act good *pro tanto*. He added, that the third claim was new, and if not, it was an application to a new purpose.

Curtis, e contra, contended, that the section applied only to cases where the patent was broader than the invention, by mistake, accident, or inadvertence. He further insisted, that the plaintiff's patent was substantially, in all respects, like Simmons's patented invention, with unimportant differences of form. And he called a witness who established the facts; and his testimony was admitted by the plaintiff to be unimpeachable.

STORY, J. It seems to me, that, upon the evidence [* 410] admitted by the parties, the plaintiff has no case. His patent is not (as the plaintiff admits) for a new combination of old materials, or for a new rocking-chair, framed in a manner unknown before. If it were, it seems admitted by the plaintiff, that, upon the evidence, it would not be maintainable. It would seem open to one of two objections; (1). That the defendant does not use precisely the same combination, but a modification thereof; that is to say, although he uses the two first specifications of the claim in the patent, he does not use the third; but an

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apparatus to accomplish the same purpose, of a somewhat different structure. Or, if the last apparatus be substantially like the plaintiff's, then that the same apparatus is not new, nor the combination in any part new. But he contends, and it seems to me, that it may perhaps be deemed a fair interpretation of the words, in which the claim is summed up in the specification, that it is a claim for three distinct and several things, and that if either is new, *pro tanto*, he is entitled to maintain his suit under the 9th section of the Patent Act of 1837, ch. 45. Now, the summing up of his claim is as follows: "What I claim as my invention, and desire to secure by letters-patent, consists, (1). In making the seat and stool of the chair in two parts, so that the seat shall rock on the top of the stool, instead of having the parts permanently united with rockers on the legs of the stool as heretofore. (2). And also the mode of connecting together the seat and stool by the vertical plates attached to the seat, passing through the stool, with shoulders projecting from the sides thereof, which catch against the under side of the stool when the seat is rocked to or fro. (3). And likewise the manner of reclining the back of the seat at any angle required, by the lock, plates, and notches in the hanging plates, which receive them as before described."

The two first specifications of claim are admitted to be the same as in Simmons's patent, and therefore are not new or *patentable. The third and last specification of claim, upon the testimony of Mr. Eddy, which is admitted to be true, is equally unsupportable. He says, that the same apparatus, stated in this last claim, has been long in use, and applied, if not to chairs, at least in other machines, to purposes of a similar nature. If this be so, then the invention is not new, but at most is an old invention, or apparatus, or machinery, applied to a new purpose. Now, I take it to be clear, that a machine, or apparatus, or other

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mechanical contrivance, in order to give the party a claim to a patent therefor, must in itself be substantially new. If it is old, and well known, and applied only to a new purpose, that does not make it patentable. A coffee mill applied for the first time to grind oats, or corn, or mustard, would not give a title to a patent for the machine. A cotton gin applied without alteration to clean hemp, would not give a title to a patent for the gin as new. A loom to weave cotton yarn would not, if unaltered, become a patentable machine as a new invention by first applying it to weave woollen yarn. A steam-engine, if ordinarily applied to turn a grist mill, would not entitle a party to a patent to it, if it were first applied by him to turn the main wheel of a cotton factory. In short, the machine must be new, not merely the purpose to which it is applied. A purpose is not patentable; but the machinery only, if new, by which it is to be accomplished. In other words, the thing itself which is patented must be new, and not the mere application of it to a new purpose or object.

Under the circumstances, upon the admissions of the parties, it does not strike me that the action is maintainable.

The plaintiff submitted to a nonsuit.

ROSS WINANS v. BOSTON AND PROVIDENCE RAILROAD
COMPANY.

[2 Story, 412. October T. 1843.]

Where the plaintiff, in the specification of his patent, claimed as his invention "an improvement in the construction of the axles or bearings of railway, or other wheeled carriages," and it appeared, that the improvement, though it

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had never before been applied to railway carriages, was well known as applied to other carriages; *It was held*, that the patent was not good.

CASE for infringement of a patent dated the 30th of July, 1831, for "a new and useful improvement of railway and other wheeled carriages." Plea, the general issue with special matters of defence, (1). That the invention was not new. (2). That the invention was in public use before the patent, with the consent of the patentee. The specification annexed to the patent was in substance as follows: "*To all whom it may concern*, be it known, that I, Ross Winans, have invented an improvement in the construction of the axles, or bearings, of railway, or other wheeled carriages, and that the following is a full and exact description thereof:

"The axle, with my improved journals, or bearings, may be made straight, and the wheels placed thereon in the usual way; but instead of forming the bearing under the body of the carriage, and within the naves, or hubs, of the wheels, there to sustain the weight of the load, I extend the axles out at each end, projecting beyond the naves to such a length as shall enable me to form them into gudgeons. The lengths and diameters of these gudgeons, I regulate according to the load they are intended to sustain, and to other circumstances. In all cases, however, the value of my invention depends upon the gudgeons having their diameters as small as a due attention to the strength required will allow. The causing the *axles to run in boxes, or upon bearings, [* 413] without the naves, admits of their being made much smaller than usual, the degree of diminution which I have found to answer well in practice, will hereafter be stated. They should be formed of good wrought iron, and case-hardened; or overlaid, or cased with the best steel, and hardened, which materially diminishes the extent of bearing surface necessary to enable them to receive and resist the pres-

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sure of the load, and their tendency to wear ; they may therefore be short, and are consequently strong, when of comparatively very small diameter.

“ The tendency to lateral movement is checked, or limited by forming the end, or point of the axle, or gudgeon, so as to be met occasionally by the external cap or cover of the gudgeon box, when lateral pressure occurs.

“ By placing the bearing outside, (as aforesaid,) the diameter of the wheels may be enlarged with more advantage than formerly, as the axles between the wheels may be made of any required strength, (to resist the increased stress thrown on to that part of them by an enlargement of the wheels,) without affecting the size or strength of the bearing journals.

“ By the foregoing means, the leverage of the wheels (or the mechanical advantage with which the moving power acts, to overcome the resistance to motion) is increased and consequently the friction or resistance to motion in railroad carriages, diminished to a greater extent than heretofore.

“ This improvement in the axles and journals of railway carriages, was devised and carried into operation on my experimental railway, and exhibited to various persons in the early part of the year 1827 ; and it was put into practical operation, under my direction, on the Baltimore and Ohio, and on the Liverpool and Manchester Railroads, in the early part of 1829, in connection with another improvement for the

further diminution of friction, by means of a revolving bearing, * or friction wheel, for which other

improvement a patent was granted to me on the 11th of October, 1828.

“ The object of the invention, and a practical demonstration of its utility having been shown, its application and adaptation to the different railroad carriages, burdened wagons, locomotive engines, &c., and to the different bearing boxes that may be preferred for different purposes, (either revolving or com-

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mon,) will be evident and easy, to any person acquainted with the building of railway carriages. But to render it still more so, the following general directions and proportions are given, &c.

“I therefore declare that the improvement, or improvements, above explained and described, in diminishing the resistance to motion in wheeled carriages to be used on railways, which I claim as my own invention, is the extending the axles each way outside of a pair, or pairs, of wheels, far enough to form external gudgeons to receive the bearing box of the load body, and diminished as aforesaid with a view to lessen the resistance of friction, as small as its situation, with the use of the most favorable metal for wear, will permit. Thus conveniently increasing the leverage of the wheels, without impairing their effective strength or durability.”

At the trial it appeared that Winans had obtained a patent for the invention in England in Oct. 1828, and afterwards on the 30th of July, 1831, he took the present patent.

It was argued by *B. R. Curtis*, for the defendants, that this was too late; and *Shaw v. Cooper*, 7 Peters' R. 292, 320, 322; Act of 1839, ch. 88, sec. 7; and *McClurg v. Kingsland*, 1 How. Sup. Ct. R. 202; S. C. 17 Peters' R. 228, were cited. But the main ground was, that the invention was not new, but had been before applied to other carriages, although not to railway carriages, before the patentee applied it to *railways. The patent was not [* 415] for the application of the improvement to railway carriages alone, but it was “to railway and other wheeled carriages.” *Edgeworth on Roads and Carriages*, printed in 1817, appendix 2, pages 71, 73, 76; and *Dr. Hook's Essay upon Carriages*, printed in 1684, pages 145, 146, were cited in support of the objection.

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C. G. Loring, for the plaintiff, argued, that it was the intention of the plaintiff to claim as his invention the application of extended axles of wheels to carriages with flanges on railroads; that the plaintiff claimed this particular combination as new and it was so. But he did not mean to claim the invention as applicable to all other wheel carriages.

STORY, J. I fear that it is impossible to give this limited interpretation to the plaintiff's patent. The patent itself is for "a new and useful improvement of railway and other wheeled carriages;" and the specification expressly states, that the patentee has invented "an improvement in the construction of the axles, or bearings, of railway, or *other wheeled carriages*," and then he proceeds to give a description thereof. It is plain from this language that he does not limit his invention to railway carriages; but he insists, that it is new as to other carriages. It is true, that in summing up his claim, in the close of the specification, he seems to use language somewhat more restrictive; but even there he says, that what he claims as his invention is, "the extending the axles each way outside of a pair or pairs of wheels, far enough to form external gudgeons to receive the bearing box of the load body, and diminished as aforesaid with a view to lessen the resistance of friction, as small as its situation, with the use of the most favorable metal for wear, will permit; thus conveniently increasing the leverage of the wheels without impairing their effective strength or durability." Now the invention, [*416] as *stated in this general form, is precisely what the defendants insist is not new, but was well known before, as applied, not to railway, but to other carriages. If this be true, it seems difficult to perceive how the present patent can be maintained.

A verdict was thereupon taken *pro forma* for the defend-

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ants, with liberty to move a new trial upon the question of law. No such motion was made.

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[2 Story, 432. October T. 1843.]

The Patent Act of 1836, ch. 357, sect. 13, and the Act of 1837, ch. 45, sect. 8, authorizing the reissue of a patent, because of a defective or redundant specification or description, without fraud, or for the purpose of adding thereto an improvement, do not require the patentee to claim, in his renewed patent, all things which were claimed in his original patent, but gives him the privilege of retaining whatever he deems proper.

Where the plaintiff, in a patent for "a new and useful improvement in the ribs of the cotton gin," claimed as a part of his invention, the increasing the space between the upper and lower surface of the rib, either "by making the ribs thicker at that part, or by a fork, or by any other variation of the particular form; *It was held*, that the claim was sufficiently accurate as a matter of law, and that it was not necessary that he should describe all possible modes by which the rib might be varied, but only the most important, and that mere formal variations therefrom would be violations of the patent.

Objections, that a patented invention is old; or that the specification in a patent does not clearly describe the mode of making the machine; or that the original and the renewed patent are not for the same invention; or that either were obtained with a fraudulent intent; all involve matters of fact, and are for the jury, upon the evidence, to decide.

Where the original patent was for "a new and useful improvement in the ribs of saw gins for ginning cotton," and the renewed patent was for "a new and useful invention in the manner of forming the ribs of saw gins for ginning * cotton," and in the renewed patent, was claimed, in addition to the thickness of the rib, the sloping up of it so as to leave no shoulder; *It was held*, that the claim in the renewed patent, was not for two distinct improvements, but for additional parts of the same improvement, and that the same thing was patented in both patents.

Patents are to be interpreted by a consideration of the whole instrument, and it is to be thereby determined what thing is intended to be patented.

The Statute of Massachusetts of 1821, ch. 28, relating to the individual liabilities of members of manufacturing corporations, is to be construed as a remedial statute, and the phrase "debts contracted," as employed therein, means

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not only debts in the strict sense of the term, but any liabilities incurred by the corporation. If the liability be for unliquidated damages arising from contract or *tort*, it relates to the time of its origin, and not of its liquidation; and, therefore, *It was held*, that the testimony of Edson, who was a member of the corporation at the time when the liability asserted in the present suit arose, must be rejected, although he had since sold out all his interest.

CASE for infringement of a patent, dated the 16th of November, 1839, for "a new and useful improvement in the ribs of the cotton gin." The present patent was a renewed patent, granted upon the surrender of the original patent, dated the 12th of June, 1838, which was cancelled on account of a defective specification. The specification annexed to the original patent was as follows, "*To all whom it may concern*: Be it known that I, Eleazer Carver, of Bridgewater, in the county of Plymouth, and State of Massachusetts, have invented a certain improvement in the manner of forming the ribs of saw gins, for the ginning of cotton, and I do hereby declare, that the following is a full and exact description thereof:

"In the cotton gin, as heretofore known and used, the fibres of the cotton are drawn by the teeth of circular saws through a grating formed of a number of parallel bars or ribs, having spaces between them sufficient to allow the saws to pass, carrying the fibres of the cotton with them, (which are then brushed off by a revolving brush,) but not wide enough to let the seeds and other foreign substances pass [* 434] through. * Above the saws, the ribs come in close contact, thus forming a shoulder at the top of the space between them.

"Various forms have been given to the bars or ribs, with a view to procure a free passage for the cotton, but the cotton gin, as heretofore made, has been always subject to the inconvenience of the grate becoming choked by hard masses of cotton, and motes, or false seeds, collecting in the upper part

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of the spaces between the ribs, and impeding the action of the saws, and also preventing the mass of cotton, which is drawn by the saws up to the top of the spaces, but not drawn through them, from rolling back freely, so as to pass again over the saws, as it should do.

“My improvement, which I am about to describe, is intended to obviate these difficulties, and it consists in giving a new form to the ribs composing the grate. Instead of making the ribs of a bar of iron of equal thickness throughout, so that the upper and under surfaces shall be parallel, I so form the rib that at the part where the saws pass through, carrying the cotton with them, the space or depth between the upper or outer surface, and the lower or inner surface, shall be greater than the thickness of the rib in other parts has heretofore been, or needs to be, and so great as to be equal to the length of the fibre of the cotton to be ginned, so that the fibre shall be kept extended between the ribs for about its full length, while it is drawn through them by the saws. This will, of course, require either that the rib should be as thick at that part as the length of the fibre, or that the rib should be forked or divided about that part, so that the upper or outer surface and the under or inner surface shall diverge to that distance from each other, instead of being parallel, as formerly, when the rib was made of one bar of uniform thickness. This under or inner surface then takes a new direction upwards, and slopes toward the upper or outward surface, until the two surfaces meet above the periphery of the saw.

*This last described part of the under surface is [* 435] fastened against the framework of the gin.

“The operation of this improvement is, that those fibres of the cotton, which are so firmly caught by the teeth of the saws as to be disengaged from the mass of the cotton to be ginned, are drawn out to their full length, and pass clear through the grate, and are then brushed off by the revolving

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brush, while the fibres that are drawn into the grate, but are not caught by the teeth of the saws firmly enough to be carried quite through, are disengaged, and pass up to the point where the under surface meets the upper surface above the saws, and finding no obstruction there, pass back out of the grate without choking it, and roll down again with the mass of the unginned cotton, and are then caught below by the saws and carried up again, and so on, until all the fibres are drawn through.

“ Having thus described my improved rib, and its advantages, I now claim as my invention, and desire to secure by letters-patent, the increasing the depth or space between the upper or outer surface of the rib and the lower or inner surface of it, at the part where the cotton is drawn through the grate, so that it shall be equal to the length of the fibre of the cotton to be ginned, (whether this be done by making the ribs thicker at that part, or by a fork or division of the rib, or by any other variation of the perpendicular form) ; and I also claim, as part of the same improvement, the sloping up of the lower or inner surface of the rib, so as to meet the upper or outer surface above the saws, leaving, when the rib is inserted into the frame, no break or shoulder between the two surfaces, but a smooth and uninterrupted passage upwards between the ribs as above described.”

The defendant pleaded the general issue, and also filed special matters of defence.

[* 436] * *Willard Phillips* and *Fletcher*, for the defendants, at the trial made several points of defence, which, however, are sufficiently referred to in the opinion of the Court, delivered at the trial, and hereinafter stated.

Franklin Dexter, for the plaintiff, denied the validity of all

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the objections. As the matters of objection were afterwards fully considered in the arguments for a new trial, they are here also omitted.

At the trial one Edson, who was a member of the corporation (the defendants) at the time of the supposed infringement, but had since sold out his interest, was offered as a witness for the corporation. But upon an objection by the plaintiff, his testimony was rejected, as being inadmissible, as he still had an interest in the event of the suit. The Court, however, ruled out the testimony, *hesitanter*, expressing a desire to reëxamine it, if the verdict should be for the plaintiff.

A great deal of evidence was introduced on each side; but the questions, on which the cause seemed principally to rest, were questions of law, and were accordingly argued by the counsel in the course of the trial.

Stoxx, J., upon the close of the arguments, said: So far as the questions of fact are concerned, I shall leave them for the consideration of the jury, if upon the whole evidence the counsel desire it. But the questions of law are those, upon which I am ready to express my present opinion, subject to reëxamination, if the counsel shall wish any of them to be more deliberately considered. The first objection is, that the specification has not sufficiently described the mode of making the improvement, or in such full, clear, and exact terms as to enable a skilful mechanic, skilled in the art or science to which it appertains, or with which it is most nearly connected, to make or construct it. This is certainly a matter mainly of *fact. It is true, that the plaintiff, in [* 437] his specification, in describing the thickness of the rib in his machine, declares, that it should be so thick, that the distance or depth between the upper and the lower surface should be "so great as to be equal to the length of the fibre to be ginned," which, it is said, is too ambiguous and

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indefinite a description to enable a mechanic to make it, because it is notorious, that not only the fibres of different kinds of cotton are of different lengths, long staple, and short staple, but that the different fibres in the same kind of cotton are of unequal lengths. And it is asked, what then is to be the distance or depth or thickness of the rib? Whether a skilful mechanic could from this description make a proper rib for any particular kind of cotton, is a matter of fact, which those only, who are acquainted with the structure of cotton gins, can properly answer. If they could, then the description is sufficient, although it may require some niceties in adjusting the different thicknesses to the different kinds of cotton. If they could not, then the specification is obviously defective. But I should suppose, that the inequalities of the different fibres of the same kind of cotton would not necessarily present an insurmountable difficulty. It may be, that the adjustment should be to be made according to the average length of the fibres, or varied in some other way. But this is for a practical mechanic to say, and not for the Court. What I mean, therefore, to say on this point is, that, as a matter of law, I cannot say, that this description is so ambiguous, that the patent is upon its face void. It may be less perfect and complete, than would be desirable; but still it may be sufficient to enable a skilful mechanic to attain the end. In point of fact, is it not actually attained by the mechanics employed by Carver, without the application of any new inventive power, or experiments? If so, then the objection could be answered as a matter of fact or a practical result.

[* 438] *The next objection is, that the patentee has omitted some things in his renewed patent, which he claimed in his original patent as a part of his invention, namely, the knob, the ridge, and the flaring of the lateral surface of the rib above the saw, and that he claims in his

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renewed patent the combination of the thickness and the slope of the front and back surfaces of the rib. Now, by the 13th section of the Patent Act of 1836, (ch. 357,) it is provided, that whenever any patent, which is granted " shall be inoperative or invalid by reason of a defective or insufficient description, or specification, or by reason of the patentee claiming in his specification as his own invention more than he had or shall have a right to claim as new, if the error has or shall have arisen by inadvertency, mistake, or accident, and without any fraudulent or deceptive intention, it shall be lawful for the commissioner, upon the surrender to him of such patent, and the payment of the further sum of fifteen dollars, to cause a new patent to be issued to the inventor for the same invention, for the residue of the period then unexpired for which the original patent was granted, in accordance with the patentee's corrected description and specification." And it is afterwards added, that, " whenever the original patentee shall be desirous of adding the description of any new improvement of the original invention or discovery, which shall have been invented or discovered by him subsequent to the date of his patent, he may, like proceedings being had in all respects as in the case of original applications, and on the payment of fifteen dollars, as hereinbefore provided, have the same annexed to the original description and specification." The Act of 1837, (ch. 45, § 8,) further provides, " that whenever any application shall be made to the commissioner for any addition, or a newly discovered improvement, to be made to an existing patent, or whenever a patent shall be returned for correction and reissue, the specification annexed to every such patent shall be subject to revision and restriction, * in the same manner as original applications [* 439] for patents ; the commissioner shall not add any such improvement to the patent in the one case, nor grant the reissue in the other case, until the applicant shall have entered

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a disclaimer, or altered his specification of claim, in accordance with the decision of the commissioner."¹

Now, I see nothing in these provisions which upon a re-issue of a patent requires the patentee to claim all things in the renewed patent, which were claimed as his original invention, or part of his invention in his original patent. On the contrary, if his original patent claimed too much, or if the commissioner deemed it right to restrict the specification, and the patentee acquiesced therein, it seems to me, that, in each case, the renewed patent, if it claimed less than the original, would be equally valid. A specification may be defective and unmaintainable under the Patent Act, as well by an excess of claim, as by a defect in the mode of stating it. How can the Court in this case judicially know, whether the patentee left out the knob, and ridge, and flaring of the lateral surface of the rib, in the renewed patent, because he thought, that they might have a tendency to mislead the public by introducing what, upon further reflection, he deemed immaterial or unessential, and that the patent would thus contain more than was necessary to produce the described effect, and be open to an objection, which might be fatal to his right, if it was done to deceive the public?² Or, how can the Court judicially know, that the commissioner did not positively require this very omission? It is certain, that he might have given it his sanction. But I incline very strongly to hold a much broader opinion; and that is, that an inventor is always at liberty in a renewed patent to omit a part of his [* 440] original invention, if he * deems it expedient, and to retain that part only of his original invention, which he deems it fit to retain. No harm is done to the public by giving up a part of what he has actually invented; for the

¹ See Act of 1836, ch. 357, § 7. See Appendix.

² Act of 1836, ch. 357, § 15. Ib.

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public may then use it; and there is nothing in the policy or terms of the Patent Act, which prohibits such a restriction.

The other part of the objection seems to me equally untenable. If the description of the combination of the thickness and the slope of the front and back surfaces of the rib, were a part of the plaintiff's original invention, (as the objection itself supposes,) and were not fully stated in the original specification, that is exactly such a defect, as the Patent Acts allow to be remedied. A specification may be defective, not only in omitting to give a full description of the mode of constructing a machine, but also in omitting to describe fully in the claim the nature, and extent, and character of the invention itself. Indeed this latter is the common defect, for which most renewed patents are granted.

Another objection is, that the plaintiff, in his claim, has stated, that the desired distance or space between the upper and the lower surfaces of the rib, whether it "be done by making the ribs thicker at that part, or by a fork or division of the rib, or by any other variation of the particular form," is a part of his invention. It is said that the modes of forking and dividing are not specified, nor the variations of the particular form given. This is true; but then the Patent Act requires the patentee to specify the several modes, "in which he has contemplated the application of the distinguishing principle or character of his invention."¹ Now, we all know that a mere difference of form will not entitle a party to a patent. What the patentee here says in effect is: One important part of my invention consists in the space or distance between the * upper and lower surfaces [* 441] of the ribs, and whether this is obtained by making the ribs solid, or by a fork, or division of the rib, or by any

¹ Act of 1836, ch. 357, § 6. See Appendix.

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other variation of the form of the rib, I equally claim it as my invention. The end to be obtained is the space or distance equal to the fibre of the cotton to be ginned; and you may make the rib solid, or fork it, or divide it, or vary its form in any other manner, so as that the purpose is obtained. The patentee, therefore, guards himself against the suggestion, that his invention consists solely in a particular form, solid, or forked, or divided; and claims the invention to be his, whether the exact form is preserved, or not, if its proportions are kept so as to be adapted to the fibre of the cotton which is to be ginned. In all this I can perceive no want of accuracy or sufficiency of description, at least so far as it is a matter of law, nor any claim, broader than the invention, which is either so vague or so comprehensive, as, in point of law, not be patentable. It was not incumbent upon the patentee to suggest all the possible modes by which the rib might be varied, and yet the effect be produced. It is sufficient for him to state the modes which he contemplates to be best, and to add, that other mere formal variations from these modes he does not deem to be unprotected by his patent.

Another objection is, that the patentee has not sufficiently described the slopes between his ribs, so as to make the description intelligible, or to enable a skilful mechanic to construct them. Whether this be so, or not, is not a matter of law upon the face of the patent, but a matter of fact for the jury, if there be any serious doubt about it.

Some other objections have been taken, such as, that the invention is not new, that the original patent and the renewed patent are not identical for the same invention, and that the patent was obtained with a fraudulent intent, for the purpose of covering the invention of Copeland, which has been patented and sustained in this Court against the claim [* 442] of the * plaintiff. But these all involve matters of fact, which belong to the province of the jury, upon

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the evidence, with which I do not intermeddle, and upon which the parties are at liberty to take the opinion of the jury.

I have thus stated summarily, according to the suggestions of the counsel for the defendants, my own views of the patent ; and of the objections taken thereto. I have stated them in my own language ; and with a view to make my own meaning clear. I cannot admit, that I am bound to respond to the very terms, in which the objections are taken, or to give instruction to the jury, affirming or denying them, without qualification or explanation. If the counsel for the defendants wish for a more deliberate examination of the points of law, after the trial is over, they can be brought again before this Court, upon a motion for a new trial ; or, if a verdict is given to the plaintiff to an amount, which will justify an appeal, the opinion of the Supreme Court may be taken upon the matters of law.

Upon these statements of the Court, the defendant's counsel elected not to go to the jury, and a verdict was by consent taken for the plaintiff, for \$960.50, subject to the opinion of the Court upon the matters of law ; and also to the ruling of the Court as to the inadmissibility of one Edson, who was, at the time of the supposed infringement, a member of the corporation, and had since sold out his interest ; and whom the Court rejected as a witness for the corporation.

In the trial of this case the following rulings were excepted to by the defendants :

The defendants understand the following points to have been ruled by the Court, namely, " That the describing and claiming the increasing of the distance from where the cotton goes in, to where it comes out from between the grates, to be equal * to the length of the fibres of [* 443]

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cotton to be ginned, is a sufficiently accurate, specific, and definite description and claim.

“That the patentee had a right to drop the things patented in his original patent, namely, the knob, the ridge, and the flaring of the lateral surface of the rib above the saw, and patent in his renewal the combination of the thickness and the slope of the front and back surfaces of the rib.

“That the claiming of the increasing of the distance from where the cotton enters to where it comes out from between the ribs, by forking, division, or any variation of the particular form, is not claiming too much.

“That the patentee had a right to claim, and patent, the knob or projection F, in his renewal, of the same width as the rib, notwithstanding he had described and patented the same in his original as narrower than the rib.

“That the patentee was not bound to specify the modes of forking, and division, and variations of the particular form claimed and patented by him.

“That the original was invalid and inoperative, within the provisions of the Patent Law for a renewal.

“That the patentee, by specifying the distance, which the cotton is carried between the ribs, and not claiming the same as an element of his patent, did not thereby abandon the same.

“That the patentee, by distance, which the cotton was so carried to be equal to the “full” length of the fibre in the original, was not thereby precluded from claiming and patenting that distance, caused by thickness of the rib or otherwise, equal to the average length of the fibres on one seed, in his renewal.

“That the patent describes, and claims with sufficient clearness, and exactness, a slope between the ribs.

“That the specification states sufficient elements [* 444] for a * patent for a combination, and adequately specifies, points out, and claims a combination.

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“That John Edson was interested in the event of the suit, and by reason of such interest, was incompetent as a witness.

“It was, as the counsel for the defendants understood the case, established by the testimony, and not disputed, that the thickness of the grate, or distance that the cotton passed between the grates, and the obliquity or slope of the shoulder, as specified by the plaintiff, were neither of them new.”

Phillips and Fletcher, for the defendant, now moved for a new trial.

Franklin Dexter, for the plaintiff.

STORY, J. To many of the objections, stated in the motion for a new trial, to the supposed rulings of the Court, a very brief answer may be given. In the first place, I cannot admit, that they are in terms the actual rulings of the Court, upon the points in controversy at the trial; and since they have been furnished to me, I have drawn out at large the views, which I then suggested upon the points in controversy at the trial; so that my actual meaning should be accurately understood. Upon further reflection, I do not feel it necessary to add to the views there suggested. They were as follows: [Here the judge recapitulated the remarks already cited as made at the trial.] I see no reason to be dissatisfied with what was then said; and if the observations then made were correct, it seems to me, that they dispose of the principal objections, at least, so far as my own judgment is concerned. They might be elaborated; but they contain the substance of all that I desire to say on these points.

One point is, however, now brought out upon the argument for a new trial, which was not so fully suggested at the * trial, and, indeed, which arose so [* 445] incidentally, that it was scarcely a matter calling for

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any very positive expression of the opinion of the Court. It is now said, that the plaintiff's claim is, in fact, for a new combination, a combination of a rib of a particular thickness, with the particular sloping up of his rib, as described in the specification; and that it is not the thing which is patented. It appears to me, that there is more of refinement in the form of this objection, than there is of difficulty in resolving it. The renewed patent is, in terms, a patent for "a new and useful improvement in the ribs of saw gins for ginning cotton." The original patent is substantially like it in the descriptive words. It is for "a new and useful improvement in the manner of forming the ribs of saw gins for ginning cotton." The language of the specification annexed to the renewed patent is, for "an improvement in the manner of forming the ribs of saw gins for ginning cotton." So that in substance we may clearly see, that the same improvement is designed to be included in the descriptive words. In the summing up of his claim in this last specification the patentee says: "I now claim as my invention, and desire to secure by letters-patent, the increasing the depth or space between the upper or outer surface of the rib, and the lower or inner surface of it, at the part where the cotton is drawn through the grate, so that it shall be equal to the length of the fibre of the cotton to be ginned (whether this is done by making the ribs thicker in that part, or by a fork, or division, or by any other variation of the particular form); and I also claim as a part of the same improvement the sloping up of the lower or inner surface of the rib, so as to meet the upper or outer surface above the saws, leaving, when the rib is inserted into the frame, no break, or shoulder between the two surfaces, but a smooth and uninterrupted passage upwards between the ribs, as above described." The drawings annexed to the specification are designed to make the description more

[* 446] * palpable and clear. And it is not without signifi-

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cance in the case to remark that, as the patent is for an improvement upon the common cotton gins, it presupposes, on the part of those interested in the matter, a full knowledge of the machinery and structure of the common gins. Now, to me it is perfectly clear, that the present patent is founded upon a claim for one entire thing, that is, for an improved rib, or a specified improvement upon the common rib of cotton gins. It is not a claim for two distinct and independent improvements, each susceptible of a distinct operation, or each claimed as a distinct invention; but both are claimed as parts and parcels of the same improvement, and necessary thereto. I do not say, whether each of the specified things, going to make up the entire improvement, might not have been separately claimed as several inventions. That is not a necessary point in the present case. What I mean to say is, that they are not so summed up in the claim; but they are summed up as making an entirety. They go to make up the improved rib, which is patented. That rib is the thing claimed, and not the thickness or depth or space of the rib alone, or the sloping up of the surfaces thereof alone. Both are claimed as parts of the same improvement, but neither alone as constituting it. I see no objection to its being called a combination of particular forms and arrangements of structure to complete the improved rib. In a just sense, that is a combination which requires different things or different contrivances or different arrangements to be brought together, to accomplish the given end. But it is far from following from this, that the combination is not and may not be treated as an entirety.

There is no magic in words; and above all, in patents, the Court looks through the whole patent and specification, in order to ascertain what the thing claimed and patented is; whether it is for an entirety, or for various distinct improvements, capable of a distinct operation and independent

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[* 447] use * in the same machine, or for both; or whether it is for a combination of two or more things in a particular machine, to produce a given result, or for a simple or single improvement in a particular machine; or whether it is for any one or more of them. There is no artificial or universal rule of interpretation of such instrument beyond that which common sense furnishes, which is to construe the instrument as a whole, and to extract from the descriptive words and the claim, what the invention is, which is intended to be patented, and how far it is capable of exact ascertainment, and how far it is maintainable in point of law, supposing it clear from all ambiguity.

Now, looking at the present patent, it seems to me impossible to entertain any real doubt as to its true interpretation. It is, as the words of the claim state it to be, for a single thing — “an improved rib.” The improvement is upon the existing rib in the cotton gin, and consists in two things, neither of which (as has been already suggested) is claimed separately, but both together, as constituting one conjoint improvement. It appears to me, that the claim sufficiently expresses the real nature, extent, and character of the improvement, and is in perfect compliance with the 6th section of the Patent Act of 1836, ch. 357. I should not have thought it necessary to consider this objection so far, if it had not been for the zeal and ingenuity with which it has been pressed upon the Court. Call the improvement an entirety or a combination, as we may please, it is still a patent for “an improved rib,” and nothing more.

The remaining objection is to the rejection of the testimony of Edson. And here it is, that I have entertained some doubt, upon which I was desirous of hearing the further argument which has now been had. The defendants were created a corporation by the Statute of Massachusetts of the 14th of June, 1823, and were, of course, made subject to all the lia-

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bilities and requirements of the general statute of 1821, (ch. 28,) * respecting the liabilities of manu- [* 448] facturing corporations. That statute provides " that every person, who shall become a member of any manufacturing corporation, which may be hereafter established in this Commonwealth, shall be liable in his individual capacity for all debts contracted during the time of his continuing a member of such corporation." The question turns, therefore, upon the meaning of the words " debts contracted," in the statute. Do they mean literally and strictly such debts as are due and payable in money, *ex contractu*, by the positive or implied engagements of the corporation, and resolve themselves into liquidated or determinate sums of money, due as debts,¹ or do they extend to all legal liabilities incurred by the corporation, and which, when fixed by a judgment, or award, or otherwise, are debts of the corporation? And if the latter be the true meaning, then, does the statute liability exist only from the time when it becomes an ascertained debt of the corporation, or does it relate back to the origin of the liability, and bind the corporators from that time?

If the words " debts contracted," in the statute, are to receive the limited construction, that they are applicable only to debts in the strict sense of the term, that is, contracts of the party for the payment of money, and nothing else, it is obvious, that the purposes of the statute, which although, in some sense, it may be deemed penal, is also in another sense remedial, would be comparative of little value. Suppose the case of a contract by the corporation to do work, or to manufacture goods of a particular quality or character, or to furnish materials, or to buy cotton or wool undelivered, or to build houses, or to employ workmen; and the contract should be

¹ See 2 Black. Comm. 464; 3 Black. Comm. 154.

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entirely unperformed, and broken, and refused to be performed, so that the right of the other party would [* 449] be, not to money, but to unliquidated *damages for the non-performance or refusal to perform; if these, which are by no means uncommon contracts, should be without the purview of the statute, it would have a very narrow and inadequate range and operation. Yet such cases sound merely in damages. Suppose a manufacturing corporation to obstruct its neighbor's mill-privilege, or stop his mill works, by back flowage, if such acts be not within the protection of the statute, we see, at once, that an insolvent corporation might do irreparable mischief without any just redress to the other party. Suppose such an insolvent corporation should unlawfully, under an unfounded claim of right, convert 100 or 1000 bales of cotton belonging to a third person, we see, that the mischief could be redressed only by an action of trover for unliquidated damages; and if the individual corporators were not liable therefor, after an unsatisfied judgment, the statute would be little more than a delusion. If, on the other hand, we should construe the statute broadly as a remedial statute, and give to the word "debts," a meaning, not unusual, as equivalent to "dues," and to the word "contracted," a meaning, which, though more remote, is still legitimate, as equivalent to "incurred;" so that the phrase, "debts contracted," in this sense would be equivalent to "dues owing," or "liabilities incurred," the statute would attain all the objects for which it seems designed. The Supreme Court of Massachusetts, in the *Mill-Dam Foundry v. Hovey*, (21 Pick. 455), held, under the Statute of 1829, (ch. 53, § 6,) which makes the stockholders liable for the debts of the corporation, that the term "debts" included a claim for unliquidated damages. That was a case arising *ex contractu*; but the language certainly extends the term "debts" beyond its close and literal meaning. And if it

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covers cases of unliquidated damages, *ex contractu*, it is difficult to say, why it should stop there, and not go further and cover cases of unliquidated damages arising from torts to property. In each case there is *no debt [* 450] until the damages are ascertained and liquidated ; and then the debt seems to relate back to its origin. Blackstone says, "a debt of record is a sum which appears to be due by the evidence of a court of record : thus when any specific sum is adjudged to be due from the defendant to the plaintiff in an action or suit at law, this is a contract of the highest nature, being established by the sentence of a court of judicature."¹ Here Blackstone manifestly included all sorts of actions or suits, where the judgment is for a sum certain, whatever may be its nature or origin.²

I agree that it is no part of the duty or functions of courts of justice, to supply the deficiencies of legislation, or to correct mischiefs which they have left unprovided for. That is not the question here. But the question is, whether, if the words of a statute admit of two interpretations, one of which makes the legislation incomplete for its apparent object, and the other of which will cover and redress all the mischiefs, that should be adopted, in a statute confessedly remedial, which is the most narrow, rather than that which is the most comprehensive, for the reason only, that the latter will create an obligation or duty, beyond what is imposed by the common law ?

It seems clear, that, in common parlance, as well as in law, the term is in an enlarged sense sometimes used to denote any kind of a just demand.³ And in the Roman law it

¹ 2 Black. Comm. 464 ; 3 Black. Comm. 160.

² 2 Black. Comm. 464 ; 3 Black. Comm. 160, 161 ; Com. Dig. Debt, A. 2.

³ See *Commonwealth v. Keeper of Philadelphia Prison* (4 Serg. & R. 506) ; *Gray v. Bennett* (3 Metcalf, R. 522, 526).

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had sometimes the like enlarged signification. *Sed utrum ex delicto an ex contractu Debitor sit, nihil refert*, says the Digest.¹

Upon this subject I confess that with all the [* 451] lights which * have been thrown upon the question by the able arguments at the bar, I am not without some lurking doubts. But having reflected much upon the subject, and being in the same predicament, which Lord Eldon is said to have suggested as having sometimes occurred to himself, that he felt doubts, but was unable to solve them to his own entire satisfaction, I have at length come to the conclusion that the rejection of the witness as an interested witness was right. I follow out the doctrine of the case of the Mill-Dam Foundry v. Hovey (21 Pick. R. 455), which as far as it goes, disclaims the interpretation of the word, "debt," as limited to contracts for the payment of determinate sums of money. Passing that line, it does not seem to me easy to say, that if cases of unliquidated damages may be treated as debts, because they end in the ascertainment of a fixed sum of money, that we are at liberty to say, that the doctrine is not equally applicable to all cases of unliquidated damages, whether arising *ex contractu* or *ex delicto*. If ultimately it ends in a debt, as a judgment for damages does, that case asserts, that its character as a debt relates back to its origin. Besides, it seems to me upon principle to be reasonable, if not absolutely justified by authority, to hold, that if the transaction occurs while a person is a member of the corporation, and he would, if he remained a member, be liable for the ultimate debt adjudged, it may well be treated as an inchoate debt consummated by the judgment. Since the argument was had, my attention has been called to the

¹ Dig. Lib. 5, tit. 3, l. 14; Pothier, Pand. Lib. 50, tit. 16, n. 69.

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case of *Gray v. Bennett* (3 Metcalf's R. 522, 530, 531), which, in several respects, confirms the reasoning, which I had previously adopted, in relation to the meaning of the word "debt," and the construction which it ought to receive in a remedial statute. If I had seen that case at an earlier period, it would have somewhat abridged my own researches on the same subject.

The result is, that the motion for a new trial is overruled, and judgment must pass for the plaintiff.

WILLIAM BROOKS v. EZEKIEL BYAM AND OTHERS.

[2 Story, 525. October T. 1843.]

A patentee of friction matches, by a deed under seal, undertook as follows : " to grant, bargain, sell, convey, assign, and transfer to B, his executors, administrators, and assigns, the right and privilege, hereinafter mentioned, of making, using, and selling the friction matches," patented, and to have and to hold " the right and privilege of manufacturing the said matches, and to employ in and about the same six persons, and no more, and to vend the said matches in any part of the United States." *It was held*, that this was a license or authority from the patentee, and need not be recorded in the Patent Office, under the Patent Act of 1836, ch. 357, s. 11.

A license need not be recorded in the Patent Office, unless there be some positive provision of the Patent Act, which renders it an indispensable prerequisite to its validity.

The recording within three months, according to the statute, is merely directory; and any subsequent recording of an assignment will be sufficient to pass the title to the assignee, except as to intermediate *bona fide* purchasers, without notice.

The Patent Act of 1836, ch. 357, s. 11, provides for the recording of three kinds of assignments, and of no others; first, an assignment of the whole * patent; secondly, an assignment of any undivided part thereof; [* 526] and, thirdly, a grant or conveyance of the exclusive right under the patent within any specified part of the United States.

It was held, that the right granted by the above deed was a license or authority,

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coupled with an interest in the execution, to the grantee and six persons to be employed by him in making matches; that the right was an entirety, incapable of being apportioned or divided among different persons; that, therefore, an assignment by B of a right to make as many matches as one person could roll up, was void.

Quere, if the license is not such a personal privilege, that the entirety cannot be assigned, notwithstanding it was given to B and *his assigns*.

The general rule of the common law is, that contracts are not apportionable; and this rule seems ordinarily, though not universally true, where the apportionment is by the act of the party, and not by mere operation of law; or where the contract is only in part performed, and is not in its own nature severable.

Quere, if by the maritime law the contract in the case of *Cutter v. Powell*, 6 T. R. 320, was not divisible.

No apportionment or division of a license or privilege can be made, if it be contrary to the true intent of the parties thereto.

Quere, if an owner grant to A the privilege of cutting timber off his land, with the assistance of four men employed by him, can A sell the license and right of employment to the extent of one man's share?

An authority to A, cannot be assigned or executed by B. *A fortiori*, it is not apportionable, so that a part may be executed by B, and a part by C, and a part by D, and the residue by A.

BILL in equity for an injunction and for relief. This is the same case which has already been before the Court on an interlocutory motion (*ante*, 1 Story R. 296.) It also relates to the same patent which formed the subject of inquiry in *Ryan [Byam] v. Goodwin* (*ante*, 3 Sumner R. 514.)

The bill states that one Alonzo D. Phillips obtained letters-patent for the making of friction matches; that he sold six rights therein, that is, the right to employ six persons at the same time, in the manufacture of the said matches, to one John Brown; and that Brown sold one such right to the plaintiff; but that the deeds of conveyance, both to Brown and the plaintiff, were not recorded in the Patent Office. It also states that the defendants, claiming to be the sole assignees [* 527] of Phillips, * by a deed of conveyance, bearing date July 20th, 1838, from him to Byam, and from Byam to the other defendants, but of later date than the deed to the

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plaintiff, had commenced a suit against him, in the Circuit Court of the United States, for the district of Massachusetts, for an alleged invasion of their said right; the plaintiff averring that he has done nothing therein not granted to him by the deeds from Phillips to Brown, and from Brown to him.

The bill further alleged, that at the time of the assignment from Phillips to Byam, and before delivery of the deed, the said Byam and the other defendants knew, or had good cause to know, of the said conveyances from Phillips to Brown, and from Brown to the plaintiff.

Evidence was taken tending to show knowledge on the part of the defendants, as alleged in the bill; but the case was argued on other grounds.

The following are the conveyances from Phillips to Brown, and from Brown to Brooks, the plaintiff:

“Copy of Assignment from John Brown to William Brooks. An agreement made this eighteenth day of September, A. D. 1837, by and between John Brown, of Fitchburg, of the one part, and William Brooks, of Ashburnham, of the other part. Witnesseth —

“That the said Brown, in consideration hereinafter mentioned, agrees to sell and convey unto the said Brooks a right of manufacturing friction matches according to letters-patent granted to Phillips and Chapin of Springfield, in said town of Ashburnham, to the amount of *one right*, embracing one person only so denominated in as full and ample a manner to the extension of the said one right, as the original patentee. And the said Brown further agrees to go to Ashburnham and assist the said Brooks in learning the art and mystery of manufacturing said friction matches for the term of two days, and also to furnish from his, the said Brown's establishment in *Fitchburg, one girl, acquainted with said [* 528] manufactory, to instruct other girls in said Brooks's employment in the said art and mystery of folding and binding

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up said matches, for the term of two weeks. Also the said Brown further agrees with said Brooks, not to sell any right of manufacturing said friction matches, or of vending the same to any person living or intending to manufacture or vend said matches within forty miles of said Ashburnham.

“ And the said Brooks, on his part, agrees with said Brown, upon condition that the said Brown keeps and truly observes all and each of his agreements aforesaid, to pay him, the said Brown, the sum of fifty dollars in six months from this date.

“ And it is mutually agreed between the parties, that if it should turn out, upon legal investigation, which is now in progress, that said Phillips’s and Chapin’s patent-right is invalid and of no effect in law, then said Brooks is not to pay said Brown any part of the said sum of fifty dollars, but only the reasonable expenses for the services of the said Brown, and the girl, for the term aforesaid.

“ JOHN BROWN.

“ WILLIAM BROOKS.

“ Witness,

“ EDMUND SANDERSON.

“ JOSEPH MERIAM.

“ September (), 1837.

“ Renewed the said Brooks’s note for the sum of twenty-five dollars to this agreement.

“ Patent Office. — Received and recorded, Liber D. of Transfers of Patent-Rights, page 96. July 15th, 1839.

“ HENRY L. ELLSWORTH,

“ Commissioner of Patents.”

“ Copy of Assignment of Phillips and Brown. — Know all men by these presents, that I, Alonzo D. Phillips [* 529] of Springfield, * in the County of Hampden and

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Commonwealth of Massachusetts, in consideration of three hundred dollars to me paid by John Brown of Warren, in the County of Merrimac and State of New Hampshire, the receipt whereof I do hereby acknowledge, have granted, bargained, sold, and conveyed, and do by these presents for myself, my executors and administrators, grant, bargain, sell, convey, assign, and transfer to him the said Brown, his executors, administrators, and assigns, the right and privilege hereinafter mentioned, of making, using, and selling the 'friction matches,' an invention of the said Phillips, and patented to him by letters-patent of the United States, bearing date October 24, 1836, for the term of fourteen years. To have and to hold to him the said Brown, his executors, administrators, and assigns, as fully as I can or may, by virtue of said letters-patent, the right and privilege of manufacturing the said matches, and to employ in and about the same six persons and no more, and to vend said matches in any part of the United States. And I do covenant and agree with the said Brown, that I have full power and lawful authority to convey the said right and privilege, and will warrant and defend the same, for the purposes aforesaid. Provided, however, that nothing herein contained shall prevent or restrict me from making and vending the same or of selling and conveying similar rights and privileges to others. Provided also, that the said Brown shall not manufacture the said matches in any place within forty miles of Methuen.

"In witness whereof I have hereunto set my hand and seal this 2d day of January, A. D. 1827.

"ALONZO D. PHILLIPS. [L. S.]

"Signed, sealed and delivered, in presence of

"RHODOLPHUS KINSLEY.

"ARTEMA ROGERS."

"* Hampden, ss. January 2d. A. D. 1836.— Per- [* 530]

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sonally appeared the above Alonzo D. Phillips, and acknowledged the foregoing instrument to be his free act and deed.

“ Before me, R. E. BEMIS, Justice of the Peace.

“ Patent Office. — Received and recorded. Liber D. of Transfers of Patent-Rights, page 89. July 15, 1839.

“ HENRY L. ELLSWORTH,
“ Commissioner of Patents.”

It will be observed that these were not recorded until some time subsequent to the conveyance to Byam.

The cause being set down for a hearing upon the bill, answers, and evidence in the cause, was argued by *C. Sumner* and *Greenleaf*, for the plaintiff, and by *E. Smith* and *Dexter*, for the defendants.

The first question that was presented, was whether it was requisite to the validity of the deeds from Phillips to Brown, and from Brown to Phillips, that they should be recorded in the Patent Office.

Sumner, for the plaintiffs, argued, that *recording* is not required by the common law, or any general principles of law. It is of statute origin; and we are, therefore, to look to the legislation on the subject of patents, to ascertain if there be any requisition applicable to these deeds. He then reviewed all the Patent Laws of the United States, those obsolete, as well as those in force, to show that the recording of a *mere license* under a patent, had never been required.

Dexter, for the defendants, said he should not contend that it was necessary that the license assigned by the patentee, Phillips to Brown, or by Brown to Brooks, should be recorded

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in the Patent Office. But he argued, that the assignment by Brown to Brooks was utterly void, because the license to *Brooks by the patentee was an entirety, [* 531] and incapable of being divided. It was transmissible, but not apportionable.

The Court then requested *Sumner* and *Greenleaf* to confine their argument to this last point.

The argument for the plaintiff was as follows: The ancient rule of the common law was, that a *contract could not be apportioned*. The reason of this was expressed by Holt, C. J., in *Hawkins v. Cardell* (1 Salk. 65,) where he said, "where a man's contract has subjected him *only* to one action, it cannot be *divided*, so as to subject him to *two*." Finch says, "the duty growing upon a contract cannot be *apportioned*."¹ The rule seems to have been of the same class with the rule prohibiting the assignment of a *chose of action*; and also prohibiting *maintenance*. Both of these, in various ways, have lost much of their original stringency. Choses in action, through the intervention of equity, are now assignable; and the commissioners for the reform of the criminal law in England, in their seventh report, recently offered, class *maintenance* among the offences, "the policy of retaining which is at least doubtful."—Law Magazine, No. 61, p. 3. The same policy, which has gradually restrained the ancient rules in the two last cases, would bear in restraint of the rule against the *apportionment of a contract*.

But even in the earliest times this rule was *very much restrained*, or rather, received a very limited application.

¹ See Finch's Law, book ii. cap. 18.

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Let us consider first the cases to which the rule was applied.

Apportionment did not take place in the following cases:

(1.) *Debt.* Brooke, Abr. Apportionment, pl. 17; 3 Viner,

Abr. Appt. A. § 7. (2.) *Contract.* 3 Viner,

[* 532] Appt. § 11. * (3.) *Obligation.* 3 Viner, Appt.

§ 10. These three instances are only expressions

of the rule we are considering. (4.) *Rent-charge.* 3 Viner,

Appt. § 1. (5.) *Rent-seck.* 3 Viner, Appt. § 2. The last two

instances are where there was an obligation, debt, or contract, so that in principle they are like the others. (6.) A *Condition*

cannot be apportioned except by act of law. 3 Viner,

Appt. § 17. (7.) A *Relief.* 3 Viner, Appt. § 18. (8.) An

Assent. 3 Viner, Appt. § 5. Both of these last are technical,

and applicable the first to feuds, and the second to attornments.

(9.) An *Authority* (as of a sheriff to his undersheriff not to meddle with executions beyond such a sum,) cannot

be apportioned. Norton v. Simms (Hobart, 13); 3 Viner,

Appt. § 25. This case might be extended to all offices,

which implied a *personal* confidence.

Let us now consider the cases where *apportionment* has

been allowed. And here we remark one element common to

these cases, namely, that wherever the right in question is in

the *nature of property*, in contradistinction to a mere *chose in*

action, it may be *apportioned*.

1. *Common appurtenant* to land for cattle, levant, and couchant,

by grant shall be *apportioned*, if part of the land is granted

over to another. Danver's Abr. p. 504. This principle

was established in a case in Hobart's Rep. 235 a. Where it

was adjudged, that, where one had a common appurtenant to

ten acres of land, &c., and sold part of it, that the common

should be *apportioned*, and every one should have common

for his beasts, levant and couchant, upon his part; for

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these are things entire in several degrees; *save that it cannot be divided by any act of the parties*, as warranty, conditions, and such other, which yet by act in law are divided. But the case of common is not so strict an entirety; and the mischief of generality of the case requires an extension for the general good.

* Another instance where common was *apportioned* is in Danver's Abridgt. Apportionment B. §

19: "If a man prescribes to have common for two yard-lands for four beasts, four horses, and sixty sheep, &c., and after he leases for years one of the yard-lands, *the lessee shall have common, pro ratâ.*" The principle of the *apportionment* in this case seems like that which should govern the *license* from Brown to Brooks, to exercise a right to the *extent* of what *one girl* could roll up. The right to the whole common for the *two yard-lands* was not conveyed, but only such a right as was attached to *one yard-land*.

Another instance, which is in the nature of *common*, is in 3 Viner's Abr. Apportionment, A. § 22: "*Fold-course* appurtenant to a manor for 300 sheep in 70 acres, &c., may be *well divided,*" &c.

Another instance in Danvers, Abr. Appt. B. § 18: "If a man, seised of 60 acres of land, prescribes to have common in other land for all his cattle, levant and couchant thereupon, and he makes a feoffment in fee of *five* of these acres, his feoffee shall have common proportionably, *pro ratâ.*"

2. *Rent.* We have seen, that certain kinds of *rent* could not be *apportioned*. But the disposition to break in upon the rigor of the rule has been very strong. It will not be necessary to go over all the cases where *rent* has been *apportioned*. "If there be lord and tenant of 20 acres by fealty, and 10 shillings rent, and the tenant aliens two acres in fee, the alienee shall hold the *two acres, &c., and the rent shall*

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be apportioned according' to the value." Danvers, Appt. B. § 1.

"If the king's tenant leases for years, rendering rent, and after grants the reversion of two parts to another, and dies, and his heir is in ward for the third part of the reversion, which descended, and the king grants the third part over, *the grantee shall have an action of debt for the third part of the rent; for it shall be apportioned.*" 3 Viner, Abr. Appt. B. § 3.

[* 534] * "If lessee for 20 years leases for 10 years, rendering 3*l.* 6*s.* 8*d.*, and after devises 20*s.* of this rent to *three* persons, to hold to each of them *one third* part divided, and dies, *this rent shall be apportioned* according to the devise, and *each devisee may have an action of debt against the lessee for his part*, namely, 6*s.* 8*d.*, **THOUGH HEREBY THE LESSEE MAY BE CHARGED IN SEVERAL ACTIONS.**" Danvers Appt. B. § 4; S. C. 3 Viner, Appt. B. § 4. See also Fitzherbert, N. R. 235.

"If one have a *rent-service* of money, or corn, or pepper, &c., issuing out of land, and purchase part of it in fee, the whole rent is not extinct, but shall be apportioned *juxta valorem terræ*; and so also it is of other services, **IF THEY BE DIVISIBLE**, but if they be *entire* and *valuable*, as a *horse*, or the like, then they be gone and extinct." Shepperd's Epitome, Appt. cap. 14, p. 100.

3. *Services* shall be *apportioned* upon disseisin. 3 Viner, Appt. § 4. The case in 8 Edward III. Year Book, I have not been able to find. An exception to this is with regard to *suit of Court*, which is not apportionable. Shepperd's Epitome, p. 103, Appt. And they shall be apportioned even without disseisin. "Where a man is bound to repair a bridge by reason of his land, and aliens part of it, he shall be rated according to the portion." 3 Viner, Appt. A. § 9. A writ in this case is given in Fitzherbert, N. B. p. 235.

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4. *Tithes*. "Money, payable for tithes by composition or sale of part of the land, shall be apportioned; and each purchaser shall pay his share," &c. 3 Viner, Appt. A. § 19.

5. *Power*. "A power is apportionable; but a seignory or condition is not," &c. Edwards v. Slater, Hardres, 416; 3 Viner, Appt. A. § 25.

It would seem, from this survey of the cases on the subject of *apportionment*, that the Courts have endeavored to extricate themselves as much as possible from the rule. The ancient cases have been invaded by many exceptions; and *even the rule *with regard to contracts* [* 535] has only a modified application now, compared with what it once had.

There is another principle which bears on this subject; the rule that a contract could not be *apportioned*, is a rule of the *common law*, and is not to be extended beyond the proper influence of this jurisprudence. There are some ingenious remarks by Mr. Hammond, in his *Nisi Prius*, p. 409, (note,) Replevin, cap. 3, pl. 6, which illustrates this: "Rent reserved upon a *tenure* (he says) is *apportionable* by act of contracting parties; because the first is the offspring of the *feudal system*, and, therefore, amenable to its rules only; the other, the creature of our own common law, and, therefore, subject to the maxim that *a contract cannot, but by act of law, be divided*."

Let us now apply the result of these authorities to the deed from Brown to Brooks.

In the first place, this deed does not concern any interest known to the ancient common law; it is not a contract in the view of the old law. It is evidence of property; or, to use the language of the deed, it is a "*right and privilege*," under the Patent Law of the United States; a system of legislation more distinct from the *common law* than the *feudal law*, which, according to Mr. Hammond, was a distinct system.

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This consideration serves to remove the question from the immediate stress of the ancient rule.

But, in the second place, it is not only under rules different from those of the common law ; but it does not come within any of the things to which this old rule has been applied. It is not a *debt* ; nor a *contract* ; nor an *obligation* ; nor a *rent-charge* ; nor *rent-seck* ; nor a *condition* ; nor a *relief* ; nor an *assent* ; nor an *authority* (according to the acceptance of this word in the old cases.)

It is a certain interest under the Patent Laws ; an interest first provided for expressly by the Act of Congress, [* 536] April * 10th, 1760, cap. 34, § 4. It has been called a *license*, and, in some senses, may be regarded as such. But if a simple machine, that has been patented, should be conveyed to a person, this conveyance comes with an *implied license* to use the same ; and the machine with the license would be valuable as property. Such is the character of the "right and privilege" in the present case, to make matches. It is *property*.

As *property*, it is not touched by any of the ancient cases, which are adduced as *authorities* against its *division* or *apportionment*.

But, further, it is in its *nature* "*divisible*;" and this of itself is a reason, according to Shepperd's Epitome, p. 100 for allowing the *division*. It is a right to make as many matches as *six* girls can roll up ; if it were to make as many as *one* girl could roll up, it might well be doubted whether it was "*divisible*;" but *one sixth* of the original right is, at once, a *fractional* part of that right, and a *unit* in itself. It is like a *rent-service* of *six* horses, which would be "*divisible*."

To this reasoning it is objected, that, by this division, the original patentee would be put to the trouble of watching *six* persons, instead of *one*, and that this should not be imposed on him. But, it is submitted that, in point of fact, no greater

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trouble will be imposed on him than he has already assumed. It seems to be admitted, that Brown might send his *six girls* to *six different* sections of the country, each girl carrying on in her section a separate establishment. Here would be *six* establishments for the patentee to watch. The only difference asserted between such a case and that now before the Court, is, that in the one case, Brown, the original assignee, would be primarily liable for any *misuser* of the *right*; whereas, in the present case, the patentee would be driven to look to the *several parties* to whom the *right* had been conveyed. But this difference in reality is very slight; it is what Lord Eldon would have called "very thin."

* But suppose this additional trouble of watching [* 537] *six persons*, instead of *one*, is imposed by the *division*; it is confidently submitted that, in point of strict law, this would not prevent the division. The case in Danvers, Abr. Appt. B. § 4, was where an apportionment was allowed, "*though thereby the lessee might be charged in several actions.*" The cases, with regard to *apportionment* of common, all recognize the same principle. In all these the trouble is imposed upon the parties interested in the common to watch a larger number of persons. The other cases, already cited, where apportionment has been allowed, as of rent, &c., all involve the same "trouble," multiplied by every division. And yet these cases were decided in the early periods of our law, when the rule against apportionment was regarded with more favor than at present.

Another consideration remains, whether there is any thing in this so-called *license*, which is *personal*, and, in its nature, not to be *assigned*. In determining this, we are to look again at the laws from which it draws its origin — *Patent Laws*. The *license* to make matches is a *sale* of the "right and privilege" to make matches; it being a certain interest under the patent, which, according to the *spirit* of the Patent Laws,

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is *saleable*. In its character, it does not differ from the *sale* of a patented machine, as of a pump, which carries with it a *license* to use. But has any one ever contended that a *patented* pump may not be sold and resold, as often as the owners of it may desire? No *sale* is *personal*. An article once *sold* is given to the world.

The very language of the deed from Phillips to Brown is in confirmation of this view. The words of grant are the strongest known to our law. The language denotes, that it was considered *property*, and not a mere *chose in action*. It is essential, that all the words employed should have an operative meaning. The law does not, of itself, strike [* 538] out words, * which the parties have introduced. It construes an instrument so as to give reasonable effect to all the words; *ut res magis valeat quam pereat*. Lord Bacon has expressed the rule on this subject in distinct words. *Verba aliquid operari debent, verba cum effectu sunt accipienda*. Maxims of the Law Regula, III.

But if it should be doubted whether effect is to be given to this word "*assigns*," and further, whether the deed is capable of *division*, then we rely upon another rule of interpretation, which is adapted to a case like this. *Verba fortius accipiuntur contra proferentem*. Lord Bacon has clearly pointed out the reason of this rule, and the cases, which will justify its application. Maxims, Reg. III.

The argument for the defendants was as follows: It is a mistake to call this *property*, in any sense which is decisive of the question. It is not an assignment of any part of the patent-right, as the grant of it in no degree abridges the remaining right in the hands of the patentee. It is not classed among assignments in the Patent Act. It needs not to be recorded, and the licentiate can maintain no action in his own name. It is a valuable right, and in no other sense is it pro-

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perty ; but rights are not dividible, because they are valuable. It is strictly a permission to do that which none but the patentee can do without his consent. The right to make, does not imply the right to sell that privilege, much less to sell six privileges, where only one was granted.

Such is not the compact made between the parties ; it is an executory contract, or, at least, a continuing contract, and not in the nature of a grant of property. Property, once conveyed, without any peculiar restriction, is as completely at the disposition of the grantee, as it was at that of the grantor ; but that right, which consists in the liberty of continuing to do a thing, must be taken and used as it is given.

The *grantee of the power cannot vary or add to the [* 539] terms of the contract. The case falls precisely within that class of "authorities" which, according to the cases cited on the other side, cannot be apportioned. The authority given by a sheriff to his deputy, according to the case in Hobart, is not more strictly a new authority than that of a license by a patentee, which conveys to the grantee no portion of that exclusive right, which the patentee derives from his patent. It is asked whether the vendee of a patented machine may not sell it with the implied right of using it. Certainly he may ; because the machine is property, in the strict sense of the word ; and the right of using it is but appurtenant to the possession. Upon a similar distinction proceeds that class of cases in which the right of common is held to be divisible, because it is appurtenant to land, which is itself divisible, and so the man, who bought six patent machines, bought therewith the right of use appurtenant to each, and could, therefore, sell them each with the right annexed.

If I may be permitted to use the expression, the fallacy of the argument on the other side consists in treating this contract as a sale of as many matches as six girls can roll up ; thereby making the right of manufacturing a mere appurte-

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nant to the principal grant ; like the cases put of a sale of as many bricks from a yard as two horses can haul, &c. In all these cases it is a sale of clay, timber, or wood, with a right to take it from the vendor's land, and this brings them within the reason of the cases of common rent, and other things issuing out of land, where the principal thing is a divisible property, and the appurtenance follows the principal ; but the present case contains no contract of sale of the matches, nor of any of the materials of which they are composed ; it is simply a license to Brown to take his own wood, phosphorus, chalk, glue, and brimstone, and make them up into matches according to the vendor's patent ; it is a mere power, [* 540] coupled * indeed with an interest, and, therefore, not revocable. There is something of a personal trust in the contract, as the vendor might prefer to trust one man rather than another with a power so likely to be abused. Perhaps the use of the word *assigns* in the deed, though of no force at law, if the thing be not assignable, might protect an assignee of the whole in equity. But it is unnecessary to pursue this inquiry, because there are no words in the deed contemplating a division. It is not agreed, that by a fair interpretation of the license, Brown could establish six manufactories in six different places. The license provides that Brown shall not manufacture in any place within forty miles of Methuen. This shows the place of manufacture was thought of some importance, although the right is given to vend in any part of the United States ; but supposing such a right to exist, it is by no means true, that the same inconvenience would follow from it to the patentee, as from the establishment of six independent manufactories. The patentee would thereby lose the responsibility of the person with whom he contracted for the conduct of his subordinates, though perhaps the same evil to a less extent might result from the general assignability of the contract.

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But no answer has been given to the more weighty objection urged at the bar, and that is, that by this subdivision six competitors with the patentee are brought into the market instead of one, each with the power, and under the obvious temptation, to undersell the other in a manufacture, in which the materials cost almost nothing, the consumption is almost unlimited, and the profit very great. We think this decisive, and that Mr. Phillips and his assignee may well say that they have made no such contract with Brown.

As to the point, that if Brooks took no legal title, he ought, at least, to be protected as an equitable assignee, it is obvious that this construction would leave the patentee and his * assignees exposed to all the disadvantages of a [* 541] legal title in Brooks. The cases of *Dunlap v. Stetson*, and *Moody v. Towle*, 4 Mason, 349; 5 Greenl 415, cannot be applied to this; for in those cases the thing divided was of a divisible nature, although the note, the evidence of the debt, was not.

The following cases were cited by the counsel for the defendant. *Robson v. Drummond*, S. B. & Ad. 303; *Planche v. Coburn*, 5 Car. & Payne, 58; S. C. 8 Bing. 14; *Hall v. Gardner et al.*, 1 Mass. R. 172; *Davis v. Coburn*, 8 Mass. R. 299.

STORY, J. The question, which seems originally to have been one of the main hinges of this controversy, and to which, as a matter of fact so much of the evidence is addressed, is, whether Byam, at the time of the purchase of the patent-right of Phillips, which was subsequent to the license granted by the patentee to Brown, had notice of the license so granted to Brown. That point becomes wholly immaterial, if the license itself is not by law required to be recorded. And independent of the admission of counsel, I am entirely satisfied, upon the

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true construction of the Patent Act of 1836, ch. 357, § 11, that such a license is not required by law to be recorded in the Patent Office, in order to give it effect and validity. In this view of the matter, I adopt throughout the argument of the learned counsel, who opened the cause for the plaintiff. My reasoning upon the point is briefly this. The license is not *per se* required to be recorded, unless there be some positive provision of the Patent Act, which renders it an indispensable prerequisite to its validity and obligation. There is no other act in force requiring any assignment of any patent-right to be recorded, except the Act of 1836; and the eleventh section of that act is in these words: "That every patent shall be assignable in law, either as to the whole [* 542] 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 grant to others to make and use, the thing patented within and throughout any specified part or portion of the United States, shall be recorded in the Patent Office within three months from the execution thereof, for which the assignee or grantee shall pay to the commissioner the sum of three dollars."

I have already, in other cases, had occasion to decide that the recording within three months is merely directory, and that, except as to intermediate *bona fide* purchasers, without notice, any subsequent recording of an assignment will be sufficient to pass the title to the assignee. Now, as has been well observed by the counsel for the plaintiff, three cases only of the recording of assignments are provided for in the foregoing section; first, an assignment of the whole patent; secondly, an assignment of any undivided part thereof; and, thirdly, a grant or conveyance of the exclusive right under the patent within any specified part or portion of the United States. The present case falls not within either predicament. It is

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not a grant of any exclusive right ; but at most the grant of a right of privilege of manufacturing matches under the patent in any place not within forty miles of Methuen, and to vend them in any part of the United States concurrently with the patentee and any other grantees under him. It is in no sense, therefore, an exclusive right. It is not an assignment of the patent itself, or of any undivided part thereof, or of any right therein limited to a particular locality. In truth, in propriety of language, it is strictly a license or authority from the patentee to Brown to make and vend the matches, without giving him any exclusive right except as to the matches he shall manufacture, exactly as the sale of a patented machine by the patentee would give to the purchaser the right to use the same, without in any manner restricting the patentee in his right to grant or *sell other similar machines to [* 543] any other persons for use. The language of the instrument of conveyance to Brown by the patentee, is that he doth "grant, bargain, sell, convey, assign, and transfer to him the said Brown, his executors, administrators, and assigns, the right and privilege hereinafter mentioned of making, using, and selling the friction matches" patented, and to have and to hold "the right and privilege of manufacturing the said matches, and to employ in and about the same six persons, and no more, and to vend said matches in any part of the United States." Then comes the proviso, that nothing herein contained shall prevent or restrict the patentee from "making and vending the same, or of selling and conveying similar rights and privileges to others ;" and a further proviso, that "the said Brown shall not manufacture the said matches in any place within forty miles of Methuen." It seems to me that this language admits of no other rational interpretation, than that which I have already put upon it. My judgment accordingly is, that no recording of this instrument was necessary to give it complete validity ; and therefore the question

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of notice thereof by Byam, at the time of his purchase, becomes unnecessary to be decided.

The other question as to the indivisibility of the license granted to Brown, involves considerations of more nicety and difficulty. By the agreement between Brown and Brooks, (18th of September, 1837,) it was agreed by Brown to sell and convey unto Brooks "a right of manufacturing friction matches according to letters-patent, granted to Phillips, &c. in the said town of Ashburnham, *to the amount of one right*, embracing one person only, so denominated, in as full and ample a manner to the extension of the said one right as the original patentee;" and Brown further agrees "to go to Ashburnham and assist Brooks in learning the art and mystery of manufacturing such friction matches, &c., &c.;" and,

also, "not to sell any right of manufacturing said [* 544] friction matches, or of vending * the same to any person living, or intending to live, to manufacture or vend said matches within forty miles of said Ashburnham."

The question, then, is, whether the license or privilege granted by the patentee to Brown is not an entirety, and incapable of being split up into distinct rights, each of which might be assigned to different persons in severalty. I do not meddle with another point, and that is, whether the entirety of the license or privilege to Brown was capable of being assigned, though if it were intended to be a personal privilege or license, it might open a ground for argument, notwithstanding the use of the word "assigns." That point does not arise in the present case; for here the whole license or privilege is not sold or assigned; but one right, embracing one person only. It has been well said that the right or license may be transmissible, although not apportionable. There is some obscurity in the language of the instrument, which makes it somewhat difficult to give a definite interpretation to it. Brown's

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privilege or license is at most to himself and his assigns, and "to employ in and about the manufacturing of the matches six persons, and no more." Brown agrees to sell to Brooks "one right, embracing one person." Now, the privilege or license to Brown, (assuming it to be capable of assignment,) is to him, and to his assigns, to employ six persons. Whoever is employed is to be employed by Brown and his assigns. It would seem to be a reasonable interpretation of this language to say, that all of these persons should be employed by one and the same party, either all by Brown, or all by his assigns. But the sub-agreement with Brooks conveys to him one right in severalty, embracing one person, that is, (as I understand it,) the right to employ one person in the manufacture of the matches. So that if this agreement be valid, then the original privilege or license, granted by the patentee to Brown, upon this construction, includes six distinct and independent rights, each of which may be granted to a different *person in severalty. Now, I must confess, that such a construction is open to all the objections stated at the bar. It exposes the patentee to the competition of six different distinct persons, acting in severalty, and independently of each other. It may make an essential difference to the patentee in his own sales, whether the whole of the right or privilege granted to Brown be in the possession of one, or more persons, having a joint interest, and of several persons, each having a separate and independent interest. The danger to the patentee of an abuse or excess of the right or privilege granted by him is materially enhanced by the circumstance, that each of the sub-holders may be acting at different places at the same time, and the nature and extent of their claim and use of the right or privilege may be difficult for him to ascertain, and leave him without any adequate remedy for any such excess or abuse of it. The language

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ought, in my judgment, to be exceedingly clear, that should lead a Court to construe an instrument of this sort, granting a single right or privilege to a particular person or his assigns, as also granting a right or license to split up the same right into fragments among many persons in severalty, and thus to make it apportionable as well as transmissible. The patentee might well agree to convey a single right as an entirety to one person to manufacture the matches and to employ a fixed number of persons under him, when he might be wholly opposed to apportioning the same right in severalty among many persons. I observe, that the parties are admitted, both by the evidence and at the bar, to have adopted, and to be willing to abide by, a construction of the grant to Brown, which I confess, I should hardly have arrived at by an examination of the words of the instrument. That construction is, that the grant to Brown was to manufacture as many matches as six girls could roll up in a day; and that as many other persons might be employed by him to prepare the work, as [* 546] might be necessary to accomplish this * end. (See Printed Record, p. 20, 64, 125.) But the employment of six girls by one or more persons holding the entire right, might be very different in the effect upon the value of other rights, grantable by the patentee, from what it would or might be, if there were six separate owners, each entitled to employ one girl, with all the proper auxiliaries.

There are many rights and privileges which are grantable, but which, at the same time, are not assignable. And the rules on this head, are founded, sometimes upon the consideration of the nature and objects of the grant, and sometimes upon a supposed personal confidence, and sometimes upon the apparent inconvenience of allowing an assignment. Some of the cases on this subject will be found collected in Com. Dig. Grant D., and Assignment, C. I. Even transmissible

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rights are not always severable or apportionable. Of this, several illustrations may be found in Coke on Litt., 164*b*, 165*a*, and Com. Dig. Parcener, A 2.

But, what is more immediately to our present purpose, there are many rights, which, although assignable as an entirety, are not apportionable or divisible by assignment. Thus, for example, it is said in Com. Dig. Grant D., that if A hold three acres by fealty and rent, and the lord grant the services of one of the acres, it is void; for he cannot make severance of the tenure. And the same doctrine is laid down, by Perkins, Grant, 67, and by Littleton, J., in the Year Book, 7 Edw. 4, 25. The like rule is laid down in Comyns's Dig. Grant, D., and in Perkins, Grant, 68, where three jointments hold, and the lord grants the services of one of them unto a stranger; for the grant is void for the like reason.

But the case of Lord Mountjoy, reported in Godbolt, R. 17, Moore, R. 174, and more fully upon the same points in Anderson, R. 307, approaches by a very near analogy to the present case. There, Lord Mountjoy granted by indenture a certain manor to one Browne in fee, and there was a proviso in the *indenture, and a covenant by [* 547] Browne, that Lord Mountjoy, his heirs, and assigns, might dig for ore in the lands, parcel of the manor, and dig for turf also, for the purpose of making alum. Lord Mountjoy demised his interest for a term of years to one L., and L. assigned over the same to two other persons; and among other questions, one was, whether Lord Mountjoy could assign over his right, and if the subsequent assignment to the two were good. Godbolt says, that it was decided by the judges, that the assignment to the two persons was good; but that the two assignees could not work severally, but together with one stock, or such workmen as belonged to them both. Lord Coke, who was counsel in the case of Lord Mountjoy, and who reported

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to the Privy Council, where the question arose, the opinion of the judges, confirms in Co. Litt. 165*a* the report of Godbolt, and says, that the judges, among other things, resolved, "That the Lord Mountjoy might assign his whole interest to one, two, or more; but then, if there be two or more, they could make no division of it, but work together with one stock; neither could the Lord Mountjoy, &c., assign his interest in any part of the waste to one or more, for that might work a prejudice and a surcharge to the tenant of the land." And, therefore, Lord Coke adds, if such an uncertain inheritance descendeth to two partners, it cannot be divided between them. It is true (as Mr. Butler, in his Note, Co. Litt. 165 *a*, note 1, has observed) that Lord Anderson's Report takes no notice of the point of indivisibility, nor is it contained in the certificate, there stated to have been given by the judges. But that is quite consistent with Lord Coke's account of the matter, which does not merely refer to the certificate, but to the reasoning of the judges; and the point of indivisibility was certainly fairly open before the judges, in considering the subject. Lord Coke, from his position in the case, could scarcely have been mistaken upon so important a point, which went to limit, and not to enlarge, the rights of his client.

[* 548] * Now, it seems to me, that, in this aspect, the case of Lord Mountjoy has a very striking application to the present case. The grant was of a mere right to dig ore, &c.; and yet upon the ground of possible or probable prejudice to the grantor (Browne) of this privilege, it was held to be indivisible.

A great many cases were cited at the argument by the learned counsel for the plaintiff, turning upon the general doctrine of apportionment, and the analogies furnished thereby to illustrate the present case. Some of those cases are exceedingly obscure; others turn altogether upon principles of

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the feudal law, applicable to rent service, and other kindred tenures, since the Statute of Quia Emptores;¹ others again are cases of very doubtful authority, such as *Ardes v. Watkins*, (Cro. Eliz. 637, 651,) where the Court were at first divided, and Popham, Chief Justice, dissented from the final opinion; and others, again, turn upon apportionments by operation of law, and independent of the acts of the parties. The general rule of the common law is, that contracts are not apportionable; and this rule seems ordinarily, although not universally, true, where the apportionment is by the act of the party, and not by mere operation of law; or where the contract is only in part performed, and is not in its own nature and terms severable.² The case of *Cutter v. Powell* (6 Term R. 320) is directly in point, although I entertain considerable doubt, whether, by the maritime law, the contract in that case was not divisible. In respect to rent, there are doubtless, many cases, where, at the common law, it is apportionable by operation of law, when it could not be by the act of the parties.³ And in some cases also it may be apportioned even by the act of the party entitled thereto, as is shown in the cases put in Bacon's *Abridgment, Rent, M.⁴ But the [* 549] grounds, upon which this is supported, are not always clearly stated or defined, or made consistent with each other. Thus, it is there said, that if I make a lease of three acres, reserving 3s. rent, as I may dispose of the whole reversion, so I may also of any part of it, since it is a thing in its own nature severable, and the rent, as incident to the reversion may be divided, too. This is intelligible enough; but

¹ See Viner's Apportionment, b. pl. 1; Bac. Abridg. Rent, M. 1.

² See 1 Story Eq. Jurisp. s. 471, s. 472, s. 476, s. 480, s. 481.

³ Co. Litt. 147b, 145a, 148b, 149b; Bacon Abridg. Rent, M.; Wotton v. Shirt, (Cro. Eliz. 742); Viner, Abridg. Apportionment, B.

⁴ See also Viner, Abridg. Apportionment, B.

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then it turns upon the very ground, that a reversion is severable; and the very question raised in the case now before the Court is, whether this license is so severable or divisible. It is upon the like reason that the case of *Ardes v. Watkins* (Cro. Eliz. 637, 681) is there attempted to be supported. In *Ewer v. Moyle*, (Cro. Eliz. 771,) the Court found great difficulty in allowing an apportionment of rent, where there had been a devise, and finally adjudged, "that there should be an apportionment, in regard it was not a division by the act of the party, but by the law, namely, the Statute of Wills;" which seems a strange reason for the case, as the devise was clearly the act of the party. In Bacon's Abridgment, (Rent M. 1,) it is said that the law allowed of grants of rent-charge, and thereby established such sort of property, and it would be unreasonable and severe to hinder the proprietor to make proper distribution for the promotion of his children, or to provide for the contingencies of his family, which were in his view. If this be a good reason, it would carry the doctrine of apportionment to a vast many other cases, which it has never been supposed to reach. The case in *Hobart's Rep.* 235, where it was adjudged that where one had a common appurtenant to ten acres of land for all his beasts, levant and couchant, on the land, and sold part of it, the common was apportionable, and every one should have common for his beasts, levant and couchant, upon his part, turned upon the [* 550] *ground that the right of common there was several in its nature, and is not so strict an entirety, as a warranty, a condition, &c., which cannot be divided by the act of the parties, which yet by act of law are divided. The same doctrine was applied in the case cited from *Danvers's Abridgment*, Apportionment, B. 4, and to be found also in *Viner's Abridgment*, Apportionment B. pl. 19, and reported as the case of *Morse v. Well*, in 1 *Brownlow*, R. 150, 2 *Brownlow*, R. 297, and in *Morse and Well's case*, in 13 *Co. R.* 65, upon the

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ground that the common was severable, and belonged to each portion of the land ratably.

I have dwelt somewhat upon these cases of apportionment because they were greatly relied upon at the bar in the argument. But I cannot say that they have any very forcible application to the present case, because they are either distinguishable from the present case in their circumstances, or stand upon grounds of reasoning, often obscure, and subtle, and unsatisfactory; or because, admitting their authority, they proceed upon the ground that, in general, apportionment is not allowed in contracts by the mere acts of the party, although it may be by act of law; and therefore they rather stand as exceptions, than as illustrations of a general principle, to be applied by analogy to other cases. The cases of rent-service are admitted by the authorities to stand upon a peculiar ground, resulting from the feudal law and feudal tenures, and are unquestionably exceptions to the general doctrine.

What I proceed upon is, that every conveyance of this sort must be decided upon its own terms and objects, and that it is very clear that no apportionment or division of the license or privilege can be made, if it is contrary to the true intent and meaning of the parties in the conveyance.

It is said that the present conveyance is the grant of an interest and right and property; and, therefore, it is divisible in its own nature. It is unnecessary to dispute about terms; * if I were called upon to characterize the present grant, I should rather call it an authority, or license, coupled with an interest in its execution. It seems to me not so much a property or interest *in rem*, as a right of user for the benefit of the licensee. It is like a right of way granted to a man for him and his domestic servants to pass over the grantor's lands.

Many cases have been put at the argument to sustain the views of the counsel for the plaintiff. But in my judgment,

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they are all distinguishable from the present case ; and perpetually admonish us of the truth of the maxim, *Nullum simile est idem*. Thus, it is said, that if I buy as many bricks from a kiln as two horses can haul in an ordinary wagon, or as one mason can lay on the wall of my house in a day, it is a valid sale of the quantity of bricks when ascertained. Certainly it is ; but then it is a valid sale of the bricks as property, not the sale of the mere privilege to manufacture bricks at my kiln. So, it is asked, if the owner of a brickyard sells to A the right of making as many bricks on any land, as six men can strike in a day, whether it may not make a valid sale to a third person of all that one man can strike ? Certainly he may ; but then he sells the ascertained quantity of bricks ; and not the right to make them. So, in the case at bar, Brown might well sell to any person or persons all or any undivided portion of the matches made by him under his license ; but that would be a very different thing from a sale of a fraction of the privilege to make them. The case of the sale of timber to be cut off lands in Maine, is of the same nature as those already stated. The subparties purchase the timber when cut, not the privilege of cutting it. But, suppose the owner grants to A the privilege of cutting timber off of his land, with the assistance of four men employed by him, can he sell the license and right of employment to each of four men in severalty for one man's share ? That would be very near the present case.

But can we, by any straining, declare that a license [* 552] to A to employ his four * servants on my land, is a license assignable to B to employ his four servants ? Or if assignable, would A have a right to assign the right to employ one servant to B, another to C, and another to D in severalty ? Now, that is the very hinge of the case at the bar. It was the very point in Lord Mountjoy's case, in Godbolt, R. 17. We all know that an authority granted to A cannot be assigned or executed by B. *A fortiori* it is not

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apportionable, so that a part may be executed by B, and a part by C, and a part by D, and the residue by A.

Upon the whole, I retain the opinion that the license in this case was an entirety, and incapable of division, or of being broken up into fragments in the possession of different persons. The right granted is to the grantee and six persons to be employed by him in making matches; and if it be assignable, the assignment must be of the entirety of the license to the assignee, and it cannot be apportioned among different persons in severalty.

It has been suggested, that, whatever may be the case at law, the plaintiff has an equitable right, which the Court ought to enforce. The short answer to this is, that the plaintiff has no equity, as against Byam and the other defendants, to do an act, for which he had no authority, or to exercise a right never assignable to him. If he has any equity, it is against Brown, and not against the defendants.

The bill, therefore, must be dismissed; but the question of costs will be reserved, if the parties desire it.

HIRAM A. PITTS v. LUTHER WHITMAN.

[2 Story, 609. October T. 1843.]

Where the plaintiff, in the specification of his patent, described his invention to be "a new and useful improvement," whereas, in fact, it consisted of a combination of several improvements, distinctly set forth in the specification; it was *held*, that the patent was good, not only for the combination, but for each distinct improvement, so far as it was his invention, and that the descriptive words were to be construed in connection with the specification.

Where the plaintiff claimed, as his invention, "the construction and use of an endless apron, divided into troughs and cells, in a machine for cleaning grain, operating substantially in the way described," it was *held*, that the

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claim was for a combination of the endless apron with the machine for cleaning grain, and that, if the combination were new, it was patentable, although a part of the apparatus were old.

The Act of 1836, ch. 357, s. 11, relating to the recording of assignments of patents, is merely directory, for the protection of *bonâ fide* purchasers without notice, and does not require the recording of an assignment within three months, as a prerequisite to its validity.

It is immaterial whether an assignment of a patent, offered in evidence, was recorded before or after the suit was brought.

The Court is never bound to give an instruction to a jury on a point of law, in the precise form and manner in which it is put by counsel, but only in such a manner as comports with the real merits and justice of the case.

A motion having been made in arrest of judgment in this case, on the ground, that no description of the patent was set forth in the declaration, it was *held*, that the profert of the letters-patent made them, when produced, a part of the declaration, and gave the invention all the requisite certainty.

THIS was a case for the infringement of a patent granted to Hiram A. Pitts and John A. Pitts, as inventors of "A new and useful improvement in the machine for threshing and cleaning grain." The patent was dated on the 29th of December, A. D. 1837. The writ was dated on 3d of October, 1840; and the plaintiff in his declaration alleged an assignment by John A. Pitts to himself of all his (John A. [* 610] Pitts's) right in the *invention, for, in, and within the State of Maine; and the breach alleged was, that the defendant, after the assignment, unlawfully made, used, and vended the said improvement in the said State of Maine. The cause was tried upon the general issue before the district judge, at the last May term; and a verdict was then taken for the plaintiff.

In order to understand the case, it is necessary to state, that the patent was for "A new and useful improvement in the machine for threshing and cleaning grain," and the specification annexed to the letters-patent was in the following terms:

"To all whom it may concern. Be it known, that we, John A. Pitts and Hiram A. Pitts, of Winthrop, in the county

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of Kennebec, and State of Maine, have invented a new and improved combination of machinery for separating grain from the straw and chaff, as it proceeds from the threshing machine; and we do hereby declare, that the following is a full and exact description thereof."

The specification then describes the invention, referring to an accompanying drawing. The claim was as follows:

"(1.) We claim as our invention the construction and use of an endless apron, divided into troughs or cells, in a machine for cleaning grain, operating substantially in the way described. (2.) We claim also the revolving rake for shaking out the straw, and the roller for throwing it off the machine, in combination with such a revolving apron, as set forth. (3.) We claim the guard slats E in combination with a belt constructed substantially as above described; and, (4.) the combination of the additional sieve and shoe with the elevator for carrying up the light grain in the manner and for the purpose herein set forth.

A motion was afterwards made, on behalf of the defendant in arrest of judgment, and, also, for a new trial, and was * argued at the present term, by *Preble* and [* 611] *Samuel Fessenden* for the defendant, and by *Codman* and *Fox* for the plaintiff.

The motion in arrest of judgment was substantially as follows:

"1. Because it is not alleged in said writ what is the new and useful improvements in the machine for threshing and cleaning grain, which the plaintiff claims to have invented, and which he alleges that the defendant has violated.

"2. Because the plaintiff has not, in his said writ and declaration, anywhere set forth what he does claim as his invention, or the extent of his claims.

"3. Because the plaintiff, in his said writ and declaration,

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has not set forth, or in any manner described the new and useful improvement in the machine for threshing and cleaning grain, which he claims as his invention."

The motion for a new trial was founded upon the following grounds stated by the defendant: "The plaintiff offered in evidence a deed from John A. Pitts to the plaintiff, dated April 17, 1839, and recorded in the Patent Office, April 19, 1841; to the admission of which the plaintiff objected, for the reason, that the said deed was not recorded within three months from its date, and because it was not recorded until long after the action was commenced. But the judge admitted it as evidence to the jury, and overruled the objection. For which erroneous ruling, the defendant moves, that the verdict be set aside and a new trial be granted.

"The counsel for the defendant contended, that by his claim the plaintiff claimed, that John A. Pitts and Hiram A. Pitts did claim to be the inventors of said endless apron, so as aforesaid constructed, *i. e.*, divided into troughs or cells, in a machine for cleaning grain, and operating substantially in the way described, and that if, in fact, they were not the inventors of an endless apron divided into troughs [* 612] or cells, but * were the inventors only of an application of such an apron to a machine for threshing and cleaning grain in the way described, then, that their claim was too broad, and, therefore, void. And they contended further, that if, in fact, they were not the inventors of an endless apron, divided into troughs or cells, then the application of it to a machine for threshing and cleaning grain substantially in the way described, was not the subject of a patent, as an application of an old machine to a new use or purpose was not patentable. And the judge was requested to give the construction contended for by the defendant's counsel, to the said claim; but the judge refused, and ruled, that the claim could not, and ought not to be so construed. That

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the true construction was, that the said Pittses did not claim to be the inventors of an endless apron, or an endless apron of troughs or cells, but that they claimed it only in a machine for threshing and cleaning grain, operating substantially in the way described; and that their claim was good and valid, as the inventors of its application to such a machine in the manner described. And for this ruling, which the defendant contends is erroneous, he moves the Court for a new trial.

“The counsel for the defendant further contended, if an endless belt of troughs or cells was known and used at the time of, and prior to the supposed invention of said Pitts & Pitts, then the mere application of an endless belt of troughs or cells to the new purpose of separating straw and grain, in a machine for threshing and cleaning grain, is not the subject of a patent, and any patent taken out for the use of such a belt for that purpose is void. The judge declined to give such instructions, for which cause the defendant moves for a new trial.

“The counsel for the defendant further contended, that, if the claim of the plaintiff to the construction and use of an *endless belt, with troughs or cells, embraces [* 613] any other different form substantially of construction, than the one by him particularly specified, the claim, in that case, would be too broad, and the action could not be sustained. This instruction the judge declined to give. For which cause, also, the plaintiff moves for a new trial.”

There was also an exception taken to another supposed ruling of the judge at the trial, which was afterwards abandoned, as it turned out to be incorrectly stated, and therefore it is here omitted.

Preble and *Fessenden*, for the defendant, in their argument, mainly relied upon the grounds stated in the foregoing motions. They cited, Patent Act of 1836, ch. 357, § 11;

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Wyeth v. Stone, 1 Story's R. 273, 295, 296; *Prouty v. Rugles*, 1 Story's R. 568; S. C. 16 Peters's R. 336.

Codman and *Fox*, for the plaintiff, argued as follows: To the objection, that plaintiff cannot maintain this action, because his deed from his co-patentee was not recorded within three months, and not till long after this suit was commenced, the answer is, that it is not necessary as between these parties. The defendant does not claim title by purchase, extent of execution, or otherwise; he resists the validity of the patent. It is enough, that it was recorded, before it was offered in evidence. The object of the requirement of the statute, that such a record should be made within three months was to protect subsequent purchasers, &c., and to give sufficient time for first purchasers to have their deed recorded.

The case of *Wyeth v. Stone*, (1 Story, R. 273,) cited by defendant, does not apply to this case. It was based upon the Statute of 1793, which, in terms and substance, is materially different from the Statute of 1836. See [* 614] *United States v. Slade*, 2 Mason, 71; *Prescott v. Potter*, 3 Pick. 391; *Welch v. Joy et al.* 13 Pick. 477; *Emerson v. Towle*, 5 Greenl. 197.

Under the general Registry Statute of Massachusetts and Maine, it has been repeatedly held, and is well-settled law, that notice or even possession is equivalent to registry. *Priest v. Rice*, 1 Pick. 165; and see *Brooks v. Byam et al.* 1 Story, 296.

As to the motion to set aside the verdict, we are unable to perceive any just ground of support for either branch of it; it is believed to be in strict conformity with both law and evidence. Moreover, there is no report of the evidence, and we believe that this Court cannot entertain the motion to set aside the verdict on the ground of its being against the evidence.

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STORY, J. There is no ground to support the motion in arrest of judgment, which indeed ought properly to be heard after the motion for a new trial, which, if granted, might supersede the other motion. The short answer to be given to the motion in arrest of judgment is, that the profert of the letters-patent (of which the specification constitutes a part) makes the letters-patent, when produced, a part of the declaration, and so gives all the certainty as to the invention and improvement patented, which is required by law. It would indeed be more formal to annex a copy of the letters-patent and specification to the declaration, and to refer thereto in the declaration. But the common practice is according to the declaration in the present case; and there seems to be no substantial objection to it.

The first objection, taken upon the motion for a new trial is, that the deed of assignment from John A. Pitts to the plaintiff, dated on the 17th of April, 1838, was not recorded in the Patent Office until the 19th of April, 1841, after the present suit was commenced; whereas it ought to have *been recorded within three months after the [* 615] execution thereof. By the Patent Act of 1793, ch. 55, § 4, every assignment, when recorded in the office of the Secretary of State, was good to pass the title of the inventor, both as to right and responsibility; but no time whatever was prescribed within which the assignment was required to be made. By the 11th section of the Act of 1836, ch. 357, it is provided, "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 an exclusive right under any patent to make and use, and to grant to others to make and use, the thing patented within and throughout any specified portion of the United States, shall be recorded in the Patent Office within three months from the execution thereof."

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Now, it is observable, that there are no words in this enactment, which declare, that the assignment, if not recorded, shall be utterly void; and the question, therefore, is, whether it is to be construed as indispensable to the validity of an assignment, that it should be recorded within the three months, as a *sine qua non*; or whether the statute is merely directory for the protection of purchasers. Upon the best reflection, which I have been able to bestow upon the subject, my opinion is, that the latter is the true interpretation and object of the provision. My reasons for this opinion are, the inconvenience, and difficulty, and mischiefs, which would arise upon any other construction. In the first place, it is difficult to say, why, as between the patentee and the assignee, the assignment ought not to be held good as a subsisting contract and conveyance, although it is never recorded by accident, or mistake, or design. Suppose the patentee has assigned his whole right to the assignee for a full and adequate consideration, and the assignment is not recorded within the three months, and the assignee should [* 616] make and use the patented machine * afterwards; could the patentee maintain a suit against the assignee for such making or use as a breach of the patent, as if he had never parted with his right? This would seem to be most inequitable and unjust; and yet if the assignment became a nullity and utterly void by the non-recording within the three months, it would seem to follow as a legitimate consequence, that such suit would be maintainable. So strong is the objection to such a conclusion, that the learned counsel for the defendant admitted at the argument, that as between the patentee and the assignee, the assignment would be good, notwithstanding the omission to record it. If so, then it would seem difficult to see, why the assignment ought not to be held equally valid against a mere wrongdoer, piratically invading the patent-right.

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Let us take another case. Could the patentee maintain a suit against a mere wrongdoer, after the assignment was made, and he had thereby parted with all his interest, if the assignment was not duly recorded? Certainly it must be conceded that he could not, if the assignment did not thereby become a mere nullity, but was valid as between himself and the assignee; for then there could accrue no damage to the patentee, and no infringement of his rights under the patent. Then, could the assignee, in such a case, maintain a suit for the infringement of his rights under the assignment? If he could not, then he would have rights without any remedy. Nay, as upon this supposition, neither the patentee nor the assignee could maintain any suit for an infringement of the patent, the patent-right itself would be utterly extinguished, in point of law, for all transferable purposes. Again, could the assignee, in such a case, maintain a suit for a subsequent infringement against the patentee? If he could, then the patentee would be in a worse predicament than a mere wrongdoer. If he could not, then the assignment would become, * in his hands, in a [* 617] practical sense worthless, as it would be open to depredations on all sides.

On the contrary, if we construe the 10th section of the act to be merely directory, full effect is given to the apparent object of the provision, the protection of purchasers. Why should an assignment be required to be recorded at all? Certainly not for the benefit of the parties, or their privies; but solely for the protection of purchasers, who should become such, *bonâ fide*, for a valuable consideration, without notice of any prior assignment. By requiring the recording to be within three months, the act, in effect, allows that full period for the benefit of the assignee, without any imputation or impeachment of his title for *laches* in the intermediate time. If he fails to record the assignment within the three months,

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then every subsequent *bond fide* purchaser has a right to presume that no assignment has been made within that period. If the assignment has not been recorded until after the three months, a prior purchaser ought, upon the ground of laches, to be preferred to the assignee. If he purchases after the assignment has been recorded, although not within the three months, the purchaser may justly be postponed, upon the ground of *malâ fides*, or constructive notice of the assignment. In this way, as it seems to me, the true object of the provision is obtained, and no injustice is done to any party. In respect to mere wrongdoers, who have no pretence of right or title, it is difficult to see, what ground of policy or principle there can be in giving them the benefit of the objection of the non-recording of the assignment. They violate the patent-right with their eyes open; and as they choose to act *in fraudem legis*, it ought to be no defence, that they meant to defraud or injure the patentee, and not the assignee. Indeed, if the defence were maintainable, it would seem to be wholly immaterial, whether they knew of the assignment or not.

In furtherance, then, of right, and justice, and [* 618] the apparent * policy of the act, *ut res magis valeat quam pereat*, and in the absence of all language importing, that the assignment, if unrecorded, shall be deemed void, I construe the provision as to recording to be merely directory, for the protection of *bond fide* purchasers without notice. And assuming that the recording within the three months is not a prerequisite to the validity of the assignment, it seems to me immaterial (even admitting, that a recording at some time is necessary), that it is not made until after the suit is brought. It is like the common case of a deed required by law to be registered, on which the plaintiff founds his title, where it is sufficient, if it be registered before the trial, although after the suit is brought; for it is still admissible in evidence as a deed duly registered.

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The next objection taken is to the ruling of the district judge upon the point of the construction of the claim in the specification in the patent. The learned Judge ruled "That the true construction of the patent was, that the Pittses did not claim to be the inventors of an endless apron, or an endless apron of troughs or cells. But the true construction must be, that they claimed it only in a machine for threshing and cleaning grain, operating substantially in the way described; and that their claim was good and valid as the inventors of its application to such a machine in the manner described." I am of opinion, that the construction thus given by the learned judge of the claim of the patentees in the specification is the true one. What is the language of the specification? "We claim as our invention the construction and use of an endless apron, divided into troughs or cells, in a machine for cleaning grain, operating substantially in the way described;" that is, described in the specification. It is, therefore, clear, that it was not a claim of an invention of an endless apron of troughs or cells; but of an endless apron of troughs and cells combined with a particular threshing machine, described in the specification. If this combination was * new, and invented by the patentees, [* 619] then it was valid in point of law, which is all that the learned judge purported to state. And this disposes in effect of the next objection; for if the combination was new, it is a patentable matter, although a part of the apparatus might have been applied to similar purposes in other and different machines. Under such circumstances it would not be a mere application of an old apparatus to a new purpose, but a new combination of machinery, incorporating, in part, an old apparatus for a new purpose.

The third instruction, asked, and refused by the Court, is objectionable in several respects. It proceeds upon the assumption of the existence of facts, which it was no part of

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the duty of the Court to assume or affirm. It undertakes to put a construction upon the invention, as claimed by the patentees, which is not (as has been already suggested) correct. It separates the consideration of the endless belt of troughs from the other machinery, with which it was combined, as though it were claimed as a distinct invention, and not in combination, and asks the Court to give an instruction founded upon that supposition. It was no part of the duty of the Court thus to break up the case into fragments, or to give an instruction as to abstract points, not actually presented by the state of the cause. The like answer may be given for similar reasons to the fourth instruction asked and refused.

The fifth instruction asked, and refused, involved matter of fact, namely, the character of Parsons's machine, and in what respects it was identical with, and in what respects it differed from, the machine of the Pittses, and that of Whitman; and therefore was properly refused; for the learned judge had no right to determine upon any such matters, or to give the instruction prayed for. The instruction upon this point supposed in the motion for a new trial to have been given by him, was in fact (as he states) never given. On the contrary,

he gave the instruction in the form and manner, [* 620] which are * stated by the counsel for the plaintiff in their written objection to the motion for a new trial. In short, he left the whole as a matter of fact for the consideration of the jury, with such observations on his own part, as were fit to be submitted by way of commentary on the evidence, for their consideration.

It may here be proper to add, that the Court is never bound to give an instruction to a jury upon a point of law, even when pertinent, and relevant to the fact of the case, precisely in the form and manner in which it is put by counsel; for that may sometimes have a tendency to mislead the jury, and withdraw their attention from the merits of the

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case. All that is the duty of the Court is, to give such instructions to the jury in point of law, as clearly arise upon the evidence, and are proper for the consideration of the jury, upon the issue before them, in such terms and in such manner as shall comport with the real merits and justice of the case, and enable the jury to give a proper verdict in point of law. Having done this, the Court has discharged its entire duty, and is not bound to respond to instructions asked, which are of a more general form, or of an abstract nature, or are not necessary for a just decision of the cause.

Before closing this opinion, it is fit to take notice of an objection, raised in the argument at the bar on behalf of the defendant, that the present patent is professedly for "a new and useful improvement," and not for new and useful improvements (in the plural); and that consequently it covers only the whole combination in its entirety; and not the several improvements specified in the claim, separately and distinctly from each other. The conclusion, intended to be deduced from this argument, is, that inasmuch as the evidence did not show a violation of the whole combination, but of one only of the asserted improvements, therefore, the present suit is not maintainable. I cannot assent either to the premises, or to the conclusion; and, in my judgment, each is unsupportable in *point of law. [* 621] There is, in my judgment, no difficulty in maintaining the validity of a patent (as in the present case) for a machine combining several distinct improvements, each of which is the invention of the patentee, and also of including in the same patent a right to each of these several and distinct improvements. In other words, the patentee may in such a case take out a valid patent for the combination, and also include therein a right to each distinct improvement severally contained in the same machine. Such was the doctrine maintained by this Court in *Wyeth v. Stone* (1 Story,

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R. 273); and it stands confirmed by the obvious intent of the 9th section of the Patent Act of 1837, ch. 45, which gives to the patentee a right of action for a piratical use of any one of his invented improvements, which is distinctly stated in his patent, although he may, by mistake, accident, or inadvertence, have claimed others in his specification, of which he was not the inventor.

In construing a patent for an invention we are not to look alone to the descriptive words contained in the letters-patent, but we are to construe those words in connection with the specification, which in our law is always annexed to and made a part of the letters-patent. Here, indeed, the letters-patent described the invention to be "a new and useful improvement (this is the common formulary) in the machine for threshing and cleaning grain;" but then it is afterwards added, "a description whereof is given in the words of the said John A. Pitts and Hiram A. Pitts, in the schedule hereto annexed, and is made part of these presents." So, that for the nature and character of the improvement and the claim of the invention we are to look to the specification. Now, in the specification, the patentees begin by saying, that they "have invented a new and improved combination of machinery for separating grain from the straw and chaff, as it proceeds from the threshing machine;" so that we here clearly [* 622] see, that the patentees *claim the entire combination of the machinery as new. In the summing up of their invention they claim four distinct improvements in the machinery, as their invention. The words are: "We claim as our invention, (1). The construction and use of an endless apron divided into troughs or cells in a machine for cleaning grain, operating substantially in the way described (i. e., in the specification). (2). We claim also the revolving rake for shaking out the straw, and the roller for throwing it off the machine, in combination with such a revolving apron

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as set forth. (3). We claim the guard slats, E, in combination with a belt constructed substantially as above described; and, (4). The combination of the additional sieve and shoe, with the elevator for carrying up the light grain in the manner and for the purpose herein set forth." It is plain, therefore, that the patentees not only claim the entire machinery in combination, but also for four improvements above enumerated as their invention. And if they are their invention, there is no objection, in point of law, to their claim. And a violation of any one of the specified improvements, without any violation of the others, by the defendant, is sufficient to entitle the patentees, or their assignees, to an action for the infringement.

So that in every way, in which I am able to contemplate the case, the motion for a new trial and in arrest of judgment ought to be overruled. The District Judge concurs in this opinion, and, therefore, the motion is overruled.

BOYD v. BROWN.

[3 McLean, 295. December T. 1843.]

The exclusive grant in a patent is, the construction and use of the thing patented.

Where the right consists in certain instruments by which a bedstead of a particular structure is made, the structure or use of these instruments is prohibited.

A patentee for a flouring mill of a certain structure has an exclusive right to make and use such mill, but he can claim no monopoly in the sale of the flour he manufactures.

The Court will not enjoin the sale of a similar article under the same patent in a particular district assigned to an individual, though manufactured in a different district.

Kenna appeared for the plaintiff.

Chase for the defendant.

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OPINION OF THE COURT.

THE complainant filed his bill, representing that he is the legal owner of a certain patent-right, within the county of Hamilton, Ohio, for making bedsteads of a particular construction, which is of great value to him; that the defendant, professing to have a right under the same patent, to make and vend bedsteads in Dearborn county, Indiana, which the complainant does not admit, but denies; that the defendant sends the bedsteads he manufactures to Hamilton county to sell in violation of the complainant's patent; and he prays [* 296] that the defendant may be enjoined * from manufacturing the article and vending it within Hamilton county, &c.

The defendant sets up in his answer a right duly assigned to him to make and vend the article in Indiana, and that he is also possessed of an improvement on the same; and he denies that the sales in Hamilton county, complained of by the complainant, are made at his instance, or for his benefit.

A motion is now made for an injunction, before the case is prepared for a final hearing.

On the part of the complainant, it is contended, that, by his purchase of the right to make and vend the article within Hamilton county, he has an exclusive right to vend as well as make, and that his right is infringed by the sales complained of; that his right is notorious, and is not only known to the defendant, but to all those who are engaged in the sales stated.

If the defendant, who manufactures the bedsteads in Indiana, be actually engaged in the sale of them in Hamilton county, it might be necessary to inquire whether this is a violation of the complainant's right. But, as this fact is denied in the defendant's answer, for the purposes of this motion, the answer must be taken as true, and that question is not necessarily involved.

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The point for consideration is, whether the right of the complainant is infringed by a sale of the article within the limits of the territory claimed by complainant.

It is not difficult to answer this question. We think that the article may be sold at any and every place, by any one who has purchased it for speculation or otherwise.

There can be no doubt that the original patentee, in selling rights for counties or States, might, by a special covenant, prohibit the assignee from vending the article beyond the limits of his own exclusive right. But, in such a case, the remedy would be on the contract, and not under * the Patent Law. For that law protects the thing [* 297] patented, and not the product. The exclusive right to make and use the instruments for the construction of this bedstead in Hamilton county, is what the law secures, under his assignment to the complainant. Any one violates this right who either makes, uses, or sells these instruments within the above limits. But the bedstead, which is the product, so soon as it is sold, mingles with the common mass of property, and is only subject to the general laws of property.

An individual has a patent-right for constructing and using a certain flouring mill. Now, his exclusive right consists in the construction and use of this mill; the same as the right of the complainant to construct and use the instruments in Hamilton county, by which the bedstead is made. But can the patentee of the mill prohibit others from selling flour in his district? Certainly he could not. The advantage derived from his right, is, or may be, the superior quality of the flour, and the facility with which it is manufactured. And this sufficiently illustrates the principle involved in this motion.

The injunction is refused.

Washburn et al. v. Gould. 3 Story.

WILLIAM WASHBURN, *et al.* v. JAMES GOULD.

[3 Story, 122. May T. 1844.]

The extension of a patent may be granted to an administrator.

Whoever finally perfects a machine, and renders it capable of useful operation, is entitled to a patent, although others may have had the idea, and made experiments towards putting it into practice, and although all of the component parts may have been known under a different combination, or used for a different purpose.

Drawings, not referred to in the specification of a patent, may be treated as part of the specification, and used to explain and enlarge it.

A new trial will not be granted for surprise on account of new evidence, whenever, by reasonable diligence, it could have been previously obtained.

The meaning of technical words of art in commerce and manufactures, used in a patent, as well as the surrounding circumstances, which may materially affect their meaning, are to be interpreted by the jury.

Every instrument is to be interpreted by a consideration of *all* its provisions, and its obvious design is not to be controlled by the precise force of single words.

Where a grant was made of a right to construct and use fifty machines within certain localities, reserving to the grantor the right to construct, and to license others to construct, but not to use them therein, it was *held*, that the grant was of an exclusive right under the Statute of 1836 in regard to patents, and that suits were to be brought in the name of the assignees, even though agreed to be at the expense of the grantor.

Where a patent has been granted, and there has been an exclusive possession of some duration under a patent, an injunction will be granted, without obliging the patentee previously to establish the validity of his patent by an action at law. But it is otherwise, if the patent be recent, and the injunction be resisted on the ground, that the patent ought not to have been granted, or is imperfectly stated in the specification.

Held, That the patent in the present case was, upon the true interpretation of the specification, a patent for an improved machine:

THIS was an action on the case for the infringement of a patent-right for "a new and useful improvement in the method of planing, tonguing, grooving, and cutting into mouldings, or either, plank, boards, or any other material, and

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for reducing the same to an equal width and thickness ; and also for facing and dressing brick, and cutting mouldings, or facing metallic, mineral, or other substances," and described in the schedule annexed to the letters-patent, and forming a part thereof, in the following words :

* "The plank, boards, or other material, being [* 123] reduced to a width by circular saws, or friction wheels, as the case may be, is then placed on a carriage resting on a platform, with a rotary cutting wheel in the centre, either horizontal or vertical. The heads, or circular plates, fixed to an axis, may have one of the heads movable to accommodate any length of knife required. The knives fitted to the heads with screws or bolts, or the knives or cutters for moulding, fitted by screws or bolts to logs connecting the heads of the cylinder, and forming, with the edges of the knives or cutters, a cylinder. The knives may be placed in a line with the axis of the cylinder or diagonally. The plank, or other material resting on the carriage, may be set so as to reduce it to any thickness required, and the carriage moving by a rack and pinion, or rollers, or any lateral motion, to the edge of the knives or cutters on the periphery of the cylinder or wheels, reduces it to any given thickness. After passing the planing and reducing wheel, it then approaches, if required, two revolving cutter wheels, one for cutting the groove, and the other for cutting the rabbets, that form the tongue. One wheel is placed directly over the other, and the lateral motion moving the plank, or other material, between the grooving and rabbeting wheels, so that one edge has a groove cut the whole length, and the other edge a rabbet cut on each side, leaving a tongue to match the groove. The grooving wheel is a circular plate, fixed on an axis, with a number of cutters attached to it to project beyond the periphery of the plate, so that, when put in motion, it will perform a deep cut or groove, parallel with the face of the plank or other material.

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The rabbeting wheel also of similar form, having a number of cutters on each side of the plate, projecting, like those on the grooving wheel, cuts the rabbet on each side of the edge of the plank, and leaves the tongue or match for the groove. By placing the planing wheel axis and cutter knives vertical, the same wheel will plane two planks, or other material in the same time of one, by moving the plank or other material opposite ways, and parallel with each other, against the periphery of the planing or moulding wheel. The groove and tongue may be cut in the plank or other material, at the same time, by adding a grooving and rabbeting wheel.

“Said William Woodworth does not claim the invention of circular saws or cutter wheels, knowing they have long been in use, but he claims as his invention the improvement and application of cutting or planing wheels to planing boards, plank, timber, or other material; also his improved method of cutters for grooving, and tonguing, and cutting mouldings on wood, stone, iron, metal, or other material, and also for facing and dressing brick, as all the wheels may be used single, and separately, for moulding, or any other purpose before indicated. He also claims as his improved method the application of circular saws for reducing floor plank and other materials to a width.

“Dated Troy, Dec. 4th, 1828.

“WILLIAM WOODWORTH.

“Witnesses, HENRY EVERTS,
D. S. GLEASON.”

The original patentee was William Woodworth, to whom the aforesaid letters-patent were granted on the 27th day of December, 1828, and who died on the 9th day of February, 1839. On the 14th day of February, 1839, administration of the goods and estate of the said William Woodworth was

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granted in the State of New York, to his son, William W. Woodworth, who subsequently, on the 16th day of November, 1842, obtained a renewal and extension of the said letters-patent for the additional term of seven years from the expiration thereof. On the 2d day of January, 1843, the said administrator disclaimed so much of the claim in the said letters-patent as embraced the application of circular saws to reduce floor plank and other materials to a width; and *afterwards, on the 2d day of January, 1843, [*125] he granted to William Washburn and Charles W.

Brown, the present plaintiffs, certain rights to use the said patent, by the following deed, which was duly recorded in the Patent Office:

“This indenture of three parts, made and concluded on the second day of January, in the year eighteen hundred and forty-three, by and between William W. Woodworth, of the town of Hyde Park, of the county of Dutchess, and State of New York, Esq., as he is administrator of the goods and estate, which were of William Woodworth, hereinafter mentioned, deceased, of the first part, William Washburn, and Charles W. Brown, both of Boston, in the county of Suffolk, and State of Massachusetts, carpenters, of the second part, and James G. Wilson, of the city, county, and State of New York, gentleman, of the third part, witnesseth:

“That whereas letters-patent bearing date on the twenty-seventh day of December, in the year eighteen hundred and twenty-eight, were granted to William Woodworth, now deceased, by the United States of America, for an improvement in the method of tonguing, grooving, and cutting into mouldings, or either, plank, boards, and other materials, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings on, or facing metallic, mineral, or other substances.

“And whereas the term for which the said letters-patent

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were granted, did expire by the limitation contained therein, on the twenty-seventh day of December now last past, and before the expiration of the said term, such proceedings were had, that, pursuant to act of Congress in such case made and provided, the said letters-patent were renewed and extended for the further period of seven years from and after the expiration of the said first term, the certificate of renewal whereof bearing date on the sixteenth day of November, being granted unto the party of the first part, one of the heirs, and the administrator of the said William Woodworth, de-
[* 126] ceased; * and whereas the parties of the second part have paid to the party of the first part the sum of five hundred dollars, and have given to the party of the first part their negotiable promissory notes, bearing even date with these presents, one for the sum of one thousand dollars, payable in ninety days from the date thereof; one for the same sum, payable in six months from the date thereof; one for the same sum, and payable in twelve months from the date thereof; one for the same sum, and payable in eighteen months from the date thereof; one for the same sum, and payable in two years from the date thereof; one for the same sum, and payable in thirty months from the date thereof; and the last for the sum of five hundred dollars, payable in three years from the date thereof, and all the said seven promissory notes bearing interest from their date.

“And whereas, in consideration of the said money and notes, the party of the first part hath agreed to license and empower the parties of the second part to construct and use, and to license others to construct and use fifty of the said patented machines, within the counties of Suffolk and Norfolk, and in the towns of Charlestown, Cambridge, West Cambridge, Watertown, Medford, and Malden and Rockbottom village, in the county of Middlesex, in the State of Massachusetts — in such manner, nevertheless, that the license and authority

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so granted shall stand and be as security unto the party of the first part, and his assigns, for the payment of each and all of the said promissory notes.

“Now, the said parties have covenanted, granted, and agreed in manner following.

First. The party of the first part does hereby license and empower the parties of the second part, and their executors and administrators, to construct and use fifty of the said patented machines within the territory aforesaid; and also within the same territory to license and empower other person or persons to construct and use one or more of the said patented *machines, during the whole period [* 127] for which the said letters-patent have been granted; but the whole number of machines by the parties of the second part, and by all persons empowered by them, constructed and used during the said period in the said territory, shall not, at any one time, exceed the said number of fifty machines.

“And provided also, that if at any time or times the parties of the second part, or their representatives, shall make any default in the payment of the said promissory notes or either of them, it shall be lawful for the party of the first part, or his assigns, at any time while such neglect or default shall continue, to give notice in writing to the parties of the second part or their assigns, and to any person or persons, licensed and empowered by them to use the said machine, to cease and discontinue the use thereof; and if they or either of them shall fail so to do for the space of ten days after such notice, the parties of the second part hereby covenant with the party of the first part, and his assigns, that it shall be lawful for any court of equity, having jurisdiction of the premises, to enjoin the parties of the second part and their assigns, and all persons empowered by them as aforesaid, from using the said machines, until the further order of the Court; and if such neglect or default should continue for the space of thirty

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days after such notice, it shall and may be lawful for the party of the first part, or his assigns, to sell at public auction, in the city of Boston, after advertising the same six times in some newspaper printed in the said city, all the right, title, and interest which, by these presents, are in any way granted unto the said parties of the second part; and the party of the first part, or his assigns, may bid at such sale, and in the names of the parties of the second part, or their assigns, as the case may require, may convey and assure the same to the purchaser, and thereupon all license, power, and authority of the parties of the second part and their assigns, and of all persons empowered by them shall cease, and thereupon it shall and may be lawful for any court of equity.

[* 128] *having jurisdiction of the premises, perpetually to enjoin the parties of the second part and their assigns, and all persons empowered by them, from constructing or using any of the said patented machines. And the proceeds of such auction sale, after deducting all necessary expenses, shall be applied to the payment of all such of the said promissory notes as then remain unpaid, without prejudice to any remedy, which the party of the first part or his assigns may have for any balance, which may remain due to him; but if the said proceeds should be more than sufficient to pay the amounts remaining due on the said notes, such excess is to be paid to the parties of the second part, or their representatives or assigns.

Second. The parties of the first part and third part covenant with the parties of the second part, that they will institute suits at law, and in equity, against any and all person or persons who shall infringe upon the patent aforesaid, within the territory aforesaid, during the period of two years from the date hereof, upon receiving notice of such infringement from the parties of the second part, that they will prosecute the said suits at their own expense to final judgment with due diligence, and that, after deducting all the expenses of such

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suits, and a reasonable compensation for their own expenses, time, and pains in prosecuting them, they will pay over the damages recovered therein unto the parties of the second part, or their representatives or assigns.

Third. If it should be finally decided in either of the suits, commenced as aforesaid, within the said period of two years, by the highest court, to which the said parties of the first and third part, or the defendants in such suit shall carry such suit by writ of error or appeal, that the said extended and renewed letters-patent are void, the parties of the second part shall be thereby released and discharged of and from the payment of all such of the said promissory notes as shall then remain unpaid; and if either of the said notes shall then be paid, the said party of the first part, and the said party of the * third part, each of them, severally, and *not jointly*, [* 129] covenants with the parties of the second part, that each of them will repay to the parties of the second part, one half of whatever sum shall have been so paid on the said notes, with interest from the several times of payment, deducting, however, a reasonable compensation for any benefits, profits, or advantages, which shall then have been received by the parties of the second part, under or by virtue of the license hereby granted.

Fourth. The parties of the second part covenant with the parties of the first and third parts that they will at all times, during the said term of two years, suffer and permit the parties of the first and third parts to use their names in all such suits as may be commenced as aforesaid, and that they will aid and assist the parties of the first and third parts in procuring the necessary evidence to sustain such suits when commenced.

Fifth. The party of the first part covenants with the party of the second part, that he will not license and empower any person or persons to use any of the aforesaid machines within

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the territory before named, during the said term of seven years, for which the said letters-patent have been extended; but nothing herein contained shall be so construed as to prevent the party of the first part from constructing or licensing the construction of the said machine to be used elsewhere than in the territory aforesaid.

In testimony whereof, the said parties have set their hands and seals, on the day and year first above written, to this and to two other instruments of like tenor and date.

W. W. WOODWORTH,
W. WASHBURN,
CHARLES W. BROWN,
JAMES G. WILSON.

Sealed and delivered in presence of
HORACE PHILBROOK.

[* 130] * The plea was the general issue, and a notice of special defence was filed.

The present action is brought by the plaintiffs for an alleged violation of their right under the said deed by the defendant, and the damages were laid at \$2,500.

Franklin Dexter and B. R. Curtis, for the plaintiffs.

C. G. Loring, Joel Giles, and W. Dehon, for the defendants.

At the trial the following points were made by the counsel for the defendants.

1st. That the plaintiffs could not bring the present action, they being merely limited licensees, and not exclusive owners of a right in the patent. That under the existing Patent Law, the plaintiffs must be either grantees of an undivided

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interest in the patent, or grantees or owners of the exclusive right in the patent within a given territory. That the term "exclusive," signified the "whole" interest, which the patent conferred, and that the patentee, having reserved to himself, by a clause in the contract with the plaintiffs, the right to construct and to license others to construct these machines within the territory for which the right was granted to the plaintiffs, the plaintiffs could in no sense be considered as possessing the exclusive right.

To this it was answered, in behalf of the plaintiffs, that the person actually interested in the patent-right, was authorized by the law to bring an action for a violation thereof; and that although the said clause in the contract was, taken separately, ambiguous, yet that the whole covenant, and especially that portion, providing that the parties of the first and third parts might use the name of the party of the second part, plainly indicated, that the grant was of an exclusive right; * and that, if the plaintiffs could not bring the ac- [* 131] tion, no one could, for they were the only parties having an exclusive right and interest.

STORY, J., said, — The language of the Patent Act, of 1836, § 11, refers to the grant of an exclusive right in a patent, and the term *exclusive* comprehends not only an exclusive right to the whole patent, but an exclusive right to the patent in a particular section of country. The action for the violation of an exclusive right is confined to the owner of such a right. But the right granted to the plaintiffs in this case is exclusive, for the limitation of the number of the machines does not destroy the character of that right. That the exclusive right in certain territories does exist in the assignees, is clearly indicated by the fourth clause in the indenture, and the grant of such a right is not inconsistent with the reservation, that the grantor might construct machines there, because he might do

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that by way of a license reserved to him under his assignees. The present judgment of the Court is, that the grant to the assignees is of an exclusive right, and suits are to be brought in the name of the assignees, but at the expense of the grantor.

The second point raised by the defendants' counsel, was that, under the Patent Laws, nobody but the patentee was entitled to an extension or renewal of the patent, and that in this case, the patentee having died previous to such an extension, no one else was authorized to procure it. That such a right was nowhere given by the statute to the legal representative of a patentee, but solely and exclusively to the patentee himself, and that it was manifest, from all previous and subsequent legislation in the United States, that the absence of any such provision was not an accidental omission, but the result of design. That the right of renewal was intended as a personal privilege of the patentee alone.

[* 132] * To this point, it was answered by the counsel for the plaintiffs, that no new patent was issued, and no new right granted, but that there was a mere extension of an existing right for an increased length of time. That the design and policy of the act were to reward the inventor by securing to him, his family and representatives, the benefit of the invention, and consequently the grant was to him, his heirs, administrators, or assigns; and that this policy was inconsistent with the idea, that the benefit of his invention was to be strictly limited to the inventor. That there was nothing in the Statute of 1832 to show, that an assignee was not entitled to a renewal; and that the counsel for the defendant had confounded the term "patentee" with that of "inventor," and assumed what the law did not, that one must necessarily be the other. But that, in point of fact, the term "patentee" applied to any person having a right under the

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patent, whether as executor, administrator, or assignee. That the right of the original grantee to make a contract for the renewed right, clearly established his power to make a valid assignment of all his rights and privileges in the patent; for it was not possible, that Congress could have designed, that the death of the patentee should operate to put an end to that right, when vested in his grantee. That the application for the patent must, indeed, be in the name of the patentee, and that the holder of the legal interest must apply for it, and then that it would enure to the holder of the beneficial interest. That such was the practice of the board of commissioners for patents, and that such had been decided to be the law by Judge Thompson, in the case of *Van Hook v. Scudder*, which was subsequently reaffirmed by him. That an injunction had been granted by Judge McKinley on the same ground; and that the same doctrine had been affirmed by Judge McLean in the case of *Brooks v. Bicknell et al.* (*Walker's Western Law Journal*, January, 1844.)

*STORY, J., said, — The rule of comity always [* 133] observed by the Justices of the Supreme Court in cases which admitted of being carried before the whole Court, was to conform to the opinions of each other, if any had been given. Such decisions amounted to authority, which, though not conclusive, were operative, whenever the question should be carried up; and therefore, although his mind was not without much difficulty on this point, he should rule for the plaintiffs, in conformity with the opinion of Mr. Justice McLean.

3d. Another point made by the defendants was, that as the drawings of Woodworth's machine were not referred to in the specification, they could not be used to explain, aid, or enlarge it. This point was elaborately argued on both sides.

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and was ruled by the Court in favor of the plaintiffs, in accordance with the decision of Mr. Justice McLean, in *Brooks v. Bicknell*.

4th. Another point contended for by the defendants was, that all parts of Woodworth's machine were previously known, and could be found described in Bentham's specification.

STORY, J., said, — The law is, that whoever first perfects a machine, is entitled to the patent, and is the real inventor, although others may previously have had the idea, and made some experiments towards putting it in practice. In England, the law goes even so far as to grant such an one the patent, although the antecedent experiments of others were known to and used by him in perfecting his machine. The law in this country has not gone quite so far, but I do not mean to say, that there would be any difficulty in going to that extent. At any rate, he is the inventor, and is entitled to the patent, who first brought the machine to perfection, and made it capable of useful operation.

[* 134] * Various other points were made by the defendants, which, together with the ruling of the Court, are sufficiently stated in the charge and in the opinion on the motion for a new trial. Much evidence was introduced by the defendants, to prove the vagueness and insufficiency of Woodworth's specification; and also to prove, that every thing claimed by Woodworth was to be found in the specification of the patent granted to Samuel Bentham, in England, April 23d, 1793, and printed in the *Repertory of Arts and Manufacture*, Vol. X. published in London, A. D. 1799; also in the specification of the patent granted to Bramah in England, A. D. 1802, and published in *Rees's Encyclopedia*, Vol. XXVIII.; also in the specification of the patent granted to Malcom Muir, of the city of Glasgow in Scotland, dated

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June 1, A. D. 1827, an abstract of which was published in the London Journal of Arts, second series, Vol. II. p. 68, and a notice whereof was published in the United States, in the Franklin Journal, Vol. I. for A. D. 1828; also in the specification of the patent granted in the United States, to James Collins of Anson, in the State of Maine, A. D. 1827, for shearing cloth by revolving shears. In rebutter of which, much evidence was also introduced on behalf of the plaintiffs.

In the course of the trial, the following question was suggested by the counsel for the defendants: Whether a license purchased under the original patent, would cease on the expiration of the patent, or continue in force during the subsequent extension.

STORY, J. I have an impression, but it is not a very distinct one, that some question of an analogous nature arose under the act of Congress for the renewal of the patent of Oliver Evans, (Act 22d Jan. 1808, chap. 117,) which was, of course, governed by the old Acts of 1798 and 1800; and that it was then held, that any future use of the patented machine of Evans, after the renewal, except so far as it was * saved by the proviso of that act, would [* 135] be an infringement of his patent. Whether that applied to cases of licenses, I do not exactly remember.¹ But I have had occasion recently to decide the very point, in a case in Maine, in respect to a license. And I there held, upon full consideration, that every license, or assignment, under the old laws, before the Act of 1836, expired with the limitation of the original patent, unless it was expressly in terms so granted as to be applicable to any renewal of the patent afterwards. The decision of the Court proceeded upon the

¹ The case referred to, probably, was *Evans v. Jordan*, 9 Cranch, R. 199. See Vol. I. page 57.

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ground, that under the old laws, before the Act of 1836, the licensee's, or assignee's right, was necessarily bounded by the same limits as that of the licensor, or patentee, — that is to say, to the original term granted by the patent to the licensor or patentee. If, afterwards, the patent was renewed, it was a new grant independent of the old, and the patentee was entitled to the sole and exclusive benefit thereof, unless the licensees or assignees under them had, by their original contract, secured to themselves by express covenant or grant, a right to the benefit of the renewed patent.

STORY, J., afterwards charged the jury as follows :

This is a case, gentlemen of the jury, which, as you are well aware, has taken up a vast deal of time and attention. And, indeed, I may truly say, that it has been the most protracted civil cause ever tried in this Court.

Undoubtedly this planing machine is an invention of great utility, and the patent-right, therefore, is the more likely to be contested ; and it often happens, that in this class of actions, many points are made in the opening and perhaps much dwelt upon in the trial, which ultimately prove of small importance, and are abandoned or waived in the sequel.

You have seen this in the present case. I do not [* 136] feel called * upon to go into any minute discussion of the points raised here, for after the full and elaborate arguments of the counsel, I could not aid your judgments by going over the whole ground ; and shall only present to you a general view of the mass of the evidence, as it has been given.

But before doing this, I shall take notice of what has been entirely omitted on each side. Not a word has been said as to the amount of damages, in case the verdict should be in favor of the plaintiffs. And this has been omitted, on the long-settled and very proper ground, that whenever a patent-

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right is contested here for the first time—fully and fairly contested—it is only for the sake of determining whether the patent be valid or not. If its validity be sustained, then the patentee can obtain from the equity side of the Court, an injunction to restrain a party from using the invention to the injury of the owner. Still, it is your duty, if you find for the plaintiff, to give him such reasonable damages—not vindictive—but such as are not covered by any of the costs he will recover, to indemnify him for the necessary and unavoidable expenses of establishing his right. Observe, you are not always bound to do this; for I can conceive of cases, where only nominal damages should be rendered; as where a patentee fraudulently leads a party to infringe on his right, and then brings an action against him merely to gratify his own malice or revenge. But you should suffer no valid patent to go out of court without indemnifying the owner for his reasonable and necessary charges in establishing his true right; in other words, he should not be sent away worse than he came into court. Therefore, if you find for the plaintiffs, you will award such damages as you think them fairly and reasonably entitled to, under all the circumstances.

A considerable number of questions of law have been raised by the defendant, and reduced to writing, most of which have been disposed of, but which I will recapitulate before coming to the matters of fact.

* These questions are stated as follows: [* 137]

1st. That the grant of an extension of patent to an administrator, is not within the Statute of 1836.

This point is overruled.

2d. That plaintiffs have not such title to any exclusive right as enables them to maintain this action under the indenture in their declaration mentioned.

Overruled.

3d. That the patent was void at the time when, and from

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which, the contract between the plaintiffs and the administrator, and Wilson, took effect; because it purports to grant a right under the patent, as including the circular saw, which is disclaimed, and admitted not to be valid; and at the time of the date of said contract, the disclaimer of the circular saw had not been filed or recorded.

Overruled.

4th. That the contract between the patentee and Strong, on one part, and Emmons and Toogood and others, of the other part, avoids both patents, being a mutual admission, that neither patent was good, because purporting, that each was of equal validity, whereas both could not be good; and because such contract operates as a fraud upon the public.

Overruled as an admission in point of law. And I hold that the occasion of the contract may be established by other evidence, and the reasons why it was entered into; and if the jury believes the evidence on this point in the case, the contract was a compromise on both sides, without any admission, of, or intent to admit, on either side, the invalidity of the patent.

5th. That the surrender of the patent by the administrator defeated the title of plaintiffs.

Overruled.

6th. That the patent is imperfect and void, for the want of suitable drawings and references, and that if the [* 138] drawings * may be referred to, they should be as composing part of the description, and not part of the claim.

Overruled. The drawings are to be treated as part of the written specification, and may be referred to, to show the nature, and character, and extent of the claim, as well as to compose a part of the description.

7th. That the patent is void, for uncertainty and ambiguity in the description; and also for uncertainty and ambiguity in the claim.

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Answer. Whether the patent is void for uncertainty and ambiguity in the description, is a matter of fact to be decided upon the evidence of experts. The patent is not void for uncertainty and ambiguity in the claim, for the written specification of the claim may be, and is, aided by reference to the drawings. Upon examining the written specification, in connection with the drawings, the claim, so far as it is a matter of law, must be deemed to be a claim for an improved machine, as described in the written specification and drawings.

8th. That the patent is void for multiplicity of claim.

Overruled.

9th. That the patent is void for falsity of claim.

Answer. This is not a mere matter of law, but involves matters of fact.

10th. That the disclaimer of the circular saw was not made within a reasonable time.

Answer. This is not a mere matter of law in this case, but is to be judged of with reference to all the circumstances in evidence.

11th. That the claim stated by the counsel as that relied on in this trial, "as one for the whole machine or apparatus as an improved machine, capable of three distinct operations, or of producing three results, to wit: planing, tonguing and grooving at the same time in the manner described; and also of performing each of those operations, or producing each of those results separately, in the manner described," is not set * forth in the specification; or, in other [* 139] words, that the claim therein stated is not reasonably susceptible of this construction.

Overruled, as a matter of law. The drawings are to be deemed a part of the specification, and taking the whole together, the patent is for an improved machine, and, as such, is not open to the objection stated.

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12th. That the drawings cannot be referred to for the purpose of adding any thing to the specification or claim not specifically contained or mentioned therein; so that if top pressure rollers be not described in the specification, recourse cannot be had to the drawings to supply or describe them, as making part of the specification or claim.

Overruled. The drawings are to be deemed a part of the specification, and may be referred to for the purpose suggested in the objection.

13th. That the specification and drawings do not contain any description or claim of top pressure rollers with such reasonable certainty and precision, as the law requires, to constitute a valid claim therefor, as a part of the machine described, either separately or in combination with the cutting wheel.

.Answer. This is not a matter of law, but involves a matter of fact, as to the certainty and sufficiency of the description, in the particulars mentioned.

14. That the patent cannot be maintained for a mere combination or connection of the top pressure rollers with the rotary cutting wheel, because the claim set forth in the specification, and as made by counsel, described and embraced an organized machine, designed to be used in many cases without them, and where they cannot be applied.

Answer. This is not a mere matter of law, but involves matter of fact. The patent is not understood by the Court to be for a mere combination or connection of the top pressure rollers with the rotary wheel, considered alone [* 140] *per sese*, but * in combination with the other parts of the machine; and whether the top pressure rollers can be applied, or not, for all the uses described in the specification and drawings, is a matter of fact for the consideration of the jury.

15th. That if top pressure rollers for the purpose of con-

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fining the plank to the carriage, are embraced in the patent, nevertheless the defendant has not infringed, because he uses rollers, only for the purpose of feeding, and not for the purpose of confining the material to the carriage, as he uses no carriage; and the incidental effect of their serving as pressure rollers, if they do so, is no infringement of their patent, because the specification admits of feeding rollers as one means of lateral motion not claimed as an invention.

Answer. This is a question of fact for the consideration of the jury.

16th. If plaintiffs have a valid patent for the organized machine described therein, the defendant has not infringed upon it; because the machine used by defendant is substantially different from that patented, the machine patented having as a part of its specified organization, a carriage, which is essential to many of the operations, which it is described as designed to perform, and several of which it cannot perform with the use of feeding rollers, and to which carriage alone the moving power is directed to be applied, and which carriage is described and pointed out as the only means of adjusting the material or machine for producing the various thicknesses that may be required; whereas the machine of defendant has no carriage, but applies the moving power always directly to the material, and no carriage can ever be useful for the purpose for which it is constructed and used, and the adjustment for producing various thicknesses is regulated by means of boxes and apparatus applied to the cutting wheel for the purpose of raising or depressing it, as occasion may require.

Answer. This, likewise, is a question of fact.

* 17th. Plaintiffs' claim is for a combination of [* 141] machines, or mechanical means, all old, and none applied to a new use, and is not for an organized machine embracing any new part or parts put to new uses, and is,

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therefore, for a combination merely, and unless we infringe the whole, we do not violate the patent.

Answer. This is not a mere matter of law. The Court cannot judicially know, whether the machine patented is composed of parts, none of which are substantially new in their application.

18th. That the patent in this case, according to the specification and claim as therein contained and stated by the counsel, is not for any particular form or construction of a rotating cutting wheel, nor for any particular form of platform, nor for any particular form of carriage, nor for any particular mode of effecting the lateral motion of the carriage to the cutting wheel; and therefore, that if any machine described in Bentham's patent, or either of those testified to by Blanchard, was composed of a platform or bench with a sliding bed or carriage to which the material was attached, and which carriage was moved by any lateral motion to and along the cutting wheel, in such manner as that the surface of the material was cut, or planed, or reduced by the cutter wheel, and such machines were, in these respects, suitable for that purpose, then the defendant has not infringed the patent of the plaintiffs in these particulars or either of them.

Answer. This is also not a mere matter of law, but involves facts and skill and knowledge in mechanics. The jury must decide on the facts.

Having thus disposed of the questions of law, we come to those of fact relied upon by defendant, which naturally arrange themselves in four classes. The defendant alleges:

1st. That Woodworth's specification is too vague to enable a competent mechanic to construct a machine from it.

2d. That the invention was not new on the part [* 142] of Woodworth,* but previously known both to Bentham and Blanchard, the former having described it in his specification, and the latter having actually carried it into effect.

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3d. That Gould's machine is substantially different from Woodworth's; and, as auxiliary to this,

4th. That Woodworth did not contemplate feeding rollers as a mode of operating his machine.

Now, gentlemen, it is for you to say, whether the invention belonged to Woodworth, or whether the planing machine was known and used prior to the issue of his patent. If you think the latter, you need go no further, but find for the defendant at once. But as to this point, the burden of proof rests upon the defendant. He must satisfy you beyond a reasonable doubt, that there was a prior invention to Woodworth's, because the plaintiff has a right to rest upon his patent for his invention, till its validity is overthrown. And consequently, if it should so happen, that your minds are led to a reasonable doubt on the question, inasmuch as it is incumbent on the defendant to satisfy you beyond that doubt, you will find for the plaintiff so far as this point is concerned.

In relation to this alleged priority of invention, there are but two modes in which it is attempted to be made out; namely, by Bentham's description, and by Blanchard's machine. Blanchard refers us to 1822-23, and gives a description of a machine, which he then constructed and used to plane blocks and gunstocks. He used a roller, to which knives were attached, but he did not use it long.

In answer to a direct question put by the Court, he said his machine was not like the one in evidence, and, as I understood, did not pretend, that he ever made a machine, which operated substantially by the same means as Woodworth's. He considered the movements of all these machines the same, but the means of operation different. But if the means are substantially different in any supposed cases, then there is or may be invention. The spinning machinery now so universal * is an example of this; [* 143] and the complicated means now used to produce

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the same result, formerly obtained by hand labor, and with infinitely more rapidity and regularity, no one will deny to be a great invention. Blanchard's machine was burnt, and we have nothing now before us, but his recollection of what it was; and it is for you to say, whether he has satisfied you, that it was substantially the same invention as Woodworth's.

It is probable, however, that you will find it necessary to go further, and look into Bentham's description, which has been so copiously commented on in this case. For one, I do not comprehend a tithe of what may be found there; but the question is for your judgments, aided by the testimony of the experts, whether Woodworth's planing machine is contained in that description. Now, you have found, that the experts are not agreed, and, indeed, in the course of thirty years' experience, I have never, I think, known them to agree in opinion, as to whether any machine was really an invention or not. You will weigh their testimony and give it its proper effect. The whole argument, in regard to Bentham, turns on this question. Does he substantially describe, not a machine by which planing may be done, but a machine like the plaintiffs'? He does describe various things, which will accomplish various purposes. But the question is not, whether by using some parts of his invention we may make a machine, which will plane, but whether that machine will be substantially the same as the one Woodworth patented. That is the sole question; for he may have suggested fifty different modes or methods of planing, and still if this very mode be not there, it cannot be properly said, that he has described the plaintiffs' machine. You must see, in effect, that this same machine was substantially in Bentham's eye when writing his specification, and would be in the eye of an expert on reading it. I am not mechanic enough to aid you in explaining that specification; but you have heard several of [* 144] the plaintiff's *witnesses testify, that they could

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not discern this machine in it, that they could not make it from it. They are all able and ingenious men. Mr. Keller, whose opinion may well be regarded as of the very highest authority, since it is impossible for any man to have a more weighty experience on this subject, he having for so long incessantly devoted his attention to machinery and to patents,— Mr. Keller tells you distinctly, that there is no such machine as Woodworth's in Bentham's specification. On the other hand, Mr. Adams, also an extremely able and experienced man, states directly the contrary. And so of the others. You will remember the names of the witnesses on the one side and on the other, and also the diversity of their opinions on this point. Now, after all, in relation to this various evidence, all honestly and clearly given, by men of great skill and ability, what is your conclusion? Have you evidence, which leaves no reasonable doubt in your minds, that Bentham really does substantially describe Woodworth's machine?

Upon this point, the counsel for the plaintiff made a suggestion, towards the close of his argument, which struck the Court as possessing great force. Bentham's specification was known and filed so early as 1793, while Woodworth's patent was not taken out till 1828. It is universally admitted, that the planing machine is a most valuable invention. The counsel have said, indeed, that it is the most valuable of all, which have been made; and though, for myself, I should scarcely go so far as that, but regard the cotton-gin, next after Fulton's wonderful invention of the steamboat, whose incalculable benefits the whole civilized world is every day experiencing, in the comparative annihilation of distance and time, and the consequent advancement of human improvement, as perhaps the most important invention within my knowledge; still I can have no hesitation in conforming to the general high estimate of the importance and utility of the

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planing machine. But in the best scientific works [* 145] of the * day, no planing machine like Woodworth's was ever alluded to, till after his patent was taken out, though Bentham's specification was constantly spoken of, and the planing machine he patented in 1791 was well known and is described. Now, with so many ingenious and inquiring minds constantly at work upon the construction and improvement of machinery, both in Great Britain and America, all having easy access to well-known publications relating to science and the arts, how could it have happened, that down to the year 1828, no man should ever construct this machine from Bentham's specification of 1793, if it is so clearly to be found therein? Why should it be, that for a period of thirty-five years, not a man in America or England, dreamt of constructing this machine, which has proved of such vast utility, from Bentham, if Bentham really had described it? Certainly, it could not have been from ignorance of the specification, for the Repertory of Arts, in which it was published, was a work of much authority in England, and was, besides, as well known here, as on the other side of the Atlantic. This seems to me a fact of great importance, though I have no right to say how far it ought to affect your minds. But is not this total silence for so long a time, a circumstance, which may naturally aid you in forming a conclusion on this controverted point? And if, as I have before said, you are in doubt, your verdict in regard to this point must be for the plaintiffs.

But the great question of the case is, as indeed from an early period of the trial I thought it would be, this:—Is the machine used by the defendant, substantially the machine which Woodworth invented? And in regard to this, likewise, there is very great diversity in the testimony of the experts. At the opening for the plaintiff, four or five very intelligent men gave their evidence, that there is no substan-

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tial difference between the two ; that a portion of the apparatus is different, but that substantially the mode of operation is the same ; and that, in truth, the substance of defendant's *machine is Woodworth's invention. [* 146] But on the other hand, the testimony is just as positive, explicit, and strong the other way. And the burden here is upon the plaintiff, who must show, that there has been an infringement upon his right. This is a point which will merit and require your deliberate and careful attention.

Woodworth's claim is substantially for a planing machine ; for a mode of accomplishing a particular end by certain means ; and to maintain his case, the plaintiff must show, that there has been a substantial invasion of his machine by the defendant.

There are various modes of operation mentioned in Woodworth's specification. He speaks in the first place of "rack and pinion," but does not confine himself to that means ; for he says the carriage may be moved "by rollers, or by any lateral motion, to the edge of the knives or cutters." You will observe, that he contemplates the use of knives, as distinct from teeth or burrs. He speaks likewise of a carriage, throughout. He "does not claim the invention of circular saws, or cutter wheels," but he does claim "the improvement and application of cutter or planing wheels to planing boards, plank, timber, or other material." His claims, in effect, may be stated thus : "I claim this planing apparatus as my invention ; but though I have pointed out one particular mode of operating it, I do not confine myself to that mode, but mention, that any lateral motion may be employed to advance the work to the cutting wheel."

Now, if Gould in his machine only dispensed with the rack and pinion, still continuing to use the carriage, beyond all question there would be a plain invasion ; for the rack and pinion are not made essential to the machine. It is true,

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that Woodworth always speaks of a carriage. There is nothing to show that he ever dispenses with it. But he says, that the movement may be given to the carriage by any of various ways. And here arises the question, whether, if an invention in the aggregate be new, and a party omits one part of the machine always used by the inventor, such mere omission will operate to deprive the inventor of his patent-right? But the real pinch of this part of the case, is in this inquiry: Does the defendant, in using a part of Woodworth's machine, adopt a mode of movement essentially different from that pointed out by the inventor, or is that mode substantially within the scope of the invention?

Woodworth speaks throughout of a carriage. Gould does not use any carriage, in the technical sense of the term, but employs a platform. He uses feeding rollers to conduct the work to the cutters. He has no rack and pinion, for none is necessary. And his argument is, that as he uses merely feeding rollers, without a carriage, he employs a mode of operation not at all indicated in Woodworth's specification, and substantially different from moving a carriage by rollers or any other lateral motion. If there is this essential difference, the case is his. But if you are satisfied, that this principle of feeding rollers is substantially embraced in the specification and drawings, a mere change in the form or position of the rollers will not change the character of the patentee's right. The defendant contends, that neither in the specification nor the drawings, is there any reference to rollers as a moving power, distinct from a carriage; that feeding rollers, as such, are nowhere pointed out; and that the rollers, which are to be found in Woodworth, are merely friction or guiding rollers. On the other side, the plaintiff maintains, that even in the vertical machine represented in the drawings, the rollers are pressure rollers; that in changing the machine to a hori-

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zontal form, which the inventor expressly indicates may be done, they would operate as feeding rollers; and that any competent mechanic would understand them as so intended, and would contrive means to make them rise and fall, as necessary to produce the very result contemplated by the inventor.

* Now, are these rollers, as to this mode of operation, [* 148] substantially described in the patent? The language relates to rollers generally. Their use is not pointed out in words, except so far as it mentioned, that the motion of the carriage may be given by rollers. Supposing the machine to be horizontal, say the plaintiffs' counsel, what office would these rollers perform? Those below the plank, by being geared, would produce its motion to the cutter wheel; those above the plank and beyond the wheel would serve to keep it steady, and would operate as pressure rollers to the extent necessary for that object. So that in point of fact, the rollers above and below would operate as, and would be, feeding rollers. If it is true, that the rollers indicated in the drawings would perform this office, were the machine horizontal, and if a skilful machinist would know, that they necessarily must perform it, and would therefore give them the necessary means of adjustment to produce the intended result — then the point appears to be with the plaintiff. But the counsel on the other side take the opposite ground, and maintain that nothing is to be applied in the horizontal machine except in the precise manner, in which it is indicated to be applied in the vertical; that the vertical rollers are not geared in the drawings, and therefore we cannot suppose the inventor intended, that gearing should be given to the horizontal. I am not sufficiently acquainted with mechanical science to be able to decide about this; but I can scarcely think it an unreasonable supposition, that, where an inventor contemplates different forms and positions of his machine from that in

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which he describes it, a skilful machinist, in making the change of form, would also make the requisite changes in the parts, from his own knowledge. But there is a good deal of forcible argument on the part of the defendant, that these vertical rollers could never have been intended as feeding rollers, and that they could not perform such an office; though it is unnecessary to dwell on that part of the argument [* 149] founded on the want of top-journals in the drawing, because any skilful mechanic in building the machine would naturally, and almost of course, confine the rollers at both ends, whether they were intended for feeding, or pressure, or guiding rollers. And as to the rollers in the drawings, which are represented as beyond the cutting cylinder, the plaintiff says, as we have seen, that they are pressure rollers to some extent, and were meant as such; while the defendant again contends, that in the vertical machine they are guides merely, and in the horizontal machine would be nothing but the same guides. That is a question for your consideration, for on this point you are better judges than I possibly could be. That in the vertical machine with the carriage they are friction rollers in form, is, however, of no importance; for a change of form is not a change of substance. The defendant admits, too, that incidentally his feeding rollers comprehend, to some extent, pressure rollers. It is clear they must. But he alleges that their primary object is to draw the work along to the cutting cylinder, and that the character of pressure rollers is but an incidental, though necessary, result of their office. But on the other hand, the argument is just as good for the plaintiff, that his pressure rollers incidentally comprehend feeding rollers, and would operate to feed the work to the cutting wheel.

But again. Is the carriage, in Woodworth's specification, treated of as an essential and indispensable part of the invention, or might the machine be complete without the car-

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riage, and by the substitution of some other means? If in all cases the inventor contemplated the use of a carriage, and of no other means, and if the defendant in dispensing with it thereby employs what the inventor never thought of, that is a good ground of defence. You are the judges of this; and if you find, that the defendant's feeding rollers are not substantially in the patent, and that the carriage is an essential part * of the Woodworth machine, your [* 150] verdict, in that respect, must be for the defendant.

But then comes another consideration. Admitting all this to be true, as the defendant alleges, is there any other part of Woodworth's machine, on which he has infringed? Because, if his dispensing with the carriage and using the feeding rollers constitute the only differences in the two machines, and if the rest be the invention of Woodworth, not known before, then Gould has merely improved upon Woodworth, and has no right to use Woodworth's invention, up to the point where the difference commences. He might, to be sure, have a clear title to a patent for his improvement, but it must be as an improvement; and it would give him no authority to use the other parts of the machine, which Woodworth invented. Therefore it is not sufficient for him to show that his machine is a great deal better than Woodworth's; he must establish the fact, that he uses nothing which Woodworth invented. Now, he does not use Woodworth's carriage, nor the rack and pinion, nor his pressure rollers, except in so far as his feeding rollers are necessarily pressure rollers. What of his, then, does he use? The cutters. No particular form of the cutting knives is mentioned in Woodworth's specification; nor was it necessary, because a change in the form, while the principle remains the same, will not escape a violation of patent-right.

The question here for the jury to determine is, whether the defendant's improvement is made on the plaintiff's ma-

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chine as a whole, by taking out part and substituting something better, but still retaining a part or parts of the original invention ; or whether the plaintiff's machine is a mere aggregate, a congregation of parts, all old in themselves, constituting a unit, to which the carriage, in combination with a rack and pinion, or rollers, or some lateral motion, is absolutely essential ; and which unit, defendant has not invaded because he dispenses with some of its indispensable [* 151] constituent * parts. If you think, that there is any such invention, on the whole, as the patentee claims, and that defendant's alterations in the machine are mere improvements, but the residue in the aggregate is the invention of the patentee, and was not known before him, then your verdict will be for the plaintiffs. The difficulty lies in saying, where the invention was ; and you are to consider, whether, taking out the carriage, this machine in its other parts was an invention of those parts, or any of them, or whether it was merely a combination or aggregate. I confess, that my impression has been, that Woodworth meant his claim to be for an aggregate machine, but such is its obscurity, that I am unable to say, decidedly, what, in this respect, he did mean it to be. If you should be of opinion, that the original machine is composed of parts, all of which were known before, and that Woodworth's invention was merely of a new aggregate or combination of those parts, to which the carriage was indispensable, you will find for the defendant. But if, on the contrary, you think, that the defendant uses parts of Woodworth's real invention, or if his machine is but an improvement on the original, and not substantially and essentially different from it, the verdict should be for the plaintiffs.

I do not know, gentlemen, that, by saying any thing more, I could aid you at all in coming to a conclusion, and indeed I fear, that I have not made myself so clearly understood throughout, as I could desire. But before leaving the case

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in your hands, I must take notice of the point of law, upon which the plaintiff's counsel have asked me to instruct you. The ground they take I consider clearly correct, and you will therefore regard it as the law, that the plaintiff's patent is not avoided by the publication of Bentham's specification, unless you are satisfied, that that specification contains an intelligible description of an organized machine, fit for the planing of plank or boards, substantially like plaintiff's; and that if every part of plaintiff's machine can be found described in * Bentham's specification as parts of other [* 152] machines, but not as combined in one machine in such a manner as to be fit for planing boards and plank, it will not avoid the plaintiff's patent.

The jury rendered a verdict for plaintiffs, with \$50 damages.

On a subsequent day, a bill of equity was filed, setting forth the facts heretofore stated, and praying, that an injunction should be issued against the defendants, to restrain them from the further use of the machines, which were the subject of the present patent. Two motions were made, one on the law side of the Court for a new trial, and the other on the equity side of the Court for an injunction,—which were both argued at the same time.

The motion for a new trial was as follows:

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And now after verdict and before judgment, the defendant respectfully prays this honorable Court, that a new trial may be granted to him for the following reasons:

1st. Because the honorable judge, who presided at the trial, instructed the jury as matter of law, that the plaintiffs under their indenture with the administrator of the patentee

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and Wilson, mentioned in the declaration, had title to such an exclusive right as would enable them to maintain this action.

2d. Because the honorable judge, who presided at the trial, instructed the jury as matter of law, that the patent was not void at the time when and from which, the indenture between the plaintiffs and the administrator and Wilson took effect, by reason of its purporting to grant a right under the patent, as including the circular saw, which was afterward disclaimed, and is admitted not to be valid ; and which disclaimer at the time of the date of said contract had [* 153] not been * filed. Whereas the jury should have been instructed, that the *patent was void*, because at the time of the date of said indenture, when and from which said indenture took effect, it purported to grant a right under the patent, as including the circular saw, which has since been disclaimed and is admitted not to be valid ; but which disclaimer had not been filed according to law at the time of the date of said indenture.

3d. Because the honorable judge, who presided at the trial, refused to instruct the jury, that the patent was imperfect and void for want of suitable drawings and references, and that if the drawings may be referred to they should be as composing part of the description and *not part of the claim*.

4th. Because the honorable judge, who presided at the trial, instructed the jury as matter of law, that the patent was not void, for ambiguity and uncertainty in the claim.

5th. Because the honorable judge, who presided at the trial, refused to instruct the jury as prayed for by defendant's counsel, that the patent was void for multiplicity of claim.

6th. Because the honorable judge, who presided at the trial, refused to instruct the jury as matter of law, that the drawings could not be referred to for the purpose of adding

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any thing to the description or claim, not specifically mentioned therein ; so that if top pressure rollers were not described in the specification, recourse could not be had to the drawings to supply or describe them, as making part of the specification ; whereas the jury should have been instructed as prayed for by the defendant's counsel.

7th. Because the honorable judge, who presided at the trial, refused to instruct the jury, that if top pressure rollers were embraced in the patent, for the purpose of confining the plank to the carriage, nevertheless defendant had not infringed in that respect, if he used rollers *only* for the purpose of feeding, and *not* for the purpose of confining the material to the carriage, and that the *incidental effect* of their serving *as pressure rollers, if they did so, would not [* 154] be an infringement of the patent, as the specification admitted, of feeding rollers as one means of lateral motion not claimed as new ; whereas the jury should have been instructed as prayed for by defendant's counsel.

8th. Because the honorable judge, who presided at the trial, refused to instruct the jury, that if the plaintiffs' machine consisted of a composition of machines or *mechanical means*, all old and none applied to new uses ; and did not embrace any new parts, or parts put to new uses ; it was in point of law a claim for a combination ; and that if the defendants did not use the whole combination they did not infringe ; whereas the jury should have been so instructed as prayed for by defendant's counsel.

9th. Because the honorable judge, who presided at the trial, refused to instruct the jury as prayed for by defendant's counsel, that the patent, according to the specification and claim, as therein contained, was not for any particular form or combination of a rotary cutting cylinder — nor for any particular form of platform, nor for any particular form of carriage, nor for any particular mode of effecting the lateral

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motion of the carriage to the cutting wheel, and therefore, that if any machine described in Bentham's patent, or either of those testified to by Blanchard, was composed of a platform or bench, with a sliding bed or carriage, to which the material was attached, and which carriage was moved by any lateral motion to and along the cutting wheel, in such manner as that the surface of the material was cut or planed or reduced by the cutter wheel, and that such machines were suitable for that purpose, then, the defendant had not infringed the patent in these particulars or any of them.

10th. Because the honorable judge, who presided at the trial, instructed the jury, that the plaintiffs' patent was not avoided by the publication of Bentham's specification, unless the jury were satisfied, that the specification contained an * intelligible description of an organized machine fit for the planing of plank or board, substantially *like* the plaintiffs. And that if any parts of the plaintiffs' machine could be found described in Bentham's specification as parts of other machines, but not as combined in one machine in such a manner as to be fit for planing boards and plank, it would not avoid plaintiffs' patent.

11th. Because the honorable judge, who presided at the trial, omitted to construe the claim set forth and made by the patentee, but left it to the jury to decide, whether or not the claim was for an organized machine or for a combination merely.

12th. Because the honorable judge, who presided at the trial, instructed the jury, that it was not sufficient for defendant to show, that defendant's machine was a great deal better than Woodworth's, but the defendant must establish the fact, that he used nothing that Woodworth had invented. That defendant did not use his carriage, nor rack and pinion, nor his pressure rollers, excepting in so far as his feeding rollers were pressure rollers, but that he did use the cutters. That no

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particular form of cutter knives was mentioned in this specification. Nor was it necessary, because a change in form, while the principle remains the same, would not escape a violation of the patent-right; by means whereof the jury were led to understand, that the use of a cutting roller by the defendant was a violation of the right claimed by plaintiff.

13th. Because, by the course and result of the trial, the defendant is precluded from carrying up for final decision in the Supreme Court, the points of law, which were ruled against him for the purposes of the trial.

14th. Because the verdict was against the weight of evidence.

15th. Because of the discovery since the trial of new evidence, which defendant is advised, is material to the right decision of the case.

In support of this last point of his motion for a [156] new trial, the defendant stated, that he should rely chiefly, but not exclusively, upon the deposition of Isaac Adams, the evidence of Thomas Blanchard, Charles M. Keller, and the charge of the judge, as published; and that the new evidence would be disclosed in the affidavit of Daniel Dunbar, to be filed in the equity suit, on plaintiffs' motion for for an injunction, to be heard at the same time as the above motion for a new trial.

The motion for a new trial was then briefly spoken to by the counsel on both sides. Upon the motion for an injunction,

B. R. Curtis, for the plaintiffs, argued, that the injunction should be granted upon three grounds. 1st. Because of the long possession by the patentee and his assigns under the patent; to which point he cited *Bolton v. Bull*, 3 Vesey, 140; *Universities of Oxford, &c. v. Richardson*, 6 Vesey, 707;

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Harmer v. Plane, 14 Vesey, 130. 2d. Because of the renewal of the patent by the board of commissioners, which was a strong circumstance to show that the possession was lawful. 3d. Because of the verdict in the trial at law, which was a decisive reason why it should be granted; and to this point he cited *Bolton v. Bull*, 3 Vesey, 140.

Dehon and Giles, for the defendant, argued, that the possession, which would entitle a party to an injunction, must be long and undisputed; whereas the present patent had been disputed. To this point was cited *Collard v. Allison*, 4 Mylne & Craig, 487; *Hill v. Thompson*, 3 Meriv. 622.

STORY, J. After the very elaborate arguments had at the trial at law in this case, and unexampled in length in this Court, I do not deem it fit or proper to go over the various grounds for a new trial, which have again been argued at large at the bar. Some of the questions, which then occurred, were new to my mind, and upon which I entertained [* 157] *considerable doubts; but, after all, I then pronounced the opinion respecting them, which, upon the fullest reflection, I entertained. These doubts, whatever they were, have not been strengthened by the arguments since had. On the contrary I must say, that I have since felt far greater difficulties in supporting the opposite conclusions. And on the whole, I wish now to say, that I feel no inclination to change those opinions.

As to the points which had been ruled by my brethren on other circuits, and which I adopted from that just comity which belongs to their learning and ability, and which has long been adopted as a fit rule to govern me in my circuits, since I know of no higher authority except that of the Supreme Court of the United States, I shall continue to adhere

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to their doctrine, as I have not the presumption to suppose my own judgment entitled to more weight than theirs.

There are a few grounds only, upon which I shall deem it necessary to add any thing beyond what was suggested at the trial. In the first place, as to the supposed surprise by new evidence on the part of the defendant, not known to him at the time of the trial. Several answers may be justly given to this suggestion, but I shall limit myself to two. The first is, that, by reasonable diligence, the information might have been obtained; the second is, that it was, in point of fact, within the reach of the party before the trial was concluded. I ought to add, that every person, who violates a patent, is bound, before he does so, to know that he puts himself to the peril of establishing a good defence, and he has no right to violate it, and then to seek indulgence from the Court to find out some possible ground or some probable evidence to support him in his acts.

In respect to another objection, namely, that the Court was bound to state what, in point of law, the invention claimed by the patentee was, I agree, that this is generally true, so far as the construction of the words of the patent, and specification * is concerned. But then this doctrine is [* 158] to be received with qualifications, and *sub modo*, as the very opinion of Mr. Baron Parke, cited by the counsel, in the case of *Nelson v. Harford*, (*Webster's Reports on Patents*, pp. 275, 370,) abundantly shows; and the jury are to judge of the meaning of words of art, and technical phrases in commerce and manufactures, and of the surrounding circumstances, which may materially affect, enlarge or control the meaning of the words of the patent and specification. But I do not proceed upon this ground. The Court did explicitly give to the jury its construction of the patent in the present case, and that was, that it was for an improved machine. But then it was necessarily open to the jury to say, what part or parts of

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this improved machine were new ; in other words, what parts and combinations of parts in the same were the invention of the patentee, and what were known before. If the defendant did not infringe the whole of the improved machine, that is, by making or using one entirely identical ; yet if he did make and use a substantial part thereof, which was exclusively the invention of the patentee, and distinguishable from other parts of the machine, that would be an infringement of the patent according to our law. This was not a matter of mere law, but involved matter of fact, and left it open to the jury to say, what, upon the whole evidence connected with the patent and specification, was the extent of the plaintiff's invention. Did the plaintiff invent the aggregate or combination only incorporated in the machine? Or did he invent certain parts also of the machine distinguishable from the rest, which were unknown before? It was to this part of the case, which seems to have been misunderstood by counsel, that the language referred to in the charge was addressed, when the Court said : " If you (the jury) should be of opinion, that the original machine is composed of parts, all of which were known before, and that Woodworth's invention was a mere aggregate or combination of those parts, to which [* 159] the carriage * was indispensable, you will find for the defendant. But if, on the contrary, you think, that the defendant uses parts of Woodworth's real invention, or if his machine is but an improvement on the original, and not substantially and essentially different from it, the verdict should be for the plaintiffs."

The next ground, which has been most elaborately argued, is, indeed, to a point, confessedly merely technical and aside from the real merits. It is, that the assignment under which the plaintiffs claim, does not convey to them a territorial or sectional right under the patent in the sense of the Patent Act of 1836, ch. 357, and the subsequent acts. I say, that

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this is purely technical, and aside from the merits, and would involve a mere question of costs, since it was admitted at the trial, that, by agreement between the parties, it was arranged, that the name of the patentee or other proper party might be substituted, if the Court thought the objection valid. To allow this objection now to prevail, if upon the merits the case were otherwise unobjectionable, would be in effect, therefore, to turn the parties round to a new suit, upon a ground that is not entitled to any favor, and stands upon the very limits *strictissimi juris*. So far as the law goes, the party is entitled to it; but certainly not beyond that.

Let us now proceed to consider the language of the instrument or indenture of assignment of the 2d January, 1843. It is difficult to make the whole force of the argument understood, without citing at large some of the clauses, which I shall accordingly refer to as before the Court.

The indenture, after reciting, that for certain considerations, therein stated, the patentee "hath agreed to license and empower parties of the second part (the plaintiffs) to construct and use, and to license others to construct and use, fifty of the said patented machines, within the counties of Suffolk, and Norfolk, and in the towns of Charlestown, Cambridge, West Cambridge, Watertown, Medford, and Malden and * Rockbottom village, in the county of Middle- [* 160] sex, in the State of Massachusetts; in such manner, nevertheless, that the license and authority so granted shall stand and be as security unto the party of the first part (the patentee) and his assigns, for the payment of each and all of the said promissory notes," (the consideration-money,) proceeds to say: "First, The party of the first part (the patentee) does hereby license and empower the parties of the second part, (the plaintiffs, and their executors and administrators,) to construct and use fifty of the said patented machines within the territory aforesaid; and also within the same territory to

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license and empower other person or persons to construct and use one or more of the said patented machines during the whole period for which said letters-patent have been granted ; but the whole number of machines by the parties of the second part, (the plaintiffs,) and by all persons empowered by them, constructed and used during the said period in the said territory, shall not at any one time exceed the said number of fifty machines."

Then follows a proviso, providing for a sale of the right granted to the plaintiffs, in case of a default in the payment of the notes given for the consideration-money. I do not know, that any thing very important can be gathered from it, to assist our inquiries upon the present occasion, unless it be, that it speaks in one place of the sale of "all the *right, title, and interest* which are in any way *granted* unto" the plaintiffs ; and, in another place, that, upon the sale, the patentee may, in the names of the plaintiffs or their assigns, "convey and assure the same to the purchaser, and thereupon all *license, power, and authority*" of the plaintiffs and their assigns, &c., "shall cease." If the language of this proviso is to have any distinct effect, with reference to the point before the Court, it is, that it is explanatory of the preceding clause, and shows that the words "right, title, and interest [* 161] granted," *and "license, power, and authority," were used by the parties as precise equivalents.

Then comes the second clause, by which the party of the first part (the patentee) and the party of the third part (Wilson) covenant with the plaintiffs, that they will institute suits at law, and in equity, against any and all persons, who shall infringe upon the patent aforesaid, within the territory aforesaid, during the period of two years from the date of the indenture, at their own expense ; and after deducting the expenses of the suits, &c., to pay over the damages recovered to the plaintiffs.

The third clause may be passed over as not important.

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The fourth clause then provides, and the plaintiffs covenant with the patentee and Wilson, that they will at all times, during the said term of two years, suffer and permit the patentee and Wilson to use their names in all such suits as may be commenced as aforesaid, and that they will aid and assist them (the patentee and Wilson) to procure the necessary evidence to sustain such suits when commenced.

The fifth clause contains a covenant by the patentee with the plaintiffs, "That he will not license and empower any person or persons to use any of the aforesaid machines within the territory before named during the said term of seven years for which the said letters-patent have been extended. But nothing herein contained shall be so construed as to prevent the party of the first part (the patentee) from constructing or licensing the construction of the said machines to be used elsewhere than in the territory aforesaid."

Such are the most material parts of the indenture, which are necessary to be brought directly under review in the present discussion. The whole argument of the defendant's counsel turns upon this, that the instrument amounts, not to a grant of sectional rights of the patent in a particular territory, but as merely a license to construct and use fifty machines within the prescribed territory.

*There is no magic in particular words; but we [* 162] must understand them, as they stand and are used in the particular instrument; and in searching for the true interpretation, we must look to all the provisions of the instrument, and give such effect to it, as its obvious objects and designs require, without nicely weighing the precise force of single words. Much stress has been laid upon the words "license and empower" in this instrument; as though they imported something different from "grant." There is no doubt, that the words may be used in contradistinction to "grant;" but it by no means follows, that they are or must

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naturally or necessarily be so construed. In a broad and general sense, in common parlance, we use the words indiscriminately. We say, that a license or power is granted to do so and so; and no one ever perceives any impropriety in the language. A mere license, properly so speaking, passeth no interest in the thing, but only makes an action lawful, which without it would have been unlawful. But if it passeth an interest therein, then it is no longer a mere license, but a grant. So the law is laid down in *Thomas v. Sorrell*, (Vaugh. R. 351.)¹ In *Brooke's Abridg., License*, pl. 19, it is laid down, that if a man license one to enter into his land and occupy it for a year, &c., it is a lease, and should be so pleaded, and not as a license. And for this he cites 5 Henry VII. 1, which, upon examination, I find fully supports the proposition, if indeed it were possible to entertain a doubt upon the point.² Now, in the present case, there can be no doubt, that the instrument did not convey a mere license, but a license coupled with an interest in the machines, and in the patent-right itself, so far as concerned these machines. So that there is nothing in the language, which in any manner restricts the interpretation; and we are at full [* 163] liberty to construe the words "license and *empower" to mean a grant, if that will effectuate the true intent and apparent objects of the parties.

Now, what were the true intent and objects of the parties in the present instrument? They were, in my judgment, to give the exclusive right, for the purpose of profit, to construct and use the patented machines, and with them the exclusive right to the patent itself, as an appropriate incident, within the prescribed territorial limits. This is made clear by the

¹ See also *Warren v. Arthur*, 2 Mod. R. 317.

² *S. P. Hull v. Seabright*, 2 Keble, R. 561; 1 Mod. R. 14; 1 Siderf. 428.

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covenant on the part of the patentee, that he will not license and empower any other person to use the same machines, within the same territory, during the whole period of the running of the patent-right under the patent. Then comes the proviso, that nothing in the instrument shall be so construed as to prevent the patentee from constructing or licensing the construction of the said machine to be used elsewhere than in the prescribed territory. It is suggested, that this proviso shows, that it was the intent of the parties to allow the patentee, and any other persons licensed by him, to construct machines within that territory, to be used elsewhere, which is a right inconsistent with the supposition, that the patent-right had passed to the plaintiffs. I confess, that, upon a close examination of the language, I entertain great doubts, if this is to be deduced as a very clear inference from the language used. The word "elsewhere," in its actual connection, is susceptible of being applied, as well to the construction, as the use of the machine elsewhere, and thus to be deemed a mere cautionary provision, very proper in cases of this sort, to prevent misinterpretation. And if the other parts of the instrument would justly lead to the conclusion, that the patent-right was intended to be exclusively granted to the plaintiffs within the prescribed territory, I should not scruple, *ut res magis valeat, quam pereat*, to adopt it.

But assuming the true interpretation of the words to be, as the defendant contends, it by no means leads to the conclusion for which it is urged. Even upon his construction, the patentee, or his licensees, could not use or sell for use * any machines within the territory, if they [* 164] could construct them there. Now, the right to use the machines is as much a part of the patent, as the right to construct them; and supposing the patent-right to be, in contemplation of law, an entirety, then we should have a case, in which the intent of all the parties, upon the very face of

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the instrument, would be utterly defeated, and the instrument itself become a nullity, or neither party would have any right whatsoever against third persons under the patent, for any violation thereof. The patentee intended to convey to the plaintiffs and their assigns, the sole and exclusive right to use the machines constructed by them, within the territory, and to reserve to himself and his licensees at most only a concurrent right to construct machines, but not to use them within the territory, so that nothing was intended to be reserved to the patentee but a naked concurrent right to construct, and to the plaintiffs a similar right to construct, with the full and exclusive use of all the machines constructed by them within the territory. If by law such an intent cannot be carried into effect, because the patent is, as to all the operative rights granted therein, "the full and exclusive right and liberty of making, using, and vending to others to be used, the invention," entire and indivisible, then, as has been suggested, the instrument is a mere nullity. If, on the other hand, it is an operative instrument, then, as the exclusive use of the machines within the territory has passed to the plaintiffs, the patentee can maintain no suit for any violation thereof, therein, for he has no residuary right to such use; and the plaintiffs can maintain no suit for such violation, according to the argument of the defendant, because they are not assignees of the entirety, of any territorial right. I confess, that if I were driven to make a choice under such difficulties—in order to escape from such consequences, going manifestly to defeat all the proper purposes of the Patent Acts—I should rather construe these acts distributively, and say, that the patent-right ought not to be deemed an entirety, but to be [* 165] divisible, so as * to permit a grant of the exclusive right to construct to one person, to use to another, and to vend to another.

But I am not driven to make any such choice. On the

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contrary, a construction of the instrument perfectly consistent with its terms and intent and objects, taking all the clauses together, may be adopted, which shall give full effect to every part thereof. Suppose the instrument had in terms declared, that the patentee granted the exclusive right of the patent within the territory of the plaintiffs, but the plaintiffs were still to permit and allow the patentee and his assigns to construct machines within that territory, to be used and sold elsewhere, there could be no difficulty, in law, in giving full effect to such a provision. The patent-right would pass to the plaintiffs within the territory, and the patentee and his assigns would still be entitled, as licensees under the plaintiffs, to construct machines, without infringing the grant, within the territory. Now, this is precisely what, in my judgment, the parties intended in this case to do, and what, taking all the clauses together, they have actually done. In the first place, the grant, for so I call it, was not a mere personal naked license to the plaintiffs; but it was intended to be an assignable interest. The plaintiffs were to construct and use, and to license others to construct and use, machines within the territory. They might assign their whole right to all the machines, or to any one or more of them. Suppose a man should sell a horse to another, and the buyer were to agree, that the seller should have the privilege to use the horse once a week, as his occasions may require, would not the exclusive property in the horse pass to the buyer? Suppose a person should buy of another a loom for weaving, and he should agree, that the seller might weave certain cloth in it, would not the sale convey the entire title to the loom to the buyer? Suppose a person should buy a corn-mill of another, and should agree at the same time, that the seller might grind his own corn therein, would not the entire title * to the mill pass? I put these cases, [* 166] because they stand upon a strong analogy, and

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show that there is nothing unreasonable or repugnant in giving such constructions to instruments of this nature.

In the next place, if there was any violation of the patent-right within the territory, in whose name was the suit contemplated to be brought? Plainly, as the fourth clause, already referred to, shows, in the name of the plaintiffs, and yet at the expense of the patentee; and the plaintiffs were to receive all the damages recovered, after deducting the costs and expenses of the suits. Now, this very clause is decisive to show, that all the parties contemplated, that the patentee had parted with all his patent-right within the territory, and that it was exclusively vested in the plaintiffs. If that was the intent — the true and sincere intent, what is there in the law which prevents this Court from giving full effect to it? But it is said, that the parties acted under a mistake of the law on this subject. But how does that appear? It is assuming the very matter in controversy, and assuming it, when, upon the interpretation of the instrument itself, already suggested, there was no mistake of law at all. It is clear that the parties intended no mistake of law, and we are not at liberty to defeat their intentions by assuming, that one did exist.

The very proviso already commented on, corroborates the views already taken by the Court. If the parties did not intend, that the plaintiffs should have the exclusive right to the patent within the territory, but meant, merely, that the plaintiffs should possess a limited license therein, the proviso, so sedulously incorporated into the fifth clause, was utterly useless and unnecessary. But, if the plaintiffs were to have such an exclusive right, then the proviso may have a very just, and, in one view, a very important operation. Upon the construction contended for by the defendant, it secures a license to the patentee, to construct machines within the territory, [* 167] * although not to use them or vend them there.

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In the other aspect, it excludes any conclusion, that the patentee did not "elsewhere" retain his full and exclusive right and liberty to make, use, and vend any machines, whatsoever, under the patent.

But it is suggested, that the limitation of the right, granted to fifty machines, shows, that the patentee contemplated a license for that number only, and not an exclusive grant of the patent to construct and use machines within the territory. I profess not to feel the force of this, as an independent, or cogent objection. It is a circumstance, in the case, fit to be weighed. But it is by no means one that is, in itself, entitled to very grave consideration. The limitation of the number of machines, to be made or used under a patent, is not inconsistent with the grant of an exclusive right in the patent, within a particular territory. It is a matter of policy, or convenience, or profit, to be judged of by the parties, as to its effects upon the value of the patent-right, out of that particular territory. Suppose a patentee should sell an undivided moiety of his patent to another person, and should agree with him, that neither of them should erect more than a given number of machines; so that the market should not be unduly glutted with them, either for use or sale; or suppose that the patentee should sell the exclusive right of his patent to A., in six of the United States, to B. in six other States, and to C. in six other States, retaining the remaining States to himself, and he and they should mutually agree not to make or use, or vend, more than a fixed number of the patented machines in any one State, what would there be in such an agreement inconsistent with the exclusive right of each within his prescribed circuit of States? I profess to be unable to perceive any legal objection to such an agreement, or to its legal operation, as an exclusive grant of the patent, within the prescribed States. There is, or at least may be, a wide difference between the right to a thing, and

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[* 168] the unrestricted * exercise of that right, under a grant. A man may purchase a house in fee, and yet he may limit himself, as to his mode of enjoyment thereof; as, for example, he may covenant not to carry on a particular trade there, nor to let it for a tavern, or not to let it in parts to more than four families at the same time. The house is still in his exclusive ownership, although he should thus qualify the general rights, ordinarily incident to that ownership.

The limitation of the number of machines in this case, was, at least, as far as we can gather from the nature and apparent objects of the instrument, not designed to prevent an exclusive patent-right within the territory, but to exclude an injurious competition to the patentee, elsewhere. If the plaintiffs were at liberty to construct and use as many machines as they pleased, within the prescribed territory, the value of the patent-right, to the patentee, in all the adjacent and neighboring territory, might be materially impaired, if not totally extinguished. The limitation, then, was designed, not to change the nature of the right, but to limit its exercise. It was not to reduce it from a grant to a mere license, but to limit the extent of the actual exercise of the right granted. It is not, properly speaking, an exception of a part out of the thing granted, *ejusdem generis*; but it is a restriction upon the mode and extent of using it.

There are many other suggestions, which might be made upon the true character and interpretation of this instrument, and various other expositions have been relied on, at the argument, upon which I forbear to comment, because they do not appear to me materially to alter, or control those, which have been already considered. I do not say, that the interpretation of this instrument is free from all doubt. But that which approves itself best to my judgment, is that which has been already stated. The opposite conclusion could not, in

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my judgment, be arrived at, without encountering more difficulties — some of which strike me to be almost insuperable. * On the whole, therefore, I hold, that [* 169] the interpretation given to the instrument at the trial was the true one, and it has not been shown to be erroneous.

For the reasons already given on the other points, as well as on this point, the motion for a new trial must be overruled, and judgment pass upon the verdict for the plaintiffs. I have the less hesitation in coming to this conclusion, because the present trial is not absolutely final; and the merits of the case may be fully considered in the bill in equity, and carried for a final decision to the Supreme Court.

Upon the other motion for an injunction, founded on the bill in equity, it is not necessary to say much. The injunction is asked for, upon the ground of long possession, the renewal of the patent, and the legal effect of the trial at law. In respect to the possession, the case is certainly very strong. The original patentee, (Woodworth,) went to his grave in full possession of it, if not undisturbed and undisputed, as to his title to the invention patented, at least without any successful impeachment of it. The patent has been renewed, since his decease, by the board of commissioners, after full examination and deliberation, in favor of his administrator. I think, too, that it was clearly established at the recent trial, that Woodworth was the true and original inventor of the machine patented, and it was so found by the jury. Indeed, the only question, upon the merits, was, whether the defendant used the patent machine, or one substantially different from it. Upon that, as a question of fact, there was a considerable conflict of evidence. But the jury found a verdict upon that point, also, for the plaintiff, and, as it appears to me, according to the preponderance of the evidence. The defendant has established no title in himself, or in any other person, to use the patented invention; and he has failed in his defence, that he did not violate it.

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The doctrine laid down by Lord Eldon, in *Hill v. Thompson*, (3 Meriv. R. 622,) is, in my judgment, the true [* 170] doctrine, * and is indispensable to the repose of titles, and the security of patentees. It is this, — that where a patent has been granted, and an exclusive possession, of some duration, under it, the Court will interpose its injunction, without putting the patentee previously to establish the validity of his patent by an action at law. But where the patent is but of yesterday, (meaning, that it is recent,) and upon an application being made for an injunction, it is endeavored to be shown, in opposition to it, that there is no good specification, — or otherwise, that the patent ought not to have been granted, the Court will not, upon its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained, by a previous trial at law; and will send the patentee to law, and oblige him to establish the validity of his patent, in a court of law, before it will grant him the benefit of an injunction. Correctly considered, there is nothing in Lord Cottenham's judgment, in *Collard v. Allison*, (4 Mylne & Craig, 487,) which in any manner impugns or shakes this doctrine. In that case, a new trial at law had been granted, and therefore his lordship held the legal title of the parties, as still undecided. I have, myself, in former cases, adopted Lord Eldon's doctrine, and especially, in the case of Ames's paper manufacturing patent, which was, at the time, most strenuously contested upon various grounds, and, especially, upon the ground, that the invention was not new. Yet the jury having, after a great conflict of evidence, established the validity of Ames's patent, an injunction was granted.

I shall, therefore, direct an injunction to issue, and to remain, until the hearing of the cause, or the further order of the Court.

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WILLIAM WOODWORTH v. ABRAHAM P. SHERMAN.

THE SAME v. WILLIAM A. CHEEVER, AND EIGHTEEN OTHERS.

[3 Story, 171. May T. 1844.]

Where a bill in equity was brought for an injunction against the defendants, to restrain them from using and selling a planing machine, constructed according to the specification in the plaintiff's patent — *It was held*, that, after the lapse of time which had occurred, since the patent was granted, taken together with the other circumstances of the case, the affidavit of a single witness was not sufficient to outweigh the oath of the patentee, and the general presumption arising from the grant of the letters-patent.

The Patent Act of 1836 authorizes the granting of an extended term of a patent to an administrator, as well as to the patentee.

The assignee or grantee, under the original patent, does not acquire any right under the extended patent, unless such right be expressly conveyed to him by the patentee.

In this circuit the practice in patent cases has not been to require the plaintiff to give security for costs.

THESE were bills in equity, filed in the Circuit Court of the United States, in this district, to obtain injunctions against the defendants, in twenty suits, to restrain them from using or selling any planing machine, constructed substantially according to the specification under William Woodworth's patent. (See the preceding case of *Washburn v. Gould*.) The complainants produced affidavits, stating that the several defendants were using a planing machine substantially the same in its construction and mode of operation as the machine of James Gould of Charlestown, and the bill, among other things, averred, that the plaintiffs had already recovered a judgment in an action at law, against the said Gould, for the use of his machine. Various points were relied on in answer to the motion for an injunction. It was contended :

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1st. That Woodworth was not the sole inventor, but that one Dunbar was a joint inventor with him.

2d. That the act of Congress did not authorize the granting of the extended term of the patent to an administrator, but only to the patentee.

3d. That some of the defendants had purchased [* 172] rights * under the original patent, and that, by virtue of the act of Congress, the same interest that they had in the original patent enured to them in the extended patent.

B. R. Curtis, for the plaintiff.

J. Giles Buttrick and *William D. Sohler, Jr.*, for the defendants.

STORY, J., granted the injunction prayed for in each case. As to the first point, he said, it had been before him in another case, and he then declared, that the affidavit of a single witness, after the lapse of so much time, and after the occurrence of some other circumstances, which were in proof, was not sufficient to outweigh the oath of the patentee, and the general presumption arising from the grant of the letters-patent.

As to the second point, he said, that, on the fullest reflection, he had come to the opinion, that Mr. Justice McLean was right in his decision,¹ that an administrator was competent to apply for and receive this grant. That to hold otherwise, would be going contrary to the whole spirit and policy of the Patent Laws.

As to the third point, he said, that he had already decided,

¹ Brooks v. Bicknell, (Walker's Western Law Journal, January, 1844.)

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after full argument and great consideration, in a case tried in Maine, and not yet reported, that the assignee or grantee, under the original patent, did not acquire any right under the extended patent, unless such right was expressly conveyed to him by the patentee.

In the course of the case, the judge remarked, that he observed that the bills contained a charge of an actual combination to resist the patent. That it was a question of much importance, what would be the legal effect of such a combination. That he did not intend to express any opinion on this part of the case, but that in a former case, he had * occasion to declare, that it seemed to him [* 173] that it approached very near, if it did not actually reach, a criminal conspiracy. That, in many cases, it was lawful for individuals to do what could not lawfully be done by a combination. That an individual patentee might successfully resist an individual, but it was much more difficult to resist the combined force of a great number of persons united to oppose a patent.

In the course of the case a question having arisen whether the plaintiff, in patent cases, was required to furnish security for costs,

Stoxx, J., said: In my circuit the plaintiff in patent cases has never been required to give any security for costs. But I do not recollect any reported case, in which that point was decided.

The following opinion was afterwards written out.

Stoxx, J. When these cases were heard before me at Chambers, I expressed my opinion briefly on the three points made at the argument, not then having time to go into them at large. I do not desire to say any thing further upon the first two points. But the last point involves a question of so

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much general importance, that it has appeared to me a duty, which I owe to the public, as well as to the parties, to give at large the reasons which influenced my opinion, and governed the decision. I do this the more readily, because I have not been able to find among my papers any statement reduced by me to writing, of the particular circumstances attending the case in Maine, to which I have already alluded, or any report of the grounds on which that decision was made. If I prepared, after the term, any written opinion, (of which I am not certain,) it has been mislaid, and after considerable search, I have not been able to find any. I rather think, from my general recollection, that the question arose incidentally upon a renewed patent, granted by a special [* 174] act of Congress, * after the first patent had regularly expired, and before the passage of the Patent Act of 1836, ch. 357. It may, perhaps, have been in a case involving the validity of the renewed patent, granted by the Act of Congress of 3d of March, 1835, to Eastman, for "a new and useful improvement, called the Circular Saw Clap-board Machine." But of this I am not quite sure, and I have not within my reach, at this moment, the means of verifying the conjecture. The doctrine, however, which I then held, was, that every license and assignment under the old laws, before the Patent Act of 1836, expired with the limitation of the original patent, unless it was expressly, in terms, so granted as to be applicable to any renewal of the patent afterwards; for, otherwise, the licensee's or assignee's right was necessarily bounded by the same limits as that of the licensor or assignee, that is to say, by the original term granted by the patent to the licensor or patentee. The doctrine proceeded upon the plain ground, affirmed by the common law, that a man can pass by a grant or assignment only that which he now possesses, and which is in existence, at the time, either actually or potentially. His grant or

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assignment is, therefore, by its natural interpretation, limited to the rights and things which are then in existence, and which he has power to grant, unless he uses other language, which imports an intention to grant what he does not now possess, and what is not now in existence. In the latter case, the language does not even then operate strictly as an assignment or grant, but only as a covenant or contract, which a court of equity will carry into full effect, when the right or thing comes *in esse*. Thus, it is laid down in Comyns's Digest, (Assignment, c. 1, c. 2, c. 3. Id. Grant D,) and better authority could not be, for, as was well observed by Lord Kenyon, he was the greatest lawyer of his day in all Westminster Hall, that an assignment or grant cannot, at law, be of a *chose in action*, bare right, or possibility. And in a case in Lord Hobart's Reports, it was said, that although * a man may, by grant or assignment, assign all the [* 175] wool then growing on the backs of the sheep owned by him; yet he cannot grant or assign the wool that shall grow upon the backs of the sheep he shall hereafter buy.¹ And this doctrine was fully recognized by Lord Eldon in the case of Curtis v. Amber, 1 Jac. & Walk. 506, 512. But I need not dwell on this point, because it came under the full consideration of the Court in Mitchell v. Winslow, (2 Story, R. 630, 639 to 644,) where the principal authorities were collected and commented upon at large; so that the only remedy for the licensee or assignee, where a grant or assignment has been made to him and his heirs, of a right to a thing not then in existence, but which is to operate *in futuro*, when the thing is created or comes *in esse*, is in equity, by way of specific enforcement of a covenant or contract.²

Now, it appears to me, that this doctrine is expressly ap-

¹ Grantham v. Hawley, Hob. R. 132.

² See 2 Story, Eq. Jur., § 1040 to § 1041, 3d edit.

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plicable to licenses and assignments under the Patent Act of 1836, and, indeed, as I think, *à fortiori* applicable, because the whole design of the 18th section of the act, providing for renewed patents, is, in terms, exclusively confined to the original inventor, and to be for his sole benefit, and not for the benefit of his licensee or assignee; and, therefore, that section is to receive a correspondent construction in favor of the inventor alone, unless the particular clause of the section, which I shall presently consider, does, by natural or necessary implication, confer the right upon the licensee or assignee.

Let us then, for this purpose, examine the 18th section of the Patent Act of 1826. It enacts, that, whenever any patentee (not any assignee) shall desire an extension of his patent beyond the term of its limitation, he may make application therefor to the commissioner of the Patent Office, setting forth the grounds thereof; and then, after prescribing the notice, &c., to be given of the application, it pro-
[* 176] vides, that * the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury, shall constitute a board to hear and decidè upon the evidence produced before them for and against the extension; and the patentee is required to furnish to the board a statement in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficient to exhibit a true and faithful account of loss and profit accruing from or by reason of the said invention. The section then proceeds to declare, that "If, upon a hearing of the matter, it shall appear to the full and entire satisfaction of the board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, (not the assignee,) without neglect or fault on his part, having failed to attain from the use and sale of *his* invention a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and

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the introduction thereof into use, it shall be the duty of the commissioner to renew and extend the patent, by making a certificate thereon of such extension, from the term of seven years from and after the expiration of the first term, &c.; and therefore the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years." Now, bearing in mind that, at this time, no patent could by law issue except to the inventor, and that it was only by the subsequent Act of 3d of March, 1837, ch. 45, § 6, that it could be issued to the assignee, we have, at once, a perfect key to the true object and purpose of this 18th section of the Act of 1836, that the word "patentee" is used therein as equivalent to "inventor," and that the law looked to him as the sole object of its bounty, and meant to reward him, and him alone, for his time, ingenuity, and expense in perfecting his invention. Another consideration is also important to be borne in mind; and that is, that the 18th section refers solely to applications to be made before the original patent has expired. Indeed, the *very [* 177] proviso to the section contemplated, that the application not only may be, but must be made while the term of the original patent is yet running, and before it has expired; for it expressly declares "that no extension of a patent shall be granted after the expiration of the term for which it was originally issued." Now, keeping this in view, we see, at once, the object of the clause of the same section immediately preceding the proviso. It is in these words: "And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented *to the extent of their respective interest therein.*" The clause does not mean to enlarge the right of the assignees or grantees to use the thing patented beyond the extent of the interest originally granted to them. If that interest was, from its nature, or character, or just interpretation, limited to the original term, for which the in-

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ventor held the patent, then the assignees and grantees were to have no benefit *ultra* in the renewed patent. But if the original assignment or grant had expressed in terms, or by just implication conferred on the assignees or grantees a right or interest in the renewed patent, then that interest was to be protected; for it was a possibility, for the benefit of which the assignees or grantees had originally stipulated, and for which they must be presumed to have paid a valuable consideration. In this view of the matter, there would be good sense in the clause, founded upon the actual intentions of the parties to the original assignment or grant upon a just interpretation of the language used by them. But what is the consequence of adopting a different interpretation of the clause, and applying it indiscriminately to all cases of grants and assignments of or under the original patent, where no such auxiliary intentions can be deduced from the language of the assignment or grant? Let us suppose the case, where an assignment has been made by the inventor of his whole patent-right under his patent for a small, and (comparatively speaking) an utterly inadequate compensation, considering its real value, and this has been forced upon him by embarrassment, or poverty, or public indifference, or his own mistaken estimate of its value, (a case by no means uncommon in the history of inventors,) could it be for a moment imagined, that the 18th section intended, contrary to its professed object, to benefit, not the inventor himself, but his assignee? That the latter and not the former was to receive the whole profits accruing from the renewed patent? Or, that, in such a case, the inventor would not be entitled to take out a renewed or extended patent? And yet, if the argument be worth any thing, the 18th section applies, as fully to such a case, as it would apply to any other case; and we cannot except it from the pressure of the section, unless we look broadly into the objects, which it

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purports to accomplish, and limit the language to cases, where the inventor has intended to part, not merely with all his present rights, but prospectively with all the future rights and possibilities which he might acquire by a renewed or prolonged patent. Now, the words of the clause extend to the assignees and grantees of the right, (that is, of the patent-right,) the benefit of the renewal "*to the extent of their respective interest therein,*" that is, of the patent-right, and no more. Now, what is the extent of their interest therein? Clearly, upon the principles of the common law, neither more nor less than the assignor or the grantor then possessed, and was capable of assigning or granting at the time of the assignment or grant, for to that the language of the grant or assignment, must, in reason and good sense, be limited, unless the grantor or assignor has by express words or necessary implication shown a broader intention, an intention not merely to grant or assign the right, which he now possesses, but the possibilities, which he may hereafter acquire. And these are the best grounds to support such a limitation and interpretation of the grant or assignment.

In the first place, the grantor or assignor cannot be presumed to have received any compensation or consideration *except for the very thing, and to the [* 179], very extent, which the language properly indicates.

In the next place, no court is at liberty to add to the terms used any meaning beyond their ordinary import, unless there are some supplementary expressions to justify such a construction. In the present case, there is no ground to suppose, that either party contemplated, that the grant, or assignment, or license was to be prolonged beyond the term of the original patent, and there are no words requiring a more expanded interpretation. In the next place, to give such an expanded interpretation, for which the inventor has received no consideration, would be to transfer the bounty intended by the

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government for the benefit of the inventor, whose genius had brought it out, and brought it to perfection, and who had not received a reasonable remuneration therefor, to the grantee or assignee, who had paid nothing and done nothing to deserve it, but had simply given the *quid pro quo* to the extent of the right or interest conferred upon him under the existing patent. The inventor may, from necessity or expediency, or otherwise, (as has been already suggested,) have conveyed his whole right and interest under the original patent, for a sum utterly unworthy of its intrinsic value. The grantee or assignee may have grown rich by the success of the inventor, and the inventor himself may be now languishing in poverty. Can it be, that the section, professing to intend a remuneration and bounty to the inventor, should, at the same time, have intended to sweep from him the future profits of the renewed invention? That if he should have parted with the half, or two thirds, or the whole of his rights and interests, under the original patent, he shall be narrowed down to a corresponding part, or excluded from all the profits of the renewed patent? If so, it would be but another sad illustration of the fate of genius, *Sic vos non vobis*. Besides, we are to recollect, that this section of the Act of 1836, is not limited to cases of future patents, or to future [* 180] grants or assignments thereof; but * it applies to past also; and that the language, if applicable at all, reaches to both classes, the past, as well as the future; and the present case is one of the prolongation of a patent issued long before the Act of 1836. So that the section is thus made to apply to a case, where neither party could have contemplated any right of renewal, or any possibility of a future interest therein. The patentee had no right of renewal either *in esse* or *in posse*. The whole vested in the exercise of a sound discretion by Congress, which it would or might apply singly to the merits of each particular case, as it should be presented to them for consideration.

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Now, if we construe the language of this clause with reference to the scope of the antecedent language, and the professed objects of the section, however loose and general it may, at first view, seem to be, it admits of an easy and satisfactory exposition. The rights of assignees and grantees to use the thing patented, and to have the benefit of the renewal, is to be to the extent of their respective interests therein, and no more. If that interest was short of the whole of the original term, for which the patent was originally issued, it is not to reach the renewed term. If it was limited to the extent of the original term, it is still to be bounded by it. But if it is an interest in terms, designed to be coextensive with all the interest, which the patentee now has, or may hereafter acquire, not merely to his present rights *in esse*, but with his contingent rights *in posse*, then the section makes that a legal interest, which, otherwise, would be but a mere potential, equitable interest, to be enforced in equity, as a mere right under contract, and not as a fixed, present, vested interest. In this way, the whole structure of the section becomes harmonious with its professed objects, the benefit and remuneration of the inventor, and it saves only those rights in the renewed patent for which the inventor has already secured a compensation, and to which he has voluntarily extended his original grants, and assignments, and licenses to the

* very terms and intent thereof. Interpret the section [* 181] in any other manner, and it speaks an intention in one part, which it contradicts or controls in another. It takes from the inventor, what he never intended to part with, and may deprive him in part, or in the whole, according to circumstances, of the reward, which the section seemed so studiously to hold out to encourage his genius and skill, and to reimburse his expenditures.

These are some of the reasons, which have influenced my mind in arriving at the conclusion which I have before stated.

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If they are erroneous, it will belong to the Supreme Court to correct the errors, and to adopt a rule, which, adhering to a literal interpretation of the clause, may, at the same time, deprive the inventor of all motives to renew the patent, or make the renewal worthless to him, and injurious to the public.

JEREMIAH H. PIERSON v. THE EAGLE SCREW COMPANY.

[3 Story, 402. June T. 1844.]

To entitle a person to claim the benefit of the 7th section of the Patent Act of 1839, ch. 88, he must be a person, who is a purchaser, or who has used the patented invention before the patent was issued, by a license or grant, or by the consent of the inventor, and not be a purchaser under a mere wrong-doer.

The case of *McClurg v. Kingsland*, 1 How. Sup. Ct. R. 202, commented on and explained.

In causes for violation of a patent, the jury are at liberty to give such reasonable damages as shall vindicate the rights of the patentee, and shall indemnify him for all expenditures necessarily accrued in the suit beyond what the taxable costs will repay.

THIS was an action of the case brought by the plaintiff, as assignee of a patent "for an improvement in the machine for cutting the threads of wood and other screws," for an infringement of the patent. The patent under which the plaintiff claimed was taken out by one Henry Crum, as the inventor, and bore date November 14th, 1836. The assignment was made by Crum to the plaintiff on the 20th of January, 1838. No question was made at the trial as to the substantial identity of the machines used by the Eagle Screw Company, with the improvement patented by Crum, [* 403] which * improvement consisted mainly in a feeding-wheel, called the wheel (D,) in Crum's specifi-

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cation, of a tambourine shape, which supplied, with regularity and precision, the blanks to the cutters or dies, for the purpose of cutting the threads of the screws.

At the trial, *John P. Knowles* and *Richard W. Greene* for the defendants, rested their defence mainly upon two grounds. First, they denied that Crum was the original and first inventor of the feeding-wheel of the machine, and claimed to use it under a patent taken out for a similar cutting machine, which embraced a feeding wheel substantially the same, which patent was taken out by one Clement O. Read, on December 15th, 1837, and had been by mesne assignment vested in them. The testimony, however, clearly proved, that Crum was prior in time in his invention as well as in his patent; and, indeed, the counsel for the defendant, upon the coming in of the proof at the trial, did not contend before the jury for the priority of Read's invention, but rather, in reference to the question of damages, that it was an independent invention of Read's, prior to Crum's patent or application for a patent, though posterior in point of time to Crum's invention.

The second point of defence was, that the Eagle Screw Company had purchased a right to use a certain number of cutting machines, embracing the improvement in question, of the Providence Screw Company, as assignees of Read, an independent inventor, prior to Crum's application for his patent; and that, notwithstanding Crum was first inventor and patentee of the improvement, they had a right to use the machines actually in operation in their works, under and by virtue of the 7th section of the Patent Act of 1839, without accountability to Crum or his assignee.

They cited the case of *M'Clurg et al. v. Kingsland et al.*, (1 Howard's Sup. Ct. Rep. 202,) and insisted, that the opinion of the Supreme Court in that case, and, especially, that

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portion of it (pages 208, 209) in which they say, [* 404] "The * object of this provision (7th section of the Act, 1839) is evidently twofold. First, to protect the person who has used the thing patented, by having *purchased*, constructed, or made the machine, &c., to which the invention is applied, from any liability to the patentee or his assigns. Second, to protect the rights granted to the patentee against any infringement by any other person, &c."

Samuel Ames and *Seth P. Staples*, in behalf of the plaintiff contended, that the case cited was to be distinguished from the case at bar in this, that, in the case cited, the purchase of the machine or right was from *the first inventor and only patentee*, made, it is true, prior to his obtaining his patent, whereas in the case before the Court, the purchase by the defendant, was from one whose invention and patent were subsequent in point of time to the invention and patent of the plaintiff, and could vest no greater right than he had—and that the defence was therefore nothing more than the setting up a subsequent invention of patent against a prior invention and patent, which, if permitted to prevail, would operate as a virtual repeal of the Patent Law, and take away all protection from inventors. It was said, that the general language of the Court in *M'Clurg v. Kingsland* was of course to be construed in reference to the facts before them.

They farther contended, that *Crum's* patent, under which the plaintiff claimed, was taken out in 1836, nearly three years prior to the passage of the Act of 1839, and that rights had vested under it prior to that Act; and that, in the case of *M'Clurg v. Kingsland* the Court say, (page 206,) that Acts of Congress "may be retrospective in their operation, and that is not a sound objection to their validity; the powers of Congress to legislate upon the subject of patents is plenary by the terms of the Constitution, and as there are no restraints in its

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exercise, there can be no limitation of their rights to modify them at their pleasure, *so that they do not take away the rights of property in existing patents.*"

* In *M'Clurg v. Kingsland* the patent was de- [* 405] stroyed by public use of the thing patented prior to the application for the patent, and could be sustained only by the help of the seventh section of the Act of 1839, passed subsequently to the issuing of the patent. The same seventh section, which held up the patent in that case, killed the case itself; so that though retroacting, it could not be said in this case to take away the rights of property in existing patents.

STORY, J., in summing up to the jury, said: I have already in the course of the discussion at the bar had occasion to express my opinion upon the second point made at the bar, as a matter of law; for there is no dispute as to the facts. I shall now, therefore, merely recapitulate it. For the defendants the argument is, that the Eagle Screw Company had a right to use the machines purchased by them from Read before Crum's patent was obtained, although Crum was the prior and true inventor and patentee under the 7th section of the Patent Act of 1839, ch. 88; and great reliance is placed upon the case of *M'Clurg v. Kingsland*, 1 How. Court R. 202. In my opinion, neither the Act of Congress, nor the case of *M'Clurg v. Kingsland*, justifies such a doctrine. Supposing the argument to be well founded, what would be the legal result? Why, that a mere wrongdoer, who by fraud or artifice, or gross misconduct, had gotten knowledge of the patentee's invention before he could obtain his patent, without any *laches* on his part, could confer upon a purchaser under him — *bonâ fide* and without notice — a title to the patented machine, which he himself could not exercise or possess. Certainly there is no ground to say, that a person, who

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pirates the invention of any party prior in point of time and right, can make any valid claim thereto against the prior and true inventor. How, then, can he confer on others a title, which he himself does not possess? Upon general [* 406] principles, * the assignee can ordinarily claim no more than his assignor can lawfully grant.

But it is said, that the 7th section of the Act of 1839, ch. 88, declares, "That every person or corporation, who has or shall have purchased or constructed any newly-invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use and vend to others to be used the specific machine, manufacture, or composition of matter so made or purchased, without liability therefor to the inventor, or any other person interested in the invention; and no patent shall be held to be invalid by reason of such purchase, sale, or use, prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public, or that such purchase, sale, or prior use, has been for more than two years prior to such application for a patent." Certainly the language in the first clause of this section is very general, not to say loose, in its texture. But if it stood alone, a first interpretation of it might fairly lead to the conclusion, that the purchaser there spoken of was a purchaser, not from a mere wrongdoer, but from the first and true inventor, before he had obtained his patent. The language of the clause does not even include the qualification, that the purchaser should be a *bonâ fide* purchaser for a valuable consideration, without notice of the claim or title of the inventor, or of any fraud of the vendor upon that claim or title. Yet, surely, it could never have been the intention of this clause to confer on a fraudulent purchaser, or a purchaser with full notice, a right to use an invention pirated from the original inventor, by wrong. If, on the other hand, we interpret the language

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to mean a purchaser from the inventor himself, before his application for a patent, the omission of such qualifying words is at once material and consistent with the apparent objects of the section. But the remaining clauses of the section render this interpretation perfectly clear and right. These clauses point solely to the inventor, and demonstrate, that

* the purchaser before spoken of was a purchaser [* 407] from the inventor himself. The language is, "and no patent shall be held to be invalid by reason of any such purchase, sale, or use prior to the application for a patent, as aforesaid, except on proof of an abandonment of such invention, to the public.

Now, the inventor, and the inventor alone, is competent to abandon his invention to the public, and no use by the public except with his knowledge and consent can be deemed an abandonment of his invention to the public. It is, therefore, put as an exception carved out of the preceding words; and if the purchase, sale, or prior use were from or under the inventor, and with his consent and knowledge, the exception would have its appropriate effect. It is an exception *ejusdem generis*. The clause would then read in legal effect 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. Then follows the remaining clause: "Or that such purchase, sale, or prior use, has been for more than two years prior to such application for a patent;" which also imports another exception, limiting the right to make application for a patent to the period of two years after the inventor has sold or allowed his invention to be used by others. Any other construction of these clauses would lead to this extraordinary conclusion, that the inventor would be deprived of the benefit of his invention and his right to a patent without any *laches*, or misconduct on his own part, by the mere acts of a wrong-

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doer without his knowledge or against his will; and the exceptions, in a practical sense, would become nullities. But construed, as we construe them, and they have a plain, appropriate, and satisfactory meaning. This view of the matter is in entire coincidence of the whole theory and enactments of all the other Patent Acts, and with the judicial interpretations, which have been constantly put upon them. It

has been the uniform doctrine of the Courts of the [* 408] United States, * that no fraudulent or wrongful use of an invention, and no public use without the consent or knowledge or sanction of the inventor, would deprive him of his right to a patent.¹

The case of *M'Clurg v. Kingsland*, 1 How. Sup. Ch. R. 202, properly considered, contains nothing in conflict with this doctrine. The learned judge (Mr. Justice Baldwin) who delivered the opinion of the Court, in commenting upon the 7th section of the Act of 1839, said: "The object of this provision is evidently twofold; first, to protect the person, who used the thing patented by having purchased, constructed, or used the machine, &c., to which the invention is applied, from any liability to the patentee, or his assignee; second, to protect the rights granted to the patentee against any infringement by any other persons." This language is certainly general; but then, in order to understand it correctly, we must apply it to the very case then before the Court; and in this view, it was perfectly accurate and appropriate. What was that case? It was a case, where the patentee, before he attained his patent, allowed the defendants to use for their

¹ See *Pennock v. Dialogue*, 2 Peters Sup. Ct. R. 1, Vol. I. 542; *Grant v. Raymond*, 6 Peters Sup. Ch. R. 248, 249, Vol. I. 604; *Shaw v. Cooper*, 7 Peters Sup. Ch. R. 292, Vol. I. 643; *McClurg v. Kingsland*, 1 How. Sup. Ch. R. 202, 207, *ante*, 105. See Act of 3d July 1832, ch. 162, sec. 3; Act of 1836, ch. 357, sec. 15, Appendix, Vol. II.

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own profit the very improvements invented by him ; and indeed, the improvement was invented by the patentee, while he was in their employment and receiving wages from them, and he freely allowed them to use it. Afterwards, the assignee of the patentee brought the suit against the defendants for using the improvement after the patent was granted. The Circuit Court held, that the facts justified the jury in presuming, that the defendants used the improvement under a license or privilege originally granted to them by the inventor, and that the facts of the case brought it directly within the 7th section of the Act of 1839. Mr. Justice Baldwin presided in the Circuit Court at the trial, and he also delivered the opinion in * the Supreme Court. So that, putting [* 409] both opinions together on the points in controversy, it is plain that the learned judge, by the language above stated, meant to affirm no more than that where the invention had, before the patent, been used under a license or grant of the patentee, that license or grant being a purchase, or sale, or use with the consent of the patentee, was within the provision of the 7th section of the Patent Act of 1839. It seems to us, that no reasonable objection exists to this doctrine; and it is in conformity to and in illustration of the very doctrine already stated by us as the true meaning of the section.

Indeed, the context immediately following the passage here cited from the opinion of the learned judge, shows this to have been his meaning. In the former part of the opinion he had endeavored to show, that, under the prior acts of Congress, if the patentee allowed not merely the public use, but even a free individual use of his invention before he obtained a patent, that would deprive him of his right to a patent; and that the 7th section of the Act of 1839 was intended to cure this inconvenience and defect in the law. "This," [section] says the learned judge, "relieved him (the patentee) from the effect of the former laws and their constructions by this Court,

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&c., &c., 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 to use his invention; which, if given before the application for a patent, would justify the continued use after it issued without liability." So that here we have expressed in a pointed manner the true object and intent of the 7th section of the Act of 1839, which was to give validity to the patent, and yet to secure to a purchaser from him before the patent, the same right to use the same after the patent which he previously possessed.

The other point of the defence is so completely met by the evidence, that it is unnecessary to comment on it. It seems to be admitted that the evidence is too strong in [* 410] favor of the * plaintiff, and against the defendant, to admit of any reasonable doubt; and accordingly the counsel for the defendants, considering the law upon the other point ruled against them, have confined themselves mainly in the closing argument to the question of damages. I shall leave the whole evidence for your consideration without remark. But upon the question of damages I would upon this occasion state, (what I have often ruled before,) that if the plaintiff has established the validity of his patent, and that the defendants have violated it, he is entitled to such reasonable damages as shall vindicate his right, and reimburse him for all such expenditures as have been necessarily incurred by him beyond what the taxable costs will repay, in order to establish that right. It might otherwise happen, that he would go out of Court with a verdict in his favor, and yet have received no compensation for the loss and wrong sustained by him. Indeed, he might be ruined by a succession of suits, in each of which he might, notwithstanding, be the successful party, so far as the verdict and judgment should go. My understanding of the law is, that the jury are at liberty, in the exercise of a sound discretion, if they see fit, (I do not say

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that they are positively and absolutely bound under all circumstances) to give the plaintiff such damages, not in their nature vindictive, as shall compensate the plaintiff fully for all his actual losses and injuries occasioned by the violation of the patent by the defendants.

Verdict for the plaintiff, \$2,000.

HENRY BOYD v. HENRY M'ALPIN.

[3 McLean, 427. July T. 1844.]

Under the eleventh section of the Act of 1836, respecting patent-rights, the patentee may assign any part of his patent so as to vest in the assignee the legal right.

By the same section every assignment of a patent-right is required to be recorded in three months from the time of its execution.

A failure to record such patent assignment does not forfeit the right of the assignee.

Should the same right be assigned, after the expiration of the three months, to a stranger, the assignee would hold it, whether he had or had not notice of the previous assignment.

The sale of the product of a patented machine is not an infringement of the patent.

But, if the person who sells is connected with the use of the machine, he is responsible for damages and may be enjoined.

And this may be done where the Court have jurisdiction of the person, although the machine may be used beyond the jurisdiction of the Court.

Kenna appeared for the plaintiff.

Storer for the defendant.

OPINION OF THE COURT.

IN his bill the plaintiff represents that he holds by assign-

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ment the exclusive right, within the county of Hamilton, * in this State, to make and sell "a new and useful improvement in the machine for cutting screws on the ends for the rails of bedsteads," patented to Lindley. And he charges that the defendant, Henry M'Alpin, in connection with one William Brown of Lawrenceburgh, county of Dearborn, and State of Indiana, in disregard of the complainant's right, constructed, and has now in operation in the said town of Lawrenceburgh, one or more machines, in all the material parts thereof substantially like and upon the plan and arrangement and contrivance of the machines invented, improved, patented, and put in operation by the said Lindley, and described in said letters-patent." And the bill prayed for an injunction to restrain the said M'Alpin from using said machine or selling the product thereof.

On the filing of the bill a motion is made for an injunction, until the final hearing, &c. And on the argument of this motion it is objected to the defendant's title, that two of the assignments which he claims were not recorded within the time limited by the Act of Congress, and that they are, consequently, void.

By section 11, of the Act of 1836, the patentee may assign any part of his patent, which assignment shall vest in the assignee the legal right to such part. And the same section provides, "that every such assignment shall be recorded in the Patent Office, within three months from the execution thereof."

In the case of *Dobson v. Campbell*, 1 Sum. 319, Mr. Justice Story held, that, under the fourth section of the Act of 1793, "the recording of the assignment was indispensable to convey the right." The words of that section are, "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." After

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the recording, by the words of that act, the right vested in the assignee ; of course it could not * vest [* 429] before the recording. But the Act of 1836 affixes no penalty or condition, on a failure to have the assignment recorded in three months. That the assignment takes effect from its date is clear, and if it be not recorded in three months, the act imposes no forfeiture. In this aspect, the question must be considered as between the assignor and the assignee. And it is not perceived how any sound construction of the act can cause the right to revert to the assignor, if the assignee fail to record the assignment within three months. After the expiration of three months, no record having been made of the assignment, if another assignment of the same right shall be made, the last assignment would be valid. The doctrine of notice, as applied to land titles, could not operate in such a case. There is no exception in the statute, as to purchasers without notice. And this seems to me to be the proper effect to be given to the act.

It is insisted that a sale of the thing manufactured by the patented machine, is a violation of the patent. But this position is wholly unsustainable. The patent gives "the exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement." A sale of the product of the machine, is no violation of exclusive right to use, construct, or sell the machine itself. If, therefore, the defendant has done nothing more than purchase the bedsteads from Brown, who may manufacture them by an unjustifiable use of the patented machine, still the person who may make the purchase from him has a right to sell. The product cannot be reached, except in the hands of one who is in some manner connected with the use of the patented machine.

There are several patents of mills for the manufacture of flour. Now, to construct a mill patented, or to use one, would be an infringement of the patent. But to sell a barrel of flour

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manufactured at such mill, by one who had purchased it at the mill, could be no infringement of the patent.

[* 430] * And the same may be said of a patented stove, used for baking bread. The purchaser of the bread is guilty of no infringement. But the person who constructed the stove, or who uses it, may be enjoined, and is liable to damages. These cases show, that it is not the product, but the thing patented, which may not be constructed, sold, or used. This doctrine is laid down in *Keplinger v. De Young*, 10 Wheat. 358. In that case watch chains were manufactured by the use of a patented machine, in violation of the right of the patentee; the defendant, by contract, purchased all the chains so manufactured, and the Court held, that as the defendant was only a purchaser of the manufactured article, and had no connection in the use of the machine, that he had not infringed the right of the patentee.

But in the case under consideration, the bill charges that the defendant, in connection with Brown, constructed the machine patented; and that they use the same in making the bedsteads which the defendant is now selling in the city of Cincinnati. If this allegation of the bill be true, the defendant is so connected with the machine in its construction and use as to make him responsible to the plaintiff. The structure and use of the machine are charged as being done beyond the jurisdiction of the Court, but having jurisdiction of the person of the defendant, the Court may restrain him from using the machine and selling the product. When the sale of the product is thus connected with the illegal use of the machine patented, the individual is responsible in damages, and the amount of his sales will, in a considerable degree, regulate the extent of his liability.

Whether, if the defendant acts as a mere agent of Brown, who constructed the patented machine and uses it in Indiana in making bedsteads, is responsible in damages for an infringe-

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ment of the patent and may be enjoined, is a question which need not now be determined. Such a rule would, undoubtedly, be for the benefit of Brown, who, according to * the bill, had openly and continually violated the [* 431] patent in the construction and use of the machine. There are strong reasons why the interest of the principal should, by an action at law, and also by a bill in chancery, be reached through his agent. Injunction allowed, &c.

BROOKS & MORRIS v. STOLLEY.

[3 McLean, 523. April T. 1845.]

The Circuit Court of the United States has no jurisdiction to enforce the specific execution of a contract for the use of a patent-right, where the parties live in the State where suit is brought; but they may, by injunction, protect the right of the patentee or his assignee from infringement.

If a license to use a patented machine be conditional, the conditions must be performed, or there can be no right to the use.

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

There is no pretence of right, under the license, in such a case, and the question must be considered as though no license had been granted.

When a license to use a patented planing machine was granted, on rendering a weekly account of the boards planed, and paying on each thousand feet planed one dollar and twenty-five cents, and other conditions, the payment must be made weekly, &c., to authorize the use. Any alleged failure by the patentee or his assignee, under the contract of license, will not authorize the use, unless the defendant has done every thing in his power to perform the contract. In such a case there is no adequate remedy at law.

As the defendant justifies under the license, he must show the performance of the conditions of the grant.

A party claiming a right under a contract, must take it as agreed to by the parties.

Equity will direct the cancellation of a contract for fraud or mistake, but it cannot alter the contract.

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Jurisdiction being acquired, on the ground of infringement, the Court may settle other matters between the parties in the case, which do not afford original ground of jurisdiction.

The defendant will be enjoined except on the terms of the license.

Under the circumstances, the failure of the defendant cannot be considered as an abandonment of the license. •

Wright and Coffin, for the complainants.

Walker for the defendant.

OPINION OF JUDGE McLEAN.

THIS is an application at Chambers for an injunction to restrain the defendant from using a certain planing machine, claimed by the complainants under Woodworth's patent. In their bill, the complainants set out the obtainment [* 524] of the * original patent by Woodworth, and the renewal of it by his administrator, the 16th November, 1842, all of which proceedings are alleged to be formal and valid ; and they further state that they are the assignees of the patent for Hamilton county, Ohio, and other territory, as specified in the assignment ; that in the above county, they have had for a long time the machine in operation and that the defendant, having full knowledge of this, applied for a license to run said machine in Hamilton county, which was granted by the complainants, agreeably to the terms of a sealed contract, dated the 11th of September, 1843 ; that, by the contract, defendant bound himself to pay to the complainants one dollar and twenty-five cents for every thousand feet of boards he should plane, to be paid on Monday of every week, and that he should render an account, if required, under oath, and also should keep books, to which the complainants should have access, and in which the boards planed should be entered ; that the defendant should require payment in cash before the boards planed, except those planed for himself, should be

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taken out of his possession ; that, for a short time, the defendant complied with the contract by making payment, &c., but for some time past he has utterly refused to make the stipulated payments to the complainants, and in other respects has refused to be governed by the contract, although he still continues to run the machine ; and on this ground an injunction is prayed, &c.

The defendant admits the obtainment, renewal, and assignment of the patent, as stated by the complainants ; but he denies the validity of the renewed patent. He denies that he has refused to render an account of the plank planed, or that he has rendered a false account. His books, he alleges, have always been accessible to the complainants, but he admits the failure to make payment, and he avers that the complainants have, in several respects, violated * the [* 525] contract on their part ; that he was deceived as to the import of certain parts of the contract, &c., and he insists that the complainants have ample remedy at law, &c. The application is made on the bill and contract referred to ; and on these it must be considered, in connection with the answer.

In the argument, an objection is made to the jurisdiction ; and this will be first examined.

It is suggested, that, as the whole controversy in the case arises under the contract of license, the parties to which being citizens of this State, the federal court cannot take jurisdiction. The objection would be unanswerable, if no right were involved in the controversy, except what arises out of the contract ; as, for instance, the Circuit Court could take no jurisdiction under the contract of an action, merely to recover the sums agreed to be paid by the defendant ; but, in the present aspect of the case, it is not limited to the contract. The complainants set up their right under the patent, and allege that the defendant is infringing that right ; that the license

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affords no justification whatever to the defendant. The right then of the complainants to an injunction, is not founded by them on the contract, but on the assignment of the patent. If the object of the bill were merely to enforce a specific execution of the contract, the Circuit Court of the United States could exercise no jurisdiction in the case.

It must be admitted that the contract constitutes an important part of the case. Except on the ground that the patent is invalid, under which the complainants claim, there is no pretence of right by the defendant to use the machine, unless he derives it from the contract. In this view, the contract must be considered as a license to the defendant, and its terms must be construed.

As the validity of Woodworth's patent, and the assignment to the complainants, as far as regards the right to an injunction, has been heretofore considered and decided, [* 526] on *this motion that question will not be examined. It may not be improper, however, to suggest, whether the defendant, having acknowledged the validity of the complainants' right, under his hand and seal, is not estopped now from denying it. If in this admission he was misled, and on that ground contends that he is not bound by it, he must repudiate the contract, and claim nothing under it. He cannot claim that part of the contract which may be favorable to his interest, and reject that which operates against him.

The defendant admits that he has failed to make payment, which is the important fact of the agreement, as it constituted the only motive which the complainants could have had to enter into the agreement. But as the weekly payments may be enforced at law, it is contended that the remedy is at law, and not in equity. Whatever right the defendant can have to run the machine, arises under the contract; and the payment of the consideration is the foundation

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of that right. Can he claim a benefit under a contract which he has refused to perform ?

The defendant by the agreement was to use the machine, in the language of the writing, "on conditions hereinafter mentioned." The weekly payments, planing for cash only, no credit, &c., &c., being stated, the contract proceeds: "now in consideration of the propositions aforesaid, to wit, that the said John Stolley shall pay said Brooks & Morris one dollar and twenty-five cents for each and every thousand feet of boards he may plane, payable on Monday of every week, &c., and shall do the other things stipulated, the said Brooks & Morris license said Stolley the right of running either of his two machines provided he does not run both at the same time, &c., and provided also he shall keep and perform on his part all the stipulations aforesaid."

Now the terms of the contract make the performance of its stipulations by the defendant a condition to his continued use of the machine; and if the words of the contract did not import, and indeed clearly sustain this view, equitable * considerations, arising from the nature of the [* 527] contract, would require such a construction of it.

The payment is to be made weekly. Could any reasonable construction of the contract give the right to run the machine by the defendant, in default of such payment? The frequent settlement and payments show that longer indulgence was not intended by the parties, and a remedy at law would be no adequate relief to the complainants. To enforce the payments by legal means, would require a weekly suit; and this would subject the complainants to inconvenience, delay, and expense, which would nearly, if not quite, be equal to the amount recovered. Such a construction of the agreement would be as inequitable as the remedy proposed would be inadequate.

If the defendant claims any right under the contract, he

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must show that he has done every thing on his part, which in equity he can be required to do, to entitle him to the right asserted. He has a license to use the machine on certain conditions ; but it does not follow that he may use it without conditions. The alleged violation of the contract by the complainants, does not help the equity of the defendant. He asks a specific execution of the contract, for he justifies under it. Can he do this on the ground that the complainants have given a license to others to use Woodworth's patent, in violation of the agreement? In admitting his failure to make the weekly payments, he, in effect, admits that he has done nothing to entitle him to the use of the machine.

The complainants, in the close of the contract, reserve the right, under certain circumstances, to give other licenses. This the defendant avers was not understood by him, and that he was overreached by it. If the defendant be dissatisfied with the contract, he has only to abandon it. He is under no obligation to run the machine. But if he do run it, he must conform to the conditions on which the right to do so was granted.

[* 528] * The complainants invoke the aid of equity, not to decree a specific execution of the contract, but to protect their rights as assignees of the patent. This right they allege has been infringed. The defendant relies on the license contained in the contract; but having failed to make the weekly payments, he has no pretence of right to run the machine. To entitle himself to the benefit of the license, it is incumbent on the defendant to do all which he is bound to do ; and then, if he fail in the strict performance, by reason of the act of the complainants, he will be equally entitled to the use of the machine, as if he had literally and fully performed his part of the contract, — as if he had tendered the weekly payments, having kept a regular account, and the complainants

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refused to receive the money, the defendant's right could not be questioned. But he has failed either to make or tender these payments. He, therefore, can have no standing or claim in law or equity, either to the use of the machine or to damages from the complainants.

A question is made whether the failure of the defendant to make the weekly payments operates as a forfeiture of the contract. There is no condition of forfeiture in the contract. Whether it has been abandoned by the defendant must depend upon the circumstances of the case. A Court of Chancery will not decree the cancelment of a contract, except for fraud or mistake. In this case, the party who has violated the contract, and complains of its unfairness, claims the benefit of it. A Court of Equity, as well as a Court of Law, must act upon a contract as it is; or, for sufficient reasons, Chancery will direct it to be delivered up and cancelled.

The right claimed by the complainants is an equitable right, which is protected by the exercise of the extraordinary jurisdiction of a Court of Chancery; and in this view, it is of no importance whether the alleged violation is under the * pretence of a license or not. If the defendant [* 529] have no license to use the machine, as he is now using it, he is without right or excuse.

An injunction is prayed, which, in effect, will annul the contract. Now, although it may be admitted that the defendant, as the facts of the case stand, could not successfully invoke in his behalf the action of a Court of Equity or of law, yet, under the relief asked by the complainants, a somewhat different view may be taken. Are the complainants entitled to an absolute injunction, which shall annihilate the contract? It appears to me, that short of this, adequate relief may given. In this respect the case is altogether different from an ordinary case of infringement, where no contract has been made by the parties. In that case an absolute injunction is the only

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adequate relief; but, in the case under consideration, the complainants have licensed the defendant to use the patented right on certain conditions. If the use go beyond these conditions, there is an infringement, which must stand upon the general ground, unaffected by the contract; and as to such an use, the injunction should be absolute. On this ground the jurisdiction of this case is sustainable; and, having jurisdiction, the Court may decide other matters between the parties, which, of themselves, might not afford ground for the original exercise of jurisdiction.

Upon the whole, I will allow the writ prayed for, to enjoin the defendant for the use of the planing machine described in the bill, unless he shall pay, or offer to pay, to the complainants, one dollar and twenty-five cents for each and every thousand feet of boards he may have planed, the preceding week, every Monday, during the unexpired term of the patent; and unless he shall keep a regular account of the planing done, and permit the complainants to have access to the books, and unless the defendant shall also do the other things, which, by the contract, he is bound to do, as the conditions on which he is authorized to use the machine.

ETHAN ALLEN v. ORISON BLUNT, AND ANOTHER.¹

[3 Story, 742. May T. 1845.]

The decision of the Commissioner of Patents is conclusive as to the law and facts arising under an application for a patent, unless it be impeached for

¹ As to counsel-fees, see *Whittemore v. Cutter*, *ante*, Vol. I. 28; *Boston Manufacturing Co. v. Fiske et al.*, *ante*, Vol. I. 320. Also *Stimpson v. The Railroads*, *post*.

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fraud or connivance between him and the patentee; or unless his excess of authority be manifest on the face of the papers.

Where a particular authority is confided in a public officer, to be exercised in his discretion upon an examination of facts, of which he is the appropriate judge, his decision upon those facts, is, in the absence of any controlling provision, absolutely conclusive.

A verdict upon an issue, ordered by a Court of Equity, is not final upon the facts it finds, nor binding upon the judgment of the Court, unless it is sanctioned and adopted by the Court upon the subsequent hearing on the merits.

Quere — Whether a verdict in a suit at law, is evidence of any thing but the fact that it was rendered, unless a judgment be duly rendered thereon.

The Patent Act contemplates two classes of persons, as peculiarly appropriate witnesses in patent cases, namely: 1st. Practical mechanics, to determine the sufficiency of the specification as to the mode of constructing, compounding and using the patent. 2d. Scientific and theoretic mechanics, to determine whether the patented thing is substantially new in its structure and mode of operation, or a mere change of equivalents; and the second class is by far the higher and most important of the two.

CASE for infringing of a patent for “An improvement in the method of constructing locks for fire-arms.” Plea the general issue, with a special statement of matters of defence.

At the trial it appeared that the original patent was granted * on the 11th of November, 1837, and [* 743] was surrendered for some imperfections in the specifications, and a new amended patent was taken out on the 15th of January, 1841, which was again, for a like defect, surrendered, and a new, amended patent was taken out on the 3d of August, 1844.

Upon the opening of the defence, *Gray*, (with whom was *Dexter*,) for the defendants, took a preliminary objection, that the last (the present) patent was not good as an amended patent, for the specifications attached to the three patents were for different things and not for one and the same invention; and that consequently the Commissioner of Patents had

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exceeded his authority in granting the present patent, and he cited the 13th section of the Patent Act of 1836, ch. 357.

B. R. Curtis and *R. Choate*, for the plaintiff, contended, that the present patent was for the same invention as the two former; and they also insisted that the Commissioner of Patents was the proper judge of the matter, and his decision in granting the patent was conclusive.

STORY, J. The 13th section of the Patent Act of 1836, ch. 357, enacts, that whenever any patent shall be inoperative or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification, as his own invention, more than he had, or shall have a right to claim as new, if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the commissioner, upon the surrender to him of such patent, and the payment of the further duty of fifteen dollars, to cause a new patent to be issued for the same invention for the residue of the term then unexpired, for which the original patent was granted, in accordance with the patentee's corrected description and specification. Now the specification may be defective or insufficient either by a mistake [*744] of law, *as to what is required to be stated therein in respect to the claim of the inventor, or by a mistake of fact, in omitting things which are indispensable to the completeness and exactness of the description of the invention, or of the mode of constructing, or making or using the same. Whether the invention claimed in the original patent, and that claimed in the new amended patent, is substantially the same, is and must be in many cases a matter of great nicety and difficulty to decide. It may involve considerations of fact as well as of law. Who is to decide the question? The

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true answer is, the Commissioner of Patents ; for the law intrusts him with the authority, not only to accept the surrender, but to grant the new amended patent. He is bound, therefore, by the very nature of his duties, to inquire into and ascertain, whether the specification is definite or insufficient, in point of law or fact, and whether the inventor has claimed more than he has invented, and in each case, whether the error has arisen from inadvertency, accident, or mistake, or with a fraudulent or deceptive intention. No one can well doubt, that, in the first instance, therefore, he is bound to decide the whole law and facts arising under the application for the new patent. *Prima facie*, therefore, it must be presumed that the new amended patent has been properly and rightfully granted by him. I very much doubt whether his decision is or can be reëxaminable in any other place, or in any other tribunal, at least, unless his decision is impeached on account of gross fraud or connivance between him and the patentee ; or unless his excess of authority is manifest upon the very face of the papers ; as, for example, if the original patent were for a chemical combination, and the new amended patent were for a machine. In other cases, it seems to me, that the law, having intrusted him with authority to ascertain the facts, and to grant the patent, his decision, *bona fide* made, is conclusive. It is like many other cases, where the law has referred the decision of a matter to the sound discretion of a public officer, whose adjudication becomes conclusive. Suppose the Secretary of the Treasury * should [* 745] remit a penalty or forfeiture incurred by a breach of the laws of the United States, would his decision be reëxaminable in any Court of law upon a suit for the penalty or forfeiture ? The President of the United States is, by law, invested with authority to call forth the militia to suppress insurrections, to repel invasions, and to execute the laws of the Union ; and it has been held by the Supreme Court of the

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United States, that his decision as to the occurrence of the exigency, is conclusive.¹ In short, it may be laid down as a general rule, that, where a particular authority is confided to a public officer to be exercised by him in his discretion upon an examination of facts, of which he is made the appropriate judge, his decision upon these facts is, in the absence of any controlling provisions, absolutely conclusive as to the existence of those facts. My opinion, therefore, is, that the grant of the present amended patent by the Commissioner of Patents is conclusive as to the existence of all the facts, which were by law necessary to entitle him to issue it; at least, unless it was apparent on the very face of the patent itself, without any auxiliary evidence, that he was guilty of a clear excess of authority, or that the patent was procured by a fraud between him and the patentee, which is not patented in the present case.

The defence upon the merits turned upon two points :

(1.) That the defendants did not use the same combination as the plaintiff, and consequently there was no violation of his patent.

(2.) That the invention patented did not belong to the patentee, he not being the first inventor thereof.

In the course of the trial, the counsel for the defendant, in support of their defence, offered in evidence the record of a suit in equity between the same parties in the Circuit [* 746] Court *of the United States, for the district of New York, in which the Court had directed an issue upon the same points, which were now in controversy, and the jury found a verdict upon these points in favor of the defendants.

¹Martin v. Mott, 12 Wheat. R. 19.

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But it further appeared upon the record, that no further proceedings were had upon the verdict, and no hearing was had upon the merits of the case by the Court; but the plaintiff, by the leave of the Court, was allowed to dismiss his own bill without any final hearing thereon.

Curtis and *Choate*, for the plaintiff, contended that, under these circumstances, the record was not admissible as evidence. *Gray* and *Dexter*, for the defendants contended that it was, being a verdict upon the very points now in controversy.

STORY, J. My opinion is, that the record is not admissible as evidence. No hearing was ever had by the Court subsequently to the verdict, and no decree rendered upon the merits of the case. A verdict upon an issue ordered by a Court of Equity is, in no just sense, final upon the facts it finds, or binding upon the judgment of the Court. The Court may at its pleasure set it aside, and grant a new trial, or, disregarding it; may proceed to hear the cause and decide in contradiction to the verdict; or it may adopt the verdict, *sub modo*, and give it a limited effect only. But it can never be known what effect is given to the verdict, or whether any is given to it, until the subsequent hearing upon the merits, and a decree rendered thereon by the Court. Under such circumstances, it is plain to me, that this verdict is not admissible in evidence, for it has not been sanctioned or established by the Court, and without such sanction it is no proof of any fact, but that it was actually rendered in the case, and not proof of the facts found thereby. Indeed, I entertain great doubts, 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 rendered thereon; for [* 747] judgment may have been arrested therein, or a new

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trial granted ; and then the verdict would become a nullity.¹ But in a Court of Equity, the verdict, independent of the adoption and sanction of it by the Court, can establish nothing in the case.

The cause was afterwards argued to the jury upon the facts.

STORY, J., in summing up to the jury, said : There is one consideration applicable to the evidence, which has been much discussed by the learned counsel, and upon which it is proper that I should say a few words. It is as to the relative weight of the evidence of persons practically engaged in the trade, employment or business of the particular branch of mechanics to which the patent-right applies, and the evidence of persons who, although not practical artisans, are thoroughly conversant with the subject of mechanics as a science. It appears to me, that the Patent Acts look to both classes of persons not only as competent, but as peculiarly appropriate witnesses, but for different purposes. Two important points are necessary to support the claim to an invention : First, that it should be substantially new, as, for example, if it be a piece of mechanism, that it should be substantially new in its structure or mode of operation. Secondly, that the specification should express the mode of constructing, compounding, and using the same in such full, clear, 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." Now for the latter purpose, a mere artisan, skilled in the art with which it is

¹Phillips & Ames on Evidence, pt. 2, ch. 3, § 1, p. 618, edit. 1838. See Phillips on Evidence, by Cowen & Hill, vol. 3, note 729, p. 1070.

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connected, may in many cases be an important and satisfactory witness. If, as a mere artisan, he can, from the description in the specification, so make, construct, compound, and * use the same, it would be very cogent [* 748] evidence of the sufficiency of the specification.

Still, it is obvious, that although a mere artisan, who had no scientific knowledge on the subject, and who was unacquainted with the various mechanical or chemical equivalents employed in such cases, might not be able to make or compound the thing patented, from the specification ; yet a person who was skilled in the very science on which it depended, and with the mechanical and chemical powers and equivalents, might be able to teach and demonstrate to an artisan, how it was to be made or constructed, or compounded or used. *A fortiori* he would be enabled so to do, if he combined practical skill with a thorough knowledge of the scientific principles on which it depended. But upon the question of the novelty of an invention, and in reference to this, the identity or diversity of two or more machines, or compounds, it is obvious, that mere artisans, however well skilled in the mere details of their art, might be wholly incapable of giving a satisfactory answer ; when a person trained in the science to which it belonged, would, at a glance, ascertain whether the mechanical apparatus or chemical compound was identical in its composition and structure or not, or whether the differences consisted in the mere change of one known mechanical equivalent for another. In short, science alone would be able to answer the question whether or not a particular machine was substantially in its mode of operation new, or identical with another, although with apparent differences of form and structure, which might mislead the unscientific mind. The like considerations would apply to a chemical compound ; Sir Humphry Davy, for example, might, from his vast knowledge of the chemical affinities of different substances, be able to tell, what must be

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the effect of the combination thereof from their known qualities, and what what would be a mere change of known chemical equivalents without any exercise of the inventive powers, although he might, never perhaps have made the particular compound then before the Court. I should, therefore, [* 749] say to the jury, that * each of these classes of witnesses was important and competent for different purposes in causes respecting patents for inventions. But that the very highest witnesses to ascertain and verify the novelty of an invention, and the identity or diversity of mechanical apparatus and contrivances and equivalents, were, beyond all question, all other circumstances being equal, scientific mechanics ; that they were far the most important and most useful to guide the judgment, and to enable the jury to draw a safe conclusion, whether the modes of operation were new or old, were identical or diverse.

The judge then proceeded to sum up the facts, and left them to the jury. The jury, not being able to agree upon a verdict, were discharged.

WILLIAM W. WOODWORTH, ADMINISTRATOR, AND OTHERS,
v. JOEL STONE.

[3 Story, 749. May T. 1845.]

An injunction granted on an original bill, before the surrender of a patent, cannot be maintained upon the new patent, unless a supplemental bill be filed, founded thereon.

A patentee cannot, by a surrender of his patent, affect the rights of third persons, to whom he has previously assigned his interest in the whole or a part of the patent, unless the assignees consent to the surrender.

To support an action at law for the breach of a patent, it is indispensable to

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prove a breach before the action is brought; but, if the patent-right be admitted or established, a bill in equity *quia timet* will lie for an injunction, upon well-grounded proof of any apprehended intention of the defendant to violate it.

The decision of the Commissioner of Patents in respect to accepting a surrender of an old patent, and granting a new one, is not reëxaminable elsewhere, unless it appear on the face of the patent, that he has exceeded his authority.

THIS was the case of a bill in equity, brought for an infringement of what is commonly called Woodworth's Planing Machine. The bill prayed for an injunction and other * relief. Upon an interlocutory hearing [* 750] a temporary injunction was granted by the district judge.

Pending the proceedings, the patent was surrendered on account of a defect in the specification, and a new patent was granted; and upon this new patent a supplemental bill was filed against the defendant for the continuance of the injunction and other relief.

Giles, for the defendant, now moved to dissolve the original injunction; and contemporaneously, *B. R. Curtis*, for the plaintiff, moved for the continuance of the injunction upon the supplemental bill.

Various objections were urged for the defendant against the motion for the continuance of the injunction on the supplemental bill, and the surrender of the old patent was relied upon in support of the motion to dissolve the injunction granted on the original bill.

These objections were replied to on behalf of the plaintiff, and the propriety of continuing the injunction insisted on. It is not, however, necessary to repeat the arguments, as they are sufficiently stated in the opinion of the Court.

STORY, J. If the present case had stood merely upon the original bill, it appears to me clear, that the motion to dissolve

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the injunction granted upon that bill, ought to prevail, because, by the surrender of the patent, upon which that bill is founded, the right to maintain the same would be entirely gone. I agree that it is not in the power of the patentee, by a surrender of his patent, to affect the rights of third persons, to whom he has previously, by assignment, passed his interest in the whole or a part of the patent, without the consent of such assignees. But, here, the supplemental bill admits, that the assignees, who are parties to the original and supplemental bill, have consented to such surrender. They have, therefore, adopted it; and it became theirs in the [* 751] same *manner as if it had been their personal act, and done by their authority.

The question, then, is precisely the same, as if the suit were now solely in behalf of the patentee. In order to understand with clearness and accuracy some of the objections to the continuance of the injunction, it may be necessary to state, that the original patent to William Woodworth, (the inventor,) who is since deceased, was granted on the 27th of December, 1828. Subsequently, under the 18th section of the Act of 1836, ch. 357, the Commissioner of Patents, on the 16th of November, 1842, recorded the patent in favor of William W. Woodworth, the administrator of William Woodworth, (the inventor,) for seven years from the 27th of December, 1842. Congress, by an act passed at the last session, (Act of 26th February, ch. 27,) extended the time of the patent for seven years from and after the 27th of December, 1849, (to which time the renewed patent extended); and the Commissioner of Patents was directed to make a certificate of such extension in the name of the administrator of William Woodworth, (the inventor,) and to append an authenticated copy thereof to the original letters-patent, whenever the same shall be requested by the said administrator or his assigns. The Commissioner of Patents, accordingly, on the 3d of

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March, 1845, at the request of the administrator, made such certificate on the original patent. On the 8th day of July, 1845, the administrator surrendered the renewed patent granted to him "on account of a defect in the specification." The surrender was accepted, and a new patent was granted on the same day to the administrator, reciting the preceding facts, and that the surrender was "on account of a defective specification," and declaring that the new patent was extended for fourteen years from the 27th of December, 1828, "in trust for the heirs at law of the said W. Woodworth, (the inventor,) their heirs, administrators, or assigns."

Now, one of the objections taken to the new patent is, that *it is for the term of fourteen years, [* 752] and not for the term of seven years, or for two successive terms of seven years. But it appears to me that this objection is not well founded, and stands *inter Apices juris*; for the new patent should be granted for the whole term of fourteen years from the 27th of December, and the legal effect is the same as it would be, if the patent was specifically renewed for two successive terms of seven years. The new patent is granted for the unexpired term only, from the date of the grant, namely, for the unexpired period existing on the 8th of July, 1845, by reference to the original grant in December, 1828. It is also suggested, that the patent ought not to have been in trust for the heirs at law of the said W. Woodworth, their heirs, administrators, or assigns." But this is, at most, a mere verbal error, if indeed it has any validity whatsoever; for the new patent will, by operation of law, enure to the sole benefit of the parties, in whose favor the law designed it should operate, and not otherwise. It seems to me that the case is directly within the purview of the 10th and 13th sections of the Act of 1836, ch. 357, taking into consideration their true intent and objects.

Another objection urged against the continuation of the

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injunction is, that the breach of the patent assigned in the original bill can have no application to the new patent, and there is no ground to suggest, that, since the injunction was granted, there has been any new breach of the old patent, or any breach of the new patent. But it is by no means necessary, that any such new breach should exist. The case is not like that of an action at law for the breach of a patent, to support which it is indispensable to establish a breach before the suit was brought. But in a suit in equity, the doctrine is far otherwise. A bill will lie for an injunction, if the patent-right is admitted or has been established, upon well-grounded proof of an apprehended intention of the defendant to violate the patent-right. A bill, *quia timet*, is an ordinary [* 753] * remedial process in equity. Now, the injunction already granted, (supposing both patents to be for the same invention) is *prima facie* evidence of an intended violation, if not of an actual violation. And the affidavit of James N. Buffum is very strong and direct evidence to this same effect.

But the most material objection taken is, that the new patent is not for the same invention as that which has been surrendered. And certainly, if this be correct, there is a fatal objection to the prolongation of the injunction. But is the objection well founded in point of fact? It is said, that the present patent is for a combination only, and that the old patent was for a combination and something more, or different. But I apprehend that, upon the face of the present patent, the question is scarcely open for the consideration of the Court; and, at all events, certainly not open in this stage of the cause. I have already, in another cause, had occasion to decide, that where the Commissioner of Patents accepts a surrender of an old patent and grants a new one, under the Act of 1836, ch. 357, his decision, being an act expressly confided to him by law, and dependent upon his judgment, is not

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reëxaminable elsewhere ; and that the Court must take it to be a lawful exercise of his authority, unless it is apparent upon the very face of the patent, that he has exceeded his authority, and there is a clear repugnancy between the old and the new patent, or the new one has been obtained by collusion between the commissioner and the patentee. Now, upon the face of it, the new patent, in the present case, purports to be for the same invention and none other, that is contained in the old patent. The avowed difference between the new and the old, is, that the specification in the old is defective, and that the defect is intended to be remedied in the new patent. It is upon this very ground, that the old patent was surrendered and the new patent was granted. The claim in the new patent is not of any new invention ; but of * the old invention more perfectly [* 754] described and ascertained. It is manifest that, in the first instance, the commissioner was the proper judge whether the invention was the same or not, and whether there was any deficit in the specification or not, by inadvertence, accident, or mistake ; and consequently, he must have decided that the combination of machinery claimed in the old patent was, in substance, the same combination and invention claimed and described in the new. My impression is, that at the former trial of the old patent before me, I held the claim substantially (although obscurely worded) to be a claim for the invention of a particular combination of machinery for planing, tonguing, and grooving, and dressing boards, &c. ; or, in other words, that it was the claim of an invention of a planing machine or planing apparatus such as he had described in his specification.

It appears to me, therefore, that *primâ facie*, and, at all events, in this stage of the cause, it must be taken to be true, that the new patent is for the same invention as the old patent ; and that the only difference is, not in the invention

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itself, but in the specification of it. In the old, it was defectively described and claimed. In the new, the defects are intended to be remedied. Whether they are effectually remedied is a point not now properly before the Court. But as the Commissioner of Patents has granted the new patent as for the same invention as the old, it does not appear to me, that this Court is now at liberty to revise his judgment, or to say, that he has been guilty of an excess of authority, at least, (as has been already suggested,) not in this stage of the cause; for that would be for the Court of itself to assume to decide many matters of fact, as to the specification, and the combination of machinery in both patents, without any adequate means of knowledge or of guarding itself from gross error. For the purpose of the injunction, if for nothing else,

I must take the invention to be the same in both [* 755] patents, * after the Commissioner of Patents has so decided, by granting the new patent.

Upon the whole, therefore, I do order and direct, that the injunction do stand continued, as to the new patent, stated in the supplemental bill, until the hearing or farther order of the Court.

BRYCE v. DORR AND JONES.

[3 McLean, 582. June T. 1845.]

A patent-right is infringed, by making the thing patented, though employed by another to do so.

But where the thing was made without the knowledge of its having been patented, more than nominal damages should not be given.

Douglass for plaintiff.

Joy & Porter for defendants.

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OPINION OF THE COURT.

THIS action is brought for the violation of a patent-right, by the defendants, in casting at their foundery water-wheels for mills.

* It was proved that several wheels were cast on [* 588] the same principle of the plaintiff's patent. The model was furnished by Sage. Only two wheels were cast after the defendants came to the knowledge of the plaintiff's patent.

As the defendants were employed by Sage to cast the wheels, it was insisted that the action should have been brought against him, and was not maintainable against the defendants. But the Court held the defendants were liable for an infringement of the patent. But, as the defendants had *cast but a few wheels*, and, with the exception of two of them, had acted without a knowledge of the plaintiff's right, they suggested to the jury that nominal damages were all that the plaintiff could demand. Nominal damages were found.

WILLIAM C. DAVOLL AND OTHERS v. JAMES S. BROWN.

[1 Woodbury and Minot, 53. October T. 1845.]

It is the duty of the Court, rather than the jury, to construe the language used in a specification of a patent, if no parol evidence is offered in explanation, or none which is contradictory.

A patent is not to protect a monopoly of what existed before and belonged to others, but to protect something, which did not exist before, and which belongs to the patentee.

A construction of patents, liberal for the patentees, is proper. But the description of the patent must be so certain, as to be understood by those acquainted with the subject-matter.

But the whole of the specification, as well as the summary and the drawings, are generally to be examined and compared, and not one alone looked to, in

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order to decide what new part or new combination is claimed to be invented and protected.

In coming to a result, practical views, rather than subtle distinctions, must govern.

THIS was an action on the case for a violation of a patent-right, owned by the plaintiffs, for an improvement in the speeder for roving cotton.

[* 54] * The letters-patent were averred to have issued May 19th, 1843.

The general issue was pleaded, and notices given of several defences, all of which at the trial here at this term were found by the jury against the defendant.

He then moved for a new trial, on account of a supposed misdirection by the Court to the jury, in relation to the specification, a copy of which is annexed.¹

¹ The Schedule referred to in these Letters-Patent, and making part of the same.

To all whom it may concern. Be it known, that I, William C. Davoll, of Fall River, in the county of Bristol, and State of Massachusetts, have invented certain new and useful improvements in the machine known by the name of Speeder, Double Speeder, or Fly-frame, used for roving cotton, preparatory to spinning, and I do hereby declare that the following is a full and exact description thereof:—My main improvement consists in the manner in which I arrange the spindles, in two rows, by means of which arrangement only about one half the room is required to receive the same number of spindles; the operator can also attend to a greater number than usual; much less power will be required to put them in motion; the cost per spindle will also be much less, the double row requiring but little more gearing than a single row, and the machine will bear running at a much higher velocity than the English Fly-frame. In the accompanying drawing, figure 1 represents an end view of the machine, and figure 2 a top view of a spindle or flyer-rail. The position these rails occupy in the machine, is shown at *n* and *o*, figure 1, *n* being an end view of the spindle, and *o* of the flyer-rail, with the requisite gearing upon them, which is the same on each of them. These rails, instead of being drilled, like those in common use, with a single row of holes for supporting the spindles which

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* The grounds for the motion will appear in the [* 55] opinion of the Court.

B. R. Curtis and Warren, for the plaintiffs.

pass through them, are drilled with a double row, as shown at *a a*, and *b b*, figure 2. The back row, *b b*, is placed about five inches from the front row, *a a*, or about the width of the flyer to be used. The holes *b b*, of the back row, are drilled intermediate between those of the front row *a a*, and by this arrangement the bobbins *h* are readily changed. The spindles *e e e*, figure 1, work up and down through the rows of holes *a a*, and *b b*, and through the tubed wheels *c c*, figures 1 and 2, and also through the bottoms of the flyers as seen at *a*. The respective revolving and vertical motions of the spindles and flyers are effected in any of the known modes. The flyers, as shown in the back row at *i*, figure 1, are made to stand with their planes at right angles to those of the front row *k*; this, with their intermediate position, greatly facilitating the changing of the bobbins. To the bottom of each flyer a tube wheel is attached, as seen at *c*, figures 1 and 2; and a similar wheel is attached to each spindle, as shown at *c c*, figure 1; and motion is consequently communicated to them independently; but the respective flyers and spindles of both rows are geared into the same intermediate wheels, *f f*, as shown in figure 2. The above constitutes the whole gearing for giving motion to the back row of flyers and spindles.

It will be seen, that the flyers, as used by me and shown at *i i*, and *k k*, are made in one continuous piece, instead of being open at the bottom as is the case with those generally used in the English fly-frame, and this, among other reasons, enables me to give the increased velocity above referred to.

Having thus fully described the nature of my invention, in the improved construction of the Speeder, Double Speeder, or Fly-frame, what I claim therein as new, and desire to secure by letters-patent, is the arrangement of the spindles and flyers in two rows, in combination with the described arrangement of the gearing. And this I claim, whether the said gearing be arranged precisely as herein represented, or in any other manner which is substantially the same, producing a like result, upon the same principle.

WILLIAM C. DAVOLL.

Witnesses, { B. K. MORSELL,
 { EDWIN L. BRUNDAGE.

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Dexter and Ames, for the defendant.

WOODBURY, J. This motion is founded upon the position, that, by the specification, the improvement of the plaintiff is not confined to the use of the bow-flyer, that is, the flyer in "one continuous piece," as part of his new combination; and that the Court, in charging the jury that it was so confined, on a fair construction of the whole specification and drawing, erred in point of law.

In the argument, the counsel seemed to contend, that there was another error, in not leaving the point to the jury, as a question of fact, whether the bow-flyer required a different gearing from the open flyer, and if it did, then the [* 56] * bow-flyer formed a part of the new combination claimed; but if it did not require a different gearing, then the bow-flyer was not in point of law a portion of the new combination.

But it is enough to dispose of this last position, to see that it would narrow the question of law as to what kind of flyer was contemplated in the patent, and that it must depend on a single fact, to be found by the jury. Whereas, in truth, that question depended mainly on the language used in the specification and on the drawing, and not upon any fact in the case, which was in dispute at the trial, and *dehors* or independent of the writing. Nor was the Court, at the trial, requested to charge the jury, that the construction of the writing in this respect depended on any such fact; nor was it understood to be argued to the jury by the counsel, that the construction depended on it, but rather on the writing itself and the drawing, with some two or three other facts, about which no controversy or conflicting evidence existed.

It is well settled law, also, as to all written instruments, that their meaning in general is to be collected from the language of the instruments themselves.

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The construction seldom rests on facts to be proved by parol, unless they are so referred to, as to make a part of the description and to govern it; and when it does at all depend on them, and they are proved, or admitted, and are without dispute, as here, it is the duty of the Court, on these facts, to give the legal construction to the instrument.

But whether the Court gave the right construction to the patent in dispute, so far as regards the kind of flyer to be used in it, is a proper question for consideration now; and if any mistake has occurred in relation to it, in the hurry and suddenness of a trial, it ought to be corrected, and will be most cheerfully. There is no doubt as to the general principle contended for by the defendant in this case, that a patentee should describe with reasonable certainty his invention. Several reasons exist for this. One is, the act of

Congress itself requires, that he "shall particularly [* 57] specify and point out the part, improvement, or combination which he claims as his own invention." Act of July 4, 1836, ch. 357, § 6; 5 Stat. at Large, p. 119. And another is, that unless this is done, the public are unable to know whether they violate the patent or not, and are also unable, when the term expires, to make machines correctly, and derive the proper advantages from the patent. *Bovill v. Moore*, *Davies's Cases*, 361; *Phillips on Patents*, 286; *Lowell v. Lewis*, 1 *Mason*, 182, 189.

These principles, however, are not inconsistent with another one, equally well settled, which is, that a liberal construction is to be given to a patent, and inventors sustained, if practicable, without a departure from sound principles. Only thus can ingenuity and perseverance be encouraged to exert themselves in this way usefully to the community; and only in this way can we protect intellectual property, the labors of the mind, productions, and interests as much a man's own, and as much the fruit of his honest industry, as the wheat he

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cultivates, or the flocks he rears. *Grant v. Raymond*, 6 Peters, 218. See also *Ames v. Howard*, 1 Sumn. 482, 485; *Wyeth v. Stone*, 1 Story, 273, 287; *Blanchard v. Sprague*, 2 Story, 164.

The patent laws are not now 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.

In this case, therefore, the jury were instructed to consider the case under these liberal views, but not to hold the patent valid, unless the invention, such as the Court construed it to be in point of law, was described with so much clearness and certainty, that other machines could readily be made from it, by mechanics acquainted with the subject.

[*58] • *Looking to the whole specification and drawing, both the figure and language, could any one doubt that bow-flyers were intended to be used in the new combination which was patented? The figure is only that of a bow-flyer, so is the language. First, the spindles are described as working up and down “through the bottom of the flyers, as seen at *a*,” which is not possible in case of the open flyer, as that has no bottom for the spindle to work in.

Again the specification says, “to the bottom of each flyer a tube wheel is attached, as seen at *b*, figures 1 and 2,” which is impracticable with an open flyer. Again it says, motion is communicated to the flyer independently, but that is not feasible with the open flyer. And finally, towards the close, in order to remove all possible doubt, the specification adds,—“it will be seen, that the flyers, as used by me, and shown at *i i* and *k k*, are made in *one continuous piece*, instead of being open at the bottom, as is the case with those

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generally used in the English fly-frame." All know, that the flyer, in one continuous piece, is the bow-flyer. Besides this, other admitted or apparent facts tended to show, that the bow-flyer alone was intended. One great advantage, claimed from the new combination in the patent, was an increased velocity of the spindle. Thus, in the early part of the specification, it is stated, among the advantages of his improvement, that "the machine will bear running at a much higher velocity than the English fly-frame." And towards the close, he says, that it is the use of the flyer in "one continuous piece," i. e., the bow-flyer, instead of the open one, as in the English fly-frame, which; "among other reasons, enables me to give the increased velocity above referred to." How could there, then, be any reasonable doubt, that in his patent it was this bow-flyer he intended to use in his new combination?

In truth he not only says so, and could not otherwise obtain one of his principal objects and advantages, but it is * manifest from the form of the flyer itself, [* 59] and was not doubted at the trial, that only the bow-flyer could be geared, as he described his flyer to be, in two places, through its bottom; the other form of the open flyer confessedly having no bottom susceptible of being used or geared in this manner.

But it is said, the clause at the end does not specify this kind of flyer, and therefore all the rest of the specification is useless, redundant, and entitled to no weight in deciding what kind of a flyer is referred to in the closing part of the specification.

We think otherwise. Sometimes the preamble, even, may be resorted to for ascertaining the object of the specification. *Winans v. Boston & Prov. R. R. Co.* 2 Story, 412. Sometimes, the body of the specification. *Russell v. Cowley*, 1 Crompt. Mees. & Rosc. 864, 876. Sometimes, the summing up. *Moody v. Fiske*, 2 Mason, 112, 118. And sometimes, the formal clause at the end of the specification.

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Generally, all of them are examined together, unless the formal clause seems explicitly to exclude the rest, and require a decision on itself alone. *McFarlane v. Price*, 1 Starkie, R. 199; *Rex v. Cutler*, Ibid. 354; 1 Story, 285; 2 Story, 169, 170; *Ames v. Howard*, 1 Sumn. 482, 485; 11 East, 101.

But there is no such exclusion or conflict between the formal clause and the rest of the specification. On the contrary, it speaks of no different spindles from what he had just described and boasted of, as giving the increased velocity his machine possessed. And when he proceeds to describe what he claims therein, as new, to be, "the arrangement of the spindles and flyers, in two rows, in combination with the described arrangement of gearing," he manifestly refers, not to spindles or flyers generally, but the spindles and flyers before exhibited in his drawing, and described in his specification, namely, the short spindle and bow-flyer, rather than the long spindle and open flyer. And it is not pretended, [* 60] * that any other kind of spindle or flyer could act in combination with the described arrangement of gearing," which he had before given, of spindles working through the bottom of the flyers, and a tube wheel attached to the bottom of each flyer.

There was no fact in doubt about this, to be left to the jury; and there was but one construction as to the kind of flyer intended to be used, that was consistent either with the drawings, or the express language employed, or the chief object of the machine in its increased velocity, or in the practicability of gearing it in the manner before described by him in two important particulars, or of giving motion to it "independently." It is as clear and decisive on this point as if he had said, the *before described* spindles and flyers, because he says the spindles and flyers, "with the described arrangement of gearing;" and no other spindles or flyers, but the short spindles and bow-flyers, could be geared in the manner before described, through the bottoms of the latter.

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Matters like these must be received in a practical manner, and not decided on mere metaphysical distinctions. *Crossley v. Beveley*, 3 Carr. & Payne, 513, 514.

Taking with us, also, the settled rules, that specifications must be sustained, if they can be fairly, (*Russell v. Cowley*, 1 Crompt. Mees. & Rosc. 864, 876; *Wyeth v. Stone*, 1 Story, 273, 287,) that we should not be astute to avoid inventions, and that it is a question for the Court, and not the jury, whether the specification can be read and construed intelligibly in a particular way, (*Whitney v. Emmett*, Baldw. 303, 315; *Blanchard v. Sprague*, 2 Story, 164, 169,) we think the instructions given at the trial in this case were correct, and that no sufficient ground has been shown for a new trial.

Motion refused.

JOHN NESMITH AND OTHERS v. FRANCIS A. CALVERT AND OTHERS.

[1 Woodbury and Minot, 34. October T. 1845.]

Where a bill in equity alleged, that one of several defendants contracted to transfer a patent (not then obtained) for a machine, and that after it was obtained he refused so to do; and that the other defendants, knowing these facts, bought machines of him; *held*, that as the suit could be maintained against him alone, the fact that some of the other defendants were citizens of the same State with the plaintiffs, was not fatal to the jurisdiction.

A bill in equity to enforce a specific performance of a contract to convey a patent, is not "a case arising under the laws of the United States" as to patents, so as alone to give jurisdiction to its courts.

But an objection on that account, or on account of the residence of the parties, should be taken before the pleadings are closed, and the evidence published. *Semble*.

If the bill prays for an injunction against the use of a patent, the question as to the issuing of that may come within the above laws of the United States.

A contract may be made to convey a future invention, as well as a past one, and for any improvement, or maturing of a past one. Allegations in bills

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need not set out all the facts, in detail, which are to be proved; but if they do not, they must contain general statements, under which the details proved are pertinent.

A deed, or other documentary exhibit, may be put in after the evidence is published.

THIS was a bill in equity, complaining that, about the 15th of February, 1841, Francis A. Calvert had invented a machine for picking and cleaning wool and cotton, and was then contemplating to make improvements thereon, and was preparing to take out letters-patent for the machine and improvements. That the plaintiffs, with Royal Southwick and William W. Calvert, being engaged in the woollen manufacture, and knowing the facts aforesaid, and the skill and ingenuity of said Francis, agreed with him that he should go on and mature and perfect his invention and improvements, and take out letters-patent therefor, and assign and transfer the same to them, so far as they related to the subject of cleaning or burring wool.

That about the 15th of February aforesaid, Francis A. Calvert proceeded to execute a deed to them, which was recorded in the Patent Office of the United States on [* 35] the 25th * of that month, selling and assigning to them the exclusive right of using said machine and improvements for the purpose last mentioned, and covenanted that he would use due diligence in maturing said invention and taking out letters-patent therefor, and would assign the same, when procured, to them, so far as regards wool, and would assign them to no other persons. That William W. Calvert in the same year conveyed his interest in the subject-matter to the complainants, and said Southwick his interest to William C. Appleton, who, in September, 1843, transferred it to the complainants; that they thus became entitled to the exclusive use of F. A. Calvert's inventions, so far as respects the cleaning of wool; and that F. A. Calvert then proceeded

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to mature his improvement, and about 25th November, 1841, applied for letters-patent; and they were then given to him in due form.

The bill then avers, that about the third day of June, 1843, F. A. Calvert obtained other letters-patent for additional improvements in cleaning cotton and wool; that the improvements, described in the two letters-patent, are those contemplated and referred to in F. A. Calvert's deed to the complainants, and are embraced in its grants and covenants, and the complainants are entitled to transfers of them, so far as they relate to the latter subject; that the complainants hoped said Francis would assign them; but, on the contrary, he has combined with the defendants and others, and utterly rejects and refuses to comply with his agreements, covenants, and grants, and to transfer to them so much of them as concern wool, and has used, and allowed others to use them, and sold the same to the other defendants, and has derived great advantage therefrom.

The bill then proceeds to pray for answers to certain interrogatories, and that F. A. Calvert may be required to perform specifically his agreements, and to transfer to them the patents aforesaid, so far as they relate to the cleaning of wool.

* And that an account may be taken of the machines made by him and the other defendants; and that they be restrained from the further use of said patents for the purposes before named.

The joint and several answer of the defendants admits, on the part of F. A. Calvert, his inventions, and an agreement for the conveyance of the right to use the first one for cleaning wool, to the persons named in the bill, and to mature the same; but denies that the agreement extended to the improvement contained in the second patent, or that the last improvement was contemplated in that agreement. He

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further denies any use of the machine invented in 1841, by himself, or others under him, for cleaning wool, except by way of experiment.

The answer further avers, that after maturing his first patent, February 15, 1841, he did, on the 14th of October, 1841, convey to the complainants his said invention, and the letters-patent about to be obtained for it, and received \$1,000 instead of the one fourth part of the income reserved in the former deed, and said F. A. Calvert is now, and always has been ready to make any other deed desired, of said first named patent; but the same has never been requested as to either patent.

The answer moreover, throughout, denies any connection between the two patents, or any contemplation of the second one when the agreement was made and the first patent taken out, or any profit from either beyond an indemnity for expense, or any right in the complainants to any interest whatever in the last patent.

The interrogatories are answered at length, and the other defendants profess to be either ignorant of the matters concerned generally, or admit or deny to the extent to which F. A. Calvert does. They, however, deny that they have made, or are making for F. A. Calvert, several of the machines included in the last patent.

[* 37] * Some minor matters are stated in the answer, which need not be detailed here, but will be referred to, so far as material, in the opinion of the Court, as also will be the evidence offered that has a bearing on the essential points in the case.

Warren and Rand, counsel for the complainants.

Giles and Dexter, for the respondents.

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WOODBURY, J. There is a preliminary objection to the jurisdiction of this Court in the present case, which must first be considered.

It was not made till the argument, after the pleadings to the merits, and after the evidence was taken and published.

The ground of it is, that the matter in dispute does not arise out of or under the Patent Law itself, but under a contract to transfer a patent.

I am inclined to think this objection is well founded in respect to the subject-matter, as our jurisdiction is extended in this class of cases so far as regards the subject-matter only to "all actions, suits, controversies, and cases, arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions or discoveries," &c. Act of July 4th, 1836, § 17; 5 Statutes at Large, 124.

The present action or controversy arises rather under a *contract* concerning a patent afterwards to be obtained, than under the *Patent Law* itself.

But the objection, if good against the jurisdiction of this Court, merely on account of the subject-matter, does not impair it over Francis A. Calvert personally, as he belongs to a different State from the complainants; and his interests are several, and capable of being severed from those of the other respondents. The bill then, as against him, both on principle and precedent, gives the Court jurisdiction by his residence, even if it does not by its subject. *Ward v. Arredondo*, * 1 Paine, C. C. 414. See *Shute v. Davies*, [* 38] 1 Peters, C. C. 431, note; *Cameron v. McRoberts*, 3 Wheat. 591; *Strawbridge v. Curtiss*, 3 Cranch, 267.

The same reasoning authorizes it to be sustained as against Gay, who belongs to New Hampshire.

But the objection is probably made too late to operate in favor of any of the respondents, as it was not stated till after answers were put in to the merits, replications filed, and the

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evidence published. See *D'Wolf v. Rabaud*, 1 Peters, 476, 498; 1 Sumner, 578; 1 Story, 64; 2 Sumner, 252; *Skilern's Ex'rs v. May's Ex'rs*, 6 Cranch, 267.

There seems, also, so far as regards the prayer for an injunction against the use of the patents, to be one ground of jurisdiction given over all the respondents on account of the subject-matter.

Under these considerations, the preliminary objection to our jurisdiction must be overruled.

The next inquiry is, whether the complainants have made out a case justifying an interference to compel a specific performance, or an account, or to issue an injunction such as is prayed for.

This depends upon the true intent of the original contract between the parties. The chief inquiry is, was that intended to include any thing not actually embraced in the first patent?

This is resolved into two subordinate inquiries, ramifications of that. One is, did that contract by its terms, in their proper extent and meaning, look beyond the first patent, and thus mean to include more? And the next is, if not so, did it include more than was in the patent in consequence of some further improvement being known and contemplated at the time of the first patent, which was not inserted in it, though covered by the contract; being withheld as not matured and being suppressed, and afterwards introduced into the second patent.

[* 39] * In either of those events, the complainants are entitled to the benefit of the improvement, and it ought, under the contract, to be conveyed to them; but not otherwise.

The clauses in the original agreement, relied on to sustain the view, that all improvements, then or afterwards to be made by F. A. Calvert, in machines for burring wool, were to be conveyed to the complainants and no other persons, are

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these. He sells to them the exclusive right to clean wool, &c., "upon the machines invented or improved by" him, and "for which improvements I am now preparing to obtain letters-patent of the United States." He then covenants to "use all due diligence and effort to mature my said inventions and improvements for cleaning wool, as soon as possible," and to take out letters-patent therefor, and assign the same for cleaning wool to the complainants and to no other persons.

To bear on the construction of this instrument, it is further proved or admitted, that the complainants were manufacturers of woollens, and anxious to obtain possession and control of all the inventions for cleaning wool; that the said F. A. Calvert was an ingenious mechanic, and supposed to be making and able to make great improvements in the machinery for that purpose; that by an agreement made at the same time with that referred to, he was to receive one fourth of the profits from the use of all said improvements by the complainants; and that afterwards, on the 14th of October, 1841, he transferred that one fourth to them for the gross sum of \$1,000, using language still stronger than the first deed, and illustrative of it.

In this last conveyance, after describing it as transferring his right under the original agreement, he adds, "Also my right to a certain improvement in burring wool," "to have and to hold" the same, as "described in his specification and caveat, and all my right and claim of whatever nature, under or by virtue of said agreement, and all my improvements in * machines for burring wool, and all my [* 40] right to any letters-patent which may be obtained for the same."

But the respondent, F. A. Calvert, denies that, either by the first or second deed, any intention existed to convey any improvements he might make, except those then contem-

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plated, and afterwards patented in November, 1841. The natural import of the language in the first deed certainly accords with this, rather than a more extended engagement, such as the complainants infer more particularly from the last deed, looking to all improvements on this subject made by him in all future time.

The attendant circumstances of the parties and the subject-matter, so far as bearing on the construction of the agreement in the first deed, would not necessarily enlarge the construction to this extent. They are all consistent with the idea that improvements then thought of or started were the only subject-matter then contemplated to be transferred.

Had the parties contemplated more, and wished to cover all improvements ever made at any future time by F. A. Calvert, explicit language to that effect would be likely to have been selected, as it would have been equally easy and more natural. *Iggulden v. May*, 7 East, 237, 241.

But in the second deed by F. A. Calvert to the plaintiff, it is equally true there are some expressions that will bear a wider meaning, and they may have been introduced to cover what was doubtful in the first deed, and in consequence of a change in the consideration paid to F. A. Calvert, being, perhaps, deemed more advantageous to him; as it was a gross sum at once, instead of a share in remote and uncertain profits. Hence, after referring to the first improvements and the agreement in relation to them, he adds, as a part of the subject-matter conveyed in the second deed, what is susceptible of a construction much broader, namely: "All my improvements in machines for burring wool, and all [* 41] my right * to any letters-patent which may be obtained for the same."

This language might, without any very strained interpretation, be extended to future improvements, as well as those already made, or to a second as well as first patent for them,

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and especially when it is recollected, that the complainants were desiring to purchase from F. A. Calvert and others all the machines, which might be useful in relation to this subject-matter: that F. A. Calvert was in embarrassed circumstances, and the complainants relieved him by the advances made in October, when the second deed was executed; and that such engagements for the real benefit of inventors as well as the public, ought to be viewed literally when they tend to enable the inventors to continue their efforts, and eventually contribute to the public means and instruments for advancing useful industry and the arts.

But it is not necessary to form a decisive opinion on this point of the case, as I am satisfied on the other point that the balance of the testimony is in favor of the fact, that F. A. Calvert, before maturing his improvements and taking out his patent in 1841, had in contemplation, and had considered the further improvement patented in 1843. It would seem, however, that either, because he feared infringing Crane's rights, or had not time to finish the improvement in 1841, or entertained doubts of its superiority, or wished to reserve it for himself, he took out the patent of 1841, without including the same in it. It is not averred, nor is it necessary to infer, that he did this fraudulently. But that the principle of it had occurred to him in 1841, and had been in some degree tested, is quite clear, notwithstanding his denial, if we credit the testimony of William W. Calvert his brother, and of Mr. Crane. It is true, that William W. Calvert, though a brother, was a rival, and once had interests and feelings opposed to Francis A. Calvert. But he has no such interests at this time. So Crane was once interested in the patent. But neither of them *seem now to be incompetent; and [* 42] their manner of testifying is distinct and credible. Indeed, besides Crane's denial of any interest in it himself, the complainants offer now to show by a deed, that he had

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parted with all he possessed before giving his deposition, and put that in now as a documentary exhibit, though the evidence has been published. 2 Daniels, Ch. Pr. (Perk. Ed.) 1025.

These witnesses testify to facts, which show distinctly, that the differences between the first patent, in November, 1841, and the second one in June, 1843, consisted chiefly in this — that the first had the angular tooth guard; and the latter dispensed with it, by using a receiver beneath, and bringing the saw cylinder nearer to the fine-toothed comb cylinder.

Crane swears, that as early as the spring of 1841, Francis A. Calvert said the machine “could work without it,” that is, without the angular tooth guard. And whenever he said that, a caution was given to him that he might then encroach on Crane’s and William W. Calvert’s patent, which seemed to deter him from then making such a change. Again, as to the angular tooth guard, Crane says, “I don’t recollect that he said what he should use as a substitute, but he said he could do without it.” The idea then had occurred to him, and the matter had been discussed, before his contracts with the complainants.

William W. Calvert testifies, that the angular tooth guard could be dispensed with by bringing the cylinders nearer together and using a receiver, and such was the course of experiments tried in April, 1842, by his brother and himself. This was the second step in relation to the subject, — a series of experiments testing what he had thought of and talked of previous to his conveyances.

He seems to have been deterred from resorting to this change in the spring of 1841, for some reason or other, and probably in part from threats of Crane that it would [* 43] encroach * on his rights; but that it was contemplated, can hardly admit of doubt on examining the

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evidence. When he afterwards, in 1842, proceeded to develop this idea in a machine, he seems to have been conscious that it did not differ materially in principle from what he had patented in 1841, and should have been included in that; and hence he proposed to the complainants to buy back from them the patent of that year.

The change was rather a further progress in the same machine, than inventing a new one; was maturing its form without introducing any new principle — was merely withdrawing the angular tooth, and substituting for it the receiver, and a nearer position of the saw cylinder to the fine-tooth comb cylinder. He told Crane that the machine would work without the angular teeth, before he obtained his first patent; and his brother came to that same conclusion with him; but the precise substitute, if any, or the change throughout, which he had in his mind, was not developed to them in detail, if it was matured, till 1842.

But it being admitted, that in the winter of 1841 he had not matured any part of his invention — that his plans were but partially explained to any one — that the plaintiffs then, in advance of their completion and a patent, bought and he conveyed all of his improvements, such as they would be when matured — it was a natural form and design of the contract to reach every thing then in embryo in his mind on this subject; and after such a contract, it is equitable and just that it should pass the perfection or progress at any future day of any improvement in these machines, which he had thought of in 1841, and should at some future day complete.

Under these circumstances, as the improvement in 1842 of what was patented in 1841, is proved in point of fact to have been only a further development of ideas entertained in 1841 on the same subject, we see no just reason why it should not * be considered as assigned and granted [* 44] to the complainants as was stipulated to be done in

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February as well as October, 1841, in terms covering at least all improvements he had then contrived.

It is hardly necessary to go much into various other points pressed by the counsel on the one side or the other. The bill distinctly avers that the improvements patented in 1843 were contemplated by said Francis A. Calvert in 1841, and hence the proof on this point is admissible, and the *probata* thus correspond, as they should, with the *allegata*. Story's Eq. Plead. § 264; 2 Story, 469; 18 Ves. 312.

I do not by this remark mean to be understood as expressing an opinion, that no evidence can be put in which is not alleged or specifically described in the bill; but there must be in the bill allegations broad enough to cover any evidence offered, before it becomes admissible. After that, confessions, or declarations, or documents, or cumulative facts are admissible to support any general allegations to which they apply; and such general allegations are alone often sufficient to render the introduction of such evidence proper. *Smith v. Burnham*, 2 Sumn. 612; *Jenkins v. Eldredge*, 3 Story, 181.

Nor is it necessary to examine in detail another question which the counsel have discussed, — whether a demand should be made for a conveyance of the patent of 1841 or 1843, before Francis A. Calvert is bound to convey them.

For in all views of the deed and the testimony, he must be considered as having covenanted unconditionally to transfer them when obtained. He has long since received the consideration for doing it, and he now refuses absolutely to assign or grant the use of the last patent of 1843, which is a neglect of duty and violation of his contract sufficient to sustain the bill.

Believing, for the reasons assigned, that he is bound to do it, so far as regards its use for cleaning wool, I think [* 45] the * prayers in the bill against F. A. Calvert ought to be granted; and the use of both patents for that

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purpose be assigned to the complainants, — conferring on them an exclusive license to use both in that way, and an injunction issue also to all the respondents, as all have interfered in making, or using, or vending these machines, to do so no more, for cleaning wool; and that they render an account of whatever has hitherto been received for the same beyond the expenses incurred.

Decree for Plaintiffs.

**MATILDA K. ORR, ADMINISTRATRIX OF ISAAC ORR v. JAMES
LITTLEFIELD AND OTHERS.**

[1 Woodbury and Minot, 13. October T. 1845.]

In a suit in equity for the violation of a patent-right, an injunction will not be granted before a hearing upon the merits, merely upon proof that the complainant has obtained a patent.

But proof of undisturbed possession and user of the patent-right, for a reasonable length of time, by the complainant, is ground for granting an injunction. It is also ground for granting an injunction, that the complainant has prosecuted other persons for violations of the same patent, and recovered judgment against them; and it makes no difference that such judgment was rendered by agreement of parties, where there was no collusion, or under a specification of this patent, which has been surrendered as defective, and a new one taken out.

An injunction will not be dissolved, as a matter of course, on the coming in of the answer, denying the equity of the bill, if the complainant has adduced auxiliary evidence of his right, as in the present case.

THIS was a bill in equity. It alleged, that before the 20th of January, 1836, Isaac Orr, whom the complainant represented, was the inventor of a new improvement in stoves, called the air-tight stove, and on that day obtained a patent therefor. But the specification being made out inaccurately, he caused the patent, on the 12th of November, 1842, to be

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cancelled, and a new one to be issued. It further [* 14] averred * that the patent was valuable during his life, which terminated in 1844, and had since yielded large sums to her as administratrix. The bill contained further averments as to the violation of the patent by Hunneman & Son, and a recovery of damages in a suit at law therefor, in October, 1843; and that the respondents had not respected her rights under the patent, but made and sold stoves like those described in his specification; and hence the bill prayed, among other things, for an injunction to restrain the respondents from making or selling any more air-tight stoves, during the residue of the time the patent has to run.

The case was heard before WOODBURY, J., at Portsmouth, on the 13th of October, when the complainant moved for an injunction, in conformity to the prayer of the bill. In support of this motion, she offered in evidence the patent, which appeared to have been issued, cancelled, and re-issued, as stated in the bill; and which claimed the invention to be a new combination of particulars in a stove for heating rooms. She next offered copies of a case in which Isaac Orr recovered damages against Hunneman & Son, for a violation of this patent in October, 1846. She next gave in evidence another recovery of damages and costs against Ira Hazelton, for breach of this patent in May, 1845; and the issue of an injunction in her bill against Badger, for another breach, in October, 1844. After that, she read the affidavits of nine persons, showing, that Isaac Orr received about five thousand dollars for licenses and plates to use his stove, the three years previous to his death, and the complainant a like sum since; that the combination in Orr's stove were new and useful; that his right was unquestioned till the stoves came into general use; and that all using them since, as well as before,

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had paid when required, except the persons before named and the respondents, who had made and sold stoves similar to them, and refused to pay for the right now, though in 1844 they had purchased some of the plates, which were given as evidence of license.

* On the part of the respondents, evidence was [* 15] then offered that the judgment against Hunneman & Son was rendered on a verdict, taken by agreement of the parties, but without any proof of collusion or fraud. They showed, further, that the judgment against Hazelton was on a default by agreement; and offered the affidavits of four witnesses, stating that the invention of the complainant's intestate was not new, but had been used previously to the original issue of his patent.

The motion was argued by *S. E. Sewall* (of Boston) and *Hackett*, for the complainant; and *Hatch* for the respondents. Subsequently, at Boston, the opinion of the Court was delivered by

WOODBURY, J. This motion for an injunction is in accordance with a special prayer in the bill; and hence it is properly asked for. 2 Dallas, 360; 2 Story, Eq. Jur. 156. The subject-matter of the bill is, also, one in which it is usual and fit for the Court to interpose by this remedy, and on a proper state of facts before a final decision is had on the merits; because every stove sold is an injury if the patent is valid, and without such a remedy, — the supposed offence being constantly repeated, — the causes of action and the multiplicity of suits would probably become much extended, and relief, in that way, prove very defective. *Harmer v. Plane*, 14 Ves. Jr. 130; *Livingston v. Van Ingen*, 9 Johns. R. 507, 570; 9 Wheat. 738, 845; *Poor v. Carleton et al.* 3 Sumn. 70. An injunction, in such a case, proves to be useful as a

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bill of peace. On the contrary, however, such injunctions are a check on the business of respondents; and interferences subjecting others to a loss before a full trial between the same parties, are not always to be justified.

In what cases, then, should injunctions issue? It is not enough that a party has taken out a patent, and thus obtained a public grant, and the sanction or opinion of the [* 16] * Patent Office in favor of his right, though that opinion, since the laws were passed requiring some examination into the originality and utility of inventions, possesses more weight. But the complainant must furnish some further evidence of a probable right; and though it need not be conclusive evidence, — else additional hearing on the bill would thus be anticipated and superseded, — yet it must be something stronger than the mere issue, however careful and public, of the patent, conferring an exclusive right; as, in doing that, there is no opposing party, no notice, no long public use, no trial with any one of his rights. The kind of additional evidence is this. If the patentee, after the procurement of his patent, conferring an exclusive right, proceeds to put that right into exercise or use for some years, without its being disturbed, that circumstance strengthens much the probability that the patent is good, and renders it so likely, as alone often to justify the issue of an injunction in aid of it. *Ogle v. Ege*, 4 Wash. C. C. 584; 2 Story, Eq. Jur. 210; *Drew. on Injunc.* 222; *Phil. on Pat.* 462. After that it becomes a question of public policy no less than private justice, whether such a grant of a right, exercised and in possession so long, ought not to be protected, until avoided by a full hearing and trial. *Harmer v. Plane*, 14 Ves. 130.

In this case, the evidence is plenary and uncontradicted as to the use and sale of this patent by the inventor and his representative for several years, publicly and without dispute. Computing from the original grant, the time is over nine

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years, and since the reissue of the letters-patent it is nearly three. I concur in the opinion delivered by Judge Sprague in *Orr v. Badger*, that the time to be regarded under this view is what has elapsed since the original issue or grant. Law Reporter for February, 1845. In *Thompson v. Hill*, (3 Meriv. 622,) the time was only three years from the first grant. In *Ogle v. Ege*, (4 Wash. C. C. 584,) it was but six years. And though in some cases reported, it had *been thirteen, and in others twenty years, (14 [* 17] Ves. 130,) yet it is believed, that seldom has a court refused an injunction in applications like this, on account of the shortness of time after the grant, however brief, if long enough to permit articles or machines to be constructed by the patentee in conformity to his claim, and to be sold publicly and repeatedly, and they have been so sold and used under the patent without dispute. Here the sales were extensive and profitable from 1836 downwards, and the right as well as the possession does not appear to have been contested till 1842. In *Hill v. Thompson*, (3 Meriv. 622, 624,) it is true that the Court dissolved an injunction, when only about one year had elapsed since any work had been completed under the patent, and only two years since the specification was filed, the chancellor calling it a patent "but of yesterday;" but, he added, that he would not dissolve it, if an "exclusive possession of some duration" had followed; though an answer had been put in denying all equity, and doubts existed as to the validity of the patent; and no sales under it were proved in that case. So though the patent had been issued thirteen years, and the evidence is doubtful as to *acquiescence* in the possession or use, an injunction may be refused. *Collard v. Allison*, 4 Mylne & Craig, 487. But in the present case, the acquiescence appears to have been for several years universal.

Another species of evidence, beside the issue of the patent

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itself, and long use and possession under it, so as to render it probable the patent is good and to justify an injunction, is the fact, that if the patent becomes disputed, the patentee prosecutes for a violation of his rights, and recovers. Same authorities; *Kay v. Marshall*, 1 Mylne & Craig, 373. This goes upon the ground, that he does not sleep over his claims or interests, so as to mislead others, and that, whenever the validity of his claim has been tried, he has sustained it as if good. But such a recovery is not regarded as binding [* 18] the * final rights of the parties in the bill, because the action was not between them; though when the judgment is rendered without collusion or fraud, it furnishes to the world some strong as well as public assurance, that the patent is a good one. In this view of the evidence of this character in the present action, it is not contradicted, nor impaired at all, by the judgments having been given on verdicts and defaults under agreements. Such judgments, when, as is admitted here, not collusive, are as strong, if not stronger evidence of the patentee's rights, than they would have been, if the claim was so doubtful as to be sent to a jury for decision, rather than to be so little doubtful as to be admitted or agreed to, after being legally examined. Both of these circumstances, therefore, possession and judgments, unite in support of an injunction in the present case.

The only answer to the motion as made out on these grounds, is, the evidence offered by affidavits on the part of the respondents, tending to cast doubt on the originality of the invention of the patentee. I say, tending to this, because some of the affidavits, at least, do not distinctly show that the persons making them intended to assert that the whole of any one of the combination of particulars contained in Dr. Orr's claim in his specification, had been used before his patent issued; because, they are counteracted by other testimony, from the witnesses of the complainants, more explicit

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and in larger number; and because, in this preliminary inquiry, where the evidence is taken without the presence or cross-examination of the opposite party, it would be unsafe to settle and decide against the validity of the patent, when a full and formal trial of it is not contemplated till further progress is made in the case. All that is required in this stage, is, the presumption before named, that the title is good. This presumption is stronger here than usual, as it arises from the issue of the patent and an enjoyment and possession of it undisturbed for several years, beside the two recoveries against those charged with violating it.

* After these, other persons can, to be sure, con- [* 19] test the validity of the patent, when prosecuted either in equity or at law; but it is hardly competent for them to deprive the complainant of her right, thus acquired to an injunction, or, in other words, to be protected in so long a use and possession, till her rights are disproved after a full hearing; surely it is not reasonable to permit it when the affidavits of the respondents to invalidate or cast a shade over her right are met by that which is stronger, independent of the long possession, judgments, and presumptions before mentioned. But another objection has been urged in argument. When an answer to the bill denies all equity in it, the respondents contend that an injunction would be dissolved, and hence it ought not to be imposed, if the respondent denies equity by affidavit. This may be correct, in respect to injunctions termed *common*, as there affidavits and counter affidavits are inadmissible; Eden, 326, 117; yet in these, the denial must be very positive and clear. Ward v. Van Bockelen, 1 Paige, 100; Noble v. Wilson, Ib. 164. But the position cannot be correct in the case of injunctions called *special*, like the present one, and, where facts and counter evidence show the case to be different from what is disclosed in the affidavits or an answer of the respondents alone. No usage

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or cases are found where the injunctions are dissolved, as a matter of course on such answers, if the complainant has adduced auxiliary presumptions in favor of his right like those in the present instance. On the contrary the cases are numerous where the whole is regarded as still within the sound discretion of the Court whether to issue the injunction or refuse it; or if issued, to dissolve or retain it. 3 Merivale, 622, 624; 2 Johns. Ch. R. 202; 3 Sumn. 74; Livingston v. Van Ingen, 9 Johns. R. 507, 570; Rodgers v. Rodgers, 1 Paige, 426. And where the complainant has made out not merely a grant of the patent, but possession and use and sale under it for some time undisturbed, and beside this [* 20] a recovery against * other persons using it, the courts have invariably held that such a strong color of title shall not be deprived of the benefit of an injunction, till a full trial on the merits counteracts or annuls it. In several cases, where the equities of the bill were even denied, and in others, where strong doubts were raised whether the patent could in the end be sustained as valid, the courts decided, that injunctions should issue under such circumstances as have before been stated in favor of the plaintiff, till an answer or final hearing; or, if before issued, should not be dissolved till the final trial, and then cease, or be made perpetual, as the result might render just. The chancellor in Roberts v. Anderson, 2 Johns. Ch. R. 202, cites 2 Vesey, 19, and Wyatt's P. R. 236; Boulton v. Bull, 3 Ves. 140; Universities of Oxford and Cambridge v. Richardson, 6 Ves. 689, 705; Harmer v. Plane, 14 Ves. 130; and Hill v. Thompson, 3 Mer. 622, 624.

But if this injunction leads to serious injury in suspending works, the Court can require security, if desired, of the complainant, to indemnify for it, if the patent is avoided, or can make orders to expedite a final hearing and decision. 4 Paige, 447; 2 Paige, 116. So the defendants can have security

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given for costs, especially as the plaintiffs live out of the State. Let the injunction issue till after a final hearing; and as the defendants request it, security be filed by the plaintiffs for costs in thirty days.

Injunction granted.

MATILDA K. ORR, ADMINISTRATRIX OF ISAAC ORR, IN
EQUITY v. WILLIAM MERRILL.

[1 Woodbury & Minot, 376. October T. 1846.]

Where a bill in chancery asks for an injunction against the use of a patent stove, and for an account of sales, and on proof of former recoveries of others and long possession, an injunction had been granted, the Court will not dissolve it merely on an answer denying the validity of the patent; but will, if requested, direct an issue to be tried at law on that point, or, if not requested, continue the injunction and dissolve it at the next term, if in the mean time a suit at law is not brought to test the title.

An answer is sufficient for this purpose, though it do not set out the names of the *persons, who used the stove patented, or knew it [*377] before the patentee did, nor the names of the places where it was used or known.

But the answer at law should set them out, and so should the answer and notice on which in chancery an issue is asked to be formed and tried at law.

THIS was a bill in chancery, filed the 9th of September, 1845, charging the defendant with selling Orr's Patent Airtight Stoves, without a license from the complainant. She was averred to be the owner of said patent procured by her husband, and to have supported her right to it and the validity thereof in several former trials, and to have been for some years in the possession and sale of it.

The bill prayed an injunction against farther sales, and an account of prior ones, and a disclosure of certain facts in reply to several interrogatories.

On a notice to the respondent, and a failure to appear, an

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injunction issued September 17th, 1845, which the respondent now moves to have dissolved.

In the mean time, November 27th, 1845, the respondent had filed an answer, in which he denied generally the originality of the patent claimed by the plaintiff, and also the use of it by the respondent, though admitting he made other but different air-tight stoves, and stated his inability therefore to exhibit any account as asked for.

The complainant filed exceptions to the answer. 1st. That the denial of the originality of the plaintiff's patent does not specify the names of the persons who before invented or used it, nor the names of the places where it was used or known, before the invention of the plaintiff's patent.

2d. That it is imperfect and deficient in other respects. But these it is not material to detail, in the view of the subject taken by the Court.

Fox, counsel for the plaintiff; *Wells*, counsel for the respondent.

WOODBURY, J. It is proper in this case to look [* 378] at the * answer and exceptions, before deciding on the motion to dissolve the injunction.

The answer, if it was intended to form an issue to try the validity of the patent, because not original, ought probably to contain more allegations, and set out the names of places and persons, where and by whom, a like stove had before been used. Story, Eq. Pl. § 852.

For in a trial of such a question at law, the act of Congress is peremptory, that such notices shall be given in writing; and it would not do in equity to place a patentee on a ground less favorable than he is placed in a trial at law.

But the answer here is sufficient for another purpose, and that for which it was probably filed. It shows, that the de-

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fendant denies, and wishes to have tried in a proper way, the validity of the plaintiff's patent, and also denies his own use of it, if it turn out on a trial to be valid.

But where is that trial to be had?

Not usually by this Court in chancery, nor often in issues sent from here to the law side of the Court to be settled by a jury, unless requested by the respondent.

But when it is to be done in the last mode in any case, on request or otherwise, it would be proper under those issues to have all the specific notices given by the defendant in detail of persons and places connected with the former use of it.

Here, however, no such request being preferred by either side, the trial of the validity of the patent could be had most properly in a new action brought at law, and there, in such a defence as this answer discloses, all the notices must be set out which the plaintiff claims to have done, before he is allowed to be driven to trial on the merits. Phillips on Pat. p. 392, and cases there cited.

Again, bills brought in equity for injunctions are usually instituted after the title of the patent has been established at law against the defendant, or some other person using it; * and the expectation is, that the only [* 379] questions agitated will be as to the amount to be accounted for, and the restrictions for the future, and not the validity of the right.

But if the right is put in question by the defendant, and an injunction has been already granted, it may be dissolved, if not proper to be retained, and the plaintiff referred to a court of law to try the validity of the patent there. Or the injunction may be retained as proper till the validity of the patent is settled between them, if it appears as here, that the plaintiff has supported the validity of the patent in other trials, and been some time in the use and possession of it. See Orr v. Littlefield, *ante*, 223.

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That question can be settled by an issue framed and sent to a jury, under this bill, and to the law side of the court, when desired by the respondent, or by a new action brought at law for damages. See cases in *Pierpont v. Fowle*, Mass. Dist. Oct. 1846.

A common injunction is dissolved on an answer denying title, &c., but a special one is not, unless the denial is justified by something else, or the claim is strengthened by some evidence. See all the cases and decisions noticed in *Poor v. Carleton*, 3 Sumn. 82.

In special injunctions, a motion to dissolve depends on the sound discretion of the Court, after affidavits as to merits, if required, and on the nature of the case. *Ibid.*

Here, the answer is full enough and direct enough to show that the defendant denies the validity of the patent, so as to render a trial necessary; but till sustained by the result of such a trial in favor of the defendant, this naked denial is not sufficient to overcome the former recoveries and long possession of the plaintiff in favor of retaining the injunction that has before been granted. Perfect justice, however, can be enforced for both parties, as no desire is expressed to form an issue here on the matters in dispute to be tried by a jury.

We can direct, as we do, that the plaintiff must [* 380] institute a * suit at law before the next term, to try the validity of her patent with the defendant, and his use of it or not, if valid, else the injunction will then be dissolved.

But sufficient cause does not seem to be now shown to render the dissolution of it proper at this time.

Motion refused.

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JAMES STIMPSON, PLAINTIFF IN ERROR, v. THE WEST CHESTER RAILROAD COMPANY, DEFENDANTS.

[4 Howard, 330. January T. 1846.]

The practice of excepting, generally, to a charge of the Court to the jury, without setting out, specifically, the points excepted to, censured. The writ of error not dismissed, only on account of the peculiar circumstances of the cause.

Where a defective patent had been surrendered, and a new one taken out, and the patentee brought an action for a violation of his patent-right, laying the infringement at a date subsequent to that of the renewed patent, proof of the use of the thing patented during the interval between the original and renewed patents will not defeat the action.

The seventh section of the Act of March 3, 1839, has exclusive reference to an original application for a patent, and not to a renewal of it.

An original patent being destroyed by the burning of the Patent Office, and the only record of the specifications being a publication in the Franklin Journal, the claim is not limited by that publication, because the whole of the specifications are not set forth in it.

Whether a renewed patent, after a surrender of a defective one, is substantially for a different invention, is a question for the jury, and not for the Court.

As the thirteenth section of the Act of 1836, provides for the renewal of a patent, where it shall be "inoperative or invalid by reason of a defective or insufficient description or specification," "if the error shall have arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention," the fact of the granting of the renewed patent closes all inquiry into the existence of the inadvertence, accident, or mistake, and leaves open only the question of fraud for the jury.

THIS case was brought up, by writ of error from the Circuit Court of the United States for East Pennsylvania.

It was a suit brought, in the Circuit Court, by Stimpson against the Railroad Company, for a violation of his patent-right.

On the 23d of August, 1831, Stimpson took out letters-patent for an improvement in the mode of turning short curves on railroads. These letters were not given in evidence upon

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the trial, having been burned in the conflagration of the Patent Office, in December, 1836, and no copy could be found. Secondary evidence was given of their contents by the following publication in the Franklin Journal: —

“For an improvement in the mode of turning short curves on railroads, such as the corners of streets; James Stimpson, city of Baltimore, August 23.

“37. The plan proposed is to make the extreme edges of the flanches flat, and of greater width than ordinary, and to construct the rails in such a manner that where a short turn is to be made, the extreme edge of the flanch shall rest upon it, instead of upon the tread of the wheel, thus increasing the effective diameter of the wheel in a degree equal to twice the projection of the flanch. The claim is made to ‘the application of the flanches of railroad carriage-wheels to turn short curvatures upon railroads or tracks, particularly turning the corners of streets, wharves, crossing of tracks or roads, and passing over turnabouts,’ &c.” Franklin Journal, vol. 9, p. 124.

[*381] *On turning to pages 270 and 271, vol. 4, there will be found specifications of two patents granted to James Wright, of Columbia, Pennsylvania, for the mode of turning curves claimed by Mr. Stimpson. The only difference is, that Mr. Wright proposes to adapt his cars to several different curves by having three or more offsets in his wheels when necessary.

On the same day, namely, the 23d of August, 1831, Stimpson took out, also, letters-patent for an improvement in the mode of forming and using cast or wrought iron plates or rails, for railroad carriage-wheels to run upon. These letters being also destroyed, the following extract from the Franklin Journal was given in evidence.

Franklin Journal, vol. 9, p. 125. “39. For an improvement in the mode of *forming and using cast or wrought*

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iron plates, or rails, for railroad carriage-wheels to run upon; James Stimpson, city of Baltimore, Maryland, August 23, 1831.

“The claim in this case is to ‘the application of cast or wrought iron plates for the use of railways on the streets or wharves of cities or elsewhere. The objects of said improvement being to employ rails that will not present any obstacles to the ordinary use of streets, or sustain injury therefrom, and so to form the plates at the intersections of streets or other crossings, that cars will readily pass over them, and also on circles of small radius.’

The rails are to be formed with a groove, in them to receive the flanches of the wheels; on one side of the groove, the width is to be sufficient for the tread of the wheel, on the other, it need not exceed three quarters of an inch. These rails are to be laid flush with the pavement of the streets. At corners to be turned, the rails are to be cast, or made of the proper curvature, one of them only being provided with a groove, as the flanch is to run upon the other, upon the principle described in No. 37. Provision is to be made by scrapers, or brushes, preceding the carriages, to clear the grooves of dust, ice, and other obstructions.”

In 1835, the first mentioned of these letters, namely, for an “improvement in the mode of turning short curves on railroads,” were surrendered on account of a defective specification, and on the 26th of September, 1835, a renewed patent was issued for the term of fourteen years from the 23d of August, 1831. The schedule referred to in this patent was as follows:—

“*Short Curves.*

“23d August, 1831. Renewed 26th September, 1835.

“To all whom these presents shall come: Be it known, that I, James Stimpson, of the city and county of Baltimore,

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and the State of Maryland, have invented a new and useful improvement in the mode of turning short curves upon railroads with railroad carriages, particularly those round the [* 382] corners of streets, wharves, &c., and * that the following is a full and exact description of said invention or improvement, as invented or improved by me, namely: I use or apply the common peripheries of the flanches of the wheels for the aforesaid purpose, in the following manner: I lay a flat rail, which, however, may be grooved, if preferred, at the commencement of the curvation, and in a position to be centrally under the flanches of the wheels upon the outer track of the circle, so that no other part of the wheels which run upon the outer circle of the track rails shall touch or bear upon the rails, but the peripheries of the flanches; they bearing the whole weight of the load and carriage, while the opposite wheels, which run upon the inner track of the circle, are to be run and bear upon their treads in the usual way, and their flanches run freely in a groove or channel; which treads are ordinarily about three inches in diameter less than the peripheries of the flanches.

“Were the bearing surfaces of the wheels which are in contact with the rails while thus turning the curve, to be connected by the straight lines from every point, there would thus be formed the frustrums of two cones, (if there be four wheels and two axles to the carriage,) or if but one axle and two wheels then but one cone; which frustrums, or the wheels representing their extremities, will, if the wheels are thirty inches in diameter, and are coupled about three feet six inches apart, turn a curve of about sixty feet radius of the inner track rail. The difference in diameter between the flanches and treads before stated, the tracks of the usual width, and the wheels coupled as stated, would turn a curve of a somewhat smaller radius, if the axles were not confined to the carriage in a parallel position with each other; but this

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being generally deemed necessary, the wheels run upon lines of tangents, and these upon the inner track being as wide apart in the coupling as the outer ones, keep constantly inclining the carriage outwards, and thus cause the carriage to tend to run upon a larger circle than the difference in diameter of the treads and flanches would otherwise give; but the depth of the flanches and the couplings may be so varied as to turn any other radius of a circle desired.

“What I claim as my invention or improvement is the application of the flanches on the wheels on one side of railroad carriages, and of the treads of the wheels on the other side, to turn curves upon railways, particularly such as turning the corners of streets, wharves, &c., in cities and elsewhere, operating upon the principle herein set forth.

JAMES STIMPSON.

“Witnesses,

“JAMES H. STIMPSON,

“GEORGE C. PENNIMAN.”

In October, 1840, Stimpson brought his action against the * West Chester Railroad Company for [* 383] a violation of this renewed patent, and laid the infringement to have taken place in 1839.

In April, 1842, the case came on for trial.

The plaintiff produced his patent, and gave evidence that the defendants had used upon their road several curves of this description.

The defendants disputed the originality of the invention of the thing patented, under which head of defence much evidence was given; and also contended that the groove was not claimed in the first patent of 1831, and therefore was not included in the renewed patent of 1835. The evidence of Dr. Jones upon this last head being referred to by the Court below, it is proper to insert that part of it.

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“ *Interrogatory fifth.* What are the contents of the specification of the alleged improvement of August 23, 1831? What are your means of knowing what were their contents? If you know them, are they dissimilar or similar to those of the plaintiff's specification of September 26, 1835, a copy of which marked A, is hereto annexed? If dissimilar, state in what particulars, and whether they are as to matters of form and substance, and particularly describe the difference, if any. Answer fully.”

“ To the fifth interrogatory, I answer, that the plaintiff exhibited to me the specification in question, previously to his filing the same in the Patent Office ; as he likewise did at the same time the specification of a patent for ‘ forming and using cast-iron plates or rails for railroad carriage-wheels to run upon,’ which last patent is noticed on page 125, vol. 9 second series, of the Journal of the Franklin Institute. I then examined them cursorily, and expressed an opinion, that the improvements described in the two specifications might have been embraced in one, and that it would have been better to have pursued that course. The specification of the mode of turning short curves appeared to me incomplete ; an essential feature of it being contained in that for ‘ forming and using cast-iron plates,’ &c. The papers, however, remained as drawn up by Mr. Stimpson's legal adviser, and when the patents were subsequently surrendered in 1835, it was thought best to preserve the division into two ; it was probably in fact necessary to pursue this course, as I am not aware of any precedent for uniting two patents into one, although one may be divided into two or more.

“ Nearly ten years have elapsed since I first saw the specifications upon which these patents were first issued, and nearly six years since I last read them ; and my recollection of them extends to certain prominent points only. The claim under the patent for turning short curves, as given in vol. 9, p. 124,

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of my Journal is, I have no doubt, literally correct. There has been an omission in the printing of inverted commas [“] after the word ‘turnabout,’ &c. In this specification it was proposed to make the extreme *edges [* 384] of the flanches flat, and of greater width than ordinary ; this, however, did not enter in the claim, and it is not probable that I should have recollected the fact, had it not been noted in my Journal, or called up by some other collateral circumstance. The main defect, in my judgment, of the original specification, in the patent for turning short curves, was the omission of the mention of the groove in the inner rail. I believe, however, that it was alluded to in this specification, but the description of it was contained principally, if not wholly, in the specification of the patent for ‘forming and using cast-iron or wrought plates,’ &c., above noticed, as may be inferred from a reference to my Journal, vol. 9, p. 125, patent 39.

“ *Cross Interrogatories.* 1. Did you or did you not prepare the papers of the plaintiff when his patent for short curves was surrendered and renewed? What was the object of such surrender and renewal? Was it or was it not that the claim of running over or across tracks at right angles might not continue any longer to be incorporated in the same patent with the claim for short curves, as it had been theretofore ?

“ To the first cross interrogatory, I answer, that I did prepare the papers of the plaintiff when his patent for turning short curves was surrendered for reissue ; that the object of such surrender and renewal was to limit and confine it to the turning short curves in streets, &c., by leaving out certain matters in it respecting the crossing of tracks or roads, and the passing over turnabouts ; and to define the subject-matter of the patent more clearly, without its being necessary to refer

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to that simultaneously obtained for 'forming and using cast or wrought iron plates,' &c."

The bill of exceptions taken by the plaintiff was to the following part of the charge of the Court to the jury, namely: —

"Having thus presented you with a view of the rules and principles of the common law applicable to the renewal of patents, as laid down by the Supreme Court, together with the provisions of the different Acts of Congress on this subject, we will now state to you what is, in our opinion, their legal result.

"To authorize the surrender of an old patent and issue of a new one, consistently with the provisions of the original Patent Law of 1793, and the decisions of the Supreme Court, independently of any Act of Congress conferring such power, there are these requisites indispensable to the power arising. (1.) The original patent must be inoperative or invalid for the causes set forth in the Act of 1832 — the non-compliance with the third section of the Act of 1793, for the want of a proper specification of the thing patented, through inadvertence, accident, or mistake, without any fraudulent or deceptive intention. This being the only case embraced in the law to which the authority conferred applies. (2.) 1, The defect in the specification, which makes it incompetent to secure the rights of the patentee, must have arisen from inadvertence, [* 385] accident, * or mistake, and 2, not from any fraud or misconduct. The reissue of the patent by the appropriate officer is presumptive evidence that the requisites of the law have been complied with, on the production of such evidence or proof otherwise as justified it; but the question of the validity of the new patent is a judicial one, depending on the fact of inadvertence or fraud, as you shall find it; and the opinion of the Court on matters of law involved in the inquiry. 14 Peters, 458; 6 Peters, 243; 7 Peters, 321;

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Act of 1839 (5 Little & Brown's ed. 353.) The reason why there must be an inquiry into both the inadvertence and fraud arises from the settled construction of the Act of 1793, that where the defect is not owing to fraud, the defendant is entitled to a verdict and judgment in his favor, but not to a judgment that the patent is void for the defect, unless he shows that the defect was owing to fraud. 1 Bald. ; 6 Peters, 246. You must then be satisfied, affirmatively, that the defect of the patent arose from the inadvertence of the patentee, and negatively, that it did not arise from his fraud or misconduct, or, in the words of the Acts of 1832 and 1836, 'without any fraudulent or deceptive intention.' The finding of the fact of inadvertence may negative the fact of fraud, but in this, as in other cases, fraud may be inferred from gross inadvertence or negligence, such as may be the indication of a design to deceive the public. The defects in the old patent must be in the specification, when it does not comply with the requisites of the third section of the Act of 1793, calling for a correct description of the thing patented (6 Peters, 247); a new one may be issued on compliance with those requisites, which are there prescribed. But the new patent must be confined to the thing patented by the old one—the thing invented or discovered—'*the same invention*;' it cannot embrace another substantive and essential matter, which was not before patented; the thing, the invention, must be the same in both patents; the only object in the renewal being to cure a defect in the description, not to supply the omission of an essential part of the invention; the new patent cannot be broader than the old one. If the thing patented is the same in both patents, its public use did not, under the former laws, amount to an abandonment, or such an acquiescence as to affect the new patent on the ground of delay or negligence in the assertion of the right of the patentee, from the date of the old patent to its reissue. But when an essential part is omitted,

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and the patentee suffers it to remain unpatented till it has come into public use, before the new patent issues, it will be subject to the same rules which apply to an original patent, making it incompetent to protect the patentee in his claim to such part in virtue of the patent reissued, if it was not described in the one surrendered. The thirteenth section of the Act of 1836 authorizes a new improvement, invented since the first patent, to be added in a renewed [* 396] *one; no law gives any authority to add an improvement, which had been invented by the patentee before the original grant; for it is not and cannot be any part of the description or specification of another distinct improvement. A patent for the combination of the parts of an old machine must show wherein such combination exists; what parts compose it; how they are combined in their action. If the description is defective, it may be corrected by a new one; the correction, however, must not extend beyond the combination of the parts first specified, as the introduction of other parts, not before specified, makes an entire new combination; consequently the thing patented becomes essentially different, being not the same invention, but a new one, made by a combination of a part not combined before, which might be a proper subject of an original patent, yet would not be authorized in a renewed one.

“These are the tests which the law applies to the description of the thing patented, in order to ascertain whether, in the words of the Act of 1832, the old patent was ‘invalid or inoperative’ by reason that the conditions of the former law not having been complied with, or, in the language of the Supreme Court, the patent ‘is found to be incompetent to secure the reward which the law intended to confer on the patentee for his invention.’ In such case, the patent may be surrendered for reissue, in order to correct the defects which invalidated the first, but the law expressly makes the new pa-

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tent 'in all respects liable to the same matter of objection and defence' as the old one, and imposes on the patentee the obligation of 'compliance with the terms and conditions prescribed by the third section of the Act of 1793.' This is done by showing, according to its requisitions, what was the invention, the thing patented, by a designation of the invention principally, made in fuller, clearer, and more exact terms than those used, so as to give it validity and effect, and secure the same invention, which is the only legitimate office of the renewed or reissued patent. A specification consists of two parts — description and claim. The descriptive part is the explanation of the improvement in all the particulars required by the law ; the claim, or summary, at the close of the description or specification, is the declaration of the patentee of what he claims as his invention, by which he is bound, so that he can claim nothing which is not included in the summary, and could disclaim nothing which was included in it till the passage of the Act of 1837. But the summary may be referred to the description, and both will be liberally construed to ascertain what was claimed, and if the words will admit of it, both parts will be connected in order to carry into effect the true intention of the patentee, as it may appear on a judicial inspection of the whole specification. This makes it a question of law what is the thing patented, depending not on the actual or supposed intention of the patentee, but the conclusion of the law * on the language he has used [* 387] to express it ; a part of the description may be construed as a claim, and carried into the summary, and made a part of the thing patented, the effect of which is the same as if it was included in the summary in express terms. *Cooper v. Matheys*, C. C. MS. To authorize a recovery for the violation of a patent-right, the plaintiff must show that he is the inventor of every thing he claims as new, that it is embraced in the patent, and that every thing so claimed and patented

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has been infringed by the defendant ; thus, where the patent is for a particular combination of the parts of an old machine, and the defendant has not used the whole combination as specified in the description, and carried into the summary, the plaintiff cannot recover. Prouty et al. v. Ruggles, 16 Peters, 336."

The Court then proceeded to state the substance of the plaintiff's declaration, and referred to the patent of 1835, and the specification thereto attached, in order to ascertain the thing patented by that patent which was stated therefrom ; they then inquired what was the thing patented in 1831, by referring to the evidence of Thomas P. Jones, contained in the deposition aforesaid, in connection with the Journal of the Franklin Institute, referred to by him. The Court, remarking that there being in evidence no copy of the patent of 1831, any drawing or specification of the thing patented, or other proof of the contents of either than was contained in the deposition and Journal aforesaid, then gave their opinion to the jury, that, on this evidence, the use of grooves was not claimed, and was no part of the thing patented in 1831 for turning short curves, but was a part of the thing patented in 1835. That it was an essential part of this invention, as Jones testified, and without which all the witnesses agreed that the invention was useless ; as without the groove the cars would run off the road, and that the patent was not for any parts of the machine which were new, but for a new combination of the old parts. It was then submitted to the jury, whether, on the evidence aforesaid, the omission of the groove in the patent of 1831 arose from inadvertence, and if it was done contrary to the advice of Jones, and in conformity with the opinion of the legal adviser of the plaintiff, and whether, without the groove, the description of the thing patented was sufficient, under the third section of the Act of 1793, which was read and commented on by the Court, who then proceeded as follows :

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The Secretary of State is a ministerial officer, who must issue a patent if the requisites are performed. 6 Peters, 241. The question of inadvertence or mistake is a judicial one, which the Secretary cannot decide, nor those judicial questions on which the validity of the patent depends. He issues the patent without inquiry. The correct performance of all the preliminaries to the * validity* of [* 388] the original patent are always examinable in the Court where the fact is brought. 6 Peters, 6, 47, 242.

“ In the application of the law to the evidence before you, the first inquiry is into the state of facts existing at the time of granting the patent of 1835 ; did they present a case for renewal, under the rules of law on which we have given you our instructions ? Whether the original patent was invalid or inoperative is more a question of law than fact, to be ascertained on a judicial inspection of the patent, specification, drawings, models, and the evidence of the contents ; the Court must construe all written evidence ; but as depositions are considered merely as oral testimony, a jury must decide what parts are proved by them. The Court must take as true the statements of witnesses as they are made, and lay down the law on the assumption of their credibility, and both Court and jury must take an agreed or admitted uncontested state of facts to be their rule of action ; a jury may deem a witness unworthy of credit, or not believe his statement, but ought to do neither without good cause. Whether the defects in the old patent arose from inadvertence or otherwise is also a mixed question of law and fact — of law so far as depends on written, and of fact as to parol evidence ; on this subject you have the evidence of Dr. Jones, who officially examined the old patent, &c., and made out the new, and we are mainly left to ascertain the facts in relation to both patents from him. In laying down the law to you, we assume his verity in all he says, and, taking his statement as proof of the facts there ex-

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isting, our opinion is, that, connected with the publication in the Journal of the Franklin Institute, in 1832, when the matter was fresh in his recollection, and the specification in the new patent, the old one was invalid and inoperative, by reason of non-compliance with the requisites of the Act of 1793. That it did not embrace the groove, which was essential to its validity, that the new patent is not for the same invention, and that the plaintiff has not made out a case of such inadvertence, accident, or mistake as justified the issue of the new patent, inasmuch as it appears from the patent for plates on railroads, issued at the same time with the one for short curves, that he had known and described the grooves.

“It is for you to say, whether you will take this evidence as we do; if you discredit it, in the whole or in part, you will find accordingly.

“Another important question arises in this case, on the construction of the seventh section of the Act of 1839, taken in connection with former laws, which is, whether the plaintiff can sustain an action for the use of his invention in the construction of his curves, before the granting of the patent of 1835.

“This section provides — ‘That every person or corporation who has, or shall have, purchased or constructed any newly-invented machine, manufacture, or composition of [* 389] matter, prior to * the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held to be invalid by reason of such purchase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public, or that such

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purchase, sale, or prior use has been for more than two years prior to such application for a patent.'

" Though this act is retrospective in its effects on then existing patents, it is not void on that account ; it was within the constitutional power of Congress to enact it as a rule for all cases to which its words and intentions apply, by its fair and legal interpretation, which we must ascertain by looking at the old law ; the mischief and the remedy, which must be traced through the decisions of the Supreme Court, and the Acts of Congress on the same subject.

" In 1808, an act was granted to Oliver Evans, renewing his patent, which had expired by its own limitation ; in the interval, the defendant had constructed a machine of his invention, and continued to use it ; after the new patent issued, he was held liable, according to the words of the law, for such subsequent use, but the Supreme Court thus express their opinion of the case, had it rested on general principles : — ' The legislature might have proceeded still further, by providing a shield for persons standing in the situation of these defendants ; it is believed that the reasonableness of such a provision could have been questioned by no one, &c., &c. The argument, founded on the hardship of this and similar cases, would be entitled to great weight, if the words of this proviso were obscure and open to construction.' Evans v. Jordan, 9 Cranch, 203."

And thereupon the counsel for the plaintiff did then and there except to the aforesaid charge and opinion of the said Court.

The above not being enough of the charge of the Court below to the jury, the counsel for the plaintiff in error applied for and obtained a writ of *certiorari* to bring up additional extracts.

The return was as follows :

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On searching the record and proceedings of the Circuit Court of the United States, in and for the Eastern District of Pennsylvania, in the third Circuit, in a certain cause therein lately depending between James Stimpson, plaintiff, and the West Chester Railroad Company, defendants, we find the following omission in the charge of the judge to the jury, which, in obedience to the annexed writ of *certiorari*, is hereby certified, to wit: —

“ In *Morris v. Huntington*, Judge Thompson held, that after a patent was surrendered, the invention would be [* 390] open to public use * without hazard, so far as depends on such patent. 1 Paine, 355. In *Grant v. Raymond*, the Court notice the case of the use of the invention between the date of the old and before the new patent, but remark, that that defence is not made; and the Circuit Court did not say that such defence would not be successful; and they add— ‘The defence, when true in fact, may be sufficient in law, notwithstanding the validity of the new patent.’ 6 Peters, 244. The Court, in this and the subsequent case of *Shaw v. Cooper*, held that the new patent was a continuation of the old, but gave no opinion on the question, whether damages could be recovered for the intermediate use of a machine constructed after the first.

“ This question was, however, put at rest by the last clause of the Act of 1832, which, assuming that damages could not be recovered for a use of the patented invention, before the new patent, provides: — ‘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.’ The Act of

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1836, is still more explicit, by providing for the right of recovering damages only for 'causes subsequently accruing.'

"It thus appears that the Act of 1839, goes only one step beyond those of 1832 and 1836, and is a dead letter, if it protects the person who has purchased, constructed, or used the machine invented by the patentee no farther than from damages accruing prior to the new patent, for the same protection is given by those laws.

To have any effect, it must be held to be, in the words of the Supreme Court, 'a shield,' which covers the party from all liability, and by so construing it, the Act of 1839 embodies the very principle, and none other, which, in *Evans v. Jordan*, 9 Cranch, 203, that Court declared to be one which they believed that no one could question its reasonableness, in order to prevent the hardship of a case precisely similar in principle to that presented. Such construction is the more reasonable, when it is considered that the protection is confined to the specific machine used before the patent, and cannot be extended to protect the use of any new or other machine, or construed to invalidate the patent, or justify the subsequent use by any other persons than those so protected.

"That such was the intention of Congress in relation to an original patent cannot be doubted, and we can perceive no reason why they should omit the very case on which the Supreme Court had so explicitly declared their opinions, if the words of the Act of 1808 would have permitted them to apply an unquestionable principle. The Act of 1839 not only does not exclude its application, but authorizes and requires it. In referring to the application * for a [* 391] patent, it was evidently intended to apply it to the patent on which the patentee sought to recover, the renewed one, on which alone his right rested, for the law cannot be presumed to be intended to apply to a patent which, being invalid or inoperative, as a ground of action, had been surren-

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dered, cancelled, and cancelled by the Act of the patentee himself, and was thus divested of all intrinsic efficiency by the Acts of 1832 and 1836. It could have no effect without the aid of the new one, and it would be absurd to suppose that the law overlooked the application for the only effective patent, and looked only to that which derived new life from it; besides, the Act of 1839 would take from a defendant the protection of the Acts of 1832 and 1836, by confining its operation to the old patent, for damages could then be recoverable for the use between the date and the renewal—a conclusion wholly inadmissible on a sound construction of either the acts in question.

“The Act of 1832 expressly declares that the new patent shall be subject in all respects to the same matters of objection and defence as the original one; from which it necessarily follows, that if the purchase or construction of a machine, before the application for an original patent, would protect a defendant from all liability to the patentee, the same defence is available when applied to the new one.

“This view of the Act of 1839, suffices for the purposes of the present case; a broader one has been taken of it, in all its bearings, in another district in this circuit, which it is not now necessary to examine to decide the point now under consideration.

“In the case before us, it clearly appears that the defendants constructed their railroad with the plaintiff's curves in 1834, one year or more before the plaintiff's application for his renewed patent; consequently, they may continue its use without liability to the plaintiff.”

The case was argued by *C. J. Ingersoll* and *J. R. Ingersoll*, for the plaintiff in error, and *Miles*, for the defendants in error.

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The brief of the counsel on the part of the plaintiff in error was as follows :

This case comes up for argument upon a bill of exceptions taken by the plaintiff to the charge of the learned judge in the Court below, by which, in effect, the jury were directed to find for the defendants, which they accordingly did.

The plaintiff took a patent the 23d of August, 1831, for an invention or improvement in the application of the flanches of the wheels on one side of railroad carriages and of the treads of the wheels on the other side, to turn short curves upon railroads.

It was surrendered in consequence of a defect in the specification, and a new patent taken by him the 26th of September, 1835.

* "The object of such surrender and renewal [* 392] (see deposition of Dr. Thomas P. Jones, a witness for the defendant, in answer to the first cross-interrogatory, *ante*, p. 384) was to limit and confine it to the turning short curves in streets, &c., by leaving out certain matters in it respecting the crossing of tracks or roads, and the passing over turnabouts, and to define the subject-matter of the patent more clearly, without its being necessary to refer to that simultaneously obtained, for forming and using cast or wrought iron plates, &c."

The action was brought at the October session, 1840. The curves used by the defendants were said to have been constructed and first used by them between the dates of the first and second patents, the use being continued by them since the date of the second patent.

The learned judge, after considering at length the law touching this part of the case, said to the jury : —

"It clearly appears that the defendants constructed their railroad with the plaintiff's curves in 1834, one year or more before the plaintiff's application for his renewed patent ; con-

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sequently, they may continue its use without liability to the plaintiff."

In *Grant v. Raymond*, 6 Peters, 244, the defendant made it a question, whether the patentee who took an amended patent could recover damages for the defendant's use, subsequent to the amendment of the patent, of machinery which had been constructed prior to the amendment. The Court did not decide the point, thinking it did not come directly up for decision. But they said of it, — "This objection is more formidable in appearance than in reality. It is not probable that the defect in the specification can be so apparent as to be perceived by any but those who examined it for the purpose of pirating the invention."

Grant v. Raymond was decided early in 1832.

On the 3d of July, 1832, was passed (4 Little & Brown's ed. 559) the first act by which the amendment of patents for defective specifications was statutorily recognized. The third section of the act contains a proviso, that the new patent shall be open to all objections which existed against the old one, by virtue of which, if the phrase stood alone, a defendant, in this case, for example, might say, I used your curves before 1835 — before the date of your patent, — that is, between the new patent and the old one, and as a use by the public prior to the date of the patent would be fatal as against the old patent, so it is against the new.

Now to meet such an argument, the same proviso goes on to say, that no use of the patented invention between the dates of the first and second patents, excepting under a surrender of the invention to public use, shall prejudice the patentee's right to recover damages "for any use" after the grant of the new patent.

We quote at length the proviso of the third section.

[* 393] * " *Provided, however,* That such new patent so granted shall, in all respects, be liable to the same

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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, 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.”

It is submitted, that by the terms of this statute, to use, after date of the second patent, the patented machinery, even though the specific machine used had been constructed and used between the dates of the first and second patents, is expressly denied to the public.

On the faith of this statute of the 3d July, 1832, the plaintiff, in September, 1835, surrendered the patent granted him the 23d August, 1831, and took an amended one.

Has any Act of Congress changed the law in this particular since 1832?

As any such law, so far as regards this plaintiff, would be retroactive, it ought to be clearly expressed.

On the 6th July, 1836, was passed the new Patent Act, by which the whole system was recast, but the thirteenth section, which relates to amended patents, says in broad terms:—

“And the patent so reissued, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all actions hereafter commenced, for causes subsequently accruing, as though the same had been originally filed in such corrected form before the issuing of the original patent.”

It is submitted that the words, “for causes subsequently accruing,” are not to be strained from their natural construction, in order to be made to retroact against the rights already

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vested under the protection of a statute; and that the cause of action against these defendants, as far as concerns their use of the patented invention since the 26th of September, 1835, is a cause subsequently accruing within the just and obvious meaning of the act.

In 1837, the 3d of March, was passed an amendment to the law of 1836.

The plaintiff submits that the seventh and ninth sections of the Act of 1837 bear on his case, by analogy. They permit a patentee who has patented too much, and more than he invented, to make disclaimer of the excess, with the same effect, as regards the validity of the patent, as if his disclaimer were part of his original specification. That is to say, the patentee shall recover as if his patent had been originally right instead of wrong; and no exception is made in favor of [* 394] parties who, like the defendants here, use, *after disclaimer, one of the patented things, which they had constructed and begun to use while the patent was too broad; the legislature being influenced, perhaps, by the suggestion of this Court in *Grant v. Raymond*, that that party is not entitled to much favor, who scans a specification in order to pirate it.

On the 3d of March, 1839, the latest amendment of the patent laws was passed.

The seventh section of this act is cited by the learned judge, who asks, what this section means, if it do not mean that the use of a patented machine shall be free to a defendant after the patent, if he constructed it before. It reads thus:—

“Sect. 7. *And be it further enacted*, That every person or corporation who has, or shall have, purchased or constructed any newly invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and to

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vend to others to be used, the specific machine, or manufacture, or composition of matter so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held to be invalid by reason of such purchase, sale, or use, prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public, or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent."

It is admitted, in answer to the learned judge, that the seventh section of the Act of 1839 was intended to protect defendants, constructors of machinery prior to the patent, in the use of such machinery after the grant to the patentee. This section, which has no reference to renewed or amended, more than to all other, patents, is believed to provide for a case, till 1839 unprovided for; namely, the case in general, whether it arise under an original patent, or under one which has been amended, or which has been modified by disclaimer of the use by a defendant, after the issuing of the letters, of a machine such as they patent, but which specific machine was purchased or constructed before their date. But it is respectfully submitted, that this prior use meant a use prior to the first or original application of the inventor for his patent, and that the legislature had not in their contemplation the second application of the inventor, when they used the words "prior to the application of the inventor or discoverer for a patent." The last clause of the section has obvious reference to the original application alone, when it is declared that "such purchase, sale, or use, prior to the application for a patent," shall not (except under certain circumstances) make the patent invalid; for it was clear already, and quite independently of this statute, that no renewed or amended patent could be worth paying for, if the use of the patented machinery

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by third persons, prior to the renewal, could make it invalid.

[* 395] * Grant v. Raymond, however, furnishes the best answer to the learned judge's position, that the plaintiff's patent is liable to be damaged by what has taken place since the date of the original letters. At page 244, (6 Peters,) the Court says: —

“ It has also been argued, that the new patent must issue on the new specification, and on the application which accompanies it. Consequently, it will be true that the machine was ‘not known or used before the application.’ But the new patent, and the proceedings on which it issues, have relation to the original transaction. The time of the privilege still runs from the date of the original patent. The application may be considered as appended to the original application.”

The plaintiff in error contends, that a true interpretation of the letter of these several acts, and a due regard to the spirit of all recent legislation on the subject of patent-rights, which has been kind and liberal towards patentees, enforce the conclusion, that it was meant, when the new patent was granted, to give to the new, in all particulars, the charter of the old, unless when restrained by express words to narrower limits. And further, that while, for obvious reasons, the acts deny to the patentee a right to recover damages, under the new patent, for a use of the invention of earlier date than the patent itself (which denial is in terms) no express words of the statutes, or fair or necessary implication from them, or leaning, can be found, in the whole course of the legislation since 1832, to warrant the conclusion that the new patent does not confer upon the grantee an entire monopoly of the fruits of his invention, from the date of the second letters to the expiration of the fourteen years from the date of the first.

The plaintiff in error therefore assigns for error the learned

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judge's instructions to the jury, recognizing the defendants' right to use the patented invention, after the date of the second patent, provided they had commenced its use prior to that date, and continued after that date to use only the specific machine at first used.

The learned judge also charged the whole case to be against the plaintiff upon another question, namely, that of the description of the "groove," in the original patent.

The judge was of opinion that the groove was not in the first patent, and was in the second; and therefore that the second was broader than the first, and not confined to the thing there patented, and thus was defective as an amended patent. The plaintiff's patent being, as he supposed, established fully by judicial sanction of the highest sort, in his contest with the Trenton Railroad Company, reported in 14 Peters, 448, had not even brought with him, when he came to try his cause in Philadelphia, the original letters-patent, and the drawings which accompanied them. Nor was any notice given him by the defendant to produce them.

The result of his suit against the Baltimore and Susquehanna * Railroad Company, tried in the [* 396] Maryland District, in April term, 1843, when both the original patent and the drawings were produced in Court, proved to be quite ill founded, the attempt of the defendants, in the present case, to criticize his second patent as actually varying from the first, by the addition of this new matter, the groove.

He is aware, however, that he must sustain his case as it appears by this record, and he proceeds to do so.

The whole invention of the plaintiff consisted of a new method of attaining conical action in turning short curves on railroads. And the groove had no more to do with it than this: — that when to attain this action the outer wheel was mounted upon its flanch, the groove, by receiving the inner

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wheel, prevented the car from slipping off the track — a very material consideration, it is true — in turning the corner ; and so was the car, or the steam-engine that drew the car ; but neither of them had any thing to do with the plaintiff's method of producing conical action. Without a groove, just as without steam, a horse, or other power, the corner could not be turned ; and therefore, in describing the plaintiff's invention, both this power and the groove must needs be referred to ; but it is respectfully denied, that more than the merest allusion to either is necessary, neither of them being any part of the invention, nor so occult as to demand, for even the most unenlightened observer, more than a mere allusion to it.

Now it was in proof from the witness called by the defendant to testify to the contents of the original specification, that it alluded to the groove.

“ I believe, however, that it (the groove) was alluded to in this specification.” Evidence of Dr. Jones.

This allusion to the groove in the first patent, the learned judge rules, in his charge to be insufficient, and in the paragraph *ante*, pp. 387, 388, after so holding, he goes on to declare, that the groove should have been “ claimed.” It may be mentioned that it is not claimed in the new patent, nor even alluded to in the summary of the specification ; so collateral is it to the invention.

The plaintiff in error further assigns for error, in this portion of the charge touching the groove the learned judge's decision against the plaintiff's right to claim under his patent, because of his alleged omission in regard to the groove ; and particularly to the judge's saying, that, assuming the truth of Dr. Jones's deposition, the opinion of the Court was, that the old patent was “ invalid and inoperative by reason of non-compliance with the requisition of the Act of 1793. That

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it did not embrace the groove, which was essential to its validity; that the new patent is not for the same invention."

Also, the learned judge's taking from the jury the question, which came fairly up as a question of fact, namely, whether this mention * of, or allusion to, the groove [* 397] was or was not too slight a description of that part of the combination to enable one skilled as an engineer to make a curve, or to stand for a compliance, by the patentee, with the requisition of the statute touching the proper description of the invention.

Also, the learned judge's deciding it to be a matter of law, and not of fact for the jury, what the thing patented in 1831 was, when the evidence of what it was lay not in a written paper, which the judge could read and construe, but in parol evidence, and explanations *per testes*.

Also, the learned judge's not giving the due legal effect to the secretary's seal and letters-patent, as *prima facie* evidence that the second patent legitimately succeeded to the first, and to his assuming, on the contrary, that it was incumbent on the plaintiff, and not on the defendant, (who assailed it,) to show what the first patent contained, and what its character and defects were, and in the absence of the patent, and of any notice or call for it by the defendant, and in the absence of any satisfactory account of its contents to the learned judge, making the plaintiff and not the defendant, responsible for the imperfectness of the proofs regarding the same.

The judge left nothing to the jury, as distinctly appears in his summing up, in regard to the groove, (*ante*, p. 388,) but the question whether Dr. Jones's testimony was to be believed or not. If believed, he told the jury they must find for the defendants, the old patent being defective, in not embracing the groove, and the new patent, which he said did embrace it, being therefore for a different invention altogether.

The plaintiff in error also assigns it for error, that the learn-

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ed judge ruled "mistake," in the statute about amending patents, to mean inadvertence or accident only, and excluded cases of honest mistakes of judgment.

Mr. Miles, for the defendants in error, filed the following brief: —

Abstract of Case.

1. This is a writ of error to the Circuit Court for the Eastern District of Pennsylvania. The plaintiff in the Circuit Court is the plaintiff in error in this Court. The verdict in the Circuit Court was for the defendants.

2. The action was brought to recover damages for an alleged infringement by the defendants of an exclusive right, alleged to belong to the plaintiff, to make, use, construct, and vend an improvement "in the mode of turning short curves on railroads," of which he claimed to be the original inventor, and alleged to have been secured to him by letters-patent of the United States, according to the Acts of Congress.

The plaintiff claimed under letters-patent, dated [* 398] September 26th, * 1835, which recited that letters for the same improvement were granted to him on August 23d, 1831, but which were "hereby cancelled on account of a defective specification."

3. The plaintiff declared on the letters-patent of September 26th, 1835, in four counts, (only varying in the allegation of different modes of infringement, namely, making, constructing, selling, and using,) all setting forth that "the said letters-patent (that is, of August 23d, 1831) were cancelled in due form of law, on account of a defective specification."

4. The defendants pleaded not guilty, gave due notice to the plaintiff, under the Acts of Congress, of a defence based upon the want of originality of invention of the thing patented

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on the part of the plaintiff, under the several patents of 1831 and 1835, said notice including the prior use and knowledge of other persons, and of prior printed and published descriptions of the same, &c., and under such plea and notice gave evidence to the jury.

The original letters of the 23d of August, 1831, were not in evidence, they having been destroyed in the conflagration of the Patent Office in December, 1836, nor was there any copy of them given in evidence.

Their loss or destruction having been proved, secondary evidence was given of their contents. (Journal Franklin Institute, vol. 9, p. 124, No. 37; and by deposition of Dr. Thomas P. Jones.)

The claim by this evidence, under the patent of 1831, was "to the application of the flanches of railroad carriage wheels to turn short curvatures upon railroads or tracks, particularly turning the corners of streets, wharves, crossing of tracks or roads, and passing over turnabouts," &c. No mention was made therein of the use of a groove upon the inner circle for the flanch to run in, so as to enable the wheel on the inner circle to run on its tread, without which there was evidence tending to show that the whole alleged invention was useless.

The claim under the patent of 1835 was to "the application of the flanches of the wheels on one side of railroad carriages, and of the treads of the wheels on the other side, to turn curves upon railways," &c., "operating upon the principles herein set forth." The specification referred to in this summary describes the use of the flanch running on the surface of the outer rail, and of the tread running on the inner rail, which is formed with a groove to receive the flanch of the wheel on the inner rail, as the essential parts, which, combined together, form the improvement.

5. Upon the trial, several questions of law and of fact arose. His Honor, Mr. Justice Baldwin, charged the jury upon the

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law, and left the facts falling within the scope of the principles of the law, as laid down by him, to the determination of the jury.

[* 399] * *Points of Law arising under the Charge contended for by Defendants.*

The third section of the Act of 21st February, 1793, in substance, provides that the applicant for a patent shall give a description, in full, clear, and exact terms, of the thing invented, and its modes of application.

By the sixth section of the same act, a defendant in a suit brought on letters-patent may show that the description (that is, specification) does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the desired effect, which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, or that the thing secured by patent was not originally discovered by the patentee, &c.

The third section of the Act of July 3, 1832, provides, in substance, that if any patent shall be invalid or inoperative by reason of noncompliance with the terms of the third section of 1793, by "inadvertence, accident, or mistake," and "without any fraudulent or deceptive intention," it may be lawful for the Secretary of State, on surrender of the original patent, to grant a new patent, on compliance with the conditions of the third section of the Act of 1793, for the residue of the term unexpired.

The thirteenth and fifteenth sections of the Act of 4th July, 1836, which supplied the former laws enacted on the subject, contain in substance the same provisions as to the inoperation of a patent by reason of the defective description, and allowing a surrender and regrant where the defect arose from "in-

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advertency, accident, or mistake, and without any fraudulent or deceptive intention."

The seventh section of the Act of March 3, 1839, provides, "that every person or corporation who has, or shall have, purchased or constructed any newly invented machine, &c., prior to the application by the inventor, &c., for a patent," may use and vend it at all times, without liability to the inventor or any person, &c.

Under these acts, the following points are submitted to have been judicially decided.

1. That where a patentee, under the Act of February 21st, 1793, has not complied with the terms of its third section, even through inadvertence, accident, or mistake, the plaintiff cannot recover for an infringement prior to a surrender and new grant. *Grant v. Raymond*, 6 Peters, 244; *Shaw v. Cooper*, 7 Peters, 320; *Whitney v. Emmett*, 1 Bald. 303.

2. That if the patentee under the Act of 1793 has not complied with the terms of its third section, through fraudulent and deceptive intention, by the concealment of or addition to his real discovery, his * patent, by [* 400] the sixth section, is absolutely void. *Grant v. Raymond*, 8 Peters, 246, 247; *Whitney v. Emmett*, 1 Bald. 303.

3. (1.) That a surrender under the Act of 1832, and a new grant are only sustainable where the defect in the description of the first patent was the result of inadvertence, accident, or mistake. *Grant v. Raymond*, 6 Peters, 246, 247. (2.) That a new grant, on such a surrender, is not sustainable, but is absolutely void, if it appear that the defect in the description of the first patent, whether of concealment or addition, was the result of a fraudulent and deceptive intention on the part of the patentee. (3.) That if a patentee surrendered his first patent, and, under pretence of an inadvertence, accident, or mistake in its description, obtained a new patent, adding thereto a new material or element of which he was not the

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original inventor, and which is necessary to make the thing patented useful, thus in the second patent specifying another combination, constituting a mode or a machine substantially different from that described and claimed in the first, it is fraud in the patentee, and the patent is void. *Grant v. Raymond*, 6 Peters, 218, 244; *Philadelphia Railroad v. Stimpson*, 14 Peters, 462; *Shaw v. Cooper*, 7 Peters, 292.

Note. The Act of 1832 (July 3d,) authorizing a surrender and regrant, shortly followed the decision in *Grant v. Raymond*, 6 Peters, (January term, 1832,) and by express enactment provided for that which had before been allowed by practice and judicial construction only.

4. That an original patent, as well as that granted on a surrender of the first under these acts, are *prima facie* evidence only of the novelty and utility of the alleged invention, and of the compliance by the patentee with the terms of the several acts of Congress entitling him to a patent; but their validity is examinable in a judicial proceeding upon any such patent, part of the inquiry being within the province of the Court where the construction of written documents is to be made, and part being for the determination of the jury where questions of fact are involved. *Grant v. Raymond*, 6 Peters, 218; *Shaw v. Cooper*, 7 Peters, 292; *Philadelphia Railroad v. Stimpson*, 14 Peters, 448; *Prouty v. Ruggles*, 16 Peters, 336.

5. If a patentee's first patent be inoperative for want of a full and exact description, and he stands by for a long and unreasonable period of time, without surrendering and remedying the defect by furnishing such a description, and obtaining a regrant, and in the mean time permits others to use what he subsequently claims to be his invention, with a knowledge of such use without objection or asserting his right, this is evidence from which a jury may infer his acquiescence and

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abandonment to the public as a matter of fact. *Shaw v. Cooper*, 7 Peters, 320–322.

6. Under the act of 1839, if the defendants purchased or constructed this mode of turning curves, before the application for the * patent of 1835, and this combination or mode described in that patent was newly invented by the patentee, the plaintiff cannot recover, notwithstanding the Act of 1839 was subsequent to the dates of such purchase or construction, and the patent of 1835. *Shaw v. Cooper*, 7 Peters, 320–322; *M'Clurg v. Kingsland*, 1 How. 204; *Evans v. Jordan*, 9 Cranch, 201.

Note 1. This statute was intended to provide expressly and in terms (designating a specific point of time) for all that class of cases of implied acquiescence and waiver in favor of the public, resulting from the negligence of the patentee, by which judicial construction held that the patentee had no claim against persons using or constructing the alleged invention under such circumstances.

Note 2. This action was brought in the Circuit Court after the passage of the Act of 1839, to wit, at the October session 1840.

The charge of the Court left all the facts falling within the scope of the legal principles therein stated to the determination of the jury.

1. "The question of the validity of the new patent is a judicial one, depending on the fact of inadvertence or fraud, as you shall find it." "You must then be satisfied affirmatively," &c. "The finding of the fact of inadvertence may negative the fact of fraud," &c.

2. "It was then submitted to the jury, whether, on the evidence aforesaid, the omission in the patent of 1831 arose from inadvertence," &c.

3. "Depositions are considered merely as oral testimony; a jury must decide what facts are proved by them,"

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a mixed question of law and fact; of law so far as depends on written, and of fact as to parol evidence," &c.

4. "It is for you to say, whether you will take the evidence as we do; if you discredit it, in whole or in part, you will find accordingly."

Mr. Justice McLEAN delivered the opinion of the Court.

The plaintiff brought an action against the defendant for an infringement of his patent, for a "new and useful improvement in the mode of turning short curves on railroads." The questions for decision arise on exceptions to the charge of the Court to the jury. And here it may be proper to remark, that the exceptions are to the charge as published at length, and not to the points ruled by the Court, as is the correct practice. Under the peculiar circumstances of this case, the Court will not dismiss the writ of error upon this ground, but it is expected that a different course will hereafter be pursued.

On the 21st of August, 1831, the plaintiff obtained a patent for an invention or improvement in the application of the flanches of the wheels on one side of railroad carriages and [*402] of the treads of * the wheels on the other side, to turn short curves upon railroads. The specification of this patent being defective, it was surrendered the 26th of September, 1835, and a renewed one obtained, in order, as proved, "to limit and confine it to the turning short curves in streets, &c., by leaving out certain matters in it respecting the crossing of tracks or roads, and the passing over turnabouts, and to define the subject-matter of the patent more clearly, without its being necessary to refer to that simultaneously obtained, for forming and using cast or wrought-iron plates," &c.

In his charge, the judge said to the jury: — "It clearly appears that the defendants constructed their railroad with the

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plaintiff's curves in 1834, one year or more before the plaintiff's application for his renewed patent; consequently, they may continue its use without liability to the plaintiff."

The patent was surrendered, and a new one obtained, under the third section of the "Act concerning Patents," of the 3d of July, 1832; and the correctness of the above opinion is to be ascertained by a reference to the proviso of that section. It is there declared — "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."

The charge of infringement, in the declaration, is laid some years after the new patent, so that the question does not arise, whether an action could be sustained for a violation of the right prior to the corrected patent. The above proviso would seem to be 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 a new patent." Now it is plain that no prior use of the defective patent can authorize the use of the invention after the emanation of the renewed patent under the above section. To give to the patentee the fruits of his invention was the object of the provision; and this object would be defeated, if a right could be founded on a use subsequent to the original patent and prior to the renewed one.

The thirteenth section of the Act of the 4th of July, 1836, which remodelled the Patent Law in this respect, made no material change in the Act of 1832. The words in the latter act are, — "And the patent, so reissued, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all actions hereafter

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commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form, before the issuing out of the original patent." Now any person using an invention protected by a renewed patent [* 403] *subsequently to the date of this act, is guilty of an infringement, however long he may have used the same after the date of the defective and surrendered patent.

The Circuit Court relied upon the seventh section of the Act of the 3d of March, 1839, as sustaining their construction in regard to the use of the invention after the renewed patent. But that section has exclusive reference to an original application for a patent, and not to a renewal of it. We think the Court erred in their instruction to the jury above stated.

In their charge, the Court said — "The use of grooves was not claimed and was no part of the thing patented in 1831, for turning short curves, but was a part of the thing patented in 1835." "That it was an essential part of the invention." And further, "in taking the statement" of Dr. Jones "as proof of the facts there existing, our opinion is, that, connected with the publication in the Journal of the Franklin Institute, in 1832, when the matter was fresh in his recollection, and the specification in the new patent, the old one was invalid and inoperative, by reason of non-compliance with the requisites of the Act of 1793. That it did not embrace the groove, which was essential to its validity; that the new patent is not the same invention, and that the plaintiff has not made out a case of such 'inadvertence, accident, or mistake,' as justified the issue of the new patent, inasmuch as it appears, from the patent for plates on railroads issued at the same time with the one for short curves, that he had known and described the grooves."

The original patent, as proved by Dr. Jones, was burnt

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with the Patent Office, and no part of the specifications is preserved, except that which was published by the witness in the Franklin Journal. That publication does not purport to give the whole of the specifications, and, consequently, the claim is not limited by the notice in that journal. Doctor Jones, speaking of the patent issued in 1831, says, — “The main defect, in my judgment, of the original specifications in the patent for turning short curves was the omission of the mention of the groove in the inner rail. I believe, however, that it was alluded to in the specifications, but the description of it was contained principally, if not wholly, in the specification of the patent for forming and using cast-iron or wrought plates,” &c.

That there was a defect in regard to the grooves in the specifications of the first patent is shown, and also that the patent was surrendered in order to remedy that defect. But whether this vitiated the patent is not a question in this case, as it does not affect the right now asserted, if the first patent were void. Whether the new patent was substantially for a different invention from the first one, was a question for the jury on the evidence. But the Court ruled this point, withdrawing the facts from the jury. The witness thinks “that in the first patent the grooves were alluded to,” but the * terms used are not recollected by him, and as [* 404] the patent has been burnt, they cannot now be proved. We think the Circuit Court erred in not leaving the jury to act upon the facts, as regards the difference between the original and the renewed patent. On the facts, we should draw a different conclusion from that which was given to the jury by the Circuit Court. An allusion to the grooves in this specification, as more particularly described in the other patent, would at least show the intention of the patentee, if it did not make good his patent.

By the thirteenth section of the Act of 1836, “if the patent

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shall be inoperative or invalid, by reason of a defective or insufficient description or specification," &c., "if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful" to surrender it, &c. Now, as in granting the renewed patent, the officers of the government act under the above provisions, their decisions must at least be considered as *prima facie* evidence that the claim for a renewal was within the statute. But this would not be conclusive against fraud in the surrender and renewal, which, on the evidence, would be a matter for the jury. And we suppose that the inquiry in regard to the surrender is limited to the fairness of the transaction. In whatever manner the mistake or inadvertence may have occurred is immaterial. The action of the government renewing the patent must be considered as closing this point; and as leaving open for inquiry, before the Court and jury, the question of fraud only.

The judgment of the Circuit Court is reversed, and the cause remanded to that Court, with instructions to award a *venire facias de novo*.

JAMES G. WILSON, PLAINTIFF, v. LEWIS ROUSSEAU AND
CHARLES EASTON.

[4 Howard, 646. January T. 1846.]

The eighteenth section of the Patent Act of 1836 authorized the extension of a patent, on the application of the executor or administrator of a deceased patentee.

Such an extension does not inure to the benefit of assignees under the original patent, but to the benefit of the administrator (when granted to an administrator) in his capacity as such. But those assignees who were in the use of the patented machine at the time of the renewal have still a right to use it. The extension could be applied for and obtained by the administrator, although

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the original patentee had, in his lifetime, disposed of all his interest in the then existing patent. Such sale did not carry any thing beyond the term of the original patent.

A covenant by the patentee, made prior to the law authorizing extensions, that the covenantee should have the benefit of any improvement in the machinery, or alteration or renewal of the patent, did not include the extension by an administrator, under the Act of 1836. It must be construed to include only renewals obtained upon the surrender of a patent on account of a defective specification. Parties to contracts look to established and general laws, and not to special acts of Congress.

A plaintiff, therefore, who claims under an assignment from the administrator, can maintain a suit against a person who claims under the covenant.

An assignee of an exclusive right to use two machines within a particular district can maintain an action for an infringement of the patent within that district, even against the patentee.

In the case of Woodworth's planing machine, the patent granted to the administrator was founded upon a sufficient specification and proper drawings, and is valid.

The decision of the board of commissioners, to whom the question of renewal is referred, by the Act of 1836, is not conclusive upon the question of their jurisdiction to act in a given case.

The Commissioner of Patents can lawfully receive a surrender of letters-patent for a defective specification, and issue new letters-patent upon an amended specification, after the expiration of the term for which the original patent was granted, and pending the existence of an extended term of seven years. Such surrender and renewal may be made at any time during such extended term.

THIS case, and the three subsequent ones, namely, *Wilson v. Turner*, *Simpson et al. v. Wilson*, and *Woodworth & Bunn v. Wilson*, were argued together, being known as the patent cases. Many of the points of law involved were common to them all, and those which were fully argued in the first case which came up were but incidentally touched in the discussion of the subsequent cases. *They all [* 647] related to the rights which were derived under a patent for a planing machine, taken out by Woodworth, and renewed and extended by his administrators. The validity of the original patent was questioned only in one case, namely, that which came from Kentucky, which was the last

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argued. There were four cases in all, namely, one from New York, one from Maryland, one from Louisiana, and one from Kentucky. In the course of the argument, counsel referred indiscriminately to the four records, as some documents were in one which were not to be found in another.

The cases will be taken up and reported *seriatim*, and the documents which are cited in the first will not be repeated in the others.

The first in order was the case from New York, the titling of which is given at the head of this report.

It came up from the Circuit Court of the United States for the Northern District of New York, on a certificate of division in opinion.

On the 26th of November, 1828, William Woodworth, presented the following petition.

“To the Honorable Henry Clay, Secretary of State of the United States.

“The petition of William Woodworth, of the city of Hudson, in the county of Columbia and State of New York, respectfully represents:

“That your petitioner has invented a new and improved method of planing, tonguing, grooving, and cutting into mouldings, or either, plank, boards, or any other material, and for reducing the same to an equal width and thickness; and also for facing and dressing brick, and cutting mouldings on, or facing, metallic, mineral, or other substances, not known or used before the application by him, the advantages of which he is desirous of securing to himself and his legal representatives. He therefore prays that letters-patent of the United States may be issued, granting unto your petitioner, his heirs, administrators, or assigns, the full and exclusive right of making, constructing, using, and vending to others to be used, his aforesaid new and improved method, agreeably

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to the acts of Congress in such case made and provided ; your petitioner, having paid thirty dollars into the treasury of the United States, and complied with the other provisions of the said acts.

WILLIAM WOODWORTH.

“ November 26th, 1828.”

On the 4th of December, 1828, Woodworth executed to James Strong the following assignment.

“ Whereas I, William Woodworth, of the city of Hudson, in the State of New York, heretofore, to wit, on the 13th day of * September, 1828, assigned and [* 648] transferred, for a legal and valuable consideration, the one equal half of all my right, title, claim, and interest in and to the invention or improvement mentioned and intended in the foregoing petition, oath, and specification, to James Strong, of the city of Hudson.

“ And whereas, also, the subjoined assignment is intended only to convey and assign the same interest transferred and assigned in the assignment of the 13th of September above mentioned, without any prejudice to my one equal half part of said invention or improvement, which is expressly reserved to myself and my legal representatives.

“ Now, know all men, that I, the said William Woodworth, for and in consideration of the sum of ten dollars, and other valuable considerations me moving, have, and do hereby, for myself and legal representatives, give, assign, transfer, and assure to the said James Strong and his legal representatives the one full and equal half of all my right, title, interest, and claim in and to my new and improved method of planing, tonguing, grooving, and cutting into mouldings, either plank, boards, or any other material, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings on, or facing, metallic, mineral, or other substances, mentioned and intended to be

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secured by the foregoing petition, oath, and specification, together with all the privileges and immunities, as fully and absolutely as I do or shall enjoy or possess the same; to have and to hold and enjoy the same, to the said James Strong, and his legal representatives, do or may.

“In witness whereof, I have hereunto set my hand and seal, the 4th day of December, 1828.

WILLIAM WOODWORTH. [Seal.]

Witnesses: —

HENRY EVERTS,
DAVID GLEASON.”

On the 6th of December, 1828, Woodworth took the following oath.

“*State of New York, Rensselaer County, ss.:*

“On this sixth day of December, A. D. 1828, before the subscriber, a justice of the peace in and for the county of Rensselaer aforesaid, personally appeared the aforesaid William Woodworth, and made solemn oath, according to law, that he verily believes himself to be the true and original inventor of the new and improved method, above described and specified, for planing, tonguing, grooving, and cutting into mouldings, or either, plank, boards, or any other material, and for reducing the same to an equal width and thickness; and also for facing and dressing brick, and cutting [* 649] *mouldings on, or facing, metallic, mineral, or other substances; and that he is a citizen of the United States.

JOHN THOMAS, *Justice of the Peace.*”

The above documents appear to be recorded in the third volume of *Transfers of Patent Rights*, pages 155, 156, in the Patent Office of the United States.

On the 27th of December, 1828, a patent was issued as follows.

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“Letters-Patent to W. Woodworth.

“The United States of America to all to whom these letters-patent shall come :

“Whereas William Woodworth, a citizen of the United States, hath alleged that he has invented a new and useful improvement in the method of planing, tonguing, grooving, and cutting into mouldings, or either, plank, boards, or any other material, and for reducing the same to an equal width and thickness ; and also for facing and dressing brick, and cutting mouldings on, or facing, metallic, mineral, or other substances, which improvements, he states, have not been known or used before his application ; hath made oath that he does verily believe that he is the true inventor or discoverer of the said improvement ; hath paid into the treasury of the United States the sum of thirty dollars, delivered a receipt for the same, and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said improvements, and praying that a patent may be granted for that purpose. These are, therefore, to grant, according to law, to the said William Woodworth, his heirs, administrators, or assigns, for the term of fourteen years from the 27th of December, 1828, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said William Woodworth himself, in the schedule hereto annexed, and is made a part of these presents.

“In testimony whereof, I have caused these letters to be made patent, and the seal of the United States to be hereunto affixed. Given under my hand, at the [L. s.] city of Washington, this 27th day of December, in the year of our Lord 1828, and of the independence of the United States of America, the fifty-third.

(Signed,)

J. Q. ADAMS.

“By the President.

(Signed,) H. CLAY, *Secretary of State.*”

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Certificate of William Wirt, Attorney-General of the United States.

“ *City of Washington, to wit :*

“ I do hereby certify, that the foregoing letters-
[* 650] patent were * delivered to me on the 27th day of
December, in the year of our Lord 1828, to be
examined ; that I have examined the same, and find them
conformable to law ; and I do hereby return the same to the
Secretary of State, within fifteen days from the date afore-
said, to wit, on this 27th day of December, in the year afore-
said.

WM. WIRT,

Attorney-General of the United States.”

Schedule.

“ The schedule referred to in these letters-patent, and making part of the same, containing a description, in the words of the said William Woodworth himself, of his improvement in the method of planing, tonguing, grooving, and cutting into mouldings, or either, plank, boards, or any other material, and for reducing the same to an equal width and thickness ; and also for facing and dressing brick, and cutting mouldings on, or facing, metallic, mineral, or other substances.

“ The plank, boards, or other material, being reduced to a width by circular saws or friction-wheels, as the case may be, is then placed on a carriage, resting on a platform, with a rotary cutting-wheel in the centre, either horizontal or vertical. The heads or circular plates, fixed to an axis, may have one of the heads movable, to accommodate any length of knife required. The knife fitted to the head with screws or bolts, or the knives or cutters for moulding fitted by screws or bolts to logs, connecting the heads of the cylinder, and forming with the edges of the knives or cutters a cylinder. The knives may be placed in a line with the axis of the cylinder, or diagonally. The plank, or other material resting on the

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carriage, may be set so as to reduce it to any thickness required; and the carriage, moving by a rack and pinion, or rollers, or any lateral motion, to the edge of the knives or cutters on the periphery of the cylinder or wheel; reduces it to any given thickness. After passing the planing and reducing wheel, it then approaches, if required, two revolving cutter-wheels, one for cutting the groove, and the other for cutting the rabbets that form the tongue; one wheel is placed directly over the other, and the lateral motion moving the plank, or other material, between the grooving and rabbeting wheels, so that one edge has a groove cut the whole length, and the other edge a rabbet cut on each side, leaving a tongue to match the groove. The grooving-wheel is a circular plate fixed on an axis, with a number of cutters attached to it to project beyond the periphery of the plate, so that when put in motion it will perform a deep cut or groove, parallel with the face of the plank or other material. The rabbeting-wheel, also of similar form, having a number of cutters on each side of the plate, projecting like those on the grooving-wheel, cuts the rabbet on the side of the edge of the plank, and leaves the tongue or match for the *groove. By placing the planing-wheel axis and [* 651] cutter-knives vertical, the same wheel will plane two planks or other material in the same time of one, by moving the plank or other material opposite ways, and parallel with each other against the periphery of the planing or moulding wheel. The groove and tongue may be cut in the plank or other material at the same time, by adding a grooving and rabbeting wheel.

“Said William Woodworth does not claim the invention of circular saws or cutter-wheels, knowing they have long been in use; but he claims as his invention the improvement and application of cutter or planing wheels to planing boards, plank, timber, or other material; also his improved method of cutters for grooving and tonguing, and cutting mouldings on

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wood, stone, iron, metal, or other material, and also for facing and dressing brick ; as all the wheels may be used single and separately for moulding, or any other purpose before indicated. He also claims, as his improved method, the application of circular saws for reducing floor plank, and other materials, to a width.

“ Dated Troy, December 4th, 1828.

WILLIAM WOODWORTH.

“ HENRY EVERTS, }
D. S. GLEASON, } Witnesses.”

On the 25th of April, 1829, one Uri Emmons obtained a patent for a new and useful improvement in the mode of planing floor-plank, and grooving, and tonguing, and straightening the edges of the same, planing boards, straightening and planing square timber, &c., by machinery, at one operation, called the cylindrical planing machine. The said letters-patent, and specification attached thereto, being in the following words and figurès.

Uri Emmons's Patent.

“ United States of America to all to whom these letters-patent shall come.

“ Whereas, Uri Emmons, a citizen of the United States, hath alleged that he has invented a new and useful improvement in the mode of planing floor-plank and grooving and tonguing the edges of the same, planing boards, straightening and planing square timber, &c., by machinery, at one operation, called ‘ the cylindrical planing machine,’ which improvement he states has not been known or used before his application, hath made oath that he does verily believe that he is the true inventor or discoverer of the said improvement, hath paid into the treasury of the United States the sum of thirty dollars, delivered a receipt for the same, and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said improvement, and

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praying that a patent may be granted for that purpose. These are therefore to grant, according to law, to the said Uri Emmons, his * heirs, administrators, or [* 652] assigns, for the term of fourteen years from the twenty-fifth day of April, one thousand eight hundred and twenty-nine, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given, in the words of the said Uri Emmons himself, in schedule hereto annexed, and is made a part of these presents.

“In testimony whereof, I have caused these letters to be made patent, and the seal of the United States to be hereunto affixed.

“Given under my hand, at the city of Washington, this twenty-fifth day of April, in the year of our Lord one thousand eight hundred and twenty-nine, and of the independence of the United States of America the fifty-third.

[SEAL.] (Signed,) ANDREW JACKSON.

“By the President.

(Signed,) M. VAN BUREN.”

“*City of Washington, to wit: —*

“I do hereby certify that the foregoing letters-patent were delivered to me on the twenty-fifth day of April, in the year of our Lord one thousand eight hundred and twenty-nine, to be examined; that I have examined the same, and find them conformable to law; and I do hereby return the same to the Secretary of State, within fifteen days from the date aforesaid, to wit, on the twenty-fifth day of April in the year aforesaid.

(Signed,)

J. MACPHERSON BERRIEN,
Attorney-General of the United States.”

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Schedule.

“The schedule referred to in these letters-patent, and making part of the same, containing a description, in the words of the said Uri Emmons himself, of his improvement in the mode of planing floor-plank, and grooving, and tonguing, and straightening the edges of the same, planing boards, straightening and planing square timber, &c., by machinery, at one operation, called the cylindrical planing machine.

“The machinery for the improvement consists, —

“1st. Of a frame of wood or metal.

“2d. Of the gear and fixtures combined and connected together for the above-named operation, the principle of which consists in running the plank, boards, or timber over, under, or at the sides of a cylinder of wood or metal, on which knives are placed, straight or spiral, with their edges exactly corresponding with each other, having from two to twelve knives or edges; also burrs or saws, similar to those used for cutting teeth in brass wheels, to groove and tongue the edge of the boards or plank as they pass through between rollers, or on a carriage, by the surface of the cylinder. [* 653] der. *The shape, form, and construction of the above principle may be varied in shape and position, dimensions, &c., still the same in substance, — the same principle producing the same effect. I have, by experimental operation, found that the following mode in form is the best:

“1st. A frame composed of two pieces of timber, from twelve to eighteen feet long, about six by ten inches broad, placed about fifteen inches apart, framed together with four girths, one at each end, and at equal distances from the centre, and flush with the under side. This frame is supported by posts of a proper length, framed into the under side of the above pieces of timber, and braced so as to be of sufficient strength, to maintain the operative posts. There is placed a roller in the centre, of metal or hard wood, across the frame,

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the surface of the roller being even with the surface of the frame; directly above, and parallel with this roller, is hung the cylinder, with two or four spiral edges or knives, six to ten inches diameter, and hung on a cast-steel arbor, resting in movable boxes attached to the sides of the frame, so as to set the cylinder up and down from the roller, to give the thickness of the timber to be planed. On each side of the cylinder is placed a pair of feeding-rollers, of hard wood or metal, the under one of each pair being level with the centre one. The upper ones are hung in boxes, which are pressed down with springs or weights, so that when the timber comes between them, they will hug and carry it through. These rollers are connected and turned by wheels, at a velocity of about twelve feet surface of the roller per minute. The cylinder with two edges to make about two thousand five hundred revolutions per minute, cutting five thousand strokes every twelve feet; this can be varied according to the number of edges, power, and velocity of the different parts. The power is attached to the cylinder by a bolt running on a pulley, on the outward end of the cylinder shaft. Each way from the feeding rollers is placed rollers about two feet apart for the timber to rest on while running through. On one side of the frame is fastened a straight edge, to serve as a guide, lined with metal; on the other side, rollers are placed in a piece of timber, which is pressed up to the plank or board to keep it close to the guide or straight edge by a spring. The grooving and tonguing is done by burrs or circular cutters similar to a saw; these burrs are hung on perpendicular spindles, the arbors of which rest in boxes attached to the inward side of the frame, a burr on one side to cut the groove, and on the other is placed two burrs, just as far apart as the thickness of the above one, for cutting the groove. At or near one end of the frame is hung a shaft, with a drum or roller, from which belts pass over to pulleys on each spindle of the burrs or circular cutters, which must have about the

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same velocity of the cylinder. These burrs are placed on one side of the cylinder, opposite to each other, so [* 654] * as to cut the tongue to match the groove; on the other side of the cylinder is an arbor parallel with the cylinder, on which is placed circular cutters for planing the edges of the board or plank as they pass through. The cutter on the side next to the guide is stationary on the arbor; the opposite one is movable in the arbor, but fastened with screws to set it for different widths. A belt runs from a pulley on the end of the arbor, outside the frame, to the said drum, as also the same from the cylinder, each having about the same motion. The feeding-rollers are put in motion by a belt from the slow part of the driving power. I have also put in operation a carriage for feeding, but rollers save the time of running the carriage back.

“Now, what I, the said Uri Emmons, consider and claim as my improvement, and for which I solicit a patent, is as follows, namely:—

1st. The principle of planing boards and plank with a rotary motion, with knives or edges on a cylinder, placed on the same, straight or spiral, as before described, which I put in operation at Syracuse, in the county of Onondaga, in the State of New York, in the early part of the year 1824.

“2d. The burrs for grooving and tonguing, in contradistinction from the mode used by William Woodworth, he using the duck-bill cutters.

“3d. The feeding, by running the timber through on a carriage, or between feeding-rollers, guided by a straight edge, as before described.

“In testimony that the foregoing is a true specification of my said improvement, as before described, I have hereunto set my hand and seal, the eighth day of April, in the year of our Lord one thousand eight hundred and twenty-nine.

(Signed,)

URI EMMONS.

“Witnesses—THOS. THOMAS, SILAS HATHAWAY.”

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On the 16th of May, 1829, the said Emmons sold his entire interest in the last mentioned patent to Daniel H. Toogood, Daniel Halstead, and William Tyack, by the following instrument :

Deed from Emmons to Toogood, Halstead, and Tyack.

“ Whereas Uri Emmons, of the State of New York, machinist, has received letters-patent of the United States of America, dated April 25th, one thousand eight hundred and twenty-nine, [for] the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, a new and useful improvement in the mode of planing floor-plank; and grooving, and tonguing, and straightening the edges of the same, planing boards, straightening and planing square timber, &c., by machinery, at one operation, called the cylindrical planing machine.

* “ Now, know all men by these presents, that [* 655] I, Uri Emmons, of the city of New York, in consideration of five dollars, to me in hand paid by Daniel H. Toogood, Daniel Halstead, and William Tyack, all of said city of New York, who fully viewed and considered the said improvement, and the said patent and specifications therein contained, have granted, sold, and conveyed, and by these presents do grant, sell, and convey, to the said Daniel H. Toogood, Daniel Halstead, and William Tyack, their heirs, executors, administrators, and assigns, the full and exclusive right and liberty derived from the said patent, of making, using, and vending to others to be made, used, and sold, the said improvement, within and throughout the United States of America. To have and to hold and enjoy all the privileges and benefits which may in any way arise from the said improvement by virtue of said letters-patent. And I do hereby empower the said Daniel H. Toogood, Daniel Halstead, and William Tyack, their heirs, executors, administrators, and assigns, to commence and prosecute to final judg-

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ment and execution, at their own cost, any suit or suits against any person or persons who shall make, use, or vend the said improvement, contrary to the intent of the said letters-patent and law in such case made and provided, and to receive, for their own benefit, the avails thereof, in such manner as I might do.

“In witness whereof, I have hereunto set my hand and seal, this sixteenth day of May, in the year of our Lord one thousand eight hundred and twenty-nine.

URI EMMONS. [SEAL.]

“Witnesses, THOMAS AP THOMAS.
ALEX. DEDDER.”

“*City and County of New York, ss. :*

“Be it remembered, that on the sixteenth day of May, in the year of our Lord one thousand eight hundred and twenty-nine, before me, personally appeared Uri Emmons, known to me to be the person described in, and who executed the within deed, and acknowledged that he executed the same for the purposes therein mentioned; and there being no material alterations, erasures, or interlineations, I allow the same to be recorded.

THOMAS THOMAS, *Commissioner, &c.*”

On the 28th of November, 1829, the following mutual deed of assignment was executed between Woodworth and Strong, on the one part, and Toogood, Halstead, Tyack, and Emmons, on the other part, by which Woodworth and Strong convey to Toogood, Halstead, and Tyack all their interest in the patent of December 27th, 1828, in the following places, namely:—In the city and county of Albany, in the State of New York; in the State of Maryland, except the western part which lies west of the Blue Ridge; in Tennessee, Alabama, South Carolina, Georgia, the Floridas, Louis-

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iana, * Missouri, and the territory west of the [* 656] Mississippi; and Toogood, Halstead, Tyack and Emmons conveyed to Strong and Woodworth all their interest in Emmons's patent of 25th April, 1829, for the rest and residue of the United States; by which mutual deed of assignment the parties agreed, that any improvement in the machinery, or alteration, or renewal of either patent, such improvement, alteration, or renewal should accrue to the benefit of the respective parties in interest, and might be applied and used within their respective districts.

Mutual Deed between Woodworth, Strong, Toogood, Halstead, Tyack, and Emmons.

“Know all men by these presents, that William Woodworth, now of the city of New York, the patentee of an improved method of planing, tonguing, grooving, &c., &c., plank, boards, &c., by letters-patent from the United States, dated December 29th, 1828, and James Strong, of the city of Hudson, in the State of New York, the assignee of one equal half of the rights and interests secured by the aforesaid letters-patent, of the one part, and Uri Emmons, of the city of New York, the patentee of an improvement in the mode of planing floor-plank, and grooving, tonguing, and straightening the edges of the same, &c., by letters-patent from the United States, dated April 25th, 1829, and Daniel H. Toogood, Daniel Halstead, and William Tyack, of the city of New York, the assignees, by deed dated the 16th day of May, 1829, of all the rights and interest secured by the last aforesaid patent to said Emmons, of the other part, in consideration of the following covenants and agreements, do hereby covenant and agree as follows:—

“First. The said Woodworth and Strong, and their assigns, have, and hereby do assign to the said Toogood, Halstead, and Tyack, and their assigns, all their right and interest

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in the aforesaid patent to William Woodworth, to be sold and used, and the plank or other materials prepared thereby to be vended and used, in the following places, namely: — In the city and county of Albany, in the State of New York; in the State of Maryland, except the western part thereof which lies west of the Blue Ridge; in Tennessee, Mississippi, Alabama, South Carolina, Georgia, the Floridas, Louisiana, and the territory west of the River Mississippi, and not in any other State or place within the limits of the United States or the Territories thereof. To have and to hold the rights and privileges hereby granted to them and their assigns for and during the term of fourteen years from the date of the patent; and they are also authorized to prosecute, at their own costs and charges, any violation of the said patent, in the same manner as the patentee, Woodworth, might lawfully do.

“Secondly. The said Emmons, Toogood, Halstead, [* 657] and Tyack, *in consideration aforesaid, have, and hereby do covenant and agree to assign, and do assign, for themselves and assigns, to the said Woodworth and Strong and their assigns, all their right and interest in the aforesaid patent granted to the said Uri Emmons, to be sold and used, and the plank or other material prepared thereby to be vended and used, in all and singular the rest and residue of the United States, and the Territories thereof, that is to say, in all places other than in those especially assigned to the said Toogood, Halstead, and Tyack, as aforesaid. To have and to hold the said rights and privileges hereby granted to them and their assigns for and during the term of fourteen years from the date of the said letters-patent to the said Uri Emmons; and they are also authorized to prosecute, at their own costs and charges, any violation of the said patent, in the same manner as the patentee, Uri Emmons, might lawfully do.

“Thirdly. And the two parties further agree, that any improvement in the machinery, or alteration, or renewal of

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either patent, such alteration, improvement, or renewal shall accrue to the benefit of the respective parties in interest, and may be applied and used within their respective districts as hereinbefore designated.

“Witness our hands and seals, at the city of New York, the 28th of November, 1829.

WILLIAM WOODWORTH.	[SEAL.]
JAMES STRONG.	[SEAL.]
WILLIAM TYACK.	[SEAL.]
D. H. TOOGOOD.	[SEAL.]
DANIEL HALSTEAD.	[SEAL.]
URI EMMONS.	[SEAL.]

“Sealed and delivered in presence of

THOMAS AP THOMAS,

Witness to the signing of Toogood, Tyack,
Halstead, and Emmons.”

Under this mutual assignment, the respective parties and their assignees would possess the following rights, namely: if they claimed under Woodworth's patent, to use the same for fourteen years from the 29th of December, 1828, that is to say, until the 29th of December, 1842; and if they claimed under Emmons's patent, to use the same for fourteen years from the 25th of April, 1829, that is to say, until the 25th of April, 1843.

On one or the other of these days, therefore, if things had remained in the same condition, all rights either in the patentees or their assignees would have ceased, as far as respected an exclusive use of the thing patented.

In 1836, Congress passed an act from which the following is an extract, and the construction of which was the chief controversy. (Act approved 4th July, 1836, ch. 357, 5 Little & Brown's ed. 117, *§ 18.) “And [* 658] be it further enacted, that whenever any patentee

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of an invention or discovery shall desire an extension of his patent beyond the term of its limitation, he may make application therefor, in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof; and the commissioner shall, on the applicant's paying the sum of forty dollars to the credit of the treasury, as in the case of an original application for a patent, cause to be published in one or more of the principal newspapers in the city of Washington, and in such other paper or papers as he may deem proper, published in the section of country most interested adversely to the extension of the patent, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. And the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury shall constitute a board to hear and decide upon the evidence produced before them, both for and against the extension, and shall sit for that purpose at the time and place designated in the published notice thereof. The patentee shall furnish to the said board a statement in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit, in any manner accruing to him, from and by reason of said invention. And if, upon a hearing of the matter, it shall appear to the full and entire satisfaction of said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault upon his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the commissioner to renew and extend the patent, by making a certificate thereon of such extension, for the term

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of seven years from and after the expiration of the term; which certificate, with a certificate of said board of their judgment and opinion as aforesaid, shall be entered on record in the Patent Office; and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years. And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interest therein. Provided, however, that no extension of a patent shall be granted after the expiration of the term for which it was originally issued."

On the 3d of February, 1839, William Woodworth, the patentee, died; and on the 14th of February, 1839, William W. Woodworth took out letters of administration upon his estate, in the county of New York.

In 1842, William W. Woodworth, the administrator, applied for * an extension of the patent [* 659] under the above-recited Act of 1836, and on the 16th of November, 1842, the board issued the following certificate.

"In the matter of the application of William W. Woodworth, administrator of the estate of William Woodworth, deceased, in writing to the Commissioner of Patents for the extension of the patent for a new and useful improvement in the method of planing, tonguing, and grooving, and cutting into mouldings, or either, plank, boards, or any other material, and for reducing the same to an equal width and thickness; and also for facing and dressing brick, and cutting mouldings on, or facing, metallic, mineral, or other substances, granted to the said William Woodworth, deceased, on the 27th day of December, 1828, for fourteen years from said 27th day of December.

"The applicant having paid into the treasury the sum of

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forty dollars, and having furnished to the undersigned a statement in writing, under oath, of the ascertained value of the invention, and of the receipts and expenditures thereon, sufficiently in detail to exhibit a true and faithful account of loss and profits in any manner accruing to said patentee from or by reason of said invention; and notice of application having been given by the Commissioner of Patents, according to law, said board met at the time and place appointed, namely, at the Patent Office, on the 1st September, 1842, and their meetings having been continued by regular adjournments until this 16th day of November, 1842, they, on that day, heard the evidence produced before them, both for and against the extension of said patent, and do now certify, that, upon hearing of the matter, it appears to their full and entire satisfaction, having due regard to the public interest therein, that it is just and proper that the term of the said patent should be extended, by reason of the patentee, without neglect on his part, having failed to obtain from the use and sale of his invention a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use.

“ Washington city, Patent Office, November 16th, 1842.

DANIEL WEBSTER,
Secretary of State.

CHAS. B. PENROSE,
Solicitor of the Treasury.

HENRY L. ELLSWORTH,
Commissioner of Patents.”

And on the same day the Commissioner of Patents issued the following certificate.

“ Whereas, upon the petition of William W. Woodworth, administrator of the estate of William Woodworth, deceased,

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for an * extension of the within patent, granted to [* 660] William Woodworth, deceased, on the 27th day of December, 1828. The board of Commissioners, under the eighteenth section of the Act of Congress approved the 4th day of July, 1836, entitled an Act to promote the progress of useful arts, to repeal all acts and parts of acts heretofore made for that purpose, did, on the 16th day of November, 1842, certify that the said patent ought to be extended.

“ Now, therefore, I, Henry L. Ellsworth, Commissioner of Patents, by virtue of the power vested in me by said eighteenth section, do renew and extend said patent, and certify that the same is hereby extended for the term of seven years from and after the expiration of the first term, namely, the 27th day of December, 1842, which certificate of said board of commissioners, together with this certificate of the Commissioner of Patents, having been duly entered of record in the Patent Office, the said patent now has the same effect in law as though the term had been originally granted for the term of twenty-one years.

[SEAL.] “ In testimony whereof, I have caused the seal of the Patent Office to be hereunto affixed, this 16th day of November, 1842.

HENRY L. ELLSWORTH,
Commissioner of Patents.”

On the 2d of January, 1843, William W. Woodworth, the administrator, filed the following disclaimer.

“ To all men to whom these presents shall come, I, William W. Woodworth, of Hyde Park, in the county of Dutchess and State of New York, Esq., as I am administrator of the goods and estate which were of William Woodworth, deceased, hereinafter named, send greeting :

“ Whereas letters-patent, bearing date on the twenty-

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seventh day of December, in the year of our Lord eighteen hundred and twenty-eight, were granted by the United States to William Woodworth, now deceased, for an improvement in the method of planing, tonguing, grooving, and cutting into mouldings, or either, boards, plank, or any other material, and for reducing the same to an equal width and thickness; and also for facing and dressing brick, and cutting mouldings on, or facing, metallic, mineral, or other substances. And whereas, before the term of fourteen years, for which the said letters-patent were granted, had fully expired, such proceedings were had that, pursuant to the act of Congress in such case made and provided, the said letters-patent were renewed or extended for the term of seven years from and after the expiration of the said term of fourteen years, and to the certificate granting the said extension and renewal unto me in my said capacity, bearing date on the sixteenth day of November now last past, and which is duly recorded according to act of Congress in that behalf, reference is * hereby made, as showing my title and interest in and to the said letters-patent.

“And whereas the said William Woodworth, through inadvertence, accident, or mistake in his application for letters-patent, made his specification of claim too broad, in this, namely, that he, the said William Woodworth, claimed as his improved method the application of circular saws for reducing floor-plank and other material to width, of which he was not the original and first inventor. And whereas some material and substantial part of the said patented thing was justly and truly the invention and improvement of the said William Woodworth.

“Now therefore know ye, that I, the said William W. Woodworth, in my capacity aforesaid, and as the person to whom the said certificate was granted as aforesaid, have disclaimed, and do by these presents, for myself, and for all claiming

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under me, disclaim, all and any exclusive right, title, property, or interest of, in, or to the application of circular saws for reducing floor-plank or other materials to a width, by reason of the aforesaid letters-patent, and the aforesaid renewal or extension thereof.

“In testimony whereof, I have hereto, in my capacity aforesaid, set my hand and seal, on this second day of January; in the year eighteen hundred and forty-three.

WILLIAM W. WOODWORTH,

Administrator of W. Woodworth, deceased.

[SEAL.]

“Executed in presence of

CHAS. W. EMESN,

B. R. CURTIS.”

In March, 1843, Woodworth, the administrator, made an assignment of his patent-rights in some of the States to James G. Wilson, the plaintiff. At what time the assignment was made for New York, the record in that case did not state, but it was one of the admitted facts that he was the grantee. The assignment first referred to was recorded in the Patent Office, in Liber 4, pp. 291, 292, on the 20th of March, 1843.

On the 9th of August, 1843, the administrator assigned his right to Wilson, in and for the State of Maryland.

On the 26th of February, 1845, Congress passed the following act.

“An Act to extend a Patent heretofore granted to William Woodworth.

“Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the patent granted to William Woodworth on the twenty-seventh day of December, in the year one thousand eight hundred and twenty-eight, for his improvement on the

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method of planing, tonguing, grooving, and cutting [* 662] into mouldings, or either, plank, boards, or * any other material, and for reducing the same to an equal width and thickness; and also for facing and dressing brick, and cutting mouldings on and facing several other substances, a description of which is given in a schedule annexed to the letters-patent granted as aforesaid, be, and the same is, hereby extended for the term of seven years from and after the 27th day of December in the year one thousand eight hundred and forty-nine; and the Commissioner of Patents is hereby directed to make a certificate of such extension in the name of the administrator of the said William Woodworth, and to append an authenticated copy thereof to the original letters-patent, whenever the same shall be requested by the said administrator or his assigns.

“Approved February 26, 1845.

“A true copy from the roll of this office.

R. K. CRALLE, *Chief Clerk.*

“*Department of State, March 3, 1845.*”

And on the 3d of March, 1845, the following certificate was issued.

“In conformity, therefore, with the directions in the said act contained, I, Henry L. Ellsworth, Commissioner of Patents, do hereby certify, that the patent therein described is, by the said act, extended to William W. Woodworth, administrator of said William Woodworth, for the term of seven years from and after the twenty-seventh day of December, in the year one thousand eight hundred and forty-nine; and this certificate of such extension is made on the original letters-patent, on the application of William W. Woodworth, the administrator of the said William Woodworth.

“In testimony whereof, I have caused the seal of the Pa-

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tent Office to be hereunto affixed, this 3d day of March, 1845.

[L. s.]

HENRY L. ELLSWORTH,
Commissioner of Patents."

On the 8th of July, 1845, a new patent was issued, with an amended specification as follows:—

"The United States of America to all to whom these letters-patent shall come:

"Whereas, William W. Woodworth, administrator of William Woodworth, deceased, of Hyde Park, N. Y., has alleged that said William Woodworth invented a new and useful improvement in machines for planing, tonguing, and grooving, and dressing boards, &c., for which letters-patent were granted, dated the 27th day of December, 1828, which letters-patent have been extended (as will appear by the certificates appended thereto, copies of which are hereunto attached) for fourteen years from the expiration of said letters-patent; and which letters-patent are hereby cancelled on *account of a defective specification, [* 663] which he states has not been known or used before said William Woodworth's application; has made oath that he is, and that said William Woodworth was, a citizen of the United States; that he does verily believe that said William Woodworth was the original and first inventor or discoverer of the said improvement, and that the same hath not, to the best of his knowledge and belief, been previously known or used; has paid into the treasury of the United States the sum of fifteen dollars, and presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose.

"These are, therefore, to grant, according to law, to the said William W. Woodworth, in trust for the heirs at law of

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said W. Woodworth, their heirs, administrators, or assigns, for the term of twenty-eight years from the twenty-seventh day of December, one thousand eight hundred and twenty-eight, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said William W. Woodworth, in the schedule hereunto annexed, and is made part of these presents.

"In testimony whereof, I have caused these letters to be made patent, and the seal of the Patent Office has [L. s.] been hereunto affixed.

"Given under my hand, at the city of Washington, this eighth day of July, in the year of our Lord one thousand eight hundred and forty-five, and of the independence of the United States of America the seventieth.

JAMES BUCHANAN,
Secretary of State."

"Countersigned, and sealed with the seal of the Patent Office.

HENRY H. SYLVESTER,
Acting Commissioner of Patents."

"The schedule referred to in these letters-patent, and making part of the same: —

"To all whom it may concern: — Be it known, that the following is a full, clear, and exact description of the method of planing, tonguing, and grooving plank or boards, invented by William Woodworth, deceased, and for which letters-patent of the United States were granted to him on the 27th day of December, in the year one thousand eight hundred and twenty-eight; the said letters-patent having been surrendered for the purpose of describing the same invention, and pointing out in what it consists, in more clear, full, and exact terms than was done in the original specification.

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* "*Amended Specification.* [* 664]

"The plank or boards which are to be planed, tongued, or grooved are first to be reduced to a width by means of circular saws, by reducing-wheels, or by any other means. When circular saws are used for this purpose, two such saws should be placed upon the same shaft, on which they are to be capable of adjustment, so that they may be made to stand at any required distance apart; under these the board or plank is to be forced forward, and brought to the width required; this apparatus and process do not require to be further explained, they being well understood by mechanics.

"When what has been above denominated reducing-wheels are used, these are to consist of revolving cutting-wheels, which resemble in their construction and action the planing and reducing-wheel to be presently described; these are to be made adjustable like the circular saws, but the latter are preferred for this purpose. The plank may be reduced to a width on a separate machine.

"When the plank or boards have been thus prepared (on a separate machine) they may be placed on or against a suitable carriage, resting on a frame or platform, so as to be acted upon by a rotary cutting or planing and reducing-wheel; which wheel may be made to revolve either horizontally or vertically, as may be preferred. The carriage which sustains the plank or board to be operated upon may be moved forwards by means of a rack and pinion, by an endless chain or band, by geared friction-rollers, or by any of the devices well known to machinists for advancing a carriage or materials to be acted upon in machines for various purposes. The plank or board is to be moved on towards the cutting edges of the cutters or knives, on the planing-cylinder, so that its knives or cutters, as they revolve, may meet and cut the plank or board in a direction contrary to that in which it is made to

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advance; the edges of the cutters are, in this method, prevented from coming first into contact with its surface, and are made to cut upwards from the reduced part of the plank towards said surface, by which means their edges are protected from injury by gritty matter, and the board or plank is more evenly and better planed than when moved in the reversed direction.

“After the board or plank passes the planing-cylinder, and as soon, or fast, as the planing-cylinder has done its work on any part of the board or plank, the edges are brought into contact with two revolving cutter-wheels, one of which wheels is adapted to the cutting of the groove, and the other to the cutting of the two rebates that form the tongue. When the axis of the planing and reducing-wheel stands vertically, the grooving and tonguing wheels are placed one above [* 665] the other, with the plank edgewise between * them; when the axis of the planing-wheel stands horizontally, these wheels are on the same horizontal plane with each other, standing on perpendicular spindles.

“The grooving-wheel consists of a circular plate fixed on an axis, and having one, two, three, four, or more cutters, which are to be screwed, bolted, or otherwise attached to it, the edges of which cutters project beyond the periphery of the plate to such distance as is required for the depth of the groove; their thickness may be such as is necessary for its width; they are, of course, so situated as to cut the groove in the middle of the edge of the board, or as nearly so as may be required. The tonguing-wheel is similar in form to the grooving-wheel, but it has cutters on each of its sides, or otherwise, so formed and arranged as to cut the two rebates which are necessary to the formation of the tongue.

“The grooving and tonguing cutters, at the same time and by the same operation, reduce the board or plank to an exact width throughout. When the axis of the planing-wheel is

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placed vertically, the knives or cutters may be made to plane two planks at the same time ; the planks being in this case moved in contrary directions, and so as to meet the edges of the revolving knives or cutters. When the machine is thus constructed, a second pair of grooving and tonguing wheels may be made to operate in the same way with those above described. A machine to operate upon a single plank or board, and having the axis of the planing-wheel placed horizontally, will however be more simple and less expensive than that intended to operate on two planks simultaneously.

“In the accompanying drawing, fig. 1 is a perspective representation of the principal operating parts of the machine when arranged and combined for planing, tonguing, and grooving ; and when so arranged as to be capable of planing two planks at the same time, the axis of the planing-wheel being placed vertically. A A is a stout substantial frame of the machine, which may be of wood or iron, and may be varied in length, size, and strength, according to the work to be done. B B are the heads of the planing-cylinder, and C C the knives or cutters, which extend from one to the other of said heads, to the peripheries of which they may be attached by means of screws. The knives C C, with the faces forming a planing angle, may be placed in a line with the axis, J, of the cylinder, or they may stand obliquely thereto, as may be preferred ; but in the latter case the edge should form the segment or portion of a helix ; *b* represents a pulley near to the upper end of the axis J ; and I, a pulley or drum, which may be made to revolve by horse, steam, or other motive power, and from which a belt may extend around the pulley *b*, to drive the planing-cylinder and other parts of the machinery ; G is the carriage, which is represented as being driven forward by means of a rack * and pinion, H ; [* 666] against this carriage, the plank K, which is to be planed, tongued, and grooved, is placed, and is made to ad-

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vance with it. It will be manifest, however, that the plank may be moved forward by other means, as, for example, by an endless chain or band, passing around drums or chain-wheels, or by means of geared friction-wheels borne up against it. To cause the carriage and plank to move forward readily, there may be friction-rollers, *fff*, placed horizontally, and extending under them; the rollers, *fff*, which stand vertically, are to be made to press against the plank and keep it close to the carriage, and thus prevent the action of the cutters from drawing the plank up from its bed in cutting from the planed surface upwards; they may be borne against it by means of weights or springs, in a manner well known to machinists. In a single horizontal machine, the horizontal friction-rollers may be geared, and the pressure-rollers placed above them to feed the board with or without the carriages, a bed-plate being used directly under the planing-cylinder.

“ Fig. 2 is a separate view of the planing-cylinder, with its knives or cutters; and fig. 3, an end view of one of the heads. E E are the revolving cutters, or tonguing and grooving-wheels, and D D, whirls upon their shafts, which may be driven by bands, or otherwise, so as to cause said wheels to revolve in the proper direction.

“ Fig. 4 is a side view of one of these wheels; fig. 5 is an edge view of the tonguing-wheel; and fig. 6, an edge view of the grooving-wheel; the latter being each shown with two cutters in place. The number of cutters on these wheels may be varied, but they are represented and furnished with four. The cutters may be fixed on the sides of circular plates, with their edges projecting beyond the periphery of said plate.

“ The edges of the plank, as its planed part passes the planing-cylinder, are brought in contact with the above-described tonguing and grooving-wheels, which are so placed upon their shafts as that the tongue and groove shall be left at the proper distance from the face of the plank, the latter

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being sustained against the planing-cylinder by means of the carriage or bed-plate, or otherwise, so that it cannot deviate, but must be reduced to a proper thickness, and correctly tongued and grooved.

" In fig. 1, above referred to, only one carriage and one pair of cutter-wheels are shown, it not being deemed necessary to represent those on the opposite side, they being similar in all respects.

" Fig. 7 represents the same machine, with the axis of the planing-cylinder placed horizontally, and intended to operate on one plank only at the same time. A A is the frame; B B, the heads of the planing-cylinder; C C, the knives or cutters attached to said heads. To meet the different thicknesses of the planks * or boards, the bearings of the shaft or cylinder may be made movable, by screws or other means, to adjust it to the work; or the carriage or bed-plate may be made so as to raise the board or plank up to the planing-cylinder. E and E' are the revolving cutters, or tonguing and grooving wheels, which are placed upon vertical shafts, having upon them pulleys, D D, around which pass belts or bands from the main drum, I, to which a revolving motion may be given by any adequate motive power.

" From the drum, I, a belt, L, passes also around the pulley, b, on the shaft of the planing-cylinder, and gives to it the requisite motion. There may in this machine be a horizontal carriage moved forward by a rack and pinion, in a manner analogous to that represented in fig. 1; but in the present instance the plank is supposed to be advanced by means of one or two pairs of friction or feed rollers, shown at *f f'*; the uppermost, *f f'*, of the pairs of rollers may be held down by springs, or weighted levers, which it has not been thought necessary to show in this drawing, as such are in common use. The lowermost of these rollers may be fluted or made rough on their surfaces, so as to cause friction on the under side of the

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plank. M M' are pulleys on the axes of these lower rollers which are embraced by bands, N N', which also pass around a pulley, O, on a shaft which crosses the frame, A A, and has a pulley, T, on it, which is embraced by the belt, P, on a pulley, Q, on the shaft of the main drum, I; these bands and pulleys serve to give motion to the feed-rollers, as will be readily understood by inspecting the drawing. R R are guide-strips, used in place of the rollers used for the same purpose, and also for bearing or friction rollers, when the machine is vertical, to direct one edge of the plank, and against its opposite edge; any pressure may be used equal to the weight of the board or plank, when worked in a vertical position. One of the cutter-wheels should be made adjustable, to adapt it to stuff of different widths.

"The planing-cylinder, and likewise the cutter or tonguing and grooving wheels, may be constructed in the manner represented in figures 2, 3, 4, 5, and 6, and hereinbefore fully described. One of the heads of the planing-wheel may be made movable, to accommodate its width to the width of the boards or plank to be planed.

"The respective parts of this machine may be varied in size, as may also the velocity of the motion of the planing-cylinders and cutter-wheels; but the following has been found to answer well in practice. The planing-cylinder, having four knives or cutters, may be twelve inches in diameter, and may make two thousand and upwards revolutions in a minute. In a machine like that shown in fig. 7, the main drum, I, may be two feet in diameter, and may be driven with the speed of five hundred, and upwards, revolutions in a minute.

[* 668] The pulleys on the planing-cylinder, and on * the cutter-wheels, may be six inches in diameter. The plank should be moved forward at the rate of about one foot for every hundred revolutions of the cutter-wheel; and, of course, the diameter of the feed-rollers and of the pulleys by which they are turned must be so graduated as to produce

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this result. The size and speed of the above parts of this machine may be in some degree varied ; but the above have been found to work well.

“ Having thus fully described the parts and combination of parts, and operation of the machine for planing, tonguing, and grooving boards or plank, and shown various modes in which the same may be constructed and made to operate without changing the principle or mode of operation of the machine, what is claimed therein as the invention of William Woodworth, deceased, is the employment of rotating planes, substantially such as herein described, in combination with the rollers, or any analogous device, to prevent the boards from being drawn up by the planes when cutting upwards, or from the reduced or planed to the unplanned surface, as described.

“ And also the combination of the rotating planes with the cutter-wheels for tonguing and grooving, for the purpose of planing, tonguing, and grooving boards, &c., at one operation, as described. And also the combination of the tonguing and grooving cutter-wheels for tonguing and grooving boards, and at one operation, as described. ”

“ And, finally, the combination of either the tonguing or the grooving cutter-wheel for tonguing or grooving boards, &c., with the pressure-rollers, as described, the effect of the pressure-rollers in these operations being such as to keep the boards, &c., steady, and prevent the cutters from drawing the boards towards the centre of the cutter-wheels, whilst it is moved through by machinery. In the planing operation, the tendency of the plane is to lift the boards directly up against the rollers ; but in the tonguing and grooving, the tendency is to overcome the friction occasioned by the pressure of the rollers.

WILLIAM W. WOODWORTH,

Administrator of William Woodworth, deceased.

“ Witnesses,

JAMES MILHOLLAND,

CHAS. M. KELLER.”

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The above papers show the title of the administrator, who was the grantor of Wilson, the plaintiff in the suit. The record in the New York case was exceedingly brief, and contained neither the declaration nor pleas, but only the state of the pleadings and the existence of demurrers. But from the eighth fact in the statement of facts, in which it is said that "the defendants trace no title to themselves to a right to use said machines from the assignment made by William [* 669] Woodworth and James Strong to Halstead, Toogood, and Tyack," the inference must be, that their defence was in showing an outstanding title.

The following is the the entire case presented by the New York record.

"United States of America, Northern District of New York :

"At a Circuit Court of the United States, begun and held at Albany, for the Northern District of New York, on Tuesday, the twenty-first day of October, in the year of our Lord one thousand eight hundred and forty-five, and in the seventieth year of American independence.

"Present, the Honorable Samuel Nelson and Alfred Conkling, Esquires.

"JAMES G. WILSON

v.

LEWIS ROUSSEAU AND CHARLES EASTON.

"State of the Pleadings.

"This is an action on the case to recover damages for the alleged infringement of letters-patent issued to William Woodworth, on the 27th day of December, 1828, for the term of fourteen years, for an improvement in machinery for planing,

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tonguing, and grooving boards and plank at one operation ; which letters-patent were on the 16th day of November, 1842, extended for seven years more, such extension being granted to William W. Woodworth, as administrator of said William Woodworth.

“ To the first count of the plaintiff’s declaration, the defendants interposed three several special pleas in bar, to each of which pleas the plaintiff demurred, and the defendants joined in demurrer. To the second count of the plaintiff’s declaration, the defendants demurred, and the plaintiff joined in demurrer.

“ The case coming on to be argued at this term, the following questions occurred for decisions, to wit : —

“ 1. Whether the eighteenth section of the Patent Act of 1836, authorized the extension of a patent on the application of the executor or administrator of a deceased patentee.

“ 2. Whether, by force and operation of the eighteenth section of the Act of July 4th, 1836, entitled “ An act to promote the progress of the useful arts,” &c., the extension granted to William W. Woodworth, as administrator, on the 16th day of November, 1842, inured to the benefit of assignees, under the original patent granted to William Woodworth, on the 27th day of December, 1828, or whether said extension inured to the benefit of the administrator only, in his said capacity.

“ 3. Whether the extension specified in the foregoing second point inured to the benefit of the administrator to whom the same * was granted, and to him in [* 670] that capacity exclusively ; or whether, as to the territory specified in the contract of assignment made by William Woodworth and James Strong to Toogood, Halstead, and Tyack, on the 28th day of November, 1829, (and set forth in the second plea of the defendants to the first count of the declaration,) and by legal operation of the covenants

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contained in said contract, the said extension inured to the benefit of the said Toogood, Halstead, and Tyack, or their assigns.

“4. Whether the plaintiff, claiming title under the extension from the administrator, can maintain an action for an infringement of the patent-right within the territory specified in the contract of assignment to Toogood, Halstead, and Tyack, against any person not claiming under said assignment; or whether the said assignment be of itself a perfect bar to the plaintiff’s suit.

“5. Whether the extension specified in the second point could be applied for and obtained by William W. Woodworth, as administrator of William Woodworth, deceased, if the said William Woodworth, the original patentee, had in his lifetime, disposed of all his interest in the then existing patent, having, at the time of his death, no right or title to, or interest in, the said original patent; or whether such sale carried with it nothing beyond the term of said original patent; and, if it did not, whether any contingent rights remained in the patentee or his representatives.

“6. Whether the plaintiff, if he be an assignee of an exclusive right to use two of the patented machines within the town of Watervliet, has such an exclusive right as will enable him to maintain an action for an infringement of the patent within said town; or whether, to maintain such action, the plaintiff must be possessed, as to that territory, of all the rights of the original patentee.

“7. Whether the letters-patent of renewal issued to William W. Woodworth, as administrator aforesaid, on the 8th day of July, 1845, upon the amended specification and explanatory drawings then filed, be good and valid in law; or whether the same be void, for uncertainty, ambiguity, or multiplicity of claim, or any other cause.

“8. Whether the Court can determine, as matter of law,

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upon an inspection of the said two patents and their respective specifications, that the said new patent of the 8th of July, 1845, is not for the same invention for which the said patent of 1828 was granted.

“9. Whether the decision of the Board of Commissioners, who are to determine upon the application for the extension of a patent, under the eighteenth section of the Act of 1836, is conclusive upon the question of their jurisdiction to act in the given case.

“10. Whether the Commissioner of Patents can lawfully receive a surrender of letters-patent for a defective specification, and issue new letters-patent upon an amended specification, after the expiration of the term for which the original patent was granted, and * pending the ex- [* 671] istence of an extended term of seven years; or whether such surrender and renewal may be made at any time during such extended term.

“On which questions the opinions of the judges were opposed.

“Whereupon, on a motion of the plaintiff, by William H. Seward, his counsel, that the points on which the disagreement hath happened may, during the term, be stated under the direction of the judges, and certified under the seal of the Court to the Supreme Court, to be finally decided.

“It is ordered that the foregoing state of the pleadings, and the following statement of facts, which is made under the direction of the judges, be certified, according to the request of the plaintiff by his counsel, and the law in that case made and provided, to wit:—

“1. That William Woodworth, as the inventor of a machine, or improvement in machinery, for planing, tonguing, and grooving boards and plank at one operation, on the 27th day of December, in the year 1828, applied to the proper department of the government for a patent for said invention,

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and upon the same day, on filing his specifications and explanatory drawings, and complying with the other legal prerequisites, letters-patent, signed by the President, and under the seal of the United States, were duly issued to the said William Woodworth, granting to him the exclusive right, throughout the United States, to construct and use, and vend to others to be used, the machine or improvement patented, for and during the term of fourteen years from the said 27th day of December, 1828.

"2. That subsequently, to wit, on the 28th day of November, 1829, the said William Woodworth and James Strong, who had become jointly interested with said Woodworth in the rights secured by the said letters-patent by contract of assignment of that date, transferred to Daniel H. Toogood, Daniel Halstead, and William Tyack all their right and interest in and to the said patent for certain parts and portions of the United States in said contract specifically set forth, including the city and county of Albany, in the State of New York, which is the domicile of the defendants.

"3. That the *habendum* in said contract of assignment is in the words following, to wit:—

"'To have and to hold the rights and privileges hereby granted for and during the term of fourteen years from the date of the patent.'

"And that the third clause in said contract of assignment is in the following words, to wit:—

"'And the two parties further agree, that any improvement in the machinery, or alteration or renewal of either patent, such improvement, alteration, or renewal, shall inure to the benefit of the respective parties interested, and may be applied and used within their respective districts, as hereinbefore designated.'

[* 672] * "4. That previous to the expiration of the fourteen years' limitation of said patent, William Wood-

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worth, the patentee, died, to wit, on the 9th of February, 1839; that William W. Woodworth was thereupon duly appointed, and now is, administrator of the estate of the said William Woodworth, and that said Woodworth, in his lifetime, had sold all his interest in the said original patent.

“ 5. That William W. Woodworth, as administrator aforesaid, on the 16th day of November, 1842, under the eighteenth section of the Act of Congress of July 4th, 1836, applied to the board of commissioners created by the said section for an extension of said patent; and that, upon complying with the requisites in said section prescribed, an extension of said patent was granted by said board to William W. Woodworth, as administrator of the estate of William Woodworth, on said 16th day of November, 1842, and letters-patent of extension were on said day duly issued to him, granting to him in his aforesaid capacity, the exclusive right to make and use, and vend to others to be used, the said invention or improvement, for the term of seven years from and after the term of limitation of said original patent.

“ 6. That on the 8th day of July, 1845, the said William W. Woodworth, in his capacity as administrator aforesaid, and in accordance with the provisions of the thirteenth section of the said Act of July 4th, 1836, made a surrender to the Commissioner of Patents of the letters-patent to him granted on the 16th day of November, 1842, for an insufficiency of the specification upon which the said original patent was issued, and upon filing a corrected and amended specification, with explanatory drawings, a copy of which is annexed hereto and made a part of this statement, the said commissioner, on the said 8th day of July, 1845, issued to the said William W. Woodworth new letters-patent of said invention for the unexpired term of the first extension thereof, and of the extension granted by special Act of Congress on the 26th day of February, 1845.

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"7. That the defendants in this action have erected and put in operation, in the town of Watervliet, which is within the county of Albany and State of New York, one or more machines for planing, tonguing, and grooving boards and plank, substantially the same in principle and mode of operation as that the subject of the patent granted to William Woodworth.

"8. That the defendants trace no title to themselves to a right to use said machines from the assignment made by William Woodworth and James Strong to Halstead, Toogood, and Tyack.

"9. That the plaintiff in this action is the grantee of William W. Woodworth, as administrator, of the exclusive right to construct and use, and vend to others to be used, two of said patented machines within the said town of Watervliet, in said county of Albany and State of New York."

[* 673] * The case was argued by *Mr. Seward*, *Mr. Latrobe*, and *Mr. Webster*, (the two latter dividing the points,) on behalf of the plaintiff, and *Mr. Stevens*, for the defendants. The reporter has been kindly furnished with the arguments of these gentlemen, but his limits will not permit their publication *in extenso*, and he is unwilling to take the responsibility of condensing them.

Mr. Justice NELSON delivered the opinion of the Court.

The questions in this case come before us on a certificate of division of opinion from the Circuit Court of the United States for the Northern District of New York, involving the construction of various provisions of the act of Congress to promote the progress of useful arts, commonly called the Patent Act. We shall examine the questions in the order in which they appear on the record. The first is as follows:—

1. Whether the eighteenth section of the Act of 1836 au-

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thorized the extension of a patent on the application of the executor or administrator of a deceased patentee.

The eighteenth section provides, in substance, that whenever any patentee of an invention or discovery shall desire an extension of his patent beyond the term of its limitation, he may make application therefor, in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof. That the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury shall constitute a board to hear and decide upon the application; the patentee shall furnish to the board a statement in writing, under oath, of the value and usefulness of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of the invention; and if, upon a hearing of the matter, it shall appear to the satisfaction of the board, having a due regard to the public interest, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the commissioner to renew and extend the patent, by making a certificate thereon of such extension for the term of seven years from and after the expiration of the first term, &c.

This is the substance of the section, so far as is material to the consideration of the question; and it will be seen, that, according to the words of the provision, the application is to be made by, and the new term to be granted to, the patentee himself, and hence the objection on account of its having been granted to the administrator.

The main argument relied on to support the objection is, that the patentee had no interest or right of property in the

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[*674] extended term at *the time of his death. That all he had was a mere possibility, too remote and contingent to be regarded as property, or any right of property, in the sense of the law, and therefore not assets or rights in the hands of the administrator which would authorize an application within the meaning of the statute.

At common law, the better opinion, probably, is, that the right of property of the inventor to his invention or discovery passed from him as soon as it went into public use with his consent; it was then regarded as having been dedicated to the public, as common property, and subject to the common use and enjoyment of all.

The act of Congress for the encouragement of inventors, and to promote the progress of the useful arts, and for the purpose of remedying the imperfect protection, or rather want of protection, of this species of property, has secured to him, for a limited term, the full and exclusive enjoyment of his discovery.

The law has thus impressed upon it all the qualities and characteristics of property, for the specified period; and has enabled him to hold and deal with it the same as in case of any other description of property belonging to him, and on his death it passes, with the rest of his personal estate, to his legal representatives, and becomes part of the assets.

Congress have not only secured to the inventor this absolute and indefeasible interest and property in the subject of the invention for the fourteen years, but have also agreed, that upon certain conditions occurring and to be shown, before the expiration of this period, to the satisfaction of a board of commissioners, an indifferent tribunal designated for the purpose, this right of property in the invention shall be continued for the further term of seven years. Subject to this condition, the right of property in the second term is as perfect, to the extent of the intent, as the right of property in the first.

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The circumstances upon which the condition rests, and the occurrence of which gives effect and operation to the further grant of the government, are by no means uncommon, or difficult to be shown. They have often happened to inventors in the course of their dealings with this species of property. The act of Congress contemplates their occurrence again, and has therefore provided further security and protection, by enlarging the interest and right of property in the subject of their invention.

The provision is founded upon the policy of the government to encourage genius, and promote the progress of the useful arts, by holding out an additional inducement to the enjoyment of the right secured under the first term; and as an act of justice to the inventors for the time, ingenuity, and expense bestowed in bringing out the discovery, frequently of incalculable value to the business interests of the country. And it is apparent, therefore, unless the executor or administrator is permitted to take the place of the patentee in case * of his death, and make application for the [* 675] grant of the second term, which continues the exclusive enjoyment of the right of property in the invention, the object of the statute will be defeated, and a valuable right of property, intended to be secured, lost to his estate.

The statute is not founded upon the idea of conferring a mere personal reward and gratuity upon the individual, as a mark of distinction for a great public service, which would terminate with his death; but of awarding to him an enlarged interest and right of property in the invention itself, with a view to secure to him, with greater certainty, a fair and reasonable remuneration. And to the extent of this further right of property, thus secured, whatever that may be, it is of the same description and character as that held and enjoyed under the patent for the first term. In its nature, therefore, it continues, and is to be dealt with, after the de-

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cease of the patentee, the same as an interest under the first, and passes, with other rights of property belonging to him, to the personal representatives, as part of the effects of the estate.

It would seem, therefore, from the nature of this interest in an extended term itself, as well as from a consideration of the object and purpose of the statute, plainly expressed upon its face, in providing for the prolonged enjoyment and protection of this species of property, that the board of commissioners were well warranted in making the renewed grant to the administrator, upon his complying with the conditions.

An argument has been urged against this conclusion, grounded upon the tenth and thirteenth sections of the Patent Law. The former provides in express terms for the issuing of a patent to the executor or administrator, in case of the death of the inventor before it is taken out; and the latter, for the surrender of a patent defective by reason of an insufficient description, and the reissuing of a new one. These are supposed to be analogous cases, and manifest the sense of Congress, that, without the express provisions of law, the patent in the one case, and the surrender in the other, could not be issued to, or be made by, the legal representative. The argument is no doubt a proper one, and entitled to consideration; but is not necessarily conclusive.

As it respects the provision for a surrender by the executor or administrator, which is most analogous to the question in hand, we think there could be no great doubt that the right would exist in the absence of any such express authority, regard being had to the nature of the property, and the rights and duties of the legal representative, within the spirit and object of the Patent Law. It would be the surrender of a patent, the legal interest and property in which had become vested in him as part of the assets, which he was bound to take care of, and protect against waste; a step necessary to

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perfect the title and give value to the property *would seem to be not only directly within the [* 676] line of his duty, but in furtherance of the chief object of the law, namely, to secure remuneration to the meritorious inventor.

It has also been argued, that the executor or administrator could not comply with the terms and conditions of the eighteenth section, upon which the right of property in the extended term is made to depend. In other words, that he would be unable to furnish to the board of commissioners a statement under oath of the usefulness of the invention, and of the receipts and expenditures of the patentee, exhibiting a true and faithful account of the loss and profit in any manner accruing from, and by reason of, the invention. This argument assumes as a matter of fact that which may well be denied. Suppose the dealings of the patentee in the subject of his discovery have been carried on through the instrumentality of agents or clerks, or, if not, that the patentee himself, as business men usually do, has kept an accurate account of his receipts and expenditures, all difficulty at once disappears. The account-books of a deceased party, in many of the States of the Union, identified, and the handwriting proved, are received as legal evidence of the demand in the courts of justice, and afford full authority, upon legal principles, for the admission of the books before the board, in support of the application. We perceive no great difficulty in a substantial compliance with the terms of the section, on the part of the executor or administrator.

The second question is, Whether, by force and operation of the eighteenth section already referred to, the extension granted to W. W. Woodworth, as administrator, on the 16th day of November, 1842, inured to the benefit of assignees under the original patent granted to William Woodworth, on the 27th day of December, 1828, or whether said extension

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inured to the benefit of the administrator only, in his said capacity.

The most of this section has already been recited in the consideration of the first question, and it will be unnecessary to repeat it. It provides for the application of the patentee to the commission for an extension of the patent for seven years; constitutes a board to hear and decide upon the application; and if his receipts and expenditures, showing the loss and profits accruing to him from and on account of his invention, shall establish, to the satisfaction of the board, that the patent should be extended by reason of the patentee, without any fault on his part, having failed to obtain from the use and sale of his invention a reasonable remuneration for his time, ingenuity, and expense bestowed upon the same, and the introduction of it into use, it shall be the duty of the commissioners to extend the same by making a certificate thereon of such extension for the term of seven years from and after the first term; "and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years." And [* 677] * then comes the clause in question: — "*And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein.*"

The answer to the second question certified depends upon the true construction of the above clause respecting the rights of assignees and grantees.

Various and conflicting interpretations have been given to it by the learned counsel, on the argument, leading to different and opposite results, which it will be necessary to examine.

On one side, it has been strongly argued, that the legal operation and effect of the clause save and protect all the rights and interests of assignees and grantees in the patent

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existing at the time of the extension; and thus secure and continue the exclusive use and enjoyment of these rights and interests for the seven years, to the same extent, and in as ample a manner, as held and enjoyed under the first term. That if A holds an assignment of a moiety of the patent, he will hold the same for the new term of seven years; if of the whole patent, then the whole interest for that period. And that as soon as the new grant is made to the patentee, the interest therein passes, by operation of this clause, to the assignees of the old term, in proportion to their respective shares.

On the other side, it has been argued, with equal earnestness, that, according to the true construction and legal effect of the clause, protection is given, and intended to be given, only to the rights and interests of assignees and grantees acquired and held by assignments and grants from the patentee in and under the second or new term; and that it does not refer to, or embrace, or in any way affect the rights and interests of assignees or grantees holding under the old.

In connection with this view, it is said that the rights thus protected in the new term may be acquired by means of the legal operation of the clause, either from a direct assignment or grant after the extension of the patent, or by an appropriate provision for that purpose, looking to an extension, contained in the assignment or grant under the old.

It is not to be denied, but that, upon any view that has been taken or that may be taken of the clause, its true meaning and legal effect cannot be asserted with entire confidence; and, after all, must depend upon such construction as the Court can best give to doubtful phraseology and obscure legislation, having a due regard to the great object and intent of Congress, as collected from the context and general provisions and policy of the Patent Law.

The rule is familiar and well settled, that, in case of obscure

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and doubtful words of phraseology, the intention of the law-makers is to be resorted to, if discoverable from the context, in order to fix and control their meaning so as to reconcile it, if possible, with the general policy of the law.

[*678] *Now, the serious difficulty in the way, and which renders the first interpretation inadmissible, except upon the most explicit and positive words, is, that it subverts at once the whole object and purpose of the enactment, as is plainly written in every line of the previous part of the section. It gives to the assignees and grantees of the patent, as far as assigned under the old term, the exclusive right and enjoyment of the invention—the monopoly—in the extended term for the seven years; when, by the same provision, it clearly appears that it was intended to be secured to the patentee as an additional remuneration for his time, ingenuity, and expense in bringing out the discovery, and in introducing it into public use. It gives this remuneration to parties that have no peculiar claims upon the government or the public, and takes it from those who confessedly have.

The whole structure of the eighteenth section turns upon the idea of affording this additional protection and compensation to the patentee, and to the patentee alone, and hence the reason for instituting the inquiry before the grant of the extension, to ascertain whether or not he has failed to realize a reasonable remuneration from the sale and use of the discovery,—the production of an account of profit and loss to enable the board to determine the question; and as it comes to the one or the other conclusion, to grant the extended term or not.

It is obvious, therefore, that Congress had not at all in view protection to assignees. That their condition on account of dealing in the subject of the invention, whether successful or otherwise, was not in the mind of that body, nor can any good reason be given why it should have been.

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They had purchased portions of the interest in the invention, and dealt with the patent-rights as a matter of business and speculation; and stood in no different relation to the government or the public, than other citizens engaged in the common affairs of life.

Nothing short of the most fixed and positive terms of a statute could justify an interpretation so repugnant to the whole scope and policy of it, and to wise and judicious legislation.

We think this construction not necessarily required by the language of the clause, and is altogether inadmissible.

Then as to the second interpretation, namely, that the clause refers to, and includes, assignees and grantees of interests acquired in the new term, either by an assignment or grant from the patentee after the extension, or by virtue of a proper clause for that purpose, in the assignment under the old term.

The difficulty attending this construction lies in the uselessness of the clause upon the hypothesis, — the failure to discover any subject-matter upon which to give reasonable operation and effect to it, — and hence, to adopt the construction is to make the clause *virtually a [* 679] dead letter, the grounds for which conclusion we will proceed to state.

The eleventh section of the Patent Act provides, that every patent shall be assignable, in law, either as to the whole interest, or any undivided part thereof, by an instrument in writing; which assignment, and also every grant and conveyance of the exclusive right under any patent, &c., shall be recorded in the Patent Office. And the fourteenth section authorizes suits to be brought in the name of the assignee or grantee, for an infringement of his rights, in a court of law.

One object of these provisions found in the general patent system is to separate the interest of the assignee and grantee

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from that which may be held by the patentee, and to make each fractional interest held under the patent distinct and separate; in other words, to change a mere equitable into a legal title and interest, so that it may be dealt with in a court of law.

Now, in view of these provisions, it is difficult to perceive the materiality of the clause in question, as it respects the rights of assignees and grantees held by an assignment or grant in and under the new term, any more than in respect to like rights and interests in and under the old.

The eleventh and fourteenth sections embrace every assignment or grant of a part or the whole of the interest in the invention, and enable these parties to deal with it, in all respects, the same as the patentee. They stand upon the same footing, under the new term, as in the case of former assignments under the old. Nothing can be clearer. It is impossible to satisfy the clause by referring it to these assignments and grants; or to see how Congress could, for a moment, have imagined that there would be any necessity for the clause, in this aspect of it. It would have been as clear a work of supererogation as can be stated.

The only color for the argument in favor of the necessity of this clause, in the aspect in which we are viewing it, is as respects the contingent interest in the new term, derived from a provision in an assignment under the old one, looking to the extension. As the right necessarily rested on contract, at least till the contingency occurred, there may be some doubt whether, even after its occurrence, the eleventh and fourteenth sections had the effect to change it into a vested legal interest, so that it could be dealt with at law; and that a new assignment or grant from the patentee would be required, which could be enforced only in a court of equity. To this extent there may be some color for the argument, — some supposed matter to give operation and effect to the clause.

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But what is the amount of it? Not that the clause creates or secures this contingent interest in the new term, for that depends upon the contract between the parties, and the contract alone, and which, even if the general provisions of the law respecting * the rights of assignees [* 680] and grantees could not have the effect to change into a legal right, might be enforced in a court of equity.

The only effect, therefore, of the provision in respect to assignees and grantees of this description would be, to change the nature of the contingent interest after the event happened, from a right resting in contract to a vested legal interest; or, to speak with more precision, to remove a doubt about the nature of the interest in the new term, after the happening of a certain contingency, which event in itself was quite remote. This seems to be the whole amount of the effect that even ingenious and able counsel have succeeded in finding, to satisfy the clause. It presupposes that Congress looked to this scintilla of interest in the new term, which might or might not occur, and cast about to provide for it, for fear of doubts as to its true nature and legal character, and the effect of the general system upon it.

We cannot but think a Court should hesitate before giving a construction to the clause so deeply harsh and unjust in its consequences, both as it respects the public and individual rights and interests, upon so narrow a foundation.

But there are other difficulties in the way of this construction.

The eleventh section, regulating the rights of assignees and grantees, provides, "that every patent shall be assignable at law," &c., "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, the thing patented within and throughout any specified part or portion of the United States," &c., "shall be recorded."

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Now it will be apparent, we think, from a very slight examination of the clause in question, that it does not embrace assignees or grantees, in the sense of the eleventh section, at all; nor in the sense in which they are referred to when speaking of these interests generally under the Patent Law, without interpolating words or giving a very forced construction to those composing it.

The clause is as follows: — “ And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein.”

It will be seen that the word “ exclusive,” used to qualify the right of a grantee in the eleventh section, and, indeed, always when referred to in the Patent Law (§ 14) and also the words “ to make,” “ and to grant to others to make and use,” are dropped, so that there is not only no exclusive right in the grantee, in terms, granted or secured by the clause, but no right at all, — no right whatever, — to make or to grant to others to make and use the thing patented; in other words, no exclusive right to make or vend. And it is, we think, quite obvious, from the connection and phraseology, that assignees and grantees are placed, and were intended to be placed, in this respect, upon the same footing. We [* 681] should scarcely be * justified in giving to this term a more enlarged meaning as to the right to make and sell, as it respects the one class, than is given to the others, as they are always used as correlative in the Patent Laws, to the extent of the interests held by them. The clause, therefore, in terms, seems to limit studiously the benefit, or reservation, or whatever it may be called, under or from the new grant to the naked right to use the thing patented; not an exclusive right even for that, which might denote monopoly, nor any right at all, much less exclusive, to make and vend. That seems to have been guardedly omitted. We

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do not forget the remaining part of the sentence, "to the extent of their respective interest therein," which is relied on to help out the difficulty. But we see nothing in the phrase, giving full effect to it, necessarily inconsistent with the plain meaning of the previous words. The exact idea intended to be expressed may be open to observation; but we think it far from justifying the Court in holding, that the grant or reservation of a right to use a thing patented, well known and in general use at the time, means an exclusive right to make and use it; and not only this but an exclusive right to grant to others the right to make and use it, meaning an exclusive right to vend it.

The Court is asked to build up a complete monopoly in the hands of the assignees and grantees in the thing patented, by judicial construction, founded upon the grant of a simple right to use it to the extent of the interest possessed; for the argument comes to this complexion. A simple right to use is given, and we are asked to read it an exclusive right, and not only to read it an exclusive right to use, but an exclusive right to make and vend, the patented article.

Recurring to the Patent Law, it will be seen that Congress, in granting monopolies of this description, have deemed it necessary to use very different language. The grant in the patent must be in express terms, for "the full and exclusive right and liberty of making, using, and vending," in order to confer exclusive privileges. The same language is also used in the act when speaking of portions of the monopoly in the hands of assignees and grantees. (§§ 11, 14.)

We cannot but think, therefore, if Congress had intended to confer a monopoly in the patented article upon the assignees and grantees by the clause in question, the usual formula in all such grants would have been observed, and that we should be defeating their understanding and intent, as well as doing violence to the language, to sanction or uphold rights

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and privileges of such magnitude by the mere force of judicial construction.

We conclude, therefore, that the clause has no reference to the rights or interest of assignees and grantees under the new and extended term, —

1. Because, in that view, giving to the words the [* 682] widest * construction, there is nothing to satisfy the clause, or upon which any substantial effect and operation can be given to it; it becomes virtually a dead letter, and work of legislative superfluity; and

2. Because the clause in question, upon a true and reasonable interpretation, does not operate to vest the assignees and grantees named therein with any exclusive privileges whatever, in the extended term, and therefore cannot be construed as relating to or embracing such interests in the sense of the law.

The extension of the patent under the eighteenth section is a new grant of the exclusive right or monopoly in the subject of the invention for the seven years. All the rights of assignees or grantees, whether in a share of the patent, or to a specified portion of the territory held under it, terminate at the end of the fourteen years, and become reinvested in the patentee by the new grant.

From that date he is again possessed of “the full and exclusive right and liberty of making, using, and vending to others the invention,” whatever it may be. Not only portions of the monopoly held by assignees and grantees as subjects of trade and commerce, but the patented articles or machines throughout the country, purchased for practical use in the business affairs of life, are embraced within the operation of the extension. This latter class of assignees and grantees are reached by the new grant of the exclusive right to use the thing patented. Purchasers of the machines, who were in the use of them at the time, are disabled from further use

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immediately, as that right became vested exclusively in the patentee. Making and vending the invention are prohibited by the corresponding terms of this grant.

Now, if we read the clause in question with reference to this state of things, we think that much of the difficulty attending it will disappear. By the previous part of the section, the patentee would become reinvested with the exclusive right to make, use, and vend the thing patented; and the clause in question follows, and was so intended as a qualification. To what extent, is the question. The language is, "And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein;" naturally, we think, pointing to those who were in the use of the patented article at the time of the renewal, and intended to restore or save to them that right which, without the clause, would have been vested again exclusively in the patentee. The previous part of the section operating in terms to vest him with the exclusive right to use, as well as to make and vend, there is nothing very remarkable in the words, the legislature intending thereby to qualify the right in respect to a certain class only, leaving the right as to all others in the patentee, in speaking of the benefit of the renewal extending to this class. The renewal vested him with the whole right to use, and therefore there is no great impropriety of language, if intended, to protect this * class, by giving them in terms the benefit of the [* 683.] renewal. Against this view it may be said that "the thing patented" means the invention or discovery, as held in *McClurg v. Kingsland*, 1 How. 202, and that the right to use the "thing patented" is what, in terms, is provided for in the clause. That is admitted, but the words, as used in the connection here found, with the right simply to use the thing patented, not the exclusive right, which would be a monopoly, necessarily refer to the patented machine and

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not to the invention ; and, indeed, it is in that sense that the expression is to be understood generally throughout the Patent Law, when taken in connection with the right to use, in contradistinction to the right to make and sell.

The "thing patented" is the invention ; so the machine is the thing patented, and to use the machine is to use the invention, because it is the thing invented and in respect to which the exclusive right is secured, as is also held in *McClurg v. Kingsland*. The patented machine is frequently used as equivalent for the "thing patented," as well as for the invention or discovery, and no doubt, when found in connection with the exclusive right to make and vend, always means the right of property in the invention, the monopoly. But when in connection with the simple right to use, the exclusive right to make and vend being in another, the right to use the thing patented necessarily results in a right to use the machine, and nothing more. Then, as to the phrase "to the extent of their respective interests therein," that obviously enough refers to their interests in the thing patented, and in connection with the right simply to use, means their interests in the patented machines, be that interest in one or more at the time of the extension.

This view of the clause, which brings it down in practical effect and operation to the persons in the use of the patented machine or machines at the time of the new grant, is strengthened by the clause immediately following, which is, "that no extension of the patent shall be granted after the expiration of the term for which it was originally issued." What is the object of this provision ? Obviously, to guard against the injustice which might otherwise occur to a person who had gone to the expense of procuring the patented article, or changed his business upon the faith of using or dealing with it, after the monopoly had expired, which would be arrested by the operation of the new grant. To avoid this consequence,

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it is provided that the extension must take place before the expiration of the patent, if at all. Now, it would be somewhat remarkable if Congress should have been thus careful of a class of persons who had merely gone to the expense of providing themselves with the patented article for use or as a matter of trade, after the monopoly had ceased, and would be disappointed and exposed to loss if it was again renewed, and at the same time had overlooked the class who in addition to this expense and change of business *had [* 684] bought the right from the patentee, and were in the use and enjoyment of the machine, or whatever it might be, at the time of the renewal. These provisions are in juxtaposition, and we think are but parts of the same policy, looking to the protection of individual citizens from any special wrong and injustice on account of the operation of the new grant.

The consequences of any different construction than the one proposed to be given are always to be regarded by Courts, when dealing with a statute of doubtful meaning. For between two different interpretations, resting upon judicial expositions of ambiguous and involved phraseology, that which will result in what may be regarded as coming nearest to the intention of the legislature should be preferred.

We must remember, too, that we are not dealing with the decision of the particular case before us, though that is involved in the inquiry; but with a general system of great practical interest to the country; and it is the effect of our decision upon the operation of the system that gives to it its chief importance.

The eighteenth section authorizes the renewal of patents in all cases where the board of commissioners is satisfied of the usefulness of the invention, and of the inadequacy of remuneration to the patentee. Inventions of merit only are the subject of the new grant; such as have had the public confi-

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dence, and which it may be presumed to have entered largely, in one way and another, into the business affairs of life.

By the report of the Commissioner of Patents it appears, that five hundred and two patents were issued in the year 1844, — for the last fourteen years, the average issue yearly exceeded this number, — and embrace articles to be found in common use in every department of labor or art, on the farm, in the workshop, and factory. These articles have been purchased from the patentee, and have gone into common use. But, if the construction against which we have been contending should prevail, the moment the patent of either article is renewed, the common use is arrested, by the exclusive grant to the patentee. It is true the owner may repurchase the right to use, and doubtless would be compelled from necessity ; but he is left to the discretion or caprice of the patentee. A construction leading to such consequences, and fraught with such unmixed evil, we must be satisfied, was never contemplated by Congress, and should not be adopted unless compelled by the most express and positive language of the statute.

The third question certified is, whether the extension of the patent granted to W. W. Woodworth, as administrator, on the 16th of November, 1842, inured to the benefit of the administrator exclusively, or whether, as to certain territory specified in the contract of assignment made by W. Woodworth and James Strong to Toogood, Halstead, and [* 685] Tyack, on the 28th of November, 1829, and * by legal operation of the covenants contained in said contract, the said extension inured to the benefit of said Toogood, Halstead, and Tyack, or their assigns ?

William Woodworth was the original patentee, and took out letters-patent on the 27th of December, 1828 ; and soon after conveyed a moiety of the same to James Strong. One Uri Emmons also obtained a patent for a similar machine on the 25th of April, 1829, and soon after conveyed all his inte-

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rest in the same to Toogood, Halstead, and Tyack. With a view to avoid litigation, both parties mutually assigned to each other their interests in the respective patents to different and separate portions of the United States; and in the assignment from Woodworth and Strong to Toogood, Halstead, and Tyack, the following covenant was entered into by the parties. "And the two parties further agree, that any improvement in the machinery, or alteration, or renewal of either patent, such improvement, alteration, or renewal shall inure to the benefit of the respective parties interested, and may be applied and used within their respective districts, as herein before designated."

At the time this covenant was entered into, there was no provision in the Patent Laws authorizing an extension or renewal of the same beyond the original term of fourteen years. The first act providing for it was passed in July, 1832. Before this time, the only mode of prolonging the term beyond the original grant was by means of private Acts of Congress upon individual applications.

A construction had been given by the Circuit Court of the United States, in New York, as early as 1824, by which the patentee, on surrendering his patent on account of a defective specification, would be entitled to take out a new patent correcting the defect, which construction was afterwards upheld by this Court in *Grant v. Raymond*, 6 Peters, 218, and the principle since ingrafted into the Patent Law by the Act of 1832.

The Court is of the opinion, that the covenant in question should be construed as having been entered into by the parties, with a reference to the known and existing rights and privileges secured to patentees under the general system of the government established for that purpose; that the parties would naturally look to the established system of law on the subject of arranging their several rights and obligations, in

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dealing with property of this description, rather than to any possible change that might be effected by private Acts of Congress upon individual application. Contracts are usually made with reference to the established law of the land, and should be so understood and construed, unless otherwise clearly indicated by the terms of the agreement. If the parties in this case contemplated any alteration or modification of their rights, more advantageous, by the further legislation of Congress, we think some more specific provision [* 686] having reference to it should have been *inserted in their covenant. The term renewal may be satisfied by a reference to the law as it then stood. The patentee might surrender his patent, and take out a new one, within the fourteen years; and the term was used, probably, to guard against any question that might be raised as to the right under the assignment in the new patent, if a surrender and new issue should become necessary. The specification accompanying the patent was a complicated one, and has been the subject of much controversy, and the necessity of a surrender for correction and amendment might very well have been anticipated.

We think this view satisfies the use of the term, and that no right is acquired in the new grant by virtue of the assignment or covenant.

The fourth and fifth questions certified are answered by the opinion of the Court upon the first and second questions.

The sixth question certified is as follows:—Whether the plaintiff, if he be an assignee of an exclusive right to use two of the patented machines within the town of Watervliet, has such an exclusive right as will enable him to maintain an action for an infringement of the patent within the said town; or whether, to maintain such action, the plaintiff must be possessed, as to that territory, of all the rights of the original patentee.

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The plaintiff is the grantee of the exclusive right to construct and use, and to vend to others to be used, two of the patented machines within the town of Watervliet, in the county of Albany.

The fourteenth section of the Patent Law authorizes any person, who is a grantee of the exclusive right in a patent within and throughout a specified portion of the United States, to maintain an action in his own name for an infringement of the right.

The plaintiff comes within the very terms of the section. Although limited to the use of two machines within the town, the right to use them is exclusive. No other party, not even the patentee, can use a right under the patent within the territory without infringing the grant.

The seventh question certified is as follows:—Whether the letters-patent of renewal issued to W. W. Woodworth, as administrator, on the 8th of July, 1845, upon the amended specification and explanatory drawings then filed, be good and valid in law, or whether the same be void for uncertainty, ambiguity, or multiplicity of claim, or any other cause.

The Court is satisfied, upon an examination of the specification and drawings referred to in the question certified, that it is sufficiently full and explicit, and is not subject to any of the objections taken to it.

The remaining questions will be sufficiently answered by the certificate sent to the Court below.

* *Order.*

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This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of New York, and on the points and questions on which the judges of the said Circuit Court were opposed in opinion, and which were certified to this Court for

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its opinion, agreeably to the Act of Congress in such case made and provided, and was argued by counsel. On consideration whereof, it is the opinion of this Court,—

1. That the eighteenth section of the Patent Act of 1836 did authorize the extension of a patent on the application of the executor or administrator of a deceased patentee.

2. That, by force and operation of the eighteenth section of the Act of July 4th, 1836, entitled "An act to promote the progress of the useful arts," &c., the extension granted to William W. Woodworth, as administrator, on the 16th day of November, 1842, did not inure to the benefit of assignees under the original patent granted to William Woodworth on the 27th day of December, 1828, but that the said extension inured to the benefit of the administrator only, in his said capacity.

3. That the extension specified in the foregoing second point did inure to the benefit of the administrator, to whom the same was granted, and to him in that capacity exclusively; and that, as to the territory specified in the contract of assignment made by William Woodworth and James Strong to Toogood, Halstead, and Tyack, on the 28th day of November, 1829, (and set forth in the second plea of the defendants to the first count of the declaration,) and by legal operation of the covenants contained in said contract, the said extension did not inure to the benefit of the said Toogood, Halstead, and Tyack, or their assigns.

4. That the plaintiff, claiming title under the extension from the administrator, can maintain an action for an infringement of the patent-right within the territory specified in the contract of assignment to Toogood, Halstead, and Tyack, against any person not claiming under said assignment. And that the said assignment is not, of itself, a perfect bar to the plaintiff's suit.

5. That the extension specified in the second point could

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be applied for and obtained by William W. Woodworth, as administrator of William Woodworth, deceased, although the said William Woodworth, the original patentee, had in his lifetime disposed of all his interest in the then existing patent, having at the time of his death no right or title to or interest in the said original patent; and that such sale did not carry any thing beyond the term of said original patent; and that no contingent rights remained in the patentee or his representatives.

6. That the plaintiff, if he be an assignee of an exclusive right * to use two of the patented machines within the town of Watervliet, has such an exclusive right as will enable him to maintain an action for an infringement of the patent within said town.

7. That the letters-patent of renewal issued to William W. Woodworth, as administrator as aforesaid, on the 8th day of July, 1845, upon the amended specification and explanatory drawings then filed, are good and valid in law; and are not void for uncertainty, ambiguity, or multiplicity of claim, or any other cause.

8. That the question involved in the eighth point propounded does not present any question of law which this Court can answer.

9. That the decision of the Board of Commissioners, who are to determine upon the application for the extension of a patent under the eighteenth section of the Act of 1836, is not conclusive upon the question of their jurisdiction to act in a given case.

10. That the Commissioner of Patents can lawfully receive a surrender of letters-patent for a defective specification, and issue new letters-patent upon an amended specification, after the expiration of the term for which the original patent was granted, and pending the existence of an extended term of seven years; and that such surrender and renewal may be made at any time during such extended term.

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It is thereupon now here ordered and adjudged by this Court, that it be so certified to the said Circuit Court.

McLEAN, J. As I dissent from the opinion of the Court, in their answer to the second question certified, I will state, in few words, the reasons of my dissent.

The question is, whether the extension of the patent, under the Act of 1836, to William W. Woodworth, the administrator, inured to the benefit of the assignees of the first patent.

I had occasion to consider this question in the case of *Brooks and Morris v. Bicknell and Jenkins*,¹ on my circuit, and on a deliberate examination of the eighteenth section of the above act, I came to the conclusion, that unless the assignment gave to the assignee the right in the extended or renewed patent, his interest expired with the limitation of the original patent.

The lamented Justice Story, without any interchange of opinion between us, about the same time, gave the same construction to the section. The late Mr. Justice Thompson, and several of the district judges of the United States, have construed the act in the same way.

The eleventh section of the act makes the patent assignable in law, either as to the whole interest or any undivided part thereof, by any instrument of writing, which is required to be recorded in the Patent Office within three months from the date.

By the eighteenth section, the patentee may make [* 689] application * for the extension of his patent to the commissioner, who is required to publish a notice of such application "in one or more of the principal newspapers in the city of Washington, and in such other paper or papers as he may deem proper, published in the section of country

¹ *Ante*, page 118.

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most interested and adversely to the extension of the patent.” “And the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury shall constitute a board to hear and decide upon the evidence produced before them both for and against the extension, and shall sit for that purpose at the time and place designated in the published notice thereof. The patentee shall furnish to said board a statement in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of said invention. And if, upon a hearing of the matter, it shall appear to the full and entire satisfaction of the said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the commissioner to renew and extend the patent,” &c. ; “and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years. And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interest therein.”

This section embraces patents previously issued, and the construction now to be given to it operates on all cases of extensions under it, whether the assignments were made before or after the passage of the act.

The object of this section is so clearly expressed as not to admit of doubt. It was for the exclusive benefit of the patentee; for the extension can only be granted when it shall be made to appear that the patentee, “without neglect or

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fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for his time, ingenuity, and expense," &c. This, then, being the clear intent of Congress, expressed in this section, it must have a controlling influence in the construction of other parts of the section. A statute is construed by the same rule as a written contract. The intent of law-makers, and of the persons contracting, where that intent clearly appears, must be carried into effect. Where the statute or the contract is so repugnant in its language as not to show the intent, then no effect can be given to it. If the words used be susceptible of such a construction as not only to show the intent, but to enable the Court to give effect to it, it is the duty of the Court so to construe it.

Bacon, on the construction of statutes, says, — "The most natural and genuine way of construing a statute is to construe one part by another part of the same statute; for this best expresseth the meaning of the makers." And, — "If any part of a statute be obscure, it is proper to consider the other parts; for the words and meaning of one part of a statute frequently lead to the sense of another." "A statute ought, upon the whole, to be so construed, that, if it can be prevented, no clause, sentence, or word shall be superfluous, void, or insignificant."

That the patentee may have his patent extended, though the assignee held the entire interest in it, is undoubted. He has only to show that he has not been reimbursed, &c., within the meaning of the section, to establish his claim for an extension. And, in such a case, if the benefit of the extension go to the assignee, he having the entire interest in the patent, how is the patentee benefited? And yet the law was enacted exclusively for his benefit. Does not such a construction defeat the object of the law? And if it does, can it be maintained? Where the assignment of the patent has been for

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less than the whole, the same objection lies, though the object of the law is subverted only to the extent of the assignment.

The interest of the assignee, it is supposed, is protected by the provision, that "the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interest therein." There can be no doubt that the words, "to the extent of their respective interest therein," refer to their right to use the thing patented; and this, it is contended, is the benefit which results to the assignee from the renewal. That this would seem to be the import of these words, disconnected from other parts of the section, is admitted; but such a construction is wholly inadmissible, when the object of the section is considered.

The patent is extended for the benefit of the patentee. This is so obvious that no one will deny it. And the above construction gives the benefit to the assignee. Here is a direct repugnancy, and there is no escape from it; for the same repugnancy exists, though in a less degree, where a part of the patent only has been assigned. Under such circumstances, we must inquire whether this repugnancy may not be avoided by giving another and a different application to the provision, of which the words may be susceptible.

The benefit of the renewal is given to the assignees; but to what extent?—to the extent of their interest in the renewal. But it is said, that this cannot be the true construction, as it renders the provision inoperative. If, by the assignment, there was an *express contract that [* 691] the assignee should enjoy the same interest in the renewal or extension of a patent, this would secure such interest, without the provision.

To this it may be answered, that such an assignment of a thing not *in esse* would, at most, only be a contract to convey the legal right. But, under the eighteenth section, the as-

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signment after the extension becomes a legal transfer. In addition to this, the right under the extension being legal, all purchasers would be affected with notice, where the assignment had been recorded in the Patent Office. This view gives effect to the section, and harmonizes its provisions. The other construction makes the parts of the section repugnant, and nullifies the whole of it. Now, which is the more reasonable view? But, in addition to this, what conceivable motive could Congress have had to give a boon to the assignee? How is he injured by the extension?

Without the extension, the assignee would only have a right, in common with all others, to use the invention. This could be of no more value to him than the worth of his machinery; for competition equally open to all cannot be estimated of any value. Under the assignment, the assignee, claims a monopoly. Now, did Congress intend to give him this boon? Why should he be an object of public munificence? He laid out his money in the purchase of the patent-right, because he believed it would be profitable. And, in most cases, the assignee speculates upon the poverty of the inventor. Inventors are proverbially poor and dependent. The history of this patent illustrates strongly this fact. Half of the right was originally assigned to pay the expense and trouble of taking out the patent. Another part of the patent was assigned to compromise a pretended claim to a similar invention.

The hardship complained of by the assignee is more imaginary than real. If the patentee takes all the benefit of the extension, the assignee loses, it is said, the value of his machinery. This does not necessarily follow. For if the machinery has been judicially selected, and put in operation at a proper place, it will sell for its value generally, if not always. If the invention be of great value, as is undoubtedly the case in this instance, the machinery will be wanted by

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any one who may wish to continue the business, under the extended patent. So that the loss in the sale of the machinery would not be greater than would have been suffered by a sale if the patent had not been extended.

This construction, then, inflicts little or no injury on the assignee, whilst the other construction, as has been shown, defeats the object of the statute. But this inconvenience or loss to the assignee is duly considered and weighed, under the statute, as the board, in granting the extension, must have a due regard to the public interest. Notice is to be given, as far as practicable, to all persons interested against the extension of the patent, who may *appear before the board and oppose it. And it was stated in the argument, that the assignees of this patent did oppose the extension of it. Little did they suppose at the time that they were resisting a boon secured to them by the above section. Whatever loss, real or imaginary, the assignee may suffer from the extension of the patent, is a loss or inconvenience which results from the general advancement of the public good, and for which society does not, and indeed cannot, make compensation. The price of property is affected by general legislation. An embargo is laid, and ships, during its continuance, are valueless. The increase or diminution of the tariff affects beneficially or injuriously the value of machinery used in manufactures. The reduction of the price of the public lands affects the price of lands generally in the new States. An act authorizing a company or individual to construct a railroad renders useless turnpike roads in its neighborhood, and the public houses established thereon; but for these injuries no compensation is made. Indeed, it is difficult to find any great public enterprise which does not, in a greater or less degree, affect injuriously private rights. But these must yield to the general welfare of society.

All enlightened governments reward the inventor. He is

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justly considered a public benefactor. Many of the most splendid productions of genius, in literature and in the arts, have been conceived and elaborated in a garret or hovel. Such results not only enrich a nation, but render it illustrious. And should not their authors be cherished and rewarded?

If the assignee under the eighteenth section take any thing, in my judgment he takes the whole extent of his interest,—the whole or nothing. And it appears to me the construction given by the Court is, if possible, less warranted by the section, than to hold that the assignee takes under the extension the entire interest assigned.

The words, “and the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interest therein,” cannot, it seems to me, by any known rule of construction, be held to give to the assignee or grantee the right to use the machine he may have had in operation at the time the extension took effect. The words, “to use the thing patented,” are descriptive of the right assigned or granted, and refer to such right, not to the mere use of the machine. “The extent of their respective interest therein” undoubtedly covers the whole interest, and cannot refer merely to the number of machines the individual may have in operation.

Mr. Justice WAYNE expressed his dissent from that part of the opinion of the Court which, in answer to the second question, gave a right to an assignee to continue the [* 693] use of the patented * machine, and said he would probably file his reasons with the clerk.

WOODBURY, J. There is one of the leading questions certified to us in this cause, in the decision of which I have the misfortune to differ from a majority of the Court.

As that decision bears on several of the other questions,

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and also disposes entirely of some of the four causes connected with this matter, which have been so long and so ably under argument before us, I consider it due to the importance of this subject to the parties and the public, as well as just to myself, to state the reasons for my dissent.

The difference in our views arises in the construction of the eighteenth section of the Patent Law of July 4th, 1836, and relates to the benefits which may be enjoyed under it by assignees and grantees.

Before the passage of that law, a patent could not, under any circumstances, be extended in its operation for the benefit of any body beyond its original term, except by a special act of Congress. But this section allowed a patentee to apply to a board of officers and obtain from them a renewal of his patent for seven years longer, provided he offered to them satisfactory proofs that his expenses and labor in relation to the patent had not been indemnified. It provided further, that the renewal be indorsed on the back of the original patent; "and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years." It then added, "And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein." This last clause creates the chief embarrassment. In this case, the patentee having died, and we having just decided that a renewal was legally granted to his administrator, the controverted question about which we differ is, whether that renewal inures exclusively to the use of the patentee through his administrator, or goes either in full or in part to his assignees and grantees under the old patent. In the present case it is conceded, that by the contract of assignment or grant, nothing is expressly conveyed but the old patent, and in words, only for the original term of "fourteen years."

The question is not, then, whether, when assigning an in-

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terest in the old term, before or after the passage of the Act of 1836, it might not be competent and easy to use language broad and explicit enough to transfer an interest in any subsequent extension by means of the contract of assignment, and this be confirmed by the words of the eighteenth section ; but whether those words alone transfer it, or were [* 694] intended to transfer it, when the contract of * assignment, as in this case, was made before the Act of 1836 passed, and referred, *eo nomine*, only to the old patent, and expressly limited the time for which the patent was assigned to the old term.

In such case, it seems to me that both the language and spirit of this section restrain its operation to the patentee or his legal representatives; and convey no rights in the extension to assignees or grantees, whether prior or subsequent, except where the patentee had clearly contracted that they should have an interest beyond the original term.

But the majority of the Court hold here, that this clause, independent of any expression in the assignment, transfers an interest in the extension to all assignees and grantees, so that they may continue to use any machine already in operation during the new term, without any new contract, or any new compensation for such farther use.

The argument on the part of the assignees, in all the cases before us, on this subject, has been, that by force of this section all assignees before authorized to make, vend, or use these machines, for fourteen years, could continue to make and vend, as well as use them, for seven more, without any new contract or new consideration ; and that " grantees of the right to use " should have a like prolongation of all their interests. And such seems to have been the opinion of the Circuit Court in Maryland, in *Wilson v. Turner*,¹ October term, 1844, Chief Justice Taney presiding, though other

¹ Post.

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points besides arose there, and were disposed of in that opinion.

But now, for the first time, it is believed, since the passage of the Patent Law, this court, by force of the last clause in the eighteenth section, not only give to assignees and grantees a greater or longer interest in the thing patented than was given in the contract of assignment to them, but undertake to introduce a novel discrimination, not seeming to me to be made in the clause itself, and give to assignees of the patent-right itself an extension of only a part of their former interest, but to "grantees of the right to use" the patent, an extension of all their former interests.

We propose to examine the objections to this decision of the Court, first, on the principle of giving to old assignees and grantees an extension of their interests to the new patent at all, unless the contract of assignment to them was manifestly meant to embrace any new term; and, after that, to examine the propriety of the discrimination in allowing a right in the renewed patent to grantees of the use, to the extent of all their old interests, and withholding a like privilege from assignees of the patent itself.

First, it has been repeatedly decided, that "a thing which is in the *letter* of a statute is not within the statute, unless it be within the intention of the makers." Dwarris on Statutes, 692; Bac. Abr. Statute, T; 2 Instit. 107, 386.

* Here the great design of the whole section was [* 695] to extend assistance to an unfortunate and needy class of men of genius, who had failed to realize any profits from their valuable inventions during the first term of their patents. The intention of the makers of this law is usually conceded to have been relief to such patentees, and not to assignees or grantees.

It was the former, and not the latter, who were sufferers, and whom Congress had before, by special acts of extension,

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occasionally tried to indemnify for their losses ; and to whom now, in a more summary way, on application and proof by them alone, an extension was authorized to be given by a board of officers, in order that they and not others might reap the profits of such extension.

But, by allowing the benefit of it to go to the former assignees of only the old patent, the intention of the makers appears to be defeated, and those profited who have not proved any loss or suffering, but, on the contrary, may have already derived great advantages from the assignment.

It might thus happen, likewise, where, in a case like this, the patentee has assigned all his old patent before the extension, and the use of it under the extension would constitute all or its chief value, that neither he nor his representatives— he whose genius had produced the whole invention, at the sacrifice of time and toil, and whose sufferings, losses, and disappointments the law is expressly made to indemnify— would receive the smallest pittance from it ; but those reap all its advantages who may already have grown rich by the assignment to them of the old patent, and who nobody can pretend were the particular or principal objects of relief. Under such a construction, how absurd would it be for such a patentee ever to apply for an extension, when he must do it at new cost and expense, and then have the whole fruits of it stripped from him by persons who had neither paid for the extension, nor had it conveyed to them. It is an equal violation of the leading intention of this section, and of most of these principles and of much of this reasoning, to allow, as the opinion of the Court does, such persons to take, unpaid for and unbought, a *part* of the benefits of the renewal, as to take the *whole* of them.

Secondly, by the construction of the Court, contracts and vested rights seem to be radically encroached upon. Under it, an assignee of an old patent, limited in the contract con-

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veying it to fourteen years, will, for some purposes, get it for twenty-one years, directly in conflict with the express stipulation of the parties. Congress will, in this way, be made unworthily to tamper with the private obligations of individuals, and will impair them by taking from the rights of one, and enlarging or adding to the rights of the other ; and this without any new consideration or new engagement passing between them, but, on the contrary, against the wishes, assent, and interests of one. That view, also, involves us in the unreasonable inference, * that Congress in- [* 696] tended to violate a solemn compact, to disturb the vested rights and written agreements of parties, when the language used is susceptible of a different construction, and one that is consistent with what is just, and with the spirit of the whole section.

By that view, an assignee or grantee will obtain "a right to use the thing patented" for a term of seven years longer than he contracted or paid for, while the patentee, without any such agreement in his contract assigning or granting the right to use, and without any new consideration, will be deprived of all his new and vested rights in the extension, so far as regards that use, and will have his former contract impaired virtually in its whole vitality, by making him part with the use for a term of twenty-one years, when the contract says but fourteen, and making him do it, also without any application by others for the extension, any proof by others of not being indemnified, any payment by others of the cost and expenses for procuring the additional seven years, and when the avowed and cardinal object of the renewal was to indemnify him alone for losses which he and not others had sustained. Well may he say, as to these new and extended interests attempted to be conferred on assignees and grantees beyond the contract of assignment, *in hæc federa non veni*.

Thirdly, the construction I contend for seems to me the

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only one consistent with the language used in the latter portion of the eighteenth section. By this, no part of those troublesome four lines is senseless, or expunged, or ungrammatical, or contradictory to the object of the previous portion of the section. While the construction opposed to this must, in my view, require interpolations or extirpations of words, and a violation of the object of the rest of the section, in order to give to the clause the meaning the advocates of that construction impute to it. Look at the phraseology of the clause. "*The benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein,*" but surely to no more than that *extent*. It would violate both the words and design to have them enjoy more than the extent of their interests therein, quite as much as not to let them enjoy all of the extent of them. In the construction of statutes it is a well-settled axiom, that, "to bring a case within the statute, it should be not only within the mischief contemplated by the legislature, but also within the plain, intelligible import of the words of the act of parliament." *Brandling v. Barrington*, 6 Barn. & Cressw. 475. In this case the assignees and grantees were not within either the mischief intended to be remedied, that is, a want of indemnity for losses by the patentee; or within the "plain intelligible import of the words," as their contract of assignment or grant did not extend to the renewed term at all, for any purpose whatever, but was expressly limited to the fourteen years of the original patent.

There must be some measure of their respective [* 697] interests, when *the act passed. What was it?

Clearly, the contracts under which they had been acquired. Nothing had been done, either in other acts or previous portions of this, to increase those interests beyond the contracts, but merely to enable assignees and grantees of exclusive rights to protect them by suits in their own names.

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The present clause, also, does not profess to increase those interests, but simply to let assignees and grantees enjoy them under the renewal, if by their extent by the contract which limits and defines them they run into the extended term. Various hypotheses and metaphysical refinements have been resorted to for the purpose of putting a meaning on the words of this clause differing from this, which is so plain and so consistent with the spirit of the section; and virtually making it provide, that assignees and grantees shall have more benefits under the renewal in the thing patented than the "extent of their respective interests therein."

But before testing more critically the extent of those interests by the only standard applicable to them, it will be necessary to consider separately the true meaning of two of the words employed in this clause, namely, "*renewal*" and "*therein*."

Much research has been exhibited, in attempting to draw distinctions in this case between the words *renewal* and *extension*. But I am not satisfied that any exist, when these words are employed as in this act of Congress, or in contracts relating to this subject. It is true that some "renewals" are not "extensions," in the sense of prolonging the term of the patent, — that is, when an old patent is surrendered and a new one taken out, or a renewal made for the rest of the term, — while all *extensions* prolong the term. But still "renewals" are as often used for a prolongation of the term, or for a new term, as *extensions* are, and in this very section, "*to renew and extend*" is used as if synonymous, and this in sound analogy to the use of the word *renewal* on several other subjects. Thus, to renew a lease is to extend it another term. To renew an office is to extend it another term. To renew griefs, *revocare dolores*, is to extend them. Again; the second "*therein*," at the close of the clause, has been considered by some as meaning "in the *renewal*," and by others,

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“in *the right to use*,” and by others still, “in the thing patented.” But, grammatically, it refers to the “thing patented,” and hence “the interests therein” are “the interests in the *thing patented*.”

Phillips treats it as a matter of course to mean in the “*patent*,” and uses that as synonymous to “therein ;” and though, in regard to my construction of the whole clause, the result is much the same, whether “therein” is considered to mean in “the thing patented,” or “the patent,” or “the renewal,” yet I incline to the first view of it as that most strictly grammatical and the most natural, as well as coming

[* 698] nearest to the views of this court in * *M'Clurg v. Kingsland*, 1 How. 210. Further objections to its meaning “in the right to use” will be stated hereafter, under another head. Passing, then to a more careful scrutiny of the whole clause, it would seem, that there could be but one rational test of “the extent” of the interests of assignees and grantees in the thing patented, and that such test must be the previous contract of assignment or grant, under which alone they hold any interests.

If that contract grants to them one fourth or one half of the old patent, or the use of it in one State or county, and for a term of five years, or ten, or fourteen, from the issue of the patent, then such and such alone is the extent of their interests, and they will not run into the new term. But if the contract goes further, and grants one half or all of the old patent to assignees, and for a term not only of fourteen years, but twenty-one years, or any number to which the patentee may afterwards become entitled by any extension or new grant, then such is the extent of their interests, and they will in such case run into the new term. This view gives meaning and spirit to every word, and excludes or alters none. This, too, conforms to the design of the section in taking away no part of the benefit intended to be conferred by it on

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the patentee, unless he has chosen to dispose of it clearly and deliberately, and receive therefor, either in advance or after actually granted, such additional consideration as he deemed adequate and contracted to be sufficient.

If after the word "*extent*" in this clause, there had been added, what is the legal inference, *both in time and quantity*, this meaning might have been still more clear to some. But without those words, the extent of interest seems to me to depend as much on the length of time the patent is granted to the assignee, as on the dimensions of territory over which he may use it, or the proportion of the whole patent he is authorized to use. It is like a lease-hold interest in land, or a grant of it. The extent of interest by such a grant of land is more or less, as the term is shorter or longer, quite as much as if the land conveyed is more or less in quantity.

The word "*extent*," in common parlance, varies somewhat in meaning, according to the subject to which it is applied, and as that changes, it may as well refer to time as to space or proportion; and more especially so, when applied to interests, as in patents, for a particular term of years.

There is another analogy in support of this view, that has not been urged in the ingenious arguments offered, but has struck me with some force. A patent was the description once applied to commissions for office; and the records of this court at first speak of the commissions of the judges as patents.

Now what is the extent of interest the incumbent has in any *office under his commission or patent? [* 699] Clearly, in part, the length of time it is to run, whether four years, during good behavior, or for life, and in part only its yearly profits; often quite as much depending on that length of time, as the amount of the salary or fees annually attached to the office.

What is the chief objection in reply to all this? Nothing,

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except that the assignee could get protected to the extent of his interest, in this view, by the contract alone, without the aid of the provision at the close of the eighteenth section, and hence that the provision is in this view unnecessary or nugatory, and must have been inserted for some other purpose. But were it in reality unnecessary, that would not require us to consider it as intending something different from its words, or different from the previous contracts of the parties. Legislatures often add clauses to acts, which do not prove to be in reality necessary, but are inserted from abundant caution and to remove future doubts or litigation. So, in this very act, in the eleventh section, it is declared, that a patent may be assigned. Yet this is probably unnecessary, as an interest like that of a patentee can of course be assigned, on common-law principles, without the aid of a statute.

When we look, however, to another circumstance, — that, though a contract of assignment would, without any clause in the statute, pass the interest to the assignee, yet it would not enable him to sue in his own name, — we can discover another reason for this provision still more effective. A clause had been inserted in a previous part of the act to enable the assignee to sue in his own name on the old patent, if violated; and, probably in doubt whether such provision would be extended to assignees under the renewal, when having any interest therein, it was provided further, that “the benefit of the renewal” should reach them to the extent of their interests therein, — a part of which benefit would be to sue in their own name for any infringement on their rights to it, as fully as they could do for a violation of their rights in the original patent, and as if that had been for twenty-one years. The provision thus would be far from nugatory, by clearly conferring on them every power and privilege to sue under the extension which they possessed under the original patent.

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By means of this provision, also, in another view, the condition of the parties might be changed, from a reliance on a contract alone that they should have a certain interest in the new patent, to a vested interest in it; or, in another view still, from an executory to an executed right.

There is, in the construction given by some of the majority of the Court to the clause immediately preceding this, another ample reason for inserting such a provision.

The previous clause, stating, that "thereupon the said patent shall have the same effect in law as though it had been originally granted for * the term of twenty- [* 700] one years," would, it is argued, if the section had there ended, have conferred on any assignee or grantee of the old patent, or any part of it, the extended term, so as to enable them to use the patent as if it originally had been granted for twenty-one years instead of fourteen.

Suppose, then, for a moment, that this construction was considered by Congress proper, or only possible, it is manifest that the additional clause which follows had a second and most pregnant object, — no less than to prevent that consequence, so hostile to the design of inserting the whole section, — to grant an extended term for the benefit and indemnity of the patentee, and not of the assignee. In this view, the last clause might well be added, as a limitation on what would otherwise be the inference from that just preceding it; and might well declare, instead of this inference, that assignees of the old patent should not hold it, in all cases, as if originally granted for twenty-one years, though patentees might; but that assignees should hold only in conformity to "the extent of their respective interests" in the thing patented. In other words, if by contract they had acquired clearly an interest for twenty-one years, they should hold for that time; but if by contract they had acquired an interest for only five or fourteen years, they should hold it only to

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that extent. This is rational, consistent with the great object of the section, and gives new and increased force and necessity to the clause. The assignees would then, after the renewal, hold the patent for all the time they had stipulated, and for all they had paid, but for no more.

It will be perceived, that very few assignees or grantees, prior to the passage of the Act of 1836, would in this view be likely to come under this provision, and be benefited by it; because, not knowing that any future law would pass allowing an extension, very few would be likely to anticipate one, and provide in their contract and pay for a contingent interest in its benefits.

This would make the provision, in practice, apply chiefly to future assignees, who, knowing that such a provision existed, might be willing to give something for a right to any extension which might ever take place under it; and therefore might expressly stipulate in the assignment for that right. Indeed, the arguments on the part of the patentee in this case have mostly proceeded on the ground that this provision was intended to apply solely and exclusively to future assignees. Considering that any other construction is in some degree retrospective, and that this would give force to the provision, as well as preserve the spirit of the section, I should be inclined to adopt it, if mine did not produce a like effect, and was not alike free from objection, as limited by me; because I do not make the provision retrospective except in cases where the parties had expressly contracted that the prior assignee should receive the benefit of any extension, and in that case it has the preference in its operation [* 701] * over the other view, as it carries into effect that express compact, and does not cramp the force of it to the future alone, where the language and the consideration are equally applicable to past engagements of this character.

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This conclusion is also strengthened by being in harmony with all the leading rules of construction applicable to statutes, while that adopted by the Court seems to my mind, to violate some of the most important of them.

Beside those already referred to, it is well settled, that "if a particular thing be given or limited in the preceding parts of a statute, this shall not be taken away or altered by any subsequent general words of the same statute." *Dwarris*, 658; *Standen v. The University of Oxford*, 1 Jones, 26; 8 Coke, 118, *b*. Here a particular benefit is, by the former part of the eighteenth section, conferred on a patentee, for reasons applicable to him alone; and yet, in this case, by the opposite construction, a few general words towards the close are construed so as in some respects to destroy entirely all those benefits of the patentee; and that too, when the language is susceptible of a different construction, more natural and perfectly consistent with the previous particular grant to the patentee.

Some collateral considerations have been urged in support of the conclusions of the Court on this branch of the construction, which deserve notice. On a close scrutiny they appear to me to amount to less in any respect than is supposed, and in some particulars strengthen the grounds of dissent. Thus, it has been said that the English Act of the 5th and 6th of William the Fourth, passed September 18th, 1835, was before Congress in 1836, and was intended to be copied or adopted; and as, under that, assignees have been allowed to participate in the extended time, it has been argued that such was the intention here. But it is doubtful whether that act was before the committee when they reported the bill in 1836, as the intervening time had been short, and the eighteenth section, on examining the journals and files, appears not to have been in the bill at all as originally introduced, or as originally reported; but was afterwards inserted

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as an amendment in the Senate. The consideration of this section, therefore, does not seem to have been so full as of the rest of the bill ; and it is very far, in language, from being a copy of the English act. Assignees are not named at all in that act ; and though, in extensions under it, assignees have in two or three cases been allowed to participate, it has only been where an enlarged equity justified it, — as where the patentee consented, or was to receive a due share in the benefits, or had clearly conferred a right in the extension by the assignment ; and where, also, the assignees are expressly named in the new grant or patent as entitled to a share of it. See Webster's Patent Cases, 477.

There, also, an assignee, under like circumstances [* 702] would doubtless benefit by the renewal, under its ordinary operations ; and the practice in England, thus limited, will fortify rather than weaken the construction I adopt of the true design of the last clause in our own law.

There is much, also, in another collateral consideration here, which does not apply in Great Britain, and which restricts conferring the benefit of an extension, or an extension itself, on an assignee by or under any statute, if it goes beyond what a patentee had himself contracted to do.

Here the Constitution limits the powers of Congress to give patents to inventors alone.

“The Congress shall have power to promote the progress of science and the useful arts, by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries.” — Article I., § 8.

No authority is conferred to bestow exclusive rights on others than “authors and inventors” themselves.

Hence a patent could not probably be granted to an assignee, nor an extension bestowed on one, independent of the assent or agreement of the patentee, or of its inuring to his

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benefit, without raising grave doubts as to its being a violation of the Constitution. But so far as inventors have expressly agreed that assignees shall be interested in their patents, or in the extensions of them, the latter may well be protected; and so, as far as administrators represent the inventor or patentee, when deceased, the grant to them is substantially a grant to the inventor, as the benefit then inures to his estate and heirs. But to grant an exclusive right to an assignee would confer no benefit on the patentee, or his estate; and it would violate the spirit as well as letter of the Constitution, unless the inventor had himself agreed to it, and had substituted the assignee for himself by plain contract, whether for the original term or any extension of it.

Cases have been cited in this country, likewise, where Congress, in ten or twelve instances, have renewed patents to the inventors; but they have never done it to assignees. And though in two out of the whole, which were renewed after the term had expired and the assignees and the public were in the free use of the patent, some limitations have been imposed on requiring further payments from the assignees for the longer use of the old patent; yet in these only, and under such peculiar circumstances, has it been done, and in these no term was granted by Congress directly to the assignee rather than the patentee; and this limitation or condition in favor of the assignee, in the grant to the patentee, is of very questionable validity, unless it was assented to by the patentee. In this case it is most significant of the views of Congress to relieve the patentee rather than assignees, that by a special law, passed February 26th, 1845, they have conferred on the representative of the * origi- [* 703]
nal patentee still another term of seven years, without mentioning the assignees in any way, and without any pretence that the benefits of this extension were designed for them.

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The argument, that the assignee is sometimes a partner and makes liberal advances, furnishes a good reason, in a pecuniary view, why an assignment should be made to him of such an interest in the old patent as will indemnify him, but furnishes none for giving him, even if he regards money above public spirit or benevolence, more than an indemnity; or for giving him a benefit in any renewal, which it has never been agreed he should have, and for which he never has paid.

So the reasoning, that the assignee stands in the shoes or in the place of the patentee, and represents him, and therefore should have an interest in the extension, applies very well, so far as he is assignee, or so far as the contract extends. But he no more stands in the shoes of the patentee beyond the extent of his contract, than an entire stranger does. Such are the cases of *Herbert v. Adams*, 4 Mason, 15, and that cited in 1 Hawk. P. C. 477, note.

In one, the assignee of the old patent represented the patentee as to that, and that only; and in the other, where by law a further copyright was authorized in all cases, and the patentee assigned his whole interest, the second term passed also; because the law had previously given it absolutely, without contingency or evidence of losses, but in connection with, or appurtenant to, the first copyright.

Again, it has been urged that the assignee should have the benefit of the extension; otherwise he may have made large expenditures, in preparing for a free use of the patent after the original term expires, and will lose them in a great degree, or be obliged to pay largely for the continued use of the patent. But this same reasoning applies equally well to the whole world as to the assignee; because any individual, not an assignee, may have incurred like expenditures in anticipation of the expiration and free use of the old patent. In fact, the argument is rather a legislative than judicial one, and operates against the policy of the whole section, rather than the construction put on the last clause.

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But the hardship to any person, in such case, is more apparent than real. The price to be paid for the new patent is not so much as the gain by it, and hence those who have proposed to use it and do use it after the extension, and pay anew for a new or further term, gain rather than lose, or they would have employed the old machinery in operation before this invention.

Nor is it any relief to the community at large, as seems by some to have been argued, to hold that the renewal, or a large part of it, vests in the assignee and grantee rather than in the patentee. For the great mass of the people must still purchase the patent, or the *right to use [* 704] it, of some one, and must pay as much for it to the assignee as to the patentee.

Finally, the construction of the Court, by conferring any privilege whatever on assignees and grantees beyond the extent of their interests in the thing patented, when those interests, as in this case, were expressly limited in the contract to the term of the old patent, goes, in my view, beyond the language of the act, beyond the contract of assignment, beyond the consideration paid for only the old term, and beyond any intention of the legislature for relief or indemnity to others than unfortunate patentees.

I feel not a little fortified in these views on the case, by several decisions and opinions that have heretofore been made, in substantial conformity to them. Indeed, independent of opinions in some of the actions now before us (from which an appeal has been taken, or the cause has come up on a certificate of division) every reported case on this subject has been settled substantially in accordance with these views. See *Woodworth v. Sherman*, and *Woodworth v. Cheever et al.*, Cir. Ct. for Mass., May Term, 1844, decided by Justice Story; *Van Hook v. Wood*, Cir. Ct. for New York, October Term, 1844, by Justice Betts; *Wilson v. Curties &*

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Grabon, Cir. Ct. for Louisiana, by Justice McCaleb; Brooks & Morris v. Bicknell et al., Cir. Ct. for Ohio, July Term, 1844, by Justice McLean (Western Law Journal, October, 1845); Butler's opinion, as Attorney-General, in Blanchard's case (Opinions of Attorneys-General, pp. 1134 and 1209.)

All that remains for me is to advert a moment to that branch of the construction adopted by the majority of the Court, which, after giving to both assignees and grantees a benefit in the new patent or term beyond "the extent of their interests" under the contract of assignment, undertakes to go still farther, and make a discrimination between assignees and grantees, as to the enjoyment, under the renewal, of their different original interests. It gives to the latter, the grantees, by the mere force of this last clause in the eighteenth section, the enjoyment of all their old interests during the whole of the new term; but it gives to the former, the assignees, the enjoyment of only about a third portion of their old interests during that term. In other words, it gives to "grantees of the right to use the thing patented" a continuance of all their interests; but to assignees, whose interests extended to the right to make and to vend, as well as use, the thing patented, a continuance of only a part of theirs. In such a discrimination, uncountenanced and unwarranted, as it seems to me, by either the words or the spirit of the act of Congress, I am sorry to find another strong ground of dissent to the opinion of the Court. The act does not say, as is their construction, that "the benefit" of only "the right to use the thing patented" shall extend to any one, whether an assignee [*705] or grantee; but that the benefit of the *renewal shall extend to both, "to the extent of their respective interests," though differing clearly in extent as they do, and as will soon be more fully shown.

"Judges are bound to take the act of Parliament as the

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legislature have made it." 1 D. & E. 52 and *Dwarris on Statutes*, 711.

But the words in this act, "the right to use the thing patented," must be transposed, and other words altered in their ordinary meaning, to make these a description of the interests conferred.

They are now a description of one kind of purchasers, that is "grantees of the right to use the thing patented," to whom the renewal should extend, if they had stipulated for any interest therein by their contracts. The clause refers to two classes, who may in such case be benefited by the renewal. "Assignees" are one class, and "grantees of the right to use the thing patented," are the other class. This accords with the language itself, and also with the punctuation of this clause, as examined by me in manuscript on file in the Senate, and as printed by the State department, having no comma or other pointing in it except after the word "patented." It accords, too, with what is well understood to be the fact, that assignees and grantees usually constitute two distinct classes of purchasers, the former being those who buy a part or all of the patent-right itself, and can protect their interests by suits in their own name; and the latter being those who buy only "the right to use the thing patented," and generally, except where the use is exclusive (fourteenth section) cannot institute suits in their own name for encroachments upon it. In the face of this, to hold that assignees and grantees mean the same thing here, and that the words "of the right to use the thing patented" apply equally to both, is a departure from the above established usage in employing those terms, and gives a different meaning to them from what is previously twice given in this very act. Thus in the eleventh section an "assignment" is mentioned as one thing, and "a grant and conveyance of the exclusive right," &c., as another, and in the fourteenth section, "assigns" are spoken of as if one

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class, and "grantees of the exclusive right," &c., as if another. And why does the conclusion to this clause say "to the extent of their *respective* interests therein," if such assignees and grantees as to patents were not in this very clause considered by Congress as having different interests, and that these were to be protected according to their *respective* extents? It would have said, and must be made to say, if sustaining the construction of the Court, "to the extent of that *right*," or "to the extent of that *interest*," and there stop. Manifestly, then, there is not conferred on these two classes, by this clause, either in its spirit or *in totidem verbis*, merely "the right to use the thing patented," but on the contrary, "the benefit of the renewal," "to the extent of [* 706] their respective interests in the * thing patented."

The interests of the grantees may be limited to the use, and those of the assignees may not be, but include the right to make and vend as well as use; yet large or long as may be the interests of either, the benefit of the renewal is to cover them, if *the extent* of them, under the original assignment or grant, reached to the new term. One is not to have the whole of his interests protected and the other a part only, when their equities are the same. But the assignee is to have to the extent of his, which is to make, vend, and use; and the grantee only "of the right to use" is to have to the extent of his.

This, to my apprehension, is unquestionably the substance of what Congress has said on this topic; and yet it is only by supposing new language not in the act, or by transposing some of the old, so as not to be in harmony with the original structure of the sentence, or by giving a meaning to words different from what has been established and, in my view, only by doing this, that any foundation can be laid in support of this part of the construction approved by the Court. But "it is safer," said Mr. J. Ashhurst, "to adopt what the

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legislature have actually said, than to suppose what they meant to say." 1 D. & E. 52; 6 Adolph. & Ellis, 7.

It may be well, also, not to forget, that it is always more judicial, and less like legislation, to adhere to what Congress have actually said, and that it is more imperative to do this when by adhering to it you carry out, as in this case, the manifest intention of the previous part of the section. Nor can the inconsistency produced by the construction of the Court be without influence in creating doubts as to its correctness; as by it "the benefit of the renewal" will be extended to assignees and grantees not in ratio with "their respective interest," — the words of the law — nor in conformity with their respective contracts, nor according to the respective considerations they have paid, nor in proportion to the respective losses they have sustained, but, under the same general permission as to the extent of the "respective interests" of both, one class will be allowed to the full extent of his previous interest, and the other to only a part of that extent.

By what authority, let me respectfully ask, is this general permission thus divided, and in one class or case limited and in the other not? By what legal authority are assignees cut off from a valuable portion of their interests in a patent, while grantees to use the thing patented are allowed to exercise the whole of theirs, and both under one and the same general permission, covering all "their *respective* interests"? To make this discrimination, and allow to one class the full extent of their interests and to the other not the full extent of theirs, when the law says it shall be "to the extent of their *respective* interests," and when their respective contracts and equities show that this should include both the duration and quantity of their interests, looks like a distinction in a great degree arbitrary, * and not a little in conflict [* 707] with the plain words and design of the act of Congress.

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But, beside this further departure from what seems to me the obvious meaning of the eighteenth section, caused by this branch of the construction of the Court, it will fail, I fear, as any compromise of the difficulties arising under the section, if any compromise be expected from it. It is not likely to avert ruin from most of those indigent inventors, who have in their distresses resorted for aid to the delusive provisions of that section. Their very necessities and embarrassments, which are the justification for granting the renewal to them, have usually forced them to sell and assign all the original patent, as was the case with Woodworth in this instance; and if in such circumstances the law is to strip them of all benefits under the renewal, and, without any contract to that effect, confer those benefits on the assignees and grantees of the old patent, the law is perfectly suicidal as to the only design to be effected by its bounty. But if, seeing this, the construction is modified, as here, by the Court, so as to deprive the patentee in such cases of only the benefits of the use of his old patent or old machines during the new term, this qualification in the operation of the law will, it is apprehended, usually prove a mere mockery, working, in most cases, as fully as the Court's construction without the qualification would, the entire defeat of the laudable object of the renewal towards patentees. In one or two of the cases now before us, the patentee, under this construction, will still be subjected to defeat and burdensome costs. In relation to its effect on the present patent as a whole, all the consequences cannot now be ascertained. But it is admitted, that the inventor had assigned the whole of the old patent, so that no right whatever to use will remain in his representatives to dispose of; or if a right remains where machines are not now in actual use, probably enough are now in use to supply, for some time, the public wants in most parts of the United States.

The right to continue to use them will probably last during

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the whole seven years the renewal runs, as the machine will usually, with proper repairs, do service beyond that time. It will not, then, be very difficult to calculate what value, during the seven years, will be derived from the right to make and vend machines, when the use of others already in existence is scattered over every section of the country, and they may be employed all the time of the extended patent, without the assignees or grantees ever having paid or being obliged to pay a dollar for that extended use.

Looking, then, to the beneficent design of the eighteenth section, to enforce the Constitution, by advancing science and the arts, and protecting useful inventions, through the security for a longer term to men of genius of a property in their own labors, in cases where they had not been already remunerated for their time and expenses, I cannot but fear that the construction given by the *majority of the [*708] Court will prove most unfortunate. It will tend to plunge into still deeper embarrassment and destitution, by losses in litigation and by deprivation of a further extended sale of their inventions, those whose worth and poverty induced Congress to attempt to aid them.

Nor would a different construction tie up, as some suppose, the future use of numerous patents. Of the fourteen thousand five hundred and twenty-six heretofore issued, since the Constitution was adopted, I am enabled, by the kindness of the Commissioner of Patents, to state, that only ten have been renewed under the eighteenth section during nearly ten years it has been in operation.

And if the individuals who use the improved machines, the fruit of the toil and expense and science of others, were obliged in but one case in a year, over the whole country, to pay something for that further use, is it a great grievance? They are not obliged to employ the patent at all, and will not, unless it is better by the amount they pay than what was in

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use before. And is it a great hardship or inequitable, where they are benefited by another's talents, money, and labor, to compensate him in some degree therefor?

While other countries, and Congress, and our State Courts are adopting a more liberal course yearly towards such public benefactors as inventors, I should regret to see this high tribunal pursue a kind of construction open to the imputation of an opposite character, or be supposed by any one to evince a feeling towards patentees which belongs to other ages rather than this (and which I am satisfied is not cherished) as if patentees were odious monopolists of the property and labors of others, when in truth they are only asking to be protected in the enjoyment and sale of their own, — as truly their own as the wheat grown by the farmer, or the wagon built by the mechanic.

Nor should we allow any prejudices against the utility of patents generally, and much less against the utility of the invention now under consideration, to make our constructions more rigid in this case. The settled doctrine of the Courts now, under the lights of longer experience, though once otherwise, is in doubtful cases to incline to constructions most favorable to patentees. *Grant et al. v. Raymond*, 6 Peters, 218; 1 Sumner, 485; *Wyeth v. Stone*, 1 Story's Rep. 287; *Blanchard v. Sprague*, 2 Story's Rep. 169. Nor is it strange that this should be the case in the nineteenth century, however different it was some generations ago, when we daily witness how the world has been benefited since by the patented inventions and discoveries in steam, in all its wonderful varieties and utilities, and in cleaning, spinning, and weaving cotton by machinery for almost half the human race, and in myriads of other improvements in other things, shedding so benign a light over the age in which we live, and [* 709] most of them excited and matured only * under the protection secured to their inventors by an enlightened government.

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Some estimate can be formed of the usefulness of the present patent, and its title to favor, when one machine is computed to perform the labor of planing and grooving in one day that would require fifty days by a man, and which is supposed to reduce near seven tenths of the expense of such work in every building where the improved method is used, — as it ere long will be by the many millions of our own population, and in time over the civilized world. Every honest social system must shield such inventions, and every wise one seeks undoubtedly to encourage them.

To be liberal, then, in the protection of patentees, is only to be just towards the rights of property. To stimulate them in this and other ways to greater exertions of ingenuity and talent is to increase the public wealth, and hasten the progress of practical improvements, as well as of science. And to discountenance encroachments on their rights, and defeat piracies of their useful labors, is calculated in the end to better the condition of every rank in society, and introduce wider and faster all the benefits of a superior state of civilization and the arts.

JAMES G. WILSON, COMPLAINANT AND APPELLANT V. JOSEPH
TURNER, JUNIOR, AND JOHN C. TURNER, DEFENDANTS.

[4 Howard, 712. January T. 1846.]

The decision of the Court in the two preceding cases, namely, that where a patent is renewed under the Act of 1836, an assignee under the old patent has a right to continue the use of the machine which he is using at the time of the renewal, again affirmed.

This case came up, by appeal, from the Circuit Court of

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the United States for the District of Maryland, sitting as a Court of Equity.

The bill was filed by Wilson, as the assignee of William W. Woodworth, the administrator of Woodworth, the patentee, as stated in the report of the preceding case. It set out the patent and assignment, and then prayed for an injunction and account.

The answer referred to the mutual assignment made between Woodworth and Strong on the one part, and Toogood, Halstead, Tyack, and Emmons of the other part, which was recited in the preceding case, and traced title regularly down from these latter parties to the defendants.

A statement of these facts was agreed upon by counsel, and all the documents set forth at length ; and upon this statement, together with the bill and answer, the cause was argued.

At April term, 1845, the Court dismissed the bill, and from this decree the case was brought up, by appeal to this Court.

It was argued by *Phelps* and *Webster*, for Wilson, the appellant, and *Schley*, for the appellees, who were the defendants below.

Mr. Justice NELSON delivered the opinion of the Court.

The judgment of the Court in the previous case of *Wilson v. Rousseau et al.*, disposes of the question in this case, and affirms the decree of the Circuit Court.

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ANDREW P. SIMPSON, JOSEPH FORSYTH, AND BAGDAD MILLS,
APPELLANTS V. JAMES G. WILSON.

[4 Howard, 709. January T. 1846.]

The decision of the Court in the preceding case of *Wilson v. Rousseau et al.*, namely, that when a patent is renewed under the Act of 1836, an assignee under the old patent has a right to continue the use of the patented machine, but not to vend others, again affirmed.

An assignment of an exclusive right to use a machine, and to vend the same to others for use, within a specified territory, authorizes the assignee to vend elsewhere out of the said territory, the product of said machine.

The restriction upon the assignee is only that he shall use the machine within the specified territory. There is none as to the sale of the product.

THIS case came up on a certificate of division in opinion between the judges of the Circuit Court of the United States for the District of Louisiana, sitting as a Court of Equity.

Wilson was the complainant below, who filed a bill, and obtained an injunction against Simpson, Forsyth, and Mills. After sundry proceedings in the case, Forsyth put in a plea, and a rule was obtained, that the plaintiff should show cause why the injunction should not be dissolved. Upon argument the Court dismissed the rule, and the case was set down for hearing by consent of parties; the complainants not admitting the facts alleged in the plea, but for the purpose of raising the questions of law which they involved, and obtaining a speedy decision of the same.

* Upon the argument, the division of opinion arose [* 710] which will be presently stated.

The facts in the case were these:

The patent for planing, &c., having been obtained by Woodworth in 1828, as has been particularly mentioned in the report of the preceding case of *Wilson v. Rousseau et al.*,

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Forsyth, one of the defendants below, became an assignee under that patent for all its rights within the county of Escambia, in West Florida. This took place in 1836.

Woodworth, the patentee, having died, his administrator, in 1842, obtained a renewal of the patent under the Act of 1836; and in 1843 assigned to Wilson, the complainant below, all the rights under the extended patent for the States of Louisiana, Alabama, and the Territory of Florida.

On the 13th of April, 1844, the said Wilson instituted proceedings in equity, in the Circuit Court of Louisiana, against the defendants, on the ground that they infringed on his just rights by setting up and putting in operation the said patented machines in the territory of Florida; and by vending in New Orleans large quantities of dressed lumber, plank, &c., the products of the machines there established.

In May, 1845, the cause came up for hearing, as above stated, when the following points were ordered to be certified to this Court, namely: —

“ J. G. WILSON v. SIMPSON ET AL. No. 1925.

“ This case coming on to be heard on demurrer filed to the plea of Joseph Forsyth, one of the defendants set down for hearing by consent, and the matters of law arising on said plea, the following points became material to the decision, and being considered, the Court were divided in opinion on the following points: —

“ 1. Whether, by law, the extension and the renewal of the said patent, granted to William Woodworth, and obtained by William W. Woodworth, his executor, inured to the benefit of said defendant, to the extent that said defendant was interested in said patent before such renewal and extension.

“ 2. Whether, by law, the assignment of an exclusive right to the defendant, by the original patentee, or those claiming

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under him, to use said machine, and to vend the same to others for use, within the county of Escambia, in the Territory of West Florida, did authorize said defendant to vend elsewhere than in said county of Escambia, to wit, in the city of New Orleans, State of Louisiana, plank, boards, and other materials, product of a machine established and used within the said county of Escambia, in the Territory of West Florida.

“ Wherefore, upon the request of defendants’ counsel, it is ordered and directed, that the foregoing points of law be certified for the opinion of the Supreme Court of the United States.

*The case was argued by *Gilpin* and *Westcott*, [* 711] for the defendants below, who were the appellants in this Court, and by *Henderson* and *R. Johnson*, for Wilson.

Mr. Justice NELSON delivered the opinion of the Court.

The questions in this case come up on the certificate of a division of opinion in the Court below. The judgment of this Court in the previous case of *Wilson v. Rousseau et al.*, upon the second question certified in that case, disposes of the first question certified here, and is answered accordingly.

The second question certified involves the point, whether or not the assignment of an exclusive right to make and use, and to vend to others, planing-machines, within a given territory only, authorizes the assignee to vend elsewhere, out of the said territory, the plank, boards, and other materials, the product of said machines.

The Court have no doubt but that it does; and that the restriction in the assignment is to be construed as applying solely to the using of the machine. There is no restriction,

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as to place, of the sale of the product. Certificate accordingly to the Court below.

Order.

This cause came on to be heard, on the transcript of the record from the Circuit Court of the United States for the District of Louisiana, and on the points and questions on which the judges of the said Circuit Court were opposed in opinion, and which were certified to this Court for its opinion agreeably to the act of Congress in such case made and provided, and was argued by counsel. On consideration whereof, it is the opinion of this Court, —

1. That, by law, the extension and renewal of the said patent granted to William Woodworth, and obtained by William W. Woodworth, his executor, did not inure to the benefit of said defendant to the extent that said defendant was interested in said patent before such renewal and extension; but the law saved to persons in the use of machines at the time the extension takes effect the right to continue the use.

2. That an assignment of an exclusive right to use a machine, and to vend the same to others for use, within a specified territory, does authorize an assignee to vend elsewhere, out of the said territory, plank, boards, and other materials, the product of such machine.

It is therefore now here ordered and decreed by this Court, that it be so certified to the said Circuit Court.

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WILLIAM W. WOODWORTH, ADMINISTRATOR, &C., AND E. V. BUNN, ASSIGNEE, COMPLAINANTS AND APPELLANTS, v. JAMES, BENJAMIN, AND ALPHEUS WILSON.

[4 Howard, 712. January T. 1846.]

An objection to the validity of Woodworth's patent for a planing machine, namely, that he was not the first and original inventor thereof, is not sustained by the evidence offered in this case.

Nor is the objection well founded, that the specifications accompanying the application for a patent are not sufficiently full and explicit, so as to enable a mechanic of ordinary skill to build a machine.

An assignee of the exclusive right to use ten machines within the city of Louisville, or ten miles round, may join his assignor with him in a suit for a violation of the patent-right, under the circumstances of this case.

* THE bill was filed in this case, in the Circuit [* 713] Court for the District of Kentucky, by the complainants, setting forth that William Woodworth was the inventor and patentee of a certain planing machine, describing it; also, the extension of the said patent to W. W. Woodworth, as administrator, and that E. V. Bunn, one of the complainants, took an assignment from the said W. W. Woodworth for the exclusive right of making, using, and vending machines for planing, &c., under the extension of the patent, within the limits of the city of Louisville, and in the district of country ten miles around said city.

The bill further charges, that the defendants have, in violation of the rights of the complainants, erected and put in operation in the city of Louisville a planing machine, &c., which machine is, in all its material parts, substantially like and upon the plan of the machine of the complainants, and persists in using the same.

The defendant James Wilson answered the bill, substantially denying most of the material allegations contained in it.

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The other defendants answered by denying that they had any interest in the machine.

The Court granted an injunction, enjoining the defendant, James Wilson, from using the machine.

Afterwards an application was made to the Court, on behalf of the complainants, for a rule upon the defendant, James Wilson, to show cause why an attachment should not be issued against him for a violation of the injunction, which was accordingly granted.

The defendant showed cause by affidavit, in which he affirms, that immediately on the service of the injunction he had ceased to use the machine mentioned in the bill, and conformed himself to the order of the Court, and that he had purchased and set up Bicknell's planing machine, which he was using, and which was substantially different from the machine of the complainants.

Much testimony was taken in the Court below, on the question whether the machine which the defendant had substituted and was using was, in all its material and substantial parts, like Woodworth's, which it is not material to refer to more particularly. A great deal of testimony was also taken, for the purpose of showing that Woodworth was not the original inventor of the complainant's machine, which it is also not necessary to recite.

The cause afterwards came to a hearing on the merits, upon the pleadings and proofs, and also upon the rule previously granted against the defendant, to show cause why an attachment should not issue for a violation of the injunction, and, after consideration, the Court dissolved the injunction and dismissed the bill, and discharged the rule to show cause, with costs.

As the opinion of the Court refers in general terms to the interest of Woodworth under the assignment, as a [* 714] justification for his * being joined as a party in the

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suit, it is proper to set forth the assignment, which was as follows.

Transfer from Woodworth, Administrator, &c., to E. V. Bunn.

“Whereas William Woodworth, now deceased, did, in his lifetime, obtain letters-patent, issued under the great seal of the United States, bearing date the 27th day of December, 1828, giving and granting to him, the said Woodworth, his heirs, administrators, and assigns, for and during the term of fourteen years from the date of the said letters-patent, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, a certain improved method for planing, tonguing, grooving, and cutting into mouldings, or either, plank, boards, or any materials, and for reducing the same to an equal width and thickness; and also for facing and dressing brick, and cutting mouldings in, or facing, metallic, mineral, or other substances.

“And whereas William W. Woodworth, administrator of said William Woodworth, hath applied and obtained an extension of said letters-patent for the term of seven years from and after the expiration of said patent, to wit, the 27th day of December, 1842, pursuant to an act of Congress in such case made and provided, and hath a certificate of said extension annexed to said patent, signed by the Commissioner of Patents, under the great seal of the Patent Office of the United States, and dated November 16th, A. D. 1842. And whereas E. V. Bunn, of the city of Louisville, in the State of Kentucky, hath fully viewed, examined, and considered for himself the said improvement, and of his own motion hath requested and desired the said William W. Woodworth, administrator of said William Woodworth, deceased, to give a license and permission, in writing, for constructing and using machines on the said improved plan in the city of Louisville aforesaid, including the district of country within ten miles of

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said city, and in no other city, town, or place in the United States, or the territories thereof, on the conditions hereinafter mentioned; and have offered to pay him the sum of fifteen hundred dollars for such license and consent in writing; with which request and desire the said William W. Woodworth, administrator of William Woodworth, deceased, has agreed to comply.

“Now, know all men by these presents, that the said W. W. Woodworth, administrator of William Woodworth, deceased, in consideration of the said sum of fifteen hundred dollars, secured to be paid to him, the said William W. Woodworth, administrator of William Woodworth, deceased, doth hereby give his full consent and permission in writing, and license to the said E. V. Bunn, and to his executors, administrators, and assigns, to construct and use, during the said extension of the aforesaid patent, ten planing machines on the improved plan aforesaid, within the city of [* 715] Louisville, * and including the district of country within ten miles of said city, and in no other city, town, or place within the United States or the territories thereof; and also, within said limits, to dispose of the plank or other things dressed and prepared in the said machines; and he doth also hereby authorize and empower the said E. V. Bunn, and his executors, administrators, and assigns, in the name of said Woodworth, administrator aforesaid, or in his own name, to commence and prosecute to final judgment any suit or suits against any person or persons who shall construct or use the said improvements within the said limits, contrary to the true meaning and intent of the aforesaid letters-patent, and the extension thereof, and the law in such case made and provided; and to receive for his own benefit, and at his own proper costs and charges, any penalty or penalties which he may recover. And in consideration of the premises, it is hereby covenanted and agreed, by and between the said William W. Woodworth, administrator of William

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Woodworth, deceased, his executors, administrators, and assigns of the one part, and the said E. V. Bunn, his executors, administrators, and assigns of the other part, as follows, namely: —

“ 1st. That the said William W. Woodworth, administrator of William Woodworth, deceased, his executors or administrators, during the terms aforesaid, shall not, nor with themselves, construct, or use, nor give their license, consent, and permission to any other person than the said E. V. Bunn to construct or use, the improved planing machine, aforesaid, within the said city of Louisville, or within the district of country within ten miles of said city.

“ 2d. That the said E. V. Bunn, his executors, administrators, and assigns, shall not nor will, during the times aforesaid, construct or use more than ten machines as aforesaid within the limits above mentioned, nor construct or use any such machines, nor sell and dispose of any plank or other thing dressed and prepared in such machine, anywhere else within the United States and the territories thereof; it being declared to be the true intent and meaning of these presents that not more than ten planing machines in the whole shall be constructed and used by virtue of the license, consent, and permission herein given.

“ 3d. It is understood and agreed that the said William W. Woodworth has entered and filed at the Patent Office, at Washington, a disclaimer of that part of said patent for the planing machine which claims the reduction of materials, boards, and plank to an equal width and thickness by circular saws; and a lien is retained and renewed on this assignment for the security of the payment of the fifteen hundred dollars, — the consideration and purchase-money to be paid to said Woodworth.

Signed, sealed, and delivered, this 21st day of June, 1843.

W. W. WOODWORTH, [L. S.]

Administrator of W. Woodworth, deceased.

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[* 716] “The words ‘to him in hand paid by the said’ were erased, and the word ‘ten,’ and the words ‘in the name of said Woodworth, administrator aforesaid, or in his own name,’ were interlined before the execution of the foregoing instrument in presence of D. E. Sickles.”

The cause was argued by *Latrobe* and *Staples*, for the complainants, Woodworth and Bunn, and by *Bibb*, for the defendants.

Mr. Justice NELSON delivered the opinion of the Court.

The objection taken, that the administrator could not apply for an extension of the patent granted to Woodworth, his intestate, under the eighteenth section of the Patent Law, has been disposed of in the previous case of *Wilson v. Rousseau et al.*, and need not be further noticed.

Another objection taken to the right of the complainants to maintain the suit is, that Woodworth was not the first and original inventor of the planing machine, against the using of which the defendant was enjoined.

Without going into the proofs in the case, which are very voluminous, it will be sufficient to state, that after fully considering all the evidence produced bearing upon the question, the Court is satisfied that the weight of it is decidedly against the objection, and in favor of the allegation in the bill, that Woodworth was the original inventor of the machine.

It is objected, also, that the specifications accompanying the patent were not sufficiently full and explicit, so as to enable a mechanic of ordinary skill to build a machine. The Court is not satisfied, according to the proof in the case, that the objection is well founded, and it cannot be relied on as affording sufficient ground for the dismissal of the bill.

A further objection was taken, that W. W. Woodworth, one of the complainants, was improperly joined with E. V.

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Bunn, the assignee of the exclusive right in Louisville and ten miles around it. The Court is of opinion, that the interest of Woodworth in the assignment, as appears from the record, is sufficient to justify his being made a party jointly with the assignee.

Some other objections were taken to the maintenance of the suit on the argument, which it is not material to notice particularly; they have all been considered, and in the judgment of the Court afford no sufficient ground for the dismissal of the bill and the dissolving of the injunction.

We think the Court erred, and that the decree dismissing the bill, as to the defendant James Wilson, and dissolving the injunction, should be reversed, and that a perpetual injunction should issue.

WILLIAM HOVEY, IN EQUITY, *v.* SILAS STEVENS.

[1 Woodbury & Minot, 290. May T. 1846.]

Where a bill is filed for an injunction against the use of a patent, and the answer denies the use of it, and also the originality of the invention, if the denial is supported by affidavits bringing the originality of the invention into doubt, an injunction will not issue till the parties settle the right in an action, which is pending between them at law, for a violation of the patent, unless the complainant shows, that he has for some time been in the undisturbed use and sale of his patent, or has recovered damages against others for the use of it.

* Nor can a patent be aided in respect to such an use or such recoveries, if it be one useful in respect to another patent for another invention, where such an use and such recoveries have been had, unless it is connected in law to that patent and is a part of it.

It is doubtful, whether a mere change in the mode of fastening knives on a cylinder to be ground, or to fasten one instead of several, is a change in structure from an old machine sufficient to justify a patent for it.

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If the respondent constructed and used his machine before the complainant took out a patent for his, it is not a justification, if he had seen and copied an improvement from the complainants.

If the patentee claims, as a part of his invention, some things which are old and some new, he cannot succeed, without disclaiming what is old.

It should appear also with reasonable certainty, whether the complainant in his patent claims a new combination of old parts and things, or a new invention of new parts, and if not intelligible as to which is claimed, the patent may be void for uncertainty.

Declarations of a party, made before the dispute arose, in connection with acts, may be competent evidence for him, as tending to show what intentions then existed.

THIS was a bill in equity, filed April 14th, 1846, for an injunction against the defendant not to make or use a machine "for grinding tools," for which a patent had been taken out by the plaintiff, September 23d, 1845.

Among other things, the bill alleged that the plaintiff, before February 12th, 1844, had invented and obtained a patent for a machine called "Hovey's Spiral Revolving Straw Cutter," which, on the 1st of April, 1845, was violated by the defendant and one E. Hovey, who were sued therefor, and the action against the defendant settled or compromised, and that against Hovey prosecuted to a verdict and judgment in favor of the plaintiff. It was further averred, that the machine for grinding tools was necessary to make the other useful, being adapted to grind the knives in the straw-cutter and being a highly beneficial machine for that purpose, and that it was copied and infringed upon by the defendant, October 1st, 1845, to an extent very injurious to the plaintiff. That for this an action at law has been instituted against him, but before a trial can be had, the damage is likely to be great, and the defendant is irresponsible, and, therefore, an immediate injunction is prayed for.

[* 292] * Various other matters were detailed in the bill, but it is not necessary to repeat them, except as some of them may be mentioned in the opinion of the Court.

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The answer denied the originality of the invention, and all the principal allegations affecting the defendapt and was sworn to, accompanied by several affidavits. Others were put in by the plaintiff, which will be referred to in the opinion.

The case was argued at this term by *Hallett* and *Charles Sumner*, for the complainant, and *Stanton* and *Charles L. Woodbury*, for the defendant.

WOODBURY, J. I shall pass by all the formal objections to the bill in this case, as being multifarious, and as seeking distinct objects, some of which are supposed by the defendant to be improper and untenable. Because a decision on the merits may be more satisfactory to both parties, if there be enough in the case to enable me to form one.

Nor is it necessary to settle in detail the objections to some portions of the depositions, which are excepted to as incompetent; because my opinion will not rest on those portions where the declarations of third persons, not agents nor witnesses, are introduced by either side; or those of the parties are introduced by themselves, unless made before this dispute and proving the existence of certain inventions in connection with certain acts before a particular date. In such case, as developing a link in a transaction, they may be competent. See *Burnham v. Rangeley*, *ante*, p. 7, and cases there cited.

Looking then, to the merits, before deciding whether the patent of the plaintiff for grinding tools has been violated or not, it is necessary to ascertain first, what is the extent and character of it; how are they, if this patent is considered as standing alone? and how are they, if it is considered as connected with the prior patent by the plaintiff for cutting straw?

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[* 293] * Standing alone, the patent itself purports to be merely for "a new and useful improvement in machinery for grinding tools."

When we refer to the schedule annexed for a specific and more minute description of it, the patent is described to be "a new and useful machine for grinding the twisted or spiral cutters or knives used in the machine for cutting straw, and generally known as Hovey's straw-cutter."

There is then added, "The nature of my invention consists in attaching the twisted (sometimes called spiral) blades or cutters to a flange, projecting from a stock, hung on journals in traversing carriage, so as to present the back of the cutter to be ground to the action of a grindstone or other reducing or polishing wheel, so that as the cutter on the carriage traverses lengthwise, it shall vibrate freely on the axis of the stock to which it is attached, to follow the twist of the blade, and grind it to a sharp edge, such as is required in cutting by impinging the cutting edges against the surface of a cylinder by the rotation of the two cylinders or the cutting cylinder on a plane, the cutting being effected by a pressure towards the centre of the axis of the cylinder of knives. The reciprocating motion of the cutters during the traverse motion being governed by the spiral or twisted surface of the knife itself, or any thing analogous thereto." Had the specification closed here, or only made references afterwards to the drawings, and some particulars as to gearing and details in the construction, there could not be much doubt that the patentee intended to claim, as a part of his invention, the "attaching the twisted (sometimes called spiral) blade or cutters, to a flange projecting from a stock."

But he proceeds to add another description of his invention, in which this part is omitted, and details it as being "to give to the stock to which the knives or cutters are attached, a reciprocating motion on its axis whilst it traverses longitu-

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dinally before the grinder. And therefore," says he again, * in the summary which follows immediately in the close of his specification, " what I claim as my invention, and desire to secure by letters-patent, is giving to the spiral or twisted knife or cutter, attached to a flange in a line radiating (or nearly so) from the axis of the stock a traversing motion in the direction of its axis, in combination with a reciprocating rotary motion on its axis, when this latter motion is governed by the twisted plane of the cutter, or any thing essentially the same to enable the grinder to give the required bevel to the ground face and the proper line to the edge, substantially in the manner herein described."

From these two last descriptions of his invention, some doubt is cast over the fact, whether the mode of attaching the cutter to a flange in the stock, was intended as a part of it or not. He says nothing about it in one of them, and in the other, it seems more natural to regard what is said about the attachment of the cutter, as a mere description of the machine, than as a part of the claim of what had been newly invented by him. This would confine the claim for inventive novelty as he had just before done, to the " traversing motion of the stock, in combination with a reciprocating rotary motion on its axis."

From these last clauses, independent of the description in the commencement of the specification, I should come to the conclusion, that the attaching of the cutter to the stock was not claimed as his invention, but merely used as a part of his machine. But we can resort to the introduction of the specification as well as the summing up at the close, to ascertain the true extent of the claim. See the cases collected in *Davoll v. Brown*, *ante*, p. 53, 59. Adverting to that, I am inclined to hold, for the purpose of this inquiry, that notwithstanding the second description of his invention, omitting

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entirely the attachment of the cutters and the final description of it, speaking of the attachment rather as a part of the machine, than a part of what he claimed as his invention, it * may be regarded as a portion of that claim. Though in describing all machines, many parts mentioned are not new, nor claimed as what has been invented by the patentee, such as in this case the grindstone and the bands, and several other portions, yet at first he seems distinctly to claim this mode of attaching the knife as a part of his invention; and though not repeating that claim in another description afterwards, and leaving it somewhat ambiguous in the summing up, yet he does not expressly renounce it, and is therefore probably entitled to it. In the next place, considering the attachment of the knife as a part of the claim, can the whole invention be treated as a part and parcel of the former patent for the straw-cutter? The answer to this becomes material in the discussion of future points, on account of the longer possession enjoyed of the patent for the straw-cutter, and the verdicts which have been recovered for it, and the settlement made formerly for the use of it by the present defendant. But neither the patent nor specification for the straw-cutter, refers to the grinder, nor does the patent for the latter say any thing of the grinder being auxiliary to the straw-cutting machine. It is described there as an "instrument or machinery for grinding tools" generally; and from the evidence, it may be used to grind any tools, that need a bevel or chisel edge, and can be securely attached or fastened into the stock. But in the specification, as before detailed, it is described "as a new and useful machine for grinding the twisted or spiral cutter or knives used in the machine for cutting straw, and generally known as Hovey's straw-cutter." It is not, however, claimed as having been invented with the other. Its originality has never been tried with the other. It is not taken out as a part of the other, nor is the

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oath to its originality extended so as to embrace the other.
4 Wash. C. C. 259.

And though from the evidence, as well as the description, it is, as averred in the bill, very useful and economical in the * manufacture or use of the other, yet [* 296] the patent for it being a separate independent patent, as is the machine, it must be tried on its own merits, and be protected according to the facts connected with its own operations and use. The next inquiry on the merits, then, arises and is whether the evidence shows an infringement on the patent for the grinder by the respondent, standing as it does alone and independent. There is some contradiction on this point. The respondent undoubtedly has used a grinding machine, where the transverse and rotary motions are probably combined as here, and probably the cutters or knives are attached to the stock in a like manner.

I say probably, because the witnesses, who describe his machine as now used, do it in general terms as being like Hovey's in appearance, without going into details on this point, or producing the machine itself or a model of it. Perhaps E. Hovey's affidavit is an exception, and in some respects is particular enough, but not in others. The importance of greater distinctness on this point hereafter will be seen from the circumstance, that, by evidence on the part of the respondent, and, indeed, by admissions by the counsel for the plaintiff, the combination of these two motions is not new. Most of Blanchard's machines for turning unequal surfaces, contain them. If, then, the patent for the grinder claimed, as newly invented, the combination of those two motions and only that, the patent is not new, and the defendant has not violated it by using a combination, which was so long and so commonly employed before.

But if he be considered as claiming also a new mode of attaching the knives or cutters in a stock in order to be ground,

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as we have been inclined to construe it for the purpose of this hearing; and if it be proved, that the defendant uses the same mode of attaching his knives to the stock, which seems probable, though not shown with much certainty, then the only consideration remaining under this head is, [*297] whether that *kind of attachment or fastening is new, so as to be entitled to protection by a patent.

This must be proved by the testimony of more than one witness, as urged by the counsel for the respondent, because the answer is responsive to the bill concerning an infringement, and denies any novelty whatever in the patent, and is sworn to. See *Carpenter v. Prov. Wash. Ins. Co.*, 4 How. 185.

But Leonard Worcester, C. Wheelock, and Albert Curtis testify, that the machines in use several years ago for grinding clothiers' shears and other spiral knives, similar to one produced in Court by the respondent, and proved to be prior in use, by Lyman Wilder's affidavit and letter, did not fasten the knives to a stock separately, but put in the cylinder to which the knives were attached, and fastened that, and ground all the knives together in that cylinder.

It further appears, that Hovey's cylinder, with all the knives attached as in his hay-cutter, can be so inserted and fastened to the stock, but are so close together as not to be then capable of being ground in that way to a chisel edge, which is desirable; and hence each knife must be placed in separately, or a portion of the knives be removed from the cylinder, the others standing further apart, and then in that position they are capable of being ground together. I do not see any evidence on the part of the defendant, which specially rebuts this, or proves either that the defendant's machine does not attach the knives separately to the stock, or if it does, that such a mode of attaching the knives was in use many years previous to Hovey's invention for the grinder. Showing

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either of these would have ended this inquiry. But this not having been done, we must proceed to the next question, which is, whether such a change from the old form is a material one, and though new in form is also new in principle? A novelty in principle may consist in a new and valuable mode of applying an old power; affecting it, not *merely by a new instrument or form of the machine or any mere equivalent, but by something giving a new or greater advantage. Now it is certain that one knife in Hovey's hay-cutter, and in others like his, may need to be ground alone, and though there it could be ground, held in the hand or on the old plan, while fastened in the cylinder, if as far apart from the other knives as the shares are in the old shear cutters for cloth; yet it could not be so ground if set in the cylinder so near others as in Hovey's machine. And for aught which appears, it could not be so ground, if set as near together as in the defendant's machines, they being, I understand, like Hovey's in this respect, and differing only in the manner of securing the knives on the cylinder by rings at the ends rather than by screws. It may seem a small change to attach single knives in a stock to grind them, rather than several of them on a cylinder; but is, perhaps, a material one in all cases, like Hovey's and Stevens's machines, where the knives are fastened so close together on the cylinder as not to be able to be ground to the proper edge together while on the cylinder. It is also in appearance a small change, and, as one witness expresses it, a very *obvious* change to any mechanic, when the occasion or exigency arises for such a convenience, to alter the means of attaching a cylinder with several knives in it to the stock, so as to attach it with a single knife or cutter in it, or with a flange and one knife screwed to the flange. And I should like to hear more evidence from mechanics and experts, whether such a change merely in the fastening is a change of principle, or is

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any thing which is new in principle ; or whether one mode is not a mere equivalent for the other, so as to fix one knife instead of several in one cylinder or flange on a cylinder, whenever it becomes convenient or necessary to grind one knife alone. The testimony of Nourse and Eddy throws considerable doubt over the novelty of this in point of principle, and so do the cases cited in Phil. on Pat. 100, 125. But [* 299] * at present, I feel disposed to regard it as new, though with some hesitancy. The rotary motion possibly may be shown to be imparted differently to the single knife attached to the stock in Hovey's grinder, from what it is when the cylinder is attached as in Stevens's. My own opinion at first was, that the rotary motion in the old machines was obtained by the ends of the axle of the cylinder resting loose enough to revolve easily in holes or boxes or arbours, and the ends in Hovey's being fixed and not revolving, but the piece to which the flange was attached being hollow, and revolving on a solid bar. But I find, on further examination, that both the cylinder to which the old knives were attached and the stock to which the single knife is attached, have their ends resting on screws which enter each end, and revolve probably in the same manner.

And so may Stevens's new machine revolve ; though his old one, which is present, is believed not to. If this be so on seeing Stevens's machine now in use, and having it critically examined, the consequence must be, that the only difference between his and the old machine for grinding, or between Hovey's and the old ones, will be, that in the old ones all the knives revolved as attached to a cylinder, and in the others only one may revolve so attached. For the stock to which the flange for the single knife is attached, may be and is a cylinder, or a cylinder with a flange. If there be any other difference between the grinders, it will consist in the fastening this single knife to the flange with screws in Hovey's

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machine, while in Stevens's it may be so fastened or may be secured at the ends, as in the old machines, by rings or otherwise, and not by screws. More light and certainty on these particulars are desirable, and may, in the end, be very important. For without some difference in producing the rotary motion, a change merely in attaching several knives on a cylinder to attaching but one, or in attaching that one to a flange on the cylinder by screws, instead of attaching it to * the cylinder by rings at the end, hardly seems a [* 300] sufficient change in form, or principle, or results, as to grinding, to justify a patent. In that event, this patent might be invalid without the further objection urged by the defendant, that the grinder has neither new parts, nor a new combination. It would then be, as Nourse and Eddy testify, composed of changes from the old grinding machine, which are probably either formal or mere equivalents, and exhibit no new power or principle. In the case of Hovey's straw-cutting machine, which has been adverted to in argument, the new fastening by screws was such as enabled a party to adjust the knives, if becoming uneven or unequal in width, and when they otherwise would not be adjusted. It was likewise so constructed as to take one out, and grind or repair it alone with ease, when before it could not be. But here no such gain as to adjustment in grinding is obtained by this fastening of one to a flange by a screw, because one left alone in a stock, or at a greater distance from others, could be ground on the old cylinder as well as in the new way. Leaving this point, then, to be settled definitely hereafter on fuller testimony and examination by experts, (and I leave it for this inquiry and for this only, as if favorable to the plaintiff, in order to reach other matters,) I shall proceed to the next question that is controverted. Nothing is said here as to the permanent stock itself being claimed in the patent as a new inven-

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tion by the plaintiff, and hence I shall make no comments on that point.

The next question is, whether the respondent did not himself, before Hovey obtained his patent, discover or construct this new mode of fastening; and if he did, whether it would be reasonable or legal to restrict him in the use of it, because Hovey afterwards procured a patent for it.

As to this, on the whole evidence, it is very clear that Stevens erected his machine for grinding before Hovey obtained his patent. It is also proved that he had projected [* 301] such a * machine or contemplated it, before he saw Hovey's or had Fisher in his employment. It is further manifest, that all the parts of it insisted on, except the mode of attaching the single knives, had been in use and well known to mechanics for many years previously. At the same time, it is very evident that he did not *perfect* his machine as now used in all its parts till he had seen Hovey's, which was made as early as 1843. That a workman with him, by the name of Fisher, had before lived with Hovey, and used the grinder, and had afterwards reëxamined Hovey's. And that the defendant's resembles Hovey's not only in general form and principle, but in some accidental defects. Under these circumstances, it becomes a very important question, whether he did not copy his invention in some respects from Hovey's, and especially as to the mode of attaching single knives, and giving to them a rotary motion. If he did this, without Hovey's consent, and before he made his machine public or sold it, I should think that his use of such a grinder, though begun before Hovey obtained his patent, ought not to be protected. It would be a use by fraud, and could not be contemplated and saved under the Act of 1839, ch. 88, § 7, 5 Stat. at Large, 354. To be sure, that act in broad terms allows any one to use and vend a machine, which he has pur-

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chased or constructed before the inventor applied for a patent. This, however, I think must be construed to mean a purchase of the inventor or his grantee, or a construction by their consent, or by his own ingenuity. Hence, if he himself invented it before, or if he copied it before from other inventors than Hovey; or if Hovey consented to the construction or use of one machine of this kind by Stevens for grinding, of which there is some testimony, then the respondent should not be restrained in the continued use of that one machine, whether we look to the act of Congress itself, or to what is reasonable and equitable, independent of the act. 1 Paine, 348.

But, as before remarked, if he constructed it by a fraud * and piracy on the inventor, I shall hold, for [* 302] the purpose of this examination, that he is not protected. So grave a question as this of fraud, and where the testimony as now, is conflicting, it would hardly be decorous for me to settle in this preliminary inquiry, when the same question is soon to be tried by a jury in the action now pending at law between these same parties, for a violation of this patent.

And the more especially is it inexpedient for me to settle it under such circumstances, when it does not appear that in the mean time any very great additional damage can occur to the plaintiff; or that the defendant may not have sufficient property, though not wealthy, to respond for such further small injury as is likely to occur during the present term, till a trial will probably be had.

In addition to these considerations against deciding the question of fraud now, and, if adjudged for the plaintiff, against now issuing an injunction, there are several others of some moment. One is this:

Does the plaintiff claim this mode of fastening as only a part of a new combination, though old in and of itself, sepa-

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rately as a piece of machinery? Or does he claim to have invented originally that mode of fastening?

The specification is somewhat uncertain on this point, and as it has not been much adverted to in argument, and the construction adopted may have a decisive influence on the result in the trial at law, I do not propose to decide it now. If the specification be so uncertain, in this respect as to be unintelligible, it would be void, and it will have to be surrendered and amended. *Lowell v. Lewis*, 1 Mason, 182. But if it be clear and distinct, as being only a new combination, then there is no claim to invention except in regard to the combination, and no parts of the machine need be proved to be novel. While on the contrary, if it be clear that the mode of fastening is claimed as newly invented by him, then he must prove that as new, and also satisfy the Court [* 303] that he * can unite, in the same patent, claims for a new invention of one part, and for a new combination of that and a rotary with a transverse motion, which is old.

Or that he can claim them as a new combination throughout, when it is new only in part. *Whittemore v. Cutter*, 1 Gall. 429. If he does not so satisfy the Court, he will, in that event, likewise have to take out a new specification for only one of those claims, and a new patent for the other, or disclaim such part as is not new. See *Whittemore v. Cutter*, 1 Gall. 429; *Lowell v. Lewis*, 1 Mason, 182; 3 Wash. C. C. 443; 1 Paine, 441.

Again, in respect to the present application. An injunction, when asked before the trial and resisted, is never to issue as a matter of course till the trial. There must, in such case, in order to obtain it in advance, be proof not only of a patent, but also of some length of use under it, or some considerable sales of it, or some recovery, establishing the validity of the patent, so as to impart to it weight or strength as valid

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beyond the mere issue of it. Here are neither. The patent issued only in September, 1845, and the offence is averred to have happened in the next month, and the proof is, that the patent was not taken out at all till the plaintiff saw the defendant use the machine, and then took out the patent in order to prosecute him. There have been no sales of it proved.

There has, likewise, been no recovery or settlement shown by anybody, tending to establish the validity of the patent for the grinder, but only of the hay-cutter, a separate and independent machine, as before explained; and the invention and validity of which are questions distinct from those in the grinder, and in discussing which in trials heretofore, it is not pretended that the invention or validity of the grinder have been canvassed at all, or in any way passed upon, either by Courts or juries. These last circumstances are of course no bar to the recovery in the action at law, for an infringement * of a patent, but they disable a party [* 304] from obtaining an injunction in advance.

If an injunction should issue in advance of the trial in a case like this, without any of the above circumstances to justify the right claimed by the patent, it should issue in all cases on the patent alone, though resisted and impugned by the opposite party. But such never has been the law, and if the practice was adopted, it would produce often heavy losses and irreparable mischief among conflicting claimants. While the present course gives ample redress in damages, if the plaintiff succeed for an infringement, and moreover, in case of long use, numerous sales, or previous recoveries, adding strength and greater probability of validity to his patent beyond merely getting it out, will assist him by a preliminary injunction. In *Orr v. Littlefield*, Nov. Term. N. Hamp. Dist. Cir. Ct. *ante*, p. 13, where most of the precedents are collected, not a case is given where an injunction, when resisted,

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was granted, unless a possession and use of the patent had existed for some time. The shortest was three years, and, in most of the cases there collected, the time had been several years longer. Here the time had not been one month before the alleged infringement, and only about half a year before this suit was instituted, being, in the words of the decision in 3 Merivale, 624, a patent of but "yesterday," when the alleged violation occurred. In most of these cases, also, there had been numerous sales of the patent, and recoveries for violations. Here there have been none of either.

Again, in many cases there referred to, it is shown that when possession for some years has existed, or numerous sales, or recoveries, the Court will not refuse an injunction, or dissolve it on a denial of the validity of the patent by a respondent, either through affidavits, or an answer, or other pleadings. Yet, on the other hand, as there shown, if none of those fortifying circumstances exist, Courts will not only refuse an injunction, if one has not before been granted, [* 305] but * also dissolve it if it has been previously allowed, provided the validity of the patent is denied or brought into doubt. Here there is an entire absence of all those fortifying circumstances, and there are also pleadings in this denying the validity of the patent, as well as in the case at law in relation to this same subject. Besides these considerations, some doubts are cast on the originality and validity of the patent for the grinder by the evidence of Nourse, Eddy, and others; and an issue on that is framed, and is to be tried in the action at law, and, without deciding on that question now, except *pro forma*, as before remarked, in order to reach the other points, it is doubtful enough to prevent the allowance of an injunction, where none of the counterbalancing and fortifying circumstances exist that have just been referred to. 4 Wash. C. C. 514.

The injunction, then, cannot be granted, as the case now

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stands; but I shall not dismiss the bill, till it can be seen during the term, whether any new facts shall be developed by the trial or otherwise, that may require a different disposition to be made of it, in order to enforce substantial justice between these parties.

Injunction refused.

WILLIAM W. WOODWORTH AND OTHERS IN EQUITY V. ISAAC
HALL AND ANOTHER.

[1 Woodbury & Minot, 248. May T. 1846.]

An injunction will not be issued against a respondent's using a machine, unless it is proved, that he has used it himself, or employed others to use it for him, or at least has profited by the use of it.

Where long possession of a patent has existed, and frequent recoveries under it, an injunction will be issued, the originality of the invention by the patentee not being denied, unless the letters appear for some cause illegal or void.

Where Congress granted an extension of the term to an administrator, it was held to be legal, and that the letters of administration need not be produced after such a grant.

A signature to the patent, and the certificate of copies, by a person calling himself "acting commissioner," is sufficient on its face in controversies between the patentee and the third persons, as the law recognizes an acting commissioner to be lawful.

A patent surrendered and renewed operates as from the commencement of the original patent, except as to causes of action arising before the renewal.

If a mistake occurs in a copy of a patent, it can be corrected without causing any injury, but if it exist in the original patent, it cannot [* 249] be corrected, so as to avail without the assent or resigature of the Secretary of State.¹

But the commissioner, if correcting it, need not re-sign or re-seal the letters, he being the same officer here who did it before.

¹ See this case again reported, *post*.

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If the mistake corrected be a material one, the letters cannot operate except on cases arising after it is made. But if a mere clerical one — *quere*.

Where a renewal of patents surrendered is void, perhaps the surrender itself becomes also void, and the original patents remain in force.

Mere technical objections to letters-patent are not to be encouraged, or construed liberally, for him making them.

THIS was a bill in chancery, filed July 28th, 1845, praying for an injunction against the defendants, not to use longer the planing machine invented and patented by William Woodworth; and for an account of profits from the use heretofore.

The letters-patent were alleged to have been issued to him as the inventor of that machine, December 27th, 1828, for the term of fourteen years. It was further alleged, that he died on the 9th of February, 1839, and that on the 14th of the same month, administration on his estate was granted to William W. Woodworth aforesaid. That the administrator applied to the commissioner of patents for an extension of the term of the original patent for the machine, and that it was duly granted to him, after proper proceedings, on the 16th of November, 1842, for seven years after the end of the first term of fourteen years. That about the 2d of January, 1843, he disclaimed the circular saws described in the schedule to said patent; and, on or about the 10th of the same month, he conveyed to Washburn and Brown, two of the complainants, the exclusive use of said machine in the county of Suffolk and some other enumerated places, with certain reservations to himself; and on the 11th of January, 1844, assigned to Wilson, the other plaintiff, all his remaining interest in the patent, except in the State of Vermont.

[* 250] * It is then stated, that the respondents are now using a machine like his substantially, and are thus infringing on the patent owned by the complainants; and the bill prayed a discovery how long it had been done, and an answer to several interrogatories.

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In aid of the prayer for an injunction, and for the account before named, the bill further averred, that said Washburn and Brown prosecuted, and in May, 1844, recovered judgment in the county of Suffolk for a violation of this patent, and soon after they instituted a similar suit against the respondent Isaac Hall, who settled the same without trial, and paid damages, and received from them a license to use one of their machines for a specified term and for a certain rent, which he had neglected to pay.

It was further averred, in a subsequent amendment to the bill, that William W. Woodworth, as administrator, finding the specification in the patent open to certain objections and doubts as to its sufficiency, did, on the 8th of July, 1845, surrender the patent, and procure new letters with an amended specification; and that the said Washburn and Brown approved the surrender, and agreed to accept the same rights under the new patent as had been conveyed to them under the extension of the original one.

An answer was filed by Clement Hall on the 18th of September, 1845, which disclaimed any knowledge of most of the averments in the bill, and of the matters about which he was interrogated specifically; though a belief in the truth of most of them is expressed, except that he denied Woodworth to have been the original inventor of this planing machine, or that it is in other respects valid; and the answer further asserted that the new patent was for a different machine from the old one; and that the old one was not surrendered within the fourteen years of its term; and that Woodworth, before he died, had assigned to others all his interest in it; and that Washburn and Brown possessed no interest in the new * patent, and wished an issue framed by the [* 251] Court to try these matters before a jury. In the course of the answer he admitted the use by himself alone,

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and not jointly with others, of a machine for planing, similar in some respects to Woodworth's but unlike in others.

The answer of Isaac Hall was in most respects similar, except that he denied any violation of his former agreement with Washburn and Brown, or any use of the planing machine, either severally or jointly with others, since the expiration of a certain license to him to use it.

Some papers and affidavits were then submitted to the Court by the counsel, and an agreement made to have a hearing on the prayer for an injunction before an issue was completed and tried on the originality of the patent, and in this hearing to waive any objections to the originality of the patent in Woodworth.

The substance of the papers and testimony, with the points raised against the injunction, will appear at sufficient length in the opinion of the Court.

B. R. Curtis, counsel for the complainants; *Giles* and *Dehon*, for the respondents.

WOODBURY, J. There has been no evidence whatever offered in this case of any using of the planing machine by Isaac Hall since his license expired, except what is contained in the affidavit of Aaron Pratt. This witness did not see him use it; but made a bargain with him about the 15th of July, 1845, to plane for the witness certain boards at the ordinary price, intending to set off the amount against rent due from said Isaac.

Clement Hall, however, was present, and said, "we can plane them for you," and the work was done, but the witness does not say by whom, nor whether in fact the compensation for it was made to Isaac.

Against this is the answer of Isaac, responsive to [* 252] the bill, *and sworn to, denying that he had ever

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used the machine since his license expired ; and this agrees with Clement's assertion in his answer, that the machine was used by him alone. The facts testified to by Pratt might, standing alone, be sufficient to justify an inference that Isaac had planed the boards and used the machine.

In such cases, it may be, that any workman on the machine, though not interested in it, is liable to be restrained in order to prevent evasions, by treating all as principals who are aiding.

It is a common case, also, that if one does not in person perform the work, but procures another to do it for his advantage on a machine owned by himself, he can still be restrained, and is estopped from denying, *qui facit per alium, facit per se*. Possibly, too, if one hires another to do work on such a machine, he may be restrained. 4 Mann. & Grang. 179. But it is not necessary to give a decisive opinion on this, after comparing the evidence with the denial in Isaac's sworn answer.

After that answer thus testified to as true, the probability is, and it is a construction not inconsistent with the veracity of both Pratt and Isaac, that the boards were planed by Clement, alone, and on his own contract, or his own assent to the arrangement, and for his own profit. It would seem, also, very easy to produce further evidence of the fact of Isaac's using the machine, or receiving the profits from it, if such was the truth. Until it is produced, the fairest construction of the affidavits and answer are, that Isaac did not work the machine or profit by it. If this construction were not the most reasonable, and did not reconcile what is sworn to in the affidavit and answers, the Court would still be compelled to refuse to issue an injunction against Isaac, on the affidavit of Pratt alone, for the want of evidence in it to overcome Isaac's answer. Because something more must be pro-

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duced than the evidence of a single witness to over-
[* 253] come * an answer under oath, and responsive to
the bill. *Carpenter v. Prov. Wash. Ins. Co.* 4 How.
185. Certainly something more than the evidence of one
witness, and he not testifying explicitly that Isaac either
owned or worked the machine, or received any of its profits.

But in respect to the liability of Clement to an injunction,
the testimony is very different; and notwithstanding the
several ingenious objections that have been urged, I have
come to the conclusion that one ought to be issued against
him.

He admits that he uses a machine for planing, which is, in
some important respects, similar to that described in Wood-
worth's patent.

He waives, also, any opposition in this hearing to its having
been originally invented by Woodworth.

It is shown, moreover, that this patent has been possessed
by Woodworth and others under him for something like eigh-
teen years.

It is well known, too, that, during this period, numerous
recoveries have been had against persons for infringements
upon it in several States in the Union; and that the sales
of it by Woodworth and his assignees have been very exten-
sive.

Furthermore, two of the plaintiffs, Washburn and Brown,
are admitted to have obtained verdicts in its favor against
persons in this city; and a settlement and recognition of their
title by the other defendant, Isaac Hall, brother of Clement,
is a conceded fact in this case.

The various questions of law which have been started in
this litigation, whether technical or on the merits, have mostly
been carried up to the Supreme Court of the United States;
and after full argument and patient scrutiny have, in almost

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every instance, been decided in favor of the patentee and those claiming under him.

But still, if objections are now taken in favor of Clement * Hall, new or otherwise, which ought on [* 254] sound principles to prevail, the injunction should not issue against him.

Hence it becomes necessary to examine all the objections which have been urged on the present occasion ; but I shall not decide in any occurring to me but not urged, presuming that they are waived till the future trial on the merits.

The first objection taken is to the new letters-patent, because they are issued to the administrator of the original patentee.

But that objection was overruled in the case on this patent from New York, in *Wilson v. Rousseau*, 4 How. 646. The renewal in the name of the administrator by the board of commissioners, for seven years, was considered good, on the ground that an invention was personal property. An invention possesses value beyond the first patent on it ; being valuable for purposes abroad as the ground for a patent there, and also for a renewal at home, independent of any unexpired period of the original term, which might go as assets to an administrator. And Congress has confirmed this view of the right by extending the patent, through a special law to the administrator, even seven years longer, after the time given by the board expires.

The next objection is, that no letters of administration are now produced. But in the *Kentucky case*, (*Woodworth v. Wilson*, 4 How. 712,) this objection, among others, was urged, and the Court did not sustain it, because the patent, being renewed to the plaintiff as administrator, was proof that he had satisfied the board at the Patent Office of the fact of his being administrator, and it was not now competent to go behind their decision in respect to it.

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The third objection taken here is, that the patent is not certified by Mr. Burke, who was the commissioner at that time, but by H. H. Sylvester, as acting commissioner. This point was also made in the New York case, 4 How. 646.

But on my suggestion to the counsel that there [* 255] were two * early acts of Congress, which authorized the President to appoint acting heads to the different departments and bureaus, though the offices were not vacant *de jure*, but the incumbents were absent from the seat of government or indisposed ; and that the law conferred on those so acting all the powers which belonged to the officers they represented ; and that this might, on the face of it, be legal, on the presumption it was such an appointment, unless the contrary was shown, the point was no further argued ; and the Court, in their opinion, held the patent to be good, which could not have been if this objection was deemed valid, under such a state of the facts.

The laws mentioned may be seen in the 8th section of the Act of Congress of May 8th, 1792, ch. 37, (1 Stat. at Large, 281,) and the Act of 13th February, 1795, ch. 21, (1 Ibid. 415.)

If the provision in the Patent Act of 1836, that the chief clerk may perform certain duties when the office of commissioner is vacant, alone governed the present question, as was formerly supposed, then the ingenious argument of the respondents' counsel might apply. But it is an appointment of acting commissioner which may have been under the other general laws in the absence or illness, and not a technical vacancy of the head of the bureau, and whose powers, when so acting, are as full as those of the commissioner himself, and his appointment under that law by the President alone being authorized expressly by Congress, it must be presumed to have been made here, in the absence of any evidence to the contrary, and to have been duly made where drawn in question

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incidentally or collaterally, if it be shown that the person certifying is in the public discharge of those duties.

In such cases, as acting appointments may be legal, he will be presumed to be acting legally till the contrary is shown. *Potter v. Luther*, 3 Johns. R. 431; *Berryman v. Wise*, 4 D. & E. 366; 3 *Ibid.* 635. Even in cases of murder.

* *Dalmer v. Barnard*, 7 *Ibid.* 248, 251; *McNally* [*256] on *Ev.* 487, 488.

In such case, too, as the laws recognize acting officers at the heads of bureaus, whose appointment is not in the hands of the secretaries alone, like the Patent Office since 1836, the signatures of persons as acting commissioners carry as much verity and legality on the face of certificates themselves, as those by the commissioner himself.

They meet, then, the requisitions of the past as well as the following cases, (3 *Wash. C. C.* 531, 1 *Burr's Trial*, 98,) until it be shown if it can be properly, in contests between third persons, that the acting appointment was not in truth made in the manner authorized by law.

There are some other objections, however, taken here, which were not decided in the 4th *Howard*, 647 to 716, and which it is proper to examine.

One of them is this. The original patent for fourteen years, given in December, 1828, expired in 1842, and though it was extended by the board for seven years more, which would last till 1849, and by Congress for seven more, which would not expire till 1856, yet all of these patents were surrendered July 8th 1845, and a new one taken out for the whole twenty-eight years from December, 1828. This was done, also, with some small amendments or corrections, in the old specification of 1828. After these new letters-patent for the whole term, no assignment having been made to Washburn and Brown, but only one previously on the 2d of January, 1843, the plaintiffs contend that all the previous

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letters being surrendered, and a new specification filed, and new letters issued, any conveyance of any interest under the old letters is inoperative and void under the new ones ; and hence that Washburn and Brown possess no interest in these last, and are improperly joined in the bill.

But my impression, as at present advised, is, that when a patent has been surrendered, and new letters are [* 257] taken out * with an amended specification, the patent has been always considered to operate, except as to suits for violations committed before the amendment, from the commencement of the original term. The amendment is not because the former patent or specification was utterly void, as seems to be the argument, but were defective or doubtful in some particular, which it was expedient to make more clear.

But it is still a patent for the same invention. It can by law include no new one, and it covers only the same term of time which the former patent and its extensions did.

In the present case, these are conceded to have been the facts ; and it is an error to suppose that on such facts the new letters ought to operate only from their date. By the very words of those letters, no less than by the reasons of the case, as just explained, they relate back to the commencement of the original term, and for many purposes should operate from that time. I do not say for all, as an exception will hereafter be noticed.

This is in strict analogy to amended writs and amended judgments, which, for most purposes, have the same effect as if the amended matter was in them originally.

Again, if such were not the result, generally, the new letters would be treated as taking out a new patent, or an old one in a form then first valid ; and, in such a view, would, of course run fourteen years from the date of the new letters, instead of only fourteen from the issue of the original letters ;

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or if they have been extended as here, fourteen longer, they would not run only twenty-eight years from the beginning of the original term, *i. e.* December, 1828, as here, but twenty-eight years from July, 1845, the date of the new letters.

Besides these considerations, it has been held, that recoveries under the original patent are evidence after the new letters and new specification, to strengthen the title of the plaintiff so as to obtain an injunction; thus treating the patent as one and the same, and a conveyance of it once therefore for a * specified term, as good for the term, [* 258] whether an amended specification be filed or not before the term closes. See *Orr v. Littlefield*, *ante*, p. 13. Also, *Orr v. Badger*, before Justice Sprague, February, 1845.

It would be a little strange, that a recovery under the new and amended and corrected specification should be, as is another argument for the defendant, any stronger evidence of right than a recovery, even when the specification was more objectionable.

Independent of these circumstances, it is averred in the bill as amended, that Washburn and Brown have adopted and approved of the new specification; and that they claim under their contract, and to the extent of it, all the rights conferred by it on the patentee.

There is, moreover, a clause in the Act of July 4th, 1836, ch. 357, § 13, which seems to have been designed to dispose of such objections; and though it does not mention contracts or assignments, it is quite broad and comprehensive enough to cover them. It is: "The patent, so reissued together with the corrected descriptions and specifications, shall have the same *effect and operation in law* on the trial of all actions hereafter commenced for causes subsequently occurring, as though the same had been originally filed in such corrected form before the issuing of the original patent.

It would be very doubtful, also, whether a misjoinder of

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parties as plaintiffs in an application of this kind, could defeat a prayer for an injunction not to use a machine in which any of them were interested. At law, such a misjoinder could be objected to only in abatement, as the act sounds *ex delicto*, (1 Chit. Pl. 75); and probably it could not be objected to at all in equity, though in the final judgment, of course it would be entered up in favor of those alone who appeared to have some right and interest to be protected.

As the claims of the two plaintiffs, however, have [*259] been *already proved and established in several recoveries before the new letters; and the contract now offered, under which they claim, confers on them a right to use fifty planing machines within certain territory, including this city; and there is a covenant by the grantees of that right not to sell to different persons liberty to use others within those limits, during the time of Washburn and Brown's contract, their interest within them would seem to be sufficiently exclusive to make them properly plaintiffs, and entitled to judgment.

The strongest doubt with me is in relation to the interests of the others in this city, so as to justify joining them; but as that objection has not been taken, and all the facts are not known to me concerning them, I pass it by for the present.

But there is one more exception in this case; and it is of a character causing some difficulty, if the evidence in respect to it was more clear, and accorded with what is supposed by the counsel for the respondent to have been the truth of the transaction.

The original patent is not put in evidence here, but a certified copy from the Patent Office. That copy now reads, that the term is one of twenty-eight years from December, 1828, but when produced at a former opening of the cause, it is admitted that it read fourteen years from December, 1828.

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A letter from the commissioner is offered by the respondents stating, as I understand it, that the change has since been made in order to correspond with the truth, the new letters-patent being for twenty-eight years from 1828, and the record being so, but the forms for copies having been printed fourteen, some were filled up without altering the printed term from fourteen to twenty-eight.

The respondents infer from this explanation, that the letters-patent themselves, as issued in July, 1845, and not *merely the copy of them, contained the same [* 260] mistake, and that the record of them did also; and supposing that both had been altered since, as well as the copy, the respondents object to the legality of such amendments, and likewise contend, that if legal at all, it is so only in respect to suits and other matters arising subsequently to the alteration. But I do not understand the letter of the commissioner to go beyond the copies; and if only the copies were erroneous, and they have been corrected, he undoubtedly had the power, and ought to make them conform to the patent itself and the record.

On the contrary, if the new letters-patent themselves were by mistake for only fourteen years from December, 1828, when they were intended to be twenty-eight, and thus to cover not only the original term, but both the renewed terms; and the commissioner has amended them since this bill was filed; I doubt whether, on the testimony now before us, they could be received in evidence to sustain this bill, considering its allegations to go on a patent for twenty-eight years, and one so issued on the 8th of July, 1845.

It would probably be his duty to correct the letters-patent in such a case, when applied to, and to minute the correction on or in them; as these matters are between him representing the government and the patentee.

Nor would it be necessary for him in such case to re-sign

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or re-seal the letters, as is urged on English precedents. See Sharp's case, and Nicholls', in Webster's Patent Cases, 645 and 658. For those do not apply here when the signing and sealing are by the same officer, and by the same also as he that makes the correction. For he adopts them as his own acts by redelivering the patent after it is amended, as much as he adopts the writing of it on the paper or parchment.

But it would seem necessary to have the Secretary of State sign anew, or assent to the amendment, as he [* 261] is a * distinct officer, and without signing anew, or assenting, has never examined and authenticated the letters as amended.

The record or enrolment must also be made to correspond with the letters as amended, if it does not already. As to the effect of such alteration, I entertain an impression, resting on general principles and the grounds of some of the precedents abroad, and in the absence of any statute here, to allow amendments of this kind, or to prescribe their effect in such cases; that a patent after thus amended in a material mistake, could not operate as to third persons against whom prosecutions were pending, but only for causes accruing after the correction. See Webster on Pat. 664. It may be different if the mistake was entirely clerical. If the mistake was not clerical, or one made by the patentee himself, it is quite clear that the law abroad makes it operate only from that correction, and it is so here in respect to defective specifications, when they are allowed by statute to be amended in certain cases. See 13th section of Act of July 4th, 1836, ch. 357. They are not good as to suits pending, but only as to actions for causes subsequently accruing.

But in cases like this: if it should turn out, on clear evidence, that the new letters themselves had been altered so as to be wholly void, a different and equally difficult question may arise. It is this: it might be that the surrender of the

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original letters, and of the extensions of them, so that all might be renewed in one, would become also void; and the party might then, perhaps, be allowed to amend his bill, and enjoin and recover on the former letters-patent, if the old specification was not too defective for that purpose.

On this I give no opinion at this time; but if evidence be obtained, that the new letters-patent themselves have been altered as to the term in them since this action was commenced, as the respondents' counsel apprehend, it may then become necessary to decide it.

The mode adopted in this case, of issuing one set of new * letters-patent for the three different terms [* 262] before existing, when the old specification was sought to be corrected, is likewise open to some question concerning its legality. The most obvious mode would be to renew each separately, or renew only the old letters and their specification; and let the others be cured or aided by relation back to the original one.

But as no such objection is pressed now, I forbear comment upon that also.

It may not be improper to add before closing, in relation to technical objections, as most of them are when urged against injunctions generally, that though they are to be weighed and examined, and allowed to prevail, as they must in other cases in equity, if legal, yet they ought to be treated with no particular indulgence. In all inquiries in equity, the leaning in *doubtful* points must certainly be rather against than in favor of them; and more especially must it be so in *preliminary* injunctions, where the decision is only temporary, and may be dissolved on motion at any time, on showing fuller proof as to any thing affecting the merits of the controversy.

The injunction as to Clement Hall is allowed till the further order of the Court, but not against Isaac Hall.

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BUCK ET AL. v. GILL ET AL.

[4 McLean, 174. July T. 1846.]

The claim of Buck, in his cooking stove, as his own invention is, "the flues described in combination with the extended oven."

And as the defendants appeared to have infringed the right of Buck, thus stated, a preliminary injunction was granted.

Fox, for complainants.

Ewing and *Swayne*, for defendants.

OPINION OF THE COURT.

THIS bill is filed by the complainants, representing that they are interested in the making and selling of Buck's cooking stove, for which Darius Buck obtained a patent from the United States, on the 20th of May, 1839. That he was the original inventor of the improvement specified in his patent; and that the defendants have long been in the practice of making and vending cooking stoves, substantially on the same plan and principle as Buck's stove, which operates to their injury, in preventing the sale of their stove, and the complainants pray that an injunction may be allowed to prevent the further infringement of their right, by the defendants, and that other and further relief may be given, etc.

The defendants in their answer deny the infringement, and call upon the plaintiffs to prove their right under the patent, the validity of which is questioned, etc.

[* 175] * In his schedule, which constitutes a part of his patent, Buck says, "whereas difficulties occur in the cook stoves now in use in carrying on at the same time baking and boiling, and also in having an oven of such uniform temperature that every part will cook or bake uniform, and also

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in having an oven of sufficient size as to do away with the occasional use of the brick oven, in large families, without any increase of fuel, and also in having an oven around which there is a certain free and uniform draft. And whereas, my invention has respect to the aforesaid difficulties, now, therefore, be it known, that I, etc., have invented certain improvements in the construction of stoves used for cooking, and I do hereby declare that the following is a full and exact description thereof, reference being had to the drawings which accompany this specification, and are a part of the same," etc. In describing the structure of the stove, among other things he says, "No. 2, the oven, is thus made to extend from the back part of the stove to the front part of the stove, under the open hearth, so that the back plate of the stove is a flue plate under the open hearth of the stove. The plates that form the outside of the flue around the oven under the hearth, are so constructed that any horizontal division of the flues and oven under the hearth is similar to the hearth; or the last mentioned outside flue plate may be made straight or flaring, but they are better to curve according to the shape of the hearth-plate, for, by preserving this form, the flue will be enlarged, and the heat of the hearth, the top of the oven, the temperature of the oven and the draft, all will be increased."

In summing up, he says, "I do not claim as my invention the placing of the oven in cooking stoves, under the fireplace of the stove, as that has been long known and in use, nor do I claim the invention of reverberating flues for conducting the heat, etc., under the oven, as they also have been for a long time known. What I do claim as my invention, and for which I desire to secure letters-patent, is, the extension of * the oven under the apron or open [* 176] hearth of the stove, and the combination thereof with the flues, constructed as above specified, by which means I am enabled to obtain greater room for baking and

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other cooking purposes, and effect a greater saving of expense and fuel than in cooking stoves of the ordinary construction."

Now, what does Buck claim as his invention? He says he "does not claim as his invention the placing of the oven in cooking stoves under the fireplace of the stove, as that has been long known and in use." But he says, "what I do claim as my invention, is, the extension of the oven under the open hearth of the stove, and the combination thereof with the flues, constructed as above specified." In fewer words, "he claims the flues described, in combination with the extended oven."

Was this improvement known before? Hathaway's stove was in use before Buck claims to have invented his improvement. But there is this difference between them: The Buck stove has the oven extended, and the front flue or air chamber connected therewith, which gives a uniform heat in the front of the stove, as well as in the rear of it. Hathaway's stove has not this connection. And in this consists the improvement claimed by Buck.

Arthur Platt, Adam Powers, and Leonard Duval say there is nothing new in an air chamber, to equalize the heat of the oven. This is no doubt correct; but they do not say there is nothing new in connecting the flues with the extended oven, as claimed by Buck.

The Harris stove, sold in 1836, had the oven extended under the hearth, and only differed from the Buck stove in the connection claimed by Buck. The Lawrence stove, which was constructed and extensively sold in Tennessee, in 1837, with flues similar to Buck's, but there seems to have been no air chamber in front.

Upon the whole, from the evidence before us, the [* 177] stoves * made by the defendant, or at least some of them, appear to infringe the right of the complain-

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ant, and a preliminary injunction is granted, enjoining the defendants from making or vending any cooking stoves made with a combination of flues down the back and under the oven, and connecting at the bottom thereof with a flue or air chamber in front of the stove; and the said defendants are enjoined from making or vending stoves in which said flues and air chambers are so connected at the bottom of said air chamber or flue in front.

DAVID ROOT v. BALL & DAVIS.

[4 McLean, 177. July T. 1846.]

To an action for an infringement of a patent-right, a plea that the thing claimed to have been invented was in use and for sale before the application for the patent, is demurrable, unless the plea aver an abandonment, or that such sale or use was more than two years before the application.

Where the use or sale has not exceeded two years before the application, the Act of the 3d of March, 1839, declares it shall not invalidate the patent.

The same patent cannot include inventions for two distinct machines.

But a claim for a combination of mechanical powers, and the invention or improvement of one or more parts of which the combination consists, may be in one patent.

There must be special pleas or the general issue, and notice of special matters.

Fox for the plaintiff.

Hart for defendants.

OPINION OF THE COURT.

THIS is an action for an infringement of a patent. The plaintiff declares against the defendants for violating a patent-right granted for a design of ornamental parts of a stove, dated 9th of September, 1845, with the ordinary breaches.

The defendants pleaded :

1. The general issue.

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2. Because before the date of the patent on the [* 178] 6th of * January, 1844, "stoves constructed upon the plan of the stove patented by plaintiff, with the same general design and combination of the ornamental parts, were publicly made and sold by the defendants at the district, etc.

3. Because before the date of the application for the said letters-patent on the 1st November, 1844, and thence on till the date of said application, stoves constructed on the plan of the stoves patented by the plaintiff, with the same general design and combination of the ornamental parts, were publicly for sale by the plaintiff himself, at the district, etc.

4. Because before the date of issuing the patent on the 1st of January, 1845, and thence on to the date of the same, stoves constructed upon the plan of the stove patented by the plaintiff, with the same general plan and combination of the ornamental parts, were publicly for sale by the plaintiff himself, at Cincinnati, etc.

5. Because at the date of application for said letters on Nov. 1st, 1844, and thence till the date of said application, stoves constructed upon the plan of the stove patented by the plaintiff, with the same general design and combination of the ornamental parts, were in public use, and for sale in the city, etc., by the consent and allowance of the plaintiff himself.

6. Because before the date of issuing said letters-patent of the plaintiff, on the 1st January, 1845, and thence continually till the date of the patent, stoves constructed upon the same plan with the stove patented by the plaintiff, with the same general design and combination of the ornamental parts, were in public use and for sale at the city, etc., by consent and allowance of the plaintiff himself.

To the 2d, 4th, and 6th pleas, the plaintiff demurred, and joined issue on the 3d and 5th.

The pleas demurred to allege, that before the issuing of the

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patent, stoves of a similar design and combination were in use and for sale. And this, it is contended, is no answer to the plaintiff's action. By the 7th section of the Act of 3d of * March, 1839, it is declared that "no [* 179] patent shall be held invalid by reason of any such purchase, sale, or use prior to the application for a patent, except on proof of abandonment of such invention to the public, or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent."

None of the pleas state that the use spoken of was more than two years prior to the application for the patent, and this is indispensable to render the patent invalid. Independently of this statute, the plea would have been bad, as the application for a patent must protect the right of the inventor, and the delay which may occur, in the Patent Office, in making out the patent, cannot operate to the injury of the applicant. On both grounds, therefore, it is clear that the pleas demurred to constitute no bar to the plaintiff's action, as they do not show that the patent is invalid, by abandonment or otherwise. When an abandonment is relied on, it should be stated in the plea, and the facts on which the pleader relies, as showing an abandonment. The present is different from the former law. *Shaw v. Cooper*, 7 Pet. R. 292.

The jury were sworn to try the issues joined, and witnesses were examined.

George H. Knight, in September, 1844, was employed by plaintiff to make out the specifications, which are stated in the patent.

Elias J. Peck is a pattern maker, and he says that Root's stove was sold in the fall of 1844. And from other witnesses it appeared that Root's stove was put up early in the year 1845. Several designs were shown to ornament cooking stoves similar to the plaintiff's, but the figures differ.

It is admitted that the application and specifications on

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which the plaintiff's patent issued, were filed the 15th of December, 1844.

It is objected to the plaintiff's patent that two distinct things cannot be united in the same patent. This [* 180] is true, *when the inventions relate to two distinct machines. And the reason assigned is, that it would deprive the officers of the government of their fees, and in other respects would be inconvenient. But the same patent may include a patent for a combination, and an invention of some of the parts of which the combination consists. A patent for a combination is not infringed by the use of any part less than the whole, of the combination. *Moody v. Fiske*, 2 Mason, 112.

It was objected by the defendant, that as a penalty is imposed on a patentee for selling an article unstamped, and as stoves were sold by the plaintiff made before the patent, and which were not stamped, the plaintiff could not recover. But the Court overruled the motion, saying that the matter stated could have no influence in this case.

The Court instructed the jury that, as there was no notice or plea, which authorized the defendant to show a want of novelty in the invention claimed by the plaintiff, they would disregard the evidence which had been given on that head. There is no notice appended to the plea of the general issue to that effect, nor do the special pleas make a want of novelty a ground of defence. They would seem to rely on the effect of an abandonment. Or at least, that the right of the plaintiff did not originate with the discovery, or the application for a patent, but with the emanation of his patent.

And the jury were instructed, if they should find that the defendants had infringed the plaintiff's patent by using, substantially the same device, as ornamental on the same parts of the stove, they would of course find the defendant guilty, and assess such damages, as, in their judgment, the plaintiff

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was entitled to. To infringe a patent-right, it is not necessary that the thing patented should be adopted in every particular; but if, as in the present case, the design and figures were substantially adopted by the defendants, they have infringed the plaintiff's right. If they adopt the same principle, the defendants are guilty. The principle of a machine is * that combination of mechanical powers [* 181] which produce a certain result. And in a case like

he present, where ornaments are used for a stove, it is an infringement to adopt the design so as to produce, substantially, the same appearance.

The jury found for the plaintiffs, and assessed their damages at twenty-five dollars — judgment.

WM. W. WOODWORTH, IN EQUITY v. ISAAC HALL AND ANOTHER; AND WOODWORTH v. STONE.

[1 Woodbury and Minot, 389. October T. 1846.]

Where evidence is offered to prove, that the "acting commissioner," who signs a patent, was not appointed by the President, it is questionable whether it be competent to admit it in controversies where he is not a party.

Under the Patent Law of 1836, the chief clerk is held to be the "acting commissioner," as well in the necessary absence of the head of the office, as in case of a vacancy *de jure*.

The sanction of the Secretary of State, to a correction of a clerical mistake in letters-patent, may be given in writing afterwards; and he need not re-sign the letters themselves.

If the correction be of only a clerical mistake, it operates back to the original date of them, unless perhaps as to third persons, who have acquired intervening rights to be affected by the alteration.

If a new patent, issued on a surrender of old ones, be void for any cause connected with the acts of public officers, it is questionable whether the original patents must not be considered in force till their terms expire.

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An injunction once granted will not be dissolved on account of any doubts, as to the validity of a new patent in such cases, caused by the errors of such officers, if measures are pending in Congress to remove them by legislation.

[*390] * IN these cases, injunctions were granted at May term, 1845, and at May term, 1846 ; a motion was made, in the first-named case, to dissolve the injunction. An opinion was given at the same term, stating the facts, and retaining the injunction as to one of the defendants, but dissolving it as to the other, for reasons applicable to the merits. *Ante*, p. 248.

Among the objections which were then urged against the validity of the patent, on which the claim of the plaintiff was founded, were these : Because it was signed by H. Sylvester, as acting commissioner, rather than by Edmund Burke, Esq., the commissioner ; and because the patent had been altered at the Patent Office since it originally issued.

For further particulars in relation to these objections, and the detailed facts on which they rested, reference can be had to the opinion and case, as drawn up.

At an adjourned session of the same term, held at Boston, in September, 1846, the motion to dissolve the injunction was renewed as to the first case, and the like motion made as to the second case, both of which are now to be disposed of. They were founded on the same grounds, accompanied by new evidence, offered under the first objection, to show that Mr. Sylvester, at the time of signing this patent, was not acting under any appointment made by the President, by virtue of the 8th section of the act of Congress, passed May 8th, 1792, ch. 37 ; but, being then chief clerk in the Patent Office, claimed to be authorized to sign it in the necessary absence of the commissioner, under the power conferred by the 2d section of the Act of 8th of July, 1836, ch. 357, (5 Stat. at Large, 117,) reorganizing the Patent Office.

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In respect to the second objection — the alteration of the patent — it was further proved that a mistake, as to the time it was intended to run when renewed, occurred in the patent itself, as well as the record and copy of it; the proof, at the * first hearing, extending only to the [* 391] copy. Thus, it was issued for fourteen years, but was meant to be for twenty-eight, and was afterwards altered to twenty-eight. In answer to this, it was now shown that the Secretary of State subsequently expressed in writing his assent and sanction to the correction of the mistake, though he was not consulted at the time it took place.

The present motion was argued by *Giles*, in support of it; and by *B. R. Curtis*, against it.

WOODBURY, J. It is not necessary to go into many of the facts and principles considered in the former motion in this subject, and then disposed of; but the new and material facts since obtained are to be examined, so far as they may weigh upon the objections, and affect the principles before settled.

The first inquiry now is, whether the chief clerk in the Patent Office, not having been in fact specially appointed to be acting commissioner by the President, in the absence of the commissioner himself, could legally sign this patent, under the general provision in the 2d section of the Patent Law of 1836, ch. 357. The words of that section, bearing on this question, are: "The chief clerk, 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."

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It is contended by the defendant that this clause empowers the chief clerk to act as commissioner only when his office is entirely, or *de jure*, vacant; and not when he is merely absent from sickness, or other necessary cause, constituting a *de facto* vacancy, only, or a want of the commissioner present to discharge the duties arising from some such cause. It is certain that the words here used, looking no farther, [* 392] * appear to countenance the more narrow and limited view of the word "vacancy;" but if we look to the object of the clause, to other sections of this and the succeeding Patent Act, to the contemporaneous construction placed upon it, to the long acquiescence under that construction, and the great public as well as private interests which have grown up in conformity to it within the last ten years, a broader meaning to the term seems fortified by the whole spirit of the act, and by the analogies of the case.

It is proved as a fact, that the chief clerk, since July, 1836, has been accustomed to perform, under this section, all the duties of commissioner during his necessary absence, and without any new special authority being obtained from the President, under the law of 1792. It has been uniform in the office to consider the word "vacancy" here as meant to cover an actual, or *de facto* vacancy, by a necessary absence from the city; and the act has been construed so as to include as a vacancy, for this purpose and object, the inability of the commissioner at the seat of government to discharge his official duties, arising from any necessary cause, as well as a vacancy arising from his death or resignation.

It is conceded, also, that many patents during that period have been signed, and many records certified, by the chief clerk, as acting commissioner, under the 2d section of the Patent Law, and which must become invalid if this one be so pronounced, for that cause.

It is further apparent, from the fourth section of the same

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law, that, unless this broad construction be correct, the chief clerk is not empowered to certify copies of the original records and papers, in the necessary absence of the commissioner, however urgent may be the necessity for them, in the protection of public or private rights. But, by a subsequent act, passed March 3d, 1837, ch. 45, section 2, (5 Stat. at Large, 191,) the chief clerk is expressly empowered, in the absence of the commissioner, to give copies of former records supplied * where formerly burned. And hence it [* 393] would follow, if necessary absence in the first law is not covered by the term "vacancy," he is not authorized to give copies of original records in the absence of the commissioner, though he may of records burnt, and supplied again afterwards. This would be a distinction most groundless, and hardly presumable to have been intended. It would likewise follow, that, in the absence of the commissioner, the chief clerk was to have charge of the seal and records, but could not use them for some of the most common and necessary and urgent business connected with them.

Furthermore, he is placed under oath, and also under bonds, so as to secure the community when he does act; and is, indeed, more safe for the public than a temporary commissioner selected by the President, as such a one may be under no bonds, whatever; yet, though under this security, a construction is urged that he has not been trusted by Congress to act, in the very cases where a person is trusted by them to act, without security, if selected by the President. And this is the reasoning, too, though he is selected to be chief clerk, rendering him eligible to perform these duties, virtually by the President, in all cases, and often by his express wish. Nor is it any stretch of confidence, extraordinary or unnecessary, for Congress to confer on a clerk such a power as the signing of a patent. It is done clearly, and is conceded to be properly done, when the commissioner dies or resigns, and a

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technical vacancy exists ; and in case of his absence it is done, not for personal favor, but for public convenience ; so that citizens are not to be delayed in getting patents till a successor is appointed, and arrives, perhaps from some remote place. So it is conceded to have been done for more than half a century, by a grant to the President from Congress, by the 8th section of the Act of 8th May, 1792, ch. 37. The danger from the broad construction here, is then no greater [* 394] than from other powers, admitted already to * exist in other ways, in relation to this same subject. But to guard against long absences, without a regular and more responsible head to a department or bureau, it is wisely provided, by the Act of 13th February, 1795, ch. 21, that the temporary appointment by the President shall not continue over six months at one time, because a regular successor could in that time be procured, and the sanction of the Senate should be asked for filling the office during a longer time ; and by the section now under consideration it is contemplated that the temporary head of the bureau shall act only during the "absence" of the commissioner which is "necessary," or a vacancy happening in any way ; both of which are, of course, not likely in any case to last longer than six months, in an age when such offices are so much sought after as in this.

Again, in respect to the meaning of the word "vacancy" as used in like cases, it is obvious that the Act of 13th February, 1793, looked to it as covering absence and sickness, as well as death or resignation of the regular incumbent, because it speaks of a "vacancy" when referring to the former act, and a temporary appointment for only six months under it, and when that previous act authorized such appointment as much in case of absence and sickness as of death. All of them, then, seem to be covered by the reference, as each constituting a "vacancy," *de facto*, to be sure, in case of absence

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and sickness, but still referred to under the generic term of a "vacancy."

There is another circumstance of some importance, not yet noticed, bearing on this question. It is well known to all who have been familiar with the departments and bureaus at Washington, that the delay and inconvenience to the public in obtaining temporary appointments from the President, if absent far from the seat of government, as he sometimes is, when the head of a department or bureau, by sickness or accident, is obliged to be away from his office, has led

* sometimes to complaints of a suspension or post- [* 395]
ponement of business of an important character ;

and it has been contemplated, either by a general law, or as the department and bureaus become from time to time reorganized, to provide that the chief clerks in each should temporarily exercise the duties of the heads thereof, while they were necessarily absent. It is obvious that the public would often be much benefited by such a provision, in cases like the President's being away, so that he could not at once make a temporary appointment ; and it is equally obvious that the public can never *suffer* by such an appointment, and by operation of law, more than it does now, when made by the President, if not away ; nor would such a general provision be either novel or dangerous, considering that in the case of most ministerial offices under the government, such as collectors of the customs and marshals, their deputies, appointed by themselves, can now act for them in their absence, and do constantly perform most important duties at such times.

Hence, when the Land Office was reorganized, 4th July, 1836, the same day the bill passed reorganizing the Patent Office, containing the provisions now under consideration, clauses were inserted in both bills, with a view to confer such a power or appointment on the chief clerks in both bureaus. The clause in respect to the Patent Office I have already

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quoted, and have been examining its spirit, and other analogies, in order to see if the broad one covering the present case is not the proper construction of its language and intent. The other clause, in respect to the Land Office, is on the same subject; but, by a different arrangement of the sentence, is too clear to admit of any different construction from that I have applied to the Patent Office. In the last, the language is: "And in case of a vacancy in the office of the commissioner of the general Land Office, or of the absence or sickness of the commissioner, the duties of said office shall devolve upon, and be performed, *ad interim*, by the clerk of the public lands."

[* 396] * This clerk of the public lands was the chief clerk in the office.

Undoubtedly the object to be attained was alike in both; the inconvenience to be remedied was the same; the risks similar; and it was probably only by inadvertence that less precise language was employed in the Patent Act than in the act as to the Land Office.

It is a sound rule, in the construction of statutes generally, that "every thing which is within the intent of the makers of the act, although it be not within the letter, is as much within the act as if it were within the letter and intent also." 4 Paige, 252, in *Walker v. Devereaux*, cites 1 Plowd. 366, *Dwarris on Stat.* 691. It is conceded, however, that the intent must be ascertained by the words that are used, coupled with the mischief to be remedied. But it is a mistake to argue that because ministerial officers can do only what they are specially empowered (7 Mass. 281 - 283) they cannot do what, on a fair and liberal and useful construction of the words used by Congress, they are specially empowered to do. The intent of an act of Congress, as to such offices, is to be gathered from the whole spirit, no less than the letter of the act, as much as it is in other cases.

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In both of the provisions we have just been considering, the intention of Congress, seeming to have been the same, the action of the chief clerks, or heads of their respective bureaus, in their absence, is not an action without pretence of justification by any express act of Congress, without countenance of any law, and a mere *usurpation*, as it would be, if done under an idea that they can so act, and transcend limited powers by mere construction, as being clerks, and their superiors absent; or as being more convenient, at times, to the public.

But they equally rely here, and for ten years have relied, on explicit and special provisions by Congress to authorize their action in both cases; both provisions being made at the * same time, with a like view, though [* 397] one uses language not susceptible of a different construction, while the other does not; but language which, at the same time, will fairly bear a construction in conformity with the spirit of the law, and similar to that which must confessedly be put on the other act.

Besides this reasoning and these analogies on the present question, the conclusions which I have formed in favor of the validity of these letters-patent, under this objection, are strengthened by some other considerations.

Here a patent is offered in evidence, valid on its face, and objected to only on account of matter *dehors*, that the acting commissioner who signs it was not in fact one so acting by appointment of the President. If he had been, it is conceded, the patent is valid; and this was virtually decided by the Supreme Court in *Wilson v. Rousseau*, 4 How. 646, 663, where this very patent, signed by Mr. Sylvester as acting commissioner, was objected to, and upheld. No proof was offered there, that he had, or had not, received any such appointment; but, in such cases, it being legal to have an acting commissioner, it was presumed he was duly appointed so, and his acts therefore valid. So, in this case, such a presumption

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would be enough, provided it be not competent to go further, with evidence on the subject, in a proceeding between third persons; the power of the officer himself not being here put directly in issue in a proceeding where he is a party. That a person is an acting officer is enough in most cases, even in that of murder, see the cases collected at the last session of this Court, in the case of the United States v. Peterson, *ante*, p. 305.

For like reasons, probably, Justice Story, in this case, when the injunction was granted, intimated that the patent must be bad on its face, in order to sustain an objection about the officer, and Judge Kane countenances, to some extent, [* 398] the same idea in his opinion in *Smith v. Mercer*, connected with this same patent, August, 1846, Penn. D. Ct.

These reasons and opinions make it very questionable whether the evidence is competent, or admissible at all in this action, that the acting appointment of the chief clerk was not made by the President himself; and if it is not, the patent on its face, as in the 4th of Howard, must be deemed valid.

I should however, do injustice to the intrinsic difficulties of this question, and the different reasonings and analogies which have been and may be fairly brought to bear on it, were I not to add that some doubt remains in respect to the results I have reached, though the inclination of my mind is decidedly to sustain the validity of the letters.

The second objection to the patent, on account of its alteration, has been fully considered before, on some different facts, when the motion to dissolve one of the injunctions was made last spring. The correction of a mistake, though committed clerically, yet as here in a matter material, was then supposed not to be valid, though made by the commissioner, unless approved by the Secretary of State. It was not

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thought necessary by me that the patent, after such a correction, should be re-sealed or re-signed by the commissioner, he being the officer who did both acts originally. But, as the Secretary of State must by law sign it, as well as the commissioner, should the patent be altered after he signs it, he must, by analogy, be made aware of any such subsequent alteration, and sanction it, before his signature can be regarded as verifying the amended patent.

No evidence was produced before of his knowledge, and his sanction of this change; but such evidence is now offered, and is probably sufficient, without any entry of the same on the letters-patent themselves. That would certainly be a convenient mode of perpetuating the evidence of his sanction; but, no law requiring it, the principles seem to demand nothing *beyond his assent or ratification of [* 399] it; both of which exist here in writing.

Independent of form, it is in substance very seldom that he interferes at all with the issue or correction of patents; but the commissioner practically discharges all such duties.

There is still another question connected with this point which might arise, but has not been now pressed. It is, whether a patent so amended could operate, except as from the time of the amendment; and, if not so, then those letters, being altered since the bill was filed, cannot avail the plaintiff in support of it.

If new matter was inserted not originally contemplated, or corrections made not clerically, it is questionable whether they could relate back to the date of the letters-patent; but here it seems they ought to, as much as any like clerical amendments of declarations, or pleas, or judgments, under the statutes of jeofails.

A different conclusion might be formed, on a fuller examination of the subject, as to third persons who had acquired rights as the patent stood before it was corrected, unless by

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[2 Woodbury and Minot, 121. October T. 1846.]

In a motion for a new trial; because an official letter from the commissioner of the Patent Office on an official matter was admitted as evidence, tending to prove the time of making the invention, there is some analogy to justify its admission after proving its signature as official correspondence, and also as a declaration made at the time containing a particular act, as part of the *res gestæ*; and though its competency may be questionable, if subsequent evidence in the progress of the case rendered it unnecessary to prove the fact for which it was offered, a new trial will not be granted on account of its admission.

So it will not be granted, where parol evidence was offered of the contents of a former letter, and rejected, because no satisfactory proof was first furnished to the Court of the loss of that letter; or its having come to the possession of the opposite party. Courts will receive the affidavits of either party, to establish or rebut such preliminary facts, to be proved to them.

Letters put in the post-office are not of course in all cases, and under all circumstances, presumed to have been received, though putting them in, may be using due diligence as to notice by the holders of negotiable paper. But in questions of fact addressed to the Court, to lay the foundation of secondary evidence of a written paper, such a letter will not be presumed to have been received, merely from putting it in a post-office, if no answer was returned, and the party, to which it was addressed, makes affidavit it never came to hand.

A former verdict between these parties on an issue out of chancery in a bill in which an injunction was prayed for against the further use of a [* 122] patent, and a * trial of an action for damages for its violation, and on an amended specification, seems not to have been a trial of the same matter, and if it was, the former is not a bar when no judgment was ever rendered on that verdict, or on the merits of the bill, praying an injunction, the bill having been dismissed on the plaintiff's own motion.

A deposition shall not be taken during the session of the Court, at which the case is to be tried, except by its order or consent of parties, or taken merely *de bene esse* in case of death or absence abroad.

When counsel have acted publicly in former trials of a like cause, between these parties, and are still employed, though not one of the counsel, whose name appear on the record, if living within a hundred miles of the place where the deposition was taken, he ought to be notified.

It is doubtful whether a caption is not insufficient by describing the action as against one, when it was against two, and so entered and defended, though with service since only on one. If the ruling had been erroneous, no new trial is proper when no injury resulted, as the minutes of counsel containing

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the testimony of the witness on a former trial went to the jury, and, for aught which appeared, contained all that was material in his deposition.

A renewal of a patent by the commissioner with an amended specification, is presumed to have been made legally, that is, to correct a mistake or inadvertence, and for the same invention.

But this presumption may be rebutted by evidence, and if so, it should be submitted to the jury when requested to decide as a fact, whether the last letters issued for the same invention.

Under the Acts of 1836 and 1839, the earliest invention is to prevail over any subsequent one, unless it was allowed to go into public use, or be on sale for two years before taking out a patent, in all trials where no point is made of a subsequent inventor having perfected and patented his invention, while the other neglected to use due diligence to complete his.

An invention, to be valid as the first, must be seasonably reduced to practice, and put in use.

A patentee, who uses certain words in his specification, and then takes out an amended one, omitting them, is not estopped by those words, after being thus withdrawn.

Where the plaintiff makes out a *prima facie* case for the violation of his patent, and then the defendant goes forward to prove his special defence under a notice, that the invention had been known and used at divers places by divers persons, it is right to instruct the jury, that on this defence it is the duty of the defendant to turn the scales of evidence in his favor.

To indemnify a patentee in damages, the jury may allow actual cost in suits relating to it, and also counsel fees, if reasonable in amount; and this court, under the act of Congress, will award treble what is found by the jury as damages, if deemed proper to protect useful inventors from combinations and ruin.

If one of the jury, before retiring, publicly inquire as to a particular fact on the records of the Court, and no objection being then interposed by counsel on either side, it is publicly answered by the clerk, it cannot be taken advantage of by a motion for a new trial after a verdict is returned.

* Damages in cases of this kind and of torts, where the jury passed on [* 123] them fairly and legally, will not be considered excessive, unless they clearly exceed what is necessary to indemnify the patentee; and a court will not set aside a verdict for such excess, unless large and palpably unreasonable. When a motion for a new trial is not drawn up for some weeks, and the counsel disagree as to some of the rulings made, the Court must settle the differences, and will not award a new trial on account of them if no injustice seems on the whole case to have been done by the verdict.

Nor when such is the result will the Court allow a new trial, if the counsel believe that in his argument he expressed a wish for the Court to instruct the jury on some points, and it was not done, but furnished no written list of the instructions desired, nor stated verbally, after the charge was through, and before the jury retired, that any point had been omitted, or any further directions were desired.

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It is not the duty of the Court to instruct the jury on abstract or irrelevant questions, but only such as arise on the evidence in the case; and though, as general rules, new trials are granted for the admission of evidence not competent, or the rejection of what is legal, or for a misdirection in point of law, yet by well-established exceptions, in the exercise of a sound discretion, this is not to be done, if in the course of the trial the evidence became immaterial, or on the whole case, notwithstanding some erroneous ruling or instruction, the verdict does not seem to have been influenced by them, or to be against the justice of the cause.

A motion for an allowance of a bill of exceptions, under the authority given by the Patent Act to this court in all cases under it, where it seems "reasonable," in order to enable the parties to carry questions contained in it to the Supreme Court, when the damages are less than \$2,000, ought to be granted in the exercise of a sound discretion, as to cases involving points which arise in the construction of the Patent Law itself, where those are important in their character and really doubtful, but as to no cases involving points of a different character.

THIS was an action on the case for a violation of a patent-right for a self-cocking pistol.

The suit was instituted September 2, 1844, and counted on a patent issued for the last time on the 3d of August, 1844, but which had originally issued, November 11, 1837, and been surrendered and cancelled for a defective specification, January 15, 1844, as well as again August 3, 1844.

The plea was, not guilty, accompanied by notices of a prior knowledge and use of the same modes of constructing locks to fire-arms, in various places and by various persons, that need not be recapitulated.

The writ was served on Blunt only, and the [* 124] cause came * on for trial here in June, 1845, when the jury disagreed. It was tried again in June, 1846, and after ten days spent in putting in the testimony, and in arguments of counsel, was submitted to the jury, and a verdict returned for the plaintiff for \$1,200 damages.

In the progress of the trial, several rulings were made of disputed questions on the admission of evidence, and the jury were instructed on certain points of law connected with the case.

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But a bill of exceptions was not then filed by the counsel for the defendant, from an impression that as the damages were less than \$2,000, the case could not be carried up to the Supreme Court by a writ of error.

A motion for a new trial, however, was made, and the reasons assigned for it were filed, July 14, 1846, a copy of which follows:—

“And now, after verdict, defendants move the Court here for a new trial, and assign the following causes.

1. Because the Court, notwithstanding the objection of defendants, allowed the plaintiff to read in evidence a certain letter, purporting to have been written and addressed by one Ellsworth, assuming to be Commissioner of Patents, bearing date the 15th July, 1837.

2. Because the Court refused to allow defendants to read in evidence and exhibit a portion of the deposition of one William H. Elliot, in relation to his, said Elliot's, having transmitted to plaintiff a certain letter and certain drawings of pistol locks, copies of which were annexed to said deposition, on the ground that the plaintiff, by his affidavit, denied the receipt of any such letter and drawings.

3. Because the Court refused to permit defendants to give in evidence the record of the proceedings, verdict, and final disposition of a suit in equity between the plaintiff and defendants in the State of New York, touching the same subject-matter, which is at issue in this suit.

* 4. Because the Court refused to permit defend- [* 125] ants to read in evidence the deposition of Samuel Colt, taken by said defendant in and for said suit.

5. Because defendants' counsel having insisted that the first letters-patent were for another and different invention from those claimed in the second and third letters-patent, the Court ruled as a matter of law, that the reissue by the Commissioner of Patents to plaintiff of the two letters by him

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obtained upon surrender of his first and of his second letters-patent, was conclusive that all said letters were for one and the same invention.

6. Because the Court, having permitted the plaintiff to introduce evidence as tending to show that plaintiff, several years prior to his first application for letters-patent therefor, did invent and put in use the invention claimed by him and set forth in said letters-patent, did thereupon rule that although the same invention had, subsequent to plaintiff's making his said invention, and before his making his said application, been made and put in use by Elliot or any other persons, yet the plaintiff's patent would still be valid.

7. Because the Court, although requested by defendants' counsel, omitted to instruct the jury as matter of law, that unless they should find that the plaintiff had not merely first discovered, but first reduced to practice, and put to use, his said invention prior to the discovery, and putting in use by others of the same invention, the plaintiff's patent would be void.

8. Because the Court did not instruct the jury as matter of law, though requested by defendants' counsel, that plaintiff was estopped as against defendant and the public by his first letters-patent from asserting that the mode of disengagement of the slide trigger does not constitute a substantial difference between the lock of plaintiff and a lock disengaged in the mode of detaching such slide trigger.

[* 126] *9. Because the Court omitted to instruct the jury, though requested by defendants so to do, that if plaintiff made his said invention in 1833, and reduced the same to practice, yet if he concealed the same, and did not apply for letters-patent until July, 1837, the letters-patent thus obtained would be void in case of a subsequent similar invention reduced to practice, and put in use prior to said application for letters-patent; but instructed the jury that if they

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should be satisfied that plaintiff made his said supposed invention in the year 1833, and reduced it to practice, but did not apply for letters-patent therefor until July, 1837, yet that plaintiff's patent was valid.

10. Because the Court instructed the jury, that if plaintiff had made out a *prima facie* case of originality of invention, and of a violation of his patent by defendants, the evidence on the part of defendants to entitle them to a verdict, must be sufficient to turn the scale; that if defendants impugn the originality of the invention, or the similarity of the instruments, they must offer such evidence as shall render it probable that plaintiff was not the first inventor, or that the machines are not similar.

11. Because the Court instructed the jury in relation to damages, that they were at liberty to include therein the costs and expenditures of plaintiff in conducting this suit, other than and besides the costs by law taxable therein.

12. Because the jury were permitted, upon the question of damages, to inquire of the clerk and ascertain what damages had been given in two other patent cases that had been tried in said court.

13. Because the damages assessed by the verdict were without evidence, against the evidence and the weight of the evidence, and are also excessive."

At the adjourned session of the Court, held in September, 1846, the new motion was made for leave of the Court, then to file a bill of exceptions, embracing some of the * causes assigned for a new trial, in order to carry [* 127] the case up by a writ of error under the special provision as to the subject of allowing writs of error in all patent cases when deemed reasonable by the Court under the 17th section of the Patent Act of July 4, 1836.

This motion was made without abandoning that for a new trial, in case it should not succeed; and both were argued at

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the September session by *Bartlett* and *C. G. Loring*, for the motions, and *B. R. Curtis* and *Choate*, against them.

WOODBURY, J. The counsel for the defendants have assigned reasons for these two motions, which undoubtedly seemed to them well founded in fact, as well as sufficient in law.

But the trial having ended June 24, 1846, and these reasons not having been filed till July 15, 1846, twenty-one days after, and when the Court was not in session, they are open to greater chances of mistake, and cannot so easily and satisfactorily be corrected, if erroneous, as when filed near the time of the trial.

The reasons for the delay, however, are satisfactory; but do not lessen or remove at all the difficulties produced by it. These have still got to be met, and having listened to the respective views of the counsel on both sides as to the facts and the law involved in these motions, I shall now proceed to perform my further unpleasant portion of duty in respect to them, by deciding first, what it appears to me actually took place at the trial in connection with each point, and next, whether it furnishes a reasonable ground for a new trial, or the allowance of a bill of exceptions under the special provision of the 17th section of the Patent Act. There are thirteen reasons assigned for the new trial, and it will be more convenient, intelligible, and useful in examining so [* 128] * many, to consider them in relation to a new trial, separately from the motion for a bill of exceptions.

1. The first one is the admission of a letter from the Commissioner of Patents, which was objected to by the defendants. There is no difference of views between the counsel as to the ruling of the Court on this point having been as stated. But the letter was admitted merely as evidence to prove that as early as the 15th of July, 1837, the day of its

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date, the plaintiff had made this discovery in fire-arms, and applied to the Patent Office for a patent for it. This letter was an acknowledgment of such an application. I entertained doubts at the trial whether the letter must not be regarded like that of any third person not a party, and hence was not so good evidence as his statements under oath as a witness.

But it may be, that coming from a public officer under an official oath and on official business, it is competent as an official act and document of a public officer in relation to such a subject; and being duly proved as to its signature, there is some analogy for making it competent evidence for the jury to weigh in deciding whether the invention of the plaintiff had not at that time been completed. If copies are admissible in such cases on general principles, *à fortiori* are the originals.

The rules as to admitting official correspondence to prove official facts in this manner in certain cases, may be seen in 1 Greenl. Evid. pp. 359, 554; 1 Johns. R. 38-51; 1 Cranch, 1, 37, 38.

Another principle, urged at the hearing, though not at the trial, in support of the admission of this letter is, that it was a part of the transaction, when the plaintiff applied for a patent. And being made at the time, and in relation to that subject, is a competent declaration, as a part of the *res gesta* and explanatory of what took place. 14 Peters, 448; * 2 Bing. 102; 1 Stark. 46; 1 Greenl. on [* 129] Evid. 120, 122. This is certainly plausible as to any letters then written by the plaintiff, or declarations then made by him.

But whether these should not be proved by witnesses, may be questionable, and if the person with whom he was thus dealing is a competent witness, as Mr. Ellsworth is, for aught which appears, it would seem that his testimony is more proper evidence of what the plaintiff said or did than his

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letter, unless as before remarked, that letter coming from a public officer, and under oath in respect to an official matter, be legal evidence as to that matter, in the light of a public document or record to prove it, and not as a mere private letter admitted for being a part of the *res gesta*.

But there is another circumstance connected with this testimony, which seems decisive against the objection to its admission.

It is to be remembered in considering both of these motions, that they are not matters of right as to being granted, but the discretion of the Court is to be exercised; and if, in the hurry of a trial, a direction was erroneous, but afterwards became immaterial or unnecessary in consequence of other evidence, a new trial ought not to be granted. See on this, *Greenleaf's Lessee v. Birth*, 5 Peters, 132; 1 Metc. 242.

Now it is certain, that the letter of the commissioner was admitted to show an invention of this lock by the plaintiff, he having applied for a patent for it as early as July, 1836. But in the chain of proof on this subject, evidence was subsequently offered, proving an invention of it by the plaintiff by having made arms, or caused them to be made with this lock on them, several months earlier. By that, therefore, the date of the application, as shown in this letter, became of no importance for this purpose, and there is no pretence or suggestion that the date was in truth erroneous, and would not be sustained by the commissioner as a witness, if placed [* 130] * on the stand. This ground for a new trial, therefore, cannot be sustained.

2. The next objection relates to the ruling of the Court, that a portion of a deposition by Wm. H. Elliot, as to the contents of a certain letter, could not be read. It is alleged to have been excluded on the ground of the plaintiff's denial that he received any such letter. But there is a mistake in part as to this. It is true, that the Court decided against the

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competency of a portion of Elliot's deposition, but it was because it went to prove the contents of a written paper and drawings of pistols, which paper and drawings were not first shown to be lost, nor in the possession of the plaintiff with notice to produce them.

The fact, that he wrote letters to him at a particular time, and on the subject of pistols, was not ruled out, as may be seen by looking at the deposition filed in the case, and the marks now existing on what was deemed inadmissible. They were only as to the particular contents of the letter and drawings. These were ruled out till the usual previous proof was given of the loss of the originals, or of their being actually in the possession of the plaintiff, and notice given to produce them. The correctness of such a ruling is sustained by all the books on evidence, and rests on the familiar principle, that a resort will not, as a general rule, be allowed to parol or secondary evidence of a fact, when written or higher evidence exists and may be obtained.

The defendant then gave notice to the plaintiff in Court to produce the letter and drawings, and the plaintiff thereupon filed his affidavit, that no such letter had ever been received by him.

Another question thus arose and was decided by the Court, whether the defendants had offered to the Court, not the jury, satisfactory proof to justify it in point of law in the admission of parol evidence to the jury of the contents of that letter and drawings. Nothing had been offered to the jury to weigh on this point, and nothing could be by [* 131] law, except the original letter itself and the drawings, until proof was furnished to the Court that they had been lost or had gone into the plaintiff's custody. 1 Pet. 597; 15 Pick. 37; 16 Johns. 193; Woods v. Gassett, 11 N. Hamp. R. 445; Schermerhorn v. Schermerhorn, 1 Wend. 123.

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Nobody testified to these last facts. The deponent swore he sent the letter, rather than delivered it. If sent by a private hand, then the person carrying it could testify whether it was delivered or not to the plaintiff. If sent by mail, then, where notice is to be brought home to the correspondent, the letter must be shown to have been received, and the more especially, where the correspondent denies under oath to the Court that it ever was received. *Carpenter v. Providence Washington Insurance Company*, 4 How. 185.

It is a mistake to suppose that in case of letters, put in the mail to give notice of demand of commercial paper and non-payment, the law considers it sufficient on the presumption that the letter is always received. But it is on the fact, that writing and doing so are using due diligence to give notice.

If such a presumption of the receipt of letters put in the post-office, is to be made in all cases, it is a presumption, contradicted daily by the immense dead-letter collections never received by correspondents, and requiring the constant employment of several clerks to overhaul and dispose of, in our own general post-office alone.

But however that may be, this letter was not proved to have been put in the post-office at all, and the proof addressed to the Court, and the contradiction by the oath of the plaintiff's and Elliot's own testimony, that he never got any reply, failed entirely to convince me that the letter was ever received by Allen.

That a party, before being allowed to give second [* 132] dary or *parol evidence of the contents of a writing, supposed to be in the possession of the opposite party, must first prove to the Court the possession of it as well as the notice, may be seen in the following books. 1 Greenl. on Evid. 597; 3 Camp. 499; 16 Johns. 193; 1 Peters, 597.

This may be done by the affidavit of the party, and be disproved by like affidavits of his opponent, and interroga-

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ories be put in the discretion of the Court, to each by the other, if desiring it and pertinent. *Woods v. Gassett*, 11 N. Hamp. 447.

For it is all addressed to the Court and not to the jury, and is weighed under liberal views rather than technical scruples, and in connection with all the other evidence and circumstances bearing on the point. *Tayloe v. Riggs*, 1 Peters, 596; *Schermerhorn v. Schermerhorn*, 1 Wend. 123.

Were it necessary to go farther on this objection, it would be seen that the evidence thus rejected became, likewise, immaterial; because it related to a communication of certain drawings by Elliot to Allen at a particular date in the summer of 1837, in order to show that Elliot was then the inventor before Allen; whereas Allen afterwards proved that on two occasions, both some time previous to that date, he had caused locks of this kind to be made.

3. The next ruling of the Court was, not admitting in evidence the former verdict and proceedings between these parties in New York.

My predecessor, on a former trial of this cause, considered this question, and gave an elaborate written opinion against the admission of this testimony. 3 Story, R. 742. I have examined it with care, and feel satisfied it is correct, unless in point of fact the judgment of the Court in New York, dismissing the bill, was a judgment made on the merits, and grounded on this very verdict. That Court, on its law side, may not have saved questions, or ordered a new trial as to that verdict.

*But something still more than that fact is necessary to give it "vitality and finality," and that is judgment, actually rendered upon and enforcing the verdict. 6 Wheat. 113.

The bill in chancery, to aid which this verdict was taken, was dismissed. But that is an equivocal act unless explained.

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Dismissing bills is sometimes done for want of prosecution, and is then like a nonsuit in a court of law, which is of course no bar, or competent evidence to affect a subsequent suit. Sometimes it is by agreement, without any examination or action on the merits by the Court itself. *Jenkins v. Eldredge*, 3 Story, R. 182.

Sometimes it is done to enforce an order or rule of the Court, and not to bar the party from a subsequent prosecution, and sometimes it is a judgment on the whole case, and is then meant to settle fully the rights of the parties. *Sibbald v. United States*, 12 Peters, 492; 1 Wheat. 355; *Hopkins v. Lee*, 6 Wheat. 113-116.

When it is of the latter character, it is usually pleaded in bar to a subsequent proceeding, and averments are made, that the dismissal was on the merits. But if it is not so pleaded and averred, and is only offered in evidence, then the evidence *dehors* the record, if not in it, should accompany the record, and prove all which is proper to show that the dismissal was the result of a judicial inquiry and disposal of the rights of the parties involved in the proceedings and verdict. See *Aspden et al. v. Nixon*, 4 How. 467; especially cases cited in the arguments. See *Burnham v. Webster*, 1 Wood. & Min. 172.

But aside from these principles, it appears in this case, that before any judgment was rendered on or against this verdict, the plaintiff, on his own motion, had his bill dismissed without any decision on the verdict, or the merits of the case.

A mere verdict in any suit does not, as a matter of
[* 134] * course, settle the rights of the parties. *Butler v.*

Stephens, Walk. R. 219. It is open, as the verdict in the very case now under consideration strongly illustrates, to numerous exceptions growing out of rulings on evidence that was offered, and opinions or principles involved in the merits, and is open to be set aside for various errors in

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them or for misbehavior of the jury, and, as the counsel for the defendants contend in this very case, ought in law and justice often to be set aside, rather than stand and be given in evidence to control or influence other trials between the same parties. But after all the objections to such a verdict have been weighed by the Court deliberately, and the Court proceeds to pronounce judgment on it, and does pronounce one sustaining it, then it should put an end to further litigation between the parties of the same points involved in that case. It is for public quiet, the interests of the republic, to do this, but not to prevent one full decision on the merits between the parties. Again, if the same merits or points once decided are not again agitated in the second suit, then of course the principle in question does not make or allow the first decision, being on different matters, to bind or control the second. 5 N. Hamp. R. 262; *Burnham v. Webster*, 1 Woodb. & Min. 172; *Bank of United States v. Beverly*, 1 How. 148, 149.

Accordingly, it is further contended in this case by the plaintiff, that if a judgment had been rendered in the first proceeding in New York on the merits, it did not involve the points here agitated. That was an application in equity for an injunction. This is a suit at law for damages for a violation of a patent-right. An injunction will not always be granted, though the patent be a valid one.

So the specification in the patent then relied on, was not the same as now, and hence that proceeding may have failed on the very objection since obviated by a correction of the specification.

* There should have been further evidence and [* 135] explanations on both of these questions before that verdict could safely or properly be allowed to go to the jury.

These views are sustained not only by sound reason, but various authorities cited in *Aspden et al. v. Nixon*, and by

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Judge Story in the present cause; and I do not regard the remarks of 1 Greenleaf on Evidence, § 510, as sustaining a contrary doctrine when applied (as they are understood by me to be) either to the necessity not existing of any judgment at law on verdicts found on issues out of chancery, but leaving the necessity of judgments on them in chancery as imperative, as principle and the precedents just cited require.

But it must appear of course, that the Court decided the merits, relying on that verdict, in order to show that the question involved in that verdict has been settled or adjudged on once by a proper tribunal. That is the gist of the principle in its ever being a bar or possessing weight. Bul. N. P. 234; 1 Story, R. 166; 2 N. Hamp. R. 474.

Hence in Willes, 367, note, it is said, there must be a decree in chancery; and that is evidence that the verdict is in force. Gresley, Eq. Ev. 109; Graham on N. T. 596; 1 Newland, Ch. Pr. 353.

4. The fourth reason assigned for a new trial is the exclusion of Colt's deposition. It will be recollected that this deposition was taken without giving any notice to the opposite party or his counsel, and during the sitting of this Court at which the cause was to be tried. Such depositions, if admissible at all under the act of Congress, are very dangerous in their *ex parte* character, for the fair trial of the final merits of a cause, and according to the views of this Court expressed with much deliberation, are to be very closely scrutinized. Bell v. Morrison, 1 Pet. S. C. 356.

It is there settled, that no presumptions are to be made in aid of evidence taken contrary to common-law [* 136] principles. * See also 2 Wheat. 287; 5 Peters, 604; 1 Gall. 488; 3 Wash. C. C. 408; 1 Brock. C. C. 367.

My own opinion is, that when taken during the session of the Court, though over a hundred miles distant, whether with or without notice, they are entirely inadmissible.

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The admission of depositions, taken *in perpetuum rei memoriam*, under authority from the United States' Courts, and those authorized by some States by express statutes in cases of sickness, or going abroad, or old age, are to be used only in case the witness dies, or has not returned; and often, in the States, notice in these cases must be given to the party likely to be affected by them. See Act of Sept. 24, 1789, § 30. See Statutes in New Hampshire and Massachusetts.

It is held in *P. Ins. Co. v. Southgate*, 5 Peters, 616, that when taken *de bene esse* under the United States' statute, as here without notice, they cannot be used, if the disability is removed. But when the witness lived over one hundred miles distant at the time taken, the opposite side must show the witness to be now nearer, and that this provision applies to cases of over one hundred miles distant out of the district, as well as within it. But 3 Wash. C. C. 409, 531, is against this, and in my view on the soundest reasons, though the other decision being by the Supreme Court must govern till altered by that Court. Here, however, a new principle interposes as to a deposition taken while this Court is in session.

The party and his counsel, (getting express notice from the other side, or getting none in that way, but learning as they may accidentally when and where the deposition is to be taken, and) anxious as they may be to attend and cross-examine, have a prior and paramount legal duty to perform here in court to attend and be ready for the trial here. This is a duty enjoined by law, and not to be neglected. By a rule in the English courts, counsel cannot be required to attend elsewhere during the sittings at Westminster. 1 Tidd's Pr. 57. * In Maine the Courts usually will not allow [* 137] depositions to be used, taken during the session of the Court, unless in the same place, and when the Court is not in actual session, &c. *Wyman v. Wood*, 25 Maine, 439.

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So, not the day before the Court sits. 8 Greenl. 326. *Sed quare*, 25 Maine, 440, as to the last.

It is only by consent of parties, or discretion of the Court under peculiar circumstances, that in ordinary cases of taking depositions, this prior and paramount duty in Court should be required to be neglected or suspended, by absence in attending on the taking of depositions. They ought to be all taken, and the case prepared before the term begins.

But beside this, the plaintiff had counsel in this case, residing in the very city where this deposition was taken, and though his name was not entered on the record here, he had acted in the former trial, and this was known to the defendants.

Furthermore, the names of the parties in this suit are not given correctly in the caption, being described as a suit against Blunt, when it is against Blunt and Simmes, though not served on the latter. It is entered against both, and both plead and defend. Whether for such a variance the witnesses would be examined or not, if indicted for perjury, it is an objection, when the proceedings are to be strictly scrutinized as here, not without some weight.

The exceptions to the admission of this deposition are the more readily sustained also; because, instead of a continuance to take it over again, the testimony of the witness was still allowed to go to the jury, as given in a previous trial, and contained in the minutes of the counsel on both sides; and if the deposition varied from that, by containing any material and new facts, it was not stated, either at the trial or in the argument of these motions, that in truth it did so vary.

[* 138] * My predecessor, in one district of this circuit, made it an invariable rule, if depositions were taken without notice, to allow a continuance to enable the other party to cross-examine the witness, or repel his testimony; and such I understand to be the practice of most of the judges of the Supreme Court in their circuits. The 68th rule of this Court in equity virtually does the same.

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5. In respect to the next objection, a supposed ruling by the Court, that the different letters-patent to the plaintiff for his lock, must in point of law be regarded as conclusively for one and the same invention, the counsel for the plaintiff contend, that no such ruling was made by the Court.

My own minutes and recollections are, that the plaintiff's counsel in the opening, stated something as to the opinion of my predecessor about the binding force of the doings of the commissioner, unless it was set up and proved that fraud had been practised in procuring the last letters from the commissioner; and that the counsel on the other side expressed doubts as to the correctness of this doctrine.

But no attempt was made during the trial to offer any evidence to show that these last letters were not for the same invention, or to show fraud practised on the commissioner in obtaining the last letters, and I can find no minute that my own views on this point were expressed at all. Indeed, in the closing argument for the defendants on this motion, the counsel admit that the Court made no such charge or ruling.

No doubt, however, exists in my mind that if any direction had been required by the evidence and given, I should have said that in point of law the jury ought, until the contrary was shown, to presume the commissioner, in issuing new letters, had discharged his duty faithfully and correctly. *Tr. Railroad Company v. Stimpson*, 14 Peters, 448.

This involves the idea, that he issued them on [* 139] account of mistake or inadvertence in the description or specification of the invention attached to the first letters. And therefore that he issued the new ones, as a matter of course, with a different amended description or specification, but for the "same invention," as he is expressly required to do by the 13th section of the act. But this *prima facie* inference or presumption in respect to the identity was open

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to be contradicted by proper evidence, though if none had been offered, it should stand as a fact, that the invention meant to be described in both, was the same. I entertain the same impressions now, and the correctness of them is fortified by my view of the decision of the Supreme Court in *Simpson v. Westchester Railroad Co.*, 4 Howard, 404. See also, 14 Peters, 458.

Probably my predecessor deemed the decision of the commissioner binding or conclusive farther than I should, and not, as I am informed, to be overturned, either as to the question of mistake in the specification, or as to the identity of the patent, unless fraud was shown, or an error by the commissioner was apparent on the face of the paper. *Allen v. Blunt*, 3 Story, R. 744.

It is not extraordinary, that no such attempt at counter proof was made; because it is now stated in the argument, that the counsel for the defendant then considered the question of identity as a question of law merely for the Court, and asked a ruling of the Court on that point, whether as a question of law, after examining the descriptions in the two specifications, the new letters were or were not for the same invention.

If I omitted, then, to give such a ruling, which is all contended for in the closing argument, the omission seems to have been right.

But had I done what the defendants' counsel now say they wished, that is, given a ruling on the identity as a [* 140] * question of law, and looking to the specification alone, it would have been then, as it is now, against the defendants.

On the face of the two specifications without other evidence, neither a Court nor a jury could much hesitate to believe the renewed letters and the original ones were for the same invention. So the commissioner must have meant, and

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so only had the plaintiff any motive to make them. Because new letters could then with equal ease have been taken out for any new invention; and its use for fourteen years from that date protected by them, instead of only for the residue of the term as in the renewed letters. These last, also, could not operate back on violations any more than new letters.

To be sure he uses in the renewed letters words somewhat different from those in the old ones. That he might do this, was doubtless one of the very reasons for obtaining the renewed letters. But it was different language to describe more correctly the same invention, and this was proper. A part of the opinion of my predecessor on those specifications illustrates this point also. *Allen v. Blunt*, 3 Story, R. 744; *Woodworth et al. v. Stone*, *Ibid.* 754.

The whole mistake on this matter is perhaps in the defendant's supposition, that the commissioner's renewal was held by me to be conclusive in law as to the identity; because he understood my predecessor to have thought so, unless fraud was shown, or an error on the face of the papers.

But from what has been said, it does not appear that the defendant is likely to have suffered from his mistake as to this, so as to justify a new trial for it.

6. The next ruling involves the question, whether under the Act of 1836, when the inquiry is, which is the original invention, the earliest is not to prevail over a succeeding one, though a succeeding one may be made, and used before letters-patent are taken out for the first. There is no doubt *it must prevail as a matter of historical or [* 141] chronological truth. It is, in truth, the first invention.

Is there then any provision in the Patent Laws which contradicts or annuls this truth? Whatever may be the law abroad, or whatever it may have been here under the Act of 1793, or whatever may have been the speculative opinions of

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writers as to what seems most appropriate, it is clear now, that no act of Congress makes delay in taking out a patent fatal to the earliest or first inventor, unless he abandons his discovery to the public, or, by his "consent," allows it to be put in "public use or on sale" for two years before taking out a patent. Then he forfeits his right in it. See Patent Act, July 4th, 1836, § 15; 5 Stat. at Large, 123; Act of March 3, 1839; 5 Ibid. 353.

The plaintiff's patent would be good under the above qualification or the above statutory provisions. The great contest in the present case was, which person in point of fact first invented this kind of self-cocking pistol. There was no pretence that Elliot, the rival inventor, ever actually took out any patent for his supposed invention, or that either of them made, except one or two experimental pistols, or put any others in "public use," or on sale, till the year previous to the patent of the plaintiff, when several were made under the direction of the plaintiff, and not of Elliot.

The plaintiff's invention then and thus, if not earlier, became perfected prior to Elliot's completing his. Allen's was also first patented, being the only one patented.

Elliot sleeping twenty years after, and taking out no patent, is strong presumptive evidence against him as inventor. 3 Story, R. 171, 754; 1 Story, 336.

Again, though I have referred to all the statutory provisions now governing this point, there may, under former statutes, have been established a principle like the following. That is, notwithstanding priority in date of an invention, the party must proceed to perfect and patent it, with due [* 142] * diligence, otherwise a succeeding inventor, who is more diligent in perfecting his, though not getting out a patent, may prevail against or defeat him.

But there was no attempt here to offer evidence, that Allen was not employed after his invention till his patent, or the

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year previous, in perfecting and improving his invention, or that he ever dedicated it to the public or meant to; or allowed it to be in "public use" without any patent "for more than two years prior to such application for a patent." See 7th Sec. Patent Act of March 2, 1839.

The laws were different in phraseology before these last acts, and the construction of them may be seen in 4 Mason, 108.

By the Act of February 1, 1793, the invention must not have been "known or used before the application" for a patent.

They were not so strong as now for the patentee, being now "not known or used" "before the discovery."

Yet, under the old law, Judge Story held, "that the first inventor has a right to a patent, though there may have been a knowledge and use of the thing invented by others before his application for a patent, if such knowledge or use was not anterior to his discovery." *Mellus v. Silsbee*, 4 Mason, 111; *Washburn et al. v. Gould*, 3 Story, R. 133; *Pierson v. Eagle Screw Company*, Id. 408.

This he conceded was different from the English decisions on their Patent Law. But the language and design of their law in this respect were not like ours. See Hall, R. 58; *Davies on Patents*, 429.

He held, that there the use must be such as to show a dedication to the public. 1 Gall. 482. That the use must have been a public use. *Shaw v. Cooper*, 7 Peters, 292; 1 Wash. C. C. 440. And with his knowledge. *Whitney et al. v. Emmett et al.* 1 Baldwin, C. C. 311; 2 Peters, 12, 20. See also, 6 Peters, 248; 1 Howard, 202.

* Hence, whatever may have been thought on [* 143] this in England, as in *Dolland's case*, in the special language of their law, (2 Hen. Bl. 487,) or by Phillips here, (p. 395,) before the Act of 1839, it is clear under that act and the Act of 1836, the intervening use, in order to defeat a prior invention, must be public, and with consent of the

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inventor, and continue two years. *Reed v. Cutter et al.* 1 Story, R. 590.

Again, through the whole trial, as well as in his notice, the defendant denied that the plaintiff had made the invention earlier in time than Elliot, and went on the ground, that *prior in tempore, potior in re.*

Hence he could not, without an absurdity, have insisted at the same time, that Allen had invented it first, but abandoned it afterwards to the public.

The instruction then, as given, was correct upon the point raised, and on which it was given, and which alone was then under consideration. And no instruction should be given on any other points than such ones.

The Court, though seasonably requested, is not bound to instruct the jury on points not arising in the case, or on abstract and irrelevant propositions, points not raised by the evidence. 3 Wend. 75; 4 Howard, 289; 1 Dana, 35; 4 J. J. Marsh. 194; *McNiel v. Holbrook*, 12 Peters, 84.

7. This disposes also of part of the seventh objection. The counsel for the plaintiff think an instruction was given, such as was desired under that head with the above explanation, and such is my own impression; and, on the second argument the counsel for the defendant waived this exception.

8. The eighth objection is overruled, because if the law allows a party to withdraw expressions, used in his first specification by inadvertence or mistake, and he does withdraw them, it would involve no little absurdity for the law afterwards to estop him in consequence of the very [* 144] words * which have been withdrawn or cancelled under its permission. The case of *Kimball's Adm. v. Bellows*, 13 N. Hamp. R. 58, is very analogous to this view.

It was a case of words, struck out of a count in a declaration, and afterwards attempted to be proved against the plaintiff as his admissions, and refused.

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9. The next objection is a supposed omission by the Court to instruct the jury, that if the plaintiff made his invention in 1833, and reduced it to practice, and concealed the same till he applied for a patent in July, 1837, the letters would be void in case that a similar invention was subsequently made, reduced to practice, and put in use before he applied.

It will be seen, by what has before been remarked under another head, that no question was made at the trial in relation to an use by the public of the plaintiff's patent for two years before he applied for it ; and that there was no evidence, whatever offered of such a "public" use of any other patent like his.

It is also equally certain, that no evidence whatever was offered, or point made, that the plaintiff had invented, and improperly concealed his invention, till another person made and perfected a similar one.

But, on the contrary, as before remarked, the contest was, whether he had invented it at all first, and this was inconsistent with any position, that he had invented but concealed it.

The latter clause of this objection as to the instruction which was actually given, has before been considered, and, as before explained and limited, was the instruction proper on the evidence.

10. The next objection relates to that part of the charge to the jury, where the Court stated, that if they believed in the first instance on the paper evidence, that the plaintiff had made out a case, he was entitled to recover, unless the defendant had in his defence rebutted or overcome it, or, in other words, turned the scales.

* The sentence, which follows in this objection, [* 145] shows how the remark about turning the scales of evidence was applied and intended to be understood. It was thus. The plaintiff having made out his case, he stopped, and then the defendant went on and tried to make out a spe-

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cial defence, to overcome the right which the plaintiff had proved *prima facie* to recover, that is, he tried to "impugn the originality of the invention, or the similarity of the instruments," and of this, as a special defence, notice had been given on the record.

It was observed on this by the Court, that the defendants, to support that special defence, must, in the language of this objection, "offer such evidence as shall render it probable that the plaintiff was not the first inventor, or that the machines are not similar." The burden of proof was on him to turn the scales in respect to this new matter which he had attempted to prove under his special notice. All remarks, like this now questioned, are right or wrong as applied or not to a particular state of pleadings, or particular course of trial and evidence. So far as regards these, the notice here was like a special plea in bar, the support of which belongs to the defendant in all cases. He must, in relation to that, after the plaintiff has gone far enough to make out a *prima facie* case, turn the scales in his own favor, or, in other words, take on himself the burden of proof and discharge it.

Thus, one of the defences set up in the notice was a use of a like lock abroad in England before the plaintiff's supposed invention, and another was the use of such a lock previously in Westchester county in the State of New York. The idea intended to be inculcated was that the defendant, in respect to these particulars, must render them probable; he must turn the scales; the burden was on him. If there could be any doubt of the correctness of such a direction in point [* 146] of law, * it will be removed by reading the case of *Powers v. Russell*, 13 Pick. 76.

There is still another view of this matter. If some points in the declaration or claim by the plaintiff were contested, on which the plaintiff had made out a *prima facie* case, or offered enough evidence to turn the scales in his favor, it

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may have been suggested that then the defendant must offer enough, standing by itself, to render his position probable, or turn the scales as to that in his favor, else there would not be sufficient to overcome the balance already proved for the plaintiff.

But it never was intended, and nothing is offered to show that the jury understood, they were on all controverted points in the declaration, which were common to that and the defence, not to compare in the end all the evidence on both sides, and find for whichever party the whole appeared to preponderate.

11. The next objection is, that the Court instructed the jury they might allow to the plaintiff in damages his actual costs, as well as any taxable cost he had paid in consequence of any violation of his patent, which the defendants had committed. I think so still.

The fees of counsel were specially authorized to be allowed by my predecessor, (2 Mason, 119,) though at first he thought differently. 1 Gall. 482. Of course they must be reasonable fees.

In cases of actions for breaches of covenants of seisin, where the object is an indemnity for the injury sustained, costs in former suits are not only allowed, but "reasonable counsel fees" beside. *Staats v. Ex'rs of Ten Eyck*, 3 Caines' R. 111; *Kingsbury v. Smith*, 13 N. Hamp. R. 122; 4 Johns. 1; *Swett v. Patrick*, 12 Maine, 9; *Beale v. Thompson*, 3 B. & P. 407; *Pitkin v. Leavitt*, 13 Verm. R. 379.

The "actual damages" sustained, include all necessary and proper expenses in protecting one's violated rights. And * though they should not include "smart [* 147] money," or what is proper merely for example, they may well embrace every thing really suffered by the wrong. 1 Baldwin, C. C. 328; *Gray v. James*, 1 Peters, C. C. 394; *Whittemore v. Cutter*, 1 Gall. 478; *Washburn et al. v. Gould*, 3 Story, R. 136.

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In the Admiralty Courts, counsel fees are allowed by way of damages, and in one case \$500. The Apollon, 9 Wheat. 379.

There is no exact measure of damages, except in cases founded on contracts; and unless patentees are to be fully indemnified for injuries inflicted on them, they are destined in all valuable patents to be broken down by litigation alone.

If they can escape that untoward fate now, from which Arkwright and Watts suffered so much at first, and by which Oliver Evans and many others have been ruined, and which the very importance and worth to the world of the property their genius had created, exposes them to only the more, it will be effected solely by giving to them an ample indemnity, a real and substantial, and not a mere technical one for rights, which are sacredly recognized both by the laws and the Constitution. Indeed I am prepared, in all cases of wanton and persevering encroachments on the fruits of their honest inventions and labors, to go further, and do what Congress, doubtless for this useful purpose, empowered this court to do, and that is, treble the damages, if required for the full indemnity and protection of any wronged patentee. See 14 Sec. of Pat. Law of July 4, 1846. This, I understand, has been done here on some former occasions.

12. The next objection on account of the damages is, that the jury were permitted to inquire of the clerk, and ascertain what damages had been given in two other patent cases recently tried here.

I am surprised at this objection, when the inquiry [* 148] was * made by one of the jury in the box, in the presence of the Court, counsel, and parties, and no objection raised to it at the time, nor any pretence now set up, that the reply of the clerk did not correspond with the record.

The proper time to object to the admission of such a ques-

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tion and reply, is that which is conformed to in all other cases of testimony, where the parties and counsel and Court are present, and is the time when the question is asked.

It is not permissible to acquiesce then by silence, and take the chance of a favorable verdict on the sums stated in former trials, they both having been in this instance comparatively small, and make the objection for the first time after the jury have returned a verdict for a larger sum.

It is well settled, that a new trial should not be granted for a cause existing at the trial, but which was not stated or excepted to then. *Davidson v. Bridgeport*, 8 Conn. 472; *Nichols v. Alsop*, 10 Conn. 263, 499; 7 Conn. 500; *State v. Hascal*, 6 N. Hamp. 352; 1 Wash. C. C. 440; 5 Cowen, 173; 5 Pick. 217; 11 Pick. 469; 13 Wend. 524; 4 Halst. 225; 1 Bibb, 247; 1 A. K. Marsh. 76; 2 Peters, 15.

The more especially is this so, when any wrong or misleading of the jury was likely to flow from the objection not being then made. 2 Pick. 145; 5 Mass. 1; 6 Mass. 350.

New evidence may be admitted after a case is closed, and even after a jury has gone out, if no objection is taken at the time. 4 Cowen, 451; 4 Stewart & Porter, 34; *Parish v. Fite*, 1 Law Rep. 238.

13. The last objection is, that the sum returned by the jury as damages, was excessive.

The Court, from what had been noticed in respect to the probable damages, did not anticipate so large a sum. But it must be a very aggravated and oppressive case, where the Court would feel justified in setting up its own opinion, even if decidedly different from that of the jury as to the true * amount of damages in an injury in practical [* 149] life, and as to business not susceptible of exact proof in its details, but peculiarly lying within the range of the experience and observation of a jury. It must stand, notwithstanding such difference, if the matter was submitted

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to their "fair judgment." *Alden et al. v. Dewey et al.*, 1 Story, R. 336, 340, 341.

So nothing was left to the jury to be weighed in estimating the damages which the Court, on reconsideration, deems to have been improper. Indeed, my predecessor was inclined to leave a very wide range to the jury on this subject, and hardly exclude any thing at all bearing on it from their consideration. *Earle v. Sawyer*, 4 Mason, 14; *Pietson v. The Eagle Screw Co.*, 3 Story, R. 410.

Retiring then with what is proper, or not objected to at the proper time, if in weighing all that is pertinent, the jury give more damages than any one witness testified to, it has been considered to be no ground for a new trial, as being excessive. 12 Pick. 547; 4 Bibb, 70; A. K. Marsh. 67.

Their being excessive, is the last branch of this exception. If damages are slightly more than the Court deem proper, they are not to be regarded as a ground for a new trial. *Littell*, Sel. Ca. 178; 1 Dana, 355; *Hardin*, 317; 6 Johns. 270; *Stanley v. Whipple*, 2 McLean, R. 40.

Some cases hold, that they must be extravagantly excessive, (1 Bibb, 247; 2 Bibb, 591; 1 Yeates, 209,) unless some exact measure of damages exists in the case, as it does in suits on some contracts. 5 Mason, 497; 4 Mass. 1, 11; 5 Mass. 435.

Others, that they must be unreasonable. *Sampson v. Smith*, 15 Mass. 365. Or in torts, flagrantly excessive. 3 Dana, 464; *Littell*, Sel. Ca. 136; 2 A. K. Marsh. 365; 1 *Ibid.* 345; 3 *Ibid.* 454; 2 Penn. 814; 1 South. 338, 586; 2 Pick. 113, 114; 7 *Ibid.* 82; 3 *Ibid.* 379; 4 Mass. 1; 9 Johns. 45; 10 *Ibid.* 443; 5 Cow. 106; 9 Conn. 309.

[* 150] * It is true in this case as stated by the counsel for the defendant, the evidence as to damages on either side was general and somewhat loose. This arose from the fact that the contested right was the main question.

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But the objection is not well founded, that nothing was submitted to the jury which justified any damages, or any thing like the sum given. 1 Baldw. C. C. 328.

For it was certainly shown, that the respondents made and sold pistols similar in principle to the plaintiff's, that the improvement in them was a valuable one, that there had been a long and expensive trial between these parties on the subject in New York, and another here before the present one; and every man fit for the jury box could, from all this, without having the particulars in bills of cost, form a general opinion, likely to be very sound and not unjust, as to the sum in damages which would probably indemnify the plaintiffs. Washburn et al. v. Gould, 3 Story, R. 136.

Having gone through with the specific reasons assigned for a new trial, and come to a conclusion against their sufficiency, it seems proper now to advert to some other considerations of a general character, connected with several of the objections that might in some cases operate in favor of a new trial.

They are, that the counsel on the part of the defendants, and those on the part of the plaintiff, do not always agree in respect to what was in fact done or omitted to be done at this trial; and that some requests to the Court, made in the argument of the cause as to charging the jury, were not complied with when the charge was finally given.

I can readily conceive of cases, where the differences in recollection between the counsel were so great after the lapse of several weeks, and the point so material, about which they differed, that the Court might deem a new trial necessary to a right disposal of the case.

But here, the Court feels satisfied, where they differ on * what is material, and it is for the Court [* 151] in such case to decide on these differences, (Bond v. Cutler, 7 Mass. 205; 4 Greenl. R. 508,) that, looking to its own minutes and the leading points made on each side,

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the course pursued at the trial was such as it has just explained under the different objections; and in respect to the merits of the case, as tried and settled in the end, that no injustice is likely to happen from coming to the conclusion, not to disturb the verdict. Again, I can conceive of cases in the hurry of a trial at Nisi Prius, and one like this of ten days' length, where some omission of the Court or counsel must have had such an influence on the verdict as to require a new trial.

For there may be mistakes, not to say sins of omission as well as commission, in all concerned in administering the laws. But the omissions, supposed to have occurred here in charging the jury on particular points, are not admitted by the counsel on the other side to have happened in some of the cases supposed; and, in the others, they related to questions as before shown, which did not arise on the evidence, and on which instructions ought not to be given. It is well, also, in all cases to remember, that after a judge has charged the jury, if a written list of the points, on which instructions are requested by either party, has not been handed to him in conformity to the practice in most of the States south of us, it is their duty after the charge is closed, to call his attention to any point which has been omitted, as some oversights are likely to happen where the points are numerous, and the evidence to be commented on to the jury is very abundant and complicated. *Stanton v. Bannister*, 2 Verm. 464.

If the counsel do observe such omissions at the time, and do not mention them, so that they may be corrected and supplied at once, before the jury go out, it would be a very dangerous practice to let his client take the chance of a verdict; before naming them, and then, if losing the [* 152] verdict, * for the first time proceed to suggest the omission as a ground for a new trial.

On the contrary, if counsel do not at the time observe any

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omissions, it is pretty conclusive evidence, that the points omitted were not then deemed very material, since they did not make so much impression on their minds as to cause them to notice that instructions had not been given concerning them.

My own opinion as to the importance of any points omitted, which were relevant, corresponds with this supposition, that they were of little weight, and did not alter the verdict in any respect.

There are some cases on this point not unimportant. Thus it has been settled, that it is no ground for a new trial, if the judge omitted to charge on some points, unless the omission probably influenced or changed the verdict. 6 Monroe, 61; *Graham*, N. T. 273; 12 Moore, 231; *Armstrong v. Toller*, 11 Wheat. 277; *Calbreath v. Gracy*, 1 Wash. C. C. 198; 4 Halst. 149.

And that it is too late to remind the Court of any omission after the jury have retired. *State v. Catlin*, 3 Verm. 534.

In fine, the general rule as to new trials throughout is not to disturb the verdict, if it appears to be according to the justice of the case, and the ruling is only doubtful in point of law. *Brayton*, 169; 3 J. J. Marsh. 710.

Though if the ruling be clearly wrong, it will be, as a general rule, a good ground for a new trial. 1 Dana, 481; 2 Bibb, 89; 3 Wend. 418.

But in examining the elementary books and cases on this subject, it is highly important to discriminate what are the exceptions from what is the general rule on this last point.

Thus, as a general rule, though it will be a ground for a new trial, if illegal testimony is admitted, (*Graham* on * N. T. 236, 237, and cases cited; 2 Wash. 276; [* 153] 11 Mass. 140,) yet it is equally well established as an exception, not to grant a new trial if it be manifest that the illegal evidence has not prejudiced the case. 6 Cowen, 682; 3 Wilson, 18; 1 Taunt. 12; 6 Bing. 681.

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Or if the legal objection is merely technical, *e. g.* as to admitting a printed statute when an exemplification is proper; and when on a new trial the same result will probably happen. 8 Cowen, 223; 2 D. & E. 275; 6 Cowen, 449.

Or if the evidence became immaterial, and the jury did not rely on it probably. 16 Johns. 92; 3 Cowen, 621; Preston v. Harvey, 2 Hen. & Mumf. 55.

Or if there was enough to justify the verdict without it, on examining the report of the case. Doe v. Tyler, 6 Bing. 561.

Or if the rejection was right, but on a ground different from that assigned. 4 Hammond, 5; 2 Bibb, 608.

So, if incompetent evidence be admitted, the Court will not grant a new trial if it was not material. 4 N. Hamp. R. 369; 2 Conn. 31; 6 N. Hamp. R. 80, *sed quare*; 9 Pick. 176.

Or if no injustice appears to have been done by it. Brown v. Wilde, 12 Johns. 455; 2 South. 765; 1 Chip. 304; 5 How. 509; Hamblett v. Hamblett, 6 N. Hamp. R. 333.

Or if cumulative merely. 3 Ham. 107; 12 Conn. 219. Or if not controverted. 12 Conn. 410. Or if the fact was proved also by other evidence. 6 Cowen, 449. So, 1 Taunt. 12, and 2 Moore, 153; Prince v. Shepherd, 4 Pick. 216; 4 Wend. 453; 10 Ibid. 338.

Again, it is a general rule to grant a new trial if there was any misdirection on the law to the jury. Graham, N. T. 262, cases cited; 5 Mass. 365.

But it is an exception, if no injustice seems to [* 154] have been * done by it, as if it was on a trifling or immaterial point; or did not affect the verdict; or if justice appears to have been done. 11 Conn. 342, 377; 3 Marsh. 506; 10 Johns. 447; 6 Cowen, 118; 5 Day, 479; 2 Johns. 46; 5 Mass. 368, 438, 487; 5 D. & E. 425; 1 Pet. 188; Graham, 301, 341, 342, and cases cited; 2 Salk. 644, 646.

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Or the objection was only technical. 2 D. & E. 4; 1 Bet. P. 338, note; 6 Taunt. 366; 7 Greenl. 442; 2 Pick. 177, 310; 1 Pick. 206; 5 Day, 479; 1 Bibb, 265, 605.

It is an exception, too; if the point was frivolous or litigious. 9 Conn. 1; 12 Mass. 22, 163; 3 Johns. 239; 3 Wend. 83; 1 Johns. Cas. 250; 5 Johns. 137; 2 Marsh. 546.

Furthermore, if I could find errors in the instructions to the jury, not specified, which led or were likely to lead to injustice, such as my remarks, that the improvement was useful in itself, though in fire-arms or instruments of war and death, because increasing the powers of high civilization over barbarism, and thus tending to preserve and perpetuate all the benefits of the former from the destruction which, in former ages, often assailed it from rude force; and my other remark, that if this invention was not useful to the community in making pistols, the defendants would not be likely to use it; or if other presumptions of error existed, because the finding for the plaintiff by the jury was unexpected and strange, when in fact the plaintiff alone had taken out any patent for this improvement, and had first brought it into general use, and the defendants had not pretended themselves to have invented it; or because the giving so much damages for a violation of so useful a patent, was matter of surprise, when the whole amount was not likely more than to indemnify him for all his costs and expenses in so protracted and severe a litigation, and much less all his losses of larger sales and profits. I say, if injustice was thus apparently stamped on any part of the *proceedings by observations not ob- [* 155] jected to, or by occurrences, which the Court is now conscious were wrong, it would make me hesitate in refusing another trial.

But when the whole aspect of the case is the other way, it seems to be my duty, in the exercise of a sound discretion, not to disturb what the jury have decided.

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The second motion for the allowance of a bill of exceptions to be now filed, so as to embrace these reasons assigned for a new trial, in order to bring a writ of error on them, involves several considerations, different from those in the naked motion for a new trial.

This second motion is founded upon the special proviso to the 17th section to the Patent Act of July 4, 1836. That section allows a writ of error and appeals "to the Supreme Court of the United States in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of Circuit Courts, and in all other cases in which the Court shall deem it reasonable to allow the same."

This presents a novel question. I am not aware of any case, and none is referred to on either side, where this portion of the Patent Law has received a construction in any court during the ten years since its passage.

In the absence of any decision, I am inclined to the opinion, that, however anxious my wishes are to facilitate attempts of parties to have a revision of the decisions of this court whenever dissatisfied with them; yet I am limited by Congress in my power to allow it, and must confine the indulgence to cases where it appears to the Court to be "reasonable," looking to the subject-matter of this provision, and the general law as to appeals. Opposing parties, also, have an interest in this matter against further delay and expense; and the public has a policy as to limited jurisdiction in suits, which is to be respected; and, therefore, without yielding to my own wishes to permit a writ of error or appeal [* 156] * in all cases, I must execute the act of Congress as it exists in regard to the public interest and the convenience and rights of parties.

What then is reasonable as a general rule in respect to this request?

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Adverting to the manifest policy of the law as to appeals and writs of error, independent of this particular provision, it will be seen, that most cases are to be disposed of finally, in the States where one of the parties reside, as less expensive and more convenient, unless the amount in controversy be as large as \$2,000, or unless the judges disagree in their opinions.

There is nothing in the public policy as to the sum being now too large, which limits appeals, and hence causing a disposition to carry up cases of smaller pecuniary importance. On the contrary, two thousand dollars was regarded as high here in 1789, as three or four thousand would be now.

The necessary delay of justice in the Supreme Court, beyond what once existed before the country grew to be so much larger and wealthier, increases the grievance of being compelled to go there unless required by strict law.

I regard these objections more than any additional expense in further hearings there, at such a distance, instead of nearer home, as the attendance of witnesses and parties is not required there. But they all show, that in a case where the amount, as here, is little over half of what was required in 1798 to carry a case up, it should not be deemed reasonable to aid in doing it, unless to promote some great end or interest, not involved simply in the payment of the sum, found as damages in this particular case.

One of those ends undoubtedly is, uniformity in the construction of our great system of Patent Laws throughout the United States, and because questions connected with the Patent Laws themselves, when decided, govern numerous other cases and much larger amounts [* 157] than are disclosed in any one verdict.

These considerations show that the exceptions to be allowed, using a reasonable discretion, ought to relate to constructions of the Patent Laws. If not to be confined to these,

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why limit the indulgence to patent cases? There is no reason why, as to the other incidental questions, not relating to patents, the parties in these suits should enjoy privileges concerning their decision, not enjoyed by other suitors as to such questions. Why should it be permitted, then, as to matters casually connected with suits upon the Patent Acts? Why, if adverting to the public interests, or the rights of opposing parties, prolong litigation on such points at great inconvenience, delay, and expense?

So it is discreet and reasonable to confine the appeals, even on patent questions under the Patent Laws, to such as involve important, and not trifling matters connected with those laws, not mere technical difficulties; also to such as involve questions really doubtful.

If the discretion concerning what is "reasonable," which is to be exercised by the Court, is not to extend to a selection of cases having questions, that really relate to the Patent Laws, Congress would have provided, that appeals should exist in respect to all patent actions without distinction.

Looking to the first test, none of the causes assigned for a new trial, are to be considered in deciding as to a bill of exceptions, but the 5th, 6th, 7th, and 9th, as none others relate to the construction of the Patent Laws.

Now the fifth, as it will be seen, if allowed in any form, must be in one already substantially settled by the Supreme Court in *Stimpson v. Westchester Railroad*, 4 Howard, before cited; and one, probably not controverted by the defendant, when explained as it is understood by the Court.

[* 158] * The sixth, as has been shown, either attempts in its present form to raise a point about a "public use" of the plaintiff's patent, which was not made at the trial, or, if it merely relies on the position, that a prior invention is not valid when a subsequent one is made, but not

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patented, before the first one is patented, it seems too clear against the defendant to hang a doubt on.

The seventh is now abandoned.

The eighth is for a supposed omission to instruct the jury on particular points, and not for mis-instructions, and of course cannot be a ground for a bill of exceptions, independent of what has before been said against the intrinsic character of the rulings desired upon it. The case does not, therefore, seem to contain matter to make it a reasonable one for granting this privilege.

Both motions are refused; and judgment must be entered on the verdict.

WILLIAM HOVEY v. SILAS STEVENS.

[3 Woodbury & Minot, 17. October T. 1846.]

In a patent for an improvement in the machinery to grind knives, it is necessary, by the act of Congress, not only to describe the machine to be used under the patent, but to distinguish what part of it, or what combination under it, is new, or is the improvement claimed to be invented. It is made necessary, also, by that act, to do this in clear, intelligible, and certain terms. This is not now required to be done with so great accuracy as was formerly exacted, nor to be done in technical language; but it must be made with reasonable certainty and clearness. It may be done in a summary at the close of the specification, disclosing as new any of the machine before described, which is old in its parts, or in combination, or it may be done in the summary, referring in terms, or by implication, to other parts of the specification for assistance, and in such case the other parts are to be considered as explanatory of the summary, or a portion of it, for this purpose.

In this case, the summary appeared to claim a traverse motion of a part of the grinder, in combination with a rotary one, so as to bring up the knife to the stone steadily, though spiral in form. On referring to other parts of the specification, as to what his invention consisted of, it still seemed to be the combination of those two motions, and it was held that such a combination, when

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connected, as here, with the mode of effecting it, was a legal subject of a patent.

But it being conceded that it was not original, the plaintiff was not allowed now to consider his invention or improvement to be the stock used in the machine, or the goose-neck, pressing the blade against the stone, when he had not distinguished either of them in any portion of the specification as the new and particular improvement he had made, nor done it, if at all, with reasonable certainty.

[* 18] * It is not enough to describe a machine containing the stock, or goose-neck ; but he must state further, that they or one of them, is what he claims to have invented, either as a new part or used in a new combination, if such be the fact.

So, if he claims the whole machinery as newly invented, either in parts or in combination, he must state that distinctly ; and it will suffice, if he really invented the whole combination, or all the parts. But if he claims too much, or too broadly, it will be fatal, unless the excess is disclaimed.

If his particular improvement, which he really meant to claim as new, is not distinguished from the rest of the machinery, as new, nor in sufficiently clear terms set out, the only mode of obviating the difficulty is either by an amended specification or a new patent.

Costs in equity are *prima facie*, to be allowed to the prevailing party. But where they are inequitable in whole, or in part, they may be disallowed ; though the burden of showing them to be so rests on the party objecting to them. If the bill is brought solely for the benefit of the complainant, they are disallowed to him, unless the respondent is charged with some wrong ; and if the respondent succeeds on other grounds than those, in which cost was incurred, his cost may be disallowed in the discretion of the Court.

But where he succeeds in a bill for an injunction against the use of a patent, on the objection of too great uncertainty in the specification, and no decision has been made in equity or at law in favor of the originality of the patent, which had been denied by him, he is to receive costs incurred in that defence.

But where the evidence cast some shade over his fairness of conduct in respect to the plaintiff and his machine, the Court declined to allow him beyond actual costs, and rejected travel and attendance in the bill in equity while taxed at the same terms in the suit at law.

THIS was an action at law for a violation of a patent, which had been obtained by the complainant, for " a new and useful improvement in the machinery for grinding tools." It was alleged to be peculiarly fitted to sharpen knives used in Hovey's straw-cutter, and the letters-patent were in the form set

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out in the case of *Hovey v. Stevens*, heard here May term, 1846, for an injunction. 1 Wood. & Min. 290. The material parts of the specification are there extracted, as well as in the opinion of the Court here, and are referred to as part in this case.

At the trial here, October term, 1846, before Judge Sprague, the plaintiff, after proving his patent, offered a paper, certified to be a copy of one filed by him in the Patent Office, October 6, 1846, as a new specification for a reissue of letters-patent. It described certain portions * of [* 19] the original patent, as in substance in the case before referred to.

It set out, also, that "the nature of my invention consists in applying to said machine a stock or arbor, having a flanch thereon, on which the spiral or twisted knives are fastened to be ground," &c. And further, that the stock was "not claimed as new;" and in the close, that he did not "claim the grinder, the traversing carriage, or rotary motion, as they have before been used; but what I do claim as new, and desire to secure by letters-patent, is the combination of the stock, constructed" as described, and knives attached, &c., &c.

The Judge ruled, that this paper offered as evidence of a disclaimer of portions of the old specification, was not competent evidence for that purpose, as it had not been filed as a disclaimer in the Patent Office; nor was it completed as a new specification by a surrender of the old one. And he further stated, therefore, that, in his opinion, the plaintiff's claim was so uncertain and so imperfectly described without it, or in the original specification, as to make his patent invalid until he filed another and more accurate and more specific description of what he deemed new and patentable in his invention. He held, that it might be considered as clear enough for combination of two motions described, but for nothing

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else; and the mode of constructing them was conceded not to be original.

Thereupon the plaintiff became nonsuit, with leave to move to set it aside and be heard on this ruling before the whole Court.

The hearing was commenced in November, 1846, and renewed and finished in April, 1847.

C. Sumner and *B. F. Hallett*, for the plaintiff; *Charles Levi Woodbury* and *Stanton*, for the defendant.

SPRAGUE, J., stated his views at length, against the motion.

[* 20] * WOODBURY, J. I concur, generally, in the conclusions expressed by my associate, on this motion. Having tried the case, he has devoted particular attention to its different aspects; and it is not, therefore, necessary for me to go very fully into the grounds for my opinion.

But, as the argument has been before both of the judges of this Court, in order to have the minds of both exerted on the question, I do not feel at liberty to withhold some detail of the impressions made on mine.

The ruling at the trial, that the new specification, not being completed, could not be considered as a disclaimer, is not objected to at the argument. The sole question, then, is, whether the original specification sufficiently distinguishes what is the particular improvement claimed to be invented by the plaintiff, and then describes it with proper clearness and accuracy.

On a former occasion, when an injunction was moved against this defendant, I presented some views on the matters supposed to be claimed as new in this patent. 1 Wood. & Min. 290. But by the proposed new specification since

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filed, and the admission of counsel in the argument of the present motion, the aspect of the case has been, in some respects, changed, and our inquiries much narrowed.

This patent is, in the letters themselves, described to be for "a new and useful improvement in machinery for grinding tools." This obviously means, looking to the patent itself, not "that he has invented" the whole machine for grinding, which he afterwards describes in his specification, either as a new combination throughout, or as having new parts throughout, but that he has made some "new and useful improvement in the machinery" ordinarily used for that purpose.

The next inquiry is, what is that particular improvement, looking to the specification and drawings? How is it *described, or distinguished from what is not [* 21] new? when there is a summary setting out the claim to some particular novelty that is to govern. 2 Mason, 112, 119; 1 Story, R. 285. But, if it refers to other parts of the specification and drawings, those parts are to be examined in connection with it in order to ascertain what is claimed in the summary as the new improvement. See *Davoll v. Brown*, and cases cited therein. 1 Wood. & Min. 58.

I am not aware that the new paper filed as an amended, or new specification, but not completed, can be referred to in construing the summary and original specification. And it is now conceded not to be properly in the case as a disclaimer. But it can probably be considered as an explanation by the plaintiff, of his intended meaning, and can be referred to, in considering whether the words as used in the original specification carry out clearly, or not, what it is now said he then intended. The summary is in these words:—

"What I claim as my invention, and desire to secure by letters-patent, is, giving to the spiral or twisted knife or cutters, attached to a flanch in a line radiating (or nearly so)

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from the axis of the stock, a traversing motion in the direction of its axis, in combination with a reciprocating rotary motion on its axis, when this latter motion is governed by the twisted plane of the cutter, or any thing essentially the same, to enable the grinder to give the required bevel to the ground face, and the proper line to the edge, substantially in the manner herein described."

No one can read this without coming to the conclusion that the improvement Hovey describes here, as invented by him, is giving to the knife, as fastened, a traversing motion in combination with a reciprocating rotary motion.

In the next place, if the concluding words, "substantially in the manner herein described," allow and claim any different manner of giving those motions in combination, [* 22] it "does not alter what is claimed as the improvement, but merely permits the mode of giving the motions to be different, if remaining "substantially" the same.

If, also, "herein described" means, in the whole specification, rather than the summary, which is a little doubtful, but *ut res magis valeat*, I will so consider it, by adopting a liberal construction towards the patentee. I do this, not to prejudice him by including more than is in his summary, and thus making the latter too broad, and hence void. But it is to aid him by further illustrations and explanations. I do not see, however, that the obvious meaning of the summary, when standing alone, is altered by the description when they are carefully analyzed.

There are two of these. The first one is:—

"The nature of my invention consists in attaching the twisted (sometimes called spiral) blades or cutters to a flanch projecting from a stock hung on journals in a traversing carriage, so as to present the back of the cutter to be ground to the action of a grindstone, or other reducing or polishing

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wheel, so that as the cutter on the carriage traverses lengthwise it shall vibrate freely on the axis of the stock to which it is attached, to follow the twist of the blade, and grind it to a sharp edge, such as is required in cutting, by impinging the cutting edges against the surface of a cylinder by the rotation of the two cylinders, or the cutting cylinder on a plane, the cutting being effected by a pressure towards the centre of the axis of the cylinder of knives. The reciprocating motion of the cutters, during the traverse motion, being governed by the spiral or twisted surface of the knife itself, or any thing analogous thereto."

Here, again, the leading feature is the combination of the two motions. So is it in the only other description of his invention, as follows: — Certain things are necessary "to carry out my invention, namely, to give to the stock to which the * knives or cutters are attached, a recipro- [* 23] cating motion on its axis, whilst it traverses longitudinally before the grinder, so as to give the required bevel to the ground face, and a line to the cutting edge, which, in its rotation, will generate a cylinder."

Now, although those motions are described as produced by the stock and other machinery used to grind the knives, yet it is the combination of the two motions which is the most clearly described as his new improvement, and not the use of either a stock, or goose-neck, or flange, or attaching the knife by a screw. They seem to be mere parts of the machinery in which the combination of these two motions is represented as the novelty. In the next place, though it is doubtful whether a patent can be taken out for mere motions, or for mere combination of motions, yet adopting again the most liberal construction for the patentee that this is a patent for a new mode, or manner of producing those motions, and the matter might be patentable. *Stone v. Sprague*, 1 Story, 270; 3 Car. & P. 502; *Jupe v. Pratt*, Webs. Pat. R. 51.

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But after reaching that conclusion we are met by the admission in the amendment of the specification filed, and in the argument for the plaintiff, that the combination of those two motions is not a novelty; and that if the patent is to be regarded as for that, it is too broad, and hence, being not original for that, must be invalid. *Kay v. Marshall*, 1 Myln. & Cr. 373; *Wyeth v. Stone*, 1 Story R. 273; 7 Wheat. 356; *Moody v. Fiske*, 2 Mason, C. C. 112; 4 Barn. & Ald. 541; *Bovill v. Moore*, 2 Marsh. Com. Pl. 211. How then can the plaintiff be entitled to recover, or be aided by a new trial?

Only, I apprehend, by showing from the specification, that some other thing than this combination is actually and clearly claimed in the original specification as the new improvement.

[* 24] * At the hearing of the motion for the injunction, it was conjectured, that if any other new improvement was claimed, it might be the mode of fastening or attaching the knife to the flange with a screw.

But it appears now, in the admission before referred to, that the fastening of the knives with a screw is not meant to be claimed as a novelty.

Neither is the grinding one knife at a time claimed as a novelty, standing alone and *per se*.

While, on the contrary, in the statements in the new specification filed, it is the stock, in combination with the other parts, which he desires to have considered as his particular improvement.

But at the argument of the present motion, it seems to be contended, there are three novelties in the improvement of the plaintiff, and either of them well enough distinguished. One is a new combination of all the parts, they all being old for like purposes — that, it is said, never before so united in this manner. One is in the stock as permanent, united with the

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other parts ; and one is the mode of pressing the blade against the stone, combined with the rest.

Now, as to the first claim, we are unable to discover it in the specification, as for any new combination of parts, unless it be the traverse and rotary motions, united — and that is now acknowledged not to be new.

As to the second claim for a new part in a permanent stock, or a new combination with it, it is certain that the original patent refers to the stock, and so does the proposed disclaimer. But the latter concedes it is not a new part.

Neither of them speak of it as a permanent stock, *ipsis verbis*, and the machine, it is conceded, would work well without its being a permanent stock — but not so well for some purposes.

Undoubtedly a permanent stock at times is better, so * as to attach to it separate knives and grind them, [* 25] when out of order, or to attach newly made separate knives and grind them, so as be ready for commercial sales at a distance, and for immediate use.

Unless the stock, then, be claimed as a permanent one, and, being such, as a novelty, either in the combination or as a separate part, this second ground fails. For temporary stocks, or movable stocks have long been used in grinders for sharpening clothing shears — if both they and permanent ones have not been in combination with other parts similar to those for grinding knives to split or shave leather.

The third and last claim of novelty in a part or in the combination, is the goose-neck pressing the knife to the stone. Because, according to the paper filed as an amendment, unless the combination consists of a permanent stock with the other parts, there is nothing else in the combination which is now claimed at this hearing, that is new or useful, unless it be the goose-neck and screw to hold against the back of the knife to keep it close to the grindstone.

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Now, in examining whether the original specification can be fairly construed to distinguish this stock in particular, or this goose-neck, as the new improvement of the plaintiff, when combined with the rest—that is, never having been before so combined substantially, the language used must be looked at liberally and favorably to the plaintiff.

It is apparent, from all the specifications and drawings, that both the stock and goose-neck, to press the knife against the stone, are enumerated and described as parts of the whole machine.

This, however, is not enough to relieve the case from its difficulties.

Here, after describing the whole machine with all its parts, which is well enough done in most respects, he should have distinguished the stock or the goose-neck as the new [* 26] parts he * had invented; or if neither, he should have stated the combination of one or both to be new with the rest of the machinery, or if not so, that some other combination in the machine, or the whole of it, was what he claimed as his improvement, 2 Marshall Com. Pl. 212. Thus the whole machinery and apparatus were claimed as new in *Wyeth v. Stone*, 1 Story, R. 273—9. But, instead of any of these being done here, he seems to distinguish and particularize with clearness nothing as novel in the machine, except, as first mentioned, the combination of the two motions.

Nor are these distinctions useless or arbitrary, or of recent requirement in our Patent Laws.

A party may claim to have discovered some new part of a machine which is useful, or some new combination, or in other words, new arrangement of old parts, which is useful. Either is patentable.

But they are not to be described in the same way; and whichever is his particular improvement must be plainly stated;

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because the public, when making or using similar machines, have a right to know, first, what he claims to have patented and invented as new — whether new parts or new combinations only; and if new parts, what new ones? and if new combinations, of what old parts? See cases cited in *Davoll v. Brown*, 1 Wood. & Min. 53. So the persons whom a patentee prosecutes have a right to know clearly what they are to defend against; a claim of new parts or of new combinations? and if of either, the specific parts which are set up as new, or which are set up as brought into a new combination. 1 Story, R. 286; Webster on Patents, 86, note; *Macfarlane v. Price*, 1 Starkie, 199; *Rex v. Cutler*, Ibid. 354.

So the act of Congress requires this. What is claimed as new or an improvement is to be set out substantially, in order that the Commissioner of Patents may judge if it be * new, so as to issue a patent, and Courts may [* 27] see whether it is new in the trials contesting it. *Lowell v. Lewis*, 1 Mason, 189.

It is necessary to be done, also, to see if he claims any thing before known or not; or, in other words, too much. On these points see also, 1 Starkie, N. P. 199; *Evans v. Eaton*, 3 Wheaton, 351; Phil. on Pat. 268 and 270, — cases cited therein; 3 Bro. & B. 5; 2 Hen. Bl. 489, 464; 3 Car. and Paine, 611; 1 Sumner, 485; 2 Starkie, N. P. 249.

Hence, saying that the patentee has made an improvement in certain machinery without distinguishing what it is, or what part is new, has been adjudged to be bad. *Barrett v. Hall*, Mason, C. C. R. 447; 1 Starkie, N. P. 149; Phil. on Pat. 398.

Or saying he has made an improvement in a machine, and describing the machine, but not distinguishing the novelty or new improvement from the rest, is equally bad. *Davies on Patents*, 361; 2 Marsh. 211.

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Also, it must not only be distinguished, but so distinguished as to be intelligible, unambiguous, accurate. 3 Car. & Payne, 611.

Beside the good reasons in favor of this, there are the positive requisitions by Congress.

By the Act of July 4th, 1838, the patentee "shall particularly specify and point out" what he claims "as his own invention or discovery." See also, *Bovill v. Moore*, 2 Marsh. Com. Pl. 211; 1 Story, 270-3; 2 Mason, C. C. 112.

See sec. 5, "Specifying what the patentee claims as his invention or discovery."

See sec. 6. "In case of any machine he shall fully explain the principle and the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions." 5 Statutes at Large, 119.

[* 28] *I would not, however, be so strict on this as was once the practice. See *Phil. on Pat.* 398. I would be as indulgent to patentees in describing their claims as is consistent with the rights of the public and of other inventors, and the imperative requirements by Congress. To obtain clearness and exactness I would not confine them to technical language; but rather encourage what is in popular use, and better understood by all. 4 East, 135.

Nor in most cases are they to be restricted to any particular part of their specification, but resort for light to all portions of it and of the drawings. See *Davoll v. Brown*. Yet still the claim to novelty must, not merely for the reasons before stated, and the Act of Congress before cited, but by all on this subject from the foundation of the government, be clearly described somewhere in the specification. Thus, by the Act of 1790, sec. 182, it must clearly, "truly" and "fully" be set out. By the Act of 1793, sec. 3, it must be described in "full, clear, and exact terms," so as to distinguish from

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what was before known. In short, the bargain by government is to give the inventor an exclusive use for fourteen years, if he will place on record and distinguish clearly and truly what his novelty or improvement is, so that the public can easily understand it and benefit by it after the fourteen years, if not before. Webster on Patents, 86; 11 East, 105; 3 Merivale, 161.

Hence, of course, the claim must be made to something as new, in such plain terms that it can be readily understood, and with "reasonable certainty," (1 Story, R. 286,) what it is. The fewer technical terms are used the better, if the subject is intelligible without them. But as specifications are legal instruments no less than descriptions of mechanical and philosophical, and sometimes chemical improvements, it is desirable that they should always, before filed, be examined by some experienced lawyer as well as by some machinist or other expert, fully acquainted with *its sub- [* 29] ject-matter. Infinite expense and trouble would be yearly-saved by this. The advice of legal counsel is as useful in the preparation of such an instrument as in preparing a difficult deed or will.

In the present case, for instance, how easy and clear it would have been, to say in the specification what the inventor wished, and to say it so as to be at once intelligible to all.

If originally he claimed no part as new, to say so; and to add, that all these old parts so combined and arranged, in order to give a bevel edge to the knives, was the sole novelty in his claim. And if, in that combination, the stock to be used was meant to be a permanent one, and that was deemed important, to say so.

Again, if he meant to claim some part as new, as well as a new combination, and he deemed it proper to unite both in one patent, how easy it would have been to have identified

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the part as new, which he claimed, as well as described the new combination. So, if he meant to claim as a new invention some part alone, independent of any new combination, it would and should have been so described, separately, as a new part.

But now, unfortunately, all is doubtful on the face of the patent as to what he claims to be new, unless it be the combination of the two motions. It is not doubtful what the machine is in which he intends to patent "an improvement," as before remarked, except, perhaps, in one important particular, as to the stock, of its being permanent or not.

But, putting the construction on that most favorable to him, the doubt remains from his description of the machine, what was the particular improvement in it which he claims to have invented? what does the machine perform, that he supposed was novel? or by what improved arrangement, except the two motions combined together.

[* 30] * It was not new for it to give a bevel edge to instruments, as that had been given before. Nor does he claim this as the novelty in his operations. But he rather claims a novelty in the mode of doing it. At first he seemed to claim that novelty in the mode to be by combining the traverse and rotary motions. Next, it seemed, from other portions of the specification, to be by attaching the knives to a flange by a screw; then it was said to be by using a permanent stock for the flange and knife; and lastly, by the goose-neck and screw, to secure the knife when grinding, to the grindstone. All these occurred to others, on reading the patent, if they were not all suggested on his part. This uncertainty and obscurity as to which was meant, or which is, in fact, described as the novelty, except the two motions, are an insuperable difficulty, as the letters now stand, and cannot be overcome except by a new specification.

They are objections, not merely on conjectural data. The

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latter stand out in bold relief on the face of the specification, and the objections cannot be removed but by the use of new language. It is now said, that in point of fact he did not mean to claim the two motions, or the attachment by a screw, or movable stock, as novel; but rather a permanent stock, and the apparatus to crowd the knife, while grinding close to the stone. He seems yet to hesitate between these two last. But if he meant to describe these two, or either of them, as the novelties, in his original specification, he was very unlucky in the terms selected, since the other matters, rather than these, were, at the first hearing of the case, supposed to constitute what was new in his apprehension. They still, on the face of the specification, seem most prominent.

Whether these parts now insisted on, the stock or the gooseneck, are, in truth, new or not, either in themselves or in combination, is a question not before us at this time; but only whether they are plainly distinguished in the specification *as the particular improvement which he [* 31] claims to have invented? On that, it is enough to say, that by the language he has there used, neither of them seem to be so described at all; much less described with reasonable certainty.

The machine itself, as a whole, is described with sufficient clearness and certainty, as the counsel justly argue, unless it be whether the stock is permanent or movable. But that is not the difficulty. It is the want of a description, whether his improvement is meant to be as consisting in the combination of the whole, or of all the parts, or only of one or two of them; and if the last, which? And, also, whether it consists in such new combination of some of the parts; or of an invention, also, of some, and if so, which? This is the fatal uncertainty, and extends to every thing claimed as new; except, also, the two motions, and the combination of them is admitted to be not original.

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Several cases have been cited and urged on us parallel to this, where the patent or principle contended for by the plaintiff, has been sustained. But, in all, the description was different, or the validity of the claim was overruled; and in the present case the description fails to meet either of the two strongest cases cited in Story's Reports, or those in Mason, Wheaton, and Marshall, which have not been cited, but which bear strongly on this case. I have made a thorough analysis of all of them, but it is not necessary to repeat it, as the principles involved in them are embodied into the remarks already submitted by me.

I regret the delay and expense which an amendment of his specification will cause to the patentee; but am better satisfied in coming to the conclusions that it is necessary, (forced on us by considerations of settled law, and safety to the public as well as individuals,) by the reflection that the patentee, if he has made a new and useful invention, is still [* 32] * able to reap the benefits of it. He will effect this by describing, in a new specification, what he claims as new, with greater certainty, accuracy, and clearness, so as to comply nearer with the act of Congress, and to give to the community the particular information, to which they are, by law, entitled, concerning what he claims to be new. Care, of course, will be taken, also, to disclaim all he does not consider as new, in his combination, or new in the parts used. *Bovill v. Moore*, 2 Marsh. Com. P. 212; *Prouty v. Ruggles*, 16 Peters, 336.

The motion to set aside the nonsuit cannot be granted.

After this decision was announced, the bill in Chancery, which was pending between the same parties for an injunction against the use of this grinding machine, by the defendant, was directed to be dismissed. See a report of the original case at the last term. 1 Wood. & Min. 290.

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The complainant moved that no cost be allowed to the respondent, except in the present action at law, on the nonsuit. This motion was argued at the May term, 1847, by the same counsel on both sides, and the opinion was pronounced by

WOODBURY, J. It is, doubtless, a sound principle in Chancery, to exercise some wider discretion over the allowance of cost, than is done in a Court of Law. See *Hunter v. Marlborough*, at the last term, and *Burnham v. Rangley*, 2 Wood. & Min. 417; *Hullack on Cost*, 625, 626; 2 Ath. 111, 400, 552.

But still the general rule is there, as at law, to give costs to the prevailing party. See cases cited in those above, and *Barker v. Birch*, 1 Dowl. & L. 816; and 7 Scott, 397; 4 Beavan, R. 350. What prevails by law — what is legal is presumed to be moral, and conscientious, and equitable, * till the contrary is shown. *Vancouver v.* [* 33] *Bliss*, 11 Ves. Jr. 462. This rule is applied, likewise, to bills for injunctions, as well as to other proceedings. 3 Mylne & Craig, 738. But, if peculiar circumstances of an equitable character exist in favor of the defendant receiving no cost in the case, or none for particular items, it is deemed justifiable to withhold them. See *ante*. But the burden to show these peculiar circumstances is on the complainant. 2 Ves. Jr. 463. See cases before cited. And Lord Eldon regretted that the rule in Chancery had ever been different from that at law. See cases in *Hunter v. Marlborough*, 2 Wood. & Min. 168.

I am not disposed to depart from what has been long established on this subject; but shall not be inclined to make exceptions to the general rule which prevails both in equity and law, beyond what is sustained by sound principles and established precedents. None have been referred to, withholding

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costs from the prevailing party, under circumstances like these, while several cases seem opposed to it.

Thus, it has been held, where a party had obtained an injunction, and it was dissolved, that costs of affidavits, taken and used for the respondent, should be allowed, though he might have succeeded without them, on a demurrer. He had a right to pursue either course. *Bamearly Canal Corp. v. Timbly*, 13 Law Journal, N. S. 34.

On the contrary, where a long defence was resorted to against a bill in Chancery, and failed, though the bill was dismissed on other grounds, costs to the respondent were disallowed, (*Saunders v. Benson*, 4 Beavan, 350,) because he had not succeeded in what they related to. So, if the will was not for any wrong of the defendant, but to settle what the title of the plaintiff was, and a decree was for the plaintiff, he had no costs against the defendant. In *Robinson v.*

Cropsey, 2 Edw. Ch. R. 143; 2 Chip. Eq. D. [* 34] * 933-4. Again, where items exist in the bill of cost, which are vexatious or unnecessary, they can be excluded if distinguishable from others which were proper. 1 Beavan, 130; 4 Beavan, 25.

Bringing the present case to these tests, nothing is found in the general character of the cause which raises any peculiar claim from exemption from the usual rule of allowing costs to the prevailing party.

The fact, that the bill for an injunction failed, on account of a defective specification, which thus made the title to the patent bad, by an express act of Congress, was not a failure for any fault of the defendant; nor was it from the want of form in the bill or pleadings, which could be cured by the statutes of jeofail, or an amendment; and hence, not be visited by large costs, charged to the plaintiff. But it was a defect in the patent or deed itself, of the plaintiff — an imperfection in his title. It was not curable by any amendment

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within the power of this Court. And, by the Patent Law itself, when amended at the Patent Office, as it may be under the 13th section of that law, if happening "by inadvertence, accident, or mistake;" yet it is only then, and it is done at the loss of all the previous term of the patent, and of all actions pending, and, of course, of the cost incident to them; being valid only in respect to "cases subsequently accruing." See 13th section of Act of July 4th, 1846; 5 Statutes at Large, 122.

It has been further argued, that the merits of this case are with the plaintiff, and hence he should not pay costs.

But how the real merits between these parties as to originality of the invention, are, the Court cannot anticipate till they are tried. The originality is claimed on the one side, and denied by the other; and both the action at law and bill in Chancery have been disposed of without a decision on that point.

* Had that point been settled in favor of the [* 35] plaintiff, and the cases failed merely on technical grounds, in prosecuting the action, whether of form or substance, it might be proper in the bill in equity to allow no cost to the respondent. *Wray v. Barwis*, 1 Peake's Cases, 69.

But that has not been settled in the bill in Chancery, and the error in the reasoning of the plaintiff, consists, chiefly, in supposing it has been settled in his favor. That having ended in a postponement of any injunction, till the validity or originality of the patent — they being denied — should be tried at law. On the only trial at law, before going into the question of originality, the letters-patent of the plaintiff were adjudged to be bad under the Act of Congress, for want of certainty in the particular part, or combination, claimed to be original, and the plaintiff became nonsuit.

Consequently, though in the hearing for an injunction some

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evidence was offered by the plaintiff to prove priority in making his machine before the defendant made his — and some knowledge of its qualities, by a workman afterwards employed by the respondent, and some apparent resemblance between them, even in defects or mistakes; and thus a strong presumptive case was made out by the plaintiff, as to originality; yet the respondent denied the originality of it, under oath, and put in several affidavits, and some models, to prove an earlier existence and general use of similar grinding machines.

But whether this satisfactorily overcame the plaintiff's evidence, I did not decide. On the contrary, I expressly forbore to do it for the various reasons there stated, and continued the bill in Chancery till that issue, as to originality, could be tried and settled by a jury.

Another argument is now urged against costs to the respondent, on the ground that the letter and deposition of Wilder were used to mislead, and did mislead, about the old machines and knives, in the hearing as to an injunction.

[* 36]. * It will be seen, however, that nothing decided in that hearing, or in the trial at law, could be affected by that letter and deposition, whatever was the intent in using them. But on examining them with care, is it at all certain that the ground blade, referred to by Wilder, was likely or designed to mislead; and was not a new one sent with the old machine and old knives, in order that they might be compared together? And it is clear, that "the care-worn and gray witness," to which Wilder poetically refers in his letter, was the old "machine," and not this blade. It is called "machine" — *totidem verbis*.

It is difficult, then, to find any peculiar reason in the case, as yet appearing, or yet ascertained, which renders it inequitable to follow the general rule of allowing costs, as before

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explained, to the prevailing party. A different state of facts may be settled hereafter, and results reached, which may change the equities as well as law, between these parties ; but until that time arrives we must be governed by the situation of things as they now stand. I came to a like conclusion, in *Hunter v. Marlborough*, and think the exceptions to the general rule should be very few, and rest on very strong grounds. But, although nothing is yet found, by the Court or jury, to justify me in refusing cost to the respondent, as inequitable in the bill for an injunction ; yet I feel compelled to say, that several matters were proved against him in that hearing, which made an impression on my mind less favorable to his claims in equity, than to those of the plaintiff.

And though I formed no decisive opinion, whether other persons than these parties might not have invented and used like machines earlier than either of them, and thought that I should not, for the reasons then given, form a decisive opinion till a trial at law ; yet the course of the defendant was not, in some respects, such towards the plaintiff and his machine, * as to entitle him to any more costs than [* 37] are clearly proper under all the facts and circumstances, belonging to both cases.

Hence, being obliged to travel and attend here, in the action at law, I deem it just he should not tax travel and attendance, also, in the bill for an injunction, at the same terms, between the same parties. But all the depositions taken and used in the latter case, which were pertinent, and the usual counsel fee, seem to be proper charges, necessary to his defence, and, therefore, are allowed.

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JAMES WOOD, PLAINTIFF IN ERROR, v. WILLIAM A. UNDERHILL AND ASCHEL H. GEROW, DEFENDANTS.

[5 Howard, 1. January T. 1847.]

In order to obtain a patent, the specification must be in such full, clear, and exact terms as to enable any one skilled in the art to which it appertains, to compound and use the invention, without making any experiments of his own.

If the patent be for a new composition of matter, and no relative proportions of the ingredients are given, or they are stated so ambiguously and vaguely that no one could use the invention without first ascertaining, by experiment, the exact proportion required to produce the result, it would be the duty of the Court to declare the patent void.

But the sufficiency of the description in patents for machines, or for a new composition of matter, where any of the ingredients do not always possess exactly the same properties in the same degree, is, generally, a question of fact to be determined by the jury.

Where a patent was obtained for a new improvement in the mode of making brick, tile, and other clay ware, and the process described in the specification was, to mix pulverized anthracite coal with the clay before moulding it, in the proportion of three fourths of a bushel of coal-dust to one thousand brick, some clay requiring one eighth more, and some not exceeding half a bushel, this degree of vagueness and uncertainty was not sufficient to justify the Court below in declaring the patent void.

The Court should have left it to the jury to say, from the evidence of persons skilled in the art, whether the description was clear and exact enough to enable such persons to compound and use the invention.

This case was brought up, by writ of error, from the Circuit Court of the United States for the Southern District of New York.

It appeared that, in the year 1836, Wood took out amended letters-patent for "a new and useful improvement in the mode of making brick, tile, and other clay ware," and filed the following specification of his invention: —

"Be it known that I, the said James Wood, have invented

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a new and useful improvement in the art of manufacturing bricks and tiles. The process is as follows: Take of common anthracite coal, * unburnt, such quantity [* 2] as will best suit the kind of clay to be made into brick or tile, and mix the same, when well pulverized, with the clay before [it] is moulded; that clay which requires the most burning will require the greatest proportion of coal-dust; the exact proportion, therefore, cannot be specified; but, in general, three fourths of a bushel of coal-dust to one thousand brick will be correct. Some clay may require one eighth more, and some not exceeding a half-bushel. The benefits resulting from this composition are the saving of fuel, and the more general diffusion of heat through the kiln, by which the whole contents are more equally burned. If the heat is raised too high, the brick will swell, and be injured in their form. If the heat is too moderate, the coal-dust will be consumed before the desired effect is produced. Extremes are therefore to be avoided. I claim as my invention the using of fine anthracite coal, or coal-dust, with clay, for the purpose of making brick and tile as aforesaid, and for that only claim letters-patent from the United States.

JAMES WOOD."

Dated 9th November, 1836.

In July, 1842, he brought a suit against the defendants in error, for a violation of this patent.

And at the trial the defendant objected to the sufficiency of the specification, "because no certain proportion for the mixture is pointed out, but only that such quantity of coal must be taken as will best suit the kind of clay to be made into brick or tile; but that clay which requires most burning will require the greatest quantity of coal-dust; the exact proportion cannot, therefore, be specified; but, in general, three fourths of a bushel of coal-dust to one thousand brick will be

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correct. Some clay may require one eighth more, and some not exceeding half a bushel; so that there is no fixed rule by which the manufacturer can make the mixture, but that must be ascertained by experiments upon the clay; and the claiming clause in the specification is only for the abstract general principle of mixing anthracite coal-dust with clay, for the purpose of making brick, without any practical rule as to the proportions, which is too vague and uncertain to sustain a patent;" which objection was sustained by the Court. The plaintiff excepted. And the verdict and judgment being against him, the case was brought up here upon this exception.

The cause was argued by *Silliman*, for the plaintiff in error, and *Rowley*, for the defendants.

Silliman, for the plaintiff in error, made the following points:

The plaintiff insists, —

1. That he has in his specification given a general [* 3] rule by which * every kind of clay may be much better burned than by any previous process. And that the general proportions specified are, with some exceptions, the very best that can be used.

That a patent may properly be granted for a *beneficial general rule*, although there might be some exceptions to it not provided for.

2. That if it is necessary to entitle the plaintiff to a patent for a most beneficial invention for burning clay of the qualities usually found, that he should also discover the means of burning, to best advantage, clays of qualities not usually found; that his patent should not therefore be deemed void on its face, but he should be permitted to prove, by persons conversant with the business, that they could instantly determine, on inspection of clays of uncommon qualities, whether they

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required more or less than the usual burning, and how much more or less, so as to regulate the variation of proportions in such manner as to burn to the best advantage.

3. The plaintiff should have been permitted to show, under his specification by *experts*, that any kind of clay of which bricks can be made, however varied the qualities, can be better burnt under his general rule than by any previous process; and if such is the fact, the plaintiff should be entitled to a patent for the discovery, if he had given the general rule only, and had taken no notice of those exceptions, in which some uncommon kinds of clay can be best burned with a greater or less proportion of coal than that specified in the general rule.

4. The judge in his decision adopts all the errors of the defendants' objection, which states that there is no fixed rule by which the manufacturer can make the mixture, but that must be ascertained by experiments upon the clay. Suppose this to be so, and that the inventor has only furnished a guide by which such experiments can be successfully made, and that the subject, on account of the variable qualities of the materials, does not admit of greater certainty, and that by the simplest and cheapest experiments the manufacturer, in consequence of the plaintiff's invention, will be able to burn his bricks much better in less than half the time, and at less than half the cost of burning, by any other process, is not the inventor entitled to a patent for an invention practically so useful?

The fact that not a single brick has for some years past been burned, except according to the plaintiff's specification, is pretty good evidence that the manufacturers have been able to discover something from plaintiff's specification.

5. The objection, as adopted by the Court, declares that the claiming clause in the specification is only for the abstract general principle of mixing anthracite coal-dust with clay, for

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the purpose of making bricks and tiles, without any practical rule as to the proportions, which is too vague and uncertain to sustain a patent. Suppose this objection true in [* 4] point of fact, and that no information had * been intentionally suppressed, and that the qualities of clay varied so much that the proportions most useful could only be ascertained by an experiment on each bed of clay, it might, nevertheless, be a very useful invention, for which the inventor should be, in some measure, compensated by a patent. But this part of the objection is not true in fact, for the claiming clause is of the invention of using fine anthracite coal, or coal-dust, with clay for the purpose of making brick and tile "as aforesaid." These words, "as aforesaid," refer to the general rule of three fourths of a bushel of coal for a thousand bricks, with the exceptions or variations previously expressed.

6. The judgment should be reversed, with costs, including the costs in the Circuit Court.

Rowley, for the defendant in error.

The patentee's specification is uncertain and insufficient. It furnishes no rule for making bricks, without the manufacturer's first making a series of experiments. The most it does is to prescribe in about what manner the trials are to be conducted; which is not enough to sustain his patent. *The King v. Arkwright*, Dav. Pat. Cases, 106 (per Buller, J.); *Turner v. Winter*, 1 Term R. 606 (per Ashurst, J.); *Boulton v. Bull*, 2 H. Bl. 484 (Buller, J.); *Harmer v. Playne*, 11 East, 101 (Lord Ellenborough); *The King v. Wheeler*, 2 Barn. & Ald. 345 (Abbott, Ch. J.); *Godson on Patents*, 85; *Lowell v. Lewis*, 1 Mason's R. 182 (Story J.); *Langdon v. De Groot*, 1 Paine's R. 203; *Phillips on Patents*, 283, 267, 268, 283, 284, 289.

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Mr. Chief Justice TANEY delivered the opinion of the Court.

The question presented in this case is a narrow one, and may be disposed of in a few words.

The plaintiff claims that he has invented a new and useful improvement in the art of manufacturing bricks and tiles ; and states his invention to consist in using fine anthracite coal, or coal-dust, with clay, for the purpose of making brick or tile ; and for that only he claims a patent. And the only question presented by the record is, whether his description of the relative proportions of coal-dust and clay, as given in his specification, is upon the face of it too vague and uncertain to support a patent.

The degree of certainty which the law requires is set forth in the Act of Congress. The specification must be in such full, clear, and exact terms as to enable any one skilled in the art to which it appertains to compound and use the invention ; that is to say, to compound and use it without making any experiments of his own. In patents for machines the sufficiency of the description must, in general, be a question of fact to be determined by the jury. And this must also be the case in compositions of matter, where any of * the ingredients mentioned in the specification do [* 5] not always possess exactly the same properties in the same degree.

But when the specification of a new composition of matter gives only the names of the substances which are to be mixed together, without stating any relative proportion, undoubtedly it would be the duty of the Court to declare the patent to be void. And the same rule would prevail where it was apparent that the proportions were stated ambiguously and vaguely. For in such cases it would be evident, on the face of the specification, that no one could use the invention without first ascertaining by experiment the exact proportion of the different ingredients required to produce the result in-

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tended to be obtained. And if the specification before us was liable to either of these objections the patent would be void, and the instruction given by the Circuit Court undoubtedly right.

But we do not think this degree of vagueness and uncertainty exists. The patentee gives a certain proportion as a general rule; that is three fourths of a bushel of coal-dust to one thousand bricks. It is true he also states that clay which requires the most burning will require the greatest proportion of coal-dust; and that some clay may require one eighth more than the proportions given, and some not more than half a bushel instead of three fourths. The two last mentioned proportions may, however, be justly considered as exceptions to the rule he has stated; and as applicable to those cases only where the clay has some peculiarity, and differs in quality from that ordinarily employed in making bricks. Indeed, in most compositions of matter, some small difference in the proportions must occasionally be required, since the ingredients proposed to be compounded must sometimes be in some degree superior or inferior to those most commonly used. In this case, however, the general rule is given with entire exactness in its terms; and the notice of the variations, mentioned in the specification, would seem to be designed to guard the brick-maker against mistakes, into which he might fall if his clay was more or less hard to burn than the kind ordinarily employed in the manufacture.

It may be, indeed, that the qualities of clay generally differ so widely that the specification of the proportions stated in this case is of no value; and that the improvement cannot be used with advantage in any case, or with any clay, without first ascertaining by experiment the proportion to be employed. If that be the case, then the invention is not patentable. Because, by the terms of the act of Congress, the inventor is not entitled to a patent unless his description is so

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full, clear, and exact as to enable any one skilled in the art to compound and use it. And if, from the nature and character of the ingredients to be used, they are not susceptible of such exact description, the inventor is not entitled to a patent. But this does not appear to be the case on the face of this specification. And whether the fact is so or not is a question to be decided *by a jury, upon the [* 6] evidence of persons skilled in the art to which the patent appertains. The Circuit Court therefore erred in instructing the jury that the specification was too vague and uncertain to support the patent, and its judgment must be reversed.

Order.

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Southern District of New York, and was argued by counsel. On consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby reversed with costs; and that this cause be, and the same is hereby remanded to the said Circuit Court, with directions to award a *venire facias de novo*.

STIMPSON v. THE RAILROADS.¹

[1 Wallace, 164. April T. 1847.]

Damages — New Trial — Force of Verdict.

A jury cannot allow the plaintiff in a patent case, as part of his actual damages, any expenditure for counsel fees or other charges, even though necessarily incurred to vindicate the rights given him by his patent, and though not taxable costs.

Where, however, a jury did make such allowance under a direction from the

¹ See as to counsel fees *Boston Manufacturing Co. v. Fiske et al. ante*, Vol. I 320; *Allen v. Blunt et al. ante*, 530.

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Court, conceded afterwards to be erroneous, their verdict was sustained by way of an exception; the misdirection of the Court not having been assigned as a reason for a new trial, the expenditures having been proved to be paid, and the verdict having attained, though improperly, the same result nearly, that the Court, in its power to treble the damages, might have reached in a regular way.

STIMPSON brought sixteen suits against different railroad companies or proprietors for infringing his patent for railroad curves. The validity of his patent having been settled by a previous decision, the only question in these cases was *the amount of damages*; which it was agreed should be assessed in all the cases by the same jury.

As part of the evidence of damages, the Court, upon the authority of a decision of Judge Story,¹ and with considerable reluctance, allowed the plaintiff to prove the value of the time he had given, with the amount of the counsel fees and other expenses, not taxable costs, which he had necessarily paid in the prosecution of these sixteen suits: and in charging the jury, directed them, in the language of Judge Story, that "they were at liberty, if they saw fit, to allow the plaintiff as part of his actual damages any expenditures for [* 165] counsel fees or other charges which * were necessarily incurred to vindicate the rights derived under his patent, and are not taxable in the bill of costs."

The verdicts which were for the plaintiff, showed by their amounts that all these expenses had been assessed by the jury as damages.

After the verdicts, the defendants, on the one hand, moved for a new trial because the damages were excessive, though not because of the direction of the Court on the subject of damages. The plaintiff, on the other hand, moved to treble these damages as already found.

¹ *Boston Manufacturing Co. v. Fiske*, 2 Mason, 119, *ante*, Vol. I. 320.

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In connection with the last motion it is requisite to state that by an act of Congress¹ now repealed, it was enacted that any person infringing a patent "shall forfeit and pay, &c., a sum equal to the actual damages sustained by the patentee," and by a subsequent act² still in force, that where the verdict is for the plaintiff, "it shall be in the power of the Court to render judgment for any sum above the amount found by such verdict as the *actual damages* sustained by the plaintiff, not exceeding three times the amount thereof, according to the circumstances of the case, with costs."

After full argument by *W. L. Hirst* and *White* for the plaintiff, and *Clarkson* and *Saunders Lewis* on the other side, both motions were now disposed of as follows by

GRIER, J. I do not think that excessive damages, the reason urged for a new trial in these cases, is sufficient to justify the Court in granting the motion, it being conceded * that the verdict was in accordance with the di- [*166] rections of the Court. As the law formerly stood, where the Court without any exercise of their discretion were compelled to treble the damages, cases might occur in which a court would feel it to be their duty to set aside a verdict because the damages were excessive. And even then, they would require a case which appealed strongly to their sense of justice, before they would disregard the opinion of twelve men on matters of fact which it was their peculiar province to decide. Since the Act of 4th July, 1836, the Court are not compelled to treble the actual damages assessed by the jury, but may increase them or not at their discretion within that limit. In the exercise of that discretion the Court will

¹ Act of April 17, 1800; c. 25, § 3. Appendix.

² Act of July 4, 1836; c. 357, § 14. Ibid.

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judge for themselves, and will not increase the damages, if in their opinion the jury have already exceeded the proper measure.

There was however a portion of our charge to the jury the correctness of which we doubted when we gave it, and which on more mature consideration we are ready to admit was erroneous. It was that which relates to the evidence of damages; where upon the authority of Mr. Justice Story, we directed the jury, not without an expression of some doubt as to the correctness of the law as so laid down, that "if they saw fit to allow the plaintiff as part of his actual damages, any expenditures for counsel fees or other charges, which are necessarily incurred to vindicate the rights derived under his patent and are not taxable in his bill of costs, they might say so."

If the counsel for the defendants had insisted on this error as a ground for a new trial in these numerous cases, [* 167] * we should have felt ourselves compelled to grant it. But as in the exercise of the discretion intrusted to us of increasing the damages, we may neutralise the effect of this error, we think the ends of justice may be attained, though somewhat irregularly, without putting the parties to the expense and trouble incident to so many new trials.

In thus disposing of both these motions, I will take occasion to state why I venture to differ from the very learned judge on whose authority alone I was induced to give my instruction on this point to the jury.

I do not think that the practice of courts of admiralty, which Judge Story would seem to have had a good deal in his mind, affords any proper precedent for courts which are governed by the common law. Courts of admiralty proceed according to the principles of the civil law; and costs are awarded at the discretion of the judge, and are paid by such parties and to such an extent as he may judge equitable and right according to the circumstances of each case. The rule

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of our law is different. There were no costs given at common law, but if the plaintiff did not prevail he was amerred *pro falso clamore*. If he did prevail then the defendant was *in misericordia* for his unjust detention of the plaintiff's right, and therefore was not punished with the *expensa litis* under that title. But it being thought exceeding hard that the plaintiff for the costs which he was out of pocket in obtaining his right, could not have any amends, the statute of Gloucester¹ was passed, * which gave [* 168] costs in all cases where the plaintiff recovered damages. This was the original of costs *de incremento*; for when the damages were found by the jury, the judges held themselves obliged to tax the moderate fees of counsel and attorneys that attended the cause.²

Under the provisions of this statute, every court of common law has established a system of costs which are allowed to the party who succeeds in a cause, by way of amends for his expense and trouble in prosecuting or defending his suit. It may be true no doubt, and is especially so in this country, (where the legislatures of the different States have so jealously reduced attorney's fee bills, and refused to allow the *honorarium* paid to counsel to be exacted from the losing party,) that the legal taxed costs are far below the real expenses incurred by the litigant. Yet it is all the law allows as *expensa litis*. If the jury may, "if they see fit," allow counsel fees and expenses as part of the actual damages incurred by the plaintiff, and then the Court add legal costs *de incremento*, the defendant may truly be said to be *in misericordia*, being at the mercy both of court and jury.

In courts governed by the civil law, if the Court may give costs and expenses according to their discretion to the plain-

¹ 6 Ed. 1 Ch. 1.

² See Bacon's Abridgement. Tit. Costs. (A.)

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tiff, they can also exercise the same discretion in favor of the defendant when he has been unjustly harrassed. If the jury can exercise this wide discretion of giving incremental costs to a plaintiff under the name of actual damages, why should they not be allowed to give them to the defendant when he succeeds? He has certainly as good a right to [* 169] them as the plaintiff, both in law and * equity.

On every principle of morals a plaintiff would be as liable to punishment *pro falso clamore*, as the defendant, for the unjust detention of the plaintiff's right. If this principle be introduced from the civil law, both parties should have the benefit of it. A defendant should not be left to contend with such odds against him. In actions of debt, covenant, assumpsit, &c., where the plaintiff always recovers his "*actual damages*," he can recover but legal costs as compensation for his expenditure in the suit, and as punishment to defendant for his unjust detention of the debt. His equity is no greater, nor his injury of a higher order, where his action is for a trespass or a tort. It is a moral offence of no higher nature to infringe a patent, than to detain a just debt. Why then shall the law give the plaintiff such an advantage over the defendant in the one case, and not in the other? There is certainly nothing in the act of Congress, or in the phrase "*actual damages*," which it uses, to countenance the doctrine. The term "*actual damages*," cannot be construed to mean exemplary, vindictive, or punitive damages inflicted by way of smart-money, or punishment of the defendant for fraudulent, malicious, or outrageous wrongs.

Before 1836, the law compelled the Court to treble the "*actual damages*" found by the jury. This was intended, no doubt, to punish the defendant, and thus indirectly remunerate the plaintiff for his extra expenditures in establishing his patent. This law was found to act unequally, for defendants were often found to have the prior invention and to have

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been unjustly harassed by the plaintiff, and yet they *recovered nothing but costs. Often where [* 170] the plaintiff recovered, the contention was a *bond fide* one, on the respective interests or titles of the parties: it was, therefore, obviously unjust in such a contest that the plaintiff should recover treble damages, if he succeeded, while the defendant could recover nothing. It was for this reason that the Act of 1836 submitted the question of trebling the damages to the discretion of the Court, and thus left the parties to contend on a more equal field. The defendant suffers the infliction^o of vindictive damages only when the Court are of opinion he has acted unreasonably or oppressively.

It is a well-settled doctrine of the common law, though somewhat disputed of late,¹ that a jury in actions of trespass or tort may inflict exemplary or vindictive damages upon a defendant, having in view the enormity of defendant's conduct rather than compensation to the plaintiff. Indeed in many actions such as slander, libel, seduction, &c., there is no measure of damages by which they can be given as compensation for an injury, but are inflicted wholly with a view to punish, and make an example of the defendants. But in no case is the degree of the defendant's delinquency measured by the expenses of the plaintiff in prosecuting the suit. The plaintiff, it is true, is thus indirectly compensated for his expenses, but it is not this measure of defendant's punishment, nor a necessary element in its infliction.

The doctrine for which we here contend is supported by the best authority. *Arcamble v. Wiseman*,² which Judge Story admits is in conflict with him, carried it so far as to apply it to cases of admiralty, and Judge [* 171]

¹ Law Reporter, vol. 10, p. 49.

² 8 Dallas, 306.

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Story's own decision was a complete reversal of a rule which he had himself previously established on the authority of that case. In a Massachusetts case,¹ more recent than any of these decisions, Chief Justice Shaw, after remarking upon the notion that had once prevailed on the subject, says:—"It is now *well settled* that even in an action of trespass or other action sounding in damages, the counsel fees and other expenses of prosecuting the suit not included in the taxed costs, cannot be taken into consideration in assessing damages." And in another² in New York, Chief Justice Neilson says:—"The charge as to expenses beyond taxable costs and counsel fees, in conducting the suit, as a particular item of damages to be taken into the account, I am also inclined to think was erroneous. These have been fixed by law, which is as applicable to cases sounding in damages as debt." He refers to the case in Massachusetts, and approves of it "on principle."

A case in Connecticut,³ I am aware, is an apparent authority for a contrary doctrine. But the main question discussed in the opinion of the Court, is whether a jury may give vindictive or exemplary damages in an action for a tort, against a defendant who has acted with gross negligence: and the proposition that the plaintiff's counsel fees and expenses should be assumed as the exact measure of the defendant's punishment, seems to have been founded on some custom or practice peculiar to the State of Connecticut, and not on any principle of the common law. The Court was not unanimous, and Mr. Justice Waite who dissented from [* 172] the majority, uses *some arguments on this point which I have not seen answered.

¹ Barnard v. Poor, 21 Pickering, 378-382.

² Lincoln v. The Saratoga R. R. Co. 23 Wendell, 425-435.

³ Levesly v. Bushnell, 15 Connecticut, 226.

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Convinced, therefore, that the doctrine I laid down to the jury on the trial of these cases, is not founded on the well-established principles of the common law, and that it would work inequality and injustice, I take this opportunity to retract it: and say that, hereafter, such evidence as was then given, will not be objected to, if permitted to go to the jury, nor will the Court instruct the jury, "that they are at liberty if *they see fit*, to allow the plaintiff as part of his actual damages, any expenditures for counsel fees, &c., incurred to vindicate his rights, and not taxable in the bill of costs." If such expenditures are proper elements of *actual* damages, the jury should have no discretion to omit them; if not, the jury should not be permitted to add them. It is a principle of too much importance to be submitted to their arbitrary discretion. In almost every instance where I have seen it done, they have assessed more than treble the amount of actual damages, while the Court have been called on to add to the injustice, by trebling them again. Patentees should be protected liberally by the law: but their wrongs should not be made subject for speculation and extortion.

Both rules dismissed.

WILLIAM WOODWORTH v. HIRAM CURTIS.

[2 Woodbury and Minot, 524. May T. 1847.]

Where A. owns the patent-right to a planing machine, and conveys to B. the authority to use one in a certain county, B. may erect as well as use that one; so he may use and build another instead of it, but not both at one time. When the term expires, that machine, then in use under the conveyance from A., may, without any new license or grant, be employed till it wears out or is destroyed, either by B. or his assigns, notwithstanding A. has obtained an extension and renewal of his patent-right.

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THIS was a bill in equity, praying for an injunction against the use, by the respondent, of the planing machine [* 525] * invented by William Woodworth. The plaintiff claimed to be possessed of Woodworth's rights, and also Emmons's under a like patent. The answer of the respondent admits the use of one of said machines in Boston, in the county of Suffolk, but insists on his authority to do it under a license from the proprietors of the patents for said machine.

Several assignments were given in evidence to sustain his authority, and several affidavits on both sides were filed, tending to prove that the present machine used by the defendant was not the first one that had been put in operation under the license, and that this and another had at times been run together, and that the respondent purchased this machine of Tothill after the first patents expired. The farther contents of these assignments and affidavits will be stated in the opinion of the Court, where they become material.

The case was argued by *B. R. Curtis*, for the complainant, and *Charles L. Woodbury*, for the respondent.

WOODBURY, J. It is conceded that Richard Urann, May 26, 1840, had become proprietor of the patent-right to use the Woodworth planing machine in the county of Suffolk. On that day he granted to Thomas H. Holland, under his hand and seal, as follows: "I do license and empower the said Thomas H. Holland and his assigns, to use one machine in Boston aforesaid, constructed according to the specification under either of said patents," &c., "during the continuance of the term for which the said letters-patent were respectively granted," &c.

On the 13th of March, 1846, Holland assigned his rights, under that conveyance or power to "William Tothill, his

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heirs and assigns forever ;” and Tothill, on the 8th day of August, 1846, assigned the same to the respondent, “Hiram Curtis, his heirs and assigns.”

It is not to be doubted, that the intention of the parties to * these instruments was to convey a right [* 526] to use one of these machines in Boston, during the continuance of the patents which were in being, May 26, 1840.

The first question is, did this involve the right to make or procure to be made, the machine thus permitted to be used ?

I think it did. Otherwise the whole license might be defeated, if the grantor refused to make for him at all, or to make at any but an exorbitant price, or demanded another consideration for a right in the grantee to make for himself, under a license like this, to use one machine.

From the nature of the transaction and the subject-matter, as well as the terms in the conveyance about the machine, being “constructed according to the specification under either of said patents,” it is probable both parties contemplated that the grantee should construct as well as use one.

In respect to some patents, the rights to make, vend, or use may be distinguishable from each other, yet they all are united in this patentee ; and he may so convey the right to make, as to involve or include the right either to sell or use what the grantee makes.

And he may so convey the right to use, as to imply the right to sell within the same limits, as well as to make machines within them. The circumstances, nature, and words of each grant must decide the construction, which is just and legal.

This point is not without difficulty ; but the cotemporaneous construction put on the grant, by the purchaser proceeding at once to make, or cause to be made, a machine to use under his grant, and he and his grantees continuing to use at

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least one so made, without complaint from either the grantor or owner of the patent, for several years and till the term expired, inclines the scales in favor of the respondent's view.

The next question is, did the grant include the use of a machine during the term, though changed or [* 527] amended, within * the time? The first one built might wear out, or, what was very likely, be destroyed by fire, or be constructed erroneously in some important respects, or be disused entirely for some time from want of repair. Could a different one be run in such events?

My opinion is, it could, as the license to use one machine covered the whole term, and was not limited to any particular machine then sold, but merely to what must be considered one machine in number at one time.

The next question is, whether this right to use could be assigned to a third person. I think the license must be considered assignable.

But much more is a machine, and the right to use it, personal property rather than a mere patent-right; and much more has it all the incidents of personal property, making it subject to pass by sale, as in this case, to Curtis.

Here, that Curtis bought the machine itself, is manifest from the affidavits of Tothill and Loring; and, beside this, the right to use it was conveyed also in the written assignment to him. The injunction, for these reasons, cannot be granted, as the sale extended the use not merely to the original grantee, as a personal privilege, and limited to him alone, but to him and his assigns; because the word "assigns" is expressly inserted in the instrument, and as the grantor was paid for the use during the whole term or continuance of the patent, and as the grantee might die or become insolvent, or wish to remove or change his business, it would be natural and useful to the grantee to stipulate for the right to assign the use, and this would be no injury to the grantor.

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The next inquiry is, did the respondent use more than one machine at any one time, so as to come within the scope of the prayer for this injunction?

It is certain that the conveyance would authorize the grantee and his assigns to use only one machine at any one time, in Boston or the county of Suffolk; and though the *evidence here is contradictory, some [* 528] of it showing an old machine to have been used at times after a new one was procured and put in operation, and some contradicting this; yet it is clear, from the proof on both sides, that the old machine was sold by the respondent long before the filing of this bill, and not used in Boston for three or four years past, and was removed to another town and county. It went away, Loring swears, before July, 1846, and Lord swears it was in the spring of 1844. It is not, then, such an old use of that in Boston which must be regarded as now complained of, but a use of the new machine, and the new one for the work done on it since Woodworth's original patents expired on the 29th of December, 1842.

The next question left is, whether a use like this, since the expiration of the old patent, conflicts with the rights of the plaintiff under the extension of the patent which has been granted to Woodworth's representatives by the board of commissioners, Nov. 16, 1842, for seven years longer; and whether it is or is not permissible, by the construction given to that extension by the Supreme Court, under the 18th section of the Patent Law of July 4, 1836. 5 Stat. at Large, p. 125.

The leading and controlling decision upon this question is that of *Wilson v. Rousseau*, in 4 How. 682.

The majority of the Court there held, that where a machine or right to use a machine, had been sold before the original terms expired, the use might be continued till the machines then in operation under the grant wore out, or were destroyed.

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The reason assigned for this was, the expression used in the 18th section, extending the benefit of the renewal to "assignees and grantees of the right to use the thing patented to the extent of their respective interests therein." 5 Stat. at Large, p. 125.

Some plausibility exists in the idea, that where [* 529] the right * to use a machine till the end of the then existing term, had been paid for, there was an implied understanding on both sides, that the use of it afterwards would be free and undisturbed; but the assignment being only for one term, and the plaintiff having obtained another term from the board, my own views differed in that case from the majority. I feel bound, however, to carry theirs into effect, to their full extent, as they are to be understood from the printed opinion of the Court, and the reasons applicable to the subject.

The respondent then having paid for the right to use one machine in Boston till the original term expired, and having a machine in operation, which existed and was in use under that right, both when the above renewal took place and the old term expired, he must, by the decision of the Supreme Court, be allowed to continue the use of the same machine, till it is worn out, unless a fact, which will soon be adverted to, alters or impairs that right.

The decision seems meant for and founded on a case where the grantee had a "right to use," in the broadest terms. No distinction is taken between the acquisition of that right by purchasing a particular machine, or by purchasing the right to use a machine while the term lasted, and under this creating one which continued to be in use when the original term expired.

I do not therefore feel warranted in weakening or impairing the force of their decision by a discrimination not made by the Supreme Court itself, and perhaps not required, by

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any very conclusive reasons. My opinion refers only to the first renewal, and has no regard to what is proper under the second renewal made by Congress.

But a fact just referred to requires me to consider one other question before closing.

When the term expired, December 27, 1842, this machine was owned and used by Holland and those employed under him, having, according to the testimony of Coolidge, been *framed and set up the summer pre- [* 530] vious; and his right to continue that use, it is argued, could not afterwards be further assigned as it was to Tothill in 1846, and the same year by him to the respondent.

The assignees and grantees of the right to use it, who are by the 18th section to have the benefit of the renewal, are doubtless those holding the right, at the time of the renewal.

But what is their right, then, obtained and confirmed by the opinion of the Supreme Court?

Not, as before remarked, in relation to the interest or license under the conveyance from Urann, in May, 1841; not a mere personal privilege. It is a right of property. The value of it is attached to the machine used, when it is the last one used at the time the term expires. The right might be assigned, separately as before; but under the decision of the Supreme Court the right could not be exercised after the term closes, except in the particular machine then in use.

In this respect it is unlike the right which exists before the term of the patent expires, having become fixed and limited to that machine alone.

It has become like a patented medicine bought by a patient. The right to use the particular quantity sold passes with the medicine itself.

There being then this property in that machine, when the term expires, like any other property, the machine and the right attached to it may pass by sale, devise, or levy of exe-

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cution, or assignment of an insolvent's effects. As to the last, see 3 Bos. & Pull. 565; 5 Barn. & Cres. 169; Phil. on Pat. 357; Hindm. on Pat. 242, 327; Sawin v. Guild, 1 Gall. 485.

In those cases in the 4 Howard, before cited, the patent-right had been considered property, and even deemed assets in the hands of the administrator, and the renewal had been in his name.

WILLIAM W. WOODWORTH ET AL., IN EQUITY, v. JAMES EDWARDS ET AL.

[3 Woodbury & Minot, 120. May T. 1847.]

The omission to make oath to a bill in chancery, praying for an injunction, is not here a cause of demurrer, after a hearing and order to file evidence.

But it should be objected to by motion when the respondents appear, and the oath will then be directed, unless good cause is shown to the contrary. There is no rule of the Court, requiring an oath here to be filed with the bill.

After a special demurrer to a bill, the allegations of fact must, on the hearing of the demurrer, be considered as true. When a special statute extends a patent for seven years, the original patent must be treated as in law for seven years longer. So must a patent be, which is extended seven years by the Board of the Patent Office. An original patent, extended in both of these ways, must be considered as a patent for twenty-eight years.

The specification for both extensions is the original specification. If all are surrendered and an amended one issued, the new letters should be for twenty-eight years. If the old specification had been adjudged good, but was still questioned and litigated, and appears to be in some degree inoperative from certain defects, supposed to have happened by mistake, the commissioner, on its surrender, may issue new letters for twenty-eight years, with an amended specification, and if he does, they will be presumed—till the contrary is shown—to be for the same invention, and for a defect rendering the old letters, in some degree, inoperative, and which happened from inadvertence or mistake.

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When a demurrer for these causes is overruled, the respondents may have leave to answer further by the payment of costs, and they may further contest a temporary injunction, though after an order to file testimony in it none was filed but merely a demurrer.

* But after such neglect of the order and the overruling of the demur- [* 121] rer as bad, the case will not be opened for further hearing as to the temporary injunction, but be treated as if the facts were confessed, unless an affidavit is filed that the course pursued was not for delay, and indemnity is also filed against any damage caused by the delay and the use of the machine against which an injunction is desired.

Where one respondent run a planing machine and two others owned it, the injunction was issued as proper against the three.

After the supposed inventor of a machine, in a contest with these plaintiffs in another circuit, had been enjoined not to use that machine, because an infringement on the plaintiffs', those purchasing it of the supposed inventor, so enjoined, cannot be allowed to use it while that injunction remains in full force and the grounds of that decision are in no way overturned.

But where the respondents deny the validity of the patent of the plaintiffs, the Court will dissolve the injunction at the next term, if the suit at law is not by that time brought against them to try that validity.

The terms imposed on the suit are, that the trial be confined to the objections set up by the respondents in their answer and affidavit against the validity of the patent, and that the action may be in the name of any one claiming an interest in this district, which is supposed to have been violated by the respondents.

THIS was a bill in chancery, praying for an injunction against the respondents for using a planing machine, the patent for which was alleged to be vested in the plaintiffs.

The allegations were as usual in this class of cases, several of which, in this circuit, have been before tried and reported, stating, among other things, the original invention to have been made and patented in December, 1828, by William Woodworth, since deceased — his rights to have become vested in the plaintiffs — an extension to have been granted of the original patent for seven years by the Board of Commissioners, in 1842 — another, for a like term, by Congress, in a special law in February, 1845 — and a surrender of them all made afterwards, on account of mistake in the specifica-

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tion — and new letters-patent issued for the whole twenty-eight years, on the 8th day of July, 1845.

The bill was filed 16th July, 1847, and a subpoena and notice given that day.

On the 23d July, 1847, a hearing was had before Judge Sprague, on a motion for a preliminary temporary [* 122] *injunction, and, after listening to both parties, an order was made by him that the plaintiffs, within twenty days, file their evidence in support of it, and the respondents file theirs within ten days. Before this last period expired, namely, 2d August, 1847 — the last day to file evidence by the respondents — instead of complying with the order, they filed a special demurrer to the whole bill, setting out the following causes :

1st. That no oath or testimony to the truth of the bill had been put on file with it.

2d. That the letters-patent, now relied on, of July, 1845, should have been issued for twenty-one years instead of twenty-eight years, and consequently were void.

The case, on this motion, came on for a hearing September 18th, 1847, at an adjourned session of the May Term, and was argued by

B. R. Curtis, for the complainants, and *J. T. Tasker*, for the respondents.

WOODBURY, J. We have requested the demurrer in this case to be argued first, as a demurrer may affect both a temporary and permanent injunction.

In the natural order of things, such an objection, by demurrer, which may turn out to be one of form merely, ought to be considered before the merits of the application.

In a prayer for an injunction and a demurrer filed, it has

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been adjudged that the demurrer should be first heard and disposed of. 6 Madd. 299; 1 Smith, Ch. 214.

The first ground assigned for this demurrer, is the want of an oath to the bill, or any evidence in its support. But this is a ground more properly to be taken at a hearing on the merits against proceeding further, till such oath or such evidence is put in. It is a matter *in pais* and affecting the trial of the facts rather than a defect in the bill itself.

* Of course, at the trial, or hearing, whether a [* 123] case is made out, or not, if the facts which the bill alleges are denied by the respondents, the plaintiffs must furnish evidence of them before succeeding. Generally they must do it by their oath to the truth of the bill, and always by other testimony, *prima facie* satisfactory, before the respondents are obliged to rebut it by evidence on their part.

But, sometimes this need not be done by the complainant where the respondents do not appear and are defaulted; or, after an appearance and order, do not comply with it, and the allegations in the bill are taken *pro confesso*; or, if after such an appearance the respondent virtually admits the truth of the facts, by demurring merely on account of the want of law in the bill.

The only precedent cited of a different character is that of *Lansing v. Pine*, 4 Paige, Ch. R. 639.

But that decision seems to be founded on the special rules of the New York Court of Chancery and its peculiar practice, requiring an oath to the truth of some bills to be filed with them, such as in that case, for discovery and other matters as to the contents of a writing, without any evidence accompanying the bill as to its loss. See the rule stated in 1 Barbour, Ch. Pr. 44.

Here no such rule exists as to bills of injunction or any others.

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The practice here is usually for the complainant to make oath to his bill when it is signed, but this is not imperative nor uniform.

It is not then done, if he is absent or indisposed, though it should be done probably before the hearing, unless it be a bill by a corporation, or unless an answer under oath is not asked, or unless an oath to the bill is waived, or its absence is not objected to by the respondents when first heard.

[* 124] * And if the principal is not in a situation to swear to it, the oath may be made by an agent. 1 Barbour, Ch. Pr. 41.

When this case was before my associate at a former hearing, and when the order was made as to filing other evidence, no exception was taken to the absence of an oath to the bill, and we both concur in the opinion that afterwards, if at all, a demurrer is not good for that cause in this Court.

The only remaining ground for a demurrer assigned in it, is, that the last letters-patent, set out in the bill as for twenty-eight years, should have been issued for only twenty-one.

Thus, after reciting the surrender and issue of new letters for twenty-eight years, the demurrer says: "whereas the defendants are advised that by law the said last mentioned letters-patent should have been granted for the term of twenty-one years from the said 27th day of December, 1828," &c.

This would seem to have been stated under an impression that the bill contained no averment of a second extension of the original patent for a second seven years; and hence that from the bill on its face, the renewal, in order to cover all the terms alleged in the bill, should have been for only twenty-one years instead of twenty-eight.

But, on examination, the second renewal for seven years appears to have been alleged in the bill, saying it was made by Congress by a special Act in February, 1845.

To be sure it is not inserted immediately following the

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avertment of the other renewal, and hence may have been overlooked by the respondents; but it is there.

The bill then, on its face, contains allegations of an old patent of fourteen years and two renewals of seven years each; and hence the last letters, to cover them all, are properly for twenty-eight years instead of twenty one.

* But in argument another position is taken, [*125] namely, that the renewal could not by law be made to cover the last extension of seven years by Congress, as that extension had not been evidenced by any letters-patent which might be surrendered.

But on turning to the eighteenth section of the Act of Congress of July 4, 1836, concerning patents, it will be found that when the board made the first extension of seven years, and it was certified on the original letters of fourteen years, it came within the enactment which existed in express terms, that "thereupon the said patent shall have the same effect in law as though it had been originally issued for twenty-one years." 5 Statutes at Large, 125.

And when the second extension was granted by Congress for seven years more, making, in all, twenty-eight, from December, 1828, the act, *proprio vigore*, merely extended the patent seven years longer than before. The original patent, in this way, had, in law, become one for twenty-eight years.

The act imposed, next, an obligation on the commissioner to give a certificate as to the last extension, if desired by the administrator of the patentee, but not without.

Next, the original patent had not only thus in law, *de jure*, as well as in common parlance, become one for twenty-eight years from December, 1828, instead of the original fourteen, or that and the next seven, but it had become a patent for twenty-eight years under one and the same original specification.

There was no other in existence.

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But the administrator became satisfied from repeated trials, and numerous exceptions taken to his specification, that it was in some respects defective; that this cast a shade over its validity, and rendered it less operative and successful and profitable than it would be if the defect was removed; [* 126] and, believing that this defect had arisen from inadvertence or mistake when the original specification was filed, he applied, as the law permits in such case, for leave to surrender his patent, as it then stood, and to receive instead of it one with an amended specification.

It is difficult to conceive, then, why, when this patent was afterwards surrendered under the thirteenth section of the Patent Law, and new letters were obtained with an amended specification, it should not be for the whole twenty-eight years, and should not be as valid for the whole twenty-eight as it would be for twenty-one years.

The demurrer seems to admit the renewal to be valid for the term of twenty-one years, but not for the twenty-eight years. But it being as valid for the latter as the former, the demurrer, with such an admission, cannot probably be sustained on this account.

There is another difficulty in sustaining this demurrer, on the ground now taken by counsel — that the old specification has been, by some Courts, pronounced valid and not defective or insufficient, and therefore that it must be considered to have been valid. But it is questionable whether the defendants can now be permitted to argue that the patent was good in form at first, after the allegations in the bill of its defective character, and which the demurrer virtually admits. “On the hearing of a demurrer the Courts are bound by the plaintiffs’ allegations of facts,” &c. *Cuthbert v. Creasy*, 6 Madd. 189; 1 Smith, Ch. 211; *Balls v. Strutt*, 1 Hare, 148.

But supposing these objections to go rather to what must be

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considered matters of law than fact alleged, how does the case, in this respect, stand?

The reasoning being that the renewal is not valid for even twenty-one years, on the ground that the first letters-patent and first specification had been upheld as good by *judicial decisions, the respondents, therefore, are [* 127] right in contending that those letters and specification could not be considered "inoperative or invalid," in the language of the thirteenth section, so as to justify the commissioners in issuing new letters with an amended specification. 5 Statutes at Large, 122.

But it would be a sufficient answer to this position, were it proper to be taken under the form of this demurrer, and after admitting the renewal to be good for twenty-one years, that the Supreme Court has, in the cases under this renewed patent for twenty-eight years, in 4 Howard, R. 646, proceeded on the ground that these identical renewed letters were valid. And though I have no recollection that this question in relation to these was discussed in those cases, yet the letters must necessarily have been considered good in order to authorize the judgments in their favor, which were then and there rendered on them. *Woodworth v. Stone et al.* and *Same v. Hall*, 1 Wood. & Min. 248, 389.

And though this would not preclude the Supreme Court from hearing their validity debated in another case upon this objection, yet it would be hardly decorous for a Circuit Court to decide differently on their validity, till the Supreme Court had reconsidered and changed what is involved in its former decisions. *Towne v. Smith*, 1 Wood. & Min. 115.

Nor would these be of much use to the respondents, if this Court, or the Supreme Court, should make a different decision. Because, if the renewal was not valid at all, neither could the surrender be valid, which led to it, assuming the

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ground of the respondents, that the old patent surrendered was, and had been pronounced by the judiciary to be good.

The old letters, and the extension under them, would be considered in full force, and goods also, if the surrender was by mistake, supposing new letters could be validly [* 128] * given instead of them, when they could not be, avoiding thus both the new letters and the surrender. All violators of the patent could be prosecuted under the old and valid patent, in the old form and with the old specification, as well as under the new letters and new specification.

If these were vacated, bills and writs could be amended and would declare on the old instead of the new letters, and this done with little or no terms, under such circumstances, not altering the merits but affecting merely forms. This was intimated in *Woodworth v. Stone*, and *Same v. Hall*, 1 Wood. & Min. 248, 389.

But the present respondents have not been satisfied on suggestions like these to abandon this objection, or to refrain from asking a decision by this Court on the force of it.

Hence to oblige them, I would state frankly, that my impressions are strongly in favor of the validity of the new letters, independent of what has been done on them in the Supreme Court. I think, by law, the original patent had become one for twenty-eight years instead of fourteen or twenty-one. I think the old specification applied to the patent for the whole term of twenty-eight years; that the surrender was of all for the twenty-eight years; the renewal for all; and that the right to renew by the Commissioner probably existed, although some Courts had decided in favor of the old patent.

Because their decision, if right, might still rest in some doubt, might not be acquiesced in generally, and without amendments in the specification, might be constantly open

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to a new and prolonged litigation, so as render the patent valueless, and, in many respects, "inoperative."

If the decision was wrong — as judicial opinions by State Courts and Circuit Courts, and even by Supreme Courts, sometimes are wrong — surely these amendments would be prudent and proper, in order to save the patent from becoming, ere long, entirely both "inoperative" and "invalid."

*The Act of Congress makes the commissioner [* 129] the judge in relation to the allowance of an amendment, on the ground that the patent is inoperative or invalid so as to justify it, and that the error, to be corrected in the specification, has happened from "inadvertency, accident, or mistake."

If he permits an amendment, after a hearing on these matters, it is at least *prima facie* proof that the state of things in these respects warranted it, as well as that the amended specification relates to the same patent. For he is not by law allowed to permit any other than the old patent to be described in the amendment, and he must be presumed to have done his duty in all these particulars, till the contrary is shown. *Allen v. Blunt*, 2 Wood. & Min. 121.

Nor is this a great or dangerous power to be intrusted to that officer; but a salutary, remedial authority, necessary often to insure justice to useful inventors, and protect the sacred rights of genius and property. But whenever there is any just ground to suppose this power has been fraudulently or corruptly abused, the door is open to prove it, and visit its consequences on the guilty, not only by avoiding the renewal, but by inflicting condign punishment for the guilt.

Viewing this objection as imputing neglect or error to a public officer, rather than the plaintiffs, it is to be considered, also, with favorable inclinations not to let individuals suffer, except in clear cases of wrong, by the neglect of such officers

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— persons other than the inventors, or those in their private employ — persons in official station, and to whom they are, by the laws of the Constitution, and not always by their own choice, compelled to confine portions of their business. *Woodworth v. Stone*, 1 Wood. & Min. 389.

Much less should they suffer by others, when their error is one more of form than substance to third persons, and if to a certainty not sustainable in law, this change would [* 130] * work no injustice to others, and would leave the plaintiff still entitled to redress in an amended form of the bill relying on the old letters.

Deciding against this demurrer, the next inquiry is, whether this decision must operate as final in favor of the application for a preliminary and temporary injunction. Because the order of the Court, in July last, to file testimony by the respondents, in ten days, has not been complied with, and no excuse is offered for this omission except a demurrer put in on the last day of the time granted, and which has led to several weeks' further delay, and been overruled.

Under the twenty-fourth rule of this Court, where a demurrer is to a bill as here, and it is overruled, the party making it can still — on paying costs — have a trial on the merits, or principal matter in dispute — which is here a permanent injunction.

In England, without a specific rule: — “If the demurrer is overruled, the defendant pays to the plaintiff the taxed cost occasioned thereby, unless the Court make other order to the contrary.” 1 Smith, Ch. 213.

The respondents, then, may still have a hearing as to a permanent injunction, and I am willing to allow a hearing on that, after the proper pleadings and proofs are put in, and the costs paid.

But how stands the right to proceed further in the preliminary hearing and motion for the temporary injunction, after

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having once appeared and an order made, which has been neglected, and a demurrer put in, which has created much delay, and finally has been overruled? My impression is that the former order should not be renewed and extended after all this, unless the party, by affidavits, will satisfy the Court that the order was not omitted to be complied with for purposes of delay, and will put security on file for any damage done by running the machine in * dispute, [* 131] during the delay to comply with the order. If this is done in a reasonable time — say forty-eight hours — I would extend the order longer; but if not done, issue the temporary injunction on account of the neglect to comply with the first order, and the virtual confession of a violation of the plaintiffs' patent by the demurrer, if the present letters are valid — as we are inclined to hold them to be.

In either case — though the respondents by their course seem to admit the truth of the facts alleged in the bill — the plaintiffs if they can conscientiously, had better file their oaths to the truth of the bill; and file any collateral evidence which has been taken on their part under the order.

The respondents then moved for leave to answer to the bill, which prayed for a permanent injunction, and were allowed to do it on payment of costs. They moved next for leave to contest the temporary injunction further, and be excused from the non-fulfilment of the first order, and were allowed to do it on filing an affidavit that their course had not been adopted for the purpose of delay, and on giving indemnity for any damages by running the machine since the non-compliance with the order.

This case came on at an ensuing day in the term, for a further hearing as to a temporary injunction. The respondents, in the mean time, had filed an affidavit that the demurrer

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was not for delay, and had filed a bond that any damages during it would be indemnified against. The plaintiffs had also filed an affidavit as to the truth of the matter in the bill.

Some evidence was submitted on both sides; and among that on the part of the respondents were some answers which had been prepared to the bill, as for a permanent injunction, and which had been sworn to, and were here offered [* 132] as affidavits of the parties, in respect to their contents.

The substance of the exceptions taken in them to the validity of the patent set up by the plaintiffs, was, that it was not original with Woodworth, several persons being named who had discovered and used it before, and that the renewals of it afterwards were obtained by misrepresentations and fraud; and that it was improperly surrendered, and improperly reissued, with a new or amended specification.

It was admitted that the machine used by Smith, one of the respondents, was owned by the Edwardses, and was the same which Rogers was, the last spring, enjoined from running.

There was no evidence or admission which charged Bancroft, one of the respondents, and the motion as against him was dismissed.

The evidence offered did not change the case on either side, from what has been reported in *Woodworth et al. v. Rogers*, *post*, p. 135.

Several propositions were made for disposing of the motion by amicable arrangement, which were not acceded to, and need not therefore be repeated. An application was also made by the respondents to have the injunction, if imposed, continue no longer than the next term; and that the plaintiffs, in the mean time, should institute an action at law to try the validity of the patent denied by the respondents.

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The plaintiffs also moved to have the respondents make certain admissions as to evidence and points in respect to the suit at law, if ordered, and file security for the damages and costs which might be recovered.

The Court, after hearing the same counsel, at another * day in the term, expressed, by Justice [* 133] Woodbury, its opinion in favor of the temporary injunction against the two Edwardses and Smith. The Court observed, that one runs the machine and the other two own it, and all hold under Brown, the supposed patentee. But in a bill against him, by Woodworth's assignees in Vermont, in the Circuit Court, after a full hearing, Brown has been enjoined against the farther use of this very machine.

It would be sporting with the faith and confidence due to judicial proceedings in our own tribunals, to permit that machine to be used by any person claiming from Brown, while that injunction against him remains in full force, and the grounds of it no way overturned.

At the same time, as stated in the similar case between those complainants and Rogers at the last session here, these defendants are not prevented, and should not be, from trying their legal rights in their own appropriate cases. And though the plaintiffs, by former repeated recoveries on this patent, by extensive sales and long possession of it, and especially by succeeding in obtaining an injunction against Brown from using this very machine — are entitled to a temporary injunction against these respondents, yet it should, in the first instance, be only till the validity of the plaintiffs' title — which they deny — can be tried with them at law.

As the counsel for the respondents, who is also the counsel for Rogers, prefers that the trial be had in this case instead of that — let that one stand continued to abide the event of this, if not in the mean time otherwise arranged. And let a suit at law be brought, before the next term, against the two Ed-

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wardses and Smith for their infringement ; and if not done, the injunction now ordered against them must be then dissolved.

In respect to the terms and conditions attached to this suit, the most natural and appropriate one, that the trial [* 134] * shall be of the validity of the patent in the present bill, under the objections set out against in the before-mentioned answers, used here as affidavits by the respondents. Let this be one condition ; and another, that the suit may be in the name of any assignor or assignee, claiming an interest in this district, which the respondents are alleged to have infringed.

Various other conditions and restrictions are asked ; and it is not unusual for Courts to impose many others required by the nature of the case. See 2 Smith, Ch. Pr. 90; 2 Ves. 518 ; 1 Ves. 293 ; 2 Hare, 13, 14.

But some of those asked here, as to taking a model, and as to confessions of the use of the machine, &c., are easily accomplished or obviated, as the case now stands ; and too minute interference in these matters, by the Court, is to be avoided if possible.

Nor do I think it a case for requiring collateral security to cover damages and cost, after the oath of one of the respondents to his property being worth several thousand dollars.

It is to be hoped, on account of public considerations, that some amicable adjustment may, in the mean time, without further litigation, be effected of the controversies in respect to the validity of this patent in this district—controversies, which, after numerous decisions, still seem to multiply and require great attention to them at each term of this Court, to the delay and injury of other business.

We do not profess to know, or state, which of the parties are most blamable for this :—but to enjoin both to a sincere spirit of compromise, forbearance, and peace.

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The rights of inventive genius, and the valuable property produced by it, all persons in the exercise of this spirit will be willing to vindicate and uphold, without colorable evasions or wanton piracies ; but those rights, *on [* 135] the other hand, should be maintained in a manner not harsh towards other inventors, nor unaccommodating to the growing wants of the community.

WM. W. WOODWORTH ET AL. V. LAWRENCE ROGERS ET AL.

[3 Woodbury and Minot, 135. May T. 1847.]

A party who has been enjoined against the use of a patent, is guilty of a contempt if he afterwards use another patent similar in principle, when the author of the last had previously been enjoined by the owner of the first patent.

He can purge himself of such contempt only by satisfying the Court that he was not aware that the last patent had been enjoined.

If one makes an improvement in a prior patent, obtained by another, it gives him no right to use what had before been patented, without license, while the term of the prior patent continues.

Where a special injunction against the use of a patented machine has been imposed when a bill is filed, motions to dissolve it will not be heard on the same evidence, or new evidence improperly neglected to be offered before ; but will be on new and material testimony.

When an answer is filed to the bill denying the validity of the patent, and evidence supporting the answer, *prima facie*, is offered, the injunction will be dissolved, unless the other side file counter-evidence sustaining the validity of the patent. What generally is proper evidence on that point, considered.

It is the duty of the Court to weigh the evidence, and if the balance seems in favor of the plaintiff, to continue the injunction till a trial of the right can be had at law, by an issue out of the chancery side of the Court, or by an action at law. If the parties cannot agree on an issue, the Court will direct an action at law to be brought speedily, to settle the conflicting title ; and if not done, will dissolve the injunction.

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The remedy by injunction, used in this way, does not impair any right to a trial by jury, as secured by constitution, but merely aids the party appearing to have the legal title, till such a trial, if desired, can be had.

THIS was a bill in equity, filed September 8th, 1846.

It averred, that the plaintiffs possessed the title to the patent-rights of William Woodworth, senior, to the [* 136] planing * machine alleged to have been invented by him. That the defendants were using one of said machines, or one substantially like them. That the plaintiffs had before recovered a verdict and judgment against one J. Gould, for the use of a like machine ; and had requested the defendants to desist from infringing on the rights of the plaintiffs therein, but they refused to comply. The bill prayed for a discovery how long the defendants had used the machine, and after asking replies to several interrogatories, requested that the defendants be made to account for the profits derived from the machine, and be enjoined from any further use of it ; and for such other relief as might seem meet.

The respondents in November, 1846, filed answers to the bill. That of Rogers, which is the only one now under consideration, answering the interrogatories, set out, that some months before May, 1846, he used a machine similar to that claimed by said Woodworth as his, but has not done it since, nor used, since, any similar machine ; and hence, considers himself not bound to answer further.

Rogers then proceeded to deny that Woodworth was the original inventor of the machine patented by him in December, 1828 ; and that he well knew that fact, and thus obtained his letters, therefore, fraudulently. He further averred, that the surrender of the patent, July 8th, 1845, and the taking out a new specification for the same machine, instead of for one before defective, was for a new and different thing from what had been before claimed ; and this being known to Woodworth, made the last patent void.

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Rogers then prayed that an issue be ordered by the Court, and sent to a jury, to try the question of fraud in obtaining the patent in 1828, and the amended specification in 1845.

On the 19th of January, 1847—after a hearing before Sprague, J., a special injunction issued against Rogers not * to use the planing machine, patented by [* 137] Woodworth, or any one of similar construction.

In February, 1847, a motion was filed to punish Rogers for a contempt in violating that injunction.

At the hearing for this contempt, it was proved, that a planing machine like the plaintiffs' was used in Rogers's shop; but, on his affidavit that it was run by others who leased the shop from him for hire, and the Court considering it doubtful whether his connection with it was such as to render him responsible for its use, he was exonerated from the supposed contempt, on the payment of the costs of that motion.

On the 17th April, 1847, the plaintiffs filed another motion against the respondent, Rogers, for another contempt in violating said injunction, since the previous hearing.

On the 27th May, 1847, he put in an answer, denying his breach of that injunction, and adding, that since the 18th of February, 1847, he had used a machine in his shop like that invented and patented by Benjamin Brown, of Vermont, on the 9th of November, 1845; and the right to use which Rogers bought of James H. Edwards, assignee of Brown; and that it is not substantially like any machine said to have been invented and patented by Woodworth, 27th December, 1828, as heretofore described by the plaintiffs in their original bill. The answer adds, that if the plaintiffs claim, under their patents, any such machine substantially as that used by Rogers, William Woodworth was not the original inventor thereof; and if any such one is described in these letters of July, 1845, they were obtained on false representations and fraud. That there was no defect in his specification of December, 1828,

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and if any existed, it arose from design and fraud, and not from mistake. And that the letters-patent of July, 1845, if purporting to cover such a machine, were obtained [* 138] * corruptly and falsely, and made to embrace what he knew belonged to others.

On the 1st of June, Rogers filed amendments to the above answers, denying again the title of the plaintiffs to the Woodworth patent within the limits of Boston, and restating, with formal variations, his charge of fraud in the new letters-patent, issued July 8th, 1845, and the want of identity between the subject of them and the letters of December, 1828, and also charges of fraud committed on Congress in procuring the extension made by it. The amendments not only repeated these matters, but set up Daniel Dunbar, of South Boston, to be the earliest and true inventor of the planing machine used by Woodworth. They next averred, that the pressure rollers, named in his patent, had been well described in a patent to Samuel Bentham, in 1783, and other parts in a patent to J. Bramah, in England, in 1802.

They further alleged, that Daniel N. Smith, of Warwick, (Mass.) invented and patented a machine similar to Woodworth's, in 1827, and that James Hill, of Lynn, and Joseph Hill, and several others, had knowledge of a like machine made by said James and Joseph, prior to Woodworth's first patent — and similar allegations were made as to the invention of such a machine by John Hale, of Oakham, (Mass.) and that the rollers were known and used by James Baldwin, of Westford, (Mass.) as early as 1818.

At the first hearing of this case, to punish Rogers for a contempt, by violating the injunction, another motion was made by the counsel of Rogers to dissolve the original injunction imposed by Sprague, Justice. It was agreed, that these two motions be argued together; and it was further agreed that time should be allowed to Rogers to procure and file testimony,

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pertaining to both motions, and plaintiff have further opportunity to procure testimony in reply.

Various affidavits and other evidence were accordingly * put into the case on both sides at the times [* 139] mutually agreed. Reference will be made in the opinion of the Court to such portions of them as seemed important under each motion.

The questions and testimony were argued, by

B. R. Curtis, counsel for the plaintiffs, and *Tasker*, for the defendant.

WOODBURY, J. The first question to be disposed of, is the motion against Rogers, for punishment for a contempt in violating an injunction which was granted in this case against him in favor of the plaintiffs.

That injunction was against the use of the planing machine invented by Woodworth, or any machine substantially the same.

It was in these words: "You shall not use or vend any one or more of the machines substantially the same in construction as the machine of the said Wm. Woodworth, patented as mentioned in the said bill of complaint, on the 18th day of July, A. D. 1845."

The first inquiry is, what are the matters of fact and law which are properly to be examined on this motion?

They are — not the originality of Woodworth's machine, not any fraud in the renewals of it, not the propriety of the original injunction.

Those questions were all passed on, so far as made and as material in this motion for a contempt, at the original hearing before my associate. They are for the present inquiry, therefore, *rem judicatum*.

But it is important here to ascertain whether Rogers —

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and that is the next step in the inquiry — while under the injunction not to use any machine, substantially like Woodworth's, has disregarded the rights of the plaintiffs and the authority of the United States, as existing in the Circuit Court, so as to violate the order given to him? Has he, after [* 140] * a full hearing, and in contempt of that order, proceeded to use a planing machine similar in principle to Woodworth's?

As to this, it is admitted by Rogers, that since the 15th of February, 1847, about the time he paid the costs on the previous motion to punish him for contempt, he has used a planing machine invented by Benjamin Brown and patented in November, 1845.

But he denies that this machine is substantially like the planing machine patented by Woodworth.

The plaintiffs contend, it is in principle the same, and its use is therefore a breach of the injunction. This, then, is the point controverted, which is to be settled. What is the evidence on this question? and how is the balance of it?

Various witnesses on the part of the plaintiffs, and among them some highly intelligent machinists and experts, testify unqualifiedly, that this machine, now used by Rogers, is the same in substance and principle as Woodworth's.

On the contrary, several witnesses testify in his behalf, that they consider this machine as differing in substance or principle from the plaintiff's.

But some of these last describe this difference to consist in certain specified improvements made by Brown on the original machine of the plaintiffs, rather than as containing parts, all of which vary from Woodworth's, or which are independent and different from his.

Thus, Isaac Adams, for one instance, speaks of Brown's machine being different, but still containing "a combination claimed in the Woodworth patent." And others, like J. E.

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Andrews, admit that Brown's machine uses, substantially, two parts of Woodworth's own, "the cutting cylinder and a small guide roller."

In the examination of this evidence, as well as of Brown's own letters-patent, which are put into the case, and in *which he claims to have "invented a new and [* 141] useful improvement in planing machines," it hardly can be doubted that this machine contains some of the most important parts of Woodworth's, but it is in other respects different, and perhaps an improvement on it.

It is well known, however, as sound law, that where a machine has been invented like that of Woodworth's, in 1828, no one can make an improvement on it, and use important portions of the original invention, while the original term, or the renewals of it, exist, without the license of the original patentee, or a purchase from him of the right so to use what belongs to him. *Hovey v. Stevens*, 1 Wood. & Min. 290; *Washburn v. Gould*, 3 Stor. R. 150. See Act of Congress, February 21st, 1793, (1 Stat. at Large, 323.)

For the same reason, if the improvement by a succeeding inventor be genuine and important, no one can use that improvement without a license or purchase from him, although they have obtained the right to use the original machine on which the last invention is an improvement.

In this view of the evidence and law, therefore, Rogers is using a machine, which in its substance and principle contains important portions of Woodworth's patent, though it may in other respects have some qualities or parts which are new or improved, and, in thus using what is material in Woodworth's invention, he certainly violates the injunction.

But I can conceive, if the case stopped here, that some apology might exist in the apprehension of the party, that because Brown's machine was considered by several as an improvement on Woodworth's, he might use it without vio-

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lating Woodworth's rights, or paying him for such parts of his as are included in Brown's. To see then whether a designed evasion of the order, or, in other words, a [* 142] contempt * was committed, it is proper to look further into the testimony on the part of the plaintiffs. They proceed to show further, that the question, whether Brown's machine is original and independent of Woodworth's, so as to entitle him to make and use it, or license others to, without Woodworth's permission, is a question which has already been settled. It has been settled, too, against Brown himself, and in favor of Woodworth, after a full hearing in the Circuit Court of the United States, in the Vermont District where Brown resides.

The evidence is direct and plenary as to this, and furthermore that Brown has been put under an injunction, in behalf of Woodworth, not to use without Woodworth's license, the machine for which Brown took out a patent in 1845, and which Rogers is now using.

The proceedings were commenced May 7th, 1846, by Hickok, an assignee of Woodworth, against Brown and others, alleging that Brown's machine in all material parts was substantially the same as Woodworth's, and asking an injunction against it; and, after hearing affidavits and arguments on both sides, at the May Term of the Circuit Court for Vermont, in 1846, an injunction was issued against the further use of Brown's machine without a license from Woodworth, or his assignees, on the ground that it was an infringement on their rights.

It can hardly be tolerated after this, happening as long ago as May, 1846, that a person, under injunction not to use a machine substantially like Woodworth's, should proceed to purchase and use one, which had, after a public hearing in an adjoining Circuit, been enjoined against as substantially

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alike—and that in a legal proceeding against the patentee himself.

On all this evidence the Court would be blind to the facts, and unfaithful to the rights of parties and the public, * to allow such evasions of their orders and decrees; and it feels compelled to say on this evidence, unexplained, not only that their injunction has been violated, but in a manner highly culpable. We would not, however, bar the respondent from any exculpation which truth may warrant. If he can show that he was entirely ignorant of this injunction against Brown during the time he has been using Brown's machine, it would go far in extenuation.

This he can do, presumptively at least, by the affidavit of Edwards, his vendor, showing that Edwards was ignorant of that injunction; or if not so, did not communicate the fact to Rogers; and also by his own affidavit, purging himself of all knowledge of the proceedings in Vermont, from either Edwards or others, and all design to evade the orders of this Court in the use of Brown's machine.

The other motion to dissolve the injunction, imposed on Rogers by my associate, presents a different question, and is to be governed by several rules and considerations entirely dissimilar.

The main point in that is not whether an injunction should be imposed at all, for that has already been done, and after a full hearing—and till the contrary is shown, it is to be presumed it was done rightly. *Woodworth v. Hall*, 1 Wood. & Min. 248, 389; *Maxwell v. Ward*, 11 Price, 17. *Omnia presumuntur rite esse acta.*

The burden, then, is on the respondent to overcome that presumption. It is open to be overcome by new matter or evidence arising since the injunction was imposed, though very seldom by matter then existing, which the party neglected

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to present to the consideration of the Court. If this were not the rule, the same matter might be offered anew, or matter before neglected offered on new motions to dissolve injunctions, weekly, the year round, and the Court be entirely occupied either in virtual rehearings of like facts [* 144] * and like arguments in one and the same cause, or in considering what the petitioner had before improperly neglected to introduce.

The new matter, usually relied on in cases of this category, is a subsequent answer, denying the originality of the patent or its validity in other respects, and supporting the objection, if contested by the plaintiff, with *prima facie* proof not rebutted. *Poor v. Carleton et al.*, 3 Sumn. 70. Or it is by showing a trial at law, since had between these parties, and at times between others, involving like questions, and a judgment rendered against the validity of the patent.

The ground chiefly relied on here is, therefore, a subsequent answer, which not only denies the originality of Woodworth's patent in 1828, but the validity of the succeeding renewals of it, both by the Board for the Patent Office and by Congress, through gross frauds, alleged to have been practised on them by Woodworth and his assigns.

This denial of legal title in the plaintiffs, made by the respondent, under oath, is not without some weight, when standing alone. Once it was deemed sufficient to dissolve an injunction, already specially granted on a hearing, and not a mere common injunction, issued of course.

See the cases, collected in 3 Sumn. 75, and *Orr v. Littlefield*, 1 Wood. & Min. 13.

But such is not the law or the practice now, either in England or this country. (See cases last cited, and 16 Ves. 49; 19 Ves. 183; 11 Price, 17; 1 Wood. & Min. 280, in Parker's case.) The presumptions arising from the answer, may now be disproved by evidence on the part of the plaintiffs, and

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then counter testimony is admissible by the respondent to sustain his answer.

After this, it becomes the duty of the Court to balance *these allegations and proofs, and decide [* 145] how the weight of them is; and whether in the exercise of a sound discretion upon them the injunction ought to be dissolved or not. 2 Ves. 19; 2 Johns. Ch. 204; 3 Sumn. 74.

Here the plaintiffs have offered a variety of evidence to countervail and disprove the answer, and also the testimony introduced by Rogers.

(1.) They show not only the letters-patent themselves, to Woodworth, which are public records and acts of public officers, that are alone *prima facie* evidence for the patentees of the validity of their claim, but next (2) the oath of the patentee, when they were obtained, that he was the original inventor. Alden v. Dewey, 1 Story, R. 336. (3.) Next a subsequent confirmation of his claim as inventor, by the renewal of those letters by the Board of the Patent Office. (4.) Next, such a confirmation by Congress itself, in granting a further term for the patent. (5.) Next, the possession and a use and sales of this patent and numerous machines over the whole country, and for large sums of money, as if rightfully entitled to it, for nearly twenty years past. Hindmarch on Patents, 305; Drury on Register, 320-2; Orr v. Littlefield, 1 Wood. & Min. 20.

The doctrine in England, as to this alone, is very strong. In Bickford v. Skews, (4 Mylne & Craig, 500,) the Lord Chancellor says: "If the patentee has been long in possession, the Court will not look into the title, but will give credit to it, until displaced by a trial at law."

It is stated that in the adjoining circuit, one of my brethren on the Bench of the Supreme Court (Nelson, J.) has recently

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held this circumstance alone to be sufficient to retain an injunction.

Next, (6) by a recovery of damages in a Court of Law for an infringement on it, after a severe contest in this Circuit, under my predecessor. *Woodworth v. Sherman*, [* 146] 3 Story, * R. 171 ; *ibid.* 139, 754. This involved the originality of his invention as against Evans and all others then set up.

(7.) Next, the recovery in Courts of Equity in several cases where his rights were contested, not only in the different Circuits of the United States, but in several cases, fully heard and considered in the Supreme Court of the United States, and some of them involving the originality of this very invention. 4 Howard, 712, 716.

(8.) Next, special injunctions, that have been obtained in great numbers, many of which are still pending, and none of which are shown ever to have been dissolved on a hearing upon the merits, as to the validity of the patent.

(9.) And, finally, a special injunction obtained, after resistance, against this very defendant.

Such facts, in these preliminary inquiries into the legal title, as connected with the propriety of imposing or dissolving an injunction, are proper and legal ones to influence the decision of the Court, are paramount in their character over all individual opinions of witnesses, and should usually be conclusive till parties contest these claims in some issue in a Court of Law and disprove or rebut their force. See *Orr. v. Littlefield*, 1 Wood. & Min. 20, and the cases cited there.

Their great strength, when united as here, is entirely superior to any evidence offered against them by the respondent.

It is true that the matters in the answer are attempted to be sustained by Rogers by evidence and documents.

But some of them relate to mere hearsay statements;

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some are from persons under injunctions against the use of this same machine of Woodworth's and some are open to various other objections, soon to be explained, and decisive against them.

*It deserves special notice, that among several [* 147 instances named, where the planing machine is supposed to have not been sustained, that not a single case is shown for Rogers, by proper proof, of a recovery at law or in equity against Woodworth's patent. The cases referred to rest on hearsay, or are apocryphal. Again, where in some instances, after special injunctions have been obtained, it is shown by him that the plaintiffs became nonsuit, the evidence or rebuttal is, that the respondents were irresponsible and not able to pay the cost of further proceedings; or they were cases in which some assignee, and not Woodworth and his immediate representatives, conducted the prosecution, and were not nonsuits or dismissals made by order of the Court on a hearing.

In the case cited from Maryland, where an injunction was dissolved, it does not appear to have been from want of title. The respondent was still required to keep an account, thus recognizing for some purposes the *prima facie* right as to the patent, but deeming the remedy by injunction unsuited to the circumstances there existing, or unjust, or unnecessary, as it is at times when the defendant is in large business and amply responsible for any damages. *Bramwell v. Halcomb*, 3 Mylne & Craig, 739. Or what seems most probable, it was a case of a common, and not a special injunction. The former is usually dissolved as a matter of course, on the coming in of an answer denying merits, or a legal title in the plaintiffs, and without any inquiring into the truth of the allegation. See *Orr v. Littlefield*, 1 Wood & Min. 20; 3 *Merivale*, 622; 3 *Sumn.* 74; *Eden on Inj.* 88.

Notwithstanding these exceptions to this evidence, when

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coupled with the denials and allegations in the answer— they all standing alone, and not rebutted by the plaintiffs, would probably be a sufficient ground for dissolving the injunction.

[* 148] * They would furnish this, because making, probably, when standing alone, a *prima facie* case, that the plaintiffs had no legal title ; and an injunction is intended to aid or protect what seems to be a legal title.

It is granted for this purpose, when issued before a trial, on presumptive evidence offered of such a title ; and it stands on that till the probabilities furnished by the plaintiffs of their having a legal title are overcome by answers and counter oaths, and proofs of a stronger character by the respondents than those adduced by the plaintiffs, or by a subsequent trial at law in which such counter proofs have been examined and been successful. 3 Mylne & Craig, 739.

But being, as the respondent's answer is, as well as his evidence, counteracted by the strong and numerous facts offered by the plaintiffs to rebut them, the probabilities seem to me wholly changed, and to be decidedly in favor of the validity of Woodworth's patent. His proofs are of a character entirely to overcome what might otherwise be inferred from the defendants. Take Dunbar's affidavit, for one instance, as to the material point concerning the originality of the invention. He testifies as to what transpired before the patent, and it has been slept over for a generation, and till Woodworth (senior) is in his grave, and till the originality has been not only sworn to by the patentee, but when attacked frequently since has been sustained triumphantly in the Supreme Court of the United States, as well as in several Circuits, and before Congress itself.

Leading circumstances, like these, should also overcome the statements of the defendant from mere hearsay as to fraud— an imputation, which, above all others, is to be proved clearly or not at all. *Roberts v. Anderson*, 2 Johns. Ch. 202.

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And they outweigh all loose and general impressions as * to no differences in principle existing between Woodworth's and other old machines, when this has been so often tested in Courts where witnesses were cross-examined, and what is meant by principle has been often found and explained to be only such changes in form as turn out to be immaterial, or a substitution of only what are well known to experts to be mere mechanical equivalents.

Another consideration has been urged against the continuance of this injunction which deserves some notice. It is the alleged illegality or oppression of this remedy and its great encroachment on the trial by jury, and consequently the propriety of dissolving it in this instance. But the power exercised under injunctions has existed from the early ages of chancery jurisdiction, and is remedial and useful as a preventative of injury and multiplicity of lawsuits, when it is properly exercised. It is also a power conferred on this Court in one of the earliest acts of Congress, passed after the adoption of the Constitution. 1 Statutes at Large, 81, §§ 13, 14, and p. 334. It has constantly been used by it since for more than half a century.

It is a mistake, likewise, to suppose that this power, in its legitimate use, impairs, supersedes, or prevents the trial by jury where it has ever existed.

In most questions pending in Courts of Chancery, or on the equity side of Courts of Law, a trial by jury has never been usual in this country or abroad.

The 7th amendment to the Constitution secures that trial only in cases "at common law."

But still chancery may order an issue to be tried at law to help itself as to facts, and retried, if dissatisfied with the verdict. 2 Price, 314, note; 416, note. Or it may decide facts for itself in all cases, except, perhaps, in England,

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[* 150] in * the case of an heir at law disputing a will, and a rector suing for tithes. *Bullen v. Michel*, 2 Price, 423.

So a jury trial can always be had, and is cheerfully allowed in cases like this, connected with injunctions, where the rights and titles of parties are doubted in law and facts are supposed to exist which are disputable and proper to be settled by a jury. *Bramwell v. Halcomb*, 3 Mylne & Craig, 737. An injunction is never issued in hostility to what seems to be the legal rights of the parties, but in the aid and protection of them. At first, it is as those rights appear before trial, and only till a trial by jury can be had, if desired. *Ridgway v. Roberts*, 4 Hare, 108; 17 Ves. 422. And whenever a trial is had before a jury or otherwise, which shows that the rights at law are with the party enjoined, the injunction is, as a matter of course, dissolved. *Bickford v. Skews*, 4 Mylne & Craig, 498. Nor does the injunction delay or retard a trial by jury, but makes the *prima facie* title prevail till then. *Harman v. Jones*, 1 Craig & Phil. 299; *Hilton v. Granville*, 1 Bailey, Cases, 120.

In the present case it was imposed in favor of the party appearing on the evidence to possess the legal right to the patent and machine. It was done only the last winter, and after full hearing, and has been no obstacle since to the respondent having a jury trial as soon as he was sued in a Court of Law, where such trials can alone be had, or as soon as he put in an answer here which denied the legal title of the plaintiffs and requested a trial at law, and that trial can in due course be had. This he has not done till the last month; and now having had a hearing on this request, and the injunction being still retained to aid and protect what still seems to be the legal title till the contrary is fully shown, he can have

[* 151] a jury trial of the title to this * patent whenever issues can be formed by the parties and the case pre-

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pared for a hearing upon them ; or, if preferred, as soon as an action at law can be instituted and prepared. The bond which he voluntarily offers, to secure the damages and costs which may be recovered, obviates the objection which is sworn to have existed in going on further with some other cases and having a trial on them.

On the last circuit, where an answer like this was put in, and the parties did not agree to form an issue to be tried by a jury, out of the equity side of this Court, I directed that unless a suit at law was brought at the next term to try the legal title, the injunction should then be dissolved. See *Orr v. Merrill*, 1 Wood. & Min. 376 ; *Perry v. Truefitt*, 6 Beav. 418 ; 9 Jurist, 717 ; 3 Mylne & Craig, 739 ; 6 Jurist, 269 ; *Casswell v. Bell*, 2 Railway Cases, 782, and *Clarence R. Co. v. Junction R. Co.*, *Ibid.* 763.

I am ready to do the same here, but see no sufficient grounds for ordering it to be dissolved at this time, when there appears so decided a balance of testimony in favor of the plaintiffs' legal rights to this patent.

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[1 Wallace, 192. October T. 1847.]

Evidence under Patent Act — Practice.

The 15th section of the Act of Congress of July 4, 1836, commonly called the Patent Act, does not require notice of the names and places of residence of the witnesses, by whom it is intended to prove a prior knowledge and use of the thing patented.

IN this suit, which was one for an infringement of a patent-

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right, the defendants pleaded the general issue; and relying in their defence upon a previous use and knowledge of the thing patented, gave notice to the plaintiffs under [* 193] the act of Congress,¹ that * they would offer proof upon the trial, that it had been publicly used at certain places which they named, and that a prior knowledge of it was possessed by certain persons whom, together with their places of residence, they also named: But the notice did *not* specify the names nor residences of *the witnesses by whom* it was intended to prove what was thus notified.

The act of Congress² which allows this defence and notice says: "Whenever the defendant relies in his defence on the fact of a previous invention, knowledge, or use of the thing patented, he shall state in his notice of special matter the names and places of residence of those whom he intends to prove to have possessed a prior knowledge of the thing, and where the same had been used."

Mallery now calling upon a witness to prove where and by whom the thing had been used, Mr. Hazlehurst objected to the testimony, because the name and residence of the *witness* had not been given. He cited *Greenleaf on Evidence*,³ where it is said "the facility with which this defence" (of prior use,) "may be made, affords a strong temptation to the crime of subornation of perjury; to prevent which the defendant is required to state, in his notice, the names and residence of the witnesses by whom the alleged

¹ Of July 4th, 1836, § 15, 5 Statutes at Large, 123, that the defendant shall be permitted to plead the general issue, and to give any special matter in evidence of which notice in writing may have been given thirty days before the trial, tending to prove that the thing patented had been in public use, &c.

² July 4th, 1836, § 15.

³ Vol. II. § 501.

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previous invention is to be proved." He cited also *The Philadelphia and Trenton Railroad v. Stimpson*,¹ in the Supreme Court of the United States. The Court below had rejected the testimony of one White, for want, says the Reporter, "of the notice *required by the act of Congress*, of the *use of the machine at *Mauch Chunk*, at which [* 194] place it was said his testimony would show it had been used." This report, Mr. Hazlehurst thought, did not show precisely what notice was or was not given, but Judge Story in giving the opinion of the Court clearly did. "There is no proof on the record," says that judge, "that notice had been given *according to the requirements of the statute*, that *White was to be a witness*," &c. "Unless such notice was given, it is plain that the examination could not rightfully be had." What notice does the Court here mean, as being within "the requirements of the statute?" Clearly "that *White was to be a witness*." Dr. Greenleaf, without quoting this case, yet seems to have the same notion of the requirements of the act. Indeed, if a witness *knows*, i. e., legally knows, of another man's discovery, he himself knows of the discovery, and the notice ought to be given.

Meredith, contra. There has been a misconception of the act by Judge Story and by Dr. Greenleaf who follows him. The case cited,² shows that the ground of the rejection of White's testimony, was because notice was not given of a use of the machine at *Mauch Chunk*. White was, himself, the person who had used it there, and his *name* ought to have been given, not as a witness, but as that of a person who "possessed a prior knowledge of the thing." The point

¹ 14 Peters, 448, 459, *ante*, 46.

² *The Philadelphia & Trenton Railroad v. Stimpson*, 14 Peters, 448, 459, *ante*, 46.

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adjudged was as to the "*place.*" The language of the Court or rather the judge who delivers the opinion of the Court, is loose, and goes for what it is worth.

[* 195] *GRIER, J. The language of the act, I think, requires nothing more than the names and residences of the persons who possessed the prior knowledge of the thing patented, and the name of the place at which it had been used. It would be unreasonable to extend it, unless it clearly required us to do so, to the *names and residences of all the witnesses* whom the defendant meant to summon. The other requisition is reasonable enough, and was intended to guard against surprise from such evidence as was given in Whitney's case.¹ Though Mr. Whitney's cotton-gin was an invention of perfect originality, two persons were yet brought forward, one of whom testified that he had seen a similar machine in England seventeen years before, and the other that he had seen one in Ireland.

It would have been quite enough in order to disprove it, that the other side had had notice of the place at which, and the name of the party by whom, the alleged prior machine was used.

HERRICK AIKEN v. S. C. BEMIS.

[3 Woodbury and Minot, 348. October T. 1847.]

A new trial will not be granted on the ground that the verdict is against the weight of evidence, if there was some to be weighed on both sides, unless some clear mistake is shown, or some manifest abuse of power.

Where the action is for a misfeasance in violating a patent, and \$2,000 damages are given, the Court will not set it aside on the ground that they are excessive, unless they are plainly and largely beyond the injury inflicted.

¹ Whitney v. Fort, A. D. 1807; Fessenden on Patents, ed. 1822, p. 134.

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* The declarations of a person as an agent, in relation to the business [* 349] intrusted to him, and made at the time when so intrusted, are competent concerning it in an action by a third person against the principal, as a part of the *res gestæ*, if they relate to the act clearly.

A new trial will be granted for newly-discovered evidence, if there was not gross neglect in not procuring it at the first trial, and if it is not merely cumulative. Evidence is cumulative if it relates to the same subordinate or specific fact, to which proof was before adduced of a like character, but not when it is a new fact respecting the general question or point in issue.

Where depositions or affidavits are taken with notice in conformity to a special order, but when the opposite side was not able to confer with his counsel and attend, they will be admitted with the condition that the opposite party have time to take them over again and cross-examine the witnesses.

Costs of the former trial must usually be the terms for a new trial on the ground of newly-discovered evidence.

Where a patent for a saw-set describes it as having a hammer of iron with a steel point, and says nothing of any other material or equivalents, and the evidence was, that a hammer entirely of steel had first been tried and abandoned by the patentee, before taking out his letters in this form, doubts exist whether saw-sets made by the defendant with hammers entirely steel are a violation.

THIS was an action on the case for violating a patent of the plaintiff.

The letters were averred to have been obtained May 24th, 1830, for "a new and useful improvement on the saw-set," and the infringement to have been made in A. D. 1837 and 1838.

At the trial here, at the last May term, before Sprague, J., the patent was given in evidence and described as consisting of a hammer, a shank, a regulating screw and spiral spring. It is not necessary to describe either of them, except that the hammer was to be of iron with a steel point.

Much testimony was put in tending to prove that saw-sets similar to this had been known and used a few years before the date of these letters, and other testimony by the plaintiff to raise a presumption that some of the saw-set machines, which, by some of the witnesses of the defendant, were sworn to have been used earlier, were probably made by the plain-

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[* 350] tiff, after his invention and the * maturing of his saw-set, which happened about two years previous to the taking out of his patent.

The evidence, showing an infringement by the defendant, proved that the hammers in his saw-sets were all made of steel, and not in part of wrought iron, and that the plaintiff, in experiments made before completing his saw-set, found that steel hammers broke frequently, and wrought-iron ones enduring longer, his specification was confined to the last with steel points.

The defendant, therefore moved for a nonsuit on this ground, which the Court refused. The plaintiff then offered further proof that the manufacture by the defendant extended to six or seven hundred dozen, and that the profit on the sale of them was \$2 per dozen.

In the course of this testimony a witness swore that one Call, who made some of these saw-sets, was a foreman for Bemis, and that Call said he had made a certain number of them in all, specifying it, and gave to the witness an order on Bemis for the wages for his work.

The admission of this testimony to that statement about the number was objected to, but it was allowed to go to the jury.

A verdict was returned for the plaintiff for \$2,000 damages.

A motion was made for a new trial by the defendant, assigning the following causes.

1. The refusal to nonsuit the plaintiff for the variance in the hammer described in the specification, from that hammer made by Bemis.
2. The admission of Call's declarations as to the number of saw-sets made by Bemis.
3. The damages being excessive.
4. The verdict being against the weight of evidence.
5. Newly-discovered evidence since the trial.

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* The affidavits as to the newly-discovered evidence were numerous. The oath of the defendant showed that this new evidence was not known before the trial, though one of the witnesses was named in the notice of the defence, thinking that, as a mechanic, he was likely to know something on the subject. But he was not talked with nor summoned. A portion of the other witnesses resided at distances not very remote from the defendant.

The substance of the newly-discovered evidence was in depositions taken under an order requiring notice to be given to the opposite party. Their use was objected to by the plaintiff, because the notice was so short that his counsel were unable to see him or confer together before the time arrived, and to reach the place of taking them seasonably. But the Court, on being satisfied no unfairness was intended by the defendant in the notice, stated that the depositions would be admitted conditionally, as they came within the order.

In this class of inquiries they might, without a special order, always be *ex parte*. But the Court said, that, if admitted, time would be allowed to the plaintiff, under the circumstances, to take the depositions over again, and cross-examine the witnesses, if he desired it.

The plaintiff concluded to proceed without doing this.

Among the new witnesses was Ealim Stebbins, who testified to seeing a saw-set like this, except brass for iron in the guards, as early as 1820, at Goodnow's, and another, belonging to D. B. Perkins, afterwards.

Another witness was D. B. Perkins, who swore to seeing one like this as early as 1816, in Waterville, Me., one in Lancaster, N. H., in 1826, and one bought in Connecticut in 1828.

The next witness was Jethro Latham, who testified to buying another saw-set, like this in principle, between 1824 and 1826, in Rhode Island.

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[* 352] * Another new witness, O. Dickerson, testified to seeing, in 1828, a different, but in some respects similar saw-set.

Another, A. Blanchard, swore to the making, by himself and brother, in Palmer, Mass., of a like saw-set in 1826. It was constructed from a description given him by his brother. He swore to another made in Springfield, by two machinists, in 1823 or in 1825.

Eli Parsons testified that he bought another similar one at Springfield in 1827.

Horace Lee swore to another still in 1820, in Hartford, Conn., and Dyer White to another, less like the plaintiff's in form, but with some such principles, made by him in 1819.

The motion was argued at an adjourned session in September, 1847, by *Bates* and *B. R. Curtis* in its favor, and *Hayes* and *J. P. Hale* against it.

WOODBURY, J. It may not be amiss for the benefit of these parties, to notice all the grounds assigned here for a new trial, though we decide the question only on one of them.

The cause relied on as to the damages being excessive, is not so clearly made out as to justify the setting aside of a verdict in an action for misfeasance. The case might be different in a suit on a contract, as there the rule of damages is more certain. Some of the data in favor of this large amount of damages in the present case, were rather loose, even for a misfeasance, but the sum given in this class of cases must be plainly exorbitant, or what is sometimes called "*outrageous*," to require the interference of the Court. *Allen v. Blunt*, 2 Woodb. & Min. 121, and *Taylor v. Carpenter*, *Ibid.*, 1, and cases there cited. 2 Wils. 160, 244; 4 Mass. 43; 3 Pick. 385; 7 Pick. 82; *Washburn v. Gould*, 3 Story, R. 122.

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* Another of the causes assigned for a new trial [* 353] is, that the verdict was against the weight of evidence. Though this is sustained by some plausible appearances, it is not shown so clearly as to raise a strong presumption that the jury either wantonly abused their powers, or made some inadvertent mistake.

These last are the leading tests in such cases. *Fearing v. DeWolf*, *ante*, 185; 12 N. Hamp. 171; 12 Wend. 27; 8 Pick. 122. And where evidence existed on both sides which was material, and to be compared or weighed, as it did here, the finding of the jury is not to be disturbed, though the Court would have come to a different conclusion upon it from that of the jury. See the cases cited in *Fearing v. DeWolf*, and *May v. DeWolf*, *ante*, 185, 193; 18 Pick. 13; 15 Pick. 291; 7 Wend. 270; 1 Sumn. 451; 12 N. Hamp. 179.

But the other reasons assigned for a new trial are of a different character, are supposed to be errors in law, and rest on exceptions entirely disconnected with the finding, or the opinion of the jury.

One is a question arising on the refusal of the Court, in the progress of the trial, to nonsuit the plaintiff on account of a variance between his specification and the form or substance of the machine, which was considered as an encroachment on the patent.

It is well settled that if the machine used by the defendant differed materially from that described in the patent, it is not an infringement. *Davoll v. Brown*, 1 Woodb. & Min. 53; *Webster on Pat.* 11; 4 Barn. & Ald. 540.

Where the patent is for a new combination, and not for newly-invented parts, a violation must extend to the whole. 16 Peters, 341. .

The present was a case of the former character, for a * combination, and the difference in the patent [* 354] from the instrument here, consists in this — that the

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hammer of the saw-set was all made of steel by Bemis, and that all but the point was made of wrought-iron in the patent.

This looks, at the first blush, as not a very material difference, and one rather colorable or accidental, than designed. 1 Sumn. 485; 13 Mee. & W. 592; Phil. on Pat. 472; Peters, C. C. 394.

But when we advert to the evidence in the case, it appears that the use of wrought-iron was found by experiments to be much better than steel, and was hence patented, and this, without making the specification in terms broad enough to cover steel also.

It is a matter of doubt, therefore, whether the use of an inferior material for the hammer of the saw-set, when the patent covers only a superior one, is a legal violation of it. Why should the plaintiff complain of what he had tried but deemed too useless or valueless to be adopted?

Had the patent extended only to the form or parts of the saw-set, combined as set out, and made of any kind of materials, or saying nothing as to the materials, the right would be violated by a machine of like form, as the form would be the sole matter patented.

But when the patentee chooses to go farther, and cover, with his patent, the material of which a part of his machine is composed, he entirely endangers his right to prosecute when a different and inferior material is employed, and especially one, which he himself, after repeated experiments had rejected. Webster on Pat. 27; 4 Manning & Gr. 462; 4 Mason, 1; 3 Carrington & Payne, 502.

The form of the specification, in this case, extending to the material at all, was ill-advised, and especially so, without adding, as is usual, if made of any other material in [* 355] the * form and combination described. Webster on Pat. 20; 16 Peters, 341; 4 Barn. & Ald. 540.

But we do not now decide this case on this point, being

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inclined, if practicable, to let the parties settle their rights on the merits as to the originality of the patent.

Another exception in law to the ruling of the Court, is the admission of the declarations of Call. The ground on which their admission was sought to be justified, seems to be that Call was the agent of Bemis, and the declarations of the agent will often bind the principal.

This ground is sound whenever the person is proved to have been agent in that particular business, and made the declarations while engaged in it, and in relation to it. They then became a part of the *res gestæ*, and bind the principal as if made by himself. 12 Wheat. 468; 2 Peters, 364; Story on Agency, § 134; 24 Pickering, 245.

I am inclined to think here, that, in truth these declarations were made under such circumstances. But their admission being an exception to the general rule, that a party is not to be affected by the declarations of third persons, it would have been well to have shown with more distinctness whether Call's agency extended to this particular business, and whether the declarations were made when he was engaged in it, and not afterwards. 2 Starkie on Ev. 60; Greenleaf on Ev. 144; Phil. Ev. 103; 3 Conn. 250; 9 N. Hamp. R. 271; 4 Pick. 378; 11 Pick. 309.

Passing by this last fact as not so clear either way, as to be decisive of the motion, I proceed to the other cause for a new trial, growing out of the new discovery of material evidence since the trial. On that, it is thought proper the jury should have an opportunity to deliberate, at least once, before disposing finally of the rights of these parties.

The rules as to such evidence, when sufficient or not, * to require a new trial, were fully considered [* 356] and explained in *May et al. v. De Wolf et al. ante*, 193.

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The limitations are, that

1. The evidence must not have been known before the trial. 1 Johns. Cases, 402; 2 Caines' Cases, 155.
2. It must be material. 2 Wash. C. C. 411.
- 3 It must not be merely cumulative. 10 Wend. 285.

There is no doubt here, that most of this new evidence has been discovered since the trial, and, indeed, a part of it since the motion. This is sworn to and not contradicted. It is true, that in the notice given, one of the witnesses was referred to before the trial, as likely to know something on the subject, and others resided near the parties. But the testimony is, that it was not then known whether any of them could in truth testify to what is material.

Nor was that known as to some, even when this motion for a new trial was made. Next, did the defendant employ due diligence?

In a case like this, where the transactions or matter to be proved about similar saw-sets in use was of such long standing, being twenty years or more old, and where the defendant was not a party to them, nor supposed to possess any peculiar or previous knowledge of them, I do not see sufficient ground for imputing to him such negligence as should bar him from using this evidence. See cases in *Fearing et al. v. De Wolf et al. ante.*

And so far from excluding him from the use of any new evidence not discovered when the motion for a new trial was made, but ascertained before the hearing of the motion, and before judgment, certainly when the motion, as here, is broad enough in form, and early enough by our rules, the new evidence ought in justice to be considered and weighed with the rest.

[*357] *It may be regarded as a breach of the rule concerning the proof being newly discovered, that if evidence was not, in fact, known before the other trial, but

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ought to have been, and probably would have been by the exercise of due diligence, a new trial should not be awarded in consequence of it.

It is true here, also, that the new witnesses did not reside very remote. But it is not shown that the defendant knew previously what they could testify, or had any special reason to suppose they were able to give useful testimony.

And so far as he might suppose, on general facts and reasoning, that most mechanics would be likely to know something of the subject, he certainly seems to have resorted to enough of them, and used the testimony of enough at the trial to show due diligence, so far as required by any general information or duty.

Nor can there be any question here that the new evidence is material.

It goes to the very gist of the claim of the plaintiff, the originality of his patent. It goes, likewise, to several new saw-sets, similar in structure, testified to have been in use some years earlier, besides strengthening the old testimony, as to some of the old saw-sets proved at the former trial.

The ends of justice, therefore, render it proper that a jury should, once at least, pass upon this testimony between these parties, as to saw-sets not sworn to, nor known before, unless it is what the law regards as merely cumulative.

For it is, as before named, the last and an important condition, as to newly-discovered evidence, that it be not merely cumulative.

This means, that it be not heaping up farther proof as to the same point or fact, on which evidence was before offered. If it only serve to strengthen such old point or fact, and not to introduce any new on the jury, a new trial is not allowable on account of it.

* The only difficulty under this rule is, what must [* 358]

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be considered, in this case, a new point or fact, and what is merely cumulative, as to an old one.

When, as here, the general defence is placed on the ground that the patent of the plaintiff was not original, the meaning of the rule cannot be to exclude, as cumulative, newly-discovered evidence of subordinate points or facts bearing on that general question.

For in such a view, no new trial for new evidence could ever be obtained, all new evidence relating, as it must, if it be pertinent, to the general ground or general fact put in issue before.

But it must mean that new evidence to a subordinate point or fact is not competent when that subordinate point or particular fact was before gone into, because it is then cumulative or additional as to that fact. For example, here it would be a new point of fact, that a similar saw-set had been known and used in Hartford, Conn., in 1820, by the witness, Lee, because nothing was proved in respect to that saw-set before.

But it would not be a new point or fact, that a similar saw-set was known and used in Springfield, in 1827, by Parsons, because the point or fact was before gone into by the evidence, and further proof as to that would be merely cumulative.

Much of this new evidence being then as to subordinate points and particular facts not before agitated, cannot be regarded as cumulative. 10 Wendell, 285; 1 Cowen, 359; 23 Pick. 248; 4 Wend. 579. See the precedents on this in *May et al. v. De Wolf, ante*; 6 Greenl. 479; 1 Sumn. 451, 482, 491; 10 Wend. 294; 6 Pick. 114; 24 Pick. 246-8.

The new particular facts or cases of the prior use of such a saw-set sworn to, are on the face of the affidavits very striking and numerous.

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* They may all be disproved or contradicted at the [* 359] trial, but they are proper to be brought to such a test.

They make out, *prima facie*, one of the strongest cases to be found in the history of new trials for this cause, and require us, therefore to grant the motion.

But in these cases of new trials for newly-discovered evidence, the terms are usually that the costs of the former trial be first paid. See the cases in *Fearing et al. v. De Wolf et al.* 2 Wood. & Min. *ante*.

Another reason for such terms here is the near residence of the new witnesses, and not obtaining them before.

Though some other causes seem to unite in rendering a new trial just, yet as this is the principal and decisive one, we think those costs ought first to be paid, unless the defendant can offer some satisfactory reason for different terms.

If no such reason be offered during the session, the new trial will be allowed on paying such costs.

PETER HOGG AND CORNELIUS H. DELAMATER, PLAINTIFFS
IN ERROR, v. JOHN B. EMERSON.

[6 Howard, 437. January T. 1848.]

When a case is sent to this Court under the discretion conferred upon the Court below by the seventeenth section of the Act of July 4, 1836, (Patent Law,) 5 Stat. at Large, 124, the whole case comes up, and not a few points only.

The specification constitutes a part of a patent, and they must be construed together.

Emerson's patent for "certain improvements in the steam-engine, and in the mode of propelling therewith either vessels on the water or carriages on the land," decided not to cover more ground than one patent ought to cover, and to be sufficiently clear and certain.

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A patentee, whose patent-right has been violated, may recover damages for such infringement for the time which intervened between the destruction of the Patent Office by fire, in 1836, and the restoration of the records under the Act of March 3, 1837.

THIS case was brought up, by writ of error, from the Circuit Court of the United States for the Southern District of New York. It was a suit for the violation of a patent-right, and the writ of error was allowed under the seventeenth section of the Act of 1836.

On the 8th of March, 1834, John B. Emerson, the defendant in error, obtained the following letters-patent, (which were recorded anew on the 5th of March, 1841,) namely:—

The United States of America, to all to whom these letters-patent shall come :

Whereas John B. Emerson, a citizen of the United States, hath alleged that he has invented a new and useful improvement in the steam-engine, which improvement he states has not been known or used before his application; [* 438] hath made * oath that he doth verily believe that he is the true inventor or discoverer of the said improvement; hath paid into the treasury of the United States the sum of thirty dollars, delivered a receipt for the same, and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose. These are therefore to grant, according to law, to the said John B. Emerson, his heirs, administrators, or assigns, for the term of fourteen years from the eighth day of March, one thousand eight hundred and thirty-four, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used; the said improvement, a description whereof is given in the words of the said John B. Emerson himself, in the schedule hereto annexed, and is made a part of these presents.

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In testimony whereof, I have caused these letters to be made patent, and the seal of the United States to be hereunto affixed.

Given under my hand, at the city of Washington, this eighth day of March, in the year of our Lord [L. s.] one thousand eight hundred and thirty-four, and of the independence of the United States of America the fifty-eighth.

ANDREW JACKSON.

By the President:

LOUIS McLANE, *Secretary of State.*

CITY OF WASHINGTON, to wit:

I do hereby certify, that the following letters-patent were delivered to me on the eighth day of March, in the year of our Lord one thousand eight hundred and thirty-four, to be examined; that I have examined the same, and find them conformable to law; and I do hereby return the same to the Secretary of State, within fifteen days from the date aforesaid, to wit, on this eighth day of March, in the year aforesaid.

B. F. BUTLER,

Attorney-General of the United States.

The schedule referred to in these letters-patent, and making part of the same, containing a description in the words of the said John Brown Emerson himself, of his improvement in the steam-engine:—

To all whom it may concern:

Be it known, that I, John Brown Emerson, of the city of New York, have invented certain improvements in the steam-engine, and in the mode of propelling therewith either vessels on the water or carriages on the land, and that the following is a full and exact description thereof.

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[* 439] * One object of my improvement is to substitute for the crank motion a mode of converting the reciprocating motion of a piston into a continued rotary motion, by a new combination of machinery for that purpose.

This mode is applicable to an engine either with one or with two cylinders, and is carried into effect as follows. Alongside of the cylinder I place a shaft, the lower end of which may revolve in a step on the platform or foundation upon which the cylinder stands; in which case it must be somewhat longer than twice the length of the cylinder, as it must extend above it to a height somewhat greater than the length of the stroke of the piston. Sometimes, however, this shaft may have its lower gudgeon only a small distance below the upper end of the cylinders, whence it must extend above it as before. Its upper gudgeon must of course be sustained by a suitable frame. This shaft is to stand parallel to the piston-rod, from which it is to receive its revolving motion. Upon the upper end of the shaft, above the top of the cylinder, there is to be placed a solid cylinder of wood, or of any other convenient substance, of such diameter as shall cause its periphery to come nearly into contact with the piston-rod for its whole length, when the piston is raised. The solid cylinder above described is to be made to revolve in the following manner. I make a groove in it, which commences near its lower end, and, passing spirally, extends half way round it by the time it reaches nearly to the upper end, or to a distance vertically equal to the stroke of the engine; from that point it passes down around the opposite half, and returns into itself at the point of beginning. Upon the upper end of the piston, against its side, I place a friction-roller, which is to work in the groove in the solid cylinder; the piston-rod rising between parallel guide-pieces, by which it is kept in its proper place, and its tendency to turn round by the action of the roller in the groove is checked. When the

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piston is down, this friction-roller will stand in the V formed by the junction of the grooves on the opposite sides, and as it is raised, it will in its passage to the upper junction give half a revolution to the solid cylinder, and in descending will complete the revolution by the action of the friction-roller on the other portion of the groove.

When two cylinders are used, they are to be placed parallel to each other, and at such a distance apart that the pistons of each may, in like manner, act upon the solid cylinder; the piston of one being up when the other is down. The boiler, the steam-pipe, the valves for the admission and discharge of steam, and other appendages, may be similar to some of those already in use. From the revolving shaft, already described, * a rotary motion may be communicated [* 440] to paddle-wheels, steam-carriages, or other objects.

As it is my intention, in general, to place my cylinders and revolving shaft vertically, I communicate motion to the horizontal shaft of a paddle-wheel by means of bevel-gear wheels near the lower end, or at any convenient part of the shaft; and by similar gearing, carriages may be propelled upon rail or ordinary roads.

When used for steamboats, I employ an improved spiral paddle-wheel, differing essentially from those which have heretofore been essayed. This spiral I make by taking a piece of metal of such length as I intend the spiral propeller to be, and of a suitable width, say, for example, eighteen inches; this I bend along the centre so as to form two sides, say of nine inches in width, standing at right angles, or nearly so, to each other, and give to it, longitudinally, the spiral curvature which I wish. Of these pieces I prepare two or three, or more, and fix them on to the outer end of the paddle-shaft, by means of arms of a suitable length, say of two feet, more or less, in such a position that the trough-form given to them longitudinally shall be effective in acting upon

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the water. It must be entirely under water, and operate in the direction of the boat's way; instead of metal, the spiral propeller may be formed of wood, and worked into the proper form,—the shape, and not the material thereof, being the only point of importance.

Where a capstan is required, as on board of a steamboat, I allow the upper end of the vertical shaft before described to pass through the deck of the vessel, and attach the capstan thereto, so that it may be made to revolve by the action of the shaft, using such ray-wheels and falls to connect the shaft and the capstan as will allow of their being conveniently engaged and disengaged.

What I claim as my invention, and for which I ask a patent, is the substituting for the crank in the reciprocating engine a grooved cylinder, operating in the manner hereinbefore described, by means of its connection with the piston-rod, together with all the variations of which this principle is susceptible; as, for example, a bar of metal may be bent in the form of a groove, and attached to the revolving shaft, and friction-wheels on the piston-rod may embrace this on each side, producing an effect similar to that produced by the groove. I also claim the spiral propelling-wheel, contracted and operating in the manner in which I have set forth; and likewise the application of the revolving vertical shaft to the turning of a capstan on the deck of a vessel. Not intending, in either of these parts, to confine myself to precise forms or dimensions, but to vary them in such manner as [* 441] experience or convenience may * dictate, whilst the principle of action remains unchanged, and similar results are produced by similar means.

JOHN BROWN EMERSON.

At April term, 1844, Emerson brought an action of trespass on the case in the Circuit Court of the United States for the

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Southern District of New York, against Hogg and Delamater, for an infringement of his patent-right. As one of the points decided by the Court was whether or not the allegations of the declaration corresponded with the evidence of the patent, it is thought proper to insert the declaration. It was as follows, namely: —

“John B. Emerson, a citizen of the State of New York, by Peter Clark, his attorney, complains of Peter Hogg and Cornelius Delamater, citizens of the same State, defendants, in custody, &c., of a plea of trespass on the case.

“For that, whereas the said plaintiff was the original inventor of a certain new and useful improvement, in the letters-patent hereinafter mentioned and fully described, the same being a certain improvement in the steam-engine, and in the mode of propelling therewith either vessels on the water or carriages on the land, which was not known or used before his said invention, and which was not, at the time of his application for a patent, as hereinafter mentioned, in public use with his consent or allowance. And the said plaintiff being so as aforesaid the inventor thereof, and being also a citizen of the United States, on the eighth day of March, one thousand eight hundred and thirty-four, upon due application therefor, did obtain certain letters-patent therefor, in due form of law, under the seal of the United States, signed by Andrew Jackson, then President, and countersigned by Louis McLane, then Secretary of State, bearing date the day and year aforesaid, whereby there was secured to him, the said plaintiff, his heirs, executors, administrators, or assigns, for the term of fourteen years from and after the date of the said patent, the exclusive right and liberty of making, using, and vending to others to be used, the said improvement, as by the said letters-patent in court to be produced will fully appear. And the said plaintiff further says, that the said defendants, well knowing the said several premises, but contriving, and

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wrongfully and injuriously intending to injure the plaintiff, and deprive him of the profits, benefits, and advantages which he might, and otherwise would, have derived and acquired from the making, using, and vending of the said invention or improvement, after the making and issuing of the said letters-patent, and within the term of fourteen years in said [*442] letters-patent, mentioned, to wit, on the * first day of January, eighteen hundred and forty, and on divers other days and times between that time and the commencement of this suit, at the city of New York, and within the southern district of New York, wrongfully and unjustly, without the leave or license, and against the will, of the plaintiff, made and sold divers, to wit, ten machines for propelling boats, in imitation of the said invention and improvement, or a part of the said invention or improvement, to the benefit, use, and enjoyment whereof the said plaintiff was and is entitled as aforesaid, in violation and infringement of the said letters-patent, and of the exclusive right and privilege to which the plaintiff was and is entitled as aforesaid, and contrary to the form of the statutes of the United States in such case made and provided.

“And the said plaintiff further says, that the said defendants, well knowing the said several premises, but further contriving and intending as aforesaid, after the obtaining of the letters-patent by the said plaintiff as aforesaid, and within the said term of fourteen years, to wit, on the said first day of January, eighteen hundred and forty, and at divers other times between that day and the commencement of this suit, within the southern district of New York aforesaid, wrongfully and unjustly, without the leave or license, and against the will, of the plaintiff, did make and sell divers, to wit, ten improved machines for propelling boats or vessels upon the water, constructed in a similar form and acting upon the same principle as the said machine or improvement, to the benefit,

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use, and enjoyment whereof the said plaintiff was and is entitled by his said letters-patent, as aforesaid, in violation and infringement of the exclusive right so secured to the said plaintiff by the said letters-patent as aforesaid, and contrary to the form of the statute in such case made and provided.

“And the said plaintiff further says, that the said defendant, well knowing the said several premises, but contriving and intending as aforesaid, after the obtaining of the said letters-patent by the said plaintiff as aforesaid, and within the said term of fourteen years, to wit, on the said first day of January, eighteen hundred and forty, and at divers other times between that day and the commencement of this suit, in the southern district of New York aforesaid, wrongfully and unjustly, and without the consent or allowance, and against the will, of the plaintiff, did imitate in part and make a certain addition to the said invention or improvement, to the benefit, use, and enjoyment whereof the plaintiff was and is entitled as aforesaid, in breach of the said letters-patent, and in violation and infringement of the exclusive right and privilege so secured to the said * plaintiff [* 443] as aforesaid, and contrary to the form of the statute in such case made and provided.

“ By means of the committing of which said several grievances by the said defendants as aforesaid, the said plaintiff is greatly injured, and has lost and been deprived of divers great gains and profits which he might and otherwise would have derived from the said invention and improvement in the said letters-patent described and set forth, and in respect whereof he was and is entitled to such privilege as aforesaid, and was and is otherwise damnified to the damage of the said plaintiff of ten thousand dollars, and therefore,” &c.

To this declaration, the defendants pleaded the general issue, and filed a copy of the special matters of defence to the action.

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In May, 1847, the cause came on for trial. The patent was given in evidence, when the counsel for the defendants prayed the Court to instruct the jury that the patent, thus produced in evidence by the said plaintiff, was void, for the reasons following:—

1. That the claim of the plaintiff, as set forth in his specification annexed to his letters-patent, embraces the entire spiral paddle-wheel; the claim is, therefore, too broad upon the face of it, and the letters-patent are void upon this ground, and the defendants are entitled to a verdict.

2. That the patent is void upon its face, for this,—that, purporting to be a patent for an improvement, and specifying that the invention is of “an improved spiral paddle-wheel, differing essentially from any which have heretofore been essayed,” without pointing out in what the difference consists, or in any manner whatever indicating the improvement by distinguishing it from the previously essayed spiral paddle-wheels, it is wanting in an essential prerequisite to the validity of letters-patent for an improvement.

3. That the patent is void upon its face, for this,—that it embraces several distinct and separate inventions, as improvements in several distinct and independent machines susceptible of independent operation, not necessarily connected with each other in producing the result arrived at in the invention, and the subject-matter of separate and independent inventions.

4. It appears in evidence, that the drawing and model of the paddle-wheel of plaintiff, filed and deposited originally in the Patent Office, had been lost by the destruction of that office in December, 1836, and that in restoring the record of the patent, under the Act of March, 1837, the plaintiff sent from New Orleans to the office a new drawing, to be filed on the 5th of May, 1841, together with a court copy of the letters-patent which were deposited in the office. The

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drawing was not * sworn to by the plaintiff, but [* 444] remained in the office till January 1844, when it was delivered to an agent of the plaintiff and sent to New Orleans, and sworn to by him, and filed in the department on the 12th of February, 1844. On an examination subsequently by the plaintiff, it was discovered that this drawing was imperfectly made, and thereupon a second drawing was procured by him, which he claimed and offered to prove to be an accurate one, and was sworn to, and filed on the 27th of March, 1844, an authenticated copy of which was offered in evidence on the trial by the plaintiff; which was objected to by the counsel for the defendants, but the objection was overruled and the evidence admitted, to which an exception was taken.

5. That if from the evidence the jury are satisfied that no propelling-wheels were made by the defendants between the 27th of March, 1844, the date of the alleged completion of the record of the plaintiff's patent, under the Act of March 3d, 1837, and the commencement of this suit in April following, that, upon this ground, the defendants are entitled to a verdict.

The Court charged, in respect to the instructions prayed for, that "the claim of the plaintiff was for an improvement on the spiral paddle-wheel or propeller; that, by a new arrangement of the parts of the wheel, he had been enabled to effect a new and improved application and use of the same in the propulsion of vessels; that the ground upon which the claim is grounded was this: it is the getting rid of nearly all the resisting surface of the wheels of Stevens, Smith, and others, by placing the spiral paddles or propelling surfaces on the ends of arms, instead of carrying the paddles themselves in a continued surface to the hub or shaft. It is claimed that a great portion of the old blade not only did not aid in the propulsion, but actually impaired its efficiency, and also that

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the improved wheel is made stronger. It was made a question on the former trial, whether the plaintiff did not claim, or intend to claim, the entire wheel. But we understand it to be for an improvement upon the spiral paddle wheel, claimed to be new and useful in the arrangement of its parts, and more effective, by fixing the spiral paddles upon the extremity of arms, at a distance from the shaft."

The Court further instructed the jury, that "the description of the invention was sufficient, and that the objection, that the parts embraced several distinct discoveries, was untenable."

The Court further charged, "that the damages were not necessarily confined to the making of the wheels between March, 1844, when the drawings were restored to the Patent Office, and the bringing of the suit. Such a limitation assumes * that there can be no infringement of the patent after the destruction of the records, in 1836, until they are restored to the Patent Office, and that, during the intermediate time, the rights of patentees would be violated with impunity." We do not assent to this view.

In the first place, the act of Congress providing for the restoration was not passed till 3d March, 1837; and in the second place, in addition to this, a considerable time must necessarily elapse before the act would be generally known, and then a still further period, before copies of the drawings and models could be procured. Patentees are not responsible for the fire, nor did it work a forfeiture of their rights.

The ground for the restriction claimed is, that the community have no means of ascertaining, but by a resort to the records of the Patent Office, whether the construction of a particular machine or instrument would be a violation of the rights of others, and the infringement might be innocently committed.

But if the embarrassment happened without the fault of

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the patentee, he is not responsible for it ; nor is the reason applicable to the case of a patent that has been published, and the invention known to the public. The specification in this case had been published. It is true, if it did not sufficiently describe the improvement without the aid of the drawing, this fact would not help the plaintiff. If there had been unreasonable delay and neglect in restoring the records, and in the mean time a defendant had innocently made the patented article, a fair ground would be laid for a mitigation of the rule of damages, if not for the withholding them altogether ; and the Court left the question of fact as to reasonable diligence of the patentee or not in this respect, and also all questions of fact involved in the points of the case for the defendants, to the jury.

The counsel for the defendants excepted to each and every part of the charge of the Court, so far as said charge did not adopt the prayer on the part of the defendants.

The verdict of the jury was, that the said Peter Hogg and Cornelius Delamater, the defendants, are guilty of the premises within laid to their charge, in manner and form as the said John B. Emerson hath within complained against them, and they assess the damages of the said plaintiff, on occasion thereof, over and above his costs and charges by him about this suit in this behalf expended, at one thousand five hundred dollars, and for those costs and charges at six cents.

The judgment of the Court was, that the said John B. Emerson do recover against the said Peter Hogg and Cornelius Delamater his damages, costs, and charges in form aforesaid * by the jurors aforesaid assessed, and also [* 446] three hundred and twenty-four dollars and fifteen cents, for his said costs and charges by the said court now here adjudged of increase to the said John B. Emerson, and with his assent ; which said damages, costs, and charges, in the whole amount to one thousand eight hundred and twenty-four dollars and fifteen cents.

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The cause was argued in this court, in printed arguments, by *Upton* and *John O. Sargent*, for the plaintiffs in error, and *Morton* and *Cutting*, for the defendant in error. The arguments were too voluminous to be reported *in extenso*, and it is not possible, therefore, to give more than extracts from each.

The counsel for the plaintiffs in error assigned as errors the following points.

I. The defendant in error has no patent for an improved spiral paddle wheel.

II. If the defendant's patent is for the combination of instruments described in the specification, there is no pretence that the combination has been infringed; if for several separate improved machines, it cannot be supported in law.

III. Defendant's patent is void for too broad a claim, and for not distinguishing his alleged improvement from other inventions, nor particularly specifying, as the statute requires, the particular improvement which he claims as his own invention or discovery. The case exhibits an improvement as the invention, and the claim is for the whole machine.

IV. The drawing filed March 27th, 1844, was not legal evidence of defendant's patented invention, because there was a drawing filed by the patentee on the 12th of February previous, which was by the second section of the Act of 1837, with his letters-patent, the only legal evidence of his invention, *as patented*, that could be offered in any judicial court of the United States.

V.—1. The patentee, after an alleged correction of the record of his letters-patent, by filing the second drawing, could not, in law, avail himself of that alleged correction to cover by it alleged causes of action previously accruing; and in the absence of proof of any subsequent infringements, the plaintiffs here were entitled to a verdict below.

2. Nor was he entitled to recover damages for any alleged

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infringement prior to the alleged *completion* of his record by the filing of the corrected drawing of 27th March, 1844.

VI. What was reasonable time in this case for the restoration of defendant's patent to the office, if not expressly fixed * by statute (Act of 1837, sec. 2,) was [* 447] exclusively a question of law.

Upton, for plaintiffs in error.

I. This action was brought to recover damages from the defendants below, for their asserted infringement of an alleged patent of the plaintiff for "an improved spiral paddle-wheel;" and the first question to which the attention of the Court is requested is one which is presented upon the face of the letters-patent, which constitute the basis of the action, and which are incorporated into the bill of exceptions; it is this: Has the defendant in error any such patent?

If it be manifest to this court, upon an inspection of the record and an examination of the letters-patent, that he has no grant, as patentee, of "an improved spiral paddle wheel," then it is submitted, that there is no escape from the necessity of reversing the judgment which has been rendered, awarding him damages for the invasion of such a grant. This necessity is in no manner affected, though it appear that the objection was not taken in the Court below, either at the trial or upon a motion in arrest of judgment. It is sufficient if the defect be manifest upon the record; for it would be monstrous to contend that this court is powerless, in any case, to reverse the judgment when it appears upon the record before them that the very foundation of the judgment is so incurably and fatally defective as to have been completely beyond the remedy of the party, though the objection were taken at the earliest possible stage of the proceedings. Authority can scarcely be necessary to sustain this position. But this court has decided, in the case of *Slacum v. Pomeroy*,

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6 Cr. 221, that it is not too late to allege as error in the Supreme Court a defect which ought to have prevented the rendition of the judgment in the Court below. "Had this error," say the Court, "been moved in arrest of judgment, it is presumable the judgment would have been arrested;" and "there can be no doubt, that any thing appearing upon the record which would have been fatal upon a motion in arrest of judgment is equally fatal upon a writ of error." So also *Garland v. Davis*, 4 Howard, 131.

By the bill of exceptions it appears, that, upon the introduction in evidence of the letters-patent by the plaintiff, "the counsel for the defendants did insist before the said Circuit Court, on behalf of said defendants, that the said letters-patent so produced and given in evidence on the part of the said plaintiff, as aforesaid, were wholly insufficient as the basis of the aforesaid action and claim upon the said defendants." Now, by reference to the letters-patent, [* 448] (page 7 of the record,) the *Court will perceive that the grant to the patentee, upon the face of the letters, is for "an improvement in the steam-engine," and for that alone; that it was for that alone that he solicited a patent by petition; that it was of that improvement only that he made oath that he was the original and first inventor. Such is the grant, and so is it recorded; and the public would seek in vain upon the records of the Patent Office for a patent to the plaintiff below for "an improved spiral paddle wheel."

It will not be contended that the letters, standing alone, confer any title to such an invention. But it may be said, that, inasmuch as the patentee has described a paddle wheel, and also an improved method of causing a capstan to revolve upon the deck of a vessel, as well as his improvement in the steam-engine, and claimed these, as well as his steam-engine, in his schedule annexed to the letters-patent, the grant must be construed to cover the paddle wheel and the capstan, as

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well as the steam-engine, though it be in express terms for the steam-engine only, though it was for that alone that he solicited a patent, and it was that alone that he made oath he had invented. Were this doctrine maintainable, it is obvious that it would be wholly subversive of the policy of the law, which looks as well to the protection of the public as it does to the encouragement of inventors. That the schedule annexed to letters-patent forms a part of the patent, and that they are to be construed together, is undoubtedly well established. This is the English doctrine, as well as that of our own courts; and, by a careful investigation of the authorities, it will be perceived that Mr. Phillips, in his elementary work, (pp. 224, *et seq.*) is mistaken in supposing that there is any conflict between them.

By these authorities it is decided, that the title of the invention, as contained in the patent, may be explained by its description in the specification, whenever such title is general, ambiguous, or uncertain; and the patent will be sustained in all cases, unless the patent indicate one invention, and the specification describe another and different invention. *American authorities.* — Phillips on Patents, 224, and cases cited; Sullivan v. Redfield, Paine C. C. R. 442; Shaw v. Cooper, 7 Peters, 292, 315; Evans v. Chambers, 2 Wash. C. C. R. 125; Barrett v. Hall, 1 Mason, 476; Whittemore v. Cutter, 1 Gall. 437; Evans v. Eaton, Peters, C. C. R. 341. *English authorities.* — Godson on Patents, 108, 113, and cases; Neilson v. Harford, Webster, 312, and arg.; Rex v. Wheeler, 2 Barn. & Ald. 350; S. C., 3 Merivale, 629; Glegg's Patent, Webster, 117; Russell v. Cowley, Webster, 470; Househill v. Neilson, Webster, 679.

When Mr. Phillips says (Phillips on Patents, 225) that any defect in the title may be remedied by the specification, what * he means is apparent by reference to [* 449] the cases which he cites. The description comes

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in aid of a defective title, but never can create a new title, by adding to the grant. There must be such a conformity between the title and the specification as that the former shall give some idea of the latter. It is the description of the thing patented "which is made part of these presents," not a description of something else, of which the title of the grant gives no idea.

Thus reads the patent itself. After reciting that John Brown Emerson had by petition solicited a patent for an improvement in the steam-engine, had made oath that he was the first and original inventor of said improvement, and paid the fee of thirty dollars into the treasury, it grants to him the exclusive right, &c., in the said improvement, "a description whereof is given in the words of the said John Brown Emerson himself, in the schedule hereunto annexed, and is made a part of these presents." Then follows the caption of the schedule, thus: — "The schedule referred to in these letters-patent, and making part of the same, containing a description in the words of the said John Brown Emerson himself of his improvement in the steam-engine."

No reported authority can be found in the remotest degree sustaining the proposition, that a description and claim of any thing contained in a specification are covered by the grant, though the grant make no reference to it, and the title is so entirely distinct from it as to suggest no idea of the thing described. Were this proposition tenable, then were we to strike out from this patentee's specification every word descriptive of his improvement in the steam-engine, leaving nothing but the comparatively few words descriptive of the spiral paddle wheel and the improved capstan, the grant for the improvement in the steam-engine must be construed as a grant for an improved spiral paddle wheel and an improved capstan. Now, would it not be monstrous to contend that an instrument of so solemn a character as a government grant

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of letters-patent is to be added to and enlarged by construction?

The doctrine as settled, upon every principle of construction, is the true doctrine; — that the description of the thing patented, contained in the schedule annexed to the patent, constitutes a part of the patent, and may be and should be resorted to, in construing the patent, to control the generality of the title and to explain or elucidate ambiguities or uncertainties; but that a description of a thing not indicated by the patent, not even remotely suggested by the grant or the title, can never be construed with the patent for the purpose of adding to or enlarging the terms of the grant.

* That this doctrine may be made more obvious [* 450] and conclusive, — if it be possible or desirable, — the Court is referred to the provisions of the statute under which the letters-patent in this case issued.

The inventor is required to present his petition soliciting the patent, and to make oath that he is the inventor. The statute further requires that the letters-patent shall recite the allegations and suggestions of the petition, and give a short description of the invention. This requisition was obviously for the twofold purpose, 1st, that it might appear that the proper preliminary steps had been taken by the applicant, of which the recital in the letters was proof; and 2d, that it might, on their face, be seen what was the nature and character of the grant. (Act of 1793, §§ 1, 3.) Now, did this patentee present his petition, soliciting a patent for an improved spiral paddle wheel, and make oath that he was the inventor of that improvement? If it be answered that he did, then the positive requisition of the statute is not complied with, for the patent recites the allegations and suggestions of no such petition, and gives a short description of no such invention; and for this reason the patent would be absolutely void.

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This is well established in the following cases :— *Evans v. Eaton, Peters*, C. C. R. 340; *Kneiss v. Schuylkill Bank*, 4 Wash. C. C. R. 9; *Cutting et al. v. Myers*, 4 Wash. C. C. R. 220; *Evans v. Chambers*, 2 Wash. C. C. R. 125.

If the letters-patent do recite the allegations and suggestions of the petition, then the patentee did not solicit a patent for “an improved spiral paddle wheel” or an “improved capstan;” he did not make oath that he had invented these improvements, and hence the letters contain no description whatever of these improvements, and confer no grant of an exclusive right in them upon the patentee.

(The counsel then quoted largely from the opinion of Judge Washington in *Evans v. Eaton, Peters*, C. C. R. 340.)

II. At the trial, the defendants’ counsel requested the Court to instruct the jury, “that the patent of the plaintiff was void upon its face, for this,—that it embraces several distinct and separate inventions, as improvements in several distinct and separate machines susceptible of independent operation, and not necessarily connected with each other in producing the result aimed at in the invention, and the subject-matter of separate and distinct patents.” The Court charged the jury that “the objection that the patent embraced several distinct discoveries is untenable.” In this it is respectfully submitted that the Court below erred.

(The counsel here cited and commented on *Phillips v. Inwood*, 15 How. 451.)

[* 451] *Phillips v. Inwood* on * Patents. “It is well settled, that two or more distinct machines, capable of independent operations, cannot be united in one patent.” 3 *Wheat*, 454; 1 *Mason*, 447; 2 *Mason*, 112; 1 *Story*, 290.)

III. At the trial of this case, the counsel for the defendants requested the Court to instruct the jury “that the claim of the plaintiff, as set forth in his specification annexed to his letters-patent, embraces the entire spiral paddle wheel; the claim is, therefore, too broad upon the face of it, and the let-

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ters-patent are void upon this ground." Upon this point the Court charged the jury as follows:—"It was made a question on the former trial, whether the plaintiff did not claim the entire wheel; but we understand it to be for an improvement upon the spiral paddle wheel, claimed to be new and useful in the arrangement of its parts, and more effective, by fixing the spiral paddles upon the extremity of arms, at a distance from the shaft."

IV. At the trial, the counsel for the defendants also requested the Court to instruct the jury, "that the patent is void upon its face for this,—that, purporting to be a patent for an improvement, and specifying that the invention is of an improved spiral paddle wheel, 'differing essentially from any that have heretofore essayed,' without pointing out in what the difference consists, or in any manner whatever indicating the improvement by distinguishing it from the previously essayed spiral paddle wheels, it is wanting in an essential prerequisite to the validity of letters-patent for an improvement." Upon this point the Court charged the jury as follows:—"the claim of the plaintiff was for an improvement on the spiral paddle wheel, or propeller,—that, by a new arrangement of the parts of the wheel, he has been enabled to effect a new and improved application and use of the same in the propulsion of vessels. That the ground upon which the claim is founded is this: it is getting rid of nearly all the resisting surface of the wheels of Stevens, Smith, and others, by placing the spiral paddles or propelling surfaces on the ends of arms, instead of carrying the paddles themselves in a continued surface to the hub or shaft. It is claimed that a great portion of the old blade not only did not aid in the propulsion, but actually impaired its efficiency, and also that the improved wheel is much stronger." And the Court further charged the jury, that "the description of the invention was sufficient."

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Upon these two points, it is submitted that the Court below erred. They are so connected, by reason of the peculiar circumstances of the case, that they will be presented and considered together, though they are distinct grounds of objection to the patent.

[* 452] * (The counsel then contended that the specification ought to be construed by itself, and be so clear as to be understood without resorting to evidence or any other source of information, and cited : — *English Authorities*. *McFarlane v. Price*, 1 Starkie, 199 ; *In re Nickels*, Hindmarch on Patents, 186 ; *Hill v. Thompson*, 3 Merivale, 622 ; S. C., 8 Taunton, 325. *American Authorities*. *Dixon v. Moyer*, 4 Wash. C. C. R. 69 ; *Evans v. Hettick*, 3 Wash. C. C. R. 425 ; *Lowell v. Lewis*, 1 Mason, C. C. R. 189 ; *Ames v. Howard*, 1 Sumner, 482.)

This leads to the principle in the law of patents involved in the fourth point. It is the positive requisition of the statute, and has been repeatedly considered and passed upon by the federal judicial tribunals.

Before an inventor shall receive a patent, he is required, "in case of any machine, fully to 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 shall particularly specify and point out the particular improvement or combination which he claims as his own invention or discovery." The requisition of the English law is similar in this respect.

Now, before proceeding to consider whether the patentee, in this case, has complied with this positive and salutary requisition of the law, the attention of the Court is requested to the reported cases in which the requisition has received judicial construction.

By a careful examination of these authorities, it will be found established, that, where a patent is taken out for an im-

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provement, the specification must describe what the improvement is, and the patent be limited to such improvement;—if the patent includes the whole machinery, it includes more than the patentee invented, and is therefore void;—that if the patent be for an improvement in an existing machine, the patentee must, in his specification, distinguish the new from the old, and confine his patent to such parts only as are new, and if both be mixed up together, and a patent is taken for the whole, it is void; that, however the authorities may apparently vary in pointing out the particular manner in which the patentee must specify his improvement, and distinguish what he claims as new and his invention from what was old and before known, yet that they are in perfect harmony in deciding that he must do this in some manner, and upon the face of the specification. *American authorities.* *Evans v. Eaton*, 3 Wheat. 454; *Woodcock v. Parker*, 1 Gall. 438; *Whittemore v. Cutter*, 1 Gall. 478; *Odiorne v. Winkley*, 2 Gall. 51; *Lowell v. Lewis*, 1 Mason, 182; **Barrett v. Hall*, 1 Mason, 447; *Sullivan v. Red-* [* 453] *field*, Paine, C. C. R. 441; *Evans v. Eaton*, 7 Wheat. 408; *Dixon v. Moyer*, 4 Wash. C. C. R. 69; *Isaacs v. Cooper*, 4 Wash. C. C. R. 261; *Cross v. Huntley*, 13 Wend. 385; *Head v. Stevens*, 19 Wend. 411; *Ames v. Howard*, 1 Sumner, 482; *Kneiss v. Schuylkill Bank*, 4 Wash. C. C. R. 9; *Morris v. Jenkins et al.* 3 McLean, 250; *Peterson v. Woodler*, 3 McLean, 248. *English Cases.* *McFarlane v. Price*, 1 Starkie, 199; *Williams v. Brodie*, *Davies, Patent Cases*, 96, 97; *Manton v. Manton*, *Davies, Patent Cases*, 349; *Hill v. Thompson*, 8 Taunton, 325; *Minter v. Wells*, 1 Webster, 130; *Rex v. Nickels*, *Hindmarch on Patents*, 186.

Now apply the rule of law, as prescribed by the statute and construed by these authorities, to the patent in this case. Admit that rule, as most liberally stated, in any reported decision, and the counsel respectfully asks, in what manner,

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upon the face of the patentee's specification, has he distinguished that which he claims as new, and his invention, from what was old and before known, or pointed out in what his improvement consists? It is most confidently answered, that he has done this in no manner whatever, neither expressly nor by implication, nor by any reference, and it is not in the wit of man to determine, upon the face of the specification, what the improvement is which the patentee claims or intended to claim. The Court below, in their construction of the claim, in charging the jury, say, that the improvement consists "in a new arrangement of the parts." Does this appear, either in terms, or even impliedly, upon the face of the description? So far from this, the last words of the patentee, in his description, are, that the "shape" of the thing is the "only point of importance." The Court further say, that this new arrangement of the parts consists in "getting rid of nearly all the resisting surface of the wheel of Stevens, Smith, and others, by placing the spiral paddles or propelling surfaces on the ends of arms, instead of carrying the paddles themselves in a continued surface to the hub or shaft."

Where, upon the face of the description, is there any mention made of Stevens's, Smith's, or of any previously invented wheel, save in the general declaration by the patentee, that his improved wheel "differs essentially from any which have been heretofore essayed,"—a declaration which the Court, in the case of *Barrett v. Hall*, above cited, declare to be "no specification at all?" And where, upon the face of the specification, is there the most remote allusion to the "getting rid of resisting surface?"

V. At the trial of the case, "it appeared in evidence [* 454] that the drawing and model of the paddle wheel of the plaintiff, filed and deposited originally in the Patent Office, had been lost by the destruction of that

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office in December, 1836, and that, in restoring the record of the patent, under the Act of March, 1837, the plaintiff sent from New Orleans to the office a new drawing, to be filed on the 5th of May, 1841, together with a Court copy of the letters-patent, which were deposited in the office. The drawing was not sworn to by the plaintiff, but remained in the office till January, 1844, when it was delivered to an agent of the plaintiff, and sent to New Orleans, and sworn to by him, and filed in the department on the 12th day of February, 1844. On an examination, subsequently, by the plaintiff, it was discovered that this drawing was imperfectly made, and thereupon a second drawing was procured by him, which he claimed and offered to prove to be an accurate one, and was sworn to and filed on the 27th day of March, 1844, an authenticated copy of which was offered in evidence on the trial by the plaintiff, which was objected to by the counsel for the defendants; but the objection was overruled, and the evidence admitted, to which an exception was taken."

It is contended, that the Circuit Court erred in admitting in evidence the second drawing of March 27th, 1844, and in support of this position, the following considerations are respectfully submitted.

(The counsel then urged, —

That the patentee had exhausted his privilege, when he swore to the first drawing.

That, if allowed to file more than one one, he might continue to file them down to the day of trial.

That the first drawing became, by the statute, *prima facie* evidence of the invention, and there could not be two such.

That if this patentee had procured a reissue of his patent, under the third section of the Act of 1837, he would not have been entitled to the privilege which he now claims, and it is

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unreasonable to suppose that Congress intended to give greater privileges under one section than another.)

VI. At the trial of this case, the counsel for the defendants requested the Court to instruct the jury as follows: — “that if, from the evidence, the jury are satisfied that no propelling wheels were made by the defendants between the 27th of March, 1844, — the date of the alleged completion of the record of the plaintiff’s patent, under the Act of March 3d, 1837, — and the commencement of this suit in April following, that, upon this ground, the defendants are entitled to a verdict.”

The Court refused to grant this prayer, and left it, as a question of fact, for the jury to say, whether there [* 455] had or had * not been unreasonable delay on the part of the patentee in restoring the record. Now, was this a question of fact? It is submitted, that it was not, but that, under the circumstances, it was purely a question of law, to be passed upon by the Court.

The record shows, that, from the burning of the Patent Office, in December, 1836, up to the month of May, 1841, no step whatever was taken by the patentee to restore the record of his patent, and that he then delayed to complete the record until the month of February, 1844. Of course, there could have been no dispute as to the fact in connection with the question of reasonable or unreasonable diligence. Now, the authorities are clear in establishing this doctrine, — that, when there is no dispute as to the facts, the questions of reasonable or unreasonable time, or delay, or diligence, are questions of law for the Court, and not of fact for the jury. The following cases are referred to: — *Ellis v. Paige*, 1 Pick. 43; *S. C.* 2 ib. 71, 77, note; *Gilbert v. Moody*, 17 Wend. 354; *Reynolds v. Ocean Ins. Co.*, 22 Pick. 191; *Livingston & Gilchrist v. Maryland Ins. Co.*, 7 Cr. 506.

And now as to the charge of the Court, that “the damages

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were not necessarily confined to the making of the wheels between March, 1844, when the drawings were restored to the Patent Office, and the bringing of this suit." Is not this error? Why was the drawing of March 27th, 1844, filed in the Patent Office? For the reason only, as avowed, that the drawing of February preceding was incorrect and defective. For the reason only, that the public had no notice, or, what is still worse, that the public had an imperfect and deceptive information, by the first drawing of the particulars of the patentee's invention. Would it not be monstrous to allow a patentee to recover damages for an alleged infringement made at a time when, by his solemn oath, he declares that the defendant was not notified of the character of his invention? — nay, more, when he swears, that, at the time of the alleged infringement, the only recorded notice of his invention, sworn to by himself, was imperfect, incorrect, and insufficient?

But by an examination of the grounds upon which the Court rest their decision upon this question, it will be seen in what manner the error has arisen. The Court say, the limitation contended for by the defendants "assumes that there can be no infringement of the patent after the destruction of the records in 1836, until they are restored to the Patent Office, and that, during the intermediate time, the rights of patentees would be violated with impunity." With the greatest deference, it will appear, upon a consideration of the statute provisions, that the doctrine contended for involves no such assumption.

* The second section of the Act of 1837, provides [* 456] for the very difficulty which is urged by the Court as the sole objection to the limitation contended for. Foreseeing that some time must necessarily elapse before patentees could be informed of their rights and duties, and prepare copies of their patents and drawings and models, Con-

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gress has provided, in this section, that, from the 15th of December, 1836, when the Patent Office was burned, to the 1st day of June, 1837, and not after, patentees and others may give in evidence their patents in any Court, notwithstanding that they have not been re-recorded, and no verified drawing of the invention has been filed in the Patent Office.

Is there not great danger, in the disposition to give the most liberal and enlarged interpretation to statute provisions for the protection and encouragement of inventors, that the rights of the public may be too much disregarded ?

By the burning of the Patent Office, something more was involved in the loss of the evidences of the rights of patentees. The public were thereby deprived of the only notice which the law recognizes of what they could and what they could not do, without being subjected to prosecutions for invasions of patent-rights. For the public, in the language of Judge Washington, in a case before cited, " can depend upon no other information, to enable them to avoid the consequences of litigation, than what the records may afford. No description of the discovery, secured by a patent, will fulfil the demands of justice and of the law, but such as is of record in the Patent-Office, and of which all the world may have the benefit."

Now Congress, in legislating to repair the loss of the Patent Office, and to provide against its natural consequences, had in view the protection of the public, as well as patentees ; and while, on the one hand, it was justly considered that patentees ought not to suffer by reason of a loss arising from no fault of theirs, on the other, it was as justly considered that the public ought not to suffer by reason of a too long delay on the part of patentees to furnish to the public anew the recorded descriptions of their inventions. Thus the second section of the Act of 1837, saving the rights of patentees, en-

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ables them to recover damages for infringements after the burning of the Patent Office, and down to the month of June, 1837, notwithstanding the non-existence of any public record of their inventions; but, saving the rights of the public, the statute gives no further time.

Is not this clear? And being so, is it not manifest that the Court below erred in the instructions given to the jury upon this point?

The drawing of the patentee, annexed to his [457] patent, or referred to in his specification, constitutes a part of the patent, and oftentimes, as in this case, is the most material portion of the description, — without which the invention would be virtually undescribed. Now, when a patentee alters or amends his patent, whether in the *written* description or the *delineated* description, there is nothing better established than that he cannot recover damages for an alleged infringement committed prior to such amendment. The authorities to this point are conclusive, and in perfect uniformity; some of them, and those the most recent, going so far as to maintain that it makes no difference though the amendment be of a mere clerical error. *In re* Nickels, Turner, & Phillips, 44; S. C., 1 Webster, 659; Hindmarch on Pat. (Eng. ed.) 216 *et seq.*; *Wyeth v. Stone*, 1 Story, 290; *Woodworth v. Hall*, 1 Min. & W. 248, 389.

It is submitted, that a denial of the doctrine here urged on behalf of the plaintiffs in error would be equivalent to an abrogation of the provisions of the thirteenth section of the Patent Act of 1837, which declares that a patent can only be amended by a surrender and reissue, and that the amended patent can only operate upon causes of action accruing subsequently to the amendment.

Construe the first section of the Act of 1837 as the Court below has construed it, and what is the consequence? A patentee, whose grant is dated on or before the 14th of Decem-

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ber, 1836, may maintain actions for infringement of his rights from then to the present time, without any public record of his patent whatsoever being in existence during the entire period, provided he produces at the trial an authenticated copy of his patent and drawings from the Patent Office, recorded there, perhaps, but the day before! From this consequence, it is submitted, there could be no escape, and small, indeed, would be the hope of escape for the innocent invader of the unrecorded right, with the question of reasonable diligence in the restoration of the record left to the decision of a jury.

Morton and Cutting, for the defendant in error.

I. The first point raised by the plaintiffs in error does not properly arise. The jury rendered a verdict for \$1,500 damages. The amount in controversy being less than \$2,000, the defendants below had no right to remove the cause to this Court. They moved the Circuit Court for a new trial upon a case made, which motion was denied, and judgment was docketed upon the verdict. The defendants below then applied to the Circuit Court for the allowance of a writ of error, under the 17th section of the Act of Congress, [* 458] approved July 4, 1836, * which authorizes writs of error in patent cases to the Supreme Court of the United States, in the same manner, and under the same circumstances, as was then provided by law in other judgments and decrees of Circuit Courts, "and in all other cases in which the Court should deem it reasonable to allow the same."

Having no right to a writ of error, therefore, unless the judges of the Circuit Court "should deem it reasonable to allow the same," application for the writ was made to the discretion of the Court; and the application was granted so far as to allow the defendants to raise, for the consideration of the Supreme Court, five points specified by the Court be-

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low, and which constitute the 2d, 3d, 4th, 5th, and 6th points now presented by the plaintiffs in error.¹ The defendants availed themselves of the permission to issue a writ of error, restricted as above stated, and now, after the writ has been allowed, they seek to argue a question not embraced in those specified by the Court.

It is respectfully submitted, that this course ought not to be encouraged, and that the grounds discussed in the first point taken by the plaintiffs in error need not be considered by the counsel for the patentee. It may be briefly remarked, however, that the point referred to was not raised at the trial, and does not appear upon the face of the record, or even upon the bill of exceptions. It was insisted below, that the patent was void for the reasons specified in the bill of exceptions. The Court will search in vain for the question attempted to be discussed by the counsel for the plaintiffs in error in his first point.

Even if it were raised by the bill of exceptions, and were a point that could be argued here, it would be untenable. The argument appears to be, that the patentee has no patent for "an improved paddle wheel," because the title of the grant

¹ Writ of error allowed in respect to the question:—

1. Whether the patent is void as embracing two or more distinct and independent inventions or improvements.

2. Whether the claim is for an entire paddle wheel, or only for an improvement.

3. Whether the new is sufficiently distinguished from the old.

4. Whether the corrected drawing was properly allowed and filed.

5. Whether the rule of damages was correct, on condition that case be submitted on written argument to Supreme Court at an ensuing term, before 1st February, and judgment to be secured by filing the usual bond.

A copy of Judge Nelson's indorsement on petition for writ of error.

ALEX'R GARDINER, *Clerk.*

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is for an improvement in the steam-engine, and the counsel for the plaintiffs in error argues as if the letters and the schedule were not a part of the same instrument. By taking the whole patent together, that is, the letters and the specification, [* 459] there can be no difficulty in ascertaining the extent of the patent. It grants to the patentee the right "of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said patentee himself in the schedule hereto annexed, and is made a part of these presents."

Thus the schedule is made a part of the patent, as much as if it were recited in the letters themselves. The grant is for the improvement described in the schedule, — and by referring to the schedule, the improved paddle wheel is distinctly embraced as a part of the claim.

In the construction of patents, the schedule annexed must be always kept in view, and resorted to in order to ascertain what is the invention claimed and patented. If the claim or specification be more extensive than the actual invention, the patent may be void in part or in whole for that reason; but there can be no doubt that, *prima facie*, the patentee has a grant for all that he claims in the schedule annexed to his patent. The description in the letters of the thing invented is always very brief, because it points to and incorporates the patentee's specification and description annexed, and which usually sets forth minutely the whole claim.

The argument on the other side, as to the effect of a variation between the title of the patent and the thing patented and described in the schedule, assumes that a good and perfect specification and description of the invention claimed by the patentee may be utterly defeated by a defect in the title, so that a specification and claim free from all ambiguity will be rendered utterly worthless by a defect in what the counsel

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terms "the title" of the patent. A rule of construction so harsh and unreasonable would be most destructive in its consequences. If applied to the interpretation of statutes, it would nullify many of them that are free from doubt; not many of the acts of Congress would stand, if defective titles were declared to be fatal to the laws themselves.

The Patent Act of 1793, section first, provides that the Secretary of State may cause letters-patent to be granted, "giving a short description of said invention or discovery." When the patentee presents his specification, it is referred to in, and made a part of, the patent, and it is from the patent, with schedules and drawings taken together, that it is to be determined what thing is intended to be patented. *Pitt v. Whitman*, 2 Story, 621. Any defect in the title is remedied by a proper description in the schedule. *Barrett v. Hall*, 1 Mason, 477; *Whittemore v. Cutter*, 1 Gall. 437; *Phil. Pat. 224, 225*.

*In England, the rule appears to be different. [*460] There the patent is distinct from the specification, and controls it in construction, so that the patentee cannot cover any thing by the specification which is not embraced in the patent. *Campion v. Benyon*, 3 Brod. & Bingh. 5; *The King v. Wheeler*, 2 Barn. & Ald. 345.

II. But the plaintiffs insist, that the patent "is void, for the reason that it embraces several distinct and separate inventions, as improvements in several distinct and independent machines susceptible of independent operation, not necessarily connected with each other in producing the result arrived at in the invention, and the subject-matter of separate and independent inventions."

It is clear from the specification, that the patentee claims to have discovered an improvement in the steam-engine, and with it, in the mode of propelling vessels. He substitutes for the crank motion a mode of converting the reciprocating

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motion of a piston into a continued rotary motion, by a new combination of machinery for that purpose. From the revolving shaft described by him, a rotary motion may be communicated to paddle wheels or other objects. When used for steamboats, the patentee employs the improved paddle wheel described by him, which is necessarily to be worked in connection with the other machinery. When a capstan is required, as on board of a steamboat, he describes the mode of connecting the shaft of the engine with the capstan, so that it may be made to revolve by the action of the shaft; and he claims as his invention the substituting for the crank, in the reciprocating engine, a grooved cylinder, operating as described; the paddle wheel constructed and operating as set forth; and the application of the revolving vertical shaft to the turning of a capstan.

Now it is manifest that the invention is a mechanical unity. The improved engine and paddle wheel are intended to act together, and if a capstan be used, the improved engine is made to connect with and turn the capstan, as it does the paddle wheels. Although the engine may be applied to the old-fashioned wheel, and though it may or may not be attached to the capstan, yet it is manifest that the improved engine connected with the paddle wheel, or with a capstan, may be used in connection to produce or aid the result designed by the patentee, namely, the propulsion or navigation of a vessel.

(The remainder of the argument upon this head is omitted.)

III. The defendants prayed the Court to instruct the jury, "that the claim of the plaintiff, as set forth in his specification annexed to his letters-patent, embraced the entire spiral paddle wheel; that the claim was, therefore, too broad upon the face of it, and the letters-patent were void upon that ground.

[* 461] * The Court charged the jury, that "it was made

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a question on the former trial, whether the plaintiff did not claim or intend to claim the entire wheel; but we understood it to be for an improvement upon the spiral paddle wheel."

The counsel for the plaintiffs in error supposes that the Court below arrived at this conclusion, not from the face of the patent, but from matters *dehors* the specification. This assertion is unfounded. The view of the Court below is the result of a just construction of the patent itself.

It is difficult to perceive by what course of argument the patent can be shown to be too broad upon its face. By the expression "too broad," I presume, it is intended that the patentee claims more than he has invented. This is usually a question of fact, dependent upon the proofs at the trial. The face of this patent certainly does not disclose the fact, that the patentee has a grant for any thing of which he does not claim to have been the inventor. The counsel for the plaintiffs has not discussed this point, except so far as his observations under his fourth point may be applicable to it; and it is therefore not deemed necessary here to enlarge further upon this branch of the case, except to observe that the patentee does not claim to be the inventor of paddle wheels," nor of "wheels acting on the spiral or screw principle;" on the contrary, he refers to wheels previously "essayed," upon which wheels the patentee claims to have improved. What he does claim, then, is an improved spiral propelling-wheel, constructed and operating under water in the manner described, which improvement, as described in the schedule, is new, and is the invention of the patentee.

IV. It is insisted, that the Court below ought to have charged the jury as prayed for; namely, "that the patent is void upon its face for this, — that, purporting to be a patent for an improvement, and specifying that the invention is of an improved spiral paddle wheel, differing from any which

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have heretofore been essayed, without pointing out in what the difference consists, or in any manner whatever indicating the improvement by distinguishing it from previously essayed spiral paddle wheels, it is wanting in an essential prerequisite to the validity of letters-patent for an improvement."

The Court refused so to charge, and held that the description of the invention was in this respect sufficient.

The point now raised is one purely technical, because it must be assumed after verdict, and upon the bill of exceptions, that the patentee was the real inventor of what he claims; that *de facto* he has not claimed as new that which had been known before; that the improvement is useful, and that the specification is so full and clear, and free [* 462] from ambiguity, that * any mechanic skilled in the art of making propellers could, by following it, construct the thing patented.

But however meritorious the invention may be, yet it is contended that the patent ought to be adjudged void, because it does not point out the difference between the improved propeller and all other propelling-wheels previously essayed.

The object of pointing out the old from the new is, that the public may be informed what the party claims as his invention, and may ascertain if he claims any thing in common use.

The law does not require that he should describe the various paddle wheels then known, or point out the differences between them and his improvement; such a rule, even if practicable, would be too onerous to be endured. Take, for example, a patent for an improvement upon all stoves previously essayed; it would be unreasonable to prescribe that the specification should describe all the stoves in use, or that had ever been essayed, and that it should point out the difference between them and the particular improvement; such requirement would be impracticable. When Emerson ap-

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plied for his patent, in 1834, there were a very great number of paddle wheels and propellers known, or which had been essayed, many of which had been patented in this country and in England. Now, it was not necessary for him to have described all these various wheels and propellers. It is enough if he has specified his own improvement; and if he has done so in an intelligible form, his patent is good on its face, although, when tested by evidence *dehors* the patent, it might appear that he has claimed what was old, and thus his patent might be defeated.

In *Evans v. Eaton*, (7 Wheat. 435,) the rule is thus expressed: — “We do not say that the party is bound to describe the old machine, but we are of opinion that he ought to describe what his own improvement is, and to limit the patent to such improvement. The law is sufficiently complied with by distinguishing in full, clear, and exact terms the nature and extent of his improvement only.”

Most of the authorities cited by the counsel for the plaintiffs in error, under his fourth point, are referred to by Phillips, in his work on Patents, and the rule that he deduces from them is thus stated, at page 269: —

“In specifying an improvement in a machine, it is often necessary to describe the whole machine as it operates with the improvement, in order to make the description intelligible, and enable an artist to construct the machine, as the inventor is bound to do in his description, and which if he fails to do, he falls into the fault of obscurity; on the other hand, if the whole * machine, as well the old as the [* 463] new part, be thus described, it is requisite to distinguish what part the patentee claims, since, if this does not satisfactorily appear, the patent will, as we have seen, be void for ambiguity; or if the obvious construction is, that he claims the whole machine in its improved state, the patent will be void by reason of the patentee’s claiming too much. The

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mode of expression generally used in the books, in relation to this subject, is, that the specification must distinguish the old from the new. The only object of this distinction is, however, to specify what the patentee claims, and the mere discrimination of the new from the old would not necessarily show this, for perhaps he does not claim all that is new. When the cases say, therefore, that the specification must distinguish the new from the old, we must understand the meaning to be, that it must show distinctly what the patentee claims, the only object of this distinction being for this purpose. This doctrine is illustrated by some of the cases already stated, and it runs through them all wherein this question arises."

Most of the patents describe the improved machine only, as will be seen by referring to the specifications in the Patent Office, and to the reports of patent cases.

It has been, of late years, the practice of the courts of this country to give effect to patents, if possible, rather than to destroy them; and to this end, mere technical objections are no longer encouraged. The rigorous rules of the English courts, and of some of our earlier cases, by which meritorious patents were frequently overturned, have given place to more liberal and enlightened principles.

(The remainder of the argument upon this head is omitted.)

V. The authenticated copy of the corrected drawing, filed in the Patent Office on the 27th of March, 1844, was correctly admitted.

The original drawing, filed with the patent in 1844, had been destroyed by fire; the patentee could not of course produce the original, and he therefore resorted to the next best evidence that the nature of the case permitted; this consisted of a copy which the plaintiff below offered to prove to be an accurate copy of the original; and this copy so offered was duly authenticated in the manner provided by the first and second sections of the Act of March 3, 1837.

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Upon the strictest principles of the law of evidence, the plaintiff below was entitled to prove what the original drawing really was. The original being lost, the next best evidence of it was an exact copy, proved to be accurate.

This proof would have been admissible and proper, irrespective * of the Act of 1837, and [* 464] whether the copy so offered was a record of the Patent Office or not. Suppose the Act of 1837 had never been passed, and the plaintiff had proved the destruction of the original drawing, he might have produced upon the trial a copy of it; and after proof that it was a true copy, he would have entitled himself to read it in evidence.

But there can be no reasonable doubt that the corrected drawing, filed on the 27th of March, 1844, was properly received by the Patent Office, and that an authenticated copy thereof was admissible as evidence under the provisions of the Act of 1837.

That act was remedial in its character; its object was to restore the records, and to repair the loss occasioned by the fire. To that end, it was of the highest public importance that the specifications and drawings should be correctly and accurately restored. To have received imperfect or inaccurate copies would have increased, and not have remedied, the mischief, and to assert that the Patent Office had exhausted its power to restore models and drawings by the reception of what were not copies or true representations of the originals would be to give a construction to the statute that would defeat its object.

The first section declares, "that it shall be the duty of the commissioner to cause the copies offered by the patentee, or any authenticated copy of the original record, specification, or drawing, which he may obtain, to be transcribed," &c. It is not only within the powers of the department to receive corrected drawings or models, in place of those that prove to

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be inaccurate or imperfect, but it is the duty of the commissioner to obtain exact substitutes for the originals, if possible; and if those already filed are shown to be erroneous, imperfect, or untrue delineations of the originals, it is the duty of the commissioner to replace them with corrected copies. In this way only can the objects of the act be accomplished. To deny this power would be to perpetuate errors.

VI. The Court below properly refused to charge the jury that the defendants were not entitled to a verdict, if they were satisfied that no propelling-wheels were made between the 27th of March, 1844, and the commencement of the suit.

The defendants excepted to the charge so far only as it did not adopt the prayer insisted on by them.

The prayer upon this point insists that the defendants were entitled to a verdict, if no wheels were made by them after the 27th of March, 1844, no matter how often they had infringed the plaintiff's patent prior to that date. It assumes that all persons may, with impunity, infringe upon all or any patents intermediate between the destruction by [* 465] fire of the records of the Patent * Office, and the complete restoration of them under the Act of 1837.

If the principle contended for be sound, then the patentee has no remedy for wilful and deliberate violations of his patent committed intermediate the destruction of the records of the Patent Office and the complete restoration of them, no matter how public and notorious the patent may have become, and no matter how extensively the patent may have been published and circulated in works of art or otherwise.

This principle cannot be sound; and the defendants' prayer and exception raise no other question. The prayer assumes the broad ground, that there is no liability for infringements committed prior to the restoration, not only of the patent itself, but of the drawings, and that the patentee is not entitled even to nominal damages.

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The patent, in the present case, had been restored and recorded anew long before the 27th of March, 1844, namely, in the year 1841; the recorded copy of the specification and claim was correct, and disclosed the patentee's right; and yet the Court was asked in effect to charge the jury, that infringements might be perpetrated with impunity at any time after the fire, and at any time after the recording anew of the letters and schedule, until the 27th of March, 1844. The letters-patent were published in the Franklin Journal in 1834, were filed anew in 1841, and of themselves were sufficient to protect the patentee, even if the restoration of the drawing had been imperfect.

The views of the learned judge in his charge need no illustration; he charged the jury as favorably for the defendants as they had a right to request.

The complaint of the counsel for the plaintiffs in error, that the Court left the question of unreasonable delay, on the part of the patentee, in taking measures to restore his records to the jury, is not properly urged, upon the present writ of error, because,—

1. It is not one of the five points that the Court below allowed to be raised.

2. That part of the charge was not excepted to at the trial, and, on the contrary, the exception was limited to the point taken in the defendant's prayers.

3. Even if this point were properly before the Court, it is clear that the question whether the patentee had been guilty of unreasonable delay and neglect in restoring the records was a question of fact upon the evidence then before the Court

It was a question of fact, submitted to the jury for the benefit of the defendants below; for if there had been such neglect or delay, the Court instructed the jury, that, if the defendants * had innocently made the pa- [*466]

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tented article, it would be a fair ground for a mitigation of the rule of damages, if not for the withholding them altogether.

The charge was as favorable to the defendants as the law and the evidence would permit.

John O. Sargent, for the plaintiffs in error, in reply and conclusion.

It is objected to the first point raised by the counsel for the plaintiffs in error, that it is not properly presented to the Court, though it is admitted to arise upon the record. The argument is, that the Court below intended to restrict the plaintiffs to the consideration of certain specified questions. True it is, that the Court struck out from the bill of exception several points on which the plaintiffs relied ; but the object of the Court in so doing is misapprehended. It was the purpose of the Court merely to disembarass and relieve the record of objections which they considered ill-taken, and the discussion of which they deemed unnecessary. That, besides this limitation, of which the plaintiffs have not complained, it was the intention of the Court to cut them off from their right of dealing with this record according to law, is not to be presumed or implied. No doubt whatever is entertained by the counsel for the plaintiffs, that the objection is well raised on the record, and that it is fatal to the defendant's claim.

I. The point made is, that the defendant in error has no patent for an improved spiral paddle wheel.

The learned counsel for the defendant is mistaken in supposing that the argument of plaintiffs' counsel proceeds upon the idea, that the letters-patent and the specification are not parts of the same instrument. The specification forms a part of the patent, and they are to be construed together, but construed with reference to the fundamental principle of interpretation, *Quoties in verbis nulla ambiguitas, ibi nulla ex-*

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positio contra verba fienda est, — or, as it is sometimes laid down in the books, “No construction shall be made contrary to the very express words of a grant.”

In construing this instrument, we must look to the situation of the parties, and the mode in which it was prepared. The formal letters-patent speak the language of both parties. In the instrument of grant, there is nothing equivocal or ambiguous. It is not capable of being misunderstood. No ingenuity can extort a double meaning from it. Mr. Emerson made oath that he was the inventor of an improvement in the steam-engine; solicited a patent for said improvement; received a patent reciting the exclusive privileges vested in him in said *improvement, and making [* 467] the description of said improvement contained in the schedule annexed a part of his patent. All this must be taken as absolute truth. The patentee claiming under this instrument is bound by its recitals, and estopped from denying any thing that it alleges. The letters-patent in fact, are the joint production of the grantor and grantee. The Secretary of State adopted the description of his improvement which the grantee furnished in his petition. The entitling of the schedule is debatable ground. This may have been the work of the grantee alone, or of a clerk in the department. In either event, it indicates the intention of the parties, and, as if to exclude the possibility of the grantee's taking an exclusive privilege to any other thing than that contemplated and expressed in the patent, the heading or title of the schedule recites, in effect, that said schedule is made a part of the patent, so far as it contains a description of the improvement in the steam-engine, and no farther.

The language of the parties indicates plainly enough what was intended to be granted, and what was actually granted. Then comes the descriptive part of the schedule, or the specification, in the words of the grantee alone. This contains a

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particular description of the improvement in the steam-engine secured by the patent. It then describes an application of this improved engine to turn the capstan on the deck of a vessel; and an improved spiral paddle wheel, alleged to differ materially from those previously essayed. Now, the ground taken by the counsel who opened this case is simply this,—that Mr. Emerson cannot, by the introduction of new matters in his specification, make his patent operate as a grant for the improvement mentioned in his petition, oath, and letters; and also as a patent for other things not mentioned in such petition, oath, and letters. It is respectfully submitted, that such is clearly the law.

It is presumed that there is no difficulty in the Court's taking judicial notice of any thing involved in the construction of a patent, which a judge at *nisi prius* would know without the aid of a jury. If this view is correct, the Court will know that an improved steam-engine is not an improved paddle wheel, and was not at the time this patent was issued. This being so, the improved spiral paddle wheel is not only not in terms included in this patent, but is by legal implication as absolutely excluded from the patent as if it were excluded in express terms. In the fair, natural, obvious interpretation of this grant, collecting its meaning from the terms used in it, understood in their plain, ordinary, and popular sense, the improved steam-engine is the subject, and the sole [* 468] subject, of Mr. Emerson's * patent. Apply these principles, which, in the language of a learned and eminent judge, furnish a "rule of construction which applies to all instruments," and they establish beyond a question that Mr. Emerson has no grant for an exclusive privilege in a spiral paddle wheel.

And, first, because the force of the schedule is thus restrained in express terms by the patent, and these terms are the language of both parties. Again, because the language

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of the schedule is throughout the language of the grantee alone, and binds the grantor only so far as it has been expressly, or by necessary implication, adopted by him. Now the duty of the Secretary of State, under the Act of 1793, was purely ministerial. He took no such judicial cognizance of specifications as is now rigidly exercised by the Commissioner of Patents. The grantee might have included many distinct machines in his schedule, and the Secretary of State was not called upon to notice the fact, did not notice it, and could not have prevented it. The patent was within his control, and the schedule so far as it was made a part of the patent, but not otherwise. He could so far restrict it as to limit its effect to the description of the thing patented, and to that extent he did in fact, in express terms, limit it. Beyond this he had no jurisdiction. The same is true of the Attorney-General. It was his duty merely to see that the patent purported to embrace but one improvement, and that the specification was signed by the patentee, and attested by two witnesses. His duty was then discharged, and he certified to the patent's being conformable to law. Now, is it not against reason, and therefore against law, to say that such a schedule, made by the grantee alone, and not examined by the grantor, is, in any other respect, and to any greater extent, operative in conferring exclusive privileges, than it is made so by the mutual assent of the parties, expressed in their common and joint language in the patent itself? Can such recklessness and improvidence in the issue of its grants as a different construction would establish be attributed to any government? If the schedule had contained the specification of a spiral paddle wheel alone, would it have been patented under the terms of this grant? Would the patentee in that case have complied with that provision of the statute of 1793, which required him to "recite" his invention in his petition? Would his oath to the invention of an improved steam-engine

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then have covered the invention of a spiral paddle wheel? And if not in that case, why in this? Does the mere fact of describing the improved steam-engine in the schedule, incorporate in this patent an improved paddle wheel, which would not have been incorporated if the improved steam- [* 469] engine had been * omitted altogether? If such is the construction to be put upon these instruments, the secretary might as well have issued his letters-patent in blank, and suffered individuals to fill them up at their pleasure. The petition, the oath, the description, the grant, the signing by the Secretary and President, the reference to the Attorney-General, were all superfluous. But, say the counsel for the defendant in error, the schedule is a part of the patent, and if the schedule contains a description and claim of a machine, that machine becomes the subject of the exclusive privileges granted by the patent, just as much as if the inventor had petitioned for, sworn to, paid for, and received a patent for the same. This understanding of the matter would have been a very convenient one for a patentee under the law of 1793, because it would have enabled him to include in his letters the inventions of others, without incurring the penalties of perjury; and as many of them as he pleased at the expense of a single fee. With all deference, but with all confidence, it is repeated, that the schedule is so far a part of the patent as it contains a description of the thing patented, and no farther. It is the description of the improvement patented contained in the schedule, which is the specification that forms a part of the patent. It is in this view that the language of the Court is to be applied, when they say that the specification is a part of the patent, and that the whole is to be taken together, and construed as one instrument. As a general thing, under the law of 1793, the schedule contained only such a specification; in contemplation of law it never can contain any other; if it contains any thing more, the ex-

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cess is surplusage. If it does not vacate the patent, it is at least inoperative, — it cannot enlarge the grant.

On the English cases there would be no doubt on this point. For the non-conformity between the title in the patent and the description in the specification, the patent would be declared void on two grounds: — 1st. For the false suggestion in the petition. 2d. For the claim in the specification of an improvement not within the true meaning and extent of the grant.

Either of these objections would render a patent in England absolutely void: — 1st. Because the crown has been deceived. 2d. Because the inaccurate title is calculated to deceive the public.

These consequences flow, not from any special provision in the English patents or statutes, but from principles of the common law applicable to all public grants. These principles apply with equal force to public grants of the United States, unless there is some provision in our patents as issued, or in * our statutes on this subject, rendering them inapplicable. It is submitted, with all deference, that no such provision can be found, and that the reasons for sustaining them in their full effect are stronger under the system established by our Act of 1793, than under the English system.

(The remainder of the argument upon this head is omitted.)

II. It is again objected by the counsel for the defendants in error, that there is nothing in the exception to the ruling of the Court in regard to the insertion of several claims for distinct and separate machines in the specification.

The case of the defendant is obviously very much distressed by this point, and his counsel protest strongly that the inventions described exhibit a “mechanical unity,” being all a means of propelling vessels. To maintain this proposition they resort to a very extraordinary mechanical discussion, to

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show that, by means of the capstan, without regard to the motive power of the engine, they could propel a vessel. If this be so, and the counsel should present their argument to the Commissioner of Patents in the shape of a specification, they might readily obtain a patent for it if a new and useful invention. They think, if a vessel with Mr. Emerson's machinery on board should be becalmed, without fuel, that, by applying "the motive power" by manning the capstan, motion would thereby be communicated to the propeller. The answer to this is, that no such application is contemplated by the patentee; and to arrive at it the learned counsel is compelled to sever and destroy his mechanical unity, by leaving the steam-engine useless for the want of fuel.

The question is now, for the first time, distinctly presented to this tribunal, and the doctrine on this subject is to be settled by the judgment of the Court in this case. It is a question of no inconsiderable public importance, and it is desirable that it should be adjudicated on plain and substantial grounds. All inventions are supposed to conduce more or less to one common object, to wit, the benefit of the public. This common purpose is probably too remote to sustain the introduction of all manner of inventions into the same patent; but, for all practical purposes, it is precisely as proximate and tenable as the common purpose claimed for the patentee in this case.

It is most humbly submitted, that the doctrine of this Court, as suggested in *Evans v. Eaton*, is the true doctrine on this subject: — "On the general Patent Law a doubt might well 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 [* 471] in * combination." This language obviously contemplates a case in which the machines patented

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might be used in combination ; and the whole force of Mr. Justice Marshall's very sound and pregnant suggestion is destroyed the moment the converse of the proposition is established, namely, that when machines are capable of being used in combination, then any number of them may be united in the same patent. The language of the Court in the case cited applies only to the case where the machines in question are capable of acting together ; withdraw such cases from the operation of the principle propounded by the Court, and there is an end of it. And yet this doctrine, as laid down by the Court in that case, is daily acted upon by the Patent Office, under the Act of 1836 ; and if it is materially shaken or qualified, the revenues of the department will be very seriously diminished.

The suggestions in *Evans v. Eaton*, on this point, was much considered in *Barret v. Hall*, and it may be said that no cases on record present more masterly expositions of the principles of Patent Law which they discuss. *Wyeth v. Stone*, stands on the extreme verge of sound principle ; but there the two instruments were in fact but part of one and the same machine. The instruments contemplated in that case formed a compound machine for cutting ice. They were, in fact, but parts of one and the same instrument. Two things cannot be readily imagined more absolutely distinct and separate instruments, than a steam-engine and a paddle wheel. A steam-engine is employed to give motion to every manner of machinery. A paddle wheel may be turned by horse-power, or man power, or windmill power, as well as by a steam-engine. Here the engine is the motive power ; the wheel is the thing moved. The engine might be well employed to move any thing else ; the wheel might well be put in action by any other motive power. They are as distinct and separate as cause and effect, and cannot be united in one patent, except upon principles that would entirely nullify the rule of law laid down

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in *Evans v. Eaton* and *Barrett v. Hall*, and admit of the introduction in the same patent of entirely distinct and separate machines.

It is suggested, that a different doctrine from that contended for by the plaintiffs prevails in England. We have cited no English authorities on this point. It arises on our own statutes, and is so rested by Mr. Justice Marshall.

There is no hardship in the rule contended for. In no other way can the subject-matter of an invention be distinctly brought out, so as to warn the public against undesigned infringements. If several machines can be mixed up in one specification, and several improvements on each, [*472] and then patented in the name *of one of those machines, it is respectfully, but earnestly, insisted, that the Patent Office cannot fail to become the source of more oppression and outrage than will be long tolerated by a people who are masters of their own institutions. Under such an understanding of the law, letters-patent will be regarded by the public as mere charters of iniquity, and the whole system must be swept away. It must be as impracticable to sustain such an institution in the United States as it would be to establish the Inquisition here, or vest in the government those odious prerogatives the abuse of which led to the English statute of monopolies.

It is most humbly submitted, then, that, on the authorities and on the reason of the case, there was error in the charge of his honor, the circuit judge, that "the objection that the patent embraces several distinct discoveries is untenable."

III. Counsel for the defendant in error cannot perceive by what course of argument this "patent" can be shown to be too broad upon its face. We are embarrassed somewhat in reasoning upon this case, because it is an anomaly. This is the first attempt on record to sustain a grant of an exclusive privilege by virtue of letters-patent which contain *no allusion*

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whatever to the alleged subject-matter of the privilege which is set up under them. We repeat, and to this point pray the special attention of the Court, that, among the many hundred patent cases that have been adjudicated in this country and in England, not one such case is reported. In discussing analogies, therefore, we must waive for the time the great difference between this and all other cases, arising from the fact that the patent before us contains no grant of an exclusive privilege in a spiral paddle wheel.

Plaintiffs' counsel do not allege, therefore, that this patent is too broad upon its face. It is as broad upon its face as the law will allow. It is broad enough to cover an improved steam-engine, and no more broad. It is made void by attempting to include more in the specification than is included in the grant, and more in the claim than is shown to be of the patentee's invention. The objection of plaintiffs' counsel is, that the claim is broader than the invention.

The claim is for the entire spiral paddle wheel, constructed and operating as set forth; and more than that, it is for such a machine "not confined to precise forms or dimensions, but varied as experience or convenience may dictate, whilst the principle of action remains unchanged, and similar results are produced by similar means."

Here is a claim for the entire wheel, to be varied as the inventor may see fit to vary it, and for every other wheel operating *on the same principle, and producing similar results by similar means. It is a claim, as broad and distinct as language can make it, for the spiral propelling wheel, and every part of it, and for liberty to vary it in form as the inventor pleases, as long as a similar result — to wit, the propulsion of vessels — is produced by similar means, — to wit, by a spiral wheel. The result contemplated is propulsion; the means or instrument is a spiral wheel, of such form as experience or convenience may induce

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the inventor to make, without changing the principle of action. Such is the claim ; and if the claim is a valid one, no man can effect the propulsion of a vessel on the principle of action contemplated by a spiral wheel, without invading Mr. Emerson's claim.

But, while such is the claim with which Mr. Emerson arms himself, and goes out among men, as Lord Kenyon expressed himself in a similar case, "hanging terrors over the unlearned," when we come to examine the specification of his wheel, we find an implied acknowledgment that it is only an improvement, and merely an implied acknowledgment. He speaks of an "improved spiral paddle wheel," leaving the unavoidable inference, that he has improved the ordinary paddle wheel by making it spiral, and that the spiral features — or, as he subsequently describes it, his spiral trough — is the only material part of his improvement.

Here is the old defect, that has been decided over and over again to be fatal, — the invention of an improvement and the claim of the whole machine. No ingenuity can withdraw this case from that large class of cases in which the rule we contend for has been laid down with a distinctness that cannot be mistaken, and applied with a wise, uniform, and unrelenting firmness. The Courts say, that no man shall give that false color to his claim which may enable him to "hang terrors over the unlearned." The case before the Court is Jessop's case, where the patent was for the whole watch, and the invention of a particular movement. It is the case presented in *Williams v. Brodie*, where the invention was an improvement on a stove, and the patent for the whole stove. It runs on all fours with *Cross v. Huntley*, where the invention was of an improvement in the washing-machine, and the claim was for the whole machine ; where the Court did not hesitate, in an action where the patent came up collaterally, to declare it void. It is *Boville v. Moore*, where the patent for an im-

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provement on a lace-machine was held void, because the claim was for the whole machine, though a considerable part of it had been long in use.

There is no matter of fact to be found, in order to bring out this defect, that the law may be applied to it.

It lies on the * face of the specification. Jessop, [* 474] Williams, Cross, and Boville, showed that they had invented improvements, and claimed the entire machines. Emerson suggests that he has invented an improvement, and claims the entire machine. Where is the difference? What subtilty can distinguish between these cases? And why should we seek to establish thin, fine, and subtle distinctions, in a case where the policy of the law is so plain, obvious, and honest, and where the great end to be attained is to prevent patentees from "hanging terrors over the unlearned?"

These cases, it may be said, are not binding authorities upon this Court. They are not so cited. No weight is claimed for them beyond that which they derive from their intrinsic good sense and sound reason. Their authority, as well-considered decisions, has never been judicially disturbed or questioned. But there is a case of controlling authority, — that of *Evans v. Eaton*, — sustaining the doctrine for which we contend, to its full extent. To this case I shall have occasion again to refer, in considering the fourth head of the argument of the learned counsel for the defendant, to which I now pass.

IV. The fourth point discussed by the learned counsel for the defendant touches the second prayer made to the Court below.

Plaintiffs contend that Mr. Emerson's specification does not define with precision the nature and extent of the alleged improvement in the spiral paddle wheel, but describes the whole machine, and claims the whole as improved, without distinguishing the new from the old. A patent with such a speci-

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fication cannot be supported. This doctrine rests so firmly on the authoritative decision of this Court, that it may well be left to authority. We shall, therefore, merely allude to the obvious reason for it, which is, to limit the exclusive privilege to the actual improvement, and disarm the patentee of the power of "hanging terrors over the unlearned," and practising upon the fears and credulity of the public, by "pretending that his invention is more than what it really is, or different from its ostensible objects." If a patentee can mix up a single undefined improvement in details of the construction and operation of an old machine, and then claim the whole machine constructed and operating in the manner set forth, then a patent, instead of being merely the reward of meritorious invention, is a device to encourage litigation, extortion, and fraud. Such a patent shifts its grounds at every trial, changes its color according to the aspect in which it is presented or met, and adapts itself with a fatal elasticity to the length and breadth of the evidence which happens to be applied to it.

[* 475] * (The remainder of the argument upon this head is omitted.)

V. Now with regard to the drawings. It appears from the record, (p. 10,) that two drawings were filed by Mr. Emerson in the Patent Office, under the Act of 1837; one as early as 1841, which was re-filed, with the plaintiff's oath to its correctness, on the 12th of February, 1844, and the other, with the same oath, on the 27th of March, 1844. The second drawing was the one produced and relied on by the plaintiff below as constituting, with the letters-patent, that certified copy of the renewed record in the Patent Office which the second section of the act last cited makes the only proof of the alleged patent admissible in any judicial Court of the United States.

The learned counsel for the defendant in error suggest,

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that, after the original drawing was destroyed by fire, the next best evidence of it was an accurate copy of it, offered to be proved such. It is submitted, with great deference, that a drawing of Mr. Emerson's paddle wheel, filed in March to lay the foundation of a suit in April, was not the next best evidence of the alleged original, for the reason that there was another drawing, previously filed and sworn to, which was something more than next best evidence of the lost original, being made by statute absolutely the only evidence of it that could be received in any judicial Court in the United States. It might, indeed, be well contended, that the first-filed drawing did not at all partake of the character of secondary evidence. It became, by force of the statute, to all legal intent, the original drawing. It filled the place of the original drawing on the record, being verified by the same oath, vesting the same rights, construed in the same way as part of the specification, and conclusive proof of all that it purported to prove, until it should be rebutted. The letters-patent and first drawing filed by Mr. Emerson, under the first section of the Act of 1837, became, by virtue of the second section, so far as the patentee was concerned, primary evidence. It was open to observation and impeachment to all the rest of the world; but by operation of the statute, in connection with well-established principles of law, it was at all events conclusive upon the patentee. The drawing, therefore, filed on the 27th of March, 1844, was in law the "next best" evidence of Mr. Emerson's original drawing, because there was a prior drawing filed on the 12th of February, which the statute had expressly declared to be the legal original, at least for all purposes of litigation.

(The remainder of the argument upon this head is omitted.)

VI. On the question of damages, counsel for the defendant

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insist that there was no error in the charge of the learned judge, that "the damages were not necessarily con- [* 476] fined to the * making of the wheels between March, 1844, when the drawings were restored to the Patent Office, and the bringing of the suit." Such a limitation was prayed below, and, as it was supposed, on well-established principles of law and equity. It is again pressed, with all deference, but with perfect conviction, that the refusal of the prayer was error, for which the judgment under consideration ought to be reversed.

The Patent Act contemplates, that every thing to be done by an inventor, with respect to his specification and drawings, is to be done before the patent issues. There is no such thing as correcting the record of a specification or drawing by mere substitution of some other specification or drawing. After the patent issues, the patentee cannot, by merely depositing a new drawing, on any plea whatever, make it a part of his patent, or any evidence whatever of his invention, as originally patented, so as to cover cases of alleged infringement prior to such change in the record. There can be only one motive of desiring to add a new drawing, and that is, to remedy a defect or insufficiency in the original drawing or specification, or to correct the same. The object of such a change can never be merely to present a more tasteful drawing, or a drawing more agreeable to the eye, or more in conformity to pictorial rules. Other arts than the fine arts induce such an application. The offer to file a new drawing is an admission on the part of the patentee, that his new drawing covers something in which the original drawing is defective or insufficient. And, under these circumstances, what does the statute say? That the patentee must surrender his patent, and that a new patent may issue in conformity with his corrected specification, and thereafter operate, for the residue of the original term, on the trial of all actions thereafter commenced for causes subsequently accru-

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ing, as though the same had been originally filed in such corrected form before the issuing out of the original patent. And in this case, the commissioner is not bound to grant such re-issue, nor can he grant it except in cases where the error has arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention. Similar proceedings may be had in regard to the addition of an improvement. (Act of 1836, § 13.)

(The remainder of the argument upon this head is omitted.)

It is respectfully submitted, then, —

1. Because the defendant in error has no grant of exclusive privilege in the machine, which is the subject-matter of the present controversy :

2. Because he could not in law receive a grant for it, as one of several distinct machines in the same patent :

* 3. Because, as the author of an improvement, [* 477] he could not take out a valid patent for the whole machine :

4. Because he has not in his specification distinguished between the old and new parts of his alleged improved machine, but has claimed the whole machine as improved :

5. Because he did not produce in evidence the record of his patent which the law had made such, but another record ; and,

6. Because he has recovered damages for causes of action accruing previously to the alleged correction of his record, and prior to the alleged renewal of it under the Act of 1837 :

For all these reasons, and for others raised upon the exceptions and record in this cause, presented perhaps too much at length, but not more at length, in the view of counsel, than their public importance may justify, — that the judgment of the Circuit Court in this case ought to be reversed.

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Mr. Justice WOODBURY delivered the opinion of the Court.

This is a writ of error brought under some peculiarities which are first to be noticed.

It comes here by virtue of the 17th section of the general Patent Law of July 4th, 1836. (5 Statutes at Large, 124.)

That section grants a writ of error from decisions of actions on patents, as in ordinary case, and then adds the privilege of it "in all other cases in which the Court shall deem it reasonable to allow the same." This was doubtless intended to reach suits where the amount in dispute was less than \$2,000, on account of the importance of the points sometimes raised, and the convenience of having the decisions on patents uniform, by being finally settled, when doubtful, by one tribunal, such as the Supreme Court.

The judges below, in this case, deemed it reasonable, that only a certain portion of the questions raised at the trial, concerning the validity of the patent, should come here, and the record was made up accordingly.

But the appellants contend for their right to bring here all the questions which arose in the case, and this is a preliminary point to be settled before going into the merits. The present is believed to be the first writ of the kind, which has given occasion for settling the construction of any part of the above provision; and therefore, without the aid of precedent, after due consideration of the words and design of the statute, we have come to the conclusion, that the position of the plaintiffs in error, in this respect, is the correct one, and that when a Court below deem it "reasonable" to allow a writ of error at all, under the discretion vested in them by this special provision, it must be on the whole case.

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

It may be very proper for the Court below to examine those

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points separately and with care, and if most of them present questions of common law only, and not of the construction of the Patent Acts, and others present questions under those acts which seem very clearly settled or trifling in their character not to grant the writ of error at all. It might, then, well be regarded as not "reasonable" for such questions, in a controversy too small in amount to make the writ a matter of right to persons, if standing on an equal footing with the suitors. But we think, from the particular words used rather than otherwise, that the act intended, if the Court allowed the writ as "reasonable" at all, it must be for the whole case, or in other words, must bring up the whole for consideration.

We shall, therefore, proceed to examine all the questions made at the trial, which it is supposed are relied on, and are now before us on the original writ and a *certiorari* issued since.

Looking to the declaration, the action is for a violation of a patent for an "improvement in the steam-engine, and in the mode of propelling therewith either vessels on the water or carriages on the land."

The evidence offered at the trial was a patent for "a new and useful improvement in the steam-engine," "a description whereof is given in the words of the said John B. Emerson himself, in the schedule hereto annexed, and is made a part of these presents."

In the schedule annexed is described fully what he says he invented, namely, "certain improvements in the steam-engine, and in the mode of propelling therewith either vessels on the water or carriages on the land."

The first question arising on this statement is, whether the evidence proves such a patent as is set out in the writ to have been violated by the respondents.

If the patent is to be ascertained from the letters alone, or rather from what is sometimes called their title or heading, without reference to the schedule annexed, the evidence is

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undoubtedly defective, as the writ speaks of a patent for an "improvement in the steam-engine and in the mode of propelling" vessels, &c., therewith, — while the letters themselves, in their title or heading, speak only of a patent for "a new and useful improvement in the steam-engine." But the schedule annexed and referred to for further description, after "improvement in the steam-engine," adds, "and in the mode of propelling therewith" vessels, &c.

It can hardly be doubted, therefore, that the improvement * referred to in the writ and in the letters-patent, with the schedule or specification annexed, was in truth one and the same.

Coupling the two last together, they constitute the very thing described in the writ. But whether they can properly be so united here, and the effect of it to remove the difficulty, has been questioned, and must therefore be further examined. We are apt to be misled, in this country, by the laws and forms bearing on this point in England being so different in some respects from what exist here.

There the patent is first issued, and contains no reference to the specification, except a stipulation that one shall, in the required time, be filed, giving a more minute description of the matter patented. (Webster on Pat. 5, 88; Godson on Pat. 6, App.) It need not be filed under two to four months, in the discretion of the proper officer. (Godson on Pat. 176.)

Under these circumstances, it will be seen that the patent, going out alone there, must in its title or heading be fuller than here, where it goes out with the minute specification. But even there it may afterwards be aided, and its matter be made more clear, by what the specification contains. They are, says Godson on Pat. 108, "connected together," and "one may be looked at to understand the other." See also 2 Hen. Bl. 478; 1 Webst. Pat. R. 117; 8 D. & E. 95.

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There, however, it will not answer to allow the specification, filed separately and long after, to be resorted to for supplying any entire omission in the patent; else something may be thus inserted afterwards which had never been previously examined by the proper officers, and which if it had been submitted to them in the patent and examined, might have prevented the allowance of it, and which the world is not aware of, seeing only the letters-patent without the specification, and without any reference whatever to its contents. 3 Brod. & Bingh. 5.

The whole facts and law, however, are different here. This patent issued March 8th, 1834, and is therefore to be tested by the Act of Congress then in force, which passed February 21st, 1793. (1 Statutes at Large, 318.)

In the third section of that act it is expressly provided, "that every inventor, before he can receive a patent," "shall deliver a written description of his invention," &c.;—thus giving priority very properly to the specification rather than the patent.

This change from the English practice existed in the first Patent Law, passed April 10th, 1790, (1 Statutes at Large, 109,) and is retained in the last Act of Congress on this subject, passed July 4th, 1836, (5 Statutes at Large, 119.)

It was wisely introduced, in order that the officers of the government might at the outset have before them full means to * examine and understand the claim [* 480] to an invention better, and decide more judiciously whether to grant a patent or not, and might be able to give to the world fuller, more accurate, and early descriptions of it than would be possible under the laws and practice in England.

In this country, then, the specification being required to be prepared and filed before the patent issues, it can well be referred to therein *in extenso*, as containing the whole subject-

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matter of the claim or petition for a patent, and then not only be recorded for information, as the laws both in England and here require, but beyond what is practicable there, be united and go out with the letters-patent themselves, so as to be sure that these last thus contain the substance of what is designed to be regarded as a portion of the petition, and thus exhibit with accuracy all the claim by the inventor.

But before inquiring more particularly into the effect of this change, it may be useful to see if it is a compliance with the laws in respect to a petition which existed when this patent issued, but were altered in terms shortly after.

A petition always was, and still is, required to be presented by an inventor when he asks for a patent, and one is recited in this patent to have been presented here. It was also highly important in England, that the contents of the petition as to the description of the invention should be full, in order to include the material parts of them in the patent, no specification being so soon filed there, as here, to obtain such description from, or to be treated as a portion of the petition, and the whole of it sent out with the patent, and thus complying with the spirit of the law, and giving fuller and more accurate information as to the invention than any abstract of it could.

In this view, and under such laws and practice here, it will be seen that the contents of the petition, as well as the petition itself, became a very unimportant form, except as construed to adopt the specification, and the contents of the latter to be considered substantially as the contents of the former.

Accordingly, it is not a little curious, that though the Act of 1793, which is to govern this case, required, like that of 1790, a petition to be presented, and the patent when issued, as in the English form, to recite the "allegations and suggestions of the petition," (1 Statutes at Large, p. 321, sec. 1 and p. 110, sec. 3,) yet, on careful inquiry at the proper office, so far as its records are restored, it appears that, after the first

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Act of 1790 passed, the petitions standing alone seldom contained any thing as to the patent beyond a mere title; sometimes fuller, and again very imperfect and general, with no other allegations or suggestions, or descriptions whatever, except those in the * schedule or specific- [* 481] cation. The only exception found is the case of *Evans v. Chambers*, 2 Wash. C. C. 125, in a petition filed December 18th, 1790.

Though the records of the Patent Office before 1836 were consumed in that year, many have been restored, and one as far back as August 10th, 1791, where the petition standing alone speaks of having invented only "an easy method of propelling boats and other vessels through the water by the power of horses and cattle." All the rest is left to the schedule. Other petitions, standing alone, are still more meagre; one, for instance, in 1804, asks a patent only of a "new and useful improvement, being a composition or tablets to write or draw on;" another, only "a new and useful improvement in the foot-stove," and another only "a new and useful improvement for shoemaking;" and so through the great mass of them for nearly half a century. But the specification being filed at the same time, and often on the same paper, it seems to have been regarded, whether specially named in the petition or not, as a part of it, and as giving the particulars desired in it; and hence, 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. This may have grown out of the decision of *Evans v. Chambers*, in order to remedy one difficulty there. Cases have been found as early as 1804, and with great uniformity since, explicitly making the schedule annexed a part of the letters-patent. Proofs of this exist, also, in our reports, as early as 1821, in *Grant et al. v. Ray-*

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mond, 6 Peters, 222; and one, 1st Oct. 1825, in Gray et al. v. James et al. Peters, C. C. 394; and 27 Dec. 1828, Wilson v. Rousseau, 4 How. 649.

Indeed, it is the only form of a patent here known at the Patent Office, and the only one given in American treatises on patents. Phillips on Pat. 523. Doubtless this use of the schedule was adopted, because it contained, according to common understanding and practice, matter accompanying the petition as a part of its substance, and all the description of the invention ever desired either in England or here in the petition. Hence it is apparent, if the schedule itself was made a part of the patent, and sent out to the world with it, all, and even more, was contained in it than could be in any abstract or digest of a petition, as in the English form.

We regard this mode and usage on this subject, adopted so early here and practised so long, as not proper to be overruled now, to the destruction of every patent, probably, [* 482] from 1791 to * 1836; and this, too, when the spirit of all our system was thus more fully carried out than it could have been in any other way. *

As this course, however, sometimes was misunderstood and led to misconstructions, the revising act as to patents, of July 4th, 1836, changed the phraseology of the law in this respect, in order to conform to this long usage and construction under the Act of 1793, and required not in terms any abstract of the petition in the patent, but rather "a short description" or title of the invention or discovery, "correctly indicating its nature and design," and "referring to the specification for the particulars thereof, a copy of which shall be annexed to the patent." And it is that — the specification or schedule — which is fully to specify "what the patentee claims as his invention or discovery." Sec. 5. (5 Statutes at Large, 119.)

It was, therefore, from this long construction, in such various ways established or ratified, that, in the present patent,

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the schedule, or, in other words, the specification, was incorporated expressly and at length into the letters themselves, — not by merely annexing them with a wafer or tape, as is argued, but describing the invention as an “improvement, a description whereof is given in the words of the said John B. Emerson himself, in the schedule hereto annexed, and is made a part of these presents.” Hence, too, wherever this form has been adopted, either before or since the Act of 1836, it is as much to be considered with the letters, — *literæ patentæ*, — in construing them, as any paper referred to in a deed or other contract. Most descriptions of lands are to be ascertained only by the other deeds and records expressly specified or referred to for guides; and so of schedules of personal property, annexed to bills of sale. *Foxcroft v. Mallett*, 4 How. 378; 21 Maine, 69; 20 Pick. 122; Phil. on Pat. 228; *Earle v. Sawyer*, 4 Mason, C. C. 9; *Ex parte Fox*, 1 Ves. & Beames, 67. The schedule, therefore, is in such case to be regarded as a component part of the patent. *Peters*, C. C. 394, and *Davis v. Palmer et al.* 2 Brockenbrough, 301. The oath of Emerson, too, that he was inventor of the improvement, must thus be considered as extending to all described in the schedule, no less than the title; and this is peculiarly proper, when the specification is his own account of the improvement, and the patent is usually only the account of it by another, an officer of the government. Taking, then, the specification and letters together, as the Patent Office and the inventor have manifestly in this instance intended that they should be, and they include what has long been deemed a part and the substance of the petition; and the patent described in them is quite broad enough to embrace what is alleged in the writ to have been taken out as a

* patent by the plaintiff, and to have been violated [* 483] by the defendants. They are almost *ipsissimis verbis*. And when we are called upon to decide the mean-

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ing of the patent included in these letters, it seems our duty not only to look for aid to the specification as a specification, which is customary, (1 Gall. 437; 2 Story, R. 621; 1 Mason, C. C. 477,) but as a schedule, made here an integral portion of the letters themselves, and going out with them to the world, at first, as a part and parcel of them, and for this purpose united together for ever as identical.

It will thus be seen, that the effect of these changes in our Patent Laws, and the long usage and construction under them, is entirely to remove the objection, that the patent in this case was not as broad as the claim in the writ, and did not comply substantially with the requirements connected with the petition.

From want of full attention to the differences between the English laws and ours, on patents, the views thrown out in some of the early cases in this country do not entirely accord with those now offered. Paine, C. C. 441; Pennock et al. v. Dialogue, 2 Pet. 1. Some other diversity exists at times, in consequence of the Act of 1793, and the usages under it in the Patent Office, not being in all respects as the Act of 1836. But it is not important, in this case, to go farther into these considerations.

The next objection is, that this description in the letters thus considered covers more than one patent, and is, therefore, void.

There seems to have been no good reason at first, unless it be a fiscal one on the part of the government when issuing patents, why more than one in favor of the same inventor should not be embraced in one instrument, like more than one tract of land in one deed, or patent for land. Phillips on Pat. 217.

Each could be set out in separate articles or paragraphs, as different counts for different matters in libels in admiralty or declarations at common law, and the specifications could be made distinct for each, and equally clear.

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But to obtain more revenue, the public officers have generally declined to issue letters for more than one patent described in them. *Renouard*, 293; *Phillips on Pat.* 218. The courts have been disposed to acquiesce in the practice, as conducive to clearness and certainty. And if letters issue otherwise inadvertently, to hold them, as a general rule, null. But it is a well-established exception, that patents may be united, if two or more, included in one set of letters, relate to a like subject, or are in their nature or operation connected together. *Phil. on Pat.* 218, 219; *Barrett v. Hall*, 1 *Mason*, C. C. 447; *Moody v. Fisk*, 2 *Mason*, C. C. 112; *Wyeth et al. v. Stone et al.* 1 *Story*, 273.

* Those here are of that character, being all connected with the use of the improvements in the steam-engine, as applied to propel carriages or vessels, and may therefore be united in one instrument.

Another objection is, that these letters, even when thus connected with the specification, are not sufficiently clear and certain in their description of the inventions.

This involves a question of law only in part, or so far as regards the construction of the written words used. *Reutgen v. Kanowrs et al.* 1 *Wash. C. C.* 168; *Davis v. Palmer et al.* 2 *Brockenbrough*, C. C. 303; *Wood v. Underhill*, 5 *How.* 1. The degree of clearness and freedom from ambiguity required in such cases is, by the Patent Act itself of 1793, to be sufficient "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." 1 *Statutes at Large*, 321. See also on this, *Godson on Pat.* 153, 154; 2 *Hen. Bl.* 489; *Wood v. Underhill*, 5 *How.* 1; *Davoll et al. v. Brown*, 1 *Woodb. & Min.* 57; *Pet. C. C.* 301; *Sullivan v. Redfield*, *Paine C. C.* 441.

There are some further and laudable objects in having ex-

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actness to this extent, so as, when the specification is presented, to enable the Commissioner of Patents to judge correctly whether the matter claimed is new or too broad. 3 Wheat. 454; 3 Brod. & Bingh. 5; 1 Starkie, N. P. 192. So, also, to enable courts, when it is contested afterwards before them, to form a like judgment. 1 Starkie, N. P. 192. And so that the public, while the term continues, may be able to understand what the patent is, and refrain from its use, unless licensed. Webster on Pat. 86; 11 East, 105; 3 Merivale, 161; Evans v. Eaton, 3 Wash. C. C. 453; 4 Wash. C. C. 9; Bovill v. Moore, Davies's Cas. 361; Lowell v. Lewis, 1 Mason, C. C. 182-189.

In the present instance, yielding to the force of such reasons in favor of a due and rational degree of certainty in describing any improvements claimed as new, there still seems to us, though without the aid of experts and machinists, no difficulty in ascertaining, from the language used here, the new movement intended to be given to the steam-engine, by substituting a continued rotary motion for a crank motion, and the new form of the spiral wheel, when the engine is used in vessels, by changing the form of the paddles and placing them near the ends of the arms; and the new connection of the power with the capstan of such vessels, by inserting the upper end of the shaft into the capstan.

[* 485] It is obvious, also, that the inventor * claims as his improvement, not the whole of the engine, nor the whole of the wheel, but both merely in the new and superior form which he particularly sets out. He, therefore, does not claim too much, which might be bad. Hill v. Thompson et al. 2 J. Marsh. 435; 4 Wash. C. C. 68; Godson on Patents, 189; Kay v. Marshall, 1 Mylne & Cr. 373; 1 Story, R. 273; 2 Mason, C. C. 112; 4 Barn. & Ald. 541; Bovill v. Moore, 2 Marsh. Com. P. Rep. 211.

The novelty in each he describes clearly, as he should;

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and it is not necessary he should go further. 1 Story, R. 286; Webster on Pat. 86, note; MacFarlane v. Price, 1 Starkie, 199; and King v. Cutler, ib. 354; 3 Car. & Payne, 611; 2 Mason, C. C. 112; Kingsby & Pirsson on Pat. 61; Godson on Pat. 154; Isaacs v. Cooper et al. 4 Wash. C. C. 259.

He need not describe particularly, and disclaim all the old parts. 7 Wheat. 435; Phil. on Pat. 270, and cases cited.

And the more especially is that unnecessary, when such disclaimer is manifestly, in substance, the result of his claiming as new only the portions which he does describe specially. All which is required on principle in order to be exact, and not ambiguous, thus becomes so.

It is to be recollected, likewise, that the models and drawings were a part of this case below, and are proper to be resorted to for clearer information. Earle v. Sawyer, 4 Mason, C. C. 9. With them and such explanatory testimony as experts and machinists could furnish, the Court below were in a condition to understand better all the details, and to decide more correctly on the clearness of the description; but from all we have seen on the record alone, we do not hesitate to concur in the views on this point as expressed in that court.

In conclusion, on the other objections to the proof, as to the drawings and to the charge below in relation to the effect of them, and to the destruction of them by fire, we likewise approve the directions given to the jury.

The destruction by fire was no fault of the inventor; and his rights had all become previously perfected. This is too plain to need further illustration. We cannot consent to be over astute in sustaining objections to patents. 4 East, 135; Crosley v. Beverly, 3 Car. & Payne, 513, 514. The true rule of construction in respect to patents and specifications, and the doings generally of inventors, is to apply to them plain

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and ordinary principles, as we have endeavored to on this occasion, and not, in this most metaphysical branch of modern law, to yield to subtleties and technicalities, unsuited to the subject and not in keeping with the liberal spirit of the age, and likely to prove ruinous to a class of the community so inconsiderate * and unskilled in business as men of genius and inventors usually are.

Indeed, the English letters-patent themselves, now, however different may have been once their form or the practice under them, declare that "they are to be construed" "in the most favorable and beneficial sense, for the best advantage" of the patentee. Godson on Pat. 24, App. 7; Kingsby & Pirsson on Patents, 35. See also, on this rule, Grant v. Raymond, 6 Peters, 218; Ames v. Howard, 1 Sumn. 482 - 485; Wyeth v. Stone, 1 Story, R. 273, 287; Blanchard v. Sprague, 2 Story, R. 164; 2 Brockenbrough, C. C. 303; 2 Barn. & Ald. 345, in The King v. Wheeler; 5 Howard, 708, in Wilson v. Rousseau et al.; 1 Crompt. Mees. & Ros. 864, 876, in Russell v. Cowly.

The judgment below is affirmed.

Note. — After the delivery of this opinion, the counsel for the plaintiffs in error suggested that other questions were made below, which they desired to be considered, and therefore moved for another *certiorari* to bring them up. This was allowed, and judgment suspended till the next term.

PHILLIPS v. COMBSTOCK.

[4 McLean, 525. May T. 1849.]

A special plea or notice must be filed thirty days before the term, in a patent case, or the plaintiff will be entitled to a continuance.

Parker v. Haworth. 4 McLean.

The option to file the general issue and give notice, does not take away the right to set up the special matter in a plea.

Baird for the plaintiff.

Judah for defendant.

OPINION OF THE COURT.

THIS is an action for the violation of a patent-right. The defendant filed a special plea, setting up that the right was not in the plaintiff; a previous discovery; and that the right was of no value. And a question was raised whether a special plea could be filed, or whether the plaintiff was not bound to plead the general issue and give notice as authorized by the statute.

The Court held that a special plea may be filed. That a right to plead the general issue, and give notice by the statute, was an enlargement of the defendant's mode of defence, but that it did not take away his right to plead specially. But the Court held also, that as the plea was not put in thirty days before the term, the plaintiff was entitled to a continuance. The statute provides that the notice under the general issue shall be filed thirty days before the term. This entitles the plaintiff to the thirty days whether the matter be set up by a plea or notice.

Z. PARKER v. JAMES F. HAWORTH.

[4 McLean, 370. June T. 1848.]

A patent may be assigned in part, or the whole of it.
An averment in the declaration that the defendant has made the thing "in imitation of the patent," is sufficient to sustain the action.

Parker v. Haworth. 4 McLean.

The machinery complained of, if the same in principle as the plaintiff's, is an infringement.

Parker's patent is for improvements on known machinery and a combination of mechanical powers.

There can be no infringement of the combination, which does not embrace all the parts.

But it is an infringement to adopt any improvement of the plaintiff's of any of the parts of the combination.

An inventor, under his patent, claims no monopoly.

Logan for the plaintiff.

Weed for the defendant.

OPINION OF THE COURT.

THIS action is brought, charging the defendant with a violation of the plaintiff's patent for a percussion and reaction water-wheel. The defendant pleaded not guilty. The jury being sworn, the plaintiff offered an exemplification of his patent, containing certain assignments, in evidence, which was objected to by defendant, on two grounds: 1. That there is no proof of the original assignment to McElvey; and 2. That there is no proof that McElvey was administrator, as he assumed to be.

[* 371] * The assignment of a patent in whole or in part, is authorized by act of Congress, and it is required to be recorded in the Patent Office. The assignments in this case have been recorded, and the paper now offered contains a copy of them, duly authenticated; and the law of Congress makes such copies evidence, as well as a copy of the patent. Such copies, therefore, must be received, as *prima* evidence at least, of the genuineness of the originals on file; and absolute evidence of the correctness of the copies from the record.

Several witnesses were examined to show the value of the improvement claimed by the plaintiff. One of the witnesses, Mr. West, says he has built forty or fifty of Parker's percus-

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sion water-wheels; and the question being asked him whether there were not other wheels similar to those of Parker's, it was objected to, there having been no notice given, as the statute requires, and the Court sustained the objection. The witness says, the product of Parker's improvement is nearly three times as great as the other wheels in use.

A question being asked of a witness whether the defendant throws the water upon the wheel through a spiral trunk, was objected to because the declaration contained no such averment. But the Court permitted the question to be asked, as in the declaration the trunk was averred to be made in imitation of the plaintiff's patent.

Several witnesses were examined, who thought the improvement of no great value, and, in some respects, they considered it less valuable than the flutter-wheel, generally in use: and some of them who are millwrights, do not think the defendant's wheel is an infringement upon that of the plaintiff's.

The case having been argued to the jury, the Court observed to them: This action is brought to recover damages *for a violation of the plaintiff's right. [* 372] The policy of the law, which protects the right of the inventor, is wise. It stimulates genius, by endeavoring to secure a reasonable compensation to those who have spent their time and money in producing something of utility to the public. It is not a monopoly the inventor receives. Instead of taking any thing from the public, he confers on it the greatest benefits; and all he asks, and all he receives, is, that for a few years he shall realize some advantage from his own creation; not that he withholds his machine or discovery from the country, but that in distributing it he may receive a small compensation for the great benefit he confers.

The triumphs of the inventor are intellectual triumphs. His demonstrations are made through mechanical agencies,

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but these, in the highest degree, are attributable to mind; and the same may be said of our inventive mechanics generally. The range of their thought embraces the system of natural philosophy, in all its practical bearings; and in carrying out their views, the highest degree of mechanical ingenuity. Through the labors of these men our country has been advanced by machinery, on the land and on the water, in the saving of labor, and in a rapid and increased intercourse, and especially in the communication of intelligence, in the last forty years, more than could have been hoped for, without their instrumentality, in many centuries. And yet, how few of them are considered public benefactors. Their inventions are pirated, and they often reduced to indigence by the vindication of their rights.

The plaintiff in this case is not entitled to recover damages unless he shows that the defendant has violated the patent by using the machinery invented or improved by the plaintiff. There seems to be nothing in the evidence which can create a doubt, in regard to the invention claimed by the patent.

And your inquiry will be chiefly directed to the infringement [* 373] charged in the declaration. To this the plaintiff is limited. If the defendant has arranged his machinery on the same principle as claimed by the plaintiff, he is guilty of infringement. You will understand that it is not essential that the wheel of the defendant, in its form, should be exactly similar to that of the plaintiff; but it must work on the same principle. The force of the water must be thrown upon it in substantially the same manner.

If you shall find for the plaintiff, you will assess such damages, as in your judgments shall be just. There are no circumstances in the case which call for exemplary damages. The defendant may not have been aware of the plaintiff's right, at the time he procured his machinery to be constructed.

Verdict for the plaintiff.

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A motion was made in arrest of judgment, on the ground, that the declaration does not set forth the act complained of as contrary to the statute. This is necessary when an action is brought on a penal statute, but not in a case like the present, where damages are sought for on an injury done. Where the plaintiff sues for a penalty, as the statute is the only foundation of the action, the declaration must aver that the act is *contra formam statuti*. In *Tryon v. White*, (Peters, C. C. Rep. 96,) it is said, "if the declaration in an action for the invasion of a patent-right, fails to lay the act complained *contra formam statuti*, the defect will be purged after the verdict."

Another ground in arrest is stated, that the declaration should allege an infringement of the combination claimed in the patent.

It is a well-established principle that where the invention consists of a combination of known mechanical powers, the use of a part less than the whole combination, would be no infringement. Each one of the different powers combined constitutes a part of the whole, but the invention is not in * any of the parts, but in the combination of [* 374] them. The parts of which the combination consists, remain unrestrained from general use, as before the invention.

But the plaintiff's invention consists, not only in the combination, but in the improvement of several of the parts of which that combination is composed. And the violation of one of them is an infringement for which an action will lie. The motion in arrest is overruled and judgment.

Hotchkiss's Executrix, etc. v. Greenwood & Wood. 4 McLean.

HOTCHKISS'S EXECUTRIX, ETC. v. GREENWOOD & WOOD.

[4 McLean, 456. July T. 1848.]

A patent-right cannot be sustained for making an article of a new material, according to a known mode.

If the material be new, as a compound invented, a patent-right may be claimed for that.

[*457] *The invention must relate to something new, in structure or material.

Door knobs having been made of glass, wood, brass, and other materials, the making of the same of potter's ware, or porcelain, a material long known, will not entitle any one to a patent.

And if the mode of fastening the shank to the knob be the same as has been done in fastening the shank to knobs made of other materials, there is no invention to sustain an exclusive right.

And this is the case, although the porcelain knob may be more valuable than knobs made of any other materials.

Ewing for plaintiffs.

Fox and *Chase* for defendants.

OPINION OF THE COURT.

THIS action was brought against the defendants, to recover damages for the infringement of a patent-right obtained by John E. Hotchkiss and others, for an improved method of making knobs for locks, doors, cabinet furniture, and all other purposes for which wood and metal, or other material, for knobs are used, etc.

The defendants pleaded not guilty, and gave notice that the improvement claimed was known and practised, and that such knobs were made, used, and sold by others, before his patent, in different parts of this country, and also in Great Britain and Germany, etc.

The patent was given in evidence, and the schedule which

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constitutes a part of the patent, in which the patentees claimed that they "had invented an improved method of making knobs for locks, doors," etc. "And that the improvement consists in making said knobs of potter's clay, such as is used in any species of pottery; also of porcelain; the operation is the same as in pottery, by moulding and burning, and glazing; they may be plain in surface and color, or ornamented to any degree in both; the modes of fitting them for their application to doors, locks, furniture, and other uses, will be as various as the uses to which they may be applied, but chiefly founded on one principle, that of having the * cavity in which the screw or shank is inserted, by [* 458] which they are fastened, largest at the bottom of its depth, in form of a dove-tail, and a screw formed therein, by pouring in metal in a fused state. In the annexed drawing, A represents a knob with a large screw inserted, for drawers and similar purposes; B represents a knob with a shank to pass through and receive a nut; C the head of the knob calculated to receive a metallic neck; D a knob with a shank, calculated to receive a nut on the outside or front."

"What we claim as our invention, and desire to secure by letters-patent is, the manufacturing of knobs, as stated in the foregoing specifications, of potter's clay, or any kind of clay used in pottery, and shaped and finished by moulding, turning, burning, and glazing; and also of porcelain."

Evidence was given to the jury, conducing to show the novelty and utility of the invention by the patentees, as claimed by them, and that it was their joint invention.

Some evidence was given by the defendants tending to show that the said alleged invention was not originally invented by any one of the said patentees; and that, if said invention was original with any of the patentees, it was not the joint invention of all of them; and other evidence tending to show that the mode of fastening the shank or collet to the

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knob, adopted by the plaintiffs and described in their specifications, had been known and used in Middletown, Connecticut, prior to the alleged inventions of the plaintiffs, as a mode of fastening shanks or collets to metallic knobs. And the evidence being closed, the counsel for the plaintiffs insisted in the argument that, although the knob, in the form in which it is patented, may have been known and used in the United States, prior to their invention and patent, and although the shank and spindle, by which it is attached, may have been used and known in the United States prior to said invention and patent, yet if such shank and spindle had never before been attached to potter's clay or porcelain, and if [*459] it required *skill and thought and invention to attach the said knob of clay to the metal shank and spindle, so that the same would unite firmly and make a solid and substantial article or manufacture; and if the said knob of clay or porcelain so attached, were an article better and cheaper than the knob theretofore manufactured of metal or other materials, that the patent was valid, and asked the Court so to instruct the jury.

This instruction, gentlemen of the jury, the Court refuse to give, in the form requested. The plaintiffs claim no invention in regard to the material of which the knob is composed. In their specifications, they say, "the improvement consists in making said knobs of potter's clay, such as is used in any species of pottery; also of porcelain," etc. These materials have been known for ages, nor was there any novelty in the knob itself, as knobs of a similar form, made of other materials, had long been in use. They had been constructed of brass, silver, glass, wood, iron, etc. The shank and spindle were not claimed as new. There was nothing left, then, but the attaching of the spindle to the knob. And on this point the instruction is made to turn. "Yet if such shank and spindle had never before been attached to a knob

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made of potter's clay or porcelain, and if it required 'skill and thought and invention' to attach the said knob of clay to the metal shank and spindle, so that the same would unite firmly and make a substantial article of manufacture," etc. It is true this part of the instruction is founded upon the supposition, that to attach the spindle to the knob of clay or porcelain, "required skill and thought and invention," leaving the invention, without designating it in any form, or saying that it must be different from any known mode, open to the jury. Now it requires skill and thought to attach a spindle to any kind of knob. Such skill as an individual acquainted with mechanics, only, can exercise; and no skill can be exercised without more or less of thought. And where * skill and thought are united, two of the requisites [* 460] to sustain the right of the plaintiffs, unless the mind of the jury were brought distinctly to the point of invention, which is the hinge of the case, they might infer its existence from the two preceding requisites.

To give an exclusive right, there must be what is called a new principle, invented. Not a new principle in an abstract sense, for none such is likely to be discovered; but a new combination or mode, for instance, of attaching the spindle to the knob. If in this there is nothing different from a known mode, there can be no invention which gives a new right to the plaintiffs. And yet the mind of the jury, by the instruction asked, is not drawn to this consideration. This instruction, therefore, in the form asked, is rather calculated to mislead the jury than to bring to their minds, distinctly, what the invention must be.

Another part of this instruction, as asked, is objectionable. "And if the knob of clay or porcelain so attached, were an article better and cheaper than the knob theretofore manufactured of metal or other materials, that the patent was valid," etc. Now, here, the "cheapness" and "quality" of

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the article are relied on as giving, or contributing to give, the plaintiffs an exclusive right. But these afford no ground whatever for a patent. The words "so attached," are used referring to the preceding part of the sentence, requiring skill, thought, and invention, but not so as to bring the mind of the jury to what must be invented to sustain the patent; and the quality and cheapness of the article are so connected as to have an influence on the jury, to which they are not entitled. In an action of this kind, the comparative value of the thing invented, so far as the exclusive right is concerned, it is not necessary to show beyond the fact that it is useful, or of some value.

An article made according to a known method, may be better than other articles made in the same manner, [* 461] on * account of its superior mechanism. But this is no foundation of an exclusive right. And if a material not before used in the same structure be used, that gives no claim to a patent, though the article be more valuable than any other of the kind. If a compound be made, not before known, of different ingredients, that is a ground for a patent, not for the thing constructed, but for the compound of which it is made.

The ground on which a patent may be claimed is, that something new and useful has been invented. A thing which did not before exist. A machine, for instance, differing from all other machines in its structure, movement, or effect, by reason of the introduction of some new mechanical combination or principle.

The Court will, therefore, instruct the jury, "that if knobs of the same form and for the same purposes with that described by the plaintiffs in their specifications, made of metal or other material, had been known and used in the United States prior to the alleged invention and patent of the plaintiffs; and if the spindle and shank, in the form used by the

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plaintiffs, had before that time been publicly known and used in the United States, and had been theretofore attached to metallic knobs by means of the dovetail and the infusions of melted metal, as the same is directed in the specification of the plaintiffs, to be attached to the knob of potter's clay or porcelain, so that if the knob of clay or porcelain is the mere substitution of one material for another, and the spindle and shank be such as were theretofore in common use, and the mode of connecting them to the knob by dovetail be the same that was theretofore in use in the United States, the material being in common use, and no other ingenuity or skill being necessary to construct the knob than that of an ordinary mechanic acquainted with the business, the patent is void and the plaintiffs are not entitled to recover."

The counsel for the defendants asked the Court to instruct the jury, that if they should be satisfied that any one of the *patentees was the original inventor of [* 462] the article in question, and that the same was new and useful, yet if they should be satisfied from the evidence that all the patentees did not participate in the invention, the patent is void, and the plaintiffs cannot recover. And the Court gave the instruction, modified by the remark, that the patent was *prima facie* evidence that the invention was joint, though the fact might be disproved at the trial; and the Court said, there was no evidence, except that of a slight presumption, against the joint invention as proved by the patent.

The jury found for the defendants, and the case being taken to the Supreme Court, on points excepted to, was affirmed. 11 Howard.

Parker v. Corbin. 4 McLean.

PARKER V. CORBIN.

[4 McLean, 462. November T. 1848.]

Where a patent-right has been infringed, the defendant not knowing of the plaintiff's right at the time, no more than compensatory damages will be given.

But where the infringement is characterized by a disposition to affect the interest of the patentee, counsel fees, and what may be termed vindictive damages, may be assessed by the jury.

Ewing for plaintiff.

OPINION OF THE COURT.

THIS is an action for the infringement of a patent, by the construction of a water wheel for a saw-mill, using the right which exclusively belonged to the plaintiff. The defendant suffered a default, and the jury were sworn to inquire of the damages, etc.

The counsel prayed the Court to instruct the jury that the plaintiff was entitled to recover as a part of the damages the counsel fees paid by the plaintiff. The Court declined giving the instruction positively, but said to the jury, the damages were to be assessed by them in the exercise of their [* 463] *judgment, from the evidence. That where the act complained of had been done without a knowledge of the plaintiff's right, and under such circumstances as to authorize the jury to infer that the defendant was not aware that he was violating the rights of any one, the damages should be so graduated as to give nothing more than to compensate the injury done to the plaintiff. But where the circumstances were of a somewhat aggravated character, what was sometimes called in the law vindictive damages might be given, which would include counsel fees, and something more by way of example to deter others from doing the same thing.

Verdict for plaintiff.

Blanchard v. Eldridge. 1 Wallace.

BLANCHARD v. ELDRIDGE.

[1 Wallace, 337. April T. 1849.]

Assignment of Patent-Right — Parties to Sue.

Where a transfer of certain specified privileges, part of larger privileges secured by the patent-right, does not confer a legal title to the whole, or to an undivided portion of the right, nor grant the entire or exclusive right within a specified part of the United States, a suit for an infringement of one of the privileges transferred, is properly brought at law, in the name of the original holder.

For example, B having a patent for turning irregular forms generally grants to C the full and exclusive license, right, and permission, to use it for turning shoe lasts. D having infringed the patent by turning shoe lasts, it was held, that suit for the infringement was properly brought at law in B's name.

BLANCHARD had brought a suit, in his own name, at law, and recovered damages for an infringement of a patent he had obtained for turning every kind of irregular forms. In the course of the trial, however, the defendant was allowed to show, that prior to the bringing of the suit, Blanchard had assigned to one Carter, "the full and exclusive license, right, and permission to have, hold, use, and enjoy Blanchard's patent for turning irregular forms, &c., so far as said improvement is or may be used for turning shoe lasts, boot and shoe trees, and hat blocks, and also for turning spokes for wheels of all kinds of carriage wheels, and all other articles that form any part in the construction of carriages. To have and to hold the said right and license exclusive of all others, except such persons as have received grants or licenses before the date hereof," &c.

The infringement proved on the trial was that of making shoe lasts, that is to say, an infringement of one of

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[* 338] * the rights and interests granted exclusively to Carter.

Hirst, for the defendant, having moved for a new trial, relied, among other reasons for it, upon the fact of this transfer to Carter; his argument being, that as Carter was the "party injured," and had the "exclusive right," he was the only person entitled to an action; and that the plaintiff, having parted with all right to use the machine for the purpose of making lasts, &c., over the whole United States, could not support an action for the infringement.

The Patent Law,¹ it is requisite here to state, enacts, "that every patent shall be assignable in law either as to the whole interest or any undivided part thereof, &c., which assignment, and also every grant and conveyance of the exclusive right under any patent to make, use, and to grant to others to make and use, the thing patented within and throughout any specified part or portion of the United States, shall be," &c., and makes no other provision about assignments.² And also that the act requires the action for an infringement to be "brought in the name or names of the person or persons interested, whether as patentee, assignees, or as grantees, of the exclusive right within and throughout a specified part of the United States."

F. W. Hubbell and *Saunders Lewis*, cited a MS. report of a recent decision in the New York Circuit, upon this identical assignment, in which it was held by Judge Nelson, that suit was properly brought in Blanchard's name.

[* 339] * GRIEB, J. The point here raised by the defendant's counsel is not without its difficulty, and

¹ Act of July 4, 1836, § 11; 5th Statutes at Large, 121.

² Id. § 14. See Appendix.

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the force of his argument cannot be evaded if his assumption be true, that this deed transfers the legal title to Carter of that portion of the patent, which it purports to vest in him. But if it does not so operate, it cannot be noticed in a court of law, and cannot affect the case.

As the grants of the crown were at common law, construed with the greatest strictness, the privileges granted by a patent for a monopoly, would probably not have been treated as capable of assignment, unless made so by the letter of the grant. Since the statute 21 James I.,¹ patents for useful inventions (notwithstanding the statute itself mentions the "inventor" only,) have always granted the privilege or monopoly to the inventor, his executor, administrator, and assigns. These monopolies are, therefore, assignable as other personal chattels, by force of the grant which creates them.

As a chattel also, it might be held by two or more joint owners; hence any undivided portion or interest in the whole as an unity might be assigned, and if the original grantee died, such assignees might join in action for an infringement of their right.² "But the patent-right itself was insusceptible of local subdivision."³ As a privilege or monopoly, it was an entire thing, indivisible, and incapable of apportionment.⁴

But the Act of Congress of 1836, has regulated the assignment of patents. The eleventh section provides, that a patent shall be assignable, 1st. As to *the [* 340] whole interest; 2d. As to any undivided part thereof; and 3d. An exclusive right may be granted throughout any specified part or portion of the United States. The fourteenth section requires the action for an infringement of

¹ Ch. 8d, § 5.

² *Boulton v. Bull*, 2 Henry Blackstone, 468.

³ *Whittemore v. Cutter*, 1 Gallison, 429-481; *ante*, vol. 1, 28.

⁴ *Brooks v. Byam*, 2 Story, 525; *ante*, 161.

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the patent, to be brought "in the name or names of the person or persons interested, whether as patentee, assignees, or as grantees of the exclusive right within and throughout a specified part of the United States." The word "assignees," in this section, must be construed by reference to the eleventh section, already referred to, which defines in what way a patent may be assigned — to wit: either the whole or any undivided portion of the whole. This statute also renders the monopoly capable of subdivision in the category of its locality, but in no other way. The patentee is not allowed to carve out his monopoly, which is an unity, into a hundred or more, all acting in the same place, and liable to come into conflict. The grant to Carter by the deed under consideration, is not of the whole monopoly, nor of any undivided portion of the whole, and though, for an "exclusive right," it is not exclusive of all others within a certain district, or specified part of the United States; on the contrary it is an exclusive right to use the machine for a specified purpose. A machine for turning irregular figures may be used for numberless purposes. If the patentee or his assignees can assign to A an exclusive right to use the machine for making shoe lasts, to B for turning spokes, to C for axe handles, and so on to the end of the alphabet, then may he, out of his one monopoly, carve out a thousand others, each subdivision, like a polypus, [* 341] being itself a several * monopoly, and having a separate existence in the same place. What endless perplexity and confusion must necessarily arise from the establishment of such a doctrine. Suppose the monopoly granted by this patent parcelled out to some twenty sub-monopolies, with an exclusive right to each to use his machine for certain purposes, in any given place; what remedy could A have against B for an infringement of his special privilege? The patentee or grantor, might restrain his grantee of a machine for a special use by a covenant; but as between the several grantees no

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action could lie, although they alone might suffer from a breach of the covenant.

But it is sufficient, for purposes of the present inquiry, that the Act of Congress has not given a legal sanction to such transfers or assignments, nor subjected even a pirate of the machine to fifty different suits by fifty several assignees, whose several interests might be affected, if a patent could be thus split up into numerous exclusive rights, or sub-monopolies. Whether the deed confers on Carter and his assigns more than a special license, or what remedy a court of equity might be disposed to extend to him, where his rights are infringed, it is not necessary now to inquire. As it does not confer a legal title to the whole, or an undivided portion of the patent, nor grant "an exclusive right within a specified part of the United States," it cannot be received to affect this case. It was wholly irrelevant and ought not to have been received in evidence.

It adds to my confidence in the correctness of this * view, that, as I have been informed, my brother Nelson has ruled the question in the same way in the second circuit.

New trial refused.

CASE V. REDFIELD & PUETT.

[4 McLean 526. May T. 1849.]

It is not essential to the validity of an assignment of a patent-right between the parties, or as against strangers, that it should be recorded in the Patent Office.

The record is notice to purchasers.

An ordinary assignment will not convey to the assignee an interest in the renewed patent.

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The renewal is for the benefit of the inventor, and an interest in it before its renewal must be especially assigned.

The individual who holds the original right patented, and also an improvement on that right, must assert his entire right in an action for an infringement. To show a violation of the patent, the declaration need only aver that the defendant has constructed, used, and sold to others, the things patented.

Smith and White, for plaintiffs.

Judah and McGaughey, for defendants.

OPINION OF THE COURT.

HUNTINGTON, J. The plaintiff claims to be the assignee of the patent-right granted to Zebulon and Austin Parker, on the 18th October, 1829, for the term of fourteen years, for the invention of "a percussion and reaction water wheel for mills," etc. And he alleges that on the 27th of June, 1840, the said patentees having invented a new and useful improvement on the above right, a patent for the improvement was issued to Zebulon Parker and Robert McKelvey, administrator of Austin Parker, deceased, in trust for his heirs at law, for fourteen years.

On the 31st of July, 1841, McKelvey, for the consideration of twenty-five hundred dollars, assigned to Zebulon Parker, "all the right, title, and interest which said heirs had in said invention and improvement, as secured to them by said letters-patent, for the whole of the United States, with certain exceptions, and for the use and behoof of his legal representatives, for which letters-patent were or may be granted for said improvements, as fully and entirely as the same would have been held and enjoyed by said heirs had that [* 527] *assignment and sale not been made." Other assignments were made down to the right asserted by the plaintiff.

And the plaintiff avers that the defendants have infringed his right, as stated under the patent. The defendant demurs

to the declaration, and assigns, as causes of demurrer, the following:

1. "That the declaration does not show that any assignment was ever made by the administrator of Austin Parker, deceased, of the extension of the original patent granted to Zebulon and Austin Parker, nor does it show any right in the present plaintiff in but one half of the present patent."

2. "The declaration is double and multifarious in this, that the plaintiff sues for the invasion in each count, of two separate and distinct rights growing out of separate and distinct patents, that is to say, for the invasion of the original patent granted October 19th, 1829, and also for an invasion of the patent for an improvement granted 27th June, 1840."

3. "The declaration does not set forth in what or by what means, the defendants violated the patents set forth."

There is also a demurrer to the last count in the declaration, which sets out the assignments, but does not aver that they are recorded in the Patent Office.

The assignments are set out in the declaration originally filed, and they are stated to have been recorded in the office; but this cannot obviate the objection made by the demurrer to the last count.

By the law of Congress, the assignments are required to be recorded; but the effect of an omission to have them recorded is not declared. It has been held by Mr. Justice Story, that a failure to record an assignment was not essential to its validity as between the parties and against strangers, and was only necessary by way of notice to purchasers. The same construction has been given to the statute by several circuit courts of the United States, and we think it is the true one. The demurrer to the last count in the declaration is therefore overruled.

In regard to the objection first made on the [528] special demurrer, that there has been no assignment

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of the interest in the heirs of Austin Parker, in the extended patent, it must be admitted that there has been no assignment of it since the patent was extended; and if there was no assignment of this interest before the extension, the truth of the fact is established, whatever may be its legal effect.

In the case of *Wilson v. Rousseau*, 4 Howard, 646, it was held, that the extension of the patent was given for the benefit of the original inventor or his representatives to compensate him for his expenditures, labor, and ingenuity in the invention, and in perfecting it; and that an ordinary assignment of the right in the patentee would not convey any right in the extended patent. But that such an interest, when intended to be assigned, must be expressed.

The original patent of the Parkers was extended for seven years, on the 4th of October, 1843. And, since the extension, there has been no assignment by the heirs of Austin Parker. But the plaintiff relies upon the assignment of McKelvey to Zebulon Parker, on the 31st July, 1841, as transferring the interest of the above heirs in the renewed patent. And it would seem, from the language of that assignment, this construction of it is sustainable.

It appears, at the time of this transfer, the original patent had but little more than two years to run. And, although one half of the improvement on the original patent was included in the assignment, yet the improvement without the original invention could not be used, and would be of little value. The sum of twenty-five hundred dollars was the consideration named in the assignment. From this it would be reasonable to infer that the entire interest in the heirs, present and future, in the invention, was intended to be conveyed; so large a sum would not have been paid for one half of the improvement on the original right, and a moiety of the original patent which would expire in two years.

The operative words of the assignment show the intention

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* of the parties. They are, "all the right, title, and [* 529] interest which said heirs had in said invention and improvement as secured to them by said letters-patent, for the whole of the United States, with certain exceptions, and for the use and behoof of his (Zebulon Parker's) representatives, for which letters-patent were or may be granted for said improvements, as fully and entirely as the same would have been held and enjoyed by said heirs had that assignment not been made."

Here is not only a present but a future interest assigned. An interest secured by the present letters-patent, or by patents which may (hereafter) be granted for said improvements. This was intended to transfer the right under a renewal of the patent. No other construction can be given to the words used. They can not be made to apply to any correction of a supposed error in the specifications or claims of the patent. Under the law when this assignment was made, the patent was not void for claiming more than was invented. And it is not pretended that there is any want of precision in the specifications.

Under the Act of 4th of July, 1836, Sec. 18, for the extension of a patent, it may have been supposed that a new grant would be issued. But a much shorter mode has been adopted by an indorsement on the original patent.

The second ground of objection in the special demurrer that "the declaration is double and multifarious," is not sustainable.

The wrong complained of is for an infringement on the improved patent, not for a violation of the original patent or of the improvement upon the original grant, but of the entire right, united in the plaintiff, by the different patents and assignments. The right set up is an entirety, and being united in the same individual is not susceptible of a division. Had he divided his cause of action, claiming damages in one

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case for the infringement of the original patent, and in another for an infringement of the improvement, the [* 530] actions * could not have been sustained. As well might different actions be brought for trespass upon a close, on the ground that the land was held under distinct titles. The injury done was to the entire close, and that constitutes the ground of the action.

It may be admitted that two defendants cannot be united in the same action, where each has infringed distinct patents: for in that case there could be no joint defence. There would be no right common to the defendants, and consequently both would be subjected to additional costs and delays by the joinder of the two. But where the original patent and the improvement on it are united in the same person, they constitute a whole, an entire right, and must be assessed as such in an action for an infringement.

The other ground of demurrer, as to the violation of the plaintiff's right is answered by the declaration. The wrong done is alleged in the usual form, that the defendant "made, constructed, used, and vended to sundry persons," etc., the said invention. The special demurrer is overruled.

ROBERTS & ROBERTS v. WARD & WARD.

[4 McLean, 565. June T. 1849.]

To entitle a person to a patent, his invention or improvement must be new. It must also be useful.
These points being submitted to a jury, they found against the plaintiff.

G. C. Bates and J. M. Howard, for complainants.

Joy and Porter, for defendants.

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OPINION OF THE COURT.

THIS bill charges the defendants with the violation of a patent-right. The complainants claim under Isaac Babbitt, the inventor, in virtue of legal assignments made and recorded in the Patent Office, the right within the State of Michigan.

The patentee claimed to have invented a new and improved mode of making or constructing the boxes, within which the gudgeons or journals of machinery in general and the axles of railroad cars, etc., are to run, by which mode of constructing or making such boxes or bearings, the heating and abrasions, which are apt to occur in the ordinary mode of constructing them, and their durability is consequently increased, and the following is the full description thereof:

“I prepare boxes which are to be received into housings or plumber’s blocks, in the ordinary mode of forming such boxes, making them of any kind of metal, or metallic compound, which has sufficient strength and which is capable of being tinned. The inner side of these boxes are to be lined, etc.

“To prepare the boxes for the reception of the composition, I cast them with projecting rims, etc. In finishing one of these boxes I cast the inside, including the rim, with tin, in the well-known manner of performing the operation. The composition being melted is poured in through a hole left for the purpose. When the ledges are not used the coating of the composition metal should be thin.”

And in the summing up he says: “What I claim as my * invention is, the making of the boxes for [* 566] axles and gudgeons, in the manner set forth, by the casting of hard pewter or composition metal, of which tin is the basis, into the said boxes, they being first prepared and provided with rims or ledges and coated with tin, as hereinbefore described.”

The above includes an improvement upon the original invention, for which a patent has also been obtained.

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An issue was made up and sent to the jury to try, whether the invention was new and useful.

To entitle an individual to a patent, his invention must be new and useful.

In ascertaining its usefulness, it is not important that it should be more valuable than other modes of accomplishing the same result; but it must be a practicable method of doing the thing designed, in which its utility will more or less consist.

The invention must be new. In the present case the improvement of the present box used for wheels so as to retain the composition metal, and the metal thus composed and applied as stated, constitute the invention. Now if any other individual used a similar box and compound, before the invention claimed by Babbitt, he can have no exclusive right. If a box was constructed upon the same principle, though not exactly in the same manner, it will defeat that part of the plaintiff's claim. The word principle, as applied to mechanics, is where two machines or things are made to operate, substantially in the same way, so as to produce a similar result, they are considered the same in principle. As where any of the mechanical powers, the lever, the screw, the wheel, etc., are used to accomplish certain purposes, the same powers being used in a somewhat different form, to do the same thing, will not be a difference in principle. Whether the mechanical instruments be larger or smaller, whether their action be horizontal or vertical, the principle is the same.

[* 567] * The patentee claims a combination of the box as stated, and the composition as applied. From his own statement he has improved the box, and put in it the metal. He does not, it seems, claim that the component parts of the metal are new or that the combination of them is so. The thing claimed is, the use of a softer material in-

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served in the box so as to prevent its heating or abrasion, by the action of the wheel. In this view, the introduction of this material is the principle of this improvement, and not the particular elements of which it is composed; and if it shall appear to the jury from the evidence, that a material similar in its effect had been publicly used in the box before the invention claimed by the patentee, his patent, in this particular, is void for want of novelty.

Evidence was given to the jury conducing to prove a want of novelty to the jury. And the case was submitted to them on principles as above stated. The jury found for the defendants. A motion for a new trial was made, which the Court overruled.

WILSON v. BARNUM.

[1 Wallace, 347. October T. 1849.]

*Value of Grant of Patent — Injunction — Second Trial —
Divided Court.*

The grant of a patent at the Patent Office, is not of itself, or in virtue of § 7 of the Act of July 4th, 1836, a bar to an interlocutory injunction in favor of a person claiming to be a prior patentee of the same thing; such person not having received notice at the Patent Office to appear and be heard, and the Court on a hearing before it, being well satisfied that the last patent is an interference with the one granted before.

The District Judge sitting for the Circuit Court, and being himself well satisfied of an infringement — although, of numerous experts examined, a majority thought differently from him on that point, — may grant an interlocutory injunction to restrain the use of a patented machine as an infringement of a prior one; the machine last patented not having been granted after notice from the Patent Office to the complainant, to appear and be heard.

Where a jury has had a case before it and disagreed, a second trial cannot be

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had by another jury from the residue of the panel. The case must go over in order that it may be tried on a new venire.

Where the District Judge, sitting for the Circuit Court, and being satisfied of an infringement, had granted an interlocutory injunction till trial, to restrain the use of a machine, and the President Judge, after hearing the evidence before the jury on the trial, differed from his brother, who after hearing the same evidence, still retained his former opinion, and the jury could find no verdict; the full Court, in its subsequent action on the injunction, need not consider itself either as bound or as unable to dissolve it; but the action upon it may be modified; the modification being largely regulated by what probably would have been the original action of a full Court.

THIS was a bill for an interlocutory injunction, to restrain the defendant from using a patented machine which it was said interfered with another machine previously patented to the complainant. The defendant did not deny the originality of the complainant's invention, but asserted his own to be no infringement of it. The complainant's patent was an ancient one. The defendant's had been granted under an act¹ which directs, that whenever a person applies for a patent, [* 348] an examination shall be made * by the Commissioner of Patents into the originality of the alleged invention; and allows the issuing of a patent, only in case the commissioner is satisfied that the invention is original. If on examination the commissioner thinks that there is interference, he then gives² notice to the patentee, with whose invention he supposes that the interference takes place, and lets him be heard. In this case the commissioner did not consider that there was an interference, and of course the complainant had no notice of the intended issue to the defendant.

Hirst and Stoughton, of New York, relying, among other grounds, including those of fact, upon this first provision of the act, opposed the grant of an injunction. The defend-

¹ Act of July 4th, 1836, § 7.

² Id. § 8. See Appendix.

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ant, they contended, has a patent which gives him a *prima facie* case everywhere. He has a right to trial by jury. It was impossible to regard his machine as so palpably or so probably an infringement, as to warrant the summary process of injunction, when the Commissioner of Patents, who has every means at command for ascertaining the originality, and employs them all, has regarded it as too manifestly original to cause a question. The act of the commissioner may not have been a judicial decree in form; nor have the technical conclusiveness of a precedent, and a *res adjudicata*. But it deserves every respect short of that, and will receive the highest respect as the investigation and a decision on the matter by an officer of state, to whom the investigation and decision are primarily and particularly intrusted. It is *quasi* judicial at least.

* *W. H. Seward*, of New York, *St. G. T. Camp* [* 349] *bell* and *S. V. Smith*, mentioned several cases where the commissioner had issued patents, after notice to prior patentees who came in and defended their rights, which patents had been afterwards pronounced, judicially, to be infringements. In this case there had been no notice to the complainant or to anybody. The commissioner issued the patent upon first impressions. He had not perceived any infringement, only because none had been shown to him. His act was extra-judicial; and if it were not, would be at best but a judgment without either writ, plea, issue, or argument. Even if there had been a hearing, the grant could not be a legal objection. It could not be pleaded nor put in evidence. It would at best be an extra-judicial opinion of more or less weight. If this Court — after a judicial examination — is thoroughly satisfied of the interference, it will not regard such an act as conclusive on its conscience.

KANE, J., sitting for the Circuit Court. There are cases

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under the present laws, in which the Court would enter reluctantly upon the discussion of the validity of patent. Some of the provisions of the Act of 1836, gave a quasi-judicial character to the action of the Commissioner of Patents; and it has accordingly been held, I believe generally, as well as justly, that the patent itself is to be taken as *prima facie* evidence of the novelty and usefulness of the invention specified in it.

There are other cases, in which the official action of the Patent Office claims, properly, a still higher degree [* 350] * of consideration. Whenever antagonist patentees, or third persons generally, have been first called in, it is reasonable to consider the action as a preliminary adjudication upon their rights. And this for the obvious reason, that they have been parties, or, but for their own fault, might have been parties, to the proceeding on which the adjudication was based.

But this is the limit, beyond which comity cannot be required to go. It cannot be asked, that a third person shall have his legal rights impaired, or his legal remedies impeded, by any proceeding to which he was not, and could not have made himself a party. To hold ourselves concluded by the action of the Patent Office, where that action has been without notice, would be as perilous to the interest of inventors as to that of the public. We had a case in our own Court not long since, where an injunction was sought against the real inventor, on the faith of a patent granted to a surreptitious claimant. The grant of a patent to the defendant can therefore have no other effect on the present discussion, than as it indicates the opinion, which highly respectable and skillful officers have formed, on an *ex parte* examination of the case.

Order accordingly.

This preliminary question being disposed of, an elaborate

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investigation was made as to the infringement in fact. The opinion of Mr. Justice Kane, sitting for the Circuit Court was, that there was an infringement. The testimony of many experts had been taken, and there was a direct conflict of opinion between them; the majority, however, being of opinion that the new machine was no infringement. In these * circumstances the defendant's counsel argued that [* 351] there was the greatest reason for leaving the case to a jury. There was no conflict of evidence as to the facts in the case. The conflict was in the conclusions arrived at by the different gentlemen upon the facts.

KANE, J. My only embarrassment in awarding an injunction, has been owing to the fact, that of the highly educated mechanics whose affidavits have been taken in the cause, the greater number have expressed an opinion different from that expressed by me. The consideration which was pressed in the argument, that the responsibility of deciding this question, might with propriety be devolved on a jury, has had no influence with me. That judicial morality might be impeached for infirmity, which could shrink from awarding to a party his remedy after ascertaining his rights. "The right of a party to the most speedy and effectual protection against a meditated wrong, is as complete as his right to redress for wrongs already inflicted; and the accident of position confers no right on one party, whether he be plaintiff or defendant, at the expense of the other. The special injunction in equity, like the arrest on mesne process at law, may be abused to the injury of an opponent; but it is no less on that account the duty of the judge to further them both, when, in the exercise of his best discretion, he believes that they are called for by the merits and the exigency." This was the language of the Court when on a former occasion this patent was before us, and my experience since has not taught me that it ought to be modified.

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[* 352] The preventive interposition * of equity, is very often the only effective resort of a meritorious patentee, and where the facts of the case are not controverted, I am by no means satisfied that it is not the safest for both parties.

There is no conflict of evidence here; the question is one of deduction of opinion. Were the case at this time under trial at bar, it would be the office of the judge to interpret the specification, and define the principle of the invention. This is the only point of difficulty, and it must be encountered by the judge, when he sits on one side or other of the Court.

To send the cause to a jury, would be to delay its adjudication for many months, leaving the complainant in the mean time with his legal rights suspended, and swelling the measure of the defendant's liabilities. I should do injustice to both parties, were I, with my present views of the merits of this controversy, to refuse the injunction.

Injunction awarded.

At the following sessions, the validity of the patent came on to be tried upon an issue directed to a jury; but after a thorough examination and argument, the jury could not agree and were discharged.

Hirst and *W. W. Hubbell*, having now shown that a great number of licenses, about to expire within a fortnight, were waiting for renewal upon the decision of the right, and that it was otherwise very important to their client and the public, that the right should be decided at once; moved for a second trial at this same term, by a new jury selected out of

[* 353] the existing panel, instead of waiting * as they would otherwise have to do, until the next session, a term of six months. *St. G. T. Campbell* opposed the application.

GRIER, J. An application of this same sort was made to

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me in a case while I presided in the District Court at Pittsburgh, where the case went off by withdrawing a juror. A decision from one of the Ohio or Indiana Courts was then cited in support of the motion. In consequence of that decision, I looked thoroughly into the matter at the time, and was satisfied that the decision was not founded in the principles of the common law and was wrong. I have no doubt that a settlement of this patent-right, at once, is important, but it cannot be tried now except by consent. There must be a second *venire*.

Motion refused.

On a subsequent day, it having appeared by a communication from the bench that the Court, after full argument on the evidence, were divided on the question of infringement, and the jury having been unable to find a verdict, Mr. Hirst and Mr. W. W. Hubbell, moved to dissolve the injunction absolutely. It had been granted by the District Judge, they argued, in the absence of his brother, who now after full examination, came to the conclusion that there was no infringement. Had the latter judge been present when the injunction was applied for, the Court being divided, would not have granted it; and if it could, would not. A jury had moreover refused to pronounce that there was any infringement. This, supported by the action of the Patent Office, which regarded the invention as original, and by the *patent which [*354] gave a *prima facie* right, made a clear case for a jury alone.

W. H. Seward, St. G. T. Campbell, and S. V. Smith, in favor of continuing the injunction, argued that the act of either judge, sitting for the Circuit Court, was the act of the Court. As a Circuit Court, each judge is of absolute equality. It is impossible to say, what the circuit judge's opinion would have been, had he heard the argument for the injunction.

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That is a matter past and gone, and of which no judicial cognizance could now be taken. Each judge was satisfied of the correctness of his own opinion; and whether each chose to rely on his own, or each to defer to his brother's, the Court would still be equally divided. In that state of things, what could be done? Simply nothing. The injunction would stand of its own force.

The inability of the jury to find a verdict, Mr. Seward argued, was of no significance. They had been summoned to settle the matter, and they had not settled it, but left it where it was. Had they even found a verdict, it would have been of little value unless approved by the Court, who, if disapproving of it, would have set it aside. No verdict was of no value.

GRIER, J., expressing the high respect he entertained for the opinion of his brother Kane, particularly upon questions relating to patents, and Kane, J., stating that from the time he found that a difference of opinion existed between him and the presiding judge upon the question of infringement, his inclination was to have the matter disposed of, as if [* 355] the * Court had been full when the injunction was applied for; and both members of the Court—in the difference of opinion which existed between them, and which it seemed could not be removed—being desirous of protecting both parties to the suit from any errors which might exist by either dissolving absolutely, or absolutely continuing the injunction, made an order to this effect: That the injunction should be dissolved if the defendant in ten days should give security in \$10,000 to keep an account, &c., and pay, &c., in case of a final decree being entered against him. On his failure to give such security, then in case the complainant should in ten days afterwards give security in \$20,000, the injunction to stand; and in default of his giving such security, to be dissolved without condition.

APPENDIX.

PATENT LAWS.

CONSTITUTION OF THE UNITED STATES.

ARTICLE 1ST, SECTION 8TH.

“ THE Congress shall have power, &c., to promote the progress of science and useful arts, by securing for limited times to Authors and Inventors the exclusive right to their respective writings and discoveries.” Also, “ to make all laws which shall be necessary and proper for carrying into execution the foregoing powers.”

CHAP. VII.—AN ACT to promote the progress of useful arts.

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

1790.
Patents for useful discoveries, how applied for, and granted.
Repealed by the Act of 21st Feb. 1793, chap. 11.
The Secretary of State, the Secretary of War, and the Attorney-Gen'l, or any two of them, if

deem the invention, &c., useful and important, to cause letters-patent to be issued.

Continuance of a patent.

Attorney-General to certify the conformity of the patent with this act.

Patents to be recorded.

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.

Specification in writing, with a draft or model thereof, to be delivered and filed in the office of the Secretary of State.

SEC. 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; 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.

Certified copies, in what cases to be evidence.

Copies of specification and models may be taken.

SEC. 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.

SEC. 4. *And be it further enacted*, That if any person or persons shall devise, make, construct, use, employ, or vend within these United States, any art, manufacture, engine, machine, or device, or any invention or improvement upon, or in any art, manufacture, engine, machine, or vice, 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.¹

Penalty for making, &c., any art, &c., for which a patent has been granted.

Damages to be assessed by a jury.

SEC. 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

Patents surreptitiously obtained.

How to be repealed.

¹ Hasting's Patent—forfeiture of the thing made. See Webster's Patent Cases, page 6.

by the Court, and recovered in such manner as costs expended by defendants, shall be recovered in due course of law.

In actions for penalty, patents to be deemed *prima facie* evidence of the first discovery; but special matter may be given in evidence; and to what effect.

Sec. 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; but that nevertheless the defendant or defendants may plead the general issue, and give this act, and any special matter whereof notice in writing shall have been given to the plaintiff, or his attorney, thirty days before the trial, in evidence, tending to prove that the specification filed by the plaintiff does not contain the whole of the truth concerning his invention or discovery; or that it contains more than is necessary to produce the effect described; and if the concealment of part, or the addition of more than is necessary, shall appear to have been intended to mislead, or shall actually mislead the public, so as the effect described cannot be produced by the means specified, then, and in such cases, the verdict and judgment shall be for the defendant.

Patent fees.

Sec. 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 10, 1790.

Repealed by Act July 4, 1836. CHAP. XI. — AN ACT to promote the progress of useful arts, and to repeal the act heretofore made for that purpose.

Same as Act of 1790, chap. 7, except Secretary of State instead of Secretary of War.

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, manu-

facture, or composition of matter, not known or used before the application, and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State, to cause letters-patent to be made out in the name of the United States, bearing teste by the President of the United States, reciting the allegations and suggestions of the said petition, and giving a short description of the said invention or discovery, and thereupon granting to such petitioner, or petitioners, his, her, or their heirs, administrators, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery, which letters-patent shall be delivered to the Attorney-General of the United States, to be examined; who, within fifteen days after such delivery, if he finds the same conformable to this act, shall certify accordingly, at the foot thereof, and return the same to the Secretary of State, who shall present the letters-patent thus certified, to be signed, and shall cause the seal of the United States to be thereto affixed; and the same shall be good and available to the grantee or grantees, by force of this act, and shall be recorded in a book, to be kept for that purpose, in the office of the Secretary of State, and delivered to the patentee or his order.

Letters-patent, how and by whom made out. Act of April 10, 1790, ch. 7, repealed. To bear teste by the President, and

be examined by the Attorney-General.

1800, ah. 25.

SEC. 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. 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.

The liberty of using an improvement defined. Additional to Act of 1790. Changing the form or proportions of any machines, &c., not to be a discovery.

SEC. 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

How to proceed to obtain letters-patent. 1800, ch. 25, sec. 2. Specification.

Additional to Act of 1790. to enable any person skilled in the art or science, of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions; and he shall accompany the whole with drawings and written references, where the nature of the case admits of drawings, 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. And such inventor shall, moreover, deliver a model of his machine, provided the secretary shall deem such model to be necessary.

Specification.

Inventors may assign their titles.

Additional to Act of 1790.

Record of assignment to be made in the office of the Sec. of State.

Forfeiture on using patented inventions without leave.

See Act 1800.

Three times the price to be the penalty.

Additional to Act of 1790.

How recovered.

How defendants may give this act in evidence.

Act 1790.

SEC. 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 there-after stand in the place of the original inventor, both as to right and responsibility, and so the assignee of assigns, to any degree.

SEC. 5. *And be it further enacted*, That if any person shall make, devise, 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; 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.

SEC. 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, of which notice in writing may have been given to the plaintiff, or his attorney, thirty days before trial, in evidence, tending to prove that the specification, filed by the plaintiff, does not contain the whole truth relative to his discovery, or that it contains more than is neces-

sary 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, or had been described in some public work anterior to the supposed discovery of the patentee, 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.

Addition al to Act of 1790.

And judgment shall be given.

SEC. 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.

State rights to inventions, when to be deemed void.

Addition al to Act of 1790.

SEC. 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, intitled "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.

How applications depending under former law shall be prosecuted under this act.

Addition al to Act of 1790, ch. 7.

SEC. 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 choose 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.

Proceedings to be had on interfering applications.

Addition al to Act of 1790.

SEC. 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

And against persons surreptitiously obtaining patents.

One year, in Act of 1790.

afterwards, it shall and may be lawful for the judge of the said District Court, if the matter alleged shall appear to him to be sufficient, to grant a rule, that the patentee, or his executor, administrator, or assign show cause why process should not issue against him to repeal such patent. And if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued against such patentee, or his executors, administrators, or assigns, with costs of suit. And in case no sufficient cause shall be shown

Repeal of a patent illegally obtained.

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.

Inventor, before presenting petition, to pay \$30 into the treasury.

Additional to Act of 1790.

Alteration of fees.

Copying fees.

Additional to Act of 1790.

Act of April 10, 1790, ch. 7, repealed.

Proviso.

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

SEC. 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 21, 1793.

CHAP. LVIII. — AN ACT supplementary to the act intituled "An act to promote the progress of useful arts." (Obsolete.)

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 intituled 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 7, 1794.*

Suits, &c., had under certain act revived.
Act of February 21, 1793, ch. 11.
Act of April 10, 1790, ch. 7.
In what manner.

CHAP. XXV. — 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. (Repealed.)

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, Aliens having resided two years within the United States, entitled to the benefit of the former act. Act of Feb. 21, 1793, ch. 11.

Additional to Act of 1793. 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

Oath to be taken by such resident, that the invention or discovery hath not been used. 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

By Act of 1793, he must be "the true and original inventor." shall be obtained pursuant to this act, for any invention, art, or discovery which it shall afterwards appear had been known or used previous to such application for a patent, shall be utterly void.

The legal representatives of a deceased inventor may obtain a patent. Additional to Act of 1793. SEC. 2. *And be it further enacted,* That where any person hath made, or shall have made, any new invention, discovery, or improvement on account of which a patent might, by virtue of this or the above-mentioned act, be granted to such person, and shall die before any patent shall be granted therefor, the right of applying for and obtaining such patent, shall devolve on the legal representatives of such person in trust for the heirs at law of the deceased, in case he shall have died intestate; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations, and restrictions, as the same was held or might have been claimed or enjoyed by such person, in his or her lifetime; and when application for a patent shall be made by such legal representatives, the oath or affirmation, provided in the third section of the before-mentioned act, shall be so varied as to be applicable to them.

Damages for breach of patent-right. SEC. 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 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

Additional to Act of 1793. to three times the actual damage sustained by such patentee, his executors, administrators, or assigns, from or by

To be covered by reason of such offence, which sum shall and may be covered, by action on the case, founded on this and the above-mentioned act, in the Circuit Court of the United States, having jurisdiction thereof.

SEC. 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.

Repealed of part of the former act. Act of Feb. 21, 1793, ch. 11.

Approved April 17, 1800.

CHAP. XIX.—AN ACT to extend the jurisdiction of the Circuit Courts of the United States to cases arising under the law relating to patents.

Repealed by Act of July 4, 1886.

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.

The Circuit Courts to have original cognizance in equity and at law, in controversies respecting the right to inventions and writings.

Act of Feb. 21, 1793, ch. 11.

Act of May 31, 1790, ch. 15.

Proviso. Additional to previous acts.

Approved February 15, 1819.

CHAP. CLXII.—AN ACT concerning patents for useful inventions.

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.

Repealed by Act of July 4, 1886, chap. 357.

Additional to previous acts.

List of expired patents to be annually reported to Congress.

Form of application to prolong or renew patent.

Addition- al to previ- ous acts.

Patent to be invalid in case of inventor not having complied with the terms, &c. 1793, ch. 11.

Addition- al to previ- ous acts.

Secretary of State, upon sur- render, &c., to grant a new patent.

In case of death, &c., right to vest in execu- tors, &c. Proviso.

SEC. 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 presenta- tion, 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.

SEC. 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 Con- gress, intituled "An act to promote the progress of useful arts, and to repeal the act heretofore made for that pur- pose," passed on the twenty-first day of February, in the year of our Lord, one thousand seven hundred and ninety- three, or of any of the acts supplementary thereto, shall be invalid or inoperative, by reason that any of the terms or conditions prescribed in the third section of the said first-mentioned act, have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive inten- tion, 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 assign- ment 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 mat- ters of objection and defence, as any original patent granted under the said first-mentioned act. But no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be a free public use thereof, shall, in any manner, prejudice his right of recovery for any use or violation of his invention after the grant of such new patent as aforesaid.

Approved July 3, 1832.

CHAP. CCIII.—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 13, 1832.

Repealed by act of July 4, 1836. The privileges granted to aliens extended. Act of April 17, 1800, ch. 25. *Provido.* Additional to previous Acts. By Act of July 4, 1836. By Act of July 4, 1836, time extended to eighteen months.

CHAP. CCCLVII.—AN ACT to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That there shall be established and attached to the Department of State 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 pro-

Mar. 3, 1837, ch. 43. Additional to previous Acts. Commissioner of Patents to be appointed, and his duties. August 29, 1842, ch. 263.

vided for, or shall hereafter be, by law, directed to be done and performed, and shall have the charge and custody of all the books, records, papers, models, machines, and all other things belonging to said office. And said commissioner shall receive the same compensation as is allowed by law to the Commissioner of the Indian Department, and shall be entitled to send and receive letters and packages by mail, relating to the business of the office, free of postage.

Chief clerk.
Additional to previous Acts.

SEC. 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, 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. 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. And said commissioner, clerks, and every other person appointed and employed in said office, shall be disqualified and interdicted from acquiring or taking, except by inheritance, during the period for which they shall hold their appointments, respectively, any right or interest, directly or indirectly, in any patent for an invention or discovery which has been, or may hereafter be, granted.

Examining clerk, and other officers.

Officers to make oath, &c.
Additional to previous Acts.

SEC. 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.

SEC. 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 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. And any person making application therefor may have certified copies of the records, drawings, and other papers deposited in said office, on paying, for the 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 seal to be provided. Additional to previous Acts.

SEC. 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, 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, 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, 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.

Patents to be signed by the Secretary of State and by the Commissioner.

Substantially the same as previous provisions. By Act of 1837, may issue to assignees, &c.

Additional to previous Acts.

SEC. 6. *And be it further enacted*, That any person or persons having discovered or 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 by others 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, as the inventor or discoverer, and shall desire to obtain an exclusive property therein, may make application in writing, to the Commissioner of Patents, expressing such desire, 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

Applications, how made.

1790, 1793, 1798, entitled upon allegation of discovery, or invention.

Specification.

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; and in case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions; and shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery. He shall, furthermore, accompany the whole with a drawing or drawings, 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. The applicant shall also make oath, or affirmation, that he does verily believe that he is the original and first inventor or discoverer of the art, machine, composition, or improvement, for which he solicits a patent; and that he does not know or believe that the same was ever before known or used; and also of what country he is a citizen; which oath or affirmation may be made before any person authorized by law to administer oaths.

Drawings, &c.
Sec. 6,
Act 1887,
requires
duplicate
drawings.

Models.

Oath or
affirmation.
See Sec.
13, Act of
1887.

Examination of
invention,
to be made,
and proceedings
thereon,
should it
not be
deemed
new.

Additional to
previous Acts.
See Sec.
8, Act of
1887,
March 8.

SEC. 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, 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, if the commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. 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 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. 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. 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, 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, to be composed of three disinterested persons who shall be appointed for that purpose by the Secretary of State, one of whom, at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains; who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate in writing of the opinion and decision of the commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, as well as to the commissioner, of the time and place of their meeting, that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision; and it shall be the duty of the commissioner to furnish to the board of examiners such information as he may 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

By Act of 1837, March 3, sec. 7, applicant may disclaim if specification be too broad.

See Sec. 8, also of the same Act.

By the Act of 1839, March 3d, sec. 11, appeals are allowed to the Chief Justice of the District of Columbia instead of the Board of Examiners. And by the Act of 1852, Aug. 30, appeal allowed to either of the assistant judges of the Circuit Court for the District of Columbia.

So much of this section as relates to the Board of Examiners is repealed by sec. 11, act of 1889.

By the 2d sec. of the Act of 1852, Aug. 30, the sum of twenty-five dollars to be paid to the Chief Justice or assistant judges.

Interfering applications. Additional to previous acts.

See sec. 12, Act of 1839, as to regulations for taking testimony.

By the Act of 1839, sec. 6, entitled to the patent though the application be not made within six months after date of foreign patent.

Thirty dollars to be paid to the credit of the United States treasurer by a citizen or, &c. See sec. 12, Act of 1837.

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.

SEC. 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; and if either shall be dissatisfied with the decision of the commissioner on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act, and the like proceedings shall be had to determine which, or whether either, of the applicants is entitled to receive a patent as prayed for. But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters-patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings. And whenever the applicant shall request it, the patent shall take date from the time of filing of the specifications 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.

SEC. 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, to the credit of the treasury, if he be a citizen in 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; 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.

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

SEC. 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, the thing patented within and throughout any specified part or portion of the United States, shall be recorded in the Patent Office within three months from the execution thereof, for which the assignee or grantee shall pay to the commissioner the sum of three dollars.

SEC. 12. *And be it further enacted*, That any citizen of the United States, or alien, who shall have been a resident of the United States one year next preceding, and shall have made oath of his intention to become a citizen thereof, who shall have invented any new art, machine, or improvement thereof, and shall desire further time to mature the same, may, on paying to the credit of the treasury, in manner as provided in the ninth section of this act, the sum of twenty dollars, file in the Patent

Act of 1800. Two years is required; 1832, must be a resident and declare his intention to become a citizen.

Five hundred dollars by a subject of Great Britain, and three hundred by other persons.

Inventors dying without taking a patent, their executors, &c., may &c.

1798. Act of 1800. Act of 1832.

Assignment of a patent, and record thereof.

1798. By the 6th sec. of the Act of 1837, patent may issue in the name of the assignee if assignment be recorded before the patent is issued.

Fee for recording assignments, see sec. 2, Act of May 27, 1848.

Caveat Office a caveat setting forth the design and purpose thereof, and its principal and distinguishing characteristics, and praying protection of his right, till he shall have matured his invention; which sum of twenty dollars, in case the person filing such caveat shall afterwards take out a patent for the invention therein mentioned, shall be considered a part of the sum herein required for the same. And such caveat shall be filed in the confidential archives of the office, and preserved in secrecy. And if application shall be made by any other person, within one year from the time of filing such caveat, for a patent of any invention with which it may in any respect interfere, it shall be the duty of the commissioner to deposit the description, specifications, drawings, and model, in the confidential archives of the office, and to give notice (by mail) to the person filing the caveat of such application, who shall, within three months after receiving the notice, if he would avail himself of the benefit of his caveat, file his description, specification, drawings, and model; and if, in the opinion of the commissioner, the specifications of claim interfere with each other, like proceedings may be had in all respects as are in this act provided in the case of interfering applications. *Provided, however,* That no opinion or decision of any board of examiners, under the provisions of this act, shall preclude any person interested in favor of or against the validity of any patent which has been or may hereafter be granted, from the right to contest the same in any judicial court, in any action in which its validity may come in question.

Patents invalid from defective specifications may be surrendered, and new patents may be issued in certain cases. *Act, 1832, sec. 3. See sec. 5, Act of 1837.*

SEC. 13. *And be it further enacted,* That whenever any patent, which has heretofore been granted, or which shall hereafter be granted, shall be inoperative or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification, as his own invention, more than he had or shall have a right to claim as new, if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the commissioner, upon the surrender to him of such patent, and the payment of the further duty of fifteen dollars, to cause a new patent to be issued to the said inventor for the same invention, for the residue of the period then unexpired, for which the original patent was granted, in accordance with the patentee's corrected description and specification. And in case of his death, or any assignment by him made of the original patent, a similar right shall vest in his executors, administrators, or assignees. And the patent so reissued,

together with the corrected description and specifications, shall have the same effect and operation in law, on the trial of all actions hereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form, before the issuing of the original patent. And whenever the original patentee shall be desirous of adding the description and specification of any new improvement of the original invention or discovery, which shall have been invented or discovered by him subsequent to the date of his patent, he may, like proceedings being had in all respects as in the case of original applications, and on the payment of fifteen dollars, as hereinbefore provided, have the same annexed to the original description and specification; and the commissioner shall certify, on the margin of such annexed description and specification, the time of its being annexed and recorded; and the same shall thereafter have the same effect in law, to all intents and purposes, as though it had been embraced in the original description and specification.

Patentee may make additions to his patent. (Additional to previous Acts.

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

Courts may render judgment for a sum not exceeding three times the amount of actual damages.

See Act, 1800.

Three times actual damages sustained.

1790, damages sustained, and profert the thing patented and in use by defendant.

SEC. 15. *And be it further enacted*, That the defendant in any such action shall be permitted to plead the general issue, and to give this act and any special matter in evidence, of which notice in writing may have been given to the plaintiff or his attorney, thirty days before trial, tending to prove that the description and specification filed by the plaintiff, does not contain the whole truth relative to his invention or discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made for the purpose of deceiving the public; or that the patentee was not the original and first inventor

Defendant may plead the general issue, &c. 1790. 1793.

X

1793. or discoverer of the thing patented, or of a substantial and material part thereof claimed as new; or that it had been described in some public work, anterior to the supposed discovery thereof by the patentee, or had been in public use, or on sale, with the consent and allowance of the patentee, before his application for a patent; or that he had surreptitiously or 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; or that the patentee, if an alien at the time the patent was granted, had failed and neglected, for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reasonable terms, the invention or discovery for which the patent issued; and whenever the defendant relies in his defence on the fact of a previous invention, knowledge, or use of the thing patented, he shall state, in his notice of special matter the names and places of residence of those whom he intends to prove to have possessed a prior knowledge of the thing and where the same had been used; in either of which cases judgment shall be rendered for the defendant, with costs: *Provided, however,* That whenever it shall satisfactorily appear that the patentee, at the time of making his application for the patent believed himself to be the first inventor or discoverer of the thing patented, the same shall not be void on account of the invention or discovery, or any part thereof, having been before known or used in any foreign country; it not appearing that the same, or any substantial part thereof, had before been patented or described in any printed publication; *And provided, also,* That whenever the plaintiff shall fail to sustain his action on the ground that in his specification or claim is embraced more than that of which he was the first inventor, if it shall appear that the defendant had used or violated any part of the invention justly and truly specified and claimed as new, it shall be in the power of the Court to adjudge and award, as to costs, as may appear to be just and equitable.

Additional to previous acts. Unless such use or rule was more than two years prior to the application for a patent. Act of March 3, 1839, sec. 7. 1793. Partly additional. See Act, 1832. Additional to previous acts. Proviso. See sec. 9, Act of 3d March, 1837, patent shall be deemed good for so much as the patentee is *bona fide* the inventor of, although a part of that claimed may not be new, provided, &c. Proviso. Additional to previous acts. Interfering patents, &c. Additional except, see Act 1793.

SEC. 16. *And be it further enacted,* That, whenever there shall be two interfering patents, or whenever a patent or application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant, in the other case, may have remedy by bill in equity; and the Court having cognizance thereof, on notice to adverse parties, and other due pro-

ceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative and invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall, in any such case, be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act: *Provided, however,* that no such judgment or adjudication shall affect the rights of any person, except the parties to the action, and those deriving title from or under them subsequent to the rendition of such judgment.

The provisions of the section are extended to all cases of refusal of patents whether by the Commissioner or Chief Justice of the District of Columbia; see sec. 10 of the Act of 1839, March 3.

Proviso.

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

Actions cognizable in Circuit Courts of the United States, &c. Act of 1793. Act of 1800. Not exclusive.

Proviso. Additional as to appeal and exclusive.

SEC. 18. *And be it further enacted,* That whenever any patentee of an invention or discovery shall desire an extension of his patent beyond the term of its limitation, he may make application therefor, in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof; and the commissioner shall, on the applicant's paying the sum of forty dollars to the credit of the treasury, as in the case of an original application for a patent, cause to be published in one or more of the prin-

Patents may be extended seven years in certain cases. Act of 1832, ch. 162.

By the 1st section of the Act of May 27, 1841, this power is vested in the Commissioner solely.

cipal newspapers in the city of Washington, and in such other paper or papers as he may deem proper, published in the section of country most interested adversely to the extension of the patent, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. And the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury, shall constitute a board to hear and decide upon the evidence produced before them, both for and against the extension, and shall sit, for that purpose, at the time and place designated in the published notice thereof. The patentee shall furnish to said Board a statement, in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of said invention. And if, upon a hearing of the matter, it shall appear to the full and entire satisfaction of said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault on his part, having failed to obtain from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the commissioner to renew and extend the patent, by making a certificate thereon of such extension, for the term of seven years from and after the expiration of the first term; which certificate, with a certificate of said board of their judgment and opinion as aforesaid, shall be entered on record in the Patent Office; and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years; and the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented to the extent of their respective interests therein: *Provided, however,* That no extension of a patent shall be granted after the expiration of the term for which it was originally issued.

Library of Patent Office. Additional. SEC. 19. *And be it further enacted,* That there shall be provided, for the use of the said office, a library of scientific works and periodical publications, both foreign and American, calculated to facilitate the discharge of the duties hereby required of the chief officers therein, to be purchased under the direction of the committee of the library of Congress. And the sum of fifteen hundred dollars is hereby appropriated for that purpose, to be paid out of the Patent Fund.

Sec. 20. *And be it further enacted*, That it shall be the duty of the commissioner to cause to be classified and arranged, in such rooms or galleries as may be provided for that purpose, in suitable cases, when necessary for their preservation, and in such manner as shall be conducive to a beneficial and favorable display thereof, the models and specimens of compositions and of fabrics, and other manufactures and works of art, patented or unpatented, which have been, or shall hereafter be deposited in said office. And said rooms or galleries shall be kept open during suitable hours, for public inspection.

Models to be classified and arranged. Additional.

Sec. 21. *And be it further enacted*, That all acts and parts of acts heretofore passed on this subject be, and the same are hereby repealed: *Provided, however*, That all actions and processes in law or equity, sued out prior to the passage of this act, may be prosecuted to final judgment and execution, in the same manner as though this act had not been passed, excepting and saving the application to any such action of the provisions of the fourteenth and fifteenth sections of this act, so far as they may be applicable thereto: *And provided, also*, That all applications for petitions for patents, pending at the time of the passage of this act, in cases where the duty has been paid, shall be proceeded with and acted on in the same manner as though filed after the passage thereof.

Former acts repealed. Proviso.

Proviso.

JAMES K. POLK,

Speaker of the House of Representatives.

W. R. KING,

President of the Senate, pro tempore.

Approved July 4, 1836.

ANDREW JACKSON.

CHAP. XLV.—AN ACT in addition to the act to promote the progress of science and useful arts.

The Act of 1836

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That any person who may be in possession of, or in any way interested in, any patent for an invention, discovery, or improvement, issued prior to the fifteenth day of December, in the year of our Lord one thousand eight hundred and thirty-six, or in an assignment of any patent, or interest therein, executed and recorded prior to the said fifteenth day of December, may, without charge, on presentation or transmission thereof to the Commissioner of Patents, have the same recorded anew in the Patent Office, together with the descriptions, spe-

forms the basis, and all subsequent acts are additional. Patents issued, and assignments executed and recorded prior to 15th December, 1836, may be recorded anew, &c.

cifications of claim, and drawings annexed or belonging to the same ; and it shall be the duty of the commissioner to cause the same, or any authenticated copy of the original record, specification, or drawing, which he may obtain, to be transcribed and copied into books of record, to be kept for that purpose ; and, wherever a drawing was not originally annexed to the patent, and referred to in the specification, any drawing produced as a delineation of the invention, being verified by oath in such manner as the commissioner shall require, may be transmitted and placed on file, or copied as aforesaid, together with certificate of the oath ; or such drawings may be made in the office, under the direction of the commissioner, in conformity with the specification. And it shall be the duty of the commissioner to take such measures as may be advised and determined by the Board of Commissioners, provided for in the fourth section of this act, to obtain the patents, specifications, and copies aforesaid, for the purpose of being so transcribed and recorded. And it shall be the duty of each of the several clerks of the judicial courts of the United States to transmit, as soon as may be, to the Commissioner of the Patent Office, a statement of all the authenticated copies of patents, descriptions, specifications, and drawings of inventions and discoveries, made and executed prior to the aforesaid fifteenth day of December, which may be found on the files of his office ; and also to make out and transmit to said commissioner, for record as aforesaid, a certified copy of every such patent, description, specification, or drawing, which shall be specially required by said commissioner.

Measures to be taken to obtain patents, &c., to be recorded, &c.

Clerks of the judicial courts of U. States to transmit statements of authenticated copies of patents, &c., prior to 15th December, 1836, &c.

Certified copies of such record, &c., to be evidence in any judicial court of U. S. &c.

No patent, &c., issued, &c., prior to Dec. 15, 1836, to be received in evidence in said courts, after 1st June next, unless re-recorded anew.

SEC. 2. *And be it further enacted*, That copies of such record and drawings, certified by the commissioner, or, in his absence, by the chief clerk, shall be *primâ facie* evidence of the particulars of the invention, and of the patent granted therefor, in any judicial court of the United States, in all cases where copies of the original record or specification and drawings would be evidence, without proof of the loss of such originals ; and no patent issued prior to the aforesaid fifteenth day of December shall, after the first day of June next, be received in evidence, in any of the said courts, in behalf of the patentee, or other person who shall be in possession of the same, unless it shall have been so recorded anew, and a drawing of the invention, if separate from the patent, verified as aforesaid, deposited in the Patent Office ; nor shall any written assignment of any such patent, executed and recorded prior to the said fifteenth day of December, be received in evidence in any of the said courts,

in behalf of the assignee, or other person in possession thereof, until it shall have been so recorded anew.

SEC. 3. *And be it further enacted*, That, whenever it shall appear to the commissioner that any patent was destroyed by the burning of the Patent Office building, on the aforesaid fifteenth day of December, or was otherwise lost prior thereto, it shall be his duty, on application therefor by the patentee, or other person interested therein, to issue a new patent for the same invention or discovery, bearing the date of the original patent, with his certificate thereon, that it was made and issued pursuant to the provisions of the third section of this act, and shall enter the same of record: *Provided, however*, That, before such patent shall be issued, the applicant therefor shall deposit in the Patent Office a duplicate, as near as may be, of the original model, drawings, and descriptions, with specifications of the invention or discovery, verified by oath, as shall be required by the commissioner; and such patent and copies of such drawings and descriptions, duly certified, shall be admissible as evidence in any judicial court of the United States, and shall protect the rights of the patentee, his administrators, heirs, and assigns, to the extent only in which they would have been protected by the original patent and specification.

New patents to be issued for those lost or destroyed on or before Dec. 15, 1886. Extended to patents lost subsequently to Dec. 15, 1886, Act of 29 August, 1842, sec. 2. Proviso.

SEC. 4. *And be it further enacted*, That it shall be the duty of the commissioner to procure a duplicate of such of the models destroyed by fire on the aforesaid fifteenth day of December, as were most valuable and interesting, and whose preservation would be important to the public; and such as would be necessary to facilitate the just discharge of the duties imposed by law on the commissioner in issuing patents, and to protect the rights of the public and of patentees in patented inventions and improvements: *Provided*, That a duplicate of such models may be obtained at a reasonable expense: *And provided, also*, That the whole amount of expenditure for this purpose shall not exceed the sum of one hundred thousand dollars. And there shall be a temporary Board of Commissioners, to be composed of the Commissioner of the Patent Office and two other persons to be appointed by the President, whose duty it shall be to consider and determine upon the best and most judicious mode of obtaining models of suitable construction; and, also, to consider and determine what models may be procured in pursuance of, and in accordance with, the provisions and limitations in this section contained. And said commissioners may make and establish all such regula-

Duplicates of certain models to be procured.

Proviso.

Further proviso.

A temporary board of commissioners to be appointed; their duties.

tions, terms, and conditions, not inconsistent with law, as in their opinion may be proper and necessary to carry the provisions of this section into effect, according to its true intent.

Patents returned for correction, &c., under the 18th section of the act to which this is additional, &c.

Act of 1836, ch. 357.

Proviso.

No addition, &c., to be made to any patent heretofore granted, &c., until a verified duplicate model, &c., is deposited, &c.

Compensation for models, &c.

Patents hereafter to be issued.

SEC. 5. *And be it further enacted*, That, whenever a patent shall be returned for correction and reissue, under the thirteenth section of the act to which this is additional, and the patentee shall desire several patents to be issued for distinct and separate parts of the thing patented, he shall first pay, in manner and in addition to the sum provided by that act, the sum of thirty dollars for each additional patent so to be issued: *Provided, however*, That no patent made prior to the aforesaid fifteenth day of December, shall be corrected and reissued, until a duplicate of the model and drawing of the thing, as originally invented, verified by oath as shall be required by the commissioner, shall be deposited in the Patent Office.

Nor shall any addition of an improvement be made to any patent heretofore granted, nor any new patent be issued for an improvement made in any machine, manufacture, or process, to the original inventor, assignee, or possessor of a patent therefor, nor any disclaimer be admitted to record, until a duplicate model and drawing of the thing originally invented, verified as aforesaid, shall have been deposited in the Patent Office, if the commissioner shall require the same; nor shall any patent be granted for an invention, improvement, or discovery, the model or drawing of which shall have been lost, until another model and drawing, if required by the commissioner, shall, in like manner, be deposited in the Patent Office. And in all such cases, as well as in those which may arise under the third section of this act, the question of compensation for such models and drawing, shall be subject to the judgment and decision of the commissioners provided for in the fourth section, under the same limitations and restrictions as are therein prescribed.

SEC. 6. *And be it further enacted*, That any patent hereafter to be issued, may be made and issued to the assignee or assignees of the inventor or discoverer, the assignment thereof being first entered of record, and the application therefor being duly made, and the specification duly sworn to by the inventor. And in all cases hereafter, the applicant for a patent shall be held to furnish duplicate drawings, whenever the case admits of drawings, one of which to be deposited in the office, and the other to be annexed to the patent, and considered a part of the specification.

SEC. 7. *And be it further enacted,* That, whenever any patentee shall have, through inadvertence, accident, or mistake, made his specification of claim too broad, claiming more than that of which he was the original or first inventor, some material and substantial part of the thing patented being truly and justly his own, any such patentee, his administrators, executors, and assigns, whether of the whole or of a sectional interest therein, may make disclaimer of such parts of the thing patented as the disclaimant shall not claim to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent; which disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office, on payment by the person disclaiming, in manner as other patent duties are required by law to be paid, of the sum of ten dollars. And such disclaimer shall thereafter be taken and considered as part of the original specification, to the extent of the interest which shall be possessed in the patent or right secured thereby, by the disclaimant, and by those claiming by or under him, subsequent to 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 the same.

Whenever any patentee shall, through inadvertence, &c., make his specification too broad, &c., he, &c., may make disclaimer, &c.

SEC. 8. *And be it further enacted,* That, whenever application shall be made to the commissioner for any addition of a newly-discovered improvement to be made to an existing patent, or whenever a patent shall be returned for correction and reissue, the specification of claim annexed to every such patent shall be subject to revision and restriction, in the same manner as are original applications for patents; the commissioner shall not add any such improvement to the patent in the one case, nor grant the reissue in the other case, until the applicant shall have entered a disclaimer, or altered his specification of claim, in accordance with the decision of the commissioner; and in all such cases, the applicant, if dissatisfied with such decision, shall have the same remedy, and be entitled to the benefit of the same privileges and proceedings, as are provided by law in the case of original applications for patents.

Applications for additions to newly discovered improvements to be made to existing patents, &c.

SEC. 9. *And be it further enacted,* (any thing in the fifteenth section of the act, to which this is additional, to the contrary notwithstanding,) That whenever, by mistake, accident, or inadvertence, and without any wilful default or intent to defraud or mislead the public, any patentee shall have, in his specification, claimed to be the original and first inventor or discoverer of any material

When, by mistake, &c., any patentee claims to be the original inventor of part of the thing pa-

tented, of
which he
was not,
&c.

Proviso.

Further
proviso.

Agents to
be appoint-
ed to re-
ceive and
forward
models, &c.

Two ex-
amining
and one
copying
clerk to be
appointed.

Tempora-
ry clerks
may be
employed.

or substantial part of the thing patented, of which he was not the first and original inventor, and shall have no legal or just right to claim the same, in every such case the patent shall be deemed good and valid for so much of the invention or discovery as shall be truly and *bona fide* his own: *Provided*, It shall be a material and substantial part of the thing patented, and be definitively distinguishable from the other parts so claimed without right as aforesaid. And every such patentee, his executors, administrators, and assigns, whether of a whole or of a sectional interest therein, shall be entitled to maintain a suit at law or in equity, on such patent, for any infringement of such part of the invention or discovery as shall be *bona fide* his own, as aforesaid, notwithstanding the specification may embrace more than he shall have a legal right to claim. But in every such case, in which a judgment or verdict shall be rendered for the plaintiff, he shall not be entitled to recover costs against the defendant, unless he shall have entered at the Patent Office, prior to the commencement of the suit, a disclaimer to all that part of the thing patented which was so claimed without right: *Provided, however*, That no person bringing any such suit shall be entitled to the benefits of the provisions contained in this section, who shall have unreasonably neglected or delayed to enter at the Patent Office a disclaimer, as aforesaid.

SEC. 10. *And be it further enacted*, That the commissioner is hereby authorized and empowered to appoint agents in not exceeding twenty of the principal cities or towns in the United States, as may best accommodate the different sections of the country, for the purpose of receiving and forwarding to the Patent Office all such models, specimens of ingredients and manufactures, as shall be intended to be patented or deposited therein, the transportation of the same to be chargeable to the patent fund.

SEC. 11. *And be it further enacted*, That, instead of one examining clerk, as provided by the second section of the act to which this is additional, there shall be appointed, in manner therein provided, two examining clerks, each to receive an annual salary of fifteen hundred dollars, and, also, an additional copying clerk, at an annual salary of eight hundred dollars. And the commissioner is also authorized to employ, from time to time, as many temporary clerks as may be necessary to execute the copying and draughting required by the first section of this act, and to examine and compare the records with the originals, who shall receive not exceeding seven cents for every page of one hundred words, and for drawings

and comparison of records with originals, such reasonable compensation as shall be agreed upon or prescribed by the commissioner.

SEC. 12. *And be it further enacted*, That, whenever the application of any foreigner for a patent shall be rejected and withdrawn, for want of novelty in the invention, pursuant to the seventh section of the act to which this is additional, the certificate thereof of the commissioner shall be a sufficient warrant to the treasurer to pay back to such applicant two thirds of the duty he shall have paid into the Treasury on account of such application.

Certificate of the commissioner to be sufficient warrant to the treasurer

SEC. 13. *And be it further enacted*, That, in all cases in which an oath is required by this act, or by the act to which this is additional, if the person of whom it is required shall be conscientiously scrupulous of taking an oath, affirmation may be substituted therefor.

Affirmation may be substituted for an oath.

SEC. 14. *And be it further enacted*, That all moneys paid into the Treasury of the United States for patents, and for fees for copies furnished by the Superintendent of the Patent Office, prior to the passage of the act of which this is additional, shall be carried to the credit of the patent fund created by said act; and the moneys constituting said fund shall be, and the same are hereby, appropriated for the payment of the salaries of the officers and clerks provided by said act, and all other expenses of the Patent Office, including all the expenditures provided for by this act; and, also, for such other purposes as are or may be hereafter specially provided for by law. And the commissioner is hereby authorized to draw upon said fund, from time to time, for such sums as shall be necessary to carry into effect the provisions of this act, governed, however, by the several limitations herein contained. And it shall be his duty to lay before Congress, in the month of January, annually, a detailed statement of the expenditures and payments by him made from said fund. And it shall also be his duty to lay before Congress, in the month of January, annually, a list of all patents which shall have been granted during the preceding year, designating, under proper heads, the subjects of such patents, and furnishing an alphabetical list of the patentees, with their places of residence; and he shall also furnish a list of all patents which shall have become public property during the same period; together with such other information of the state and condition of the Patent Office as may be useful to Congress or the public.

Moneys paid into the treasury for patents, &c., prior to passage of the act to which this is additional, to be carried to credit of patent fund created by said act; and said fund appropriated for salaries, &c.

Commissioner authorized to draw upon the same, &c.; and lay before Congress annually a statement of expenditures, &c.; and also a list of patents, &c.

Approved, March 3d, 1837.

CHAP. LXXXVIII — AN ACT in addition to an "Act to promote the progress of the useful arts."

- Act of July 4, 1888, ch. 357.
- Act of Aug. 29, 1842, ch. 268.
- Two assistant examiners to be appointed; how; their salaries.
- Temporary clerks.
- Proviso. List of patents to be published.
- Pay for use of rooms in City Hall.
- Purchase of books.
- No person to be debarred from receiving a patent, &c.
- Proviso.
- Proviso.
- Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be appointed, in manner provided in the second section of the act to which this is additional, two assistant examiners, each to receive an annual salary of twelve hundred and fifty dollars.
- SEC. 2. *And be it further enacted,* That the commissioner be authorized to employ temporary clerks to do any necessary transcribing, whenever the current business of the office requires it: *Provided, however,* That instead of a salary a compensation shall be allowed, at a rate not greater than is charged for copies now furnished by the office.
- SEC. 3. *And be it further enacted,* That the commissioner is hereby authorized to publish a classified and alphabetical list of all patents granted by the Patent Office previous to said publication, and retain one hundred copies for the Patent Office, and nine hundred copies to be deposited in the library of Congress, for such distribution as may be hereafter directed; and that one thousand dollars, if necessary, be appropriated, out of the patent fund, to defray the expense of the same.
- SEC. 4. *And be it further enacted,* That the sum of three thousand six hundred and fifty-nine dollars and twenty-two cents be, and is hereby, appropriated from the patent fund, to pay for the use and occupation of rooms in the City Hall by the Patent Office.
- SEC. 5. *And be it further enacted,* That the sum of one thousand dollars be appropriated from the patent fund, to be expended under the direction of the commissioner, for the purchase of necessary books for the library of the Patent Office.
- SEC. 6. *And be it further enacted,* That no person shall be debarred from receiving a patent for any invention or discovery, as provided in the act approved on the fourth day of July, one thousand eight hundred and thirty-six, to which this is additional, by reason of the same having been patented in a foreign country more than six months prior to his application: *Provided,* That the same shall not have been introduced into public and common use in the United States prior to the application for such patent: *And provided, also,* That in all cases every such patent shall be limited to the term of fourteen years from the date or publication of such foreign letters-patent.

SEC. 7. *And be it further enacted,* That every person or corporation who has, or shall have, purchased or constructed any newly-invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition of matter so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held to be invalid by reason of such purchase, sale, or use, prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public, or that such purchase, sale, or prior use, has been for more than two years prior to such application for a patent.

Persons, &c., having purchased or constructed any newly invented machine, &c.

SEC. 8. *And be it further enacted,* That so much of the eleventh section of the above-recited act as requires the payment of three dollars to the Commissioner of Patents for recording any assignment, grant, or conveyances of the whole or any part of the interest or right under any patent, be, and the same is hereby, repealed; and all such assignments, grants, and conveyance shall, in future, be recorded without any charge whatever.

So much of 11th sec. Act July 4, 1832, ch. 857, as requires payment for recording assignments, repealed.

SEC. 9. *And be it further enacted,* That a sum of money, not exceeding one thousand dollars, be, and the same is hereby, appropriated out of the patent fund, to be expended by the Commissioner of Patents in the collection of agricultural statistics, and for other agricultural purposes; for which the said commissioner shall account in his next annual report.

Agricultural statistics, &c.

SEC. 10. *And be it further enacted,* That the provisions of the sixteenth section of the before-recited act shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the Chief Justice of the District of Columbia, upon appeals from the decision of said commissioner, as well as where the same shall have been refused on account of, or by reason of, interference with a previously-existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by the applicant, whether the final decision shall be in his favor or otherwise.

Provisions 16th sec. Act July 4, 1836, ch. 857, extended.

SEC. 11. *And be it further enacted,* That in cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall

Appeals.

By the 2d sec. of the Act of 1852, Aug. 30, the Assistant Judges of the Circuit Court may entertain appeals.

The fee to be paid to the judge who hears the appeal.

Proviso.

Commissioner may make regulations respecting contested cases.

Compensation of chief justice.

Repealed by sec. 8, of the Act of Aug. 30, 1852.

have a right to appeal to the Chief Justice of the District Court of the United States for the District of Columbia, by giving notice thereof to the commissioner, and filing in the Patent Office, within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of twenty-five dollars. And it shall be the duty of said chief justice, on petition, to hear and determine all such appeals, and to reverse such decisions in a summary way, on the evidence produced before the commissioner, at such early and convenient time as he may appoint, first notifying the commissioner of the time and place of hearing, whose duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as said judge shall prescribe. The commissioner shall also lay before the said judge all the original papers and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of the appeal, to which the revision shall be confined. And at the request of any party interested, or at the desire of the judge, the commissioner and the examiners in the Patent Office may be examined under oath, in explanation of the principles of the machine or other thing for which a patent, in such case, is prayed for. And it shall be the duty of the said judge, after a hearing of any such case, to return all the papers to the commissioner, with a certificate of his proceedings and decision, which shall be entered of record in the Patent Office; and such decision, so certified, shall govern the further proceedings of the commissioner in such case: *Provided, however,* That no opinion or decision of the judge in any such case shall preclude any person interested in favor or against the validity of any patent which has been, or may hereafter be, granted, from the right to contest the same in any judicial court, in any action in which its validity may come in question.

SEC. 12. *And be it further enacted,* That the Commissioner of Patents shall have power to make all such regulations in respect to the taking of evidence to be used in contested cases before him, as may be just and reasonable. And so much of the act to which this is additional, as provides for a board of examiners, is hereby repealed.

SEC. 13. *And be it further enacted,* That there be paid annually, out of the patent fund, to the said chief justice, in consideration of the duties herein imposed, the sum of one hundred dollars.

Approved March 3, 1839.

CHAP. CCLXIII.—An Act in addition to an act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose.

Act of July 4, 1886, ch. 857.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the Treasurer of the United States be, and he hereby is, authorized to pay back, out of the patent fund, any sum or sums of money, to any person who shall have paid the same into the treasury, or to any receiver or depository to the credit of the treasurer, as for fees accruing at the Patent Office through mistake, and which are not provided to be paid by existing laws, certificate thereof being made to the said treasurer by the Commissioner of Patents.

Act of Mar. 3, 1887, ch. 45.
Act of Mar. 3, 1889, ch. 87.
Treasurer authorized to pay back, out of the patent fund, certain money paid as fees.

SEC. 2. *And be it further enacted,* That the third section of the Act of March, eighteen hundred and thirty-seven, which authorizes the renewing of patents lost prior to the fifteenth of December, eighteen hundred and thirty-six, is extended to patents granted prior to said fifteenth day of December, though they may have been lost subsequently: *Provided, however,* The same shall not have been recorded anew under the provisions of said act.

Sec. 3, Act of Mar. 3, 1887, ch. 43, extended to patents granted prior to 15th Dec. 1886, though lost subsequently.

SEC. 3. *And be it further enacted,* That any citizen or citizens, or alien or aliens, having resided one year in the United States, and taken the oath of his or their intention to become a citizen or citizens, who by his, her, or their own industry, genius, efforts, and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, or any new and original design for the printing of woollen, silk, cotton, or other fabrics, or any new and original design for a bust, statute, or bas relief or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on, any article of manufacture or any new and original shape, or configuration of any article of manufacture not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein to make, use, and sell, and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application, in writing, to the Commissioner of Patents,

Proviso. Citizens, &c., may obtain a patent; how.

expressing such desire, and the commissioner, on due proceeding had, may grant a patent therefor, as in the case now of application for a patent: *Provided*, That the fee in such cases, which by the now existing laws would be required of the particular applicant, shall be one half the sum, and that the duration of said patent shall be seven years, and that all the regulations and provisions which now apply to the obtaining or protection of patents not inconsistent with the provisions of this act, shall apply to applications under this section.

Oath
may be
taken be-
fore U. S.
ministers,
&c.

SEC. 4. *And be it further enacted*, That the oath required for applicants for patents may be taken, when the applicant is not, for the time being, residing in the United States, before any minister plenipotentiary, 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 such applicant may be.

Penalty
for infring-
ing the
rights of a
patentee,
&c., by
marking.

SEC. 5. *And be it further enacted*, That if any person or persons shall paint or print or mould, cast, carve, or engrave, or stamp, upon any thing made, used, or sold by him, for the sole making or selling which he hath not, or shall not have obtained letters-patent, the name or any imitation of the name of any other person who hath or shall have obtained letters-patent for the sole making and vending of such thing, without consent of such patentee, or his assigns or legal representatives; or if any person, upon any such thing not having been purchased from the patentee, or some person who purchased it from or under such patentee, or not having the license or consent of such patentee, or his assigns or legal representatives, shall write, paint, print, mould, cast, carve, engrave, stamp, or otherwise make or affix the word "patent," or the words "letters-patent," or the word "patentee," or any word or words of like kind, meaning, or import, with the view or intent of imitating or counterfeiting the stamp, mark, or other device of the patentee, or shall affix the same, or any word, stamp, or device of like import, on any unpatented article for the purpose of deceiving the public, he, she, or they, so offending, shall be liable for such offence to a penalty of not less than one hundred dollars, with costs, to be recovered by action in any of the Circuit Courts of the United States, or in any of the District Courts of the United States having the powers and jurisdiction of a Circuit Court; one half of which penalty, as recovered, shall be paid to the patent fund, and the other half to any person or persons who shall sue for the same.

How re-
coverable,
&c.

SEC. 6. *And be it further enacted,* That all patentees and assignees of patents hereafter granted, are hereby required to stamp, engrave, or cause to be stamped or engraved, on each article vended or offered for sale, the date of the patent; and if any person or persons, patentees or assignees, shall neglect to do so, he, she, or they shall be liable to the same penalty, to be recovered and disposed of in the manner specified in the foregoing fifth section of this act.

Approved August 29, 1842.

CHAP. XLVII. — AN ACT to provide additional examiners in the Patent Office, and for other purposes.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That there shall be appointed, in the manner provided in the second section of the act entitled "An act to promote the progress of useful arts, and to repeal all acts and parts of acts heretofore made for that purpose," approved July fourth, eighteen hundred and thirty-six, two principal examiners, and two assistant examiners, in addition to the number of examiners now employed in the Patent Office; and that hereafter each of the principal examiners employed in the Patent Office shall receive an annual salary of twenty-five hundred dollars, and each of the assistant examiners an annual salary of fifteen hundred dollars: *Provided,* That the power to extend patents, now vested in the board composed of the Secretary of State, Commissioner of Patents, and Solicitor of the Treasury, by the eighteenth section of the Act approved July fourth, eighteen hundred and thirty-six, respecting the Patent Office, shall hereafter be vested solely in the Commissioner of Patents; and when an application is made to him for the extension of a patent according to said eighteenth section, and sixty days' notice given thereof, he shall refer the case to the principal examiner having charge of the class of inventions to which said case belongs, who shall make a full report to said commissioner of the said case, and particularly whether the invention or improvement secured in the patent was new and patentable when patented; and thereupon the said commissioner shall grant or refuse the extension of said patent, upon the same principles and rules that have governed said board; but no patent shall be extended for a longer term than seven years.

SEC. 2. *And be it further enacted,* That hereafter the

Patentees, &c., required to mark articles offered for sale. Penalty for neglect.

May 28, 1848.

1836, ch. 367. Additional examiners in the Patent Office. Salaries.

Extension of patents.

Fee for recording conveyances of patents.

Commissioner of Patents shall require a fee of one dollar for recording any assignment, grant, or conveyance, of the whole or any part of the interest in letters-patent, or power of attorney, or license to make or use the things patented, when such instrument shall not exceed three hundred words; the sum of two dollars when it shall exceed three hundred and shall not exceed one thousand words; and the sum of three dollars when it shall exceed one thousand words; which fees shall in all cases be paid in advance.

Two copying and recording clerks authorized.

SEC. 3. *And be it further enacted*, That there shall be appointed in manner aforesaid two clerks to be employed in copying and recording, and in other services in the Patent Office, who shall be paid a salary of one thousand two hundred dollars per annum.

Franking privilege of Commissioner of Patents.

SEC. 4. *And be it further enacted*, That the Commissioner of Patents is hereby authorized to send by mail, free of postage, the annual reports of the Patent Office, in the same manner in which he is empowered to send letters and packages relating to the business of the Patent Office.

Approved May 27, 1848.

INDEX.

ABANDONMENT.

1. If, before the patent is taken out, the inventor looks on and sees his invention going into general use without objection, the Court will treat his conduct as an abandonment or dedication of his right to the exclusive use, to the public. *Treadwell et al. v. Bladen*, I. 531; *Mellus v. Silsbee*, I. 506.
2. And this holds, although such use was by a particular person authorized by the patentee. *Pennock et al. v. Dialogue*, I. 466.
3. And it will be presumed by a public use of the invention before application, if acquiesced in by the inventor. *Shaw v. Cooper*, I. 643; *Pennock et al. v. Dialogue*, I. 466.
4. A knowledge without immediate assertion of the right, will amount to an acquiescence. *Ib.*
5. Such knowledge may be presumed from circumstances. *Ib.*
6. The question of abandonment does not depend upon the intention of the inventor, for whatever may be the intention, if he suffers his invention to go into public use, through any means whatever, without an immediate assertion of his right, he is not entitled to a patent. *Ib.*
7. Voluntarily permitting the invention to be on public sale or use, or acquiescing in such sale or use, creates a disability to comply with the terms of the statute on which alone the Secretary of State is authorized to grant a patent. *Pennock et al. v. Dialogue*, I. 542.
8. The question whether certain acts or acquiescence furnish satisfactory proof of abandonment, is one of fact rather than law. *Ib.*
9. Whether the delay to take out a patent, and allowing it to go into use by others, should be considered as an abandonment, is a question that should always be submitted to the jury. *Morris v. Huntington*, I. 448.
10. But a public use, or a sale thereof by the inventor, is not conclusive here, as it is in England. *Mellus v. Silsbee*, I. 506.
11. Public sale, or use with consent of patentee, is not evidence of abandonment, since the Act of March 3d, 1839, unless more than two years before application. *Root v. Ball et al.* II. 513.
12. This inchoate right thus lost, cannot afterwards be resumed at the pleasure of the inventor. *Pennock et al. v. Dialogue*, I. 466.
13. Of a *patent-right* will not arise from disuse, however long continued. *Gray et al. v. James et al.* I. 120.

ABATEMENT OF SUIT.

See ASSIGNEE.

ACTING COMMISSIONER.

1. Where evidence is offered to prove that the person who signs a patent is such, was not appointed by the President, it is questionable whether it is competent in cases where he is not a party. *Woodworth v. Hall et al.* II. 517.
2. Under the Patent Law of 1836, the chief clerk is held to be the acting commissioner, as well in the necessary absence of the head of the office as in case of a vacancy *de jure*. *Ib.*
3. And the certificate of copies verified by a person so styling himself, is sufficient on its face. *Woodworth et al. v. Hall et al.* II. 495.

ACTION.

If the patentee has sold a moiety of his patent-right, a joint action lies by himself and his assignee for a violation of it. *Whittemore v. Cutter*, I. 28.

See ASSIGNEE.

ACTS OF CONGRESS.

See STATUTES.

ADMINISTRATOR.

1. Of a deceased patentee may apply for and obtain a renewal in his own name. *Brooks et al. v. Bicknell et al.* II. 118.
2. And extensions of patents by the act of the Board of Commissioners may be granted to the administrator of a deceased patentee—for the benefit of the estate, although the patentee, in his lifetime, had disposed of all his interest in the then existing patent, as such sale did not carry any thing beyond the original patent. *Wilson v. Rousseau et al.* II. 372.

AFFIDAVIT.

Of a single witness, not sufficient to outweigh the oath of the patentee on the question of originality. *Woodworth v. Sherman*, II. 257.

AGREEMENT.

1. An agreement to assign his interest in the patent, will not bar the right of the patentee to recover in his own name. *Park v. Little et al.* I. 17.
2. But after an agreement between an original inventor of a machine, and the inventor of an improvement, that they would mutually use the same; the patent should have issued in the names of both inventors. And the plaintiff taking out patent in his own name to be considered as trustee. *Rutger v. Knowers et al.* I. 1.

ALIENAGE.

May be given in evidence under the general issue, without notice and without pleading it. *Kneass v. The Schuylkill Bank*, I. 303.

ALIENS.

By the provisions of the Act of 1800, aliens, as to patent-rights, are placed substantially on the same ground with citizens. *Shaw v. Cooper*, I. 643.

ALTERATIONS.

See IMPROVEMENT.

AMBIGUITY.

1. The patentee must describe in his patent in what his invention consists, with reasonable certainty, otherwise it will be void. *Lowell v. Lewis*, I. 131.
2. But the patent and specification may be explained by the affidavit annexed to the specification. *Pettibone v. Derringer*, I. 152.

ANSWER.

To a bill for injunction, though filed before the time for answering, will be treated as an answer on the interlocutory motion. *Brooks et al. v. Bicknell et al.* II. 118.

See NOTICE; See PRACTICE.

APPEAL.

See JURISDICTION.

APPLICATION.

See PATENT.

ART.

1. May be subject of a patent, but it must be practical and referrible to something which may prove it to be useful. *Evans v. Eaton*, I. 68.
2. Copperplate printing on the back of bank-notes is an art for which a patent may issue. *Kneass v. The Schuylkill Bank*, I. 303.

ASSIGNEE.

1. Of a part of a patent-right cannot maintain an action [under the Act of 1793,] on the case, for a violation of the patent. *Tyler et al. v. Tuel*, I. 14. See note.
2. But of part of a patent circumscribed as to the interest, by local limits, he can maintain a suit in equity for an injunction. But whether he can sue at law, in his own name or jointly with the patentee.— *Quere. Ogle et al. v. Ege*, I. 516.
3. Of a moiety of a patent-right, may maintain an action jointly with the patentee for a violation of it, under the Act of February 21, 1793. *Whittemore v. Cutter*, I. 28.
4. Of the exclusive right to use ten machines within the city of Louisville, or ten miles around, may join his assignor in a suit with him for infringement,

- under the circumstances of this case. *Woodworth et al. v. Wilson et al.* II. 473.
5. Of an exclusive right to use two machines in a particular district may maintain an action for an infringement of the patent within that district, even against the patentee. *Wilson v. Rousseau et al.* II. 372.
 6. The patentee cannot maintain a suit after assignment, but it must be brought by the assignee. *Herbert v. Adams*, I. 505.
 7. But he cannot maintain a suit at law or in equity against third persons, until the assignment is recorded in the Patent Office. *Wyeth et al. v. Stone, et al.* II. 23.
 8. Of the right to use a patented machine, within a specified territory, may sell the product of such machine elsewhere; as the restriction is only that he shall use the machine within that territory, there is none as to the sale of the product. *Simpson et al. v. Wilson*, II. 469.
 9. Under the original patent have not a coextensive interest under an extended patent, but if they are in the use of a patented machine at the time of the extension, they may continue to use it. *Wilson v. Rousseau et al.* II. 372; *Simpson et al. v. Wilson*, II. 469; *Wilson v. Turner et al.* II. 467; [See also *Wilson v. Simpson et al.* 9 Howard, 109.]
 10. Of part or the whole of a patent will not be affected by the surrender by the patentee, unless consented to by them. *Woodworth et al. v. Stone*, II. 294.
 11. But he takes the right subject to the legal consequences of the previous acts of the patentee. *McClurgh et al. v. Kingsland et al.* II. 105.

ASSIGNMENT.

1. Of a patent-right made before the patent is obtained is good, and binds the right. *Herbert v. Adams*, I. 505.
2. May be made of a license to use the thing patented. *Woodworth v. Curtis*, II. 603.
3. Of the right to use a machine and to vend the same to others to use within a specified territory, authorizes the assignee to vend elsewhere the product of the machine. *Simpson et al. v. Wilson*, II. 469.
4. Where a patent is for a machine that can be applied to various purposes, a grant of the exclusive right to use it for one of said purposes, within a specified district, does not give such a right in the patent as will enable the grantee to maintain a suit for infringement against any person using it, even for the same purpose, within said district. *Blanchard v. Eldridge*, II. 737.
5. B having a patent for turning irregular forms generally, grants to C the exclusive right to use it for turning shoe lasts, D having infringed by turning shoe lasts; it was held that the suit was properly brought at law in B's name. *Ib.*
6. Under the original patent does not give an interest in the extended patent, unless it expressly conveys it. *Woodworth v. Sherman*, II. 257; *Case v. Redfield et al.* II. 741.
7. And the intention to give such interest clearly appears. *Phillips v. Comstock*, II. 724.

8. Such an interest, before renewal, will pass under the words "for which letters-patent were or *may be* granted for said improvements." *Case v. Redfield et al.* II. 741.
9. But a grant of an interest in the patent prior to the law authorizing extensions, with a covenant that the grantee should have "the benefit of any improvement in the machinery, or alteration or *renewal* of the patent, did not include the extension by an administrator under the Act of 1836. *Wilson v. Rousseau et al.* II. 372.
10. A plaintiff therefore who claims under an assignment from the administrator can maintain a suit against a person who claims under the covenant. *Ib.*
11. As between the parties, need not be recorded in the Patent Office, and is only necessary as notice to purchasers. *Case v. Redfield et al.* II. 741.
12. Under the 11th section of the Act of 1836, an assignment of any part of the patent vests in the assignee the legal right. And a failure to record such assignment within three months does not defeat the title under it unless the *same interest* has been after the expiration of the three months conveyed to some other person. And the latter will hold notwithstanding he had notice of the previous assignment. *Boyd v. McAlpin*, II. 277.
13. The requirements of the statute being merely directory. *Brooks v. Byam et al.* II. 161.
14. But it must be recorded before the assignee can maintain a suit at law or in equity as against third persons. *Wyeth et al. v. Stone et al.* II. 23.
15. It is immaterial whether the assignment offered in evidence was recorded before or after the suit was brought. *Pitts v. Whitman*, II. 189.
16. A mere agreement to assign will not vest the right in another. And the patentee will be entitled to recover at law, unless he has made a legal assignment and transfer of his invention. *Parks v. Little et al.* I. 17.

See CONTRACT; See INFRINGEMENT.

BILL OF EXCEPTIONS.

1. In cases where the damages are less than \$2,000, will be granted in the exercise of a sound discretion, and only where questions arising upon the Patent Laws are important in their character and really doubtful. *Allen v. Blunt, et al.* II. 288.
2. The practice of excepting generally to a charge of the Court to the jury, without setting out specifically the points excepted to, censured by the Supreme Court. *Stimpson v. W. C. Railroad*, I. 335.
3. The record of, should not contain the testimony and evidence offered at the trial, if the opinion of the Court, delivered to the jury, presented a general principle of law merely, and the application of the evidence to it was left to the jury. *Pennock et al. v. Dialogue*, I. 542.
4. The Court condemns the practice of thus burdening the record as irregular, unnecessary, and expensive. *Ib.*

BOARD OF COMMISSIONERS.

1. It is a presumption of law that all public officers, and especially such high functionaries, perform their proper official duties until the contrary is proved. *The P. & T. Railroad Co. v. Stimpson*, II. 46.

2. Can lawfully receive a surrender of a patent for a defective specification, and issue new letters upon an amended specification, after the expiration of the term for which the original patent was granted, and during the period of the extension. *Wilson v. Rousseau et al.* II. 372.
3. The decision of the board is not conclusive upon the question of their jurisdiction to act in a given case in issuing a patent. *Id.*

CHIEF CLERK.

See ACTING COMMISSIONER.

CLAIM.

See SPECIFICATION; CLAIM.

COMBINATION.

1. However simple and obvious, yet if entirely *new*, is patentable. *Earle v. Sawyer*, I. 490.
2. If well-known effects are produced by machinery in *all its combinations* entirely new, a patent may be claimed for the *whole* machine. *Whittemore et al. v. Cutter*, I. 40.
3. And if old materials and old principles be used in a state of combination to produce a new result, the inventor may obtain a patent. *Pennock et al. v. Dialogue*, I. 466; *Evans v. Eaton*, I. 68.
4. If the combination existed to a certain point, and the patentee adds an improvement, he must not include the whole, but only the improvement. *Barrett et al. v. Hall et al.* I. 207.
5. But the use of one of such machines only separately, will not be an infringement. *Evans v. Eaton*, I. 68; *Parker v. Howarth*, II. 725; *Barrett et al. v. Hall*, I. 207.
6. But if the patentee be the inventor of one of the machines composing such combination, which is used by the defendant, can he recover for such use. *Quere. Evans v. Eaton*, I. 68.
7. The use of any number less than the whole will not be an infringement. *Prouty et al. v. Draper et al.* II. 75.
8. The use of any two parts only, or of the two combined with a third, differing in form and arrangement from the plaintiff's third, is not an infringement. *Prouty et al. v. Ruggles et al.* II. 92.
9. The patent will protect any of the parts invented or improved by the patentee. *Parker v. Howarth*, II. 725; See *Ames v. Howard, et al.* I. 685.

See COMPOSITION; IDENTITY; SPECIFICATION; CLAIM.

COMMISSIONER OF PATENTS.

1. Where a particular authority is confided in a public officer, to be exercised in his discretion upon the examination of facts, of which he is the appropriate judge, his decision thereon, in the absence of any controlling provision, is absolutely conclusive. *Allen v. Blunt et al.* II. 283.

2. The decision of the Commissioner of Patents, on the law and facts arising upon the application, is to be conclusive, unless impeached for fraud, or collusion, or unless the excess of authority be manifest upon the face of the papers. *Ib.*
3. Decision of, in respect to surrendering an old patent and granting a new one, is not reëxaminable elsewhere, unless it appear on the face of the patent that he has exceeded his authority. *Woodworth et al v. Stone*, II. 296.
4. The presumption that a renewed patent is for the same invention as the former, and that it was to correct a mistake and inadvertence, may be rebutted by evidence. *Allen v. Blunt et al.* II. 530.

See BOARD OF COMMISSIONERS.

COMPOSITION.

1. It is not necessary that any of the ingredients should be new or unused before, for the purpose. The true question is, whether the combination is new. *Ryan et al. v. Goodwin et al.* I. 725.
2. Nor will the patentee be limited to the particular ingredients named in making a compound, if the same purpose can be accomplished by substituting in part other ingredients, possessing similar properties, which had never been used before in like combination, and the patentee may claim them also. Example. *Ib.*

CONCEALMENT.

1. Of material parts of the invention in the description ; what will invalidate a patent? *Gray et al. v. James et al.* I. 120.
2. The matters not disclosed in the specification must appear to have been concealed for the purpose of deceiving the public. *Park v. Little et al.* I. 17.
3. And the onus of proving such intent is on the defendant. *Whitmore v. Cutter*, I. 28.
4. And it must not only be with a view to deceive, but must be material. *Reutgen v. Kanours et al.* I. 1.

CONSTRUCTION.

It is the province of the Court to construe the patent and determine what improvements are intended to be patented, and of the jury to decide whether they are described with sufficient clearness to enable a skilful mechanic to construct them ; and the jury should give a liberal, common sense construction to the directions. *Davis v. Palmer*, I. 518.

See STATUTES ; SPECIFICATION ; TERMS.

CONTEMPT OF COURT.

See INJUNCTION. *Woodworth et al. in equity, v. Rogers et al.* II. 625.

CONTRACT.

1. May be made to carry a future invention, as well as a past one, and for any improvement, or maturing of a past one. *Nesmith et al. v. Calvert et al.* II. 311.
2. For sale of right under an *expected* patent, is binding, although the patent first granted be declared void for defective specification, provided a new patent be granted upon corrected specification. *Stanley v. Whipple*, II. 1.
3. Obligation of, shall not be impaired by laws of States, but Congress may pass laws having that effect. *Evans v. Eaton*, I. 68.

COSTS.

1. In equity, are, *prima facie*, to be allowed to the prevailing party. But if they are inequitable they may be disallowed, and the burden is upon the party so alleging them to be. *Hovey v. Stevens*, II. 479.
2. If defendant prevails, the plaintiff will not be allowed costs unless the respondent is charged with some wrong; and if defendant succeeds on other grounds than those in which costs were incurred, his costs may be disallowed in the discretion of the Court. *Ib.*
3. But if he prevails on the ground of a defect in the specification, he is entitled to costs, although the question of originality has not been decided. *Ib.*
4. But where the evidence cast some shade over his fairness of conduct in respect to the plaintiffs, and his machine, the Court declined to allow him beyond actual costs, and disallowed travel and attendance in the equity suit for the terms in which they were taxed in the suit at law. *Ib.*
5. Plaintiff in equity not required to give security for costs. *Woodworth v. Sherman*, II. 257.

COUNSEL FEES.

See DAMAGES. See *Allen v. Blunt et al.* II. 531.

CUMULATIVE EVIDENCE.

1. Evidence is cumulative if it relates to the same subordinate or specific fact to which proof was before adduced, but not when it is a new fact respecting the general question or point in issue. *Aiken v. Bemis*, II. 644.
2. Cumulative evidence, although newly discovered, is not a sufficient ground for a new trial. *Ib.*

See NEW TRIAL.

COVENANT.

See ASSIGNMENT; ASSIGNEE.

DAMAGES.

1. The plaintiff is entitled to actual damages only, and not a vindictive recompense. *Whittemore et al. v. Cutter*, I. 40.

- Actual damages means such damages as the plaintiff has in fact sustained, as contradistinguished to mere imaginary or exemplary damages which in personal torts are sometimes given. *Ib.*
3. Where the law gives a remedy for a particular act, the doing of that act imports a damage. The mere making of a patented machine is such a violation of the patent as to entitle the plaintiff to a verdict for damages. But if no user be proved, nominal damages are to be given. *Ib.* 28.
 4. If a user of a machine be proved, the measure of damages is the value of the use, during the time of user. *Ib.* 40.
 5. If making only be proved, the plaintiff is entitled only to nominal damages. *Ib.*
 6. Neither the price nor the expense of making a machine is a proper measure, &c. *Ib.*
 7. Only nominal will be given if the defendant made the thing patented for another person, without knowledge of the patent. *Bryce v. Dorr et al.* II. 302.
 8. Where the defendant infringed the patent without knowledge of the plaintiff's right, no more than compensatory damages will be given. *Parker v. Corpin*, II. 736.
 9. But where the acts complained of were of an aggravated character, vindictive damages, which would include counsel fees, would be allowed. *Ib.*
 10. Counsel fees for prosecuting the suit are not a proper item of damages in an action for violation of a patent. *Whittemore v. Cutter*, I. 28; *Simpson v. The Railroads*, II. 595.
 11. But expense of counsel fees may be allowed as part of the actual damage if the jury see fit. *Boston Manufacturing Co. v. Fiske et al.* I. 320; *Allen v. Blunt et al.* II. 530.
 12. The jury are at liberty to give such reasonable sum as shall indemnify the patentee for all expenditures necessarily incurred in the suit beyond what the taxable costs will repay. *Pierson v. The Eagle Screw Co.* II. 268.
 13. And the Court will treble the amount found by the jury if deemed proper to protect useful inventors from combination and ruin. *Allen v. Blunt et al.* II. 530.
 14. Will not be considered excessive unless they clearly exceed what is necessary to indemnify the patentee. *Ib.*
 15. May be recovered for an infringement of a patent during the time which intervened between the destruction of the Patent Office by fire, in 1836, and the restoration of the records under the Act of March 3, 1837. *Hogg et al. v. Emerson*, II. 655.
 16. If a patent be granted by special Act of Congress for an invention in public use at the time of the act. *Quære*, whether the act would be constitutional if it gave damages for such use prior to the grant? *Blanchard v. Sprague*, I. 734.
 17. As to the rule for estimating damages, see *Earle v. Sawyer*. I. 490.
 18. As to joint and several liability. See INFRINGEMENT.

See TREBLE DAMAGES.

DECLARATION.

See PLEADINGS.

DECLARATIONS OF PATENTEE.

When admissible, as showing date of invention, and particulars thereof
Evans v. Hettick, I. 417.

See EVIDENCE.

DECLARATION OF OTHERS.

Evidence, when. See EVIDENCE.

DEDICATION.

If the patentee has acquiesced for a long period in the public use of an invention, without objection, it may amount to complete proof of dedication or surrender to the public. *Wyeth et al. v. Stone et al.* II. 23.

See ABANDONMENT.

DEFECTIVE SPECIFICATION AND DEFECTIVE DESCRIPTION.

See SPECIFICATION.

DEMURRER.

See PLEADINGS.

DEPOSITION.

1. Of a witness residing within the district, above one hundred miles from the place of holding the court, taken under a rule entered by the plaintiff in the clerk's office, but not in conformity with the requisitions of the 30th section of the judicial act, cannot be read in evidence. *Evans v. Hettick*, I. 417.
2. But if taken without a commission or rule of Court, in another State, and more than one hundred miles from the place of trial, and in conformity with the 30 sec. of the Act of 1789, it may be read in evidence. *Pettibone v. Derriuger*, I. 152.
3. But although so taken under the 30th sec. of the Judiciary Act of 1789, it cannot be read in evidence, unless the judge certifies that it was reduced to writing by *himself* or by the witness in *his* presence. *Ib.*
4. Where counsel have acted publicly in former trials of like cause, though not named in the docket as such, if he be living within one hundred miles of the place where a deposition is taken, he ought to be notified. *Allen v. Blunt et al.* II. 530.
5. *Quere*, if a deposition taken without notice to the adverse party, is admissible, if the caption incorrectly describes the action as against one defendant, when it is entered against and defended by two, although service was made only on the one? *Ib.*
6. Or affidavits taken with notice in conformity to a special order, but when

- the other party was unable to confer with his counsel and attend, will be admitted, upon condition that the other party shall have leave to take them over so far as to cross-examine the witnesses. *Aiken v. Bemis*, II. 644.
7. And they should not be taken during the session of the Court, at which the case is to be tried unless by its order or consent of parties, or taken merely *de bene esse* in case of death or absence abroad. *Allen v. Blunt et al.* II. 530.
 8. When taken *de bene esse*, is offered in evidence, the party offering it must show that he has used due diligence to procure the attendance of the witness. *Pettibone v. Derringer*, I. 152.
 9. But it is no objection to the reading the deposition of a witness taken under a rule of Court, who lives in another State, more than one hundred miles from the place of trial, that he had been in the city during the session of the Court, the fact not being known to the party. *Ib.*
 10. Whether if known it would make any difference. *Quere. Ib.*
 11. Having been read without objection, cannot be afterwards rejected, and withdrawn, because the Court subsequently refused to allow a deposition to be read, on account of an exception which would also have excluded the deposition which had been read, had it been objected to. *Evans v. Hettick*, I. 166; *Same Case*, I. 417.

DESCRIPTION.

See SPECIFICATION.

DISCLAIMER.

1. Where more is claimed by a patentee than he has invented, he must within a reasonable time disclaim the part so improperly claimed or his patent will be void. *Brooks et al v. Bicknell et al.* II. 118; *Hovey v. Stevens*, II. 479.
2. Whether it has been made within a reasonable time is a question for the jury. *Ib.*
3. And the assignee (if any) must unite with the patentee in a disclaimer to entitle the parties to the benefit of the Act of 1837. *Wyeth et al. v. Stone et al.* II. 23.
4. If filed during the pendency of the suit, it will not entitle the plaintiff to any benefit thereof; but if filed before the suit is brought, he will be entitled to costs if he shall establish that part of the invention not disclaimed, has been infringed. *Reed v. Cutter et al.* II. 81.
5. If he has unreasonably neglected or delayed to enter the same at the Patent Office, he will not be entitled to any benefit under it whether filed before or after the suit was brought. *Ib.*
6. If not filed until after the suit in equity is brought, he will not be entitled to an injunction whatever may be the effect of such at law. *Wyeth et al. v. Stone et al.* II. 23.
7. See *Treadwell et al. v. Bladen* I. 531.

DISCOVERY.

See PATENT.

DIVERSITY.

What constitutes. *Whittemore et al. v. Cutter*, I. 40.

See IDENTITY.

DRAWINGS.

1. Connected with and referred to in the specification, are part of the same. *Earle v. Sawyer*, I. 490.
2. The whole specification, summary, and drawings must be referred to and taken together in deciding what new part or combination is claimed to be invented. *Davoll et al. v. Brown*, II. 303.
3. And although not referred to in the specification, may be treated as a part thereof, and used to explain and enlarge it. *Washburn et al. v. Gould*, II. 206.

EFFECT.

Patent cannot be granted for an effect only, but for an effect produced in a given manner. *Whittemore et al. v. Cutter*, I. 40.

See COMBINATION; IDENTITY; PRINCIPLE.

ENGLISH STATUTES.

Although the language of the exception in the statute of monopolies is not identical with the Patent Law of the United States, yet the construction of it adopted by the English courts, and the principles and practice which have regulated the grant of their patents, afford materials to illustrate our law. *Pennock et al. v. Dialogue*, I. 542.

EQUITY.

Will not aid to protect a patent when the patentee has dedicated or surrendered the invention to public use; or has acquiesced in such public use for a long period without objection. *Wyeth et al. v. Stone et al.* II. 23.

EQUITY.—EVIDENCE.

1. Affidavits may be read on both sides as to facts unconnected with the title. *Brooks et al. v. Bicknell et al.* II. 118.
2. In proceedings in equity on motions for injunction, if witnesses differ on the fact of infringement, the matter should be submitted to a jury. *Id.*

EQUITY.—PRACTICE.

1. Where a feigned issue for trial of fact is directed by the Court, no declaration is requisite. The jury will be sworn to try the issue in the words of the order itself. *Wilson v. Barnum*, II. 749.

2. To entitle the defendant to the benefit of dedication, or surrender, the facts must be explicitly relied on and put in issue by the answer, or the Court will not notice it. *Wyeth et al. v. Stone et al.* II. 23.

EQUITY DEFENCE.

See "USE;" INJUNCTION.

ERROR.

1. Lies to Circuit Court on a judgment in *scire facias* to repeal a patent. *Stearns in Error v. Barrett*, I. 97.
2. The refusal of a Court to amend a verdict cannot be assigned for error. *Ib.*
3. If the rejection of evidence is a matter resting in the sound discretion of the Court, this cannot be assigned as error. *The Phil. & Trenton Railroad Co. v. Stimpson*, II. 46.
4. The mode of conducting trials, the order of introducing evidence, and the time when it is to be introduced, are subject to the discretion of the Circuit Courts. *Ib.*
5. Testimony was not offered by defendant, or stated by him as matter of defence in the stage of the cause, when it is usually introduced according to the practice of the Court; but was offered after defendant's counsel had stated that evidence was closed, and plaintiff's witnesses had been thereby dismissed. The Court rejected it; held that the rejection was proper. *Ib.*
6. As to admission or rejection of testimony,

See EVIDENCE; WITNESS.

EVIDENCE.

1. A patent is *prima facie* evidence of right to the thing patented. *Brooks et al. v. Bicknell et al.* II. 118.
2. Reissued patent is *prima facie* evidence that the original patent was cancelled on account of a defective specification, and that all things have been done which the law requires to authorize the reissue. *The Phil. & Trenton Railroad Co. v. Stimpson*, II. 46.
3. Patent is evidence *prima facie* of invention by the patentee. *Ib.*
4. A copy of a patent afterwards surrendered and cancelled, may be given in evidence to show that a subsequent invention is not original. *Delano v. Scott*, I. 700.
5. An assignment, though recorded after the suit brought, is admissible in evidence. *Pitts v. Whitman*, II. 189.
6. After an act of Congress extending a patent to an administrator, it is not necessary to produce the letters of administration in evidence. *Woodworth et al. v. Hall et al.* II. 495.
7. The signature of a person styling himself "Acting Commissioner," is sufficient on its face in controversies between the patentee and other persons. *Ib.*
8. Letters to the Secretary of State containing application for patent and specifications, duly certified as papers on file in that department, are admissible. *Pettibone v. Derringer*, I. 152.

9. A letter from the Commissioner of Patents on an official matter, tending to prove the date of the invention, may be admissible, as official correspondence, or as part of the *res gestæ*, being a declaration accompanying an act. *Allen v. Blunt et al.* II. 530.
10. Parol evidence of the contents of a letter was rejected because no satisfactory proof was offered of the loss of the letter; or of its having been received by the party to whom it was addressed. *Ib.*
11. Affidavits of either party will be received to establish or rebut such preliminary facts.
12. The mere putting of a letter in the post-office will not raise a presumption that it was received, as a foundation for parol evidence of its contents, if no answer was returned, and the party to whom it was addressed makes affidavit that it never came to hand. *Ib.*
13. A verdict on an issue out of Chancery between the parties, is not a bar when no judgment was ever rendered thereon; or on the merits of the bill: it having been dismissed on plaintiff's motion. *Ib.*
14. A verdict upon an issue ordered by a Court of Equity is not final upon the facts it finds, nor binding upon the Court, unless adopted by the Court upon a subsequent hearing on the merits. *Ib.*
15. *Quære*, whether the verdict in a suit at law is evidence of any thing but the fact that it was rendered, unless there be a judgment thereon. *Ib.*
16. Deposition taken under the 30th section of the Judiciary Act of 1789, cannot be read in evidence, unless the judge certifies that it was reduced to writing by himself or by the witness in his presence. *Pettibone v. Derringer*, I. 152.
17. Declarations of a patentee at a time previous to his application for letters-patent, admissible to prove that he then asserted a right as inventor of the thing then described. *Evans v. Hettick*, I. 166.
18. Declarations of a party made before the dispute arose, in connection with acts, may be competent evidence for him as tending to show then existing intentions. *Hovey v. Stevens*, II. 479.
19. The declarations of a person as an agent in relation to the business intrusted to him, and made at the time when so intrusted, are competent concerning it, in an action by a third person against the principal, as part of the *res gestæ*, if they relate to the act clearly. *Aiken v. Bemis*, II. 644.
20. Parol evidence bearing upon written contracts and papers ought not to be admitted without the production of such written contracts and papers. *The Phil. & Trenton Railroad Co. v. Stimpson*, II. 46.
21. Although generally the declarations and conversations of plaintiff are not admissible in favor of his own rights, yet in many cases of inventions it is hardly possible in any other manner to ascertain the precise time and exact origin of the invention. *Ib.*
22. The declaration of a patentee merely that at some former time he invented a particular machine, may well be objected to. But a declaration at a particular time, describing an invention in detail, and explaining its operation, is legitimate evidence of it as early as that period. *Ib.*

23. The mode of conducting a trial, the order of introducing evidence, and the times when it is to be introduced, are matters resting in the discretion of the Court. *Ib.*
24. The original patent being destroyed by the burning of the Patent Office, the only record of the specification being in the Franklin Journal, the claim is not limited by that publication, because the whole of the specification is not set forth in it. *Stimpson v. West Chester Railroad Co.* II. 335.
25. Minutes of a hose company of which the plaintiffs were members, and at whose instigation and expense the hose, the subject of the patent, was asserted to have been invented, may be read on the part of the defendant, to prove that the plaintiffs were not the inventors. *Pennock et al. v. Dialogue*, I. 466.
26. But other entries made at other times in the same books cannot be read to prove that the company acknowledge the plaintiffs to be the inventors, (the defendants not being members,) or to show that the company were not the inventors, it not being alleged by the defendant that the invention was by the company. *Ib.*
27. A report to the hose company is not a public work within the meaning of the sixth section of the Patent Law. *Ib.*
28. Minutes of other hose companies of which the plaintiffs were not members cannot be read in evidence by the defendant for any purpose. *Ib.*
29. The defendant's refusal to submit to arbitration under the 9th section of the Act of 1793, is not conclusive proof that patent was obtained surreptitiously. *Stearns in Error v. Barrett*, I. 97.
30. Proof that the plaintiffs at a particular time made a specimen of the thing patented, which had not been seen or heard of by the witness is *prima facie* evidence that it was invented by the patentee. *Pennock et al. v. Dialogue*, I. 466.
31. That persons, whose prior use of the machine had been proved by the defendant, had paid the patentee for license to use the machine since the patent—ought not to be absolutely rejected, though entitled to very little weight. *Evans v. Eaton*, II. 243.
32. That the invention of the defendant, is better than that of the plaintiff is improper except to show a substantial difference between them. *Alden et al. v. Dewey et al.* I. 17. ●
33. To show that the invention was not original, but was suggested to the plaintiff by another, although the precise mode of carrying it into effect was not pointed out—is not sufficient unless the jury are satisfied that it was so far communicated that the plaintiff could have applied it without more inventive power. *Ib.*
34. The oath of the inventor made prior to the patent may be opposed to the oath of a witness in the case whose testimony is offered to show that the invention was not original. *Ib.*
35. The decision of the board constituted to act on applications for extensions of patents—is conclusive of certain facts—but not as to the right of an administrator to an extension. *Brooks et al. v. Bicknell et al.* II. 118.

36. When practical mechanics are enabled to supply any omissions in the specification, an intention to defraud will not be presumed. *Gray et al. v. Jones et al.* I. 120.
37. An offer to the patentee to take from him a license, does not estop the person in offering to deny that the patentee was the original inventor. *Evans v. Eaton*, I. 68.
38. May be given of the use by other persons than those named in the notice of special matter. *Evans v. Kremer*, I. 66; *Evans v. Eaton*, I. 68.

EVIDENCE—PRACTICE.

1. The defendants cannot put in new rebutting evidence to affidavits of the plaintiff offered in reply to that first offered by defendants. *Ames v. Howard et al.* I. 689.
2. It is incumbent on them who seek to show that the examination of a witness has been improperly rejected, to establish their right to have it admitted; for the Court will be presumed to have acted correctly until the contrary is established. *The Phil. & Trenton Railroad Co. v. Stimpson*, II. 46.
3. And it is the duty of the party who insists upon the right to put particular questions to a witness to establish that right beyond any reasonable doubt for the very purpose stated by them. And they are not at liberty to desert that purpose, and show the pertinancy or relevancy of the evidence for any other purpose not then suggested by the Court. *Ib.*
4. A party cannot by his own omission to object to the admission of improper evidence, brought out on cross-examination, found a right to introduce testimony in chief to rebut or explain it. *Ib.*

EVIDENCE—GENERAL ISSUE.

1. Burden of proof on a trial of the general issue under the 10th section of Act of 1793, lies on the plaintiff. *Stearns in Error v. Barrett*, I. 97.
2. Plaintiff must prove that the thing made by defendant, substantially resembles the plaintiff's invention. If they differ in form and proportion only they are the same. *Dixon v. Moyer*, I. 324.
3. Under the general issue without notice, the defendant cannot give in evidence any matters mentioned in the sixth section of the act of Congress. *Kneass v. The Schuylkill Bank*, I. 303.
4. But under the general issue he may give in evidence the act of Congress, without notice and without pleading it. Also alienage—and a license. *Ib.*
5. On the general issue, without notice, the defendant may object to the plaintiff's recovery, because there is no specification; or that it is unintelligible; that the patent is broader than the discovery; that it is for an improvement not distinguished from the original invention. And that the suggestions of the petition are not recited in the specification. *Ib.*
6. There is no limitation of the period in which, when the general issue is pleaded, the defendant may give in evidence that the patentee is not the original inventor. *Evans v. Eaton*, I. 68.
7. If the general issue has been pleaded, is it competent for the defendant to

give in evidence that the machine is useless, and has been abandoned?
Quere. Gray et al. v. James et al. I. 120.

See ALIENAGE; CUMULATIVE EVIDENCE; DECLARATIONS.

8. See Equity—Evidence,—where witnesses differ as to the fact of infringement.

See INJUNCTION; ONUS PROBANDI; LICENSE; NOTICE.

9. For the effect of the decision of the board on applications for renewals, see
Brooks et al. v. Bicknell et al. II. 118.

EXPERIMENT.

With a machine to test its value is such a use, within the 6th section of the Patent Act, as will avoid a patent for a subsequent invention. *Watson v. Bladen, I. 510.*

See SPECIFICATION; USE.

EXPERTS.

See WITNESSES.

EXTENSION.

1. May be granted to an administrator. *Washburn et al. v. Gould, II. 206; Woodworth v. Sherman, II. 257; Woodworth et al. v. Hall et al. II. 495.*
2. And the letters of administration need not be produced. *Woodworth et al. v. Hall et al. II. 495.*
3. Does not enure to the benefit of the assignee or grantee, under the original patent, unless such right has been expressly conveyed by the patentee. *Woodworth v. Sherman, II. 257.*
4. A patent extended by the board, and also extended by special act of Congress must be considered as a patent for twenty-eight years. *Woodworth et al. in Equity v. Edwards et al. II. 610.*
5. The specification for both extensions is the original one; and if surrendered for defect therein, the new and reissued letters should be for twenty-eight years—and although the old specification may have been adjudged good, in several suits—yet if still questioned and litigated—and appears to be in some degree inoperative from certain defects supposed to have happened by mistake, the Court, on its surrender, may issue new letters for the twenty-eight years in an amended specification. *Ib.*
6. An act of Congress extending the patent, passed after the original patent had expired—providing that “no person who shall have used the said improvements or have erected the same for use before the issuing of the said patent shall be liable to damages therefor,” did not authorize the use of such improvements after the issuing of the second patent. *Evans v. Jordan et al. I. 20.*

See ASSIGNMENT.

EXTENDED PATENT.

Does not enure to the benefit of the assignees under the original patent. But those assignees who were in use of the patented machine at the time of extension still have a right to continue the use of it. *Wilson v. Rousseau et al.* II. 372.

FALSE SUGGESTION.

1. In any of several material facts set forth in the specification invalidates the patent. *Delano v. Scott*, I. 700.
2. Though a patentee believes himself *bona fide* to be the original inventor of the improvement patented, yet the fact of his not being so, if it does not constitute a false suggestion in obtaining it, appears to be a sufficient ground for repealing it, under the act of 1793. *Ib.*
3. Refusal to refer under 9th Sec. of Act of 1793, not conclusive proof. *Sawin Error v. Barrett*, I. 97.
4. Proceedings to repeal patent for — burden of proof. *Ib.*

See CONSTRUCTION OF STATUTES.

FORM.

1. A mere difference in the manner and form of applying an invention which is the same in principle with one previously used, will not justify or sustain a new patent. *Delano v. Scott*, I. 700.
 2. But change of form or proportion, which produces a new effect, does not come within the inhibition of the statute. *Davis v. Palmer*, I. 518.
 3. Suggestions of form made by the mechanic employed to construct the machine, will not invalidate the patent. *Pennock et al. v. Dialogue*, I. 466.
- See EVIDENCE ; GENERAL ISSUE ; IMPROVEMENT ; PRINCIPLE.

FRAUD.

1. The mere existence of a previous patent is not sufficient to establish fraud in a subsequent patentee of the same invention, without actual knowledge. *Delano v. Scott*, I. 700.
2. A patent cannot be said to be obtained by fraud of the right of another, who expressly or tacitly permitted him to obtain a patent. *Dixon v. Meyer*, I. 324.

See REISSUED PATENTS ; EVIDENCE.

GENERAL ISSUE.

See PLEADINGS.

GIFT.

See ABANDONMENT.

GRANT.

1. Every instrument is to be interpreted by a consideration of *all of its provi-*

- sions, and its obvious design is not to be controlled by the precise force of single words. *Washburn et al. v. Gould*, II. 206.
2. A grant of a right to construct and use fifty machines within certain localities, reserving to the grantor the right to construct and to license others to construct, but not to use them therein, was held to be a grant of an exclusive right under the act of 1836, and that suits were to be brought in the name of the assignee. *Ib.*
 3. A grant of a right under the original patent, does not give a right in the extended patent, unless it be included in *express terms*. *Woodworth v. Sherman*, II. 257.
 4. A grant by the Legislature of a State of an exclusive privilege in an invention, does not imply an irrevocable contract with the people that at the expiration of the period the invention shall become their property. The State may revive it or refuse it. *Evans v. Eaton*, I. 68.

IDENTITY,

1. Or diversity of two machines, depends not on the employment of the same elements or powers of mechanics, but upon producing the given effect by the same mode of operation, or the same combination of powers. *Odiorne v. Winkley*, I. 52.
2. Where two machines are *substantially* the same, and operate in the same manner to produce the same kind of result, they must be in principle the same. *Gray et al. v. James et al.* I. 120.
3. What constitutes. *Whittemore et al. v. Cutter*, I. 40.

IMPROVEMENT.

1. To sustain a patent, must be in the *principle* of a machine, art, or manufacture before known, and not in form or proportions only. *Reutgen v. Kanours*, I. 1; *Park v. Little et al.* I. 17; *Evans v. Eaton*, I. 68; *Smith v. Pearce*, II. 13.
2. *Quere* — If a new result is produced by a change of form and proportion, is not this evidence of the introduction of a new principle? (See *Muny v. Sizer et al.*, October Term, 1848, tried before Sprague, J., — carried to the Supreme Court on writ of Error, December Term, 1849.) *Davis v. Palmer*; *Same v. McCormack*, I. 518.
3. An improvement on an existing machine may be the subject of a patent. *Evans v. Eaton*, I. 193.
4. If a person be the inventor of an improvement only, and not of the whole machine, he is entitled to a patent for no more than his improvement. *Whittemore et al. v. Cutter*, I. 40; *Odiorne v. Winkley*, I. 52.
5. Alterations merely formal, or a slight improvement, will give no right. *Smith v. Pearce et al.* II. 13.
6. Whether the invention be of the whole machine or of an improvement only, is a question of fact for the jury. *Whittemore et al. v. Cutter*, I. 40.
7. And also whether it be new in principle, or form and proportion only. *Reutgen v. Kanours*, I. 1.

8. Patent for, must distinguish the new from the old, or will be void. *Lewis v. Lewis*, I. 131.
 9. And the specification of an improvement should describe the thing in use that it may be known in what the improvement consists. *Sullivan v. Redfield*, I. 477; *Dixon v. Moyer*, I. 324.
 10. And it is not sufficient to show it by exhibiting the invention on the trial. *Dixon v. Moyer*, I. 324; *Evans v. Eaton*, I. 336.
 11. But if the improvement be so described as to be definitely distinguishable from the rest, although the patentee may have claimed more than he has invented, the patent will be sustained. *Peterson et al. v. Wooden*, II. 116.
 12. If a machine, in the state in which it was first made, was so far inferior to other machines used for the same purpose as that it was of no intrinsic value, yet if another person superadd to the invention and remove its defect the inventor of the improvements derives no right to the original machine from having made it of value by the addition to it. *Gray et al. v. James et al.* I. 140.
 13. Improvement on a patented invention, will not entitle the inventor of the improvement to use the original machine without the license of the patentee while the term lasts. *Gray et al. v. James et al.* I. 120; *Woodworth et al. in Eq. v. Rogers et al.*, II. 625.
 14. When several improvements on a machine are claimed in the patent, if any one of them is not new the patent is void. *Moody v. Fiske et al.* I. 312.
 15. Whether on different machines used in combination, capable of being used separately also, can be embraced in one patent.
- See EVIDENCE; GENERAL ISSUE; INVENTORS; PATENT; PRINCIPLE; SPECIFICATION; DESCRIPTION.

IMPROVEMENT. — ILLUSTRATION.

If a machine produces several different effects by a particular combination of machinery, and those effects are produced in the same way in another machine, and a new effect added, the inventor of the latter cannot entitle himself to a patent for the whole machine. *Whittemore et al. v. Cutter*, I. 40.

INFRINGEMENT.

1. When a patent embraces several improvements on a machine, if any one of them be used by the defendant it is an infringement. *Moody v. Fiske et al.* I. 312.
2. The use of a substantial part of the invention, although with some modifications of form and apparatus, is a violation of the right. So if the patents be of two machines, each new, if the defendant uses only one. *Wyeth et al. v. Stone et al.* II. 23.
3. The making of a patented machine, fit for use and with a design to use it for profit, is an infringement. *Whittemore v. Cutter*, I. 28.
4. But if no user be proved, nominal damages only to be allowed. *Ib.*

5. The making the thing patented, though employed by another to do so, is an infringement. *Bryce v. Dorr et al.* II. 302.
6. But a mere workman employed by a person who is not the patentee, to make parts of the patented machine, is not liable. *Delano v. Scott*, I. 700.
7. If a person has a license to use on conditions to pay a certain sum weekly and do certain things, if the payment be not made weekly, the continued use is an infringement. *Brooks et al. v. Stolley*, II. 281.
8. Whether printing on the back of bank-notes with steel plates is an infringement of a patent for copper-plate printing on the bank-notes, *quare*. *Kneass v. The Schuylkill Bank*, I. 303.
9. The use of one of the old machines composing a combination that is patented, will not be an infringement. *Evans v. Eaton*, I. 68.
10. It is not an infringement to use any number of the parts of a combination less than the whole. *Prouty et al. v. Ruggles et al.* II. 92; *Prouty et al. v. Draper et al.*, II. 75; *Parker v. Haworth*, II. 725; *Howe v. Abbott*, II. 99.
11. Unless the parts so used were invented or improved by the patentee. *Parker v. Haworth*, II. 725.
12. Nor will the use of the machines, comprising a combination, separately be an infringement. *Barrett et al. v. Hall et al.* I. 207.
13. And if the patent be for an entire process, it is not infringed by the use of a part. *Howe v. Abbott*, II. 99.
14. Where the invention is of a mould-board of a plough of a certain form, worked upon transverse circular lines, the proportion of the radii of which is exactly given, the patent is not violated unless the same circular lines are adopted, unless the imitation be so nearly exact as to satisfy the jury that the defendant intended to copy the model, and to make some almost imperceptible variation for the purpose of evading the patent. This will be considered a fraud upon the law, and the variation be disregarded. *Davis v. Palmer*, I. 518.
15. The continued use after letters-patent are issued, of an invention constructed and used previously to the application, will not be an infringement if such prior use was with the knowledge and consent of the patentee. *Piereson v. The Eagle Screw Co.* II. 268.
16. But a person constructing the thing invented, without the consent of the inventor, before the application for letters-patent, does not thereby acquire a right to use it, if a patent is afterwards granted. *Evans v. Weiss*, I. 10.
17. The sale of the product of a patented machine, is not an infringement of the patent. *Boyd v. McAlpin*, II. 277.
18. A person purchasing of another an article, under a contract for a supply of all manufactured by him with a patented machine, is not liable for an infringement, if the contract was *bonâ fide*, and not colorable, although he knew that the machine by which such article was produced was patented by another, as the inventor. *Keplinger v. De Young*, I. 458.
19. But if the contract was made for the purpose of evading the plaintiff's right, and of this the jury must judge, it would be an infringement. *Ib.*
20. A sale by a sheriff under an execution, of the materials of a patented ma-

chine, will not subject him to an action for infringement. *Savin et al. v. Guild*, I. 47.

21. Must be proved to have taken place after the application or date of the patent. But if the defendant seeks to avoid the patent by showing a prior existence of the thing patented, the patent will relate back to the time of discovery. *Dixon v. Moyer*, I. 324.
22. Action for, cannot be maintained without proof of an infringement previous to the commencement of the suit. *Woodworth et al. v. Stone*, II. 25.
23. But an injunction will be granted upon well-grounded apprehension of an intention to infringe, if the patent has been admitted or established. *Ib.*
24. In proceedings in equity for an injunction, if witnesses differ on the fact of infringement, the matter should be submitted to the jury. *Brooks et al. v. Bicknell et al.* II. 118.
25. Plaintiff may recover against one of two defendants, though the evidence does not apply to both, for all torts are joint and several: a plaintiff may recover against one although the other be acquitted. *Reutgen v. Kanover et al.* I. 1.

See SPECIFICATION; *Akin v. Bemis*, II. 644.

INJUNCTION.

1. Rule for granting injunction, stated. *Ogle et al. v. Ege*, I. 516.
2. The principles on which injunctions are granted are not altered by the Act of 15 February, 1819. *Sullivan v. Redfield*, I. 477.
3. The practice of the Court is to grant an injunction upon the filing of the bill, and before a trial at law, if it shows a clear right verified by affidavit. *Isaacs v. Cooper et al.* I. 332.
4. But it will not be granted merely upon proof that the plaintiff has obtained a patent; there must be either undisturbed possession and use under the patent for a reasonable length of time, or judgment rendered in favor of plaintiff in suits for violation. And it makes no difference that such judgment was rendered by consent, if not collusive. *Orr v. Littlefield et al.* II. 323.
5. It should be stated in the bill or by affidavit, that the complainant is the inventor, and the bill must be sworn to. *Sullivan v. Redfield*, I. 477.
6. To warrant an injunction there must be but little, if any, doubt on the minds of the Court, of the validity of the patent. *Ib.*
7. But if the bill states an exclusive possession of the invention, an injunction will be granted, although the Court may have doubts as to the validity of the patent. But if the defects in the patent and specification are so manifest that the Court can entertain no doubt, an injunction will be refused until a trial at law can be had. *Isaacs v. Cooper et al.* I. 332.
8. And where there has been an exclusive possession of some duration under a patent, without requiring the patentee to establish his patent by an action at law. It is otherwise if the patent be recent. *Washburn et al. v. Gould*, II. 206; *Sullivan v. Redfield*, I. 477.
9. But where long possession of a patent has existed, and frequent recoveries under it, if the originality is not denied, and the patent does not appear to be void, it will be granted. *Woodworth et al. v. Hall et al.* II. 495.

10. And where an action at law is pending between the parties, and a bill is filed for an injunction, if the answer denies the use of the thing patented, also the originality of the invention, supported by affidavits raising a doubt of such originality, an injunction will not be granted until the right has been settled in the action; unless the complainant shows undisturbed use and sale of the patent for some time, or recoveries against others. *Hovey v. Stevens*, II. 479.
11. Recoveries under a former patent for an invention, to which the invention in the second patent is auxiliary, will not avail unless the second patent is connected with the former, and is a part of it. *Ib.*
12. An injunction does not impair any right to a trial by jury, as secured by the Constitution, but aids the party appearing to have the legal title, till such a trial, if desired, can be had. *Woodworth et al. in Eq. v. Rogers et al.* II. 625.
13. An interlocutory injunction will be granted if the Court be satisfied that the defendant has infringed, notwithstanding defendant may have a patent subsequently obtained for the same invention — the first patentee having had no notice of the application therefor. *Wilson v. Barnum*, II. 749.
14. Injunction will not be issued against the defendant, unless it appear that he has used the invention himself, or employed others to use it, or participates in the profits of the use. *Woodworth et al. v. Hall et al.* II. 495.
15. When one of the respondents run a planing machine, and two others owned it, the injunction was allowed as against the three. *Woodworth et al. in Eq. v. Edwards et al.* II. 610.
16. The use of a machine, against which an injunction has issued by a subsequent purchaser thereof, will not be permitted while the injunction continues in force. *Ib.*
17. The answer to a bill for an injunction, though filed before the time for answering, will be treated as an answer on the interlocutory motion. *Brooks et al. v. Bicknell et al.* II. 118.
18. When the patent has been admitted or established, an injunction will be granted upon well-grounded proof of an apprehended violation of it. *Woodworth et al. v. Stone*, II. 296.
19. A person who is within the jurisdiction of the Court may be enjoined from using a patented machine beyond the jurisdiction of the Court. *Boyd v. McAlpin*, II. 277.
20. Assignee of part of the patent, for a particular district or territory, may maintain a suit in *Equity* for an injunction in his own name. *Ogle et al. v. Ege*, I. 516.
21. An injunction granted on an original bill, before the surrender of the patent, cannot be maintained upon the new patent, unless a supplemental bill be filed founded thereon. *Woodworth et al. v. Stone*, II. 296.
22. An injunction will not be dissolved merely on an answer denying the validity of the patent; but the court will direct an issue at law to be tried, if requested. If not so requested, the injunction will be continued until the next term, and then dissolved, unless a suit is brought in the mean time to

- test the title. *Orr v. Merrill*, II. 331; *Woodworth et al. v. Edwards et al.* II. 610.
23. An injunction will not be dissolved as a matter of course, on the coming in of the answer denying the equity, if complainant has adduced auxiliary evidence of his right. *Orr v. Littlefield et al.* II. 323.
24. Motions to dissolve an injunction will not be heard on the same evidence on which it was granted, nor on new evidence that might have been offered at the time; but will on new and material testimony. *Woodworth et al. v. Rogers et al.* II. 625.
25. An injunction will be dissolved on the filing of an answer denying the validity of the patent, supported by evidence *prima facie*, unless there be counter evidence sustaining the patent. *Ib.*
26. And if the balance of evidence appears to be in favor of the plaintiff, the injunction will be continued until a trial can be had at law, and if the action is not brought the injunction will be dissolved. *Ib.*
27. An injunction will not be dissolved on account of any doubts as to the validity of a re-issued patent, caused by the errors of public officers, if measures are pending in Congress to remove them by legislation. *Woodworth v. Hall et al.* II. 517.
28. A person who has been enjoined is guilty of a contempt if he afterwards use another patent similar in principle, when the author of the latter has been previously enjoined on motion of the owner of the former. *Woodworth et al. v. Rogers et al.* II. 625.
29. He can purge himself only by satisfying the Court that he was not aware of the injunction against the latter patent. *Ib.*

INSTRUCTIONS.

1. It is not the duty of the Court to instruct the jury on abstract or irrelevant questions, but only such as arise on the evidence of the case. *Allen v. Blunt et al.* II. 530.
2. The Court is never bound to give an instruction to a jury on a point of law, in the precise form and manner in which it is put by counsel, but only in such manner as comports with the real merits and justice of the case. *Pitts v. Whitman*, II. 189.
3. It is no ground of reversal that the Court below omitted to give directions to the jury upon any points of law which might arise in the cause, when it was not requested by either party at the trial. *Pennock et al. v. Dayboe*, I. 542.
4. If either party considers any point presented by the evidence omitted in the charge of the Court, it is competent for him to require an opinion upon that point. The Court cannot be presumed to do more than to express its opinion upon questions that have been raised at the trial. *Ib.*

INTEREST OF WITNESS.

1. The liability of a witness to a like action, on his standing in the same predicament with the party sued, if the verdict cannot be given in evidence

against him is an interest in the question only, and does not exclude him. *Evans v. Eaton*, I. 336.

2. Short of that which would exclude him on the ground of incompetency, how far it should weigh. *Evans v. Hettick*, I. 166.

See WITNESSES.

INVENTION.

1. Defined. *Earle v. Sawyer*, I. 490.
2. Must be described with reasonable certainty, or the patent will be void. *Lowell v. Lewis*, I. 131.
3. If for an improvement, the new must be distinguished from the old; but if sufficiently distinguished the patent is good, although not described in such exact terms that a person skilled in the art or science of which it is a branch could make or construct the thing invented, unless such defective description was with intent to deceive. *Lowell v. Lewis*, I. 131.
4. And this holds, although the patentee has claimed more than his invention. *Peterson et al. v. Wooden*, II. 116.
5. An imperfect and incomplete invention, resting in mere theory or in intellectual notion, or in uncertain experiments not actually reduced to practice and embodied in some distinct machinery, apparatus, manufacture, or composition of matter, is not the subject of a patent. *Reed v. Cutter, et al.* II. 81.
6. It is doubtful whether a mere change in the mode of fastening knives in a cylinder to be ground, or to fasten one instead of several, is such a change in the structure of an old machine, as to justify a patent. *Hoovey v. Stevens*, II. 479.
7. The substitution of potters' clay, or any kind of clay used in pottery, in the manufacture of door knobs, for metal or wood, although it produces a cheaper or better article, is not the subject of a patent, if no more ingenuity and skill was necessary to construct the new knob than was possessed by an ordinary mechanic, acquainted with the business. *Hotchkiss et al. v. Greenwood et al.* II. 780.
8. To be valid as the first, must be seasonably reduced to practice and put into use. *Allen v. Blunt et al.* II. 530.
9. The earliest invention will prevail over a subsequent one, if not allowed to be in public use, or to be on sale more than two years before application for a patent, it not appearing that the subsequent inventor had perfected his invention and taken out a patent, while the other delayed and neglected to use diligence in perfecting his. *Ib.*

See SPECIFICATION; CLAIM.

INVENTOR.

1. The original inventor is entitled to a patent for his invention. *Odiome v. Winkley*, I. 52.
2. He who is first in time, has the exclusive right to the patent. *Lowell v. Lewis*, I. 131.

3. The right to a patent belongs to him who is the first inventor, even before the patent is granted, and whoever constructs the machine invented, acts at his peril, and will have no right to use it, if a patent be subsequently obtained. *Evans v. Weiss*, I. 10.
4. The plaintiff must prove that he was the *first* inventor, as well as an original inventor. *Darson v. Follen*, I. 9.
5. Who is the first inventor, question of fact for the jury; he must be so with reference to all the world — otherwise in England. *Reedgen v. Kanovers et al.* I. 1; *Evans v. Hettick*, I. 166.
6. The patentee cannot be considered the first inventor, if a machine similar to his own had been in use before, although at the time of his invention it had gone into disuse, or was not notoriously in use. *Ib.*
7. Whoever finally perfects a machine, and renders it capable of useful operation, is entitled to a patent, although others may have had the idea, and made experiments towards putting it into practice, and although all the component parts may have been known under a different combination before. *Washburn v. Gould*, II. 206.
8. But he must be the first as well as original inventor; and a subsequent, although original inventor, will not be entitled to a patent, if the invention is perfected and put into actual use by the first. *Reed v. Cutter et al.* II. 81.
9. And the former will be so entitled, though the latter may have first obtained a patent for such subsequent invention. *Woodcock v. Parker et al.* I. 37.
10. And although a subsequent inventor may have first adapted and perfected his invention, and reduced it to practice, provided the first inventor used reasonable diligence in perfecting and adapting the same. *Reed v. Cutter et al.* II. 81.
11. The decision in Dolland's case held not to be applicable to the patent laws of the U. States. *Ib.*
12. And he must make application for a patent within a reasonable time after perfecting it, and will not be permitted to gather the profits of it until competition should force him to procure the exclusive right. This would retard rather than promote the progress of the useful arts and sciences. *Pezock et al. v. Dialogue*, I. 542.
13. The inventor of a combination of old principles and old materials, producing a new result, is entitled to a patent. *Ib.* 466.
14. Of an *improvement*, cannot entitle himself to a patent to comprehend more than his *invention*. *Woodcock v. Parker et al.* I. 37; *Odiome v. Winkley*, I. 52.
15. He will be limited to the improvement. *Whittemore et al. v. Cutter*, I. 40.
16. Of a machine for which he obtains a patent, which is invalid, on the ground that it covers that which is not new, may afterwards take out a patent for so much of said invention as was new. *Treadwell et al. v. Bladen*, I. 381.
17. And he is the only person who can take out a patent; if he abandons the use of the invention and does not apply, no other person can. *Evans v. Eaton*, I. 68.
18. And he may lose his right to a patent by suffering the invention to go into general use, or by giving it to the public. *Whittemore et al. v. Cutter*, I. 40.

19. He who permits his invention to go into general use without objection, before he takes out his patent, will be held to have abandoned his right to the public. *Treadwell et al. v. Bladen*, I. 531.
20. And if, before he obtains a patent, he makes his discovery public, and permits the free use of it by others, without objection or assertion of claim, abandons his right to the discovery, although the making and using was by a particular person authorized by him. *Pennock et al. v. Dialogue*, I. 466.
21. Of a machine patented before the plaintiff's invention, alleged to be the same in principle with the latter, is a competent witness to prove the priority of his invention. *Treadwell et al. v. Bladen*, I. 531.

See COMBINATION; PRINCIPLE.

INDEPENDENT INVENTORS.

The right to a patent in a race of diligence would seem to belong to him who first reduces his invention to practice; but this right is qualified by the 15th section of the Act of 1836, by protecting the first inventor, if he is using reasonable diligence in perfecting his invention. *Reed v. Cutter et al.* II. 81.

JUDGMENT.

1. On a *scire facias* repealing a patent vacates it, but a judgment in favor of the patentee will not prevent his right being contested in a suit afterwards brought by him for infringement. *Delano v. Scott*, I. 700.
2. In *scire facias* to repeal, a patent may be reviewed in Circuit Court on writ of error. *Stearns in Error, v. Barrett*, I. 97.

JURISDICTION.

1. The Circuit Court has no jurisdiction to enforce the specific performance of a contract for the use of a patent-right, where all the parties reside in the same State where the suit is brought. But the Court having jurisdiction on the question of infringement, may settle other matters, not ground of original jurisdiction. *Brooks et al. v. Stoley*, II. 281.
2. Of Circuit Courts extended by Act of 15 Feb. 1819, to bills in equity, for injunction. *Sullivan v. Redfield*, I. 477.
3. Over the person, gives the Court the power to enjoin the party from using the patented machine even in places without the jurisdiction of the Court. *Boyd v. McAlpin*, II. 277.
4. Of the Board of Commissioners to act in a given case not conclusive by their decision upon the application. *Wilson v. Rousseau et al.* II. 372.

JURY.

1. To find whether the plaintiff was first inventor. *Reutgen v. Kanawors et al.* I. 1.
2. ——— whether an improvement made by defendant is in principle or in form, and proportion. *Ib.*
3. If in form and proportion to determine whether a new effect is thereby produced. *Davis v. Palmer*, I. 518.

4. That a patented invention is old; that the specification does not clearly describe the mode of making the machine, or that the original and reissued patent are not for the same invention, or that either were obtained with fraudulent intent, all involve matters of fact, and are for the jury to decide. *Carver v. Braintree Manufacturing Co.* II. 141.
5. To determine whether there is a difference in principle between two machines, from the model exhibited and the other evidence. *Smith v. Pease et al.* II. 13.
6. Whether the specification has declared the whole truth. *Reutgen v. Knowers et al.* I. 1.
7. Whether there has been a concealment with a view to deceive. *Ib.*
8. Whether the concealment is material. *Ib.*
9. To determine whether the invention is described with sufficient clearness to enable a skilful mechanic to construct the thing invented, and they are to give the directions a liberal and common-sense construction. *Brooks et al. v. Bicknell et al.* II. 118; *Davis v. Palmer*, I. 518; *Reutgen v. Knowers et al.* I. 1.
10. To determine the sufficiency of the description in patents for machines or for a new composition of matter where any of the ingredients do not always possess exactly the same properties in the same degree. *Wood v. Underli et al.* II. 588.
11. Also to find from the evidence of persons skilled in the art, whether the description is clear and exact enough to enable such persons to compound and use the invention. *Ib.*
12. The meaning of technical words of art, used in a patent, as well as the surrounding circumstances which may materially affect their meaning are to be interpreted by the jury. *Washburn et al. v. Gould*, II. 206.
13. To find whether the renewed patent, after the surrender of a defective one, is substantially for a different invention. *Allen v. Blunt et al.* II. 530; *Simpson v. W. C. Railroad*, II. 335.
14. To find whether there was fraud in the surrender of an original patent, and obtaining a new one. *Simpson v. W. C. Railroad*, II. 335.
15. To decide upon infringement in cases where witnesses differ in proceedings on motion for injunction. *Brooks et al. v. Bicknell et al.* II. 118.
16. To find whether the patentee be the inventor of the whole machine or of an improvement only. *Whittemore et al. v. Cutter*, I. 40.
17. To decide upon the question of novelty and utility. *Parks v. Little et al.* I. 17.
18. To decide whether the thing patented resembling any other thing be the same in principle with it. *Pennock et al. v. Dialogue*, I. 466.
19. It is not sufficient to prove that an article similar to that produced by the plaintiff's machine, was seen by a witness prior to plaintiff's claim. The jury must be satisfied that it was made by a machine like it in principle. *Treadwell et al. v. Bladen*, I. 531.
20. Should determine whether the delay to take out a patent, and allowing it to be put into use by others before application for a patent is an abandonment. *Morris v. Huntington*, I. 448.

21. To determine the fact of acquiescence by inventor in the public use. This may be presumed from circumstances, such as a knowledge of such use without an immediate assertion of right. *Shaw v. Cooper*, I. 643.
22. Will find single damages, the Court will treble them in proper cases. *Gray et al. v. James et al.* I. 120; *Whittemore et al. v. Cutter*, I. 40.
23. In estimating damages, may allow expense of counsel fees if they see fit. *Boston Manufacturing Co. v. Fiske et al.* I. 320.
24. In estimating damages, will not be authorized to include counsel fees. *Stimpson v. The Railroads*, II. 595.

See DEFENCE; EQUITY; NOVELTY; UTILITY.

LEGISLATIVE GRANT.

Of an exclusive privilege in an invention.

See GRANT.

LETTERS.

1. Of plaintiff to the Secretary of State, containing applications for a patent, and specifications, certified under the seal of the department, as papers remaining in that office, are admissible in evidence. *Pettibone v. Derringer*, I. 152.
2. Of commissioner. See EVIDENCE.

LETTERS.—CORRESPONDENCE.

See EVIDENCE.

LICENSE.

1. What will be considered a license to use the patented invention. *Reutgen v. Kanours et al.* I. 1.
2. If the right to use be conditional, the conditions must be performed, or such user will be an infringement. *Brooks et al. v. Stotley*, II. 281.
3. If the license be granted on condition that the licensee shall pay a certain sum, weekly, and do certain acts at stated times, the payment must be made, and the acts performed, or he will have no right to continue the use. *Ib.*
4. If the defendant justifies under the licenses, he must show the performance of the conditions. *Ib.*
5. If a person employed in the manufactory of another, receiving wages, makes experiments there at the expense of the employer, and receives additional wages in consequence of the results of the experiments, makes the article produced, and permits the employer to use it without demanding pay for such use, and afterwards obtains a patent, the employer will not be liable for the continued use, as these facts justify the presumption of a license. *McClury et al. v. Kingsland et al.* II. 105.
6. A grant of the right and privilege of manufacturing friction matches, and to employ in and about the same six persons and no more, and to vend the

- same in any part of the United States, was held to be a license, and need not be recorded, unless required by some positive provision of the Patent Act, to give it validity. *Brooks v. Byam et al.* II. 161.
7. It was also held that the right conveyed was an entirety and incapable of being apportioned or divided among different persons. *Ib.*
 8. No apportionment or division of a license can be made if it be contrary to the intention of the parties thereto. *Ib.*
 9. *Quere*, whether it can be assigned, notwithstanding the words to B and his "assigns" in the grant. *Ib.*
 10. To use one machine, gives authority to construct another, instead of it, but only one can be used at a time. *Woodworth v. Curtis*, II. 603.
 11. When the term expires, [*if the patent is extended*], the machine then in use may be employed until it wears out or is destroyed. *Ib.*
 12. Such license is assignable. *Ib.*
 13. Equity will cancel a contract or license under a patent-right, for fraud or mistake, but will not reform or alter it. *Brooks et al. v. Stolley*, II. 281.
 14. May be given in evidence under the general issue, without notice, and without pleading it. *Kneass v. The Schuylkill Bank*, I. 303.
 15. A mere license is an entirety and incapable of division or of being broken up into fragments in the possession of different persons. *Brooks v. Byam et al.* II. 161.

See CONTRACT.

MATERIALITY.

Of thing concealed, a question for the jury. Test, could an artist after plaintiff's right has expired, construct such a machine by looking at the specification. *Reutgen v. Kanowers et al.* I. 1.

MISTAKE.

1. If a mistake occur in the copy of a patent, it can be corrected without causing any injury, but if it exist in the original patent it cannot be corrected without the consent of the Secretary of State. *Woodworth et al. v. Hall et al.* II. 495.
2. The sanction of the Secretary of State to the correction of a clerical mistake in the letters-patent, may be given in writing afterwards, and he need not resign the patent. *Ib.*
3. But the commissioner, if correcting it, need not re-sign or re-seal the letters being the same officer who did it before. *Ib.*
4. If the mistake corrected be a material one, the patent cannot operate, except on causes arising after it is made; but if a mere clerical one. *Quere. Ib.*
5. If it be of a clerical mistake only it operates back to the original date of the patent, unless, perhaps, as to third persons who have acquired intervening rights affected thereby. *Ib.* 517.
6. An injunction will not be dissolved, because of such a mistake in the patent, if measures are pending to remove it by legislation. *Ib.*

7. In an expression, proved to be so by other parts of the specification, will not vitiate the patent. *Kneass v. The Schuylkill Bank*, I. 303.

See NEW TRIAL.

NEWLY-DISCOVERED EVIDENCE.

See NEW TRIAL; CUMULATIVE EVIDENCE.

NEW TRIAL.

1. Will not be granted, on account of surprise at the trial, where the party chooses to go on, relying upon other matters. *Ames v. Howard et al.* I. 689.
2. Will not be granted, because a deposition taken without notice, was rejected, the caption being held insufficient, in describing the action as against one defendant, when it was entered against, and defended by two; the minutes of counsel containing the testimony of the witness on a former trial, having been submitted to the jury. *Allen v. Blunt et al.* II. 530.
3. Will not be granted because an official letter of the Commissioner of Patents was admitted tending to prove the time of making the invention, though its competency may be questionable, if subsequent evidence in the case rendered it unnecessary to prove the fact for which it was offered. *Ib.*
4. Nor will it be granted where parol evidence of the contents of a former letter was rejected because the loss of that letter was not satisfactorily proved, or no proof that it had been received by the opposite party. *Ib.*
5. Will not be granted, because one of the jury publicly inquired of the clerk, what damages had been allowed in a former suit. *Ib.*
6. Where a motion for a new trial is not drawn up for some weeks, and counsel disagree as to some of the rulings made, the Court must settle the differences, and will not grant a new trial, on account of them, if justice seems on the whole to have been done. *Ib.*
7. Nor will a new trial be granted because an instruction was not given, which counsel did not request either orally or in writing to be given, although he may have intended and believed that by his argument a desire for such instruction was manifest. *Ib.*
8. Will not be granted for erroneous ruling, if the verdict has not been influenced thereby, or be against the justice of the cause. *Ib.*
9. Will not be granted on the ground that the verdict is against the weight of evidence, if there be some to be weighed, on both sides, unless a clear mistake be shown or manifest abuse of power. *Aiken v. Bemis*, II. 644.
10. The Court will not set aside a verdict for \$2,000 damages, on the ground that they are excessive, unless they are plainly and largely beyond the injury inflicted. *Aiken v. Bemis*, II. 644; *Allen v. Blunt et al.* II. 530.
11. Will be granted for newly-discovered evidence, if there was not gross neglect in not procuring it at the first trial; but it must not be merely cumulative. *Ames v. Howard et al.* I. 689; *Aiken v. Bemis*, II. 644.
12. Costs of the former trial must usually be the terms for a new trial on the ground of newly-discovered evidence. *Aiken v. Bemis*, II. 644.

13. Will not be granted at the same term at which the jury disagree. *Winn v. Barnum*, II. 749.

NONSUIT.

1. The omission of the words "against the form of the statute," in the declaration, is not the foundation of a nonsuit. *Tyron v. White*, I. 64.
2. But where the declaration professes to set out the specification, the slightest variance is fatal, and the defendant may claim a nonsuit. *Ib.*

NOTICE.

1. Of special matter, need not include all matters of defence, under the general issue, but the defendant may give in evidence all matters of defence that he may legally make. *Evans v. Hettick*, I. 417.
2. And where witness was asked whether the machine used by the defendant was like the model of the plaintiff, exhibited in Court, no notice was necessary to authorize the inquiry. *Ib.*
3. Where defendant pleads the general issue it is sufficient in the notice of special matter to state that the plaintiff is not the original inventor, and it is not necessary to state in the notice who was the inventor, or who had used the machine. *Evans v. Kremer*, I. 66.
4. If the notice specifies some persons, the use thereof by others may be given in evidence. *Ib.*
5. Under the 6th sec. of the Act of 1793, notice having been given of certain places in which the alleged invention had been previously used, it was held that evidence might be given of such use in other places than those named. *Evans v. Eaton*, I. 243.
6. In the notice of special matter to be given in evidence by the defendant, certain mills were mentioned where a machine of which the plaintiff claimed to be the inventor, was in use prior to the date of the alleged invention. It was held that the defendant might give evidence of the use of the said machines at other mills than those mentioned in the notice. *Evans v. Eaton*, I. 68; I. 243.
7. Required by the 15th sec. of the Act of 1836, need not contain the names of the witnesses, by whom it is intended to prove a prior knowledge and use of the thing patented. *Wilton v. The Railroads*, II. 641.
8. And a witness may be asked generally if he knew that the improvement had been in use by any person prior to the application of the patentee for a patent, and the plaintiff is not confined to the knowledge of a use by persons named in the notice of special matter. *Treadwell et al. v. Bladen*, I. 531.
9. An answer denying the validity of the patent, is sufficient to justify the Court in ordering a trial at law, although it does not set out the names of the persons who used or knew the thing patented prior to the alleged invention, nor the names of the places where it was used or known. But in the trial at law, or of the issue out of chancery, the answer should set them out. *Orr v. Merrill*, II. 331.

10. The Courts will not permit evidence of a prior use in England under a notice of such a use in the United States. *Dixon v. Moyer*, I. 324.
11. No previous notice of right is necessary to enable the patentee to maintain a suit. *Ames v. Howard et al.* I. 689.

See ALIENAGE; EVIDENCE; GENERAL ISSUE; LICENSE.

NOVELTY.

1. To entitle an individual to an exclusive right under the Patent Law, his invention must be substantially different from any machine or thing in use. *Stanley v. Whipple*, II. 1.
2. The novelty of an invention is either the manufacture produced, or the manner of producing an old one. See *Whitney et al. v. Emmett et al.* I. 567.
3. The invention must not have been known and used before in any part of the world. If it had been the patent will be invalid although the patentee was ignorant of such previous knowledge and user. *Evans v. Eaton*, I. 68.
4. Whether the invention is new, is to be decided by the jury. *Park v. Little et al.* I. 17.

OATH.

1. If the oath required by the Patent Act, previous to the issuing of a patent, be not taken, still the patent is valid. *Whittemore v. Cutter*, I. 28.
2. Of patentee on application for a patent, effect of as against the testimony of a witness to prove want of originality. *Alden et al. v. Dewey et al.* II. 17.
3. There is no rule of the Court requiring an oath to be filed with the bill for an injunction. *Woodworth et al. in Equity, v. Edwards et al.* II. 610.

OBLIGATION OF CONTRACTS.

May be impaired by Acts of Congress, though not by laws of States.

See CONTRACTS.

ONUS PROBANDI.

Where the plaintiff makes out a *prima facie* case for the violation, and the defendant introduces evidence to prove his special defence under notice, that the invention had been known and used, &c., and that the thing used by the defendant was not similar to the thing patented; it was held proper to instruct the jury, that as to this defence, it was the duty of the defendant to turn the scales of evidence in his favor. *Allen v. Blunt et al.* II. 530.

ORIGINAL INVENTOR.

1. Who has introduced his invention to practice is entitled to a priority of patent-right, although subsequently the same machine may have been invented by another person, and patented before the date of the first inventor's patent. *Woodcock v. Parker et al.* I. 37.

2. Parol evidence bearing upon written contracts and papers.

See EVIDENCE.

PARTICULAR PATENTS — BLANCHARD'S.

Blanchard's patent held to be for a machine and not a principle or function.
Blanchard v. Sprague, I. 734.

OLIVER EVANS'S.

1. The Act of 1808, ch. 117, authorizes a patent to Oliver Evans for his invention, discovery, and improvements in the art of manufacturing flour, and of the several machines applicable to that purpose. *Evans v. Eaton*, I. 243.
2. The act of Congress for the relief of Oliver Evans does not preclude judicial inquiry into the originality of his invention. *Ib.*
3. Although the Act of Congress authorized the issue of a patent to Evans for the several machines as well as for the entire improvement—yet the patent issued is confined to the improvements in the art of manufacturing flour by those machines. *Ib.*
4. As to right of Oliver Evans to a patent for all of his improvements—and degree of particularity required in the description of his improvements. And of his right to sue in the Circuit Courts. *Ib.*

EMERSON'S PATENT.

Sustained. See *Hogg et al. v. Emerson*, II. 655.

WOODWORTH'S PATENT.

The specification of this patent for a planing machine, held sufficient and proper, and the reissued patent declared to be valid. *Wilson v. Rousseau et al.* II. 372; *Woodworth et al. v. James Wilson et al.* II. 473.

PARTIES IN ACTIONS.

For violating patent-rights, the parties only are concerned, although the public may have an eventual interest in it, yet the United States are in no wise a party to the proceedings, and cannot be substituted as plaintiff in place of the petitioner. *Wood v. Williams*, I. 717.

PATENT.

1. Is not to protect a monopoly of what existed before, but something which did not exist and which belongs to the patentee. *Davoll et al. v. Brown*, II. 303.
2. They are not monopolies, in the odious sense—they are not granted as restrictions upon the rights of the community, but to promote science and the useful arts. *Blanchard v. Sprague*, I. 734.
3. The exclusive right under a patent does not rest alone on the discovery of the inventor—but also upon the legal sanctions which have been given it and the forms of law with which it has been clothed. There must be a substantial compliance with every legal requisite. *Shaw v. Cooper*, I. 643.
4. But it is valid although the oath required by the act, previous to the issuing of the patent, be not taken. *Whittemore v. Cutter*, I. 28.

5. Must substantially recite the allegations and suggestions of the petition. *Evans v. Chambers*, I. 7.
6. And it can only be for the invention recited in the patent and described in the specification. *Evans v. Eaton*, I. 68.
7. May be for a joint invention. If each of the patentees obtain a separate patent for the same invention they are estopped by the joint patent—to assert any title in the separate patents. *Barrett et al. v. Hall et al.* I. 207.
8. The right to a patent belongs to him who is the first inventor, even before the patent is granted, and any one constructing the invention will acquire no right to use it if a patent is subsequently granted. *Evans v. Weiss*, I. 10.
9. And if the inventor abandons the use of it, and does not make application, no other person can. *Evans v. Eaton*, I. 68.
10. No extent of disuse will be an abandonment. *Gray et al. v. James et al.* I. 120.
11. When the invention is of an improvement only and not of the whole machine, the patent is to be limited to the improvement. *Whittemore et al. v. Cutter*, I. 40.
12. For several improvements in a machine, each of which is claimed, if any one of them be not new the patent is void. *Moody v. Fiske et al.* I. 312.
13. Void if claim is for more than the invention. *Stanley v. Whipple*, II. 1; *Evans v. Eaton*, I. 336.
14. For an improvement, is void if it is broader than the particular improvement invented. *Woodcock v. Parker et al.* I. 37.
15. For a machine embracing a prior invention, without which the plaintiff's invention could not operate to produce the desired result, is too broad and consequently void. *Watson v. Bladen*, I. 510.
16. Although too broad in its general terms, will be limited by the summary in the specification, if the thing intended to be patented be clearly shown. *Whitney et al. v. Emmett et al.* I. 567.
17. Is a contract with the public, and must be complied with in the same good faith as other contracts, and the right secured by it will be protected by a liberal construction of the law, and the acts of the patentee. *Ib.*
18. Can only be declared void by the Court in the cases provided for in the sixth section of the Act of 1793. *Ib.*
19. If it be for the whole machine it must be shown to be substantially new in its structure and mode of operation. *Evans v. Eaton*, I. 336.
20. If the same combination existed up to a certain point, and the invention consisted in adding something new to the old, the patent should be limited to such improvement. *Ib.*
21. And it must clearly appear by the description in the specification in what the improvement consists. It is not sufficient that it be made out and shown at the trial, or by comparison of the machine described with others in prior use. *Ib.*
22. Shall not include inventions for two distinct machines. *Root v. Ball et al.* II. 513.

23. But in cases of combination, it may extend to elements of such combination that are new or improvements thereon. *Ib.*
24. And for a combination of parts, is not a patent for each of the parts separately. *Treadwell et al. v. Bladen*, I. 531.
25. May be granted for a combination of old principles and old materials—producing a new result. *Pennock et al. v. Dialogue*, I. 466; *Evans v. Eaton*, I. 336.
26. If for the whole machine when the invention is of an improvement only, will be void. *Evans v. Eaton*, I. 68.
27. But if for a machine or an improvement it will be good, although parts of it were known before. *Ib.*
28. For a combination of machines to produce a given result, is not a patent also for the particular machines comprising the combination—but to secure them the inventor should take out a patent for each of said machines of which he is the original inventor. *Ib.*
29. *Quere*, whether improvements on different machines, can be comprehended in the same patent so as to give a right to the exclusive use of several machines separately, as well as the right to the use of them in combination. *Ib.* 69.

SEE PARTICULAR PATENTS. *Oliver Evans.*

30. May include several improvements on one and the same machine or (two) machines which conduce to the same common purpose; although they are each separately capable of a distinct application. But cannot include them if designed for different and independent objects. *Wyeth et al. v. Stone et al.* II. 23.
31. But one patent cannot include the separate machines as well as the combination. *Barrett et al. v. Hall et al.* I. 207.
32. There must be several patents for several improvements of distinct machines. *Ib.*
33. For an improvement on an existing machine, will be limited to such improvement, which must be clearly described. If not it is void for ambiguity. If broader than the improvement it is void on other grounds. *Ib.*
34. For a machine, or an improvement on one, should not be for a method but for the machine or improvement. *Ib.*
35. They are to be construed liberally. *Blanchard v. Sprague*, I. 734.
36. And will not be vitiated by a mistake in an expression, appearing to be so by another part of the specification. *Kneass v. The Schuylkill Bank*, I. 303.
37. Nor will it be invalid because the description contains matters of form and proportion suggested by the mechanic employed to construct the machine. *Pennock et al. v. Dialogue*, I. 466.
38. A patent for “a new and useful improvement in the machine for threshing and cleaning grain; but described in the specification as consisting of a combination of several distinct improvements, was held to embrace not only the combination, but each distinct improvement, so far as it was the invention

- of the patentee; and that the descriptive words were to be construed in connection with the specification. *Pitts v. Whitman*, II. 189.
39. For an improvement on an existing machine, in which the new is distinguished from the old, will be good, although the description should not be so clear as to enable a person skilled to construct the thing invented; unless the defective description was intended to deceive. *Lowell v. Lewis*, I. 131.
40. Not void as under the former law, because the patentee claims more than he has invented, but so far as the invention goes he is protected, provided it be clearly distinguishable from that claimed without right. *Peterson et al. v. Wooden*, II. 116.
41. May be granted for an improvement in the *principle* of an existing machine. *Evans v. Eaton*, I. 68.
42. But for an improvement on a previously patented machine is invalid unless the improvement be substantially different in principle from the original invention. *Smith v. Pearce*, II. 13.
43. Cannot be granted for an effect only; but for an effect produced in a given manner, or by a peculiar operation. *Whittemore et al. v. Cutter*, I. 40.
44. May be for a new and useful *art*; but it must be practical and be explicable and referable to something which may prove it to be useful. *Evans v. Eaton*, I. 68.
45. May be granted for the *art* of printing on the back of bank-notes. *Kneass v. The Schuylkill Bank*, I. 303.
46. May be for a new mode or process to produce an old result; but not for an old process to produce a new result. *Howe v. Abbott*, II. 99; *Bean v. Smallwood*, II. 133.
47. May be for a mode or method of doing a thing; mode, when referred to something permanent, means an engine or machine; when to something fugitive, a method, which may mean process, instrument, manner of effecting the purpose. *Whitney et al. v. Emmett et al.* I. 567.
48. For particular means or implements by which an article is produced, does not give a monopoly in the sale of the product. *Boyd v. Brown*, II. 203; *Boyd v. McAlpin*, II. 277.
49. Will not be granted for an invention resting in mere theory or intellectual motion, or uncertain experiments. *Reed v. Cutter et al.* II. 81.
50. For a principle or function simply, detached from machinery, will not be valid. *Blanchard v. Sprague*, I. 734.
51. For an abstract principle is void. *Stone v. Sprague et al.* II. 10; *Wyeth et al. v. Stone et al.* II. 23.
52. "For cutting ice by any other process than human, is a claim for an abstract principle. *Wyeth et al. v. Stone et al.* II. 23.
53. For all modes of communicating motion from one part of a machine to another part would be void, as an attempt to patent an abstract principle. *Stone v. Sprague et al.* II. 10.
54. But for an improvement in the art of making nails by means of a machine which cuts and heads the nails at one operation, is not the grant of an ab-

- stract principle, nor is it the grant of the different parts of any machine but of an improvement applied to a practical use, effected by a combination of various mechanical powers to produce a new result. *Gray et al. v. Jones et al.* I. 120.
55. The invention must be *new* in structure or material. *Hotchkiss v. Greenwood et al.* II. 730.
56. Cannot be sustained for making an article, after a known method; because the material out of which it is made was never applied to that purpose before. But if the material be a new compound, a patent may be sustained for that. *Ib.*
57. Door knobs having been made of glass, wood, brass, and other materials, the making them of potter's ware or porcelain will not sustain a patent. A
58. Will not be avoided by showing the prior existence of a thing similar in principle to the thing invented, unless it be proved that it was in use. *Pennock et al. v. Dialogue*, I. 466 - 542.
59. Under the law of 1793, is valid, though the invention may have been in use for years prior to the patent, if the patentee was the first inventor. *Case Goodyear v. Matthews*, I. 50.
60. To invalidate the plaintiff's patent it is not sufficient to show that the thing patented was used prior to the plaintiff's application for a patent. It should be shown that it was prior to his discovery. *Treadwell v. Bladen*, I. 531.
61. Date of will relate back to the time of discovery, if the defendant seeks to avoid it by showing the existence of the thing patented before the date of the patent. *Dixon v. Moyer*, I. 324.
62. For an invention will be defeated by the use of a machine, similar in principle, prior to the invention, although such use was by way of experiment only to test its value. *Watson v. Bladen*, I. 510.
63. Will not be invalidated by the use of his invention by others before application, and while he was practising upon it with a view to improve it; but the motive for delay is a question for the jury. *Morris v. Huntington*, I. 448.
64. Will not be defeated by showing that modifications of form and proportion were suggested by the mechanic employed to construct the machine, although such suggestions are set forth in the specification. *Pennock et al. v. Dialogue*, I. 466; *Watson v. Bladen*, I. 510.
65. But if any of the essential parts and principles of the machine were suggested by another, the patent would be invalidated. *Watson v. Bladen*, I. 510.
66. Is not avoided on account of defect or concealment in the specification, unless omitted or made with the intent to deceive the public. *Whitmore v. Cutter*, I. 28.
67. Defective may be surrendered, and a new one obtained. *Shaw v. Cooper*, I. 643.
68. Reissued to have relation back to the emanation of the first, and being a continuation of the first, the rights of the patentee must be ascertained by the law under which the original application was made. *Ib.*
69. Patent reissued with a corrected specification, need not contain a recital that

the former patent was cancelled on account of a defective specification. The granting of the new patent is *prima facie* evidence that all the proofs were regularly made, and were satisfactory. *The P. & T. Railroad Co. v. Stimpson*, II. 46.

70. A second patent cannot be taken out for the same invention, until the first is surrendered, repealed, or declared void, which may be after verdict against it, or a vacation entered on surrender; but a patentee cannot declare his own patent void. *Morris v. Huntington*, I. 448.
71. Whether a new patent can be taken out when the patent has been declared void under the 6th sec. of the Act of 1793? *Quere. Ib.*
72. On surrendering a patent, and taking out a new one, the latter should be only for the unexpired time. *Ib.*
73. An inventor cannot have two subsisting valid patents at the same time for the same invention. The first, while unrepealed, is an estoppel to any subsequent patent for the same inventions. *Odiorne v. Amesbury Nail Factory*, I. 300.
74. But if he has obtained a patent, which is invalid, because too broad, he may afterwards take out a patent for such parts of the machine as were actually invented by him. *Treadwell et al. v. Bladen*, I. 531.
75. A patent which is extended seven years by the board, must be treated as in law for seven years longer; so one which is further extended by Act of Congress; and a patent extended in both of these ways must be considered as a patent for twenty-eight years. *Woodworth et al. in Equity, v. Edwards et al.* II. 610.
76. Granted on correct specifications has relation back, and for all legal purposes covers the whole time from the emanation of the first patent which was declared void for defective specification. *Stanley v. Whipple*, II. 1; *Smith v. Pearce*, II. 13.
77. Signed by a person calling himself Acting Commissioner, is sufficient on its face, in controversies between the patentee and third persons, as the law recognizes such an appointment as lawful. *Woodworth et al. v. Hall et al.* II. 495, 517.
78. Surrendered and renewed, operates as from the commencement of the original patent, except as to causes of action arising before the renewal. *Ib.*
79. More technical objections to, are not to be encouraged. *Ib.*
80. If a mistake occurs in an original patent, it cannot be corrected, so as to avail without the assent or re-signature of the Secretary of State; otherwise if it occurs in a copy. *Ib.*
81. For an improvement on an invention already patented does not give the inventor of the improvement a right to use, without license, the invention previously patented. *Woodworth et al. in Equity, v. Rogers et al.* II. 625.
82. May be granted by special Act of Congress, and may operate retrospectively, and give a patent for an invention in public use at the time of the grant. *Blanchard v. Sprague*, I. 734.
83. But whether the act would be constitutional if it gave a right to damages for the previous use. *Quere. Ib.*

84. The act would not be construed to act retrospectively, unless that construction was unavoidable. *Ib.*
85. The grant of a patent is not a bar to an interlocutory injunction in favor of a prior patentee of the same thing, no notice having been given to the first patentee of the application on which the second patent was granted. *Wilson v. Barnum*, II. 749.
86. For an invention reduced to practice, and afterwards patented, will prevail over a patent granted to a *bonâ fide* subsequent inventor, although the latter patent be issued before the former. *Woodcock v. Parker et al.* I. 37.

PATENT ACTS.—CONSTRUCTION.

See USE. *Reed v. Cutter et al.* II. 81.

PETITION.

Suggestion of, See EVIDENCE; GENERAL ISSUE.

PLEADING.

1. There must be special pleas, or the general issue with notice of special matter. *Root v. Ball et al.* II. 513.
2. The defendant is permitted to proceed according to the 6th sec. (Act, 1793,) but is not prohibited from proceeding in the usual manner so far as it respects his defence, except that special matter may not be given in evidence under the general issue. *Grant et al. v. Raymond et al.* I. 604.
3. Evidence of fraudulent intent in the addition or concealment is required only for the purpose of vacating the patent. *Ib.*
4. Where a contract binds the defendant to pay five dollars for each store sold, the special contract need not be declared on. The amount received may be recovered on the count for money had and received. *Stanley v. Whipple*, II. 1.

PLEADING.—DECLARATION.

1. Ought always to show a title in the plaintiff, and that with sufficient certainty. *Gray et al. v. James et al.* I. 120.
2. That is, that the grant in the form prescribed by law was issued, it is not sufficient to declare that it was made out, but it must be averred that it was tested by the President, sealed with the seal of the United States, and delivered. *Cutting et al. v. Myers*, I. 159.
3. But he need not state that the stages preliminary to the issuing of a patent were observed. *Ib.*
4. If an action be brought by the assignee of a patent-right, and there be an omission to state that the assignment has been duly recorded, the defect will be cured by a verdict. *Dobson v. Campbell*, I. 681.
5. And if the declaration contain general terms sufficient to comprehend a fact necessary to be proved, the omission to state it particularly will be cured by the verdict. *Ib.*
6. And if the plaintiff's title depends upon the performance of certain acts he must affirm their performance. *Gray et al. v. James et al.* I. 140.

7. If plaintiff has a patent for an invention, and also one for an improvement thereon, he must assert his entire right in an action for infringement. *Case v. Redfield et al.* II. 741.
8. And the improvement must be stated as an essential part of the plaintiff's right, if not the declaration is demurrable. *Peterson et al. v. Wooden*, II. 116.
9. But it is not necessary that the declaration should contain a description of the thing patented, the profert of the letters-patent when produced makes them a part of the declaration. *Pitts v. Whitman*, II. 189; *Case v. Redfield, et al.* II. 741.
10. Where the declaration describes the plaintiff's improvement in the words of the patent, it is not necessary that the description as stated in the specification should be set forth. If the defendant requires the specification in his defence, he may have it placed on the record by asking oyer of it. *Gray et al. v. James et al.* I. 140.
11. But where it professes to set out the specification, the slightest variance is fatal. *Tryon v. White*, I. 64.
12. The breach assigned must be as broad as the right set forth in the declaration, and granted by the patent. *Cutting et al. v. Myers*, I. 159.
13. An averment that the defendant has made the thing "in imitation of the patent" is sufficient to sustain the action. *Parker v. Haworth*, II. 725.
14. The plaintiff need not set forth the act complained of as contrary to the statute. *Ib.*
15. In the case of an extended or renewed patent, the plaintiff will be restricted to proof of infringement subsequent to the date of the extension, unless there is an independent count for acts of infringement of the original patent. *Eastman v. Bodfish*, II. 72.
16. Where time is material, the plaintiff is strictly bound by the time specified in the declaration. *Ib.*
17. The general averment of an extension in due form of law is sufficient, without alleging a compliance with the prerequisites of the statutes. *Phillips v. Combetock*, II. 724.

PLEADING.—GENERAL ISSUE.

1. *Quere*, Whether under this plea the defendant can show that the machine is useless and has been abandoned. *Gray et al. v. James et al.* I. 120.
2. The defendant may give in evidence that the patentee is not the original inventor at any time; the time elapsed since the date of the patent is no bar to this right, however long. *Evans v. Eaton*, I. 68.
3. Burden of proof on the plaintiff in a trial under the 10th sec. of Act of 1793. *Stearns, in Error, v. Barrett*, I. 97.

PLEADING.—DEMURRER.

1. The want of an averment that the patent was attested by the President, sealed, and delivered, is ground of demurrer. *Cutting et al. v. Myers*, I. 159.

2. It is no cause of demurrer that neither the patent nor the declaration states in what the improvement consists. *Ib.*
3. It is not a cause for demurrer that the bill praying for an injunction has not been sworn to, no objection being made for the want of the oath at the time of entering the appearance, and not taken until after an order for filing the evidence had been entered. *Woodworth et al. in Equity, v. Edwards et al. II. 610.*
4. On the hearing of a demurrer the allegations of fact in the bill must be taken as true. *Ib.*
5. When a demurrer for objections to the patent is overruled, the respondent may have leave to answer further upon the payment of costs; and they may also contest the motion for a temporary injunction although the time named in the order for filing evidence has passed without being complied with, but the hearing will proceed upon the facts stated in the bill, taken for confessed, unless it be shown by affidavit that the demurrer was not for delay, and a bond of indemnity be filed. *Ib.*
6. A plea that the thing claimed to have been invented was in use and for sale before the application for the patent is demurrable, unless the plea aver an abandonment, or that such sale or use was more than two years before the application. *Root v. Ball et al. II. 513.*

See EVIDENCE; NOTICE; SPECIAL MATTER.

PRACTICE.

1. The 14 and 15 sects. of the Act of 1836, prescribes the rules which must govern on the trial of actions, and they are operative so far as they are applicable, notwithstanding the patent may have been granted before the passage of the Act of 1836. *McClurg et al. v. Kingland et al. II. 105.*
2. The defendants cannot put in new rebutting evidence to affidavits offered by the plaintiff in reply to those first offered by the defendants. *Ames v. Howard et al. I. 689.*
3. The bill for an injunction need not be sworn to. *Woodworth et al. in Equity, v. Edwards et al. II. 610.*

See PLEADING.

PRIORITY.

1. He who is first in time has a prior right to the patent. *Lowell v. Lewis, I. 131.*
2. The first inventor who has put the invention into practice, and he only, is entitled to a patent. A subsequent patentee, though an original inventor, may be defeated of his right upon proof of such prior invention put in practice. *Bedford v. Hunt et al. I. 148.*
3. Of Invention.

See ORIGINAL INVENTOR; PRIOR INVENTION.

PRIOR KNOWLEDGE.

See USE.

PRIOR USE,

Or description in a public work anterior to the supposed discovery, will defeat a patent, although such use and description were unknown to the inventor. *Evans v. Eaton*, I. 243.

See NOTICE.

PROOF.

Burden of, on a trial under the general issue under the 10th sec., Act of 1793, is on the plaintiff. *Stearns, in Error, v. Barrett*, I. 97.

PRINCIPLE.

1. Defined, see *Barrett v. Hall*, I. 207, 231.
2. As applied to a machine, is the peculiar structure, or constituent parts. See more on this subject. *Ib.*
3. By the principles of a machine, (as these words are used in the statute,) is not meant the original elementary principles of motion which philosophy and science have discovered, but the *modus operandi*, the peculiar device, or manner of producing any given effect. *Whittemore et al. v. Cutter*, I. 40.
4. The word principle, as applied to mechanics, is where two machines are made to operate substantially in the same way. As where the lever, the screw, the wheel, &c., are used to accomplish certain purposes, the same powers used in a different form to do the same thing will not be a difference in principle. *Roberts et al. v. Ward et al.* II. 746.
5. Distinction between principle and form. Test — ascertain the result to be obtained by the discovery, and whatever is essential to that object, independent of the form and proportions of the thing used for that purpose, may generally, if not universally, be considered as the principles of the invention. *Treadwell et al. v. Bladen*, I. 531.
6. Where two machines are *substantially* the same, and operate in the same manner to produce the same kind of result, they must be in principle the same. *Gray et al. v. James et al.* I. 120.
7. That is called principle in a machine, which applies, modifies, or combines mechanical powers, to produce a certain result. *Smith v. Pearce*, II. 13.
8. Differences in form or proportion only, makes no difference in the principle of machines. *Brooks et al. v. Bicknell et al.* II. 118.
9. If the principle on which the machinery works is the same, and the effect is similar in both, in contemplation of law the machines are identical, a change of position of the operating power, or of the thing, is of no importance. *Ib.*
10. If two machines be substantially the same, and operate in the same manner, to produce the same result, though they differ in form, proportions and utility, they are the same in principle. *Evans v. Eaton*, I. 193.

11. A patent may be obtained for an improvement in the principle of an existing machine. *Ib.*
12. A patent can in no case be for an effect only, but for an effect produced in a given manner, or by a peculiar operation. *Whittemore et al. v. Cutter*, I. 43.
See IMPROVEMENT. *Whitney et al. v. Emmett et al.* I. 567.

PROPORTION.

Suggestions of, made by the mechanic employed to construct the machine, will not defeat the patent. *Pennock et al. v. Dialogue*, I. 466.
See EVIDENCE; PLEADING; GENERAL ISSUE; SPECIFICATION.

PUBLIC SALE.

See PUBLIC USE.

PUBLIC USE,

Or sale, to deprive the inventor of his right to a patent, must be with his knowledge and consent before application therefor. If after the application, and before the grant, it will have no effect. *Ryan et al. v. Goodwin et al.* I. 725.

PUBLIC WORK.

A report of a committee of a Hose Company, although printed, is not such a public work within the meaning of the statute, as will defeat a patent. *Pennock et al. v. Dialogue*, I. 466.

See EVIDENCE.

RE-CONSTRUCTION.

See ASSIGNEE.

RECORD.

1. The Patent Act of 1836 requires the recording of three kinds of assignments: 1st, an assignment of the whole patent; 2d, of any undivided part thereof; 3d, a grant or conveyance of any exclusive right under the patent within any specified part of the U. States. *Brooks v. Byam et al.* II. 161; *Pitts v. Whitman*, II. 189.
2. The recording within three months is merely directory; any subsequent recording will pass the title, except as to intermediate *bonâ fide* purchasers, without notice. *Ib.*
3. License need not be recorded. *Ib.*
4. Of proceedings under a rule to show cause. See *Scire Facias and Ex parte Wood & Brundage*, I. 438.

REISSUE.

- 1, The second patent is to be considered as having relation to the emanation

- of the original patent, and not as having been issued on new application. *Shaw v. Cooper*, I. 643.
2. If a patent has been extended by the Board, and further extended by Act of Congress for seven years, the patent is to be regarded as one for twenty-eight years; and if surrendered for defect in the specification, and a new patent issues, it must be for twenty-eight years. *Woodworth et al.* in Equity, v. *Edwards et al.* II. 610.
 3. When the reissue of a patent surrendered is void, perhaps the surrender itself becomes void, and the original patent remains in force. *Woodworth et al.* v. *Hall et al.* II. 495.
 4. Operates as from the commencement of the original patent, except as to causes of action arising before renewal. *Ib.*
 5. If a reissued patent be void for any cause connected with the acts of public officers, it is questionable whether the original patent must not be considered in force, until its term expires. *Ib.* 495 - 517.
 6. In a reissued patent, the patentee need not claim in the corrected specification all things claimed in the original patent, but may retain whatever he deems proper. *Carver v. Braintree Manuf. Co.* II. 141.
 7. Whether a reissued patent, after surrender of a defective one, is substantially for a different invention, is a question for the jury and not for the Court. *Stimpson v. Westchester R. R. Co.* II. 335.
 8. And it will be presumed to be for the same invention. *Woodworth et al.* v. *Edwards et al.* II. 610; *Allen v. Blunt et al.* II. 288.
 9. And it will be presumed to be for a defect happening from inadvertence or mistake, until the contrary be shown. *Ib.*
 10. The fact of granting the renewed patent closes all inquiry into the existence of inadvertence, accident, and mistake, and leaves only open the question of fraud for the jury. *Stimpson v. Westchester R. R. Co.* II. 335.
 11. The use of an invention, between the date of application originally, and the date of a reissued patent, is not such a use as will entitle the person using to the protection of the 7th section of the Act of 1839. *Ib.*
 12. May be granted by the Board of Commissioners at any time during an extended term, as well as before the expiration of the term for which the original patent was granted. *Wilson v. Rousseau*, II. 372.
 13. The presumption that a reissued patent is for the same invention as the former, and that it was to correct a mistake and inadvertence, may be rebutted by evidence. *Allen v. Blunt et al.* II. 530.

RENEWAL.

1. The patentee being dead, the patent may be renewed on application of the administrator. *Brooks et al. v. Bicknell et al.* II. 118.
2. An assignee of a part of a patent has no interest in the renewal unless the assignment is special, and clearly showing an intention to that effect. *Phillips v. Comstock*, II. 724.
3. An interest in a renewed patent, will not pass by an ordinary assignment, before renewal. *Case v. Redfield et al.* II. 741.

4. But must be specially assigned. *Ib.*
5. It will pass under the words, "for which letters-patent were or may be granted for said improvement." *Ib.*
6. The Board on whose judgment the renewal is granted, may be said to act judicially. Such judgment is not conclusive of the right, but conclusive of certain facts, without which the renewal could not have been granted. *Brooks et al. v. Bicknell et al.* II. 118.

See REISSUE.

REPAIRS.

See ASSIGNEES.

REPAIRS ON A MACHINE.

See ASSIGNEES.

REPEAL OF PATENT.

See FALSE SUGGESTION.

RULE TO SHOW CAUSE.

See SCIRE FACIAS.

SALE,

1. To invalidate a patent, must have been more than two years before the application. *Root v. Ball et al.* II. 513.
2. Of the materials of a patented machine, by a sheriff, on an execution against the owner, is not such a sale as subjects the sheriff to an action for an infringement. *Sawin et al. v. Guild*, I. 47.
3. The sale of the product of a patented machine, is not an infringement. *Boyd v. McAlpin*, II. 277.

SCHEDULE.

See SPECIFICATION.

SCIRE FACIAS,

1. And proceedings thereon, effect of rule to show cause, &c. *Ex parte Wood v. Brundage*, I. 438.
2. Under the 10th section of the Act of 1793, the proceedings to repeal a patent, are in the nature of a *scire facias* at common law. *Stearns*, in *Error v. Barrett*, I. 97.
3. On a judgment rendered in such suit, error lies to the Circuit Court. *Ib.*
4. An order on a rule to show cause why a *scire facias* should not issue to repeal a patent, is merely a preliminary proceeding, and does not determine the question of the validity of a patent. *Delano v. Scott*, I. 700.
5. The United States are not a party to the suit in any sense, to repeal a patent; and the Court will not permit them to be substituted as plaintiff for the petitioner. *Wood v. Williams*, I. 717.

SPECIAL ACTS.

1. Congress may, in their discretion, grant a patent for any length of time, and under whatever circumstances they may determine, and even to act retrospectively, and for an invention already in public use. *Blanchard v. Sprague*, I. 734.
2. For the relief of Oliver Evans, construed. I. 193, 243, 336, 417.

SPECIAL MATTER.

See NOTICE.

SPECIFICATION,

1. Constitutes a part of the patent and they must be construed together. *Hogg et al. v. Emerson*, II. 655.
2. And it is part of the patent so far as it is a description of the machine but no further. *Evans v. Eaton*, I. 68.
3. It need not be set out in the declaration, but if the defendant requires it in his defence he may crave oyer of it and have it placed on the record. *Gray et al. v. James et al.* I. 140; *Cutting et al. v. Myers*, I. 159.
4. The specification for patents extended either by the Board or by act of Congress is the original specification. *Woodworth et al. in Equity v. Edwards et al.* II. 610.

See EVIDENCE; GENERAL ISSUE.

See *Sullivan v. Redfield*, I. 477.

SPECIFICATION—DESCRIPTION.

1. The invention must be truly and fully described in the specification. *Park v. Little et al.* I. 17.
2. And with reasonable certainty or the patent will be void. *Lowell v. Lewis*, I. 131; *Hovey v. Stevens*, II. 479; *Langdon et al. v. De Groot et al.* I. 433.
3. Whether the claim is for a new combination of old parts and things, or a new invention of new parts, if not intelligible as to which, the patent may be void for uncertainty. *Hovey v. Stevens*, II. 479.
4. But a mistake in an expression, proved to be so by other parts of the specification, will not vitiate the patent. *Kneass v. The Schuylkill Bank*, I. 303.
5. And the description may be explained and enlarged by drawings annexed thereto, although they are not referred to. *Washburn et al. v. Gould*, II. 206.
6. And an ambiguity in the description may be explained by affidavit annexed thereto. *Petibone v. Derringer*, I. 152.
7. Need not describe what is in common use and well known. *Kneass v. The Schuylkill Bank*, I. 303.
8. It is not sufficient to invalidate a patent that the specification is materially defective, unless the patentee intended by concealment of parts of the machine to deceive; where practical mechanics are enabled to supply any omissions in the specification such an intention will not be presumed. *Gray et al. v. James et al.* I. 120; *Whittemore v. Cutter*, I. 28.

9. Whether the specification has disclosed the whole truth relative to the invention or discovery is for the jury. *Reutgen v. Kapovors et al.* I. 1.
10. A patentee who uses certain words in the specification of a surrendered patent, which are omitted in the corrected one, are not estopped by the words. *Allen v. Blunt et al.* II. 530.
11. Where the patent has been granted for an improvement on an existing machine the specification must state in full, clear, and exact terms, in what the improvement consists, or the plaintiff cannot recover. *Sullivan v. Redfield*, I. 477; *Evans v. Hettick*, I. 166-417.
12. And it will not be sufficient to show it on the trial by exhibiting the invention. *Dixon v. Moyer*, I. 324.
13. And it must show what the nature of the invention was, upon which the improvement is made. *Isaacs v. Cooper et al.* I. 332.
14. And if of an improvement of a machine it must be so clear as to enable a person skilled in the construction of machines to build one. *Brooks et al. v. Bicknell et al.* II. 118; *Lowell v. Lewis*, I. 131.
15. In describing the improvement of a machine in use and well known it is not necessary to state in detail the structure of the entire and improved machine. It is only necessary to describe the improvement by showing the parts of which it consists, and the effects which it produces. *Brooks et al. v. Bicknell et al.* II. 118.
16. It is not necessary to say whether certain parts should be made of wood or metal. *Ib.*
17. Although an inventor is bound to describe in what his invention consists and what his particular claim is, yet he is not held to any precise form of words, if their import can be clearly ascertained by fair interpretation though the expression may be inaccurate. *Wyeth et al. v. Stone et al.* II. 23.
18. But it must be capable of application by the means pointed out, in the specification, drawing, model, and the old machine. If this be done so as to be intelligible to persons skilled in the subject, it is sufficient. And it is not necessary that the disclosure should be such as to enable the public to use the invention after the patent has expired, as in England. *Whitney et al. v. Emmett et al.* I. 567.
19. And if for a compound it must be in such full, clear, and exact terms, as to enable any one skilled in the art to which it pertains, to compound and use the invention, without making any experiments of his own. *Wood v. Underhill et al.* II. 588.
20. If the patent be for a new composition of matter, and no relative proportion of the ingredients be given, or they are stated so vaguely that no one could use the invention without first ascertaining, by experiment, the exact proportion required to produce the result, it would be the duty of the Court to declare the patent void. *Ib.*
21. But the sufficiency of description in cases where any of the ingredients do not always possess exactly the same properties in the same degree is generally a question of fact for the jury. *Ib.*
22. The specification of a patent for a mode of making brick described the

- process to be to mix pulverized anthracite coal with the clay before moulding it, in certain proportions, varying, however, within defined limits with the quality of the clay used, this was held not to be such vagueness and uncertainty as to justify the Court in declaring the patent void. *Ib.*
23. The Court should have left it to the jury to find upon the evidence of persons skilled in the art, whether the description was clear and exact enough to enable such persons to compound and use the invention. *Ib.*
24. It is not only necessary to describe the thing patented, but to distinguish what part of it, or what combination or what improvement, is new; and this must be done in clear, certain, and intelligible terms, although not required to be in technical language, or with so great accuracy as was formerly exacted, yet it must be with reasonable certainty and clearness. This may be done in the summary, or with that in connection with other parts of the specification, referred to either in terms or by implication, and in such case they are to be taken as a part of the summary for this purpose. *Hovey v. Stevens*, II. 479; *Smith v. Pearce*, II. 13.
25. In this case the summary appeared to claim a traverse motion of a part of the grinder, in combination with a rotary one, so as to bring up the knife to the stone steadily, though spiral in form; on referring to other parts of the specification, it still seemed to be the combination of those two motions, and it was held that such a combination, with the mode of effecting it, was a legal subject of a patent. *Ib.*
26. But it being conceded that this was not original, the plaintiff was not allowed to claim certain parts of the machine which he had not distinguished in any portion of the specification, as the new improvement, or not with reasonable certainty. *Ib.*
27. It is not enough to describe such part, but he must state it to be claimed as new. *Ib.*
28. So if he claims the whole, either in parts or in combination, he must state that distinctly. *Ib.*
29. And if the improvement meant to be claimed as new, is not distinguished from the rest, the only mode of obviating the difficulty is by a new patent on an amended specification. *Ib.*
30. Although the defect may have arisen from inadvertence and not with the design of deceiving the public. *Grant et al. v. Raymond et al.* I. 604.
31. If the patent be for an improvement, the specification should describe the thing in use, that it may be known in what the improvement consists. *Sullivan v. Redfield*, I. 477; *Dixon v. Moyer*, I. 324.
32. It is not sufficient to show it by exhibiting the invention on the trial. *Dixon v. Moyer*, I. 324; *Evans v. Eaton*, I. 336.
33. The merely describing in the specification of the parts of the rolling process and the *modus operandi*, does not make them part of the thing granted. *Kneass v. The Schuylkill Bank*, I. 303.
34. But describing a mode of "communicating motion from the reed to the yard beam," will limit the claim to the particular mode, although the claim in terms embraced more. *Stone v. Sprague et al.* II. 10.

35. When defective description will not vitiate a patent for an improvement
See *Lowell v. Lewis*, I. 131.

See CONCEALMENT.

SPECIFICATION — CLAIM.

1. Must not contain claim of more than the invention; void. *Staley v. Whipple*, II. 1.
2. Must not be of more than the patentee has invented. *Id.*
3. When the specification describes one mode of accomplishing a particular result, but the claim embraces all modes, the patent is void. *Stone v. Sprague et al.* II. 10.
4. For a method of cutting ice by means of an apparatus worked by any other power than human, is void, being a claim for an abstract principle. But a claim for the application of the principle by means of two machines described is good; provided a disclaimer be duly entered as to the former. *Wyeth et al. v. Stone et al.* II. 23.
5. If the patentee claims more than he has invented, the patent is not void, but, under the 9th section of Stat. 3d March, 1837, is good for what he has *bona fide* invented, provided it be definitely described, and distinguishable from the rest of the thing patented. *Peterson et al. v. Wooden*, II. 116.
6. The inventor of a new compound is not limited to the precise ingredients set out; but if the object may be accomplished by the substitution of others that have never been so used, he may extend his claim to them also. *Ryan et al. v. Goodwin et al.* I. 725.
7. Annexed to a reissued patent need not contain a claim for all things that were claimed in the original patent, but the patentee may retain whatever he thinks proper. *Carver v. Braintree Manufacturing Co.* II. 141.

SPECIFICATION. — CONSTRUCTION.

1. Patents are entitled to a liberal construction. *Blanchard v. Sprague*, I. 734.
2. The Courts will give a liberal construction to the language of specifications and will in all cases by taking the whole together, adopt that interpretation which will give the fullest effect to the nature and extent of the claim. *Ryan et al. v. Goodwin et al.* I. 725.
3. Should be construed fairly and liberally and not subjected to any over nice and critical refinements. *Ames v. Howard et al.* I. 689.
4. If the Court can clearly see the nature and extent of the claim however imperfectly and inartificially expressed, the patent is good; but if it cannot be seen without resorting to conjecture, the patent is void. *Id.*
5. It is the duty of the Court rather than the jury to construe the language used in a specification if no parol evidence is offered in explanation, or none which is contradictory. *Davoll et al. v. Brown*, II. 303.
6. The construction should be liberal for the patentees, but the description must be so certain as to be understood by those acquainted with the subject matter. *Id.*

7. But the whole of the specification as well as the summary and drawings are to be looked to in determining the invention. *Ib.*
 8. In coming to a result practical views rather than subtle distinctions must govern. *Ib.*
 9. The word "about" in the specification of Davis's patent for improvement in the mould-board of a plough, rejected for uncertainty. *Davis v. Palmer*, L. 518.
 10. The meaning of technical words of art used in a patent as well as the surrounding circumstances which may materially affect their meaning are to be interpreted by the jury. *Washburn et al. v. Gould*, II. 206.
 11. Of a patent for a saw set, describing it as having a *hammer of iron, with a steel point*, and says nothing of any other material or equivalent, and the evidence was that a hammer, *entirely of steel*, was first tried and abandoned by the patentee, before application for a patent; it was held to be doubtful whether saw sets made by the defendant with hammers *entirely of steel*, was a violation. *Aiken v. Bemis*, II. 644.
 12. Where the plaintiff claimed the "construction and use of an endless apron divided into troughs and cells in a machine for cleaning grain, operating substantially in the way described," It was held that the claim was for a combination of the endless apron with the machine for cleaning grain. *Pitts v. Whitman*, II. 189.
 13. Where the plaintiff, in a patent for "a new and useful improvement in the ribs of the cotton gin," claimed the increasing the space between the upper and lower surface of the rib either "by making the ribs thicker at that part, or by a fork or by any other variation of the particular form," it was held that the claim was sufficiently accurate as matter of law, and it was not necessary to describe all possible modes by which the rib might be varied. *Carver v. Braintree Manufacturing Co.* II. 141.
 14. Where the original patent was for a "new and useful improvement in the ribs of saw gins for ginning cotton," and the reissued patent was for a "new and useful invention in the manner of forming the ribs of saw gins for ginning cotton," and in the reissued patent was claimed, in addition to the thickness of the rib, the sloping up so as to leave no shoulder; it was held that the claim in the reissued patent was not for two distinct improvements, but that the same thing was patented in both patents. *Ib.*
 15. A claim generally for "communicating motion from the reed to the yard beam" will be limited to the particular mode described. *Stone v. Sprague et al.* II. 10.
 16. Woodworth's patent held to be for an improved machine. *Washburn et al. v. Gould*, II. 206.
- FOR CONSTRUCTION OF CLAIM, see *Winans v. Boston and Providence Railroad Co.* II. 136; *Prouty et al. v. Ruggles*, II. 92.

See SPECIFICATION; CLAIM.

STATEMENT OF FACTS.

See WRIT OF ERROR.

STATUTES — CONSTRUCTION OF.

1. To promote the progress of the useful arts is the interest and policy of every enlightened government. The Patent Laws of the United States are founded thereon; the grant of a patent is the reward stipulated for the advantages derived by the public for the exertions of individuals, and is intended as a stimulus to those exertions. These laws ought to be construed in the spirit in which they were made. *Grant et al. v. Raymond et al.* I. 604.
2. The true meaning of the words of the patent law, "not known or used before the application," is not known or used by the public before the application. *Pennock et al. v. Dialogue*, I. 542.
3. The progress of science and the useful arts would be materially retarded if an inventor were permitted to hold back the secret of his invention until the danger of competition should force him to obtain the exclusive right, and would be a premium to those who should be least prompt to communicate their discoveries. *Ib.*
4. Whether Congress can constitutionally decide the fact, that a particular individual is an inventor, so as to preclude judicial inquiry into the originality of the invention — *Quere.* *Evans v. Eaton*, I. 243.
5. The Act for the relief of Oliver Evans does not preclude such inquiry. *Ib.*
6. The provisions of the 6th section of the Act of 21st February, 1793, are intended to declare the defence that shall be available to a party charged by a patentee with a violation of his right. *Delano v. Scott*, I. 700.
7. The provisions of the 10th section of the same act apply only to cases in which a patent has been obtained by fraud, surreptitiously, or by false suggestions, and are intended to protect the public from imposition. *Ib.*
8. Constitutionality.

See DAMAGES; ENGLISH STATUTES.

SURRENDER.

1. A patent, invalid by reason of a defective specification, may be surrendered, and a new patent will be granted upon a corrected specification. *Smith v. Pearce et al.* II. 13.
2. Although the law does not in terms authorize a new patent in the case of a mistake innocently made by the patentee, yet to employ the means necessary to the correction of inadvertent error, by issuing a new patent, and thus give complete effect to its object and intention, cannot be a departure from the spirit and character of the act. *Grant et al. v. Raymond et al.* I. 604.
3. The Circuit Court of the Southern District of New York having decided that under the Act of 1793, a patent might be surrendered for a defect arising from inadvertence and mistake, and a new patent issued, with an amended specification, upon which decision the Department of State had acted in other cases, the Supreme Court declined to disturb the practice arising thereupon, although the question was not free from difficulty. *Ib.*
4. In such case the new patent has relation back to the emanation of the first, and the application may be considered as appended to the original application. *Grant et al. v. Raymond et al.* I. 604; *Shaw v. Cooper*, I. 643.

5. The second patent being a continuation of the first, the rights of the patentee must be ascertained by the law under which the original application was made. *Shaw v. Cooper*, I. 643.
6. Although a patent reissued, operates as from the commencement of the original patent, it cannot affect causes of action arising before reissue. *Woodworth et al. v. Hall et al.* II. 495 - 517.
7. Where the renewal of a patent surrendered is void, perhaps the surrender itself becomes also void, and the original patent remains in force. *Ib.*
8. By patentee will not affect the rights of assignees, unless they consent to the surrender. *Woodworth et al. v. Stone*, II. 296.
See *Morris v. Huntington*, I. 448.

SURPRISE.

1. It is the practice to postpone or continue the cause in all cases of surprise at the trial, when clearly made out, if moved for. *Ames v. Howard et al.* I. 689.

See PRACTICE.

2. But if the party elects to go on without motion for postponement or continuance, relying upon other matters, he is understood to waive the surprise, and if unsuccessful with the jury, cannot have a new trial on this ground. *Ib.*

TERMS — CONSTRUCTION OF.

1. The words, "not known or used before the application," mean "not known or used by the public before the application." *Pennock et al. v. Dialogue*, I. 542.
2. The words, "any newly invented machine, manufacture, or composition of matter," in the 7th section of the Act of 1839, have the same meaning as "invention," or "thing patented." *McClurg et al. v. Kingsland et al.* II. 105.

TECHNICAL OBJECTIONS.

To letters-patent are not to be encouraged, or construed liberally for him making them. *Woodworth et al. v. Hall et al.* II. 495.

TECHNICAL TERMS.

To be interpreted by the jury. *Washburn et al. v. Gould*, II. 206.

TREBLE DAMAGES.

The jury will find the actual damages, which the Court will treble. *Gray et al. v. James et al.* I. 120.

UNCERTAINTY.

In the description of the thing invented, will avoid a patent. *Hovey v. Stevens*, II. 479.

USE.

1. The use, by the public, of an invention, before application for a patent, will avoid the patent. *Shaw v. Cooper*, I. 643.
2. The true construction of the law is, that the first inventor cannot acquire a good title to a patent if he suffers the invention to go into use, or to be publically sold for use, before he makes application for a patent. *Pennock et al. v. Dialogue*, I. 542.
3. What use by the public is considered sufficient for this purpose. *Shaw v. Cooper*, I. 643.
4. Such use, to defeat the patent, must be by the permission of the inventor, before he obtains a patent, without claim or notice of an intention. *Pennock et al. v. Dialogue*, I. 466-542.
5. But if the knowledge on the part of the public be acquired through a person who surreptitiously obtained it, the right of the inventor will not be affected thereby; and no presumption of abandonment can arise under such circumstances, although an acquiescence in such use will lay the foundation for such presumption; and his right will only be secured by giving public notice that he was the inventor, and of his intention to apply for a patent; otherwise his acquiescence will be an abandonment. *Shaw v. Cooper*, I. 643.
6. There can be no presumption of acquiescence where the inventor has no knowledge of the use. But this knowledge may be presumed from circumstances. This will be a fact for the jury. If the inventor do not immediately after this notice assert his right it is lost forever. *Ib.*
7. No presumption of abandonment arises by a use after the grant of the patent, however long continued. *Ib.*
8. A strict construction of the Act of Congress, as it regards the public use, is not only required by its letter and spirit, but also by sound policy. *Ib.*
9. It is not sufficient to prove, in order to defeat the plaintiff's patent, that the principle of his invention was known before, but it is necessary to prove also that it was in use. *Pennock et al. v. Dialogue*, I. 466-542.
10. The terms, "not known or used by others before his or their discovery thereof," merely indicates that the use should be by some other person or persons than the patentee. *Reed v. Cutter et al.* II. 81.
11. The first section of the Act of 1793, construed in connection with the other sections, means that the invention should not be known or used as the invention of any other person than the patentee, before the application. *Morris v. Huntington*, I. 448.
12. If a person knowing of an invention, proceeds to put it in use, the inventor not having secured his right by patent, the latter ought not to be permitted to take away that which was previously lawfully made. *Ib.*
13. But if he was practising his invention with a view of improving it, he ought not to be prejudiced thereby. *Ib.*
14. But the intent of delay to take out a patent should always be submitted to a jury, and whether allowing it to be used shall not be considered an abandonment. *Ib.*
15. The use of a machine as an experiment to test its value, is a using within

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- the meaning of the 6th section of the Patent Act, and will defeat a patent for a subsequent invention. *Watson v. Bladen*, I. 510.
16. It is unimportant whether the experiment or use of the thing invented and patented, was first made by the inventor or by any other person. *Pennock et al. v. Dialogue*, I. 466 - 542.
17. It is a good defence to a bill for injunction, that prior to the granting of the patent, the inventor allowed the invention to go into public use, without objection. *Wyeth et al. v. Stone et al.* II. 23.
18. But should be clearly proved that such use was with his knowledge and consent. *Ib.*
19. A mere use, either by himself for experiment, or by his neighbors as an indulgence for temporary purposes, will not defeat his right. *Ib.*
20. The prior knowledge and use of an invention which will avoid a patent, relates to the time of the application, and not the discovery. But such use must be with the privity of the patentee, and not private, in fraud of the patent. *Whitney et al. v. Emmet et al.* I. 567.
21. If the application is made within a reasonable time after discovery, no intermediate use will affect the patent. *Ib.*
22. An unmolested and notorious use of the invention prior to the application, gives the user the right to continue it after the granting of the patent, without liability, under the 7th section of the Act of 1839. *McClurg et al. v. Kingland et al.* II. 105.
23. The use of an invention before the application for a patent, to entitle it to the protection of the 7th section of the Act of 1839, must be with the knowledge and consent of the patentee. *Pearson v. The Eagle Screw Co.* II. 268.
24. The use of a machine constructed by another, before the application for a patent, will not be protected by the 7th section of the Act of 1839, if copied from the patentee's invention, without his consent. *Hovey v. Stevens*, II. 479.
25. The 7th section of the Act of 1839, refers to use before the original application. *Stimpson v. Westchester R. Road*, II. 335.
26. The use of an invention between the date of the original application for a patent and the date of a reissued patent, will not defeat the action. *Ib.*
27. The use of an invention between the date of the original application, and the date of the application for a surrender and reissue, is not such a use as will entitle the person using to the protection of the 7th section of the Act of 1839. *Ib.*
28. To defeat a subsequent patent, it is not necessary to prove that the same thing had been previously in general use. Any actual use, however limited, is sufficient. *Bedford v. Hunt et al.* I. 148.
29. If the defendant makes the patented article, but no user shown, the plaintiff will be entitled to nominal damages. *Whitemore v. Cutter*, I. 28.
30. Of the patented article for years anterior to the patent, does not invalidate it, if the patentee was the original inventor. [*Quere.*] *Goodyear v. Matthews*, I. 50.
31. The intention of an inventor to use an improvement, in the machine pa-

tented by him, not expressed in or pointed out by his specification, nor used with his invention, will not invalidate the patent of a subsequent inventor of the same improvement. *Treadwell et al. v. Bladen*, I. 531.

See INVENTOR; NOTICE.

General Use. See ABANDONMENT.

Public Use. See ABANDONMENT.

USEFUL.

See UTILITY.

UTILITY.

1. An invention must be useful or the patent will be void. *Langdon v. DeGroot et al.* I. 433.
2. It must be of some utility. *Stanley v. Whipple*, II. 1.
3. The meaning of the word useful, under the Act of Congress, explained. *Kneass v. The Schuylkill Bank*, I. 303; *Whitney et al. v. Emmett et al.* I. 567.
4. By useful is meant not an invention in all cases superior to the modes then in use, but useful in contradistinction to frivolous and mischievous. *Lewis v. Lewis*, I. 131.
5. An invention is useful that may be applied to some beneficial purpose, in contradistinction to that which is injurious to the moral health or good order of society. *Bedford v. Hunt et al.* I. 148.
6. It need not be of such general utility as to supersede other inventions in practice to accomplish the same purpose. *Ib.*
7. Whether the invention is useful, is to be decided by the jury. *Park v. Little et al.* I. 17.
8. Whether it be a question of fact for the jury or of law for the Court, (*quere.*) But if on the plaintiff, on showing it to be useless, the Court will so direct the jury. *Langdon v. DeGroot et al.* I. 433.
9. An invention of an ornamental mode of putting up thread, which gave it no additional value, is not useful within the meaning of the statute. *Ib.*
10. The want of utility may be good cause for not granting a patent, but not for setting it aside. *Whitney et al. v. Emmett et al.* I. 567.

VERDICT.

1. Repugnant or uncertain in a material point is void. *Stevens*, in error, v. *Barrett*, I. 97.
2. The refusal of a Court to amend a verdict, cannot be assigned for error. *Ib.*
3. Will cure the omission to state, in case of an assignment, that the assignment has been duly recorded. *Dobson v. Campbell*, I. 681.
4. Where a fact must necessarily have been proved at the trial to justify the verdict, and the declaration omits to state it, the defect is cured by verdict, if the general terms of the declaration are sufficient to comprehend the proof. *Ib.*

See EVIDENCE.

VOIR DIRE.

See WITNESS.

WITNESSES.

1. The Patent Act contemplates two classes of persons as peculiarly appropriate witnesses in Patent Cases: 1st. Practical mechanics, to determine the sufficiency of the specification as to the mode of constructing and using the patent. 2d. Scientific mechanics, to determine whether the patented thing is new in its structure and mode of operation, or a mere change of equivalents. *Allen v. Blunt et al.* II. 530.
2. Interest in a witness short of that which would exclude him, on the ground of incompetency, how far it should weigh. *Evans v. Hettick*, I. 166, 417.
3. A witness who uses a machine resembling that of the plaintiff, is not an incompetent witness for the defendant. *Evans v. Eaton*, I. 68.
4. A prior patentee of an invention alleged to be the same in principle with the plaintiff, is a competent witness to prove the priority of his invention. *Treadwell et al. v. Bladen*, I. 531.
5. A person having an interest only in the question, and not in the event of the suit, is a competent witness. *Evans v. Eaton*, I. 336.
6. Is not incompetent because he is sued in another action for an infringement of the same patent. *Evans v. Hettick*, I. 166.
7. Who had in use a machine like the defendant's, and who, with other persons, had been sued in similar actions, and who had agreed to contribute to a common fund, to defray the expenses of witnesses, but not any part of the damages and costs, had not such an interest in the cause as to render him incompetent to testify for defendant. *Ib.* 166 - 417.
8. If sworn on the *voir dire*, no other evidence to prove him incompetent can be given. *Evans v. Eaton*, I. 68.
9. But if it should afterwards appear in any part of his examination that he was incompetent, his testimony will be set aside. *Ib.*
10. The Court will not permit the plaintiff to put a question to a witness, called by him to rebut the defendant's testimony, which is not intended to contradict or discredit the defendant's witnesses, and which is not rendered necessary by defendant's testimony. *Ib.*
11. Nor though counsel profess that it is for that object, if the Court think it cannot have that effect. *Ib.*
12. Names of the witnesses to prove a prior knowledge and use of the thing patented, need not be given in the notice required by the 15th section of the Act of 1836. *Wilton v. The Railroads*, II. 641.
13. May be asked generally if he knew of a use of the improvement by any person, prior to the application of the patentee, although there be persons named in the notice of special matter as having knowledge of a use. *Treadwell et al. v. Bladen*, I. 531.
14. Allowed to testify as to declarations of the patentee, at a particular time, that he had made an invention then described. *Evans v. Hettick*, I. 166.

15. Cannot be asked if J. S. (not the defendant) had applied to the plaintiff for license to use his improved hopper-boy, and had offered to pay for it, it not being proved that J. S. had a hopper-boy of any kind. *Ib.*
16. Cannot be asked a collateral question, barely to test his credibility. *Odiome v. Winkley*, I. 52.
17. A party has no right to cross-examine any witness except to facts and circumstances connected with the matters stated in the direct examination. *The P. & T. Railroad Co. v. Stimson*, II. 46.
18. If he wishes to examine him on other matters, he must do so by making the witness his own, and calling him as such in a subsequent progress of the cause. *Ib.*
19. Affidavit of a single witness not sufficient to outweigh the oath of the patentee, on question of originality of invention, or a bill for an injunction. *Woodworth v. Sherman*, II. 257.
20. It is no objection to the competency or credibility of a witness that he is subject to fits of derangement if he is sane at the time of giving his testimony. *Evans v. Hettick*, I. 417.

See DEPOSITION.

Examination of. See EVIDENCE.

WORDS.

Construction of. See TERMS.

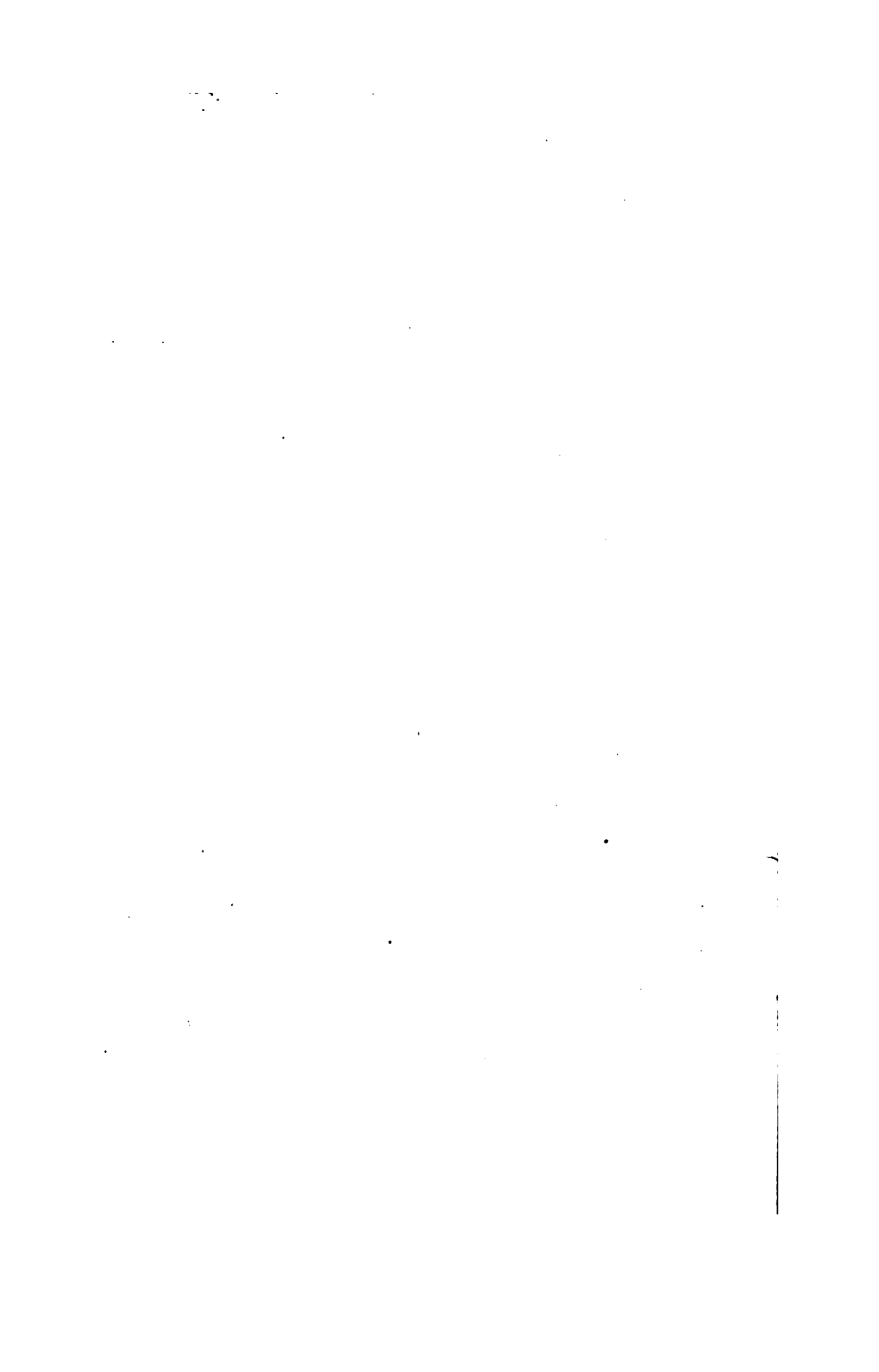
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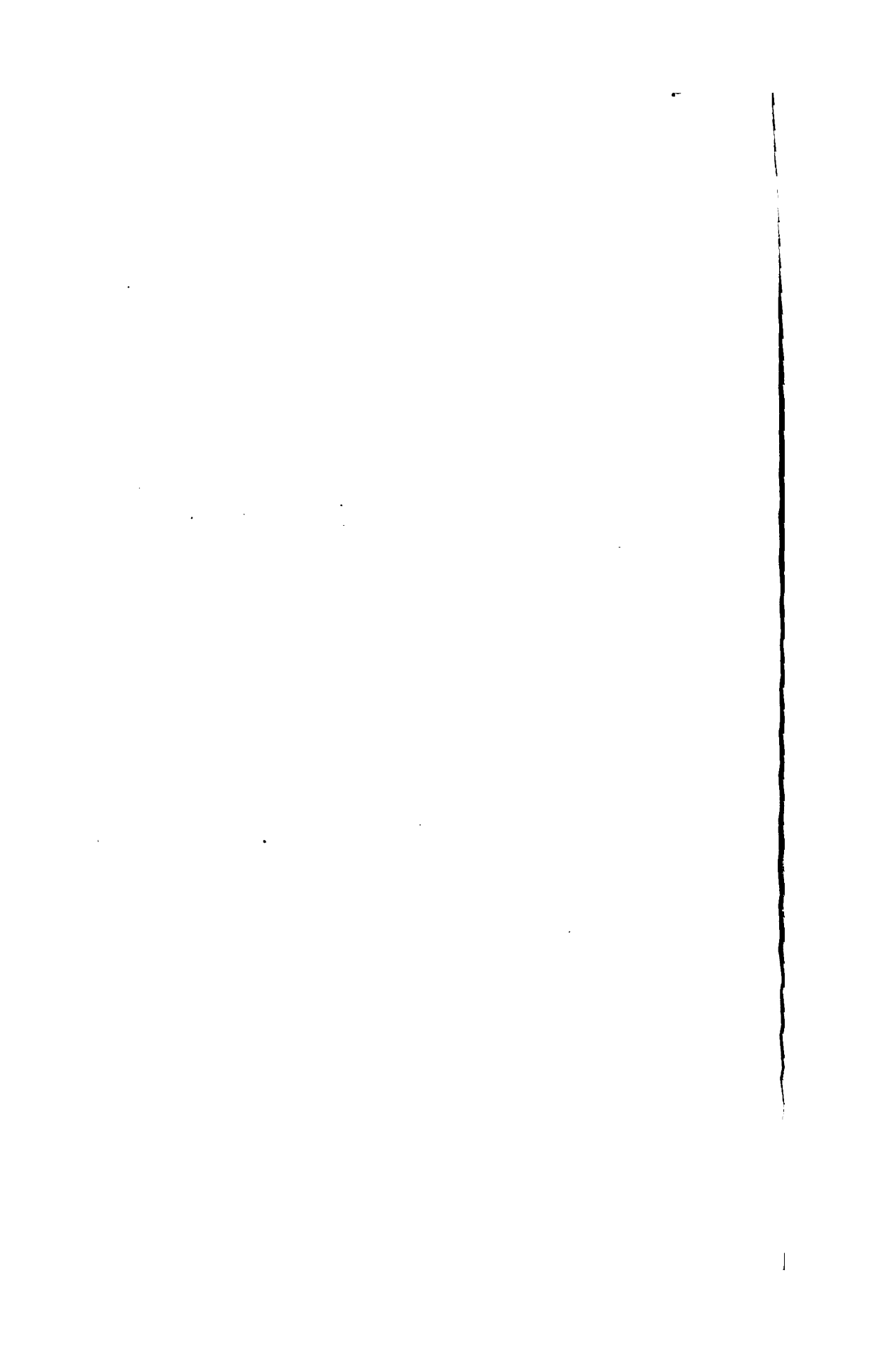
Employed by parties infringing the patent, to make parts of the patented article, not liable. *Delano v. Scott*, I. 700.

WRIT OF ERROR.

1. Will lie from Circuit Court to review judgment in *scire facias*. *Sterns*, in error, *v. Barrett*, I. 97.
2. When a case is sent to the Supreme Court, under the discretion conferred upon the Court below by the 17th sec. of the Act of 1836, the whole case must go up, and not such points as the Court may single out only. *Hogg et al. v. Emerson*, II. 655.

See BILL OF EXCEPTIONS; INSTRUCTIONS.





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