

THE
PATENT LAWS
OF
ALL NATIONS:

COMPILED AND ANNOTATED

BY

BENJAMIN VAUGHAN ABBOTT.

VOL. II.

UNITED STATES—WURTEMBERG.
INTERNATIONAL CONVENTION.

WASHINGTON:
CHARLES R. BRODIX, LAW PUBLISHER.

1886.

YALE LAW LIBRARY.

FLG
Ab 26
v. 2

~~COMPAR. LAW~~

Entered according to act of Congress, in the year 1886,
By BENJAMIN VAUGHAN ABBOTT,
In the office of the Librarian of Congress at Washington.

HENRY M. TOBITT
PRINTER,
42 DEY STREET, N. Y.

T. H. Flood.
2 v. \$ 500

TABLE OF CONTENTS.

UNITED STATES.

I. CONSTITUTIONAL AND GENERAL PRINCIPLES.

The constitutional grant of power, page 1. Extent of the power granted, 1. Its limitations and exceptions, 2. History of the Acts of Congress, 3. Construction of Acts of Congress, 5. Nature of a patent right, 6. No right reserved to government, 7. Powers of State Legislatures, 9. Analogous decisions relative to copyright, 9. Relative to trade-marks, 10.

II. THE PATENT OFFICE.

Authority of the secretary of the interior, page 11. Establishment of the patent-office. Seal, 13. Officers and employes. Salaries. Bonds, 13. Restrictions upon officers and employes, 14. Duties of commissioner, 15. Acting commissioner, 16. Duties of examiners in chief, 17. Establishment of regulations, 18. Arrangement and exhibition of models, &c. Disposal, 18. Library, 19. Correspondence with the office, 19. Patent agents and attorneys, 21. Printing of papers. Engraving, &c. Distribution and sale, 23. Certified copies, &c., to be evidence, 25. Copies of foreign letters patent, 27. Printed copies of specifications and drawings of patents, 27. Annual report of the commissioner, 27.

III. AUTHORITY FOR ISSUING PATENTS.

How issued, attested and recorded, page 28. Contents and duration, 29. Embracing two inventions in a single patent, 29. Issuing several patents for one invention, 30. Or for distinct parts of the same invention, 31. Joint inventors and patents, 32. Date of patent, 33. Delivery, 33. Correction of errors, 34. Suit by United States to annul patent fraudulently obtained, 34.

IV. WHO MAY OBTAIN PATENTS; AND FOR WHAT.

The general statutory definition, page 36. What constitutes inventing, 36. Who is a "person who has invented," &c., 37. This question, between employer and workman, 38. Mere change in materials, form, &c., not enough, 39. Discovery of a principle, law, or fact, 42. Discoveries of "processes," 44. Patentability of effects and products, 46. Machines, 47. Compositions, 49. Improvements, 50. Combinations, 52. Various specific objections to patenting them, 52. How patents for combinations should be issued, 54. Rule that the invention must be "new," 55. Rule that it must be "useful," 56. The completeness or

perfection necessary, 58. "Not known or used by others," &c., 59. Not patented, or described in any printed publication, 59. Public use or sale, 61. Abandonment, 62. Patents for inventions previously patented abroad, 63. Limiting term by that of any foreign patent, 63.

V. APPLICATION AND ISSUE.

Requisites of application, description, specification, and claim, page 66. General requisites of description or specification, 68. Description, in the case of machines, 71. In the case of improvements, 72. Of compositions of matter, 74. Of combinations, 74. The claim, 75. Amendment of application, 77. Drawings when requisite, 77. Office rules as to drawings, 80. Specimens of ingredients, &c., 83. Model, when requisite, 83. Oath required from applicant, 83. Examination, and issuing patent, 85. Limitation upon time of completing applications, 87. Abandoned, forfeited, and renewed applications, 87. Applications renewed after withdrawal, 89. Patents granted to assignee, 90. When and on what oath, executor or administrator may claim patent, 92. Renewal of application in cases of failure to pay fees in season, 93.

VI. ASSIGNMENTS, LICENSES AND OTHER CONTRACTS.

Assignments of patents, page 94. Parties to assignments, 95. Requisites and sufficiency, 97. Validity, 97. What property or interest passes, 99. Rights of the parties in other respects, 101. Illustrative cases determining rights under particular assignments, 103. Recording, 106. What is a license, 108. Presumption or proof of a license, 109. Construction, 111. Validity and obligations, 114. Estoppel, arising from a license, 115. Rights created by license, 118. Assignments of licenses. Sub-license, 119. Right of patentee to sue licensee, for royalties, 121. Right of a patentee or licensee to sue infringers, 125. Revocation or forfeiture, 126. Federal and State jurisdiction over contracts involving patents, 128. Construction and effect of such contracts, 129. In particular cases, 130. Persons purchasing of inventor, before application, may use or sell the thing purchased, 135. Sales and purchases of patented articles, 136. Territorial limits of buyer's right, 139. His right, how limited by term of patent, 140.

VII. MARKING ARTICLES "PATENTED." FALSE MARKING.

Patented articles must be marked as such, page 141. Penalty for falsely marking or labeling as "patented," 142.

VIII. CAVEATS.

Filing and effect of caveats, page 145. Requisites and sufficiency, 148.

IX. REJECTIONS AND INTERFERENCES. MOTIONS. TESTIMONY.

Notice of rejection of claim for patent to be given to applicant, page 149. Statement of reasons and references, 151. Interferences, 152. What constitutes an interference, 152. When declared, 153. When refused, 154. Examiner of interferences. Notices. Disclaimer, 155. Preliminary statements, 156. Presumptions and evidence, 158. Motions and incidental practice, 159. Prin-

CONTENTS.

v

principles of decision, 161. Effect of commissioner's decision, 162. Affidavits and depositions, 163. Subpœnas to witnesses, 168. Witness fees, 169. Penalty for failing to attend, or refusing to testify, 168.

X. APPEALS. BILL IN EQUITY.

Appeals from primary examiners to examiners in chief, page 169. From examiners in chief to commissioner, 171. From the commissioner to the supreme court District of Columbia, 172. Notice of and proceedings on such appeals, 176. Determination of such appeal, and its effect, 176. Patents obtained by bill in equity, 177.

XI. SURRENDER AND REISSUE.

Reissue of defective patents, page 179. General nature, scope and extent of the right of reissue, 180. Surrender, how made, and its effect, 181. Loss of the right by delay, 182. Who may surrender for reissue; rights of assignees, 183. The application for a reissue, 184. The hearing, 186. Powers and duties of the commissioner, 187. What defects in a patent warrant a reissue, 188. What changes may be made by a reissue, 189. Dividing a patent by reissue, 191. The invention must not be enlarged, 192. Illustrations, 194. Scope and limits of the above rule, 196. Effect of the commissioner's decision; presumptions, 198. Validity of reissued patents, 200. Reissued patents void in part only, 202. Grounds on which they may be adjudged void, 202. Construction and effect of reissued patents, 203.

XII. DISCLAIMERS. INTERFERENCE SUITS.

Disclaimers authorized, page 206. Nature and uses of a disclaimer, 207. Effect, 210. Neglect or delay in filing, 211. Suits touching interfering patents, 213.

XIII. INFRINGEMENT.

Nature of the right which must not be infringed, page 214. Its scope and extent, 217. How long it endures, 219. General rules for construction of patents, 220. Of specifications, 224. Claims, 225. Drawings, models, &c., 227. Referring to application, &c., 228. Consulting experts on questions of construction, 229. Application of rules of construction in peculiar cases, 231. What constitutes infringement, generally, 233. Motive, 237. Identity of devices, 238. Identity in principle, sufficient, 242. What is the "principle" of a machine, 244. Formal changes, 245. Nature and measure of the protection accorded to patented process or product, 247. Protection accorded to an improvement of a device already patented, 249. To a combination, 251. To a composition of matter, 259. The doctrine of equivalents, in general, 260. Application of the doctrine of equivalents to combinations, 262. To compositions of matter, 264. Rights of purchaser of a specific article from the patentee or his licensee, 265. Rights of a purchaser from an infringer, 268. What has been held to be or not to be infringement in peculiar cases, 269.

XIV. JURISDICTION OF COURTS OVER INFRINGEMENTS.

Distinction between the legal and the equitable remedy, page 272
 Original jurisdiction of circuit courts, 273. Their jurisdiction does not embrace suits to enforce licenses, 274. Or other contracts, 276. Jurisdiction of the supreme court of the District of Columbia, 277. Jurisdiction of the court of claims, 278. Appellate jurisdiction of Supreme Court, 278. It is not dependent on amount in controversy, 278. Exclusive jurisdiction of courts of the United States, 279.

XV. RIGHT OF ACTION AT LAW FOR DAMAGES.

Suits for infringement; damages, page 280. Limitation of time for bringing an action, 280. Nature of the remedy by action at law, 281. Right of action of patentee, 282. Of joint, or deceased patentee, 283. Of assignee, 284. Licensee, 287. Who may or should be sued, 288. Cases involving corporations, 290.

XVI. GROUNDS OF DEFENSE.

Interest of the public in inventions and patents, page 292. Fraud, 293. Estoppel, 294. Former adjudication, 297. That the device does not involve invention, 299. But only mechanical skill, 300. Novelty in the invention lacking, 301. Utility lacking, 302. Typical cases illustrating application of the rules requiring invention, novelty, utility, &c., 303. Cases of patents sustained against objections of want of invention, novelty, utility, &c., 311. Irregularities or defects in the patent or the proceedings to obtain it, 314. Disputing plaintiff's title to the invention, 318. Defenses allowable under general issue and notice, by Rev. Stat. § 4920 (Act of 1836, § 15), 319). *First*: fraudulent defect, or excess in specification, 320. *Second*: patent surreptitiously or unjustly obtained, 321. *Third*: prior patent, or published description, 323. *Fourth*: patentee not first inventor, 326. *Fifth*: anticipation of invention by one earlier. Priority of competitors, 330. Examples of anticipation and priority, 332. Public use or sale before application, 333. What constitutes a public use, 334. Limits and exceptions to the rule restricting public use, 336. Effect of placing invention on sale, 337. Decisions illustrating the doctrine as to public use or sale, 338. The invention had been abandoned to the public, 339. By delay in applying for patent or in prosecuting the application, 342. Examples of abandonment under peculiar circumstances, 345. Failure to mark the article "patented," 349. Matters of defense peculiar to reissue patents, 349. Various excuses for the infringement charged, 351.

XVII. MEASURE OF RECOVERY OF DAMAGES OR PROFITS, FOR INFRINGEMENT.

Compensation for actual injury; the general rule, page 352. Exemplary or punitive damages not allowable, 356. Referring to license fees, royalties, &c., to fix damages, 357. Damages awarded in peculiar cases, 359. Trebling the damages, 361. Right to

recover profits, 362. How profits are ascertained or estimated, 367. What awards of profits have been made under special circumstances, 370. Effect of recovery and payment of damages, 373. Statutory recovery of damages, in equity, 374. Interest, 377. Allowance for counsel fees and other expenses, 378.

XVIII. REMEDY BY INJUNCTION.

Power of United States courts to grant injunctions and estimate damages, page 379. General nature of the jurisdiction to enjoin, 379. Various relief obtainable in equity, 382. Suit to annul a patent on the ground of interference, 384. Necessity of establishing plaintiff's title by action at law, before resorting to equity, 386. Or of showing long possession and public acquiescence, 387. Effect of expiration of patent on the jurisdiction of equity, 389. Effect of expiration, in particular instances, 391. Effect of abandonment, acquiescence or delay on the jurisdiction, 394. Effect of delay, &c., in particular instances, 395. Proper persons to be complainants in a suit in equity, 396. Proper persons to be made defendants, 399. In what cases agents, contractors, laborers, corporate officers, may be sued, 400. The right to a preliminary injunction in general, 402. The application ; how made and how heard and determined, 404. Necessity of first establishing plaintiff's title at law, 407. Or by long public acquiescence, 410. Equitable reasons for granting a preliminary injunction on the merits, 411. Preliminary injunction granted under special circumstances, 412. Equitable reasons for refusing a preliminary injunction on the merits, 414. Refusal of preliminary injunction under special circumstances, 416. Granting or refusing injunction upon terms as to security, &c., 420. Dissolution or suspension of preliminary injunctions, 423. Operation and effect of preliminary injunctions in patent cases, 426. Violation of injunction in patent cases, 427. Proceedings to punish for a violation, 428. Enjoining prosecution of suits for infringement, 430.

XIX. PLEADINGS ; AT LAW OR IN EQUITY.

Declaration at law, for infringement, page 431. Plea, or answer, at law, 433. Necessity and uses of notice additional to the general issue, 433. Requisites and sufficiency of such notice, 436. Reception of evidence under it, 437. Bill in equity for infringement, 437. Multifariousness in such bills, 439. What faults in such bills may be reached by demurrer, 444. Plea or answer in equity, 443. Amended, supplemental or cross bill, 446. Amended or supplemental answer, 447.

XX. EVIDENCE.

Judicial notice, page 449. Presumptions, 449. Burden of proof, 455. General rules of evidence as to the construction and validity of the patent, 458. Rules of evidence as to matters connected with reissues, 462. Evidence as to plaintiff's title to the patent, or to the damages, 463. As to the charge of infringement, 464. As to matters of affirmative defense, 465. As to amount of damages

	and profits, 466. Declarations of inventor, 467. Testimony of ordinary witnesses, 467. Experts, 468. Evidence with reference to particular pleadings, 469.
XXI.	MATTERS OF PRACTICE, INCIDENTAL TO PATENT SUITS.
	Abatement of suit, page 471. Compulsory disclosure, 471. Motions, 472. Trial, 473. Hearing and rehearing, 474. Jury trial in equity, 475. Reference to ascertain damages or profits, 476. Costs, 477. Costs as affected by disclaimer, 478. Decrees, 479.
XXII.	CASES OF SPECIFICATION TOO BROAD, OR PRIOR FOREIGN INVENTION.
	Suit for infringement where specification is too broad, page 480. Patent not void on account of previous use in foreign country, 481.
XXIII.	EXTENSIONS.
	The former law granting and regulating extensions, page 483.
XXIV.	PATENTS FOR DESIGNS.
	Patents for designs authorized, page 483. Practice in the patent-office as to design patents, 483. What designs are patentable, 484. Validity of design patents, 487. Infringement of design patents, 488. Damages, or profits, for such infringement, 489. Additional provisions as to design patents, 489. Duration of patents for designs, 491. Extension of patents for designs, 491. Patents for designs subject to general rules of patent law, 491. Copyright of designs, 492. Registration of prints or labels, 492.
XXV.	FEES AND CHARGES.
	Fees in obtaining patents, page 493. Exemption of government officers from payment of fees, 495. Mode of payment, 495. Refunding, 496.
	FORMS..... 496
URUGUAY.....	516
	Law of November 13, 1885.
VENEZUELA.....	524
	Law of May 25, 1882.
VICTORIA.....	528
	Act of May 9, 1865.
VIRGIN ISLANDS.	See LEEWARD ISLANDS.
WALES.	See GREAT BRITAIN AND IRELAND.
WESTERN AUSTRALIA.....	559
	Act No. 1 of August 15, 1872.
	See also AUSTRALIA.
WURTEMBERG.	See GERMAN EMPIRE.
INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.....	567
APPENDIX OF RECENT LAWS.....	573
	Argentine Republic, Ecuador, Natal, Orange Free State, Peru, Tasmania.
INDEX.	

TABLE OF CASES

CITED IN THE NOTES TO LAWS OF THE UNITED STATES.

[The references are to pages of the second volume.]

- ABBETT v. Lusi, 105
Abbott v. Hoole Manuf. &c. Co., 258
Adair v. Trayer, 256
Adams v. Bellaire Stamping Co., 286
 v. Bridgewater Iron Co., 237, 300
 v. Burke, 98, 99, 140, 266
 v. Edwards, 56, 57, 335, 346
 v. Howard, 120, 447
 v. Joliet Manuf. Co., 263
 v. Jones, 344, 347
 v. Loft, 306
 v. Meyrose, 126
Adams & Westlake Manuf. Co. v.
 Rathbone, 312, 457, 458
 v. St. Louis Wire Goods Co., 486
 v. Wilson Packing Co., 309
Adjustable Window Screen Co. v.
 Boughton, 76, 192
Agawam Co. v. Jordon, 37, 38, 216,
 317, 321, 342
Aiken, *Re*, 86, 173
 v. Bemis, 246, 251
 v. Dolan, 212, 213
 v. Manchester Print Works, 277
Albastine Co. v. Payne, 265, 290
 v. Richardson, 269
Albright v. Texas, 121
Alcott v. Young, 307
Alden v. Dewey, 239, 243, 249, 450,
 460, 468
Alden Evaporating Fruit Co. v.
 Bowen, 308
Alger v. Murray, 96
Allen v. Blunt, 87, 186, 189, 200, 204,
 274, 297, 318, 328, 361, 364,
 378, 380, 450, 456, 469, 472
 v. Brooklyn, 292
 v. Deacon, 142
 v. Hunter, 26, 59, 146, 221, 225,
 265, 322, 323, 327, 469
 v. New York, 292
Allis v. Stowell, 234, 269, 407, 431
Alteneck, *Re*, 61
American Ballast Log Co. v. Cotter, 274
American Bell Telephone Co. v. Dol-
 bear, 42, 43, 46
 v. National Improved Telephone
 Co., 299
 v. People's Telephone Co., 232,
 466
 v. Spencer, 45, 255, 479
American Carpet Lining Co. v. Beale,
 405
American Cotton Tie Supply Co. v.
 Bullard, 113, 268
 v. McCready, 381, 401
American Cotton Tie Co. v. Simmons,
 139, 268
American Diamond Rock Boring Co.
 v. Rutland Marble Co., 390

- American Diamond Rock Boring Co.**
 v. Sheldon, 64, 141, 220, 474
 v. Sullivan Machine Co., 234, 404
 v. Sutherland Falls Marble Co.,
 220, 255
American Hide & Leather Co. v.
 American Tool & Machine
 Co., 58, 63, 99, 335, 347, 435,
 456
American Iron Co. v. Anglo American
 Roofing Co., 307
American Middlings Purifier Co. v.
 Atlantic Milling Co., 450, 455
 v. Christian, 274, 315, 423, 454
American Nicholson Pavement Co. v.
 Elizabeth, 197, 198, 360, 406
American Pin Co. v. Oakville Co., 40,
 69, 245
American S. Co. v. Emerson, 367
American Saddle Co. v. Hogg, 470
American Shoe Tip Co. v. National
 Shoe Toe Tip Protecting Co.,
 210, 409
American Telephone Co. v. Nat. Imp.
 Tel. Co., 408
Ames v. Howard, 41, 215, 221, 224, 238
Andrews v. Carman, 329, 336
 v. Creegan, 464
 v. Cross, 71
 v. Fielding, 103
 v. Hovey, 336
 v. Wright, 199
Anthony v. Carroll, 280, 281
Arkell, Matter of, 41, 305
Armstrong v. Hanlenbeck, 109, 126, 413
Armus v. Alden, 247
Arnheim v. Fiuster, 419
Arnold v. Bishop, 32, 168, 271, 319
Aron v. Manhattan R. Co., 216
Asbestos Felting Co. v. United States,
 &c. Felting Co., 282, 430
Ashcroft v. Walworth, 96, 106
Asmus v. Alden, 295, 314
Atlantic Giant Powder Co. v. Good-
 year, 197, 263
 v. Hulings, 223, 243
 v. Mowbray, 265
 v. Parker, 335
Atlantic Works v. Brady, 36, 470
Atterbury v. Gill, 289
Attorney-General v. Rumford Chemi-
 cal Works, 6, 34, 215
Atwater Manuf. Co. v. Beecher
 Manuf. Co., 193
Atwood v. Portland Co., 190
Aultman v. Holley, 133
Averill Chemical Paint Co. v. Na-
 tional Mixed Paint Co., 192
Avery v. Wilson, 382
Ayling v. Hull, 346

BABCOCK v. Degener, 175, 242
 v. Northern Pacific R. Co., 135
Badische, Anilin, &c. Fabrik v. Coch-
 ranc, 83
 v. Hamilton Manuf. Co., 63, 65,
 192, 248
 v. Higgins, 192
Bailey Wringing Machine Co. v.
 Adams, 406
Bain v. Morse, 31, 46, 162, 217
Baker v. Taylor, 33
Baker Manuf. Co. v. Washburn, &c.
 Manuf. Co., 124
Baldwin v. Bernard, 235
 v. Sibley, 97, 119, 137, 464
Ball v. Langlees, 192
Ballou Shoe Machine Co. v. Dizer, 418
Baltimore Car Wheel Co. v. North
 Baltimore Passenger, R. Co.,
 182, 295
Bancroft v. Acton, 375, 378
Banker v. Bostwick, 229
Bantz v. Elsas, 200
Barker v. Stowe, 101
 v. Woodruff, 318
Barnard v. Gibson, 427
Barney v. Peck, 439
Barrett v. Hall, 30, 32, 40, 53, 55, 73,
 76, 251
Barry v. Crane Brothers Manuf. Co.,
 39, 121, 309
 v. Gugenheim, 315
Barrow-Giles Lithographic Co. v.
 Sarony, 10
Bartholomew v. Sawyer, 59, 62, 323

- Bassett v. Malone, 425
 Bate Refrigerating Co. v. Eastman,
 270
 v. Gillett, 64, 65, 429, 482
 Batten v. Stillman, 406
 Bates v. Coe, 343, 434
 Battin v. Taggart, 189, 199, 205, 337
 Bean v. Smallwood, 40
 Beane v. Orr, 406
 Becker v. Hastings, 228
 Bedford v. Burton, 194
 v. Hunt, 55, 57, 222
 Beecher Manuf. Co. v. Atwater
 Manuf. Co., 304
 Belding v. Turner, 118
 Bell v. Daniels, 146, 347
 v. McCullough, 98, 126, 361
 v. United States Stamping Co.,
 312
 Belt v. Crittenden, 307
 Bennett v. Fowler, 30, 465
 Bensley v. North-Western Horse Nail
 Co., 296
 Berdan Fire Arms Manuf. Co. v.
 Remington, 39, 216
 Bevin v. East Hampton Bell Co., 343,
 347, 473
 Bicknell v. Todd, 99, 139, 283
 Bigelow v. Louisville, 124, 287
 Bigelow Carpet Co. v. Dobson, 366,
 490
 Bignall v. Harvey, 201
 Birdsall v. Hagerstown Agricultural
 Implement Manuf. Co., 283,
 406, 429, 430
 v. McDonald, 54, 200, 336, 344,
 353, 459
 v. Perego, 117, 122
 Birdseye v. Heilner, 433
 Bischoff v. Wethered, 231, 468
 Bishop, *Re*, 310
 Black v. Hubbard, 131
 v. Munson, 355, 363
 v. Thorne, 353, 359, 371
 Blackwell v. Armistead, 411
 Blades v. Rand, McNally & Co., 283,
 296
 Blaisdell v. Dows, 409
 Blaisdell v. Puffer, 351
 Blake v. Boisselier, 417, 428
 v. Greenwood Cemetery, 111, 372,
 374, 416
 v. Rawson, 263, 346, 458
 v. Robertson, 353
 v. San Francisco, 57, 292
 v. Sperry, 41, 53, 73
 v. Stafford, 199
 Blanchard v. Beers, 240, 245, 468
 v. Eldridge, 95, 284
 v. Haynes, 2
 v. Putman, 434, 464
 v. Sprague, 2, 6, 42, 110, 215, 221,
 275
 v. Whitney, 140
 Blanchard Gun-Stock Turning Fac-
 tory v. Warner, 2, 40, 378
 Bland, *Exp.*, 64, 154
 Blandy v. Griffith, 417
 Blank v. Manufacturing Co., 380
 Blatherwick v. Carey, 117
 Bliss v. Brooklyn, 255, 292
 Bloomer v. Gilpin, 102, 238, 351
 v. McQuewan, 3, 5, 128, 129,
 140
 v. Millinger, 140, 266, 276
 v. Stolley, 2, 204, 221, 266
 Boemer v. Simm, 324
 Bogart v. Hinds, 287, 443
 Boland v. Thompson, 182
 Booth v. Garely, 416, 487
 v. Seever, 373
 Bostock v. Goodrich, 356, 467
 Boston Elastic Fabrics Co. v. East
 Hampton Rubber Thread
 Co., 330
 Boston Manuf. Co. v. Fiske, 378
 Boughton, *Re*, 314
 Bowker v. Dows, 234, 313
 Boyd v. Brown, 277
 v. McAlpine, 107, 380
 Boyden v. Burke, 22, 23, 27
 Bradley v. Dull, 95, 223
 Bradley & Hubbard Manuf. Co. v.
 Charles Parker Co., 75, 402
 Brady v. Atlantic Works, 7, 9, 369,
 370, 377, 452, 477

- Bragg v. City of Stockton, 272, 434, 437
- Brainard v. Evening Post Assoc., 305
- Brammer v. Jones, 125, 404
- Brandon Manuf. Co. v. Prime, 447
- Brewster & Co. v. Parry, 415
- Brick v. Staten Island, 443
- Brickill v. New York City, 136, 291
- Bridgeport Wood Finishing Co. v. Hooper, 248
- Broaduax v. Central Stock-Yard & Co., 59, 201, 351
- Brodie v. Ophir Silver Mining Co., 327, 362, 452
- Brosnahan, *Re*, 215, 218
- Brooks v. Bicknell, 3, 72, 73, 93, 96, 183, 243, 251, 284, 408, 456, 457, 475
- v. Byam, 95, 107, 120
- v. Fiske, 201, 251
- v. Jenkins, 5, 26, 27, 93, 96, 244, 456, 457
- Brooks v. Moorehouse, 297
- v. Norcross, 474
- v. Stolley, 115, 126, 277, 411
- Brown v. Davis, 263
- v. Deere, 313, 424, 425
- v. Duchesse, 3, 5, 6, 213, 215
- v. District of Columbia, 138
- v. Guild, 239, 300, 316, 343
- v. Hall, 86
- v. Herrick, 175
- v. Hinkley, 389
- v. Lapham, 295, 410
- v. Piper, 36, 434, 435, 449
- v. Shannon, 278, 279
- v. Whittemore, 302
- Brush v. Condit, 190, 479
- v. Naugatuck R. Co., 333
- Bryce v. Dorr, 289
- Buchanan v. Howland, 386
- Buck v. Cobb, 288, 409
- v. Hermance, 40, 53, 297, 355
- v. McGill, 403
- Buckley v. Sawyer Manuf. Co., 134
- Buerk v. Valentine, 331, 482
- v. Imhaeser, 356, 360, 371, 375, 426, 454
- Bullock Printing Press Co. v. Jones, 341, 413
- Bunker v. Stevens, 135, 271
- Burdell v. Denig, 125, 352, 353
- v. Comstock, 376, 380, 390
- Burden v. Corning, 239, 260, 261, 315,
- Burdett v. Esty, 33, 365, 376, 377, 428, 429
- Burdsall v. Coolidge, 358
- v. Curran, 271
- Burleigh Rock Drill Co. v. Lobdell, 410
- Burlew v. O'Neil, 161, 173
- Burns v. Meyer, 226
- v. United States, 7
- Burr v. Duryea, 42, 111, 115, 118, 189
- v. Gregory, 128, 273, 277
- Burrows v. Wetherill, 315
- Burton v. Greenville, 335
- Bussey v. Excelsior Manuf. Co., 123, 358
- v. Wager, 52, 221
- Butler v. Shaw, 179
- v. Steckel, 300
- v. Watkins, 293
- Butterworth v. Hill, 274
- v. Hoe, 12, 13, 86, 179
- Buzzell v. Andrews, 231
- Byam v. Eddy, 259
- v. Farr, 264
- CAHART v. Austin, 187, 198
- Cahill v. Brown, 325
- Cahn v. Wong Town On, 54
- Cahoon v. Ring, 239, 449, 475
- Calais Steamboat Co. v. Scudder, 456
- California Artificial Stone Paving Co. v. Perine, 217
- Calkins v. Bertrand, 364, 366, 368, 477, 478
- v. Oskosh Carriage Co., 301
- Cammeyer v. Newton, 124
- Campbell v. Barclay, 354
- v. James, 8, 95, 97, 100, 288, 362, 439, 462
- v. Kavanaugh, 236
- v. Mayor, 336

- Campbell v. New York, 336, 339, 462
 Canan v. Pound Manuf. Co., 64, 483
 Cantrell v. Wallick, 243, 251, 457
 Carew v. Boston Elastic Fabric Co.,
 183, 187, 189, 192, 204, 221,
 222, 375, 476
 Carhart v. Austin, 168
 Carlton v. Bokee, 70
 Carnrick v. McKesson, 445
 Carr v. Rice, 56, 57
 Carstaedt v. United States Corset Co.,
 429
 Carter v. Carter, 174, 239, 459
 Cartridge Co. v. Cartridge Co., 208
 Carver v. Braintree Manuf. Co., 40,
 46, 71, 75, 222
 Cary v. Domestic Spring Bed Co., 241,
 311, 410
 v. Lovell Manuf. Co., 241, 311
 v. Wolff, 241, 311
 Case v. Brown, 225
 v. Redfield, 103, 107, 432
 Castle v. Hutchinson, 9, 129
 Castor Co. v. Crossman, 129
 Cawood Patent, 367
 Celluloid Manuf. Co. v. Chrolithion
 Collar, &c. Co., 241, 409
 v. Comstock & Cheney Co., 269,
 300, 301, 473
 v. Crofut, 349
 v. Goodyear Dental Vulcanite Co.,
 152, 218, 383
 v. Pratt, 269
 v. Zylonite Brush & Comb Co.,
 350, 356
 Chabat v. American Button-hole, &c.
 Co., 110
 Chaffee v. Boston Belting Co., 128,
 129, 265, 464
 v. Hayward, 274
 Chambers v. Smith, 107, 285
 Chandler v. Ladd, 312, 327
 Chase v. Wesson, 413
 Chicago Fruit House Co. v. Busch,
 200
 Child v. Boston, &c. Iron Works, 51,
 374
 Christman v. Rumsey, 190
 Clark v. Bousfield, 485
 v. Scott, 104, 445
 v. Pomace Holder Co. v. Fer-
 guson, 53, 335
 Clarke v. Cramer, 158
 v. Johnson, 261
 Clarke's Patent Steam, &c. Co. v.
 Copeland, 56, 449
 Cleveland v. Towle, 254
 Clum v. Brewer, 26, 397, 412
 Coburn v. Schroeder, 60, 372
 Cochrane v. Deener, 45, 277, 386
 v. Waterman, 147, 310
 Coffeen v. Brunton, 50
 Cohn v. National Rubber Co., 116
 v. United States Corset Co., 60
 Colburn v. Van Velzer, 98
 Cole, *Re*, 175
 Colgate v. Compagnie Francaise du
 Telegraphe, 402
 v. Gold & Stock Telegraph Co.,
 407, 427
 v. International Ocean Tel. Co.,
 124, 414
 v. Law Tel. Co., 253
 v. Western Union Tel. Co., 89, 90,
 427
 Collar Co. v. Van Deusen, 301, 318
 Collender v. Came, 229
 v. Griffith, 31, 488, 489, 492
 Collignon v. Hayes, 395
 Collins v. Feebles, 281
 Colt v. Massachusetts Arms Co., 249,
 314, 331
 v. Young, 16, 409
 Combined Patents Can Co. v. Mc-
 Dowell, 196
 Commercial Manuf. Co. v. Fairbank
 Canning Co., 248, 295, 326,
 482
 Commissioner of Patents v. Whiteley,
 5, 183, 185, 187, 199
 Comstock v. Sandusky Seat Co., 452
 Concord v. Norton, 407, 430
 Cone v. Morgan Envelope Co., 306,
 485
 Conklin, *Re*, 174, 186, 198, 341, 347
 Conover v. Dohrman, 351

- Conover v. Mers, 365
 v. Ronch, 262, 299
 Consolidated Electric Light Co. v.
 Brush-Swan Electric Light
 Co., 440
 v. Edison Electric Light Co., 92
 Consolidated Fruit Jar Co. v. Bellaire
 Stamping Co., 292, 319, 342,
 345
 v. Dorflinger, 11, 219
 v. Whitney, 118, 277, 333, 337, 346
 Consolidated Middlings Purifier Co.
 v. Guildler, 117
 Consolidated O. W. P. Co. v. Eaton,
 286
 Consolidated Safety Valve Co., v.
 Ashton Valve Co., 391, 420
 Continental Store Service Co. v. Clark,
 279
 v. New York Service Co., 420
 Continental Windmill Co. v. Empire
 Windmill Co., 107, 110
 Converse v. Cannon, 253
 Conway v. Rumsey, 473
 Cook v. Bidwell, 127
 v. Ernest, 382
 Cooledge v. McCone, 294
 Cooper v. Matthews, 288, 396, 406, 472
 Corbin, *Re*, 314
 Cornely v. Marckwald, 478
 Cornell v. Downer, &c. Brewing Co.,
 189, 228, 250
 v. Hyatt, 174
 Cornely v. Marckwald, 59, 61, 63
 Corning v. Burden, 26, 44, 230, 450
 Corvallis Fruit Co. v. Curran, 450
 Cote v. Moffit, 202
 Cottle v. Krementz, 287
 Cottier v. Stimson, 433, 434
 Coupe v. Weatherhead, 49, 50, 240, 462
 Couse v. Johnson, 41, 227, 307
 Covert v. Curtis, 413
 Cowing v. Rumsey, 272, 354, 360, 362
 Cox v. Griggs, 449
 Craig v. Fisher, 288
 Crandall v. Piano Manuf. Co., 122,
 384
 v. Watters, 41
 Cressler v. Custer, 91
 Crompton v. Belknap Mills, 84, 190
 v. Knowles, 453
 Croker, *Re*, 173, 176
 Cross v. Livermore, 415
 Crouch v. Roemer, 40
 v. Speer, 57, 451, 452
 Curran v. Burdsall, 102
 v. Craig, 119
 Cushman, *Re*, 33, 86, 187, 311
 Cutting v. Fulton, 432
 v. Myers, 481
 DALTON v. Jennings, 306
 v. Nelson, 300, 313
 Damon v. Eastwick, 39, 216
 Dane v. Chicago Manuf. Co., 459
 v. Illinois Manuf. Co., 310
 Dare v. Boylston, 126
 Davidson v. Lewis, 327
 Davis, *Re*, 76
 v. Fredericks, 42, 336
 v. Palmer, 40, 73, 221, 246
 v. Smith, 390
 Davis Improved Wrought-iron Wagon-
 Wheel Co. v. Davis Wrought-
 iron Wagon Co., 102
 Davoll v. Brown, 68, 221, 224
 Day v. Candee, 95
 v. Combination Rubber Co., 223
 v. Hartshorn, 121, 387
 v. New England Car Spring Co.,
 98, 405, 434
 v. Newark India Rubber Manuf.
 Co., 274
 v. Union Rubber Co., 138
 v. Woodworth, 360
 Dayton v. Wright, 102
 Dean v. Mason, 370, 397
 Dedrick v. Cassell, 194, 199, 262
 Dederick v. Whitman Agricultural
 Co., 97
 Deering v. Winona Harvester Works,
 472
 De Florez v. Reynolds, 63, 64, 318,
 351, 426, 448
 Delano v. Scott, 26, 289, 328
 Delaware Coal Co. v. Packer, 75, 256

- Dennis v. Cross, 235
v. United States, 278
- Densmore v. Schofield, 257
- Dental Vulcanite Co. v. Wetherbee, 187, 204
- Deplanque v. Ripka, 466
- Detmold v. Reeves, 37, 43, 70, 225
- Detroit Lubricator Manuf. Co. v. Renchard, 329
- Deweiler v. Voegel, 138
- De Ver Warner v. Bassett, 408
- Devoll v. Brown, 37, 40, 53
- Dibble v. Augur, 233
- Dick v. Struthers, 96, 390, 393, 399
- Dittmar v. Rix, 235, 248
- Dixon v. Moyer, 239, 245, 437
- Dobson v. Dorman, 487, 488, 490
v. Hartford Carpet Co., 487, 490
- Dodge v. Card, 417
- Doherty v. Haynes, 56, 200, 303, 456
- Donoghe v. Hubbard, 258, 452, 466
- Dorlan v. Guie, 420, 465
- Dorsey Harvester Rake Co. v. Marsh, 17
- Dorsey, &c. Rake Co. v. Bradley Manuf. Co., 99, 119, 218, 396
- Double Pointed Tack Co. v. Mann, 42, 52
v. Two Rivers Manuf. Co., 52
- Doubleday v. Beatty, 462
- Doughty v. West, 28, 317, 386, 408
- Dounton v. Allis, 134
- Downton v. Yaeger Milling Co., 58, 60, 286, 323
- Doyle v. Spaulding, 324
- Drake v. Cunningham, 175
- Draper v. Potomska Mills Corp., 37, 58, 190, 459
v. Wattles, 196, 337, 454
- Dreyfus v. Schneider, 457, 489
- Driven Well Cases, 193
- Drummond v. Venable, 310
- Dryfoos v. Friedman, 489
v. Wiese, 192, 202
- Duff v. Calkins, 212
- Duffy v. Reynolds, 136
- Duke v. Graham, 32, 135, 284
- Dunbar v. White, 187, 190, 192, 449
- Dunham v. Indianapolis & St. Louis R. R. Co., 115
- Dunks v. Grey, 427
- Dyer v. National Hod Elevating Co., 251
- EACHUS v. Broomall, 190
- Eagleton Manuf. Co. v. West, &c. Manuf. Co., 85, 456, 457
- Eames v. Godfrey, 251, 331, 460
- Earl v. Dexter, 445
- Earle v. Sawyer, 53, 56, 229, 355
- Earth Closet Co. v. Fenner, 405, 416
- East Hartford v. Hartford Bridge Co., 290
- Eastman v. Bodfish, 470
- Eclipse Woodmill Co. v. Woodmanse Windmill Co., 119
- Edgerton v. Breck, 396
v. Furst, &c. Manuf. Co., 192
- Edison v. Edison, 12
- Egbert v. Lippman, 333, 334, 335, 336, 339
- Elastic Fabrics Co. v. Smith, 212
- Electric R. R. Signal Co. v. Hall R. Signal Co., 239, 327
- Elizabeth v. Pavement Co., 62, 323, 324, 333, 335, 338, 366, 400, 451, 455
- Ellithorpe v. Robertson, 37, 67, 150, 327, 329
- Elm City Co. v. Wooster, 351
- Ely v. Monson, &c. Manuf. Co., 464
- Emerson v. Hogg, 25, 30, 73, 78, 224, 229, 235, 459
v. Simm, 357, 438
- Emery v. Cavanagh, 336
- Emigh v. Baltimore & O. R. R. Co., 357
v. Chamberlain, 401
v. Chicago, Burlington, &c. R.R. Co., 113
- Emmons v. Sladdin, 103, 105
- England v. Thompson, 114
- Eppinger v. Richey, 50
- Estabrook v. Noyes, 226
- Eureka Co. v. Bailey Co., 115
- Evans v. Eaton, 2, 5, 9, 41, 42, 50, 53,

- 57, 59, 68, 76, 117, 217, 223,
224, 330, 342, 351, 464
v. Hettich, 73, 434, 435, 461
v. Jordan, 328
v. Kelly, 227, 406
v. Kremer, 435
v. Robinson, 2
v. Weiss, 238, 327, 328
Everest v. Buffalo Lubricating Oil
Co., 462
Everett v. Thatcher, 471
Everson, *Re*, 310
Evory v. Burt, 240
v. Candee, 117, 418
- FAIRBANKS v. Jacobus, 11, 219, 393
Farley v. National Steam-Gauge Co.,
159
Farrington v. Gregory, 107
Faulks v. Kamp, 101
Fay v. Allen, 252, 328
v. Fraser, 197
Fetter v. Newhall, 96, 228, 240
Field v. De Conneau, 269
Filley v. Child, 392
v. Littlefield, 249
Fischer v. Hayes, 438, 457, 466, 480
v. Neil, 454
Fisher v. Consolidated Amador Mine
Co., 299, 384
v. Shaughnessy, 477
Fisk v. Hollander, 91, 228
Fitch v. Bragg, 360, 369, 465
Flint v. Roberts, 237
Florence Sewing Machine Co. v.
Singer Manuf. Co., 123, 383
Florsheim v. Schilling, 310
Flower v. Detroit, 348
v. Rayner, 198
Foote v. Frost, 15
v. Silsby, 313, 326, 357
Forbes v. Barstow Stove Co., 186
Forbush v. Bradford, 405, 421
Fornecrook v. Root, 308
Forschner v. Baumgarten, 309
Foster v. Crossin, 410, 487
v. Goldschmidt, 114, 124
v. Lindsay, 214, 385
Foster v. Moore, 236, 249, 252, 388, 421
Foss v. Hubert, 236
Foye v. Nichols, 249
Fraim v. Keen, 294
Francis v. Mellor, 457
Frankfort Whiskey Process Co. v.
Pepper, 397
Franklin B. Hunt, 12
French v. Foley, 144
French v. Rogers, 63, 315
Frink v. Petry, 314
Fry v. Quinlan, 392
Fuller, Seutzer, 252
Fultz, *Re*, 173, 302
Furbush v. Cook, 37, 40, 54, 56, 301,
314, 325, 458
- GAGE v. Herring, 194, 202
v. Kellogg, 30
Gamewell Fire Alarm Co. v. Brook-
lyn, 108, 125
Gamewell Fire Alarm Tel. Co. v.
Chillicothe, 439
Gardiner v. Howe, 3
Garretson v. Clark, 353, 366, 368, 455
Gay v. Cornell, 86, 91, 107
Gayler v. Wilder, 98, 100, 108, 282,
284, 324
Gear v. Fitch, 107, 465
v. Grosvenor, 116, 321, 449
v. Holmes, 103, 419
Giant Powder Co. v. California Vig-
orit Powder Co., 188, 198
v. Safety Nitro Powder Co., 181,
188, 449
Gibbs v. Ellithorp, 485
v. Hoefner, 119
Gibson v. Barnard, 411
v. Betts, 405
v. Cook, 456
v. Harris, 181, 381
v. Van Dresar, 421
Gilbert v. Weir Plow Co., 54
Gilbert, &c. Manuf. Co. v. Bussing,
422
Gilbert Manuf. Co. v. Walworth
Manuf. Co., 52
Gill v. Wells, 68, 74, 193

- Gillespie v. Cummings, 439, 440
 Globe Nail Co. v. Superior Nail Co.,
 251, 317, 483
 Gloucester Isinglass, &c. Co. v.
 Brooks, 318
 Glue Co. v. Upton, 301, 304, 349
 Goddard v. Wilde, 411
 Godfrey v. Eames, 89
 Goff v. Stafford, 63, 64
 Goldsmith v. American Paper Collar
 Co., 283
 Gold & Stock Tel. Co. v. Commercial
 Tel. Co., 66, 270
 Gold, &c. Separating Co. v. United
 States Disintegrating Ore Co.,
 152
 Gold, &c. Telegraph Co. v. Wiley,
 185, 190
 Goodwin v. Randolph, 231
 Goodyear v. Allyn, 142, 457
 v. Berry, 198
 v. Beverly Rubber Co., 137
 v. Bishop, 287
 v. Bourn, 425
 v. Cary, 103
 v. Chaffee, 414, 416
 v. Congress Rubber Co., 120, 399
 v. Day, 276, 326, 386
 v. Dunbar, 403
 v. Gloucester Manuf. Co., 386
 v. Hulihan, 273, 379
 v. Honsinger, 394
 v. New Jersey Central Railroad,
 138
 v. McBurney, 125
 v. Phelps, 400
 v. Providence Rubber Co., 119,
 398, 444
 v. Railroad, 50, 72, 221, 222, 224,
 249, 268
 v. Toby, 443
 v. Union India Rubber Co., 275
 Goodyear Dental Vulcanite Co. v.
 Brightwell, 271
 v. Folsom, 407
 v. Gardner, 147, 221, 230, 451
 v. Root, 300
 v. Smith, 201, 343
 Goodyear v. Van Antwerp, 354, 375
 v. Willis, 300
 Gordon v. Anthony, 96, 282
 v. St. Paul Harvester Works, 441
 Gorham v. Mixer, 245, 249, 251
 Gorham Manuf. Co. v. White, 485,
 489
 Gorrel v. Dickson, 96
 Gottfreid v. Crescent Brewing Co.,
 307, 466
 v. Miller, 111
 v. Moerlein, 380, 390
 v. Philip Best Brewing Co., 32,
 51, 118, 323, 326, 454, 466
 Gould v. Commissioner of Patents,
 54, 310
 v. Rees, 254, 262
 v. Spicers, 202, 252
 Gould's Manuf. Co. v. Cowing, 355,
 359, 363
 Gower, *Exp.*, 173
 Graham v. Gammon, 37
 v. Geneva Lake Crawford Manuf.
 Co., 31, 80, 123, 337, 398
 v. McCormick, 62, 334
 v. Mason, 324, 364, 365, 444, 445,
 448
 v. Teter, 179
 Gramme Electric Co. v. Arnoux, 65
 Gramme Electrical Co. v. Hoch-
 hausen Electric Co., 482
 Grant v. Mason, 42, 228, 244
 v. Raymond, 5, 69, 204, 221
 Gray v. James, 50, 52, 69, 244, 249,
 251, 321, 431
 Greeley, *Re*, 51
 Green v. French, 415
 v. Gardner, 414
 Greenleaf v. Yale Lock Manuf. Co.,
 359
 Greenough v. Clark, 173
 Greenwood v. Bracher, 214, 385
 Grier v. Castle, 71, 217, 242
 Grover & Baker Sewing Machine Co.
 v. Sloat, 287
 v. Williams, 407
 Guidet v. Barber, 200, 312, 445
 v. Palmer, 334, 410, 453

- Gunn v. Savage, 420
 Gutta-percha Co. v. Goodyear Co.,
 389, 406
 Guyon v. Serrell, 361
- HABEMAN v. Whitman, 263
 Hailes v. Albany Stove Co., 210
 v. Van Wormer, 53
 Hale v. Stimson, 294
 Hall v. Bird, 346
 v. Speer, 106, 389
 v. Stern, 235, 363
 v. Wiles, 40, 50, 51, 53, 209, 213,
 355, 356, 361, 362
 Halsey, *Re*, 217, 330
 Hamilton v. Ives, 229
 v. Kingsbury, 105, 108, 112
 v. Rollins, 286
 v. Simson, 427
 Hammacher v. Wilson, 1, 123, 126
 Hammerschlag v. Garrett, 248, 273
 v. Scamoni, 222
 Hammond v. Hunt, 100, 125, 287
 Hancock Inspirator Co. v. Jenks, 76,
 318
 v. Lally, 310
 Hanford v. Westcott, 158
 Hapgood v. Hewitt, 216
 v. Rosenstock, 101, 411
 Harris v. Allen, 253
 Hartell v. Tilghman, 121, 276
 Hartford Woven Wire-Mattress Co. v.
 Peerless Wire-Mattress Co.,
 247
 Hartshorn v. Eagle Shade Roller Co.,
 84, 185
 v. Shorey, 250
 Haseldean v. Ogden, 227, 234
 Haskell v. Shoe Machinery Manuf.
 Co. 26, 451
 Hatch v. Adams, 140
 v. Hall, 101
 v. Moffit, 76, 210
 Hatchman, *Re*, 188
 Hathaway v. Roach, 378
 Haussknecht v. Claypool, 467
 Havemeyer v. Bonnell, 202, 309
 v. Randall, 201, 202, 309
- Haven v. Brown, 438
 Hawes v. Antisdell, 462
 v. Cook, 312
 v. Gaze, 312
 v. Washburne, 238, 312, 359
 Hawley v. Mitchell, 140
 Hawlowetz v. Kass, 144
 Hayden v. Oriental Mills, 280, 281
 Hayes v. Bickelhaupt, 298, 439, 469,
 479
 v. Dayton, 439, 440
 v. Leton, 417
 Hays v. Sulsor, 56, 57, 60, 443
 Hayward v. Andrews, 125, 390, 398
 v. St. Louis, 280
 Heald v. Rice, 462
 Heath v. Hildreth, 145, 150, 314, 327
 Heaton v. Quintard, 289
 Hebbard, *Re*, 314
 Heinrich v. Luther, 26, 41, 229, 236
 Heller v. Bauer, 248
 Helm v. First Nat. Bank, 130
 Henderson v. Cleveland Co-operative
 Stove Co., 221, 227, 241
 Hendy v. Golden State, &c., Iron
 Works, 190
 Henry, *Re*, 243, 245, 319
 v. Francetown Soapstone Stove
 Co., 149, 337, 342
 v. Providence Tool Co., 65, 335
 Herbert v. Adams, 90, 100
 Herring v. Gage, 349, 366, 370, 372
 v. Gas Consumers' Assoc., 289,
 360
 v. Nelson, 190
 Hewett v. Penn. Steel Co., 394
 Hicks v. Ferdinand, 474
 v. Kelsey, 40, 300, 303
 v. Otto, 448, 472
 Hide & Leather Co. v. American
 Tool Co., 456
 Hill v. Biddle, 300, 461
 v. Commissioner of Patents, 149,
 258, 330, 350
 v. Dunklee, 210, 216
 v. Houghton, 486
 v. Whitcomb, 94, 272, 276, 396
 Hitchcock v. Tremaine, 474

- Hobbie v. Smith, 249, 266, 267, 286,
 303, 356, 433, 462
 Hodge v. Hudson River R. R. Co.,
 403, 432
 v. North Missouri R. R. Co., 95,
 283, 397, 441
 Hoe v. Boston Daily Advertiser
 Corp., 418, 423
 v. Cottrell, 54, 318, 456
 v. Kahler, 319
 v. Knap, 258, 350, 424
 Hoff v. Iron-Clad Manuf. Co., 237
 Hoffheins v. Brant, 237, 386
 Hoffman v. Stiefel, 47
 v. Young, 52, 54
 Hogg v. Emerson, 30, 68, 85, 220,
 221, 224, 228, 229, 357, 358
 Holbrook v. Small, 240, 306, 377, 378
 Holliday v. Covel, 261
 v. Matheson, 140
 v. Pickhardt, 454
 Hollister v. Benedict Manuf. Co., 8,
 57
 Holly v. Vergennes Machine Co., 238,
 256
 Holmes Electric Protective Co. v.
 Metropolitan Burglar Alarm
 Co., 65, 482
 Holt v. Kendall, 225
 Hood v. Boston Car Co., 60
 Hopgood v. Hewitt, 109
 Hopkins v. Barnum, 175
 Hopkins, &c. Manuf. Co. v. Corbin,
 255
 Horman Pat. Manuf. Co. v. Brooklyn
 City R. R. Co., 441
 Hotchkiss v. Greenwood, 26, 37, 49,
 300
 Houghton v. Jones, 97
 House v. Young, 199
 Hovey v. Henry, 53, 252, 340, 456
 v. Stevens, 41, 53, 71, 73, 305,
 322, 388, 408
 Howe v. Abbott, 41, 46, 47, 244, 251,
 305
 v. Morton, 59, 249
 v. Neemes, 252
 v. Newton, 453
- B**
- Howe v. Underwood, 37
 Howe Machine Co. v. National
 Needle Co., 308
 Howes v. McNeal, 249, 347, 460
 v. Nute, 78, 229, 249, 445
 Hoyt v. Slocum, 264
 Hubbell v. United States, 125
 Hubel v. Tucker, 163
 Hudson v. Draper, 272, 451, 455
 Huggins v. Hubby, 50, 227, 252
 Hull v. Commissioner of Patents, 16
 Hunt v. Howe, 150, 161, 335
 Hussey v. Bradley, 181, 186, 199, 399,
 478
 v. Whitely, 449, 450
 Hussey Manuf. Co. v. Deering, 411
 Hutchinson v. Everett, 386
- ILLINGWORTH v. Spaulding, 402
 Illinois Central R. R. Co. v. Turrill,
 377, 471
 Imhaeuser v. Burke, 262
 Imlay v. Norwich & Worcester R. R.
 Co., 221, 239, 244
 Ingalls v. Tice, 276, 285
 Ingels v. Mast, 257, 363
 Ingersoll v. Jewett, 117
 v. Musgrove, 463, 476
 Innis v. Oil City Boiler Works, 62
 136
 International Tooth Crown Co. v.
 Mills, 420
 Iowa Barb Steel Wire Co., *Matter of*,
 472
 Irwin v. Dane, 405, 406
 v. McRoberts, 408, 411
 Isaacs v. Abrams, 50
 v. Cooper, 402, 404, 408, 417, 438
 Ives v. Hamilton, 453
 v. Sargent, 182
- JACKSON, *Re*, 310
 v. Breck, 476
 James v. Campbell, 7, 31, 192, 194
 v. Sargent, 12
 v. Vankirk, 142
 Janney, *Re*, 173
 Jencks v. Langdon, 454

- Jenkins v. Greenwald, 99, 139, 286,
380, 404
v. Walker, 74
Jenks v. Swift, 232
Jennings v. Kibbe, 241, 489
Jensen v. Keasby, 60
Jewett, *Re*, 174
Jillson v. Winsor, 173
Johnson v. Beard, 294
v. Fassman, 331, 341, 348
v. Root, 147, 236, 239, 260, 261,
465
v. United States, 278
Johnston v. McCullough, 220
Jones v. Barker, 196, 335
v. McMurray, 204
v. Morehead, 444
v. Sewall, 31, 47, 215, 325, 327,
333, 336, 342, 343, 445, 452,
459
v. Wetherill, 302
Jordan v. Dobson, 2, 5, 97, 199, 200,
397, 451, 463
v. Wallace, 445, 446
Judd v. Babcock, 219
Judson v. Bradford, 58, 198, 361, 434,
436, 456, 461
v. Cope, 60, 325, 436, 458, 459
v. Moore, 56, 57, 449
Justice v. Jones, 68, 175
- KAAPES v. Hartung, 308
Kass v. Hawlowetz, 144
Kearney v. Lehigh Valley R. Co.,
319, 463
Keene v. Wheatley, 326
Kelleher v. Darling, 47, 196, 323, 334,
336, 435
Keller v. Stolsenbach, 111
Kelly v. Porter, 113, 121, 128, 289
Kells v. McKenzie, 194, 199
Kemper, *Re*, 221, 310
Kendall v. Winsor, 342
Kendrick v. Emmons, 325, 373
Keplinger v. De Young, 268
Kerosene Lamp Heater Co. v. Littell,
53, 199, 474
- Ketchum Harvester Co. v. Johnson
Harvester Co., 234
Keutgen v. Kanowrs, 109
Keystone Bridge Co. v. Phoenix Iron
Co., 289
Kimball v. Hess, 226, 261
King v. Gallum, 449
v. Frostel, 306
v. Gedney, 149, 175
v. Louisville Cement Co., 257, 262
Kinsman v. Parkhurst, 136
Kirby v. Armstrong, 366
Kirby v. Dodge & Stevenson Manuf.
Co., 465
Kirby Bung Manuf. Co. v. White, 404,
409
Kittle v. Meriam, 216, 222, 224
Klein v. Russell, 221, 316, 473
Knapp v. Shaw, 459, 463
Kneass v. Schuylkill Bank, 47, 56, 72,
315, 355
Knight v. Gavit, 229, 313, 353, 357
Knox v. Great Western Quicksilver
Min. Co., 265, 367, 369, 476
v. Loweree, 344
v. Murtha, 228
Konold v. Klein, 26, 452, 453
Kuhl v. Mueller, 270
- LA BAW v. Hopkins, 199, 249, 358,
370, 376, 434, 435
Ladd v. Cameron, 396
v. Mills, 100
v. Tucker Manuf. Co., 310
Lalace & Grosjean Manuf. Co. v.
United States Stamping Co.,
309
Landolph v. Robinson, 128, 273
Lane v. Peck, 466
Langdon v. De Groot, 315
Latta v. Hawk, 121
Laver v. Dennett, 114
Leach v. Chandler, 271, 440, 442
Leclancha Battery Co. v. Western
Electric Co., 11, 220
Lee v. Blandy, 25, 97, 461
Lefever v. Remington, 226
Leggett v. Avery, 205

- Lehnbetter v. Holthaus, 487
 Leidersdorf v. Flint, 11
 Le Roy v. Tatham, 42, 43, 46, 53, 55,
 56, 244, 303
 Lewis v. Standard Laundry Machin-
 ery Co., 402
 Libbey v. Mt. Washington Glass Co.,
 211
 Liddle v. Cory, 428
 Liggett, &c. Tobacco Co. v. Miller,
 213, 214, 384
 Lightner v. Boston & Albany R. R.
 Co., 119, 120
 v. Brooks, 290
 v. Kimball, 291
 Lilienthal v. Washburn, 443
 Lilliendahl v. Detwiler, 439
 Lindsay v. Stein, 57, 344
 Little v. Gould, 10
 Littlefield, *Re*, 303
 v. Perry, 284, 363, 366, 371, 377,
 398
 Livingston v. Jones, 362
 v. Livingston, 305
 v. Van Ingen, 273
 v. Woodworth, 361, 370
 Lock v. Penn. R. R. Co., 436
 Lockwood v. Cleveland, 214, 385,
 447, 472
 v. Faber, 302, 461
 Locomotive Engine Truck Co. v.
 Erie Ry. Co., 367
 Locomotive Engine Safety Truck Co.
 v. Pennsylvania R. R. Co.,
 342, 376
 Lord v. Whitehead & Atherton Ma-
 chine Co., 389, 390
 Lorillard v. McAlpin, 192
 v. McDowell, 196, 223, 403, 461
 v. Ridgway, 306
 v. Standard Oil Co., 399
 v. Wight, 220
 Lowell v. Lewis, 26, 40, 42, 56, 70,
 315, 328, 362
 Lovther v. Hamilton, 309
 Lull v. Clark, 232
 Lyman v. Maypole, 338
 Lyman V. & R. Co. v. Lalor, 345
 Lyman Ventilating, &c. Co. v. Cham-
 berlain, 58, 460
 M. & P. MANUF. Co. v. DuBruil, 332
 Mabie v. Haskell, 313
 McArthur v. Brooklyn Railway Sup-
 ply Co., 196
 Macaulay v. White Sewing Machine
 Co., 428
 McCloskey v. Hamill, 273
 McClurg v. Kingsland, 1, 33, 109,
 136, 216, 220, 238, 265, 333
 McComb v. Ernest, 235
 McCormick v. Howard, 294, 327
 v. Manny, 40, 219, 252
 v. Seymour, 37, 40, 51, 355, 357
 v. Talcott, 250, 251
 McCreary v. Pennsylvania Canal Coal
 Co., 201
 McCulley v. Cunningham, 256
 MacDonald v. Blackmer, 331
 v. Shepard, 476
 McDonald v. Whitney, 402
 McGaw v. Bryan, 347
 McKay v. Dibert, 30, 220, 410
 MacKay v. Jackman, 46, 112, 115,
 275
 McKay v. Mace, 114
 v. Wooster, 101, 140, 267
 McKeever v. United States, 6, 7, 8,
 215, 254, 360
 McLaughlin v. People's R. Co., 396
 McMillan v. Conrad, 417
 v. Barclay, 334, 336, 338, 340,
 386, 452
 v. Rees, 31, 52, 223, 225
 v. St. Louis & Mississippi
 Transp. Co., 379, 441
 v. St. Louis & Vickburg Anchor
 Line, 269
 McMurray v. Mallory, 194, 195, 208,
 253
 McNish v. Everson, 329, 341
 McWilliams Manuf. Co. v. Blundell,
 100, 181, 245, 340, 421
 Machine Co. v. Murphy, 246, 260
 Magic Ruffle Co. v. Elm City Co.,
 117, 392

- Magic Ruffle Co. v. Douglass, 37
 Magoun v. N. E. Glass Co., 108
 Mahn v. Harwood, 307
 Maier v. Brown, 363, 369, 372
 Mallory v. Mackaye, 100
 v. White, 237
 Many v. Sizer, 235
 Maltby v. Bobe, 401
 Mann v. Bayliss, 294, 306
 Manning v. Cape Ann Isinglass, &c.
 Co., 333, 335
 Manufacturing Co. v. Corbin, 192
 v. Ladd, 192, 193
 Many v. Jagger, 41, 57, 316, 322, 436,
 437
 v. Sizer, 57, 239
 March v. Seymour, 376
 Marchand v. Emken, 309
 Mark v. Corn, 402
 Marsh v. Commissioner of Patents,
 345, 348
 v. Dodge, &c. Manuf. Co., 52
 v. Nichols, 29
 v. Sayles, 345, 348
 v. Warren, 373
 Marshall v. Mee, 310, 327
 Marvin v. Lillie, 60, 154
 Martinetti v. Maguire, 10, 57
 Mason v. Graham, 370
 v. Rowley, 16
 Masury v. Anderson, 315
 Mathew v. Pennsylvania R. Co., 113
 Mathews v. Flower, 296, 348
 Matteson v. Caine, 252
 Matthew v. Spangenberg, 210, 258,
 353, 374, 428, 429
 Matthews v. Green, 115
 v. Iron Clad Manuf. Co., 463
 v. Shoneberger, 225
 v. Skates, 37, 56, 234, 240, 449
 v. Weede, 172
 Maule, *Re*, 310
 Maxheimer v. Meyer, 30
 May v. Chaffee, 97, 118, 140
 v. County of Fond du Lac, 237,
 258, 261, 300, 310, 316, 357,
 377, 473
 Maynard, *Re*, 299
 Maynard v. Pawling, 256
 Mellus v. Silsbee, 62, 340, 342
 Merchant v. Lewis, 477
 Merrill v. Yeomans, 47
 Merriam v. Drake, 262
 v. Smith, 286, 381
 v. Van Nest, 250
 Mersevole v. Union Paper Collar Co.,
 275
 Mershon v. J. F. Pease Furnace Co.,
 393
 Metropolitan Washing Machine Co. v.
 Earle, 118, 268
 Meyer v. Bailey, 184
 v. Goodyear's India Rubber Glove
 Manuf. Co., 196, 205
 v. Maxheimer 192
 Miller v. Androscoggin Pulp Co.,
 387
 v. Brass Co., 182, 192
 v. Force, 327
 v. Liggett and Meyers Tobacco
 Co., 298
 v. McElroy, 408
 v. Pickering, 461
 v. Smith, 87, 488, 489
 Miller's Falls Co. v. Backus, 50, 51,
 245
 Miller, &c. Manuf. Co. v. Du Brul,
 57, 199, 450
 Milligan v. Lalance, &c. Manuf. Co.,
 319
 Milligan, &c. Glue Co. v. Upton, 47,
 199
 Millner v. Schofield, 257
 Milwaukee, &c. Canal Co. v. United
 States, 278
 Mini v. Adams, 187
 Mitchell v. Tilghman, 315
 Moffit v. Cavanaugh, 356
 Moffitt v. Garr, 181, 349
 v. Rogers, 41, 68
 Montross v. Bullard, 247, 251
 Moody v. Fiske, 30, 53, 235, 251
 v. Tabor, 114
 Moore v. Marsh, 100, 282, 285
 v. Thomas, 315
 Morehead v. Jones, 448

- Morley Sewing Machine Co. v. Lancaster, 218
 Morris v. Huntington, 336
 v. Lowell Manuf. Co., 415
 v. McMillan, 57
 v. Royer, 200
 v. Shelbourne, 422
 Morse v. Bain, 64, 181
 v. Davis, 433
 v. O'Reilly, 129, 134
 Morse Arms Manuf. Co. v. United States, 7, 123
 Morton v. New York Eye Infirmary, 6, 42, 43, 215
 Motte v. Bennett, 272
 Mowry v. Barber, 89, 149
 v. Whitney, 35, 252, 367, 377
 Mulford v. Pearce, 360
 Mundy v. Kendall, 409
 v. Lidgerwood, 312, 479
 Munson v. New York, 291, 312, 368, 425, 477
 Murray v. Ager, 96
 Muscan Hair Manuf. Co. v. American Hair Manuf. Co., 387
 Myers v. Callaghan, 33
- NATHAN v. New York Elevated R. R. Co., 60, 64
 National Car Brake Shoe Co. v. L. S. & M. S. Ry. Co., 222
 National Feather Duster Co. v. Hibbard, 134
 National Hay-Rake Co. v. Herbert, 441
 National Oil Co. v. Arctic Oil Co., 314
 National Manuf. Co. v. Myers, 446
 National Pump Cylinder Co. v. Gunnison, 196, 197
 v. Simmons Hardware Co., 459, 463
 National School Furniture Co. v. Paton, 425
 Needham v. Washburn, 305, 450
 Nellis v. McLanahan, 440
 v. Pennoch Manuf. Co., 284
 Nelson v. McMann, 125, 399
- Nesmith v. Calvert, 91, 277
 Nevins v. Johnson, 381
 New v. Warren, 191, 194
 New Process Fermentation Co. v. Koch, 219, 326
 v. Maus, 42, 46
 New York v. Ransom, 353
 New York Belting & Packing Co. v. Magowan, 299, 301, 314, 391, 419
 New York Belting, &c. Co. v. Sibley, 178
 New York Bung, &c. Co. v. Doelger, 300, 308
 v. Hoffman, 194
 New York, &c. Coffee Polishing Co. v. New York Coffee Polishing Co., 35
 New York Coffee Polishing Co. v. Wilson, 392
 New York Grape Sugar Co. v. American Grape Sugar Co., 307
 v. Buffalo Grape Sugar Co., 125, 286, 398, 418, 446, 465
 v. Peoria Grape Sugar Co., 394
 New York Pharmaceutical Association v. Tilden, 97, 142, 348
 New York Rubber Co. v. Chaskel, 241
 Newbury v. Mossman, 269
 Nichols v. Harris, 158, 172, 173, 327
 v. Pearce, 401
 Nicholson Pavement Co. v. Jenkins, 103
 Niles Tool Works v. Betts Machine Co., 303
 Nock v. United States, 373
 Norrington v. Merchant's Nat. Bank, 270
 North v. Kershaw, 287, 403, 408, 414
 North Western Fire Extinguisher Co. v. Phila. Fire Extinguisher Co., 306, 317, 397, 460
 Northrup v. Adams, 488
 Norton v. Haight, 307
 Nourse v. Allen, 439
 Nutting, *Re*, 262
 Nye v. Allen, 192

- ODELL v. Stout, 198, 198, 200, 329
 Odiorne v. Amesbury Nail Factory, 30.
 v. Denney, 261
 v. Winkley, 41, 244, 453
 Odorless Excavating Apparatus Co. v.
 Clements, 313
 Odorless Excavating Co. v. Lauman,
 409.
 Ogle v. Ege, 387, 408
 Ohio Steel Barb Fence Co. v. Wash-
 burn & Moen Manuf. Co., 135
 Olcott v. Hawkins, 244, 469
 Oliphant v. Salem Flouring Mills, 143
 Oliver v. Rumford Chemical Works,
 108, 119
 Onderdonk v. Fanning, 406, 418, 428
 O'Reilly v. Morse, 37, 40, 46, 60, 63,
 64, 69, 87, 200, 208, 212, 250
 v. Smith, 154, 173
 Orr v. Badger, 26, 405, 408, 423, 453
 v. Littlefield, 387, 402, 405, 408,
 421, 424, 444
 Osmer v. J. B. Sickles Saddlery Co.,
 370
 Otis Bros. Manuf. Co. v. Crane Bros.
 Manuf. Co., 258, 296

 PACKET Co. v. Sickles, 353
 Page v. Ferry, 242, 248, 315
 v. Holmes Burglar Alarm Tel.
 Co., 15, 215, 387
 Pailard v. Gautschi, 61
 Palmenburg v. Bucholz, 309
 Palmer v. United States, 8, 117
 Paper Bag Cases, 287
 Parham v. American Buttonhole, &c.
 Machine Co., 49, 187, 199
 Park v. Little, 69, 242, 283
 Parker v. Banker, 360, 433
 v. Bigler, 378, 478
 v. Corbin, 356, 378
 v. Ferguson, 459
 v. Halfield, 382
 v. Hallock, 281
 v. Hawk, 281
 v. Haworth, 26, 95, 234, 244, 251,
 257, 432
 Parker v. Hulme, 238, 313, 327, 331,
 355, 361, 378
 v. McKee, 311
 v. Montpelier Carriage Co., 311
 v. Remhoff, 456
 v. Sears, 406, 417
 v. Stiles, 60, 68, 224, 243, 244,
 315, 324, 450, 456, 468
 v. Stow, 311
 Parkhurst v. Kinsman, 103, 249, 322,
 421
 Parks v. Booth, 53, 72, 74, 253, 377,
 378, 434, 435, 444
 Parmelee v. Burritt Hardware Co.,
 311
 Parsons v. Colgate, 230, 325
 Pattee v. Moline Plow Co., 257
 Pattee Plow Co. v. Kingman, 271
 Patterson v. Duff, 451, 452
 v. Kentucky, 9
 v. Stapler, 398
 Pearce v. Mulford, 51
 Peard v. Johnson, 53
 Pearl v. Appleton Co., 190
 v. Ocean Mills, 51
 Peck v. Collins, 181, 356
 v. Frame, 361, 479
 Peck, &c. Co. v. Lindsay, 163, 403
 Pelham v. Edelmeyer, 95, 441
 Pelton v. Waters, 37, 89
 Pennington v. Hunt, 102
 Pennock v. Dialogue, 6, 39, 53, 215,
 216, 323, 342, 462
 Pennsylvania Salt Manuf. Co. v.
 Meyers, 408
 v. Thomas, 57, 196
 Pentlarge v. Beeston, 163, 427
 v. Kirby, 143
 v. Pentlarge, 214, 385, 387
 Perfection Window Cleaner Co. v.
 Bosley, 55, 307
 Perkins v. Electric Light Co., 129
 v. Nashua Card, &c. Co., 338, 454
 Perrigo v. Spalding, 122, 373
 Perry v. Co-operative Foundry Co.,
 307
 v. Cornell, 168, 327
 v. Corning, 104, 106, 285, 438

- Perry v. Littlefield, 128, 273
 v. Starrett, 162, 489
- Peters v. Active Manuf. Co., 332
- Peterson v. Simpkins, 465
 v. Wooden, 432
- Pettibone v. Derringer, 25, 230
- Phelps v. Brown, 147, 322
 v. Comstock, 103
- Philadelphia & Trenton R. R. Co. v.
 Stimpson, 26, 201, 449, 455, 467
- Philip v. Nock, 278, 352, 377
- Phillips v. Carroll, 270
 v. Comstock, 434
 v. Detroit, 401, 427
 v. Page, 51, 73, 76
- Phipps v. Yost, 308
- Phoenix Caster Co. v. Spiegel, 233
- Pickering v. McCullough, 52, 53, 341,
 466
 v. Miller, 341
 v. Phillips, 434
- Pickhardt v. Packard, 228
- Pierson v. Eagle Screw Co., 62, 267,
 336, 340, 378
- Pike v. Potter, 460
- Piper v. Brown, 42, 45, 364, 369, 476
 v. Shedd, 263, 314
- Pitcher v. United States, 7
- Pitts v. Hall, 38, 62, 95, 288, 294, 340,
 355, 356, 362, 452
 v. Wemple, 52, 57, 236, 249, 252,
 257, 318
 v. Whitman, 53, 55, 107, 222, 431
- Planing Machine Co. v. Keith, 436,
 450, 465
- Platt v. Manuf. Co., 331
- Platts, *Exp.*, 153, 183
- Plimpton v. Winslow, 333
- Poage v. McGowan, 202
- Pomeroy v. Connison, 173
 v. Connor, 175
- Pope Manuf. Co. v. Marqua, 439
 v. Owsley, 287, 293, 295, 299, 350,
 384
- Poppenhusen v. Falke, 201, 238, 245,
 415, 427, 449, 473, 475
 v. New York Gutta Percha Comb
 Co., 291, 403, 444, 449
- Porter Needle Co. v. National Needle
 Co., 125, 135
- Post v. Richards Hardware Co., 442,
 487
- Potter v. Berthelet, 113
 v. Crowell, 403
 v. Dixon, 158, 203, 385
 v. Holland, 94, 183, 184, 449
 v. Mack, 382
 v. Muller, 388, 427
 v. Stewart, 197, 240
 v. Whitney, 407, 415
- Pratt v. Rosenfeld, 486
- Preston v. Manard, 304
- Prime v. Brandon Manuf. Co., 103, 106
- Prouty v. Ruggles, 251
- Putnam v. Hollender, 121, 399
 v. Hutchinson, 188, 203, 343
 v. Lomax, 356, 364
 v. Sudhoff, 142, 349
 v. Yerrington, 40, 42, 196, 209,
 300, 313
- QUIROLO v. Ardlite, 438
- RACINE SEEDER Co. v. Joliet Wire
 Check Sower Co., 294, 464
- Railroad Co. v. Dubois, 294
 v. Mellon, 75
 v. Sayles, 77, 218, 230
 v. Trimble, 99, 103, 284, 353
- Railway Register Manuf. Co. v.
 Broadway & Seventh Ave.
 R. Co., 312, 339, 474
 v. North Hudson C. R. Co., 65,
 75, 317, 474
- Ransom v. New York, 450
- Rapp v. Bard, 317
- Rathbone v. Orr, 90, 100, 285
- Rayer, &c. Sewing Machine Co. v.
 American Printing Co., 192
- Read v. Bowman, 469
 v. Miller, 280, 281, 434
- Reay v. Raynor, 202, 393
- Reckendorfer v. Faber, 52, 317
- Reed v. Chase, 233
 v. Cutter, 53, 212, 321, 328
 v. Robinson, 321, 328

- Reed v. Street, 200, 247, 300
 Reeves v. Keystone Bridge Co., 58,
 327, 329, 474
 Reissner v. Anness, 196, 199, 443
 v. Sharp, 65
 Renwick v. Cooper, 148
 v. Pond, 317
 Reutgen v. Kanowrs, 32, 59, 242, 267
 Rich v. Close, 217, 227, 255, 280, 281
 v. Lippincott, 37, 100, 235, 239,
 333, 329
 v. Ricketts, 280, 281
 Richardson v. Bresnahan, 270
 v. Hicks, 467
 v. Lockwood, 196
 v. Miller, 57, 492
 v. Noyes, 58, 213, 226, 328, 385
 Ritter v. Serrell, 105
 Roberts v. Blake, 435
 v. Dickey, 46, 225, 325
 v. Harnden, 242, 254
 v. Roter, 236
 v. Ryer, 40, 41, 448
 v. Schreiber, 328
 v. Walley, 86, 471
 v. Ward, 56, 244
 Robertson v. Secombe Manuf. Co.,
 147, 317
 v. Hill, 255, 409
 Robinson, *Exp.*, 9
 Roemer v. Neuman, 317, 428, 480
 v. Peddie, 233, 296
 v. Simm, 437, 456
 v. Simon, 236, 448, 456
 Rogers v. Abbott, 404, 438
 v. Beecher, 452, 453
 v. Ennis, 50
 Roosevelt v. Western Electric Co., 138
 Root v. Ball, 30, 87, 251, 433, 434,
 489
 v. Davis, 434
 v. Lamb, 75
 v. Railway Co., 380, 389, 392
 Roots v. Hyndman, 462
 Rouse, *Re*, 172, 173
 Rowell v. Lindsay, 41, 253, 267
 Rowley, *Re*, 465
 Royce v. Fifield, 248
 Royer v. Chicago Manuf. Co., 248
 v. Russell, 461
 Rubber-Coat Harness Trimming Co.
 v. Welling, 304
 Rubber Co. v. Goodyear, 93, 111, 349
 Rubber Step Manuf. Co. v. Metropol-
 itan R. R. Co., 149
 Rubber Tip Pencil Co. v. Howard, 304
 Rugg v. Haines, 150
 Ruggles v. Eddy, 368
 v. Young, 294
 Rumford Chemical Works v. Hecker,
 383, 430
 v. Laur, 331
 v. Vice, 395, 403
 Rumsey v. Buck, 102, 295
 Runstetler v. Atkinson, 32, 178
 Russell v. Dodge, 192, 193, 196, 198
 v. Place, 298, 361, 473
 Russell Manuf. Co. v. Mallory, 334,
 352
 Ryan v. Goodwin, 50, 221, 224, 336

 ST. LOUIS STAMPING Co. v. Quimby,
 70, 291, 376
 Saladee v. Racine Wagon, &c. Co.,
 252
 Salomon v. Hertz, 293, 330, 426
 Salt Manuf. Co. v. Thomas, 192, 301
 Sanders v. Logan, 337, 339, 380, 381,
 386
 Sands v. Wardwell, 54, 252, 254, 451
 Sanford v. Merrimac Hat Co., 23, 233,
 252
 v. Messer, 94, 108, 284
 Sargent v. Carter, 415, 469
 v. Hall Safe & Lock Co., 209, 221
 v. Larned, 245, 247, 412
 v. Seagrave, 387, 388, 410, 411, 453
 v. Yale Lock Manuf. Co., 377
 Sargent Manuf. Co. v. Woodruff, 415
 Sarven v. Hall, 193, 253
 Saunders v. Logan, 361, 380
 Savary v. Lauth, 67
 Sawin v. Guild, 136, 238
 Sawyer v. Massey, 385
 Saxe v. Hammond, 352

- Sayles v. Chicago & Northwestern R. Co., 241, 347
 v. Dubuque & Sioux City R. Co., 280, 281
 v. Louisville City R. Co., 280, 281
 v. Oregon Central R. R. Co., 280
 v. Richmond, Fredericksburgh, &c. R. R. Co., 280, 364
- Schillinger v. Crawford, 253, 277, 350
 v. Greenway Brewing Co., 204
 v. Gunther, 209, 353
- Schneider v. Basset, 408
 v. Lovell, 239
 v. Thill, 338
- Schoerken v. Swift, &c. Co., 27
- Schrieber v. Thornton, 10
- Schultz v. Ostrander, 350
- Schwarzel v. Holenshade, 361
- Schwarzenbach v. Odorless Excavating Co., 288
- Scott Manuf. Co. v. Sayre, 300
- Scoville v. Toland, 50
- Searls v. Bonton, 119
- Secombe v. Campbell, 107, 383
- Secretary v. McGarrhan, 277
- Seely, *Re*, 86, 314
- Selden v. Stockwell Self-lighting Gas-burner Co., 183, 191, 199
- Seligman v. Day, 305
- Sessions v. Romadka, 30, 141, 208
- Sewing Machine Co. v. Frame, 197, 247, 300
- Seymour v. McCormick, 212, 340, 356, 357, 359, 361, 367, 427, 454
 v. Marsh, 58, 196
 v. Osborne, 60, 229, 252
- Sharp v. Reissner, 446
 v. Tift, 255
- Shaw v. Colwell Lead Co., 57, 182
 v. Cooper, 62, 183, 204, 215, 340
 v. Soule, 98, 103
- Shaw Relief Valve Co. v. New Bedford, 65, 233
- Sheeder v. Shannon, 259
- Shelly v. Brannan, 386
- Shepard v. Carrigan, 226
- Shickle v. South St. Louis Foundry Co., 439
- Shoup v. Henrici, 341
- Sickels v. Falls Co., 343
 v. Borden, 42, 236, 245, 357, 358, 373
 v. Youngs, 405
- Sickles v. Evans, 194, 198
 v. Gloucester Manuf. Co., 381
 v. Mitchell, 386, 403
 v. Tileston, 413, 414
- Siebert Cylinder Oil Cup Co. v. Phillips Lubricator Co., 98
- Siemens v. Sellers, 64, 220
- Silsby v. Foote, 43, 208, 212, 242, 377, 436
- Simon v. Neumann, 235
- Simpson v. Davis, 362, 485, 490
 v. Leiper, 378
 v. Wilson, 101, 221
- Singer v. Braunsdorf, 331
 v. Walmsley, 211, 239
- Singer Manuf. Co. v. Goodrich, 201
 v. Larsen, 11, 219
 v. Riley, 11, 219
 v. Stanage, 11, 219
- Singer Sewing Mach. Co. v. Union Button Hole, &c. Co., 114, 412
- Sisson v. Gilbert, G, 334, 339
- Slawson v. Grand Street R. R. Co., 304, 445, 449, 473
- Slessinger v. Buckingham, 438, 465
- Sloat v. Patten, 472
- Smith, *Re*, 302
- Smith v. American Bridge Co., 306
 v. Baker, 471
 v. Downing, 239
 v. Elliott, 51
 v. Ely, 63, 64
 v. Fay, 253
 v. Flickmyer, 168
 v. Frazer, 436
 v. Glendale Elastic Fabric Co., 461
 v. Goodyear Dental Vulcanite Co., 360, 313

- Smith v. Halkvard, 162, 403, 428
 v. Higgins, 240
 v. Marshall, 239, 256, 261
 v. Mercer, 183, 184, 201, 211
 v. Merriam, 198
 v. Murray, 249, 260, 317
 v. Nichols, 40, 56, 211, 304
 v. O'Connor, 329
 v. Patton, 429
 v. Pearce, 40, 203, 216, 242, 244
 v. Plymouth, 273, 379
 v. Plympton, 17, 184, 188, 348, 450
 v. Sands, 380, 442
 v. Selden, 97
 v. Sharp's Rifle Manuf. Co., 381
 v. Standard Laundry Machinery
 Co., 275, 291
 v. Woodruff, 459, 464
 Soder v. Mills, 216
 Spaeth v. Barney, 198, 438
 Spain v. Gamble, 158, 262
 Sparkman v. Higgins, 39, 147, 148,
 216, 337, 340, 424, 487
 Spaulding v. Page, 373
 Spear v. Belson, 67
 Sperry v. Ribands, 395
 Spicer v. United States, 278
 Spill v. Celluloid Manuf. Co., 308
 Sprague v. Adriance, 213
 Spring v. Domestic Sewing Machine
 Co., 239, 272, 284, 286, 408,
 415, 465
 Squire, *Re*, 178
 Stainthorp v. Humiston, 253, 422
 Standard Measuring Machine Co. v.
 Teague, 226
 Stanley v. Whipple, 40, 124, 204, 295,
 432
 Stanley Rule and Level Co. v. Bailey,
 126, 276
 Stanley Works v. Sargent, 301, 303
 Star Salt Caster Co. v. Crossman, 236,
 363, 366
 Starrett v. Athol Machine Co., 202,
 289
 Steam Gauge & Lantern Co. v. Mc-
 Roberts, 432, 438
 v. Meyrose, 295
 Steam Gauge, &c. Co. v. Miller, 402
 Steam Gauge Co. v. St. Louis Ry.
 Supply Co., 423
 Steam Stone Cutter Co. v. Sheldon,
 99, 281, 374, 426
 v. Shortsleeves, 113
 v. Windsor Manuf. Co., 373, 377
 Stearns v. Barrett, 321
 v. Davis, 162
 Stebins Hydraulic Elevator Manuf.
 Co. v. Stebins, 100
 Steiger v. Heidleberger, 401
 Stein v. Goddard, 281, 286
 Stephens v. Salisbury, 67, 78, 162, 467
 v. Felt, 316, 359, 360, 361
 Stephenson v. Brooklyn Cross-Town
 R. R. Co., 254
 v. Hoyt, 162
 v. Second Ave. R. R. Co., 196
 Stevens v. Gladding, 137
 v. Pritchard, 181, 196, 197, 200
 v. Whitman, 55
 Stewart v. Mahoney, 41, 76, 479
 Still v. Reading, 106, 283
 Stilwell, &c. Manuf. Co. v. Cincinnati
 Gas-light, &c. Co., 306
 Stimpson v. Baltimore & Susquehanna
 R. R. Co., 251, 259
 v. Mad River R. R. Co., 238
 v. Pond, 144
 v. Railroads, 356, 361, 378
 v. Rogers, 93, 397
 v. Westchester R. R. Co., 199,
 238, 450, 463
 Stitt v. Eastern R. Co., 59, 332
 Stone v. Sprague, 42
 Storrs v. Howe, 236, 252, 262, 450,
 451, 455
 Stowe v. Chicago, 40, 304
 Strauss v. King, 313
 Strobridge v. Lindsay, 50, 57, 241, 250
 Strong v. Noble, 301
 Stuart v. Shantz, 351
 Sturges v. Van Hagan, 331
 Stutz v. Armstrong, 182, 212, 213, 256,
 360
 Suffolk County v. Hayden, 30, 250,
 359, 373

- Sullivan v. Redfield, 68, 73, 222, 224,
387, 404, 405, 407, 438
- Suydam v. Day, 95, 285, 431
- Swift v. Jenks, 341, 418, 423
v. Whisen, 183, 198, 199, 200
- Sykes v. Manhattan Elevator, &c.
Co., 416
- TAFT v. Steere, 264
- Tappan v. Nat. Bank Note Co., 407,
408
- Tarr v. Fulson, 57, 83, 316, 317
v. Webb, 192
- Tate v. Thomas, 237, 245
- Tatham v. Lowber, 200, 244, 366, 373,
377, 476
- Taylor v. Boston, 74
v. Carpenter, 355, 359
v. Garretson, 250
- Teas v. Albright, 128, 273
- Teese v. Huntington, 377, 436, 444
v. Phelps, 37, 69, 326, 327, 437, 450
- Terhune v. Phillips, 419
- Terrell v. Bradford, 194
- Terry Clock Co. v. New Haven Clock
Co., 316
- Thatcher Heating Co. v. Carbon Stove
Co., 431
- Thayer v. Hart, 457, 476, 480
v. Spaulding, 247, 331
v. Wales, 103, 409, 437
- Theberath v. Celluloid Manuf. Co.,
108, 127
v. Rubber & Celluloid Harness
Trimming Co., 38, 485, 487,
488
- Thomas v. Shoe Machinery Co., 187
v. Weeks, 32, 33, 387, 408
- Thompson v. Barry, 425
v. Boisselier, 300
v. Canterbury, 289
v. Haight, 342, 347
- Tilghman v. Hartell, 128, 275
v. Proctor, 45, 64, 248
- Tillinghast v. Hicks, 418
- Time Telegraph Co. v. Himmer, 296
- Tinker v. Wilber's Eureka Mower,
&c. Manuf. Co., 78, 217, 229
- Tobey Furniture Co. v. Colby, 262,
264
- Toledo Mower, &c. Co. v. Johnston
Harvester Co., 393
- Tompkins v. Butterfield, 144, 291
- Tomkinson v. Willet's Manuf. Co., 489
- Toohy v. Harding, 25, 235
- Torrent Arms Lumber Co. v. Rod-
gers, 202
- Tower v. Bemis, &c. Hardware Co., 55
- Tracy v. Torrey, 40, 421
- Trader v. Messmore, 230
- Trade-mark Cases, 10
- Travers v. Beyer, 234
v. Palmer, 264
- Treadwell v. Bladen, 30, 244, 342, 468
- Tremolo Patent, 371
- Troy Iron, &c. Factory v. Corning,
98, 119, 369, 462, 477
v. Odiorne, 462
- Troy Laundry Machinery Co. v. Bun-
nell, 297, 299, 311
- Tryon v. White, 431, 432
- Tuck v. Bramhill, 212
- Tucker v. Burditt, 192
v. Tucker Manuf. Co., 189, 194,
197
- Tucker Manuf. Co. v. Boyington, 11,
219
- Turnbull v. Weir Plow Co., 107
- Turner Seymour Manuf. Co. v.
Dover Stamping Co., 346
- Turrell v. Bradford, 182
v. Cammerer, 438
v. Spaeth, 351, 447, 477
- Turrill v. Illinois Central Ry. Co.,
476, 369, 377
v. Michigan Southern, &c. R. R.
Co., 221, 225
- Tuttle v. Gaylord, 359
- Tyler v. Boston, 239
v. Crane, 451
v. Deval, 54, 315
v. Galloway, 400
v. Hyde, 298, 385
v. Stiles, 315
v. Tuel, 285
- Tyson v. Rankin, 385

- UNDERMEYER v. Jeannot, 488
 Union Paper Bag Co. v. Newell, 424
 Union Paper Bag Machine Co. v. Pultz, &c. Co., 470
 Union Sugar Refinery Co. v. Matthiesen, 328, 449, 451, 452
 United Nickel Co. v. New Home Sewing Machine Co., 418
 v. Worthington, 296
 United States v. Colgate, 430
 v. Day, 428
 United States Annunciator, &c. Manuf. Co. v. Sanderson, 421
 United States Rifle, &c. Co. v. Whitney Arms Co., 344, 435
 United States, &c. Salamander Felting Co. v. Asbestos Felting Co., 409
 Urner v. Kayton, 476
- VANCE v. Campbell, 435, 467
 Van Hook v. Pendleton, 395, 409
 Vaughan v. Central Pacific R. R. Co., 363, 382, 390
 v. East Tennessee, Virginia, &c. R. R. Co., 364
- WADE v. Metcalf, 119
 Wagner, *Re*, 312
 Walker v. Hawthurst, 143
 v. Rawson, 310
 Wallace v. Holmes, 288
 v. Noyes, 311
 Walsh, *Re*, 303
 Ward v. Grand Detour Plow Co., 460
 Warner v. Goodyear, 149, 161, 294, 451
 Warswick Manuf. Co. v. Steiger, 60
 Warth v. Browning, 250
 Washburn v. Gould, 93, 229, 231, 249, 284, 285, 321, 355, 387, 407, 451, 455
 Washburn, &c. Manuf. Co. v. Fuchs, 194
 v. Griesche, 103, 258
 v. Haish, 98, 144, 462
 v. Wilson, 418
 Washburn & Moen Manuf. Co. v. Cincinnati Barbed Wire Fence Co., 419
 v. H. B. Scutt & Co., 419
 Washing Machine Co. v. Earle, 188
 v. Lincoln, 299
 Washington, &c. Packet Co. v. Sickles, 129
 Water Meter Co. v. Desper, 226, 262
 Waterbury Brass Co. v. Miller, 6, 215
 v. N. Y. Brass Co., 237, 462, 469
 Waterman v. Thompson, 37
 Watson, *Re*, 302
 v. Bladen, 32, 39, 216
 v. Cincinnati, I., &c. R. Co., 297
 v. Cunningham, 53
 v. Smith, 457
 Watt v. Starke, 475
 Wayne v. Holmes, 56, 57, 449
 Webb v. Quintard, 326
 Webber v. Virginia, 9, 129
 Webster v. New Brunswick Carpet Co., 371
 Webster Loom Co. v. Higgins, 52, 69, 78, 87, 222, 315, 456, 458
 Weir v. North Chicago Rolling Mill Co., 78, 217
 Welling v. Crane, 256, 308
 v. Rubber Coated Harness Trimming Co., 30, 76, 262
 Wellman v. Blood, 149, 174
 Wells v. Gill, 196, 198, 408, 409, 422
 Werner v. King, 245
 Westcott v. Rude, 122, 358, 466
 v. Wayne Agricultural Works, 101
 Western Electric Manuf. Co. v. Ansonia Brass, &c. Co., 41, 76, 226, 350
 v. Chicago Electric Manuf. Co., 460
 v. Odell, 485
 Western Union Tel. Co. v. Baltimore, &c. Telegraph Co., 188, 419
 Westinghouse v. Gardner, &c. Air Brake Co., 189, 249
 Westlake v. Carter, 252, 261, 434, 435
 Weston v. White, 64, 459, 482

- Wetherill v. New Jersey Zinc Co.,
 281, 364, 368, 429
 v. Passaic Zinc Co., 135, 391
 Wetherell v. Veith, 462
 Wheaton v. Peters, 10
 Wheeler v. Clipper Mower, &c. Co.,
 54, 58, 59, 191, 254
 v. McCormick, 31, 55, 191, 202,
 227, 391, 399
 v. Simpson, 76
 Whipple v. Baldwin Manuf. Co., 249
 v. Hutchinson, 428
 v. Middlesex Co., 236, 237
 v. Miner, 178, 317
 v. Renton, 175
 White v. Allen, 37, 231, 343
 v. E. P. Gleason Manuf. Co., 210
 v. Harris, 116
 v. Heath, 249
 v. Lee, 122, 126, 446
 Whitely v. Fisher, 16, 172, 184
 Whiting v. Graves, 108
 Whitley v. Swayne, 198
 Whitney v. Emmett, 6, 40, 41, 42,
 53, 55, 56, 70, 73, 215, 216,
 222, 294, 337, 342, 353, 356,
 468
 v. Mowry, 363
 v. Rollstone Machine Works, 415
 Whittemore v. Cutter, 46, 48, 50, 84,
 95, 238, 284, 342, 353, 355,
 356, 373, 377, 435
 Whittlesey v. Ames, 262, 328
 Wicke v. Kleinknecht, 112
 Wickersham v. Singer, 67, 879, 150,
 Wicks v. Stevens, 203
 Wilbur v. Beecher, 57, 361, 362, 373,
 461
 Wilcox v. Komp, 331
 Wilcox, &c. Sewing Machine Co. v.
 The Gibbons Frame, 7, 11,
 141, 219
 Wilder v. Adams, 116, 121
 v. Gayler, 371, 434
 v. McCormick, 16, 26, 87, 232,
 318, 431, 432
 v. Kent, 137
 Wilkens v. Spafford, 108, 109
 Willimantic Linen Co. v. Clark Thread
 Co., 480
 Willimantic Thread Co. v. Clark
 Thread Co., 362, 366, 367, 457
 Williams v. Barker, 327
 v. B. & O. R. R. Co., 236
 v. Boston & A. R. R. Co., 394
 v. Leonard, 369, 375
 v. Rome, Watertown, &c. R. Co.,
 376
 v. Stoltzenback, 270
 Wilson v. Barnum, 26, 382, 402, 423
 v. Chickering, 287, 125, 287
 v. Coon, 188
 v. Curtius, 425
 v. Janes, 316
 v. Rosseau, 17, 93, 181, 284
 v. Sanford, 128
 v. Sherman, 126, 380, 412
 v. Singer Manuf. Co., 143
 v. Stimson, 266
 v. Stolley, 126, 139, 470
 Wilson Packing Co. v. Clapp, 42, 306,
 414, 426
 Wilt v. Grier, 261
 Wilton v. Railroads, 436
 Winans v. Denmead, 40, 221, 225, 242,
 245
 v. Boston & Providence R. R.
 Co., 41
 v. New York & Erie R. R. Co.,
 231, 329, 336, 456, 468
 v. Schenectady & Troy R. R. Co.,
 41, 56, 74, 78, 229, 338,
 342
 Wing v. Richardson, 452
 v. Warren, 184
 Winne v. Snow, 144
 Winslow, *Re*, 173
 Wintermute v. Redington, 56, 57, 101
 Wire Book Sewing Machine Co. v.
 Stevenson, 457, 458
 Wire Railing Co. v. Walker, 426
 Wise v. Allis, 436
 Wisner v. Dodd, 477
 Wonson v. Peterson, 445
 Wood v. Cleveland Rolling Mill Co.,
 468

- Wood v. Dolby, 589
 v. Packer, 52, 55, 56, 202
 v. Underhill, 74
 v. Wells, 112, 126
 Wood Paper Patent, 192
 Woodbury Planing Machine Co., 345
 Woodcock v. Parker, 40, 330
 Woolen v. Banker, 9
 Woolensak v. Reiher, 182, 198, 442
 Woodruff v. Barney, 378, 478
 Woodward v. Dinsmore, 200
 v. Morrison, 210, 265
 Woodworth v. Cook, 121, 126
 v. Curtis, 99, 137
 v. Edwards, 181, 202, 400, 424, 426
 v. Hall, 17, 26, 27, 93, 181, 204,
 221, 400, 402, 404, 408, 424,
 464
 v. Rogers, 249, 424, 427
 v. Sherman, 93, 412
 v. Stone, 184, 199, 381, 446
 v. Weed, 115, 126, 413
 v. Wilson, 93, 284
 Woonsocket Rubber Co. v. Candee,
 308
 Wooster v. Calhoun, 47.
 v. Crane, 486
 v. Handy, 185, 196
 v. Howe Sewing Machine Co., 407
 v. Marks, 401
 v. Muser, 446
 v. Seidenburg, 108, 112, 267
 Wooster v. Simonson, 109, 357
 v. Singer Manuf. Co., 126, 351
 v. Taylor, 116, 267, 367
 Worden v. Fisher, 32, 318
 v. Searls, 202
 Workman v. McNaught, 12
 Worley v. Tobacco Co., 38, 216, 333,
 334
 Worswick Manuf. Co. v. Buffalo, 456
 v. Steiger, 332
 Woven Wire Mattress Co. v. Wire
 Web Bed Co., 190
 Wyeth v. Stone, 30, 42, 75, 107, 209,
 235, 245, 336, 394, 395, 405
 YALE LOCK MANUF. CO. v. Berkshire
 National Bank, 328
 v. Greenleaf, 300, 317
 v. Norwich Nat. Bank, 299
 v. Sargent, 237, 242, 282, 350
 353, 360, 376
 v. Scovill Manuf. Co., 193
 Yearsley v. Brookfield, 301, 467
 Yoder v. Mills, 39
 York & Maryland R. R. Co. v. Wi-
 nans, 17
 Yuengling v. Johnson, 404, 453
 v. Schile, 10
 ZANE v. Loffe, 478
 v. Peck, 363
 Zinn v. Weiss, 234

PATENT LAWS OF ALL NATIONS.

VOL. II.

UNITED STATES—WURTEMBERG.

UNITED STATES.

I. CONSTITUTIONAL AND GENERAL PRINCIPLES.

1. *The Constitutional Grant of Power.*

The Congress shall have power

8. 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. *Const. Art. I. § VIII.*

2. *Extent of the Power Granted.**

Congress has plenary power over the subject of granting exclusive rights to inventors; it can modify, at pleasure, the law respecting patents, provided property in existing patents is not impaired (*McClurg v. Kingsland*, 1 *How.* 202); and can determine when, and for what length of time, and under what circumstances, the patent for an invention shall be granted; and is not restricted from granting patents in cases where the invention has not been known or used by the public. An act of Congress granting a

* The extent and limits of the power granted to Congress have been discussed and expounded instructively, in *Bump Pat.* 9 ed. 1; *Pomeroy Const. L.* 3 ed. §§ 413, 414; 2 *Story Const.* 4 ed. §§ 1151-1157; *Walker Pat.* c. 7; *Walker Am. L.* § 60; *Warton Com.* § 450; *Paschal Const.* 121.

patent is not unconstitutional because it acts retrospectively, and gives a patent for an invention which was previously in public use. *Blanchard v. Sprague*, 3 *Sumn.* 535 ; 2 *Story*, 164.

To make special grants to inventors is within the constitutional power of Congress, and that body can grant an extension of a patent after it has been once extended under the general act. *Bloomer v. Stolley*, 5 *McLean*, 158 ; 8 *West. L. J.* 158. Congress has the constitutional right to confer, by special act, a new and special term on a patentee ; and that even after the expiration of the first patent. *Blanchard v. Haynes*, 6 *West. L. J.* 82 ; *Blanchard's Gunstock Turning Factory v. Warner*, 1 *Blatchf.* 258 ; *Jordan v. Dobson*, 2 *Abb. U. S.* 398 ; 7 *Phila.* 533 ; *Evans v. Robinson*, 1 *Cur. L. Repos.* 209. Congress may renew a patent right, or refuse to do so ; the grant of an exclusive privilege to an inventor for a limited time does not imply a binding and irrevocable contract, that at the expiration of the period the invention shall become public property. *Evans v. Eaton*, *Pet. Ct.* 322, 337.

A reservation in favor of assignees in an act extending a patent will not make the act unconstitutional on the ground that Congress is authorized to confer privileges only on inventors ; the power to reserve rights and privileges to assignees is incidental to the general power conferred to promote the progress of the useful arts. *Blanchard's Gunstock Turning Factory v. Warner*, 1 *Blatchf.* 258.

3. *Its Limitations and Exceptions.*

The power exercised by Congress in the enactment of the patent laws is domestic in its character, and is necessarily confined within the limits of the United States. Those laws cannot operate beyond such limits ; nor can the right of the patentee extend beyond the limits within which the law by which the right is created is confined. The use of his invention outside the jurisdiction of the United States is no infringement of his rights, and gives him no claim to compensation. Thus, the rights granted to a patentee do not extend to a foreign vessel lawfully entering our ports ; and the use on such vessel of an improvement patented in this country is not an infringement of the rights of an American patentee, provided it was placed upon her in a foreign port and authorized by the laws of the country to which she belongs. Where a vessel was built and rigged in France and equipped with gaffs which had been patented in the United States, and, so equipped, came to one of our ports, *held*, that as the gaffs were placed on the vessel when she was built

and as part of her original equipment, in a foreign country, by persons not within our jurisdiction, the use of them was not within the application of our patent laws. *Brown v. Duchesne*, 19 *How.* 183, 198 ; aff'g 2 *Curt.* 371.

Though our patent laws afford no protection to inventions beyond the jurisdiction of the United States, yet that jurisdiction extends to the decks of American vessels on the high seas, as much as it does to all the territory of the country, and for many purposes is even more exclusive. *Gardiner v. Howe*, 2 *Cliff.* 462.

Congress cannot authorize an inventor to recall rights which he has granted to others, or re-invest him with rights of property which he has before conveyed for a valuable consideration. *Bloomer v. McQuewan*, 14 *How.* 539.

4. *History of the Acts of Congress.*

The legislation of Congress upon the subject of patents began early. The act first passed was that of April 10, 1790, 1 *Stat.* 109. c. 7.

This act was repealed by the act of February 21, 1793 (1 *Stat.* 318, c. 11), which latter act, as amended and extended by a series of acts passed in 1794 (1 *Stat.* 393, c. 58), 1800, 1819 (2 *Stat.* 37, c. 25), and 1832 (3 *Stat.* 481, c. 19 ; 4 *Stat.* 559, c. 162 ; *Id.* 577, c. 203), formed the basis of our patent law down to 1836. In that year a general revision of the law of the subject was made, and a new and comprehensive act was passed,—the act of July 4, 1836,—by which former acts were repealed, and which established a system destined to continue in force, with some amendments and additions, till 1870. These amendatory or additional acts are, the act of March 3, 1837 (5 *Stat.* 191, c. 45), regulating recording and effect of records as evidence, enabling patents to be issued to assignees of the original inventor, and allowing a disclaimer of any excess in a specification, or a correction of the specification in cases of re-issue, and allowing a patent to be sustained in part ;—the act of March 3, 1839 (5 *Stat.* 353, c. 88), protecting patentees notwithstanding sales of the article made during a term not exceeding two years before the patent is issued ;—the acts of August 29, 1842 (5 *Stat.* 543, c. 263), and March 2, 1861 (12 *Stat.* 246, c. 88), allowing patents for designs ; and requiring the date of the patent to be stamped upon or affixed to each patented article offered for sale ;—the act of February 18, 1861 (12 *Stat.* 130, c. 37), authorizing the Supreme Court to review circuit court decisions in patent cases

without regard to the value in controversy ;—the act of March 2, 1861, abolishing extensions (12 *Stat.* 246, c. 88).*

The laws thus far mentioned still possess some historic interest ; and a knowledge of them, even of their precise language, is often useful in reading the decisions of former years. But they have almost lost force as respects existing rights. Few patents which were granted or extended under them are operated ; the laws themselves have been repealed sufficiently long ago to allow the ordinary rights of action under them to have become extinct ; and very few suits begun before the repeal are still pending.† The commissioners to revise the statutes, appointed under the first law for that purpose (who adopted the working plan of allotting distinct subjects to individual members of the board for preparation of a revised version of the laws), framed a revision of the laws on patents and copyrights which they reported to Congress ; and their report became (with the addition of a chapter on trademarks inserted by Congress and afterwards pronounced unconstitutional by the Supreme Court) the basis of the act of July 8, 1870, c. 230, 16 *Stat.* 198. This act is substantially reproduced in *Rev. Stat.* tit. LX. c. 3. It was technically repealed by the revision ; but the interval between the two was so short, the provisions are so nearly identical, and the general saving clause of the revision is so liberal, that the difference between the act of 1870 and the Revised Statutes is unimportant in any general study of the subject, though cases may easily occur in which it will deserve attention. The acts since the revision are : The law authorizing a resort to jury trial in patent suits (act of Feb. 16, 1875, 18 *Stat.*

* The above enumeration embraces only provisions affecting the law of patents strictly speaking, and excludes enactments relative to organization of the patent-office, powers and proceedings of officers, jurisdiction of courts, appropriations, and the like. Comprehensive collections of all the various patent laws, reprinted in chronologic order, are given in the Appendixes to the treatises of Curtis and Walker. Mr. Bump gives a convenient "List of the Laws relating to Patents, Trademarks and Copyright, showing the time of repeal and the part of the Revised Statutes where an analogous provision may now be found." (*Bump Pat.* 2 ed. xi.) It would be

more convenient to one studying patent law exclusively, if the three sorts of laws were distinguished from each other.

For a mention of some points in decisions of the courts under former patent laws which seem inapplicable to the Revised Statutes, see *Abb. Nat. Dig.* tit. Patents, VIII.

† *Oliver v. Rumford Chemical Works*, 109 U. S. 75, is an example of a case in which so lately as 1884 it was necessary to adjudicate a suit according to the long-repealed laws ; but this was because the right was acquired under them, and the question had been kept open by an unusual concurrence of death of a party and delay of litigation.

316), and a few provisions regulating conduct of business in the patent-office. For all practical purposes one who wishes to see the statute law in force at the present time (March, 1886), needs to consult only the Revised Statutes.

5. *Construction of Acts of Congress.*

Patent laws should be liberally construed, to effect the general object of securing the rights of inventors. *Grant v. Raymond*, 6 *Pet.* 218, 242 ; *Commissioner v. Whiteley*, 4 *Wall.* 522 ; *Brooks v. Jenkins*, 3 *McLean*, 432.

The general words granting the exclusive right, found in the patent law (of 1836) must be taken in connection with the whole statute or statutes on the subject and the objects and policy of the law as indicated by its various provisions, and must be construed so as to carry into execution the will of Congress. They should not be construed so as in any degree to disarm government of any of its powers, or enable an individual to embarrass it. And as attention of Congress when legislating to protect inventors is necessarily drawn to the constitutional power given for that purpose, the courts ought not to presume that the exercise of another power (here, the treaty-making power) was intended. *Brown v. Duchesne*, 19 *How.* 183, 194.

A private act of Congress authorizing the issuing of a patent to an inventor is to be considered as engrafted on the general acts for the promotion of the useful arts, and such a patent is issued in pursuance of both. *Evans v. Eaton*, 3 *Wheat.* 454, 518 ; *Jordan v. Dobson*, 2 *Abb. U. S.* 398 ; 7 *Phila.* 533.

Even if it is within the power of Congress to decide the fact that an individual is an inventor, without leaving the question of invention open to investigation, the courts will never presume Congress to have decided that question in an act, the words of which do not render such a construction unavoidable. *Evans v. Eaton, supra.*

A grant of exclusive right in an invention, for a specific term, does not imply a right on behalf of the people that at the end of that term the invention shall be public property. *Evans v. Eaton, Pet. C. Ct.* 322.

An act extending a single patent should be construed in connection with, or as engrafted upon a general law allowing extensions. *Bloomer v. McQuewan*, 14 *How.* 539.

An act granting a patent should not be construed so that it will

operate retrospectively, unless such construction is unavoidable. *Blanchard v. Sprague*, 3 *Sumn.* 535 ; 2 *Story*, 164.

6. *Nature of a Patent Right.*

The applicant must bring himself within the terms of the law before he can derive any title to demand or hold a patent. *Pennoek v. Dialogue*, 2 *Pet.* 1, 18 ; aff'g 4 *Wash.* 359.

The right which an inventor has to the exclusive use of his invention is the creature of the statute ; the supreme court has always held that he has no right upon which he can maintain suit, unless he obtains letters patent according to the statute ; and his right is regulated and measured by the provisions of the act, and cannot go beyond them. *Brown v. Duchesne*, 19 *How.* 183 ; aff'g 2 *Curt.* 371 ; S. P., *Morton v. New York Eye Infirmary*, 5 *Blatchf.* 116 ; 2 *Am. L. Reg. N. S.* 672 ; 2 *Fish. Pat. Cas.* 320 ; *Waterbury Brass Co. v. Miller*, 9 *Blatchf.* 77 ; 5 *Fish. Pat. Cas.* 48 ; *Sissons v. Gilbert*, *Id.* 109.

A patent is not a "monopoly," but resembles a contract between the government and the inventor, securing to him, for a limited time, the exclusive enjoyment of the practice of his invention, in consideration of his disclosure of the secret to the public, and his relinquishment of his invention to the public at the end of the term. *Attorney-General v. Rumford Chemical Works*, 9 *Pat. Off. Gaz.* 1002 ; *McKeever v. United States*, 14 *Ct. of Cl.* 396.*

A patent in this country is a matter of right, on complying with the conditions prescribed by law. *Whitney v. Emmett*, *Baldw.* 303.

Congress having power to secure, "for limited times," to inventors, the exclusive right to their discoveries, in consideration of the benefit which the public will derive from the invention after the expiration of the term, whatever was patented to the inventor and enjoyed by the inventor and those operating in any way under him during the term, belongs to the public and is free to all at the expiration of the term. Hence, an exclusive right under the protection solely of patents, to make frames for sewing-machines in

* The opinion gives an extended and interesting account of the rise in England, of opposition to monopolies, and of the reasons why grants of patent rights were and should be excepted from

it. See, on the same subject, op. Bradley, J., in *Butcher's Union Co. v. Crescent City Co.*, 111 U. S. 746, 761 ; and, for the Act Concerning Monopolies, 2 post, 1, and note.

the shape of the letter G, cannot be maintained after the expiration of the patents on the ground that such shape is a trademark. *Wilcox, &c. Sewing Machine Co. v. Frame*, 17 *Fed. Rep'r*, 623 ; 21 *Blatchf.* 431 ; 24 *Pat. Off. Gaz.* 1272.

7. *No Right Reserved to Government.*

In the United States, where the grant of a patent partakes the nature of a recognition and protection of the patentee's right, such grant excludes the government from using the invention without either obtaining the license of the inventor, or making him compensation therefor.* *James v. Campbell*, 104 *U. S.* 356 ; rev'g 17 *Blatchf.* 42 ; 8 *Rep'r*, 455 ; 4 *Bann. & A. Pat. Cas.* 456 ; 18 *Pat. Off. Gaz.* 979 ; *Brady v. Atlantic Works*, 10 *Pat. Off. Gaz.* 702 ; *McKeever v. United States*, 14 *Ct. of Cl.* 396.

Use of a patented machine, by officers of the government, although in prosecuting public works, does not constitute such a taking of private property for public use as gives the Court of Claims jurisdiction of a claim for compensation. Thus where a warden of United States penitentiary set up six patented broom-making machines in the prison, and employed the convicts in making brooms, but there was nothing like a bargain between him and the inventor, the court held that for want of some contract binding the government to pay, no judgment could be rendered. *Pitcher v. United States*, 1 *Ct. of Cl.* 7.

A suit may be brought in the court on a special contract with a patentee, for the use of his invention by the government at an agreed price. Thus where a patented army tent was adopted by the war department, and a contract was made by direction of the secretary, with the inventor, to pay him a royalty (which was not paid), on proof of the special contract he recovered judgment. *Burns v. United States*, 4 *Ct. of Cl.* 113 ; aff'd *sub nom.* *United States v. Burns*, 12 *Wall.* 246.

The Court of Claims has jurisdiction in an action brought

* As long ago as 1858 a claim was preferred to the secretary of war for payment for government use of a patent cut-off. The government contracted with M. to build a steamboat. M. attached the cut-off to the engine without paying royalty, considering that government was entitled to the free use of the invention. The inventor applied to the secretary of

war, and that officer asked the opinion of the attorney-general. The attorney-general of the day, Judge Black, advised that the government was equally bound with an individual to pay a royalty ; and that the secretary might pay one if there were an appropriation available. 9 *Op. Att.-Gen.* 135. Patents, &c. act, 1883, § 27, disclaims right of the crown.

upon an implied license to manufacture a patented article, or on an implied contract that government shall make compensation.* *McKeever v. United States*, 14 *Ct. of Cl.* 396 ; aff'd, 18 *Id.* 757 ; 1880, *Morse Arms Manuf. Co. v. United States*, 16 *Id.* 296 ; and see *Dahlgren v. United States*, *Id.* 30 ; *Hollister v. Benedict Manuf. Co.*, 113 *U. S.* 59.

Upon proof that a patented article was submitted by the inventor to the war department and adopted and used by the secretary of war, the Court of Claims will not presume that a gratuitous license was intended by the one party, or a tortious infringement by the other ; but rather that the government used the invention under an implied license and engagement to pay a reasonable royalty. *McKeever v. United States*, *supra*.

Where the government, on the invitation of an inventor, manufactures a patented military device having no market value, the implication is that the government shall pay for the valuable right to use, and not for the valueless right to manufacture. *Palmer v. United States*, 19 *Ct. of Cl.* 669.

The government, when it manufactures after a patented device but under an implied license, is as responsible as an individual. The ordnance department has no more right to manufacture a patented article for experiment than for use. *Palmer v. United States*, 20 *Ct. of Cl.* 432.

An officer of government (here, a postmaster) who, without license, uses a patented invention in the performance of the business under his charge, thereby saving expense to the government, renders himself personally liable as an infringer, to the owner of the patent ;† and the sum so saved is a proper measure of the profits recoverable. *Campbell v. James*, 8 *Rep'r*, 455 ; *Campbell v. James*, 2 *Fed. Rep'r*, 338 ; 17 *Blatchf.* 42 ; 18 *Pat. Off. Gaz.* 1111 ; 10 *Rep'r*, 103 ; rev'd, 104 *U. S.* 356. See other decisions

* What circumstances will not raise a presumption or implication of a contract that government shall pay for its use of a patent, see *Shavor v. United States*, 4 *Ct. of Cl.* 440 ; *Fletcher v. United States*, 11 *Id.* 748.

† Inasmuch as officers of the United States, when they use articles manufactured in violation of the rights of patentees, are liable to suit therefor, therefore, where articles are advertised for by the

United States, and it is claimed by another party that the successful bidder, in order to furnish the articles, must make them in violation of his patent, it is proper that the successful bidder should be required to furnish a satisfactory bond of indemnity for the security of the officer against any suit for infringement of patent by the use of the articles. 16 *Op. Att.-Gen.* 136.

in the cause, 3 *Fed. Rep'r*, 513 ; 10 *Rep'r*, 686 ; 18 *Pat. Off. Gaz.* 300 ; 5 *Bann. & A. Pat. Cas.* 630.

In a suit in the circuit court to enjoin an infringement, proof that respondents are manufacturing the article in question under a contract with the government and for its use does not constitute a defense. Such contract cannot confer any right to use the complainant's patent. *Brady v. Atlantic Works*, 10 *Pat. Off. Gaz.* 702.

8. *Powers of State Legislatures.*

The power conferred on Congress to grant letters patent for inventions, does not prevent the several States from legislating to protect their communities against the sale of deleterious or dangerous manufactured articles. Articles which, by the application of the invention or discovery for which letters-patent have been granted by the United States, come into existence, are, to the same extent as that of any other species of property, subject to States control. *Patterson v. Kentucky*, 97 *U. S.* 501.

Letters-patent for an invention do not authorize the patentee to sell the article within a State, in defiance of her laws enacted in the exercise of the police power forbidding or restraining such sales. *Webber v. Virginia*, 103 *U. S.* 344.

The grant of the right to the exclusive use of an invention, by a special statute of a State, does not amount to a contract securing the public use after expiration of the patent ; and if it did, Congress might, notwithstanding, grant a renewed patent. There is nothing in the constitution which forbids Congress to pass laws violating the obligations of contracts, though such a power is denied to the States individually. *Evans v. Eaton*, *Pet. Ct.* 322.

A State statute requiring that any note given in consideration of a sale of a patent right, shall contain a recital that it was so given, is unconstitutional and void for infringing the exclusive power of Congress to regulate the subject of patents. *Exp. Robinson*, 2 *Biss.* 309 ; *Castle v. Hutchinson*, 25 *Fed. Rep'r*, 394. Only Congress can prescribe special regulations as to the mode in which a patent-right may be sold and conveyed. Any interference by a State with the right to assign a patent, is void. *Woolen v. Banker*, 17 *Alb. L. J.* 72 ; 5 *Rep'r*, 259.

9. *Analogous Decisions Relative to Copyright.*

Congress has power to prescribe the conditions on which a copyright shall be obtained and owned ; and no person can avail himself

of the right, without a substantial compliance with the conditions. The courts cannot dispense with the requirements clearly prescribed by statute, because they may seem unimportant. The use of the word "securing" in the constitutional grant, does not import that an author has a natural right in his work, after publication, which the courts can protect, independent of, or beyond the act of Congress. *Wheaton v. Peters*, 8 *Pet.* 591.

Congress has power to extend the protection of the copyright law to a photographer, who, by labor and thought, artistic design and skill in placing a person before the camera, arranging costume, drapery, &c., planning light and shade, contributes to the value of a photographic portrait. Hence *Rev. Stat.* § 4952,—allowing copyright in photographs,—is constitutional, so far as its application to photographs involving such artistic labor and skill is concerned. The grant of power is not limited to protection of "books" and "authors," in the strict and limited sense; it is broad enough to authorize a copyright law protecting photographs which embody original intellectual conceptions. *Barrow-Giles Lithographic Co. v. Sarony*, 111 *U. S.* 53; aff'g 17 *Fed. Rep'r*, 591. See also *Schreiber v. Thornton*, 17 *Fed. Rep'r*, 603.

The constitution does not invest Congress with power to grant copyright (or letters patent), to a mere owner of a work as such, irrespective of his being, or having derived title from the original author, designer, composer (inventor), &c. *Yuengling v. Schile*, 12 *Fed. Rep'r*, 97; 20 *Blatchf.* 452; 13 *Rep'r*, 517.

That Congress has not power to pass a law conferring the privilege of copyright upon immoral or indecent works or compositions; the power embraces such works only as tend to "promote the progress of science and useful arts," see *Martinetti v. Maguire*, 1 *Abb. U. S.* 356.

A State cannot interfere with rights of individuals acquired under the copyright laws. *Little v. Gould*, 2 *Blatchf.* 165, 171.

10. *Relative to Trade-marks.*

The trade-marks legislation of Congress, particularly the act of Aug. 14, 1876 (19 *Stat.* 141), is unconstitutional; because the patent and copyright power does not extend to trade-marks; and the legislation in question is not sufficiently limited to foreign and interstate commerce to admit of sustaining it under the commercial power. *Trademark Cases*, 160 *U. S.* 82; 25 *Law. ed.* 550; 10 *Pat*

Off. Gaz. 999. To same effect were *Leidersdorf v. Flint*, 18 *Am. L. Reg. N. S.* 37 ; 7 *Cent. L. J.* 405 ; 6 *Rep'r*, 739.

A manufacturer of a patented article cannot claim protection, after expiration of his patent, against another person's making the article in imitation of the form, color, &c., of that manufactured by plaintiff ; nor enforce a right to continue the use of the stamp "——'s patent" as a trade-mark. Neither a patent nor a trade-mark relates to the accidental exterior appearance. The patent (while it lasted) protected only the novel, substantial mechanism, and the trade-mark only forbids representing defendant's article as being of the manufacture of plaintiff. *Fairbanks v. Jacobus*, 14 *Blatchf.* 337. To the same general effect, *Consolidated Fruit Jar Co. v. Dorflinger*, 2 *Am. L. T. N. S.* 571 ; *Singer Manuf. Co. v. Strange*, 6 *Fed. Rep'r*, 279 ; 2 *McCrary*, 512 ; 11 *Rep'r*, 661 ; *Same v. Riley*, 11 *Fed. Rep'r*, 706 ; *Wilcox, &c. Sewing Machine Co. v. Gibbens Frame*, 17 *Id.* 623 ; 24 *Pat. Off. Gaz.* 1272 ; *Singer Manuf. Co. v. Larsen*, 8 *Biss.* 151 ; 3 *Bann. & A. Pat. Cas.* 246 ; *Tucker Manuf. Co. v. Boyington*, 9 *Pat. Off. Gaz.* 455 ; *Leclanché Battery Co. v. Western Electric Co.*, 21 *Fed. Rep'r*, 538.

Where complainants were the first to adopt and use, as a mark for their product, tin tags variously colored, with the name of their brand and their own name stamped thereon and fastened upon the outside of their plugs of tobacco,—*Held*, although their patent therefor was declared void after surrender and reissue, that they had the right to the device as a trade-mark, the public having come to know their tobacco by the tags of their peculiar color, shape, and size. *Lorillard v. Wright*, 15 *Fed. Rep'r*, 383.

II. THE PATENT-OFFICE.

11. *Authority of the Secretary of the Interior.*

The secretary of the interior is charged with the supervision of public business relating to the following subjects :

5. Patents for inventions. *Rev. Stat.* § 441.

The authority of the secretary is supervisory rather than appellate. Supervisory power applies to executive or administrative duties, and includes authority to direct the performance of them. Thus, if the commissioner neglects or refuses to perform such a duty, or performs it improperly, the secretary may give the appro

priate direction. *Edison v. Edison*, 9 *Pat. Off. Gaz.* 403 ; *James v. Sargent*, 12 *Id.* 475. But decisions rendered by the commissioner, acting judicially, are not reviewable by means of an appeal to the secretary. *Edison v. Edison*, *supra* ; *Franklin B. Hunt*, 13 *Pat. Off. Gaz.* 771 ; *Workman v. McNaught*, 16 *Id.* 216. A mandamus to compel the issuing of a patent runs to the secretary, not to the commissioner. *United States v. Marble*, 22 *Pat. Off. Gaz.* 1365.

Gill applied for a patent. An interference was declared, and the commissioner decided in favor of his claim to priority, and adjudged that a patent issue to Hoe & Co., his assignees. Scott, however, the claimant of the interfering invention, appealed to the secretary of the interior, who heard the appeal and adjudged Scott the first inventor, and Gill not entitled to a patent for it. The commissioner, because of this reversal of his decision, refused to receive Hoe & Co.'s final fee, or to cause the patent to be issued. They then applied to the supreme court of the District of Columbia for a mandamus, directing him to accept the fee and prepare, seal and countersign the patent, and submit it to the secretary, &c. The commissioner resisted the application ; but solely to procure a decision upon the relative authority of commissioner and secretary. *Held*, reviewing the legislation, decisions and past practice elaborately, that the mode of reviewing a commissioner's decision refusing a patent, except in cases of interference, is by appeal to the supreme court of the District of Columbia (*Rev. Stat.* § 4911); and the mode of reviewing such decision in interference cases is by bill in equity under *Rev. Stat.* § 4915. Unless such appeal or bill is taken or filed, the commissioner's decision is final. The power of supervision vested in the secretary over the acts of the commissioner relates to his performance of executive and administrative duties ; it does not extend to a review of the action of the commissioner in cases in which he is by law appointed to exercise his discretion judicially. In issuing or withholding patents he exercises quasi judicial functions, and his decisions can be reviewed only in the modes provided by law. *Butterworth v. Hoe*, 112 *U. S.* 50. Even admitting that so far as the public alone is concerned, the secretary may satisfy his duty of direction and superintendence by prescribing general rules for the conduct of the public business, and securing, by general oversight, conformity to them, yet whenever a private person acquires by law a personal interest in the performance by the commissioner of any act, he thereby also acquires an individual in the direction and supervision of the secretary, to correct any error,

or supply any omission or defect in its performance tending to his injury ; so that the official duty of direction and supervision on the part of the secretary implies a correlative right of appeal to him, from the commissioner. Per MATTHEWS, J., *Butterworth v. Hoe*, 112 *U. S.* 50, 57.

12. *Establishment of the Patent-Office. Seal.*

There shall be in the department of the interior, an office known as the patent-office,* where all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved. *Rev. Stat.* § 475.

The seal heretofore provided for the patent-office shall be the seal of the office, with which letters patent and papers issued from the office shall be authenticated. *Rev. Stat.* § 478.

13. *Officers and Employes. Salaries.† Bonds.*

There shall be in the patent-office, a commissioner of

* An account of the management of departmental business connected with the patent-office, is given in Elmes Exec. Depts. c. 28 ; it is, however, very little more than a concise statement of matters presented in greater detail in the patent laws as published by the patent-office, and the rules of practice in the patent-office.

† The sections of the Revised Statutes purporting to fix the salaries of the above mentioned officers, and to enumerate the subordinate employes, and fix their salaries, are Nos. 477 and 440. They are omitted from this compilation not merely because they are of small importance in connection with the law of patents, but chiefly because they are likely to mislead, inasmuch as the appropriations made often vary from them. Thus, section 477 fixes the salary of the commissioner at \$4,500 ; the appropriation for the year

1885-86 is \$5,000. Stat. 1885, c. 343. Section 440 allows the office seventy-two assistant examiners arranged in three ranks ; the appropriation gives it one hundred and twenty-one, arranged in four ranks. Theoretically, such changes should be authorized by some previous, independent law ; and in many cases they are. Often, however, without any previous legislation, the appropriation for a subordinate post is reduced, or even omitted, for a year or two ; or, on the other hand, a temporary need of additional force is supplied by appropriations continued only while the need lasts, without, in either case, taking the trouble to change the general law. The result is that the actual organization and personnel of the office is best ascertained by collating with the enactments of the Revised Statutes the items in the appropriation act for the year current.

patents,* one assistant commissioner, and three examiners-in-chief, who shall be appointed by the President, by and with the advice and consent of the Senate. All other officers, clerks, and employes, authorized by law for the offices shall be appointed by the secretary of the interior, upon the nomination of the commissioner of patents. *Rev. Stat.* § 476. (See *Id.* § 169.)

The commissioner of patents and the chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the treasurer of the United States, the former in the sum of \$10,000, and the latter in the sum of \$5,000, conditioned for the faithful discharge of their respective duties, and that they shall render to the proper officers of the treasury a true account of all money received by virtue of their offices. *Rev. Stat.* § 479.

14. *Restrictions upon Officers and Employes.*

All officers and employes of the patent-office shall be incapable, during the period for which they hold their

* The office of commissioner was created by the act of 1836. The following persons have held it.

Name.	Whence appointed.	Date of commission.
Henry L. Ellsworth	Connecticut.....	July 4, 1836
Edmund Burke.....	New Hampshire....	May 5, 1845
Thomas Ewbank.....	New York.....	May 9, 1849
Silas H. Hodges.....	Vermont.....	November 1, 1852
Charles Mason.....	Iowa.....	March 24, 1853
Joseph Holt.....	Kentucky.....	September 9, 1857
William D. Bishop.....	Connecticut.....	May 7, 1859
Phillip F. Thomas.....	Maryland.....	February 15, 1860
David P. Holloway.....	Indiana.....	March 28, 1861
Thomas C. Theaker.....	Ohio.....	August 15, 1865
Elisha Foote.....	New York.....	July 28, 1868
Samuel S. Fisher.....	Ohio.....	May 1, 1869
Mortimer D. Leggett.....	Ohio.....	January 16, 1871
John M. Thatcher.....	Virginia.....	November 1, 1874
R. Holland Duell.....	New York.....	October 1, 1875
Ellis Spear.....	Maine.....	January 30, 1877
Halbert E. Paine.....	Wisconsin.....	November 1, 1878
Edgar M. Marble.....	Michigan.....	May 7, 1880
Benjamin Butterworth.....	Ohio.....	November 1, 1883
Martin V. Montgomery.....	Michigan.....	March 23, 1885

appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by the office. *Rev. Stat.* § 480.

The law does not disqualify a commissioner of patents from obtaining a patent after his term of office has expired, for an invention made by him while holding such office; and in such case the invention will date back to the time when it was actually made, although he could not then have obtained a patent for it. *Foote v. Frost*, 3 *Bann. & A. Pat. Cas.* 607.

The provision of the act of 1836 (5 *Stat.* 118),—disqualifying an employe in the patent-office from acquiring an interest in a patent,—did not disqualify such employe from obtaining a patent after such employment had ceased, for an invention made prior to the commencement of such employment. *Page v. Holmes Burglar Alarm Tel. Co.*, 17 *Blatchf.* 484; 1 *Fed. Rep'r*, 304; 17 *Pat. Off. Gaz.* 737; 5 *Bann. & A. Pat. Cas.* 165.

See the following somewhat analogous provisions: No patented article connected with marine engines shall hereafter be purchased or used in connection with any steam vessels of war until the same shall have been submitted to a competent board of naval engineers, and recommended by such board, in writing, for purchase and use. *Rev. Stat.* § 1538.

No royalty shall be paid by the United States to any one of its officers or employes for the use of any patent for the system, or any part thereof, mentioned in the preceding section [viz., the breech-loading system for muskets and carbines, known as “the Springfield breech-loading system”], nor for any such patent in which said officers or employes may be directly or indirectly interested. *Rev. Stat.* § 1673.

15. *Duties of Commissioner.*

The commissioner of patents, under the direction of the secretary of the interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the patent-office. *Rev. Stat.* § 481.

The authority of the commissioner of patents to issue patents is not of the nature of jurisdiction, in its common law and technical acceptation ; and the doctrine appertaining to acts or judgments of inferior tribunals, that he who sets up such judgment must aver and prove that the tribunal had jurisdiction in the matter, does not apply to his acts. *Wilder v. McCormick*, 2 *Blatchf.* 31.

An application for an extension of a patent, under the act of 1836, § 18, was pending at the time of the passage of the act of 1848,—which conferred upon the commissioner of patents, solely, the power previously vested in the board created by the act of 1836. *Held*, that it was not necessary to renew the application, but that the commissioner had the power to go on with the proceedings, as having been already properly instituted, and complete them by granting the extension. *Colt v. Young*, 2 *Blatchf.* 471.

Whether the commissioner of patents has authority to refuse a patent after a favorable decision of the board of examiners in chief; and as to his supervisory powers over examiners generally, see *Hull v. Commissioner of Patents*, 2 *MacArthur*, 90 ; *Id.* 125 ; 8 *Pat. Off. Gaz.* 46.

The act of July 4, 1836,—empowering the commissioner of patents to issue a patent in certain cases whenever the supreme court of the District of Columbia shall decide that an applicant is entitled to a patent,—does not authorize the court to compel the commissioner, by mandamus or injunction, to issue the patent. *Mason v. Rowley*, 2 *Am. L. T. U. S. Cts.* 8.

An action of trespass will not lie against the commissioner of patents for refusing to issue a patent ; for the duty of issuing letters-patent devolves upon the secretary of the interior ; only the duty of countersigning and affixing the seal of office to the patent, upon the commissioner. *Whitely v. Fisher*, 4 *Fish. Pat. Cas.* 248.

16. *Acting Commissioner.*

The term “acting commissioner” is used, not on the idea of there being any distinct officer known to the law by that title, but as designating a person who, in case of the death or resignation, or during the absence or sickness of the commissioner, may be temporarily authorized to perform his duties. For the provisions by which a person may thus act as commissioner, see *Rev. Stat.* §§ 178, 179. Their application is not peculiar to the office of commissioner of patents, and the necessity of resort to section 179 with

respect to that office is greatly diminished by the creation of the office of "assistant commissioner." See *Rev. Stat.* §§ 476, 178.

A patent is not invalid because it is certified by a person as "acting commissioner," instead of being certified by the commissioner himself. A patent signed by an "acting commissioner of patents" is valid upon its face. The courts will judicially take notice of the persons who preside over the patent-office, whether permanently or transiently. *Wilson v. Rosseau*, 4 *How.* 646, 663; *York & Maryland R. R. Co. v. Winans*, 17 *How.* 30, 41; *Woodworth v. Hall*, 1 *Woodb. & M.* 248; 6 *Pa. L. J.* 173.

A patent otherwise duly issued, but countersigned by an "acting commissioner," is valid, when no allegation of fraud or usurpation is made, and his act is sanctioned by the commissioner acting in person.* *Smith v. Mercer*, 5 *Pa. L. J.* 529; 4 *West. L. J.* 49.

In a case where the bill on an extended patent alleged that the extension had been granted "by the commissioner of patents," but the proof was that it was granted by H., who was examiner in chief, as "acting commissioner," *McKENNAN, J. (E. Dist. Pa., 1873)*, sustained the suit; saying that a provisional officer invested by law with the functions of the commissioner is properly described (in pleading) as commissioner; that his lawful authority is presumed from his actual incumbency, and even if this presumption is not conclusive (which it seemingly is, *Rubber Co. v. Goodyear*, 9 *Wall.* 796), no affirmative proof is needful; absence, &c., of the commissioner is presumed; the burden of showing non-existence of the contingency on which the substitute might lawfully act is upon the party who denies the validity of the ostensible act of the officer. *Dorsey Harvester Rake Co. v. Marsh*, 6 *Fish.* 387; 9 *Phila.* 395.

17. *Duties of Examiners in chief.*

The examiners in chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of

* Compare a case of a patent accidentally issued without signature of the secretary of the interior, and afterward signed by "acting" secretary. *Marsh v. Nichols*, 18 *Fed. Rep'r.* 914; 24 *Pat. Off. Gaz.* 901.

patents, and in interference cases; and, when required by the commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them. *Rev. Stat.* § 482.

18. *Establishment of Regulations.*

The commissioner of patents, subject to the approval of the secretary of the interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the patent-office. *Rev. Stat.* § 483.

Congress in creating the patent-office has by express legislation given that office the power to enact rules for its conduct; those rules, if within the powers of the office and reasonable, are just as authoritative as the laws of Congress itself. *United States v. Marble*, 22 *Pat. Off. Gaz.* 1365.

A comprehensive code of regulations, entitled *Rules of Practice in the United States Patent-Office*,* has been compiled and is published for gratuitous distribution. Copies may be obtained on application to the commissioner. They are accompanied by Forms, the observance of which in all cases to which they may be applicable, is recommended to inventors and attorneys.

19. *Arrangement and Exhibition of Models, &c. Disposal.*

The commissioner of patents shall cause to be classified and arranged in suitable cases, in the rooms and galleries provided for that purpose, the models, specimens of composition, fabrics, manufactures, works of art, and designs, which have been or shall be deposited in the patent-office; and the rooms and galleries shall be kept open during suitable hours for public inspection. *Rev. Stat.* § 484.

* The substance of the important rules is embodied in this work, in connection with the statutes or decisions on the subjects to which the rules relate. The edition in use at the time of writing,

March, 1886, is: Eighth revised edition, November 16, 1885, under which rules 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 44, 45, 47, 86, 140, 144, and 145 were amended.

The commissioner of patents may restore to the respective applicants such of the models belonging to rejected applications as he shall not think necessary to be preserved, or he may sell or otherwise dispose of them after the application has been finally rejected for one year, paying the proceeds into the treasury, as other patent moneys are directed to be paid. *Rev. Stat.* § 485.

In all cases where an application has been rejected more than two years, the model, unless it is deemed necessary that it should be preserved in the office, may be returned to the applicant upon demand, and at his expense ; and the model, in any pending case of less than two years' standing, may be returned to the applicant upon the filing of a formal abandonment of the application, signed by the applicant in person. (See Rule 165.) Models belonging to patented cases will not be taken from the office except in the custody of some sworn employe of the office specially authorized by the commissioner. *Rules of Practice, Pat. Off.* No. 59.

Models filed as exhibits in contested cases, may be returned to the applicant. If not claimed within a reasonable time they may be disposed of, at the discretion of the commissioner. *Id.* No. 60.

20. *Library.**

There shall be purchased for the use of the patent-office a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated for that purpose. *Rev. Stat.* § 486.

Library regulations. No persons are allowed to enter the alcoves, or take books from the library, except officers of the bureau and members of the examining corps. All books taken from the library must be entered in a register kept for the purpose, and returned on the call of the librarian. Any book lost or defaced must be replaced by a copy of the same. *Rules of Prac.* No. 217.

21. *Correspondence with the Office.*

All business with the office should be transacted in writing. Unless by the consent of all parties, the action of the office will be

* By the act of Aug. 4, 1854, c. 242, § 8, 10 Stat. 572, the collections of the Exploring Expedition, are placed under the care and management of the commissioner of patents.

based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding, in relation to which there is disagreement or doubt. *Rules of Practice, Pat. Off. No. 1.*

All office letters must be sent in the name of the "Commissioner of Patents." All letters and other communications intended for the office must be addressed to him. *Id. No. 2.*

Express charges, freight, postage, &c., on matter sent to the patent-office must be prepaid. *Id. No. 3.*

The personal attendance of applicants at the patent-office is unnecessary. Their business can be transacted by correspondence. *Id. No. 4.*

The assignee of the entire interest of an invention is entitled to hold correspondence with the office to the exclusion of the inventor. *Id. No. 5.*

Where there has been an assignment of an undivided part of an invention, the inventor and the assignee will both be recognized as the proper parties to hold correspondence with the office, and all amendments and other actions in such cases must be signed by both parties; but official letters will be sent in such case to the post-office address of the inventor, unless he shall otherwise direct. *Id. No. 6.*

When an attorney shall have filed his power of attorney, duly executed, the correspondence will be held with him. *Id. No. 7.*

A double correspondence with the inventor and an assignee, or with a principal and his attorney, or with two attorneys, cannot generally be allowed. *Id. No. 8.*

A separate letter should in every case be written in relation to each distinct subject of inquiry or application. Assignments for record, final fees and orders for copies or abstracts must be sent to the office in separate letters. *Id. No. 9.*

When a letter concerns an application, it should state the name of the applicant, the title of the invention, the serial number of the application (see Rule 31), and the date of filing the same. *Id. No. 10.*

When the letter concerns a patent, it should state the name of the patentee, the title of the invention, and the number and date of the patent. *Id. No. 11.*

No attention will be paid to *ex parte* statements or protests of persons concerning pending applications to which they are not parties, unless information of the pendency of such applications shall

have been voluntarily communicated by the applicants. *Id.* No. 12.

Letters received at the office will be answered, and orders for printed copies filled, without unnecessary delay. Telegrams, if not received before 3 o'clock p. m. cannot ordinarily be answered until the following day. *Id.* No. 13.

The office cannot respond to inquiries as to the novelty of an alleged invention in advance of an application for a patent, nor to inquiries propounded with a view of ascertaining whether any alleged improvements have been patented, and, if so, to whom; nor can it act as an expounder of the patent law, or as counselor for individuals, except as to questions arising within the office. Of the propriety of making an application for a patent, the inventor must judge for himself. The office is open to him, and its records and models pertaining to all patents granted may be inspected either by himself or by any attorney or expert he may call to his aid, and its reports are widely distributed. (See Rule 216.) Examiners' digests are not open to public inspection. *Id.* No. 14.

Caveats and pending applications are preserved in secrecy. (See Rule 171.) *Id.* No. 15.

After a patent has issued, the model, specification, drawings, and all documents relating to the case are subject to general inspection, and copies, except of the model, will be furnished at the rates specified in Rule 209. *Id.* No. 16.

22. *Patent Agents and Attorneys.**

Any person of intelligence and good moral character may appear as the agent or the attorney in fact of an applicant, upon filing a proper power of attorney. *Rules of Practice*, No. 17.

Before any attorney, original or associate, will be allowed to inspect papers or take action of any kind, his power of attorney must be filed. No power of attorney purporting to have been given to a firm or copartnership will be recognized, either in favor of the

* The rules advise that the assistance of competent counsel will, in most cases, be of advantage to an applicant; that the office cannot aid an inventor in selecting an attorney, or assume any responsibility for an attorney's acts; that it will be unsafe to trust those who pretend to the

possession of any facilities except capacity and diligence for procuring patents in a shorter time, or with broader claims than others, and that applicants should not impose on senators or representatives, labor in attending to applications.

firm or any of its members, unless all its members shall be named in such power of attorney. *Id.* No. 18.

Substitution or association can be made by an attorney upon the written authorization of his principal ; but such authorization will not empower the second agent to appoint a third. *Id.* No. 19.

Powers of attorney may be revoked * at any stage in the proceedings of a case upon application to and approval of the commissioner ; and when so revoked, the office will communicate directly with the applicant, or such other attorney as he may appoint. Attorneys will be promptly notified by the examiner in charge of the case, of the revocation of their powers of attorney. An assignment of an undivided interest will not operate as a revocation of the power previously given, but the assignee of the entire interest may be represented by an attorney of his own selection. *Id.* No. 20.

Attorneys will be required to conduct their business with the office with decorum and courtesy. Papers presented in violation of this requirement will ordinarily be returned. Complaints against examiners and other officers must be made in separate communications, and will be promptly investigated. *Id.* No. 22.

For gross misconduct the commissioner of patents may refuse to recognize any person as a patent agent, either generally or in any particular case ; but the reasons for such refusal shall be duly recorded, and be subject to the approval of the secretary of the interior. *Rev. Stat.* § 487.

In *Boyden v. Burke*, 14 *How.* 575, B. had made application to the commissioner, accompanied with an insulting letter, for copies of certain papers of record ; but the commissioner refused them on the ground of B.'s incivility, &c. B., without making any apology, wrote to a third person* requesting him to apply as B.'s agent for

* The death of the inventor revokes a power of attorney given by him to a patent agent. *Eagleton Manuf. Co. v. West, &c. Manuf. Co.*, 2 *Fed. Rep'r*, 774 ; 18 *Blatchf.* 218 ; 5 *Bann. & A.* 475 ; 17 *Pat. Off. Gaz.* 1504. This is the ordinary rule as to principal and agent. *Hunt v. Rousmanier*, 8 *Wheat.* 174 ; and applies even to an act of agency performed while the death of the principal is yet unknown to the agent. *Galt v. Galloway*, 4 *Pet.* 331. See also, as to effect of death of principal, 19 *Am. L. Reg. N. S.* 401 ; and 39 *Am. Dec.* 81, note.

the papers. The agent tendered the fees and demanded the papers; but the commissioner renewed his refusal, saying that until B. "comes to the conclusion to treat this office with civility," &c., "this office will have no intercourse with him, directly or through the agency of others." In B.'s action for damages, *Held*, that a person desiring official services must request it in a proper manner; a demand accompanied with rudeness and insult is not a legal demand; and the letter which accompanied the plaintiff's first demand justified the commissioner in refusing it. But the demand afterwards made through the agent was made in a proper manner, and the commissioner was not justified in refusing it on account of B.'s former misconduct. For the second refusal B. was entitled to at least nominal damages. *Boyden v. Burke*, 14 *How.* 575.

23. *Printing of Papers. Engraving, &c. Distribution and Sale.*

The commissioner of patents may require all papers filed in the Patent-Office, if not correctly, legibly, and clearly written, to be printed at the cost of the party filing them. *Rev. Stat.* § 488.

The commissioner of patents may print, or cause to be printed, copies of the claims of current issues, and copies of such laws, decisions, regulations, and circulars as may be necessary for the information of the public. *Rev. Stat.* § 489.

The commissioner of patents is authorized to have printed, from time to time, for gratuitous distribution, not to exceed one hundred and fifty copies of the complete specifications and drawings of each patent hereafter issued, together with suitable indexes, one copy to be placed for free public inspection in each capital of every State and Territory, one for the like purpose in the clerk's office of the district court of each judicial district of the United States, except when such offices are located in State or Territorial capitals, and one in the Library of Congress,

which copies shall be certified under the hand of the commissioner and seal of the patent-office, and shall not be taken from the depositories for any other purpose than to be used as evidence. *Rev. Stat.* § 490. See *Id.* § 894.

See also the following enactment : It shall be the duty of the commissioner of patents to furnish, free of cost, one copy of the bound volumes of specifications and drawings of patents published by the patent-office, to each of the executive departments of the government, upon the request of the head thereof. Act of March 3, 1875, c. 130, § 12, 18 *Stat.* 402 ; *Rev. Stat.* 1 *Supp.* 166.

The commissioner of patents is authorized to have printed such additional numbers of copies of specifications and drawings, certified as provided in the preceding section, at a price not to exceed the contract price for such drawings, for sale, as may be warranted by the actual demand for the same ; and he is also authorized to furnish a complete set of such specifications and drawings to any public library which will pay for binding the same into volumes to correspond with those in the patent-office, and for the transportation of the same, and which shall also provide for proper custody for the same, with convenient access for the public thereto, under such regulations as the commissioner shall deem reasonable. *Rev. Stat.* § 491.

The lithographing and engraving required by the two preceding sections shall be awarded to the lowest and best bidders for the interests of the government, due regard being paid to the execution of the work, after due advertising by the congressional printer under the direction of the joint committee on printing ; . . . or if . . . the work can be performed under the direction of the commissioner of patents more advantageously than in the manner above prescribed, it shall be so done, under such limitations and conditions as the joint committee on printing may from time to time prescribe. *Rev. Stat.* § 492.

The appropriation for photolithographing, or otherwise producing plates for the Official Gazette, and copies of designs, trade-marks and pending applications, and for the reproduction of exhausted copies, for the fiscal year 1885-86, was coupled with a proviso: "said photolithographing, or otherwise producing plates and copies" "to be done under the supervision of the commissioner of patents, and in the city of Washington, if it can be there done at reasonable rates; and the commissioner of patents, under the direction of the secretary of the interior, shall be authorized to make contracts therefor."

The price to be paid for uncertified printed copies of specifications and drawings of patents shall be determined by the commissioner of patents, within the limits of ten cents as the minimum and fifty cents as the maximum price. *Rev. Stat.* § 493.

24. *Certified Copies, &c., to be Evidence.*

Written or printed copies of any records, books, papers, or drawings belonging to the patent-office, and of letters patent, authenticated by the seal and certified by the commissioner or acting commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor, and paying the fee required by law, shall have certified copies thereof. *Rev. Stat.* § 892.

Papers or drawings on file in the patent-office are public records, and certified copies of them are admissible in evidence; so far as they may be discordant, one may destroy the effect of the other; but they need not concur in every particular. *Emerson v. Hogg*, 2 *Blatchf.* 1, 12; *Toohy v. Harding*, 5 *Bann. & A. Pat. Cas.* 195.

The letters of the plaintiff to the secretary of state, containing applications for a patent, and specifications, certified under the seal of that department, as papers remaining in that office, were held proper evidence. *Pettibone v. Derringer*, 4 *Wash.* 215.

A certified copy from the patent office, of an assignment, is *prima facie* evidence of the genuineness of the original, and may be read in evidence to the jury. *Lee v. Blandy*, 1 *Bond*, 361;

2 *Fish. Pat. Cas.* 89 ; Brooks *v.* Jenkins, 3 *McLean*, 432 ; 2 *West. L. J.* 11.

Certified copies of papers in the patent-office must be received as *prima facie* evidence of the genuineness of the originals on file, and absolute correctness of the copies from the record. Parker *v.* Haworth, 4 *McLean*, 370.

A certified copy of a patent, surrendered and canceled, is admissible in evidence to show that an improvement subsequently patented is not original, though it does not specify when it was canceled, or how, or for what defect. Delano *v.* Scott, *Gilp.* 489.

Letters patent granted under the great seal of the government, are *prima facie* evidence that they have been regularly issued, (Philadelphia & Trenton R. R. Co. *v.* Stimpson, 14 *Pet.* 448 ; Wilder *v.* McCormick, 2 *Blatchf.* 31 ; Orr *v.* Badger, 7 *L. Rep'r*, 467 ;) and that the patentee has made the invention for which the patent is granted. Philadelphia & Trenton R. R. Co. *v.* Stimpson, 14 *Pet.* 448 ; Haskell *v.* Shoe Machinery Manuf. Co., 3 *Bann. & A. Pat. Cas.* 553 ; Konold *v.* Klein, 5 *Rep'r*, 427. They are also received as *prima facie* evidence of the facts asserted in them as to the novelty and utility of the invention patented. Corning *v.* Burden, 15 *How.* 252, 270 ; Union Sugar Refinery *v.* Matthiesson, 3 *Cliff.* 639 ; Wilson *v.* Barnum, 2 *Fish. Pat. Cas.* 635 ; 1 *Wall. Jr. C. Ct.* 346 ; Allen *v.* Hunter, 6 *McLean*, 303 ; Heinrich *v.* Luther, *Id.* 345. The patent is, however, but very slight evidence of the novelty and utility of an invention. Lowell *v.* Lewis, 1 *Mas.* 182.

The act of the commissioner in extending letters patent is evidence of all the facts which he is required to find in order to grant such extension, in the absence of fraud and excess of jurisdiction. Clum *v.* Brewer, 2 *Curt.* 506.

A joint patent is *prima facie* evidence that the invention was joint, but such fact may be disproved at the trial. Hotchkiss *v.* Greenwood, 4 *McLean*, 456 ; see *aff'ce*, 11 *How.* 248.

A signature to the certificate of copies by a person styling himself "acting commissioner," is sufficient on its face, in controversies between the patentee and third persons ; as the law recognizes an acting commissioner to be lawful. Woodworth *v.* Hall, 1 *Woodb. & M.* 248.

Under Rev. Stat. §§ 892, 893, a copy of a French patent, certified by the director of the National Conservatory of Arts and Manufactures, under its seal, and verified by the ministers of agriculture

and commerce, and of foreign affairs, under their seals, but not under the Great Seal of France, is properly authenticated, and admissible in evidence. *Schoerken v. Swift, &c. Co.*, 7 *Fed. Rep'r*, 469 ; 19 *Blatchf.* 209 ; 19 *Pat. Off. Gaz.* 1493.

If copies of a patent are erroneous, the commissioner ought to make them conform to the patent itself and to the record. *Woodworth v. Hall*, 1 *Woodb. & M.* 248, 260 ; 6 *Pa. L. J.* 178.

Inaccuracies in a transcript from the patent-office may be shown by another transcript, duly certified. *Brooks v. Jenkins*, 3 *McLean*, 432 ; 2 *West. L. J.* 11.

Patents are public records, and all persons are entitled to copies of them, upon demand made in a proper manner, and tender of the legal fees. *Boyden v. Burke*, 14 *How.* 575.

25. *Copies of Foreign Letters Patent.*

Copies of the specifications and drawings of foreign letters patent, certified as provided in the preceding section, shall be *prima facie* evidence of the fact of the granting of such letters patent, and of the date and contents thereof. *Rev. Stat.* § 893.

26. *Printed copies of Specifications and Drawings of Patents.*

The printed copies of specifications and drawings of patents, which the commissioner of patents is authorized to print for gratuitous distribution, and to deposit in the capitols of the States and Territories, and in the clerk's offices of the district courts, shall, when certified by him and authenticated by the seal of his office, be received in all courts as evidence of all matters therein contained. *Rev. Stat.* § 894. [See *Id.* § 490.]

27. *Annual Report of the Commissioner.*

The commissioner of patents shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys received for patents, for

copies of records or drawings, or from any other source whatever ; a detailed statement of all expenditures for contingent and miscellaneous expenses ; a list of all patents which were granted during the preceding year ; designating under proper heads the subjects of such patents ; an alphabetical list of all the patentees, with their places of residence ; a list of all patents which have been extended during the year ; and such other information of the condition of the patent-office as may be useful to congress or the public. *Rev. Stat.* § 494. [See *Id.* §§ 195, 196.]

28. *Disbursements for Patent-Office.*

All disbursements for the patent-office shall be made by the disbursing clerk of the interior department. *Rev. Stat.* § 496.

III. AUTHORITY FOR ISSUING PATENTS.

29. *How issued, attested and recorded:*

All patents shall be issued in the name of the United States of America, under the seal of the patent-office, and shall be signed by the secretary of the interior and countersigned by the commissioner of patents, and they shall be recorded, together with the specifications, in the patent-office, in books to be kept for that purpose. *Rev. Stat.* § 4883.

Only the government can raise the objection that the seal appearing regularly affixed to a patent was placed upon it without due authority ; the point is not available in defense of a suit upon the patent. *Doughty v. West*, 6 *Blatchf.* 429 ; 3 *Fish. Pat. Cas.* 580.

Patents cannot be withheld on moral grounds relating to the conduct of the applicant. 1 *Opp. Att. Gen.* 170. They cannot be granted to every applicant, but only to such persons as show them-

selves to be within the description of the statute, as entitled to receive one. 2 *Op. Att. Gen.* 511. In cases of doubt as to the patentability of an invention, it will accord with the policy of the law to issue a patent to the petitioner, thereby giving him an opportunity of trying the validity of his right. 2 *Opp. Att. Gen.* 52.

The commissioner of patents in issuing letters patent does not warrant the same, nor does the patent bind the government more than it does private persons; but the validity of such patent is open to inquiry, either in whole or in part, whether at the instance of private persons or of the government. A patent does not conclude anybody. 8 *Opp. Att. Gen.* 277.

A patent must be signed by the commissioner of patents and the secretary of the interior; if signed by the commissioner and not by the secretary, it is a nullity, though the omission be accidental. A patent thus erroneously signed cannot be sustained by the production of the record of the patent-office showing a complete patent; nor can it be amended by affixing the signature of the secretary's successor in office. *Marsh v. Nichols*, 15 *Fed. Rep'r*, 914; 24 *Pat. Off. Gaz.* 901.

30. *Contents and Duration.*

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

An inventor has a right to call his invention or patented article what he pleases, provided he do not assume an already existing and popular name, to the prejudice of those who have preoccupied the name. 2 *Op. Att. Gen.* 109.

31. *Embracing two Inventions in a single Patent.*

As a general rule, a single patent cannot embrace two devices which are wholly independent of each other; or embody distinct

improvements upon unconnected machines. But where two or more devices relate to one subject or are connected in nature and operation they may be secured by a single patent. *Hogg v. Emerson*, 6 *How.* 437 : aff'g *Emerson v. Hogg*, 2 *Blatchf.* 1 ; *Barrett v. Hall*, 1 *Mas.* 437 ; *Moody v. Fiske*, 2 *Mas.* 112 ; *Wyeth v. Stone*, 1 *Story*, 273 ; 4 *Law Rep.* 54 ; *Maxheimer v. Meyer*, 9 *Fed. Rep'r*, 460 ; 20 *Blatchf.* 17 ; 20 *Pat. Off. Gaz.* 1162 ; *Root v. Ball*, 4 *McLean*, 177.

Whether both process and product may be included in one patent. *Welling v. Rubber Coated, &c. Co.*, 7 *Pat. Off. Gaz.* 608 ; 97 *U. S.* 7 ; *Gage v. Kellogg*, 23 *Fed. Rep'r*, 891.

Whether an invention or improvement ought to be embraced in one or in several patents, is discretionary with the patent-office. *Bennett v. Fowler*, 8 *Wall.* 445 ; *McKay v. Dibert*, 5 *Fed. Rep'r*, 587 ; 19 *Pat. Off. Gaz.* 1351 ; 11 *Rep'r*, 386.

Rev. Stat. § 4884, by implication requires that each patent shall embrace but one invention. *Sessions v. Romadka*, 21 *Fed. Rep'r*, 124.

An inventor took out a patent, but in an action for an infringement thereof, it was proved that as to a part of the invention he was not the first inventor, and therefore the court held that his patent was void, as being too broad ; he afterward took out another patent for those parts of his invention not known before ; and it was then held, that the two patents were not for the same invention. *Treadwell v. Bladen*, 4 *Wash.* 703.

32. *Issuing several Patents for one Invention.*

A patentee cannot have in use at the same time two valid patents for the same invention. The first patent obtained by an inventor, while it remains unrepealed, is an estoppel to any future patent for the same invention. *Barrett v. Hall*, 1 *Mas.* 447 ; *Odiorne v. Amesbury Nail Factory*, 2 *Mas.* 28. If, however, several patents are taken out by several patentees for a several invention, and the same patentees afterward take out a joint patent for the same as a joint invention, the parties are not absolutely estopped by the former patents from asserting the invention to be joint, but the former patents are very strong evidence against the joint invention. *Barrett v. Hall*, 1 *Mas.* 449.

Where the patent-office grants a patent for one invention, and afterward, upon a claim filed previously to that on which such patent has been granted, issues another, the second patent, not the first is void. *Suffolk Co. v. Hayden*, 3 *Wall.* 315 ; 3rd *Circ. (Pa.)*, 1880,

McMillin v. Rees, 1 *Fed. Rep'r*, 722; 17 *Pat. Off. Gaz.* 1222; 9 *Rep'r*, 554; 5 *Bann. & A. Pat. Cas.* 269.

A patentee cannot claim in a patent the same thing claimed by him in a prior patent; nor cover what he omitted to claim in a prior patent in which the invention was described, unless he reserved the right to claim it in a separate patent, and seasonably applied therefor. *James v. Campbell*, 104 *U. S.* 356; rev'g 17 *Blatchf.* 42; 18 *Pat. Off. Gaz.* 979; 8 *Rep'r*, 455.

The issue of a design patent more than two years prior to the issue of a mechanical patent to the same patentee and for the same device does not invalidate the mechanical patent. *Collender v. Griffith*, 2 *Fed. Rep'r*, 206; 18 *Blatchf.* 110; 18 *Pat. Off. Gaz.* 241; 10 *Rep'r*, 8; 5 *Bann. & A. Pat. Cas.* 372.

When a person has, within the meaning of the patent law, made an invention which he has described in an application for a patent, and a patent has been issued on such application for other matters of invention, he should not be precluded for that reason alone from applying for and obtaining a patent for that which was described but not claimed in the first patent. *Graham v. Geneva Lake Crawford Manuf. Co.*, 11 *Fed. Rep'r*, 138; 21 *Pat. Off. Gaz.* 1536; *Graham v. McCormick*, 11 *Fed. Rep'r*, 859; 21 *Pat. Off. Gaz.* 1533; 10 *Biss.* 39; 5 *Bann. & A. Pat. Cas.* 244.

33. *Or for distinct Parts of the same Invention.*

Although there cannot be more than one valid patent for an invention, nor can the grantee of a patent sustain an action upon another patent for the same invention, issued afterward, yet separate patents for separate and distinct parts of the same invention are nevertheless valid. *Jones v. Sewall*, 3 *Cliff.* 563; 3 *Pat. Off. Gaz.* 630; 6 *Fish. Pat. Cas.* 343; and see reversal, 91 *U. S.* 171; also *Bain v. Morse*, 6 *West. L. J.* 372.

An inventor may have distinct patents for several distinct devices, although he may have included them in one, making a separate claim for each device. *Wheeler v. McCormick*, 4 *Pat. Off. Gaz.* 692.

Separate patents for severable parts of the same invention may be granted, although the whole invention is fully described in each of them to explain the purpose and mode of operation of the parts covered by the claims in such patents. *McMillan v. Rees*, 1 *Fed. Rep'r*, 722; 17 *Pat. Off. Gaz.* 1222; 9 *Rep'r*, 544; 5 *Bann. & A. Pat. Cas.* 269.

34. *Joint Inventors and Patents.*

A joint patent may well be granted for a joint invention. When an invention is the result of the combined mental operations of two persons acting together, as neither can claim to be the sole inventor, the invention is joint, and they are jointly entitled to a patent. *Barrett v. Hall*, 1 *Mas.* 447, 472. In other words, if the circumstances are such as to show that two parties contributed to an invention, so as to make them joint inventors, a joint patent should be taken out. *Thomas v. Weeks*, 2 *Paine*, 92; *Watson v. Bladen*, 4 *Wash.* 580; *Arnold v. Bishop*, 1 *Macar. & M.* 36; with which compare *Gottfried v. Philip Best Brewing Co.*, 17 *Pat. Off. Gaz.* 675; 5 *Bann. & A. Pat. Cas.* 4; *Worden v. Fisher*, 11 *Fed. Rep'r*, 505; 21 *Pat. Off. Gaz.* 1957. Hence, where two are joint inventors of a machine, if one of them, without acquiring the other's interest, obtains a patent in his own name, he will be deemed guilty of fraud, and will in equity be considered as a trustee for the other. *Reutgen v. Kanowrs*, 1 *Wash.* 168. And where there was a mutual agreement between a patentee and the inventor of an improvement upon his device, that the patentee should surrender his individual right, and a new patent for the improved device should be applied for by the two parties jointly, it was *held*, that in equity they were joint owners of the patent as improved by the subsequent invention, and that the inventor of the improvement could restrain the patentee from using his patent except for their joint benefit. *Duke v. Graham*, 19 *Fed. Rep'r*, 647.

But a joint patent cannot be sustained upon a sole invention of either of the patentees, for the patent act gives no right to a patent except to the inventor; and no person can be at the same time the sole and a joint inventor of the same invention. *Barrett v. Hall*, 1 *Mas.* 447, 472. Where one of two persons claiming as joint inventors had transferred his interest in the invention to the defendants, who also owned, by assignment from the rival inventor, the patent upon which the joint application was rejected; and the bill (which was filed after rejection of plaintiff's application on an interference, to obtain a decree for a patent) treated the defendants as wrongful and fraudulent holders of their patent, and ignored wholly their rights to any interest in the invention, it was *held*, that the patent should not be issued to the joint inventors, for a court of equity will not aid the inventor to obtain a patent in direct violation of his agreement transferring the property in his invention. *Runstetler*

v. Atkinson, 23 *Pat. Off. Gaz.* 940; 1 *Macar. & M.* 382. Where a patent was issued to B., J. and L., jointly, in conformity to their application as joint inventors, when in fact the device patented was not the joint invention of all of the applicants, but the sole invention of B., the others (J. and L.) being his assignees only,—*Held*, that it was not within the power of the interior department to correct the patent thus issued so as to show that B. was the inventor of the device and that J. and L. are the assignees thereof; the patent issued upon such application being void, the department cannot, by means of alterations or corrections, impart validity thereto. 16 *Op. Att. Gen.* 116

35. *Date of Patent.*

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

It has been held that to antedate a patent is not unlawful, unless special circumstances render it so, as where it might override an intermediate improvement by another person (5 *Op. Att. Gen.* 722); indeed, the Act of 1836 expressly allowed it within limits (*Re Cushman*, 1 *Macarthur Pat. Cas.* 577), and under that Act an infringer might, in a proper case, be held liable for profits realized between the nominal date of the patent and the actual issue, *Burdett v. Esty*, 3 *Fed. Rep'r*, 566; 19 *Blatchf.* 1. But the present rule of the patent-office is that a patent will not be antedated. *Rules of Prac.* No. 161. Were a patent antedated to be issued by mistake, and accepted by the patentee, it might probably be sustained, as towards an infringer, upon the principle that the error operated as a waiver of part of the term (*Re Cushman, supra*; also, *Op. Att. Gen.* Gilp. ed. 168); though no similar suggestion can be made in behalf of a patent which should be inadvertently dated *after* the time allowed by law. Compare the copyright cases: *Myers v. Callaghan*, 10 *Biss.* 139; *Baker v. Taylor*, 2 *Blatchf.* 82.

36. *Delivery.*

The patent will be delivered or mailed, on the day of its date, to the patentee, unless there be an attorney of record, in which case it

will be delivered to him or the patentee, as the attorney may request; but it will not, without a special request to that effect, be delivered to an associate or substitute attorney. *Rules of Practice*, No. 163.

37. *Correction of Errors.*

Where a mistake, incurred through the fault of the office, is clearly disclosed by the records or files of the office, a certificate, showing the fact and nature of such mistake, signed by the secretary of the interior, countersigned by the commissioner of patents, and sealed with the seal of the patent-office, will, at the request of the patentee or his assignee, be indorsed without charge upon the letters patent, and recorded in the records of patents, and a printed copy thereof attached to each printed copy of the specification and drawings.

Where a mistake, incurred through the fault of the office, constitutes a sufficient legal ground for a reissue, such reissue will be made, for the correction of such mistake only, without charge of office fees, at the request of the patentee.

Mistakes not incurred through the fault of the office, and not affording legal grounds for reissues, will not be corrected after the delivery of the letters patent to the patentee or his agent.

No changes or corrections will be made in letters patent after the delivery thereof to the patentee or his agent, except as above provided. *Rules of Practice*, No. 164.

38. *Suit by United States to Annul Patent Fraudulently Obtained.*

Where a patent is obtained from the United States by fraud, the proper remedy is a simple bill in equity brought by the United States against the defendant, praying that the patent be annulled and surrendered by a decree in chancery, without any attempt of assimilating the proceeding to an information brought by the attorney-general on behalf of the crown, in England, to repeal a patent. *United States v. Hughes*, 11 *How.* 552; *Mowry v. Whitney*, 14 *Wall.* 434; *Attorney-General v. Rumford Chemical Works*, 9 *Pat. Off. Gaz.* 1062.

There is no distinction between letters patent for an invention and for land, as regards the rights and remedies for vacating them when obtained by fraud. The right is the same as that which a

State has, to annul the charter of a corporation created by its legislature, if obtained by fraud. *United States v. Gunning*, 18 *Fed. Rep'r*, 511; 16 *Rep'r*, 741; 21 *Blatchf.* 516; 26 *Pat. Off. Gaz.* 356; *United States v. Throckmorton*, 98 *U. S.* 61.

A suit to set aside, annul or declare void a patent issued by the government, except in cases where two patents have been granted for the same thing, cannot be sustained unless brought in the name of the government, or by the authority or permission of the attorney-general, so as to be under his control. History of the remedies by *scire facias* and bill in equity, reviewed. *Mowry v. Whitney*, 14 *Wall.* 434.

Proceedings to annul letters patent are wholly within the control of the United States attorneys; there is no absolute duty imposed upon them to commence such proceedings at the request of any party who declares a patent to be invalid. *New York, &c. Coffee Polishing Co. v. New York Coffee Polishing Co.*, 9 *Fed. Rep'r*, 578; 20 *Blatchf.* 174; modified, 11 *Fed. Rep'r*, 813.

A bill in equity stated that it was brought by the United States at the relation of certain persons, and did not state that the United States brought it by their district attorney, but was subscribed by other persons as solicitors for the plaintiffs; and the prayer was that certain letters patent of the United States issued to the defendant might be surrendered to be canceled. It was *held*, on demurrer, that the bill was bad, as not stating a case which entitled the United States to the relief sought. *United States v. Doughty*, 7 *Blatchf.* 424.

Upon demurrer to a bill in equity filed in the name of the United States to annul a patent on the ground that the patentee, in his application for the patent, falsely made an affidavit that the device for which the patent was asked had not been previously known and used, the device having in fact been fully described in a previous patent issued to him and long since expired, it appeared that the use of the name of the United States in the suit had been procured by persons specially and directly interested in defeating the patent, but to whom the matters alleged would be a complete defense to any action against them on the patent; and that they had indemnified the United States against all costs of the suit. *Held*, that the bill should be dismissed for want of equity. *United States v. Frazer*, 22 *Fed. Rep'r*, 106.

The United States cannot be heard to ask an injunction restraining the commencement or prosecution of suits for infringement of

a patent for the repeal of which they have begun an action, *United States v. Colgate*, 21 *Fed. Rep'r*, 318; 22 *Blatchf.* 412.

A bill in equity to set aside a patent for the fraud of the alleged inventor in obtaining it, was *held* sustained in the particular case by evidence showing that he was not, and knew that he was not, the original inventor. *United States v. Gunning*, 22 *Fed. Rep'r*, 653; S. C. on rehearing, 23 *Id.* 668 ; 32 *Pat. Off. Gaz.* 1468.

IV. WHO MAY OBTAIN PATENTS; AND FOR WHAT.

39. *The general Statutory Definition.*

Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor. *Rev. Stat.* § 4886.

40. *What constitutes Inventing.*

The application by a patentee of an old process to a new subject without any exercise of the inventive faculty, and without the development of any idea which can be deemed new or original in the sense of the patent laws, is not the subject of a patent. *Brown v. Piper*, 91 *U. S.* 37.

The design of the patent laws is to reward those who make some substantial discovery or invention which adds to human knowledge, and advances the useful arts; they do not grant a monopoly for every trifling device, every shadow of an idea, such as may naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures, or be gleaned by a speculator from watching the progress of science. *Atlantic Works v. Brady*, 107 *U. S.* 192; 2 *Sup. Ct. Rep'r*, 225.

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; nor do illustrated drawings of conceived ideas constitute an invention. *Draper v. Potomaska Mills Corp.*, 13 *Pat. Off. Gaz.* 276; 3 *Bann. & A. Pat. Cas.* 214.

A mere suggestion that a given result can be obtained is not patentable, and does not anticipate a patent by another; but some mechanism or design by which the suggested result is obtained must be described. A patent issued upon a mere suggestion, and without proper description of mechanism or design, does not constitute a good plea for want of novelty in a valid patent. *Graham v. Gammon*, 7 *Biss.* 490.

The accidental making of an improved article, in a single instance, without knowledge on the part of the producer of how to accomplish it, or to produce another like it, is not invention. *Pelton v. Waters*, 7 *Pat. Off. Gaz.* 425.

As to what constitutes inventing, considered as a mental process within the protection of the patent laws, see *McCormick v. Seymour*, 2 *Blatchf.* 240; and 3 *Blatchf.* 209; *Teese v. Phelps*, *McAll.* 48; *Devoll v. Brown*, 3 *West. L. J.* 151; *Forbush v. Cook*, 10 *L. Rep'r, N. S.* 664; *Detmold v. Reeves*, 1 *Fish. Pat. Cas.* 127; *Howe v. Underwood*, *Id.* 160; *Matthews v. Skates*, *Id.* 602; *Rich v. Lippincott*, 2 *Fish. Pat. Cas.* 1; *Ellithorpe v. Robertson*, *Id.* 83; *Magic Ruffle Co. v. Douglas*, *Id.* 330; *Union Manuf. Co. v. Lounsbury*, *Id.* 389; *White v. Allen*, *Id.* 440; *Waterman v. Thompson*, *Id.* 461; *Hotchkiss v. Greenwood*, 4 *McLean*, 456.

41. *Who is a "Person who has Invented," &c.*

Whoever first brings a machine to perfection and makes it capable of useful operation is the real inventor and entitled to the patent; although others may previously have had the idea, and made some experiments toward putting it in practice. *Agawam Co. v. Jordan*, 7 *Wall.* 583.

Inquiries made, or information or advice received from men of science, in the course of an inventor's researches, will not impair his right to the character of an inventor. It makes no difference whether an inventor derives his information from books, or from conversation with men skilled in science. *O'Reilly v. Morse*, 15 *How.* 62, 111.

If one suggests an idea as to an invention, which is indispensable to its operation, and which in reality constitutes its whole value, and another adopts such suggestion and takes out a patent therefor, the patent is void ; the invention not being his. *Thomas v. Weeks*, 2 *Paine*, 92.

A person, to be entitled to the character of an inventor, must himself have conceived the idea embodied in his improvement. If, however, he is aided by the suggestion of others in arriving at the useful result, and if, after all the suggestions, there was something left for him to devise and work out by his own skill and ingenuity, he is still to be regarded as the first and original discoverer. But if the suggestions and communications of others go to make up a complete and perfect machine, embodying all that is embraced in the patent subsequently issued to the party to whom the suggestions were made, the patent is invalid. *Pitts v. Hall*, 2 *Blutchf.* 229.

Merely improving the conceptions of another by change in form, proportion or degree, is not such an invention as will sustain a patent. *Theberath v. Rubber, &c. Harness Trimming Co.*, 15 *Ed. Rep'r*, 246; 23 *Pat. Off. Gaz.* 1121.

42. *This Question, between Employer and Workman.*

If a person employed in the manufactory of another, while receiving wages, makes experiments at the expense and in the manufactory of the 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 for it, the patent is invalid and void. *McClurg v. Kingsland*, 1 *How.* 202; *Worley v. Tobacco Co.*, 104 *U. S.* 340.

Persons employed, as well as employers, are entitled to their own independent inventions ; but where the employer has conceived the plan of an invention, and is engaged in experiments to perfect it, no suggestions of an employe, not amounting to a new method or arrangement which in itself is a complete invention, are sufficient to deprive the employer of the exclusive property in the perfected improvement. *Agawam Co. v. Jordan*, 7 *Wall.* 583.

An improvement which becomes necessary in the manufacture of a patented improvement, in order to overcome a difficulty growing out of a departure from the model, and which is introduced into it by the workmen, without the knowledge of the patentee, cannot be appropriated by him as his invention. If such an improve-

ment is embodied by the assignees of the patentee in a reissue, they cannot recover upon it, against others who use it. *Berdan Fire Arms Manuf. Co. v. Remington*, 3 *Pat. Off. Gaz.* 688.

The fact that a mechanic or workman employed by one who has devised the idea of a new invention, to make experiments, construct machinery or models, or otherwise to aid in reducing the idea to practice, has suggested improvements in the plan, will not deprive the inventor of the merit of the invention, nor affect the validity of the patent if they are embraced within it. *Pennock v. Dialogue*, 4 *Wash.* 538; *aff'd*, 2 *Pet.* 1; *Watson v. Bladen*, 4 *Wash.* 580.

One who is the first discoverer of a process is entitled to a patent therefor, even against one in whose employ he was at the time of the discovery, and at whose request and expense he was making experiments which led to the discovery. *Damon v. Eastwick*, 14 *Fed. Rep'r*, 40; 14 *Rep'r*, 644; 22 *Pat. Off. Gaz.* 1709.

If an inventor furnishes the idea to produce the result, he is entitled to avail himself of the mechanical skill of others to carry out his contrivance in practice. Thus where the plaintiffs devised designs for oilcloths, which were carried out by another person,—*Held*, that the plaintiffs, and not the pattern-maker, were the inventors. *Sparkman v. Higgins*, 1 *Blatchf.* 205; 5 *N. Y. Leg. Obs.* 122; 6 *Pa. L. J.* 344.

An employe who, before obtaining a patent for a device, introduces the device into his employers' business without their consent, and without a special agreement to pay him, and who develops his invention and brings it to a practical condition at the employers' expense, is not entitled, after obtaining a patent therefor, to royalties or profits, and damages from the employers for the use by them of the tools so introduced into their business. *Barry v. Crane Bros. Manuf. Co.*, 22 *Fed. Rep'r*, 396.

One to whom the conception of an invention belongs has the right to the invention, although others contribute, at his request, the necessary mechanical skill to embody it in an operative form. He does not thereby lose the merit due to inventive suggestiveness. *Yoder v. Mills*, 25 *Fed. Rep'r*, 821.

43. *Mere change in Materials, Form, &c. not enough.*

A mere change in the form of a machine, or in the proportions of its parts; or the mere substitution of one mechanical equivalent

for another; or an alteration in unimportant parts, causing no substantial change in the principle of operation, does not constitute an invention such as can be the subject of a patent. *O'Reilly v. Morse*, 15 *How.* 62; *Winans v. Denmead*, *Id.* 330; *Woodcock v. Parker*, 1 *Gall.* 438; *Lowell v. Lewis*, 1 *Mas.* 182; *Carver v. Braintree Manuf. Co.*, 2 *Story*, 432; *Bean v. Smallwood*, *Id.* 408; *Devoll v. Brown*, 3 *West. L. J.* 151; *Forbush v. Cook*, 10 *L. Rep'r, N. S.* 664; *Blanchard's Gun-stock Turning Factory v. Warner*, 1 *Blatchf.* 258; *Buck v. Hermance*, *Id.* 398; *Hall v. Wiles*, 2 *Blatchf.* 194; *McCormick v. Seymour*, *Id.* 240; *rev'd on other points*, 16 *How.* 480; *Tracy v. Torrey*, 2 *Blatchf.* 275; *American Pin Co. v. Oakville Co.*, 3 *Blatchf.* 190; 3 *Am. L. Reg.* 136; *McCormick v. Seymour*, 3 *Blatchf.* 209; *aff'd*, 19 *How.* 96; *Whitney v. Emmett*, *Baldw.* 303; *Davis v. Palmer*, 2 *Brock. Marsh.* 298; *Stanley v. Whipple*, 2 *McLean*, 35; *Smith v. Pearce*, *Id.* 176; *McCormick v. Manny*, 6 *McLean*, 539; 4 *Am. L. Reg.* 277.

A mere carrying forward a new or more extended application of the original thought, a change only in form, proportions, or degree, doing substantially the same thing in the same way, by substantially the same means, with better results, is not such an invention as will sustain a patent. *Smith v. Nichols*, 21 *Wall.* 112; *aff'g* 1 *Holmes*, 172; 6 *Fish. Pat. Cas.* 61; 2 *Pat. Off. Gaz.* 649; *Roberts v. Ryer*, 91 *U. S.* 150. S. P., *Putnam v. Yerrington*, 9 *Pat. Off. Gaz.* 689.

The mere change in an instrument or machine of one material into another,—as substituting iron for wood, or wood strengthened with iron,—is not “invention” in the sense of the patent laws, and not the subject of a patent; the purpose and means of accomplishment, and form and mode of operation of each instrument—the new as of the old—being each and all the same. The new instrument being better than the old one does not alter the case; it does not bring the case out of the category of more or less excellence of construction. *Hicks v. Kelsey*, 18 *Wall.* 670. S. P., *Crouch v. Roemer*, 103 *U. S.* 797; *Stow v. Chicago*, 8 *Biss.* 47; 3 *Bann. & A. Pat. Cas.* 83; *aff'd*, 104 *U. S.* 547.

There must be difference in principle to constitute a patentable difference. A mere change of form will not do, unless form is a part of the thing invented, and is essential to its value. Where, however, the form is a material part of the discovery and is essential to its value, then a departure from the form would be a substantial

departure. *Many v. Jagger*, 1 *Blatchf.* 372. S. P., 1st *Circ.* (Mass.), 1814, *Odiorne v. Winckley*, 2 *Gall.* 51.

A new mode or method of doing a thing, or producing an old result, may be protected by a patent. *Whitney v. Emmett*, *Baldw.* 303; 7th *Circ.* (Ohio), 1835, *Heinrich v. Luther*, 6 *McLean*, 345.

It is no new invention to use an old machine or process for a new purpose. The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not. *Evans v. Eaton*, 7 *Wheat.* 353; aff'g 3 *Wash.* 443; 1875, *Roberts v. Ryer*, 91 *U. S.* 150. See also, *Ames v. Howard*, 1 *Sumn.* 482; *Howe v. Abbott*, 2 *Story*, 190; *Winans v. Boston & Providence R. R. Co.*, *Id.* 412; *Matter of Arkell*, 15 *Blatchf.* 437; *Crandall v. Watters*, 9 *Fed. Rep'r.* 659; 20 *Blatchf.* 97; 21 *Pat. Off. Gaz.* 945; *Western Electric Manuf. Co. v. Ansonia Brass, &c. Co.*, 9 *Fed. Rep'r.* 706; 20 *Blatchf.* 170; *Couse v. Johnson*, 16 *Pat. Off. Gaz.* 719; 4 *Bann. & A. Pat. Cas.* 501; *Rowell v. Lindsay*, 6 *Fed. Rep'r.* 290; 10 *Biss.* 217; 19 *Pat. Off. Gaz.* 1565.

A novelty in principle may consist in a new and valuable mode of applying an old power; effecting it not merely by a new instrument or form of the machine, or any mere equivalent, but by something giving it a new or greater advantage. *Hovey v. Stevens*, 1 *Woodb. & M.* 290.

Where an invention involves a new result first thought of by the patentee, the fact that the mechanical changes by which the result is produced are not difficult, is not necessarily important. *Stewart v. Mahoney*, 5 *Fed. Rep'r.* 302; 4 *Bann. & A. Pat. Cas.* 84.

While a patent may hardly be sustained for a process or method which consists only in applying an old machine to a new use, it will only be supported when the new use is so remote from the old use that it is evident that a new idea has been discovered. *Mossitt v. Rogers*, 8 *Fed. Rep'r.* 147.

A new adaptation and arrangement of applying and using old articles for a certain purpose may be the subject of letters-patent. *Blake v. Sperry*, 2 *N. Y. Leg. Obs.* 251.

The application of a thing already known to a new and useful purpose may be the subject of a patent, provided the new use is not analogous to the old, and requires the exercise of the inventive faculties. *Winans v. Schenectady & Troy R. R. Co.*, 2 *Blatchf.* 279.

It is the development of something new, and not the arrival at comparative superiority or greater excellence in that which was always known, which the law protects as exclusive property, and which it secures by patent. *Putnam v. Yerrington*, 9 *Pat. Off. Gaz.* 680. But a result which required calculation and experiment beyond mechanical skill and good workmanship is entitled to be classed as inventive. *Davis v. Fredericks*, 19 *Fed. Rep'r*, 99. There cannot, however, be a patent for a mere form, unless the form is of the essence of the invention. *Wilson Packing Co. v. Clapp*, 8 *Rep'r*, 262. Thus, merely reducing the size of a thing in common use, though with effect to render it available for a new use, cannot support a claim to a patent. *Double Pointed Tack Co. v. Mann*, 5 *Bann. & A. Pat. Cas.* 465.

44. *Discovery of a Principle, Law, or Fact.*

The discovery of an abstract principle, of a theory or fact, of a new property of matter, such as the anæsthetic effect of ether, or of a new power in nature, such as steam or electricity, unless carried on to the contriving and development of a practical machine, method or process for rendering such discovery available and useful in affairs is not patentable; the law does not enable a person to acquire an exclusive right in a natural principle, power or fact merely because he has been the first to observe it. *Leroy v. Tatham*, 14 *How.* 156, 175; *Burr v. Duryea*, 1 *Wall.* 531; *Lowell v. Lewis*, 1 *Mas.* 182; *Barrett v. Hall*, *Id.* 447; *Blanchard v. Sprague*, 3 *Summ.* 535; *Stone v. Sprague*, 1 *Story*, 270; *Wyeth v. Stone*, *Id.* 273; 4 *L. Rep'r*, 54; *American Bell Telephone Co. v. Dolbear*, 15 *Fed. Rep'r*, 448; 23 *Pat. Off. Gaz.* 535; 28 *Alb. L. J.* 69; *Morton v. New York Eye Infirmary*, 5 *Blatchf.* 116; 2 *Am. L. Reg.* 672; 2 *Fish. Pat. Cas.* 320; 8 *Op. Att. Gen.* 269; *Piper v. Brown*, 4 *Fish. Pat. Cas.* 175; 3 *Pat. Off. Gaz.* 97; *New Process Fermentation Co. v. Maus*, 20 *Fed. Rep'r*, 725; *Bain v. Morse*, 6 *West. L. J.* 372; *Grant v. Mason*, 1 *L. Inst. & Rev.* 22; *Sickles v. Borden*, 3 *Blatchf.* 535; *Evans v. Eaton*, *Pat. C. Ct.* 322, 341; *Whitney v. Emmett*, *Bohler*, 303.

When the discovery of a principle, law or fact is coupled with the devising of an apparatus, process or method by which the new property of nature is made useful to man in the production of things or effects not known before, there is a patentable invention. In all such cases, the processes used to extract, modify, and concentrate natural agencies, constitute the invention. The elements of

the power exist; the invention is not in discovering them, but in applying them to useful objects. The principle may be the new and valuable discovery, but the practical application of it to some useful purpose is the test of its value. *Leroy v. Tatham*, 14 *How.* 156, 175; *American Bell Telephone Co. v. Dolbear*, 15 *Fed. Rep'r*, 448; 23 *Pat. Off. Gaz.*, 535; 28 *Alb. L. J.* 69. In other words, where the discoverer of a new principle or force has gone beyond the mere domain of discovery, and has laid hold of the new principle, force, or law, and connected it with some particular medium or mechanical contrivance by which or through which it acts on the material world, then he can secure the exclusive control of it under the patent law, through the means by which he has brought it into practical action; for it is then an invention, although it embraces a discovery. Every invention may, in a certain sense, embrace more or less of discovery, for it must always include something that is new; but it by no means follows that every discovery is an invention. *Morton v. New York Eye Infirmary*, 5 *Blatchf.* 116; 2 *Am. L. Reg.* 672; 2 *Irish. Pat. Cas.* 320. He who has discovered some new element or property of matter may secure to himself the ownership of his discovery so soon as he has been able to illustrate it practically and to demonstrate its value. His patent in such case will be commensurate with the principle which it announces to the world, and may be as broad as the mental conception itself. But the mental conception must have been embodied in some mechanical device or some process of art. The patent must be for a thing, not for an idea merely. *Detmold v. Reeves*, 4 *Am L. J. N. S.* 188. Thus, where a patentee claimed the application of the expansive and contractive power of a metal rod, by various degrees of heat, to open and close a damper governing the admission of air into a stove, it was *held*, that this claim was not one for a mere principle, and that the patent was good. *Silsby v. Foote*, 20 *How.* 375; *aff'g* 2 *Blatchf.* 260. Likewise, where a person discovered that articulate sounds could be transmitted by undulatory vibrations of electricity, and invented the art or process of transmitting such sounds by means of such vibration, it was *held* that the mere fact that such art or process is the only way by which speech can be transmitted by electricity, did not lessen the merit of the invention, or the protection which the patent law would give to it. *American Bell Telephone Co. v. Dolbear*, 15 *Fed. Rep'r*, 448; 23 *Pat. Off. Gaz.* 535; 28 *Alb. L. J.* 69.

But, generally, in these cases, to entitle the discoverer of a prin-

ciple, force or fact to a patent he must give such a description of a method or apparatus or process for making his discovery practically available in producing results new and useful to man as will enable skillful persons to produce them.

45. Discoveries of "Processes."

Although "processes" are not by that name declared patentable, yet the law embraces them; and its application to them has been explained in leading cases in the Supreme Court. Processes are included under the general term "useful arts." And an art may require one or more processes or machines in order to produce a certain result or manner. The term "machine" includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. But where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods or operations are called "processes." A new *process* is usually the result of discovery; a *machine*, of invention. The arts of tanning, dyeing, making water-proof cloth, vulcanizing India-rubber, smelting ores, &c., are usually carried on by processes, as distinguished from machines. One person may discover an improvement in a process, irrespective of any particular form of machinery; and another may invent a labor-saving machine, by which the operation or process may be performed, and each may be entitled to a patent—the first for the process, but not for a machine; the second for a machine, but not for a process. It is when the term "process" is used to represent some means or method of producing a result that a process is patentable, and the term thus used includes all means or methods which are not effected by mechanism or mechanical combination. *Corning v. Burden*, 15 *How.* 252, 263. Again, it is said that the term "process" is often used in a more vague sense; as when one says that a board is undergoing the process of being planed, grain is under the process of being ground, iron under that of being hammered, or cooled. In this use of the term it represents the function of a machine, or the effect produced by it on the material subjected to its action. A "process," using the term in this sense, cannot be the subject of a patent. *Ib.* But in the more technical sense of a mode of treatment of certain materials to produce a given result, or an act or a series of acts, performed upon the subject-matter, to transform and reduce it to a different state or thing, a process, if

new and useful, is just as patentable as is a machine. In the language of the patent law, it is an "art."

And a process may be patentable, irrespective of the particular form of the instrumentalities used. If one of the steps of a process be that a certain substance is to be reduced to a powder, it may not be at all material what instrument or machinery is used to effect that object, whether a hammer, a pestle and mortar, or a mill. Either may be pointed out; but (if the patent is not confined to that particular tool or machine), the use of the other would be an infringement, the general process being the same. So the machinery pointed out as suitable to perform the process may or may not be new or patentable, whilst the process itself may be altogether new, and produce an entirely new result. The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence. *Cochrane v. Deener*, 94 *U. S.* 780.

A patent may be granted for a process, irrespective of the particular mode or form of apparatus for carrying it into effect; but in order that such patent be valid, the patentee should be the first and original inventor of the process, and claim it in his application as granted. If the means of carrying it out are not obvious to ordinary mechanics skilled in the art, the specification should describe some mode of carrying it out which will produce a useful result. *Tighlman v. Proctor*, 102 *U. S.* 707.

Where a result or effect is produced by mechanical action, a patent can ordinarily only be for the mechanical appliances or means employed; where the result is attained or effect produced by chemical action, by the operation or application of some element or power of nature, or of some property in matter, or of one substance to another, then the patent may be for the art, process, or method. *Piper v. Brown*, 4 *Fish. Pat. Cas.* 175; 3 *Pat. Off. Gaz.* 97. The discoverer of a new art is entitled not to the abstract right to the art without regard to the means, but to all means and processes which he has both invented and claimed (*American Bell Telephone Co. v. Spencer*, 8 *Fed. Rep'r*, 509; 20 *Pat. Off. Gaz.* 299); for although a mere principle is not patentable, and a patent will not be issued to the discoverer of a natural force or scientific fact, yet the inventor of a process by which a certain effect of one of the forces of nature is made useful to mankind is entitled to a patent, and he is not restricted to any particular form of mechanism or apparatus by which the process is carried out. A subsequent

inventor of an improved form or apparatus embodying the same process is entitled to a patent for the apparatus, but he must obtain the consent of the inventor of the process before using that process in his apparatus. *American Bell Telephone Co. v. Dolbear*, 15 *Fed. Rep'r*, 448; 23 *Pat. Off. Gaz.* 535; 28 *Alb. L. J.* 69. A new process or method of operation is patentable, when it amounts to a successful application of known things; and the patent is *prima facie* evidence of novelty of the invention. *Roberts v. Dickey*, 4 *Brewst.* 260; 3 *Pittsb.* 352; 1 *Pat. Off. Gaz.* 4; 4 *Fish. Pat. Cas.* 532.

What is such a process as may be the subject of a patent, see *New Process Fermentation Co. v. Maus*, 20 *Fed. Rep'r*, 725; *MacKay v. Jackman*, 12 *Fed. Rep'r*, 615; 20 *Blatchf.* 466; 22 *Pat. Off. Gaz.* 85.

46. *Patentability of Effects and Products.*

An end to be accomplished or a result to be produced, is not patentable independently of some new and useful means, process, machinery, &c., devised for accomplishing it. To allow a mere effect or result to be patented, would enable persons to engross results and prohibit all other persons from producing them by any means whatever; which would discourage rather than promote the progress of useful arts. *Carver v. Hyde*, 16 *Pet.* 513; *Leroy v. Tatham*, 14 *How.* 156, 175; *O'Reilly v. Morse*, 15 *How.* 62, 112; *Whittemore v. Cutter*, 1 *Gall.* 478; *Howe v. Abbott*, 2 *Story*, 190; *New Process Fermentation Co. v. Maus*, 20 *Fed. Rep'r*, 725; *Bain v. Morse*, 6 *West. L. J.* 372; *Re Merrill*, 1 *McArt. r.*, 301.

Thus, a patentee cannot have a patent to protect "the motive power of electro-magnetism, *however developed*, for marking characters at a distance;" his patent must be confined to the manner and process described and invented by him. *O'Reilly v. Morse*, 15 *How.* 62, 112. So no patent can be obtained for the admeasurement of time, or the expansive operations of steam; but only for a new mode of new application of machinery to produce these effects; and, therefore, if new effects are produced by an old machine in its unaltered state, no patent can be legally supported, for such patent is for an effect only. *Whittemore v. Cutter*, 1 *Gall.* 478. A patent for a ruffle to be made by machinery cannot be sustained where the ruffle is identical, in mechanical construction, with a ruffle before made, although the machinery, or the process it works, performs at one operation what before required more than one; for the product

of a machine is not patentable merely because the machine makes an already known article more perfectly than it has been, or can be made without a machine. *Wooster v. Calhoun*, 11 *Blatchf.* 215 ; 6 *Fish. Pat. Cas.* 514. But printing, by copper-plate or letter-press, on both sides of bank-notes, to prevent their counterfeiting, is an art for which a patent will be granted ; such a patent is not a patent for an *effect*, but for the method of printing by which the effect is produced. *Kneass v. Schuylkill Bank*, 4 *Wash.* 9. The proper mode of enameling the proper quality of paper to enable a turned-down or folded collar to be made wholly of paper, without any danger of crumbling or breaking the enamel by the operation of folding, is a patentable invention ; the collar made from such enameled paper being a new article of manufacture. *Hoffman v. Stiefel*, 7 *Blatchf.* 58 ; 3 *Fish. Pat. Cas.* 638.

He who produces an old result by a new mode or process is entitled to a patent for the mode or process (*Howe v. Abbott*, 2 *Story*, 190); and although an inventor has obtained a patent for a process, he may have another for the product, if new. *Jones v. Sewall*, 3 *Cliff.* 583 ; 6 *Fish. Pat. Cas.* 343 ; 3 *Pat. Off. Gaz.* 630. A patentee who has invented a new process in the arts, whereby an article of manufacture is produced, new in kind and not before known, may separately claim and patent both the art and the manufacture ; he cannot indeed properly combine them in one claim ; but he may claim broadly the new product, however made, or may claim the new product when made by his described process. *Merrill v. Yeomans*, 1 *Holmes*, 331. But the fact that the product is new as an article of commerce, is not enough to warrant granting a patent ; there must have been an exercise of invention in devising the means of producing it. There is no inventing in reducing an article formerly sold in chunks to a powder—comminuting glue—when it is not improved by adding some new ingredient, or by subtracting one or more. *Milligan, &c. Glue Co. v. Upton*, 6 *Pat. Off. Gaz.* 837. The process of making and the article made are, in legal contemplation, distinct inventions, which may both be included in a single patent, though a full, clear and exact description, according to the statute, is indispensable in each case. *Kelleher v. Darling*, 14 *Pat. Off. Gaz.* 673.

47. *Machines.*

If the principles of a machine are new, to produce either a new or an old effect, the inventor is entitled to the exclusive right of the

whole machine. And by "the principles of a machine," as here used, is meant not the original, elementary principles of motion, which philosophy and science have discovered, but the *modus operandi*, the peculiar manner or device of producing any given effect. If two machines produce the same effects, by the same mode of operation, the principles of the two are the same; if the same effects are produced by combinations of machinery operating substantially in a different manner, the principles are different. Where a specific machine already exists, producing certain effects, if a mere addition is made to such machine to produce the same effects in a better manner, a patent cannot be taken out for the whole machine, but for the improvement only; on the other hand, if well-known effects are produced by machinery, in all its combinations *entirely new*, a patent may be claimed for the whole machine. *Whittemore v. Cutter*, 1 *Gall.* 478.

Inventions pertaining to machines may be divided into four classes. 1. Where the invention embraces the entire machine, as a car for a railway, or sewing-machine. Such inventions are seldom made; but when made and duly patented, any person is an infringer who, without license, makes or uses any portion of the machine. Under such a patent the patentee holds the exclusive right to make and use, and vend to others to be used, the entire machine; and if another, without license, makes, uses, or vends any portion of it, he invades the right of the patentee. 2. Those which embrace one or more elements of a machine, but not the entire machine, as the coulter of a plow, or the divider of the reaping-machine. In patents of that class, any person may make, use, or vend all other parts of the machine, and he may employ a coulter or divider in the machines mentioned, provided it be substantially different from that embraced in the patent. 3. Those which embrace both a new element and a new combination of elements previously used and well known. The property of the patentee in such a case consists in the new element and in the new combination. No one can lawfully make, use, or vend a machine containing such new element or such new combination. They may make, use or vend the machine without the patented improvements, if it is capable of such use, but they cannot use either of those improvements without making themselves liable as infringers. 4. Those where all the elements of the machine are old, and where the invention consists in a new combination of those elements, whereby a new and useful result is obtained. Most of the modern inventions are of this latter class, and many of them are of

great utility and value. The rule is, that the property of an inventor, if duly secured by letters patent, is in all cases exactly commensurate with his invention. Such an invention, however, is but an improvement on an old machine, and consequently the patentee cannot treat another as an infringer who has also improved the original machine by the use of a substantially different combination, although the machine may produce the same result. But every inventor is entitled to the full benefit of his invention as described and secured in his patent, and no one charged with infringing the same can successfully defend himself against the charge, merely because the machine he makes, uses, or vends, differs from that of the plaintiff in form or in any respect which does not render the machine so made, used, or vended, substantially different from the patented machine. Inventions of the fourth class are just as meritorious as those of any other class, and the property of the inventors is entitled to the same protection. *Union Sugar Refinery Co. v. Matthiessen*, 2 *Fish. Pat. Cas.* 600.

The mere function of a machine is not a patentable subject; but a mechanical device, adapted to perform specific functions, is patentable, whether its operative efficiency depends upon its combination with other mechanism or not. *Parham v. American Buttonhole, &c. Machine Co.*, 4 *Fish. Pat. Cas.* 468.

A machine need not be automatic to be patentable. Improvements in any tool or implement used by hand in an art or industry are patentable. *Coupe v. Weatherhead*, 16 *Fed. Rep'r*, 673; 23 *Pat. Off. Gaz.* 1927.

48. *Compositions.*

The invention of a new composition for making a familiar article may be patentable; and this even though both the article and the means employed to adapt the new composition to its manufacture are old or well known; but the mere idea of employing a well-known composition as a material for making a familiar article, the only novelty being that the composition has not been used for making that article, does not involve invention, and is not patentable. *Hotchkiss v. Greenwood*, 11 *How.* 248, 265; aff'g 4 *McLean*, 456. It is not necessary, in order to render a composition patentable, that every ingredient, or that any one ingredient used by the patentee in his invention, should not have been used before for that purpose. The right to a patent depends upon the question whether the combination of materials used by the patentee is substantially new as a

combination. If the ingredients have never been combined together in the manner stated in the patent, but the combination is new, the invention of the combination is patentable. *Ryan v. Goodwin*, 3 *Sumn.* 514; 3 *L. Rep'r*, 220.

There is a wide difference between the invention of a new method or process by which a known fabric, product or manufacture is produced in a better and cheaper way, and the discovery of a new compound, substance or manufacture having qualities never found to exist together in any other material. In the first case, the inventor can patent nothing but his process—not his composition of matter; in the latter, both are new and original, and both patentable, not severally, indeed, but as one discovery or invention. *Goodyear v. Railroad*, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626.

The introduction of a flavoring extract, whether in substitution for another or as an additional ingredient of a beverage composition otherwise well known, may be a patentable improvement, if new and advantageous results follow; for in such case there is a new composition. *Rogers v. Ennis*, 14 *Pat. Off. Gaz.* 601.

Patentability of medicines is discussed in *Coffeen v. Brunton*, 4 *McLean*, 516; 7 *West. L. J.* 59; *Scoville v. Toland*, 6 *West. L. J.* 84.

49. *Improvements.*

For discussions of the patentability of improvements considered from various points of view, see *Whittemore v. Cutter*, 1 *Gall.* 478; *Barrett v. Hall*, 1 *Mas.* 447, 476; *Hall v. Wiles*, 2 *Blatchf.* 194; *Evans v. Eaton*, 3 *Wheat.* 454, 516; *rev'g Pet. C. Ct.* 322; *Gray v. James*, *Pet. C. Ct.* 394; *Huggins v. Hubby*, 3 *West. L. Month.* 347. In general, one who devises a substantial change in the structure or mode of operation of a machine,—such as omission of certain parts and replacing them by others really new and different, thereby producing a machine better adapted to the purpose,—is entitled to a patent for the change, as an “improvement.” *Miller's Falls Co. v. Backus*, 17 *Pat. Off. Gaz.* 852; 5 *Bann. & A. Pat. Cas.* 53; *Coupe v. Weatherhead*, 23 *Pat. Off. Gaz.* 1927. This is so, notwithstanding the change made in the machine is slight and simple, if a valuable result, not before attained in a similar way, is produced (*Isaacs v. Abrams*, 3 *Bann. & A. Pat. Cas.* 616; *Eppinger v. Richey*, 23 *Int. Rev. Rec.* 319; *Strobridge v. Lindsay*, 5 *Bann. & A. Pat. Cas.* 411); and even though the change consists only in introducing old elements, if they, when introduced into an organi-

zation in which they have not before been tried, produce new and improved results, or produce the former result by a new and improved mode. *Child v. Boston, &c. Iron Works*, 6 *Fish. Pat. Cas.* 606; *Gottfried v. Phillip Best Brewing Co.*, 17 *Pat. Off. Gaz.* 675; 5 *Bann. & A. Pat. Cas.* 4.

But to warrant a patent for an improvement, the change made must be one involving invention, and the result must be new and useful. There must be something accomplished beyond what is obvious in the thing itself, to persons skilled in the art to which it relates. *Mulford v. Pearce*, 102 *U. S.* 112; 18 *Pat. Off. Gaz.* 1223; rev'g 14 *Blatchf.* 141; 2 *Bann. & A. Pat. Cas.* 542; also, 13 *Blatchf.* 173; 9 *Pat. Off. Gaz.* 204; 2 *Bann. & A. Pat. Cas.* 190; *Hall v. Wiles*, 2 *Blatchf.* 194; *McCormick v. Seymour*, 3 *Id.* 209; aff'd 19 *How.* 96. A mere enlargement of the parts of a machine, a merely colorable change or re-arrangement of relative location of parts, is not a patentable improvement. *Phillips v. Page*, 24 *How.* 164; *Re Greeley*, 4 *Pat. Off. Gaz.* 612; *Pearl v. Ocean Mills*, 11 *Pat. Off. Gaz.* 2; *Miller's Falls Co. v. Backus*, 17 *Pat. Off. Gaz.* 852; 5 *Bann. & A. Pat. Cas.* 53. There are many changes which may be suggested by the manufacturer, or by the particular uses to which the article produced is to be applied, as well as many exhibitions of superior skill in producing an article of greater excellence, which are not invention. The law gives no monopoly to industry, to wise judgment, or to mere mechanical skill in the use of known means, nor to the product of either, if it be not new. It is invention of what is new, and not comparative superiority or greater excellence in what was before known, which the law protects as exclusive property, and it is that alone which is secured by patent. Thus if a fabric be already known and in use, change of color, change of mere material, or change in its degree of fineness—if these changes involve nothing new in construction, nor in the relations of its parts, nor in the office or function of either part—does not constitute invention. *Smith v. Elliott*, 5 *Fish. Pat. Cas.* 315; 1 *Pat. Off. Gaz.* 331.

In general, the fact that the result produced by a change is greatly superior to that attained by the former machine or method is regarded as having a tendency to satisfy the courts, in a doubtful case, that the change is real and substantial, and so patentable as an improvement. *Pearl v. Ocean Mills*, 11 *Pat. Off. Gaz.* 2; *Hall v. Wiles*, 2 *Blatchf.* 194.

50. *Combinations.*

A new and useful combination,—that is an arrangement of devices so that they shall co-operate in a manner not previously known and produce a valuable result,—is patentable, independent of either of the separate devices being new; the contriving how the several parts shall work together is of itself invention, and may warrant a patent although the contriver is not inventor of either of the parts considered alone. *Loom Co. v. Higgins*, 105 *U. S.* 580; rev'g 15 *Blatchf.* 446; 16 *Pat. Off. Gaz.* 675; 4 *Bann. & A. Pat. Cas.* 88; *Gray v. James*, *Pet. C. Ct.* 394; *Bussey v. Wager*, 9 *Pat. Off. Gaz.* 300; *Wood v. Packer*, 17 *Fed. Rep'r*, 650; *Hoffman v. Young*, 2 *Fed. Rep'r*, 74; 26 *Int. Rev. Rec.* 155; 10 *Rep'r*, 259; 18 *Pat. Off. Gaz.* 794; 5 *Bann. & A. Pat. Cas.* 316; *Double Pointed Tack Co. v. Two Rivers Manuf. Co.*, 3 *Fed. Rep'r*, 26; 9 *Biss.* 258; 18 *Pat. Off. Gaz.* 683; *S. C., sub nom. Double Pointed Tack Co. v. Mann*, 5 *Bann. & A. Pat. Cas.* 465. Thus, although a mere change of relative location of the parts of a machine is not patentable, yet, where change of location brings the devices constituting the machine into a new combination, and they operate, by reason of such new combination, to produce a new and useful result, such new combination is patentable. *Gilbert, &c. Manuf. Co. v. Walworth Manuf. Co.*, 9 *Pat. Off. Gaz.* 746; *Marsh v. Dodge, &c. Manuf. Co.*, 6 *Fish. Pat. Cas.* 562; 5 *Pat. Off. Gaz.* 398. The devising a way in which a device already patented may be used in combination with other known devices, is the proper subject of a patent; and so is a new and useful improvement upon a combination already patent; though in cases of this kind the new patentee only acquires what he himself has invented; he cannot, without a license, use the former's patented device or combination, nor can the patentees of these use his combination or improvement without his license. *McMillan v. Rees*, 1 *Fed. Rep'r*, 722; 17 *Pat. Off. Gaz.* 1222; 9 *Rep'r*, 544; 5 *Bann. & A. Pat. Cas.* 269; *Pitts v. Wemple*, 6 *McLean*, 558.

51. *Various Specific Objections to Patenting Them.*

Combinations, to be patentable, must produce a different force or effect, or result, in the combined forces or processes, from that given by their separate parts; there must be a new result produced by their union. *Reckendorfer v. Faber*, 92 *U. S.* 347, 357; aff'g 12 *Blatchf.* 68; 1 *Bann. & A. Pat. Cas.* 229; *Pickering v. McCul-*

lough, 104 *U. S.* 310; aff'g 6 *Rep'r*, 101; 13 *Pat. Off. Gaz.* 818; 3 *Bann. & A. Pat. Cas.* 279. Also, a combination must differ materially and substantially from former combinations; there is no new invention if all the parts of a combination have been applied to a different object before, and they are now only applied to a new object. *Hovey v. Henry*, 3 *West. L. J.* 153. Moreover a combination of old elements is not patentable unless they all so enter into it as that each qualifies every other, and so that the new arrangement either forms a new machine of distinct character and function, or produces a result which is not the mere aggregate of separate contribution, but is due to the joint and co-operating action of all the elements. *Pickering v. McCullough*, 104 *U. S.* 310; aff'g 6 *Rep'r*, 101; 13 *Pat. Off. Gaz.* 818; 3 *Bann. & A. Pat. Cas.* 279. Followed, and the rules there stated applied to a patent for an improved school desk. *Peard v. Johnson*, 23 *Fed. Rep'r*, 507; 32 *Pat. Off. Gaz.* 895. It has been said that the results produced are a better test of whether the operation of a combination is substantially new, than the opinions of experts; or at least are good evidence of novelty; if the results are different from those produced by any previous combination, there must be a substantial change in the mode of operation; results cannot well differ when the means are the same. *Devoll v. Brown*, 3 *West. L. J.* 151; *Forbush v. Cook*, 2 *Fish. Pat. Cas.* 668; 20 *L. Rep'r*, 664.

A patent may be obtained for a combination notwithstanding some of its parts or (as several of the cases hold), all its parts separately considered, have been known and used before, provided the arrangement, union or co-operation of them is new, and produces an effect which is new and either better or more economically produced than the old. *Le Roy v. Tatham*, 22 *How.* 132; *Parks v. Booth*, 102 *U. S.* 96; aff'g 1 *Flippin*, 381; 1 *Bann. & A. Pat. Cas.* 225; *Hailes v. Van Wormer*, 20 *Wall.* 353; aff'g 7 *Blatchf.* 443; *Barrett v. Hall*, 1 *Mas.* 447; *Moody v. Fiske*, 2 *Mas.* 112; *Earle v. Sawyer*, 4 *Mas.* 1; *Evans v. Eaton*, *Pet. Ct.* 322; *Pitts v. Whitman*, 2 *Story*, 609; *Devoll v. Brown*, 3 *West. L. J.* 151; *Hovey v. Henry*, *Id.* 153; *Hovey v. Stevens*, 1 *Woodb. & M.* 290; *Blake v. Sperry*, 2 *N. Y. Leg. Obs.* 251; *Buck v. Hermance*, 1 *Blatchf.* 398; *Hall v. Wiles*, 2 *Blatchf.* 194; *Clark Pomace Holder Co. v. Ferguson*, 17 *Fed. Rep'r*, 79; 24 *Pat. Off. Gaz.* 1090; 21 *Blatchf.* 376; *Pennock v. Dialogue*, 4 *Wash.* 538; aff'g 2 *Pet.* 1; *Whitney v. Emmett*, *Baldw.* 303; *Watson v. Cunningham*, 4 *Fish. Pat. Cas.* 528; *Kerosene Lamp Heater Co. v. Littell*, 3 *Bann. & A. Pat. Cas.*

312; 1 *N. J. L.* 195; *Tyler v. Deval*, 1 *Code Rep'r*, 30; *Gould v. Commissioner of Patents*, 1 *McArthur*, 410. And a subsequent inventor may obtain a patent for a combination of the same elements as those which compose a prior one, provided the new combination is substantially different from the old, and accomplishes new and useful results. *Sands v. Wardwell*, 3 *Cliff.* 277. So patents may be granted for combinations, some of the elements of which are old and some are new; and whatever is new may also be separately secured to the inventor; although such new part may be of no practical use whatever, except in the combination described, or some similar combination. *Wheeler v. Clipper Mower, &c. Co.*, 6 *Fish. Pat. Cas.* 1. But a combination, all the elements of which are devices or substantial equivalents for devices used in previously patented inventions, and which accomplishes the same result by merely a different method, is not a patentable invention. *Gilbert v. Weir Plow Co.*, 22 *Fed. Rep'r*, 428; 29 *Pat. Off. Gaz.* 1129.

It has been held in a charge to the jury, that the fact that a device comprising several patentable elements has been patented as a whole will not prevent the patentee from afterwards securing a patent for a combination of any number of the elements less than the whole, provided he applies for it before the lesser combination has been two years in public use. *Cahn v. Wong Town On*, 19 *Fed. Rep'r*, 424; 9 *Saenger*, 630; 27 *Pat. Off. Gaz.* 299.

Moreover, it is not necessary, in order to make a valid claim for a combination, that the several elementary parts of the combination should act simultaneously; but if such parts are so arranged that the successive action of each contributes to produce one result, and this result is the product of the simultaneous or successive action of all such parts, a patent for combining such elementary parts may be obtained. *Forbush v. Cook*, 2 *Fish. Pat. Cas.* 668; 20 *L. Rep'r*, 664; *Hoe v. Cottrell*, 1 *Fed. Rep'r*, 597; 17 *Blatchf.* 546; 18 *Pat. Off. Gaz.* 59; 5 *Bann. & A. Pat. Cas.* 256; *Hoffman v. Young*, 2 *Fed. Rep'r*, 74; 26 *Int. Rev. Rec.* 155; 10 *Rep'r*, 259; 18 *Pat. Off. Gaz.* 794; 5 *Bann. & A. Pat. Cas.* 310; *Birdsell v. McDonald*, 6 *Pat. Off. Gaz.* 682.

52. *How Patents for Combinations Should be Issued*

Under early patent laws it was held that if an invention consisted in a new combination of machinery, or in improvements upon an old machine, to produce a new effect, the patent should be for

the combined machinery, or improvements on the old machine, and not for a mere mode or device for producing such effects, detached from the machinery. *Barrett v. Hall*, 1 *Mas.* 447.

A patent may be obtained for a machine combining several distinct improvements, if each is the invention of the patentee, and may include a right to each of the several and distinct improvements; in other words, the patentee may in such 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. *Pitts v. Whitman*, 2 *Story*, 669, 681.

A patent may embrace both a combination consisting of several elements, which, together, compose an organized machine, and sub-combinations consisting of fewer members of the same elements. *Stevens v. Fritchard*, 10 *Pat. Off. Gaz.* 505; 4 *Cliff.* 417.

A broad claim in a patent cannot be sustained for merely putting together two old tools for convenience of manipulation in their several and distinct uses; the patent must be limited to some patentable improvement, either in the method of combining the tools, or in one or more of the tools themselves. *Tower v. Bemis, & Co. Hardware Co.*, 19 *Fed. Rep'r.* 498.

An inventor may claim in one patent a combination of devices, when they are so connected as to operate in a certain way; and in another, he may claim in combination with some of these devices, another one, by means of which, especially, the operation so described is produced. *Wheeler v. McCormick*, 4 *Pat. Off. Gaz.* 692; 6 *Fish. Pat. Cas.* 551; 11 *Blatchf.* 334.

If the same combination existed before, up to a certain point, and the invention consists in adding some new machinery, in some improved mode of operation, or some new combination, the patent must be limited to the improvement. *Whitney v. Emmett*, *Baldw.* 303.

53. Rule that the Invention must be "New."

To entitle one claiming as an inventor, to a patent, his invention must be "new;" novelty is, by the statute, an essential condition. *Bedford v. Hunt*, 1 *Mas.* 362; *Perfection Window Cleaner Co. v. Bosley*, 2 *Fed. Rep'r.* 574; 9 *Biss.* 365; 5 *Bann. & A. Pat. Cas.* 449; 10 *Rep'r.* 67; *Wood v. Pacher*, 17 *Fed. Rep'r.* 650. If his invention is a combination, his claim can be sustained only by establishing the novelty of the combination as a whole; though novelty of all or any of the parts need not be shown. *Le Roy v. Tatham*,

14 *How.* 156, 178. And, generally, the question upon an application for a patent is whether this thing has been made before; in case of a machine, whether it has been substantially constructed before; in case of an improvement of a machine, whether that improvement has ever been applied to such a machine before, or whether it is substantially new. *Earle v. Sawyer*, 4 *Mas.* 1. That an improved result is produced is not enough, standing alone, to entitle to a patent; improvement in the result has a tendency to show novelty; but if the superiority is attained by the application of known means, in a known way, to produce a known result, though a better one, there is not such novelty as is required by the patent law. *Smith v. Nichols*, 21 *Wall.* 112; *aff'g* 1 *Holmes*, 172; 6 *Fish. Pat. Cas.* 61; 2 *Pat. Off. Gaz.* 649; *Le Roy v. Tatham*, 14 *How.* 156, 178; *Smith v. Nichols*, 1 *Holmes*, 172; 6 *Fish. Pat. Cas.* 61. The invention must be substantially different from what has gone before; if it is so, and the result which it produces is different from and better than any produced by previous devices having the same purpose, it is patentable. *Wood v. Packer*, 17 *Fed. Rep'r*, 650.

As to what constitutes "novelty" in an invention, within the requirements of the patent laws, see *Adams v. Edwards*, 1 *Fish. Pat. Cas.* 1; *Carr v. Rice*, *Id.* 198; *Wintermute v. Redington*, *Id.* 239; *Hays v. Sulsor*, *Id.* 532; *Judson v. Moore*, *Id.* 544; *Matthews v. Skates*, *Id.* 602; *Wayne v. Holmes*, 2 *Fish. Pat. Cas.* 20; *Clarke's Patent Steam, &c. Co. v. Copeland*, *Id.* 221; *Forbush v. Cook*, *Id.* 668; 20 *L. Rep'r*, 664.

54. Rule that it must be "Useful."

To entitle an inventor to a patent the invention must be "useful;" utility is a statutory condition; but almost any small degree of utility is sufficient to satisfy the requirement. The term "useful" in the patent law, is used in opposition to "frivolous" or "noxious;" that the thing invented should be the best possible of its kind is not required. *Lowell v. Lewis*, 1 *Mas.* 182; *Doherty v. Haynes*, 4 *Cliff.* 291; 6 *Pat. Off. Gaz.* 118; 1 *Bann. & A. Pat. Cas.* 289; *Winans v. Schenectady & Troy R. R. Co.*, 2 *Blatchf.* 279, 290; *Kneass v. Schuylkill Bank*, 4 *Wash.* 9; *Whitney v. Emmett*, *Baldw.* 303; *Roberts v. Ward*, 4 *McLean*, 565.

By "useful" is meant that the invention may be applied to some beneficial purpose in society, in contradistinction to an invention

which is injurious to the public morals, health or good order ; and not that it must be of such general utility as to supersede all other inventions in practice to accomplish the same purpose. The law does not look to the degree of utility. *Bedford v. Hunt*, 1 *Mas.* 302 ; *Many v. Jagger*, 1 *Blatchf.* 372 ; *Wilbur v. Beecher*, 2 *Blatchf.* 132 ; *Evans v. Eaton*, *Pet. C. Ct.* 322. To be patentable, inventions need not be superior to or better than all other things known before ; that they are useful in themselves is sufficient, provided they are also new. *Shaw v. Colwell Lead Co.*, 11 *Fed. Rep'r*, 711 ; 20 *Blatchf.* 417 ; *Crouch v. Speer*, 6 *Pat. Off. Gaz.* 187 ; *Strobridge v. Lindsay*, 2 *Fed. Rep'r*, 692 ; 18 *Pat. Off. Gaz.* 62 ; 5 *Bann. & A. Pat. Cas.* 411 ; *Pennsylvania Salt Manuf. Co. v. Thomas*, 8 *Phila.* 144 ; *Miller, &c. Manuf. Co. v. Du Brul*, 12 *Pat. Off. Gaz.* 351 ; 2 *Bann. & A. Pat. Cas.* 618. But, devising a trivial improvement, not involving invention, does not entitle to a patent, [citing and approving 107 *U. S.* 192 ; 110 *U. S.* 490 ; 20 *Wall.* 353 ; 111 *U. S.* 604 ; 11 *How.* 248 ; 24 *How.* 164 ; 21 *Wall.* 112 ; 94 *U. S.* 187 ; 104 *U. S.* 737 ;] *Morris v. McMillin*, 112 *U. S.* 244 ; *Hollister v. Benedict*, 113 *U. S.* 59 ; *Blake v. San Francisco*, *Id.* 679.

The omission from a composition of matter, of an ingredient previously supposed to be essential, but now found to be unnecessary, which omission renders the composition simpler and cheaper in manufacture, while it is equally effective in operation, is patentable. *Tarr v. Folsom*, 1 *Holmes*, 312 ; 5 *Pat. Off. Gaz.* 92 ; 1 *Bann. & A. Pat. Cas.* 24.

By analogy to what has been decided under the copyright laws, it seems that while the fact that that article is necessarily immoral or injurious should render it unpatentable (*Martinetti v. Maguire*, 1 *Abb. U. S.* 356) ; yet if it is capable of an innocent, beneficial use it should not be excluded from the benefit of the patent laws because it may also be put to wrong uses ; the fact that printed playing cards may be used for gambling does not preclude a design for them from being protected by injunction from infringement. *Richardson v. Miller*, 12 *Pat. Off. Gaz.* 3.

As to what constitutes "utility" in an invention, within the requirement of the patent laws, see *Adams v. Edwards*, 1 *Fish. Pat. Cas.* 1 ; *Many v. Sizer*, *Id.* 17 ; *Carr v. Rice*, *Id.* 198 ; *Wintermute v. Redington*, *Id.* 239 ; *Hays v. Sulsor*, *Id.* 532 ; *Judson v. Moore*, *Id.* 544 ; *Pitts v. Wemple*, 2 *Fish. Pat. Cas.* 10 ; *Wayne v. Holmes*, *Id.* 20 ; *Lindsay v. Stein*, 10 *Fed. Rep'r*, 907 ; 20 *Blatchf.* 370 ; 21 *Pat. Off. Gaz.* 1613.

55. *The Completeness or Perfection necessary.*

An imperfect and incomplete invention, resting in mere theory or 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. *Reed v. Cutter*, 1 *Story*, 590 ; *Draper v. Potomska Mills Corp.*, 13 *Pat. Off. Gaz.* 276 ; 3 *Bann. & A. Pat. Cas.* 214 ; *Wheeler v. Clipper Mower, &c. Co.*, 10 *Blatchf.* 181 ; 6 *Fish. Pat. Cas.* 1 ; 2 *Pat. Off. Gaz.* 442 ; *Judson v. Bradford*, 16 *Pat. Off. Gaz.* 171. Neither is a process which is ineffectual until some means shall be invented to accomplish the result. *Downton v. Yaeger Milling Co.*, 5 *Bann. & A. Pat. Cas.* 112. So, developing the idea of an invention by drawings does not amount to perfecting and adapting the invention, nor complete the inventor's right to a patent ; he must have carried the idea into actual practice in material form. *Reeves v. Keystone Bridge Co.*, 9 *Phila.* 368. An invention is not complete, so as to entitle the inventor to claim letters patent, until it is embodied in a form capable of successful and useful operation. *Richardson v. Noyes*, 10 *Pat. Off. Gaz.* 507 ; 2 *Bann. & A. Pat. Cas.* 398 ; *Lyman Ventilating, &c. Co. v. Chamberlain*, 10 *Pat. Off. Gaz.* 588 ; 2 *Bann. & A. Pat. Cas.* 433.

But with respect to completeness or perfection, the question is not whether the entire machine in which an improvement is embodied is a "perfect" machine, in the usual sense of that word, but whether it is perfect in the sense that it embodies a complete invention ; whether, so far as it covers improved devices, it is a perfect machine, as respects those devices. *American Hide, &c. Co. v. American Tool, &c. Co.*, 4 *Fish. Pat. Cas.* 284 ; 1 *Holmes*, 503.

The fact that a machine, when first applied in practice, does not perfectly accomplish the work for which it was designed, or does not accomplish all that its inventor supposed it would, is not enough to secure its rejection as a patentable invention ; but if, taken as a whole, it is, in its construction and operation, an advance upon the state of the art to which it appertains, furnishing a better (though still imperfect) method of performing a useful function than was before available, it is not to be discarded as destitute of patentable merit. *Seymour v. Marsh*, 6 *Fish. Pat. Cas.* 115 ; 2 *Pat. Off. Gaz.* 674 ; 9 *Phila.* 380. If the invention is such that when the thing invented shall be constructed according to the model and specifications filed, it will operate successfully as a prac-

tical and useful thing, the inventor has satisfied the law, and may have a patent without going on to actually construct it. *Wheeler v. Clipper Mower, &c. Co.*, 10 *Blatchf.* 181 ; 6 *Fish. Pat. Cas.* 1 ; 2 *Pat. Off. Gaz.* 442. An invention need not in fact be constructed in order to preserve a patent, when the patentee is a citizen of the United States, and the invention is capable of construction and operation from the model and specifications filed in the patent-office. *Broadnax v. Central Stock-Yard, &c. Co.*, 4 *Fed. Rep'r*, 214 ; 11 *Rep'r*, 6 ; 5 *Bann. & A. Pat. Cas.* 609.

An invention is not patentable until a machine has been perfected ; and, if not actually used, made capable of useful operation. *Moore v. Thomas*, 3 *Bann. & A. Pat. Cas.* 13.

56. "Not Known or Used by Others," &c.

The provision of *Rev. Stat.* § 4886,—that, to entitle a person to a patent his invention must be "not known or used by others in this country,"—is not to be construed as requiring one who contests the novelty of an invention for non-compliance with the requirement, to prove that it has been used as well as known, here. *Stitt v. Eastern R. Co.*, 22 *Fed. Rep'r*, 649.

57. Not Patented, or Described in any Printed Publication.

If the thing patented was actually described in a published work previous to the discovery or invention of it by the applicant for a patent in this country, he cannot obtain a valid patent for it, even though he had no knowledge of such prior publication, but his invention of it was original with himself ; the restriction in the law is founded on a presumption that he may have known it, which is not allowed to be rebutted. This was so held under early patent laws (in *Evans v. Eaton*, 3 *Wheat.* 454, 514 ; rev'g *Pet. C. Ct.* 323 ; *Reutgen v. Kanowrs*, 1 *Wash.* 148), and under the act of 1836, in *Allen v. Hunter*, 6 *McLean*, 303, 314. Under the Revised Statutes the restriction has been modified (by § 4887, formerly Act of July 8, 1870, c. 230, § 25, 16 *Stat.* 201), so far as effect of a foreign patent is concerned ; and an inventor can obtain a patent here, by proving that he is the original inventor here, unless the thing has been introduced into use here for more than two years prior to his application ; the only effect of the foreign patent being to limit the term of the American. *Cornely v. Marckwald*, 17 *Fed. Rep'r*, 83 ; 24 *Pat. Off. Gaz.* 498 ; 16 *Rep'r*, 102. See *Rev. Stat.* § 4887, *infra*.

In order to defeat an American patent on the ground that the invention has been already patented abroad, the foreign *patent* must have been completed (in the case of an English patent, by enrollment of the specification), before the *invention* here was made; the fact that the foreign patent was applied for before application in this country, is not enough to bring a case within the restriction. *Howe v. Morton*, 13 *L. Rep'r, N. S.* 70; *Coburn v. Schroeder*, 22 *Pat. Off. Gaz.* 419. So, a description in a printed publication will not avoid a patent unless the description was published before the invention in this country (not the application) was made. *Bartholomew v. Sawyer*, 1 *Fish. Pat. Cas.* 516; 41 *Hunt Mer. Mag.* 575.

The description in a prior printed publication which will avoid a patent obtained by an inventor in good faith, must be sufficiently full and precise to enable a person skilled in the art to make the thing, repeat the process, &c., in all material respects like that covered by or described in the plaintiff's patent. *Seymour v. Osborne*, 11 *Wall.* 516; *Cohn v. United States Corset Co.*, 93 *U. S.* 366; *Downton v. Yeager Milling Co.*, 108 *U. S.* 466; *Hood v. Boston Car Spring Co.*, 21 *Fed. Rep'r*, 67; *Parker v. Stiles*, 5 *McLean*, 44, 61; 7 *West. L. J.* 168; *Hays v. Sulser*, 1 *Fish. Pat. Cas.* 532; *Judson v. Cope*, *Id.* 615; *Nathan v. New York Elevated R. R. Co.*, 2 *Fed. Rep'r*, 225; 9 *Rep'r*, 504; 5 *Bann. & A. Pat. Cas.* 280. Anticipation by others of a patented invention is not established by descriptions in publications which show nothing more than suggestions and speculations of scientific writers, who had never tested the practicability of their suggestions or demonstrated the truth or value of their speculations. *Jensen v. Keasbey*, 24 *Fed. Rep'r*, 144.

The decisions are not agreed whether a description of an invention given in a former patent issued to the same inventor, for another invention, and in which the invention in question is not claimed, will defeat a patent afterwards issued to him for the invention before omitted. *Marvin v. Lillie*, 27 *Pat. Off. Gaz.* 299; *Vermont Farm Machine Co. v. Marble*, 19 *Fed. Rep'r*, 307; 22 *Blatchf.* 32; 27 *Pat. Off. Gaz.* 621.

Mere use abroad, if there has been no patent and no published description, does not prevent one who has originally invented it, and makes oath that he believes himself the first inventor, from obtaining a valid patent. *O'Reilly v. Morse*, 15 *How.* 62, 110; *Hays v. Sulser*, 1 *Fish. Pat. Cas.* 532; *Judson v. Cope*, *Id.* 615; *Worswick Manuf. Co. v. Steiger*, 17 *Fed. Rep'r*, 250; 5 *Op. Att.*

Gen. 18 ; and see *Cornely v. Marckwald*, 17 *Fed. Rep'r*, 83 ; 24 *Pat. Off. Gaz.* 498 ; 16 *Rep'r*, 102 ; 21 *Blatchf.* 367.

58. *Public use or Sale.*

The conditions imposed on granting a patent which have been illustrated in the previous sections (40-57) are primarily for the consideration of the commissioner ; the required proofs and examination before him must afford reason to believe that the thing to be patented is new and useful, that the applicant is the inventor, that the invention has not been patented or described in any printed publication. Notwithstanding his favorable decision upon an *ex parte* application, however, the same questions may arise in a way to be contested upon opposing evidence, in an interference proceeding, in a suit in court between competing claimants to a patent, or in a suit for infringement. The plan of the foregoing notes has been to present the decisions so far as they seem to be instructive upon the duty of the commissioner in passing upon an uncontested application for a patent ; but to reserve those which assume that the inventor's right is in litigation, for discussion in connection with those provisions of the statute which treat of the litigations which may arise over a patentee's right.

Two negative conditions imposed by the statute remain to be mentioned here. We refer to the requirements that the invention has not been in public use or on sale, and that it has not been abandoned. But as these are merely negative, and from their nature can rarely be developed in the office examination, but will usually arise only when the validity of the patent comes to be contested, they will only be mentioned ; the more convenient place for presenting the decisions in which they are discussed, is in connection with the statute provisions regulating contests over patents.

Should it appear from facts elicited in the office examination of an application that the invention has been in public use or on sale for more than two years prior to the application, the commissioner is not authorized to grant a patent. It has been held, however, that an application cannot be rejected on this ground when the only proof before the commissioner consists of mere *ex parte* affidavits taken without notice and cross-examination. *Re Alteneck*, 23 *Pat. Off. Gaz.* 269. It was also ruled under the similar provision in the Act of 1836, that the law refers to some use or sale authorized or allowed by applicant ; the analogous matter of a use or sale of substantially the same invention unknown to the applicant, by other

persons who have had the same idea, is covered by the anterior clause, "not known or used by others in this country." *Bartholomew v. Sawyer*, 4 *Blatchf.* 347; 1 *Fish. Pat. Cas.* 516; 41 *Hunt Mer. Mag.* 575. The current of opinion in the cases has been that the condition is not violated by any use of the invention, incidental to the experiments needful to developing and perfecting it, although such use may have been in public view and very generally known (*Graham v. McCormick*, 11 *Fed. Rep'r*, 859; 10 *Biss.* 39; 21 *Pat. Off. Gaz.* 1533; 5 *Bann. & A. Pat. Cas.* 244); as where the inventor of a new kind of pavement laid it in a portion of a city street, and allowed it to be used for a considerable time, merely, however, for the purpose of testing its qualities, and making sure of its merits (*Elizabeth v. Pavement Co.*, 97 *U. S.* 126; 24 *Lawyers' Ed.* 1000); or where an inventor sold one of the articles at mere cost, for the purpose of having the buyer test it by actual use. *Innis v. Oil City Boiler Works*, 20 *Fed. Rep'r*, 780; 30 *Pat. Off. Gaz.* 998.

59. *Abandonment.*

Abandonment of an invention, likewise, if established, precludes any right to a patent; for it renders the invention public property, and there is no ground on which the inventor can resume his title to it. Hence the inventor, and he alone, is deemed competent to abandon; no use, unless by his knowledge or assent, can operate to deprive him of his right. *Pierson v. Eagle Screw Co.*, 3 *Story*, 402. Abandonment is in the nature of a forfeiture of a right; the law does not presume, or favor it, but requires proof that is clear and complete (*Pitts v. Hall*, 2 *Blatchf.* 229); and will construe acts of an inventor claimed to indicate abandonment, liberally in his favor (*Mellus v. Silsbee*, 4 *Mas.* 108); thus his saying that he means to dedicate his invention to the public, will not be regarded as equivalent to his doing so; there must be some acts of actual dedication. *Pitt v. Hall*, *supra*. On the other hand, abandonment does not turn wholly upon the intention of the inventor; whatever may be his intention, if he suffers his invention to go into public use, through any means whatever, without an immediate assertion of his right, he is not entitled to a patent; nor will a patent, obtained under such circumstances, protect his right. *Shaw v. Cooper*, 7 *Pat.* 292, 320. And it makes no difference by what means an invention may be communicated to the public before a patent is obtained; any acquiescence in the public use, by the inventor, will be an abandonment of his right. *Ib.* See the decis-

ions collated in connection with the statutes relative to interposing abandonment as a defense.

60. *Patents for Inventions previously patented Abroad.*

No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years. *Rev. Stat. § 4887.*

This is substantially the provision of Act of July 8, 1870, c. 230, § 55, 16 *Stat.* 201. There were provisions on the same subject in the patent Acts of 1836, 1839, and 1861; as to which and their construction, see *O'Reilly v. Morse*, 15 *How.* 62, 112; *Smith v. Ely*, *Id.* 137; *Goff v. Stafford*, 14 *Pat. Off. Gaz.* 748; *De Florez v. Reynolds*, 8 *Fed. Rep'r*, 434; 17 *Blatchf.* 436; 17 *Pat. Off. Gaz.* 503; 5 *Bann. & A. Pat. Cas.* 140.

Among other things, the section has been held not retroactive (*Badische, Anilin, &c. Fabrik v. Hamilton Manuf. Co.*, 13 *Pat. Off. Gaz.* 273; 3 *Bann. & A. Pat. Cas.* 235); to relate to patents which are applied for in this country after issue of a patent abroad (*French v. Rogers*, 1 *Fish. Pat. Cas.* 133; *American Leather Co. v. American Tool Co.*, 1 *Holmes*, 503; 4 *Fish. Pat. Cas.* 284); and to allow a foreign inventor to obtain a patent here, notwithstanding invalidity of a patent granted him abroad. *Cornely v. Marekwald*, 17 *Fed. Rep'r*, 83; 24 *Pat. Off. Gaz.* 498; 16 *Rep'r*, 102; 31 *Blatchf.* 367. See also, *infra*, p. 482.

61. *Limiting Term by that of any Foreign Patent.*

The former patent-office rule requiring applicants to make known the existence of their foreign patents has been adjudged to have been made in accordance with law, and a failure to comply with

the rule renders the application defective, and it remains so, unless the office subsequently accepts and acts upon information respecting such foreign grants. *Exp. Bland*, 15 *Pat. Off. Gaz.* 828. An applicant may lawfully be required to disclose what patents he has procured abroad. *United States v. Marble*, 22 *Pat. Off. Gaz.* 1365.

But an omission (if inadvertent, and not attributable to bad faith) to limit the American patent in express terms to the duration of the foreign patent does not render the American void as a whole. The office in issuing the American will limit its duration so that it shall expire at the same time with the foreign, or with the shortest foreign if there are more than one (in no case, of course, giving the American more than seventeen years to run); according to the best information within its power (*Rules of Prac.* No. 29); if however, the American patent is not in fact by its terms limited to correspond with the shortest foreign, the effect is that the American is good until the expiration of the foreign; at which time the statute terminates it in favor of any one interested to raise the objection. *O'Reilly v. Morse*, 15 *How.* 62; *Morse v. Bain*, 9 *West. L. J.* 106; *Tilghman v. Proctor*, 102 *U. S.* 707; *Goff v. Stafford*, 14 *Pat. Off. Gaz.* 748; 2 *Bann. & A. Pat. Cas.* 610; *Weston v. White*, 13 *Blatchf.* 364; 9 *Pat. Off. Gaz.* 1196; 2 *Bann. & A. Pat. Cas.* 321; *Nathan v. N. Y. Elevated R. R. Co.*, 5 *Bann. & A. Pat. Cas.* 280; 2 *Fed. Rep'r*, 225; *American Diamond Rock-boring Co. v. Sheldon*, 17 *Blatchf.* 303; 4 *Bann. & A. Pat. Cas.* 603; *De Florez v. Reynolds*, 17 *Blatchf.* 426; 17 *Pat. Off. Gaz.* 503; 8 *Fed. Rep'r*, 434; 5 *Bann. & A. Pat. Cas.* 140; *Siemens v. Sellers*, 23 *Pat. Off. Gaz.* 2234. In other words, the provision does not require the limitation to be expressed in the patent, but only controls the duration of the grant. *Canan v. Pound Manuf. Co.*, 23 *Fed. Rep'r*, 185; 31 *Pat. Off. Gaz.* 119. Compare, however, contrary views expressed in *Smith v. Ely*, 15 *How.* 137, below, 5 *Mc Lean*, 137; *Paillard v. Gautschi*, 20 *Pat. Off. Gaz.* 1893. The attorney-general has advised that under such circumstances the date of the American patent may be altered to correspond with that of the foreign. 4 *Op. Att. Gen.* 335.

The courts have decided that the statute applies, and the American patent must expire coincidentally with the foreign one having the shortest time to run, notwithstanding the American application was made before the application abroad, if the foreign patent was earlier granted (*Bate Refrigerating Co. v. Gillett*, 22 *Pat. Off. Gaz.* 1205; 13 *Fed. Rep'r*, 553; 28 *Int. Rev. Rec.* 280; 14 *Rep'r*, 357;

Gramme Electric Co. v. Arnoux, &c. Co., 7 *Fed. Rep'r*, 838; 21 *Blatchf.* 450; 25 *Pat. Off. Gaz.* 193; 16 *Rep'r*, 353*), and notwithstanding the foreign patent is a secret one. Gramme Electric Co. v. Arnoux, &c. Co., *supra*. A patent issued here is not affected as to its duration, by the subsequent issue of a patent abroad (Gold & Stock Tel. Co. v. Commercial Tel. Co., 23 *Fed. Rep'r*, 340; and see Same v. Same, 22 *Id.* 838); nor has a foreign patent which does not actually patent the invention, any influence on the term for which letters may be issued for it here. Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co., 22 *Fed. Rep'r*, 341.

An extension of the foreign patent does not enlarge the term of the American; that still expires at the date fixed for the expiration of the foreign as originally issued. Henry v. Providence Tool Co., 3 *Bann. & A.* 501; 14 *Pat. Off. Gaz.* 748; and again, *Id.* 855; Bate Refrigerating Co. v. Gillett, *supra*; Reissner v. Sharp, 16 *Blatchf.* 383; 16 *Pat. Off. Gaz.* 355; 4 *Bann. & A. Pat. Cas.* 366. On the other hand the failure of the foreign patent attributable to the patentee's default in payment of yearly fees, will not impair the American; that will run until the date fixed for the termination of the foreign, as issued, is reached. Badische Anilin, &c., Fabrik v. Hamilton Manuf. Co., 13 *Pat. Off. Gaz.* 273; 3 *Bann. & A.* 235. The provision means that the term of the patent here shall be as long as the remainder of the term for which the foreign patent was granted, without reference to incidents occurring after the grant: such as the lapse of the foreign patent for non-payment of tax. Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co., 22 *Blatchf.* 471; 21 *Fed. Rep'r*, 458.

A patent for an invention was issued indorsed with a reference to a foreign patent, the effect of which was to limit the term of the patent to the period the foreign patent had to run. Such indorsement was made by mistake, and for that reason the inventor refused to accept and returned the patent, and it was canceled and a new patent issued to him. *Held*, that the time intervening between the issue of the first patent and the allowance of the new patent should

* By rule of the Austrian Office taking effect July 16, 1884, all patents are granted for the term of 15 years subject to the payment of an annual tax. Formerly they were granted for one year with the privilege of prolongation to 15 years, and the Bate, and Gramme cases, cited in

the text, *held*, that the U. S. patent granted after an Austrian patent applied for after the U. S. patent was applied for, lasted only one year. See commissioner's decision in Exp. Mann, 17 *Pat. Off. Gaz.* 330. For the rule, see 1 *ante*, 31.

not be deducted from the term of the latter. *Railway Register Manuf. Co. v. North Hudson C. R. Co.*, 23 *Fed. Rep'r*, 593.

V. APPLICATION AND ISSUE.

62. *Requisites of Application, Description, Specification, and Claim.*

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

In practice, a complete application comprises the petition, specification, oath, and drawings, the model or specimen, when either is required, and the first fee of \$15. The petition, specification, and oath must be written in the English language. From the standpoint of the patent-office it is very desirable that all parts of the complete application be deposited in the office at the same time, and that all the papers embraced in the application be attached together. Circumstances may, however, put this out of an inventor's power. Where such is the case, the parts may be sent separately; but a letter must accompany each part, accurately and clearly connecting it

with the other parts of the application. And no application for a patent will be placed upon the files for examination until all its parts, except the model or specimen, are received. The petition, which (with the oath), is the first of the papers to be sent, must be addressed to the commissioner of patents, and state the name and residence of the petitioner, requesting the grant of a patent for the invention therein designated by title, with a reference to the specification for a full disclosure thereof. By *Rev. Stat.* § 4894, *post*, the application must be completed by sending the specification, &c., and prepared for examination within two years after the filing of the petition; and in default thereof, it will be regarded as abandoned, unless the commissioner is satisfied that such delay was unavoidable.

When upon an application for a patent, papers are filed without due formalities and not authenticated as required by law, it is the duty of the patent-office to decline to act upon them in their imperfect state, and to return them to the party, with such suggestions as may present themselves for his better information; but such action on the part of the patent-office does not amount to a rejection of the application, and does not excuse subsequent want of diligence on the part of the applicant in pursuing his application, by which his invention becomes abandoned to public use. *Wickersham v. Singer*, 1 *MacArthur Pat. Cas.* 645, 688.

The various applications, as they are completed, are numbered in regular order; the series now running having been begun January 1, 1880. The office informs each applicant of the number attached to his application. *Rules of Practice*, Nos. 30–32.

With respect to the limit of the time after making an invention, within which the inventor should file his petition, it has been held there is no limit positively imposed, the inventor should act within a reasonable time (else he exposes himself to the presumption of abandonment) but what is such reasonable time, and what measure of diligence is required, depend upon the circumstances of each case. *Stephen v. Salisbury*, 1 *MacArthur Pat. Cas.* 379; *Ellithorp v. Robertson*, *Id.* 585. See also *Ellithorp v. Robertson*, *Id.* 634; *Wickersham v. Singer*, *Id.* 645, 678; *Savary v. Lauth*, *Id.* 691; *Spear v. Belson*, *Id.* 699. Under the act of 1839, the omission of an inventor to apply for a patent within two years after he became aware that another was publicly using and claiming the invention, and his interposing no warning, or objection whatever, —was held in one case to constitute a clear case of disability to

prosecute a claim for a patent within section 7 of the Act. *Justice v. Jones*, 1 *MacArthur Pat. Cas.* 635.

It has been said, perhaps some qualification should be made, that admissions by a patentee, in his specification or application for a patent, cannot afterward be contradicted by him. *Moslitt v. Rogers*, 8 *Fed. Rep'r*, 147.

63. *General requisites of Description or Specification.*

The chief feature of the specification is the written description which it contains of the invention or discovery, and of the manner and process of making, constructing, compounding, and using the same. This is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention appertains, or with which it is most nearly connected, to make, construct, compound, and use the same. It must set forth the precise invention for which a patent is solicited, explaining the principle thereof and the best mode in which the applicant has contemplated applying that principle, so as to distinguish it from other inventions.

It would be difficult to over-state the necessity of clearness, accuracy and precision in making description of the invention. The description must be neither too broad, embracing more than has been invented, nor too narrow, excluding some needful element. It must present the new invention precisely. This is necessary for several reasons. 1. To enable the commissioner to judge whether the matter claimed is new or too broad. 2. To enable the courts, when the patent is afterward contested, to form a like judgment. 3. To enable the public to understand what the patent is, and refrain from its use unless licensed. 4. To enable others to make improvements upon the device, and thus "promote the progress of the useful arts." 5. To enable licensed persons to make and use the invention. 6. To enable other inventors to judge what part of the field remains unoccupied; and, 7. To inform government what exclusive privilege has been granted, and what will become public property when the invention expires. *Evans v. Eaton*, 7 *Wheat.* 356, 433; *aff'g* 3 *Wash.* 443; *Hogg v. Emerson*, 6 *How.* 437; *Gill v. Wells*, 22 *Wall.* 1; 22 *Lawyers' Ed.* 699; *Davoll v. Brown*, 1 *Woodb. & M.* 53; *Sullivan v. Redfield*, 1 *Paine*, 441; *Parker v. Stiles*, 5 *McLean*, 44; 7 *West. L. J.* 168.

Another reason, perhaps more influential, is found in the nature

of an American patent right ; it is, that a patent is a grant by government of an exclusive privilege to an individual, and that such a privilege would be an odious monopoly, unless it was founded on a return of a just equivalent to the public. The statute holds out encouragements to stimulate invention and improvement in the arts and manufacture, by securing to the inventor a remuneration for his outlay and a reward for his ingenuity, and the consideration for which the patent issues to him is the benefit he confers on the community, by his discovery eventually becoming public property. The patentee may be regarded a purchaser from the public, being bound to so communicate his secret by specifications, drawings and models, that it shall be successfully available to the whole community at the expiration of the patent. *Wintermute v. Redington*, 1 *Fish. Pat. Cas.* 239. Thus the grant and acceptance of a patent are in the nature of a contract between the government and the inventor, in which the latter gives the public his invention from after the expiration of seventeen years, and in consideration thereof the former undertakes to protect him in the exclusive control of it during that time. This view of the relation of the parties being accepted, the duty resting upon the inventor of making a correct, useful disclosure of his invention becomes obvious. Thus it is established law that the description must be so explicit as to distinguish the invention from all others of the same kind, and so as to enable any person skilled in the art to make and use it. It should be accommodated to the comprehension of any practical mechanic, without taxing his genius or inventive powers. *Gray v. James*, *Pet. C. Ct.* 394. *S. P.*, *Teese v. Phelps*, *McAll.* 48 ; *Loom Co. v. Higgins*, 105 *U. S.* 580 ; 1 *Op. Att. Gen.* 64. The patent is void unless the specification describes the invention claimed, sufficiently to enable a person skilled in the art to make and use it. *Grant v. Raymond*, 6 *Pet.* 218, 245 ; *O'Reilly v. Morse*, 15 *How.* 62, 119 ; *American Pin Co. v. Oakville Pin Co.*, 3 *Blatchf.* 190 ; 3 *Am. L. Reg.* 136 ; *Park v. Little*, 3 *Wash.* 196.

Upon the one hand, the whole invention must be truly disclosed ; the contract of the public is not with him who has discovered, but him who also makes his discovery usefully known ; if he has discovered much and discloses little, he patents no more than he has proclaimed ; he will not be allowed afterward, when the extent of his right shall be the subject of controversy, to expand into a general expression what was before limited in a particular form, and argue that he had described the whole by implication from the first ;

Detmold v. Reeves, 4 *Am. L. J. N. S.* 189. Upon the other, it must not be exceeded, in the description; a patent may be adjudged void when it appears that the patentee, in his specification, instead of specifying distinctly what he has invented, has endeavored to anticipate, and include future inventions for the same object, and in so doing has rendered his specification ambiguous and adapted to mislead the public (*Carlton v. Bokee*, 17 *Wall.* 463; 6 *Fish. Pat. Cas.* 40); or where the specification endeavors to include an idea, or a function of the human system, or a quality of objects in nature, instead of a particular instrumentality, or concrete form of applying that idea, or function, or quality in use. 7 *Op. Att. Gen.* 276.

Still more clear is it that any fraudulent concealment in or addition to the specifications of a patent will avoid it. *Lowell v. Lewis*, 1 *Mas.* 182.

But it is settled that, although the specification is obscure, or imperfectly expressed, yet if it communicates the invention to the public in manner to enable the courts to identify, and mechanics skilled in the art to reproduce the patented device or improvement, it is sufficient. *Whitney v. Emmett*, *Baldw.* 303; *St. Louis Stamping Co. v. Quimby*, 16 *Pat. Off. Gaz.* 135; 4 *Bann. & A. Pat. Cas.* 192.

The following order of arrangement should be observed in framing the specification:

1. Preamble stating the name and residence of the applicant, and the title of the invention, and, if the invention has been patented in any country, the country or countries in which it has been so patented, and the date and number of each patent.
2. General statement of the object and nature of the invention.
3. Brief description of the several views of the drawings (if the invention admits such illustration).
4. Detailed description.
5. Claim or claims.
6. Signature of inventor.
7. Signatures of two witnesses. *Rules of Pract.* No. 39.

Two or more independent inventions cannot be claimed in one application, but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application. An application should not ordinarily embrace matters belonging to distinct official classes, nor

matters belonging to distinct subclasses in cases where a contrary practice has heretofore prevailed among applicants. *Id.* 40.

It is not necessary that the inventor correctly explain the scientific principle underlying his invention, or employ skilfully the appropriate scientific terms in explaining it. *Andrews v. Cross*, 8 *Fed. Rep'r*, 269; 19 *Blatchf.* 294; 19 *Pat. Off. Gaz.* 1705; *Hovey v. Stevens*, 3 *Woodb. & M.* 17; *St. Louis Stamping Co. v. Quimby*, *supra*. And he is not required to suggest all the possible modes by which the invention may be varied and yet the effect produced; to state the modes which he contemplates to be the best, and add, that other mere formal variations from these modes he does not deem to be unprotected by his patent is sufficient. *Carver v. Braintree Manuf. Co.*, 2 *Story*, 432. See some further discussions of the necessity and duty on the part of a patentee, of accompanying his application with a description and specification of his invention: *Wyeth v. Stone*, 1 *Story*, 273; 4 *L. Rep'r*, 54; *Sargent v. Carter*, 11 *L. Rep'r, N. S.* 651; 1 *Fish. Pat. Cas.* 277. The danger of employing generic language of description instead of specific, pointed out. 7 *Op. Att. Gen.* 133.

64. *Description; in the case of Machines.*

All that the law requires of an inventor of a machine is that he shall describe the manner of making, constructing, and using it in such full, clear, concise and exact terms as will enable any one skilled in the art to which it appertains, to make, use and construct the same, and shall explain the principle thereof and the best mode in which he contemplated applying that principle, so as to distinguish it from other inventions. *Grier v. Castle*, 17 *Fed. Rep'r*, 523; 24 *Pat. Off. Gaz.* 1176. He is not, generally, limited by the literal import of his description of his invention, but may, in its construction, make such modifications as do not involve a departure from its principle, or a material change in its mode of operation. *Ib.*

In patents for complicated machines, it is essentially proper that the specification should clearly set forth what the patent admits to be old, and what he claims to be of his invention. But in anomalous cases, when a product has been discovered and the process of compounding it or obtaining it is disclosed, the patentee, by stating his discovery and revealing his process, has done all that he is required to do or can do. The careful separation of new from old, the limitation of claims to particular parts or combinations,

cannot in such cases be required as a substantial part of the specification. *Goodyear v. Railroad*, 2 *Wall. Jr.* 356 ; 1 *Fish. Pat. Cas.* 626.

If the specification is sufficiently explicit in its details to enable a skillful machinist to construct the patented improvement or invention, without other aid, the patent is not void because some of the minor details of the machine are not set forth at large. *Union Paper Bag Co. v. Nixon*, 6 *Fish. Pat. Cas.* 402 ; 9 *Pat. Off. Gaz.* 691 ; 2 *Bann. & A. Pat. Cas.* 244 ; 1 *Flippin*, 491 ; *Brooks v. Bicknell*, 3 *McLean*, 250 ; 1 *West. L. J.* 150 ; *Vogler v. Semple*, 7 *Biss.* 383 ; 11 *Pat. Off. Gaz.* 923 ; 23 *Int. Rev. Rec.* 112 ; 2 *Bann. & A. Pat. Cas.* 556.

A specification need not particularly describe the operation of mechanism which is well known by persons acquainted with the art. *Kneass v. Schuylkill Bank*, 4 *Wash.* 9.

A specification need not state of what material, whether wood or iron, every part of the machine should be made. *Brooks v. Bicknell*, 3 *McLean*, 250 ; 1 *West. L. J.* 150.

Some inventions embrace an entire machine, and in such cases it is sufficient if it appears that the claim is co-extensive with the patented improvement. Other inventions embrace only one or more parts of a machine, and in such cases the part or parts claimed must be specified and pointed out, so that constructors, other inventors and the public may know what the invention is and what is withdrawn from general use. *Parks v. Booth*, 102 *U. S.* 96 ; aff'g 1 *Flippin*, 381 ; 1 *Bann. & A. Pat. Cas.* 225.

65. *In the case of Improvements.*

In case of a mere improvement, the specification must particularly point out the parts to which it relates, and must by explicit language distinguish between what is old and what is claimed as new, and the description and the drawings, as well as the claims, should be confined to the specific improvement and such parts as necessarily co-operate with it. *Rules of Prac.* No. 36.

Where a patent is for an improvement, the specification must describe, in full, clear and exact terms, what the improvement is: 1, to enable the public to enjoy the full benefit of the discovery when the monopoly is expired, by having it so described on record that it can be constructed ; and 2, to put every citizen on his guard, that he may not through ignorance violate the law, by infringing the rights of

the patentee. *Evans v. Hettich*, 7 *Wheat.* 453 ; aff'g 3 *Wash.* 408. If the description is so uncertain and obscure as to what is in fact the novelty, that the commissioner cannot determine whether the improvement consists in the combination of all the parts, or only of some of them, and of which—or in an invention of some new parts and if so, of what—the uncertainty will be fatal, and the patentee will have to make a new specification, setting forth his claim with greater certainty, accuracy and clearness, and disclaiming all not new. *Phillips v. Page*, 24 *How.* 164.

In a patent for an improvement, the patentee should not only describe the machine, with all its parts, but he should distinguish what is new. Whatever is the particular improvement must be clearly stated; both that the public may know what he claims as new, and that parties may know what they are to defend against. *Hovey v. Stevens*, 3 *Woodb. & M.* 17, 25. *Phillips v. Page*, 24 *How.* 164 ; *Barrett v. Hall*, 1 *Mas.* 447, 476 ; *Sullivan v. Redfield*, 1 *Paine*, 441 ; *Blake v. Sperry*, 2 *N. Y. Leg. Obs.* 251.

A patent for an improvement must show the extent of the improvement, so that a person who understands the subject may know in what it consists (*Whitney v. Emmett*, *Baldw.* 303); a general statement that the patented article is, in all respects, without stating what these are, an improvement on an old article, is no specification at all. *Barrett v. Hall*, 1 *Mas.* 447, 478.

In describing an improvement on a machine, the old and well known machinery, with which the new contrivance is to be connected, need not be described, or delineated in the drawing, when no change in their forms or proportions enters into the new invention. *Emerson v. Hogg*, 2 *Blatchf.* 1. So, giving a particular description of former machines of the same kind is not required ; a general reference or reference to some one which is well known, accompanied by such a description of the improvement as will enable a workman to distinguish what is new, will be sufficient. *Davis v. Palmer*, 2 *Brock. Marsh.* 298. And the structure in detail of the entire and improved machine need not be given. To describe the improvement itself by showing the parts of which it consists, and the effects which it produces, is enough. *Brooks v. Bicknell*, 3 *McLean*, 250 ; 1 *West. L. J.* 150.

In a case of an improvement in the construction of railroad cars, the most essential feature of which consisted in locating the two sets of trucks as remotely from each other as convenient for the support of the carriage, and bringing the two axles of each truck as

near as possible to each other, it was *held*, that the specification need not specify in feet and inches the exact distance from the ends of the car body at which it would be best to arrange the trucks, or the exact distance between the two axles. *Winans v. Schenectady & Troy R. R. Co.*, 2 *Blatchf.* 279.

66. *Of Compositions of Matter.*

The specification to accompany a patent for a new substance to be formed by means of chemical combinations of known materials should state the component parts of the new manufacture claimed with clearness and precision, and not leave the person attempting to use the discovery, to find out the exact proportions by experiment. The law requires the applicant to deliver a written description of the manner and process of making and compounding his newly-discovered compound. Giving the names of the materials only, without stating the proportions, or stating them vaguely, is not a sufficient specification, as it will not enable a person to make the compound. *Wood v. Underhill*, 5 *How.* 1; *Tyler v. Boston*, 7 *Wall.* 327; *Jenkins v. Walker*, 1 *Holmes*, 120.

67. *Of Combinations.*

The requirement of the patent law that the invention shall be fully and exactly described in the specification, applies with full force to an invention which consists in a new combination of old ingredients. *Gill v. Wells*, 22 *Wall.* 1. If the invention consists merely of a new combination of old elements the specification is sufficient if these are named, their mode of operation given, and the result pointed out. An invention may, however, embrace both a new device or element and a new combination of old devices embodied in the same apparatus or machine. In such a case particular description of the improvement is required in the specification, as the property of the patentee consists not only in the new device, but also in the new combination. *Parks v. Booth*, 102 *U. S.* 96; *aff'g* 1 *Flippin*, 381; 1 *Bann. & A. Pat. Cas.* 225.

A peculiarity of construction of a patented device, which, although shown in the drawings, was not described in the specifications or claimed in the patent, and appeared not to have been, in the mind of the patentee, a part of the essence of the invention, and the effect produced by which was not a part of the expressed

object of the invention, was *held* not sufficiently stated or claimed, to sustain, alone, the patent for a combination, other elements of which had been previously in use. *Bradley & Hubbard Manuf. Co. v. Charles Parker Co.*, 25 *Fed. Rep'r*, 907; 34 *Pat. Off. Gaz.* 249.

68. *The Claim.*

The specification must conclude with a specific and distinct claim or claims of the part, improvement, or combination which the applicant regards as his invention or discovery. *Rules of Prac.* No. 37.

If several inventions, claimed in a single application, be of such a nature that a single patent may not be issued to cover them, the inventor will be required to limit the description, drawing and claim of the pending application to whichever invention he may elect. The other inventions may be made the subjects of separate applications, which must conform to the rules applicable to original applications. If the independence of the inventions be clear, such limitation will be made before any action upon the merits; otherwise it may be made at any time before final action thereon, in the discretion of the examiner. *Id.* No. 41.

The scope of letters patent must be limited to the invention covered by "the claim," and the latter cannot be enlarged by the language used in other parts of the specification. *Railroad Co. v. Mellon*, 104 *U. S.* 112. The patentee must describe, with reasonable certainty, both in what his invention consists, and what his particular claim is. *Wyeth v. Stone*, 1 *Story*, 273; 4 *L. Rep'r*, 54. *Delaware Coal Co. v. Packer*, 5 *Bann. & A. Pat. Cas.* 296; 1 *Fed. Rep'r*, 851; 24 *Pat. Off. Gaz.* 1273.

Failure to state in the claim the nature, extent and character of the invention is the common defect; but a specification may be defective as well by an excess of claim as by a defect in the mode of stating it. *Carver v. Braintree Manuf. Co.*, 2 *Story*, 432; *Root v. Lamb*, 7 *Fed. Rep'r*, 222; 19 *Pat. Off. Gaz.* 937.

Pending an application for a patent, and before it is issued, the claims may be amended to embrace anything contained in the original specifications; and such amended claims need not be verified by the oath and signature of the applicant. *Railway Register Manuf. Co. v. North Hudson Co. R. Co.*, 24 *Fed. Rep'r*, 793.

Where the invention falls within the category of machines, a claim not only for the mechanism but also for the mode of opera-

tion generally, is void. *Hatch v. Moffit*, 15 *Fed. Rep'r*, 252. A claim for an effect or function cannot be sustained; the means by which the effect is produced, or the function performed, must be specified. *Wheeler v. Simpson*, 6 *Pat. Off. Gaz.* 434. And a patentee who, under pretext of securing an invention of his own, enlarges his claim so as to embrace what really was invented by another, only imperils his title to that which is his. *Adjustable Window Screen Co. v. Boughton*, 10 *Phila.* 251; 1 *Bann. & A. Pat. Cas.* 327.

Where an invention consists of an improvement on a machine, the claim should exclude the old parts and claim only the new by which the old were adapted to the new use, producing the new result. *Phillips v. Page*, 24 *How.* 164; *Evans v. Eaton*, 3 *Wheat.* 454; *rev'g Pet. C. Ct.* 322; *Barrett v. Hall*, 1 *Mas.* 447, 476.

A claim in a patent for a process does not cover a condition in the material used in the process which is not referred to and described in the specification and claim within the requirements of *Rev. Stat. § 4888*. *Western Electric Manuf. Co. v. Ansonia Brass &c. Co.*, 114 *U. S.* 447.

Both process and product may be included in one patent; but in such case the description of the invention in the specification and claims should disclose that the inventor had both results in his mind. *Welling v. Rubber Coated, &c. Co.*, 7 *Pat. Off. Gaz.* 606; 2 *Bann. & A. Pat. Cas.* 1.

Where a device is patentable only as used in connection with a particular combination, the claim for such device must limit it to the particular combination of which it so forms a part. *Stewart v. Mahoney*, 5 *Fed. Rep'r*, 302; 4 *Bann. & A. Pat. Cas.* 84.

A claim for a whole combination of machinery and the manner of operating it, which does not set forth and claim particularly the points of novelty constituting the matter of the discovery of the applicant, is too broad, and is properly rejected. *Re Davis*, 1 *Mac Arthur Pat. Cas.* 628.

Claims in a patent for a combination need include only such elements as are essential to the peculiar combination, and are affected by the invention; although the combination would be inoperative without other elements not claimed. *Hancock Inspirator Co. v. Jeaks*, 21 *Fed. Rep'r*, 911.

69. *Amendment of Application.*

The supreme court has said that the law does not permit enlargements of an original specification any more than it does where letters patent already granted are re-issued; and it regards with jealousy and disfavor any attempt to enlarge the scope of an application once filed, or of letters patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alteration, or improvements which have gone into public use. *Railway Co. v. Sayles*, 97 *U. S.* 554.

Nevertheless the rules of the patent-office permit amendments to a limited extent, as follows: The applicant has a right to amend before or after the first rejection; and he may amend as often as the examiner presents any new references or reasons for rejection. In so amending the applicant must clearly point out all of the patentable novelty which he thinks the case presents, in view of the state of the art disclosed by the references cited or objections made. He must also show how the amendments avoid such references or objections. After appeal, or after such action on all the claims as shall entitle the applicant to an appeal to the board of examiners-in-chief, amendments will not ordinarily be allowed. If such amendments are offered, good and sufficient cause therefor must be shown, together with the reasons why they were not earlier presented; and, if satisfied on these points, the examiner may admit and consider them. If the examiner shall refuse to admit and consider such amendments, an appeal will lie to the Commissioner, as in other cases. No amendment can be made between hearing on appeal and decision; and after decision of any appellate tribunal amendments can be made only in accordance with such decision, except as provided in rule 137. *Rules of Prac.* No. 67.

70. *Drawings, When Requisite.*

When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the patent-office; and a copy of the drawing, to be furnished by the patent-office, shall be attached to the patent as a part of the specification. *Rev. Stat.* § 4889.

The courts have held that drawings accompanying an original application for a patent, have the same force and effect as if they were referred to in the specification, and are to be deemed and taken as part of it. *Winans v. Schenectady & Troy R. R. Co.*, 2 *Blatchf.* 279. In reducing his patent to practical application a patentee is not held to strictly and entirely follow the mere mechanical device shown in his drawings, but he may deviate so long as he does not violate the principle involved in his patent. *Weir v. North Chicago Rolling Mill Co.*, 14 *Fed. Rep'r*, 42 ; 9 *Biss.* 508 ; 23 *Pat. Off. Gaz.* 191. The drawings serve to explain the description, and may be used to relieve ambiguity or uncertainty therein ; but cannot supply the entire want of a description or of a claim. *Tinker v. Wilber Eureka Mower, &c. Co.*, 1 *Fed. Rep'r*, 138 ; 9 *Rep'r*, 273 ; 5 *Bann. & A. Pat. Cas.* 92 ; *Howes v. Nute*, 4 *Cliff.* 173 ; *Untermeyer v. Jeannot*, 20 *Fed. Rep'r*, 503. The drawing and model may be taken together in explanation of the description. *Stephens v. Salisbury*, 1 *MacArthur Pat. Cas.* 379. The drawing performs substantially the same office as the model (*Emerson v. Hogg*, 2 *Blatchf.* 1) ; and in many cases may render a model unnecessary (*Loom Co. v. Higgins*, 105 *U. S.* 580 ; rev'g 15 *Blatchf.* 446 ; 16 *Pat. Off. Gaz.* 675 ; 4 *Bann. & A. Pat. Cas.* 88) ; though whether a model shall be required or not rests in the discretion of the commissioner (*Rev. Stat.* § 4891) ; and the whole subject is chiefly regulated by the office regulations.

In case the applicant seeks by amendment to introduce any claim not substantially embraced in the statement of invention or claim originally presented, and, therefore, not covered by the original oath, he will be required to file a supplemental oath to the effect that the subject-matter of the proposed amendment was part of his invention and was invented before he filed his original application, and such supplemental oath must be attached to and properly identify the proposed amendment. *Rules of Prac.* No. 47.

In original applications which are capable of illustration by drawing or model, all amendments of the model, drawings, or specification or of additions thereto must conform to at least one of them as they were at the time of the filing of the application. Matter not found in either involving a departure from the original invention can be shown or claimed only in a separate application. If the invention does not admit of illustration by drawing or model amendment of the specification is permitted upon proof satisfactory to the commissioner that the matter covered by the proposed

amendment was a part of the original invention; the affidavits prescribed in Rule 47 may or may not be sufficient. *Id.* No. 69.

The specification must be amended and revised, when required, for the purpose of correcting inaccuracies of description or unnecessary prolixity, and of securing correspondence between the claim and the other parts of the specification. *Id.* No. 70.

After the completion of the application the office will not return the specification for any purpose whatever. The model or drawing (but not both at the same time) may be withdrawn for correction. If applicants have not preserved copies of such papers as they wish to amend, the office will furnish them on the usual terms. *Id.* No. 71.

All amendments of specifications or claims must be made on sheets of paper separate from the original. Even when the amendment consists in striking out a portion of the specification or of the claims, the same course must be observed. Erasures must not be made by the applicant. In every case of amendment the exact word or words to be stricken out or inserted must be clearly specified, and the precise point indicated where the erasure or insertion is to be made. (See Rule 44.)

When an amendatory clause is amended it must be wholly rewritten, so that no interlineation or erasure shall appear in the clause, as finally amended, when the case is passed to issue. If the number or nature of the amendments shall render it otherwise difficult to consider the case, or to arrange the papers for printing or copying, the examiner or commissioner may require the entire specification to be rewritten.

Amendments must be plainly written or printed on but one side of the paper. All interlineations and erasures must be clearly marked in marginal or foot notes written on the same sheet. *Rules of Prac.* No. 44.

Applications in interference can be amended only as provided in Rules 94, 125. After notice of allowance of an application for a patent, no amendments will be received (unless by authority of the commissioner). Amendments not affecting the merits may be made after allowance and after payment of the final fee, on the recommendation of the primary examiner, approved by the commissioner, without withdrawing the application from issue.

71. *Office Rules as to Drawings.*

The applicant for a patent is required by law to furnish a drawing of his invention where the nature of the case admits of it. *Rules of Prac.* No. 48.

The drawing must be signed by the inventor or by his attorney in fact, and attested by two witnesses, and must show every feature of the invention covered by the claims, and when the invention consists of an improvement on an old machine, it must exhibit, in one or more views, the invention itself, disconnected from the old structure, and also, in another view, so much only of the old structure as will suffice to show the connection of the invention therewith. *Id.* No. 49.

Three several editions of patent drawings are printed and published: one for office use, certified copies, &c., of the size and character of those attached to patents, the work being about 6 by 9½ inches; one reduced to half that scale, or one-fourth the surface, of which four will be printed on a page to illustrate the volumes distributed to the courts; and one reduction—to about the same scale—of a selected portion of each drawing to illustrate the *Official Gazette*. This work will all be done by the photolithographic or other analogous process, and therefore the character of each original drawing must be brought as nearly as possible to a uniform standard of excellence, suited to the requirements of the process, and calculated to give the best results, in the interest of inventors, of the office, and of the public generally. The following rules will therefore be rigidly enforced, and any departure from them will be certain to cause delay in the examination of an application for letters patent:

1. Drawings must be made upon pure white paper of a thickness corresponding to three-sheet Bristol board. The surface of the paper must be calendered and smooth. India ink alone must be used, to secure perfectly black and solid lines.

2. The size of a sheet on which a drawing is made must be exactly 10 by 15 inches. One inch from its edges a single marginal line is to be drawn, leaving the "sight" precisely 8 by 13 inches. Within this margin all work and signatures must be included. One of the shorter sides of the sheet is regarded as its top, and, measuring downward from the marginal line, a space of not less than 1¼ inch is to be left blank for the heading of title, name, number, and date.

3. All drawings must be made with the pen only. Every line and letter (signatures included) must be absolutely black. This direction applies to all lines, however fine, to shading, and to lines representing cut surfaces in sectional views. All lines must be clean, sharp, and solid, and they must not be too fine or crowded. Surface shading, when used, should be open. Sectional shading should be made by oblique parallel lines, which may be about one-twentieth of an inch apart.

4. Drawings should be made with the fewest lines possible consistent with clearness. By the observance of this rule the effectiveness of the work after reduction will be much increased. Shading (except on sectional views) should be used only on convex and concave surfaces, where it should be used sparingly, and may even there be dispensed with if the drawing is otherwise well executed. The plane upon which a sectional view is taken should be indicated on the general view by a broken or dotted line. Heavy lines on the shade sides of objects should be used, except where they tend to thicken the work and obscure letters of reference. The light is always supposed to come from the upper left-hand corner, at an angle of forty-five degrees. Imitations of wood or surface-graining should not be attempted.

5. The scale to which a drawing is made ought to be large enough to show the mechanism without crowding, and two or more sheets should be used if one does not give sufficient room to accomplish this end; but the number of sheets must never be increased unless it is absolutely necessary.

6. Letters and figures of reference must be carefully formed. They should, if possible, measure at least one-eighth of an inch in height, so that they may bear reduction to one-twenty-fourth of an inch; and they may be much larger when there is sufficient room. They must be so placed in the close and complex parts of drawings as not to interfere with a thorough comprehension of the same, and therefore should rarely cross or mingle with the lines. When necessarily grouped around a certain part, they should be placed at a little distance, where there is available space, and connected by short broken lines with the parts to which they refer. They must never appear upon shaded surfaces, and, when it is difficult to avoid this, a blank space must be left in the shading where the letter occurs, so that it shall appear perfectly distinct and separate from the work. If the same part of an invention appear in more than one view of the drawing it must always be represented by the same

character, and the same character must never be used to designate different parts.

7. The signature of the inventor is to be placed at the lower right-hand corner of the sheet, and the signatures of the witnesses at the lower left-hand corner, all within the marginal line. The title is to be written with pencil on the back of the sheet. The permanent names and title will be supplied subsequently by the office in uniform style.

When views are longer than the width of the sheet, the sheet is to be turned on its side, and the heading will be placed at the right, and the signatures at the left, occupying the same space and position as in the upright views, and being horizontal when the sheet is held in an upright position ; and all views on the same sheet must stand in the same direction.

8. As a rule, one view only of each invention can be shown in the Gazette illustrations. The selection of that portion of a drawing best calculated to explain the nature of the specific improvement will be facilitated, and the final result improved, by the judicious execution of a figure with express reference to the Gazette, but which may, at the same time, serve as one of the figures referred to in the specification. For this purpose, the figure may be a plan, elevation, section, or perspective view, according to the judgment of the draftsman. It must not cover a space exceeding sixteen square inches. All its parts should be especially open and distinct, with very little or no shading, and it must illustrate the invention claimed only, to the exclusion of all other details. When well executed, it will be used without curtailment or charge ; but any excessive fineness, or crowding, or unnecessary elaborateness of detail, will necessitate its exclusion from the Gazette. [The pamphlet of Rules of Practice contains a specimen drawing illustrative of the applications of these directions.]

9. Drawings should be rolled for transmission to the office, not folded. No agent's or attorney's stamp, or advertisement, or written address, will be permitted upon the face of a drawing within or without the marginal line. *Id.* No. 50.

There are modifications of these rules in relation to drawings for design patents and for re-issue applications, which are mentioned in the appropriate places. The rules as to drawings generally are rigidly enforced ; and although a drawing not artistically executed in conformity to them may be admitted for purposes of examination, if it sufficiently illustrates the invention, yet a new

and correctly prepared one must be furnished before the application can be allowed. The office will furnish drawings at cost, as promptly as its draftsman can make them, for applicants who cannot otherwise conveniently procure them. *Id.* Nos. 51-54.

72. *Specimens of Ingredients, &c.*

When the invention or discovery is of a composition of matter, the applicant, if required by the commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment. *Rev. Stat.* § 4890.

In all cases where the article is not perishable, a specimen of the composition claimed, put up in proper form to be preserved by the office, must be furnished. *Rules of Prac.* No. 61.

Proof that the samples deposited in the patent-office with the original application do not correspond with the ingredients specified in the re-issue will not impair its validity; whether an applicant has complied with the requisites for obtaining a patent is for the commissioner to determine, and the court will not revise his action. *Tarr v. Folsom*, 5 *Pat. Off. Gaz.* 92; 1 *Holmes*, 312; 1 *Bann. & A. Pat. Cas.* 24.

A patent cannot be held void because the application was not accompanied by specimens; it was for the commissioner to decide whether they were needful. *Badische Anilin, &c. Fabrik v. Cochrane*, 16 *Blatchf.* 155; 4 *Bann. & A. Pat. Cas.* 215.

73. *Model, when requisite.*

In all cases which admit of representation by model, the applicant, if required by the commissioner, shall furnish a model of convenient size to exhibit advantageously the several parts of his invention or discovery. *Rev. Stat.* § 4891.

74. *Oath required from Applicant.*

The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does

not known and does not believe that the same was ever before known or used ; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent, holding commission under the government of the United States, or before any notary public of the foreign country in which the applicant may be. *Rev. Stat.* § 4892.

The rules of the office prescribe that besides stating of what country he is a citizen, he shall state where he resides. And : "in every original application the applicant must distinctly state, under oath, whether the invention has or has not been patented to himself, or to others with his consent or knowledge, in any country, and if it has been, the country or countries in which it has been so patented, giving the date and number of each patent, and that it has not been patented in any other country or countries than those mentioned, and must state that, according to his knowledge and belief, the same has not been in public use or on sale in the United States for more than two years prior to the application in this country." *Rules of Prac.* No. 45. A general provision of statute allows applicants to make affirmation instead of taking oath.

The oath should be attested in all cases, in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made; or when he is not provided with a seal his official character must be established by competent evidence, such as a certificate from a clerk of a court of record or other proper officer having a seal.* *Id.* No. 46.

No patent can properly issue unless oath is duly made (1 *Op. Att. Gen.* 339); if, however, a patent is issued without oath, the omission does not invalidate. *Whittemore v. Cutter*, 1 *Gall.* 429; *Crompton v. Belknap Mills*, 3 *Fish. Pat. Cas.* 536; *Hartshorn v. Eagle Shade Roller Co.*, 18 *Fed. Rep'r*, 90; 25 *Pat. Off. Gaz.* 1191.

* In all applications for letters patent filed in this office subsequent to October 24, 1882, the signature of the applicant is required to the oath, in accordance with form 17, page 63 of Rules of Practice.

A certificate of the official character of a magistrate, stating date of appointment and term of office, may be filed in the patent-office, which will obviate the necessity of separate certificates in individual cases.

The oath must be taken by the applicant in person ; and cannot be by his agent or attorney ; for it relates to matters, some of which can only be written from personal knowledge of the inventor ; if they were sworn to by an agent, the evidence could be nothing but hearsay. 10 *Op. Att. Gen.* 137.

If the application be made by an executor or administrator, the form of the oath will be correspondingly varied. The former attorneys of a deceased inventor have no authority to amend an application for letters patent unsupported by the oath of the personal representative of the decedent. *Eagleton Manuf. Co. v. West, &c. Manuf. Co.*, 2 *Fed. Rep'r*, 774; 18 *Blatchf.* 218; 17 *Pat. Off. Gaz.* 1504; 10 *Rep'r*, 297.

The oath is to be considered as extending to the specification. *Hogg v. Emerson*, 6 *How.* 437, 482

75. *Examination, and Issuing Patent.*

On the filing of any such application and the payment of the fees required by law, the commissioner of patents shall cause an examination to be made of the alleged new invention or discovery ; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor. *Rev. Stat.* § 4893.

All cases in the patent-office are classified and taken up for examination in regular order, those in the same class of invention being examined and disposed of, as far as practicable, in the order in which the respective applications are completed ; but applications which have received action by an examiner and have been put into condition for further action on his part shall be entitled to precedence over completed applications in the same class of invention which have received no action. Cases within classes specified in the rule have also precedence, in time of examination, over ordinary applications. *Rules of Prac.* No. 62.

The first step in the examination of an application will be to determine whether it is, in all respects, in proper form. If, however, the objections as to form are not vital, the examiner may proceed to the consideration of the application on its merits ; but in

such case he must if possible, in his first letter to the applicant, state all his objections, whether formal or otherwise, and until the formal objections are disposed of no further action will be taken upon its merits without the order of the commissioner. *Id.* No. 63.

The hearing before the commissioner of patents, on an application for a patent, is informal and summary, and not final. The application may be renewed from time to time, on the same or additional evidence. The previous hearings and decisions create no further bar to a further investigation. *Gay v. Cornell*, 1 *Blatchf.* 506.

The examiner in a patent case has no power to rule upon the admissibility of evidence, and defendant, as a witness, has a right, upon doubtful questions, to take the opinion of the court; and where he acts in good faith, and under the advice of counsel, his refusal to answer will not be punished as for a contempt, even though he acted mistakenly. *Roberts v. Walley*, 14 *Fed. Rep'r*, 167; 29 *Int. Rev. Rec.* 47; 15 *Rep'r*, 39.

Where the plaintiff, at the time, interposed no objection to the testimony of the witnesses of the defendant, in an examination before an examiner in a patent case, it was *held* too late to raise an objection to such testimony on the hearing before the court on the proofs. Every objection which could have thus been taken, and which did not appear by the record to have been specifically taken, must be considered as having been waived. *Brown v. Hall*, 6 *Blatchf.* 401; 3 *Fish. Pat. Cas.* 531.

Section 7 of the Act of 1836 contained the same condition, if it shall appear, that the invention "is sufficiently useful and important;" and under that statute it was *held* that the degree of usefulness or importance is not described or limited; and is not material, if the invention interferes with no prior right or claim, and is in itself innocent. *Re Aiken*, 1 *McArthur Pat. Cas.* 130. If it is capable of use for some beneficial purpose, the degree of utility, whether larger or smaller, is not a subject for consideration by the commissioner. *Re Seely*, 1 *McArthur Pat. Cas.* 248. But see *Re Cushman*, *Id.* 569.

Mandamus will lie to compel a commissioner who has adjudged that a patent issue, but refuses to prepare it, lay it before the secretary and countersign it, to compel him to perform these ministerial acts; and the writ is properly addressed to the commissioner. *Butterworth v. Hec*, 112 *U. S.* 50, 68.

76. *Limitation upon Time of completing Applications.*

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

There is no limitation of time within which a patent must be taken out, after specification filed. *5 Op. Att. Gen.* 701. Nothing in the acts of Congress requires that a patent should be issued within a given time, after the application is filed, or which forbids the postponement of it for a time at the suggestion either of the applicant or the office. *O'Reilly v. Morse*, 15 *How.* 62, 126; *Allen v. Blunt*, 2 *Woodb. & M.* 121.

Whether an invention was long antecedent to the application for a patent, or directly preceding it, is wholly immaterial to the validity of the patent. *Wilder v. McCormick*, 2 *Blatchf.* 31. The right of the inventor is protected from the time of his application; delay which may occur in the patent-office, in making out a patent, cannot operate to the injury of the applicant. *Root v. Ball*, 4 *McLean*, 177.

Where an inventor keeps his invention a secret, mere delay in applying for a patent will not forfeit his right thereto, or bar his subsequent application; and delay of less than two years will not constitute a defense against a patent in any case. *Miller v. Smith*, 5 *Fed. Rep'r*, 359; 18 *Pat. Off. Gaz.* 1047.

Of the two original inventors, the first will be entitled to letters patent, unless the other puts the invention into public use more than two years before the application for them. *Loom Co. v. Higgins*, 105 *U. S.* 580; rev'g 15 *Blatchf.* 446; 16 *Pat. Off. Gaz.* 675; 4 *Bann. & A. Pat. Cas.* 85.

77. *Abandoned, Forfeited, and Renewed Applications.*

An abandoned application is one which has not been completed and prepared for examination within two years after the filing of

the petition, or which the applicant has failed to prosecute within two years after any action therein, of which notice has been duly given (see Rules 31 and 76), or which the applicant has expressly abandoned by filing, in the office, a written declaration of abandonment, signed by himself (and assignee, if any), identifying his application by title of invention and date of filing.

Prosecution of an application, to save it from abandonment, must include such proper action as the condition of the case may require. *Rules of Prac.* No. 165.

Before an application abandoned by failure to complete or prosecute can be renewed, it must be shown to the satisfaction of the commissioner that the delay in the prosecution of the same was unavoidable. *Id.* No. 166.

When a new application is filed in place of an abandoned or rejected application, a new specification, oath, drawing, and fee will be required ; but the old model, if suitable, may be used. *Id.* No. 167.

A forfeited application is one upon which a patent has been withheld for failure to pay the final fee within the prescribed time. *Id.* No. 168.

Where the patent has been withheld by reason of non-payment of the final fee, any person, whether inventor or assignee, who has an interest in the invention for which such patent was ordered to issue, may file a new application for the same invention ; but such second application must be made within two years after the allowance of the original application. Upon the hearing of such new application, abandonment will be considered as a question of fact. *Id.* No. 169.

In such renewal, the oath, petition, specification, drawing, and model of the original application may be used for the second application ; but a new fee will be required. The second application will not be regarded as a continuation of the original one, but will bear date from the time of renewal, and be subject to examination like an original application. *Id.* No. 170.

Forfeited and abandoned applications will not be cited as references. No notice will be given to applicants, while their cases remain forfeited, of the filing of subsequent applications. Certified copies of the files in cases of rejected and abandoned applications may be furnished to applicants or to other persons when specifically ordered by the Commissioner. *Id.* No. 171. See *post*, § 80.

78. *Applications Renewed after Withdrawal.*

If an applicant for a patent withdraws his application, intending at the time of such withdrawal to file a new petition, and accordingly does so, the two petitions are to be considered as parts of the same transaction, and both as constituting one continuous application. *Godfrey v. Eames*, 1 *Wall.* 317.

The general rule is, that the first in a series of applications for a patent is the one on which the patent, when granted, depends. And if, between the first and a second application, the patentee has manifested an actual intention to abandon the first, his patent will have relation to the last one only. *Pelton v. Waters*, 7 *Pat. Off. Gaz.* 425.

Where an application is made for a patent, and is afterward amended by the withdrawal of parts of the invention, and a second application is filed claiming such parts, and patents afterward issue on both, the two applications will be considered as parts of one continuous proceeding. In such case, the continuity of the proceedings originating in the first application, will be considered unbroken in determining when the two years begin to run in which the invention claimed on the second application could be sold and publicly used without invalidating such patent. *Graham v. Geneva Lake Crawford Manuf. Co.*, 11 *Fed. Rep'r*, 138 ; 21 *Pat. Off. Gaz.* 1536. Various applications for a patent, extending over a period of more than nineteen years, were *held* one continuous application. *Colgate v. Western Union Tel. Co.*, 4 *Bann. & A. Pat. Cas.* 36.

The commissioner may permit one of two competing applicants for a patent to withdraw and refile his application after he has expressed an opinion favorable to the priority of the other. Such intervening opinion or decision is no bar to the issue of a patent on the new application, if, upon full examination of the whole subject, he considers the applicant entitled to it. 5 *Op. Att. Gen.* 220.

The withdrawal of an application for a patent and the return of a part of the patent fee do not necessarily constitute an abandonment or dedication of the invention to the public, but are equivocal, and to be interpreted by circumstances, and to be affected upon a second application by the subsequent conduct of the party—his diligence or his neglect and delay—in the same manner as his conduct is to be weighed in regard to an original application. *Wickersham v. Singer*, 1 *MacArthur Pat. Cas.* 645, 687. They have been held, in *Mowry v. Barber*, 1 *MacArthur Pat. Cas.* 563, to

be an abandonment, and in *Colgate v. Western Union Tel. Co.*, 4 *Bann. & A. Pat. Cas.* 36, not to be one.

79. *Patents Granted to Assignee.*

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

In case of an assignment of the whole interest in the invention, or of the whole interest in the patent to be granted, the patent will, upon request of the applicant, issue to the assignee ; and if the assignee hold an undivided part interest, the patent will, upon like request, issue jointly to inventor and assignee ; but the assignment in either case must first have been entered of record, and at a day not later than the date of the payment of the final fee ; and if it be dated subsequently to the execution of the application, it must give the date of execution of the application, or the date of filing, or the serial number, so that there can be no mistake as to the particular invention intended. The application and oath must be made by the actual inventor, if alive, even if the patent is to issue to an assignee. If the inventor be dead, it may be made by the executor or administrator. *Rules of Prac.* No. 26.

The assignment contemplated by the above section and rule is an assignment of the *invention* and inchoate right to obtain a patent ; and is quite distinct from the assignment of the *letters patent* when obtained ; which is covered by section 4898. The law allows an inventor to transfer his invention before patenting it ; after which an application may be prosecuted by the transferee or assignee, and the patent issued to him ; and the inventor becomes estopped by his antecedent contract of assignment from claiming any adverse title to the patent subsequent to its issue. *Herbert v.*

Adams, 4 *Mas.* 15; Rathbone *v.* Orr, 5 *McLean*, 131. Even though an application has been made in the name of the inventor, so that the patent must issue to him; and even though the application has been rejected and an appeal taken, an assignment of the invention is valid; and operates to vest in the assignee the right to the patent when issued. Gay *v.* Cornell, 1 *Blatchf.* 506; United States Stamping Co. *v.* Jewell, 7 *Fed. Rep'r*, 869; 18 *Blatchf.* 469; 18 *Pat. Off. Gaz.* 1829. So an inventor may sell whatever improvements he may make in the future, as well as those he has already made. Nesmith *v.* Calvert, 1 *Woodb. & M.* 34.

The designation in an assignment of an invention, of the subject matter assigned, as the exclusive right to an invention described in a specification already prepared and executed by the assignor, is sufficient, since the means of ascertainment are furnished. Fisk *v.* Hollander, *MacArthur & Mac.* 355. The designation, in such an assignment, of the assignees by the name and style of the partnership firm, does not render void the assignment or the patent issued to them thereon; since such designation may be applied to the parties intended, by proof of the existence of a partnership bearing that name, and of an actual delivery of the assignment to the partnership so known and designated. *Ib.* An implied license or equitable right to use a patentable improvement, which would be terminated by the issue of a patent to another than the licensor, has been *held*, sufficient to render the licensee incompetent as a witness in interference proceedings, upon the ground of interest, in Cressler *v.* Custer, 1 *MacArthur Pat. Cas.* 216.

The purpose of the provision of Rev. Stat. § 4895—that “patents may be granted, and issued or re-issued to the assignee of the inventor or discoverer, but the assignment must first be entered of record in the patent-office”—is to permit a patent to issue to the person who has the title to the invention upon the records of the patent-office. This purpose is attained when the patent runs to the ultimate assignee of the invention. It is equally well attained when the patent runs to the inventor, or to the inventor's assignee, if, by force of an assignment on record at the time, the grant inures, as soon as the patent issues, to the ultimate assignee. And inasmuch as the grant runs to the grantee named in the patent and his assigns, and operates, therefore, in favor of the ultimate assignee, to convey to him a record title as completely as if he had been named in the patent, and as it is not essential that the grantee named be one who owns the invention when the patent issues, a

patent may be valid when issued to any assignee of record. Nothing in the language of section 4895 or other sections of the patent laws, implies that a patent cannot be properly issued to any assignee whose assignment is duly recorded, when it can be done without impairing the rights of any other person having a paramount title to the invention. *Consolidated Electric Light Co. v. Edison Electric Light Co.*, 25 *Fed. Rep'r*, 719 ; 33 *Pat. Off. Gaz.* 1597. See also, *Selden v. Stockwell Self-Lighting Gas-Burner Co.*, 19 *Blatchf.* 514 ; 9 *Fed. Rep'r*, 390 ; *Read v. Bowman*, 2 *Wall.* 591 ; *U. S. Stamping Co. v. Jewett*, 18 *Blatchf.* 469 ; 7 *Fed. Rep'r*, 869 ; *Perkins v. U. S. Electric Light Co.*, 21 *Blatchf.* 308 ; 10 *Fed. Rep'r*, 513.

In every case where it is desired that the patent shall issue to an assignee, the assignment must be recorded in the patent-office at a date not later than the day on which the final fee is paid. The date of the record is the date of the receipt of the assignment at the office. *Rules of Prac.* No. 206.

80. *When and on what Oath, Executor or Administrator may claim Patent.*

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

Numerous decisions have recognized the principle established by the statute, that the death of an inventor before a grant of letters patent does not abate or impair his inchoate right, but it passes to

his heirs at law or devisees by a patent to be granted to his administrator or executor, as trustee for the person entitled; and the trust declared by the law is implied from the existence of the facts which create the trust. The principle embraces a renewal or reissue, and while extensions were allowed, included extensions. *Woodworth v. Wilson*, 4 *How.* 712; *Wilson v. Rosseau*, *Id.* 646; *Rubber Co. v. Goodyear*, 9 *Wall.* 788; *Washburn v. Gould*, 3 *Story*, 122; 1 *West. L. J.* 465; 7 *L. Rep'r*, 276; *Woodworth v. Sherman*, 3 *Story*, 171; 7 *L. Rep'r*, 279; *Woodworth v. Hall*, 1 *Woodb. & M.* 248; 5 *Pa. L. J.* 178; *Brooks v. Bicknell*, 3 *McLean*, 250; 1 *West. L. J.* 150; *Brooks v. Jenkins*, 3 *McLean*, 432; *S. C.*, *sub nom.* *Brooks v. Bicknell*, 2 *West. L. J.* 11; *Stimpson v. Rogers*, 4 *Blatchf.* 333. There is no necessity that the patent should in terms declare that it is granted to the representative in trust. *Rubber Co. v. Goodyear*, *supra*; *Stimpson v. Rogers*, *supra*.

81. *Renewal of Application in cases of Failure to pay Fees in season.*

Any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who fails to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application. But such second application must be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent was ordered to issue under such renewed application prior to the issue of the patent. And upon the hearing of renewed applications preferred under this section, abandonment shall be considered as a question of fact. *Rev. Stat.* § 4897. See *ante*, §§ 76-78.

VI. ASSIGNMENTS, LICENSES AND OTHER CONTRACTS.

§2. *Assignments of Patents.*

Every patent or any interest therein shall be assignable in law, by an instrument in writing ; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the patent-office within three months from the date thereof. *Rev. Stat. § 4898.*

There are three classes of persons in whom the patentee can vest an interest of some kind in the patent. 1. An assignee : one who has transferred to him in writing the whole interest of the original patent, or an undivided part of such whole interest in every portion of the United States. And no one, unless he has such an interest transferred to him, is an assignee. 2. A grantee : one who has transferred to him in writing the exclusive right, under the patent, to make and use, and to grant to others to make and use, the thing patented within and throughout some specified part or portion of the United States. Such right must be an exclusive sectional right excluding the patentee therefrom. 3. A licensee : one who has transferred to him in writing or orally a less or different interest than either the interest in the whole patent, or an undivided part of such whole interest, or an exclusive sectional interest. *Potter v. Holland, 1 Fish. Pat. Cas. 327.*

The monopoly granted by a patent is for an entire right: the right of making, using and vending the improvement. This right may be assigned entire, for a limited territory only, but cannot be split by assignment of the right to use and sell as distinguished from the right to make. Any instrument which purports to transfer only the right to use and sell, reserving to the patentee the right to make, can operate only between the parties and as a license merely. The legal right in the monopoly remains in the patentee, and he alone can maintain suits for an infringement. *Sanford v. Messer,*

1 *Holmes*, 140 ; *Hill v. Whitcomb*, *Id.* 317 ; 5 *Pat. Off. Gaz.* 430 ; 1 *Bann. & A. Pat. Cas.* 34. See *post*, 98.

Upon the question how far in special cases a patent right may be susceptible of subdivision, see *Whittemore v. Cutter*, 1 *Gall.* 429 ; *Brooks v. Byam*, 2 *Story*, 525 ; *Blanchard v. Eldridge*, 1 *Wall. Jr.* 337 ; *Suydam v. Day*, 2 *Blatchf.* 20 ; *Pitts v. Hall*, 3 *Blatchf.* 201 ; *Parker v. Haworth*, 4 *McLean*, 370.

Interests in patents may be vested in assignees, in grantees of exclusive sectional rights and mortgagees, and in licensees. 1. An assignee is a transferee of the whole interest of the original patent or of an undivided part of such whole interest, extending to every portion of the United States. The assignment must be written or printed, and duly signed. 2. A grantee acquires by the grant the exclusive right, under the patent, to make and use, and to grant to others the right to make and use, the thing patented, within and throughout some specified part of the United States, excluding the patentee therefrom. The grant must be written or printed, and duly signed. 3. A mortgage must be written or printed, and duly signed. 4. A licensee takes an interest less than or different from either of the others. A license may be oral, or written or printed, and duly signed. *Rules of Prac.* No. 202.

All interests in a patent are assignable in writing, and a purchaser thereof has a right to rely upon the title as appearing from the records of the patent-office. A conveyance by a party of all his property excepting such as is exempt by law from levy and sale under execution, will not pass the title to a patent, though it may operate upon a chose in action for past infringement. *Campbell v. James*, 2 *Fed. Rep'r*, 338 ; 18 *Blatchf.* 92 ; 18 *Pat. Off. Gaz.* 1111 ; 10 *Rep'r*, 103 ; 5 *Bann. & A. Pat. Cas.* 354.

If a power of attorney is executed for the purpose of providing that a right in a patent may inure to the benefit of another, it is, in a court of equity, equivalent to an assignment, and is not revocable. *Dav v. Candee*, 3 *Fish.* 9.

83. Parties to Assignments.

Upon the death of a patentee, the title to the patent vests in his personal representatives. *Bradley v. Dull*, 19 *Fed. Rep'r* 913 ; *Pelham v. Edelmeyer*, 25 *Pat. Off. Gaz.* 292 ; *Hodge v. North Missouri R. R.*, 1 *Dill.* 104. "Legal representatives" in the patent act means executors or administrators. *Shaw Relief Valve*

Co. v. New Bedford, 28 *Pat. Off. Gaz.* 283 ; 19 *Fed. Rep'r*, 753. An administrator of a patentee may assign the patent which has been renewed in his own name ; or grant an interest therein. Brooks v. Jenkins, 3 *McLean*, 432 ; S. C., *sub nom.* Brooks v. Bicknell, 2 *West. L. J.* 11.

A married woman, an infant, or a person under guardianship may take a patent as patentee or assignee. In case of an assignment by such a person, all that the United States law requires is that it shall be in writing so as to be recorded, but the capacity to make it must be found in the State law. Fetter v. Newhall, 17 *Fed. Rep'r*, 841 ; 25 *Pat. Off. Gaz.* 502 ; 16 *Rep'r*, 360.

An assignee in insolvency or a receiver under State laws does not, by virtue of his general assignment or appointment acquire patent rights issued to the assignor. Alger v. Murray, 105 *U. S.* 126 ; Dick v. Struthers, 25 *Fed. Rep.* 103. Neither an assignee in insolvency nor a receiver can acquire or pass a title to a patent, except by a written instrument, signed by the owner of the patent and duly recorded. Gordon v. Anthony, 16 *Pat. Off. Gaz.* 1135. The title of an insolvent debtor to, or his interest in, letters-patent for an invention, does not pass to his assignee in insolvency. The patent act contemplates a written instrument, signed by the owner of the patent, and duly recorded in the patent-office, as necessary to vest the legal title in the purchaser. *So held*, of an insolvent assignment, made by a judge of probate and insolvency, under the insolvency law of Massachusetts. Ashcroft v. Walworth, 1 *Holmes*, 152 ; 2 *Pat. Off. Gaz.* 546 ; 5 *Fish. Pat. Cas.* 528. But a court of equity may direct the sale of the interest of an inventor in his patent, in order to satisfy a judgment obtained against him in a court of law (the writ of execution having been returned *nulla bona*), and for that purpose will require the patentee to make an assignment of the patent as provided in Rev. Stat. § 4898 ; and in the event of the refusal of the patentee to do so, will appoint a trustee with authority to execute the same. Murray v. Ager, 1 *Mackey*, 87 ; s. e. 105 *U. S.* 126. Where a patent has been transferred by the patentee in fraud of his creditors, a creditor's suit may be maintained in a United States circuit court, by a judgment creditor whose judgment was recovered in a State court, to subject the patent right to the payment of his judgment ; the citizenship of the parties and the amount in demand being such as to give the circuit court jurisdiction. Gorrell v. Dickson, 26 *Fed. Rep'r*, 454.

84. *Requisites and Sufficiency.*

As a general rule, an assignment of an interest in a patent must be in writing, for the reason that such transactions are required to be recorded. *Baldwin v. Sibyl*, 1 *Cliff.* 150. The statute authorizes assignments only in writing, and the legal ownership can be acquired only by written instruments. *Jordan v. Dobson*, 4 *Fish.* 232 ; 2 *Abb. U. S.* 398. A conveyance of a right under a patent, of a character to create an interest in the patent itself, must be in writing ; though a license to make and use a machine need not be in writing, as it need not be recorded, and conveys neither an interest in the patent itself, nor a power authorizing a third person to construct the patented invention. *Baldwin v. Sibley*, 1 *Cliff.* 150.

The execution of an assignment by a corporation and by S., president, was *held*, to be a good execution by S. for his individual interest. *Campbell v. James*, 17 *Blatchf.* 42 ; 4 *Bann. & A. Pat. Cas.* 456 ; 18 *Pat. Off. Gaz.* 979. See reversal, 104 *U. S.* 357.

Under the New York statutes, assignments of patents duly acknowledged before a notary are sufficiently proved ; the complainant need not prove the signatures of the assignors. *Houghton v. Jones*, 1 *Wall.* 702 ; *New York Pharmaceutical Association v. Tilden*, 23 *Pat. Off. Gaz.* 272 ; 14 *Fed. Rep'r.*, 740 ; 21 *Blatchf.* 190. A certified copy of an unacknowledged instrument recorded in the patent-office, purporting to be a duly executed assignment of a patent was *held* in a suit for infringement, sufficient proof of assignment, in the absence of countervailing testimony. *Dederick v. Whitman Agricultural Co.*, 26 *Fed. Rep'r.*, 763. In general, a certified copy of an assignment from the patent-office is *prima facie* evidence of the genuineness of the original. *Lee v. Blandy*, 2 *Fish.* 89 ; 1 *Bond.* 361.

Where there is reason to doubt the construction of an assignment, its language should be taken against the grantor, as he is chargeable with any obscurity in this respect. *Smith v. Selden*, 1 *Blatchf.* 475 ; *May v. Chaffee*, 5 *Fish. Pat. Cas.* 160 ; 2 *Dill.* 385.

Validity.

An assignment of a patent may be made as well before the issuing of the patent as afterward. The thing to be assigned is not the mere parchment, but the monopoly conferred—the right of property which it creates ; and when the party has acquired an

inchoate right, an assignment of it is legal. After the patent has been issued no new assignment is necessary ; the legal right to the monopoly and the property it created is vested by operation of the assignment in the assignee. *So held*, when the assignment has been recorded before the patent issued. *Gayler v. Wilder*, 10 *How.* 477, 493. See *ante*, p. 90.

If an assignment is duly made, the motive for making it is not material. The legal title passes to the assignee, who may maintain suit for infringement without joining the patentee. *Siebert Cylinder Oil Cup Co. v. Phillips Lubricator Co.*, 10 *Fed. Rep'r*, 677.

An assignment of all the grantor's interest in certain letters patent, "except a number of counties heretofore conveyed," is not void for uncertainty because the counties reserved are not named. They may be identified by extrinsic evidence, or by averment in pleading not traversed. *Washburn, &c. Manuf. Co. v. Haish*, 4 *Fed. Rep'r*, 900 ; 10 *Biss.* 65 ; 19 *Pat. Off. Gaz.* 173.

An instrument purporting to be an assignment of an expired patent can have no operation as an assignment. *Bell v. McCullough*, 1 *Fish. Pat. Cas.* 280 ; 1 *Bond*, 194.

Delay in making an assignment of a patent after an agreement to sell, is not, of itself, evidence of fraud. *Troy Iron, &c. Factory v. Corning*, 14 *How.* 193 ; *rev'g* 1 *Blatchf.* 467.

Where a person, feeble in mind and body, and incapable of exercising control over his property, or of managing it in a prudent, careful manner, or of making any contract with reference thereto, was unduly influenced to purchase an interest in a patent-right of doubtful utility, and in consideration therefor to assign notes and a mortgage on real property to the defendant, it was *held* that such assignment was void, and transferred no title to the assignee. *Colburn v. Van Velzer*, 11 *Fed. Rep'r*, 795 ; 3 *McCrory*, 650.

Parol evidence of fraudulent representations in obtaining an assignment of a patent, is admissible to impeach the instrument. *Day v. New England Car Spring Co.*, 3 *Liv. L. Mag.* 44.

An assignee of a patent was *held* not relieved from the payment of royalties to his assignor because of alleged fraud in withholding the fact that another patent, afterward adjudged invalid, covered a part of the invention. *Shaw v. Soule*, 20 *Fed. Rep'r*, 790.

86. *What Property of Interest passes.*

A patent is a triple right; it includes to make, to use and to sell, the patented invention. *Adams v. Burke*, 17 *Wall.* 453; *Dorsey Rake Co. v. Bradley Manuf. Co.*, 12 *Blatchf.* 202; 1 *Bann. & A.* 330. A patentee may grant to another the right to make, or to make and sell for use here, and retain to himself the exclusive right to make and sell for export, or use in other countries. *Dorsey R. H. Rake Co. v. Bradley M'fg Co.*, *supra*. A patentee has the exclusive right to make, use and vend the device patented, and it is his privilege to grant the exclusive right to make to one person, to use to another, and to vend to another. *Steam Stone Cutter Co. v. Sheldon*, 5 *Fish.* 477; 10 *Blatchf.* 1; *Adams v. Burke*, 4 *Fish.* 392; 1 *Holmes*, 40; 1 *Pat. Off. Gaz.* 282; *Bicknell v. Todd*, 5 *McLean*, 233. A patentee may convey the right to make so as to include the right either to sell or use. He also may convey the right to use so as to imply the right to sell. The circumstances, nature, and terms of each grant must decide the construction. *Woodworth v. Curtis*, 2 *Woodb. & M.* 524. A grant of an exclusive right to make, use, and vend patented articles within certain territory, confers the right to make and vend within said territory for use elsewhere, and any person who manufactures said machines within said territory without the consent of the grantee, infringes his right, although the machines may neither be sold nor used within said district. *Jenkins v. Greenwald*, 2 *Fish. Pat. Cas.* 37; 1 *Bond*, 128. See *ante*, 91.

A deed by a patentee of an invention, conveying all the right, title and interest which he has in the said "invention," as secured to him by letters patent, and also all right, title and interest which may be secured to him from time to time, the same to be held by the assignee for his own use and for that of his legal representatives, "to the full end of the term for which said letters patent are or may be granted," was *held* to carry the entire invention and all alterations and improvements, and all patents whatsoever, issued and extensions alike, to the extent of the territory specified. *Railroad Co. v. Trimble*, 10 *Wall.* 367.

An assignment under a specific patent does not authorize the assignee to use subsequent improvements, although they may have been invented and attached to the original device at the time the transfer was executed. *American Hide and Leather Company v.*

American Tool & Machine Co., 4 *Fish. Pat. Cas.* 284 ; 1 *Holmes*, 503.

An assignment by the inventor, of a patent, together with the right to improvements to be subsequently invented or patented, does not include a later patent where the construction and mode of operation are substantially different. *Stebins Hydraulic Elevator Mfg. Co. v. Stebins*, 17 *Pat. Off. Gaz.* 1348 ; 1 *Fed. Rep.* 445 ; 5 *Bann. & A. Pat. Cas.* 199.

The sale of an "invention" carries with it the exclusive right to all present or future patents by the same inventor for the particular invention sold. *Hammond v. Hunt*, 4 *Bann. & A. Pat. Cas.* 111.

The inventor is vested by law with an inchoate right to the exclusive use of his device which he may perfect by proceeding as prescribed by law. An assignment of his whole interest is equally within the act, whether made before or after the patent is issued. If made before the issuing of the patent, it transfers the legal title to the assignee, although the patent afterwards issues to the inventor. *Gayler v. Wilder*, 10 *How.* 477 ; *Rathbone v. Orr*, 5 *McLean*, 131 ; *Rich v. Lippincott*, 2 *Fish. Pat. Cas.* 1 ; *Herbert v. Adams*, 4 *Mas.* 15.

Refusal of assignee to perform conditions subsequent, cannot re-vest the title to the invention in the assignor ; his remedy is action for damages. *Mallory v. Mackaye*, 22 *Pat. Off. Gaz.* 945 ; 12 *Fed. Rep.* 328.

The assignment of a patent does not carry with it a transfer of the right to damages for an infringement committed before such assignment. *Moore v. Marsh*, 7 *Wall.* 515.

Patent standing in the name of one partner, does not pass by assignment of the "firm property." *McWilliams Manuf. Co. v. Blundell*, 22 *Pat. Off. Gaz.* 177.

Two persons owning exclusive patent rights covering different territories, desiring to effect a community of interest in the whole property, conveyed the rights to a third person as trustee, authorizing him to sell rights, grant licenses, &c. It was *held* the legal effect of the instrument was to make the trustee their agent, to carry out their joint instructions. *Ladd v. Mills*, 22 *Blatchf.* 242 ; 20 *Fed. Rep.* 792.

An assignment of a patent to an assignee in trust, gives him the legal title. *Campbell v. James*, 17 *Blatchf.* 42 ; 4 *Bann. & A. Pat. Cas.* 456 ; 18 *Pat. Off. Gaz.* 979, rev'd, 104 *U. S.* 357.

Whether one of two persons holding a patent as trustees, administrators, or the like, can assign it, acting alone, see *Barker v. Stowe*, 11 *Fed. Rep'r*, 303 ; 22 *Pat. Off. Gaz.* 258 ; *Wintermute v. Redington*, 1 *Fish. Pat. Cas.* 239. Under a conveyance of the entire legal title to patents to joint trustees, with full power to dispose of them at their discretion, the joint deed of both is required to convey any title to, or interest in, the patents. *Westcott v. Wayne Agricultural Works*, 11 *Fed. Rep.* 298.

87. *Rights of the Parties in other Respects.*

An assignment of an exclusive right to make, use and vend to others a patented machine within a certain territory only, does not prohibit the assignee from selling elsewhere, out of the said territory, the products of such machines. The restriction in the assignment applies solely to the using of the machine, and is no restriction as to place of the sale of the product. *Simpson v. Wilson*, 4 *How.* 709.

An assignee of a patent taking with knowledge of an existing agreement by the assignor licensing others to make and sell the patented article, is bound by such agreement, and may be restrained from violating negative covenants on the part of his assignor contained in it. *Hapgood v. Rosenstock*, 23 *Fed. Rep'r*, 86.

The assignee of all the right, title and interest of the patentee in his invention and patent in a specified territory, without any restriction upon his right to vend in said territory, may, as opposed to the rights of a subsequent assignee for other territory, lawfully sell the patented article within his own territory, without restriction or condition. *McKay v. Wooster*, 2 *Sawyer*, 373 ; 3 *Pat. Off. Gaz.* 441 ; 6 *Fish. Pat. Cas.* 375 ; 6 *Am. L. T.* 169.

A grantee for a specified territory cannot be restrained from advertising and selling within it merely because the purchasers may take the patented articles outside. *Hatch v. Hall*, 30 *Pat. Off. Gaz.* 1096 ; 22 *Fed. Rep.* 438.

The sale of a patent-right creates an implied warranty as to title, growing out of the sale itself, and draws to it any after-acquired right of the warrantor. Even if the patent be invalid, the warrantor may be estopped from using the thing sold, within the territory for which he sold his alleged right. *Faulks v. Kamp*, 3 *Fed. Rep'r*, 898 ; 17 *Blatchf.* 432 ; 17 *Pat. Off. Gaz.* 851 ; 9 *Rep'r*, 304 ; 5 *Bann. & A. Pat. Cas.* 73. The assignee of a patent has

the right, as against the assignor, to manufacture under the patents though it be void as to the rest of the world ; and cannot be precluded, by reason of an older patent, control of which is procured by the assignor, from exercising his rights under the assignment. *Curran v. Burdsall*, 20 *Fed. Rep'r*, 835. The warranty of title to a patent, or the right to a warranty, draws to it any after-acquired right or title of the warrantor. *Ib.*

Assignees of a patented invention are not concluded or estopped by the statement made by their assignor, in his application for the patent, of the date of his invention, from proving (on a question of interfering patents) that the true date was earlier. *Union Paper Bag Machine Co. v. Crane*, 1 *Holmes*, 429 ; 6 *Pat. Off. Gaz.* 801. A license to use a patent contained a provision that it should not be transferred without the consent of the licensor. It appeared that after an assignment, without consent, the assignee of the licensor made a settlement and received royalties from the assignees. It was *held*, the assignee was estopped from urging the invalidity of the transfer. *Bloomer v. Gilpin*, 4 *Fish. Pat. Cas.* 50. If one of several joint patentees assigns to a third person, the estoppel on the assignor works a license to the assignee to use the patent, and the joint owners must look to the one who assigned, for an accounting. *Curran v. Birdsall*, 20 *Fed. Rep'r*, 835. One of two owners in common of two patents, one of which was for an improvement on the other, granted his interest in the later patent to his associate, in consideration of the latter's assignment to him of the earlier patent. It was *held*, that he who thus became sole owner of the earlier patent was estopped from claiming that the later one was an infringement upon it. *Rumsey v. Buck*, 20 *Fed. Rep'r*, 697. The assignee of a patent stands in full privity to a decree for infringement obtained by the assignor (*Dayton v. Wright*, 11 *Pat. Off. Gaz.* 197) ; and is estopped by one which binds his assignor. *Pennington v. Hunt*, 20 *Fed. Rep'r*, 195.

The legal title to a patent will prevail over the equitable title, unless the rights of the holder of the legal title were acquired with notice of the equities of the one in whom the equitable title was. *Davis Improved Wrought-iron Wagon Wheel Co. v. Davis Wrought-iron Wagon Co.*, 20 *Fed. Rep'r*, 699.

One who took an assignment of the rights in litigation of a defendant in an action for violating a patent, pending an application for an injunction, was *held*, to have no other or higher

rights than his assignor, and not to be entitled to be deemed an independent infringer. *Parkhurst v. Kinsman*, 2 *Blatchf.* 78.

An assignment of all interest in a patent, was *held* to have dissolved the partnership for working it. *Parkhurst v. Kinsman*, 1 *Blatchf.* 488 ; 8 *N. Y. Leg. Obs.* 146.

Where an assignment of a right under a patent refers to the patented improvement as being in use by a certain party, such reference is express information to the assignee of the fact of such use; and, the party referred to being in possession to the extent of such use, such possession is constructive notice of the claim of right under which the possession and use are had. *Prine v. Brandon Manuf. Co.*, 16 *Blatchf.* 453 ; 4 *Bann. & A. Pat. Cas.* 379.

No guaranty of title is binding against the setting up of unfounded claims. *So held* of a patent. *Shaw v. Soule*, 20 *Fed. Rep'r*, 790.

Where, through several assignments, an individual becomes the owner of a number of distinct patents, his rights are no greater than those of his assignors respectively. *Washburn, &c. Manuf. Co. v. Griesche*, 16 *Fed. Rep'r*, 669.

When a patent has been assigned upon condition of re-assignment under certain contingency, the court will decree a re-transfer when the contingency arises. *Andrews v. Fielding*, 20 *Fed. Rep'r*, 123.

88. *Illustrative Cases determining Rights under Particular Assignments.*

An assignment expressed to run "to the full end of the term for which letters patent are or may be granted," includes reissues, renewals, and extensions. *Railroad Co. v. Trimble*, 10 *Wall.* 367 ; *Ruggles v. Eddy*, 5 *Fish. Pat. Cas.* 581 ; 10 *Blatchf.* 52 ; *Thayer v. Wales*, 5 *Fish.* 448 ; *Phelps v. Comstock*, 4 *McLean*, 353 ; *Case v. Redfield*, 4 *McLean*, 526 ; *Gear v. Holmes*, 6 *Fish.* 595 ; *Emmons v. Sladdin*, 9 *Pat. Off. Gaz.* 352 ; 2 *Bann. & A. Pat. Cas.* 199 ; *Good-year v. Cary*, 4 *Blatchf.* 271.

An assignment of a re-issued patent, transferring to the assignee all the right, title and interest which the patentee has "in the said invention and letters patent," &c., was *held*, to transfer an extension and renewal notwithstanding the patent was reissued subsequently to the assignment. *Nicholson Pavement Co. v. Jenkins*, 4 *Wall.* 452.

T. transferred to S. all his right, title and interest in a patent, and afterward transferred to D. all his right, title and interest in the same patent. Subsequently S. transferred to T. all the interest T. had conveyed to him. It was *held*, that D. acquired nothing by the transfer to him, and that such transfer to T. did not inure to the benefit of D. so as to perfect his title. *Perry v. Corning*, 7 *Blatchf.* 195.

A. and B., general owners of a patent, except for certain counties in Michigan, united with C., the owner of those counties, in appointing B., their attorney and agent, to sell the patent improvement in whole or in part. In a conveyance of a right to manufacture and sell in Chicago, Ill., the agent signed the names of A. and B., but not C. It was *held*, that C. had no interest in the territory conveyed, and that he need not join in the grant. *May v. Chaffee*, 5 *Fish. Pat. Cas.* 100.

An agent employed to sell, having secretly purchased from the owner, and afterward sold the invention at considerable advance, is deemed a trustee for the principal as to the surplus realized, and he cannot re-acquire the rights and compel his employer to accept them. *Jeffries v. Wiester*, 2 *Sawyer*, 135.

D. applied, in August, 1866, for a patent for a hand-mirror, and at the same time for a patent for "a brush in which the bristles are inserted through a perforated plate, or holder, imbedded in a composition or cement of any suitable substance, as described, which cement shall, in common with a base-piece and stiffener of metal, or other material, form the back and handle of the brush, substantially as specified." The back of the hand-mirror, for which a patent was applied, was to be substantially of the same construction as the back of the brush. While the applications for both patents were pending, D. assigned to a corporation all his inventions "in the manufacture of composition brush-backs and handles, with suitable strengtheners," and all applications for a patent "therefor," and certain apparatus, used by him "in said manufacture," with all his useful information "for making and selling said composition brush backs and handles," "meaning hereby to transfer" all his rights "to the manufacture and sale of said composition brush-backs and handles." It was *held*, that this was only an assignment of the brush-back, and of the application for the brush patent, and did not carry a right to the invention of the hand-mirror. *Clark v. Scott*, 5 *Fish. Pat. Cas.* 245.

The expression "right, title, and interest" contained in an

assignment from a person holding under the patentee, is enough to put the assignee on inquiry, and to charge him with notice of what such inquiry, if made of the first grantor, would have disclosed. *Hamilton v. Kingsbury*, 17 *Pat. Off. Gaz.* 847; 5 *Bann. & A. Pat. Cas.* 157; 17 *Blatchf.* 460; 4 *Fed. Rep.* 428.

S. and E., patentees, executed an agreement, sale and grant to B. of "the said invention and letters-patent or extensions to be hereafter obtained on account of said invention," and containing certain covenants and agreements of quiet enjoyment of all rights under the patent so assigned, and not to make or sell, or cause to be made or sold any other machine for the purpose to which such patented machine was applicable. Subsequently S. and L. took out a patent and obtained a reissue thereof for inventions of the same character and purpose of that described in the sale or assignment to B., and brought suit against the plaintiffs herein, who were the purchasers and assignees of B.'s interest. It was *held*, that the title of S. and L. must be held to be only in trust for B. and his assigns, so far as the letters-patent of the United States embraced any inventions made by S. before the conveyance to B. and incorporated in the agreement of sale and grant to B. by S. and E. *Emmons v. Sladdin*, 9 *Pat. Off. Gaz.* 352.

A patentee granted to V. the exclusive right to construct and use and vend within a certain territory, ten *planing, tonguing and grooving* machines, and the grant declared that V. was to enjoy an exclusive use of the patent within said territory, limited to said ten machines; and afterward the patentee granted to K. the exclusive right under the patent of making, using and vending, within the same territory, *moulding planing machines*. It was *held*, that the grant first made to V. conveyed the entire interest of the patentee, and that the subsequent grant to K. was void. *Ritter v. Serrell*, 2 *Blatchf.* 379.

An inventor caused a patent to be granted to himself and two others under an agreement to that effect, and that they should have the exclusive right to manufacture and sell, until the patent expired. Later, he caused a patent to issue to himself alone, and afterward assigned it to the complainant. It was *held*, that the legal title to the last-mentioned patent was in the complainant. *Graham v. McCormick*, 5 *Bann. & A. Pat. Cas.* 244.

An assignment of a patent, paid for partly in cash and partly by several notes, contained a condition that the assignment should be void if the assignee failed to pay any one of the notes within ten

days after it was due. It was *held*, that a failure to pay a number of the notes last due worked a forfeiture of the assignment, so as to make a license granted by him after such failure void. *Abbett v. Lusi*, 5 *Bann. & A. Pat. Cas.* 38; 3 *N. J. L. J.* 47.

The sale by a patentee, for a term of years, of the exclusive right in a patent, reserving certain shop-rights, does not debar him from bringing suit against a third party for infringement, as he has a beneficial interest in the right secured by the patent. *Still v. Reading*, 20 *Pat. Off. Gaz.* 1025; 9 *Fed. Rep'r*, 40; 4 *Woods*, 345.

89. *Recording.*

For the statute on this subject, see *ante*, pp. 93, 94.

No instrument will be recorded which does not, in the judgment of the commissioner, amount to an assignment, grant, mortgage, lien, incumbrance or license, or affect the title of the patent or invention to which it relates. *Rules of Prac.* No. 204.

Assignments which are made conditional on the performance of certain stipulations, as the payment of money, if recorded in the office, are regarded as absolute assignments, until canceled with the witten consent of both parties, or by the decree of a competent court. The office has no means of determining whether such conditions have been fulfilled. *Id.* 205.

The receipt of assignments is not generally acknowledged by the office. They are recorded in regular order as promptly as possible, and then transmitted to the persons entitled to them. *Id.* 207.

An assignment to an assignee in bankruptcy, of all patents owned by the bankrupt, is not required to be recorded. Rev. Stat. § 5046, vests patent-rights at once in the assignee. *Prime v. Brandon Manuf. Co.*, 4 *Bann. & A. Pat. Cas.* 379; 16 *Blatchf.* 453.

As between the parties, recording is not necessary. The effect of the statute is that as against a subsequent purchaser from the patentee, for a valuable consideration, acting in good faith and without notice, the assignment, if unrecorded for three months from the time when it was made, is invalid. *Perry v. Corning*, 7 *Blatchf.* 195; *Hall v. Speet*, 1 *Pittsb.* 513; 6 *Pitts. Leg. J.* 403.

But an unrecorded assignment of all the grantor's right, title, and interest, in and to a certain patent, is good as against a subse-

quent recorded assignment made by the same grantor to a purchaser having notice of the previous assignment. *Ashcroft v. Walworth*, 1 *Holmes*, 152 ; 2 *Pat. Off. Gaz.* 546 ; 5 *Fish. Pat. Cas.* 528. So an agreement which operates as a transfer of a patent is good as against the patentee and those who purchase with notice, though not recorded. *Continental Windmill Co. v. Empire Windmill Co.*, 4 *Fish.* 428 ; 8 *Blatchf.* 295. The subsequent assignment may, by its mere terms, give notice of a prior one ; thus it has been held that a conveyance of " all my right, title, and interest in and to " a patent, though properly recorded, does not include the right for territory covered by a prior conveyance, although the prior conveyance was not recorded in the patent-office. *Turnbull v. Weir Plow Co.*, 14 *Fed. Rep'r*, 108 ; 9 *Biss.* 334 ; 23 *Pat. Off. Gaz.* 91 ; 5 *Bann. & A. Pat. Cas.* 288. A purchaser has the right to rely upon the apparent record title, so long as he acts in good faith ; he must, however, have parted with a consideration large enough to make it inequitable for him to be required to give up the property to one who has not the apparent legal title, and this consideration should be set forth in amount, in a plea setting forth the title. *Secombe v. Campbell*, 2 *Fed. Rep'r*, 357 ; 18 *Blatchf.* 108 ; 9 *Rep'r*, 708 ; 5 *Bann. & A. Pat. Cas.* 429.

The term of three months is merely directory ; any subsequent recording of an assignment of a patent will suffice to vest the assignee with title except as to intermediate *bona fide* purchasers without notice. *Pitts v. Whitman*, 2 *Story*, 609 ; *Brooks v. Byam*, 2 *Story*, 525 ; *Boyd v. McAlpin*, 3 *McLean*, 427 ; *Case v. Redfield*, 4 *McLean*, 526. And with respect to the assignment of an invention, recording at any time before the issuing of the patent is sufficient. *Gay v. Corneil*, 1 *Blatchf.* 503.

With respect to an assignee's right to maintain suit, it is not complete until he has recorded his assignment. *Wyeth v. Stone*, 1 *Story*, 273. But the fact that the recording does not take place till after suit commenced does not defeat the suit. *Pitts v. Whitman*, 2 *Story*, 609. And a conveyance, made after the patent has expired, of the mere right to sue for infringements which were committed during its lifetime does not need recording. *Gear v. Fitch*, 16 *Pat. Off. Gaz.* 1231.

The statute as to recording assignments does not extend to licenses (*Brooks v. Byam*, 2 *Story*, 525 ; *Chambers v. Smith*, 5 *Fish. Pat. Cas.* 12 ; *Farrington v. Gregory*, 4 *Id.* 221) ; and a purchaser of the right granted by one such, which is recorded, takes

subject to others which may have been executed contemporaneously with it, but were not recorded. *Hamilton v. Kingsbury*, 17 *Blatchf.* 264 ; 17 *Pat. Off. Gaz.* 147 ; 4 *Bann. & A. Pat. Cas.* 615.

90. *What is a License.*

A license is the mere right to use the invention ; and is neither an assignment nor a grant within the meaning of Rev. Stat. § 4928. *Wooster v. Seidenburg*, 10 *Pat. Off. Gaz.* 244. The transfer only of a right to use and vend the invention for limited purposes in specified places, is not a transfer of an undivided part of an entire patent, and the transferee is merely a licensee. *Gamewell Fire Alarm Co. v. Brooklyn*, 14 *Fed. Rep'r*, 255 ; 22 *Pat. Off. Gaz.* 1979 ; 15 *Rep'r*, 40. The construction and use of a device, with consent of the inventor, before application for patent, operates as a special license to continue to use the specific thing. *Magoun v. N. E. Glass Co.*, 3 *Bann. & A. Pat. Cas.* 114. While employment to invent and perfect machinery for a particular purpose will operate as a license to the employer, it will not of itself confer upon the employer any legal title to the invention or to the letters patent protecting it. *Whiting v. Graves*, 3 *Bann. & A. Pat. Cas.* 222 ; 13 *Pat. Off. Gaz.* 455 ; *Wilkins v. Spafford*, 3 *Bann. & A. Pat. Cas.* 274 ; 13 *Pat. Off. Gaz.* 675.

An agreement by which a patentee conveys to a grantee the exclusive right to make and vend the thing patented, within a certain territory, reserving to the grantor the right to make and sell within the same territory, is not an assignment of an exclusive interest in the patent, but is only a license. *Gaylor v. Wilder*, 10 *How.* 477. S. P., *Sanford v. Messer*, 2 *Pat. Off. Gaz.* 470 ; 5 *Fish. Pat. Cas.* 411 ; *Theberath v. Celluloid Manuf. Co.*, 3 *Fed. Rep'r*, 143 ; 10 *Rep'r*, 326 ; 5 *Bann. & A. Pat. Cas.* 597.

An exclusive right to use, within a specified territory, a patented acid in making self-raising flour, and to use and sell the flour so made within such territory, was *held*, (under 5 Stat. 121, §§ 11, 14, in force at the time the right was granted), to be a mere personal license, and not an assignment or grant of an exclusive right which would go to executors, administrators or assigns, in the absence of express words showing an intent to so extend it. [Citing 10 *How.* 477, 494 ; 13 *How.* 193, 416 ; and distinguishing 10 *Heisk.* 322.] *Oliver v. Rumford Chemical Works*, 109 *U. S.* 75.

A patentee, in consideration of weekly payments, assigned and

released all his right, title and interest in the patent, so far only as to include the exclusive right of manufacturing and vending for a term of years ; and stipulated that in case of default of payment the patentee should have the right to claim and take back the interest. It was *held*, that this agreement conveyed no interest in the patent right, but amounted to a mere license with a limitation or condition as to its continuance. *Armstrong v. Hanlenbeck*, 3 *N. Y. Leg. Obs.* 43.

Where A. erected, on his own premises and at his own expense, a machine, the invention of B., and B. then leased the machine of A. for a term of years, covenanting to deliver the same to A. at the end of the term, it was *held*, that this amounted to a license or a consent in writing (under the patent act of 1790, § 4), to use the machine after the end of such term. *Keutgen v. Kanowrs*, 1 *Wash.* 163.

91. *Presumption or Proof of a License.*

Licenses are not required to be in writing, neither need the amount of fee be shown by writing ; the whole may be shown by parol. *Wooster v. Simonson*, 28 *Pat. Off. Gaz.* 918 ; 20 *Fed. Rep'r*, 317.

If an employer has any right to the invention made by an employé during the period of his employment, it is a mere naked license to make and sell the patented improvement as a part of his business, and is not transferable. *Hopgood v. Hewitt*, 21 *Pat. Off. Gaz.* 1786 ; 11 *Biss.* 184 ; 11 *Fed. Rep'r*, 422.

If a person employed in the manufactory of another, whilst 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 a presumption of a license to use the invention. *McClure v. Kingsland*, 1 *How.* 202.

A patentee knowingly and for a considerable time acquiesced in the use of his patented machine by another who had previously constructed and used the same by his permission, and actually and voluntarily accepted a compensation for such use from the person in possession, as just payment for such use. It was *held*, that these acts of the patentee were evidence from which a license might

be inferred, unless controlled by the circumstances. *Blanchard v. Sprague*, 1 *Cliff.* 288.

An exclusive license for the use of certain patented machinery, invented and constructed during the term of service, results to an employer where the workman agreed to give the employer the exclusive benefit of his inventive faculties, and of such inventions as he should make in a particular class of machinery during the period of employment. *Wilkins v. Spafford*, 13 *Pat. Off. Gaz.* 675. So, too, an agreement that the employer shall have the exclusive benefit of the workman's service in making machinery and improvements in the employer's premises, operates to license the use of machinery perfected and constructed, or in course of construction, during the term of service, although it had actually been invented and patented by the workman prior to such service. *Ib.*

B., being in the employ of the Empire Windmill Co., contracted with them that he was to receive from them five hundred dollars for any patentable improvements which he might make; and afterward made such improvements, and obtained a patent therefor in his own name. It was *held*, that, by virtue of the contract, the Empire Windmill Co. acquired, and had, an equitable if not legal right to use the improvements. *Continental Windmill Co. v. Empire Windmill Co.*, 8 *Blatchf.* 296; 4 *Fish. Pat. Cas.* 428. B. also attempted a clandestine transfer of the improvements to one of the officers of the Empire Windmill Co., for the private benefit of B. and such officer. It was *held*, that such transfer was fraudulent as to the company, and no less so because a court of chancery would decree that such officer held as trustee for the company's use; and further, that as the suit was brought in equity, the fact that the defendant had an equitable, not a legal right to use the improvement, was not material. An equitable title is just as good as a legal title, as to matters within the jurisdiction of a court of equity. *Ib.*

A patentee, while in defendants' employment, made certain experiments at their expense, for the results of which he subsequently obtained a patent. Before this, a contract was made between patentee and defendants for the manufacture for defendant of a certain number of articles afterwards so patented, and the transfer to defendants of the tools used in their manufacture. It was *held*, that from these facts a license to the defendants to continue the manufacture after patent must be conclusively presumed. *Chabat v. American Button-hole, &c. Co.*, 9 *Phila.* 378; 16 *Int. Rev. Rec.* 164.

One who sold a machine containing a patented invention warranted the title to it and the right to use it. He afterward acquired a part interest in the letters patent. It was *held*, that the sale, so far as he was concerned, operated as a license to the vendee to use the machine. *Gottfried v. Miller*, 104 *U. S.* 521 ; aff'g 10 *Fed. Rep'r*, 471.

Payment by a partnership of the expenses of perfecting, procuring and sustaining a patent issued to a partner, the inventor, for which the firm was fully reimbursed by the profits from its use, was *held*, not to give rise to a license to another partner to use it after dissolution of the partnership. *Keller v. Stolsenbach*, 20 *Fed. Rep'r*, 47; 27 *Pat. Off. Gaz.* 209.

A decree for nominal damages in a suit for infringement of a patent against the manufacturer of infringing machines, does not operate as a license to the manufacturer or his vendee as to all existing infringing machines made by the manufacturer. *Blake v. Greenwood Cemetery*, 25 *Pat. Off. Gaz.* 89 ; 16 *Fed. Rep'r*, 676.

92. Construction.

A licensee who is authorized to use two machines constructed according to the patent, may use two at all times, whether constructed by himself or another. *Burr v. Duryee*, 1 *Wall.* 531; 2 *Fish. Pat. Cas.* 275.

A license to use an invention by a person only at "his own establishment," does not authorize a use at an establishment owned by himself and others. *Rubber Co. v. Goodyear*, 9 *Wall.* 788; aff'g 2 *Cliff.* 351 ; 2 *Fish. Pat. Cas.* 499.

Where defendants held a license under complainant's patent, granting them "the right, license and privilege to manufacture and vend landau carriages, with the said invention attached," containing the provision that "the right, privilege and license hereby granted, are not, nor is any part of the same, to be transferred or assigned, or in any manner imparted to any other person or persons whatsoever ; but they shall be exercised solely and only by the licensees personally, or by workmen in their employment, in their own manufactory or manufactories, warehouse or warehouses ;" and the further provision, "nor shall this license authorize or empower said licensees to sell, exchange, or in any manner dispose of any part, parts, or portions of carriages with, or fitted or adapted for, the said invention, otherwise than in a finished state, and ready for market ;"

it was *held*, that these restrictions do not prohibit defendants from procuring the patented fixtures to be made wherever they can be manufactured, and still less do they prohibit them from sending fixtures, already cast, to another establishment to be finished. *Wood v. Wells*, 6 *Fish. Pat. Cas.* 382. Such a license does not, indeed, grant the right to deal in the fixtures, as general merchandise. If they are sold apart from the carriage, there is an infringement on the patent, but such sale does not work a forfeiture of the license. *Ib.*

Where a person is enjoined from infringing a patent, and instead of contesting the validity of the patent and moving for a dissolution of the injunction, renews a license formerly had to use the patent such renewal will not be regarded as made under duress, and will be binding upon him. *McKay v. Zackman*, 17 *Fed. Rep'r*, 641; 24 *Pat. Off. Gaz.* 1177; 16 *Rep'r*, 163.

Where a machine is licensed for use in a particular territory, the use of it, by subsequent purchasers, in territory other than that for which it is licensed, is unlawful. The mere fact that the agent of the patentee, after the transfer of the machine to the unlicensed territory, demands of the purchasers the back royalties due upon it, confers no right to use it outside of the territory named in the license. *Wicke v. Kleinknecht*, 7 *Pat. Off. Gaz.* 1098; 1 *Bann. & A. Pat. Cas.* 608.

A license granting the right to use a patented invention, only upon the payment of a specific sum on each machine upon which the invention is used, will not include other machines where the same invention is used, unless the same is paid for in accordance with the terms of the license. *Wooster v. Seidenburg*, 10 *Pat. Off. Gaz.* 244.

A grant of a full and exclusive right to "use and sell" a patented invention within a limited territory, contained a reservation of a right (but not an exclusive right) in favor of the grantor, to "make." It was *held*, that giving the grantees a right to make must have been intended, because, 1, if the invention could not be made except at the will of the grantor, the granted right to use and sell would be worthless; and 2, if the right to make did not otherwise pass from the grantor, the reservation of a right to him to make was nugatory. *Hamilton v. Kingsbury*, 15 *Blatchf.* 64; 14 *Pat. Off. Gaz.* 448; 3 *Bann. & A. Pat. Cas.* 346.

W., the patentee of inventions in steam stone-cutting machines, granted to a corporation "the right to use said patented machine,

or any number of said machines," in its quarry at S. C. succeeded to the rights of W., and another corporation to the rights of the corporation grantee, in the quarry. D. was making a machine embodying the patented inventions, for the new corporation, for use in said quarry, and C. sought to enjoin D. from making such machine. It was *held*, that the grant conveyed the right to make machines for said use, including the right to procure them to be made, and covered the making of them by the person procured to make them. The foundation of this construction is the presumed intention of the grantor to make his grant effectual. *Steam Stone Cutter Co. v. Shortsleeves*, 16 *Blatchf.* 381; 4 *Bann. & A. Pat. Cas.* 364.

A license to use a patented invention upon the locomotives used by a railroad company on its road, or on "any road or roads now owned or that may hereafter be owned or operated by said company," was *held* to embrace not only locomotives in use at the date of the license upon roads then owned and operated by the company, but also such other locomotives as it might thereafter use and other roads which it might thereafter operate. *Mathew v. Pennsylvania R. Co.*, 8 *Fed. Rep'r*, 45; 27 *Int. Rev. Rec.* 234; 12 *Rep'r*, 234.

Where a railroad fifty-eight miles long, having a license to use a patented improvement, subsequently acquired, by consolidation and change of name, two hundred and ten miles more, it was *held*, that the license did not extend to or protect the newly-acquired portion. *Emigh v. Chicago, Burlington, &c. R. R. Co.*, 2 *Fish. Pat. Cas.* 387.

An agreement to pay license fees for the use of machinery under patents during the continuance of their terms, and each of them, was construed to mean during the term of every one of them, till the last expired. *Potter v. Berthelet*, 20 *Fed. Rep'r*, 240.

A license giving the right of manufacturing under any patent the licensee might obtain by or through his application then filed, was *held* to cover the patent issued in accordance with the claims as modified by the requirement of the commissioner of patents. *Kelly v. Porter*, 17 *Fed. Rep'r*, 519; 8 *Sawyer*, 482.

The words "licensed to use once only," stamped upon each article, were held to have imparted notice that there was a restriction in the use. *American Cotton Tie Supply Co. v. Bullard*, 17 *Pat. Off. Gaz.* 389.

Where both parties to a license have acted upon a certain construction of an ambiguous document, that construction, if in itself

admissible, will be adopted by the court. *Foster v. Goldschmidt*, 28 *Pat. Off. Gaz.* 915 ; 22 *Blatchf.* 287 ; 21 *Fed. Rep.* 70.

A license granted the right to use a machine embodying the invention contained in a patent particularly described, and other patents which the licensor had or might obtain, applicable to said machine, for the term of the existence of said patents or any of them, and of all renewals and extensions of the same. It was *held*, that the license continued in force until the expiration of the term of the youngest patent embodied in the machine. *McKay v. Mace*, 23 *Fed. Rep'r*, 76.

93. *Validity and Obligations.*

A license to make, use and sell a patented invention, within a specified territory, by mutual mistake not made exclusive, which mistake the licensor offered to correct, was *held* to be a valid contract, binding upon the licensee so as to make him liable for royalties under it, and not to be set aside as for a failure of consideration ; no loss to the licensee having been shown from the defect. *Laver v. Dennett*, 109 *U. S.* 90.

Enlarging one's factory and business carried on under a license to use a number of patented machines does not increase his liability for royalty if the number of the machines used is not increased. *England v. Thompson*, 3 *Cliff.* 271.

A corporate body gave the plaintiffs an exclusive license to sell machines, embodying inventions of which it held the patents, and agreed to furnish the machines at a stipulated price. It was *held* that the company might be prohibited from taking measures to dissolve its organization ; and that its assignee of the patents in trust for a new association, should be forbidden to dispose of them. *Singer Manuf. Co. v. Union Buttonhole, &c. Co.*, 4 *Pat. Off. Gaz.* 553.

No one can justify making and selling a patented article under a license from the patentee, after he has repudiated the license, and refused to pay the stipulated royalty ; and one who purchases from such licensee, with knowledge of his having renounced the contract, will also be liable for the sale of the articles he purchases, as well as for sale of those he makes afterward. *Moody v. Tabor*, 5 *Pat. Off. Gaz.* 273.

A license to use a patent was granted in consideration of notes given by the licensee ; with an agreement that if the notes were

not paid, the license should be void. It was *held*, optional with the grantor to enforce the collection of the notes, or treat the rights of the licensee as forfeited under the stipulation. *Woodworth v. Weel*, 1 *Blatchf.* 165.

Unless there has been an eviction or its equivalent, the royalties agreed to be paid by a licensee for the use of a patent, must be paid ; even though he has signed the license without reading it, he is bound by its terms, unless he lacked capacity to comprehend what he was doing. *Ib.* ; *McKay v. Yackman*, 17 *Fed. Rep'r*, 641 ; 24 *Pat. Off. Gaz.* 1177 ; 16 *Rep'r*, 163.

An exclusive license to use a patented invention, in a specified city, during the term of the patent, has been *held* liable, in equity, to be subject to sale for the payment of a judgment debt. *Matthews v. Green*, 19 *Fed. Rep'r*, 649.

Under a contract giving a license to use a patent on certain conditions, it has been *held*, that the licensee might be enjoined from using the patent beyond the limits fixed by the contract, and from using it at all except on performance of the conditions ; and that a breach on the part of the licensor was not an excuse for non-payment of the tariff. *Brooks v. Stolley*, 3 *McLean*, 523 ; 2 *West. L. J.* 390.

Inasmuch as joint patentees are tenants in common of the right, a license signed by only one of them clothes the licensee with the right to use it ; and the licensee cannot refuse a tender of such a license, and defend an action for the royalty on the ground that another or others have not signed it. *Dunham v. Indianapolis & St. Louis R. R. Co.*, 7 *Biss.* 223 ; 2 *Bann. & A. Pat. Cas.* 327.

94. *Estoppel, arising from a License.*

If a licensor seeks to set aside a license on account of a breach of contract, the defendant is not estopped from denying the validity of a patent by the recitals in the contract. *Burr v. Duryee*, 1 *Wall.* 531 ; 2 *Fish. Pat. Cas.* 275 ;

When parties have, after long negotiation, with full opportunities for knowing what they are doing, entered into contracts for the use of inventions covered by rival patents, and no fraud or imposition is alleged, the case of a party sued upon such a contract must be very clear to establish as a defense the invalidity of the patent for which he has agreed to pay a royalty. *Eureka Co. v. Bailey Co.*, 11 *Wall.* 488. And when such a party has furnished,

under the contract, a model of the machine which he proposes to make, on which he agrees to pay a royalty, he cannot deny that such machine contains matter covered by the patent, unless he alleges and proves circumstances which would set aside the contract for fraud, mistake, or surprise. *Ib.*

The owners of a patent are estopped from prosecuting those who have worked the invention under a license from a third party, relying upon the admission of the owners that such third party had the right to grant such license. Whether such admission can avail the respondents, will depend on whether the acts relied on to prove infringements were after, and in consequence of these admissions, and before they had notice that they were recalled and withdrawn. *Gear v. Grosvenor*, 1 *Holmes*, 215 ; 3 *Pat. Off. Gaz.* 380 ; 6 *Fish. Pat. Cas.* 314.

Selling goods manufactured under a license is a recognition or admission of title in the licensor ; and the licensee cannot dispute the validity of the patent, by way of defense to an action of covenant for the recovery of royalties. *Wilder v. Adams*, 2 *Woodb. & M.* 329 ; *Sargent v. Larned*, 2 *Curt.* 340. Not so, however, of selling goods which defendant had on hand when the patent was obtained. *White v. Harris*, 3 *Fed. Rep.* 161 ; 5 *Bann. & A. Pat. Cas.* 571.

Licenses are entitled, if they fulfill the stipulations of their licenses, to practice the invention within the terms and conditions of the instrument, to the extent of the authority conferred, without question or impediment by the owner of the patent ; but if they refuse to perform on their part, deny the validity of the patent, and repudiate the license and title of the licensor, he may have his remedy by suit upon the license, or he may elect to treat them thenceforth as infringers of his exclusive rights under the patent. Being infringers, they cannot set up the license in defense of a suit any more than if they had never possessed any such authority. *Cohn v. National Rubber Co.*, 15 *Pat. Off. Gaz.* 829 ; 5 *Bann. & A. Pat. Cas.* 568.

For a licensee to take a license to use an unlimited number of machines for a limited period, is a waiver of any prior right which he may have had, even though the license was taken under a mistake of law. *Wooster v. Taylor*, 12 *Blatchf.* 384 ; 8 *Pat. Off. Gaz.* 644 ; 1 *Bann. & A. Pat. Cas.* 594.

If a license contains a covenant on the part of the licensee which implies the validity of the patent, and if he has had the enjoyment of the license, he is estopped from impeaching the

patent. *Magic Ruffle Co. v. Elm City Co.*, 13 *Blatchf.* 151; 8 *Pat. Off. Gaz.* 773; *Birdsall v. Perego*, 5 *Blatchf.* 251.

L. sued J. in equity for infringing a patent. J. set up, by plea, that in June, 1875, L. sued T. for infringing the same patent; that T. was a licensee under a patent granted to W. before the patent to L. was granted, which embodied the improvement described in the patent to L.; that W. assumed the defense of that suit; that it was therein adjudged that W. was the first inventor, and that the patent to L. was void of want of novelty; and that J. was a licensee of W., under a license granted in October, 1874, and was making the article described in the patent to W. The fact that the license was granted before the judgment was rendered was *held*, to be alone sufficient to prevent the judgment from operating as an estoppel against the plaintiff. *Ingersoll v. Jewett*, 16 *Blatchf.* 378; 9 *Rep'r.* 105; 4 *Bann. & A. Pat. Cas.* 361.

An assignor of a patent, who agrees to stop manufacturing the patented machines, and pays a license fee to his assignee for the privilege of selling machines he has on hand, is estopped from denying its validity, in a suit against him by the assignee for its infringement by manufacture and sale under letters patent issued subsequent to the assignment. *Consolidated Middlings Purifier Co. v. Guilder*, 9 *Fed. Rep'r.* 155; 3 *McCrary*, 186. And execution and acceptance of a written license, was *held*, under the circumstances, to estop the licensor from recurring to the prior parol agreement, and the licensee from impeaching the validity of the patent, in *Evory v. Candee*, 17 *Blatchf.* 200; 4 *Bann. & A. Pat. Cas.* 545. But defendants are not estopped from denying infringement, by reason of having formerly acted under a license from complainant, which has expired. *Blatherwick v. Carey*, 9 *Fed. Rep'r.* 202; 10 *Biss.* 484; 27 *Int. Rev. Rec.* 361. And an offer to take a license from a patentee to use his invention does not take away the right of the person making such offer to deny that the patentee was the original inventor. *Evans v. Eaton*, *Pet. Ct. Ct.* 322, 347.

The government, after using a patented invention under circumstances which warrant implication that it does so under a license and an obligation to pay a royalty, cannot defend an action in the court of claims for compensation on the ground that the invention is valueless. *Palmer v. United States*, 20 *Ct. of Cl.* 432.

95. *Rights Created by License.*

A licensee, unless he is estopped by his contract, is at liberty to manufacture and sell as many articles as he pleases, either by the old method or by any new machine which may be invented. *Burr v. Duryee*, 1 *Wall.* 531.

Where the owners of a patent granted a license to use it, to a firm consisting of two persons, which firm was afterward dissolved, one of the partners buying out the entire interest of the other, an injunction to restrain the use of the invention by such purchasing partner was refused; on the ground that the dissolution of the firm and the withdrawal of one partner did not, of themselves, operate to extinguish the license. *Belding v. Turner*, 8 *Blatchf.* 321 ; 4 *Fish. Pat. Cas.* 446.

Every person who pays the patentee for a license to use his process, becomes the owner of the product, and may sell it to whom he pleases, or apply it to any purpose, unless he binds himself by covenants to restrict his right of making and vending certain articles that may interfere with the special business of some other licensee. *Metropolitan Washing Machine Co. v. Earle*, 2 *Fish. Pat. Cas.* 203 ; 3 *Wall. Jr.* 320.

A mere license cannot be apportioned so as to permit the licensee to grant to others separate rights to use or work the patent, by subdividing the rights that may have been granted to him. *Consolidated Fruit Jar Co. v. Whitney*, 1 *Bann. & A. Pat. Cas.* 356.

Where a licensee of a patented machine took it apart and used some of its parts to construct a new one, it was held, that his license did not give him permission to use it. *Gottfried v. Phillip Best Brewing Co.*, 5 *Bann. & A. Pat. Cas.* 4.

A grant by a patentee, of "the sole and exclusive right to manufacture and sell machines of the patented invention" in a specified city, gives, by implication, to a purchaser from such manufacturer, the right to use the machine until it was worn out, wherever he pleases. *May v. Chaffee*, 2 *Dill.* 385; 5 *Fish. Pat. Cas.* 160.

The owners of a patent granted to F. and G., the sole and exclusive right to manufacture and sell the patented machines in Chicago, Ill. F. and G. sold the patented machine to the defendants, who took it to Faribault, Minn., where they resided, and used it there. Complainants acquired, by proper conveyances, the exclu-

sive right to use, and sell to others to use, the patented machine, within Fairbault. It was *held* that the defendant had a right to use the machine without liability to the complainant. *May v. Chaffee, supra.*

When a member of a firm makes an invention, but manufactures the machines at the firm's expense, and permits the firm to use them, all the partners have an equal proportionate right in them and their use. *Wade v. Metcalf, 16 Fed. Rep'r, 130.*

96. *Assignments of Licenses. Sub-license.*

The general doctrine as to licenses is, that express words of assignability are needful to render them transferable; a grant of a license to a person or persons, only, does not pass to an assignee. *Troy Iron & Nail Co. v. Corning, 14 How. 193; Oliver v. Rumford Chemical Works, 10^o U. S. 75; 3 Sup. Ct. Rep'r, 61; Baldwin v. Sibley, 1 Cliff. 150; Goodyear v. Providence Rubber Co., 2 Cliff. 351; 2 Fish. Pat. Cas. 351; Lightner v. Boston & Albany R. R. Co., 1 Low. 338; Curran v. Craig, 22 Fed. Rep'r, 101; Eclipse Windmill Co. v. Woodmansee Windmill Co., 21 Fed. Rep'r, 650; 32 Pat. Off. Gaz. 1605.* Thus a license to manufacture at a specified place, or to use a patented process at the licensee's place of business, and associate others with him in it, is not transferable. *Searls v. Bouton, 20 Blatchf. 426, 12 Fed. Rep'r, 140; 21 Pat. Off. Gaz. 1784; Gibbs v. Hoefner, 19 Fed. Rep'r, 323.* An agreement between a patentee and an individual by which the former licenses and grants to the latter, without adding "executors, administrators or assigns," or anything equivalent, the exclusive right to manufacture, sell, &c., during a specified term of years, and that he will engage in the manufacture and sale, will use all his business tact and skill, &c., is a mere license to the grantee personally; is not assignable; and on his death, even before the specified term has expired, no right to manufacture or to sue infringers under it passes to the representatives of the licensee. *Oliver v. Rumford Chemical Works, 10^o U. S. 75.* Generally, however, whether a license is or is not assignable is to be determined not merely by the term "license," but by an inquiry into the intention of the parties; not only by the words of the license, but by the nature of the transaction, the consideration paid, and other circumstances showing that an assignable right was conferred. *Dorsey R. II. Rake Co. v. Bradley Manuf. Co., 12 Blatchf. 202; 1 Bann. & A. 330.*

A license that runs to the administrators and executors of the licensees, as well as to their assigns, is apportionable and may be transferred in severalty. *Adams v. Howard*, 22 *Fed. Rep'r*, 656.

A license to make and use a patented invention, which reserves no royalty to the owner of the patent, and grants the right to the persons named as parties of the second part, and to their executors, administrators and assigns, is assignable, and the whole right of one of the licensees may be transferred by him in severalty. *Adams v. Howard*, 22 *Fed. Rep'r*, 654.

Permission to use a patent may be transmissible by succession to a corporation formed of a union of two licensees, and succeeding to the rights and obligations of both. *Lightner v. Boston & Albany R. R.*, 1 *Lowell*, 338.

A patentee executed an instrument agreeing to "grant, bargain, sell, assign and transfer to B., his executors, administrators and assigns, the right and privilege of making, using and selling friction matches," as patented, to have and to hold "the right and privilege of manufacturing the said matches, and to employ in and about the same six persons and no more, and to vend said matches in any part of the United States;" and the instrument further provided that nothing therein contained should prevent or restrict the patentee from "making and vending the same, or of selling and conveying similar rights and privileges to others;" and that B. should not manufacture in certain places. It was held, that the right granted by the deed was a license or authority, 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. *Brooks v. Byam*, 2 *Story*, 525.

In general a patentee who licenses a person to use the patent reserving a royalty, has no lien upon the license as against an assignee to secure payment of the royalty accruing before the assignment was made. But where D. had an exclusive license to use the patent of G. for a particular purpose, covenanting not to use it for other purposes, and to pay a specified tariff for such use, and C. took an assignment of such license, it was *held*, that C. took the license subject to the obligation to pay the specified tariff on what he should make under it. *Goodyear v. Congress Rubber Co.*, 3 *Blatchf.* 449.

A patentee authorized a license to use and manufacture his invention "for his own proper business," to a specified amount per annum. It was held, in the absence of affirmative authority, that a sub-license was not authorized by such agreement. *Putnam v. Hollender*, 6 *Fed. Rep'r*, 882 ; 19 *Blatchf.* 48 ; 19 *Pat. Off. Gaz* 1423.

97. *Right of Patentee to sue Licensee, for Royalties.*

A suit to collect moneys due as royalties under a license to use a patent does not arise under the laws of the United States, and is not cognizable in a circuit court unless by reason of citizenship. *Albright v. Texas*, 106 *U. S.* 613 ; 1 *Sup. Ct. Rep'r*, 550, *Kelly v. Porter*, 8 *Sawyer*. 482, 17 *Fed. Rep'r*, 519.

An employé who is the owner of a patent cannot introduce his patented device into his employer's business and demand royalties for its use without the employer's consent. *Barry v. Crane Manuf. Co.*, 22 *Fed. Rep.* 396.

The patentee may elect whether to sue at law for recovery of the promised royalties, or to file a bill in equity for cancellation of the license. *Hartell v. Tilghman*, 99 *U. S.* 547. If the suit be in equity, founded upon the non-performance of the conditions of a license, the original patentee is properly joined as party plaintiff with the assignee, notwithstanding the whole beneficial interest is in the assignee, inasmuch as he was a party to the agreement or license, and may be interested in the patent and interested in upholding it. *Woodworth v. Cook*, 2 *Blatchf.* 151. And equity will enjoin a licensee from operating under a patent unless he pays the license-fee, whether the license is forfeited at law or not. *Day v. Hartshorn*, 3 *Fish.* 32.

To an action of covenant upon an agreement which granted a license to make and vend a patented article, the licensee agreeing to keep an account of the articles manufactured, and to pay a fixed price per pound on those sold, it is no defense that the patent is invalid. *Wilder v. Adams*, 2 *Woodb. & M.* 329.

The true doctrine is that a licensee may defend a suit for license fees by evidence that the validity of the patent has been successfully impeached, so that the license has not given him the right and protection intended, though evidence merely that it is valid, is not a defense, for it may have protected him, notwithstanding. [6 *El. & B.* 930 ; 1 *Gray*, 114 ; 66 *N. Y.* 206 ; 82 *N. Y.* 526.] Yet

some cases have held that a license cannot impeach the patentee's title [2 Ad. & E. 278 ; 6 C. B. N. S. 771 ; 2 Woodb. & M. 329 ; 10 H. L. Cas. 293 ; L. R. 2 App. Cas. 423] ; and some have held that invalidity of the patent may always be proved [124 Mass. 553], *White v. Lee*, 23 *Pat. Off. Gaz.* 1621.

But a licensee is at liberty to contest the question whether the articles made by him embody the invention or any material part thereof ; and a stipulation to the contrary in the contract is of no effect. *Ib.*

A bill in equity for an accounting of royalties under a license to use a patent cannot be maintained by executors of the licensor and trustees of the patent against the licensees, the remedy at law being plain, adequate and complete. That the licensees claim to have made a settlement with the heirs and devisees of the licensor, which they can only set up as a defense in a court of equity, does not give complainants claiming such royalties the right to invoke the aid of equity. *Crandall v. Piano Manuf. Co.*, 24 *Fed. Rep'r*, 738 ; *Crandell v. Piano Manuf. Co.*, 32 *Pat. Off. Gaz.* 1123.

In an action for the recovery of a sum agreed to be paid to the patentee of a machine, as a license fee for the exclusive right to make and sell the machines, in a given territory, it is no defense, that the plaintiff has himself infringed such exclusive right, or that the plaintiff was not the first and original inventor of what his patent claims. *Birdsall v. Perego*, 5 *Blatchf.* 251 ; *Morse Arms Manuf. Co. v. United States*, 16 *Ct. of Cl.* 296.

When the sale of licenses by the patentee has been sufficient to establish a price for such licenses, that price may be the measure of his damages against an infringer ; but a royalty, to be binding on a stranger to the licenses which established it, must be uniform. *Westcott v. Rude*, 27 *Pat. Off. Gaz.* 719 ; 19 *Fed. Rep.* 830. The recovery of the license or patent-fee from an infringer, and its payment, authorizes him to use the particular articles for which recovery has been had. *Perrigo v. Spaulding*, 12 *Pat. Off. Gaz.* 352 ; 13 *Blat' hf.* 389.

In determining what was the established price of a license under a patent at the time of an infringement, as a proper compensation in damages for such infringement, agreements which appear to have been made chiefly to secure the introduction of the patented machine into public use, are not to be considered as unqualified licenses. A license providing for the payment of a certain royalty, subject to a reduction if paid promptly, may be considered as pro-

viding for a royalty at the lower rate. In a doubtful case, even an abandoned and revoked license may be considered. *Graham v. Geneva Lake Crawford Manuf. Co.*, 24 *Fed. Rep'r*, 642 ; 32 *Pat. Off. Gaz.* 1603. But see *Bussey v. Excelsior Manuf. Co.*, 5 *Bunn. & A. Pat. Cas.* 135 ; 17 *Pat. Off. Gaz.* 744 ; 1 *McCrary*, 161 ; 1 *Fed. Rep'r*, 640.

Although where there appears to be a subsisting license between the complainant and the respondent, the jurisdiction of the circuit court, under the patent law, will not be extended to cover a suit to enforce the terms of the license or to forfeit the license, on the ground that the terms thereof have been violated, yet where a suit is brought for infringement, and the existence of a license is alleged by the respondent and denied by the complainant, it is competent for the court to determine whether, at the time of the filing of the bill, there was a subsisting license between the parties. *Hammacher v. Wilson*, 26 *Fed. Rep'r*. 239.

A license to manufacture under a patent contained a condition that if the proprietors of the patent should grant a license at a less royalty to any other party, the royalty to be exacted from the licensee should be reduced to correspond ; and also contained a provision that the proprietors of the patent might terminate the license upon written notice to the licensee on any non-payment of license fees. The licensee filed a bill in equity alleging that the proprietors of the patent had granted a license to another party at a lower royalty, and had concealed the fact from him for more than a year, so that he had largely overpaid the license fees properly due at the reduced rate ; and praying that they might be ordered to reduce his license fee, and to repay the sums overpaid, and that the licensors might not claim any other or further sums than at such less license fee, and might be enjoined from giving notice, during the pendency of the suit, to terminate the license, and from attempting to collect the license fees. It was *held*, that this showed no ground for relief in equity. The licensee had a remedy in his own hands, and could protect himself without the aid of any court. None of the peculiar grounds of equitable jurisdiction existed. *Florence Sewing Machine Co. v. Singer Manuf. Co.*, 8 *Blatchf.* 113 ; 4 *Fish. Pat. Cas.* 329.

In an action growing out of the alleged failure of the defendant to act up to the terms of a license granted him by the complainant, to sell a patented article, if the complainant refuses to fulfill his obligation in matters of substance, under the license, a

court of equity will not interfere to assist him in compelling the defendant to observe the obligations upon his part. Where, however, one of the conditions of such license was that the complainant (the licensor) should use reasonable diligence in prosecuting unlicensed persons who should sell imitations of the article licensed, it was *held*, that if the action of complainant was such that it resulted, practically, in stopping infringements, he fulfilled the spirit and meaning of the obligation to the defendant to use reasonable diligence in prosecuting. *Foster v. Goldschmidt*, 21 *Fed. Rep'r*, 70.

A person agreed with a patentee to pay him a certain sum on every patented article manufactured by him. The patentee brought his action for money had and received. It was *held*, that the jury might infer the receipt of money from the fact of sale of the article, and that judgment should be rendered for the plaintiff as upon an executed contract. *Stanley v. Whipple*, 2 *McLean*, 35.

The licensee from a patentee under a license which stipulated that he should pay no greater royalty than any licensee under the patent, obtained an injunction on the ground that less was exacted from other licensees than from him, against a suit for royalties, and also against the patentee's declaring the license forfeited for non-payment. It was *held*, that the suit should not be restrained, as an ample defense at law existed, but that the injunction should be continued with respect to the license, since the announcement of its revocation would injure the licensee's business. *Baker Manuf. Co. v. Washburn, &c. Manuf. Co.*, 18 *Fed. Rep'r*, 172.

A reservation by a licensor that he would hold responsible for the royalty the party for whom a licensee has contracted to do certain work under a license, is inconsistent with the license and therefore void. *Bigelow v. City of Louisville*, 3 *Fish. Pat. Cas.* 602.

The government cannot, after a patent is issued, make use of the improvement without obtaining a license from the inventor, or making him compensation. *Cammeyer v. Newton*, 94 *U. S.* 225; *Colgate v. International Ocean Tel. Com.*, 17 *Pat. Off. Gaz.* 194; 17 *Blatchf.* 308.

In an action to recover a royalty from government, founded on an implied contract to pay one, where the defense was that the department using claimant's invention had previous, to his patent manufactured the same articles, the claimant showed that he had made applications for a patent a considerable time before it was

granted. It was held that he might go into such history of his efforts and achievements in the art as would tend to show that he was the first inventor. *Hubbell v. United States*, 20 *Ct. of Cl.* 354.

As to measure of damages for use of a patented device, by a licensee thereof, continued after the expiration of his license, where the device is only a part of the mechanism used, see *Porter Needle Co. v. National Needle Co.*, 22 *Fed. Rep'r*, 829.

98. *Right of a Patentee or Licensee to sue Infringers.*

A mere license, although exclusive, to manufacture and sell a patented article does not authorize the licensee to maintain actions for damages against infringers who are not infringing the patent in those respects. *Hayward v. Andrews*, 103 *U. S.* 672.

A mere license to make and use, without the right to grant to others to make and use, the thing patented, though exclusive, will not authorize the licensee to bring suit in his own name for infringement without joining the patentee. *Wilson v. Chickering*, 23 *Pat. Off. Gaz.* 1730.

A mere licensee cannot bring suit for infringement, either at law or in equity, in his own name; but must join with him the owner of the legal title. *Nelson v. McMann*, 16 *Blatchf.* 139; 4 *Bann. & A. Pat. Cas.* 203; 16 *Pat. Off. Gaz.* 761; *Hammond v. Hunt*, 4 *Bann. & A. Pat. Cas.* 111; *Gamewell Fire Alarm Co. v. Brooklyn*, 14 *Fed. Rep'r*, 255; 22 *Pat. Off. Gaz.* 1978; 15 *Rep'r*, 40. But compare *Goodyear v. McBurney*, 3 *Blatchf.* 32.

A licensee may enjoin a party who has actually infringed his right under the license. *Brammer v. Jones*, 3 *Fish. Pat. Cas.* 340; 2 *Bond*, 100.

Where a contract provided that the net proceeds from all suits for infringement of a patent should be equally divided between licensor and licensee, and forbade the instituting of a suit without the consent of both parties, it was *held*, that the licensee was authorized to compromise with the infringing party. *Burdell v. Denig*, 2 *Fish. Pat. Cas.* 588.

In one case the laches of a patentee in regard to infringements of his patent was *held* sufficient, under the circumstances, to defeat the enforcement, in equity, by his assignee, of pecuniary claims for such infringements before the assignment of such claims and the patent to the complainant. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 24 *Fed. Rep'r*, 604; 32 *Pat. Off. Gaz.* 1356.

99. *Revocation or Forfeiture.*

Upon the breach of the conditions of a license, the patentee or licensor has a right to avoid the contract and be remitted to his original rights, and may prosecute the licensees for an infringement of the patent. *Woodworth v. Cook*, 2 *Blatchf.* 151; *Wilson v. Sherman*, 1 *Blatchf.* 536; *Brooks v. Stolley*, 3 *McLean*, 523. But non-performance of conditions does not, of itself, work a rescission of a license; the forfeiture must be enforced. *Stanley Rule & Level Co. v. Bailey*, 14 *Blatchf.* 510; 3 *Bann. & A. Pat. Cas.* 297; *Adams v. Meyrose*, 7 *Fed. Rep'r*, 208; 2 *McCrury*, 360. See *Wilson v. Sherman*, 1 *Blatchf.* 536; *Woodworth v. Weed*, *Id.* 165; *Armstrong v. Hanlenbeck*, 3 *N. Y. Leg. Obs.* 43. If the license provides in terms for a written notice as the agreed mode of terminating it, such notice must be given. *White v. Lee*, 3 *Fed. Rep'r*, 222; 5 *Bann. & A. Pat. Cas.* 575.

A stipulation for terminating a license by written notice is valid, and may be enforced by a suit for infringement begun after failure to pay royalties and service of such notice, notwithstanding subsequent offers to pay the sums due. *Hammacher v. Wilson*, 26 *Fed. Rep'r*, 239. And in general, provisions in a license prescribing a forfeiture, may be enforced according to their terms; if mere neglect to use the invention is to operate as an abandonment of the license, no formal notice from the licensor that he considers such neglect an abandonment, is necessary. *Wilson v. Stolley*, 5 *McLean*, 1.

In general, an infringement of a patent does not forfeit a license under it, unless, in his infringement, the licensee has assumed such a hostile attitude toward the patent as amounts to a repudiation of the license. *Wood v. Wells*, 6 *Fish. Pat. Cas.* 382. If a licensee neglects to pay his license-price for a long time, and finally, when prosecuted, abandons his license, or defends upon inconsistent grounds, he will be liable as an infringer. *Bell v. McCullough*, 1 *Bond*, 194; 1 *Fish. Pat. Cas.* 380. On the other hand, revocation of a license releases the licensee from any provision in the license forbidding him to dispute the validity of the patent; and if he is afterward sued for infringing, he may contest it as any other infringer might. *Wooster v. Singer Manuf. Co.*, 23 *Pat. Off. Gaz.* 2513; 15 *Rep'r*, 524. The bringing of an action, or the recovery of judgment for recovery of arrears due under a license does not re-affirm the license

after default and notice of termination. *Armstrong v. Hanlenbeck*, 3 *N. Y. Leg. Obs.* 43. If some of several licensees have surrendered the license, the others are not thereby released; and the latter may be sued without joining the former. *Theberath v. Celluloid Manuf. Co.*, 3 *Fed. Rep'r*, 143; 10 *Rep'r*, 328; 5 *Bann. & A. Pat. Cas.* 577.

An agreement for an exclusive license stipulated that the payments of royalty should "be made quarterly; that is to say, on the first day of January, April," &c., and that the license should be null and void if the licensee should fail well and truly to make the payments above referred to, or to execute or fulfill any of the other conditions contained in the agreement. It was held, that the failure to render a statement or make a payment on the first day of April, did not, *ipso facto*, work a forfeiture of rights under the agreement; that in the absence of stipulation as to place of payment the licensor should apply to the licensee for an account and a payment, and that he could not in the meantime, without the assent of the latter, re-license the patent to third parties, and that a subsequent license issued without the consent of the original licensee, and after a complete tender of the royalties then due, was void where the parties had notice of the prior agreement. *Dare v. Boylston*, 6 *Fed. Rep'r*, 493; 18 *Blatchf.* 548; 19 *Pat. Off. Gaz.* 725.

A. entered into an agreement with defendant, by the terms of which the defendant was to manufacture a certain plow, under two patents which belonged to A., and to pay him royalty and a commission on sales made by him. Subsequently, A. assigned to J. B. & Co., all royalty due or to become due, and his interest in the patents, as security for a debt, which right and interest were by them assigned to the plaintiffs, who filed a bill praying that the defendant's license be decreed forfeited, and that he be required to account to them for royalties. It was *held*, that as the assignment made by A. did not extend to commissions upon sales, a decree annulling defendant's license would not be granted, as it would not only affect the commissions but work a rescission of the entire agreement; and *further*, that as the assignment was but partial, the defendant could only be required to account for royalties becoming due after he had assented to it. *Cook v. Bidwell*, 8 *Fed. Rep'r*, 452; 2 *Pat. Off. Gaz.* 1083; 12 *Rep'r*, 554.

A license to use a patent, given pending the application therefor, unlimited as to time, providing only that it should be void on failure to procure the patent, and covenanting to protect the licensee in

its use during the application, and after the patent shall have been obtained, was held irrevocable. *Kelly v. Porter*, 17 *Fed. Rep'r*, 519 ; 8 *Sawyer*, 482.

100. *Federal and State Jurisdiction over Contracts involving Patents.*

Contracts in relation to a patented machine or implement are regulated by the laws of the several States, and are subject to State jurisdiction. *Wilson v. Sanford*, 10 *How.* 99 ; *Bloomer v. McQuewan*, 14 *How.* 539 ; *Chaffee v. Boston Belting Co.*, 22 *How.* 217.

By a valid sale and purchase of a patented machine it becomes the private, individual property of the purchaser, and is no longer subject to the laws of the United States, but to the laws of the State. *Chaffee v. Boston Belting Co.*, 22 *How.* 217 ; *Bloomer v. McQuewan*, 14 *How.* 539.

Where the controversy turns, not upon the letters-patent themselves, but only upon contracts concerning them, the circuit court has no jurisdiction except as the citizenship of the parties may give it. The subject-matter of such contracts, where neither the validity of the patent nor an infringement of it are concerned in the controversy, does not give the courts of the United States jurisdiction ; to have that effect the rights of the patentee under the patent laws must be directly and not collaterally brought in issue. *Burr v. Gregory*, 2 *Paine*, 426 ; *Landolph v. Robinson*, 2 *N. J. L. J.* 171 ; *Teas v. Albright*, 13 *Fed. Rep'r*, 406 ; 28 *Int. Rev. Rec.* 290 ; 22 *Pat. Off. Gaz.* 2069 ; 14 *Rep'r*, 712. Thus the federal courts have no power under the patent laws to determine upon the fulfillment or non-fulfillment of a contract of license. *Tilghman v. Hartell*, 11 *Phila.* 500 ; 2 *Bann. & A. Pat. Cas.* 260. So, in a suit where all the parties to the suit were citizens of New York, it was held, that the circuit court had no power to decree that the defendant execute to the plaintiff a transfer of letters-patent. *Perry v. Littlefield*, 17 *Blatchf.* 242 ; 17 *Pat. Off. Gaz.* 51 ; 4 *Bann. & A. Pat. Cas.* 624.

Property in inventions exists by virtue of the laws of Congress, and a State law restricting the sale of patent rights or in any way interfering with its enjoyment in the State, is unconstitutional and void. *Exp. Robinson*, 2 *Biss.* 309 ; 4 *Fish. Pat. Cas.* 188. A statute of a State imposing a restriction or condition upon the sale or transfer of patent rights,—such as an act requiring any person

who may take any obligation in writing for which a patent right shall form the whole or any part of the consideration, to insert in the body of such written obligation the words "given for a patent right,"—is contrary to the Federal constitution; the States can impose no restrictions in respect of a right in letters patent. *Castle v. Hutchinson*, 25 *Fed. Rep'r*, 394; *Ex parte Robinson*, 4 *Fish. Pat. Cas.* 186; 2 *Biss.* 309. After a patentee has fully complied with the laws of Congress on the subject, he is at liberty to sell his right in open market any where within the United States. *Webber v. Virginia*, 103 *U. S.* 344; *Ex p.* *Robinson*, 4 *Fish. Pat. Cas.* 186; 2 *Biss.* 309. A State or municipality may, however, require dealers in manufactured articles, notwithstanding they are patented, to take out a license and pay a license fee by way of tax on their sales. *Webber v. Virginia*, 103 *U. S.* 344. For when a patented machine passes into the hands of a purchaser, it becomes subject to State taxation like other individual property. *Bloomer v. McQuewan*, *supra*; *Chaffee v. Boston Belting Co.*, *supra*.

101. *Construction and effect of such Contracts.*

Contracts concerning the use and enjoyment of patented inventions are to be construed in the same way as contracts respecting other species of property,—that is, so as to carry into effect the intention of the parties as collected from the language employed, the subject-matter, and the surrounding circumstances. *Star Salt Castor Co. v. Crossman*, 4 *Cliff.* 568; 3 *Bann. & A. Pat. Cas.* 281. In other words, while the exclusive rights of a patentee are specially guarded from intrusion, the contracts which he makes to share them with third persons are interpreted and enforced in the same manner as other legal engagements. *Morse v. O'Reilly*, 6 *Pa. L. J.* 501; 4 *L. J. Rep.* 75; 5 *Whart. Dig.* 414.

Where a contract provides for a certain mode of ascertaining what amount of fuel has been saved by the use of certain machinery, after evidence has been given pursuant to that mode, the party may confirm it by other tests. *Washington, &c. Packet Co. v. Sickles*, 10 *How.* 419, 438.

Where a contract stipulates that an arbitration is to be a condition precedent to the right to sue upon the contract, or even if that may be inferred upon construction, no suit can be maintained until the plaintiff has made all reasonable efforts to procure arbitration. *Perkins v. United States Electric Light Co.*, 24 *Pat. Off. Gaz.* 204;

21 *Blatchf.* 308; 10 *Fed. Rep.* 513. But a company which has agreed to pay a certain sum to be determined by arbitration, and then prevents arbitration, may be sued at law. *Humaston v. Telegraph Co.*, 20 *Wall.* 20.

The word "invention," as used in a contract to assign a patent, does not embrace inventions, or reissues or extensions thereof, other than those described in the patent to be assigned. *United Nickel Co. v. American Nickel Plating Works*, 4 *Bann. & A. Pat. Cas.* 74.

An agreement between joint owners of a patent to account to each other for profits derived from the use of the invention does not constitute them partners; they are merely tenants in common. *Fraser v. Gates*, 20 *Rep'r.* 427.

An exclusive right to sell a patented article, given under seal, is a contract, and is not a revocable power of attorney. *Goddard v. Wilde*, 17 *Fed. Rep'r.* 845; 16 *Rep'r.* 617.

102. *In particular Cases.*

A patentee applied for a patent on a new combination of parts, which parts had before been patented by him; and, at the time of such application, granted to the defendants by one instrument the exclusive right to make, use, and vend, under the patent for the parts, as such; also, by another contract, the right to make, use and sell the parts in the particular combination described in the application. A patent for the combination having not been granted, the assignees of the extended term of the patent for the parts sued defendants, for using the parts in the combination. It was *held* that defendants' contract with the inventor at the time of his application for a patent on the combination secured them the right to make, use, and sell the combination, without reference to their license under the patent for the parts; that, as they were using only the specific combination, they were not liable to complainants, in the suit brought. *Hammond v. Mason, &c. Organ Co.*, 92 *U. S.* 724; *aff'g* 1 *Holmes*, 296; 6 *Fish. Pat. Cas.* 599.

In an agreement for the manufacture and sale of patent medicines, a stipulation that under certain circumstances one party shall cease their manufacture of such machines is not void, as being in restraint of trade; and if it were, this would be no defense to the patentee's claim for an accounting under the contract. *Kinsman v. Parkhurst*, 18 *How.* 289; *aff'g* 1 *Blatchf.* 488; *N. Y. Leg. Obs.*

146. An agreement made with a patentee to manufacture his machines under his patent upon certain conditions, and making and selling such machines under the patentee's title, estops the manufacturer from alleging the invalidity of the patent as a defense to an action by the patentee for an account under the contract. *Ib.*

An agreement between a patentee and a third person as trustee, that the latter should hold the patent, and have the control thereof for the benefit of those who had a right to use the same, under contracts with the patentee, transfers the entire interest and ownership, legal and equitable, of the patentee in the patent, to such trustee, for the benefit of those interested. *Hartshorn v. Day*, 19 *How.* 211. An agreement between a patentee who was about to apply for a renewal of his patent, with another, that in case of renewal he would convey to him such renewed patent in consideration of a certain sum, was held to convey to the assignee an equitable title to the entire interest of the assignor, convertible into a legal title by paying or offering to pay the agreed consideration. *Ib.*

An agreement, made in consideration of a promise to assign the invention, as soon as the patent shall issue, that the patentee shall give his promissory notes, is not impaired by the fact that no patent will issue until after the day when the last note would have been payable. *Read v. Bowman*, 2 *Wall.* 591.

An agreement or compromise between patentees has been held not to operate as a license to either to do more than use his existing method of manufacture. *Troy Iron, &c. Factory v. Corning*, 14 *How.* 193; *rev'g* 1 *Blatchf.* 467.

Minors were interested in a manufacturing establishment, as beneficiaries under a deceased partner. The administrator, who was also their guardian, in entire good faith allowed the business to be continued by the surviving partners for several years, without filing any inventory or account. The property meantime suffered no deterioration, but increased in value, and was afterwards, under a special law, transferred to a corporation created for the purpose. The beneficiaries, for more than seven years after this transfer and their coming of age, received annual stated accounts, and dividends on their shares of the stock. It was *held*, that such acquiescence prevented their maintaining a bill in equity for an account of the original estate. *Hoyt v. Sprague*, 103 *U. S.* 613.

R., the agent of the patentee, authorized the firm of H., C. & N., for a valuable consideration, to construct for use at their place

of business, the device (a furnace) involved in the patent. The defendants, who had all the rights of the firm of H., C. & N., were sued for infringement, because of the use of the device. It was *held*, 1. After the transaction with H., C. & N., the patentee had no right or interest with respect to the particular device and its use during the time of his original patent, and acquired none by the extension of his patent afterward. 2. Those who constructed the device under the authority of the patentee, and the defendants who acquired it of them, have had and still have the right to use it at the particular place, clear of any claim of infringement by the patentee or his representatives. 3. Though the right to use may not have been acquired by lawful conveyance (according to the statutes) of that right as a subject of conveyance by itself, it was acquired by constructing the device for use, with the consent of the patentee obtained and paid for: *Black v. Hubbard*, 12 *Pat. Off. Gaz.* 842.

Validity of an agreement by which the patentee of a patent which had expired, having claims for damages for its infringement made a written agreement with G., giving to G. the exclusive right to control the claims, and collect or compromise them; G. undertaking to bear all expenses, except that the patentee was to bear the taxable costs of any suit in which a recovery for costs should be had against him; and G. being entitled to receive, as compensation for his time and all expenses, except such taxable costs, one-half of the gross amount he might collect,—examined with reference to the objections of champerty and maintenance; and *held*, that as it was, in terms, to operate in many States, it must be tested by the general rules of common law and equity, and should be adjudged void for conflict with those; although by the statute law of New York, where it was made, it might be sustainable. *Gregerson v. Inlay*, 4 *Blatchf.* 503.

An inventor made an agreement with F. that, in consideration of the performance of certain covenants by him, he (F.) should have an interest in a patent. The covenants were not performed, in consequence of which default the inventor notified F. of the forfeiture of his rights. F. then presented the inventor a bill for the amount he had advanced, under his agreement with the inventor, it was *held*, that by this action F. abandoned to the inventor all his rights under the agreement. *Kittle v. Frost*, 9 *Blatchf.* 214; 5 *Fish. Pat. Cas.* 132.

Under an agreement between the owners of conflicting patents,

which defined their respective rights and provided a fund for maintaining them and for purchasing, as joint property, patents deemed necessary for their mutual protection, a patent does not pass, which had been previously purchased by one of the parties and was subsequently assigned to the original inventors, and, after having been extended, was reassigned to the same party. *Aultman v. Holley*, 5 *Pat. Off. Gaz.* 3.

Construction and effect of a peculiar contract for right to use one machine under a patent. *Steam Cutter Co. v. Sheldon*, 10 *Blatchf.* 1; 5 *Fish. Pat. Cas.* 477.

An agreement in writing between W. and M. & S., provided for the sale by W., to M. & S., of two-thirds of his mineral lease of lands in Lehigh county, from C., including tools and all appurtenances, and also of "two-thirds of all his machinery, furnaces, &c. now on or about the premises of Wetherill Zinc Company, in the town of W., with rights to use all his patents and process for the manufacture of zinc oxide, retorts, &c., which said W. now has, or has in contemplation to obtain; it being understood that the patents, heretofore referred to, mean only those which he holds in his own right." W. had previously transferred interests in his process patent, and was, therefore, only part owner of it. W.'s patent was subsequently renewed. It was *held*, 1. The interpretation of this contract must be made from the instrument itself, irrespective of the declarations of either party; but in aid thereto, it was proper to consider facts cognate to the subject of the contract, and within the knowledge of the parties. 2. The interests in the lease, and in the machinery conveyed, were separate and independent. 3. The right to use W.'s patents and processes was to be exercised in connection with the buildings, machinery, &c., and, consequently, was local and restricted. 4. The qualifying words, "The patents heretofore referred to, mean only those which he holds in his own right," apply only to patents, of which W. was the apparent but not the real owner. They did not exclude patents of which his tenure was not exclusive. 5. As the process patent was the only one for the manufacture of zinc oxide, then held by W., it was clearly conveyed by the contract; the words of the grant could apply to no other. 6. A transfer of an interest in a subsisting patent will not extend beyond the terms of the patent, unless there are words indicating an intention to convey more than a present interest. 7. The words "Now has, or has in contemplation to obtain," merely individuate the patents which the contract was

intended to embrace; they would include patents subsequently obtained for which caveats had already been filed. *Wetherill v. Passaic Zinc Co.*, 2 *Pat. Off. Gaz.* 471; 16 *Int. Rev. Rec.* 156.

A contract between owners of two patents concurrently useful in the manufacture of an article, governing the manner in which the manufacture of the article should be carried on, was *held*, valid; and obligatory on licensees of either patentee, who subsequently took their licenses with notice of the restrictions which the contract imposed on manufacture under the patents. *Morse v. O'Reilly*, 6 *Pa. L. J.* 501; 4 *L. J. Rep.* 75; 5 *Whart. Dig.* 4, 414.

A patent owned by A. and B. was assigned by them, as to certain States, to E., a corporation, part of the consideration being a prescribed number of shares of stock in E. The contract required the payment of a royalty to A. and B., and also, under penalty of forfeiture, the use by E. of its best endeavors to make the corporate scheme a success. On the other hand, A. and B. agreed to exercise reasonable diligence to promote the success of the enterprise, under the penalty of forfeiture of all rights of reversion. On failure of the corporation, F., a large stockholder, purchased its assets, including the patent right, but did not subsequently comply with the condition as to diligence, &c. Suit was brought by A. and B. to have the right acquired by F. declared forfeited. *Held*, that, as it appeared that the plaintiffs had received the full value of their patent right, and were stockholders in E., which they had caused to be formed, and that as there was failure on their part to comply with their promises as to making the business a success, no right of reverter or forfeiture existed. *Buckley v. Sawyer Manuf. Co.*, 7 *Fed. Rep'r*, 358; 2 *McCrory*, 350.

One who aided in perfecting an invention, but afterward recognized the validity of the nominal inventor's claim, in dealings which resulted in the purchase of the patent therefor, was *held* estopped from setting up a claim to being the inventor against such purchasers. *National Feather Duster Co. v. Hibbard*, 9 *Fed. Rep'r*, 558; 11 *Biss.* 76; 21 *Pat. Off. Gaz.* 635.

What contract made to promote the development of a patent will give the undertaking party an interest or title in or to the invention, see *Downton v. Allis*, 9 *Fed. Rep'r*, 766.

Construction of a contract whereby a creditor of a patentee took patented machines in payment of his demand, considered; and the right of the creditor to use the machines without paying royalty,

determined. *Porter Needle Co. v. National Needle Co.*, 17 *Fed. Rep'r*, 536.

By an agreement between patentees and a manufacturer of the patented articles, the former gave to the latter the privilege of purchasing the patent, at any time within a year, for a stipulated price, and he agreed that, if he did not purchase it, he would assign to them any and all improvements upon the invention described in the patent, or relating thereto, which he might make or patent. Upon his electing not to purchase the patent, the patentees were *held* entitled to assignments of those improvements only which were made or patented by him during the term of a year specified in the agreement. *Bunker v. Stevens*, 26 *Fed. Rep'r*, 245.

A patentee and an inventor of an improvement on his device, obtained a new patent, by agreement between them, as joint patentees. It was *held*, that in equity they were joint owners of both patents, and that the second inventor could enjoin the first from using his patent except in connection with the second patent. *Duke v. Graham*, 19 *Fed. Rep'r* 647.

An agreement between owners of patents and alleged infringers, whereby the latter accept licenses from the former, will not be specifically enforced against the licensees, where it appears that the licensors have themselves repeatedly violated the terms of the contract, even though the licensees were guilty of the first breach. The remedy of the licensors, if any, is at law. *Ohio Steel Barb Fence Co. v. Washburn & Moen Manuf. Co.*, 26 *Fed. Rep'r*, 702.

A contract for the use of an invention, requiring the payment of \$30 for each of the first 400 locomotive engines to which the invention should be applied, \$6,000 to be paid within thirty days, and the remainder within one year, can not be construed as an agreement to apply the invention to 400 locomotives and pay \$30 for each. *Babcock v. Northern Pacific R. Co.*, 26 *Fed. Rep'r*, 756.

103. *Persons purchasing of Inventor, before Application, may use or sell the Thing purchased.*

Every person who purchases of the inventor, or discoverer, or with his knowledge and consent constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall

have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor. *Rev. Stat.* § 4899.

The use of an invention prior to an application for a patent, with the knowledge and consent of the inventor, and unforbidden by him entitles the person so using, to continue the use after the patent has been granted. *McClurg v. Kingsland*, 1 *How.* 202.

The above enactment (as found in Act of 1839) was limited to the specific things made or bought; it did not extend to a general right to practice the invention. *Brickill v. New York City*, 18 *Blatchf.* 273; 7 *Fed. Rep'r*, 479; 18 *Pat. Off. Gaz.* 463.

The sale by an inventor, and the public use by the purchaser, of a machine embodying the completed invention, more than two years before the application for a patent, does not invalidate the patent, where such sale is upon condition that the machine should work satisfactorily, and is made at an under price, without profit to the seller, and the use is for the purpose of securing a fair test of the invention. And when proof has been made that the use was experimental, upon the question of its reasonableness every presumption should be made in favor of the inventor. *Innis v. Oil City Boiler Works*, 22 *Fed. Rep'r*, 780; 30 *Pat. Off. Gaz.* 998.

Consent, by the inventor of an apparatus, to the public use by others, before his application for a patent therefor, of one such apparatus sold by him to them, *held*, under the circumstances of the particular case, sufficiently shown to entitle them to continue to use the specific machine, under *Rev. Stat.* § 4899, without compensation to him, after the patent had been granted. *Duffy v. Reynolds*, 24 *Fed. Rep'r*, 855; 33 *Pat. Off. Gaz.* 621.

104. *Sales and Purchases of Patented Articles.*

The invalidity of a patent does not make the sale of the machine illegal, so as to taint with illegality the obligation of the person who is manufacturing them under an agreement with the patentee, and who receives the proceeds, to account to the patentee, under the contract. *Kinsman v. Parkhurst*, 18 *How.* 289; 1 *Blatchf.* 488.

The sale of a patented machine by a sheriff, under an execution, does not, in and of itself, convey to the purchaser any right to use the machine in the manner pointed out in the patent right. The purchaser acts at his own peril. *Sawin v. Guild*, 1 *Gall.* 485.

A patented machine, and the right of use attached to it, may pass, by sale, devise, or levy of execution, or assignment of an insolvent's effects. *Woodworth v. Curtis*, 2 *Woodb. & M.* 524. But see *Stevens v. Gladding*, 17 *How.* 447. Whatever right to use a patented machine the defendant in an execution may have, passes with the machine to the purchaser upon a sale thereof by the sheriff. The lawful sale of a patented machine takes it out of the monopoly, either altogether or *pro tanto*, according to the nature of the contract. The purchaser of a machine from the patentee acquires no right in the patent itself, and needs none to enable him to enjoy his acquisition. By implication he is invested with a license to use that particular machine, and, in the absence of express stipulation to the contrary, such license passes with the machine to successive owners as an incident of proprietorship. That such is the law in case of a voluntary sale of a patented machine by the patentee is incontrovertible, and it is equally applicable to sale upon execution. Thus a sheriff's sale of a factory "with machinery for manufacturing" certain things, carries with it the title to pieces of machinery used in said factory and for the purpose specified, although detached and separate from the realty. *Wilder v. Kent*, 15 *Fed. Rep'r*, 217; 23 *Pat. Off. Gaz.* 831; 15 *Rep'r*, 525.

The granting clause of a deed containing the following words:—"Give, grant, bargain, and sell one of Baldwin's peg-splitting machines and the right to use the same, and of vending to others to be used in the county of Cheshire, excepting the town of Hinsdale, being the same machine for which letters-patent were issued," &c.,—does not authorize the grantee to construct any machine whatever; it is the conveyance of a single machine already in existence, and of the right to use and sell that single machine within the described territory. *Baldwin v. Sibley*, 1 *Cliff.* 150.

Whenever a patentee, assignee, licensee, or other legally authorized party, sells an absolute and unconditional right to any patented article or product, the purchaser acquires the absolute right, so far as the vendor, as patentee, assignee, &c., is concerned, to use and control such patented article or product as he sees fit. And if such article be in the nature of a manufacture, the purchaser may re-work it for the manufacture of any new variety or of the same variety of goods, although such goods retain a part or all the qualities peculiar to the original product or manufactured article. *Goodyear v. Beverly Rubber Co.*, 1 *Cliff.* 348.

Where only the right to use a patent results from the purchase

of a machine, such right is co-extensive with the existence of the machine and expires with it. *Day v. Union Rubber Co.*, 3 *Atlantic*, 488 ; aff'd on other points, 20 *How.* 216.

When the owner of a patent himself sells a machine, the operation of which involves using his invention, he is understood to have to that extent parted with his exclusive right. Thus a sale of patented machines and other property, made under foreclosure of a mortgage, and by consent of the owner of the patents, was *held*, under the circumstances, to carry the right to use the machines under the patent, as well as the ownership of them as corporeal things. *Detweiler v. Voegel*, 8 *Fed. Rep'r*, 600 ; 19 *Blatchf.* 482 ; 12 *Rep'r*, 198.

The purchase of a patented article from the owner of the patent confers upon the purchaser the right to use it to the extent that he could if it were not the subject of the patent ; but such sale does not import the permission of the seller to its use in a way to interfere with his exclusive property in another invention. *Roosevelt v. Western Electric Co.*, 20 *Fed. Rep'r*, 724.

The sale of the product of a patented machine does not violate another person's exclusive right to use, construct, or sell the machine itself. *Goodyear v. New Jersey Central Railroad*, 1 *Fish*, 626 ; 2 *Wall. Jr.* 356. So the purchase of the product of a patented machine or process does not make the purchaser an infringer of the patents for the machine or process. *Brown v. District of Columbia*, 3 *Mackey*, 502.

The rightful purchaser from a licensee of a material or article manufactured under a patent has a right to convert it to any use he pleases, unrestricted by any covenant between the licensee and the owner of the patent. Another licensee cannot obtain an injunction restricting him to a use of the product in its original form or for its original purpose, upon the ground that his vendor is under covenant not to employ it otherwise. Thus where Goodyear, as patentee of the vulcanized rubber compound, sold to B. an exclusive right to use it for making "tubes," and to W. the exclusive right to use it for making "wringers," and C. bought tubes of B., converted them into wringers, and undersold W., and filed a bill to enjoin such conversion, it was *held*, that the suit was not maintainable. *Washing Machine Co. v. Earle*, 3 *Wall. Jr.* 320.

A buckle or bale-tie sold for ordinary commercial use passes beyond the monopoly of the patent ; and cannot be followed or controlled in its subsequent disposition. Even where the words

“licensed to use once only” were stamped upon the buckles, and words of like import were contained in the bill-heads and invoices, yet,—it was *held*, that the nature of the article and of its use were such that there was an implied parting with the unrestricted title at the time of sale which was inconsistent with any such reservation or limitation. *American Cotton Tie Co. v. Simons*, 13 *Pat. Off. Gaz.* 967.

A purchaser of machines from the patentees may repair and perfect them, and his using them is not an infringement; such purchase does not, however, authorize the use of machines containing the patented inventions unless they are the identical machines purchased. *Union Metallic Cartridge Co. v. U. S. Cartridge Co.*, 2 *Bann. & A. Pat. Cas.* 593; 8 *Fed. Rep.* 446.

The right to make carries the right to sell, but not necessarily the right to use the machine when made and sold. *Jenkins v. Greenwald*, 2 *Fish.* 37; 1 *Bond*, 128; *Bicknell v. Todd*, 5 *McLean*, 236.

Where one licensed to run a patented machine sells such machine, the license to run does not necessarily pass with the machine. *Wilson v. Stolley*, 4 *McLean*, 275; 4 *West. L. J.* 412.

Unconditional sale of a patented article confers the whole title therein, and impliedly warrants full ownership on part of the vendor. *Holliday v. Matheson*, 24 *Fed. Rep.* 185; 30 *Pat. Off. Gaz.* 452; 31 *Id.* 1444.

105. *Territorial Limits of Buyer's Right.*

Where a patentee has assigned his right to manufacture, sell, and use within a limited district an instrument, machine or other manufactured product, one who buys from the assignee, within the limits of the district, one of such instruments or machines, acquires the right to use it anywhere, without reference to other assignments of rights for other territories which may have been made by the patentee. The right to use such machines or instruments stands on a different ground from the right to make and sell them, and inheres in the nature of a contract of purchase, which carries no implied limitation of the right of use within a given locality. Thus where the assignee, for a limited district, of a patent for an improvement in coffins, manufactured and sold, within the district, coffins containing the patented improvement, it was *held*, that the purchaser of a coffin could put it to use in an interment anywhere;

he was not restricted to a use of it within the district designated in the assignment. *Adams v. Burke*, 17 *Wall.* 453; 1 *Pat. Off. Gaz.* aff'g 1 *Holmes*, 40; *McKay v. Wooster*, 6 *Am. L. & Eq. Cas.* 373; 3 *Pat. Off. Gaz.* 441; *May v. Chaffee*, 2 *Fish. Pat. Cas.* 385; 5 *Fish. Pat. Cas.* 160.

If the vendor of a machine be an assignee of the patent for a specified territory, the machines sold by him pass out of the monopoly, and the property sold passes from under the protection of the patent laws, and is subject, like other property, only to the operation of the laws of the State. *Hawley v. Mitchell*, 1 *Pat. Off. Gaz.* 306; 4 *Fish. Pat. Cas.* 388; 1 *Holmes*, 42.

One who purchases patented articles from a grantee of an exclusive right to manufacture and sell under the patent in a specified part of the United States, has not the right to sell the articles in the course of trade outside the designated limits covered by the grantee to his vendor. *Hatch v. Adams*, 22 *Fed. Rep'r*, 434; 29 *Pat. Off. Gaz.* 776. But see *Hatch v. Hall*, *Id.* 438; 30 *Pat. Off. Gaz.* 1096.

Where the owner of a patent sells the patented article, without restriction or conditions, in a foreign country, the use or sale of such patented article in this country, by a purchaser of it from the vendee of the patentee in the foreign country, is not an infringement of the patent. *Holiday v. Matheson*, 24 *Fed. Rep'r*, 185; 31 *Pat. Off. Gaz.* 1444. See previous decision, S. C., 30 *Pat. Off. Gaz.* 452.

106. *His Right, how limited by Term of Patent.*

The right acquired by a purchaser of the exclusive privilege of making or selling, in a particular place, a patented thing terminates at the time limited by the law which created it for its duration; unless the sale is expressly made broader. *Bloomer v. McQuewan*, 14 *How.* 539; *Bloomer v. Millinger*, 1 *Wall.* 340; *Blanchard v. Whitney*, 3 *Blatchf.* 307; *Hawley v. Mitchell*, 4 *Fish. Pat. Cas.* 388; 1 *Holmes*, 42; 1 *Pat. Off. Gaz.* 306.

The right to use a machine after the expiration of the patent is an incident to the right to use it during the original term; if that fails (here, on account of fraud), the incident falls with it. *Union Paper-Bag Machinery Co. v. Nixon*, 9 *Pat. Off. Gaz.* 331; 1 *Flippin*, 491; 2 *Mann. & A. Pat. Cas.* 244.

Articles manufactured without right during the lifetime of a

patent, cannot be lawfully sold after its expiration. *Am. Diamond Rock Boring Co. v. Sheldon*, 1 *Fed. Rep'r*, 870 ; 18 *Blatchf.* 50.

A manufacturer of a patented article after the expiration of the patent, has a right to represent that it is made according to the patent, and to use the name of the patentee for that purpose. *Wilcox & Gibbs Sewing Machine Co. v. Gibbons Frame*, 17 *Fed. Rep'r*, 623 ; 24 *Pat. Off. Gaz.* 1272 ; 21 *Blatchf.* 431 ; see *ante*, p. 11.

VII. MARKING ARTICLES "PATENTED." FALSE MARKING.

107. *Patented Articles must be Marked as such.*

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

The requirement of the above section,—that patented articles shall be marked with the word "patented," &c.,—may be sufficiently complied with, where the articles are so small that it is difficult to stamp them, by stamping and labeling the packages in which they are shipped and the invoices. *Sessions v. Romadka*, 21 *Fed. Rep'r*, 124 ; 28 *Pat. Off. Gaz.* 721.

Upon the trial of an action for infringement in which defendant claims the benefit of this section, the burden is in the first instance

upon the defendant to show that the plaintiff has made or sold articles under a patent, and has failed to mark them as required ; and then the burden rests upon the plaintiff to show that defendant had notice that he was infringing. *Goodyear v. Allyn*, 6 *Blatchf.* 33 ; 3 *Fish. Pat. Cas.* 374.

It is not an excuse for a patentee's omission to mark a patented article as such, that such marking would have been expensive, and must have enhanced the price. The law exacts the marking, unless, from the character of the article, it cannot be done ; the impossibility or impracticability is not made dependent on the question of pecuniary loss or gain to the patentee. *Putnam v. Sudhoff*, 1 *Bann. & A. Pat. Cas.* 198.

When ignorance of facts may excuse from statute penalties, discussed ; and *held*, that one who manufactures an article which is not marked "patented," &c., without knowledge of the patent, is not liable in damages for so manufacturing ; but becomes liable, upon acquiring notice, for manufacturing done afterward. *Allen v. Deacon*, 21 *Fed. Rep'r.* 122. What actual notice that an article is patented is equivalent to stamping it as patented, for the purpose of rendering an infringer liable, see *New York Pharmaceutical Assoc. v. Tilden*, 14 *Fed. Rep'r.* 710 ; 23 *Pat. Off. Gaz.* 272 ; 15 *Rep'r.* 98.

The patentee may prove against one whom he sues as licensee but who denies the license, that the defendant marked the articles as patented ; such mark is an acknowledgment that they were manufactured under a patent. *Jones v. Vankirk*, 2 *Fish. Pat. Cas.* 586.

108. *Penalty for Falsely Marking or Labeling Articles as "Patented."*

Every person who, in any manner, marks upon anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor without the consent of such patentee, or his assigns or legal representatives ; or

Who, in any manner, marks upon or affixes to any such patented article the word "patent" or "patentee," or the words "letters patent," or any word of like import, with

intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives ; or

Who, in any manner, marks upon or affixes to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offense, to a penalty of not less than one hundred dollars, with costs ; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed. *Rev. Stat.* § 4901.

This section is to be strictly construed. It makes penal the *act of marking* only ; hence, taking the marked articles into another jurisdiction than that in which they were marked, with intent to sell them there, is not within its provisions. Such act cannot be regarded as a repetition or continuance of the original offense. *Pentlarge v. Kirby*, 19 *Fed. Rep'r*, 501.

The purpose of prohibiting under penalties the marking of an unpatented article is to prevent deceiving the public (*Wilson v. Singer Manuf. Co.*, 9 *Biss.* 173 ; 16 *Pat. Off. Gaz.* 1091 ; 4 *Bann. & A. Pat. Cas.* 637) ; and in order to render a person liable, the marking must not only give the public to understand the fact of a patent, but it must be done *quo animo*, with intent to deceive. *Walker v. Hawxhurst*, 5 *Blatchf.* 494. The intent to create a belief in a present subsisting patent is necessary. If the patents marked upon the machine have all expired, and there is no subsisting patent upon the machine or any part of it, the offense is incomplete (*Wilson v. Singer Manuf. Co.*, 12 *Fed. Rep'r*, 57 ; 11 *Biss.* 293 ; 28 *Int. Rev. Rec.* 176) ; as where the patentee continued to stamp the patented article with the word "patented" and the date when the patent was issued, after the patent had expired. *Wilson v. Singer Manuf. Co.*, 9 *Biss.* 173 ; 16 *Pat. Off. Gaz.* 1091 ; 4 *Bann. & A. Pat. Cas.* 637, (See *ante*, pp. 10, 11). The question of the intent to deceive is for the jury. *Walker v. Hawxhurst*, *supra* ; *Oliphant v. Salem Flouring Mills*, 5 *Sawyer*, 128 ; 3 *Bann. & A. Pat. Cas.*

256. Whether the provision applies though the article is not of a patentable nature, so that in a legal point of view there cannot have been any deception, see *Oliphant v. Salem Flouring Mills, supra*; *United States v. Morris, 2 Bond, 23*; *3 Fish. Pat. Cas. 72*.

The question of the liability of a corporation for the act of its superintendent in wrongfully affixing the word "patented" to an unpatented article is considered in the charge to the jury in the case of *Tompkins v. Butterfield, 25 Fed. Rep'r, 556*; *33 Pat. Off. Gaz. 758*.

The second subdivision of the section does not include the case of a patented article stamped with the mark of a person who has no patent embracing or affecting the article stamped, but only a patent for a different article, and no penalty can be recovered therefor. *French v. Foley, 11 Fed. Rep'r, 801*. The remedy of the person whose mark is improperly used must be sought independent of this section (*Id.*); and the courts will restrain such unlawful use. *Washburn, & Co. Manuf. Co. v. Haish, 9 Biss. 141*; *18 Pat. Off. Gaz. 465*; *4 Bonn. & A. Pat. Cas. 571*.

The penalty "of not less than \$100" imposed, means a penalty of \$100 *only*. *Stimpson v. Pond, 2 Curt. 502*. The suit therefor must be brought in the name of the informer and not in that of the United States (*United States v. Morris, 2 Bond, 23*; *3 Fish. Pat. Cas. 78*); however, it being a *qui tam* action, plaintiff may properly describe himself as suing for himself and the United States, and a demurrer for misjoinder of parties will not be sustained for so doing. *Winne v. Snow, 19 Fed. Rep'r, 507*. Special injury is no part of the cause of action; averments of it may be struck out as irrelevant, under New York Code of Procedure, but are not ground of demurrer. *Id.* Patentability of the article need not be shown. *Id. Contra, U. S. v. Morris, supra*. Proof on the part of the plaintiff to make out his case beyond a reasonable doubt is not required. *Hawlowetz v. Kass, 34 Pat. Off. Gaz. 1499*; *aff'g S. C., nom. Kass v. Hawlowetz, Id. 1135*.

The plaintiff in an action for this penalty must prove beyond a reasonable doubt: 1. That the defendant affixed or caused to be affixed the word upon the article; 2. That he has no patent; 3. That he affixed the word with the intent to deceive the public. *Nichols v. Newell, 1 Fish. 647*.

VIII. CAVEATS.

109. *Filing and Effect of Caveats.*

Any citizen of the United States who makes any new invention or discovery, and desires further time to mature the same, may, on payment of the fees required by law, file in the patent office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his right until he shall have matured his invention. Such caveat shall be filed in the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof ; and if application is made within the year by any other person for a patent with which such caveat would in any manner interfere, the commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail, to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his description, specifications, drawings, and model within three months from the time of placing the notice in the post-office in Washington, with the usual time required for transmitting it to the caveator added thereto ; which time shall be indorsed on the notice. An alien shall have the privilege herein granted, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen. *Rev. Stat.* § 4902.

A caveat, under the patent law, is a notice given to the office of the caveator's claim as inventor, in order to prevent the grant of a patent to another for the same alleged invention upon an applica-

tion filed during the life of the caveat without notice to the caveator. *Rules of Prac.* No. 189.

If at any time within one year after the filing or renewal of a caveat another person shall file an application with which such caveat would in any manner interfere, and if, within the year, the application shall be found patentable, then such application will be suspended, and notice thereof will be sent to the person filing the caveat, who, if he shall file a complete application within the prescribed time, will be entitled to an interference with the previous application, for the purpose of proving priority of invention, and obtaining the patent, if he be adjudged the prior inventor. The caveator, if he would avail himself of his caveat, must file his application within three months from the expiration of the time regularly required for the transmission to him of the notice deposited in the post-office at Washington; and the day when the time for filing expires will be mentioned in the notice or indorsed thereon. *Id.* No. 196.

The caveator will not be entitled to notice of any application pending at the time of filing his caveat, nor of any application filed after the expiration of one year from the date of the filing or renewal thereof. The caveat may be renewed by the payment of a second caveat fee of ten dollars, and it will continue in force for one year from the date of the payment of such second fee. Subsequent renewals may be made with like effect. If a caveat be not renewed, it will be preserved in the secret archives of the office. *Id.* No. 197.

A caveat answers a double purpose; first, to give notice of the inventor's claim, and second, to prevent a patent from issuing to another for the same thing. *Allen v. Hunter*, 6 *McLean*, 303.

The filing of a caveat is not necessary to preserve the right of an inventor to a patent; it only entitles him to notice of any interfering application. *Heath v. Hildreth*, *Craich Pat. Dec.* 96; 1 *MacArthur Pat. Cas.* 12. It protects the inventor filing it from all interfering applications made within one year after the filing it by requiring the office to notify him of such application so that he may resist the interference. *Bell v. Daniels*, 1 *Fish. Pat. Cas.* 372; 1 *Bond*, 212. In other words, its purpose is to save the inventor from the principle which awards the patent to him who first perfects and introduces the invention. *Phelps v. Brown*, 1 *Fish.* 479; 4 *Blutchf.* 362. It confers no rights and affords no protection except as to notice of an interfering application filed during its

life giving the caveator the opportunity of proving priority of invention if he so desires. *Rules of Prac.* No. 198. It may be used as evidence in contests. See *Id.* No. 150. But it is not conclusive evidence that the patent to which it relates, was not, at the time of filing, perfected. *Johnson v. Root*, 1 *Fish. Pat. Cas.* 351. If, during the interval between filing the caveat and applying for the patent, the inventor allows his invention to go into public use, the caveat will not protect him. *Bell v. Daniels*, *supra*. Or, if he delays or neglects to perfect his invention, and in the meantime some one else conceives the same idea and perfects it, the caveator cannot in virtue of his caveat appropriate what has thus been embraced in a practical machine between his caveat and his patent. *Johnson v. Root*, *supra*. An application for a patent cannot be prejudiced by the failure of the officers of the patent-office to give information of his application to a person who makes inquiry there in regard to it. *Sparkman v. Higgins*, 1 *Blatchf.* 205; 5 *N. Y. Leg. Obs.* 122; 6 *Pa. L. J.* 344. A failure of the commissioner to perform his duty of giving notice to the caveator of an interfering application will not be allowed to prejudice his right, but the commissioner may issue to him a junior patent to enable him to secure it. *Phelps v. Brown*, *supra*. And the fact that the earlier patent was granted while a caveat was pending and in force will not render the patent void. *Cochrane v. Waterman*, *Cranch Pat. Dec.* 121.

There is no provision of law making the caveat assignable; although the alleged invention therein set forth is assignable, and the caveat may be used as means of identifying the invention transferred in an assignment. *Rules of Prac.* No. 199.

Caveat papers cannot be withdrawn from the office after they have once been filed; but copies of the papers may be obtained at the usual rates by the caveator or any person duly authorized by him. Additional papers, if containing new matter, must be filed as a separate caveat with another fee. *Rules of Prac.* No. 200.

For decisions on the effect of caveats in particular cases, see *Robertson v. Secombe Manuf. Co.* 10 *Blatchf.* 481; 3 *Pat. Off. Gaz.* 412; 6 *Fish. Pat. Cas.* 268; also, 4 *Pat. Off. Gaz.* 132; *Goodyear Dental Vulcanite Co. v. Gardiner*, 3 *Cliff.* 408; 4 *Fish. Pat. Cas.* 224; 5 *Pat. Off. Gaz.* 586.

110. *Requisites and Sufficiency.*

The caveat must comprise a specification, oath, and, when the nature of the case admits of it, a drawing, and, like the application, must be limited to a single invention or improvement. *Rules of Prac.* No. 192.

The same particularity of description is not required in a caveat as in an application for a patent; but the caveat must set forth the object of the invention and the distinguishing characteristics thereof, and it should be sufficiently precise to enable the office to judge whether there is a probable interference when a subsequent application is filed. If upon examination a caveat be found defective in this respect, amendment will be required. Without compliance with Rules 190, 192, 193 and 195, the caveator will not be entitled to the notice provided for in Rule 196. *Id.* No. 192.

The oath of the caveator must set forth that he is a citizen of the United States, or, if he be an alien, that he has resided for one year last past within the United States, and has made oath of his intention to become a citizen thereof, and that he believes himself the original and first inventor of the art, machine, or improvement set forth in his caveat. *Id.* No. 196.

When practicable, the caveat should be accompanied by full and accurate drawings, separate from the specification, well executed on tracing muslin or paper that may be folded.

Where the caveat contains no description or representation sufficient to enable a practical working apparatus to be made from it, and the ideas suggested by it do not appear to have been afterward developed, but a different plan is followed in a patent subsequently obtained by the party filing the caveat, such undeveloped suggestions are not sufficient to invalidate a subsequent patent to another party. *Renwick v. Cooper*, 6 *Fish. Pat. Cas.* 31; 10 *Blatchf.* 201.

That although a caveat be informal, yet if it is followed up with reasonable diligence and a patent is eventually granted for the invention, it will prevent any right from being acquired by another person, in the meantime,—see *Sparkman v. Higgins*, 1 *Blatchf.* 205; 5 *N. Y. Leg. Obs.* 122; 6 *Pa. L. J.* 344.

**IX. REJECTIONS AND INTERFERENCES. MOTIONS.
TESTIMONY.***111. Notice of Rejection of Claim for Patent to be given
to Applicant.*

Whenever, on examination, any claim for a patent is rejected, the commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the commissioner shall order a re-examination of the case. *Rev. Stat.* § 4903.

A rejected application for letters-patent is no bar to a patent; at least not where there is no evidence to show that the alleged prior invention which it discloses was ever perfected or brought to practical use, or that it was not abandoned and never revived by the original inventor. *Rubber Step Manuf. Co. v. Metropolitan R. R. Co.*, 13 *Pat. Off. Gaz.* 549.

If an application after rejection is renewed and granted, the date when it was first made, not that of its renewal, is taken as the date of application. *Henry v. Francestown Soapstone Stove Co.*, 9 *Pat. Off. Gaz.* 408; 2 *Bann. & A. Pat. Cas.* 221.

A patent should not be granted for an invention every feature of which was shown and described, but not claimed, in a previous patent issued to the same applicant, a re-issue of which cannot be obtained because of undue delay. The omission, in the prior patent, to claim the invention, is a dedication of it to the public. *Hill v. Commissioner of Patents*, 34 *Pat. Off. Gaz.* 757. The mechanic who executes the conception of his employer is not entitled to a patent; even though he use inventive skill as well as mechanical dexterity in carrying out his employer's design. *Wellman v. Blood*, 1 *MacArthur Pat. Cas.* 432; *Warner v. Goodyear*, *Id.* 60; *King v. Gedney*, *Id.* 443.

The question whether a delay in an application should be construed as an abandonment, is for the determination of the jury as matter of fact ; it is not made, by the act of 1836, a ground for refusal, by the commissioner, to grant a patent. *Heath v. Hildreth*, 1 *MacArthur Pat. Cas.* 12.

The decision of the commissioner of patents rejecting an application for a patent on the ground of abandonment of the invention is not final. Abandonment is a question of fact, and the decision is reviewable. This is so when the decision was made on renewal of an application equally as when made on the original application. *United States Rifle, &c. Co. v. Whitney Arms Co.*, 14 *Blatchf.* 94; 11 *Pat. Off. Gaz.* 373; 2 *Bann. & A. Pat. Cas.* 493.

Upon the abolition, by the act of 1839, of the board of examiners created by the act of 1836, the original jurisdiction of the board vested in the commissioner of patents ; and under sections 6 and 7 of the act of 1836, he was authorized to investigate and determine questions of public use of an alleged invention arising upon an application for a patent. The negative requirement—that the invention has not been in the public use or on sale, &c., stands in the statute in the same category with the other requisites, and their existence is to be determined by the commissioner according to a due course of proceeding had by him. *Hunt v. Howe*, 1 *MacArthur Pat. Cas.* 366 ; *Mowry v. Barber*, *Id.* 563. And see *Ellithorp v. Robertson*, *Id.* 585.

Proof of a public use of a device for two years prior to the application (Act of 1839, § 7) requires the commissioner to reject the application. *Rugg v. Haines*, 1 *MacArthur Pat. Cas.* 420.

The commissioner of patents was authorized, under section 7 of the act of 1839, to reject an application for a patent upon proof that the invention had been abandoned to the public. *Mowry v. Barber*, 1 *MacArthur Pat. Cas.* 563; *Ellithorp v. Robertson*, *Id.* 585; *Same v. Same*, *Id.* 634; *Wickersham v. Singer*, *Id.* 645, 678.

The withdrawal of an application for a patent and the return of part of the patent fee is not of itself an abandonment or dedication of the invention to the public ; but is an equivocal act, to be interpreted by surrounding circumstances, and to be affected upon a second application by the subsequent conduct of the party—his diligence or his neglect or delay—in the same manner as his conduct is to be weighed in regard to an original application. *Wickersham v. Singer*, 1 *MacArthur Pat. Cas.* 645, 689.

The rejection by the commissioner of patents, of the application of Wickersham for a patent for improvements in the feed mechanism of sewing machines, upon an interference with patents issued to Singer—affirmed, upon appeal, notwithstanding Wickersham appeared to have been the prior inventor, on the grounds that he had abandoned the invention by failing to use due diligence in applying for and prosecuting his application for a patent; that his application subsequent to that of Singer, did not, under the circumstances, relate back to the date of an earlier application; and that the invention had been in public use, with his knowledge and consent, more than two years before his second application. *Wickersham v. Singer*, 1 *McArthur Pat. Cas.* 645.

112. *Statement of Reasons and References.*

If, upon the re-examination, the application is again rejected, the reasons therefor will be fully and precisely stated. See *Rules of Prac.* Nos. 64, 89.

The rules further provide that upon the rejection of an application for want of novelty, the examiner must cite the best references at his command. If patents be cited, their dates and numbers, the names of the patentees, and the classes of invention must be stated. Where the reference shows or describes inventions other than that claimed by the applicant, the particular part relied on will be designated as nearly as practicable. The pertinence of the reference, if not obvious, must be clearly explained and the anticipated claim specified. If printed publications be cited, the title, date, page, or plate, and place of publication, or place where a copy can be found, will be given. When reference is made to facts within the personal knowledge of an employé of the office, the data will be as specific as possible, and the reference must be supported by the affidavit of such employé, which shall be subject to contradiction, explanation, and corroboration by the affidavits of the applicant and other persons. If the patent or other printed matter, plates, or drawings, so referred to, are in the possession of the office, copies will be furnished at cost upon the order of the applicant. *Rules of Prac.* No. 65; and see *Id.* 171. And whenever, in the treatment of an *ex parte* application, an adverse decision is made upon any preliminary or intermediate question, without the rejection of any claim, notice thereof, together with the reasons therefor, will be given to the applicant, in order that he may judge of the propriety

of the action. If, after receiving such notice, he traverse the propriety of the action, the matter will be reconsidered. *Id.* No. 66.

113. *Interferences.*

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

114. *What constitutes an Interference.*

An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. *Rule of Prac.* No. 92.

Two patents "interfere" only when they claim, wholly or partially, the same invention. *Gold, &c., Separating Co. v. United States Disintegrating Ore Co.*, 6 *Blatchf.* 307; 3 *Fish. Pat. Cas.* 439. The provision of *Rev. Stat.* § 4918, respecting interfering patents, cannot be invoked, unless it is asserted that the two patents are substantially for the same invention; that the patentee, in whose behalf the statute is pleaded, is the real discoverer of the invention therein set forth; and that the defendant has wrongfully appropriated the fruits of his invention. *Celluloid Manuf. Co. v. Goodyear Dental Vulcanite Co.*, 10 *Pat. Off. Gaz.* 1. Interferences are confined by the statute to cases where an applicant claims that for which a patent has already been granted, or that which is claimed or can be claimed in a previous pending application. Hence a reissue applicant cannot be placed in interference with an unexpired patent in which the record-date of original

application filed is subsequent to that of the reissue patentee, and which does not claim the subject-matter in conflict. *Exp. Platts*, 15 *Pat. Off. Gaz.* 827.

115. *When Declared.*

Interferences will be declared in the following cases, when all the parties claim substantially the same patentable invention: 1. Between two or more original applications. 2. Between an original application and an unexpired patent, when the applicant, having been rejected on the patent, shall file an affidavit showing that he made the invention before the patentee's application was filed. 3. Between an original application and an application for the reissue of a patent granted during the pendency of such original application. 4. Between an original application and a reissue application, when the original applicant shall file an affidavit showing that he made the invention before the patentee's original application was filed. 5. Between two or more applications for the reissue of patents granted on applications pending at the same time. 6. Between two or more applications for the reissue of patents granted on applications not pending at the same time, when the applicant for reissue of the latter patent shall file an affidavit showing that he made the invention before the application on which the earlier patent was granted was filed. 7. Between a reissue application and an unexpired patent, if the original applications were pending at the same time, and the reissue applicant shall file an affidavit showing that he made the invention before the original application of the other patentee was filed. 8. Between an application for reissue of a later unexpired patent and an earlier unexpired patent granted before the original application of the latter patent was filed, if the reissue applicant shall file an affidavit showing that he made the invention before the original application of the earlier patent was filed. *Rules of Prac.* No. 93.

The fact that one of the parties has already obtained a patent will not prevent an interference; for, although the commissioner has no power to cancel a patent, he may grant a patent for the same invention to another person who proves to be the prior inventor. *Id.* No. 92.

116. *When Refused.*

An applicant whose foreign patent is antecedent to any record-date of the domestic patent cited in refusal of the application, is entitled to the issue of his patent, without interference; when the domestic patent makes no claim to the common subject-matter. *Eep. Bland*, 15 *Pat. Off. Gaz.* 828.

A claim, by an applicant for a patent, of that which is shown but not claimed in a previous patent, is not ground for declaring an interference. *Marvin v. Lillie*, 27 *Pat. Off. Gaz.* 299.

An interference should not be declared merely because the purpose of both parties is the same, and both have invented improved means which are supposed to be adequate for the purpose, unless the means are substantially the same. That the specification of one party is, in some of its terms, broad enough to cover some of the forms of the invention of the other, is not conclusive. *O'Reilly v. Smith*, 1 *MacArthur Pat. Cas.* 218.

No interference will be declared between pending applications, nor between a pending application and an unexpired patent, unless there are conflicting claims; but where an application is involved in an interference in part and shows and describes, without claiming, a patentable invention claimed by another party thereto, the applicant may, at any time within twenty days after the statements of the parties have been received and approved, on motion duly made, as provided in Rule 149, file an amendment of his application duly claiming such invention, and on the admission of such amendment the invention shall be included in the interference. [Subsequent proceedings thereon prescribed.] *Id.* No. 94.

Before the declaration of interference all preliminary questions must be settled by the primary examiner, and that issue must be clearly defined; the invention which is to form the subject of the controversy must be decided to be patentable, and the claims of the respective parties must be put in such condition that they will not require alteration after the interference shall have been finally decided, unless the testimony adduced upon the trial shall necessitate or justify such change. *Id.* No. 95.

Where, however, a party who is required to put his case in a condition proper for an interference fails to do so within a reasonable time specified, the declaration of interference will not be delayed. After final judgment of priority the application of such

party will be held for revision and restriction, subject to interferences with other applications or new references. *Id.* No. 46; and see *Id.* No. 93.

117. *Examiner of Interferences. Notices. Disclaimer.*

When an interference is found to exist and the applications are prepared therefor, the primary examiner will forward to the examiner of interferences, together with the files and drawings, notices of interference for all the parties, as specified in Rule 102 (*post*, p. 155), which will disclose the name and residence of each party and that of his attorney, and if any party, as such, be a patentee, the date and number of the patent, and the date of its application, the ordinals of conflicting claims, and the invention claimed, which shall be clearly and concisely defined, in so many counts or branches as may be necessary in order to include all interfering claims. Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, the examiner in charge will notify each of said principal parties, and also the attorney, of this fact. *Rules of Prac.* No. 97.

Upon receipt of the notices of interference, the examiner of interferences will make an examination thereof, in order to ascertain whether the issue between the parties has been clearly defined, and whether it is otherwise correct. If he be of opinion, upon such examination, that the notices are ambiguous in this particular, or are imperfect in any material point, he will transmit his objections to the primary examiner, who will promptly notify him of his decision to amend or not to amend them. *Id.* No. 98.

In case of a material disagreement between the examiner of references and the primary examiner, they shall refer the points of difference to the commissioner for decision. *Id.* No. 99.

The primary examiner will retain jurisdiction of the case until the declaration of interference is made. *Id.* No. 100.

When the notices of interference have been settled, the examiner of interferences will add thereto a designation of the time within which the statements required by Rule 105 (*post*, p. 156) must be filed, and will, *pro forma*, institute and declare the interference by forwarding the notices to the several parties to the interference. *Id.* No. 101.

Notices of interference will be forwarded by the examiner of interferences to all the parties, or to their attorneys, or, in case the

application or patent in interference has been assigned, to the assignees. When one of the parties has received a patent, a notice will be sent to the patentee and to his attorney of record. When one of the parties resides abroad and has no known agent in the United States, notice, in addition to that sent by mail, may be given by publication in the *Official Gazette* for such period of time as the commissioner may direct. *Id.* No. 102.

Upon the institution and declaration of the interference, as provided in Rule 101 (*ante*, p. 154), the examiner of the interferences will take jurisdiction of the same, which will then become a contested case; but the primary examiner will determine the motions mentioned in Rule 116 (*ante*, p. 158), as herein provided. *Id.* No. 103.

An applicant involved in an interference may, with the written consent of the assignee, when there has been an assignment, before the date fixed for the filing of his statement, in order to avoid the continuance of the interference, disclaim under his own signature, attested by two witnesses, the invention of the particular matter in issue, and upon such disclaimer and the cancellation of any claims involving such interfering matter judgment shall be rendered against him, and the disclaimer shall be embodied in and form part of his specification. *Id.* 104.

118. *Preliminary Statements.*

Each party to the interference will be required to file a concise statement, under oath, showing the date of his original conception of the invention, of the making of a drawing, of the making of a model, of its disclosure to others, of its reduction to practice, and of the extent of its use. The parties will be strictly held in their proof to the dates set up in their statements. The statement must be sealed up before filing (to be opened only by the examiner of interferences), and the name of the party filing it, the title of the case, and the subject of the invention indicated on the envelope. The statements shall not be opened to the inspection of the opposing parties until both shall have been filed, or the time for filing both with any extension thereof shall have expired, nor then unless they have been examined by the proper officer and found to be satisfactory. When the invention was made abroad the statement should set forth when and where, if ever, the invention was patented (giving the date and number of the patent) and when, if ever,

it was described in a printed publication (giving the title, date and place of publication), and when, if ever, it was introduced, or knowledge of it was introduced, into this country (giving the circumstances which are thought to establish the facts thereof). *Rules of Prac.* No. 105.

If, on such examination, a statement is found to be defective in any particular, the party shall be notified of the defect, and a time assigned within which he must cure such defect by an amended statement; but in no case will any original or amended statement be returned after it has been once filed. If a party shall refuse to file the amended statement herein referred to, he will be restricted to his record date in the further proceedings in the case. *Id.* No. 106.

If the junior party to an interference fail to file a statement, or if his statement fail to overcome the *prima facie* case made by the respective dates of application, the other may demand an immediate adjudication of the case upon the record. When there are more than two parties to the interference, and any one of them fails to file his statement, judgment may be rendered upon the record as to the party failing to file his statement, unless he be the senior party, and the interference will proceed between the remaining parties. *Id.* 107.

If any party to an interference fail to file a statement, no testimony will subsequently be received from him to prove that he made the invention at a date prior to his application. The statement can in no case be used as evidence in behalf of the party making it. *Id.* No. 108.

If either party require a postponement of the time for filing the statements, he will present his motion duly served on the other parties, with his reasons therefor, supported by affidavit, prior to the day previously fixed upon. But the examiner of interferences may, in his discretion, dispense with service of notice of such motion. *Id.* No. 109.

In case of material error in the statement, arising through inadvertence or mistake, it may be corrected on motion, upon showing to the satisfaction of the commissioner that its correction is essential to the ends of justice. The motion to correct the statement must be made, if possible, before the taking of any testimony, and as soon as practicable after the discovery of the error. *Id.* No. 110.

119. *Presumptions and Evidence.*

In original proceedings in cases of interference the several parties will be presumed to have made the invention in the chronological order in which they filed their completed applications for patents clearly illustrating and describing the invention; and the burden of proof will rest upon those who shall seek to establish a different state of facts. *Rules of Prac.* No. 111.

A time will be assigned in which the junior applicant shall complete his testimony in chief, and a further time in which the other party shall complete the testimony on his side, and a further time in which the junior applicant may take rebutting testimony, but shall take no other. If there be more than two parties, either patentees or applicants, the times for taking testimony will be so arranged that each shall have an opportunity to prove his case against prior applicants and to rebut their evidence, and also to meet the evidence of junior applicants. *Id.* No. 112.

If either party fail to take his testimony within the time assigned to him, all junior applicants having duly taken theirs, the case may, on motion duly made and served on such party, be set for hearing at any time not less than ten days after the hearing of the motion. *Id.* No. 113.

Powers of the commissioners in cases of interferences, and the usual practice of the office in respect to such cases, stated. *Potter v. Dixon*, 2 *Fish. Pat. Cas.* 381; *Hanford v. Westcott*, 16 *Pat. Off. Gaz.* 1181; *United States v. Thatcher*, 2 *MacArthur*, 24.

The rules as to the admissibility of evidence in an interference are the same as at common law. *Nichols v. Harris*, 1 *MacArthur Pat. Cas.* 302.

The applicant in an interference must show that he was the first original inventor, and it is not sufficient to show that he was an original inventor merely. *Spain v. Gamble*, 1 *MacArthur Pat. Cas.* 358.

Admissions of an applicant in derogation of his rights, made *ante litam motam*, are admissible against him in the interference proceedings. *Clarke v. Cramer*, 1 *MacArthur Pat. Cas.* 473.

In an interference case, the fact of invention, and not a knowledge of the degree of its utility, is the proper subject of inquiry. If a party omit to test the value of his invention, and fail to bring it into use, and himself remain ignorant of the extent of its value, yet if it be the same with that of a subsequent discoverer, he is

entitled to a patent over the latter. *Farley v. National Steam-Gauge Co.*, 1 *MacArthur Pat. Cas.* 618.

120. *Motions and Incidental Practice.*

If either party desire to have the hearing postponed, he will make application for such postponement by motion, and will show sufficient reason therefor by affidavit. *Rules of Prac.* No. 114; see *Id.* 149.

If either party desire an enlargement of the time assigned to him for taking testimony, he will make application therefor as provided for in Rule 150, subd. 5. *Id.* No. 115.

Motions to dissolve an interference upon the ground that no interference in fact exists, or that there has been such irregularity in declaration the same as will preclude a proper determination of the question of priority between the parties, or which deny the patentability of an applicant's claim, should, if possible, be made within twenty days after the statements of the parties have been received and approved. Such motions, when in proper form, will be transmitted by the examiner of interferences, with the files and papers, to the proper primary examiner for his determination, and he will return the files and papers to the examiner of interferences, with his decision, at the expiration of the time limited for appeal if no appeal shall have been taken, or sooner if the party entitled to appeal shall file a waiver in writing of his right of appeal, and such decision will be binding on the examiner of interferences unless reversed or modified on appeal. *Id.* No. 116; see *Id.* 118.

All lawful motions, except those mentioned in Rule 116, will be made before and determined by the tribunal having jurisdiction at the time. The filing of motions will not operate as a stay of proceedings in any case. To effect this, motion should be made before the tribunal having jurisdiction of the interference, which will, sufficient grounds appearing therefor, order a suspension of the interference pending the determination of such motion. *Id.* 117.

Appeal may be taken directly to the commissioner from decisions on all motions, except motions to dissolve interferences denying the patentability of applicants' claims, or their right to make the claims, and other lawful motions involving the merits of the case, which, when appealable, may be appealed to the board of examiners-in-chief. From a decision affirming the patentability of

the claim or the applicant's right to make the same no appeal can be taken. *Id.* No. 118.

After the interference is finally declared, it will not, except as herein otherwise provided, be determined without judgment of priority founded either upon the testimony, or upon a written concession of priority by one of the parties, signed by the inventor himself, and also, in the case of an assignment, by the assignee, or upon a written declaration of abandonment of his application, as provided by Rule 165. *Id.* No. 119.

In their decision of the question of priority, or before such decision, the examiner of interferences and the examiners-in-chief will direct the attention of the commissioner to any matter not relating to priority which may have come to their notice, and which, in their opinion, establishes the fact that no interference exists, or that there has been irregularity in declaring the same (Rule 116), or which amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference. The commissioner may, before judgment on the question of priority of invention, suspend the interference and remand the case to the primary examiner for his consideration of the matters to which attention has been directed, and his decision will be subject to appeal, as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment, consider any matter affecting the rights of either party to a patent which may have been called to his attention, unless the same shall have been previously disposed of by the commissioner. *Id.* No. 120; see *Id.* No. 116.

A second interference will not be declared upon a new application on the same invention filed by either party, nor will a decision be set aside after judgment, except in accordance with the principles governing the granting of new trials. *Id.* No. 121.

If at any time during the pendency of an interference the primary examiner discover new references, he may request a suspension of the interference for their consideration *ex parte* until their pertinency shall be determined, when the files and papers will be returned to the examiner of interferences and the interference dissolved or reinstated in accordance with such determination. *Id.* No. 122.

The primary examiner may request a suspension of an interference for the purpose of adding new parties; but no new parties will be added after the taking of testimony without the special order of the commissioner. *Id.* No. 123.

No amendments to the specification will be received during the pendency of an interference, except as provided in Rules 94, 104, 125. *Id.* No. 124.

When a part only of the claims of an application are involved in an interference, the applicant may withdraw from his application the claims adjudged not to interfere, and file a new application therefor, if the application can be legitimately divided, and if no more of the devices claimed in one is shown or described in the other than is necessary to an intelligent understanding of the invention claimed in the latter: Provided, That no claim shall be made in the second application, broad enough to include matter claimed in the first application as amended. *Id.* No. 125; see *Id.* No. 42.

When applications are declared to be in interference, the interfering parties will be permitted to see or obtain copies of the interfering claims, and of so much of the specifications as relate thereto, after the statements referred to in Rule 105 have been received and approved; but no information of an application will be furnished by the office to an opposing party, except as provided in Rules 97 and 102, until after the approval of such statement. *Id.* No. 126.

When it shall appear, on motion duly made, and upon satisfactory proof, that, by reason of the inability or refusal of the inventor to prosecute or defend an interference, or from other cause, the ends of justice shall require that an assignee of an undivided interest in the invention be permitted to prosecute or defend the same, the commissioner may so order. *Id.* No. 127.

121. Principles of Decision.

In an interference between an applicant and a patentee, the only question raised is whether the former was the prior inventor. *Warner v. Goodyear*, 1 *MacArthur Pat. Cas.* 60; *Burlew v. O'Neil*, *Id.* 168.

The jurisdiction of the commissioner in an interference is not limited to the naked question of priority; he may inquire into the patentability of the invention and determine questions relating to the public use and abandonment. *Hunt v. Howe*, 1 *MacArthur Pat. Cas.* 366.

Upon an objection, in interference proceedings, to a specification, as being vague and indefinite, the construction to be given to the specification should not be too strict and technical; if it communicates to the public the manner of carrying the invention into

effect, so that a skillful workman can carry into execution the plan of the inventor, it is sufficient. *Stephens v. Salisbury*, 1 *MacArthur Pat. Cas.* 379.

Where, in an interference proceeding, it appears that the idea or suggestion of the invention was communicated by one of the parties to the other, by whom it was practically applied, producing the desired result, the former is the sole inventor; and the latter can acquire no right to the invention by the failure of the real inventor to perfect it with due diligence. *Stearns v. Davis*, 1 *MacArthur Pat. Cas.* 696.

A decision upon the question of interference is necessary to confer jurisdiction upon the question of priority; and the jurisdictional matter must be first determined. *Bain v. Morse*, 1 *MacArthur Pat. Cas.* 90; *Stephenson v. Hoyt*, *Id.* 292.

An application for a patent may be rejected on the ground of interference, although the invention of the applicant may be a better and improved mode of accomplishing the object of the patented invention, if the former be a substantial interference with the principle of the latter. *Stephenson v. Hoyt*, 1 *MacArthur Pat. Cas.* 292.

122. *Effect of Commissioner's Decision.*

Even where an interference is claimed, and as against the parties to that hearing, the commissioner's decision is not conclusive. Upon reasoning and on authority the new patent granted after a hearing merely makes out a *prima facie* case for the successful applicant. *Union Paper Bag Machine Co. v. Crane*, 1 *Holmes*, 429; 6 *Pat. Off. Gaz.* 80; 1 *Bann. & A. Pat. Cas.* 494.

The decision of the patent-office upon an interference proceeding is sufficient to entitle the successful party, as against the defeated party or his privies, to a preliminary injunction upon the question of priority of invention; but the defeated party is not precluded from raising in another action the question of novelty. *Smith v. Halkvard*, 23 *Pat. Off. Gaz.* 1832; 16 *Fed. Rep'r*, 414.

An interference in the patent-office in which priority of invention was awarded against the patent in suit does not conclude the complainant from maintaining an action thereon, if the parties are not the same. *Perry v. Starrett*, 14 *Pat. Off. Gaz.* 599; 3 *Bann. & A. Pat. Cas.* 485

The decision of the commissioner on a question of interference

will be sustained in the courts, and a preliminary injunction granted according to the priority of right as declared by him, unless it is shown to have been manifestly wrong. *Pentlarge v. Beeston*, 14 *Blatchf.* 352 ; 3 *Bann. & A. Pat. Cas.* 142.

The decision of the patent-office in an interference suit as to the priority of a certain invention binds the assignees of the inventors and purchasers from them. *Peck, &c. Co. v. Lindsay*, 2 *Fed. Rep'r*, 688 ; 18 *Pat. Off. Gaz.* 63 ; 5 *Bann. & A. Pat. Cas.* 390.

The decision of the patent office in favor of one of the parties in interference proceedings is not conclusive as an adjudication upon the question of priority of invention between them, in a suit between them as interfering patents under Rev. Stat. § 4918. *Hubel v. Tucker*, 24 *Fed. Rep'r*, 701.

123. *Affidavits and Depositions.*

The commissioner of patents may establish rules for taking affidavits and depositions required in cases pending in the patent-office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides. *Rev. Stat.* § 4905.

The following rules have been established for taking and transmitting testimony in extensions, interferences, and other contested cases :

1. Before the depositions of witnesses are taken by either party due notice shall be given to the opposite party, as hereinafter provided, of the time and place when and where the depositions will be taken, of the cause or matter in which they are to be used, and of the names and residences of the witnesses to be examined, so that the opposite party shall have full opportunity, either in person or by attorney, to cross-examine the witnesses. If the opposite party shall attend the examination of witnesses not named in the notice, and shall either cross-examine such witnesses or fail to object to their examination, he shall be deemed to have waived any objection to their examination based on want of notice thereof. Neither party shall take testimony in more than one place at the same time, or so nearly at the same time as not to allow reasonable time to travel from one place of examination to the other.

2. The notice for taking testimony or for motions must be served (unless otherwise stipulated in an instrument in writing filed in the case) upon the attorney of record, if there be one, or, if there be no attorney of record, then upon the adverse party; and it must give the opposite party reasonable time to reach the place of examination. Such service may be made by delivering a copy of the notice to the adverse party or attorney, by leaving a copy at the usual place of business of the party or attorney with some one in the employment of such party or attorney, or by leaving a copy at the party's usual place of residence with a member of his family, or by transmission by registered letter, or by express, or when it shall be shown, to the satisfaction of the commissioner, that neither of the other modes of service herein prescribed is practicable, by publication in the *Official Gazette*; and such notice shall, with sworn proof of the fact, time, and mode of service thereof, be attached to the deposition or depositions, whether the opposing party shall have cross-examined or not.

3. Each witness before testifying shall be duly sworn according to law by the officer before whom his deposition shall be taken. The depositions shall be carefully read over by the witness, or by the officer in his hearing, and shall then be subscribed by the witness, in the presence of the officer. The officer shall annex to the deposition his certificate showing, (1) the due administration of the oath by the officer to the witness before the commencement of his testimony; (2) the name of the person by whom the testimony was written out, and the fact that, if not written by the officer, it was written in his presence; (3) the presence or absence of the adverse party; (4) the place, day and hour of commencing and taking the depositions; and (5) the fact that the officer was not connected, by blood or marriage, with either of the parties, nor interested directly or indirectly in the matter in controversy. The officer shall sign the certificate and affix thereto his seal of office, if he have such seal. He shall then, without delay, securely seal up all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate, giving the title of the case, the name of each witness, and the date of sealing, address the package, and forward the same to the commissioner of patents. If the weight or bulk of an exhibit shall exclude it from the mails, it shall be authenticated by the officer and transmitted in a separate package, marked and addressed as above provided.

4. In cases of extension, where no opposition shall be made, *ex*

parte testimony will be received from the applicant; and such testimony as may have been taken by the applicant prior to notice of opposition will be received unless taken within thirty days after filing the petition for the extension. But upon receiving notice of opposition, the applicant shall immediately give notice to the opposing party or parties of the names and residences of the witnesses whose testimony shall have been thus taken.

5. If either party shall be unable to procure the testimony of a witness within the time limited, any motion which he may make for an extension of his time must be accompanied by a statement, under oath, of the cause of such inability, the name of such witness, the facts expected to be proved by him, the steps which have been taken to procure said testimony, and the dates at which efforts have been made to procure it.

6. When a party relies upon a caveat to establish the date of his invention, the caveat itself, or a certified copy thereof, must be filed in evidence, with due notice to the opposite party.

7. Upon notice given to the opposite party before the closing of the testimony, any official record, and any special matter contained in a printed publication, if competent evidence and pertinent to the issue, may be used as evidence at the hearing. *Rules of Prac.* No. 150.

The pages of each deposition must be numbered consecutively, and the name of the witness plainly and conspicuously written at the top of each page. The testimony must be taken upon legal-cap or foolscap paper, with a wide margin on the left-hand side of the page, and with the writing on one side only of the sheet. *Id.* No. 151.

The testimony will be taken in answer to interrogatories, with the questions and answers committed to writing in their regular order by the officer, or, in his presence, by some person not interested in the case, either as a party thereto or as attorney. But, with the written consent of the parties, the depositions may be written out by other persons in the presence of the officer. No officer who is connected by blood or marriage with either of the parties, or interested, directly or indirectly, in the matter in controversy, either as counsel, attorney, agent, or otherwise, is competent to take depositions, unless with the written consent of all the parties. *Id.* 152.

By leave of the commissioner, first obtained, testimony may be taken in foreign countries:

1. Such permission will be granted only upon motion duly made. *Id.* No. 153 ; See *Id.* No. 149.

The motion must designate a place for the examination of the witnesses, at which an officer duly qualified to take testimony under the laws of the United States in a foreign country shall reside, and it must be accompanied by a statement, under oath, that the motion is made in good faith, and not for purposes of delay or of vexing or harassing any party to the case ; it must also set forth the names of the witnesses, the particular facts to which it is expected each will testify, and the grounds on which is based the belief that each will so testify.

2. It must appear that the testimony desired is material and competent, and that it cannot be taken in this country at all, or cannot be taken here without hardship and injury to the moving party greatly exceeding that to which the opposite party will be exposed by the taking of such testimony abroad.

3. Upon the granting of such motion, a time will be set within which the moving party shall file in duplicate the interrogatories to be propounded to each witness and serve a copy of the same upon each adverse party, who may, within a designated time, file, in duplicate, cross-interrogatories. Objections to any of the interrogatories may be filed at any time before the depositions are taken, and will be considered and determined upon the hearing of the case.

4. As soon as the interrogatories and cross-interrogatories are decided to be in proper form, the commissioner will cause them to be forwarded to the proper officer, with the request that, upon payment of, or satisfactory security for, his official fees, he notify the witnesses named to appear before him within a designated time and make answer thereto under oath ; and that he reduce their answers to writing, and transmit the same, under his official seal and signature, to the commissioner of patents, with the certificate prescribed in Rule 150, subd. 3.

5. By stipulation of the parties the requirements of paragraph 3, as to written interrogatories and cross-interrogatories may be dispensed with, and the testimony may be taken before the proper officer upon oral interrogatories by the parties or their agents.

6. Unless false swearing in the giving of such testimony before the officer taking it shall be punishable as perjury, under the laws of the foreign state where it shall be taken, it will not stand on the same footing, in the patent-office, as testimony duly taken in the

United States ; but its weight in each case will be determined by the tribunal having jurisdiction of such case.

No evidence touching the matter at issue will be considered on the hearing which shall not have been taken and filed in compliance with these rules. But no notice will be taken of any merely formal or technical objection which shall not appear to have wrought a substantial injury to the party raising it ; and in case of such injury it must be made to appear that, as soon as the party became aware of the ground of objection, he gave notice thereof to the office, and also to the opposite party, informing him at the same time that, unless it should be removed, he should urge his objection at the hearing. This rule is not to be so construed as to modify established rules of evidence, which will be applied strictly in all practice before the office. *Id.* No. 154.

The law requires the clerks of the various courts of the United States to issue subpoenas to secure the attendance of witnesses whose depositions are desired as evidence in contested cases in the patent-office. *Id.* No. 155.

After testimony is filed in the office it may be inspected by any party to the case, but it cannot be withdrawn for the purpose of printing. It may be printed by some one specially designated by the office for that purpose, under proper restrictions. *Id.* No. 156.

Six or more printed copies of the testimony must be furnished—five for the use of the office, and one for the use of each of the opposing parties. The statement required by Rule 105 must be printed as a part of the record. These copies must be filed not less than one week before the day of hearing. They will have wide margins, with the names of the witnesses at the top of the pages over their testimony, and will contain indexes with the names of all witnesses, and references to the pages where their testimony may be found, and also to the pages where copies of papers and documents introduced as exhibits are shown. Printing can only be dispensed with on special application based upon satisfactory reasons, in which case manuscript copies must be furnished—one for the office and one for each adverse party. *Id.* No. 157.

It is desirable that arguments and briefs in all contested cases should be submitted in printed form, and filed before the hearing. If either party fail to comply with this regulation, no extension of time will be granted for the purpose, except upon consent of the adverse parties. *Id.* 158.

Rules to govern the taking and transmission of evidence, made

by the commissioner in conformity to statutory provisions, have all the binding force of statutes; both as regards the commissioner himself and parties litigant before him. *Arnold v. Bishop*, 1 *MacArthur Pat. Cas.* 27. And no notice of the taking of testimony before the examiner is waived by an appearance and cross-examination. *Ib.*

An objection to the formal sufficiency of a deposition must be raised at the hearing before the commissioner or it is unavailable on appeal. But the deposition may be considered on an application for an adjournment, although too informal to be admissible on final hearing. *Smith v. Flickmyer*, 1 *MacArthur Pat. Cas.* 46.

Informality in the caption of a deposition is not waived by a notice to have the deposition produced before the commissioner for inspection. *Perry v. Cornell*, 1 *MacArthur Pat. Cas.* 66.

Depositions taken in an interference may be used in a subsequent interference, when the issue is the same and the parties or their predecessors in title are the same. *McCormick v. Howard*, 1 *MacArthur Pat. Cas.* 238; *Carter v. Carter*, *Id.* 388.

Depositions used upon the original hearing before the commissioner may be used upon a re-hearing against a new party who came in subsequently to the taking of them. *Carter v. Carter*, 1 *MacArthur Pat. Cas.* 388.

124. *Subpœnas to Witnesses.*

The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the patent-office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits, at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him. *Rev. Stat.* § 4906