

Maxheimer v. Mayer, 9 F. R. 460, 1881, South. Dist. N. Y., Wheeler, J.

Is cited in *Sessions v. Romadka*, 21 F. R. 131, 1884, East. Dist. Wis., Dyer, J., as a case where two distinct inventions were held to be rightly joined in one patent, being designed to co-operate together for the same end or purpose.

May v. Fon du Lac County, 27 F. R. 695, 1886, East. Dist. Wis., Dyer, J.

Is said in *May v. Mercer County*, 30 F. R., 249, 1887, Dist. Ky., Barr, J., to hold a county liable for infringement of a patent. See *Collins v. Peebles*.

May v. Johnson County, MSS., Ind. 7th Circuit, Davis, J.

Is said in *May v. Mercer County*, 30 F. R. 249, 1887, Dist. Ky., Barr, J., to hold a county liable for infringement of a patent.

McClurg v. Kingsland, 1 How. 202, 1843, Supr. Court, Baldwin, J.

Is cited in *Pierson v. Eagle Screw Co.*, 3 Story, 405, 1844, Dist. R. I., Story, J., upon the construction of the patent act of 1839, ch. 88, § 7.

Is interpreted in *Wilson v. Rousseau*, 1 Blatchf. C. C. 38, 1845, North. Dist. N. Y., *per Curiam*, to the same effect as in *Day v. Union India Rubber Co.*, *infra*.

Is explained in *Day v. Union India Rubber Co.*, 3 Blatchf. C. C. 504, 1856, South. Dist. N. Y., Hall, J., as holding that the defendants who had used an invention before the patent had been applied for, with the inventor's consent, founded upon sufficient consideration, had the right to continue to use the invention after the inventor had obtained a patent and assigned it to the plaintiff.

The remark of Mr. Justice Baldwin, *obiter*, that use in a factory is public use, is quoted in *Perkins v. Nashua, &c. Paper Co.*, 5 Ban. & A. 397, 1880, Dist. N. H., Lowell, J.

This case is considered, in reference to the construction it applies to § 7 of the patent act of 1839, providing that every person or corporation may use, and sell to others to be used, any specific machine, manufacture, or composition of matter which they have purchased or constructed prior to the application for a patent, in *Brickill v. New York*, 7 F. R. 481, 1880, South. Dist. N. Y., Wheeler, J. ; s. c. 5 Ban. & A. 547 ; and in the latter case it is said not to be probable that *McClurg v. Kingsland* would be followed beyond cases of this class on the same statute, and also that the language of that case, although broad enough to cover all patents, is to be understood to be considered with reference to the very case before the court.

The principles of this case are said, in *Worley v. Tobacco Co.*, 184 U. S. 344, 1881, Supr. Court, Woods, J., to be, that if a person employed in the factory of another, while receiving wages, makes experiments at the expense and in the factory of his employer, has his wages increased in consequence of the useful results of his experiments, makes the article invented, and permits his employer to use it, no compensation for its use being paid or demanded, and then obtains a patent for it, the patent is invalid and void. This principle is approved in *Worley v. Tobacco Co.*

It is said in *New Process Fermentation Co. v. Maus*, 20 F. R. 729, 1884, North. Dist. Ind., Drummond, J., that this case sustained a patent for a process for casting iron rolls, although there was not much discussion upon the patentability of the claim.

Is cited in *Duffy v. Reynolds*, 24 F. R. 858, 1885, Dist. N. J., Nixon, J., as explaining that § 4899, U. S. R. S. has a twofold object, — to protect a person who has used the thing patented by having purchased or made the machine to which the invention is applied, from any liability to the patentee or his assignee ;

second, to protect the rights granted to the patentee against infringement by any other persons.

Is explained in *Hapgood v. Hewitt*, 119 U. S. 233, 1886, Supr. Court, Blatchford, J., as deciding only that the facts justified the presumption of a license to the employer to use the invention as a defence by him to a suit for the infringement of a patent taken out by the employee.

Is 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 parties.

McCormick v. Seymour, 2 Blatchf. C. C. 254, 1851, North. Dist. N. Y., Nelson, J.

Is explained in *Toppan v. National Bank Note Co.*, 4 Blatchf. C. C. 511, 1861, South. Dist. N. Y., Shipman, J., as deciding that if a patentee allows public use of his invention more than two years before he applies for a patent, he forfeits his right to a patent.

Also quoted in *Bevin v. East Hampton Bell Co.*, 9 Blatchf. C. C. 62, 1871, Dist. Conn., Shipman, J.

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 Nelson to the jury in the former case as to the patentability of an invention.

McCormick v. Talcott, 20 How. 402, 1857, Supr. Court, Grier, J.

Is said in *Morley Sewing Machine Co. v. Lancaster*, 23 F. R. 345, 1885, Dist. Mass., Colt, J., to lay down a clear principle that a patent for a primary invention should have a more liberal construction than is usual in the case of secondary invention, and may include all machines which do not have some substan-

tial difference; whereas in the case of an improvement on a known machine slight differences may prevent infringement.

McKay v. Wooster, 2 Sawyer, 373, 1873, Dist. Cal., Sawyer, J.

Is explained in *Hatch v. Adams*, 22 F. R. 438, 1884, East. Dist. Penn., McKennan, J., as having been decided upon an erroneous idea that the case of *Adams v. Burke*, 4 Fisher, 392, involved in its decision an extra-territorial sale of a patented article.

McMillin v. Barclay, 5 Fisher, 189, 1871, West. Dist. Penn., McKennan, J.

Is cited in *Colgate v. Western Union Telegraph Co.*, 4 Ban. & A. 65, 1878, South. Dist. N. Y., Blatchford, J., as a case where the lapse of eleven years between the rejection of an application for a patent and a renewed application was held, under the circumstances of the case, not to be evidence of an abandonment expressed or implied, the delay being satisfactorily explained.

Merrill v. Yeomans, 5 O. G. 267, 1874, Dist. Mass., Shepley, J.

Is cited to the effect that a patentee who has invented a process in the arts whereby an article of manufacture is produced, new in kind, and not before known, may separately claim and patent both the art and the manufacture, if both are new and useful in the sense of the patent law, in *Milligan & H. Glue Co. v. Upton*, 1 Ban. & A. 512, 1874, Dist. Mass., Clifford, J.

Merrill v. Yeomans, 94 U. S. 568, 1876, Supr. Court, Miller, J.

Is construed in *Gottfried v. Phillip Best Brewing Co.*, 5 Ban. & A. 36, 1879, East. Dist. Wis., Dyer, J., as a case in which a claim for a process of manufacture was subjected to rather limited construction. *Merrill*

v. Yeomans is accepted in the latter case as authority upon the question involved, but it was held that the same question was not involved in *Gottfried v. Phillip Best Brewing Co.*

Is said in *Duff v. Sterling Pump Co.*, 107 U. S. 639, 1882, Supr. Court, Blatchford, J., to be in accord with that case.

Merserole v. Union Paper Collar Co., 6 Blatchf. C. C. 356, 1869, South. Dist. N. Y., Blatchford, J.

Is cited in *Hartell v. Tilghman*, 99 U. S. 554, 1878, Supr. Court, Miller, J., as a case where Blatchford, J., states strongly the doctrine that if a case involves only rights arising under a contract respecting a patent, and not any act of Congress, or the construction of any law in regard to patents, a court of the United States has no jurisdiction unless by citizenship of the parties.

Judge Blatchford in this case is said in *Teas v. Albright*, 13 F. R. 414, 1882, Dist. N. J., Nixon, J., to have decided that a State court has jurisdiction to decree a license under a patent to be void; and if, in the investigation, that court is obliged to inquire collaterally into the invalidity or validity of the patent as a consideration for the license, such inquiry would not deprive a State court of jurisdiction, or confer it on a court of the United States.

Mevs v. Conover, 11 O. G. 1112, 1876, Supr. Court. Strong, J.

A long quotation from the opinion of the court in this case is made in *Knox v. Great Western Quicksilver Mining Co.*, 4 Ban. & A. 28, 1878, Dist. Cal., Sawyer, J., as to the proper rule for estimating profits. citing *Mowry v. Whitney*, 14 Wall. 651 (q. v.).

Middletown Tool Co. v. Judd, 3 Fisher, 141, 1867, Dist. Conn., Shipman, J.

“Whenever a change or device is new and accom-

plishes beneficial results, courts look with favor upon it; the law in such cases has no nice standard by which to gauge the degree of mental power or inventive genius brought into play in producing the new device." Quoted in *Celluloid Manuf. Co. v. Comstock & Cheney Co.*, 27 F. R. 360, 1886, Dist. Conn., Shipman, J., as illustrating the law in regard to inventive skill necessary to render an invention patentable before the decision in *Hollister v. Benedict &c. Manuf. Co.*, 113 U. S. 59 (q. v.).

Miller v. Bridgeport Brass Co., 12 O. G. 667, 1877, Dist. Conn., Shipman, J.

Following this decision, the court in *Hayes v. Seton*, 12 F. R. 123, 1882, East. Dist. N. Y., Benedict, J., held that several claims in a reissue were intended to enlarge the scope of the patent, and that while some of them were described or suggested in the original patent, it was evident on the face of the patent that there was no intention to describe them as part of the invention, or to claim an exclusive right therein, and the right to secure these improvements was lost by delay of nine years from the date of the original patent.

The opinion in this case is quoted from at length in *Putnam v. Hutchinson*, 12 F. R. 130, 1882, North. Dist. Ill., Blodgett, J., to the effect that a reissue which enlarges the claims of the original patent is invalid.

Miller v. Brass Co., 104 U. S. 350, 1882, Supr. Court, Bradley, J.

Is limited in *James v. Campbell*, 104 U. S. 371, 1882, Supr. Court, Bradley, J., as admitting that if by actual inadvertence, accident, or mistake innocently committed, the claim of a patent does not fully assert or define the patentee's right in the invention specified, a speedy ap-

plication for its correction, before adverse rights have accrued, may be successful.

Is affirmed in *Bantz v. Frantz*, 105 U. S. 166, 1882, Supr. Court, Woods, J., as deciding that an application for a reissue must be made immediately ; unreasonable delay forfeits the right.

In *Mathews v. Machine Co.*, 105 U. S. 58, 1881, Supr. Court, Bradley, J., the same is again affirmed.

Is affirmed in *Gage v. Herring*, 107 U. S. 645, 1882, Supr. Court, Gray, J., that delay in obtaining a reissue invalidates it.

Is referred to in *Combined Patents Can Co. v. Lloyd*, 11 F. R. 150, 1882, East. Dist. Penn., Butler, J., as being one of the late cases in which the subject of reissue was discussed. The opinion in *Miller v. Brass Co.* is quoted from to the effect that if there is a *bona fide* mistake by which some part of an invention has been omitted from the original patent, the claim in the reissue may be enlarged so as to include the omitted portion ; but also to the effect that if an inventor only patents a portion of his invention, and rests a long time after his patent is granted, he is equitably estopped to reissue his patent so as to cover the unpatented portion of the invention.

The reasoning of the Supreme Court in this case is said, in *McWilliams Manuf. Co. v. Blundell*, 11 F. R. 420, 1882, Dist. R. I., Colt, J., to be applicable to cases of the enlargement of a patent in the reissue, and where it is for a different invention, intimating that the application is to be limited to such cases.

The opinion of Mr. Justice Bradley in that case as to the validity of a reissue in case of a real mistake in the original patent, not a mere error of judgment, is quoted in *Jones v. Barker*, 11 F. R. 599, 1882, Dist. Maine, Lowell, J.

Is cited in *Sheriff v. Fulton*, 12 F. R. 139, 1882,

West. Dist. Penn., Acheson, J., as settling the law that acquiescence by a patentee for a long time in the patent as originally granted estops him from claiming a reissue on the ground of mistake.

Is said in *MacKay v. Jackman*, 12 F. R. 619, 1882, South. Dist. N. Y., Wheeler, J., to strongly intimate that whatever the patentee describes in a patent and does not claim is abandoned to the public unless it was omitted to be claimed by inadvertence or mistake, and the correction is sought immediately upon discovery of the omission.

Is cited in *Tillinghast v. Hicks*, 13 F. R. 390, 1882, North. Dist. N. Y., Coxe, J., as deciding that a long delay after an original patent is granted, before the reissue is applied for, acts as an estoppel to prevent the granting of a reissue.

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

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

Is cited to the same effect as above in *Newton v. Furst, &c. Manuf. Co.*, 14 F. R. 470, 1882, North. Dist. Ill., Blodgett, J.

Also *Cote v. Moffitt*, 15 F. R. 345, 1883, Dist. Mass, Lowell, J.

Also *Singer Manuf. Co. v. Goodrich*, 15 F. R. 456, 1883, Dist. Mass., Nelson, J.

Is stated in *Ives v. Sargent*, 17 F. R. 449, 1883, Dist. Conn., Shipman, J., to declare that the right to have a mistake in a patent corrected when the mistake was plain and forthwith discernible, and improperly narrowed the claim, must be speedily exercised, or the right will be necessarily abandoned and lost by unreasonable delay. *Miller v. Brass Co.* is said in the latter case to have been favorably referred to by the Supreme Court in at least four cases since its decision.

Is said in *Hartshorn v. Eagle Shade Roller Co.*, 18 F. R. 92, 1883, Dist. Mass., Lowell, J., to have given an emphatic and reiterated declaration that a delay of more time than would be reasonably sufficient to read the patent and ascertain its need of amendment should be accounted such laches as will invalidate a reissue in a case where the enlargement of the claim is the only amendment. It is said in *Hartshorn v. Eagle Shade Roller Co.*, that this emphatic and reiterated declaration cannot be overlooked.

Reconsidered and affirmed in *Mahn v. Harwood*, 112 U. S. 357, 1884, Supr. Court, Bradley, J. (Miller, J., dissenting, is of opinion that as to reissued patents the question of laches or delay should be governed by the same rules as in case of an original patent.)

Is cited to the same general effect as above in *Coon v. Wilson*, 113 U. S. 277, 1884, Supr. Court, Blatchford, J.

Is interpreted in *Wollensak v. Reiher*, 115 U. S. 99, 1884, Supr. Court, Matthews, J., to have declared that where the mistake suggested as the ground for a reissue is merely that the claim is not so broad as it might have been, as this mistake is necessarily apparent upon the first inspection of the patent, if any correction is desired, it should be applied for immediately, and that the granting a reissue for such a purpose after an unreasonable delay, is clearly an abuse of the powers to grant reissues, and may justly be declared illegal and void; that in reference to reissues made for the purpose of enlarging the scope of the patent, the rule of laches should be strictly applied, and no one should be relieved who has slept on his rights and thus led the public to rely on the implied disclaimer involved in the terms of the original patent; and that where this is apparent on the face of the instrument upon a mere comparison of the old patent and the reissue, it is com-

petent for the court to decide whether the delay was unreasonable, and whether the reissue was therefore void.

Is quoted from in *Swift v. Jenks*, 19 F. R. 642, 1884, North. Dist. N. Y., Coxe, J., to the effect that if a patent claims certain specific devices, and does not claim other devices apparent upon the face of the patent, the omitted devices are dedicated to the public.

“ If a patentee who has no corrections to suggest in his specification, except to make his claim broader and more comprehensive, uses due diligence in returning to the patent office, and says, ‘ I omitted this,’ or ‘ my solicitor did not understand that,’ his application may be entertained, and on a proper showing correction may be made.” Quoted as authorizing a reissue in *Stutz v. Armstrong*, 20 F. R. 845, 1884, West. Dist. Penn., Acheson, J.

Is said in *Crandal v. Parker Carriage Goods Co.*, 20 F. R. 852, 1884, North. Dist. N. Y., Coxe, J., to have promulgated a new doctrine in regard to reissues.

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

Is cited in *Wooster v. Handy*, 21 F. R. 53, 1884, South. Dist. N. Y., Blatchford, J., in regard to reissues.

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

Also in *Scrivner v. Oakland Gas Co.*, 22 F. R. 99, 1884, Dist. Cal., Sawyer, J.

Does not decide that a reissued patent is always void if the claims of the original patent are extended. *Odell v. Stout*, 22 F. R. 163, 1884, South. Dist. Ohio, Sage, J.

Is quoted from in *Flower v. Detroit*, 22 F. R. 301, 1884, East. Dist. Mich., Brown, J.

Is cited in *Wollensak v. Reiher*, 22 F. R. 653, 1884, North. Dist. Ill., Gresham, J.

It is said in *Gage v. Kellogg*, 23 F. R. 894, 1885, North. Dist. N. Y., Coxe, J., that if the decision in *Miller v. Brass Co.* had been announced at the time the reissue in *Gage v. Kellogg* was applied for, that reissue would not have attempted to cover other machines, as well as the inventors, by an ingenious and clever use of words.

Is explained in *Sewing Machine Co. v. Frame*, 24 F. R. 598, 1884, East. Dist. Penn., Butler, J., as carefully excepting from its decision cases where a patent is corrected by means of a reissue, the patent being inoperative for want of a full and clear description of the invention.

Is cited to the same general effect in *Shirley v. Mayer*, 25 F. R. 38, 1885, East. Dist. N. Y., Benedict, J.

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

It is said in *Pope Manuf. Co. v. Owsley*, 27 F. R. 107, 1886, North. Dist. Ill., Blodgett, J., that the Supreme Court of the United States in *Miller v. Brass Co.* took a radical departure from the rule formerly held by that court as to the validity of a reissue; before that time the rule was that a reissue taken at any time for expanded and enlarged claims was valid if a foundation of such claims could be found in the specifications of the original patent, or even the specifications aided by the drawings.

Governed the decision in *Hoe v. Knap*, 27 F. R. 212, 1886, North. Dist. Ill., Blodgett, J.

Is said in *Asmus v. Alden*, 27 F. R. 688, 1886, East. Dist. Penn., Butler, J., not to have made any change in regard to reissues prohibiting the introduction of new claims under all circumstances. This result could only follow a repeal or disregard of the statute governing this

subject. *Miller v. Brass Co.* simply applied the equitable doctrine of estoppel to a patentee who, after inexcusable delay (during which others may be presumed to have acted on the reasonable inference that all not claimed in the patent has been dedicated to the public), sought by means of reissue to enlarge the scope of his patent so as to embrace and prohibit such acts. Reference is made to Judge Butler's understanding of this case in the *Combined Patents Can Co. v. Lloyd*, 11 F. R. 149.

Is cited and approved in *White v. Dunbar*, 119 U. S. 52, 1886, Supr. Court, Bradley, J.

The principles of this case as to the validity of a reissue applied in *Electric Gaslight Co. v. Boston Electric Co.*, 29 F. R. 456, 1886, Dist. Mass., Colt, 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 is distinguished by the court as dealing with the subject of reissues, and therefore not an authority in the latter case.

Mitchell v. Hawley, 16 Wall. 544, 1873, Supr. Court, Clifford, J.

Is considered at length in *Wooster v. Sidenberg*, 2 Ban. & A. 95, 1875, South. Dist. N. Y., Shipman, J., as deciding that when a patentee makes and sells a machine without any restriction on its use, or authorizes another to construct, sell, and deliver it, or to construct and operate it, and the consideration thereupon is paid him, he loses all interest in the machine, which then passes outside the monopoly, and may be used by the owner till worn out.

Mitchell v. Tilghman, 19 Wall. 287, 1873, Supr. Court, Clifford, J.

Is said in *Henderson v. Cleveland Co-operative Stove Co.*, 2 Ban. & A. 608, 1877, North. Dist. Ohio, Brown, J., to have expanded the principle of *Seymour v. Osborne* (q. v.), and to lay down the rule that in all cases where the claim of a patent is for the result it must be construed to mean the means by which the result is produced, whether there is any reference to the specifications in the claim or not.

In *Tilghman v. Proctor*, 102 U. S. 708, 1880, Supr. Court, Bradley, J., the same patent was under consideration, on substantially the same evidence, with supplementary evidence of the patentee as to the nature of his original experiments, and the practicability of using profitably the coil apparatus described in the patent, and certain exhibits relating to the novelty of the invention. In *Tilghman v. Proctor* the court changed its opinion as given in *Mitchell v. Tilghman*, and considered the patent should be sustained as a patent for a process, and not for the particular mode of applying and using the process pointed out in the specification.

Is cited in *New Process Fermentation Co. v. Maus*, 20 F. R. 728, 1884, North. Dist. Ind., Drummond, J., to the effect that a process may be patented as an art under the statute, though it is often difficult to decide what is a process which may be the subject of a patent.

Moffitt v. Garr, 1 Black, 273, 1861, Supr. Court, Nelson, J.

In *Peck v. Collins*, 103 U. S. 663, 1880, Supr. Court, Bradley, J., *Moffitt v. Garr* is stated and quoted from as deciding that a surrender of a patent extinguishes all rights under it, even as to infringement committed prior to the surrender; and this doctrine is extended so that when an application for a reissue is made and rejected, all rights are gone, the original patent being sur-

rendered and the reissue being rejected. The effect of § 53 of the general revision of 1870 is expressly avoided in the opinion of *Peck v. Collins*, the facts of that case arising before that change; but it is intimated that if the reissue is rejected on merely formal grounds, it might entitle the applicant to a return of his prior patent.

Moody v. Fiske, 2 Mas. 112, 119, 1820, Dist. Mass., Story, J.

Is explained in *Wyeth v. Stone*, 1 Story, 290, 1840, Dist. Mass., Story, J., as deciding that while several distinct improvements in one machine may be united in one patent, it does not follow that several improvements in different machines having distinct and independent operations can be so included; much less that the same patent may be for combinations of different machines and for different improvements in each.

It is said in *Emerson v. Hogg*, 2 Blatchf. C. C. 7, 1845, South. Dist. N. Y., Betts, J., that the *caveat* of Judge Story in the former case, as to including several improvements in separate machines in one specification, is by way of caution only, and to avoid the conclusion that the court was committed upon that specific point.

Is said in *Sessions v. Romadka*, 21 F. R. 132, 1884, East. Dist. Wis., Dyer, J., to decide that several improvements in different machines having distinct and independent operations cannot be included in one patent.

Moore v. Marsh, 7 Wall. 522, 1868, Supr. Court, Clifford, J.

Is said in *Gordon v. Anthony*, 4 Ban. & A. 263, 1879, South. Dist. N. Y., Blatchford, J., to decide that the assignment of a patent does not carry with it a transfer of the right to damages for an infringement committed before such an assignment.

Is said in *Adams v. Bellaire Stamping Co.*, 25 F. R. 271, 1885, South. Dist. Ohio, Sage, J., to have decided

that in cases where an assignment does not include prior claims for infringement, the holder of the patent at the time of the prior infringement should be joined as a plaintiff, in a suit for infringement, but only for the reason that the assignment of a patent does not carry with it claims for prior infringement.

Is said in *May v. Juneau County*, 30 F. R. 245, 1887, West. Dist. Wis., Bunn, J., to decide that the original owner of a patent who has sold his right may recover for an infringement committed during the time he was owner; the court adds: "Undoubtedly the assignee thereof stands in the place of the patentees, both as to the right under the patent and future responsibility; but it is a great mistake to suppose that the assignment of a patent carries with it a transfer of the right to damages for an infringement committed before the assignment."

Morey v. Lockwood, 8 Wall. 230, 1868, Supr. Court., Nelson, J.

Is cited in *Russell v. Dodge*, 93 U. S. 463, 1876, Supr. Court, Field, J., as a case where, under special circumstances, the inventor having been induced to limit his claim by mistake of the commissioner of patents, a reissue was valid which extended beyond the ordinary scope of the statute of 1836. That statute allows a definite specification to be rendered more definite and certain so as to embrace the claim made, or the claim to be so modified as to correspond with the specification, but no more.

Cited upon the question of reissues in *Scrivner v. Oakland Gas Co.*, 22 F. R. 99, 1884, Dist. Cal., Sawyer, J., and said to be a case where the original claim in the application of the inventor included the whole invention, but the patent office compelled him to cut off part of his claim.

Is spoken of as a case of special circumstances in *Eames v. Andrews*, 122 U. S. 63, 1886, Supr. Court., Matthews, J., and the rule cited in *Russell v. Dodge*, *supra*, is affirmed.

Morris v. McMillin, 112 U. S. 244, 1884, Supr. Court, Woods, J.

The principle of decision of this case in regard 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. See *Hailes v. Van Wormer*.

Morse v. O'Reilly, 15 How. 62, 117, 1847, East. Dist. Penn., Kane, J.

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

Mowry v. Whitney. 14 Wall. 620, 1872, Supr. Court, Strong, J.

Decides that in accounting before a master for profits, the question is, What advantage did the defendant derive from using the complainant's invention, over what he had in using other processes then open to the public, and adequate to enable him to obtain an equally beneficial result? The fruits of that advantage are his profits. This rule is followed in *Littlefield v. Perry*, 21 Wall. 228, 1874, Supr. Court, Waite, C. J., and an order to account for all profits received from the manufacture and sale of articles embracing the improvements covered by any of complainant's patents condemned as too broad. *Mowry v. Whitney* also decides that interest on the amount found by the master is not allowable except in special cases, and this rule is followed in *Littlefield v. Perry*.

Is said in *Gould's Manuf. Co. v. Cowing*, 1 Ban. & A. 382, 1874, North. Dist. N. Y., Hunt, J., to decide the same point as that case, that is, that when the patent sued on is for an improvement in a machine, the profits recoverable are those gained by the improvement, not by the whole machine.

Constrains the court in *American Nicholson Pavement Co. v. Elizabeth*, 1 Ban. & A. 462, 1874, Dist. N. J., Nixon, J., to decide against interest on profits, being in reality unliquidated damages, until final decree, unless in cases when particular circumstances make interest proper.

The rule of this case in regard to profits is followed in *Wetherill v. New Jersey Zinc Co.*, 1 Ban. & A. 486, 1874, Dist. N. J., McKennan, J.

It is said in *Foster v. Lindsay*, 1 Ban. & A. 607, 1874, East. Dist. Mo., Treat, J., that *Mowry v. Whitney* holds that no one but the Government, either in its own name or by some of its officers, can vacate or rescind a patent, except as provided by § 16 of the act of July 4, 1836; and under this section the court can only annul or set aside one patent so far as necessary to protect another patent, and the decree does not affect the general public.

Is referred to in *Foster v. Lindsay*, 2 Ban. & A. 174, 1875, East. Dist. Mo., Treat, J., as deciding that if a patent is to be annulled *ab initio*, the proceeding must be at the direct motion of the Government; but it does not decide that the question between conflicting patents may not be fully and finally determined as to the parties in a suit between interfering patents.

Is examined at length in *Attorney-General v. Rumford Chemical Works*, 2 Ban. & A. 308, 1876, Dist. R. I., Shepley, J., and said to decide and only to decide that an interfering patentee, or individual, could not in his own name, or in his right, maintain a bill in equity

to vacate a patent, upon the ground of false suggestion or fraud in obtaining the patent, and the general public is left to the protection of the Government and its officers in such a case.

Is cited in *Railway Co. v. Sayles*, 97 U. S. 556, 1878, Supr. Court, Bradley, J., as deciding the principle upon which a master's accounts of profits should be rendered.

Is also quoted in *Knox v. Great Western Mining Co.*, 4 Ban. & A. 26, 1878, Dist. Cal., Sawyer, J., to the same effect as in *Manufacturing Co. v. Cowing*, *infra*.

Is cited in *Steam Stone Cutter Co. 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 the profits were really damages unliquidated upon which interest is not generally allowable; but the court would not say that in no possible case would interest be allowed.

The decision in this case is distinguished in *Burdett v. Estey*, 5 Ban. & A. 311, 1880, Dist. Vt., Wheeler, J., by the fact that in *Mowry v. Whitney* the plaintiffs, in proving profits, were required to distinguish the profits due to the patented process from those received by the defendant from an unpatented process, and that was already done in the latter case. The court also distinguished *Mowry v. Whitney* from *Elizabeth v. Pavement Co.*, 97 U. S. 126, by saying that in *Mowry v. Whitney*, where a process only was infringed, what was made by the process only was made as profits; while in *Elizabeth v. Pavement Co.*, where the product was infringed, the profits on the products were allowed.

“It would be most unreasonable to read the directions of the specifications without referring to the object they profess to have in view.” Quoted in *Roberts v. Schreiber*, 5 Ban. & A. 503, 1880, North. Dist. Penn., Strong, J.

The rule for the measure of profits as distinguished from damages for which an infringer is responsible, laid down in the above case, is approved in *Locomotive, &c. Co. v. Pennsylvania R. R. Co.*, 5 Ban. & A. 515, 1880, East. Dist. Penn., Strong, J., as founded upon the soundest reason. This rule is stated in the former case to be, that the measure of the profits as distinguished from damages for which an infringer is responsible is the aggregate of gains or savings which he has made on the use of the patented invention above what he could have made in doing the same work from the use of any other device or process existing at the time, capable of accomplishing the same purpose or attaining the same result, and free or open to public use.

Is quoted from in *Root v. Railway Co.*, 105 U. S. 197, 1881, Supr. Court, Matthews, J., as to the rule for measure of damages and denying interest upon profits.

The opinion of Mr. Justice Strong is quoted from, and said to state well the rule applicable to the damages recoverable in a suit for the infringement of a patent, in *Manuf. Co. v. Cowing*, 105 U. S. 255, 1881, Supr. Court, Waite, C. J. "The question to be determined is, What advantage did the defendant derive from using the complainant's invention, over what he had in using other processes then open to the public, and adequate to enable him to obtain an equally beneficial result? The fruits of that advantage are his profits."

The decision in this case, construing the scope and purport of § 16 of the patent act of 1836, is said in *Lockwood v. Cleveland*, 6 F. R. 726, 1881, Dist. N. J., Nixon, J., to have been used in *Foster v. Lindsay*, 3 Dill. 126, to support the decision in last-named case on the construction of § 4918, U. S. R. S.

Is said in *United States v. Gunning*, 18 F. R. 512, 1883, South. Dist. N. Y., Wallace, J., to have assumed without question that there is no distinction between

letters-patent for an invention and for land, as regards the rights and remedies for vacating them when obtained by fraud, and that a bill in equity by the Government was the proper remedy in both cases. Upon this principle *Mowry v. Whitney* decided that a patentee could not maintain a bill in equity to vacate an interfering patent which was fraudulently obtained.

Is cited in dissenting opinion of Miller, J., in *Mahn v. Harwood*, 112 U. S. 388, 1884, Supr. Court, Bradley, J., as to the conclusiveness of the decision of the commissioner of patents upon the validity of a reissue.

Is said in *New Process Fermentation Co. v. Maus*, 20 F. R. 729, 1884, North. Dist. Ind., Drummond, J., to have sustained a patent for a process.

Is cited in *Kirk v. Du Bois*, 28 F. R. 462, 1886. West. Dist. Penn., McKennan, J., to the effect that the compensation of a patentee for an infringement which he may obtain by a suit in equity, although called profits, is in reality damages unliquidated until the decree is made.

N:

Nellis v. McLanahan, 6 Fisher, 286, 1873, West. Dist. Penn., McKennan, J.

Is distinguished, in *Horman Patent Manuf. Co. v. Brooklyn City Railroad Co.*, 4 Ban. & A. 87, 1879, East. Dist. N. Y., Benedict, J., from the latter case, for the reason that in the former case the bill would have been held good if it had averred, as the bill in the latter case does, that the machine made and sold by the defendant contained devices covered by each of the two patents set forth in the bill.

Is construed in *Hayes v. Dayton*, 8 F. R. 704, 1880, South. Dist. N. Y., Blatchford, J., as deciding that when a suit in equity is brought for the infringement of

several patents for different improvements not necessarily embodied in the construction and operation of any one machine, the bill must contain an explicit averment that the infringing machine contained all the improvements embraced in the several patents, or it will be held bad for multifariousness on demurrer.

Nelson v. McMann, 16 Blatchf., C. C., 139, 1879, South. Dist. N. Y., Blatchford, J.

Is cited in *Gordon v. Anthony*, 4 Ban. & A. 262, 1879, South. Dist. N. Y., Blatchford, J., as an authority upon a construction of §§ 629, 711, 4919, 4921, U. S. R. S., relating to suits in equity and at law for the infringement of the patent, under which no person can sue on a patent who is not the patentee, or such an assignee or grantee as the statute points out.

Nevins v. Johnson, 3 Blatchf., C. C. 80, 1853, South. Dist. N. Y., Betts, J.

Is said in *Vaughan v. East Tennessee, &c. R. R. Co.*, 2 Ban. & A. 538, 1877, East. Dist. Tenn., Brown, J., to have decided that the federal courts had jurisdiction in a patent case irrespective of a prayer in the bill for an injunction, in a suit brought after the patent had expired. See now *Root v. Railway Co.*

Is referred to in *Gordon v. Anthony*, 4 Ban. & A. 257, 1879, South. Dist. N. Y., Blatchford, J., as a case where, the bill being filed after the patent had expired, the suit was maintained in equity under the statute of July 4, 1836, 5 U. S. Stat. at L. 124, § 17, irrespective to the right of the patentee to an injunction. See now *Root v. Railway Co.*

In *Root v. Railway Co.*, 105 U. S. 206, 1881, Supr. Court, Matthews, J., it is said that *Nevins v. Johnson* has been alleged to have confused the distinction between the jurisdiction of the federal courts in cases

at law and in equity under the patent act; but Mr. Justice Matthews denies that this is its effect.

New York v. Ransom, 23 How. 487, 1859, Supr. Court, Grier, J.

Is said in *Root v. Railway Co.*, 105 U. S. 197, 1881, Supr. Court, Matthews, J., expressly to approve the rule as to the measure of damages in an action at law laid down in *Seymour v. McCormick*, 16 How. 480, and to give the plaintiff, who rested on proof of infringement only, merely nominal damages.

New York Belting & Packing Co. v. Sibley, 15 F. R. 386, 1883, Dist. Mass., Lowell, 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.

New York Grape Sugar Co. v. Buffalo Grape Sugar Co., 24 F. R. 604, 1883, North. Dist. N. Y., Shipman, J.

Is cited in *Keller v. Stoltzenbach*, 28 F. R. 82, 1886, West. Dist. Penn., Acheson, J., as applying the doctrine of laches to a patent suit as barring an account of profits, on the ground of the long acquiescence and unreasonable delay of the plaintiff.

Nichols v. Newell, 1 Fisher, 647, 1853, Dist. Mass., Sprague, J.

The statement of the decision in this case in Brightley's Dig., p. 637, is accepted in *Oliphant v. Salem Flouring Mills Co.*, 3 Ban. & A. 259, 1878, Dist. Or., Deady, J.

Nicolson Pavement Co. v. Jenkins, 14 Wall. 452, 1871, Supr. Court, Davis, J.

Shipman, J., in *Waterman v. Wallace*, 2 Ban. & A. 130, 1875, Dist. Conn., says: "I do not understand that the Supreme Court, in *Nicolson Pavement Co. v. Jenkins*, intended to assert that an assignment of an invention merely, conveyed the interest of the inventor to an extension; on the other hand, that decision assumes that an assignment of an invention without words importing intention to convey a present and a future interest will not pass the right to an extension. Cf. *Mowry v. Grand Street, &c. R. R. Co.*, 10 Blatchf. C. C. 89.

Is stated briefly in *Fire Extinguisher Manuf. Co. v. Graham*, 16 F. R. 554, 1883, West. Dist. Va., Hughes, J., and said to decide that the assignment in that case carried the seven years' extension of the original patent obtained by the administrator of the original patentee.

The language of Davis, J., in this case, as to what passes by the assignment of a patent, is quoted at length in *Johnson v. Wilcox & Gibbs Sewing Machine Co.*, 27 F. R. 690, 1886, South. Dist. N. Y., Wallace, J.

Northrup v. Adams, 2 Ban. & A. 567, 1877, Dist. N. J., Brown, J.

Is quoted from in *Western Electric Manuf. Co. v. Odell*, 18 F. R. 322, 1883, North. Dist. Ill., Blodgett, J., upon the subject of design patent.

Nourse v. Allen, 4 Blatchf. C. C. 376, 1859, South. Dist. N. Y., Nelson, J.; s. c. 3 Fisher, 63.

Is cited in *Horman Patent Manuf. Co. v. Brooklyn City R. R. Co.*, 4 Ban. & A. 87, 1879, East. Dist. N. Y., Benedict, J., as a case where a bill similar to the one in the latter case was sustained.

This case is cited in *Hayes v. Dayton*, 8 F. R. 704, 1880, South. Dist. N. Y., Blatchford, J., as deciding

on demurrer that a bill in equity founded on four patents was good, since it alleged that the machine sued contained all the improvements in all the patents, although the defences might be different and unconnected.

Is said in *Deering v. Winona Harvester Works*, 24 F. R. 90, 1885, Dist. Minn., Nelson, J., to announce the principles as to joining infringements of different patents in the same bill.

O.

Oliver v. Rumford Chemical Works, 109 U. S. 75, 1883, Supr. Court, Blatchford, J.

Is said in *Curran v. Craig*, 22 F. R. 101, 1884, East. Dist. Mo., Treat, J., apparently to decide that a license is personal to the licensee, whereby an executor, administrator, or assignee, voluntary or involuntary, does not succeed to the privilege of the grant.

O'Reilly v. Morse, 15 How. 62, 1853, Supr. Court, Taney, C. J.

Is said in *Silsby v. Foote*, 20 How. 389, 1857, Supr. Court, in the opinion of Grier, J., dissenting, to have decided that a patent for the application of an element of nature to practical use was too broad, and void.

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 is for an improved product, and not for a principle.

The use of electric magnetism to mark or print characters at a distance is not patentable independently of the means by which the natural agency is utilized. Said to be the effect of this decision in *Union Paper Collar Co. v. White*, 2 Ban. & A. 64, 1875, East. Dist. Penn., McKennan, J.

The opinion of Mr. Chief-Justice Taney commenting upon the case of Neilson's patent for a hot blast, Web. P. C. 275, 312, is quoted from in *Tilghman v. Proctor*, 102 U. S. 725, 1880, Supr. Court, Bradley, J., as showing that he fully acquiesced in the validity of a patent for a process, although *O'Reilly v. Morse* is supposed to be adverse to patents for mere processes. This mistake arises from confounding a patent for a process with a patent for a mere principle. The Morse patent was invalid because it claimed a patent for discovering that a particular power could be employed, not for a particular process or particular machinery to so employ it. The opinion of Mr. Chief Justice Taney is said, in *Tilghman v. Proctor*, to be a clear and exact summary of the law on this point.

Cited in *McMillin v. Rees*, 5 Ban. & A. 271, 1880, West. Dist. Penn., McKennan, J., to the point that a patent must be limited to the specific invention described in the claim.

It is said in *New Process Fermentation Co. v. Maus*, 20 F. R. 730, 1884, North. Dist. Ind., Drummond, J., that the court in the former case refused to sustain the eighth claim of Morse, because he disavowed the specific machinery or means mentioned, but claimed the use of the motive power of the electric current, however developed, thus making an attempt to claim a principle.

Is said in *Canan v. Pound Manuf. Co.*, 23 F. R. 186, 1885, North. Dist. N. Y., Wallace, J., to overrule the case of *Smith v. Ely*, 5 McLean, 76, holding that United States letters-patent, which do not in terms limit the grant to fourteen years from the date or publication of a foreign patent, if such exist, are void. The letters-patent of the United States may be expressed to run fourteen years from their issue, but the foreign patent will limit the actual term.

Is said in *Gold & Stock Telegraph Co. v. Commercial Telegraph Co.*, 23 F. R. 343, 1885, South. Dist. N. Y., Shipman, J. to have left undecided the question whether a United States patent applied for before the date of application for a foreign patent, but issued after the issue of the foreign patent, is affected by § 6 of the patent act of 1839, limiting the term of such patent by the term of the foreign patent. See *De Florez v. Reynolds*.

Orr v. Badger, 7 Law Rep. 465, 1844, Dist. Mass., Sprague, J.

The opinion of Sprague, J., is affirmed in *Orr v. Littlefield*, 1 Wood. & M. 16, 1845, Dist. N. H., Woodbury, J.

P.

Packet Company v. Sickles, 19 Wall. 617, 1873, Supr. Court, Miller, J.

Is quoted in *Knox v. Great Western Quicksilver Mining Co.*, 4 Ban. & A. 26, 1878, Dist. Cal., Sawyer, J., to the effect that profits are recovered from an infringer upon the principle of converting him into a trustee of the patentee as regards the profits thus made. See now *Root v. Railway Co.*

Is said in *Root v. Railway Co.*, 105 U. S. 198, 1881, Supr. Court, Matthews, J., to follow the rule for measure of damages in an action at law for infringement; that is, the patent or license fee, or royalty, laid down in *Seymour v. McCormick*, 16 How. 470, and the language of Miller, J., in *Packet Co. v. Sickles*, is quoted as saying that the rule of damages in an action at law is different from that in a suit in equity, when the infringer is held a trustee for the patentee of actual profits. In *Root v. Railway Co.*, *Packet Co. v. Sickles* was urged

upon the court as a case which decided that an infringer is a trustee of the profits, and therefore a court of equity will compel him to account even after the patent has expired, and although no other equitable relief is sought; but this view was rejected by the court, and the expressions as to the infringer being a trustee explained to be only an expression of the measure of damages, not a characterization of the jurisdictional basis of the suit.

The remarks in this case of the Supreme Court, that taking profits as the basis for compensation in courts of equity has produced results creating distrust of its fairness, are quoted in *Enigh v. Baltimore & Ohio R. R. Co.*, 6 F. R. 289, 1881, Dist. Md., Morris, J.

Is stated in *Westcott v. Rude*, 19 F. R. 833, 1884, Dist. Ind., Woods, J., to affirm the rule laid down in *Seymour v. McCormick*, 16 How. 480, that in suits at law for infringement of patents, when the sale of licenses by the patentee has been sufficient to establish a price for such licenses, that price should be taken as the measure of his damages against the infringer.

Palmenburg v. Buchholz, 21 Blatchf. C. C. 162, 1882, South. Dist. N. Y., Wallace, J.

“Although the device may have been mechanically new, it was not intellectually novel.” Quoted in *New York Bung & Bushing Co. v. Doelger*, 23 F. R. 194, 1885, South. Dist. N. Y., Coxe, J., in regard to the substitution of *papier maché* for wire in the frame of a lay figure.

Parham v. American Buttonhole, &c. Co., 4 Fisher, 468, 482, 1871, East. Dist. Penn., McKennan, J.

Mr. Justice McKennan's opinion is quoted: “The evidence must clearly establish the priority of a completed and useful machine over the complainants, or it is unavailing; and to doubt upon this point is to resolve it

in the negative." *Hawes v. Antisdel*, 2 Ban. & A. 11, 1875, East. Dist. Mich., Longyear, J.

Is cited in *Reissner v. Anness*, 3 Ban. & A. 178, 1877, Dist. N. J., Nixon, J., to the point that the difference between a patent and a reissue may be determined by reference to the drawings and models filed with the original specifications, as well as by reference to the patents and reissue.

Parker v. Hall, 2 Fisher, 62, note, 1858, South. Dist. Ohio, McLean, J.

Is said in *Rich v. Ricketts*, 7 Blatchf. C. C. 230, 1870, North. Dist. N. Y., Hall, J., to favor a plea in a patent suit in the federal court based upon a State statute of limitation.

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*.

Parker v. Hallock, 2 Fisher, 543, 1857, South. Dist. Ohio, Grier, J.

It is said in *Rich v. Ricketts*, 7 Blatchf. C. C. 231, 1870, North. Dist. N. Y., Hall, J., that Grier, J., held that there was no statute limiting the time within which a suit for the infringement of a patent might be brought, and that a State statute of limitations has no force in such a suit in a federal court.

Is referred to in *Anthony v. Carroll*, 2 Ban. & A. 197, 1875, Dist. Mass., Shepley, J., as deciding that no limit exists for the time of bringing suits in the federal courts for the infringement of patents. See *Collins v. Peebles*.

Parker v. Hawk, 2 Fisher, 58, 1857, South. Dist. Ohio, Leavitt, J.

Is said in *Rich v. Ricketts*, 7 Blatchf. C. C. 230, 1870, North. Dist. N. Y., Hall, J., to favor a plea in a patent

suit in the federal court based upon a State statute of limitation.

Is criticised in *Anthony v. Carroll*, 2 Ban. & A. 197, 1875, Dist. Mass., Shepley, J., who says that *Parker v. Hawk* was decided on the authority of *McCluney v. Silliman*, 3 Pet. 270, but that case was different. *Parker v. Hawk* decides that a State statute of limitation applies to an action for infringement of a patent in the federal court, and is contrary to *Collins v. Peebles*, 2 Fisher, 541 (q. v.).

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 defence in a suit in the federal court for infringement of a patent.

Parker v. Sears, 1 Fisher, 96, 1850, East. Dist. Penn., Grier, J.

The opinion of Mr. Justice Grier is quoted in *Bailey Wringing Machine Co. v. Adams*, 3 Ban. & A. 97, 1877, West. Dist. Penn., McKennan, J., to the effect that a preliminary injunction will only be granted when the complainant's title and the defendant's infringement are admitted, or so clear and palpable that the court can entertain no doubt on the subject; and the courts are not bound to decide difficult and doubtful questions of law, or disputed questions of fact, at this stage of the case.

Parker v. Stiles, 5 McLean, 44, 1849, Dist. Ohio, Leavitt, J.

Is cited in *Whittlesey v. Ames*, 13 F. R. 898, 1880, North. Dist. Ill., Blodgett, J.; s. c. 5 Ban. & A. 102, to the effect that identity of invention is necessary to constitute an anticipating machine.

Parkhurst v. Kinsman, 1 Blatchf. C. C. 488, 1849, South. Dist. N. Y., Nelson, J.

Is explained in *North Western Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 1 Ban. &

A. 191, 1874, East. Dist. Penn., McKennan, J., as a case where, the defence of prior invention being set up, the proof showed that the invention was incomplete and imperfect, and had been abandoned as a failure.

“Crude and imperfect experiments equivocal in their results, and then given up for years, cannot be permitted to prevail against an original inventor who has perfected his improvement and obtained his patent.” Quoted in *Gottfried v. Phillip Best Brewing Co.*, 5 Ban. & A. 32, 1879, East. Dist. Wis., Dyer, J.

Parks v. Booth, 102 U. S. 96, 1880, Supr. Court, Clifford, J.

Is referred to in *Root v. Railway Co.*, 105 U. S. 204, 1881, Supr. Court, Matthews, J., as a case under the act of 1870, when both profit and damages were decreed in a suit in equity. Interest on profits was not allowed on the authority of *Silsby v. Foote*, 20 How. 378, as profits are in the nature of unliquidated damages. Counsel fees were stricken out, but compensation for complainant's time lost attending the suit was allowed as damages.

Patterson v. Kentucky, 97 U. S. 501, 1878, Supr. Court, Harlan, J.

Is cited and explained in *Webber v. Virginia*, 103 U. S. 348, 1880, Supr. Court, Field, J., as supporting the doctrine that a patent does not prevent a State from passing laws regulating the condition of the manufacture, storage, and sale of the patented article. The passing of such laws does not interfere with the patent right.

Is cited in *Re Brosnahan*, 18 F. R. 65, 1883, West. Dist. Mo., Miller, J., as supporting the propositions announced in that case, — that a patent does not give the patentee the right to sell an article prohibited by the

State laws, *e. g.*, oleomargarine. The effect of the patent is only to secure the patentee against competition.

Pearce v. Mulford, 102 U. S. 112, 1880, Supr. Court, Strong, J.

“All improvement is not invention, and entitled to protection as such. Thus to entitle it, it ought to be the product of some exercise of the inventive faculties, and it must involve something more than what is obvious to persons skilled in the art.” Quoted in *Packing Co. Cases*, 105 U. S. 571, 1881, Supr. Court., Woods, J.

Pennington v. Hunt, 20 F. R. 195, 1884, Dist. N. J., Nixon, J.

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

Pennsylvania R. R. v. Locomotive Truck Co., 110 U. S. 490, 1883, Supr. Court, Gray, J.

The opinion of Mr. Justice Gray to the point of what constitutes invention, is quoted in *Morris v. McMillin*, 112 U. S. 249, 1884, Supr. Court, Woods, J.

The opinion of Mr. Justice Gray: “It is settled by many decisions in this court, that the application of an old process or machine to a similar or analogous subject, with no change in the manner of application, and no result substantially distinct in its nature, will not sustain a patent, even if the new form of result has not before been contemplated.” Quoted in *Blake v. San Francisco*, 113 U. S. 682, 1884, Supr. Court, Woods, J.; also in *Stephenson v. Brooklyn & Crosstown R. R. Co.*, 114 U. S. 154, 1884, Supr. Court, Woods, J.

Is quoted to the same effect in *Howe Machine Co. v. National Needle Co.*, 21 F. R. 631, 1884, Dist. Mass., Nelson, J., in which case it was held that the

application of old mechanism for wood turning to the turning of machine needles and awls from metal, was not patentable.

Is followed in *Spill v. Celluloid Manuf. Co.*, 21 F. R. 632, 639, 1884, South. Dist. N. Y., Blatchford, J., on the same point that the application of an old process or machine to a similar or analogous subject, with no change in the manner of application, and no result substantially distinct in its nature, will not sustain a patent, even if the new form of result has not before been contemplated.

Is quoted to the same effect in *Miller v. Foree*, 116 U. S. 26, 1885, Bradley, J.

Is said in *Goodyear v. Hartford Spring Axle Co.*, 23 F. R. 37, 1885, Dist. Conn., Shipman, J., to have established a stricter rule in regard to the patentability of inventions than existed before, taken in connection with the decisions in *Collins Co. v. Coes*, 21 F. R. 38, and *Spill v. Celluloid Manuf. Co.*, 21 F. R. 631.

The principle stated below, in the quotation in *Niles Tool Works v. Betts Machine Co.*, is followed in *Thatcher Heating Co. v. Burtis*, 121 U. S. 295, 1886, Supr. Court, Matthews, J.

“The application of an old process or machine to similar or analogous subject, with no change in the manner of applying it, and no result substantially different in its nature, will not support a patent, even if the new form of result has not before been contemplated.” Quoted in *Niles Tool Works v. Betts Machine Co.*, 27 F. R. 305, 1886, Dist. Del., Wales, J.

Perrigo v. Spaulding, 13 Blatchf. C. C. 391, 392, 1876, North. Dist. N. Y., Johnson, J.

Is said in *Allis v. Stowell*, 16 F. R. 786, 1883, East. Dist. Wis., Dyer, J., to state the rule that when a recovery by a patentee against an infringer is had, for full

profits and damages, the infringer has the right to use the patented machine.

Perry v. Corning, 6 Blatchf. C. C. 134, 1868, North. Dist. N. Y., Hall, J.

Is cited and stated briefly in *Vaughan v. East Tennessee, &c. R. R. Co.*, 2 Ban. & A. 541, 1877, East. Dist. Tenn., Brown, J., as an ordinary bill containing the usual prayers for account and answer, but no special allegations showing the necessity of discovery, nor any prayer for injunction or discovery. The court treated it as a bill for account and discovery, to sustain the jurisdiction.

Phelps v. Comstock, 4 McLean, 353, 1849, Dist. Ind., McLean, 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 that where a license under a patent was "to the full end of the *term or terms* for which letters-patent are or may be granted," that license covers any subsequent extension of the patent.

Philadelphia & Trenton R. R. Co. v. Stimpson, 14 Pct. 448, 1840, Supr. Court, Story, J.

Is cited in *Allis v. Buckstaff*, 13 F. R. 892, 1882, East. Dist. Wis., Dyer, J., upon the competency of evidence as to anticipating inventions.

Phillips v. Detroit, 111 U. S. 604, 1883, Supr. Court, Woods, J.

Stated briefly in *Morris v. McMillin*, 112 U. S. 249, 1884, Supr. Court, Woods, J., as a case deciding that the patent in suit did not disclose a patentable invention.

Phillips v. Page, 24 How. 164, 1860, Supr. Court, Nelson, J.

Is distinguished in *Gottfried v. Phillip Best Brewing Co.*, 5 Ban. & A. 36, 1879, East. Dist. Wis., Dyer,

J., from the latter case, as in the former case the claim of the patent was merely for the organization of an old machine, and it was held that the mere enlargement did not afford ground for a patent.

Philp v. Nock, 17 Wall. 460, 1873, Supr. Court, Swayne, J.

The opinion of Mr. Justice Swayne is cited in *Gould's Manuf. Co. v. Cowing*, 1 Ban. & A. 382, 1874, North. Dist. N. Y., Hunt, J., to the point that where the patent in suit is for an improvement in a machine, the damages recoverable are generally confined to the profits made by the improvement, not by the whole machine.

“The plaintiff must show his damages by evidence. They must not be left to conjecture by the jury. They must be proved, and not jumped at.” Quoted in *Calkins v. Bertrand*, 8 F. R. 759, 1881, North. Dist. Ill., Blodgett, J.

Pickering v. McCullough, 104 U. S. 310, 1881, Supr. Court, Matthews, J.

The opinion of Mr. Justice Matthews in the above case is quoted from in *Bradley, &c. Manuf. Co. v. Charles Parker Co.*, 17 F. R. 242, 1883, Dist. Conn., Shipman, J., to the same effect as in the quotation given below as to the necessity of the co-operation of old elements, in order to produce a patentable novelty. In the latter case, the combination included a set screw to hold a lamp-shade to the lamp-holder.

The principles of this case were applied in *Mosler Safe & Lock Co. v. Mosler*, 22 F. R. 905, 1885, South. Dist. Ohio, Sage, J.

“In a patentable combination of old elements, all the constituents must so enter into it that each qualifies every other; to draw an illustration from another branch of the law, they must be joint tenants of the domain of the invention seized each of every part, — *per my et per*

tout, — and not mere tenants in common, with separate interests and estates. It must form either a new machine of a distinct character and function, or produce a result due to the joint and co-operative action of all the elements, and which is not a mere adding together of separate contributions; otherwise it is only a mechanical juxtaposition, and not a vital union." Quoted in *Peard v. Johnson*, 23 F. R. 509, South. Dist. N. Y. 1885, Coxe, J., as describing with remarkable perspicuity the essential requirements of a valid combination.

Quoted in *Scott Manuf. Co. v. Sayre*, 26 F. R. 155, 1885, Dist. N. J., Nixon, J., upon the question of patentability of a combination.

Pitts v. Edmonds, 2 Fisher, 57, 1857, East. Dist. Mich., McLean, J.

The opinion of McLean, J., is quoted in *Odiorne v. Denney*, 3 Ban. & A. 290, 1878, Dist. N. J., Nixon, J., to the effect that a patent covers all mechanical equivalents or modes which operate on the same principles.

Pitts v. Hall, 2 Blatchf. C. C., 229, 1851, North Dist. N. Y., Nelson, J.

Is cited in *Bevin v. East Hampton Bell Co.*, 9 Blatchf. C. C. 62, 1871, Dist. Conn., Shipman, J., upon the question of abandonment.

Is quoted as to forfeiture of right to invention by sale or public use by patentee for two years before application for a patent, in *Consolidated Fruit Jar Co. v. Wright*, 94 U. S. 94, 1876, Supr. Court, Swayne, J.

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

Pitts v. Hall, 3 Blatchf. C. C. 201, 1854, North. Dist. N. Y., Hall, J.

Is said in *Hodge v. Hudson River R. R. Co.*, 6 Blatchf. C. C. 89, 1868, South. Dist. N. Y., Blatch-

ford, J., to decide what language will convey an extension of a patent to an assignee.

Interpreted in *Dunham v. Indianapolis, &c. R. R. Co.*, 2 Ban. & A. 329, 1876, North. Dist. Ill., Drummond, J., as deciding that if one joint owner of a patent sells or uses his right without the authority of his co-owner, he is liable to an action by such co-owner for an infringement of the patent; and it is said in *Dunham v. Indianapolis, &c. R. R. Co.* that perhaps the conclusion might be drawn from the decision, that if the party to whom he sells uses the thing patented, an action could be maintained and an injunction granted against the grantee or licensee of the co-owner; but see *Clum v. Brewer*, 2 Curtis, 506.

Is distinguished in case of *Herring v. Gas Consumers' Association*, 9 F. R. 557, 1878, East. Dist. Mo., Treat, J.; s. c. 3 Ban. & A. 254, the former case raising the question whether one joint owner of a patent may sue another joint owner for use of the common patent; the latter case deciding that one joint owner may sue another for using an infringing device, and expressing no opinion upon the other question.

Pitts v. Whitman, 2 Story, 609, 1843, Dist. Maine, 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.

Planing Machine Co. v. Keith, 101 U. S. 479, 1879, Supr. Court, Strong, J.

Is said in *Allis v. Buckstaff*, 13 F. R. 884, 1882, East. Dist. Wis., Dyer, J., to overrule the case of *Richardson v. Lockwood*, 6 Fisher, 454, and to establish the rule that the defendant who sets up in his

defence an alleged prior use or knowledge, need not allege in his answer the names of those by whom he expects to prove prior use, but only of those who had invented or used the anticipating machine.

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 an abandonment of an invention after rejected application and before renewed application.

Pomeroy v. New York & N. H. R. R. Co., 4 Blatchf. C. C. 120, 1857, South. Dist. N. Y., Nelson, J.

Cited in *Williams v. Empire Transportation Co.*, 3 Ban. & A. 536, 1878, Dist. N. J., Nixon, J., as deciding that a corporation organized in Connecticut cannot be found in New York so as to be served with process in a federal court, although the New York State Legislature, in authorizing the corporation to purchase lands, to enter into contracts and to enter its road into the State, had expressly provided that the company should be liable to be sued by summons in the same manner as corporations created by the law of the State, and that process might be served on an officer or agent of the company. The difficulty was that a State law would not modify the act of Congress. See now *Schollenberger Ex Parte*, 96 U. S. 377, and Stat. 1886-87, c. 373.

Williams v. Empire Transportation Co. holds that a corporation which transacts business in a State other than that of its incorporation, upon the condition of rendering itself liable to service upon its agent, waives the question of the legality of the service, and is found in that State for purposes of suit in a federal court.

Potter v. Holland, 4 Blatchf. C. C. 206, 1858, Dist. Conn., Ingersoll, J. ; s. c. 1 Fisher, 333.

Is followed in *Potter v. Braunsdorf*, 7 Blatchf. C. C. 109, 1869, South. Dist. N. Y., Blatchford, J., on the

point that it is not in the power of the patentee by surrender to injure the right to third persons holding under him.

“An assignee is one who had transferred to him in writing the whole interest of the original patent or an undivided part of such whole interest in every part of the United States; and no one, unless he has such an interest transferred to him, is an assignee. A grantee is one who has transferred to him in writing the *exclusive* right under the patent to make and use, and to grant to others to make and use, the thing patented, within and throughout some specified part or portion of the United States.” Quoted with approval in *Meyer v. Bailey*, 2 Ban. & A. 77, 1875, West. Dist. Penn., McKennan, J.

Cited in *Nelson v. McMann*, 4 Ban. & A. 211, 1879, South. Dist. N. Y., Blatchford, J., as agreeing with the principles of *Gaylor v. Wilder*, 10 How. 477, as to the point that an assignment, in order to allow the assignee to sue in his own name, must be exclusive within the territory it covers, even of the patentee himself.

Potter v. Schenck, 1 Biss. 515, 1866, North. Dist. Ill., Drummond, J.

Is quoted from at some length in *Adams v. Joliet Manuf. Co.*, 3 Ban. & A. 5, 1877, North. Dist. Ill., Blodgett, J., to the point that a change of location of any part in a combination, when there is no new function performed by this change made in its new location, will not evade a patent.

This case is examined in *Tucker v. Dana*, 7 F. R. 214, 1881, Dist. Mass., Lowell, J., and the former case is said to have been carefully distinguished in this decision from *Goodyear Cases*. Lowell, J., says: “I may fail to see the difference between the *Goodyear Cases*, but I must accept the decision that there is a

difference, and must apply the law accordingly as well as I can.”

Powder Co. v. Powder Works, 98 U. S. 126, 1878, Supr. Court, Bradley, J.

“By new matter we suppose to be meant new substantive matter, such as would have the effect of changing the invention, or of introducing what might be the subject of another application for a patent.” Quoted in *Siebert Cylinder, &c. Co. v. Harper Lubricator Co.*, 4 F. R. 333, 1880, Dist. Conn., Shipman, J., upon the question of what constitutes such new matter as will invalidate a reissue.

“A specification may be amended so as to make it more clear and distinct, a claim may be modified so as to make it more conformable with the exact rights of the patentee, but the invention must be the same. So particular is the law on this subject, that it is declared no new matter shall be introduced into the specification.” Quoted in *Washburn, &c. Manuf. Co. v. Haish*, 4 F. R. 910, 1880, North. Dist. Ill., Drummond, J.

Is also quoted in *Flower v. Rayner*, 5 F. R. 799, 1881, Dist. N. J., Nixon, J.

This case is cited in *Yale Lock Manuf. Co. v. Scovill Manuf. Co.*, 5 Ban. & A. 525, 1880, Dist. Conn. Shipman, J., as construing § 4916, U. S. R. S., to decide that a reissue can only be granted for the same invention which formed the subject of the original patent of which it is a reissue. This does not exclude amendments of the specifications to make it more clear and definite, or modifications of the claim to make it more conformable to the exact rights of the patentee, but does exclude amendments covering improvements which have come into use or have been invented by others after the issue of the original patent.

Is cited in *Wilson v. Coon*, 6 F. R. 621, 1880, South. Dist. N. Y., Blatchford, J., upon the question of reissues, as deciding that where the original patent is for processes, and the reissue is for compounds which are not the result of the processes, the reissue is invalid.

A patent for a process and a patent for an implement or machine are very different things. Cited to this effect in *James v. Campbell*, 104 U. S. 377, 1881, Supr. Court, Bradley, J.

Lays down the rule for deciding whether a reissue describes the same invention as the original patent. It is for the court on inspection of the patents. *Heald v. Rice*, 104 U. S. 749, 1881, Supr. Court, Matthews, J.

“The legislature was willing to concede to the patentee the right to amend his specification (in his reissue) so as fully to describe and claim the very invention attempted to be secured by his original patent, and which was not fully secured thereby in consequence of inadvertence, accident, or mistake, but was not willing to give him the right to patch up his patent by the addition of other inventions which, although they might be his, had not been applied for by him, or, if applied for, had been abandoned or waived.” Quoted in *Atwater Manuf. Co. v. Beecher Manuf. Co.*, 8 F. R. 609, 1881, Dist. Conn., Shipman, J.

Is said in *Averill Chemical Paint Co. v. National Mixed Paint Co.*, 9 F. R. 464, 1881, South. Dist. N. Y., Wheeler, J., to have decided that § 4916, U. S. R. S., authorizing amendments of patents upon proof, in the absence of any drawing or model, did not authorize the commissioner to grant a reissue for a different invention, or to determine that one invention was the same as another or a different one, or that two inventions essentially different constituted but one. That

decision left open the question whether that clause related to all patents, or only to patents for machines; but no room was left for adding to the invention by proof.

Is stated at length in *Kells v. McKenzie*, 9 F. R. 287, 1881, East. Dist. Mich., Brown, J., as authority strictly limiting the right of reissues to the invention secured by the original patent.

Explained in *Wing v. Anthony*, 106 U. S. 146, 1882, Supr. Court, Woods, J., as deciding that when original letters-patent are for a process, the reissue cannot cover a composition, unless it is the result of the process, and the invention of one involved the invention of the other.

Is said in *Parker, &c. Co. v. Yale Lock Co.*, 18 F. R. 45, 1883, Dist. Conn., Shipman, J., to have defined the phrase "new matter" as applied to a reissue; and the opinion of the court is quoted to the effect that the reissue cannot contain other inventions not included in the original patent.

This case is construed in *Atlantic Giant Powder Co. v. Hulings*, 21 F. R. 521, 1884, West. Dist. Penn., Acheson, J., to have decided that although the claim of the patent in technical form might appear to be for the use of nitro-glycerine as an exploding agent, yet upon the proper construction it was limited to the methods or processes of exploding substances described in the specifications.

Governed the decision in *Eachus v. Broomall*, 115 U. S. 438, 1885, Supr. Court, Matthews, J.

Prouty v. Ruggles, 16 Pet. 341, 1842, Supr. Court, Taney, C. J.

Is explained in *Eames v. Godfrey*, 1 Wall. 79, 1863, Supr. Court, Davis, J., to the effect that the patent in that case was for the combination of certain parts of a

plough arranged together so as to produce a certain effect. The suit was for an infringement, and the court below charged the jury that unless the whole combination was substantially used in the defendant's machine, there was no violation of the plaintiff's patent. Taney, C. J., said, in the Supreme Court, "None of the parts referred to are new, and none are claimed as new, nor is any portion of the combination less than the whole claimed as new, or stated to produce any given result. The end in view is proposed to be accomplished by the union of all, arranged and combined together in the manner described. The use of any two of these parts only, or of two combined with a third, which is substantially different in form or in the manner of its arrangement and connection with the others, is not the thing patented. It is not the same combination if it substantially differs from it in any of its parts."

Is said in *Mabie v. Haskell*, 2 Cliff. 511, 1865, Dist. Mass., Clifford, J., to decide that where an invention consists merely of a combination of elements all of which are old, a party is not guilty of infringement who uses only a part of those elements.

It is said in *Wells v. Jacques*, 1 Ban. & A. 67, 1874, Dist. N. J., Nixon, J., that it is fairly to be inferred from the language of Taney, C. J., in *Prouty v. Ruggles*, that the difficulty of the plaintiffs in that case arose from not patenting different parts of the combination of old elements forming the new machine, so as to hold infringers who used only combinations of one or two elements, and not all.

Is said in *Holly v. Vergennes Machine Co.*, 4 F. R. 81, 1880, Dist. Vt., Wheeler, J., to hold that a patent for a combination of several parts to accomplish a result is not infringed by a combination of a less number of the same parts alone, or with others substantially different, to produce the same result.

This case is stated, in *Rowell v. Lindsay*, 6 F. R. 300, 1881, East. Dist. Wis., Dyer, J., to have considerable similarity as to the application of principles to the latter case, and the language of the court is adopted and quoted at length.

Is cited in *McMurray v. Mallory*, 111 U. S. 103, 1883, Supr. Court, Woods, J., to the effect that if a patent is for a combination of three parts, the use of any two, or of two in combination with a different third, is not infringement.

The opinion in this case is quoted from at length in *Rowell v. Lindsay*, 113 U. S. 102, 1884, Supr. Court, Woods, J., to the effect that if a patent is for a combination of old materials or devices, a use of a portion of these is not an infringement.

Putnam v. Tinkham, 4 F. R. 411, 1880, Dist. Conn., Shipman, J.

The opinion of the court in this case is quoted from at length in *Edgerton v. Hurst & Bradley Manuf. Co.*, 9 F. R. 454, 1881, North. Dist. Ill., Blodgett, J., to the effect that a reissue is void if it is on its face for a different invention from that which was embraced in the original patent.

R.

Railroad Co. v. Dubois, 12 Wall. 47, 1870, Supr. Court, Strong, J.

Is said in *La Baro v. Hawkins*, 1 Ban. & A. 432, 1874, Dist. N. J., Nixon, J., to decide that the novelty of a patented invention cannot be assailed by any other evidence than that of which plaintiff has received notice, and that the state of the art at the time of the alleged invention, though proper to be considered by the court

in construing the patent, in the absence of notice has no legitimate bearing upon the question whether the patentee was the first inventor.

Railroad Co. v. Harris, 12 Wall. 65, 1870, Supr. Court, Swayne, J.

Is cited in *Wilson v. Hunter*, 4 Ban. & A. 186, 1879, South. Dist. Ill., Drummond, J., as deciding the latter case, the court holding that the Illinois statute (Revised Statutes, c. 32, § 26) subjecting foreign corporations doing business in that State to restrictions imposed upon corporations of like character of that State, subjects foreign corporations doing business in that State to liability to suit in the courts of the United States in the district where such corporations are doing business, and that they are then found in that district, under act of Congress. But see *Schollenberger, Ex Parte*, 96 U. S. 374.

Railroad Co. v. Mellon, 104 U. S. 112, 118, 1881, Supr. Court, Woods, J.

Is distinguished in *La Rue v. Western, &c. Co.*, 28 F. R. 88, 1886, South. Dist. N. Y., Brown, J., from the latter case.

Railroad Co. v. Stimpson, 14 Pet. 448, 1840, Supr. Court, Story, J.

Is cited in *Thomas v. Shoe Machine Manuf. Co.*, 3 Ban. & A. 559, 1878, Dist. Mass., Clifford, J., as the case which changed the rule as to reissues; the rule now being that the granting a reissued patent closes all inquiry as to inadvertence, accident, or mistake, and leaves only the question of fraud for a jury.

Railroad Co. v. Trimble, 10 Wall. 367, 1870, Supr. Court, Swayne, J.

Is explained in *Nicolson Pavement Co. v. Jenkins*, 14 Wall. 457, 1871, Supr. Court, Davis, J., as being the

same in principle with the latter case, although the language of the court in the former case is somewhat broader as to the effect of an assignment of an invention and patent "to the full end of the term for which said letters-patent are or may be granted," it being held to cover a renewal as well as a reissue.

Is cited in *Campbell v. James*, 5 Ban. & A. 366, 1880, South. Dist. N. Y., Wheeler, J., upon the question what words in an assignment are broad enough to convey a patent right.

This case is briefly stated in *Fire Extinguisher Manuf. Co. v. Graham*, 16 F. R. 554, 1883, West. Dist. Va., Hughes, J., to the effect that an assignment of a patent carries the extended patent, if proper words to that effect are used.

Railway Co. v. Sayles, 97 U. S. 554, 1878, Supr. Court, Bradley, J.

The opinion of Mr. Justice Bradley in this case, in regard to the enlargement of an application by a subsequent amended application, is quoted in *Eagleton Manuf. Co. v. West, &c. Manuf. Co.*, 5 Ban. & A. 481, 1880, South. Dist. N. Y., Wheeler, J.

Is cited in *Yale Lock Manuf. Co. v. Scovill Manuf. Co.*, 5 Ban. & A. 527, 1880, Dist. Conn., Shipman, J., to the effect that courts should regard with jealousy and disfavor any attempt to enlarge the scope of an application once filed or a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alterations.

It is said in *Flower v. Rayner*, 5 F. R. 798, 1880, Dist. N. J., Nixon, J., that courts, acting upon the caution of Mr. Justice Bradley in the former case, are more and more inclined to regard with jealousy and disfavor any attempt to enlarge the scope of an application once filed, or of a patent once granted, the effect of

which would be to enable the patentee to appropriate other inventions made prior to such alterations, or to appropriate that which has in the mean time gone into public use.

Is cited in *Morley Sewing Machine Co. v. Lancaster*, 23 F. R. 346, 1885, Dist. Mass., Colt, J., to the effect that a primary patent is more liberally construed than a secondary, and puts all subsequent patents under tribute.

The language of Mr. Justice Bradley to the effect that the court will not allow anything new to be incorporated into the original specification by an amended application and model filed several years later, any more than it would permit the enlargement of an original specification by a reissue, is quoted in *Kittle v. Hall*, 29 F. R. 511, 1887, South. Dist. N. Y., Coxe, J.

Read v. Miller, 3 Fisher, 310, 1867, Dist. Ind., McDonald, J.; s. c. 2 Biss. 12.

Is referred to in *Anthony v. Carroll*, 2 Ban. & A. 197, 1875, Dist. Mass., Shepley, J., as deciding that no limit existed in the law at that time for bringing suits for the infringement of patents in the federal courts, the State statutes of limitations having no force in federal courts. See *Collins v. Peebles*.

Reckendorfer v. Faber, 92 U. S. 347, 1876, Supr. Court, Hunt, J.

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

This case is said in *Williams v. Rome, &c. R. R. Co.*, 3 Ban. & A. 422, 1878, North. Dist. N. Y., Blatchford, J., to affirm and apply the doctrine of *Hailes v. Van Wormer*, 20 Wall. 353 (q. v.).

This case is quoted in *Perfection Window Cleaner Co. v. Bosley*, 5 Ban. & A. 451, 1880, North. Dist. Ill., Dyer, J., to the effect that mechanical skill is one thing,

invention is a different thing. Perfection of workmanship, however much it may increase convenience, extend use, or diminish expense, is not patentable.

The language of Mr. Justice Hunt to the effect that a combination to be patentable must produce a different force, effect, or result in the combined process or processes from that given by the separate parts, is quoted with approval in *Pickering v. McCullough*, 104 U. S. 318, 1881, Supr. Court, Matthews, J.

Quoted to the same effect in *Sawyer v. Miller*, 12 F. R. 727, 1882, South. Dist. Ga., Pardee, J.

The principles of this case were applied in *Mosler Safe & Lock Co. v. Mosler*, 22 F. R. 905, 1885, South. Dist. Ohio, Sage, J.

Is cited in *Peard v. Johnson*, 23 F. R. 510, 1885, South. Dist. N. Y., Coxe, J., upon the question of what combination of old elements is patentable.

Quoted to the same effect in *Scott Manuf. Co. v. Sayre*, 26 F. R. 155, 1885, Dist. N. J., Nixon, J.

Reed v. Cutter, 1 Story, 590, 1841, Dist. Mass., Story, J.

“He who invents first shall have the prior right if he is using reasonable diligence in adapting and perfecting the same, although the second inventor has in fact first perfected the same and reduced the same to practice in a positive form.” Story, J., in this quotation, is said in *Hubel v. Dick*, 28 F. R. 139, 1886, South. Dist. N. Y., Shipman, J., to have announced the fundamental principle in regard to priority as between two independent inventors.

Reeves v. Keystone Bridge Co., 1 O. G. 466.

“The patentee whose patent is assailed on the ground of want of novelty may show by sketches and drawings the date of his inceptive invention, and if he has exercised reasonable diligence in perfecting it and adapting it, and in applying for a patent, his protection will be

carried back to such date." Quoted in *Kneeland v. Sheriff*, 5 Ban. & A. 483, 1880, West. Dist. Penn., McKennan, J.

Is said in *Paillard v. Bruno*, 29 F. R. 865, 1886, South. Dist. N. Y., Wallace, J., to adopt the reasoning in *Henry v. Providence Tool Co.*, 3 Ban. & A. 501, and to decide that in a case where the original term of the foreign patent has been extended subsequently to the grant of the United States patent, this extension does not prolong the term of the United States patent; but the latter expires under § 4887, U. S. R. S., at the end of the original term of the foreign patent.

Reissner v. Sharpe, 16 Blatchf. C. C. 383, 1879, South. Dist. N. Y., Blatchford, J.

Is said in *Bate Refrigerating Co. v. Gillett*, 13 F. R. 558, 1882, Dist. N. J., Nixon, J., to have followed the construction of § 4887, U. S. R. S., adopted in *Henry v. Providence Tool Co.*, 14 O. G. 855 (q. v.).

Rice v. Heald, 13 Pacific L. R. 34, 1877, Dist. Cal., Sawyer, J.

Is cited in *Gottfried v. Phillip Best Brewing Co.*, 5 Ban. & A. 34, 1879, East. Dist. Wis., Dyer, J., to the effect that a prior machine which will not produce substantially the same results as the subsequent machine, without altering its construction, cannot be an anticipation of the subsequent machine, no matter how strongly the prior machine may resemble the subsequent machine in its construction.

Rich v. Close, 4 Fisher, 282, 1870, North. Dist. N. Y., Woodruff, J.

The language of Judge Woodruff in this case to the effect that an inventor be limited in the construction of his patent by what he has claimed, is quoted in *Rowell v. Lindsay*, 6 F. R. 293, 1881, East. Dist. Wis., Dyer, J.

Rich v. Ricketts, 7 Blatchf. C. C. 230, 1870, North. Dist. N. Y., Hall, 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*.

Richardson v. Lockwood, 6 Fisher, 454, 1873, Dist. Mass., Lowell, J.

Is said in *Allis v. Buckstaff*, 13 F. R. 884, 1882, East. Dist. Wis., Dyer, J., to have intimated that the names of the witnesses by whom the defendants expect to prove prior use as a defence, should be stated in the answer; but that this case is overruled by *Roemer v. Simon*, 95 U. S. 219, and *Planing Machine Co. v. Keith*, 101 U. S. 479, which hold that only the names of those who invented or used the machine need be stated in the answer, and not the names of the witnesses.

Richardson v. Noyes, 10 O. G. 507, 1876, Dist. Mass., Lowell, J. See *Wallace v. Holmes*.

Robbins v. Chicago, 4 Wall. 657, 1866, Supr. Court, Clifford, J.

Is quoted in *American Bell Telephone Co. v. National Improved Telephone Co.*, 27 F. R. 665, 1886, East. Dist. La., by the court, as to the conclusiveness of the judgment respecting the same cause of action and between the same parties.

Roberts v. Buck, 6 Fisher, 325, 1873, Dist. Mass., Shepley, J.

Is cited in *Allis v. Buckstaff*, 13 F. R. 884, 1882, East. Dist. Wis., Dyer, J., as to the inadmissibility of evidence in defence as to anticipation not set up in the answer, if objected to.

Roberts v. Harnden, 2 Cliff. 500, 1865, Dist. Mass., Clifford, J.

Was decided in favor of the complainants; but *Roberts v. Ryer*, 91 U. S. 159, 1875, Supr. Court, Waite, C. J., a suit on the same patent (to D. W. C. Sanford for an improvement in refrigerators), was decided by the Supreme Court in favor of defendants, affirming the decision of the circuit court of the southern district of New York on the ground of prior invention by another than the patentee.

Roberts v. Buck, 91 U. S. 159, note, 1875, Supr. Court, Waite, C. J., also follows *Roberts v. Ryer*.

Roberts v. Reed Torpedo Co., 3 Fisher, 629, 1869, East. Dist. Penn., Grier, J.

Is explained in *North Western Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 1 Ban. & A. 191, 1874, East. Dist. Penn., McKennan, J.

Roberts v. Ryer, 91 U. S. 157, 1875, Supr. Court, Waite, C. J.

“It is no new invention to use an old machine for a new purpose. The inventor of the machine is entitled to the benefit of all the uses to which it can be put, no matter whether he conceived the idea of the use or not.” Quoted in *Gottfried v. Phillip Best Brewing Co.*, 5 Ban. & A. 33, 1879, East. Dist. Wis., Dyer, J.

Quoted to the same effect in *Gottfried v. Crescent Brewing Co.*, 9 F. R. 766, 1881, Dist. Ind., Gresham, J.

Said in *Cottier v. Stimson*, 20 F. R. 909, 1884, Dist. Or., Deady, J., to hold that it is no new invention to use an old machine for a new purpose.

Quoted to the same effect in *New Process Fermentation Co. v. Koch*, 21 F. R. 582, 1884, East. Dist., Mich. Brown, J.

Robinson v. Randolph, 4 Ban. & A. 163, 1879, Dist. N. J., Nixon, J.

Is said in *Cary v. Lovell Manuf. Co.*, 24 F. R. 143, 1885, West. Dist. Penn., Acheson, J., to be, like the latter case, one in which, on motion, the court declined to listen to affidavits alleging a new defence.

Roemer v. Simon, 95 U. S. 214, 1877, Supr. Court, Clifford, 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 who invented or used an anticipating machine need be pleaded under the statute, and not those who will prove such prior use.

Is cited in *Loom Co. v. Higgins*, 105 U. S. 596, 1881, Supr. Court, Bradley, J., as deciding that a failure to object, before the final hearing, to the defence of prior invention or use, on account of lack of notice of the names and residences of the prior users or inventors, waives such defect.

Is said in *Allis v. Buckstaff*, 13 F. R. 884, 1882, East. Dist. Wis., Dyer, J., to overrule the case of *Richardson v. Lockwood*, 6 Fisher, 454, and to establish the rule that when the defendant sets up the defence of prior use or invention, he need not in his answer set forth the names of the witnesses by whom he expects to prove prior use, but only the names of those who had invented or used the anticipating machine.

Rogers v. Sargent, 7 Blatchf. C. C. 507, 1870, South. Dist. N. Y., Blatchford, J.

This case was urged upon the court in the *Double Pointed Tack Co. v. Mann*, 5 Ban. & A. 473, 1880, East. Dist. Wis., Dyer, J., as a case where the invention was merely a corrugated staple, the mere use of a piece of corrugated wire such as every one had seen long before,

but which when bent into a staple produced a particular and novel effect; but the court in the latter case considered the case of *Rogers v. Sargent* at length, and held that the patent was sustained, for the reason that the corrugations were, under the patentee's claim, made by the use of dies, thus enabling the article to be constructed by machinery so that it could become a new article of manufacture.

Root v. Lake Shore & Michigan Southern Railway Co.,
105 U. S. 189, 1881, Supr. Court, Matthews, J.

The rule of that case is relied on in *Hayward v. Andrews*, 106 U. S. 675, 1882, Supr. Court, Matthews, J.

“ A bill in equity for a naked account of profits and damages against an infringer of a patent cannot be sustained. Such relief, ordinarily, is incidental to some other equity, the right to enforce which secures to the patentee his standing in court. The most general ground for equitable interference is to insure to the patentee the enjoyment of his specific right by an injunction against the continuance of the infringement; but grounds of equitable relief may arise, other than by injunction, as where the title of the complainant is equitable merely, or equitable interposition is necessary on account of the impediments which prevent the resort to remedies purely legal. Such an equity may arise out of and inhere in the nature of the account itself, springing from special and peculiar circumstances, which disable the patentee from recovery at law altogether, or render his remedy in a legal tribunal difficult, inadequate, and incomplete. As such cases cannot be defined more exactly, each must rest upon its own peculiar circumstances as furnishing a clear and satisfactory ground of exception from the general rule.” Quoted in *Campbell v. Ward*, 12 F. R. 151, 1882, Dist. N. J., Nixon, J.

Is cited in *Davis v. Smith*, 19 F. R. 823, 1884, Dist. Mass., Lowell, J., as governing the decision in the latter case.

It is said in *New York Grape Sugar Co. v. Peoria Grape Sugar Co.*, 21 F. R. 879, 1884, North. Dist. Ill., Blodgett, J., that since the decision in the former case that equity has no jurisdiction in a suit upon an expired patent, when the only relief sought is accounting for profits and damages, the decisions at the circuit have not been uniform as to such jurisdiction, in cases where a patent expires after the commencement of the suit and before decree.

It is said in *Smith v. Sands*, 24 F. R. 472, 1885, West. Dist. Mich., Withey, J., that the former case reviews the patent laws and the decisions under them, showing when the remedy is in equity, and when the sole remedy is in the court of laws, for the infringement of a patent.

Is interpreted in *Crandall v. Plano Manuf. Co.*, 24 F. R. 739, 1885, North. Dist. Ill., Blodgett, J., as proceeding upon the ground that patentees have an adequate remedy at law in suits against infringers, except in cases where there is a right to an injunction as part of the relief sought; but that in all cases where the only question is as to the amount of profits and damages, and the complainant is not entitled to an injunction, the remedy is at law.

This case is briefly stated; and the statement that an equity giving a federal court jurisdiction in a patent case may arise out of the nature of the account itself, is said, in *Lord v. Whitehead, &c. Machine Co.*, 24 F. R. 803, 1885, Dist. Mass., Colt, J., not to mean that a federal court will take jurisdiction in equity merely because of the intricacy of an account which is designed to embrace compensation for numerous tortious acts.

Is said in *Clark v. Wooster*, 119 U. S. 325, 1886, Supr. Court, Bradley, J., to contain nothing contrary to the proposition that where the case made by the bill in a patent cause was for equitable relief when the suit was instituted, the mere fact that the ground for such relief expired by the expiration of the patent would not take away the jurisdiction and preclude the court from proceeding to grant the incidental relief which belongs to that class of cases.

Is said in *Beedle v. Bennett*, 122 U. S. 75, 1886, Supr. Court, Matthews, J., not to present any objection to jurisdiction in a case where the patent is in force at the time the bill is filed, and expires before final decree.

Governed the decision in the *Consolidated Safety Valve Co. v. Ashton Valve Co.*, 26 F. R. 319, 1886, Dist. Mass., Colt, J.

It is said in *Racine Seeder Co. v. Joliet Wire Check Rower Co.*, 27 F. R. 368, 1886, North. Dist. Ill., Blodgett, J., that the decision in *Root v. Railway Co.* rendered the jurisdiction of the court, in *Racine Seeder Co. v. Joliet Wire Check Rower Co.*, doubtful; the bill in the latter case being filed about two months before the expiration of the patent, the court dismissed the bill without prejudice to a suit at law.

Is said in *Consolidated M. Purifier Co. v. Wolf*, 28 F. R. 816, 1886, East. Dist. Penn., Bradley, J., to have decided, after much consideration, that a suit merely for an account of gains, profits, and savings on a license, cannot be maintained in equity; there must be some equitable ground for relief in addition to a mere demand for account.

The principles of this case are applied in *Kittle v. Hall*, 29 F. R. 511, 1887, South. Dist. N. Y., Coxe, J.

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

Rowell v. Lindsay, 113 U. S. 97, 1884, Supr. Court, Woods, J.

Is cited and explained in *La Rue v. Western, &c. Co.*, 28 F. R. 90, 1886, South. Dist. N. Y., Brown, J.

Rubber Co. v. Goodyear, 6 Wall. 153, 1867, Supr. Court, Chase, C. J.

Is said in *American Nicholson Pavement Co. v. Elizabeth*, 1 Ban. & A. 468, 1874, Dist. N. J., Nixon, J., not to be an authority for the allowance by the court of a bond given by the defendants on final decree without sureties.

Rubber Co. v. Goodyear, 9 Wall. 788, 1869, Supr. Court, Swayne, J.

The opinion of the Supreme Court in this case was followed as conclusive, to the effect that the decision of the commissioner of patents as to the validity of an extension is conclusive in a suit for infringement in *American Wood Paper Co. v. Glen Falls Paper Co.*, 8 Blatchf. C. C. 515, 1870, North. Dist. N. Y., Woodruff, J.

Was urged by counsel for complainants in *American Nicholson Pavement Co. v. Elizabeth*, 1 Ban. & A. 459, 1874, Dist. N. J., Nixon, J., as a case deciding that in estimating profits, nothing should be allowed to the infringers for personal services, but is said by Nixon, J., to decide just the contrary; that is, to allow usual salaries of managing officers, but to disallow extraordinary salaries, which are in reality disguised dividends.

The course pursued in this case, where the inventor first patented the process and afterwards surrendered the letters-patent and took his reissue in two several patents, one for the product and the other for the process of the product, is approved in *McKay v. Dibert*, 5 F. R. 590, 1880, Dist. N. J., Nixon, J.

Is stated in *Root v. Railway Co.*, 105 U. S. 197, 1881, Supr. Court, Matthews, J., as affirming the rule that an infringer of a patent must account for his actual profits only, not for what he might possibly by diligence have made.

It is cited in *National Manuf. Co. v. Meyers*, 7 F. R. 357, 1881, South. Dist. Ohio, Swing, J., as a case where the defence of invalidity of plaintiff's patent and a license under that patent were both set up in the defendant's answer, without objection either in the circuit or Supreme Court, thereby showing that those defences were not regarded by the complainant's counsel as inconsistent.

Is said in *Railway Register Manuf. Co. v. North Hudson C. R. Co.*, 23 F. R. 594, 1885, Dist. N. J., Nixon, J., to have held that Congress did not mean a patent to be abrogated collaterally, but left the remedy in such a case to be regulated by principles of general jurisprudence.

Rubber Tip Pencil Co. v. Howard, 20 Wall. 498, 1872, South. Dist. N. Y., Benedict, J.

Decides whether a new article of manufacture is a patentable invention. 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 commissioner of patents.

Ruggles v. Eddy, 11 Blatchf. C. C. 524, 1874, North. Dist. N. Y., Woodruff, J.

Is said in *De Florez v. Raynoïds*, 4 Ban. & A. 340, 1879, South. Dist. N. Y., Blatchford, J., to be a case where an application to be allowed to amend an answer on the ground of the incompetency of the defendant's counsel, by whom the answer had been filed, was not allowed.

Russell v. Dodge, 93 U. S. 460, 1876, Supr. Court, Field, J.

Said to be similar in general principles to *Russell v. Place*, 94 U. S. 606, 1876, Supr. Court, Field, J.

Is said in *Herring v. Nelson*, 3 Ban. & A. 66, 1877, North. Dist. N. Y., Johnson, J., to decide only the point that the alleged inventions contained in the original and reissued patents were unpatentable for lack of novelty.

The opinion of Mr. Justice Field is quoted in *Atlantic Giant Powder Co. v. Goodyear*, 3 Ban. & A. 164, 1877, Dist. Mass., Shepley, J., to the effect that in a reissue a change from the specifications of the original patent, of which change the entire object is not to correct a defect in the original patent, but to change it, and to obtain a patent for a different invention, invalidates the reissued patent.

Is cited in *Gould v. Ballard*, 3 Ban. & A. 327, 1878, Dist. N. J., Nixon, J., as a case where the Supreme Court exhibited a disposition to criticise the facility with which reissues were obtained at the patent office. *Russell v. Dodge* is distinguished from *Gould v. Ballard*; the former being a case when the reissue extended the operation of the original patent, the latter a case where the omission of a part of the elements restricted the original patent in the reissue.

Is cited in *Ball v. Langles*, 102 U. S. 130, 1880, Supr. Court, Strong, J., to the point that a reissue embracing new matter, or for anything broader than the invention as originally described in the specification and drawings or models, is void.

Is said in *Atwood v. Portland Co.*, 5 Ban. & A. 538, 1880, Dist. Maine, Lowell, J., to decide that a patentee in reissuing his patent has no right to omit something which he had described in the original patent as essential.

“ A defective specification could be rendered more definite than certain, so as to embrace the claim made, or the claim could be so modified as to correspond with the specification ; but except in special circumstances, such as occurred in the case of *Lockwood v. Morey*, 8 Wall. 230, where the inventor was induced to limit his claim by the mistake of the commissioner of patents, this was the extent to which the operation of the original patent could be changed by the reissue. The object of the law was to enable the patentees to remedy accidental mistakes, and the law was perverted when any other end was secured by the reissue.” Quoted in *Giant Powder Co. v. California Vigorit Co.*, 4 F. R. 725, 1880, Dist. Cal., Field, J.

The opinion of Mr. Justice Field in this case is quoted at some length in *Washburn, &c. Manuf. Co. v. Haish*, 4 F. R. 910, 1880, North. Dist. Ill., Drummond, J., to the point that a reissue can only be granted for the same invention originally embraced by the original patent.

This case is briefly stated, and the effect of the decision given as to the validity of the reissue, in *Flower v. Rayner*, 5 F. R. 798, 1880, Dist. N. J., Nixon, J.

In *Wilson v. Coon*, 6 F. R. 620, 1880, South. Dist. N. Y., Blatchford, J., this case is considered at length, with the comment that the case of *Russell v. Dodge* is often cited as authority for the proposition that where the claim of the patent is valid, and the descriptive part of the specification is sufficient to support it, the patent cannot be reissued ; but that the case does not lay down the above proposition, nor does any case yet decided by the Supreme Court.

Is said in *Smith v. Merriam*, 6 F. R. 719, 1881, Dist. Mass., Lowell, J., to decide merely that a reissue which claims a different invention is void, and that *Russell v. Dodge* is considered by Mr. Justice Strong,

in *Ball v. Langles*, 18 O. G. 1405, to be consistent with *Seymour v. Osborne*, 11 Wall. 516.

Is stated at length in *Kells v. McKenzie*, 9 F. R. 286, 1881, East. Dist. Mich., Brown, J., as an authority strictly limiting the right of reissues.

Is stated briefly upon the question of reissues in *Scrivner v. Oakland Gas Co.*, 22 F. R. 99, 1884, Dist. Cal., Sawyer, J.

Russell v. Place, 9 Blatchf. C. C. 173, 1871, North. Dist. N. Y., Woodruff, J.

Mr. Justice Woodruff is said, in *Burdett v. Estey*, 5 Ban. & A. 313, 1880, Dist. Vt., Wheeler, J., to have treated as intentional and deliberate an infringement made by persons who knew of the patent in suit, although they supposed that another patent of the plaintiff's, which they owned, protected them in their acts.

Russell v. Place, 94 U. S., 606, 1876, Supr. Court, Field, J.

Is cited, and the principles applied, in *Steam Gauge & Lantern Co. v. Meyrose*, 27 F. R. 213, 1886, East. Dist. Mo., Brewer, J., to the effect that a judgment recovered in an action at law for damages for infringement of a patent does not estop the same defendant in an equity suit for an injunction and an account, if the validity of the patent was not necessarily involved in the prior case, except in respect to the claim which was the basis of the judgment.

Russell & Erwin Manuf. Co. v. Mallory, 10 Blatchf. C. C. 149, 1872, Dist. Conn., Woodruff, J.

“Lapse of time does not *per se* constitute abandonment. It may be a circumstance to be considered. The circumstances of the case, other than mere lapse of time, almost always give complexion to delay, and either excuse it or give it conclusive effect. The statute has made contemporaneous public use, with the consent and allow-

ance of the inventor, a bar when it exceeds two years. But in the absence of that and of any other colorable circumstances, we know of no mere period of delay which ought *per se* to deprive an inventor of his right." Quoted in *Andrews v. Carman*, 2 Ban. & A. 295, 1876, East. Dist. N. Y., Benedict, J.

S.

Sanders v. Logan, 2 Fisher, 167, 1861, West. Dist. Penn., Grier, J.

Is cited in *Vaughan v. East Tennessee, &c. R. R. Co.*, 2 Ban. & A. 540, 1877, East. Dist. Tenn., Brown, J., as doubting whether a court of equity had jurisdiction when the bill stated a case proper for neither an account nor injunction, but only for a decree for a certain sum of money, with interest, as fixed actual damages. This is construed, in *Vaughan v. East Tennessee, &c. R. R. Co.*, as a negative pregnant that if an account is prayed for, the jurisdiction is sustained.

The opinion of Mr. Justice Grier is quoted in *Vaughan v. Central P. R. R. Co.*, 3 Ban. & A. 31, 1877, Dist. Cal., Sawyer, J., to the point that in an invention for an improvement in grist-mills, the license fee is the measure of actual damages suffered.

Sargent v. Hall Safe and Lock Co., 114 U. S. 63, 1884, Supr. Court, Blatchford, J.

"In patents for combinations of mechanisms, limitations and provisos imposed by the inventor, especially such as were introduced into an application after it had been positively rejected, must be strictly construed against the inventor and in favor of the public, and looked upon as in the nature of disclaimers." Quoted in *Shepard v. Carrigan*, 116 U. S. 598, 1885, Supr. Court, Woods, J.

Sargent v. Larned, 2 Curtis, C. C. 340, 1855, Dist. Mass., Curtis, J.

Is said in *Morse v. Davis*, 5 Blatchf. C. C. 44, 1862, North. Dist. N. Y., Hall, J., not to be a case of much importance upon the question of infringement, and only to decide that a defendant who is merely a workman in the employ of another cannot be required to account for profits of an infringement.

Is cited in *Brooks v. Moorhouse*, 3 Ban. & A. 231, 1878, Dist. Mass., Shepley, J., as a case where Curtis, J., enforced by injunction an agreement not to make any articles which infringed plaintiff's patent.

Sargent v. Seagrave, 2 Curtis, C. C. 553, 1855, Dist. R. I., Curtis, J.

Is referred to in *Toppan v. National Bank Note Co.*, 4 Blatchf. C. C. 512, 1861, South. Dist. N. Y., Shipman, J.

Sargent v. Yale Lock Manuf. Co., 17 Blatchf. C. C. 244, 1879, South. Dist. N. Y., Blatchford, J.

The principle of this case is said in *Fitch v. Bragg*, 16 F. R. 247, 1883, Dist. Conn., Shipman, J., to be, that when the reduction of prices in the plaintiff's sales is the only element of damages, if the essential feature of the plaintiff's structure and of the infringing structure respectively is the patented device, and the patented device, being only a part of the structure, must necessarily be embodied in the complete structure for sale, and the patentee is enabled by the presence of such patented device to make a profit on the entire structure, and he is deprived by the acts of the defendant in selling at low prices infringing structures containing the patented device, of the profits which he otherwise would have made on the structures containing the patented device which he actually sold, the defendant's infringement must be held to have caused the entire

loss of the plaintiff by the reduction of prices, after allowing a proper sum for any other patented device contained in the defendant's structures.

Sargent Manuf. Co. v. Woodruff, 5 Biss. 444, 1873, West. Dist. Wis., Hopkins, J.

Is cited in *Cornell v. Littlejohn*, 2 Ban. & A. 327, 1876, South. Dist. N. Y., Johnson, J., to the point that a preliminary injunction in a patent suit is not a controlling authority in another circuit.

Sarven v. Hall, 9 Blatchf. C. C. 524, 1872, Dist. Conn., Woodruff, J.

Is affirmed in *Russell, &c. Manuf. Co. v. Mallory*, 10 Blatchf. C. C. 146, 1872, Dist. Conn., Woodruff, J., and distinguishes between a patentable combination and a mere aggregation of elements having no relation to one another, or no reciprocal or co-operative action to produce the result obtained.

Sawin v. Guild, 1 Gall. 485, 1813, Dist. Mass., Story, J.

Is distinguished in *Morse v. Davis*, 5 Blatchf. C. C. 44, 1862, North. Dist. N. Y., Hall, J., from the latter case.

Is cited in *Wilder v. Kent*, 15 F. R. 218, 1883, West. Dist. Penn., Acheson, J., as holding that an execution sale by the sheriff of the "materials" of several patented machines was not infringement of the patent right by the officer who made the sale.

Saxe v. Hammond, 1 Holmes, 456, 1875, Dist. Mass., Shepley, J.

The language of Mr. Justice Shepley in this case to the effect that a mere manufacture of the separate elements of a patented combination by different manufacturers is not an infringement unless such manufacture be proved to have been conducted for the

purpose and with the intent of aiding infringement, is quoted in *Snyder v. Bunnell*, 29 F. R. 48, 1886, South. Dist. N. Y., Coxe, J.

Sayles v. Chicago & N. W. R. R. Co., 4 Fisher, 584, 1871, North. Dist. Ill., Drummond, J.

Is cited by Longyear, J., in *Hawes v. Antisdell*, 2 Ban. & A. 11, 1875, East. Dist. Mich., as a case where the evidence of prior use or knowledge, being nicely balanced, the patent was sustained.

Sayles v. Dubuque & S. C. R. R. Co., 9 F. R. 516, 1879, Dist. Iowa, *per Curiam*. See *Collins v. Peebles*.

Sayles v. Lakeshore & M. S. R. R. Co., 9 F. R. 515, 1879, North. Dist. Ill., Harlan, J. See *Collins v. Peebles*.

Sayles v. Oregon Central Railway Co., 6 Sawyer, 31, 1879, Dist. Or., Deady, J.

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 limitations may be interposed as a defence in a suit in the federal court for infringement of a patent. See *Collins v. Peebles*.

Sayles v. Railway Co., 97 U. S. 554, 1878, Supr. Court, Bradley, J.

“If one inventor precedes all the rest and strikes out something which includes and underlies all that they produce, he acquires a monopoly and subjects them to tribute.” Quoted in *Steam Gauge &c. Co. v. Miller*, 8 F. R. 322, 1881, Dist. Conn., Shipman, J.

Sayles v. Richmond, F. & P. R. R. Co., 4 Ban. & A. 241, 1879, East. Dist. Va., Hughes, J.

Is cited in *Hayden v. Oriental Mills*, 22 F. R. 104, 1884, Dist. R. I., Colt, J., as deciding that the statute of limitations, act of July 8, 1870, § 55, of six years from the expiration of the patent, for bringing patent

suits for infringements, begins to run at the expiration of the period of twenty-one years as one term. *Contra*, *Sayles v. Louisville City R. R. Co.*, 9 F. R. 512; *Sayles v. Lakeshore & M. S. R. R. Co.*, 9 F. R. 515; *Sayles v. Dubuque & S. C. R. R. Co.*, 9 F. R. 516.

Schillinger v. Greenway Brewing Co., 21 Blatchf. C. C. 383, 1883, North. Dist. N. Y., Blatchford, J.

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

Schollenberger, Ex Parte, 96 U. S. 369.

The opinion of Mr. Chief-Justice Waite is quoted in *Vermont Farm Machine Co. v. Murble*, 20 F. R. 118, 1884, Dist. Vt., Wheeler, J., to the effect that the act of Congress prescribing that no person may be sued in a federal court, except in the district of which he is an inhabitant or in which he is found, is in the nature of the personal exemption in favor of a defendant, and one which he may waive. See now act of Congress, 1886-87, March 3, c. 373, that no person can be sued except in the district of which he is an inhabitant.

Schuessler v. Davis, 13 O. G. 1011, 1878, North. Dist. N. Y., Wallace, J.

Gives a construction of the same reissue on which suit was brought in *Loercher v. Crandal*, 11 F. R. 879, 1881, North. Dist. N. Y., Blatchford, J.

Selden v. Stockwell Gas Burner Co., 19 Blatchf. C. C. 544, 1881, South. Dist. N. Y., Blatchford, J.

Is said in *Consolidated Electric Light Co. v. Edison Electric Light Co.*, 25 F. R. 721, 1885, South. Dist. N. Y., Wallace, J., to decide that under § 4895, U. S. R. S., a patent may be issued to the person who by the records of the office is assignee of the patent, although not technically the assignee of the inventor.

Seymour v. McCormick, 16 How. 485, 1853, Supr. Court, Grier, J.

Is said in *New York v. Ransom*, 23 How. 489, 1859, Supr. Court, Grier, J., to have decided that where the profit of the patentee is derived neither from an exclusive use of the thing patented nor from a monopoly of making it for others to use, the actual damage which he suffers by the use of his improvement without his license is the price of it, with interest, and no more. It is to his advantage that every one should use his invention, provided he pays for a license. The only damage to the patentee is the non-payment of that sum when the infringer commences the use of the invention.

The opinion of Mr. Justice Grier is quoted in *American Nicholson Pavement Co. v. Elizabeth*, 1 Ban. & A. 444, 1874, Dist. N. J., Nixon, J., to the point that no rule can be laid down in an action at law which shall settle for all cases what damages are to be allowed the patentee.

Is said in *Goodyear Dental Vulcanite Co. v. Van Antwerp*, 2 Ban. & A. 255, 1876, Dist. N. J., Nixon, J., to establish the rule of damages, that if the patentee holds a close monopoly of the patent, damages are the infringer's profits; if the patentee sells licenses to all, the license fee is the proper measure of damages, unless punitive damages are proper.

Is said in *Buerk v. Imhaueser*, 2 Ban. & A. 454, 1876, South. Dist. N. Y., Johnson, J., to be quoted from as to the measure of damages in *Goodyear Dental Vulcanite Co. v. Van Antwerp*. In *Buerk v. Imhaueser* there is also a quotation from *Seymour v. McCormick*, to the effect that actual damages must be proved, and are not to be inferred.

The rule as to the measure of damages is again quoted in *Vaughan v. Central Pacific R. R. Co.*, 3 Ban. & A. 31, 1877, Dist. Cal., Sawyer, J.

Is stated briefly, and the opinion of Mr. Justice Grier quoted at some length, in *Root v. Railway Co.*, 105 U. S. 195, 1881, Supr. Court, Matthews, J. *Seymour v. McCormick* decides that in an action at law for an infringement of a patent no rule can be laid down for the measure of damages in every case; but the plaintiff must prove his actual damages, or he will have only nominal damages.

Is cited in *Graham v. Geneva, &c. Manuf. Co.*, 24 F. R. 643, 1881, East. Dist. Wis., Dyer, J., on the question of the measure of damages.

The rule in this case, that in suits at law for infringement of patents, when the sale of licenses by the patentee has been sufficient to establish a price for such licenses, the price should be taken as the measure of damages against the infringer, is said in *Westcott v. Rude*, 19 F. R. 833, 1884, Dist. Ind., Woods, J., to be reaffirmed in *Packet Co. v. Sickles*, 19 Wall. 611.

Seymour v. Osborne, 11 Wall. 516, 1870, Supr. Court, Clifford, J.

Is cited in *Goodyear Dental Vulcanite Co. v. Smith*, 1 Ban. & A. 205, 1874, Dist. Mass., Shepley, J., and said to be an exhaustive and authoritative exposition of the principle that when the commissioner of patents accepts a surrender of an original patent and grants a new patent, his decision as to the validity of the patent is final and conclusive in a suit for infringement, unless it is apparent upon the face of the patent that he has exceeded his authority, and that there is such a repugnancy between the old and new patent that it must be held as a matter of legal construction that the new patent is not for the same invention as is secured by the original patent.

Decides, *inter alia*, that all matters of fact involved in the hearing of an application to reissue a patent and

in granting it, are conclusively settled by the decision of the commissioner granting the application, but that matters of construction arising upon the face of the instrument, *e. g.*, whether the reissue is for the same invention as the original patent, are still open. In *Reckendorfer v. Faber*, 92 U. S. 354, 1875, Supr. Court, Hunt, J., it is said that the remarks in *Seymour v. Osborne* are chiefly upon the subject of reissues, and are consistent with the principles of *Reckendorfer v. Faber*, which are, that the question of utility in an original grant of a patent is not conclusively settled by the commissioner's decision, but is open in a suit on this patent.

Is construed by Sawyer, J., in *Atlantic Giant Powder Co. v. California Powder Works*, 2 Ban. & A. 150, 1875, Dist. Cal., Sawyer, J., as laying down the rule that on an application for a reissue of a patent, the commissioner, in looking for the invention intended to be patented, and for which a reissue may be granted, has no authority to look beyond the patent as originally granted, with the specification and drawings annexed, and the models, except in cases specified in 16 Statutes at L. 206, act 1870, § 53, last clause.

In *Reissner v. Anness*, 3 Ban. & A. 178, 1877, Dist. N. J., Nixon, J., says that the Supreme Court, in considering the differences between the reissue and the original patent which would make the former invalid, says that the patentee under an application for a reissue cannot make material additions to the invention which were not described, suggested, nor substantially indicated in the original specifications, drawings, or patent-office model.

Is referred to in *Powder Co. v. Powder Works*, 98 U. S. 159, 1878, Supr. Court, Bradley, J., as deciding that a reissue, to be valid, must be for the same invention as the original patent.

The opinion of Mr. Justice Clifford in this case is quoted at some length in *Gottfried v. Phillip Best Brewing Co.*, 5 Ban. & A. 30, 1879, East. Dist. Wis., Dyer, J., upon the question what sort of prior invention is necessary to deprive a subsequent inventor on the same device to his right to a patent.

Is said in *Horman Patent Manuf. Co. v. Brooklyn City Railroad Co.*, 4 Ban. & A. 87, 1879, East. Dist. N. Y., Benedict, J., simply to decide that when a bill sets forth several patents, all pertaining to the same subject, and all required to constitute a complete machine, and all embodied in the machine which the complainants furnish, the bill will be upheld.

Is cited in *Ball v. Langles*, 102 U. S. 130, 1880, Supr. Court, Strong, J., to the point that a reissue for anything broader than the invention described in the original specifications or drawings, and models, or embracing new invention, is void.

The powers of the commissioner of patents in regard to a reissue are briefly set forth in this case, and it is cited upon that point in *Wilson v. Coon*, 6 F. R. 618, 1880, South. Dist. N. Y., Blatchford, J.

It is said in *Strobridge v. Lindsay*, 5 Ban. & A. 414, 1880, West. Dist. Penn., Acheson, J., that this case authoritatively declares utility to exist within the meaning of the patent law "if the combination is new, and the machine capable of being beneficially used for the purpose for which it was designed."

Lays down the rule as to the question of identity between the invention described in a patent and in a reissue. *Heald v. Rice*, 104 U. S. 749, 1881, Supr. Court, Matthews, J.

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 a patentee may invoke the doctrine of equivalents on the question of infringement in a case of a

combination patent. The language of the court upon this point is quoted at length.

In *Kells v. McKenzie*, 9 F. R. 286, 1881, East. Dist. Mich., Brown, J., it is said that the tendency of later cases in the Supreme Court has been to hold a patentee to a much more rigid rule regarding reissues than is indicated in the former case. *Seymour v. Osborne* is also said in *Kells v. McKenzie* 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 introductory statement of the invention may have had reference to another portion of the machine.

Quoted in *Downton v. Yeager Milling Co.*, 108 U. S. 471, 1882, Supr. Court, Woods, J., to the point that a foreign published description of an invention to invalidate a United States patent must be in such full, clear, and exact terms that a person skilled in the art would be able to make use of it as if it was described in a prior patent.

The opinion of the court in this case as to the power of the commissioner of patents to allow whatever is suggested or indicated in the specification or drawing of the patent, and which properly belongs to the invention, to be included in the reissue, is quoted in approval in *Combined Patents Can Co. v. Lloyd*, 11 F. R. 150, 1882, East. Dist. Penn., Butler, J.

Is cited in *Nellis v. Pennock Manuf. Co.*, 13 F. R. 452, 1882, East. Dist. Penn., McKennan, J., to the effect that where all the patents sued have reference to the same general subject, and are all embodied in machines manufactured by the defendant, a demurrer for multifariousness will not lie to the bill.

Is said in *Hendy v. Golden State, &c. Works*, 17 F. R. 516, 1883, Dist. Cal., Sawyer, J., to recognize the

right to amend, in a reissue, the specifications of the original patent, by the model as well as by the drawings of the original patent.

Is said in *Hancock Inspirator Co. v. Jenks*, 21 F. R. 914, 1884, East. Dist. Mich., Brown, J., to decide that the recital in a patent that the necessary oaths were taken by the applicant, is conclusive evidence that the necessary oaths were taken.

Is quoted from, in *New Process Fermentation Co. v. Koch*, 21 F. R. 586, 1884, East. Dist. Mich., Brown, J., to the effect that to anticipate a subsequent United States patent, a foreign publication must describe the invention clearly, so that any person skilled in the art or science might construct it as they would be able to from the information of a prior patent.

The opinion of Clifford, J., is quoted in *Flower v. Detroit*, 22 F. R. 294, 1884, East. Dist. Mich., Brown, J., to the effect that a reissue by the commissioner is not re-examinable in a suit for infringement, unless it is apparent upon the face of the patent that the original patent and the reissue cannot be for the same invention.

The opinion of Mr. Justice Clifford in this case is quoted to the same effect as in *New Process Fermentation Co. v. Koch*, *supra*, in *Earnes v. Andrews*, 122 U. S. 66, 1886, Supr. Court, Matthews, J.

Sharp v. Reissner, 20 O. G. 1161, 1881, South. Dist. N. Y., Blatchford, J.

Is so limited in *Hubbell v. De Land*, 14 F. R. 474, 1882, East. Dist. Wis., Dyer, J., as not to decide that a defendant in a suit in equity cannot file a special plea, but only that the special plea filed in that case (*Sharp v. Reissner*) stated matters not proper for a plea.

Shaw v. Cooper, 7 Pet. 310, 1833, Supr. Court, McLean, J.

Is said in *Battin v. Taggart*, 17 How. 83, 1854,

Supr. Court, McLean, J., to have sanctioned the principle expressed in *Grant v. Raymond*, 6 Pet. 218; that is, that the patent office had the power to issue a re-issued and corrected patent before any legislation was had upon this subject.

Is cited in *Planing Machine Co. v. Keith*, 101 U. S. 484, 1879, Supr. Court, Strong, J., as to abandonment or dedication to the public by an inventor.

Is quoted from at length in *Driven Well Cases*, 16 F. R. 389, 1883, South. Dist. Iowa, Shiras, J., as to acquiescence in public use constituting an abandonment of a patent.

Is distinguished in *Davis v. Fredericks*, 19 F. R. 99, 1884, South. Dist. N. Y., Wheeler, J., from the latter case, as being a case which arose under the act of 1800, which provided that every patent which should be obtained pursuant to that act for any invention, art, or discovery, which it should afterwards appear had been known or used previous to the application, should be utterly void. *Shaw v. Cooper* is therefore not now authority upon that point.

Shaw Relief Valve Co. v. New Bedford, 19 F. R. 753, 1884, Dist. Mass., Lowell, J.

Is stated in *Bradley v. Dull*, 19 F. R. 913, 1884, West. Dist. Penn., Acheson, J., to have decided that the insertion of the word "heirs" in a patent does not secure to the heirs the benefit of the invention of the deceased patentee, in case of intestacy, to the exclusion of the administrator.

Shepard v. Carrigan, 116 U. S. 598, 1885, Supr. Court, Woods, 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 re-issued without the claim, there is no inadvertence, accident, or mistake which will entitle the patentee to a reissue.

Sickels v. Borden, 3 Blatchf. C. C. 535, 1856, South. Dist. N. Y., Nelson, 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.).

To constitute an infringement, it is not only necessary that the arrangement which is said to infringe should perform the same function or produce the same effect, but, as Mr. Justice Nelson says in the above case, it must do it in substantially the same way. *Werner v. King*, 96 U. S. 230, 1877, Supr. Court, Miller, J.

Sickles v. Evans, 2 Cliff. 221, 1863, Dist. Mass., Clifford, J.

Is cited in *Stevens v. Pritchard*, 2 Ban. & A. 393, 1876, Dist. Mass., Clifford, J., as deciding that when the court, on inspection of a patent and the reissue, decides that the thing patented is not the same invention, the reissue is invalid.

Sickles v. Gloucester Manuf. Co., 1 Fisher, 224, 1856, Dist. N. J., Grier, J.

The opinion of Mr. Justice Grier, to the effect that a federal court will take jurisdiction in equity, under the statute of 1870, of a patent case where no injunction can be decreed, if the subject-matter cannot be as well investigated at law, is cited in *Smith v. Baker*, 1 Ban. & A. 119, 1874, East. Dist. Penn., McKennan, J. This case was decided before *Root v. Railway Co.* (q. v.), and is of course controlled by that decision.

The opinion of Mr. Justice Grier is quoted from, to the point that the courts of the United States have juris-

diction over patent cases by statute, and not as ancillary to a court of law, and therefore do not always require a verdict at law before granting a final injunction, or grant an issue for a jury whenever that is claimed. *Cochrane v. Deener*, 94 U. S. 783, 1876, Supr. Court, Bradley, 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 right of a patentee to an injunction, and is cited to this effect in *Gordon v. Anthony*, 4 Blatchf. 258, 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, 1879, East. Dist. Tenn., Brown, J., as deciding that the federal courts have jurisdiction of a patent case where discovery to aid an account is prayed for, although no injunction can be given. See now *Root v. Railway Co.*

Sickles v. Mitchell, 3 Blatchf. C. C. 548, 1857, South. Dist. N. Y., Ingersoll, J.

Is cited in *Hodge v. Hudson River Ry. Co.*, 6 Blatchf. C. C. 171, 1868, South. Dist. N. Y., Blatchford, J., upon the question when an injunction shall be ordered.

Silsby v. Foote, 20 How. 378, 387, 1857, Supr. Court, Nelson, J.

A charge for interest on profits in a master's decree is not ordinarily allowable. The decree of the circuit court allowing it was reversed in the Supreme Court. Cited to this effect in *Brady v. Atlantic Works*, 3 Ban. & A. 579, 1878, Dist. Mass., Clifford, J.

Is cited in *Steam Stone Cutter Co. v. Windsor Manuf. Co.*, 4 Ban. & A. 453, 1879, Dist. Vt., Wheeler, J., as a case in which the interest upon the profits of an infringement was disallowed.

Is said in *Barker v. Stowe*, 11 F. R. 308, 1882, North. Dist. N. Y., Blatchford, J., to decide that the pronouncing of a decision by the circuit court, and its entry in the minutes where the judgment or decree is a simple one, "such as an affirmance or reversal, and the like," constitutes a decree from which an appeal may be taken to the Supreme Court.

Singer Sewing Machine Co. v. Union Buttonhole Co., 1 Holmes, 253, 1873, Dist. Mass., Lowell, J.

Is said in *Galley v. Colt, &c. Manuf. Co.*, 30 F. R. 121, 1887, Dist. Conn., Shipman, J., to discuss in a very able manner the question whether a court of equity has jurisdiction to grant an injunction to restrain acts which are being done in violation of a contract in regard to personal property where the nature of the contract is such that specific performance cannot be enforced.

Slawson v. Grandstreet R. R. Co., 107 U. S. 649, 1883, Supr. Court, Woods, J.

Is cited in *Bradley, &c. Manuf. Co. v. Charles 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 is one to be examined with increased care.

Is said, in *Nicodemus v. Frazier*, 19 F. R. 262, 1884, Dist. Md., Morris, J., to rule that if upon the face of the bill the invention is clearly unpatentable, the Supreme Court may, of its own motion, dismiss the bill on that ground, without looking into the answer.

Is said in *Leonard v. Lovell*, 29 F. R. 314, 1886, West. Dist. Mich., Severens, J., to be a valuable case on the question of the scope and purpose of the patent statutes.

Smith v. Baker, 5 O. G. 496, 1874, East. Dist. Penn., McKennan, J.

Follows the rule laid down in *Nevins v. Johnson*, 3

Blatchf. C. C. 80, that the federal court has jurisdiction of a patent suit in equity irrespective of the rights of a 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. See now *Root v. Railway Co.*

Smith v. Downing, 1 Fisher, 69, 1850, Dist. Mass., Woodbury, J.

In *Trader v. Messmore*, 1 Ban. & A. 640, 1875, South. Dist. Ohio, Swing, J., the language of Woodbury, J., in *Smith v. Downing*, is quoted to the effect that the court should not put a broader construction on the language of a patentee in his specification, claims, &c., than the whole subject-matter and description and nature of the case serve to indicate as designed; the construction should be natural, and not forced.

Smith v. Ely, 5 McLean, 76, 1849, Dist. Ohio, McLean, J.

Is said in *Canan v. Pound Manuf. Co.*, 23 F. R. 186, 1885, North. Dist. N. Y., Wallace, J., to have held that the patent of Morse for the electric telegraph was void under § 6 of the patent act of 1839, because, although it had been first patented in France, the United States letters-patent did not upon their face limit the term of the grant to fourteen years from the date or publication of the foreign patent; but this conclusion was overruled in *O'Reilly v. Morse*, 15 How. 62; and it was held that the only effect of the French patent was to limit the monopoly to fourteen years from the date of that patent.

Smith v. Goodyear Dental Vulcanite Co., 93 U. S. 486, 1876, Supr. Court, Strong, J.

Is distinguished on the facts in *United States Rifle, &c. Co. v. Whitney Arms Co.*, 2 Ban. & A. 499, 1876,

Dist. Conn., Shipman, J., from the latter case, as to the effect of a renewed application after a rejection.

Is adopted as settling how much importance the general use of an invention should have as a test of its patentability, in *Eppinger v. Richey*, 3 Ban. & A. 74, 1877, South. Dist. N. Y., Shipman, J.

Established the validity of the Goodyear patent and its construction; that is, a product or manufacture made in a defined manner, not the product alone separated from its process, which is as much a part of the invention as the material of which the product is made. *Goodyear Dental Vulcanite Co. v. Davis*, 3 Ban. & A. 116, 1877, Dist. Mass., Shepley, J.

In view of this decision the court, in *Comstock v. Sandusky Seat Co.*, 3 Ban. & A. 190, 1878, North. Dist. Ohio, Welker, J., overruled the defence of non-patentability, which was set up in the answer, leaving the question to the Supreme Court on appeal.

Is cited and distinguished in *Planing Machine Co. v. Keith*, 101 U. S. 488, 1879, Supr. Court, Strong, J., as to loss of rights to an invention by negligence in presenting them.

Is cited in *United States Stamping Co. v. King*, 4 Ban. & A. 477, 1879, South. Dist. N. Y., Blatchford, J., as laying down the principles which govern the latter case.

This case is said, in *American Diamond Rock Boring Co. v. Sheldon*, 4 Ban. & A. 605, 1879, Dist. Vt., Wheeler, J., to consider the question settled that an invention is not patented abroad until there is a full and perfected patent.

Is referred to in *United States Stamping Co. v. King*, 7 F. R. 868, 1879, South. Dist. N. Y., Blatchford, J., as governing the decision in the latter case.

Is cited in *Goodyear Dental Vulcanite Co. v. Davis*, 102 U. S. 224, 1880, Supr. Court, Strong, J., as decid-

ing that the Goodyear patent is for a product made in a definite manner, and not for the product alone, separate from the process by which it is created. Both product and process are necessary elements of the invention, and both must be infringed to constitute an infringement of his patent.

Is cited in *Graham v. McCormick*, 5 Ban. & A. 248, 1880, North. Dist. Ill., Drummond, J. ; s. c. 11 F. R. 862, as deciding that renewed application in 1864 ought to be regarded as one stage in a continuous effort to obtain a patent applied for originally in 1855, and then rejected.

Opinion of Mr. Justice Strong: "Undoubtedly the result or consequences of a process or manufacture may in some cases be regarded as of importance when the inquiry is whether the process or manufacture exhibits invention, thought, or ingenuity." Quoted in *Washburn & Co. v. Haish*, 4 F. R. 907, 1880, North. Dist. Ill., Drummond, J.

The decision in this case is said, in *Kells v. McKenzie*, 9 F. R. 291, 1881, East. Dist. Mich., Brown, J., not to be easily reconcilable with the decision in *Leggett v. Avery*, 101 U. S. 256 ; and the former is preferred to the latter upon the question whether a reissue, including a rejected claim of the original application, is valid.

Is cited in *Coburn v. Schroeder*, 11 F. R. 425, 1882, South. Dist. N. Y., Wheeler, J.

The difference between this case and *King v. Gallun*, 109 U. S. 102, 1883, Supr. Court, Woods, J., is said in the latter case to be that in *Smith v. Goodyear Dental Vulcanite Co.* the invention was the product of a new process applied to old elements ; but in *King v. Gallun* it is an old process applied to old materials.

"If such a substitution involves a new mode of construction, or develops new uses and properties of the

article formed, it may amount to invention." Quoted in *Celluloid Manuf. Co. v. Tower*, 26 F. R. 454, 1885, Dist. Mass., Carpenter, J.

Smith v. Nichols, 21 Wall. 112, 1874, Supr. Court, Swayne, J.

Decides that the mere carrying forward or new or more extended application of the original thought, a change only in form, proportions, or degree, doing substantially the same thing in the same way by substantially the same means with better results, is not such an invention as will sustain a patent. In *Roberts v. Ryer*, 91 U. S. 159, 1875, Supr. Court, Waite, C. J., this rule is quoted and followed.

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 the patentability of an invention is open to the court, and not conclusively decided by the commissioner of patents.

In *Putnam v. Yerrington*, 2 Ban. & A. 240, 1876, Dist. N. J., Nixon, J., *Smith v. Nichols* is approved and quoted from to the point that a mere extending of the original invention to new applications, or substituting equivalent devices for some of its parts, is not invention.

"The mere carrying forward or new or extended application of the original thought, a change only in form, proportions, or degree, a substitution of equivalents, doing the same thing in the same way by substantially the same means with better results, is not such an invention as will sustain a patent." Quoted in *Gottfried v. Phillip Best Brewing Co.*, 5 Ban. & A. 33, 1879, East. Dist. Wis., Dyer, J.

The language of Judge Lowell in the circuit court, that the application of known means in a known way to produce a known result is not invention, and the

language of the Supreme Court on appeal to the same point, are quoted in *Boykin v. Baker*, 9 F. R. 704, 1881, Dist. Md., Morris, J.

Is quoted in *Phillips v. Detroit*, 111 U. S. 607, 1883, Supr. Court, Woods, J., to the same effect.

Is quoted from in *Stephenson v. Brooklyn Crosstown R. R. Co.*, 114 U. S. 154, 1884, Supr. Court, Woods, J., to the same effect.

Is said in *Niles Tool Works v. Betts Machine Co.*, 27 F. R. 304, 1886, Dist. Del., Wales, J., to have held a patent for the manufacture of a textile fabric void because the fabric was superior in degree only, and not differing in kind from fabrics made and known before. The language of Clifford, J., in *Smith v. Nichols*, upon the question of what constitutes a patentable invention, is quoted at some length in the latter case.

Is cited in *New York Belting & Packing Co. v. MaGowan*, 27 F. R. 362, 1886, Dist. N. J., Nixon, J., to the effect that mechanical skill making a modification of an old idea is not patentable unless some new and useful result is secured.

Smith v. Sands, 24 F. R. 470, 1885, West. Dist. Mich., Withey, J.

Is cited in *Bragg v. Stockton*, 27 F. R. 509, 1886, Dist. Cal., Sawyer, J., as rendering it doubtful whether a bill in equity can be sustained when it does not appear that the defendant has ever made and sold any machine embracing the patented invention, or intends to do so, but has only used three or four machines which other parties made for him, there being no evidence of an intention to use any other machines than those which he now has.

Spaulding v. Page, 4 Fisher, 641, 1871, Dist. Cal., Sawyer, 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.

Is cited in *Bragg v. Stockton*, 27 F. R. 509, 1886, Dist. Cal., Sawyer, J., to the effect that the complainant may waive a license fee and adopt as his remedy an injunction against further or continued use of his patent, and thus maintain a suit in equity, but cannot then claim a royalty, for by so doing the person paying the royalty would be entitled to use the machine till it was worn out.

Spill v. Celluloid Manuf. Co., 21 F. R. 631, 1884, South. Dist. N. Y., Blatchford, J.

Is cited in *Goodyear v. Hartford Spring Axle Co.*, 23 F. R. 39, 1885, Dist. Conn., Shipman, J. See *Pennsylvania R. R. Co. v. Locomotive Engine Safety Truck Co.*

On the point of laches, is cited in *Hoe v. Kahler*, 25 F. R. 281, 1885, South. Dist. N. Y., Blatchford, J.

Stanley Works v. Sargent, 8 Blatchf. C. C. 344, 1871, Dist. Conn., Shipman, J.

Is quoted from in *Monce v. Adams*, 1 Ban. & A. 134, 1874, Dist. Conn., Shipman, J., to the effect that utility is not an infallible test of originality; there must also be original inventive skill, but the effect of a change is one test of the character of the change.

“Utility is not an infallible test of originality. The patent law requires a thing to be new as well as useful in order to entitle it to the protection of the statute. To be new in the sense of the act, it must be the product of original thought or inventive skill, and not a mere formal or mechanical change of what was old; though the effect of a change is often a consideration in determining the character of the change itself.” Quoted in *Washburn, &c. Manuf. Co. v. Haish*, 4 F. R. 908, 1880, North. Dist. Ill., Drummond, J.

Star Salt Caster Co. v. Crossman, 3 Ban. & A. 281, 1878, Dist. Mass., Clifford, J.

Is cited in *Hammond v. Hunt*, 4 Ban. & A. 114, 1879, Dist. Mass., Lowell, J., as overruling the case of *Hill v. Whitcomb*, 1 Holmes, 317, so far as that case decides that a bill in equity, in a federal court, between citizens of the same State, brought by an exclusive licensee against a patentee and others jointly trespassing with him knowing of the license, cannot be sustained as a patent suit.

Steam Stone Cutter Co. v. Sheldon, 10 Blatchf. C. C. 1, 1872, Dist. Vt., Wheeler, J.

This case is briefly stated in *Steam Stone Cutter Co. v. Shortsleeves*, 4 Ban. & A. 365, 1879, Dist. Vt., Wheeler, J., as deciding that a grant of "a right to use" patented machines for a specific purpose gives a right to make machines for the use specified, and also the right to procure them made by others, and protects those who so make them.

Stearnes v. Page, 1 Story, C. C. 204, 1886, Dist. Maine, Story, J.

It is said in *Hayes v. Dayton*, 8 F. R. 706, 1880, South. Dist. N. Y., Blatchford, J., that Rule 37 in equity, providing that no demurrer or plea shall be held bad and overruled because the answer of the defendant may extend to some part of the same matter as may be covered by such demurrer or plea, was made on account of the decision in *Stearnes v. Page*, that where a plea states a ground why the defendant should not go into a full defence, and yet the defendant puts in a full defence in his answer, the answer overrules the plea.

Stephenson v. Brooklyn Crosstown R. R. Co., 14 F. R. 457, 1881, East. Dist. N. Y., Benedict, J.

"To authorize a patent, the law requires the invention of a new thing. It is not satisfied by inventing a new

place for an old thing without change of result." Quoted in *Clark Pomace Holder Co. v. Ferguson*, 17 F. R. 82, 1883, North. Dist. N. Y., Coxe, J.

Stephenson v. Brooklyn Crosstown R. R. Co., 114 U. S. 149, 1884, Woods, J.

"A combination is patentable only when the several elements of which it is composed produce by their joint action a new and useful result, or an old result in a cheaper or otherwise more advantageous way." Quoted in *Railway Register Manuf. Co. v. North Hudson C. R. Co.*, 24 F. R. 795, 1885, Dist. N. J., Nixon, J.

Stevens v. Gladding, 17 How. 455, 1854, Supr. Court, Curtis, J.

The decision in this case is followed in the case of *Draper v. Hudson*, 1 Holmes, 208. In *Gordon v. Anthony*, 4 Ban. & A. 259, 1879, South. Dist. N. Y., Blatchford, J., the case of *Stevens v. Gladding* is distinguished from the case of *Draper v. Hudson*, the former being a case where the complainant was entitled to an injunction, and the point considered was whether the complainant could have a decree for an account when he had not prayed for it. In the latter case the bill prayed for an injunction and an account, and the court held that as the right of an injunction had failed, the right of an account as incident to an injunction failed also. *Draper v. Hudson* is said to have been decided upon a mistaken construction of the decision in *Stevens v. Gladding*. See now *Root v. Railway Co.*

The doctrine of Mr. Justice Curtis to the effect that there is much difficulty in holding that a patent right may be seized or sold on execution, is quoted in *Ager v. Murray*, 105 U. S. 130, 1881, Supr. Court, Gray, J.

Stevens v. Pritchard, 4 Cliff. 417, 1876, Dist. Mass., Clifford, J.

The opinion of Mr. Justice Clifford is said, in *Herring v. Nelson*, 3 Ban. & A. 63, 1877, North. Dist. N. Y., Johnson, J., to state the doctrine with great clearness and precision, as to the validity of a reissue. "Reissued patents are presumed to be for the same invention as the original, unless the contrary appears. Matters of fact are not open under such an issue in a suit for infringement. The conclusion in such a case must always be in favor of the validity of the reissued patent, unless it appears upon a comparison of the two instruments that the reissue, as a matter of legal construction, is not for the same invention as the original."

Stimpson v. Woodman, 10 Wall. 117, 1869, Supr. Court, Nelson, J.

Decides that engraving or stamping of the figure upon the surface of a roller for pebbling leather by pressure, where the use previously had been of a smooth roller, was a change involving mere mechanical skill, and not patentable. This case is cited in *Reckendorfer v. Faber*, 92 U. S. 353, 1875, Supr. Court, Hunt, J., to show that the question of patentability is not conclusively decided by the commissioner of patents.

Stimpson v. West Chester R. R. Co., 4 How. 380, 1845, Supr. Court, McLean, J.

Is said in *Battin v. Taggart*, 17 How. 84, 1854, Supr. Court, McLean, J., to have held that where a defective patent has been surrendered and a new one taken out, and the patentee brings an action for a violation of his patent right, laying the infringement at a date subsequent to that of the reissued patent, proof of the use of the thing patented during the interval between the original and renewed patents will not defeat the action.

Is cited in *Thomas v. Shoe Machine Co.*, 3 Ban. & A.

559, 1878, Dist. Mass., Clifford, J., as the turning case in the construction of reissues, the rule now being that the granting a reissued patent closes all inquiry as to inadvertence, accident, or mistake.

Stow v. Chicago, 104 U. S. 547, 1881, Supr. Court, Woods, J.

Is said in *Heald v. Rice*, 104 U. S. 755, 1881, Supr. Court, Matthews, J., to apply the principle that a mere substitution of one material for another in the construction of a machine is not patentable.

Strobridge v. Lindsay, 2 F. R. 692, 1880, West. Dist. Penn., Acheson, J.

Decides the validity of the same reissue which was the subject of an adjudication in *Strobridge v. Landers*, 11 F. R. 885, 1881, Dist. Conn., Blatchford, J.

Strong v. Noble, 3 Fisher, 589, 1869, South. Dist. N. Y., Blatchford, J.

“There is scarcely a patent granted that does not involve the application of an old thing to a new use, and that does not in one sense fail to involve anything more. The merit consists in being the first to make the application, and first to show how it can be made, and first to show that there is utility in making it.” Quoted in *Gottfried v. Phillip Best Brewing Co.*, 5 Ban. & A. 33, 1879, East. Dist. Wis., Dyer, J.

Suffolk Manuf. Co. v. Hayden, 3 Wall. 315, 1865, Supr. Court, Nelson, J.

Is stated in *McMillin v. Rees*, 5 Ban. & A. 274, 1880, West. Dist. Penn., McKennan, J., to have sustained a patent for an invention which was described but not claimed in a previous patent, upon the ground that the invention, although described, was not covered by the first patent; and that this omission to include it did not operate as an abandonment of the improvement to the public.

“In cases where there is no established patent or license fee, or even an approximation to it, general evidence must be necessarily resorted to,” to fix the amount of damages. Quoted in *Root v. Railway Co.*, 105 U. S. 198, 1881, Supr. Court, Matthews, J.

Sullivan v. Redfield, 1 Paine, 441, 1825, Dist. N. Y., Thompson, J.

The opinion of Mr. Justice Thompson as to the nature of the equity jurisdiction conferred upon the federal court in equity in patent cases by the statute of Feb. 5, 1819, c. 19, is quoted from in *Root v. Railway Co.*, 105 U. S. 192, 1881, Supr. Court, Matthews, J. Judge Thompson holds that the statute merely gives citizens of the same State a right to avail themselves in the federal court of the equitable remedy which citizens of different States had in that court before the statute.

Swain Turbine &c. Manuf. Co. v. Ladd, 102 U. S. 408, 1880, Supr. Court, Bradley, J.

The remarks of Mr. Justice Bradley in this case upon the expanded claim sought after by reissues are applied in *McMurry v. Mallory*, 5 F. R. 599, 1880, Dist. Md., Morris, J.

Is said in *Washburn, &c. Manuf. Co. v. Haish*, 7 F. R. 913, 1881, North. Dist. Ill., Drummond, J., to emphasize the principle frequently decided by the court, that a reissue must be for the same invention as was shown in the original patent, but not to lay down any new rule.

Is said in *Meyer v. Maxheimer*, 9 F. R. 100, 1881, South. Dist. N. Y., Wheeler, J., to decide that the statute concerning reissues was never intended to allow a patent to be enlarged except in a clear case of mistake, and that there was no safe or just rule but that which confines a reissue to the same invention which was described or indicated in the original.

The opinion of Mr. Justice Bradley on the evils of expanding claims in reissued patents is quoted in approbation in *Kells v. McKenzie*, 9 F. R. 288, 1881, East. Dist. Mich., Brown, J.

It is said in *Hammond v. Franklin*, 22 F. R. 836, 1885, South. Dist. N. Y., Wheeler, J., that evidence was offered in the former case to show that the invention upon which a patent was afterwards obtained was the same as that described in the reissue, although different from that described in the original patent; but the evidence was rejected.

T.

Tarr v. Folsom, 1 Holmes, 312, 1874, Dist. Mass., Shepley, J.

Is followed in *Wonson v. Peterson*, 3 Ban. & A. 250, 1878, Dist. Mass., Shepley, J.

Teese v. Huntingdon, 23 How. 2, 1859, Supr. Court, Clifford, J.

Is quoted from in *Roemer v. Simon*, 95 U. S. 219, 1877, Supr. Court, Clifford, J., on the question of the notice required to be given by defendant who intends to set up the defence of prior use.

Thomas v. Shoe Machine Co., 16 O. G. 541, 1878, Dist. Mass., Clifford, J.

The rule laid down by Mr. Justice Clifford in this case, to the effect that the decision of the commissioner of patents granting a reissue is final and decisive in a suit for infringement, as to the validity of the reissue, unless it is apparent upon comparison of the original patent and the reissue that they are not for the same invention, is quoted at length in *American Diamond Rock Boring Co. v. Sheldon*, 4 Ban. & A. 555, 1879, Dist. Vt., Wheeler, J.

Thompson v. Boisselier, 114 U. S. 1, 11, 1884, Supr. Court, Blatchford, J.

Is cited and quoted from in *Gardner v. Herz*, 118 U. S. 191, 1885, Supr. Court, Blatchford, J., to the effect that a machine, to be patentable, must contain an invention or discovery.

Is quoted in *Calkins v. Oshkosh Co.*, 27 F. R. 298, 1886, East. Dist. Wis., Dyer, J., to the effect that a device, to be patentable, must not only be new and useful, but it must, under the constitution and statute, amount to an invention or discovery.

Is said in *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.*, 28 F. R. 94, 1886, South. Dist. Ohio, Sage, J., to decide that a machine, in order to be patentable, must not only be new and useful, but it must, under the constitution and the statute, amount to an invention or discovery.

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

Tilghman v. Mitchell, 4 Fisher, 624, 1871, South. Dist. N. Y., Blatchford, J.

The court in this case followed the decision in *Tilghman v. Werk*, a previous case on the same patent, and a case substantially the same in a co-ordinate court. This course of decision was applied and followed in *Goodyear Dental Vulcanite Co. v. Willis*, 1 Ban. & A. 571, 1874, East. Dist. Mich., Emmons, J.

Tilghman v. Proctor, 102 U. S. 707, 1881, Supr. Court, Bradley, J.

It is said that Mr. Justice Bradley, in this case, quotes with approval the language of Grier, J., in *Corning v. Burden*, 15 How. 252, as to the definition of a process in the patent-law. So stated in *MacKay v.*

Jackman, 12 F. R. 618, 1882, South. Dist. N. Y., Wheeler, J.

The decision in this case is applied in *United Nickel Co. v. Pendleton*, 15 F. R. 746, 1883, South. Dist. N. Y., Blatchford, J. In the former case, Bradley, J., distinguished a patent for a process or a product from a patent for a principle, and comments on *Morse v. O'Reilly*, 15 How. 62.

Is referred to in *New Process Fermentation Co. v. Maus*, 20 F. R. 728, 1884, North. Dist. Ind., Drummond, J., as a case where a patent for a process was sustained; and it is quoted to the effect that whoever discovers that a certain useful result will be produced in any art by the use of certain means, is entitled to a patent for it, provided he specifies the means, and that it is very certain that the means need not be a machine or an apparatus; it may be a process. "A machine is a thing; a process is an act or a mode of acting."

And this view is affirmed in *New Process Fermentation Co. v. Maus*, 122 U. S. 427, 1886, Supr. Court, Blatchford, J.

Tremolo Patent, 23 Wall. 518, 1874, Supr. Court, Strong, J.

Is cited in *Reay v. Berlin, &c. Envelope Co.*, 30 F. R. 449, 1887, South. Dist. N. Y., Wheeler, J., to the effect that if the change of statement from an original patent to a reissue is only a more correct statement of the same case, the reissue is valid.

Troy Iron & Nail Factory v. Corning, 14 How. 193, 216, 1852, Supr. Court, Wayne, J.

"A mere license to a party without having 'his assigns,' or equivalent words to them, showing that it was meant to be assignable, is only a grant of a personal power to the licensee, and is not transferable by him to

another." Quoted in *Putnam v. Hollender*, 6 F. R. 892, 1881, South. Dist. N. Y., Blatchford, J.

Is quoted in *Oliver v. Rumford Chemical Works*, 109 U. S. 82, 1883, Supr. Court, Blatchford, J., that if a license does not contain words of assignability, it is but a personal power, and not assignable.

Tucker v. Spaulding, 13 Wall. 453, 1872, Supr. Court, Miller, J.

This case is briefly stated and the decision cited in *Yale Lock Manuf. Co. v. Norwich National Bank*, 6 F. R. 385, 1881, Dist. Conn., Shipman, J., upon the point of double use.

Turrell v. Spaeth, 2 Ban. & A. 185, 1875, Dist. N. J., Nixon, J.

Is cited in *Roberts v. Walley*, 14 F. R. 168, 1882, North. Dist. N. Y., Coxe, J., as stating the proper procedure when the plaintiffs seek to compel the defendants as witnesses to disclose their contracts with their customers in order to prove the infringement by them.

Turrill v. Michigan Southern, &c. R. R. Co., 1 Wall. 491, 1863, Supr. Court, Clifford, J.

Is explained in the *Carwood Patent Cases*, 94 U. S. 697, 705, 1876, Supr. Court, Strong, J., as to the construction of the patent and the explanation of the patented invention.

Tyler v. Tuel, 6 Cranch. 324, 1810, Supr. Court, *per Curiam*.

Is referred to in *Meyer v. Bailey*, 2 Ban. & A. 76, 1875, West. Dist. Penn., McKennan, J., as with *Whittemore v. Cutter*, 1 Gall. 429, settling that only a person who is invested with the entire ownership of a patent or an undivided part of the whole, is to be regarded as an assignee.

U.

Union Paper Bag Machine Co. v. Crane, 1 Holmes, 429, 1874, Dist. Mass., Lowell, J.

This case is considered in *Lockwood v. Cleveland*, 6 F. R. 725, 1881, Dist. N. J., Nixon, J., and it is stated in the latter case that the court in the former case decreed in favor of the defendants, declaring their patent to be good and valid, and against the complainants, declaring their patent to be void, thus administering affirmative relief under § 4918, U. S. R. S., without the necessity of the defendant filing a cross bill for this purpose.

The principle stated in this case, that the decision of the commissioner of patents is not final on the question of priority of invention, even between those who were fully heard in the interference, but that his decision has great weight, is adhered to and approved in *Whipple v. Miner*, 15 F. R. 117, 1883, Dist. Mass., Lowell, J.

The language of Lowell, J., as to § 4918, U. S. R. S., is as follows: "It is not ambiguous, but gives the court of equity a right to decide between interfering patents without any exception or limitation." Quoted in *Hubel v. Tucker*, 24 F. R. 702, 1885, South. Dist. N. Y., Wallace, J.

Union Paper Bag Machine Co. v. Murphy, 97 U. S. 120, 1877, Supr. Court, Clifford, J.

The opinion of Mr. Justice Clifford to the effect that a similarity of two machines in outward form and appearance is not at all material in the question of infringement, but their operation and performance alone are important, is quoted at length in *American Dia-*

mond Rock Boring Co. v. Sheldon, 4 Ban. & A. 557, 1879, Dist. Vt., Wheeler, J.

The opinion of Mr. Justice Clifford, to the effect that in deciding on a question of infringement the court and jury are to regard not the names of devices, but what function they perform, and that devices are different only when they perform different functions, or in a different way, or produce a substantially different result, is quoted in *Cantrell v. Wallick*, 117 U. S. 695, 1885, Supr. Court, Woods, J.

“Nor is it safe to give much heed to the fact that corresponding devices in two machines, organized for accomplishing the same result, are different in shape or form, the one from the other, as it is necessary in every such investigation to look at the mode of operation or the way the device works, and at the result, as well as the means by which the result is obtained.” Quoted in *Shaver v. Skinner Manuf. Co.*, 30 F. R. 71, 1887, North. Dist. Iowa, Shiras, J.

United Nickel Co. v. Anthes, 1 Holmes, 155, 1872, Dist. Mass., Shepley, J.

Is said in *United Nickel Co. v. Keith*, 1 Ban. & A. 44, 1874, Dist. Mass., Shepley, J., to give the history of the art of electro-plating with nickel before the discoveries of Dr. Adams.

The decision in this case as to the question of novelty in the invention in electro-plating is approved in *United Nickel Co. v. Harris*, 3 Ban. & A. 638, 1878, South. Dist. N. Y., Blatchford, J.

United Nickel Co. v. Keith, 1 Holmes, 328, 1874, Dist. Mass., Shepley, J.

The remarks of Shepley, J., in this case as to the state of the electro-plating art are concurred in by Blatchford, J., in *United Nickel Co. v. Harris*, 3 Ban. & A. 639, 1878, South. Dist. N. Y.

United Nickel Co. v. Manhattan Brass Manuf. Co., 16 Blatchf. 68, 1879, South. Dist. N. Y., Blatchford, J.

Is cited and distinguished in *Horman Patent Manuf. Co. v. Brooklyn City Railroad Co.*, 4 Ban. & A. 87, 1879, East. Dist. N. Y., Benedict, J.

United States v. Burns, 12 Wall. 252, 1870, Supr. Court, Field, J.

Is cited in *Brady v. Atlantic Works*, 2 Ban. & A. 441, 1876, Dist. Mass., Clifford, J., as an authority to the point that Government cannot use a patented improvement, any more than any individual, without license by the inventor, or making him compensation, even though an officer of the Government makes the invention.

United States v. Morris, 2 Bond, 33, 1866, South. Dist. Ohio, Leavitt, J.

Leavitt, J., said the statute relating to marking articles with the word "patent," to deceive the public (U. S. R. S. § 4911), did not apply to unpatentable articles. In *Oliphant v. Salem Flouring Mills Co.*, 3 Ban. & A. 259, 1878, Dist. Or., Deady, J., says this was *obiter*, and without argument, and that the opinion is alone, and that he is unable to concur with its reasoning or conclusions.

United States Rifle Co. v. Whitney Arms Co., 14 Blatchf. C. C. 94, 1877, Dist. Conn., Shipman, J.

The facts of this case were briefly stated in *Colgate v. Western Union Telegraph Co.*, 4 Ban. & A. 66, 1878, South. Dist. N. Y., Blatchford, J.

Is referred to in *Woodbury Patent Planing Machine Co. v. Keith*, 4 Ban. & A. 102, 1879, Dist. Mass., Lowell, J., as giving a construction of § 35 of the patent act of Congress of 1870, to the effect that this statute gives the commissioner in all cases jurisdiction of the question of abandonment, and at the same time makes that fact a defence on a trial of the action.

V.

Vance v. Campbell, 1 Black, 429, 1861, Supr. Court, Nelson, J.

Language of Mr. Justice Nelson is quoted: "Unless the combination is maintained, the whole of the invention fails. The combination is an entirety; if one of the elements is given up, the thing claimed disappears." *Turrell v. Spaeth*, 2 Ban. & A. 187, 1875, Dist. N. J., Nixon, J.

Is construed in *Henderson v. Cleveland Co-operative Stove Co.*, 2 Ban. & A. 607, 1877, North. Dist. Ohio, Brown, J., to have decided that if a patentee declares upon a combination of elements which he asserts constitute the novelty of his invention, he cannot abandon part of his combination and maintain his claim to the rest, nor prove any part of his combination immaterial and useless; but when the specification declares on a combination as the thing patented, and says that the use of the improvement requires both elements to be preserved, and then claims the elements separately, the patent covers the elements separately.

Is said in *Herring v. Nelson*, 3 Ban. & A. 66, 1877, North. Dist. N. Y., Johnson, J., not to decide as a judgment any doctrine material to the question of reissues, there being no reissue in the case.

Van Hook v. Pendleton, 1 Blatchf. C. C. 193, 1846, South. Dist. N. Y., Betts, J.

Is said in *Green v. French*, 4 Ban. & A. 171, 1879, Dist. N. J., Nixon, J., to decide that the owner of a patent is not to be charged with acquiescence in an infringement because he withholds suit during the pendency of other suits to determine his rights under a patent.

Vinton v. Hamilton, 104 U. S. 485, 1882, Supr. Court, Woods, J.

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

W.

Walker v. Hawxhurst, 5 Blatchf. C. C. 494, 1867, South. Dist. N. Y., Nelson, J.

The opinion of Mr. Justice Nelson is quoted in *Oliphant v. Salem Flouring Mills Co.*, 3 Ban. & A. 259, 1878, Dist. Or., Deady, J.

Wallace v. Holmes, 9 Blatchf. C. C. 65, 1871, Dist. Conn., Shipman, J.

Is approved as a sound decision, and the decision said, in *Saxe v. Hammond*, 1 Ban. & A. 631, 1875, Dist. Mass., Shepley, J., to be that the actual concert of the makers of the different elements of the combination was a certain inference from the facts, in *Wallace v. Holmes*; and the distinct efforts of the defendants to bring into use these elements of the combination which comprised the whole invention, although they could not be used without adding one other element, were found to be proved.

Is interpreted in *Turrell v. Spaeth*, 2 Ban. & A. 189, 1875, Dist. N. J., Nixon, J., to decide that under a patent for a combination he is an infringer who makes and sells only one or two parts of which the combination is composed, if done with the intent that the purchaser shall unite them with the other parts, procured either from the same or other sources, at the same or different times.

Is construed in *Buerk v. Imhaueser*, 2 Ban. & A. 466, 1876, South. Dist. N. Y., Johnson, J., to decide that a

patent for a combination cannot be evaded by different persons selling each a different part of the combination with the view of their being used together by the purchaser.

Is cited in *Schneider v. Pountney*, 21 F. R. 403, 1884, Dist. N. J., Nixon, J., as being a leading case upon the point that the defendants cannot protect themselves from the consequences of infringement of a patent for a combination by one making and selling one part, and another, another, with the intention of having them used with each other, but that in such a case all are deemed joint infringers, and all are liable for all the damages.

Is cited in *Travers v. Beyer*, 26 F. R. 450, 1886, North. Dist. N. Y., Wallace, J., as establishing a rule that defendants who sell separate parts of the materials of a patented combination, with a knowledge that they are to be used with the other parts of the combination to infringe the patent, are guilty of an infringement. *Wallace v. Holmes* is said in *Travers v. Beyer* to have been followed in *Richardson v. Noyes*, 10 O. G. 501, and in *Bowker v. Dowes*, 15 O. G. 510.

Is said in *Snyder v. Bunnell*, 29 F. R. 48, 1886, South. Dist. N. Y., Coxe, J., to be a clear illustration of the doctrine of contributory infringement, that being a case where the defendants sold a lamp-burner, for which, in combination with a chimney, the plaintiff had a patent, the defendants knowing that the burner was useless without the chimney, and that the purchaser would undoubtedly use a chimney in combination with the burner.

Washburn v. Gould, 3 Story, 122, 1844, Dist. Mass., Story, 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.

Mr. Justice Story says the rule of comity always observed by the justices of the Supreme Court on circuit, in cases which admit of being carried before the whole court, was to conform to the opinions of each other, if any had been given. Quoted in *Goodyear Dental Vulcanite Co. v. Willis*, 1 Ban. & A. 571, 1874, East. Dist. Mich., Emmons, J.

Is cited in *Rumford Chemical Works v. Hecker*, 2 Ban. & A. 360, 1876, Dist. N. J., Nixon, J., as a case where Judge Story followed the rule of comity by ruling to the same effect as Judge McLean in *Brooks v. Bricknell*, 3 McLean, 250, a decision in another circuit on the same point of law, although he, Judge Story, had great difficulty with the point.

Is cited in *Herman v. Herman*, 29 F. R. 93, 1886, South. Dist. N. Y., Brown, J., to the effect that where the patentee has given to a licensee the exclusive right to the use of a patented invention, a suit in equity for damages should be brought in the name of the licensee, but at the charge and expense of the patentee, if he has guaranteed to defend the rights secured by the patent.

Washburn & Moen Manuf. Co. v. Haish, 4 F. R. 900, 1880, North. Dist. Ill., Drummond, 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.

Water Meter Co. v. Desper, 101 U. S. 332, 337, 1879, Supr. Court, Bradley, J.

The opinion of Mr. Justice Bradley is quoted from in *Gage v. Herring*, 107 U. S. 648, 1882, Supr. Court, Gray, J., to the point that a patentee by his claim in a

combination makes all the parts of the combination stated in the claim material.

Webster v. New Brunswick Carpet Co., 5 O. G. 522, 1874, Dist. N. J., Nixon, J.

Is cited in *Welling v. Rubber Coated Harness Co.*, 1 Ban. & A. 288, 1874, Dist. N. J., Nixon, J., to the effect that a patent for a combination is infringed by the use of similar combinations, although one of the elements is omitted and another substituted, unless the substituted device is a new one, or performs a function essentially different, or was not known at the date of the patent to be a proper substitute for the one omitted.

Webster v. New Brunswick Carpet Co., 9 O. G. 203, 1876, Dist. N. J., Nixon, J.

In *Webster Loom Co. v. Higgins*, 4 Ban. & A. 99, 1879, South. Dist. N. Y., Wheeler, J., the authority of the former case, while recognized by the court, was not followed, because the cases were essentially different upon the pleadings and evidence.

Webster Loom Co. v. Higgins, 16 O. G. 675, 1879, South. Dist. N. Y., Wheeler, J.

“The burden of proof rests upon the defendant to show beyond a fair doubt the prior knowledge and use set up.” Quoted in *Washburn, &c. Co. v. Haish*, 4 F. R. 904, 1880, North. Dist. Ill., Drummond, J.

Webster Loom Co. v. Higgins, 105 U. S. 580, 1882, Supr. Court, Bradley, J.

Is said in *Zane v. Soffe*, 110 U. S. 203, 1883, Supr. Court, Bradley, J., to decide that under a general denial of the patentee's priority of invention, evidence of prior knowledge and use, taken without objection, is competent at final hearing on the question of the validity of the patent.

Is cited in *Thayer v. Hart*, 20 F. R. 694, 1884, South. Dist. N. Y., Coxe, J., to the effect that the burden of proof of priority of use or knowledge is upon the defendant.

Is said in *Hancock Inspirator Co. v. Jenks*, 21 F. R. 916, 1884, East. Dist. Mich., Brown, J., to hold that if an improvement of a well-known appendage to a machine is fully described in a specification, it is not necessary to show the ordinary modes, to attach the appendage to the machine.

Is cited in *Phillips v. Carroll*, 23 F. R. 251, 1885, West. Dist. Penn., Acheson, J., as establishing the general rule of the patentability of an invention.

Weston v. White, 13 Blatchf. C. C. 364, 1876, Dist. Conn., Shipman, J.

Is cited in *American Diamond Rock Boring Co. v. Sheldon*, 4 Ban. & A. 604, 1879, Dist. Vt., Wheeler, J., as deciding that the effect of the act of Congress, March 2, 1861, § 16, was to change the term of fourteen years to seventeen, as well in respect to patents limited by prior foreign patents as in respect to others.

Is stated and considered at some length in *De Florez v. Reynolds*, 5 Ban. & A. 151, 1880, South. Dist. N. Y. Blatchford, J.; s. c. 8 F. R. 443, upon the question how long a patent granted in 1867 will run, an English patent for the same invention being previously granted in 1859 for fourteen years. *Weston v. White* says, although not directly involved in the decision of the case, a patent issued in 1867 is under the statute of 1861, § 16, and will run for a term of seventeen years, and under § 6 of the act of 1839 it will begin to run from the date of the foreign patent.

Is said in *Siemens v. Sellers*, 16 F. R. 861, 1883, East. Dist. Penn., Butler, J., to agree with the decision in *De Florez v. Reynolds*, although the point was not

necessary to the decision of the case. See *De Florez v. Reynolds*.

Wetherill v. New Jersey Zinc Co., 1 Ban. & A. 105, 1874, Dist. N. J., McKennan, J. See *Collins v. Peebles*.

Wheeler v. Clipper Mower Co., 10 Blatchf. C. C. 181, 1872, South. Dist. N. Y., Woodruff, J.

“If an invention when constructed according to the model and specifications filed will operate as a practical and useful thing, the inventor has satisfied the law and his patent is valid. He is not bound by law to construct it in order to preserve his patent.” Quoted in *Broadnax v. Central S. Y. &c. Co.*, 5 Ban. & A. 612, 1880, Dist. N. J., Nixon, J.; s. c. 4 F. R. 216.

This case is said, in *Strobridge v. Lindsay*, 6 F. R. 512, 1881, West. Dist. Penn., Acheson, J., to be an authority for the proposition that a patent cannot be evaded by dividing the patented device into two parts which when combined produce the same result in substantially the same way, and selling these parts separately.

The doctrine in this case, that there is no rule which forbids an inventor who has omitted to claim separate new devices, or severable and distinct combinations, in the original patent, making a surrender and taking re-issues for the distinct combination or separate devices, is quoted in *Odell v. Stout*, 22 F. R. 163, 1884, South. Dist. Ohio, Sage, J.

Wheeler v. McCormick, 8 Blatchf. C. C. 267, 1871, South. Dist. N. Y., Woodruff, J.

Is cited and distinguished in *Turrell v. Spaeth*, 2 Ban. & A. 316, 1876, Dist. N. J., Nixon, J. On a motion to compel a plaintiff to elect which of two suits on a patent, in the same district, between the same parties, he will rely upon, the motion was overruled.

Is cited in *Gold & Stock Telegraph Co. v. Pearce*, 19 F. R. 419, 1884, South. Dist. N. Y., Wheeler, J., as an authority for the maintenance of several successive suits for successive infringements in different districts.

Whiteley v. Kirby, 11 Wall. 678, 1868, Supr. Court, Nelson, J.

Is cited in *Kirby v. Dodge, &c. Manuf. Co.*, 10 Blatchf. C. C. 313, 1872, North. Dist. N. Y., Woodruff, J., as not conclusive in the latter case, the facts being different.

Whitely v. Swayne, 4 Fisher, 117, 1865, South. Dist. Ohio, Leavitt, J.

Is said in *Hartshorn v. Eagle Shade Roller Co.*, 18 F. R. 91, 1883, Dist. Mass., Lowell, J., to have held that the oath to an application for a reissue should conform to the exact words of the law, or the reissue is invalid. This ruling is criticised in the latter case and not followed, but was followed by Baxter, J., in *Poage v. McGowan*, 15 F. R. 398, without considering the point again.

The reissue is not valid when granted because the original patent was not fully valid and available. It must be invalid or inoperative. Cited in *Poage v. McGowan*, 15 F. R. 399, 1883, South. Dist. Ohio, Baxter, J.

Whitely v. Swayne, 7 Wall. 685, 1868, Supr. Court, Nelson, J.

“He is the first inventor and entitled to the patent who, being an original discoverer, has first perfected and adapted the invention to actual use.” Quoted in *Albright v. Celluloid Harness Trimming Co.*, 2 Ban. & A. 635, 1877, Dist. N. J., Nixon, J.

The opinion of Nelson, J., is quoted from in *Whittlesey v. Ames*, 5 Ban. & A. 103, 1880, North. Dist. Ill.,

Blodgett, J.; s. c. 13 F. R. 898, upon the point that prior unsuccessful experiments in the same line of research do not deprive a subsequent inventor of his right to a patent.

Whiting v. Graves, 3 Ban. & A. 222, 1878, Dist. Mass., Shepley, J.

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

Whittemore v. Cutter, 1 Gall. 479, 1813, Dist. Mass., Story, J.

Is said in *Boston Manuf. Co. v. Fiske*, 2 Mason, 120, 1820, Dist. Mass., Story, J., to have been decided on authority in *Arcambal v. Wiseman*, 3 Dal. 306.

Is cited and distinguished in *Earle v. Sawyer*, 4 Mason, 12, 1827, Dist. Mass., Story, J.

Is referred to in *Loom Co. v. Higgins*, 105 U. S. 588, 1881, Supr. Court, Bradley, J., as a case deciding that an answer alleging that the patent has an insufficient specification, with an allegation of fraudulent intent in making the specification so insufficient, is a defence to a suit on a patent. Contrary to the decision in *Grant v. Raymond*, 6 Pet. 218, where an allegation of fraudulent intent was not necessary for a defence, but only if the defendant designed to avoid the patent, as was allowed by the law of 1793.

Whittlesey v. Ames, 18 O. G. 357, 1880, North. Dist. Ill., Blodgett, J.

Is said in *Woven Wire Mattress Co. v. Simmons*, 7 F. R. 725, 1881, East. Dist. Wis., Dyer, J., to have sustained the reissued patent for an improvement in bedstead frames.

Wilder v. Gaylor, 1 Blatchf. C. C. 597, 1850, South. Dist. N. Y., Nelson, J.

Is approved and distinguished in *Day v. New Eng-*

land Car Spring Co., 3 Blatchf. C. C. 181, 1854, South. Dist. N. Y., Betts, J., from the latter case.

The decision in this case as to the special pleas is said, in *Hubbell v. De Land*, 14 F. R. 473, 1882, East. Dist. Wis., Dyer, J., to be in conflict with the rule laid down by the Supreme Court in *Evans v. Eaton*, 3 Wheat. 454. *Wilder v. Gaylor* decided that when a defendant pleads the general issue with notice of special matter, and also special pleas setting up the same matter, the pleas should be stricken out.

Wilkins v. Spofford, 3 Ban. & A. 274, 1878, Dist. Mass., Shepley, J.

Explained in *Hapgood v. Hewitt*, 119 U. S. 234, 1886, Supr. Court, Blatchford, J.

Williams, Ex Parte, 3 Ban. & A. 533, 1878, Dist. N. J., Nixon, J.

Is explained in *Wilson Packing Co. v. Hunter*, 4 Ban. & A. 185, 1879, South. Dist. Ill., Drummond, J., as being a case where there was an express provision of the statute declaring that process might be served upon a foreign corporation doing business in the State or Territory where the suit was brought. See also *Schollenberger, Ex Parte*, 96 U. S. 369.

Williams v. Rome, W. & O. R. R. Co., 15 Blatchf. C. C. 200, 1878, North. Dist. N. Y., Blatchford, J.

Is said in *Williams v. B. & A. R. R. Co.*, 4 Ban. & A. 442, 1879, North. Dist. N. Y., Wallace, J., to be a controlling authority upon many of the questions presented in the latter case.

Wilson v. Barnum, 8 How. 258, 261, 1849, Supr. Court, Taney, C. J.

The opinion of Mr. Chief-Justice Taney is quoted from in *California Paving Co. v. Molitor*, 113 U. S. 617, 1884, Supr. Court, Bradley, J., to the effect that the

question of infringement is one of fact, and therefore not such a one as can be certified to the Supreme Court as a question upon which the circuit court is divided.

Wilson v. Rousseau, 4 How. 646, 1846, Supr. Court, Nelson, J.

Is explained in *Day v. Union India Rubber Co.*, 3 Blatchf. C. C. 491, 1856, South. Dist. N. Y., Hall, J., as not deciding that the right of an assignee or grantee of the original term of a patent is limited to the use of machines which such assignee or grantee had in operation when the extended term commenced, but the right includes an extended term.

Cited in *Aiken v. Manchester Print Works*, 2 Cliff. 437, 1865, Dist. N. H., Clifford, J., as establishing the distinction between a grant of a right to make and vend, and the grant of the machine with a right to use it. The latter grant includes the right to repair.

Is said in *Prime v. Brandon Manuf. Co.*, 4 Ban. & A. 384, 1879, Dist. Vt., Wheeler, J., to place a strict construction upon an assignment of a patent right in respect to extension.

In this case the effect of § 18 of the patent act of 1836, as to the rights of assignees of a patent under an extended term, is said to have undergone careful scrutiny in the Supreme Court, and the distinction was there made between persons engaged in the direct use of the machines and speculators in patents and inventions. The former can use the patented machine under an extension; the latter's rights ordinarily end with the original term. So said in *Fire Extinguisher Manuf. Co. v. Graham*, 16 F. R. 551, 1883, West. Dist. Va., Hughes, J.

Wilson v. Sandford, 10 How. 99, 1850, Supr. Court, Taney, C. J.

Is explained in *Pulte v. Derby*, 5 McLean, 336, 1852,

Dist. Ohio, *per Curiam*, as deciding that § 17 of patent act of 1836 does not give a federal court jurisdiction of a bill in equity to set aside an assignment of a patent right on the ground that the assignee has not complied with the terms of the contract.

Is cited and explained in *Goodyear v. Union India Rubber Co.*, 4 Blatchf. C. C. 68, 1857, South. Dist. N. Y., Ingersoll, J., to the effect that where a license had been given under a patent, and is still in existence, the owner of the patent cannot sue in a federal court for infringement.

The opinion of Mr. Chief-Justice Taney is quoted at length in *Consolidated Fruit Jar Co. v. Whitney*, 2 Ban. & A. 32, 1875, Dist. N. J., Nixon, J., to the point that when the controversy in a case does not turn upon letters-patent, but upon the force and effect of some contract under them or in reference to them, in which the question of their validity is not raised, the federal courts have no jurisdiction.

Is carefully considered in *Hartell v. Tilghman*, 99 U. S. 551, 1878, Supr. Court, Miller, J., and said to be the only authoritative construction of the statute of 1870 (except *Littlefield v. Perry*, 21 Wall. 205) on the question whether a court of the United States has jurisdiction of a case arising out of a contract relating to a patent where the case does not arise under an act of Congress, or depend in any way upon this construction of any law in relation to patents. *Wilson v. Sandford* decides this question in the negative, and it is followed in *Hartell v. Tilghman*.

Is examined in the dissenting opinion of Bradley, J. (Waite, C. J., and Swayne, J., concurring), in *Hartell v. Tilghman*, 99 U. S. 558, 1878, Supr. Court; and it is said that if the question was a new one, a case where a complainant seeks damages for infringement, and an injunction against an application to avoid an inequitable

license held by the defendant, might properly be brought in a federal court.

Is referred to in *Albright v. Teas*, 106 U. S. 618, 1882, Supr. Court, Woods, J., as deciding against the jurisdiction of a case relating to a patent, the case not involving the construction of any law as relating to patents or arising under any law of Congress, and not being between citizens of different States, but being a bill to set aside a contract.

Is said in *Teas v. Albright*, 13 F. R. 413, 1882, Dist. N. J., Nixon, J., to have settled the question as to the jurisdiction of the federal court in suits brought to avoid a license, where neither the citizenship of the parties nor the amount involved in the litigation gave the court jurisdiction. The court refused to entertain jurisdiction of such suits on the ground that the suit arose out of the contract or license, and not under any law of the United States granting or confirming to inventors exclusive right in their inventions or discoveries.

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

Wilson v. Sherman, 1 Blatchf. C. C. 536, 1850, North. Dist. N. Y., Nelson, J.

Is explained in *Goodyear v. Union India Rubber Co.*, 4 Blatchf. C. C. 66, 1857, South. Dist. N. Y., Ingersoll, J., as being a case where the jurisdiction of a federal court in equity in a patent suit was sustained, a license having been granted, but forfeited for noncompliance with its conditions.

Wilson v. Simpson, 9 How. 109, 1849, Supr. Court, Wayne, J.

Is explained in *Day v. Union India Rubber Co.*, 3 Blatchf. C. C. 491, 1856, South. Dist. N. Y., Hall, J., as not deciding that the right of an assignee or grantee

of the original term of a patent does not extend beyond the use of machines which such assignee or grantee had in operation when the extended term commences, though containing expressions favoring that view.

Is said in *Aiken v. Manchester Print Works*, 2 Cliff. 439, 1865, Dist. N. H., Clifford, J., to affirm the same rule as to repairing parts of a patented machine by the purchaser as decided in the latter case; that is, he may repair the machine or improve upon it.

Wilson v. Stolley, 4 McLean, 275, 1847, Dist. Ohio, McLean, J.

Said in *Wortendyke v. White*, 2 Ban. & A. 28, 1875, Dist. N. J., Nixon, J., to decide that when a person licensed to run a patented machine sold it to another, the license to run the machine did not necessarily pass to the grantee.

Wilson v. Stolley, 5 McLean, 1, 1849, Dist. Ohio, *per Curiam*.

Is affirmed in *Pulie v. Derby*, 5 McLean, 336, 1852, Dist. Ohio, *per Curiam*, upon the point that where a patent suit is founded upon a contract of license, the circuit court has no jurisdiction.

Wilson v. Turner, 7 Law Rep. 527, 1845, Dist. Md., Taney, C. J.

The opinion of Mr. Chief-Justice Taney is adopted in *Day v. Union India Rubber Co.*, 3 Blatchf. C. C. 491, 1856, South. Dist. N. Y., Hall, J., to the effect that the assignee or grantee of a patent right for the original term takes the same right during the extended term.

Wilton v. The Railroads, 1 Wall. Jr., 195, 1847, East. Dist. Penn., Grier, J.

Is said in *Planing Machine Co. v. Keith*, 101 U. S. 493, 1879, Supr. Court, Strong, J., to settle the ques-

tion that only the names of those who invented or used an anticipating machine, and not the names of the witnesses to prove prior use, need be notified under the act of Congress.

Winans v. Denmead, 15 How. 344, 1853, Supr. Court, Curtis, J.

Is quoted in *Eddy v. Dennis*, 95 U. S. 569, 1877, Supr. Court, Hunt, J., to the point that although a particular geometric form of machine is best, yet, if other forms give substantially the same results, they are infringements.

“ It is generally true that when a patentee describes a machine and then claims it as described, he is understood to intend to claim, and does by law actually cover, not only the precise forms he has described, but all other forms which embody his invention; it being a familiar rule that to copy a principle or mode of operation described is an infringement, although such copy should be totally unlike the original in form or proportions.” Quoted in *Grier v. Castle*, 17 F. R. 524, 1883, West. Dist. Penn., McKennan, J.

The language of the court in this case, to the effect that a patent for a machine covers all forms of machines which embody the invention, although such words as “ however its form or proportions may be varied ” are not used in the claim of the patent, is quoted in *La Rue v. Western &c. Co.*, 28 F. R. 90, 1886, South. Dist. N. Y., Brown, J.

Wollensak v. Reiher, 115 U. S. 96, 1885, Supr. Court, Matthews, J.

Is cited in *Gage v. Kellogg*, 23 F. R. 894, 1885, North. Dist. N. Y., Coxe, J., as affirming the doctrine that a reissue which claims a different invention from the original patent is void.

Is quoted from at length in *Ives v. Sargent*, 119 U. S. 661, 1886, Supr. Court, Matthews, J., to the effect that if a patentee understands what he has invented, he will know, on inspection of his patent when first issued, whether it covers his invention, and therefore any delay to have a mistake corrected after that is *laches*.

The language of the court in this case is quoted in *Arnheim v. Finster*, 26 F. R. 280, 1886, South. Dist. N. Y., Coxe, J., to the effect that a patent, when issued, immediately notifies the inventor, if he is conscious of the nature and extent of his invention, whether or not the patent covers the area of his invention.

Governed the decision in *Hoe v. Knap*, 27 F. R. 212, 1886, North. Dist. Ill., Blodgett, J.

Wood, *Ex Parte*, 9 Wheat. 609, 1824, Supr. Court, Strong, J.

“As patents are not enrolled in the records of any court, but among the rolls of the department of State, it was necessary to give some direction as to the character, time, and manner of instituting proceedings to repeal them.” Quoted in *Attorney-General v. Rumford Chemical Works*, 2 Ban. & A. 311, 1876, Dist. R. I., Shepley, J.

Wood v. Cleveland Rolling Mill Co., 4 Fisher, 550, 560, 1871, North. Dist. Ohio, Swayne, J.

Language of Swayne, J., to the effect that the defence of prior use or previous knowledge must be established by evidence beyond a reasonable doubt, is quoted in *Hawes v. Antisdell*, 2 Ban. & A. 11, 1875, East. Dist. Mich., Longyear, J.

Remarks of Swayne, J., as to the credibility of witnesses testifying to a want of novelty in an invention, quoted in *Hawes v. Antisdell*, 2 Ban. & A. 22, 1875, East. Dist. Mich., Longyear, J.

Is cited in *Thayer v. Hart*, 20 F. R. 694, 1884, South. Dist. N. Y., Coxe, J., to the effect that the defence of prior use should be made out beyond a reasonable doubt on the evidence. See *Collins v. Peebles*.

Wood Paper Patent, 23 Wall. 566, 1874, Supr. Court, Strong, J.

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.

Is said in *Badische Anilin, &c. Fabrik v. Cochrane*, 4 Ban. & A. 220, 1879, South. Dist. N. Y., Wheeler, J., to decide that the non-patentability of the invention in this case was decided because the paper pulp sought to be covered by the patent was not *made* by the process, but extracted by it merely, and was cellulose before and after the treatment, — an extract, and not a compound.

Woodruff v. Barney, 1 Bond, 528, 1862, South. Dist. Ohio, Leavitt, 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.

Woodworth v. Sherman, 3 Story, 178, 1844, Dist. Mass., Story, J.

The language of Story, J., in this case, is quoted in *Johnson v. Wilcox & Gibbs Sewing Machine Co.*, 27 F. R. 690, 1886, South. Dist. N. Y., Wallace, J., to the effect that the language of an assignment cannot be extended beyond its ordinary import.

Woodworth v. Stone, 3 Story, 749, 1845, Dist. Mass., Story, J.

Is cited in *Wheeler v. McCormick*, 8 Blatchf. C. C.

274, 1871, South. Dist. N. Y., Woodruff, J., as deciding that a bill in equity will lie upon well-grounded proof of a defendant's intention to violate a patent right, although no infringement has as yet taken place.

Woodworth v. Weed, 1 Blatchf. C. C. 165, 1846, North. Dist. N. Y., Nelson, 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. 66, 1857, South. Dist. N. Y., Ingersoll, J., as sustaining the jurisdiction of the federal court in a suit in equity on a patent where a license had been given and forfeited for non-payment of the license fee.

Is stated briefly in *Abbett v. Zusi*, 5 Ban. & A. 40, 1879, Dist. N. J., Nixon, J., as a case where the license containing a stipulation that if any note given by the licensee in payment of his license fee should become due and unpaid the license should be void, Judge Nelson held that the owner of the patent might apply for an injunction against the licensee the moment that one of said notes became due and unpaid.

Woodworth v. Wilson, 4 How. 712, 1846, Supr. Court, Nelson, J.

Is cited in *Jenkins v. Greenwald*, 1 Bond, 132, 1857, South. Dist. Ohio, *per Curiam*, to the effect that an affidavit of a defendant that he has ceased to use the infringing machine upon service of the injunction, is not sufficient ground for dissolving an injunction and dismissing a bill.

Wooster v. Handy, 21 F. R. 51, 1884, South. Dist. N. Y., Blatchford, J.

The remarks of Blatchford, J., in this case as to the Supreme Court's decisions in 104 U. S. (*Miller v. Brass*

Co. and James v. Campbell) are quoted in *Odell v. Stout*, 22 F. R. 164, 1884, South. Dist. Ohio, Sage, J., to the effect that the rule laid down in those decisions has been repeatedly applied in later cases.

Wyeth v. Stone, 1 Story, 273, 292, 1840, Dist. Mass., Story, J.

Is said in *Emerson v. Hogg*, 2 Blatchf. C. C. 8, 1845, South. Dist. N. Y., Betts, J., to decide that a valid patent may be had for several machines, each being a separate and independent invention, where they all have a common purpose and are auxiliary to each other and to the same common end.

Is said in *Hogg v. Emerson*, 11 How. 606, 1850, Supr. Court, Woodbury, J., to have decided that in order to render different letters-patent necessary for different inventions, the inventions must be wholly independent of each other, and distinct inventions for unconnected objects, as one to spin cotton and another to make paper.

Is cited in *Sessions v. Romadka*, 21 F. R. 132, 1884, East. Dist. Wis., Dyer, J., to the point that a single patent cannot be taken for two distinct machines, designed for totally different and independent objects.

Y.

Yale Lock Co. v. Sargent, 117 U. S. 536, 553, 554, 1885, Supr. Court, Blatchford, J.

Is said in *Kittle v. Hull*, 30 F. R. 240, 1887. South. Dist. N. Y., Coxe, J., to decide that a patentee who has retained during the term of the reissue an invalid claim, may recover upon the valid claims, though no disclaimer has been filed or is possible when he brings suit.

Yale Lock Co. v. Scovill Manuf. Co., 18 Blatchf. C. C. 248, 1880, Dist. Conn., Shipman, J.

Is distinguished, in *Siebert Cylinder, &c. Co. v. Harper Lubricator Co.*, 4 F. R. 333, 1880, Dist. Conn., Shipman, J., from the latter case, on the ground that in the former the invention described in the reissue was manifestly the same which formed the subject of the original specification, but was there cramped within too narrow bounds; in the latter case the invention which was described in the two latter claims of the reissue was not the same which was the subject of the original specification, and those claims were therefore void.

The opinion in this case is quoted from in *Parker & Whipple Co. v. Yale Lock Manuf. Co.*, 18 F. R. 47, 1883, Dist. Conn., Shipman, J., to the effect that if a patentee has made a palpable mistake and has limited his real invention by a misstatement of principles so as to lose the fruits of his labor, he should be permitted to enlarge his statements in the specification of the reissue so as to cover the invention which was plainly the subject of the original application, although there limited to a narrow patent by the misstatement.

Z.

Zinn v. Weiss, 7 F. R. 914, 1881, East. Dist. N. Y., Benedict, J.

Is cited and explained in *La Rue v. Western, &c. Co.*, 28 F. R. 90, 1886, South. Dist. N. Y., Brown, J.

INDEX.

A.

ABANDONMENT, what is, 40.

may be presumed from unexplained delay, 3, 105, 107, 126, 181, 182, 193, 198.

in applying for patent, 105.

but not from delay during experiments, 105.

when presumed from delay between rejected and renewed application, 107, 126.

or from acts after rejected application, 159.

application on file rebuts such presumption, when, 3, 19.

renewed application affects it how, 70, 75, 76.

by express dedication, 107.

by public use for two years, 157.

by negligence, 198.

not by solicitor's negligence, when, 16.

of part of machine by claiming only another part, 44.

how far decided conclusively by commissioner, 214.

See **NEGLIGENCE; APPLICATION; PATENT.**

"ABOVE DESCRIBED METHOD," these words in claim annex the specification, 18.

See **PATENT, CONSTRUCTION OF.**

ACCOUNT, as basis of equity jurisdiction in federal courts, when sufficient, 50, 54, 55, 89, 100, 101, 116, 117, 143, 149.

See **JURISDICTION; FEDERAL COURTS.**

ACCOUNTING, master's fees for, to be paid by defendant, 21.

ACQUIESCENCE, in infringement, when delay is not, 215.

ACT OF CONGRESS, relating to patents, is only basis of federal courts' jurisdiction, 18, 22, 23, 72, 73, 74, 85, 86, 93, 113, 114, 127.

See **FEDERAL COURTS; JURISDICTION.**

ACT OF CONGRESS — *continued.*

 specially granting patents, how construed, 56.

 effect of, on assignments, 65.

 extending patents, 3.

 See CONGRESS.

ACTION AT LAW, against vendees of infringer, when enjoined, 16.

 See INJUNCTION.

 pleading special matter in, 79.

 See PLEADING; PRACTICE.

 plaintiff in, who may be, 143.

 measure of damages, what, 14, 15.

 royalty, when proper measure, 15.

 See DAMAGES.

ADMINISTRATOR, succeeds to licensee's rights, when, 146.

 See LICENSE.

AFFIDAVIT, to application, informality of, does not affect patent, 94.

 is conclusively settled, by issuing patent, 192.

AGENT, when not liable for infringement, 47.

AGGREGATION OF OLD ELEMENTS, not patentable, 16, 81, 82, 83.

 See COMBINATION; PATENTABILITY.

ALBERTSON PATENT, No. 2,386, construed, 122.

AMBIGUOUS LANGUAGE IN REISSUE, construed strictly, 31.

 See REISSUE; PATENT, CONSTRUCTION OF.

AMENDMENT OF APPLICATION FOR PATENT, 167, 168.

 See PATENT, APPLICATION.

ANNULLING PATENT, suit to, 8.

 must be by Government, 139, 140.

 See GOVERNMENT.

ANSWER, does not overrule plea, 203.

ANTICIPATION OF PATENT, by prior machine, must be the same invention, 151.

 and an operative machine, 152.

 and complete, as to invention, 36, 37, 62, 63, 94, 99, 169, 190.

 and must produce same result, 170.

 by prior printed publication, what is, 34, 38, 49.

ANTICIPATION OF PATENT—*continued.*

- by foreign publication, 191, 192.
- by abnormal use of another's machine, when, 34.
- effect of, 73.
- must be set up in answer, 171.
- or evidence of is inadmissible on objection, 173.
- burden of proof is on defendant, 37, 88.
- must be proved beyond reasonable doubt, 37, 155.

See **PRIOR KNOWLEDGE AND USE.**

APPLICATION FOR PATENT, if delayed by experiments,
not abandoned, 105.

- amendment of, 167, 168.
- rejected, evidence of abandonment, when, 3, 40, 159, 199.
- are abandoned experiments, 43.
- renewed after rejection, effect on abandonment, 43, 70, 75, 76.
- several successive, when considered one, 13, 14, 19.
- affidavit to, effect of informality in, 94.

See **ABANDONMENT; PATENT, APPLICATION FOR**

ART, may be patented as a process, 36.**ASSIGNEE OF PATENT**, who is, 160, 211.

- when may sue for infringement in his own name, 62, 63, 64, 101, 160.
- of record, patent may issue to, 186.
- has right to use machine during extension, when, 19, 20.
- succeeds to license rights, when, 146.
- in insolvency, has not legal title, 7.
- may compel patentee to assign, 7.
- has licensee's rights, when, 146.

See **PRACTICE; TERM; EXTENSION; ASSIGNMENT.**

ASSIGNMENT OF PATENT, what is, 7, 114.

- must be in writing signed by owner of patent, 7.
- does not carry right to sue for past infringement, 48, 136, 137.
- what language in, conveys extension, 31, 35, 63, 89, 145, 155, 167, 225, 228.
- effect of, during extension, 225, 228.
- gives right to sue in assignee's name, when, 62, 63, 64.

See **EXTENSION.**

- includes renewal, when, 117.
- language naturally construed, 231.

ASSIGNMENT OF PATENT — *continued.*

differs from license, 64.

of personal right to sell, 84.

of such right to corporation ends with corporation, 84.

record of before issuing patent vests legal title in assignee,
62, 64, 65, 158.

effect of, after issuing patent, 64.

non-record of, effect on later assignment, 21.

unrecorded, in suit against third person, 21, 158

not void, though unrecorded, 21.

of patent granted by special act of Congress, 65.

ATTORNEY-GENERAL, suit in name of, 8, 14.

B.

BALL REISSUE, invalid, 9.

BELL, first invented speaking-telephone, 4.

patent is for a process, 4.

not anticipated by Reis, 4.

BILL IN EQUITY, by creditor to take patent-right for debt,
3, 204.

for account only, no jurisdiction of, 174, 175, 176, 182, 197.

but for account and answer, treated as bill for discovery,
135.

See **JURISDICTION; FEDERAL COURTS.**

may contain several patents, when, 69, 96, 142, 143, 145,
146, 191.

or several infringements of one patent, 70.

not dismissed on affidavit that defendant has ceased to use
infringing machine, 232.

will lie if intention to infringe is proved, 232.

dismissed if showing void patent, 33, 51.

dismissed by Supreme Court of its own motion, 196.

may be dismissed on exception to master's report, 59.

plaintiff, who may be, 143.

by licensee, when exclusive, 218.

to review commissioner's decision, additional evidence ad-
missible, 7.

is not an appeal from the office, 28, 29.

See **EQUITY; PRACTICE; COMMISSIONER.**

BOND FOR PAYMENT OF DAMAGES, not without sureties, 177.

BURDEN OF PROOF, of prior use, is on defendant, 38, 88.
not met, if his evidence is conflicting and unsatisfactory, 45.
See **ANTICIPATION; PRIOR KNOWLEDGE AND USE**.

C.

CAWOOD PATENT, explained, 211.

CITY, liable for use of patented machine, 19.
See **INFRINGEMENT**.

CLAIM OF PATENT, limits the invention, 26, 27, 47, 170.
governs the construction of patent, 107, 108, 170.
is illustrated by specifications, drawings, and models, 18,
22, 27, 47, 107.
how interpreted, 18.
liberally construed, 109.
to protect the invention shown, 54.
estops patentee to claim more, 121.
waiver of, is estoppel, 29.
rejected cannot be reissued, 194, 199.
is not inadvertence, so as to entitle a reissue, 6.
if one in reissue void, others may be good, 60.
same as in original patent, good, 60, 78.

See **REISSUE; PATENT, CONSTRUCTION OF**.
for product, must be interpreted with process, 121.
See **PROCESS; PRODUCT**.

COMBINATION OF OLD ELEMENTS, when patentable,
3, 12, 58, 81, 82, 83, 117, 122, 138, 156, 157, 169, 184,
204, 215.

additions to, when patentable, 10.

change of location of part, when patentable, 3, 122, 160,
203, 204.

of parts of machine, 58.

See **PATENTABILITY**.

patent for, covers equivalents, 39, 45, 68, 74, 77, 78, 190,
191.

what is infringement of, 77, 164, 165, 215, 218, 219.

See **INFRINGEMENT**.

COMBINATION OF OLD ELEMENTS — *continued.*

all parts of, are material, 57, 218, 219.

cannot be reissued for smaller number, 42, 67, 68, 69, 91.

subcombinations may be claimed in reissue, 42, 164.

See **REISSUE**.

COMMISSIONER OF PATENTS may decide whether different inventions may be put in one patent, 13.

had authority to grant reissue before any act of Congress, 193.

may issue valid patent to replace void one, 79.

his mistake allows expansion of claim in reissue, 177, 178.

decision of, granting reissue, how far conclusive, 65, 66, 92, 106, 107, 118, 142, 188.

See **REISSUE**.

decision of, how far conclusive as to validity of interfering patents, 212.

as to validity of extension, 177.

as to combining inventions in one patent, 13.

as to abandonment, 214.

decision of, reviewed by bill in equity, 7.

See **BILL IN EQUITY; EQUITY; DIFFERENT INVENTIONS**.

COMPENSATORY DAMAGES, when allowed, 122.

See **DAMAGES**.

CONGRESS, act of, not necessary to reissues, 193.

special, extending patent, 3.

special, granting patents, construction of, 56.

violation of obligation of contracts by, 56.

authority of, to grant patent after public use, 18, 19.

See **ACT OF CONGRESS; FEDERAL COURTS; JURISDICTION**.

CONSENT OF INVENTOR to use before patent, effect of, 123, 124.

See **PUBLIC USE; PATENT**.

CONSTRUCTION OF PATENT, and reissue to decide identity of invention, 11, 17.

See **REISSUE**.

of primary patent, liberal, 125.

See **PATENT**.

of patent, limited by claim.

See **CLAIM; PATENT, CONSTRUCTION OF**.

CONTRACT, violation of, by act of Congress, 56.

See **CONGRESS, ACT OF**.

CONTRACT — *continued.*

of license, affects jurisdiction, 18, 22, 23, 72, 73, 74, 85, 86, 93, 113, 114, 127.

See **FEDERAL COURTS; JURISDICTION; LICENSE.**

CORPORATION, must be sued in State of incorporation, 46, 159, 166, 186, 224.

See **PRACTICE.**

COSTS, how affected by disclaimer, 60, 61.

See **DISCLAIMER.**

plaintiff's, do not include model of defendant's machine, 100, 231.

defendant's, include models of plaintiff's machine, 87.

See **MASTER'S FEES; PRACTICE.**

COUNSEL FEES, when allowed as damages, 152.

COUNTY, liable for infringement, 102, 123.

COURT, how far it may review decision of commissioner as to reissue, 107, 118.

See **COMMISSIONER; REISSUE.**

may inspect patent and reissue, as to identity of invention, 11, 17.

CREDITOR'S BILL, to seize patent-right for debt, 3.

D.

DAMAGES, measure of, no rule covers all cases, 15.

how estimated, 14.

plaintiff must prove, 17, 18, 53, 91, 105, 144, 156, 188.

or he gets only nominal, 17, 18, 105, 144, 156, 188.

not presumed in his favor, 18.

license fee, when measure of, 15, 18, 25, 115, 148, 149, 182, 187, 188.

if none, actual damages, 25, 207.

royalty the measure of, at law, 14, 15, 36, 148, 149.

may waive license fee by asking injunction, 202.

how qualified, 15.

actual damages, when, 15, 187.

what is evidence of license fee, 18.

profits, measure of, in equity, 14, 15, 25, 26, 115, 116, 149, 188.

profits, what are, 32.

DAMAGES — *continued.*

profits and damages both, by statute, 15, 30, 152.

profits must be proved by evidence, 53.

are actual profits, 46, 116, 178.

not what infringer might have made by due diligence, 46.

if patent only on part of machine, profits restricted to that part, 78, 138, 139, 140, 141, 156, 183.

unless that device gives the whole machine its only market value, 48, 183.

plaintiff must separate profits of his device from the rest of the machine, 61, 62, 91.

or show the whole machine gets its value from his device, 62.

if there are no profits, there is no account, 52.

but now, by statute, actual damages may then be given, 52, 53.

interest on, not generally allowed, 114, 139, 140, 141, 152, 195.

only under special circumstances, 114, 139, 140, 141.

as profits are unliquidated damages, 142.

do not include counsel fees, 152.

may include compensation for party's time, 152.

may include rebate for salaries of managing officers, 177.

how affected by laches, 144.

compensation allowed if profits lost by defendant's negligence, 122.

right to past, not carried by assignment, 136, 137.

See ASSIGNMENT.

payment of, no title to machine, 17.

but payment of damages and profits both, gives right to use machine, 155.

DECREE, final, what is, 10, 12, 196.

for injunction and account is not, 10.

in another circuit on same part, effect of, 3, 75, 76.

See JUDGMENT.

DEDICATION TO PUBLIC, as to, 104, 193.

is abandonment, 107.

See ABANDONMENT.

by not claiming process in reissue, 104, 120.

See REISSUE.

DEFENCES, inconsistent, what are, 16.

See PLEADING; PRACTICE.

- DELAY**, if negligent, forfeits right to patent, 3, 181, 182.
 if explained, does not, 3.
 in securing reissue, effect of on original patent, 128.
 when is not acquiescence in infringement, 215, 216.
 See **ABANDONMENT**; **INFRINGEMENT**.
- DEMURRER**, not overruled by answer, 203.
- DESIGN PATENT**, 145.
 what is infringement, 76, 77.
- DIFFERENT INVENTIONS**, when may be combined in the
 same patent, 10, 13, 55, 56, 94, 123, 136.
 commissioner's decision, how far conclusive, 13.
 patents, when may be joined in one bill in equity, 69, 96,
 142, 143, 145, 146, 191.
 See **BILL IN EQUITY**; **COMMISSIONER**; **PATENT**.
- DIRECTOR OF COMPANY**, ordering infringement, when
 personally liable, 112.
 See **INFRINGEMENT**.
- DISCLAIMER**, validity of, 75.
 when necessary, 83.
 how far estoppel, 110.
 affected by provisos in patent, 182.
 when may be filed, 60, 61.
 negligence in filing must be set up in answer, 26.
 effect of, on costs, 60, 61.
 See **ESTOPPEL**; **CLAIM**; **COSTS**.
- DIVISIBILITY OF LICENSE**, depends on its terms, 22.
 See **LICENSE**.
- DOUBLE USE**, not patentable, 12, 24, 34, 99, 153, 154, 172.
 See **PRIOR USE**; **ANTICIPATION**.
- DRAWINGS**, may be filed with specification, when, 21, 217,
 218.
 limit claim, 22, 26, 27.
 See **SPECIFICATION**; **CLAIM**.

E.

- ELECTRO PLATING**, state of the art in, 213.
- ELEMENT**, application of, to use, not patentable, 146.
 See **PATENTABILITY**.

EMPLOYEE, forfeits right to patent, when, 124.

presumed license by, to employer, when, 125.

See LICENSE.

liable for infringement, when, 47.

See INFRINGEMENT.

EQUITY IN PATENT SUITS is the same as in any other,
50, 54, 55.

may declare two interfering patents void, 71, 72.

will seize patent right on execution, 3, 204.

will enjoin suit at law, when, 16.

or compel assignment to assignee in insolvency, 7.

has no jurisdiction of bill for account alone, 174, 175, 176,
182, 197.

nor if no injunction is asked, 143, 149.

because patent has expired, 40.

and does not hold infringer trustee, so as to support juris-
diction, 15, 25, 44.

has jurisdiction though patent expires soon after bill filed,
34.

See FEDERAL COURTS; JURISDICTION; ACCOUNT.

but may not grant injunction, 4.

See INJUNCTION.

has no jurisdiction if license exists, 18, 28, 72, 73, 74, 85,
86, 93, 113, 114, 127.

but has if license is forfeited, 22, 23, 85, 86.

See FEDERAL COURTS; JURISDICTION; LICENSE.

has jurisdiction to enjoin violation of contract, 196.

may grant injunction, without trial at law, 72, 73, 195.

may order infringing machine destroyed, 17.

when grants preliminary injunction, 151.

See INJUNCTION.

bill in, on two patents, is good, 69.

See BILL IN EQUITY.

special plea in, when, 192.

See PLEADING.

decree in, for injunction and account, not final, 10, 12.

See DECREE.

measure of damages in, 14.

royalty when, 14, 15.

gains and profits when, 14, 15, 25, 26, 115, 116, 149, 188.

license fee, when, 15.

EQUITY IN PATENT SUITS — *continued.*

profits and damages both, when, 15, 30, 152.

See **DAMAGES.**

EQUIVALENTS, what are, 31, 40, 59, 68.

are covered by patent, 157.

See **PATENT.**

apply to combination, 39, 45, 68, 69, 190, 191.

when not to process patents, 45.

See **COMBINATION; PROCESS; REISSUE.**

ESTOPPEL, how far disclaimer may be, 110.

See **DISCLAIMER.**

by waiver of claim in record, 29.

by description in claim, 43, 108, 121.

See **CLAIM.**

by delay, from claiming reissue, 103.

after adverse rights have accrued, 104.

See **REISSUE; ABANDONMENT; DELAY.**

by silence, 39.

by enforcing contract of license, 16.

by sale of patent right, 57.

by sale of machine, 77.

carries after acquired title, 57.

prevents prosecution for infringement, 77.

See **WARRANTY; TITLE.**

by previous judgment, 181.

See **DECREE; JUDGMENT.**

EVIDENCE, of prior knowledge and use, 36, 63.

of prior use, burden is on defendant, 37, 88.

if his is conflicting, is insufficient, 45, 100.

should be strictly scrutinized, 100.

See **PRIOR KNOWLEDGE AND USE.**

of damages, plaintiff must give, 17, 18.

by proving license fee, when, 18.

See **DAMAGES.**

of abandonment, solicitor's neglect, when is not, 16.

See **ABANDONMENT; DELAY; NEGLIGENCE.**

extrinsic, when used to explain patent, 11, 17.

See **PATENT, CONSTRUCTION OF.**

additional, in review of commissioner's decision, 7.

See **COMMISSIONER.**

new, opening cause for, after decree, 24, 25.

See **PRACTICE.**

EXECUTOR, succeeds to license of deceased, when, 146.

See **LICENSE**.

EXECUTION, levied on patent right, 3, 204.

See **BILL IN EQUITY; EQUITY**.

EXPERIMENTS, may delay application for patent, 105.

incomplete, cannot anticipate complete invention, 73, 152.

See **ANTICIPATION; APPLICATION FOR PATENT; PATENT**.

EXPIRATION OF PATENT, how it affects jurisdiction in equity, 34, 143, 149.

See **EQUITY; JURISDICTION; FEDERAL COURTS**.

how it affects right to injunction, 4.

See **INJUNCTION; EQUITY**.

how affected by foreign patent, 9, 54, 60, 71, 90, 96, 147, 148, 170, 197, 220.

See **FOREIGN PATENT; TERM OF PATENT**.

EXTENSION OF PATENT, when passes under assignment,

31, 35, 63, 89, 145, 155, 167, 225, 228.

may be issued to assignee, 89.

inchoate right to, is salable, 35.

rights of assignee under, 19, 20.

by special act of Congress, 3.

See **ASSIGNMENT; PATENT**.

F.

FACTORY, use in, is public use, 123.

See **PUBLIC USE**.

workman in, when forfeits right to patent, 124.

See **LICENSE**.

FEDERAL COURTS, have jurisdiction in patent cases only by

act of Congress, 115.

nature of jurisdiction, 207.

in equity, governed by rules of equity, 50.

See **EQUITY**.

have no jurisdiction in equity after patent expires, 34, 50, 54, 55, 89, 100, 101, 105, 143, 149, 174, 175, 176.

have no jurisdiction of suit based on license, 18, 22, 23, 28, 72, 73, 74, 85, 86, 93, 113, 114, 127, 204, 225, 226, 227.

but have if license is forfeited, 22, 23, 72, 73, 74, 85, 86, 93, 113, 114, 127, 232.

See **EQUITY; JURISDICTION; EXPIRATION OF PATENT**.

FEDERAL COURTS — *continued.*

not affected by State statute of limitations, 38, 39, 88, 150, 151, 168, 171, 185, 186.

See **LIMITATIONS, STATUTE OF.**

suit in, against State court receiver, when, 10.

FINAL DECREE, one for injunction and account is not, 10, 196.

See **DECREE.**

FIRE DEPARTMENT, is agent of city and not accountable for infringement, 4.

See **INFRINGEMENT; DAMAGES.**

FOREIGN COUNTRY, use of invention in, when a defence, 106.

See **PRIOR USE.**

FOREIGN PATENT, how it affects term of United States patent, 9, 54, 60, 71, 90, 96, 147, 148, 170, 197, 220.

See **EXPIRATION OF PATENT; PATENT; TERM OF PATENT.**
when perfected, 99, 198.

FOREIGN PUBLICATION, effect of, on United States patent, 191, 192.

See **PRIOR KNOWLEDGE AND USE.**

FORFEITURE, of right to patent by delay, 3.

See **ABANDONMENT; DELAY; ESTOPPEL.**
of license, by breach of covenant, 85, 86.

See **LICENSE.**

FORMER PATENT, effect of, on later patent for part of same machine, 30.

See **CLAIM; ESTOPPEL.**

G.

GILL MACHINE, state of art as to, 28.

GOVERNMENT, annulling of patent by, when, 8, 139, 140.

See **ANNULLING; PRACTICE.**

cannot use patented article without compensation, 103, 214.

See **INFRINGEMENT.**

GRANTEE, who is, 160.

right to use machine during extended term, 19, 20.

See **EXTENSION; PATENT.**

GREEN PATENT, construed, 5, 6.

H.

HAMILTON PATENT INVENTION, referred to, 102.
 “**HEIRS**,” effect of this word in patent, 193.

I.

IDENTITY of invention, in patent and reissue, decided by the court, 11, 17.

See **REISSUE**; **COURT**.

of invention in interference, 17.

what is, 56, 57.

IMPROVEMENTS, when patentable, 7, 8.

on combinations, when patentable, 10.

on different machines, when to be included in same patent, 10, 13, 55, 56, 94, 123, 136.

commissioner decides this, 13.

See **COMMISSIONER**; **DIFFERENT INVENTIONS**.

damages for infringement of, are profits, 78.

INADVERTENCE, as ground for reissue, none given by rejected claim, 6, 103, 104.

INFRINGEMENTS, how far joint owners may be, 158.

See **JOINT OWNERS**; **INFRINGEMENT**.

not trustee so as to give jurisdiction, 116, 148.

See **FEDERAL COURTS**; **JURISDICTION**.

gets right to use machine by paying full damages and profits, 154, 155.

See **DAMAGES**.

vendees of, when not suable, 16.

See **INJUNCTION**; **EQUITY**.

purchaser at marshal's sale, when is, 32, 33.

See **INFRINGEMENT**.

when joint patentees may be, 35, 158.

when licensee of joint patentees may be, 35.

sheriff by sale of materials is not, 184.

purchaser at marshal's sale, when may be, 33.

county may be, 102, 123.

city may be, 19.

fire department of city, not, 4.

INFRINGEMENTS — *continued.*

director of company is not, 112.

agent is not, when, 47.

workman or employee is not, 47.

INFRINGEMENT, what constitutes, 194.

is a question of fact, 106, 224, 225.

requires identity of machines, 17, 212, 213.

of patent on part of machine, 115, 120, 121.

of combination patent, 77, 164, 165, 215, 218, 219.

by use of equivalents, 39, 45, 74, 190, 191.

of subcombinations, 164.

See COMBINATION.

several, when may support several suits, 222.

several, when may be included in same bill, 70.

right of action for, barred by surrender of patent, 135.

is intentional and deliberate, when, 181.

of design patent, what is, 76, 77.

right of action for past, does not pass by assignment, 48,
136, 137.

damages for, paid, give no title to machine, 17.

machine may be ordered to be destroyed, 17.

damages and profits give license, 154, 155.

by several, making different parts, 184, 185, 216, 217, 221.

by joint patentees, 35.

by sheriff, selling materials at sale, 184.

by purchaser at marshal's sale, 33.

county liable for, 102, 123.

city liable for, 19.

but fire department of city not, 4.

director of company, how far personally liable for, 112.

agent not liable for, when, 47.

workman, or employee, when, 47.

suit for, barred by consent of inventor before patent, 123,
124.

what proof of will not support bill in equity, 201.

INJUNCTION, preliminary, not granted when validity of

patent is doubtful, 80, 103, 184.

when granted, 10, 66, 151.

may be granted, though no trial at law, 195.

may be refused, though plaintiff has judgment at law, 57.

as to granting final, after expiration of patent, 4.

INJUNCTION — *continued.*

effect of loss of right to, on jurisdiction, 50, 54, 55, 89, 100, 101.

See **FEDERAL COURTS; JURISDICTION.**

decree for, not final decree, 10.

See **DECREE; EQUITY.**

upon suit against vendees of infringer, 16.

See **EQUITY.**

INSOLVENCY, assignee in insolvency does not get legal title to patent, 7.

See **ASSIGNMENT.**

INTENTION to infringe, proof of, will support bill in equity, 232.

See **BILL IN EQUITY.**

INTEREST, not generally allowed on damages, 114, 139, 140, 141, 152, 195.

except when intentional, or under special circumstances, 114, 139, 140, 141.

See **DAMAGES.**

INTERFERING PATENTS, may both be declared void by court, 59, 71, 72, 212.

See **COURT.**

INVENTION, necessary to give patentability, 44, 78, 95, 127, 128, 149, 153, 168, 169, 200, 202, 209.

what is, 168, 169.

differs from mechanical skill, 168, 169.

is property before patent, 105.

patentability of, strictly examined, 7, 8, 78, 196, 200.

See **PATENTABILITY.**

different, when may be included in same patent, 10, 13, 55, 56, 94, 123, 136.

commissioner decides this, 13.

See **DIFFERENT INVENTIONS; PATENT; COMMISSIONER.**

described and not claimed in previous patent may be patented, 78, 206.

See **ESTOPPEL; PATENTABILITY.**

priority of, 169.

joint or separate, 10.

J.

JOINT INVENTOR, who is, 10.

JOINT PATENTEES, or owners, not infringers, 35, 158.

JUDGMENT OF CO-ORDINATE COURT, how far followed,
171, 209, 218.

See **DECREE**.

JUDICIAL NOTICE, of lack of novelty, 23, 24.

JURISDICTION, of federal courts, in equity in patent case,
nature of, 207.

given by act of Congress, 115.

depends on right to injunction, 50, 54, 55, 100, 101, 105,
174, 175, 194, 195, 197, 204.

account alone will not support, 50, 54, 55, 89, 100, 101, 174,
175, 176, 182, 195, 197.

does not exist after expiration of patent, 34, 40, 143, 149,
175, 176.

none based upon infringer as trustee, 15, 25, 44, 116.

See **BILL IN EQUITY; EQUITY; FEDERAL COURT**.

in patent cases, how affected by an existing license, 18, 22,
23, 28, 72, 73, 74, 85, 86, 93, 113, 114, 127, 203, 204, 225,
226, 227.

K.

KING PATENT, reissue, No. 3,000, construed, 108.

L.

LACHES, in claiming reissue, 103, 104.

See **ABANDONMENT; DELAY; NEGLIGENCE**.

effect of, on account of profits, 144.

See **DAMAGES**.

LEATHER PEBBLING MACHINE, patent for, 205.

LEGAL TITLE, to patent, cannot be conveyed by receiver, 76.
vests in assignee when patent is issued, 62.

See **ASSIGNMENT**.

LICENSE, differs from assignment, 64.

how far personal, 84, 146, 210, 211.

LICENSE — *continued.*

must be to assigns, to be assignable, 210, 211.

divisibility of, depends on its terms, 22.

if to corporation and not assignable, ends with dissolution of corporation, 84.

See **ASSIGNMENT.**

limited as to locality, effect of, 87, 88, 126.

on use of machine, 1, 2, 3.

as to selling old goods, 84.

forfeited by breach of covenant, 85, 86.

revoked by notice, 84.

when inferred from relation of parties, 32.

when presumed, 124.

may be pleaded with general issue, 46, 55, 117.

or denial of validity of patent, 55, 117.

how far is an estoppel, 117.

See **PLEADING; PRACTICE; ESTOPPEL.**

fee is proper measure of damages, when, 14, 15, 18, 182.

as affecting jurisdiction of Federal Courts, 18, 22, 23, 28, 72, 73, 74, 85, 86, 93, 113, 114, 127, 203, 204, 225, 226, 227.

See **FEDERAL COURTS; JURISDICTION.**

when suit may be in licensee's own name, 64, 218.

LICENSEE, may sue patentee when, 113, 203.

may sue in his own name when, 64, 218.

may join as plaintiff, 83.

of joint patentee is not infringer, 35.

to use, effect of sale by, 228.

See **INFRINGEMENT; PRACTICE; BILL IN EQUITY.**

LIMITATIONS, State statute, effect of, on suit in federal courts, 38, 39, 88, 150, 151, 168, 171, 185, 186.

See **FEDERAL COURTS.**

to application for patent, after two years' sale, 5.

See **PRIOR USE.**

M.

MACHINE, improvements on, when patentable, 7, 8, 10.

See **IMPROVEMENTS.**

in interference, identity of, 17, 56, 57.

See **PATENT.**

MACHINE — *continued.*

mode of operating when part of invention, 18, 27.

See **PATENT**.

infringing, may be ordered delivered up for destruction, 17.

MANUFACTURE, article of, when patentable, 198, 199, 200.

See **PATENTABILITY**.

MARSHAL'S SALE, purchaser at, when infringer, 33.

See **INFRINGER**; **INFRINGEMENT**.

MASTER'S FEES, for accounting, paid by defendant, 21.

See **DAMAGES**.

report, on exception to, court may dismiss bill, 59.

See **BILL IN EQUITY**.

MEASURE OF DAMAGES. See **DAMAGES**.**METHOD**, is equivalent to process, 138.

may be patented as such, 36.

when part of invention, 18, 27.

See **PROCESS**; **PATENT**.

MODEL, of infringing machine, not part of plaintiff's costs, 100, 231.

of plaintiff's machine may be part of defendant's costs, 87.

MULTIFARIOUSNESS, when bill in equity is bad for, 191.

See **BILL IN EQUITY**.

N.**NEGLIGENCE**, what is, 51.

of solicitor, when acts as abandonment, 3, 16, 53.

See **ABANDONMENT**; **DELAY**; **ANTICIPATION**.

in filing disclaimer, must be set up in answer, 26.

See **DISCLAIMER**.

NEW DEFENCE, when cause will be reopened for, 173.**NEW MATTER**, what will invalidate reissue, 161.

See **REISSUE**.

NICHOLSON INVENTION, described, 53.**NITRO-GLYCERINE**, patent for construed, 163.**NOMINAL DAMAGES**. See **DAMAGES**.**NOTICE**, judicial, taken of ice-cream freezer, 23, 24.

of revocation of license, effect of, 84.

given by record of assignment, 21.

See **ASSIGNMENT**; **LICENSE**.

NOVELTY, necessary to patentability, 12, 149, 153, 179.

of elements of combination, 12.

of old elements to new use, 206.

how affected by earlier patents, 61.

want of, must be set up by answer, 165.

See **PATENTABILITY; PRIOR KNOWLEDGE AND USE.**

O.

OATH, to application, fault in, cured by issuing patent, 192, 222.

See **APPLICATION.**

OLD ELEMENTS, when patentable in combination, 12.

See **COMBINATION.**

P.

PATENT FOR INVENTION, similarity to land patent, 141, 142.

may be for process or product, 27, 30, 36, 38, 42, 50, 73, 74, 112, 126, 135, 142, 147, 177, 198, 199, 200, 209, 210, 231.

See **PROCESS; PRODUCT; PATENTABILITY.**

must describe product if that is claimed, 36.

not for principle, 27, 42, 112, 210.

See **PATENTABILITY.**

nor for application of element of nature, 146.

nor for mere mode of operation, 27.

See **PATENTABILITY.**

right to, barred by sale for two years, 5, 40.

or by public use for same time, 37, 40, 51, 52, 53, 125, 205.

but Congress may grant, after two years' use, 19.

See **PUBLIC USE; SALE; USE.**

application for, amendment of, 167, 168.

right to, forfeited by delay, when, 3, 105.

successive applications, how treated, 13, 14, 19.

See **APPLICATION; ABANDONMENT; DELAY; NEGLIGENCE.**

may include distinct inventions, when, 10, 13, 55, 56, 94, 123, 136, 233.

See **DIFFERENT INVENTIONS; INVENTION; COMMISSIONER.**

PATENT FOR INVENTION — *continued.*

construction of, limited by claim, 47, 107, 108, 140.

illustrated by the specification, drawings, and models, 18, 22, 26, 27, 48, 107, 108.

See CLAIM.

also limited by subject-matter, 197.

primary, liberally construed, 109, 118, 125, 168.

covers all forms of same invention, 229.

or equivalents, 157.

for result, includes process, 135.

See EQUIVALENTS; PATENTABILITY; PROCESS.

informality of oath to application for, effect of, 79, 94, 192.

See OATH; APPLICATION FOR PATENT.

may be specially extended by act of Congress, 3.

See ACT OF CONGRESS.

term of, how affected by foreign patent, 9, 59, 60, 71, 90, 96, 147, 148.

See FOREIGN PATENT.

expiration of, affects jurisdiction in equity, 4, 175, 176.

after suit began, does not, 175, 176.

See JURISDICTION; FEDERAL COURTS; EQUITY.

can only be annulled by government, 8, 14, 139, 140, 178.

See GOVERNMENT.

if void, valid may be issued, 79.

void when patentee not citizen, 33.

or application is amended after applicant's death, 51.

does not exempt from State police laws, 152.

government cannot use without compensating, 103.

legal title to, does not pass to assignee in insolvency, by general assignment, 7.

legal title to, cannot be conveyed by receiver, 76.

but equitable may, 76.

See ASSIGNMENT.

may be taken by creditor, by bill in equity, 3.

See BILL IN EQUITY.

when can be sold on execution, 204.

on death of patentee, goes to administrator, 193.

may be issued to assignee of record, 186.

See RECORD.

validity of, may be tried in equity, 72, 73.

as well as at law, 72, 73.

several may be included in same bill, when, 191.

PATENT FOR INVENTION — *continued.*

cannot be expanded by reissue, 11, 17.

See REISSUE.

invalidity of, and license, when consistent defences, 16, 178.

See PLEADING; PRACTICE.

PATENTABILITY, as to, 110, 155, 220.

requires novelty, 12, 179.

is question of law, 118, 119.

not conclusively settled by commissioner, when, 118.

is strictly examined, 7, 8, 196, 200.

when examinable by the court, 178, 196, 200.

cannot be granted for new mode of operation, 27.

nor for a principle, 27, 42, 112, 210.

nor for an application of an element of nature to practice, 146.

may be for a product, when, 27, 38, 42, 50, 73, 74, 112, 126, 198, 199, 200, 210.

or articles of manufacture, 198, 199, 200.

or a process, 30, 36, 42, 73, 74, 126, 135, 142, 147, 177, 209, 210, 231.

or a method or art, as a process, 36.

requires inventive genius, 44, 78, 95, 127, 128, 149, 153, 168, 169, 200, 202, 209.

See INVENTION.

mere utility, how far a test, 54, 95, 110, 190, 198, 202.

mere mechanical skill is not, 200, 201.

of invention described in prior patent to same patentee, 11, 78, 206.

slight change in machine may be patentable, 102.

of combination of old elements, when, 10, 12, 58, 81, 82, 83, 117, 156, 157, 169.

of substitutes in a process or machine, when, 33, 45, 92, 93, 97, 98, 99, 109, 184, 199, 200.

of change in location of a part, 122.

charge of Mr. Justice Nelson, as to, 125.

of double use, 99, 153, 154, 172.

PLEADING, as to special pleas, with general issue, 17, 79, 192, 224.

special pleas of license consistent with denial of validity of patent, when, 16, 17, 46, 55, 117, 178.

bill in equity, when not multifarious, though including several patents, 69, 96, 142, 143, 145, 146, 191.

PLEADING — *continued.*

alleging several infringements, 70.

See **BILL IN EQUITY.**

plea not overruled by answer, when, 203.

See **DEMURRER; EQUITY.**

PRACTICE, as to preliminary injunction, 80.

when defendant should give bond, 80, 177.

See **INJUNCTION; EQUITY.**

as to district in which to sue a corporation, 46, 159, 166, 186, 224.

See **CORPORATION; BILL IN EQUITY.**

as to filing disclaimer, 61.

neglect to, must be set up in answer, 26.

effect of filing disclaimer, 60.

See **DISCLAIMER; CLAIM; COSTS.**

as to dismissing bill, 33, 51, 59, 84, 196.

See **BILL IN EQUITY; COURT.**

as to suit by assignee, when in his own name, 62, 63, 64, 101, 137, 143, 160.

See **ASSIGNMENT; ASSIGNEE.**

plaintiff must be owner of patent, 101, 137, 143.

when licensee should be joined, 83.

as to suit against State court receiver, 10.

as to compelling plaintiff to elect one of several suits, 221, 222.

as to declaring patents void, 71, 72.

See **EQUITY.**

master's fees to be paid by defendant, 21.

See **MASTER.**

as to opening cause for new evidence, 24, 25, 173.

as to new evidence in reviewing commissioner's decision, 7.

See **COMMISSIONER.**

as to evidence of prior use, 64.

names of witnesses not given, 171.

evidence of prior use admissible under denial of priority of invention, if not objected to, 219.

want of novelty must be notified by defendant, 165.

as to amending answer, 178.

as to final decree, what is, 10, 12.

See **DECREE; JUDGMENT.**

as to effect of decisions of other courts, 4, 5, 75, 76.

See **DECREE; JUDGMENT.**

PRACTICE — *continued.*

plaintiff must prove damages, 17, 18.

See **DAMAGES**.

compelling defendant to disclose contracts, 211.

as to granting injunction after expiration of patent, 4.

See **EQUITY; JURISDICTION; FEDERAL COURTS**.

of suit to annul a patent, 8.

PRELIMINARY INJUNCTION. See **INJUNCTION; PRACTICE**.

PRESUMPTION, none, of damages, 18.

See **DAMAGES**.

PRINCIPLE OF NATURE, not patentable, 27, 42, 112, 210.

See **PATENTABILITY**.

PRIMARY PATENT, liberally construed, 109, 118, 125, 168.

See **PATENT**.

PRIOR DESCRIPTION, of invention in patent to same inventor, effect of, 11, 78, 206.

See **PATENTABILITY**.

PRIOR INVENTION, what is necessary to anticipate a patent, 53, 169, 190, 222.

See **ANTICIPATION; DELAY; NEGLIGENCE**.

PRIOR KNOWLEDGE AND USE, what evidence will prove, 36, 63, 120.

must be notified in answer, 171, 208, 219.

names of witnesses to, need not be given, 62, 121, 158, 159, 171, 173, 229.

burden of proof of, is on defendant, 37, 88, 220.

must be established beyond reasonable doubt, 37, 149, 150, 155, 185, 218, 219, 230, 231.

as to credibility of witnesses, 64, 230.

in foreign country, effect of, 106, 191, 192.

See **ANTICIPATION**.

PRIOR PUBLICATION, as to anticipation, 34, 38, 49.

See **PRIOR KNOWLEDGE AND USE; ANTICIPATION**.

PRIOR USE. See **PRIOR KNOWLEDGE AND USE**.

PROCESS, what is, 36, 42, 209, 210.

is patentable, 30, 36, 42, 135, 142, 147, 177, 209, 210, 231.

is a useful art, 42.

equivalent to method, 42.

substitution in, may be patentable, 45.

patent for, may include product, 73, 74, 126.

PROCESS — *continued.*

but should distinguish it, 73, 74.

cannot be reissued for compound, 104, 120, 162, 163.

See REISSUE.

differs from machine patent, 30, 162.

and product, may be claimed in reissue, 177.

of making artificial teeth, 75.

See PATENTABILITY ; PRODUCT ; PATENT ; PRINCIPLE ;
REISSUE.

PRODUCT, when patentable, 27, 38, 42, 50, 73, 74, 112, 126,
198, 199, 200, 210.

and process, may both be patented, 126.

patent must describe both distinctly, 36, 73, 74.

See PATENTABILITY ; PATENT ; PROCESS ; PRINCIPLE.

PROFITS, when measure of damages, 14, 15.

must be proved by plaintiff, 17, 18.

if not, he gets only nominal damages, 17.

are not cash balances, 32.

but the advantages gained by using the machine, 32.

do not carry interest, 114.

unless infringement was intentional, 114.

rule as to, 127.

• See DAMAGES ; INFRINGEMENT ; ACCOUNT.

PROPERTY, in invention before patent, 105.

PUBLIC USE, use in a factory is, 123.

See USE.

Congress may grant patent, after two years' use, 18, 19.

See ACT OF CONGRESS.

PUNITIVE DAMAGES, when allowed, 122.

See DAMAGES.

PURCHASER, of patented machine, limited as to sale, when,
87, 88.

See LICENSE.

at marshal's sale, when infringer, 33.

See INFRINGEMENT.

R.

REASONABLE DOUBT, on question of prior use, is against
defendant, 37, 45.

See PRIOR KNOWLEDGE AND USE. •

RECEIVER, when may be sued, 10, 86.

See **FEDERAL COURTS**.

cannot convey legal title to patent, 76.

See **ASSIGNMENT**.

RECORD, of assignment, effect of, 21, 158.

See **ASSIGNMENT**.

REFRIGERATORS, patent for, held invalid, 172.

REISSUE, was grantable before any act of Congress, 79, 193.

See **CONGRESS; ACT OF CONGRESS; PATENT**.

as to validity of, 9, 11, 103, 104.

what it may claim, 11, 106.

must be for same invention as described in the original patent, and cannot enlarge it, 11, 17, 27, 28, 30, 31, 41, 49, 84, 109, 133, 134, 161, 162, 163, 165, 179, 180, 181, 189, 190, 194, 207, 208, 210, 229, 231, 234.

except when commissioner's mistake limits it, 137, 138.

but if by mistake or inadvertence the original patent does not describe the invention, a reissue may enlarge it, 118, 119, 128, 129, 132, 133, 234.

delay in claiming is laches, 41, 103, 118, 119, 128, 129, 130, 131, 132, 134, 230.

See **ABANDONMENT; DELAY; NEGLIGENCE**.

may omit part of invention when, 31, 44, 49, 61, 67, 68, 69.

can never omit anything essential, 179.

effect of inserting rejected claim in, 6, 41, 87, 111, 144, 193, 194, 199.

is presumed to be for same invention as original patent, 205.

how far court may determine this by comparison of original and reissue, 17, 58, 65, 66, 150, 162, 188, 189, 190, 192, 194, 205.

what is new matter in, 161, 162, 163.

rule as to, strictly construed, 191.

not granted for everything suggested in original patent, 191.

as to, in case of combination patent, 42, 67, 68, 69, 91.

how far granting is conclusive of validity, 92, 107, 118, 166, 206, 208, 222.

See **COMMISSIONER**.

may claim product distinct from process, 162, 163, 177.

See **PROCESS; PRODUCT**.

if process not claimed, how far abandoned, 104, 120.

See **PROCESS; ABANDONMENT**.

REISSUE — *continued.*

may be valid as to claim, same as in original patent, though invalid as to others, 60, 61, 73, 78.

how affected by public use, 205, 233.

by foreign patent, 9.

REJECTED CLAIM, when may be included in reissue, 111.

is not inadvertence, or mistake, to justify a reissue, 111, 144.

See **REISSUE**.

RENEWAL, when passes by assignment, 167.

REPEAL OF PATENT, proceedings for, 230.

See **ANNULLING PATENT**.

REVOCAION OF LICENSE, by notice, 84.

See **LICENSE**.

RICHARDSON PATENT, sustained, 6.

RIGHT TO PATENT, lost by sale two years before application, 5.

See **SALE**; **PRIOR USE**; **PATENT**.

ROYALTY, when proper measure of damages, 14, 15.

See **DAMAGES**.

S.

SALARIES, of managing officers of defendant corporation, 177.

SALE, for two years before application, a bar, 5, 40.

is presumed not to be experimental use, 51, 52, 53.

See **USE**; **PRIOR KNOWLEDGE AND USE**; **PUBLIC USE**; **PATENT**.

of patented article takes it out of monopoly, 2, 19, 134.

but if locally limited, effect of, 1, 2, 3, 20, 87, 126, 228.

of infringing article, 25.

of machine, though without title, is estoppel against suit for infringement, 77.

and draws after acquired title, 57, 77.

See **ESTOPPEL**.

SERVICE, insufficient, as ground of dismissing bill, 84.

See **BILL IN EQUITY**; **PRACTICE**.

SHERIFF, sale by, of materials of machine, not infringement, 184.

See **INFRINGER**; **INFRINGEMENT**.

SILENCE, when is estoppel, 39.

See **ESTOPPEL**.

SIMPLICITY OF CONSTRUCTION, favored by patent law, 108.

SOLE INVENTOR, who is, 10.

See **INVENTOR**.

SOLICITOR, mistake of, effect on reissue, 119.

See **REISSUE**.

negligence of, not abandonment, 16.

See **ABANDONMENT**; **DELAY**.

SPECIAL ACTS OF CONGRESS, extending patent, 3.

granting patents, 56.

effect on assignment, 65.

See **ACT OF CONGRESS**; **CONGRESS**.

SPECIAL PLEAS, when proper, 17.

See **PLEADING**.

SPECIFICATION, insufficient, is defence to suit for infringement, 79, 80, 116, 223.

illustrates construction of claim, 18, 22, 26, 27, 48, 107, 108.

See **CLAIM**; **PATENT**.

when drawings may accompany, 21.

STAPLE, of corrugated iron, why patentable, 173, 174.

STATE POLICE LAWS, not superseded by patent, 152.

See **PATENT**.

STATE OF THE ART, as affecting novelty, 165.

See **PRIOR KNOWLEDGE AND USE**; **ANTICIPATION**.

STATUTE OF LIMITATIONS, State, effect of, in federal courts, 38, 39, 88, 150, 151, 168, 171, 185, 186.

See **FEDERAL COURTS**; **LIMITATIONS**.

STEEL PLATES, substitute for copper in engraving, 109.

SUBCOMBINATIONS, when patentable, 221.

See **COMBINATION**.

SUBSTITUTION, effect of, on infringement of combination patent, 77.

See **COMBINATION**.

of new materials in machine, when patentable, 31, 33, 44, 92, 93, 97, 98, 99, 109, 199, 200, 206.

See **PATENTABILITY**.

in a process, 45.

See **PATENTABILITY**.

SUCCESSIVE APPLICATIONS, as one continuous one, 13, 14, 19.

See **APPLICATION**; **PATENT**; **ABANDONMENT**; **DELAY**.

SUIT, by assignee in his own name, when, 62, 63, 64.

See **ASSIGNEE**; **ASSIGNMENT**; **PRACTICE**.

against State court receiver, 10.

See **RECEIVER**.

against corporation, in what district, 166, 186.

See **CORPORATION**; **PRACTICE**.

dependent on license, is not within the jurisdiction of federal courts, 18, 22, 23, 28, 72, 73, 74, 85, 86, 93, 113, 114, 127, 204, 225, 226, 227.

but is if the license is forfeited, 22, 23, 72, 73, 74, 85, 86, 93, 113, 114, 127, 232.

See **FEDERAL COURTS**; **JURISDICTION**.

SURETIES, must be, on defendant's bond, 177.

See **PRACTICE**.

SURRENDER of patent bars right to sue for infringements, 135.

See **INFRINGEMENTS**.

T.

TAYLOR PATENT, construed, 44.

TERM OF PATENT, how affected by foreign prior patent to same inventor, 9, 59, 60, 71, 90, 96, 147, 148, 170, 197, 220.

See **FOREIGN PATENT**; **PATENT**; **JURISDICTION**.

TERRITORIAL LICENSE; effect of, on purchaser, 87, 88.

See **LICENSE**; **SALE**.

TITLE, legal, cannot be conveyed by receiver, 76.

equitable, may, 76.

See **RECEIVER**.

TRUSTEE, how far infringer is, 15, 25, 44, 116.

See **INFRINGER**; **JURISDICTION**; **FEDERAL COURTS**; **EQUITY**.

TWO YEARS' USE, bars right to a patent, 37, 125.

but Congress may grant one, 19.

See **PUBLIC USE**; **PRIOR KNOWLEDGE AND USE**; **SALE**; **ABANDONMENT**; **DELAY**.

U.

UNITED STATES cannot use patented article without paying for it, 103.

See **INFRINGEMENT**.

suits in name of, 8, 14.

See **PRACTICE; ANNULLING PATENT**.

USE, prior to application for two years, bars right to patent, 37, 40, 125.

not if experimental, 51, 52, 53.

sale is not experimental use, 51, 52, 53.

public, effect on patent, 205.

in a factory is public, 123.

See **PUBLIC USE; PATENT**.

double, not patentable, 24, 99.

right to, includes right to make, 203.

or to repair, 225, 228.

abnormal, as to anticipation, 34.

See **ANTICIPATION**.

new, is patentable though machine old, when, 12, 206.

See **PATENTABILITY**.

outside of limited locality, 1, 2, 3.

See **LICENSE; SALE**.

“**USEFUL ART**,” includes process of manufacture, 42.

See **PROCESS**.

UTILITY, as test of patentability, 54, 110, 190, 198, 202.

See **PATENTABILITY**.

V.

VALIDITY OF PATENT. See **PATENT**.

VENDEES OF INFRINGER, suit as to, 16.

See **INFRINGEMENT; EQUITY**.

VOID PATENT, may be replaced by valid one, 79.

See **REISSUE**.

W.

WARRANTY OF TITLE, by sale, 57.

See SALE.

WELLS INVENTION, state of the art as to, 28.

WOOD PAPER PATENT, construed, 24.

WORKMAN, not an infringer, 47, 183.

See INFRINGER.

when forfeits right to patent, 124, 125.

See PATENT; LICENSE.

Ex. G. A. A.