

A COLLECTION
OF
PATENT CASES.

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Aug 27

A COLLECTION
OF
PATENT CASES

CRITICISED, EXPLAINED, OVERRULED, OR
OTHERWISE LIMITED

BY SUBSEQUENT DECISIONS

OF

THE FEDERAL COURTS

GIVING A SHORT STATEMENT OF THE
POINT CRITICISED.

received
BY SIMON G. CROSWELL.

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BOSTON:
LITTLE, BROWN, AND COMPANY.
1888.

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Rec. Jan. 9, 1888

UNIVERSITY PRESS:
JOHN WILSON AND SON, CAMBRIDGE.

P R E F A C E.

THE object of this book is to present a view of the criticisms or explanations of the various patent decisions which have been made in subsequent decisions by the various judges of the federal courts. In order to do this, the cases criticised or explained have been placed in alphabetical order, as is generally done in collections of cases overruled, criticised, explained, etc., and the names of the parties printed in heavy-faced type. The date of the case, the court in which it was decided, and the judge giving the opinion are added to give a clearer comprehension of the effect of the decision. Following each of these principal cases come in chronological order the decisions in which the principal case has been discussed. In selecting these later decisions, the aim has been to give only those which throw some light on the real effect of the principal decision, and with this view mere citations have been avoided; but every patent case of importance in the federal courts in which the judge has said anything about a previous case, beyond merely citing it, has been, it is believed, included in the collection. The cases thus selected range from the earliest reports of patent causes in the federal

courts down to the 122 United States and the 30 Federal Reporter, inclusive, and have been collected from the United States Supreme Court Reports, the early Circuit Court Reports, the Reports of Patent Cases by Banning & Arden, and by Fisher and the Federal Reporters.

The intention has been to give a statement of the point discussed sufficiently full to enable the reader to understand in what particular the leading case was limited or affirmed or overruled, without referring to the reports. The advantage of this over a mere table of overruled cases is obvious, in that it enables the reader to select the cases criticised on the point he wishes to study, and to avoid the loss of time caused by examining in the reports many cases which do not bear upon his topic. The collection may also prove useful in the argument of a case in court, suggesting authorities to support the position taken by counsel, or showing decisions which weaken the effect of the cases cited by the opposing counsel, or explaining the view of the courts as to the effect of the various decisions.

S. G. C.

Boston, November, 1887.

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ABBREVIATIONS.

United States Supreme Court Reports	U. S.
Federal Reporter	F. R.
Banning & Arden's Patent Reports	Ban. & A.
Fisher's Patent Reports	Fisher.
Blatchford's Circuit Court Reports	Blatchf. C. C.
Wallace's Supreme Court Reports	Wall.
Official Gazette of the Patent Office	O. G.
Howard's Supreme Court Reports	How.
Wheaton's Supreme Court Reports	Wheat.
Peters's Supreme Court Reports	Pet.
Gallison's Circuit Court Reports	Gall.
Gilpin's Circuit Court Reports	Gilp.
Woodbury & Minot's Circuit Court Reports	W. & M.

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PATENT CASES

CRITICISED AND EXPLAINED

IN SUBSEQUENT CASES

IN THE FEDERAL COURTS.

A.

Adams v. Burke, 17 Wall. 453, 1873, Supr. Court, Miller, J.

Is cited and explained in *Dorsey Revolv. Harv. Rake Co. v. Bradley Manuf. Co.*, 12 Blatchf. C. C. 204, 1874, North. Dist. N. Y., Woodruff, J.; s. c. 1 Ban. & A. 332. This latter case showed a license to build reapers and to make such machines as should be required for use in certain States, and Woodruff, J., held that this license restricted the use of the machines to those States, stating that *Adams v. Burke* is not in conflict with this decision, and referring on page 208 to *Adams v. Burke* as a cautiously-guarded decision, carefully limited to the precise case under consideration: and he queries whether that case supports the doctrine that when a mere licensee to make and sell within specified limits, sells the patented machine to another, it passes from under the dominion of the patent, and may be used anywhere, even if that be true when the machine

is sold by one who has the right to make, use, and sell the machine. He also states that *Adams v. Burke* is a case where no qualification of the right to use the sold machine was expressed or inferable from the nature of the case.

Is cited and quoted in *Hatch v. Adams*, 22 F. R. 436, 1884, East. Dist. Penn., McKennan, J., as explaining the scope of decisions on the question how far an unrestricted sale of a patented article carries with it a right to its unlimited use. *Adams v. Burke*, as reported in 4 Fisher, 392, is explained in *Hatch v. Adams* as involving only the right to use and not to sell patented articles beyond a limited territory.

Is interpreted in *Hobbie v. Smith*, 27 F. R. 662, 1886, North. Dist. N. Y., Coxe, J., to have decided that when a patented article is rightfully bought, it can thereafter be used anywhere.

“The right to sell and the right to use are each substantive rights, and may be granted or conferred separately; but in the essential nature of things when the patentee or the person having his rights sells a machine or instrument whose sole value is in its use, he receives the consideration for its use, and he parts with the right to restrict that use.” Quoted in *Montross v. Mubie*, 30 F. R. 235, 1887, South. Dist. N. Y., Brown, J.

Is considered at length in *Hatch v. Hall*, 30 F. R. 614, 1887, South. Dist. N. Y., Wheeler, J., and considered to have held, against a strong dissent, that a purchaser of an article for mere use, from one having a territorial right, did not infringe against the owner of other territory by using it there. The case of *Adams v. Burke* was said, in *Hatch v. Hall*, to have been carefully limited to what was necessary to be decided, and to fall far short of holding that the purchaser from the owner of the territorial right within the territory could sell outside

without infringing. *Adams v. Burke* is admitted to be an authority in *Hatch v. Hull* as far as it goes, but is limited so as to leave to the defendant the right to sell within his territory for mere use outside.

Adams v. Joliet Manuf. Co., 12 O. G. 93, 1877, North. Dist. Ill., Blodgett, J.

“A change of location of a part in a combination, when there is no new function performed by the changed member in its new location, will not evade a patent.” Quoted in *Knox v. Gt. West. Quicksilver Mining Co.*, 4 Ban. & A. 32, 1878, Dist. Cal., Sawyer, J.

Adams v. Jones, 1 Fisher, 527, 1859, West. Dist. Penn., Grier, J.

Is explained in *Bevin v. East Hampton Bell Co.*, 9 Blatchf. C. C. 57, 1871, Dist. Conn., Shipman, J., as deciding that an application for an invention is conclusive evidence against an abandonment of an invention only when the application remains on file.

The opinion of Mr. Justice Grier is quoted from in *Planing Machine Co. v. Keith*, 101 U. S. 485, 1879, Strong, J., that negligence in prosecuting an inventor's rights forfeits them; but involuntary delay, caused by no fault of the inventor, does not affect his rights.

Agawam Co. v. Jordan, 7 Wall. 583, 1868, Supr. Court, Clifford, J.

Is said in the *Fire Extinguisher Case*, 21 F. R. 42, 1884, Dist. Md., Morris, J., to have been a case where the Supreme Court sustained an extension of a patent by special act of Congress.

Ager v. Murray, 105 U. S. 126, 1882, Supr. Court, Gray, J.

Is said in *Gorrell v. Dickson*, 26 F. R. 454, 1886, West. Dist. Penn., Acheson, J., to establish the right of a creditor to bring a bill in equity, to subject a patent right to the payment of the plaintiff's judgment debt.

Allen v. Mayor of New York, 17 Blatchf. C. C. 350, 1879, South. Dist. N. Y., Wheeler, J.

Said in *Brickill v. New York*, 5 Ban. & A. 547, 1880, South. Dist. N. Y., Wheeler, J., to decide that a fire department is a mere agency of the city, and makes no such profits for itself as render it accountable for infringement of a patent.

American Bell Tel. Co. v. Dolbear, 15 F. R. 448, 1883, Dist. Mass., Gray, J.

Is said in *Morley Sewing Machine Co. v. Lancaster*, 23 F. R. 346, 1885, Dist. Mass., Colt, J., to decide that the Bell patent embraced a process, and was not limited to any form of apparatus.

American Bell Tel. Co. v. Spencer, 8 F. R. 509, 1881, Dist. Mass., Lowell, J.

Is stated in *American Bell Tel. Co. v. Dolbear*, 15 F. R. 449, 1883, Dist. Mass., Gray, J., to have decided that Bell is the first inventor of a speaking-telephone.

Is said in *American Bell Tel. Co. v. Dolbear*, 17 F. R. 605, 1883, Dist. Mass., Lowell, J., to have decided that Reis had not described a telephone which anticipated Bell's invention.

American Diamond Rock Boring Co. v. Rutland Marble Co., 2 F. R. 355, 1880, Dist. Vt., Wheeler, J.

Is followed in *Reay v. Rau*, 15 F. R. 749, 1883, South. Dist. N. Y., Shipman, J.

Is cited in *New York Belting & Packing Co. v. MaGowan*, 27 F. R. 112, 1886, Dist. N. J., Nixon, J., as to the advisability of granting an injunction after the expiration of a patent.

American Diamond Rock Boring Co. v. Sheldon, 1 F. R. 870, 1880, Dist. Vt., Wheeler, J.

Is distinguished in *Reay v. Rau*, 15 F. R. 749, 1883, South. Dist. N. Y., Shipman, J.

American Hide, &c. Dressing Co. v. American Tool, &c. Co., 1 Holmes, 503, 1870, Dist. Mass., Shepley, J.

Is cited in *Henry v. Francestown Soapstone Stove Co.*, 5 Ban. & A. 110, 1880, Dist. N. H., Lowell, J., as holding that the right of an inventor to a patent is lost by sale of the invented article more than two years previous to the application for a patent, although the thing when sold was not perfect in a mechanical sense, but only in that it embodied a complete invention in a form which would be operative.

American Wood Paper Co. v. Fibre Disinteg. Co., 3 Fisher, 363, 1868, East. Dist. N. Y., Benedict, J.

Followed in *Goodyear Dent. Vul. Co. v. Willis*, 1 Ban. & A. 571, 1874, East. Dist. Mich., Emmons, J., as to the conclusive effect of a previous decision upon the same points in regard to a patent in another circuit.

Andrews v. Carman, 13 Blatchf. C. C. 307, 1876, East. Dist. N. Y., Benedict, J.

The construction given to the Green reissued patent *4,372, for boring wells, is examined at length and sustained in *Andrews v. Cross*, 8 F. R. 277, 1881, North. Dist. N. Y., Blatchford, J.

The construction given the Driven Wells patent by Benedict, J., is adopted in *Eames v. Andrews*, 122 U. S. 53, 1886, Supr. Court, Matthews, J.

Quoted from in *Beedle v. Bennett*, 122 U. S. 76, 77, 1886, Supr. Court, Matthews, J.

Andrews v. Cross, 19 Blatchf. 294, 305, 1881, North. Dist. N. Y., Blatchford, J.

The comments of Mr. Justice Blatchford in this case upon the Driven Wells patent are quoted at length in *Eames v. Andrews*, 122 U. S. 55, 1886, Supr. Court, Matthews, J.

Quoted from in *Beedle v. Bennett*, 122 U. S. 78, 1886, Supr. Court, Matthews, J.

Andrews v. Hovey, 5 McCrary, C. C. 195, 1883, South. Dist. Iowa, Shiras, J.

The comments of Shiras, J., upon the Driven Wells patent in this case are given at length and refuted in *Eames v. Andrews*, 122 U. S. 56, 1886, Supr. Court, Matthews, J.

Andrews v. Wright, 13 O. G. 969, 1877, Dist. Minn., Nelson, J.

The construction given to the Green reissued patent, *4,372, for driven wells in the above case, is sustained in *Andrews v. Cross*, 8 F. R. 278, 1881, North. Dist. N. Y., Blatchford, J.

Anthony v. Carroll, 2 Ban. & A. 195, 1875, Dist. Mass., Shepley, J.

See *Collins v. Peebles*.

Arnheim v. Finster, 24 F. R. 276, 1885, South. Dist. N. Y., Wheeler, J.

Is said in *Boland v. Thompson*, 26 F. R. 635, 1886, South. Dist. N. Y., Coxe, J., to be authority for the proposition that when a claim has been examined and rejected by the commissioner, the rejection acquiesced in by the patentee or his solicitor, and the patent reissued without the claim, there is no inadvertence, accident, or mistake which will entitle the patentee to a reissue.

Ashcroft v. Boston & Lowell R. R. Co., 1 Holmes, 366, 1874, Dist. Mass., Shepley, J.; s. c. 97 U. S. 189, 1877, Supr. Court, Clifford, J.

Is said in *Consolidated Safety Valve Co. v. Crosby Steam Gauge Co.*, 7 F. R. 769, 1881, Dist. Mass., Lowell, J., to have upheld the validity of the Richardson valve.

Ashcroft v. Walworth, 1 Holmes, 152, 1872, Dist. Mass., Shepley, J.

Decides that the title of an insolvent debtor to a patent right does not pass to his assignee in insolvency by an assignment of his property made by a judge under a State insolvent law, because the conveyance is not a written instrument signed by the owner of the patent, as the patent law requires. This decision is approved in *Gordon v. Anthony*, 4 Ban. & A. 262, 1879, South. Dist. N. Y., Blatchford, J.

In *Ager v. Murray*, 105 U. S. 131, 1881, Supr. Court, Grier, J., calls attention to the fact that Shepley, J., in *Ashcroft v. Walworth*, clearly intimated that the debtor might be compelled by the State court to execute a conveyance of the right.

Atkinson v. Boardman.

A manuscript decision in this case by Nelson, J., was produced in *Re Squire*, 3 Ban. & A. 136, 1877, East. Dist. Mo., Treat, J., to the point that the acts of 1836, § 16, and 1839, § 10, allow one who files a bill in equity to review the decision of the commissioner of patents in a case of anticipation, to introduce testimony additional to that which was taken before the commissioner.

Atlantic Works v. Brady, 107 U. S. 192, 1883, Supr. Court, Bradley, J.

Cited in *Bradley, &c. Manuf. Co. v. Chas. Parker Co.*, 17 F. R. 241, 1883, Dist. Conn., Shipman, J., as being one of the late decisions of the Supreme Court holding that the question of patentability must be examined with great care.

The opinion of Mr. Justice Bradley in this case is said in *Morris v. McMillin*, 112 U. S. 248, 1884, Supr. Court, Woods, J., to illustrate the grounds of decision in the latter case to the effect that not every improvement in a machine deserves a patent.

“ It is not the object of the patent laws to grant a monopoly for every trifling device which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures.” Quoted in *Thompson v. Boisselier*, 114 U. S. 12, 1884, Supr. Court, Blatchford, J.

Is stated in *Nicodemus v. Frazier*, 19 F. R. 261, 1884, Dist. Md., Morris, J., to have declared very plainly that it is not the design of the patent laws to grant a monopoly of the improvements and adaptations which from time to time would occur, as the demand for them arose, to any *skilled mechanic or operator*.

Is cited in *Calkins v. Oshkosh Carriage Co.*, 27 F. R. 298, 1886, East. Dist. Wis., Dyer, J., to the same effect.

Is said in *Leonard v. Lovell*, 29 F. R. 314, 1886, West. Dist. Mich., Severens, J., to be an especially valuable and prominent case, in which Bradley, J., explains in clear and admirable language the intent and purpose of the patent statutes.

Attorney-General v. Rumford Chemical Works, 9 O. G. 1062, 1876, Dist. R. I., Shepley, J.

Is cited in *New York, &c. Coffee Polishing Co. v. New York Coffee Polishing Co.*, 20 Blatchf. C. C. 174, 1881, East. Dist. N. Y., Benedict, J., on the question whether the Attorney-General has power to institute a proceeding in the name of the United States to annul a patent for want of novelty.

B.

Badische Anilin & Soda Fabrik v. Hamilton Manuf. Co., 13 O. G. 273, 1878, Dist. Mass., Shepley, J.

The decision in this case was examined in *De Florez v. Reynolds*, 8 F. R. 444, 1880, South. Dist. N. Y., Blatchford, J.; s. c. 5 Ban. & A. 151, and said to be that § 25 of the act of July, 1870 (U. S. R. S. § 4887), which provides that a United States patent shall expire with the shortest foreign prior patent, if any, for the same invention does not apply to a reissue in April, 1871, of a patent originally granted in October, 1869, the foreign patent having been taken in June, 1869.

Ball v. Langles, 102 U. S. 128, 1880, Supr. Court, Strong, J.

Cited in *Wilson v. Coon*, 6 F. R. 621, 1880, South. Dist. N. Y., Blatchford, J., upon the question of the validity of reissues.

Said in *Garneau v. Dozier*, 102 U. S. 232, 1880, Supr. Court, Strong, J. (a suit on the same Ball patent), to have decided the invalidity of the reissued Ball patent as embracing more than the original specification and drawing, or model.

Cited in *Washburn, &c. Manuf. Co. v. Haish*, 7 F. R. 913, 1881, North. Dist. Ill., Drummond, J., as assisting in interpreting the decision in *Swain Turbine Manuf. Co. v. Ladd* (q. v.).

Bantz v. Frantz, 105 U. S. 160, 1882, Supr. Court, Woods, J.

Followed in the decision of *Turrell v. Bradford*, 15 F. R. 810, 1883, South. Dist. N. Y., Shipman, J.

Barnard v. Gibson, 7 How. 650, 1849, Supr. Court, McLean, J.

Referred to in *Reeves v. Keystone Bridge Co.*, 2 Ban. & A. 257, 1876, East. Dist. Penn., McKennan, J.,

as deciding that a decree making an injunction perpetual, and sending the case to a master to ascertain damages, is not final but interlocutory.

Cited in *Hoe v. Boston Daily Advertiser Co.*, 14 F. R. 916, 1883, Dist. Mass., Lowell, J., to show that an injunction is not always granted on final hearing, that power being in the discretion of the court.

Barrett v. Hall, 1 Mason, 447, 1818, Dist. Mass., Story, J.

Is explained in *Wyeth v. Stone*, 1 Story, 290, 1840, Dist. Mass., Story, J., as intended to decide that one patent under the general patent act cannot include divers distinct and independent inventions having no common connection with each other, nor any common purpose.

It is said in *Emerson v. Hogg*, 2 Blatchf. C. C. 7, 1845, South. Dist. N. Y., Betts, J., that doubts were raised in the former case whether, under the general patent law, improvements on different machines can be comprehended in the same patent, so as to give a right to the exclusive use of the several machines separately as well as in combination.

“Where a combination of machinery already exists up to a certain point, and the patentee makes an addition or improvement to the machinery, he must confine his patent to the improvement. It is impossible that any person can be at the same time the joint and sole inventor of the same invention.” Quoted in *Hopkins, &c. Manuf. Co. v. Corbin*, 3 Ban. & A. 203, 1878, Dist. Conn., Shipman, J.

Barton v. Barbour, 104 U. S. 126, 1881; Supr. Court, Woods, J.

Cited in *Curran v. Craig*, 22 F. R. 102, 1884, East. Dist. Mo., Treat, J., on the question whether a receiver appointed by the State court may be sued in the federal court.

Battin v. Taggert, 17 How. 74, 1854, Supr. Court, McLean, J.

This case is briefly stated, and the subject of the validity of reissues considered, in *Wilson v. Coon*, 6 F. R. 618, 1880, South. Dist. N. Y., Blatchford, J.

Notwithstanding what was said in *Battin v. Taggert*, *Heald v. Rice*, 104 U. S. 749, 1881, Supr. Court, Matthews, J., decides that the question of the validity of a reissue so far as it is a question whether the reissue is for the same invention as the original patent, is to be decided by the court upon inspection of the patents, if this can be done without extrinsic evidence to explain the terms of the art or apply the description to the subject matter. In other words, if the court, looking at the patents, can say that the inventions are not the same, the question of identity is one of pure construction, and is for the court.

Is said in *Smith v. Merriam*, 6 F. R. 719, 1881, Dist. Mass., Lowell, J., to be perhaps inconsistent with *Leggett v. Avery*, 101 U. S. 256 (*q. v.*) and to be perhaps overruled by that case.

Is said in *Kells v. McKenzie*, 9 F. R. 286, 1881, East. Dist. Mich., Brown, J., to have been generally accepted by patentees as authority for the proposition that a patent may be reissued so as to cover everything suggested in the drawings of the original patent, although the claims and the introductory statement of the invention may have had reference solely to another portion of the machine, however misleading this might be to other people as to what the inventor claimed as his invention.

Is said in *Vermont Farm Machine Co. v. Marble*, 19 F. R. 307, 1884, Dist. Vt., Wheeler, J., to appear to have expressly adjudged, upon the statute now in force, that an inventor might have a patent for an invention described in a prior patent to himself.

Bean v. Smallwood, 2 Story, 408, 1843, First Circuit, Story, J.

“Now I take it to be clear that a machine or apparatus, or other mechanical contrivance, in order to give the party a claim to a patent therefor, must in itself be substantially new. If it is old and well known, and applied only to a new purpose, that does not make it patentable.” Story, J., quoted in *North Western Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 1 Ban. & A. 197, 1874, East. Dist. Penn., McKennan, J., to the point that the application of an old mechanism to an old use to which it had not been before applied, is not patentable.

Opinion of Story, J. “The thing itself which is patented must be new, and not the mere application of it to a new purpose or object.” Quoted in *Gottfried v. Crescent Brewing Co.*, 9 F. R. 766, 1881, Dist. Ind., Gresham, J.

Beebe v. Russell, 19 How. 285, 1856, Supr. Court, Wayne, J.

Language of Wayne, J., quoted in *Rumford Chemical Works v. Hecker*, 2 Ban. & A. 359, 1876, Dist. N. J., Nixon, J., to the effect that a final decree is one that decides the whole merits of a cause, and leaves no further questions or directions for the future judgment of the court.

Beecher Manuf. Co. v. Atwater Manuf. Co., 114 U. S. 523, 1885, Supr. Court, Gray, J.

The principle of this case as to the non-patentability of combinations of old elements was followed in *Thatcher Heating Co. v. Burtis*, 121 U. S. 295, 1886, Supr. Court, Matthews, J.

Bell v. Daniels, 1 Fisher, 377, 1858, South. Dist. Ohio, Leavitt, J.

Said in *Goodyear Dental Vulcanite Co. v. Willis*, 1 Ban. & A. 582, 1874, East. Dist. Mich., Emmons, J.,

to support the proposition that when successive applications are made in a procurement of a patent, and when there is no proof of actual abandonment, the subsequent application will be decided a continuation of the first.

Cited in *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 501, 1876, Supr. Court, Strong, J., as deciding that filing a second petition for a patent, after the first one has been rejected, is not to be regarded as severing the second from the first, or depriving the applicant of any advantage he would have enjoyed, had the patent been granted without a renewal of the application.

Bennet v. Fowler, 8 Wall. 445, 1869, Supr. Court, Nelson, J.

It is said in *M Kay v. Dibert*, 5 F. R. 590, 1880, Dist. N. J., Nixon, J., that it is a fair inference, from what was decided in the former case, that the courts have no absolute control over the head of the patent office in the exercise of his discretion whether a given invention or improvement shall be embraced in one, two, or more letters patent.

This case is cited in *Spring v. Domestic Sewing Machine Co.*, 9 F. R. 509, 1881, Dist. N. J., Nixon, J., as governing the decision of the latter case, upon the point, that slight evidence of infringement is sufficient for the plaintiff, if the defendant offers no proof on this point.

“It is difficult, perhaps impossible, to lay down any general rule by which to determine when a given invention or improvement shall be embraced in one, two, or more patents. Some discretion must necessarily be left on this subject to the head of the patent office. It is often a nice and perplexing question.” Quoted in *Sessions v. Romadka*, 21 F. R. 131, 1884, East. Dist. Wis., Dyer, J.

Benton v. Woolsey, 12 Pet. 27, 1838, Supr. Court, Taney, C. J.

Was a case where information was filed by the district attorney in the behalf of the United States. In absence of objection, the court thought the real party might be considered to be the United States, but this course is rejected in *Attorney-General v. Rumford Chemical Works*, 2 Ban. & A. 314, 1876, Dist. R. I., Shepley, J., and the information in the name of G. H. Williams, as he is Attorney-General of the United States, was rejected on demurrer. The information should be in the name and behalf of the United States.

Bevin v. East Hampton Bell Co., 9 Blatchf. C. C. 50, 1871, Dist. Conn., Shipman, J.

Cited in *Weston v. White*, 2 Ban. & A. 368, 1876, Dist. Conn., Shipman, J., as limiting the decision in *Godfrey v. Eames*, 1 Wall. 317 (*q. v.*), by saying that the Supreme Court had not intended to decide that every subsequent application for a patent should be decreed, in judgment of law, to relate back to the first, whatever the interval of time or the intervening acts of the applicant between them.

Birdsall v. Coolidge, 93 U. S. 64, 1876, Supr. Court, Clifford, J.

The court in *Locomotive Engine, &c. Co. v. Penn. R. R. Co.*, 5 Ban. & A. 518, 1880, East. Dist. Penn., Strong, J., relies upon the former case as fixing the proper standard for estimating damages, whether in actions at law or in equity, to be a fixed royalty established by the owner of the patent.

Decided after the act of 1870; is quoted from in *Root v. Railway Co.*, 105 U. S. 201, 1881, Supr. Court, Matthews, J., to the effect that since that statute, gains and profits are still the proper measure of damages in

equity suits, except in cases where the injury sustained by the infringement is plainly greater than the aggregate of what was made by the infringer; in that case the plaintiff may also have his damages. This case was urged upon the court in *Root v. Railway Co.*, as deciding that an infringer is a trustee of profits for the owner of the patent, and that a court of equity will always compel him to account, even after the expiration of the patent; but this view was rejected by the court, explaining that the expressions of Clifford, J., in the former case as to an infringer being a trustee, referred only to the rule as to measure of damages, and not to the jurisdiction of the court in equity.

Is quoted from in *Westcott v. Rude*, 19 F. R. 834, 1884, Dist. Ind., Woods, J., to the effect that no rule of damages can be prescribed which can apply to all cases. If the patented machine has been used a short time by the infringer, and only to a limited extent, the jury should find less than the license fee.

Is said in *Simpson v. Davis*, 22 F. R. 445, 1884, East. Dist. N. Y., Benedict, J., to hold that when it appears in a case in equity that the defendant's profits, derived from the use of the plaintiff's invention, do not amount to so much as the plaintiff's damages arising from the infringement, the court may add to the amount of the defendant's profits a sum sufficient to make the amount awarded by the decree equal to the plaintiff's damages.

Is said in *Stutz v. Armstrong*, 25 F. R. 148, 1885, West. Dist. Penn., Acheson, J., to hold that, although an established royalty is the measure of damages generally in an action at law, yet, where the infringement is a limited use of the patented machine for a brief period, that measure should not be applied arbitrarily and without qualification.

Birdsell v. Hagarstown Agricultural Implement Manuf. Co., 1 Hughes, 59, 1877, Dist. Ind., Bond and Giles, J.J.

Is said in *Allis v. Storrell*, 16 F. R. 788, 1883, East. Dist. Wis., Dyer, J., to have decided that a court of equity would enjoin the owner of the patent from prosecuting suits against the vendees of an infringer when he already has suit against the infringer, who is financially capable of satisfying any decree against him for damages and profits.

Birdsell v. McDonald, 6 O. G. 682, 1874, North. Dist. N. Y., Swayne, J.

Is cited in *Stilwell, &c. Manuf. Co. v. Cincinnati Gas-light, &c. Co.*, 1 Ban. & A. 614, 1875, South. Dist. Ohio, Swing, J., as giving the true rule as to aggregations.

Is said in *Henry v. Francestown Soapstone Stone Co.*, 5 Ban. & A., 111, 1880, Dist. N. H., Lowell, J., to be a case where the court held that the neglect of the inventor's solicitors to file an application for a patent was not evidence of the inventor's abandonment of his invention.

Birdsell v. Perego, 5 Blatchf. C. C. 251, 1865, North. Dist. N. Y., Hall, J.

The court, in *National Manuf. Co. v. Meyers*, 7 F. R. 357, 1881, South. Dist. Ohio, Swing, J., examines this case with reference to its citation in Bump on Patent Law, page 140, as authority that the defence of the invalidity of a patent and a license are inconsistent, and explains the case of *Birdsell v. Perego* as an action upon a contract for a license, to enforce the provisions of the contract, thereby creating an estoppel. The court says that *Birdsell v. Perego* is not an authority that the invalidity of a patent is an inconsistent defence to that of a license.

Is stated at length in *Hubbell v. DeLand*, 14 F. R. 472, 1882, East. Dist. Wis., Dyer, J., and held not to be an

authority as to the practice of filing special pleas when the same matter is given in evidence under the general issue, but to decide only that the pleas in that case presented no defence.

Birdsell v. Shaliol, 112 U. S. 487, 1884, Supr. Court, Gray, J.

“An infringer does not by paying damages for making and using a machine in infringement of a patent, acquire any right himself to the future use of the machine. On the contrary, he may, in addition to the payment of the damages for past infringement, be restrained by injunction from further use, and when the whole machine is an infringement of a patent, be ordered to deliver it up to be destroyed.” Quoted in *Brugg v. Stockton*, 27 F. R. 510, 1886, Dist. Cal., Sawyer, J.

Bischoff v. Wethered, 9 Wall. 315, 1869, Supr. Court, Bradley, J.

Is said in *Tucker v. Spalding*, 13 Wall. 456, 1871, Supr. Court., Miller, J., fully to consider the question as to the identity of the principle of two interfering patents.

In *Heald v. Rice*, 104 U. S. 749, 1881, Supr. Court, Matthews, J., says the decision is consistent with *Bischoff v. Wethered*. *Heald v. Rice* decides that if the court, looking at a patent and reissue, can say positively, without the aid of extrinsic evidence, that the inventions are not the same, then it is a pure question of construction for the court.

Black v. Munson, 14 Blatchf. C. C. 265, 1877, North. Dist. N. Y., Hunt, J.

Cited in *Gould's Manuf. Co. v. Cowing*, 3 Ban. & A. 76, 1877, North. Dist. N. Y., Johnson, J., as settling the rule of that circuit that the impossibility of producing evidence of damages or profits does not absolve plaintiff from the necessity of proving the same. If he does not prove them, he gets only nominal damages.

Is cited in *Greenleaf v. Yale Lock Manuf. Co.*, 4 Ban. & A. 585, 1879, South. Dist. N. Y., Blatchford, J., to the question what evidence is necessary to show that a fixed and established license has been approved by the plaintiff which can properly be taken as a measure for the damages sustained by him.

Blake v. Robertson, 94 U. S. 728, 1876, Supr. Court. Swayne, J.

“The damages must be proved; they are not to be presumed.” Quoted in *Calkins v. Bertrand*, 8 F. R. 759, 1881, North. Dist. Ill., Blodgett, J.

Blanchard v. Sprague, 1 Cliff. C. C. 288, 1859, Dist. Mass., Clifford, J.

Is quoted from in *Hartell v. Tilghman*, 99 U. S. 554, 1878, Supr. Court, Miller, J., to the point that if a patent case does not arise under any act of Congress, nor depend in any way upon any law of Congress, in relation to patents, but arises entirely out of an agreement for a license, the rights of the parties depend upon the ordinary rules of law, and a court of the United States has no jurisdiction unless on account of the citizenship of the parties.

Blanchard v. Sprague, 3 Sumner, 279, 1838, Dist. Mass., Story, J.

This case is said, in *Dederick v. Cassell*, 9 F. R. 312, 1881, East. Dist. Penn., Butler, J., to have decided that the words “above described method,” in the claim of a patent, require the claim to be read as one for the patentee’s methods of operating his machine, as described in the specification.

Blanchard v. Sprague, 2 Story, 170, 1839, Dist. Mass., Story, J.

Mr. Justice Story is said in this case to have said that he never doubted the statutory authority of Congress to

grant a patent to an inventor whose invention had at the time of the passage of the act gone into public use. Quoted in *Fire Extinguisher Case*, 21 F. R. 43, 1884, Dist. Md., Morris, J.

Blandy v. Griffith, 3 Fisher, 609, 1869, South. Dist. Ohio, Swayne, J.

Is said in *Goodyear Dental Vulcanite Co. v. Willis*, 1 Ban. & A. 583, 1874, East. Dist. Mich., Emmons, J., to support the proposition that when successive applications are made in the procurement of a patent, and there is no proof of actual abandonment, the subsequent applications will be deemed a continuation of the first.

Bliss v. Brooklyn, 8 Blatchf. C. C. 533, 1871, East. Dist. N. Y., Benedict, J.

Cited in *May v. Logan County*, 30 F. R. 260, 1887, North. Dist. Ohio, Jackson, J., as holding a city liable to a patentee for use of his invention in spite of a statute which attempted to exempt the corporation from liability.

Bloomer v. McQuewan, 14 How. 539, 1852, Supr. Court, Taney, C. J.

Is cited in *Day v. Union India Rubber Co.*, 3 Blatchf. C. C. 491, 1856, South. Dist. N. Y., Hall, J., as containing expressions of opinion to the effect that the right of an assignee or grantee of a patent to use the patented thing during an extended term is limited to the use of machines which such assignee or grantee has in operation when the extended term commences.

Is approved and affirmed in *Bloomer v. Millenger*, 1 Wall. 351, 1863, Supr. Court, Clifford, J., and it is said that the diversity of opinion among the judges in *Bloomer v. McQuewan* is of no weight, since the rule has been affirmed in *Chaffee v. Boston Belting Co.*, 22 How. 223.

Is explained in *Aiken v. Manchester Print Works*, 2 Cliff. 437, 1865, Dist. N. H., Clifford, J., as deciding that when a patentee sells a patented implement or machine for the purpose of using it in the ordinary pursuits of life, that machine passes outside the monopoly, and may be used till it is worn out, even under an extension of the patent.

It is said in *Adams v. Burke*, 17 Wall. 460, 1873, Supr. Court., Miller, J., in the dissenting opinion of Mr. Justice Bradley, that the remark of Taney, C. J., in *Bloomer v. McQuewan*, that when a machine passes into the hands of a purchaser it is no longer within the limits of the monopoly, applies only to time, — that is, to the right to use a machine after the original patent has expired, and a renewal granted, — but does not apply to locality.

The opinion of Mr. Chief-Justice Taney in this case is quoted from in *Fire Extinguisher Manuf. Co. v. Graham*, 16 F. R. 551, 1883, West. Dist. Va., Hughes, J., that the purchaser of a patented machine has the right to use the machine during the extension of a patent; the distinction between assignee of a share in the patent and the purchaser of the patented machine which was made in the case of *Wilson v. Rousseau*, 4 How. 646 (q. v.), is also approved. *Bloomer v. McQuewan* is also said to have legislated judicially to the extent of giving to § 18 of the law of 1836 a meaning beyond its terms, against the remonstrances of McLean and Nelson, JJ.

Bloomer v. Millenger, 1 Wall. 340, 1863, Supr. Court, Clifford, J.

The opinion of Mr. Justice Clifford is quoted in *Black v. Hubbard*, 3 Ban. & A. 39, 1877, North. Dist. N. Y., Wheeler, J., to the point that when a patentee has made and sold a machine, it is out of the patent, and the buyer may use the machine till it is worn out.

Bowker v. Dows, 15 O. G. 510, 1878, Dist. Mass., Lowell, J. See *Wallace v. Holmes*.

Boyd v. McAlpin, 3 McLean, 427, 1844, Dist. Ohio, McLean, J.

Is said in *Perry v. Corning*, 7 Blatchf. C. C. 201, 1870, North. Dist. N. Y., Woodruff, J., to have expressed the opinion that if an assignment is not recorded within three months, an assignment afterwards made would prevail, although received with notice of such prior assignment. In *Perry v. Corning* this dictum of *Boyd v. McAlpin* is said not to be material to the decision of *Boyd v. McAlpin*, and is not in harmony with the other cases.

Bridges v. Sheldon, Dist. Vt., October Term, 1879.

Is said in *Urner v. Kayton*, 17 F. R. 540, 1883, South. Dist. N. Y., Wheeler, J., to decide that the defendants must pay the master's fees for accounting in the first instance, irrespective of the question who will finally have to pay them.

Brooks v. Bicknell, 3 McLean, 250, 1843, Dist. Ohio, McLean, J.

Is said in *Emerson v. Hogg*, 2 Blatchf. C. C. 10, 1845, South. Dist. N. Y., Betts, J., to decide that under the statute, drawings of a patent may be filed with the specification, although not referred to in the specification.

Brooks v. Byam, 2 Story, 525, 1843, Dist. Mass., Story, J.

The opinion of the court in this case is said in *Perry v. Corning*, 7 Blatchf. C. C. 201, 1870, North. Dist. N. Y., Woodruff, J., to hold that although an unrecorded assignment is not void, yet no suit can be maintained against a third person by virtue of it, unless recorded before or pending suit.

Is said in *Adams v. Howard*, 22 F. R. 658, 1884, South. Dist. N. Y., Wallace, J., to have decided in effect that the divisibility of a license depends upon its terms, and that no rule can be laid down which can govern all cases.

Brooks v. Fiske, 15 How. 215, 1853, Supr. Court., Catron, J.

Is quoted from, in *Gottfried v. Phillip Best Brewing Co.*, 5 Ban. & A. 35, 1879, East. Dist. Wis., Dyer, J., to the effect that the claim of a patent is to be interpreted by its own language, together with the specifications and drawings.

Brooks v. Stolley, 3 McLean, 526, 1845, Dist. Ohio, McLean, J.

Is distinguished in *Hartshorn v. Day*, 19 How. 222, 1856, Supr. Court, Nelson, J.

Is explained in *Goodyear v. Union India Rubber Co.*, 4 Blatchf. C. C. 68, 1857, South. Dist. N. Y., Ingersoll, J., as deciding in favor of the jurisdiction of the federal court in equity, in a patent suit where a license had been given under the patent, but forfeited for non-compliance with its conditions.

Is said in *Hartell v. Tilghman*, 99 U. S. 555, 1878, Supr. Court, Miller, J., to be in some respects opposed to the authorities, which hold that when a case does not arise under any act of Congress, or depend in any way upon any law of Congress relating to patents, but involves a license, a court of the United States has no jurisdiction of that case. Miller, J., in *Hartell v. Tilghman*, says that in this respect the case of *Brooks v. Stolley* stands alone, and is not supported by the better reason.

In the dissenting opinion of Mr. Justice Bradley (Waite, C. J., and Swayne, J., concurring), in *Hartell v. Tilghman*, 99 U. S. 559, 1878, Supr. Court, it is said

that the views expressed in *Brooks v. Stolley*, supporting the jurisdiction of a federal court in a case which involves the forfeiture of a license for non-payment of royalty, are perfectly sound and just, the bill being brought in the right gained by the assignment of a patent, and alleging that the defendants are infringing that right, and that the license is no defence.

It is said in *National Manuf. Co. v. Meyers*, 7 F. R. 358, 1881, South. Dist. Ohio, Swing, J., that the former case may seem to be an authority to the effect that the defence of the invalidity of plaintiff's patent, and a license under that patent, are inconsistent defences; but *Brooks v. Stolley* was not followed in the latter case, the court deciding upon principle and the weight of authority that the defences were not inconsistent.

It is said in *Teas v. Albright*, 13 F. R. 411, 1882, Dist. N. J., Nixon, J., to be a case where a federal court took jurisdiction of a suit involving a contract of license, the ownership of the patent in that case being retained by the licensor, and the right of the licensee to use the patent being specially conditioned on his performing certain acts or paying certain royalties. It is also said in the latter case that the court in *Hartell v. Tilghman*, 99 U. S. 555 (*q. v.*), intimated that McLean, J., went too far, in *Brooks v. Stolley*, in maintaining the jurisdiction of the federal court.

Brown v. Piper, 91 U. S. 37, 1875, Supr. Court, Swayne, J.

Controlled the decision of *Terhune v. Phillips*, 99 U. S. 593, 1878, Supr. Court, Swayne, J., the court taking judicial notice that the thing patented — that is, a means for connecting the horizontal and vertical members of a show-case frame, consisting of a metallic corner piece with sockets — was known and in general use long before the issuing of the patent.

Is cited in *Western Electric Manuf. Co. v. Odell*, 18 F. R. 323, 1883, North. Dist. Ill., Blodgett, J., upon the subject of judicial notice.

Is said in *Cottier v. Stimson*, 20 F. R. 909, 1884, Dist. Or., Deady, J., to hold that a patented apparatus for preserving fish and other articles in a close chamber by a freezing mixture, covered nothing but a double use for the well-known ice-cream freezer.

Buchanan v. Howland, 2 Fisher, 341, 359, 1863, North. Dist. N. Y., Hall, J.

Is affirmed as to the validity of Mellier patent in *American Wood Paper Co. v. Glen Falls Paper Co.*, 8 Blatchf. C. C. 515, 1870, North. Dist. N. Y., Woodruff, J.

Construes the wood paper patent, and holds that the principle of the discovery was that the known effects of a solution of pure caustic soda, which had previously been used for boiling straw and other fibrous materials of a similar character and texture in open vessels in which the heat could be raised only to 212° Fahrenheit, might by the use of a much higher degree of heat, not less than 310°, be advantageously and greatly increased, while at the same time the reduction of the materials to paper pulp would be more economical, inasmuch as it dispensed with the large quantities of alkali which had previously been employed. This was held to be the true construction in the *Wood Paper Patent Case*, 23 Wall. 604, 1874, Supr. Court, Strong, J.

Buerk v. Imhaeuser, 10 O. G. 907; s. c. 14 Blatchf. C. C. 19, 1876, East. Dist. N. Y., Johnson, J.

Is said in *Ready Roofing Co. v. Taylor*, 3 Ban. & A. 371, 1878, South. Dist. N. Y., Wheeler, J., to mention the reasons for departing from the usual course of the administration of justice by opening a cause for new evidence.

Is cited in *DeFlores v. Reynolds*, 4 Ban. & A. 341, 1879, South. Dist. N. Y., Blatchford, J., to the effect that a decree can be reopened for new trial only for the gravest reasons, and the plainest proof of the sufficiency of the newly offered evidence to lead the court to a different result.

Is cited in *Adair v. Thayer*, 7 F. R. 920, 1881, South. Dist. N. Y., Wheeler, J., as laying down the rule followed in the latter case.

The remarks of Johnson, J., in this case, upon the quantity of sales of an infringing article, as determined both by price and construction, are quoted in *Hall v. Stern*, 20 F. R. 790, 1884, South. Dist. N. Y., Wallace, J.

Buerk v. Valentine, 9 Blatchf. C. C. 479, 1872, North. Dist. N. Y., Woodruff, J.

Is re-examined and followed in *Buerk v. Imhaeuser*, 1 Ban. & A. 338, 1874, South. Dist. N. Y., Woodruff, J.

Burdell v. Denig, 92 U. S. 716, 1875, Supr. Court, Miller, J.

In *Sayles v. Richmond, F. & P. R. R. Co.*, 4 Ban. & A. 244, 1879, East. Dist. Va., Hughes, J., says that the remark of Miller, J., in *Burdell v. Denig*, that damages might be recovered at law, but that profits are the measure of damages in equity, on the theory that the infringer might be treated as a trustee, was incidental, the case being an action at law, and the jurisdiction not being in contest, and the court not intimating that equity could take jurisdiction of a bill for profits arising from the use of a patent, solely on the ground of constructive trusteeship.

Cited in *Greenleaf v. Yale Lock Co.*, 4 Ban. & A. 584, 1879, South. Dist. N. Y., Blatchford, J. as settling the measure of damages to which the complainant in the latter case was entitled; namely, the license fee which he had fixed in granting licenses.

The opinion of Mr. Justice Miller is quoted in *Root v. Railway Co.*, 105 U. S. 199, 1881, Supr. Court, Matthews, J., to the effect that profits are not the true criterion of damages in an action at law for the infringement of a patent, but that rule is applied in equity. In an action at law the sales of licenses of machines, or the royalty established, is the primary and true criterion of damages. *Burdell v. Denig* was urged upon the court, in *Root v. Railway Co.*, as a case deciding that an infringer was a trustee of the profits for the owner of the patent, and that a court of equity will always compel him to account, even after the expiration of the patent; but this view was rejected by the court. See *Packet Co. v. Sickles*.

The principle of this case is adopted in *Keller v. Stoltzenbach*, 28 F. R. 82, 1886, West. Dist., Penn., Acheson, J., by decreeing compensation to the plaintiff for an infringement on the basis of his established license fee.

Burden v. Corning, 2 Fisher, 477, 498, 1864, North. Dist. N. Y., Hall, J.

Is said in *Worden v. Searls*, 21 F. R. 408, 1884, Dist. N. J., Nixon, J., to hold that the defence of unreasonable neglect or delay in filing a disclaimer must be set up in the answer before it can be considered by the court.

Burns v. Meyer, 100 U. S. 671, 1879, Supr. Court., Bradley, J.

The opinion of Mr. Justice Bradley as to the importance of the "claim" in an application for a patent, is quoted from in *Railroad Co. v. Mellon*, 104 U. S. 118. 1881, Supr. Court, Woods, J., which case decides that in view of the statute, the practice of the patent office, and the decisions of the Supreme Court, the scope of

letters-patent is limited by the claim, although it may be illustrated but not enlarged by the specification.

Is affirmed in *Duff v. Sterling Pump Co.*, 107 U. S. 139, 1882, Supr. Court, Blatchford, J.

Burr v. Cowperthwait, 4 Blatchf. C. C. 163, 1858, Dist. Conn., Ingersoll, J.

Is distinguished in *Arkell v. Hurd Paper Bag Co.*, 7 Blatchf. C. C. 477, 1870, North. Dist. N. Y., Woodruff, J., from the latter case, the patent being for an improved product and not for a principle.

Burr v. Duryee, 1 Wall. 531, 1863, Supr. Court, Grier, J.

Is cited in *Case v. Brown*, 2 Wall. 328, 1864, Supr. Court, Grier, J., to the effect that a reissue cannot be converted into a method of expanding patents for machines into patents for a mode of operation, a function, a principle, an effect, or result, so that by an equivocal use of the term "equivalent," a patentee of an improved machine may suppress further improvements.

The effect of this decision upon the patents there involved is considered in *Wells v. Jacques*, 1 Ban. & A. 65, 1874, Dist. N. J., Nixon, J.

Decided that a mode of operation, irrespective of the mechanism by which it was effected, would not be patentable. So interpreted in *Union Paper Collar Co. v. White*, 2 Ban. & A. 64, 1875, East. Dist. Penn., McKennan, J.

Referred to in *Powder Co. v. Powder Works*, 98 U. S. 139, 1878, Supr. Court, Bradley, J., as deciding that a reissue, to be valid, must be for the same invention as the original patent.

The effect of the decision in this case as to the question of the validity of reissues is briefly stated in *Wilson v. Coon*, 6 F. R. 618, 1880, South. Dist. N. Y., Blatchford, J.

The opinion of Mr. Justice Grier, "The surrender of valid patents and the granting of reissued patents thereon, with expanded or equivocal claims, when the original was clearly neither 'inoperative' nor 'invalid,' and where the specification is neither 'defective nor insufficient,' is a great abuse of the privilege granted by the statute, and productive of great injury to the public. This privilege was not given to the patentee or his assignee in order that the patent may be rendered more elastic or expansive, and therefore more available for the suppression of all other inventions." In *James v. Campbell*, 104 U. S. 370, 1881, Supr. Court, Bradley, J., says it is difficult to express the law on this subject more aptly or forcibly than in the above words.

The state of the art relating to the Wells invention for the manufacture of hat bodies, and different portions of the Gill machine, are said in *Brett v. Quintard*, 10 F. R. 742, 1882, Dist. Conn., Shipman, J. to be described in the former case.

Burr v. Gregory, 2 Paine, C. C. 426, 1828, Thompson, J.

In *Hartell v. Tilghman*, 99 U. S. 551, 1878, Supr. Court, Miller, J., this case is said to be one of the earliest cases on the point whether a court of the United States has jurisdiction in equity of a case arising under a contract concerning a patent, when the citizenship of the parties does not give jurisdiction, and to decide that they have not. *Burr v. Gregory* is approved, in *Hartell v. Tilghman*, as showing the correct rule, although decided before in the act of 1836.

Butterworth v. Hoe, 112 U. S. 50, 61, 1884, Supr. Court. Matthews, J.

Is said in *Gandy v. Marble*, 122 U. S. 439, 1886, Supr. Court, Blatchford, J., to decide that a bill in equity to compel the commissioner of patents to issue

a patent, is not an appeal from the patent office, but is a distinct suit in equity.

Byam v. Brooks, 1 Story, 296, 1840, Dist. Mass., Story, J.

Referred to in *Kittridge v. Claremont Bank*, 3 Story, 610, 1845, Dist. N. H., Story, J.

Byam v. Farr, 1 Curtis, C. C. 264, 1852, Dist. Mass., Curtis, J.

“Upon the soundest principles a patentee must be held to be estopped from asserting a claim which is expressly waived in the record.” Quoted in *Novelty Paper-Box Co. v. Stapler*, 5 F. R. 924, 1881, Dist. N. J., Nixon, J.

C.

California Artificial Stone Paving Co. v. Freeborn, 17 F. R. 735, 1883, Dist. Cal., Sawyer, J.; s. c. 8 Sawy. 443.

Quoted from *Kuhl v. Mueller*, 21 F. R. 512, 1884, South. Dist. Ohio, Sage, J.

Is explained in *California Paving Co. v. Schalicke*, 119 U. S. 405, 1886, Supr. Court, Blatchford, J.

California Artificial Stone Paving Co. v. Molitor, 7 Sawy. 190, 1881, Dist. Cal., Sawyer, J.

Is explained in *California Paving Co. v. Schalicke*, 119 U. S. 405, 1886, Supr. Court, Blatchford, J.

California Artificial Stone Paving Co. v. Perine, 8 F. R. 821, 1881, Dist. Cal., Sawyer, J.

Is quoted from in *Kuhl v. Mueller*, 21 F. R. 511, 1884, South. Dist. Ohio, Sage, J.

Campbell v. James, 104 U. S. 356, 1882, Supr. Court, Bradley, J.

Is cited in *Searls v. Bouton*, 12 F. R. 874, 1882, South. Dist. N. Y., Wheeler, J.

The statements in this case to the effect that what has been described in a former patent to an inventor cannot afterwards be patented by him, is limited in *Vermont Farm Machine Co. v. Marble*, 19 F. R. 307, 1884. Dist. Vt., Wheeler, J., to inventions described and *patented* in a former patent, and not inventions described only.

The principle of this case regarding reissues was applied in *Yale Lock Manuf. Co. v. James*, 20 F. R. 905, 1884, South. Dist. N. Y., Shipman, J.

Is said in *Wooster v. Handy*, 21 F. R. 53, 1884. South. Dist. N. Y., Blatchford, J., to establish a new doctrine in regard to reissues.

The principles of this case are applied in *American Giant Powder Co. v. Hulings*, 21 F. R. 522, 1884. West. Dist. Penn., Acheson, J.

Is said in *Scrivner v. Oakland Gas Co.*, 22 F. R. 99, 1884, Dist. Cal., Sawyer, J., to hold that a process is "a very different thing from mechanism by which it is carried out, and it is a distinct patentable invention."

"An inventor cannot take a reissue for anything but the same invention described and claimed in the original patent; but a reissued patent is not void if the claims of the original patent are extended to cover the original invention." Quoted in *Odell v. Stout*, 22 F. R. 163, 1884, South. Dist. Ohio, Sage, J. See also *Miller v. Brass Co.*

Carew v. Boston Elastic F. Co., 3 Cliff. 356, 370, 1871. Dist. Mass., Clifford, J.

Cited in *Buerk v. Imhaueser*, 2 Ban. & A. 453, 1876. South. Dist. N. Y., Johnson, J., to the effect that under the statute of 1870, in equity, the complainant may recover his damages as well as profits, but that unless damages are in excess of the profits, the complainant recovers only profits.

Carlton v. Bokee, 17 Wall. 471, 1872, Supr. Court. Bradley, J.

Opinion of Mr. Justice Bradley: "We think it proper to reiterate our disapprobation of these ingenious attempts to expand a simple invention of a distinct device into an all-embracing claim calculated by its wide generalization and ambiguous language to discourage further invention in the same department of industry, and to cover antecedent inventions." Quoted with approbation in *Union Paper Collar Co. v. White*, 2 Ban. & A. 62, 1875, East. Dist. Penn., McKennan, J.

Carter v. Baker, 4 Fisher, 404, 1871, Dist. Cal., Sawyer, J.

"It is sufficient, to constitute known mechanical substitutes, that when a skilful mechanic sees one device doing a particular thing, he knows that other devices whose uses he is acquainted with will do the same thing." Quoted in *Wilt v. Grier*, 5 F. R. 453, 1880, Dist. Del., Bradford, J.

Carver v. Braintree Manuf. Co., 2 Story, 432, 1843, Dist. Mass., Story, J.

Is cited in *Gould v. Ballard*, 3 Ban. & A. 327, 1878, Dist. N. J., Nixon, J., as deciding that an inventor is always at liberty to omit, in a reissue, a part of his original invention if he deems it expedient, and retain only that part which he deems fit to retain.

Case v. Redfield, 4 McLean, 526, 1849, Dist. Ind., Huntington, J.

Is said in *Hodge v. Hudson River R. R. Co.*, 6 Blatchf. C. C. 89, 1868, South Dist. N. Y., Blatchford, J., to decide what language will convey to an assignee an extension of a patent.

Is limited in *Hayes v. Dayton*, 8 F. R. 705, 1880, South. Dist. N. Y., Blatchford, J., to a case of an original patent, and of another patent granted in terms as an improvement on the original patent. *Case v.*

Redfield is said in the latter case to be a case difficult to understand, and opposed to the other cases on the subject.

Cawood Patent Case, 94 U. S. 710, 1876, Supr. Court. Strong, J.

In ascertaining the profits of an infringer, it is not material whether the infringer has made profits from the business, but how much cheaper he has been able to conduct the business by using the patented invention. Upon this point the Supreme Court, in the above case, is cited in *Knox v. Gt. West. Quicksilver Mining Co.* 4 Ban. & A. 27, 1878, Dist. Cal., Sawyer, J., as saying in substance that it is not the profits of the business as a business which are to be considered, but the advantage derived to the infringer in the diminished cost, &c., of carrying on the business by the use of this invention.

“In settling an account between a patentee and an infringer of a patent, the question is not what profits the latter has made in his business, or from his manner of conducting it, but what advantage he has derived from his use of the patented invention.” Quoted and affirmed in *Calkins v. Bertrand*, 8 F. R. 758, 1881, North. Dist. Ill., Blodgett, J.

Chabot v. American Buttonhole Co., 6 Fisher, 71, 1872, East. Dist. Penn., McKennan, J.

Cited in *Herman v. Herman*, 29 F. R. 94, 1886, South. Dist. N. Y., Brown, J., as holding that, under the circumstances of the case, a license or grant to use an invention was to be necessarily inferred from the contract, and from the relation and acts of the party.

Chambers v. Smith, 5 Fisher, 12, 1870, East. Dist. Penn., McKennan, J.

Is interpreted in *Wilder v. Kent*, 15 F. R. 219, 1883, West. Dist. Penn., Acheson, J., as deciding that the

purchaser at a marshal's sale of a patented machine was an infringer in operating it outside of the district to which its use was limited by license granted to the execution defendant.

Chatillon, *Ex Parte*, 2 O. G. 115, 1872, Leggett, Commissioner.

Cited in *Milligan & H. Glue Co. v. Upton*, 1 Ban. & A. 510, 1874, Dist. Mass., Clifford, J., as a case where the commissioner of patents rejected an application for a patent, when the alleged invention was only substituting one known device for another.

Child v. Adams, 1 Fisher, 189, 1854, East. Dist. Penn., Grier, J.

Is explained in *Hancock Inspirator Co. v. Jenks*, 21 F. R. 914, 1884, East. Dist. Mich., Brown, J., in that the bill was dismissed because on its own recitals it showed that the commissioner of patents had not jurisdiction to issue the patent upon which suit was brought, the application for a reissue stating that the original patent was granted to the purchaser on his statement that he was a citizen of the United States, when in fact he was a citizen of France, but believed he was a citizen of the United States, owing to his ignorance of the law.

Clark v. Scott, 2 O. G. 4, 1872, South. Dist. N. Y. Blatchford, J.

Is distinguished in *Florence Manuf. Co. v. Boston Diatite Co.*, 1 Ban. & A. 398, 1874, Dist. Mass., Shepley, J.

Clark v. Wooster, 119 U. S. 322, 1886, Supr. Court, Bradley, J.

Cited in *Reay v. Berlin, &c. Envelope Co.*, 30 F. R. 449, 1887, South. Dist. N. Y., Wheeler, J., as upholding the jurisdiction in the latter case.

Is quoted from at length in *Kittle v. De Graaf*, 30 F. R. 689, 1887, South. Dist. N. Y., Coxe, J., to the effect that if the patent is in force when the bill in equity is brought, the fact that it expires soon after does not deprive the court of jurisdiction in this case.

Clark Patent Steam, &c., Co. v. Copeland, 2 Fisher, 221, 1862, South. Dist. N. Y., Shipman, J.

Is cited in *Gottfried v. Phillip Best Brewing Co.*, 5 Ban. & A. 22, 1879, East. Dist. Wis., Dyer, J., as deciding that in order to find an invention anticipated in a prior printed publication, the description in the publication must embody substantially the same organized mechanism, operating substantially in the same manner as that described in the patent claimed to have been anticipated, and that old instruments placed in a new and different organization, producing in such new organization different results, or the same results by a new and different mode of operation, do not prevent such newly-organized mechanism from being patentable.

Clement v. Odorless Excav. Apparatus Co., 109 U. S. 641, 1883, Supr. Court, Blatchford, J.

Affirmed in *Turner & Seymour Co. v. Dover Stamping Co.*, 111 U. S. 327, 1883, Supr. Court, Matthews, J.

Clough v. Barker, 106 U. S. 166, 1882, Supr. Court, Blatchford, J.

Is said in *American Bell Tel. Co. v. Dolbear*, 17 F. R. 605, 1883, Dist. Mass., Lowell, J., to be an exceptional case, and that its doctrine must be applied with much reserve; this doctrine is, that if a certain machine or organization is capable of a certain use, only under unusual and abnormal conditions, so that a person of skill and knowledge of the art to which it relates, or a person using the machine, would only by accident dis-

cover that it was capable of such mode of operation, it shall not be considered an anticipation of a machine or organization which is founded upon such mode of operation.

Is cited in *Morley Sewing Machine Co. v. Lancaster*, 23 F. R. 346, 1885, Dist. Mass., Colt, J., upon the question of infringement in regard to a foundation patent.

Clum v. Brewer, 2 Curtis, C. C. 506, 508, 1855, Dist. Mass., Curtis, J.

Is said in *Hodge v. Hudson River R. R. Co.*, 6 Blatchf. C. C. 89, 1868, South. Dist. N. Y., Blatchford, J., to decide what language will convey to an assignee an extension of a patent.

Approved in *Dunham v. Indianapolis, &c. R.R. Co.*, 2 Ban. & A. 329, 1876, North. Dist. Ill., Drummond, J., as giving the true rule, that when one of the joint patentees uses or sells the thing patented, or any portion of it, the others cannot sue him for an infringement. This is because one tenant in common of letters-patent has the same rights as the others, to make, use, and sell the thing patented, and a licensee under one tenant in common cannot be enjoined on a bill by another tenant in common.

The decision in this case was that the inchoate right of an inventor to obtain an extension of the term of the patent was a proper subject for purchase and sale. This case is examined in *Hendrie v. Sayles*, 98 U. S. 552, 1878, Supr. Court, Clifford, J., and said to be a case of great importance, as establishing the rule that an extended term might pass by assignment, as well as the original term.

The language of Curtis, J., in this case, to the effect that when a conveyance of a patent contains something showing an intention to convey not merely the letters-patent, but the extension thereof, such extension passes

by that conveyance, is cited in *Johnson v. Wilcox & Gibbs Sewing Machine Co.*, 27 F. R. 690, 1886, South. Dist. N. Y., Wallace, J.

Cochrane v. Badische Anilin & Soda Fabrik, 111 U. S. 294, 1883, Supr. Court, Blatchford, J.

“Every patent for a product or composition of matter must identify it, so that it can be recognized aside from the description of the process for making it, or else nothing can be held to infringe the patent which is not made by that process.” Quoted in *Holliday v. Pickhardt*, 29 F. R. 860, 1887, South. Dist. N. Y., Wallace, J.

Cochrane v. Deener, 94 U. S. 780, 1876, Supr. Court, Bradley, J.

“A process is a mode of treatment of certain materials to produce a given result. It is an act or a series of acts performed upon the subject-matter to be transformed and reduced to a different state or thing.” Quoted in *MacKay v. Jackman*, 12 F. R. 618, 1882, South. Dist. N. Y., Wheeler, J.

Is said in *New Process Fermentation Co. v. Maus*, 122 U. S. 427, 1886, Supr. Court, Blatchford, J., to establish the rule that a method or art may be patented as a process, irrespective of the apparatus or instrumentality for carrying it out.

Coffin v. Ogden, 18 Wall. 120, 1873, Supr. Court, Swayne, J.

In *Judson v. Bradford*, 3 Ban. & A. 548, 1878, Dist. Mass., Clifford, J., it is said, that since the decision in *Coffin v. Ogden* evidence will support the defence of prior knowledge and use, which shows that the invention was complete and capable of working if it had been put in use, and was known to any considerable number of persons.

“The invention or discovery relied upon as a defence must have been complete, and capable of producing the

result sought, and this must be shown by the defendant. The burden of proof rests upon him, and every reasonable doubt should be resolved against him." Quoted in *Washburn, &c. Co. v. Haish*, 4 F. R. 904, 1880, North. Dist. Ill., Drummond, J.

The opinion in this case, to the effect that, on the defence of prior invention, the burden of proof is upon the defendant to prove that the invention or discovery, relied upon as a defence, was a complete and practical working machine, and in examining the proof of this the court should resolve every reasonable doubt against the defendant, is quoted in *Putnam v. Hollender*, 6 F. R. 893, 1881, South. Dist. N. Y., Blatchford, J.

Relied upon in *Hull v. McVeale*, 107 U. S. 97, 1882, Supr. Court, Blatchford, J., that if the article has been used and sold for two years, no patent can be taken on it.

Opinion of Mr. Justice Swayne: "The invention or discovery relied upon as a defence must have been complete, and capable of producing the result sought to be accomplished, and this must be shown by the defendant. The burden of proof rests upon him, and every reasonable doubt should be resolved against him." Quoted in *Allis v. Buckstaff*, 13 F. R. 891, 1882, East. Dist. Wis., Dyer, J.

Is quoted from in *Thayer v. Hart*, 20 F. R. 694, 1884, South. Dist. N. Y., Coxe, J., to the effect that the burden of proof of a prior invention rests upon the defendant.

The same quotation is made in *American Bell Telephone Co. v. People's Telegraph Co.*, 22 F. R. 313, 1884, South. Dist. N. Y., Wallace, J.

Is said in *Wetherell v. Keith*, 27 F. R. 366, 1886, North. Dist., Ill., Blodgett, J., to establish the rule that the fact of prior use as a defence in a suit for infringement must be established beyond reasonable doubt.

Cohn v. U. S. Corset Co., 93 U. S. 366, 1876, Supr. Court, Strong, J.

Is cited in *United Nickel Co. v. Pendleton*, 15 F. R. 747, 1883, South. Dist. N. Y., Blatchford, J., to the effect that a patent for a product, not describing the process of making it, may be defeated by a prior printed and published description of the product.

This rule is qualified by the subsequent statement that unless the prior description is so full and intelligible that persons skilled in the art can understand it and make the product, the subsequent patent is not defeated. Quoted to this effect in *Eames v. Andrews*, 122 U. S. 66, 1886, Supr. Court, Matthews, J.

Collar Co. v. Van Deusen, 23 Wall. 530, 1874, Supr. Court, Clifford, J.

The opinion of Clifford, J., is quoted in *McCloskey v. DuBois*, 9 F. R. 39, 1881, South. Dist. N. Y., Wheeler, J., to the effect that new articles of commerce are not patentable as new manufactures unless their production involves the exercise of invention or discovery.

Is also quoted in *MacKay v. Jackman*, 12 F. R. 619, 1882, South. Dist. N. Y., Wheeler, J.

Collins v. Peebles, 2 Fisher, 541, 1865, South. Dist. Ohio, Swayne, J.

Is said in *Rich v. Ricketts*, 7 Blatchf. C. C. 231, 1870, North. Dist. N. Y., Hall, J., to follow the decision in *Parker v. Hallock*, 2 Fisher, 543 (q. v.), that a State statute of limitations does not apply to a suit in a federal court on a patent.

Is interpreted in *Anthony v. Carroll*, 2 Ban. & A. 197, 1875, Dist. Mass., Shepley, J., to decide that State statutes could not limit the time within which actions for the infringement of patents could be brought in the federal courts, and as Congress had not legis-

lated on the subject, there was no limit to the time for bringing actions.

Is cited in *May v. Logan County*, 30 F. R. 257, 1887, North. Dist. Ohio, Jackson, J., together with *Parker v. Hallock*, 2 Fisher, 543; *Read v. Miller*, 2 Biss. 12; *Wetherell v. N. J. Zinc Co.*, 1 Ban. & A. 105; *Anthony v. Carroll*, 2 Ban. & A. 195; *Sayles v. Lakeshore & M. S. R. R. Co.*, 9 F. R. 515; *Sayles v. Dubuque & S. C. R. R. Co.*, 9 F. R. 516; *Hayward v. St. Louis*, 1 F. R. 427; *Wood v. Cleveland Rolling Mills*, 4 Fisher, 550; *May v. Fon du Lac County*, 27 F. R. 691, as being cases deciding that a State statute of limitations cannot be interposed as a defence in an action for an infringement of a patent in a suit in the federal court.

Collins Co. v. Coes, 21 F. R. 38, 1884, Dist. Mass., Gray, J.

Cited in *Goodyear v. Hartford Spring Axle Co.*, 23 F. R. 37, 1885, Dist. Conn., Shipman, J. See *Penn. R. R. Co. v. Locomotive Engine Safety Truck Co.*

Conover v. Roach, 4 Fisher, 12, 1857, South. Dist. N. Y., Hall, J.

This case is said, in *Rowell v. Lindsay*, 6 F. R. 296, 1881, East. Dist. Wis., Dyer, J., to settle the principle of law that the patentee has a right to invoke the doctrine of equivalents, on a question of infringement, in the case of a combination patent.

Consolidated Fruit Jar Co. v. Wright, 94 U. S. 92, 1876, Supr. Court, Swayne, J.

The decision of this case upon the doctrine of abandonment, is said in *Sprague v. Adriance*, 3 Ban. & A. 125, 1877, South. Dist. N. Y., Wheeler, J., to be, that he who is silent when he should speak, must be silent when he would speak, if he cannot do so without violation of law and injustice to others.

Is quoted from in the *Driven Well Cases*, 16 F. R.

389, 1883, South. Dist. Iowa, Shiras, J., as to abandonment of an invention by the inventor.

Mr. Justice Swayne is cited as saying that a single instance of sale or of use by the patentee before application for a patent may, under the circumstances, be fatal to the patent, in *Henry v. Providence Tool Co.*, 3 Ban. & A. 514, 1878, Dist. R. I., Clifford, J.

Is cited in *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.*, 27 F. R. 382, 1886, South. Dist. Ohio, Sage, J., upon the question what facts amount to abandonment of an invention after rejected application and before reissued application.

Consolidated Fruit Jar Co. v. Wright, 12 Blatchf. C. C. 149, 1874, South. Dist. N. Y., Woodruff, J.

Dictum of Woodruff, J., is quoted with approval in *United States Rifle, &c. Co. v. Whitney Arms Co.*, 2 Ban. & A. 500, 1877, Dist. Conn., Shipman, J., to the effect that if an inventor allows others to produce his invention and supply it to the public for a long time, he loses his right to a patent.

Consolidated Safety Valve Co. v. Crosby, &c. Valve Co., 113 U. S. 159, 1884, Supr. Court, Blatchford, J.

Is cited in *Morley Sewing Machine Co. v. Lancaster*, 23 F. R. 346, 1885, Dist. Mass., Colt, J., upon the question of equivalents in construction.

Is cited in *Kirk v. Du Bois*, 28 F. R. 461, 1886, West. Dist. Penn., McKennan, J., as a case where two bills, involving two patents, one of which had expired before final decree, being before the court, the Supreme Court granted an injunction in favor of the existing patent, and an account of profits on both.

Continental Windmill Co. v. Empire Windmill Co., 8 Blatchf. C. C. 295, 1871, North. Dist. N. Y., Woodruff, J.

Is explained in *Hapgood v. Hewitt*, 119 U. S. 233, 1886, Supr. Court, Blatchford, J.

Coon v. Wilson, 113 U. S. 268, 1884, Supr. Court, Blatchford, J.

The language of the court in this case as to the validity of a reissue claiming a different invention from the original patent is quoted in *Gage v. Kellogg*, 23 F. R. 894, 1885, North. Dist. N. Y., Coxe, J.

Is cited in *Arnheim v. Finster*, 24 F. R. 276, 1885, South. Dist. N. Y., Wheeler, J., as affirming the recent decisions upon the point of reissued patents.

Is said in *Western Union Telegraph Co. v. Baltimore & Ohio Telegraph Co.*, 25 F. R. 34, 1885, South. Dist. N. Y., Wallace, J., to have held that an application for a reissue to enlarge the scope of the original claim was too late three months after date of the original patent, the fact being that the claim in the reissue sought to cover articles made by the defendant subsequently to the date of the original patent, and that the subject-matter of the reissued claim had been industriously excluded from the description in the original.

The language of the court in this case is paraphrased in *Arnheim v. Finster*, 26 F. R. 280, 1886, South. Dist. N. Y., Coxe, J., to the effect that where a reissue merely enlarges the claim of the patent by expanding that claim and adding others, twenty-one months' delay invalidates the reissue.

It is said in *Ives v. Sargent*, 119 U. S. 663, 1886, Supr. Court, Matthews, J., that the lapse of time and laches was considered immaterial in *Coon v. Wilson* as regards the reissue in that case, since the court could decide that the reissue was on its face for a different invention from the original patent, and therefore void.

Corning v. Burden, 15 How. 252, 1853, Supr. Court, Grier, J.

Is distinguished, in *Arkell v. Hurd Paper Bag Co.*, 7 Blatchf. C. C. 477, 1870, North. Dist. N. Y., Wood-

ruff, J., from the latter case; the patent is for an improved product and not for a principle.

The opinion of Mr. Justice Grier in this case as to what constitutes a process under the patent law, and that it is included under the general term "useful art," is quoted at length in *MacKay v. Jackman*, 12 F. R. 618, 1882, South. Dist. N. Y., Wheeler, J.

The opinion of Mr. Justice Grier, as to what is meant by a patent for a "process," that term not being used in the patent statute, and holding that a process patent is included under the general term "useful art," is quoted from in *Tilghman v. Proctor*, 102 U. S. 722, 1880, Supr. Court, Bradley, J.

Mr. Justice Grier uses the word "method" as equivalent to "process" in this case; so said in *American Bell Telephone Co. v. Dolbear*, 15 F. R. 453, 1883, Dist. Mass., Gray, J.

The court in this case is said in *New Process Fermentation Co. v. Maus*, 20 F. R. 729, 1884, North. Dist. Ind., Drummond, J., to have defined the term "process" as meaning the means of producing a result, and when it was so used the process was patentable, and would include all methods or means not effected by mechanism. And this rule is affirmed in *New Process Fermentation Co. v. Maus*, 122 U. S. 426, 1886, Supr. Court, Blatchford, J.

Corn-Planter Patent Case, 23 Wall. 181, 1874, Supr. Court, Bradley, J.

Is said, in *Herring v. Nelson*, 3 Ban. & A. 66, 1877, North. Dist. N. Y., Johnson, J., to affirm the doctrine that a reissue for a combination of old elements which omits one element of the original patent, is void, but that this rule does not apply when, of the old elements, some are single and some are sub-combinations. The case of *Gill v. Wells*, 22 Wall. 1 (q. v.) was considered

by the court in the *Corn-Planter Patent Case*, but its rule not adopted.

Is cited in *Kerosene Lamp Heater Co. v. Littell*, 3 Ban. & A. 318, 1878, Dist. N. J., Nixon, J., as limiting the effect of *Gill v. Wells* (q. v.).

This case sustained the reissued patents on the sole ground that the reissues were for things contained within the machines and apparatus described in the original patents. In this case there is a dissenting opinion by the judge who delivered the opinion of the court in *Gill v. Wells*, 22 Wall. 1, and who sought to apply in the *Corn-Planter Patent Case* the views which he had expressed in *Gill v. Wells*. It is said in *Wilson v. Coon*, 6 F. R. 619, 1880, South. Dist. N. Y., Blatchford, J., that the *Corn-Planter Patent Case* disregards much which was said in the opinion in *Gill v. Wells* which was unnecessary to the decision in that case.

“Where an inventor, after describing a machine, claims as his invention a certain combination of elements, or a certain device or part of the machine, this is an implied declaration as conclusive, so far as that patent is concerned, as if it were expressed, that the specific combination or the thing claimed is the only part which the patentee regards as new. He or some other person may have a distinct patent for the portions not covered by this; but that will speak for itself. So far as the patent in question is concerned, the remaining parts are old or common, and public.” Quoted in *Rowell v. Lindsay*, 6 F. R. 294, 1881, East. Dist. Wis., Dyer, J.

It is said in *Putnam v. Hutchinson*, 12 F. R. 129, 1882, North. Dist. Ill., Blodgett, J., that prior to the decision in the former case it was the practice of the patent office to refuse patents when the device was shown in rejected applications on file in the office; but the court held in that case that such rejected applications must be

considered as abandoned experiments, and should not be allowed to defeat a patent.

The opinion of Mr. Justice Bradley in this case is quoted from at length in *Rowell v. Lindsay*, 113 U. S. 101, 1884, Supr. Court, Woods, J., to the effect that if an inventor describes a machine and claims a patent only upon a portion of it, the other portions of the machine are open to the public so far as that patent is concerned, although it may be covered by other patents.

Cowell v. Sessions, 17 F. R. 452, 1883, Dist. Conn., Shipman, J.

The Taylor patent, numbered 123,925, as construed in this case, is adopted in *Sessions v. Romadka*, 21 F. R. 126, 1884, East. Dist. Mich., Dyer, J.

Cowing v. Rumsey, 8 Blatchf. C. C. 38, 1870, North. Dist. N. Y., Woodruff, J.

In *Sayles v. Richmond, F. & P. R. R. Co.*, 4 Ban. & A. 244, 1879, East. Dist. Va., Hughes, J., says that the remark of the court in *Cowing v. Rumsey*, to the effect that an infringer of a patent might be treated as a trustee in respect to profits derived by him from the use of the patented article, was merely an incidental remark, *passim*, no question of jurisdiction arising, and the case being an action at law, and that this case does not intimate in any way that equity would have jurisdiction of a bill for profits arising from the use of a patented article solely on the ground of constructive trusteeship. See *Root v. Railway Co.*

Crandal v. Watters, 20 Blatchf. C. C. 97, 1881, South. Dist. N. Y., Blatchford, J.

The language of Blatchford, J., as to the question of substitution and inventive skill requisite to secure a patent, is quoted in *Butler v. Bainbridge*, 29 F. R. 145, 1886, South. Dist. N. Y., Coxe, J.

Crane v. Price, Webster Patent Cases, 409.

Decided that the substitution of anthracite for bituminous coal in hot blast in smelting iron ore was patentable as producing a better article of iron at less expense. Cited in *Hicks v. Kelsey*, 18 Wall. 674, 1873, Supr. Court, Bradley, J., as being a case of process of manufacture in which one article, replacing another in the combination, often produces different results.

In *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 497, 1876, Supr. Court, Strong, J., it is said that *Crane v. Price* has been doubted but not overruled, and the doubts have arisen from the uncertainty whether any new result was obtained by the use of anthracite.

It is said in *Rumford Chemical Works v. Hecker*, 2 Ban. & A. 361, 1876, Dist. N. J., Nixon, J., that since the decision in *Crane v. Price*, it has not been considered safe to invoke the ordinary doctrine of equivalents in construing patents for new manufactures, or compositions of matter, and that the authority and principles of that case were recognized in *Hicks v. Kelsey*, 18 Wall. 674 (q. v.).

Crompton v. Belknap Mills, 3 Fisher, 536, 1869, Dist. N. H., Clark, J.

The doctrine of Clifford and Clark, JJ., in this case, that where a patent is for a combination of old devices, the patentee cannot insist on mechanical equivalents, is approved in *Yuengling v. Johnson*, 3 Ban. & A. 106, 1877, East. Dist. Va., Hughes, J.

Crouch v. Speer, 6 O. G. 187, 1874, Dist. N. J., Nixon, J.

Is cited in *Hawes v. Antisdel*, 2 Ban. & A. 11, 1875, East. Dist. Mich., Longyear, J., as a case where the evidence of a defendant to show prior use or prior knowledge being inconsistent with itself and frequently contradicted, was insufficient to establish that defence.

D.

Day v. Newark India Rubber Co., 1 Blatchf. C. C. 628, 1850, South. Dist. N. Y., Nelson, J.

Is cited in *Williams v. Empire Transportation Co.*, 3 Ban. & A. 535, 1878, Dist. N. J., Nixon, J., as deciding that a corporation cannot be found outside the State which creates it, to be served with legal process. In *Day v. Newark India Rubber Co.*, Nelson, J., quashed a writ of attachment and summons issued in the Circuit Court of the Southern District of New York against a New Jersey corporation. But see *Schollenberger, Ex Parte*, 96 U. S. 377; and see now act of Congress, March 3, 1887, c. 373, that no person can be sued except in the State of which he is an *inhabitant*.

Day v. New Engl. Car Spring Co., 3 Blatchf. C. C. 181, 1854, South. Dist. N. Y., Betts, J.

Is said in *Hubbell v. De Land*, 14 F. R. 474, 1882, East. Dist. Wis., Dyer, J., to have held that in actions at law on patents the defendant may plead a special plea setting up a license, although he also pleads the general issue without notice of special matter.

Dean v. Mason, 20 How. 198, 1857, Supr. Court. McLean, J.

This case is said, in *Root v. Railway Co.*, 105 U. S. 195, 1881, Supr. Court, Matthews, J., to have followed the rule as to profits recoverable in a suit for infringement of a patent, laid down in *Livingston v. Woodworth*, 15 How. 46 (q. v.), that is, actual profits made by the infringer, not the estimated profits which he might have made by due diligence.

De Florez v. Reynolds, 16 Blatchf. C. C. 408, 1879, South. Dist. N. Y., Blatchford, J.

Is cited in *Adair v. Thayer*, 7 F. R. 920, 1881, South. Dist. N. Y., Wheeler, J., as laying down the rule followed in the latter case.

De Florez v. Reynolds, 17 Blatchf. C. C. 436, 1880, South. Dist. N. Y., Blatchford, J.; s. c. 8 F. R. 434.

The decision in this case, and the reasoning of the court, was followed in *Siemens v. Sellers*, 16 F. R. 861, 1883, East. Dist. Penn., Butler, J.

Delano v. Scott, Gilp. 489, 1834, East. Dist. Penn., Hopkinson, J.

Is said in *Morse v. Davis*, 5 Blatchf. C. C. 44, 1862, North. Dist. N. Y., Hall, J., to lean towards the rule that one who sells a patented article as mere agent or clerk of another would not under the statute be liable to an action for treble damages given in cases of infringement.

Is said in *United Nickel Co. v. Worthington*, 13 F. R. 393, 1882, Dist. Mass., Lowell, J., to have decided that a mere workman who makes a patented article is not an infringer, on the ground that the statute does not mean to class mere agents, servants, etc., as makers and vendors of the patented improvement, but the principals for whose account and benefit they act.

Dennis v. Cross, 6 Fisher, 138, 1872, North. Dist. Ill., Blodgett, J.

Is stated briefly in *Kuhl v. Mueller*, 21 F. R. 513, 1884, South. Dist. Ohio, Sage, J.

“There is probably no principle of the patent law better settled than that the patentee is limited by his claim.” Quoted in *Hancock Inspirator Co. v. Jenks*, 21 F. R. 916, 1884, East. Dist. Mich., Brown, J., but

qualified by saying that the specifications, models, or drawings may be looked at to assist the court in the construction of the claim.

Detroit Lubricator Manuf. Co. v. Renchard, 9 F. R. 293, 1881, East. Dist. Mich., Matthews, J.

Is distinguished in *Hubel v. Dick*, 28 F. R. 139, 1886, South. Dist. N. Y., Shipman, J.

Dibble v. Augur, 7 Blatchf. C. C. 86, 1869, South. Dist. N. Y., Blatchford, J.

Is cited in *May v. Juneau County*, 30 F. R. 245, 1887, West. Dist. Wis., Bunn, J., as holding that an assignment of a patentee's "right, title, interest, claim, or demand, in, to, or under a patent," refers wholly to the future as to infringements, and conveys only the right to claims for infringement which arise after the assignment, and not for infringement prior to the assignment.

Dobson v. Dornan, 118 U. S. 10, 1885, Supr. Court, Blatchford, J.

Was followed in *Fay v. Allen*, 30 F. R. 447, 1887, North. Dist. N. Y., Coxe, J.

Dobson v. Hartford Carpet Co., 114 U. S. 439, 1884, Supr. Court, Blatchford, J.

Governed the decision in *Dobson v. Dornan*, 118 U. S. 16, 1885, Supr. Court, Blatchford, J., as to the decree for amount of damages, reversing the decree of the circuit court.

Is said in *Reed v. Lawrence*, 29 F. R. 920, 1886, West. Dist. Mich., Severens, J., to point out the rule that when a patented feature, which has been infringed by the defendant, is one which was the sole element of value in the thing manufactured, so that but for it the article would not be marketable, because not sufficiently

adapted to the purpose for which it was intended, the defendant is liable for the whole profits of the manufacture.

Governed the decision of *Fay v. Allen*, 30 F. R. 447, 1887, North. Dist. N. Y., Coxe, J.

Dorsey Harvester Revolving Rake Co. v. Marsh, 6 Fisher, 387, 1873, East. Dist. Penn., McKennan, J.

Is cited in *Gould v. Ballard*, 3 Ban. & A. 328, 1878, Dist. N. J., Nixon, J., as holding that any feature of an invention which is actually a part of it, and was only suggested or indicated in the specification of the original patent, might be distinctly described and covered by reissue, and also that a part of the original invention might be omitted. "This an inventor may do, because the public may use it, and there is nothing in the policy or terms of the patent act which forbids it."

Doughty v. West, 2 Fisher, 553, 1869, South. Dist. N. Y., Blatchford, J.

Is distinguished in *Sarven v. Hall*, 9 Blatchf. C. C. 526, 1872, Dist. Conn., Woodruff, J., from *Hussey v. Bradley*, 2 Fisher, 362.

Downton v. Yaeger Milling Co., 9 F. R. 402, 1879, East. Dist. Mo., Dillon, J.

The construction given to the patent in suit in this case is followed in *Downton v. Allis*, 9 F. R. 770, 1881, East. Dist. Wis., Dyer, J.

Downton v. Yaeger Milling Co., 108 U. S. 466, 471, 1882, Supr. Court, Woods, J.

Is said in *Eames v. Andrews*, 122 U. S. 66, 1886, Supr. Court, Matthews, J., to affirm the rule laid down in *Seymour v. Osborne* (q. v.), that a prior printed publication, to defeat a patent, must describe the invention so that one skilled in the art could make it.

Draper v. Hudson, 3 O. G. 354, 1873, Dist. Mass., Shepley, J.; s. c. 1 Holmes, 208.

Is cited in *Milligan & H. Glue Co. v. Upton*, 1 Ban. & A. 511, 1874, Dist. Mass., Clifford, J., that an article of manufacture to be patentable must be new, and not simply manufactured by new machinery.

Is said in *Gordon v. Anthony*, 4 Ban. & A. 258, 1879, South. Dist. N. Y., Blatchford, J., to have decided that although jurisdiction of the circuit court in equity in patent causes rests upon statute provisions, it is to be exercised in accordance to the course and principles of courts of equity, and the right to an account of profits is incident to a right to an injunction; and therefore if the right to an injunction fails, the right to an account of profits fails also.

The weight of authority in this country is said in *Gordon v. Anthony* to be opposed to the decision in the case of *Draper v. Hudson*. See now, however, *Root v. Railway Co.* *Draper v. Hudson* is said in *Gordon v. Anthony* to have been decided upon a mistake of the effect of the decision in *Stevens v. Gladding*, 17 How. 455.

Is criticised in *Atwood v. Portland Co.*, 5 Ban. & A. 534, 1880, Dist. Maine, Lowell, J., as proceeding upon the supposed authority of *Stevens v. Gladding*, 17 How. 455, which when critically examined is found not to decide the point decided in *Draper v. Hudson*, namely, that an account could never be ordered except as incident to an injunction. The court in *Draper v. Hudson* is said evidently to have overlooked the decision in *Howes v. Nute*, 4 Fisher, 463, and the former case is rejected as authority in the case of *Atwood v. Portland Co.* See *Root v. Railway Co.*

Draper v. Potomska Mills, 13 O. G. 276, 1878, Dist. Mass., Shepley, J.

The opinion of Mr. Justice Shepley is quoted in

Hibel v. Dick, 28 F. R. 139, 1886, South. Dist. N. Y., Shipman, J., upon the question of diligence in securing a patent for an invention after the date of the inceptive invention.

E.

Eagleton Manuf. Co. v. West, &c. Manuf. Co., 2 F. R. 774, 1880, South. Dist. N. Y., Wheeler, J.

Is explained in *Hancock Inspirator Co. v. Jenks*, 21 F. R. 915, 1884, East. Dist. Mich., Brown, J., to the effect that the bill was dismissed because upon its face the patent was illegally granted, as it appeared that the application was amended by patentee's attorney after patentee's death, under authority given by him during his life.

Egbert v. Lippman, 104 U. S. 333, 1881, Supr. Court, Woods, J.

Is relied upon in *Hall v. McNeale*, 107 U. S. 97, 1882, Supr. Court, Blatchford, J., as to a sale of an invented article being presumptively not a case of experimental use.

Is said in *Driven Well Cases*, 16 F. R. 393, 405, 1883, South. Dist. Iowa, Shiras, J., to hold that "to constitute the public use of an invention, it is not necessary that more than one of the patented articles should be publicly used," and also that "if an inventor, having made his device, gives or sells it to another to be used by the donee or vendee without limitation or restriction or injunction of secrecy, and it is so used, such use is public, even though the use and knowledge of the use may be confined to one person." Also cited in the concurring opinion of Love, J., in the same case.

It is stated in *Davis v. Fredericks*, 19 F. R. 100, 1884, South. Dist. N. Y., Wheeler, J., that the majority of the court, as well as Miller, J., dissenting, seems to

favor the view that the consent or allowance of the inventor is necessary to invalidate a patent under the acts of 1836 and 1839 by public use and sale, although this point is expressly left open.

Elizabeth (City of) v. Nicholson Pavement Co., 97 U. S. 126, 1877, Supr. Court, Bradley, J.

Is cited by Lowell, J., in *Draper v. Wattles*, 3 Ban. & A. 620, 1878, Dist. Mass., as deciding that use, prior to application for a patent, if fairly and honestly experimental, may be public without depriving the inventor of his right to a patent if publicity was necessary to the experiment, although the inventor receives payment for the use. Mr. Justice Lowell comments on this, that it is somewhat difficult for a court to qualify, by a supposed intention not declared at the time, the acts of an inventor who sells the patented articles on two occasions apparently in the ordinary course of trade.

Is distinguished in *Campbell v. James*, 5 Ban. & A. 358, 1880, South. Dist. N. Y., Wheeler, J. In the former case the city did not make or save anything by the infringement, and was therefore discharged from a suit brought for an account of profits. In the latter case the defendant had made certain profits, but had paid them over to the Government, and was therefore held to an account to the patentee for the profits so made by him, as if he had not paid them to the Government.

Is compared in *Root v. Railway Co.*, 105 U. S. 202, 1881, Supr. Court, Matthews, J., with *Marsh v. Seymour*, 97 U. S. 348. In *Elizabeth v. Pavement Co.*, the bill was filed before the statute of 1870, and it was held that the complainant could not, before that statute, have a decree for both profits and damages, since that right was given by the statute; and as the city had made no profits, the bill was dismissed as to it, it remaining

liable to an action at law for damages. *Marsh v. Seymour* arose after that act, and a decree for damages was made, Clifford, J., saying that when the infringer had carried on his business so badly that it did not yield profits, damages of a compensatory character might be recovered.

Is referred to in *Stow v. Chicago*, 104 U. S. 551, 1881, Supr. Court, Woods, J., as showing that the filling with sand or gravel of the spaces between the blocks or rows of blocks of a pavement was part of the Nicholson invention.

This case is stated and the decision given in *Kirby v. Armstrong*, 5 F. R. 803, 1881, Dist. Ind., Gresham, J., as illustrating the point that if a complainant in a suit for an injunction and profits fails to show that the use of his invention in connection with other machinery of which his invention is an improvement has produced a definite part of the whole profits, the decree for profits must be nominal only.

Is cited in *Campbell v. New York*, 9 F. R. 503, 1881, South. Dist. N. Y., Wheeler, J., as a case where the invention, that is, a patent pavement, could not be experimented with and tested in private, and in such cases a public use may still be experimental.

Governs the decision of *Celluloid Manuf. Co. v. American Zylonite Co.*, 26 F. R. 698, 1886, South. Dist. N. Y., Shipman, J.

Ellithorp v. Robertson, 4 Blatchf. C. C. 307, 1859, South. Dist. N. Y., Ingersoll, J.

Ingersoll, J., is quoted in *Hubel v. Dick*, 28 F. R. 139, 1886, South. Dist. N. Y., Shipman, J., upon the subject of priority between one who obtains a prior patent and one who invented before him, but was guilty of laches in reducing the invention to practice and in applying for a patent. To defeat a patent, the prior

invention must have been reduced to practice, and embodied in some practical and useful form.

Emerson v. Simm, 6 Fisher, 281, 1873, Dist. N. J., Nixon, J.

Is said in *Goodyear Dental Vulcanite Co. v. Van Antwerp*, 2 Ban. & A. 255, 1876, Dist. N. J., Nixon, J., to adopt the rule of damages laid down in *Seymour v. McCormick*, 16 How. 490 (q. v.).

Eppinger v. Richey, 14 Blatchf. C. C. 307, 1877, South. Dist. N. Y., Shipman, J.

Judge Shipman, in his opinion in this case, gives to the general use of the invention as a test of its patentability the same importance as the Supreme Court did in the case of *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 486, and is quoted to this effect in *Washburn, &c. Manuf. Co. v. Haish*, 4 F. R. 908, 1880, North. Dist. Ill., Drummond, J.

Estabrook v. Dunbar, 10 O. G. 909, 1876, Dist. Mass., Shepley, J.

“The general terms, and sometimes special words in the claims, must receive such a construction as may enlarge or contract the scope of the claim, so as to uphold that invention, and only that invention, which the patentee has actually made and described, where such construction is not absolutely inconsistent with the language of the claim.” Quoted in *Clark v. Kennedy Manuf. Co.*, 2 Ban. & A. 487, 1877, Dist. Conn., Shipman, J.

Eureka Co. v. Bailey Co., 11 Wall. 488, 1870, Supr. Court, Miller, J.

Is explained in *Atwood v. Portland Co.*, 5 Ban. & A. 534, 1880, Dist. Maine, Lowell, J., as being a case where the jurisdiction in equity was sustained for an account of royalties due by a contract concerning the patent, an injunction being issued as incident to the account, that

is, until the defendant should account. See now *Root v. Railway Co.*

Is explained in *Root v. Railway Co.*, 105 U. S. 204, 1881, Supr. Court, Matthews, J., as not being a case where the injunction was incidental to the account. In that case the court had jurisdiction on account of the citizenship of the parties, and the bill demanded an injunction to restrain an infringement. The account of the royalty was incidental.

This case is cited in Bump on Patent Law, page 140, as authority that the invalidity of a patent and a license under it are inconsistent defences, but the case is examined in *National Manuf. Co. v. Meyers*, 7 F. R. 357, 1881, South. Dist. Ohio, Swing, J., and explained as being an action upon a contract for license to enforce the provisions of the contract, thereby creating an estoppel, and the court held the defences not to be inconsistent.

Evans v. Eaton, 3 Wheat. 454, 506, 1818, Supr. Court, Marshall, C. J.

It is said in *Emerson v. Hogg*, 2 Blatchf. C. C. 7, 1845, South. Dist. N. Y., Betts, J., that doubts were raised in the former case, whether under the general patent law improvements on different machines can be comprehended in the same patent, so as to give a right to the exclusive use of the several machines separately as well as in combination.

Is cited in *Day v. New England Car Spring Co.*, 3 Blatchf. C. C. 181, 1854, South. Dist. N. Y., Betts, J., to the effect that in an action at law for infringement of a patent a defendant may plead special matters which the statute authorizes to be given under the general issue.

Is said in *Hubbell v. De Land*, 14 F. R. 473, 1882, East. Dist. Wis., Dyer, J., to establish the rule that in

actions at law for an infringement of patent rights the defendant may file special pleas, although the substance of those might be given in evidence under the general issue under the statute.

The remark of the court in this case, that special patent acts extending or granting patents must be considered as engrafted on the general patent law, is said in *Fire Extinguisher Manuf. Co. v. Graham*, 16 F. R. 552, 1883, West. Dist. Va., Hughes, J., to be explained in the dissenting opinion of McLean, J., in *Bloomer v. McQuewan*, 14 How. 539, to the effect that that remark applied only to the jurisdiction of the court and other questions as to the validity of the patent, and not as to what rights are acquired by the patent. These must be regulated by the general patent law.

The Supreme Court in this case is said, in *Sessions v. Romadka*, 21 F. R. 132, 1884, East. Dist. Wis., Dyer, J., to intimate a doubt whether a patentee could claim, in the same patent, improvements on different mechanisms, so as to give a right to the exclusive use of the several mechanisms separately, as well as a right to the use of these mechanisms jointly.

Evans v. Eaton, 1 Pet. C. C. 327, 1816, Dist. Penn., Washington, J.

The remarks of Mr. Justice Washington in that case, that nothing in the Constitution prevents Congress from violating the obligation of contracts, are said in *Legal Tender Cases*, 12 Wall. 671, 1870, Supr. Court, dissenting opinion of Field, J., to be without significance against the collective force of various authorities, and are explained by him.

Evans v. Eaton, 3 Wash. 449, 1818, Dist. Penn., Washington, J.

“If two machines be substantially the same and operate in the same manner to produce the same

result, though they may differ in form, proportions, and utility, they are the same in principle." This language of Mr. Justice Washington is adopted in *Willimantic Linen Co. v. Clark Thread Co.*, 4 Ban. & A. 139, 1879, Dist. N. J., Nixon, J.

F.

Faulks v. Kamp, 3 F. R. 898, 1880, South. Dist. N. Y., Wheeler, J.

Is quoted in *Curran v. Burdsall*, 20 F. R. 838, 1883, North. Dist. Ill., Blodgett, J., to the effect that a sale of a patent right creates a warranty of title and draws to it any after acquired right of the vendor by estoppel.

Fay v. Cordesman, 109 U. S. 408, 420, 1883, Supr. Court, Blatchford, J.

Is quoted from in *Sargent v. Hall Safe & Lock Co.*, 114 U. S. 86, 1884, Supr. Court, Blatchford, J., to the effect that if in a patent for a combination the patentee embodies in his invention any element either by directly saying so in the claim, or by so describing it in the specification as to make it part of the invention, he makes that element material in his combination, and a court cannot declare it immaterial. And to same effect in *Shepard v. Carrigan*, 116 U. S. 598, 1885, Supr. Court, Woods, J.

Forbush v. Bradford, 1 Fisher, 317, 1858, Dist. Mass., Curtis, J.

Is cited in *Hoe v. Boston Daily Advertiser Co.*, 14 F. R. 916, 1883, Dist. Mass., Lowell, J., as a case where the preliminary injunction was refused, although the plaintiff had previously recovered judgment at law. The judge before whom the case at law was tried, having doubts as to the soundness of his rulings, refused the injunction when the case came before him in equity.

Forbush v. Cook, 2 Fisher, 668, 1857, Dist. Mass., Curtis, J.

The opinion of Mr. Justice Curtis is quoted in *Herring v. Nelson*, 3 Ban. & A. 61, 1877, North. Dist. N. Y., Johnson, J.: "To make a valid claim for a combination, it is not necessary that the several elementary parts of the combination should act simultaneously. If the elementary parts are so arranged that the successive action of each contributes to produce some practical result, which result, when attained, is the product of the simultaneous or successive action of all the elementary parts, viewed as one entire whole, a valid claim for thus combining these elementary parts may be made."

Is quoted from in *Hancock Inspirator Co. v. Jenks*, 21 F. R. 916, 1884, East. Dist. Mich., Brown, J., to the effect that it is not requisite to include in the claim for a combination, as elements thereof, all parts of the machine which are necessary to its action, save as they may be understood as entering into the mode of combining and arranging the elements of the combination.

Reference is made in *Celluloid Manuf. Co. v. Comstock, &c. Co.*, 27 F. R. 360, 1886, Dist. Conn., Shipman, J., to the well-known charge of Mr. Justice Curtis to the jury in the former case, as to the patentability of an invention.

Forsyth v. Clapp, 1 Holmes, 283, 1873, Dist. Mass., Shepley, J.

Language of the court is quoted in *Swain Turbine, &c. Co. v. Ladd*, 2 Ban. & A. 492, 1876, Dist. Mass., Shepley, J., to the effect that in construing a reissue the court will look into the specifications as well as the claims of the original and reissue, to see what inventions they cover.

Foster v. Lindsay, 3 Dill. 126, 1874, East. Dist. Mo., Treat, J.

This case is considered in *Lockwood v. Cleveland*, 6 F. R. 726, 1881, Dist. N. J., Nixon, J., and it is stated that Treat, J., in the former case, held under § 4918, U. S. R. S., that in a suit involving interfering patents, the court had power to adjudge both, as well as one, of the interfering patents void in whole or in part, and in that case made the decree declaring both the interfering patents to be void for want of novelty, supporting its opinion by the decision in *Mowry v. Whitney*, 14 Wall. 440.

Foster v. Moore, 1 Curtis, C. C. 279, 1852, Dist. Mass., Curtis, J.

Is cited in *Wilt v. Grier*, 5 F. R. 453, 1880, Dist. Del., Bradford, J., as holding that the doctrine of mechanical equivalents is not confined by the patent law to those elements which are directly known as such in the science of mechanics, but embraces those substitutes which, as a matter of judgment in construction, may be employed to accomplish the same end.

Fourniquet v. Perkins, 16 How. 82, 1853, Supr. Court, Taney, C. J.

Is cited in *Wooster v. Handy*, 21 F. R. 53, 1884, South. Dist. N. Y., Blatchford, J., as an authority that the circuit court may, on exceptions to a master's report, reverse an interlocutory decree and dismiss the bill.

French v. Rogers, 1 Fisher, 133, 1851, East. Dist. Penn., Kane, J.

Is said in *Gold & Stock Telegraph Co. v. Commercial Telegraph Co.*, 23 F. R. 343, 1885, South. Dist. N. Y., Shipman, J., to have decided that a United States patent issued after the issue of an English patent for the

same invention, but applied for before the date of the application for the English patent, was not within § 6 of the patent act of 1839, limiting the term of such patent by the term of the foreign patent.

G.

Gage v. Herring, 107 U. S. 640, 646, 1883, Supr. Court, Gray, J.

Is said in *Schillinger v. Greenway Brewing Co.*, 17 F. R. 248, 1883, North. Dist. N. Y., Blatchford, J., to decide that the invalidity of a claim in a reissue does not impair the validity of a claim in the original patent which is repeated and separately stated in the reissued patent.

Is quoted from in *Giant Powder Co. v. Safety Nitro Powder Co.*, 19 F. R. 512, 1884, Dist. Cal., Sawyer, J., to the same effect.

Is said in *Worden v. Searls*, 21 F. R. 408, 1884, Dist. N. J., Nixon, J., to be an authority for holding that the invalidity of a new claim in a reissue does not render the patent void or impair the validity of the original claims, and that suits may be maintained on the part which the patentee is entitled to hold, although if such suits are commenced before the disclaimer is entered, no costs can be recovered.

Is interpreted in *Yale Lock Co. v. Sargent*, 117 U. S. 553, 1885, Supr. Court, Blatchford, J., as deciding that the invalidity of a new claim in a reissue does not impair the validity of a claim in it which is only a repetition and separate statement of a claim in the original patent. A reissued patent is within §§ 4917 and 4922, U. S. R. S., and if a defendant has infringed such a restated valid claim of a reissue, the plaintiff, by filing a disclaimer of the invalid claims,

may have a decree without costs, if there has been no unreasonable delay in filing his disclaimer.

Is interpreted in *Reed v. Chase*, 25 F. R. 95, 1885, West. Dist. Mich., Matthews, J., as deciding that if the claims of a reissue, or one or some of them, are either within the scope of the claim of the original patent, or are legally identical with it, to that extent the reissued patent can and ought to be upheld.

Gallahue v. Butterfield, 6 Fisher, 203, 214, 1872, South. Dist. N. Y., Woodruff, J.

Is cited in *Gould v. Ballard*, 3 Ban. & A. 327, 1878, Dist. N. J., Nixon, J., as deciding that an inventor might always omit in a reissue a part of his original invention, and retain that part only which he deemed fit to retain. In that case the original patent had a weight co-operating with a spring to give greater efficiency to the spring, and in the reissue he claimed the spring alone.

Gardner v. Herz, 118 U. S. 180, 1885, Supr. Court, Blatchford, J.

Is said in *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.*, 28 F. R. 94, 1886, South. Dist. Ohio, Sage, J., to decide that where the mode of construction of the article claimed, the material employed, the form after construction, and the purpose for which it is to be used, have been described in separate earlier patents, although the article itself has never been described in any single patent, and to that extent is novel and is of great utility, it does not require invention to produce it.

The principle of decision of this case was followed in *Thatcher Heating Co. v. Burtis*, 121 U. S. 295, 1886, Supr. Court, Matthews, J.

Garretson v. Clark, 111 U. S. 127, 1883, Supr. Court, Field, J.

“The patentee must in every case give evidence

tending to separate or apportion the defendant's profits and the patentee's damages between the patented and unpatented features, and such evidence must be tangible and reliable, and not conjectural and speculative, or he must show by equally reliable testimony that the profits and damages are to be calculated on the whole machine, for the reason that the entire value of the whole machine as a marketable article is properly and legally attributable to the patented feature." Quoted in *Dobson v. Hartford Carpet Co.*, 114 U. S. 445, 1884, Supr. Court, Blatchford, J.

This case is stated briefly and the language of Field, J., quoted at length in *Reed v. Lawrence*, 29 F. R. 920, 1886, West. Dist. Mich., Severens, J., to the same effect.

Garretson v. Clark, 15 Blatchf. C. C. 70, 1878, North. Dist. N. Y., Blatchford, J.

Is distinguished in *Zane v. Peck*, 13 F. R. 476, 1882. Dist. Conn., Shipman, J. Was followed in *Fay v. Allen*, 30 F. R. 447, 1887, North. Dist. N. Y., Coxe, J.

Gaylor v. Wilder, 10 How. 477, 1850, Supr. Court, Tancy, C. J.

Is cited in *Railroad Co. v. Trimble*, 10 Wall. 379, 1870, Supr. Court, Swayne, J., to the effect that a contract of assignment, made before the issuing of a patent, and recorded, vests the legal title to the patent in the assignee without further conveyance.

This case is said in *Perry v. Corning*, 7 Blatchf. C. C. 201, 203, 1870, North. Dist. N. Y., Woodruff, J., to make the test of the right of an assignee to sue in his own name, the question whether he has the entire monopoly in his locality to the exclusion of the patentee himself.

Is quoted in *Coffin v. Ogden*, 18 Wall. 125, 1873, Supr. Court, Swayne, J., as decisive of that case upon the point of what test of efficiency is necessary to show that an anticipating invention is a complete invention.

Is distinguished and explained in *North Western Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 1 Ban. & A. 190, 1874, East. Dist. Penn., McKennan, J., particularly to the effect that on the question of prior invention in a suit, the fact that the alleged prior inventor has not tested his invention or brought it into public use, and has abandoned it, and is ignorant of its value, does not invalidate the defence if the inventor still has his invention in memory, and it is not wholly and irrecoverably lost to the public

Is quoted to the same effect in *Shoup v. Henrici*, 2 Ban. & A. 251, 1876, West. Dist. Penn., McKennan, J., as in *Coffin v. Ogden. supra.*

It is said in *Hendrie v. Sayles*, 98 U. S. 552, 1878, Supr. Court, Clifford, J., that *Clum v. Brewer*, 2 Curt. C. C. 520, was decided upon the authority of *Gaylor v. Wilder*, to the effect that under the assignment in the case the extended term as well as the original term passed to the assignee.

Mr. Chief-Justice Taney says of §§ 4886, 4920, U. S. R. S., "by knowledge and use, the legislature meant knowledge and use existing in a manner accessible to the public." Applied in *Bullock Printing Press Co. v. Jones*, 3 Ban. & A. 197, 1878, South. Dist. N. Y., Wheeler, J.

Is cited in *Hammond v. Hunt*, 4 Ban. & A. 113, 1879, Dist. Mass., Lowell, J., as a case where the patentee having excepted out of his grant the right to make the machine within a certain part of the territory granted, the exclusive license would not amount to an assignment. The case of *Gaylor v. Wilder* is also said to be the leading case upon the point that when the interest of the exclusive licensee does not amount to an assignment, an action at law must be in the name of the patentee.

Is cited in *Nelson v. McMann*, 4 Ban. & A. 210, 1879, South. Dist. N. Y., Blatchford, J., as deciding that

while by § 14 of the patent act of 1836, a patentee might assign his exclusive right within or throughout a specified part of the United States, and the assignee may upon such an assignment sue in his own name for an infringement of his rights; yet, in order to enable him to sue, the assignment must convey the monopoly which the patentee held in the territory specified, excluding the patentee himself as well as others; and any assignment short of this is a mere license.

It is said in *United States Stamping Co. v. Jewett*, 7 F. R. 877, 1879, South. Dist. N. Y., Blatchford, J., that the only difference between *Gaylor v. Wilder* and the latter case is, that in the former case the assignment by the inventor was recorded in the patent office before the patent was issued; whereas in the latter case the patent had been allowed and ordered to issue before an assignment was made.

Is cited in *Theberath v. Celluloid Manuf. Co.*, 5 Ban. & A. 580, 1880, Dist. N. J., Nixon, J., as settling the difference between a license and an assignment. Any assignment short of an entire and unqualified monopoly is a mere license.

Is said in *Searls v. Bouton*, 12 F. R. 142, 1882, South. Dist. N. Y., Wheeler, J., to hold that § 4886, U. S. R. S., should be construed, together with the section as to notice of the names and residences of persons alleged to have had prior knowledge of the invention, and that prior knowledge in an invention not accessible to the public would not defeat a patent.

The rule in this case as to what constitutes a licensee was applied in *Gamewell Fire Alarm Telegraph Co. v. Brooklyn*, 14 F. R. 256, 1882, East. Dist. N. Y., Wallace, J.; that is, that anything less than a transfer of this entire monopoly for a given locality makes the transferer only a licensee.

Is said in *Fire Extinguisher Manuf. Co. v. Graham*,

16 F. R. 553, 1883, West. Dist. Va., Hughes, J., to decide nothing more than that an invention may be assigned before the patent issues; and it does not touch the question whether, when the inventor and his assignee lose all right to a patent, another who obtains the right to it by the special act is bound by the assignment.

Is said in *Consolidated Electric Light v. Edison Electric Light Co.*, 25 F. R. 721, 1885, South. Dist. N. Y., Wallace, J., to have decided that the legal title to a patent vests at once upon the issue of the patent in the person who, by the records, is entitled to it.

Giant Powder Co. v. California Vigorit Powder Co., 4 F. R. 720, 1880, Dist. Cal., Field, J.

This case is said, in *Flower v. Rayner*, 5 F. R. 800, 1881, Dist. N. J., Nixon, J., to hold that the examination of the original and the reissued patents by the court is allowable, to see whether or not they disclose on their face a case in which the commissioner of patents has authority to act, or whether he has exceeded his authority in reissuing letters for an invention different from that described in the patent. If they disclose a case in which the commissioner has no jurisdiction to act, or a case in which by his determination he has exceeded his jurisdiction, the reissued letters must fall.

This case is considered critically by Lowell, J., in *Smith v. Merriam*, 6 F. R. 716, 1881, Dist. Mass., as being a case supposed by some members of the bar to declare that if the court can discover upon comparison of the original and the reissue that there was no defective specification to be amended, and that the claim was not broader than the invention, the action by the commissioner of patents in granting a reissue was in excess of his jurisdiction and void; and that if the patentee claims too little instead of too much, the specification is

not defective by reason of that mistake, but all which was not claimed was dedicated to the public. This view of the case is not approved by the court; and the decision of the commissioner upon the defectiveness of the original specification is held to be final and conclusive.

Giant Powder Co. v. Safety Nitro Powder Co., 19 F. R. 511, 1884, Dist. Cal., Sawyer, J.

Is said in *Railway Register Manuf. Co. v. North Hudson C. R. Co.*, 23 F. R. 595, 1885, Dist. N. J., Nixon, J., to say that the Supreme Court has over and over again affirmed the principle that all questions of fact behind a patent are to be examined, heard, and conclusively determined by the commissioner of patents.

Is said in *Celluloid Manuf. Co. v. Zylonite Brush & Comb Co.*, 27 F. R. 295, 1886, South. Dist. N. Y., Wallace, J., to be a decision directly and completely in point against the sufficiency of a plea denying the validity of a reissue which is granted merely to reinstate a patentee to an invention which he has surrendered in order to obtain a wider monopoly than the original patent granted him.

Gibson v. Van Dresar, 1 Blatchf. C. C. 532, 1850, North. Dist. N. Y., Nelson, J.

Is cited in *Green v. French*, 4 Ban. & A. 172, 1879, Dist. N. J., Nixon, J., to the effect that where the validity of a complainant's patent is already established by protracted and expensive litigation, and the proof of the infringement clear, the court has no discretion, but is bound to grant a preliminary injunction.

Gill v. Wells, 22 Wall. 1, 1874, Supr. Court, Clifford, J.

Showed wide differences between the original patent and the reissue. In *Collar Co. v. Van Deusen*, 23 Wall. 558, 1874, Supr. Court, Clifford, J., it was said

that the difference between the original patent and the reissue was wider even than the difference in *Gill v. Wells*.

The principles stated in this case are quoted in *Miller v. Bridgeport Brass Co.*, 3 Ban. & A. 25, 1877, Dist. Conn., Shipman, J., particularly to the point that if a patent is taken for a combination including all the ingredients of a machine, without indicating or suggesting any other invention, a reissue cannot be granted for a combination of a smaller number of ingredients which may be found to produce a new and useful result.

Is examined at length, and compared with other cases in *Herring v. Nelson*, 3 Ban. & A. 65, 1877, North. Dist. N. Y., Johnson, J., and it is said that in *Gill v. Wells* the reissues omitted one well-described ingredient of the patented combination, and substituted in its place several other devices not equivalent to the omitted element, nor claimed to be such, and the court held the reissue not to be for the original invention. *Gill v. Wells* is said in *Herring v. Nelson* not to have been followed in the *Corn-Planter Patent Case*, 23 Wall. 181.

Is referred to in *Powder Co. v. Powder Works*, 98 U. S. 139, 1878, Supr. Court, Bradley, J., as deciding that a reissue to be valid must be for the same invention as the original patent.

The decision is limited in *Kerosene Lamp Heater Co. v. Littell*, 3 Ban. & A. 318, 1878, Dist. N. J., Nixon, J., who says it will be observed that the court in *Gill v. Wells* did not say that where a patent is originally taken out for a single combination, a reissue may not be had in which a separate claim may not be made for subcombinations of a part of the elements joined in one in the original patent. Nixon, J., intimates that it may, and refers to *Corn-Planter Patent Case*, 23 Wall. 181, and *Herring v. Nelson*, 12 O. G. 753.

Is explained in *Johnson v. Flushing, &c. R. R. Co.*,

3 Ban. & A. 433, 1878, East. Dist. N. Y., Benedict, J., to be a case where there was not only an omission in the reissue of one well-described ingredient of the patented combination, but there was substituted in its place several other devices not equivalent for the omitted element. This invalidates the reissue.

Is cited in *Goodyear Dental Vulcanite Co. v. Preterre*, 3 Ban. & A. 477, 1878, South. Dist. N. Y., Wheeler, J., to the effect that inventors of a combination are as much entitled to equivalents as the inventors of other patentable improvements, if the equivalents were known to be such at the date of the patent. Compare *Goodyear Dental Vulcanite Co. v. Davis*, 12 O. G. 1, in which case the date of the invention is said to control.

“By an equivalent it is meant that the ingredient substituted for the one withdrawn performs the same function as the other, and that it was well known at the date of the patent securing the invention as a proper substitute for the one omitted in the patented invention. Hence it follows that a party who merely substitutes another old ingredient for one of the ingredients of a patented combination is an infringer, if the substitute performs the same function as the ingredient for which it was substituted, and was well known at the date of the patent as a proper substitute for the omitted ingredient; but the rule is otherwise if the ingredient substituted was a new one, or performed substantially a different function, or was not well known at the date of the plaintiff's patent as a proper substitute for the one omitted, as in that event he does not infringe.” Quoted in *Babcock v. Judd*, 5 Ban. & A. 130, 1880, Dist. Conn., Shipman, J.

Is said in *Atwood v. Portland Co.*, 5 Ban. & A. 537, 1880, Dist. Maine, Lowell, J., to decide that a patentee reissuing his patent has no right to omit something which he had before described as essential.

In this case a reissue was held invalid. It is said in *Wilson v. Coon*, 6 F. R. 619, 1880, South. Dist. N. Y., Blatchford, J., that much is said in the opinion in *Gill v. Wells* that was unnecessary to the decision in that case, and what was so said seemed to have been disregarded by the same court in the subsequent case of the *Corn-Planter Patent*, 23 Wall. 181. In this last case there was a dissenting opinion by the judge who delivered the opinion of the court in *Gill v. Wells*, and who sought to apply in the *Corn-Planter Patent Case* the views he had set forth in *Gill v. Wells*.

It is said in *Dederick v. Cussell*, 9 F. R. 308, 1881, East. Dist. Penn., Butler, J., that language may be found in *Gill v. Wells* which, standing alone, might justify the proposition that where a general combination embraces minor subordinate combinations not claimed in the original patent, a subsequent introduction of claims for the latter is invalid, but that this proposition cannot be reconciled with what has been decided elsewhere, both before and since; citing among other cases *Herring v. Nelson*, 12 O. G. 753.

Is said in *Brett v. Quintard*, 10 F. R. 742, 1882, Dist. Conn., Shipman, J., to describe the different parts and general appearance of the Gill machine for the manufacture of hat bodies and the state of the art at that time.

Gillespie v. Cummings, 3 Sawy. 259, 1874, Dist. Cal., Sawyer, J.

This case is explained in *Hayes v. Dayton*, 8 F. R. 705, 1880, South. Dist. N. Y., Blatchford, J., as deciding that a bill founded on two patents was not bad for multifariousness, since it appeared by the bill that the infringement must necessarily be an infringement of both patents, and therefore the evidence would apply to both cases, there being a common point of litigation.

Is cited in *Deering v. Winona Harvester Works*, 24 F. R. 90, 1885, Dist. Minn., Nelson, J., as following *Nourse v. Allen*, 3 Fisher, 63 (q. v.), as to joining infringements of the same patents in the same bill.

Godfrey v. Eames, 1 Wall. 317, 1863, Supr. Court, Swayne, J.

Is cited in *Bevin v. East Hampton Bell Co.*, 9 Blatchf. C. C. 60, 1871, Dist. Conn., Shipman, J., upon the question of the effect of a second application after the rejection of the first upon the point of abandonment.

Is cited in *Goodyear Dental Vulcanite Co. v. Smith*, 1 Ban. & A. 209, 1874, Dist. Mass., Shepley, J., to the effect that if a party choose to withdraw his application for a patent, intending at the time to file a new petition, and he does so, the two petitions are to be considered as parts of the same transaction, and both as constituting one continuous application within the meaning of the law.

Is said in *Goodyear Dental Vulcanite Co. v. Willis*, 1 Ban. & A. 583, 1874, East. Dist. Mich., Emmons, J., to adopt the proposition that when two successive applications are made for the procurement of a patent, and there is no proof of actual abandonment, the subsequent application will be decreed a continuation of the first.

Is cited in *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 500, 1876, Supr. Court, Strong, J., to the effect that a withdrawal of an application for a patent, with the intention of filing a new application, and the filing such application, is one continued application, and to be treated as such.

The statement in this case that "if an applicant for a patent chooses to withdraw his application, intending at the time to file a new petition, and he does so, the two petitions are to be considered as parts of one transaction, and both as constituting one continuous appli-

cation," must be understood to mean when the original application is not abandoned. *Weston v. White*, 2 Ban. & A. 368, 1876, Dist. Conn., Shipman, J.

Goff v. Stafford, 14 O. G. 748, 1878, Dist. R. I., Clifford, J.

This case is criticised in *De Florez v. Reynolds*, 5 Ban. & A. 152, 1880, South. Dist. N. Y., Blatchford, J., as regards the *dictum* of Mr. Justice Clifford on a point not directly involved in the decision of the case; that is, that a patent granted prior to the act of 1870, but under the act of 1861, for a term of seventeen years, would begin to run and remain in force for the term of seventeen years "from the time it was granted," and not from the prior date of an English patent granted to the inventor for the same invention; and the court in *De Florez v. Reynolds* refuses to follow the opinion of Clifford, J., on this point.

Is said in *Siemens v. Sellers*, 16 F. R. 861, 1883, East. Dist. Penn., Butler, J., to have decided contrary to the rule adopted in *De Florez v. Reynolds*, 17 Blatchf. 436; but the point was not directly involved in the decision of the case. See *De Florez v. Reynolds*.

Gold, &c., Separating Co. v. United States Disintegrating Ore Co., 6 Blatchf. C. C. 307, 1869, South. Dist. N. Y., Blatchford, J.

This case is stated at some length in *Lockwood v. Cleveland*, 6 F. R. 724, 1881, Dist. N. J., Nixon, J., as being a case where it was held under § 4918, U. S. R. S., that in suits in equity involving interfering patents, if proper issues are formed by the pleadings, affirmative relief can be granted to either of the parties by declaring one or the other or all of the patents void or valid, without the necessity of the defendant filing a cross bill for this purpose. The court in *Lockwood v. Cleveland* suggests that the best evi-

dence that the mode of procedure in the above case was regular, is found in the fact that neither of the distinguished patent-lawyers who argued the case, suggested a doubt that the court had authority, under the provisions of the statute, to decide such issues upon the bill and answer.

Goodyear v. Bishop, 2 Fisher, 160, 1861, South. Dist. N. Y., Shipman, J.

Is said in *Goodyear Dental Vulcanite Co. v. Van Antwerp*, 2 Ban. & A. 255, 1876, Dist. N. J., Nixon, J., to adopt the rule of damages laid down in *Seymour v. McCormick*, 16 How. 490 (q. v.).

Goodyear v. Day, 1 Blatchf. C. C. 565, 1850, South. Dist. N. Y., Nelson, J.

Is explained in *Goodyear v. Union India Rubber Co.*, 4 Blatchf. C. C. 68, 1857, South. Dist. N. Y., Ingersoll, J., as deciding that a federal court had no jurisdiction of a patent suit where the only prayer was that the defendant be enjoined from violating his agreement in a license to pay license fees.

Goodyear v. Day, 2 Wall. Jr., 283, 296, 1852, Third Circuit, Grier, J.

The opinion of Mr. Justice Grier that the practice of sending parties to law by a court of equity, where the validity of a patent is denied, before granting a final injunction, is a matter of discretion in the court of equity, and a less common practice here than in England, is quoted in *Cochrane v. Deener*, 94 U. S. 783, 1876, Supr. Court, Bradley, J., with approval.

Decided that a reissue which divides up into two patents, what was before patented in one patent, that is, a process and a product, the product being the direct result of the process, and constituting a discovery, is valid. In *Powder Co. v. Powder Works*, 98 U. S. 137, 1878, Supr. Court, Bradley, J., the case of *Good-*

year v. Day is stated, and the opinion of Mr. Justice Grier quoted from to show that a reissue which does not claim more than the original patent is valid.

The opinion of Mr. Justice Grier in this case is quoted in *Washburn, &c., Manuf. Co. v. Haish*, 4 F. R. 905, 1880, North. Dist. Ill., Drummond, J., to the effect that when any valuable discovery has been made, the invention is generally the culminating point of many experiments not only of the inventor but of others. If those others are unsuccessful, their experiments give them no right to claim a share of the honor or profit.

The opinion of Mr. Justice Grier (page 299) is quoted from in *Whittlesey v. Ames*, 5 Ban. & A. 102, 1880, North. Dist. Ill., Blodgett, J.; s. c., 13 F. R. 898, to the effect that any valuable invention is usually contemporaneous with a great number of unsuccessful experiments in similar devices, but these experiments have no effect upon the right of the inventor to his monopoly.

Is cited in *Root v. Railway Co.*, 105 U. S. 205, 1881, Supr. Court, Matthews, J., as settling the practice that a trial of the validity of a patent may be had in a suit in equity as well as at law, in the United States.

Is said in *Teas v. Albright*, 13 F. R. 412, 1882, Dist. N. J., Nixon, J., to be the same in principle with the latter case, and not to sustain jurisdiction in a federal court of a suit to enforce the covenants of a license.

Goodyear v. New Jersey Central Railroad, 2 Wall. Jr., 356, 1853, Dist. N. J., Grier, J.

Is said in *Welling v. Rubber, &c. Manuf. Co.*, 2 Ban. & A. 4, 1875, Dist. N. J., Nixon, J., to decide that one patent may cover both process and product; but in such a case the description in the specification and claim should show the inventor had both in mind.

Goodyear v. Providence Rubber Co., 2 Cliff. 351, 371, 1864, Dist. R. I., Clifford, J. ; s. c. 2 Fisher, 499.

“ No doubt can be entertained that a new product of manufacture, and a new process or method of producing the new article, are proper subjects of separate and distinct claims in an original patent.” Quoted in *Merrill v. Yeomans*, 1 Ban. & A. 55, 1874, Dist. Mass., Shepley, J.

Is said in *Badische Anilin, &c. Fabrik v. Hamilton Manuf. Co.*, 3 Ban. & A. 239, 1878, Dist. Mass., Shepley, J., fully to sustain the right to reissue a patent in two divisions, one for the new process and one for the new product.

Goodyear v. Union Rubber Co., 4 Blatchf. C. C. 63, 1857, South. Dist. N. Y., Ingersoll, J.

Stated in *Hartell v. Tilghman*, 99 U. S. 554, 1878, Supr. Court, Miller, J., as a case where a court of the United States refused jurisdiction of a case brought to restrain licensees from using an invention until they accounted and paid royalties.

Is said in *Teas v. Albright*, 13 F. R. 412, 1882, Dist. N. J., Nixon, J., to be very similar to the latter case in all its facts and aspects, except that the defendants were licensees and not grantees, and jurisdiction in a federal court of a bill to enforce the covenants of a license was not sustained. See *Wilson v. Sandford*.

Goodyear Dental Vulcanite Co. v. Davis, 12 O. G. 1, 1877, Dist. Mass., Shepley, J.

Mr. Justice Shepley says, that an inventor of a combination is entitled to equivalents, if the equivalents were known to be such at the date of the invention. But compare *Gould v. Rees*, 15 Wall. 187, 194; *Gill v. Wells*, 22 Wall. 1, where the same statement is made in regard to the date of the patent. In *Goodyear Dental*

Vulcanite Co. v. Preterre, 3 Ban. & A. 477, 1878, South. Dist. N. Y., Wheeler, J., it is questioned but not decided which is the controlling date.

Goodyear Dental Vulcanite Co. v. Davis, 102 U. S. 222, 1880, Supr. Court, Strong, J.

The evidence in *Atwater Manuf. Co. v. Beecher Manuf. Co.*, 8 F. R. 609, 1881, Dist. Conn., Shipman, J., is stated to be too scanty to bring the latter case within the doubts expressed by the Supreme Court in the former case as to the validity of a disclaimer.

Goodyear Dental Vulcanite Co. v. Gardner, 4 Fisher, 226, 1870, Dist. R. I., Clifford, J.

Is explained in *Goodyear Dental Vulcanite Co. v. Smith*, 1 Ban. & A. 207, 1874, Dist. Mass., Shepley, J., and the construction contended for by the defendant in the latter case — that is, that the use of the moulds is the process or mode by which the artificial plate for teeth and gums is constructed — is negatived.

Goodyear Dental Vulcanite Co. v. Root, 6 O. G. 154, 1874, North. Dist. N. Y., Hunt, J.

Hunt, J., considered himself bound by the previous decisions in Massachusetts on the same patent. This course is followed in *Goodyear Dental Vulcanite Co. v. Willis*, 1 Ban. & A. 571, 1874, East. Dist. Mich., Emmons, J.

Goodyear Dental Vulcanite Co. v. Wetherbee, 2 Cliff. 555, 1866, Dist. Mass., Clifford, J.

Is explained as to the question of the effect of a new application filed after a rejection of the previous one upon the question of abandonment in *Bevin v. East Hampton Bell Co.*, 9 Blatchf. C. C. 62, 1871, Dist. Conn., Shipman, J.

Is cited in *Colgate v. Western Union Telegraph Co.*, 4 Ban. & A. 64, 1878, South. Dist. N. Y., Blatchford, J.,

to the point that an original application being rejected by the commissioner of patents, and not renewed for eight years, is not proof of intention of abandonment of the invention, there being no proof of withdrawal of the application or of actual abandonment. The fact that the invention had gone into public use to some extent during that time, with the knowledge and consent of the inventor, was not held to change the case.

Goodyear Dental Vulcanite Co. v. Willis, 1 Flip. 338, 1874, East. Dist. Mich., Emmons, J.

The subject of the operation of a decree in one circuit court upon the decision of a suit on the same patent in another circuit court, is said to have been fully discussed in this case, and authorities collated, and the decision in this case is approved in *Searls v. Worden*, 11 F. R. 502, 1882, Dist. Mich., Brown, J.

Gordon v. Anthony, 16 Blatchf. C. C. 234, 1879, South. Dist. N. Y., Blatchford, J.

The rule in this case, that a receiver cannot convey title unless the legal owner of the title joins, was said in *Adams v. Howard*, 22 F. R. 658, 1884, South. Dist. N. Y., Wallace, J., not to apply to the transfer of a mere equitable title.

Gorham Co. v. White, 14 Wall. 511, 1871, Supr. Court, Strong, J.

Cited in *Perry v. Starrett*, 3 Ban. & A. 489, 1878, South. Dist. N. Y., Wheeler, J., as deciding that to constitute infringement of a design patent, the designs must be so similar as to appear to ordinary observers to be the same, and they need not be so near alike as to appear to experts to be the same.

Is said in *Jennings v. Kibbe*, 10 F. R. 670, 1882, South. Dist. N. Y., Blatchf., J., to decide that the true test of identity of design is sameness of appear-

ance; in other words, sameness of effect upon the eye, — not necessarily the eye of an expert, but the eye of an ordinary observer of ordinary acuteness.

Gottfried v. Miller, 104 U. S. 521, 1882, Supr. Court, Woods, J.

Is quoted from in *Curran v. Burdsall*, 20 F. R. 838, 1883, North. Dist. Ill., Blodgett, J., to the effect that where one sells a patented machine and subsequently acquires a right in the patent, the sale of the machine estops him from prosecuting his vendee for the infringement of the patent.

Gould v. Rees, 15 Wall. 187, 1871, Supr. Court, Clifford, J.

Is said in *Sarven v. Hall*, 11 Blatchf. C. C. 298, 1873, Dist. Conn., Woodruff, J., not to be in conflict with the decision in the latter case.

Decides that if a defendant omits one element of a patented combination, he does not infringe it although he substitutes a new element, or one which performs a substantially different function, or one which is old but was not known at the time of plaintiff's invention to be a proper substitute for the omitted ingredient. *Turrell v. Spaeth*, 2 Ban. & A. 187, 1875, Dist. N. J., Nixon, J.

Mr. Justice Clifford is cited in *Goodyear Dental Vulcanite Co. v. Preterre*, 3 Ban. & A. 477, 1878, South. Dist., N. Y., Wheeler, J., to the effect that inventors of a combination are as much entitled to equivalents as the inventor of other patentable improvements, if the equivalents were known to be such at the date of the patent. But compare *Goodyear Dental Vulcanite Co. v. Davis*, 12 O. G. 1, where it is said to be the date of the invention. It is questioned in *Goodyear Dental Vulcanite Co. v. Preterre*, which date controls.

This case is said, in *Rowell v. Lindsay*, 6 F. R. 296, 1881, East. Dist. Wis., Dyer, J., to settle the rule of law that *bona fide* inventors of a combination are as

much entitled to equivalents as inventors of other patentable improvements, and the language of the court to this point is quoted at length.

Gould v. Spicer, 15 F. R. 344, 1882, Dist. R. I., Gray, J.

Is said in *Singer Manuf. Co. v. Goodrich*, 15 F. R. 456, 1883, Dist. Mass., Nelson, J., to decide that if any invention claimed or described in a reissue is identical with either of the claims in the original, it must be protected.

Gould's Manuf. Co. v. Cowing, 8 O. G. 278, 1874, North. Dist. N. Y., Hunt, J.

Opinion of Mr. Justice Hunt: "I understood the rule to be settled that when the patent is for an improvement in a machine, the damages for an infringement of such patent are confined to the profits made by the use of the improvement only, and not by the manufacture of the whole instrument." Quoted in *Calkins v. Bertrand*, 8 F. R. 758, 1881, North. Dist. Ill., Blodgett, J.

Graham v. McCormick, 11 F. R. 859, 1880, North. Dist. Ill., Drummond, J.

Is said in *Vermont Farm Machine Co. v. Marble*, 19 F. R. 308, 1884, Dist. Vt., Wheeler, J., to seem to have decided on full consideration and argument, under the statute now in force, that an inventor may have a patent for an invention described in a prior patent to himself.

It is said in *Wilson v. Cublely*, 26 F. R. 157, 1886, North. Dist. Ill., Blodgett, J., that under the rule established in *Graham v. McCormick*, if a patentee shows in an earlier patent a feature analogous in function and operation to one described as part of the invention in a later patent, the feature so shown in the earlier patent does not prevent him from putting in a claim for this invention in the later patent.

Grant v. Raymond, 6 Pet. 218, 1832, Supr. Court., Marshall, C. J.

Is explained in *Wilson v. Rousseau*, 1 Blatchf. C. C. 100, 1845, North. Dist. N. Y., *per Curiam*, as deciding that where the commissioner of patents has issued a void patent, he may issue a valid patent afterwards for the portion of the term not then expired.

Is said in *Battin v. Taggart*, 17 How. 83, 1854, Supr. Court, McLean, J., to have sustained a reissued and corrected patent before any legislation was had upon the subject.

Is cited in *Day v. New England Car Spring Co.*, 3 Blatchf. C. C. 181, 1854, South. Dist. N. Y., Betts, J., to the effect that in an action at law for infringement of a patent the defendant may plead special matters which the statute authorizes to be given under the general issue.

Is referred to in *Loom Co. v. Higgins*, 105 U. S. 588, 1881, Supr. Court, Bradley, J., as deciding that an insufficient specification in a patent is a defence to a suit on it without an allegation of fraudulent intent, and that such allegation was only necessary if the defendant wished to avoid the patent. *Contra*, the decisions in *Whittemore v. Cutter*, 1 Gall. 429; *Lowell v. Lewis*, 1 Mas. 182; *Gray v. James*, Pet. C. C. 394.

It is said in *Odell v. Stout*, 22 F. R. 162, 1884, South. Dist. Ohio, Sage, J., that the earlier cases and some of the later are in harmony with the rule in *Grant v. Raymond*, that the correct performance of all the preliminaries to the procuring of an original or re-issued patent is always examinable in the court in which a suit for violation of such patent is brought.

Gray v. James, Pet. C. C. 394, 1817, Dist. Penn., Washington, J.

Is referred to in *Loom Co. v. Higgins*, 105 U. S. 588,

1881, Supr. Court, Bradley, J., as deciding that an insufficient specification in a patent, if done with fraudulent intent, is a defence to a suit. The fraudulent intent is not held necessary in *Grant v. Raymond*, 6 Pet. 218 (q. v.), unless the defendant wishes to avoid the patent.

Greely, *Ex Parte*, 6 Fisher, 575, 1873, Dist. Mass, Shepley, J.

Is stated briefly in *Re Squire*, 3 Ban. & A. 137, 1877, East. Dist. Mo., Treat, J.

Greenwood v. Bracher, 1 F. R. 856, 1880, Dist. N. J., Nixon, J.

Is cited and explained in *Minneapolis Harvester Works v. McCormick Harvesting Machine Co.*, 28 F. R. 566, 1886, Dist. Minn., Nelson, J.

The practice adopted in that case, of requiring the complainant in a case where there is some doubt on the question of priority of invention to show that the defendants are not pecuniarily responsible, and will not give a bond of security to satisfy the decree of the court as to damages before an injunction could be granted, was followed in *National Hat-Pouncing Machine Co. v. Hedden*, 29 F. R. 149, 1886, Dist. N. J., Wales, J.

H.

Hailes v. Albany Stove Co., 16 F. R. 240, 1883, North. Dist. N. Y., Wallace, J.

Is said in *Brush v. Condit*, 20 F. R. 831, 1884, South. Dist. N. Y., Shipman, J., to state clearly the law upon the subject of disclaimer.

Hailes v. Van Wormer, 7 Blatchf. C. C. 443, 1870, North. Dist. N. Y., Woodruff, J.

Is affirmed in *Russell &c. Manuf. Co. v. Mallory*, 10 Blatchf. C. C. 146, 1872, Dist. Conn., Woodruff, J.,

as distinguishing between a patentable combination and a mere aggregation of elements having no relation to each other, or no reciprocal or co-operative action to produce the result obtained.

Hailes v. Van Wormer, 20 Wall. 353, 1873, Supr. Court, Strong, J.

The opinion of Mr. Justice Strong is quoted in *Booth v. Parks*, 1 Ban. & A. 227, 1874, North. Dist. Ohio, Welker, J., to the effect that a new combination, if it produces new and useful results, is patentable, though all the constituents are well known, if the results are not a mere aggregate of similar results each produced by one element of the combination.

Decides as to the patentability of a combination of known elements. Cited in *Reckendorfer v. Faber*, 92 U. S. 353, 1875, Supr. Court, Hunt, J., to show that the question of patentability is open to the court, and not conclusively settled by the granting of a patent.

“ Any case where a new result is produced by a combination — a result not previously produced by either of the elements acting separately — is not in the rule as to aggregations laid down in *Hailes v. Van Wormer*.” Cited to this effect in *Stilwell, &c. Manuf. Co. v. Cincinnati Gaslight, &c. Co.*, 1 Ban. & A. 614, 1875, East. Dist. Ohio, Swing, J.

The principle of this decision is approved in *Herring v. Nelson*, 3 Ban. & A. 61, 1877, North. Dist. N. Y., Johnson, J.

The doctrine of this case is said in *Williams v. Rome &c. R. R. Co.*, 3 Ban. & A. 422, 1878, North. Dist. N. Y., Blatchford, J., to be this; that a new combination, if it produces new and useful results, is patentable, though all the constituents of the combination were well known and in common use before the combination was made; that the results, however, must be a product of the com-

ination, and not a new aggregate of several results, each the complete product of one of the combined elements; that merely bringing old devices into juxtaposition, and there allowing each to work out its own effect, without the production of something novel, is not invention; and that no one by bringing together several old devices, without producing a new and useful result, the joint product of these elements of the combination, and something more than an aggregate of old results, can acquire a right to prevent others from using the same devices, either singly or in other combinations.

Is cited in *Webster Loom Co. v. Higgins*, 4 Ban. & A. 97, 1879, South. Dist. N. Y., Wheeler, J., to the point that the mere aggregation of devices, each producing its appropriate effect, unchanged by the others, that effect having no relation to the combination and in no sense being its product, is not patentable combination, and does not show the requisite invention.

Is cited in *Slawson v. Grandstreet, P. P. & F. R. R. Co.*, 5 Ban. & A. 213, 1880, East. Dist. N. Y., Benedict, J.; s. c. 4 F. R. 534, and compared with the latter case as being a case where the claim of the patent did not show a patentable invention, but only a combination of old elements, *e. g.*, an illumination window of mica in a stove.

The opinion of Mr. Justice Strong as to the non-patentability of a combination of old elements producing a result which is an aggregate of similar results, each the complete product of one of the combined elements, is quoted from in *Pickering v. McCullough*, 104 U. S. 317, 1881, Supr. Court, Matthews, J.

Is cited in *Phillips v. Detroit*, 111 U. S. 607, 1883, Supr. Court, Woods, J., as a case where there was no invention, but a combination of old elements.

The opinion of Mr. Justice Strong to the effect that a new combination if it produces new and useful results

is patentable, though all the constituents of the combination were well known and in common use before the combination was made, but that the results must be a product of the combination, and not a mere aggregate of several results, each a complete product of one of the combined elements, is quoted in *Wood v. Packer*, 17 F. R. 651, 1883, Dist. N. J., Nixon, J.

Is cited in *Morris v. McMillin*, 112 U. S. 249, 1884, Supr. Court, Woods, J., as a case where there was no invention, but a combination of old elements.

The principles of this case were applied in *Mosler Safe & Lock Co. v. Mosler*, 22 F. R. 905, 1885, South. Dist. Ohio, Sage, J.; and the rule of decision followed in *Thatcher Heating Co. v. Burtis*, 121 U. S. 295, 1886, Supr. Court, Matthews, J.

Hall v. MacNeale, 107 U. S. 90, 1883, Supr. Court, Blatchford, J.

Is cited in *Thompson v. Boisselier*, 114 U. S. 11, 1884, Supr. Court, Blatchford, J., as a case where the invention described in the patent was held not to be patentable.

Hall v. Wiles, 2 Blatchf. C. C. 194, 1851, South. Dist. N. Y., Nelson, J.

Is said in *Worden v. Searls*, 21 F. R. 408, 1884, Dist. N. J., Nixon, J., to decide that the part of the thing patented which is claimed without right must be a material and substantial part of the invention in order to render a disclaimer necessary.

Hammond v. Hunt, 4 Ban. & A. 111, 1879, Dist. Mass., Lowell, J.

Approved in *Birdsell v. Shaliol*, 112 U. S. 487, 1884, Supr. Court, Gray, J., as to the court's ordering the joinder of licensee as plaintiff, on motion of the defendant in suit for an infringement.

Hapgood v. Hewitt, 119 U. S. 226, 232, 1886, Supr. Court, Blatchford, J.

It is said in *Montross v. Mabie*, 30 F. R. 235, 1887, South. Dist. N. Y., Brown, J., that the language of the court in that case that a right to sell, granted to a corporation under the patent, if a mere personal one, is extinguished by the dissolution of the corporation, must be interpreted in reference to new goods made by an independent corporation after the dissolution of the former corporation, and does not mean that a license to sell granted to a firm is ended as soon as the firm dissolves.

Hardin v. Boyd, 113 U. S. 756, 1884, Supr. Court, Harlan, J.

Cited in *Reay v. Berlin, &c. Envelope Co.*, 30 F. R. 449, 1887, South. Dist. N. Y., Wheeler, J., to the effect that a reissue is valid, if it only gives a more correct description of the same invention which is described in the original patent.

Harkness v. Hyde, 98 U. S. 476, 1878, Supr. Court, Field, J.

Is cited in *United States v. American Bell Telephone Co.*, 29 F. R. 28, 1886, South. Dist. Ohio, Jackson, J., as a case in which a motion to dismiss a suit was treated by the court as a motion to set aside the service, and was sustained, the illegality of the service not appearing on the face of the record.

Hartell v. Tilghman, 99 U. S. 547, 556, 1878, Supr. Court, Miller, J.

It is said in *Pentlarge v. Beaton*, 5 Ban. & A. 330, 1880, East. Dist. N. Y., Benedict, J., that the remarks of the Supreme Court in the above case are calculated to render it doubtful whether in the absence of a termination of a license by mutual agreement or final decree a revocation of the license could be effected by notice; but the case went off on another point.

Is said in *White v. Lee*, 5 Ban. & A. 574, 1880, Dist. Mass., Lowell, J., to overrule those patent cases which held that a breach of covenant in a license is *per se* a forfeiture of the license. Such a breach is not a forfeiture unless it is stipulated to that effect in the license. The case of *Hartell v. Tilghman* is a late and controlling case.

This case is said to be conclusive of the case of *Adams v. Meyrose*, 7 F. R. 201, 1881, East. Dist. Mo., Treat, J., where the plaintiff sought to charge the defendants as infringers of the patent despite the contract of license in consequence of non-compliance with its terms. Treat, J., says at first it seemed clear under the contract that the suit was well founded; but as the majority of the United States Supreme Court had taken an adverse view, nothing remained for him but to dismiss the bill in accordance with the decision.

This case is said, in *Lilienthal v. Washburn*, 8 F. R. 709, 1881, East. Dist. La., Pardee, J., to have been a case where the want of jurisdiction in the federal court appeared upon the face of the bill as it set forth a contract of license, and the parties being citizens of the same State, it was held, by a divided court, that the federal court had no jurisdiction.

Referred to in *Albright v. Teas*, 106 U. S. 619, 1882, Supr. Court, Woods, J.; as deciding against the jurisdiction of a federal court when the case is an agreement respecting a patent, but not involving the construction of any law relating to patents.

It is said in *Teas v. Albright*, 13 F. R. 412, 1882, Dist. N. J., Nixon, J., that in the former case the court intimates that McLean, J., went too far in the case of *Brooks v. Stolley*, 3 McLean, 523 (q. v.), in maintaining the jurisdiction of the courts of the United States in cases where suit is brought to enforce a license, or where there is shown by the bill to be an existing license.

Is cited in *Adams v. Meyrose*, 10 F. R. 673, 1882, East. Dist. Mo., Treat, J., to the point that a suit on a license cannot be maintained in a federal court when the citizenship of the parties does not give jurisdiction.

Is cited in *Smith v. Standard Laundry Machine Co.*, 19 F. R. 826, 1882, South. Dist. N. Y., Wheeler, J., and distinguished from the latter case.

It is said in *Curran v. Craig*, 22 F. R. 102, 1884, East. Dist. Mo., Treat, J., that the former case decides that where the demand against a receiver does not involve the administration of the trust lawfully committed to him, but alleges that he has taken unlawful possession of property not included in the trust, a suit will lie against him personally as for a trespass.

The federal court in this case is said in *Hammacher v. Wilson*, 26 F. R. 240, 1886, Dist. Mass., Carpenter, J., to have found as a fact that there was a subsisting license given by the complainant to the respondent, and therefore refused to take jurisdiction of the case, and left the parties to their remedy in the State court.

The preliminary injunction in *McCarty, &c. Trading Co. v. Glaenzer*, 30 F. R. 387, 1887, South. Dist. N. Y., Wallace, J., was denied on the authority of *Hartell v. Tilghman*, as a case not involving the validity of a patent, but rights under a license.

Hartshorn v. Day, 19 How. 211, 1856, Supr. Court, Nelson, J.

Is quoted from in *Goodyear v. Union Rubber Co.*, 4 Blatchf. C. C. 69, 1857, South. Dist. N. Y., Ingersoll, J., to the effect that if a failure to pay the license fee does not forfeit and rescind the license, the owner of the patent cannot sustain a bill in equity in a federal court for infringement of the patent.

Hatch v. Adams, 22 F. R. 434, 1884, East. Dist. Penn., McKennan, J.

Is interpreted in *Hobbie v. Smith*, 27 F. R. 662, 1886, North. Dist. N. Y., Coxe, J., as authority only for the proposition that the purchaser of patented articles from the grantee of an exclusive territorial right is not at liberty to bring them into the territory of another grantee and there sell them in the course of trade.

Hatchman, In Re, 26 O. G. 738, 1884, Dist. Col., McArthur, J.

Is said in *Boland v. Thompson*, 26 F. R. 635, 1886, South. Dist. N. Y., Coxe, J., to be authority for the proposition that when a claim has been examined and rejected by the commissioner, and the rejection acquiesced in by the patentee or his solicitor, and the patent be issued without the claim, there is no inadvertence or mistake which will entitle the patentee to a reissue.

Hathaway v. Roach, 2 W. & M. 63, 1846, Dist. Mass., Woodbury, J.

Is quoted from in *Hussey v. Bradley*, 5 Blatchf. C. C. 213, 1864, North. Dist. N. Y., Hall, J., to the effect that models, procured by the defendant, of machines described in the plaintiff's patent, may be taxed as part of the defendant's costs.

Hawley v. Mitchell, 1 Holmes, 42, 1871, Dist. Mass., Shepley, J.; s. c. 16 Wall. 544.

Is said in *American Cotton Tie Co. v. Simmons*, 3 Ban. & A. 321, 1878, Dist. R. I., Shepley, J., fully to state the law that a patentee has the right, in selling a patented article, to put a restriction on its sale or use, and to convey only a restricted title, or to license only a restricted use; and if he does so, the purchaser can convey to another only what title he gets.

Is said in *American Cotton Tie Supply Co. v. Bullard*, 4 Ban. & A. 529, 1879, South. Dist. N. Y.,

Blatchford, J., to state fully the law upon the point that a purchaser of a restricted title to a patent, or a license only to a restricted use, cannot convey a better or clearer title than he has himself.

Hayden v. Oriental Mills, 15 F. R. 605, 1883, Dist. R. I., Lowell, J.

Is cited in *May v. Logan County*, 30 F. R. 257, 1887, North. Dist. Ohio, Jackson, J., as a case holding that a State statute of limitation may be interposed as a defence in a suit in the federal court for infringement of a patent. See *Collins v. Peebles*.

Hayden v. Suffolk Manuf. Co., 4 Fisher, 103, 1862, Dist. Mass., Sprague, J.

The opinion of Sprague, J., in this case is quoted at length in *Washburn, &c. Manuf. Co. v. Haish*, 4 F. R. 205, 1880, North. Dist. Ill., Drummond, J., upon the point that when it is sought to invalidate a useful invention by an old machine made years ago, the burden of satisfying the jury upon the point that the two machines are similar rests upon the defendant.

Hayward v. Andrews, 106 U. S. 672, 1882, Supr. Court, Matthews, J.

Is distinguished in *Rogers v. Riessner*, 30 F. R. 530, 1887, South. Dist. N. Y., Wheeler, J.

Hayward v. St. Louis, 11 F. R. 427, 1882, East. Dist. Mo., Treat, J. See *Collins v. Peebles*.

Heald v. Rice, 104 U. S. 737, 1882, Supr. Court, Matthews, J.

Is said in *Avery v. Anthony*, 106 U. S. 146, 1882, Supr. Court, Woods, J., to be to the same effect as *James v. Campbell*, 104 U. S. 356 (q. v.).

The principles of its decision are followed in *Thatcher Heating Co. v. Burtis*, 121 U. S. 295, 1886, Supr. Court, Matthews, J. See *Hailes v. Van Wormer*.

Heaton v. Quintard, 7 Blatchf. C. C. 73, 1869, South. Dist. N. Y., Blatchford, J.

Is distinguished in *American Cotton Tie Co. v. McCready*, 4 Ban. & A. 599, 1879, South. Dist. N. Y., Blatchford, J.

Hendrie v. Sayles, 98 U. S. 546, 1878, Supr. Court, Clifford, J.

Is referred to in *Root v. Railway Co.*, 105 U. S. 204, 1881, Supr. Court, Matthews, J., as the only case where a suit in equity, brought after the patent had expired, for an account of profits, had come before the courts till the case of *Root v. Railway Co.* *Hendrie v. Sayles* was decided on demurrer, on a single point, and the question of jurisdiction was not noticed.

Is stated in *Fire Extinguisher Manuf. Co. v. Graham*, 16 F. R. 555, 1883, West. Dist. Va., Hughes, J., to have decided that when an assignment of an invention is made before the grant of the patent, a renewal of that patent may be issued to the assignee if the language of the assignment is broad enough to cover the extended term.

Is cited in *Johnson v. Wilcox & Gibbs Sewing Machine Co.*, 27 F. R. 690, 1886, South. Dist., N. Y., Wallace, J., explaining that case to have been decided as it was, because the assignment in terms carried extension of the patent to the assignee. The case of *Clum v. Brewer*, 2 Curtis, C. C. 520, is cited in the case of *Hendrie v. Sayles*, and the language of Curtis, J., quoted at length.

Henry v. Francestown Soapstone Stove Co., 17 O. G. 569, 1880, Dist. N. H., Lowell, J.

The opinion of Judge Lowell in the above case, and non-concurrence with Judge Shepley, whose opinion in the same case is reported in 9 O. G. 409, is noticed in

Graham v. Geneva, &c. Manuf. Co., 11 F. R. 142, 1880, East. Dist. Wis., Dyer, J.

Henry v. Providence Tool Co., 14 O. G. 855, 1878, Dist. R. I., Clifford, J.

Decides that an exceptional prolongation of a foreign patent by a foreign power beyond its natural term, does not extend the term of the patent in the United States, but the United States patent expires at the expiration of the original term of the foreign patent, which was in force at the time of the granting of the United States patent. *Henry v. Providence Tool Co.* is cited at length to this effect in *Reissner v. Sharp*, 4 Ban. & A. 377, South. Dist. N. Y., 1879, Blatchford, J.

This case is said in *Bate Refrigerating Co. v. Gillett*, 13 F. R. 557, 1882, Dist. N. J., Nixon, J., to have been a case raising the question as to whether a United States patent expires when the original term of a prior foreign patent, in force when the United States patent was granted, expires, or whether a special extension of the foreign patent saves the domestic patent from lapsing when the term ends, which was running at the granting of the domestic patent. Clifford, J., in *Henry v. Providence Tool Co.*, is said in *Bate Refrigerating Co. v. Gillett*, to have held that the prolongation of the English patent for a further term did not save the domestic patent from lapsing at the end of the term of the English patent running when it was originally granted.

This case is examined in *Paillard v. Bruno*, 29 F. R. 865, 1886, South. Dist. N. Y., Wallace, J., and said to decide that in a case where the original term of a foreign patent has been extended subsequently to the grant of the United States patent, this extension of the foreign patent does not prolong the term of the United States patent under § 4887, U. S. R. S., and the United

States patent expires at the end of the original term of the foreign patent.

Herring v. Gage, 3 Ban. & A. 396, 1878, North. Dist. N. Y., Wallace, J.

Is said in *Garretson v. Clark*, 4 Ban. & A. 538, 1879, North. Dist. N. Y., Blatchford, J., to be consistent with the rulings in the latter case, the rule being that a plaintiff in proving the profits of the defendant is required to separate between an unpatented part of what the defendant makes and sells, and the patented part, and not between such patented part and something which the defendant does not embody in his machine.

Herring v. Nelson, 14 Blatchf. C. C. 293, 1877, North. Dist. N. Y., Johnson, J.; s. c. 12 O. G. 753.

Is referred to in *Kerosene Lamp Heater Co. v. Littell*, 3 Ban. & A. 318, 1878, Dist. N. J., Nixon, J., as containing a satisfactory explanation of the law of re-issue in the case of a patent for a combination.

Is cited by the plaintiffs in *Johnson v. Flushing, &c. R. R. Co.*, 3 Ban. & A. 434, 1878, East. Dist. N. Y., Benedict, J., as being in opposition to *Gill v. Wells*, 22 Wall. 24; but the court said, in *Johnson v. Flushing, &c. R. R. Co.*, that a reference to the opinion in *Herring v. Nelson* shows that the court did not understand it to be in conflict with *Gill v. Wells*. In *Herring v. Nelson* the specification and drawings of the original patent plainly disclosed, beside the main invention, that is, the cooling grain and saving waste in converting it into flour, a subcombination producing a separate result, that is, the cooling only; and this other result was properly claimed in a separate claim in the reissue.

Is said in *Christman v. Rumsey*, 4 Ban. & A. 513, 1879, North. Dist. N. Y., Blatchford, J., to have taken a correct view of the decisions in *Gill v. Wells*, 22

Wall. 1, and *Russell v. Dodge*, 93 U. S. 360, as to the conclusiveness of the decision of the commissioner of patents upon the validity of a reissue in a suit of infringement.

The reason for sustaining the reissue in this case is said in *Blackman v. Hibbler*, 4 Ban. & A. 645, 1879, East. Dist. N. Y., Benedict, J., to have been that all that had been added was the new claim, which embodied in words that which the specifications and drawing of the original patent could not fail to disclose to any intelligent examination.

Hicks v. Kelsey, 18 Wall. 670, 1873, Supr. Court, Bradley, J.

Is said in *Goodyear Dental Vulcanite Co. v. Willis*, 1 Ban. & A. 579, 1874, East. Dist. Mich., Emmons, J., to concede that cases may arise where the degree of superiority arising in a machine by substituting new materials for old may be so great as to amount to a difference in kind of effect produced, and not merely a difference in degree, and constitutes a patentable invention.

Decides as to the patentability of an invention. Cited in *Reckendorfer v. Faber*, 92 U. S. 354, 1875, Supr. Court, Hunt, J., to show that the question of patentability is open to the court, and is not conclusively settled by the grant of the patent.

Is quoted from in *Smith v. Goodyear's Dental Vulcanite Co.*, 93 U. S. 496, 1876, Supr. Court, Strong, J., as intimating that a substitution of one material for another, if it is more than formal, that is, if it effects some new and useful result, as increase of efficiency, or a decided saving in the operation, may be patentable.

The principle of this case, that mere substitution of one material for another is not invention, was applied in *Dalton v. Nelson*, 2 Ban. & A. 228, 1876, South. Dist. N. Y., Shipman, J.

Is cited in *Rumford Chemical Works v. Hecker*, 2 Ban. & A. 361, 1876, Dist. N. J., Nixon, J., as recognizing the authority and principles of *Crane v. Price*, 1 Web. P. C. 409, that in a process of manufacture a substitution of one article for another, *e. g.*, anthracite instead of bituminous coal with the hot blast in smelting iron ore, may be a patentable invention, since it may produce different results.

Is cited in *United States Stamping Co. v. King*, 4 Ban. & A. 477, 1879, South. Dist. N. Y., Blatchford, J.; s. c. 7 F. R. 868, as settling the principles which govern the latter case.

Is said in *Heald v. Rice*, 104 U. S. 755, 1881, Supr. Court, Matthews, J., to affirm the decision of *Hotchkiss v. Greenwood*, 11 How. 248, 266, as to the non-patentability of a mere substitution of one material for another in the constitution of a machine, although it may be cheaper and better.

Is referred to in *Pennsylvania R. R. v. Locomotive Truck Co.*, 110 U. S. 495, 1883, Supr. Court, Gray, J., and the opinion of Mr. Justice Bradley quoted from, to the effect that in compositions a change of ingredients may change the composition, whereas in a machine an iron bar instead of a wooden one does not change the machine.

Hill v. Whitcomb, 1 Holmes, 317, 1874, Dist. Mass., Shepley, J.

Is cited in *Hartell v. Tilghman*, 99 U. S. 554, 1878, Supr. Court, Miller, J., to the point that if a case does not arise under any act of Congress, nor depend in any way upon any law of Congress, in relation to patents, but entirely upon a contract relating to a patent, a court of the United States has no jurisdiction of the case.

Decided that a licensee cannot alone maintain a suit in equity for the infringement of a patent. Lowell, J.,

in *Hammond v. Hunt*, 4 Ban. & A. 114, 1879, Dist. Mass., followed the authority of this case. Compare *Littlefield v. Perry*, 21 Wall. 205; *Star Salt Caster Co. v. Crossman*, 3 Ban. & A. 281.

Hitchcock v. Tremaine, 9 Blatchf. C. C. 550, 1872, South. Dist. N. Y., Woodruff, J.

In *La Bar v. Hawkins*, 1 Ban. & A. 436, 1874, Dist. N. J., Nixon, J., it is said that *Hitchcock v. Tremaine* well states the rule that a perfected and patented invention cannot be anticipated by crude and unsuccessful experiments of rival inventors, and the consciences of witnesses strained in their attempts to clothe with living flesh what had always remained an inert and useless skeleton.

Hoe v. Boston Daily Advertiser Co., 14 F. R. 914, 1883, Dist. Mass., Lowell, J.

Is stated in *Hartshorn v. Eagle Shade Roller Co.*, 18 F. R. 91, 1883, Dist. Mass., Lowell, J., to consider the point fully settled that a mistake in the form of an affidavit in application for a patent does not invalidate the patent.

Hogg v. Emerson, 6 How. 457, 483, 1847, Supr. Court, Woodbury, J.

Is said in *Fire Extinguisher Case*, 21 F. R. 44, 1884, Dist. Ind., Morris, J., to have decided that two patents may be united if they relate to a like subject or are in their nature connected together.

Hogg v. Emerson, 11 How. 587, 1850, Supr. Court, Woodbury, J.

The court in this case says it is doubtful on principle whether a patent is invalid which is for two or more entirely separate and independent inventions, but it is cer-

tainly good if they are all connected in design and operation. Cited to this effect in *Sessions v. Romadka*, 21 F. R. 134, 1884, East. Dist. Wis., Dyer, J.

Hollister v. Benedict, &c. Manuf. Co., 113 U. S. 59, 1884, Supr. Court, Matthews, J.

The language of the court as to the exercise of inventive faculty necessary to create a patentable invention, is quoted and adopted in *Kappes v. Hartung*, 23 F. R. 189, 1885, South. Dist. N. Y., Coxe, J.

Also in *New York Bung & Bushing Co. v. Doelger*, 23 F. R. 193, 1885, South. Dist. N. Y., Coxe, J.

The language of the court in this case is referred to as instructive on the subject of patentability, in *Calkins v. Oshkosh Carriage Co.*, 27 F. R. 298, 1886, East. Dist. Wis., Dyer, J.

This decision is said in *Celluloid Manuf. Co. v. Comstock & Cheney Co.*, 27 F. R. 360, 1886, Dist. Conn, Shipman, J., to be a very significant decision; prior to that case, utility of invention constituted the main test of the inventive skill which gave the device patentability. The effect of that decision is to make independent evidence of the existence of inventive skill, apart from inferences of such existence which may be drawn from the novelty and utility of the device, to be of greater importance than had been understood before. The principle of decision in this case was followed in *Thatcher Heating Co. v. Burtis*, 121 U. S. 295, 1886, Supr. Court, Matthews, J. See *Hailes v. Van Wormer*.

Is said in *Sax v. Taylor Iron Works*, 30 F. R. 838, 1887, Dist. N. J., Butler, J., to be a striking instance of a case where the machine embraced both great utility and much ingenious novelty, yet the court held that there was no invention, and did not sustain the patent.

Holly v. Union City, 14 O. G. 5, 1878, Dist. Ind., Drummond, J.

The decision of Drummond and Gresham, JJ., is followed in *Holly v. Vergennes Machine Co.*, 4 F. R. 77, 1880, Dist. Vt., Wheeler, J.

Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co., 21 F. R. 458, 1884, South. Dist. N. Y., Wheeler, J.

Is said in *Paillard v. Bruno*, 29 F. R. 865, 1886, South. Dist. N. Y., Wallace, J., to decide upon motion for preliminary injunction, that when an English patent is forfeited by failure of the patentee to pay the stamp duty required to be paid as a condition of the continuance of the grant beyond the term of three years from its date, the United States patent granted for the same invention does not expire with the forfeiture of the English patent, but extends until the expiration of the original term of the English patent, under § 4887, U. S. R. S.

Horman Patent Manuf. Co. v. Brooklyn City R. Co., 15 Blatchf. C. C. 444, 1879, East. Dist. N. Y., Benedict, J.

Is construed in *Hayes v. Dayton*, 8 F. R. 705, 1880, South. Dist. N. Y., Blatchford, J., as deciding that where a bill in equity on two patents alleged that the defendant was using machines containing in one and the same apparatus the inventions secured by each of the two patents, the bill was good; the court holding that in the absence of any other facts the circumstance that the two transactions complained of were the use in a single machine of the two patented devices connected with the mechanism of the machine, warranted the inference that no prejudice would result to the defendant from the joinder of the two transactions.

Hotchkiss v. Greenwood, 11 How. 248, 1850, Supr. Court, Nelson, J.

Is cited in *Hicks v. Kelsey*, 18 Wall. 674, 1873, Supr. Court, Bradley, J., as deciding that a change of materials in a machine or device is not sufficient change to constitute invention, the purpose being the same, the means of accomplishing it being the same, and the form and mode of operation being the same.

The opinion of Mr. Justice Nelson is quoted in *Goodyear Dental Vulcanite Co. v. Smith*, 1 Ban. & A. 212, 1874, Dist. Mass., Shepley, J., and the case thoroughly examined and said to decide only that a machine made in whole or in part of materials better adapted to the purpose for which it is used than the materials of which the old one is constructed, and for that reason better and cheaper, is not a patentable invention.

Is distinguished and explained in *Goodyear Dental Vulcanite Co. v. Willis*, 1 Ban. & A. 578, 1874, East. Dist. Mich., Emmons, J., and the explanation of Shepley, J., in *Goodyear Dental Vulcanite Co. v. Smith*, 5 O. G. 585, approved; that is, that in *Hotchkiss v. Greenwood*, if the knobs of porcelain or clay had been new, or by a new use in an old combination had accomplished new and useful results, differing not merely in degree but in kind from the result of the old combination, the patent would have been valid. The difficulty in *Hotchkiss v. Greenwood* was, that there the peculiar effect was not new.

Decides that a new and useful improvement in making door and other knobs, of all kinds of clay used in pottery, and of porcelain, by having the cavity in which the screw is inserted by which they are fastened, largest at the bottom of its depth, in form of a dove-tail, and a screw formed therein by pouring in metal in a fused state, was not a patentable invention, Woodbury, J., dissenting. This case is cited in *Reckendorfer v. Faber*,

92 U. S. 352, 1875, Supr. Court, Hunt, J., as showing that the decision of the commissioner of patents is not conclusive as to patentability.

Is said in *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 492, 1876, Supr. Court, Strong, J., to decide that if the patented invention is merely the employment of one substance for the same use in substantially the same manner and with the same effect that other substances had been used for in the manufacture of the same articles, then there is no patentable invention, and (page 496) that *Hotchkiss v. Greenwood* does not decide that no use of one material in lieu of another in the formation of a manufacture can in any case amount to invention. If such substitution involves a new mode of construction, or develops new uses and properties of the article formed, it may be patentable.

Cited in *Phillips v. Detroit*, 4 Ban. & A. 350, 1879, East. Dist. Mich., Brown, J., as establishing the rule followed in the latter case as to a mere change of material not being a patentable invention.

The language of Mr. Justice Nelson as to the non-patentability of a substitution of materials is quoted in *Heald v. Rice*, 104 U. S. 755, 1881, Supr. Court, Matthews, J.

Is cited in *Scott v. Evans*, 11 F. R. 727, 1882, West. Dist. Penn., Acheson, J., as deciding that the substitution of one well-known material for another in the production of a well-known article is not the subject of a patent.

Is cited in *Phillips v. Detroit*, 111 U. S. 607, 1883, Supr. Court, Woods, J., as a case where there was no invention, but a mere substitution of materials.

The language of Mr. Justice Nelson in this case, as to the mere substitution of one known material for another not being a patentable invention, is quoted at length in

New York Bung & Bushing Co. v. Doelger, 23 F. R. 194, 1885, South. Dist. N. Y., Coxe, J.

The dissenting opinion of Woodbury, J., in this case, citing the authorities giving a less stringent interpretation to the rule regarding the patentability of inventions, is referred to in *Leonard v. Lovell*, 29 F. R. 314, 1886, West. Dist. Mich., Severens, J.; but the court in the latter case feel bound to reject the principles of this opinion on account of the recent and authoritative cases supporting a more stringent interpretation on this subject.

Howe v. Abbott, 2 Story, 190, 1842, Dist. Mass., Story, J.

Is said in *Adams v. Loft*, 4 Ban. & A. 497, 1879, Dist. N. J., Nixon, J., not to be distinguishable from the latter case, both being cases of a double use of an old process. In *Howe v. Abbott*, the patent was for curling palm-leaf by a process of machinery which had formerly been used to curl hair. In *Adams v. Loft* the patent was for chewing-gum, prepared by washing it to free it from impurities.

Howe v. Morton, 1 Fisher, 586, 1860, Dist. Mass., Sprague, J.

This case is said, in *American Diamond Rock Boring Co. v. Sheldon*, 4 Ban. & A. 605, 1879. Dist. Vt., Wheeler, J., to have decided, in an elaborate opinion, that an invention was not patented abroad until there was a full and perfect patent, as far as relates to the act of 1839, § 6.

Howe v. Underwood, 1 Fisher, 166, 1854, Dist. Mass. Sprague, J.

The opinion of Sprague, J., in this case, is quoted at length in *Allis v. Buckstaff*, 13 F. R. 890, 1882, East. Dist. Wis., Dyer, J., to the effect that a prior machine, in order to anticipate a subsequent one, must be a complete machine, practically useful; and nothing short of

this will destroy the right of the subsequent inventor to his patent.

Is quoted from, in *Thayer v. Hart*, 20 F. R. 694, 1884, South. Dist. N. Y., Coxe, J., to the effect that testimony of prior use or invention should be strictly scrutinized.

Howes v. Nute, 4 Fisher, 263, 1870, Dist. Mass., Clifford, J.

Recognizes the rule as laid down in *Nevins v. Johnson*, 3 Blatchf. C. C. 80, to the effect that the federal court has jurisdiction in equity of a patent case irrespective of the rights of the patentee to an injunction, and is cited to that effect in *Gordon v. Anthony*, 4 Ban. & A. 258, 1879, South. Dist. N. Y., Blatchford, J.

This case is referred to in *Atwood v. Portland Co.*, 5 Ban. & A. 534, 1880, Dist. Maine, Lowell, J., as being a decision that a suit in equity may be sustained for an account, although an injunction will not be granted, the patent having expired before the suit was brought. See *Root v. Railway Co.*

Hussey v. Bradley, 2 Fisher, 362, 371, 1863, North. Dist. N. Y., Hall, J.

Is said in *Sarven v. Hall*, 9 Blatchf. C. C. 526, 1872, Dist. Conn., Woodruff, J., to give a broader scope to the right of reissue than *Seymour v. Osborne*, 11 Wall. 515.

Hussey v. Bradley, 5 Blatchf. C. C. 210, 1864, North. Dist. N. Y., Hall, J.

Is cited in *Cornelly v. Markwald*, 24 F. R. 187, 1885, South. Dist. N. Y., Wallace, J., as giving the reasons fully why the expense of obtaining a model of the defendant's infringing machine should not be allowed to the plaintiff in his taxable costs.

I.

Imlay v. Norwich & W. R. R. Co., 4 Blatchf. C. C. 227, 1858, Dist. Conn., Ingersoll, J.

Follows the rule laid down in *Nevins v. Johnson*, 3 Blatchf. C. C. 80, that the federal court has jurisdiction of a patent case in equity, irrespective of the right of a patentee in injunction, and is cited to that effect in *Gordon v. Anthony*, 4 Ban. & A. 450, 1879, South. Dist. N. Y., Blatchford, J. See *Root v. Railway Co.*

Is cited in *Vaughan v. East Tennessee, &c. R. R. Co.*, 2 Ban. & A. 540, 1877, East. Dist. Tenn., Brown, J., as similar to *Sickles v. Gloucester Manuf. Co.*, 1 Fisher, 222, and deciding that if an account is prayed for, a federal court has jurisdiction though no injunction is proper, the patent having expired. See *Root v. Railway Co.*

Ingalls v. Tice, 14 F. R. 297, 1882, South. Dist. N. Y., Wallace, J.

Is stated briefly in *Gamewell Fire Alarm Telegraph Co. v. Brooklyn*, 14 F. R. 256, 1882, East. Dist. N. Y., Wallace, J., to the effect that the transfer to the complainant being of the sole exclusive right to sell the patented article in certain specified territory, and the right to the patentee to make and use the invention not passing by the transfer, the complainant did not acquire the legal estate, and the patentee not being made a party of the suit, a demurrer for that reason was sustained.

Ingersoll v. Jewett, 16 Blatchf. C. C. 378, 1879, North. Dist. N. Y., Wallace, J.

Is stated and explained briefly in *Brush v. Naugatuck R. Co.*, 24 F. R. 373, 1885, Dist. Conn., Shipman, J.

Isaacs v. Abrams, 14 O. G. 862, 1878, Dist. Mass., Lowell, J.

“A change in the form of a machine or instrument, though slight, if it works a successful result not before accomplished in a similar way, in the art to which it is applied, or in any other, is patentable.” Quoted in *Washburn, &c. Manuf. Co. v. Haish*, 4 F. R. 908, 1880, North. Dist. Ill., Drummond, J., upon the question of patentability.

Ives v. Hamilton, 92 U. S. 426, 1875, Supr. Court, Bradley, J.

Is cited in *Hamilton v. Rollins*, 3 Ban. & A. 158, 1877, Dist. Minn., Nelson, J., as containing a description of the invention described in the Hamilton patent, No. 51, 310.

J.

Jacobs v. Hamilton County, 1 Bond, 500, 1861, South. Dist. Ohio, *per Curiam*.

Is said in *May v. Mercer County*, 30 F. R. 249, 1887, Dist. Ky., Barr, J., to be the only case known to him which holds that a county is not liable for infringement of a patent right by its use.

Is cited in *May v. Logan County*, 30 F. R. 260, 1887, North. Dist. Ohio, Jackson, J., as holding that a county is not liable for infringement of a patent right; and it is said that the case of *Jacobs v. Hamilton County*, has never been recognized or followed, and cannot be sustained upon any sound principle.

James v. Campbell, 104 U. S. 356, 1882, Supr. Court, Bradley, J.

Is said in *Wing v. Anthony*, 106 U. S. 146, 1882, Supr. Court, Woods, J., to decide that letters-patent for a machine cannot be reissued for the process of operating

that class of machines ; for if the claim is anything more than for the use of the particular machine, it is for a different invention. See *Powder Co. v. Powder Works*, 98 U. S. 126.

“If by actual inadvertence, accident, or mistake innocently committed, the claim does not fully assert or define the patentee’s right in the invention specified in the patent, a speedy application for its correction before adverse rights have accrued may be granted, as we have explained in the recent case of *Miller v. Brass Co.*” Quoted in *Combined Patents Can Co. v. Lloyd*, 11 F. R. 151, 1882, East. Dist. Penn., Butler, J.

Is cited in *Sheriff v. Fulton*, 12 F. R. 139, 1882, West. Dist. Penn., Acheson, J., as settling the law that the acquiescence of a patentee for a long period, *e. g.*, nine years, in the terms of the patent as originally granted, estops him from claiming a reissue on the ground of mistake.

This case is stated at length in *MacKay v. Jackman*, 12 F. R. 620, 1882, South. Dist. N. Y., Wheeler, J.

In *Lorillard v. McAlpin*, 14 F. R. 112, 1882, South. Dist. N. Y., Blatchford, J., the court cited the former case as throwing much doubt upon the validity of the reissue in the latter case, and a motion for preliminary injunction was therefore denied.

Was approved in *Clements v. Odorless Apparatus Co.*, 109 U. S. 649, 1883, Supr. Court, Blatchford, J.

Is said in *Hollister v. Benedict Manuf. Co.*, 113 U. S. 67, 1884, Matthews, J., to declare authoritatively that the right of a patentee to a monopoly excludes the United States Government as well as all others from the use of the invention, but to query whether a suit could be maintained against public officers for such use, or whether the United States might not be sued on an implied promise in the Court of Claims.

Is cited to the same effect in *Coon v. Wilson*, 113 U. S. 277, 1884, Supr. Court, Blatchford, J., as in *Combined Patents Can Co. v. Lloyd*, *supra*.

“Of course, if by actual inadvertence, or mistake innocently committed, the claim does not fully assert or define the patentee’s right in the invention specified in the patent, a speedy application for its correction before adverse rights have accrued may be granted.” Quoted as authorizing a reissue in *Stutz v. Armstrong*, 20 F. R. 845, 1884, West. Dist. Penn., Acheson, J., and it is said that the court, in *James v. Campbell*, evidently regarded the accrual of adverse rights as of great consequence in determining whether a reissue would be valid.

Governed the decision in the case of *Phillips v. Risser*, 26 F. R. 312, 1885, West. Dist. Ill., Blodgett, J.

This case was urged upon the court in *Eastern Paper Bag Co. v. Standard Paper Bag Co.*, 30 F. R. 65, 1887, Dist. Mass., Colt, J., as sustaining the proposition that the omission of an inventor to claim his process invention in his machine patent is in law a dedication of process invention to the public, but *James v. Campbell* is distinguished by the court as dealing with the subject of reissues, and therefore not an authority in the latter case.

Jenkins v. Johnson, 9 Blatchf. C. C. 516, 1872, South. Dist. N. Y., Blatchford, J.

The composition in this case is considered and distinguished in *Clarke v. Johnson*, 4 F. R. 440, 1880, East. Dist. N. Y., Benedict, J., from the composition in the latter case.

Jones v. Morehead, 1 Wall. 155, 1863, Supr. Court, Miller, J.

Is stated briefly in *Root v. Railway Co.*, 105 U. S. 197, 1881, Supr. Court, Matthews, J., as applying the

rule as to measure of damages laid down in *Seymour v. McCormick*, 16 How. 480, 1853; that is, that if the plaintiff does not prove actual damages, he will have nominal damages. *Jones v. Morehead* was a bill in equity.

Jones v. Sewell, 6 Fisher, 343, 1873, Dist. Maine, Clifford, J.

The opinion of Mr. Justice Clifford correctly says that it is a settled law that mere forbearance to apply for a patent during the progress of experiments, and until the party has perfected his invention and tested its value by actual practice, affords no just ground for presuming an abandonment. *Locomotive Engine Safety Truck Co. v. Pennsylvania R. R. Co.*, 1 Ban. & A. 483, 1874, East. Dist. Penn., Strong, J.

“Inventions lawfully secured by letters-patent are the property of the inventors, and as such the franchise and the patented product are as much entitled to legal protection as any other species of property real or personal; they are, indeed, property even before they are patented, and continue to be such, without that protection, until the inventor abandons the same to the public.” Quoted in *Butler v. Ball*, 28 F. R. 754, 1886, North. Dist. Ohio, Welker, J.

Jordan v. Dobson, 2 Abb. (U. S.) 398, 416, 1870, East. Dist. Penn., Strong, J.

Follows the rule laid down in *Nevins v. Johnson*, 3 Blatchf. C. C. 80, that the federal court has jurisdiction in equity of a patent suit, irrespective of the rights of the patentee to an injunction, and is cited to that effect in *Gordon v. Anthony*, 4 Ban. & A. 258, 1879, South. Dist. N. Y., Blatchford, J.

Judson v. Cope, 1 Fisher, 623, 1860, South. Dist. Ohio, Leavitt, J.

Is cited in *Illingworth v. Spaulding*, 9 F. R. 613,

1881, Dist. N. J., Nixon, J., as being a case which discusses, but does not decide, the question whether a defence, offering to prove the foreign use of an invention and knowledge of such use by persons residing in this country, as invalidating the complainant's patent, is sufficient defence. The question is said, in *Illingworth v. Spaulding*, never to have been decided.

K.

Kelleher v. Darling, 14 O. G. 673, 678, 1878, Dist. Maine, Clifford, J.

The opinion of Mr. Justice Clifford, to the effect that the question of infringement in the case of machines, manufactures, and products is a question of fact, and ordinarily is determined by the comparison of the exhibit made by the respondent with the mechanism described in the complainant's patent, is quoted in *Burdett v. Estey*, 4 Ban. & A. 143, 1879, Dist. Vt., Wheeler, J.

Kells v. McKenzie, 9 F. R. 284, 1881, East. Dist. Mich., Brown, J.

Is explained in *Searls v. Worden*, 11 F. R. 502, 1882, Dist. Mich., Brown, J., to have followed the later and sounder decisions of the Supreme Court, that a reissue of a patent is not valid for everything which might have been claimed in the original, and that its validity does not depend wholly upon the fact that the new features attempted to be secured thereby were suggested in the models, drawings, or specifications of the original patent; and if the original patent covers only a portion of a machine, a reissue which covers a distinct and different portion is not valid.

Is said in *Flower v. Detroit*, 22 F. R. 295, 1884, East. Dist. Mich., Brown, J., to have examined all the

cases up to that time, and to conclude that the court is not at liberty to review the action of the commissioner of patents in granting reissues on the ground of accident, inadvertence, or mistake. But in *Flower v. Detroit* it is queried whether later decisions of the Supreme Court have not enabled the courts to inquire whether there was such accident, inadvertence, or mistake, as would justify a reissue. The case of *Kells v. McKenzie* is also said to follow the tenor of the Supreme Court at that time, limiting reissues to that portion of the machine covered by the claim of the original patent, although the invention covered by the reissue may be described in the original specifications and drawings.

Kendall v. Winsor, 21 How. 322, 1858, Supr. Court, Daniel, J.

A part of the opinion of the court in this case is quoted in *Planing Machine Co. v. Keith*, 101 U. S. 484, 1879, Supr. Court, Strong, J., to the effect that an inventor may abandon his invention to the public either by express dedication or by conduct, such as knowingly acquiescing in the use by others of his invention, or he may forfeit his right by wilful or negligent postponement of his claims. In *Planing Machine Co. v. Keith* it is said that such abandonment may be as well after an application, rejected or withdrawn, as before.

Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S. 274, 278, 1877, Supr. Court, Bradley, J.

Is referred to in *Railroad Co. v. Mellon*, 104 U. S. 118, 1881, Supr. Court, Woods, J., as showing how important is a claim in an application for a patent. *Railroad Co. v. Mellon* decides that the claim limits the scope of the patent, although it may be illustrated but not enlarged by the other parts of the specification.

Is affirmed in *Duff v. Sterling Pump Co.*, 107 U. S. 639, 1882, Supr. Court, Blatchford, J.

The language of the court in this case to the effect that a patentee is bound by the claim in his patent, when it is clear and distinct, and cannot show that his invention is broader than the terms of his claim, is quoted in *Blades v. Rand*, 27 F. R. 97, 1886, North. Dist. Ill., Blodgett, J.

King v. Hammond, 4 Fisher, 488, 1871, North. Dist. Ohio, Sherman, J.

Is quoted in *Gottfried v. Phillip Best Brewing Co.* 5 Ban. & A. 17, 1879, East. Dist. Wis., Dyer, J., to the effect that the patent law protects simplicity and economy of construction as against prior and complex combinations.

King v. Mandelbaum, 8 Blatchf. C. C. 468, 1871, South. Dist. N. Y., Blatchford, J.

The construction of the King patent, reissue No. 3,000, is quoted and adopted in *Kursheedt v. Werner*, 2 Ban. & A. 86, 1875, South. Dist. N. Y., Blatchford, J.

King v. Werner, 12 Blatchf. C. C. 270, 1874, South. Dist. N. Y., Blatchford, J.

The construction of the King patent, reissue No. 3,000, is commented on in *Kursheedt v. Werner*, 2 Ban. & A. 87, 1875, South. Dist. N. Y., Blatchford, J.

Klein v. Russell, 19 Wall. 433, 1873, Supr. Court, Swayne, J.

Was not a case where the question before the court was whether the reissue was invalid because not for the same invention as the patent, that point not being raised in the lower courts. In *Russell v. Dodge*, 93 U. S. 464, 1876, Supr. Court, Field, J., a suit involving the same patent, it is said that what was said in *Klein v. Russell* as to the character of the first claim, so far as it conflicts with the construction given that claim in *Russell v. Dodge*, does not meet with the approval of

the court, after the extended consideration the subject had since received.

“The court should proceed in a liberal spirit, so as to sustain the patent and the construction claimed by the patentee himself, if this can be done consistently with the language he has employed.” Quoted in *Bradley v. Dull*, 19 F. R. 915, 1884, West. Dist. Penn., Acheson, J.

Kneass v. Schuylkill Bank, 4 Wash. 9, 1820, Dist. Penn., Washington, J.

Decides that the use of steel plates instead of copper in engraving is patentable. In *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 497, 1876, Supr. Court, Strong, J., it is said that the case depends on the fact that a superior product has been the result of the substitution, a product that has new capabilities and performs new functions.

Is stated briefly in *Andrews v. Wright*, 3 Ban. & A. 331, 1878, Dist. Minn., Nelson, J., and the opinion of the court quoted to show that that case held the patent in question to be one for a process, that is, printing with copper-plates on bank-notes, and not a patent for an effect, that is, security against counterfeits.

Knight v. Baltimore & Ohio R. R. Co., 3 Fisher, 1, 1840, Dist. Md. Taney, C. J.

Is cited in *Atlantic Giant Powder Co. v. California Powder Works*, 2 Ban. & A. 149, 1875, Dist. Cal., Field, J., as controlling the decision in that case to the effect that a second reissue was void, because not for the same invention as contained in the first reissue.

Kuhl v. Mueller, 21 F. R. 510, 1884, South. Dist. Ohio, Sage, J.

Is explained in *California Paving Co. v. Schalicke*, 119 U. S. 406, 1886, Supr. Court, Blatchford, J.

L.

Langdon v. De Groot, 1 Paine, 203, 1822, Dist. N. Y., Livingston, J.

Is cited in *Alcott v. Young*, 4 Ban. & A. 201, 1879, South. Dist. N. Y., Blatchford, J., as being similar to the latter case, being a case involving an unpatentable invention.

Is cited in *Pratt v. Rosenfeld*, 5 Ban. & A. 489, 1880, South. Dist. N. Y., Wheeler, J., on the question what utility in an invention is necessary to entitle the inventor to a patent.

Leggett v. Avery, 101 U. S. 256, 1879, Supr. Court, Bradley, J.

This case is construed in *Union Met. Cart. Co. v. U. S. Cart. Co.*, 7 F. R. 346, 1881, Dist. Mass., Lowell, J., to have decided that if a patentee obtains a patent upon his solemn admission of certain facts, he shall never thereafter be permitted to controvert them. *Leggett v. Avery* was urged upon the court in the latter case as converting the disclaimer filed in that case by the plaintiff into an estoppel; but the court considered that it was bound by the prior decision of Judge Shepley, holding that the same patent was valid in spite of the disclaimer, as the disclaimer was merely as to the propriety of inserting a certain clause in the descriptive part of the original.

In *Atwater Manuf. Co. v. Beecher Manuf. Co.*, 8 F. R. 609, 1881, Dist. Conn., Shipman, J., the evidence is stated to have been too scanty to bring the latter case within the doubt expressed by the Supreme Court in the former case, as to the validity of a disclaimer.

Is examined in *Kells v. McKenzie*, 9 F. R. 291, 1881, East. Dist. Mich., Brown, J., and it is said that

the decision in the former case is not easily reconcilable with that of *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 486, and other cases there cited; and the decision in *Leggett v. Avery* is not followed in *Kells v. McKenzie*, on the point that a reissue which includes a rejected claim of the original application is invalid.

The opinion of the court in this case is quoted from at length by the court in *Edgerton v. Furst & Bradley Manuf. Co.*, 9 F. R. 453, 1881, North. Dist. Ill., Blodgett, J., to the effect that in a reissue a rejected claim of an original application cannot be included if the patentee has acquiesced in the rejection.

Is quoted to the point that the rejection of a claim cannot justly be regarded as a matter of inadvertence or mistake; and even though it was, the applicant should seem to be estopped from setting it up on an application for a reissue in *Arnheim v. Finster*, 26 F. R. 279, 1886, South. Dist. N. Y., Coxe, J.

Is said in *Boland v. Thompson*, 26 F. R. 635, 1886, South. Dist. N. Y., Coxe, J., to be authority for the proposition that when a claim has been examined and rejected by the commissioner, the rejection acquiesced in by the patentee or his solicitor, and the patent reissued without the claim, there is no inadvertence or mistake which will entitle the patentee to a reissue.

The language of Mr. Justice Bradley in this case, upon the subject of limitations imposed upon a patentee by his disclaimer, is quoted at length in *Dobson v. Lees*, 30 F. R. 626, 1887, East. Dist. Penn., *per Curiam*.

Le Roy v. Tatham, 14 How. 156, 1852, Supr. Court, McLean, J.

Is quoted from in *Le Roy v. Tatham*, 22 How. 137, 1859, Supr. Court, McLean, J., to the effect that in

the view taken by the court in the construction of the patent it was not material whether the mere combination of machinery referred to was similar to the combination used by the Hansons, because the originality did not consist in the novelty of the machinery, but in bringing a newly-discovered principle into practical application by which a useful article is produced, and wrought pipe is made, as distinguished from cast pipe.

Is distinguished in *Arkell v. Hurd Paper Bag Co.*, 7 Blatchf. C. C. 477, 1870, North. Dist. N. Y., Woodruff, J., from the latter case, as the patent is for an improved product, and not for a principle.

The opinion of Mr. Justice McLean in this case, is quoted in *McCloskey v. Du Bois*, 9 F. R. 38, 39, 1881, South. Dist. N. Y., Wheeler, J., to the effect that a patent for an effect is not valid.

Lightner v. Brooks, 2 Cliff. 287, 1864, Dist. Mass., Clifford, J.

It is said in *United Nickel Co. v. Worthington*, 13 F. R. 393, 1882, Dist. Mass., Lowell, J., that in the former case it was conceded, but without being decided that a director of a company who has ordered an act which is an infringement of a patent, subjects himself to action; but this proposition is said in the latter case not to be the law.

Lightner v. Kimball, 1 Lowell, 211, 1868, Dist. Mass., Lowell, J.

Is distinguished in *American Cotton Tie Supply Co. v. McCready*, 4 Ban. & A. 599, 1879, South. Dist. N. Y., Blatchford, J.

It is said in *United Nickel Co. v. Worthington*, 13 F. R. 393, 1882, Dist. Mass., Lowell, J., that the former case decided that the director of a company who has ordered an act done which is an infringement of

a patent, subjects himself to action therefor; but in the latter case Lowell, J., says that upon further examination he thinks the law is not so.

Littlefield v. Perry, 21 Wall. 205, 1874, Supr. Court, Waite, C. J.

In *Hartell v. Tilghman*, 99 U. S. 551, 1878, Supr. Court, Miller, J., *Littlefield v. Perry* is said to be in accord with *Wilson v. Sandford*, 10 How. 99, which decides that when a case depends on the rights arising under a contract relating to a patent, and does not arise under the patent statutes, nor depend upon the construction of any law in relation to patents, — *e. g.*, a bill in equity to enforce a license, — a court of the United States in equity has no jurisdiction of the case unless the citizenship of the parties gives jurisdiction. *Littlefield v. Perry* and *Wilson v. Sandford* are said to give the only authoritative construction of the statute on this point, and are followed in *Hartell v. Tilghman*.

Is said in *Hammond v. Hunt*, 4 Ban. & A. 114, 1879, Dist. Mass., Lowell, J., to decide that a licensee himself may sustain a patent suit against the patentee, and others jointly trespassing with him knowing of the license, although citizens of the same State as the licensee. The decision in *Littlefield v. Perry*, overrules the decision in *Hill v. Whitcomb*, 1 Holmes, 317, as to the point that the jurisdiction of the circuit court in such a case depends on the suit being maintained under the patent law, and is cited to that effect in *Hammond v. Hunt*, *supra*.

“A mere licensee cannot sue strangers who infringe. In such cases redress is obtained through or in the name of the patentee.” Quoted in *Nelson v. McMann*, 4 Ban. & A. 211, 1879, South. Dist. N. Y., Blatchford, J.

Is cited in *Steam Stone Cutter v. Windsor Manuf. Co.*, 4 Ban. & A. 453, 1879, Dist. Vt., Wheeler, J., as

a case in which interest upon profits of an infringement was disallowed, with the remark that profits actually realized were usually, in a case like that, the measure of unliquidated damages; that circumstances might arise which would justify the addition of interest in order to give a complete indemnity for losses sustained by wilful infringement, but that ordinarily interest would not be allowed.

It is said in *Burdett v. Estey*, 5 Ban. & A. 313, 1880, Dist. Vt., Wheeler, J., that the former case intimates that interest may be allowed upon profits actually realized by deliberate and intentional infringement of a patent in order to give complete indemnity for the wrong; and the court in *Burdett v. Estey* accordingly allowed interest upon profits in that case.

Is explained in *Root v. Railway Co.*, 105 U. S. 199, 1881, Supr. Court, Matthews, J., as a case where the measure of damages for infringement of a patent in a suit in equity is the profits received by the infringer. This case does not involve the question of jurisdiction.

This case is stated briefly, in *Lilienthal v. Washburn*, 8 F. R. 709, 1881, East. Dist. La., Pardee, J., as sustaining the jurisdiction of a federal court in a suit in equity between the assignor and assignee of a patent, although the validity of the patent is not contested, and all the parties are citizens of the same State. See now *Root v. Railway Co.*

“The statutory power of assignment has been so construed by the courts as to confine it to the transfer of an entire patent, an undivided part thereof, or the entire interest of the patentee or the undivided part thereof, throughout a certain portion of the United States.” Quoted in *Gamewell Fire Alarm Telegraph Co. v. Brooklyn*, 14 F. R. 256, 1882, East. Dist. N. Y., Wallace, J.

Is distinguished in *Dobson v. Dornan*, 118 U. S. 16, 1885, Supr. Court, Blatchford, J., from the latter case as to the interlocutory decree for profits and damages.

Livingston v. Jones, 2 Fisher, 207, 1861, West. Dist. Penn., Grier, J. .

Mr. Justice Grier's decision that the court cannot subdivide an improvement in a machine into its elements, and give a complainant only the value of his feature in the improvement, was overruled by Emmons, J., in *Ingels v. Mast*, 2 Ban. & A. 1875, East. Dist. Ohio, and the complainant allowed profits only on his addition to the machine.

The opinion of Mr. Justice Grier is quoted, to the effect that if the inventor's profit consists in the general use of his invention by all who pay a license fee, then the license fee is the measure of damages, in *Vaughan v. Central Pacific R. R. Co.*, 3 Ban. & A. 31, 1877, Dist. Cal., Sawyer, J.

Livingston v. Van Ingen, 1 Paine, C. C. 45, 1811, Dist. N. Y., Livingston, J.

Is stated in *Root v. Railway Co.*, 105 U. S. 191, 1881, Supr. Court, Matthews, J., as a patent case which was dismissed from the Circuit Court of the United States on the ground that the court had no jurisdiction of the subject-matter, Congress at that time having passed no law conferring jurisdiction in patent cases upon the federal court in pursuance of the power given by the Constitution.

Livingston v. Woodworth, 15 How. 546, 1853, Supr. Court, Daniel, J.

Is said in *Dean v. Mason*, 20 How. 203, 1857, Supr. Court, McLean, J., to state the true rule of damages for the infringement of a patent to be the amount of profits

received by unlawful use of the machines, as this is in general the damage done to the owner of the patent.

Is explained in *Sayles v. Richmond, &c. R. R. Co.*, 4 Ban. & A. 244, 1879, East. Dist. Va., Hughes, J., as not deciding that an infringer is a trustee of the profits in such a way as to support the jurisdiction in equity in a federal court when no injunction is asked.

This case is said in *Root v. Railway Co.*, 105 U. S. 194, 1881, Supr. Court, Matthews, J., to have raised for the first time, under the act of 1836, the question as to the rule for computing the profits of an infringement of a patent upon a decree for an account. The master allowed not for actual profit, but for such as the infringer might have made by due diligence; the Supreme Court reversed this rule and allowed only for actual profit.

Lord v. Whitehead, 24 F. R. 801, 1885, Dist. Mass., Colt, J.

Governed the decision in *Consolidated Safety Valve Co. v. Ashton Valve Co.*, 26 F. R. 319, 1886, Dist. Mass., Colt, J.

Also said, in *Adams v. Bridgewater Iron Co.*, 26 F. R. 325, 1886, Dist. Mass., Colt, J., to decide that in cases based upon tortious acts, mere intricacy of the account does not furnish ground for equitable interference.

Lowell v. Lewis, 1 Mas. 182, 1817, Dist. Mass., Story, J.

Is referred to in *Webster Loom Co. v. Higgins*, 105 U. S. 588, 1881, Supr. Court, Bradley, J., as deciding that an insufficient specification in a patent, if made with fraudulent intent to deceive the public, is a defence to a suit on the patent. The fraudulent intent is held necessary in this case, although not so in *Grant v. Raymond*, 6 Pet. 218 (q. v.).

Lynch v. Dryden, 3 O. G. 407, 1873, Commissioner's Decision.

The remark of Commissioner Leggett in the above case, to the effect that neither the courts nor the commissioner have attempted to define a patentable combination so exactly as to be suited to universal application, broad enough to include all that is legitimate, and narrow enough to exclude all else, is quoted in *Hoffman v. Young*, 5 Ban. & A. 318, 1880, East. Dist. Penn., Butler, J.

M.

Magic Ruffle Co. v. Douglass, 2 Fisher, 330, 1863, South. Dist. N. Y., Shipman, J.

Is referred to in *Magic Ruffle Co. v. Elm City Co.*, 2 Ban. & A. 160, 1875, Dist. Conn., Shipman, J., as explaining the distinguishing feature in the invention in that suit.

Magic Ruffle Co. v. Elm City Co., 13 Blatchf. C. C. 151, 1875, Dist. Conn., Shipman, J.

Explained in *Atwood v. Portland Co.*, 5 Ban. & A. 534, 1880, Dist. Maine, Lowell, J., as being a case where the jurisdiction in equity was sustained for an account under a contract relating to a patent, but without injunction, the patent having expired. See now *Root v. Railway Co.*

This case is considered in the *National Manuf. Co. v. Meyers*, 7 F. R. 357, 1881, South. Dist. Ohio, Swing, J. The former case is cited in Bump on Patent Law, page 140, as an authority that the defence of the invalidity of a patent and a license are inconsistent; but the court in the latter case explains the case of *Magic Ruffle Co. v. Elm City Co.* as being an action upon a contract and agreement for a license to enforce the provisions of

the contract, thereby creating an estoppel. The court in *National Manuf. Co. v. Meyers* held that the above defences were not inconsistent.

Mahn v. Harwood, 112 U. S. 354, 1884, Supr. Court, Bradley, J.

A patent "cannot be lawfully reissued for the mere purpose of enlarging the claim, unless there has been a clear mistake inadvertently committed in the wording of the claim, and the application for a reissue is made within a reasonably short period after the original patent was granted." Quoted in *Coon v. Wilson*, 113 U. S. 277, 1884, Supr. Court, Blatchford, J.

The opinion of Mr. Justice Bradley is quoted from in *Wollensak v. Reiher*, 115 U. S. 100, 1884, Supr. Court, Matthews, J., to the effect that a reissue to correct a mistake must be applied for in a reasonable time; and if not, the commissioner of patents exceeds his authority in granting it, and the reissue is void. The courts are to judge what time is reasonable; and two years was held not to be.

The opinion of the court in this case is quoted in *Gardner v. Herz*, 118 U. S. 191, 1885, Supr. Court, Blatchford, J., to the effect that other defences besides those given by statute may arise in a patent case, as, e. g., the patentability of the invention; and this is a question of law upon which the courts are not bound by the decision of the commissioner of patents.

Quoted in *Bate Refrigerating Co. v. Eastman*, 24 F. R. 649, 1885, South. Dist. N. Y., Shipman, J.

And in *Shirley v. Mayer*, 25 F. R. 40, 1885, East. Dist. N. Y., Benedict, J., to the same effect as in *Coon v. Wilson*, *supra*.

Is said in *Western Union Telegraph Co. v. Baltimore & Ohio Telegraph Co.*, 25 F. R. 34, 1885, South. Dist. N. Y., Wallace, J., to decide a rule which covers two

propositions: the first, that a patent cannot be lawfully reissued for the mere purpose of enlarging the claim, unless there has been a clear mistake inadvertently committed in the wording of the claim, and the application for a reissue is made within a reasonably short time; second, that the question whether there has been such an inadvertent mistake is in general a matter of fact for the commissioner to decide; but whether the application is made in reasonable time is matter of law which the court may determine by comparing the reissued patents with the original, and, if necessary, with the records in the patent office when presented by the record.

Is quoted from in *Ives v. Sargent*, 119 U. S. 661, 1886, Supr. Court, Matthews, J., to the effect that if a patentee has not claimed all he is entitled to, he is bound to do so in a reasonable time; and if a commissioner of patents issues a reissue after that time, he exceeds his authority, and the reissued patent is void.

Is said in *Arnheim v. Finster*, 26 F. R. 279, 1886, South. Dist. N. Y., Coxe, J., to have decided that the reissue was invalid, because the mistake, if any, was between the inventor and his solicitor in not taking an appeal, and was not a mistake contemplated by the statute. The language of the court to this effect in *Mahn v. Harwood* is quoted at length in *Arnheim v. Finster*.

Is said in *Boland v. Thompson*, 26 F. R. 635, 1886, South. Dist. N. Y., Coxe, J., to be authority for the proposition that when a claim has been examined and rejected by the commissioner, the rejection acquiesced in by the patentee or his solicitor, and the patent reissued without the claim, there is no inadvertence, accident, or mistake which will entitle the patentee to a reissue.

Governed the decision of *Hoe v. Knap*, 27 F. R. 212, 1886, North. Dist. Ill., Blodgett, J.

This case was urged upon the court in *Eastern Paper Bag Co. v. Standard Paper Bag Co.*, 30 F. R. 65, 1887, Dist. Mass., Colt, J., as sustaining the proposition that the omission of an inventor to claim his process invention in his machine patent is in law a dedication of the process invention to the public; but *Mahn v. Harwood* is distinguished by the court as dealing with the subject of reissues, and therefore not an authority in the latter case.

Manning v. Cape Ann Isinglass Co., 4 Ban. & A. 612, 1883, Supr. Court, Woods, J.

Is distinguished in *Perkins v. Nashua, &c. Paper Co.*, 5 Ban. & A. 397, 1880, Dist. N. H., Lowell, J., from the latter case, and the law on the point involved in this decision is interpreted as to the question of public use to be, that actual knowledge of the invention need not have been derived by any one interested to practise it; but that it is enough if any one or more persons not under pledge of secrecy saw the invention practised, or even might have seen it if they had used their opportunity, provided it was in fact practised in the ordinary way after being completed.

Manufacturing Co. v. Cowing, 105 U. S. 253, 1882, Supr. Court, Waite, C. J.

Is said in *Dobson v. Hartford Carpet Co.*, 114 U. S. 445, 1884, Supr. Court, Blatchford, J., to be a case falling within the last clause of the rule in *Garretson v. Clark* (q. v.), and to be recognized as an exceptional case, since the whole demand for the patented article (an oil-pump in the oil regions) was confined to a small locality.

Is said in *Reed v. Lawrence*, 29 F. R. 918, 1886, West. Dist. Mich, Severens, J., to be an excellent illustration of the rule that when the patented feature which has been infringed by the defendant is one

which was the sole element of value in the thing manufactured, so that but for it the article would not be marketable because not sufficiently useful for the purpose for which it was intended, the defendant is liable for the whole profits of manufacture.

Is said in *Fay v. Allen*, 30 F. R. 447, 1887, North. Dist. N. Y., Coxe, J., to be an exceptional case, the patent being a pump for a special purpose in a particular locality, and the marketable value of the machine being solely due to the patented invention.

Many v. Jagger, 1 Blatchf. C. C. 372, 1848, North. Dist. N. Y., Blatchford, J.

The decision in this case was, that a claim for a manner of constructing a certain kind of wheels, covered all wheels constructed in that manner, of whatever shape. This principle was applied to a claim for the "process of constructing wells," and the patent held to cover all wells constructed in that manner, in *Andrews v. Carman*, 2 Ban. & A. 287, 1876, East. Dist. N. Y., Benedict, J.

Is said in *Planing Machine Co. v. Keith*, 101 U. S. 493, 1879, Supr. Court, Strong, J., to settle the question that only the names of those using or inventing an anticipating machine need be pleaded, and not those who will prove such prior use under the statute.

Is cited in *Woodbury Patent Planing Co. v. Keith*, 4 Ban. & A. 103, 1879, Dist. Mass., Lowell, J., to the point that under the rule in § 4920, U. S. R. S., only those persons who have invented or used the machine or improvement, and not those who are to testify to such invention or use, must be pointed out in the answer, setting up prior use or invention.

The remark of Mr. Justice Nelson in this case, that the description of the invention by the patentee in his own language affords the highest evidence of the thing

or instrument which he claims to have discovered, is quoted in *Eagleton Manuf. Co. v. West, &c. Manuf. Co.*, 5 Ban. & A. 479, 1880, South. Dist. N. Y., Wheeler, J.

Marsh v. Dodge & Stevenson Manuf. Co., 6 Fisher, 562, 1873, North. Dist. N. Y., Woodruff, J.

In *Gilbert, &c. Manuf. Co. v. Tirrell*, 1 Ban. & A. 317, South. Dist. N. Y., Woodruff, J., explains his use of the phrase "mere change of location is not invention," by the subsequent parts of the opinion, to the effect that if the change of location involves the employment of new devices to adapt the apparatus for use in its new position, and a beneficial result is produced, then the location in connection with the new devices is patentable.

Marsh v. Seymour, 97 U. S. 348, 1877, Supr. Court, Clifford, J.

Is construed in *Root v. Railway Co.*, 105 U. S. 202, 1881, Supr. Court, Matthews, J., with *Elizabeth v. Pavement Co.*, 97 U. S. 126, 1877, to show that since the act of 1870, in a suit in equity a decree for damages of a compensatory character instead of the ordinary decree for profits may be made, if the business of the infringer was so loosely carried as that no profit was made in it.

Matthews v. Shoneberger, 4 F. R. 635, 1880, South. Dist. N. Y., Blatchford, J.

The construction of the Albertson patent, No. 2386, in this case is given at length in *Matthews v. Chambers*, 6 F. R. 878, 1881, West. Dist. Penn., Acheson, J., and the court held that that construction limited the patent to the exact construction of the device shown, as the only one consistent with its validity.