

That in the process of hydrating lime, where the only novel feature was supplying the exact amount of water to complete the hydration, all the other steps of the process being old, and knowledge of the fact that such exact amount might be determined, did not involve invention, see — *Lauman v. Urschel*, 136 Fed. 190; 69 C. C. A. 206.

The hand and machine methods are essentially the same. The fact that in one case the work is done by a hand tool, and in the other by a machine, does not influence, much less control, the decision of the question. The complainant did not discover a new method of chipping glass. It is rather the old method performed by a new tool. It is impossible to demonstrate wherein the claims of this patent set forth anything not methodically pursued in the hand operation. — *Penn v. Conroy*, 159 Fed. 943; 87 C. C. A. 149.

We are satisfied that Cameron was the first one to subject a flowing current of sewage to the action of anaerobes and aerobes under conditions which secured their separate and successive action. This certainly involved "the use of one of the agencies of nature for a practical purpose." The process was one which puts a force of nature into a certain specified condition and then uses it in that condition for a practical purpose. — *Cameron v. Saratoga*, 159 Fed. 453; 86 C. C. A. 483.

Risdon v. Medart, 153 U. S. 77; *Bell Telephone*, 126 U. S. 1.

§ 820. Process and Product — Claims for.

The contention that, in the patent, the product inheres in the process, and that, therefore, the claim of the one necessarily includes the other, cannot be sustained on principle or authority. The claim is single and is either for a process or product; otherwise, if the claim is divisible, one part being for a process and the other for a product, it would be a double claim, and as such in danger of being held void for ambiguity. The applicant for a patent may separately claim both a process and a product, but cannot properly claim them in one claim. They are the proper subjects of separate and distinct claims. — *Durand v. Schulze*, 61 Fed. 819; 10 C. C. A. 97.

Merrill v. Yeomans, 1 Ban. & A. 55; *Goodyear v. Rubber Co.* 2 Cliff. 371.

If the complainant had included in his patent no claims except the product claims, he could not have obtained thereafter another patent for the process, for the reason that the process and the product are substantially one invention or discovery. — *Downes v. Teter-Heany*, 150 Fed. 122; 80 C. C. A. 76.

Mosler v. Mosler, 127 U. S. 361.

§ 821. Process and Product — Patentability.

Explaining and distinguishing *Goodyear v. Day*, 2 Wall. Jr. 283, and *Goodyear v. R. R. Co.* 2 Wall. Jr. 356. — *Powder v. Powder*, 98 U. S. 126; 25 L. Ed. 77.

The patent in suit was for a product, viz. a hard rubber plate for artificial teeth, and the product was described and claimed in terms of the process. *Held* that another product for performing the same function, but produced from different material and by a different process was not infringement. — *Goodyear v. Davis*, 102 U. S. 122; 26 L. Ed. 149.

The original patent was for a process; the reissue was for the product. Although there are two patents, one for a process and the other for a product, there is in fact but one invention; and it may be assumed that the new article of manufacture is a product which results from the use of the

process described in the patent, not one which may be produced in any other way. — *Plummer v. Sargent*, 120 U. S. 442; 30 L. Ed. 737; 7 S. Ct. 640.

One and the same patent may cover both a process and product, but, if the patentee choose to restrict himself to one by his claim, he cannot include the other also by a reference to other parts of his specification. — *Durand v. Schulze*, 61 Fed. 819; 10 C. C. A. 97.

The patent also describes a process for making it which was new, and up to the present time is the only known process by which it can be produced. Since, then, there was novelty both in the process and product, *Hinsberg* might have had one claim for the process and another claim for the product. — *Maurer v. Dickerson*, 113 Fed. 870; 51 C. C. A. 494.

Rubber v. Goodyear, 9 Wall. 788; *Merrill v. Yeomans*, 94 U. S. 568.

The original specifications and drawings disclose the envelope construction of air-passages surrounding the jet of gas. In these circumstances, we conclude that there is no substantial conflict between the statements of the original and amended specifications; that the original specification sufficiently disclosed the nature of the invention claimed in the patent, and sufficiently suggested the process involved therein; and that as the invention or discovery of the process involved the product, and the product was the result of the process, the claims for the process were properly included in the patent in suit. — *Kirchberger v. American*, 128 Fed. 599; 64 C. C. A. 107. See 215 U. S. 161.

Powder v. Powder, 98 U. S. 126; *Wing v. Anthony*, 106 U. S. 142.

That there may coexist both a patentable process and product is plain. In such case both the process and the product must be new and useful. So it may be conceded that a process may be old, but the product new, or the product old and the process new. In such case one will be patentable and the other not. In *Providence v. Goodyear*, 9 Wall. 788 it was said: "The patentability, or the issuing of a patent as to one, in no wise affects the rights of the inventor or discoverer in respect to the other. They are wholly disconnected and independent facts." Nevertheless it does not follow that a single patent may issue for both a process and a product when the latter is wholly independent of the other. The *Goodyear* patent, referred to above, originally issued for both a process and a manufacture. It was surrendered, and two patents taken, one for the process and one for the product. — *Sanitas v. Voigt*, 139 Fed. 551; 71 C. C. A. 535.

That the abandonment of an application for a patent upon the product of a process does not in any way argue invalidity of the process patent, see — *Mica Insulator v. Commercial*, 166 Fed. 440; C. C. A.

§ 822. Miscellaneous Rulings.

In cases of chemical inventions, when the manufacture claimed as novel is not a new composition of matter, but an extract obtained by the decomposition or disintegration of material substances, it cannot be of importance from what it has been extracted. — *American v. Fiber*, 90 U. S. 566; 23 L. Ed. 31.

It is quite obvious that a manufacture or a product of a process, may be no novelty, while, at the same time, the process or agency by which it is produced may be both new and useful — a great improvement on any previ-

ously known process and therefore patentable as such. — *American v. Fiber*, 90 U. S. 566; 23 L. Ed. 31.

If, however, he had in his own mind only a claim for the process of manufacture by which the article was made, his use of the term is intelligible. — *Merrill v. Yeomans*, 94 U. S. 568; 24 L. Ed. 235.

Another person might invent a better apparatus for applying the process than that pointed out by Nelson, and might obtain a patent for such improved apparatus; but he could not use the process without a license from Nelson. His improved apparatus would, in this respect, stand in a relation to the process analogous to that which an improvement on a patented machine bears to the machine itself. — *Tilghman v. Proctor*, 102 U. S. 707; 26 L. Ed. 279.

It is clear that both patents must stand or fall together. If the patent for the process is invalid so must be the patent for the product. — *Western v. Ansonia*, 114 U. S. 447; 29 L. Ed. 210; 5 S. Ct. 447.

The fact that by careful workmanship the products are indistinguishable by mere inspection does not establish the identity of the processes; and as the patent for the product must be limited to an article made by the particular process, the inquiry must be determined by a comparison between the methods actually employed. — *Plummer v. Sargent*, 120 U. S. 442; 30 L. Ed. 737; 7 S. Ct. 640.

After a patent is granted for an article described as made by causing it to pass through a certain method of operation to produce it, the inventor cannot afterwards, on an independent application, secure a patent for the method or process covered by the previous patent, which article was described in that patent as produced by the method or process sought to be covered by taking out the second patent. — *Mosler v. Mosler*, 127 U. S. 354; 32 L. Ed. 182; 8 S. Ct. 1148.

True, if the process were the mere function of a machine, another machine capable of performing the same function might be an anticipation; but this is not because a process can be anticipated by a mechanism, but because, as we have held in several cases, the mere function of a machine is not patentable as a process at all. — *Carnegie v. Cambria*, 185 U. S. 403; 46 L. Ed. 968; 22 S. Ct. 698.

The description being addressed to those skilled in the art, the statement being made that variation is necessary according to the quality of the element used, it is sufficient if its application in a specific instance be given. — *Schwarzwalder v. N. Y.* 66 Fed. 152; 13 C. C. A. 380.

It may be that the variance results from some immaterial change in the process from the use of starting material, which is within the fair range of equivalents; but, having failed to prove identity by the prescribed tests, the burden is on the holder of the patent to show that the variances in process are immaterial, or the starting materials equivalents of those of the patents. — *Matheson v. Campbell*, 78 Fed. 910; 24 C. C. A. 284.

Whether the success of the operation under the patent in suit is due to the superiority of its process for economical production or to the changed conditions referred to, or to both combined, is not material, in view of the

fact that the product, and not the process, is the claim of discovery. — *National v. Swift*, 104 Fed. 87; 43 C. C. A. 421.

It is necessary to read them (product claims) in connection with the process described in the patent and to limit the scope of the claims to a product which is the result of that process. — *Downes v. Teter-Heany*, 150 Fed. 122; 80 C. C. A. 76.

PRODUCT.

Patentability § 823 Miscellaneous Rules § 824 See — <i>Composition of Matter</i> § 264;	}	<i>Infringement</i> §§ 521, 690; <i>Machine and Product</i> § 771; <i>Manufacture</i> § 772; <i>Sale of Patented Article</i> § 899
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§ 823. Patentability.

A machine may be new, and the product or manufacture proceeding from it may be old. In that case the former would be patentable and the latter not. The machine may be substantially old and the product new. In that event, the latter, and not the former, would be patentable. Both may be new or both may be old. In the former case, both would be patentable; in the latter neither. — *Rubber v. Goodyear*, 76 U. S. 788; 19 L. Ed. 566.

Where a new process produces a new substance, the invention of the process is the same as the invention of the substance, and a patent for the one may be reissued so as to include both as was done in the case of Goodyear's vulcanized India rubber patent. — *James v. Campbell*, 104 U. S. 356; 26 L. Ed. 786.

While a new process for producing it was patentable, the product itself could not be patented, even though it was a product made artificially for the first time, in contradistinction to being eliminated from the madder root. Calling it artificial alizarine did not make it a new composition of matter, and patentable as such, by reason of its having been prepared artificially for the first time from anthracine, if it was set forth as alizarine, a well known substance. — *Cochrane v. Badische*, 111 U. S. 293; 28 L. Ed. 433; 4 S. Ct. 455.

Wood Paper Patent, 23 Wall. 566.

The fifth claim of the patent is obviously an attempt by the patentee to obtain a monopoly of the product of the apparatus described in the patent, so that in the event it should turn out that his apparatus was not patentable, or the product could be made by apparatus not infringing his, he could nevertheless enjoy the exclusive right of making it. A claim for an article of manufacture is not invalid merely because the article is the product of a machine, whether the machine is patented or unpatented; but it is invalid unless the article is new in a patentable sense, — that is, unless its original conception or production involved invention, as distinguished from ordinary mechanical skill. If it is new only in the sense that it embodies and represents superior workmanship, or is an improvement upon an old article in degree and excellence, the claim is invalid. — *Edison v. American*, 114 Fed. 926; 52 C. C. A. 546.

Hatch v. Moffitt, 15 Fed. 252; *Wooster v. Calhoun*, 11 Blatchf. 215; *Excelsior v. Union*, 32 Fed. 221; *Smith v. Nichols*, 21 Wall. 112; *Locomotive v. Medart*, 158 U. S. 79.

Whatever novelty in a patentable sense there may be in flakes of cooked wheat which are thin, crisp, and slightly brown, must be found in some

superior efficaciousness, or some new properties which they possess, and not in any mere change of form produced by mechanical division of the cooked grain either before or after the last step in cooking. Cooked grain thus prepared, and having all the characteristics called for by the claim, may constitute a new article of commerce. But do they render the article new in a patentable sense? If so, it must be due to some new properties or improved efficacy as a food. — *Sanitas v. Voigt*, 139 Fed. 551; 71 C. C. A. 535.

Glue Co. v. Upton, 97 U. S. 3; *Cerealine v. Bates*, 101 Fed. 272; *Maryland v. Dorr*, 46 Fed. 773.

A mere difference in the proportions of the constituents of an alloy, however useful the result may be, does not entitle the originator to the monopoly of a patent, in the absence of other circumstances than those here disclosed. — *Brady v. Ajax*, 160 Fed. 84; 87 C. C. A. 240.

§ 824. Miscellaneous Rules.

When a new article, a new property in the composition of matter, is thus brought to light for the enrichment of the world's knowledge and uses, the statute intends that the discoverer may be rewarded with exclusive rights to make and sell the article during the moderate term for which the patent is granted. This broad monopoly can be granted for a true discovery only, and not for the mere improvement of a known composition. — *National v. Swift*, 104 Fed. 87; 43 C. C. A. 421.

Merrill v. Yeomens, 94 U. S. 568.

Given, two such propositions as the process in the prior patents, like ingredients, with coagulation of the albuminoids and resultant product clearly set forth, there was surely no pioneer discovery in chemistry on the part of Van Ruymbeke to authorize a patent for the identical product, however meritorious his advance may have proved in the process to that end. — *National v. Swift*, 104 Fed. 87; 43 C. C. A. 421.

That claim, in terms, is for the described product, having certain distinguishing characteristics which are set forth in the claim with great fullness. In our judgment it is very clear that the claim is not restricted to the product made by the described process, but covers the chemical individual, however produced. We know of no rule requiring a construction limiting a claim for a chemical product to the described process, because the evidence shows that it cannot be made in any other way than by the process recited. No warrant for such a rule is to be found either in the statute or in the decisions. — *Maurer v. Dickerson*, 113 Fed. 870; 51 C. C. A. 494.

In general, when the patent is for a product of manufacture, it is not material by what means or by what process it is manufactured. But it is obvious that there must be an exception to this rule to cover cases where the identity or specific character of the thing patented is affected by the means or method of its manufacture. Thus it is easy to understand that a glove made up of knitted material is a different thing from one made from cloth or leather. Its qualities are dependent on the way in which it is made. — *Lamb v. Lamb*, 120 Fed. 267; 56 C. C. A. 247.

PROFITS.

Statutory Provision § 825
General Statement § 826
Accountings § 827
Deductions

General Expenses — Not Proper § 828
Losses § 829
Manufacturer's Profits § 830

Rules for § 831
 Salaries § 832
 Miscellaneous § 833
 Definition § 834
 Interest § 835
 Master in Chancery § 836
 Measure of
 Actual Gains § 837
 Entire Profits § 838
 Rules § 839
 Savings by Use § 840
 Trustee ex Maleficio Rule § 841
 Miscellaneous Rules § 842

Segregation
 Burden of Proof § 843
 Failure to Make § 844
 General Rules § 845
 Miscellaneous Rules § 846
 Miscellaneous Rules Concerning Profits § 847
See — Damages § 278; Designs § 328; Jurisdiction § 719; Marking "Patented" § 776; Reissue § 887; Royalties § 897; Statute of Limitations § 921

§ 825. Statutory Provision.

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

But in any suit or action brought for the infringement of any patent there shall be no recovery of profits or damages for any infringement committed more than six years before the filing of the bill of complainant or the issuing of the writ in such suit or action, and this provision shall apply to existing causes of action. — R. S. 4921.

The statute of limitation provision was added by the act of Mar. 3, 1897, and went into effect Jan. 1, 1898.

§ 826. General Statement.

Much that has been said by way of general statement under *Damages* applies here. Many of the rules under that title apply to profits. The difficulty in securing substantial recoupment in the nature of profits is hardly less difficult than in the nature of damages. It is unnecessary to add to what has been said upon that subject under damages, except to add the following statement, made under oath, by a lawyer of long experience:

"I have had the equity docket of the Southern District of New York examined and have found, as a fair average, that only four of the fifty-four patent causes wherein accountings were decreed, do any proceedings upon the accountings appear of record." (Compl'ts. Rec., *Hall v. General*, 153 Fed. 907.)

The statement of counsel in that case, also made under oath, may be of interest:

"It is my invariable practice founded upon my own experience in patent litigation, extending over the past eighteen years, and upon my knowledge of the experience of other patent counsel, to advise my clients that, in the absence of an established license fee, there is hardly any chance of recovering damages for infringement, and that in no event can they expect to be compensated either by damages or costs for the expense of litigation and the injury from infringement. I advise them that the one effective remedy is

injunction, and that where injunction cannot be obtained, the patentee is without remedy."

§ 827. Accountings.

The right to an account of profits is incident to the right to an injunction in copy- and patent-right cases. — *Stevens v. Gladding*, 58 U. S. 447: 15 L. Ed. 155.

See *Stephens v. Cady*, 14 How. 528.

Profits obtained by infringement after suit is begun can be reached only when such infringement is a continuation of former infringement. — *Marsh v. Nichols*, 128 U. S. 605; 32 L. Ed. 538; 9 S. Ct. 168.

Taking into account the fact that defendant did not make due effort to carry out his application (the application for the patent in suit), and that it certainly does not appear that the Morrow device was so much, if at all, better than the licensor's, that due business diligence did not require the company still to push the latter, we are of opinion that on this item it properly was held to account. — *Eclipse v. Farrow*, 199 U. S. 581; 50 L. Ed. 317; 26 S. Ct. 150.

Upon an accounting for an infringement commenced before the bill was filed, and continued afterwards, the complainant is entitled to recover profits derived by the defendant from his infringement to the date of the accounting. "The practice saves a multiplicity of suits, time and expense." — *Untermeyer v. Freund*, 58 Fed. 205; 7 C. C. A. 183.

Tatham v. Lowber, 4 Blatchf. 86; *Rubber Co. v. Goodyear*, 9 Wall. 788; *Marsh v. Nichols*, 128 U. S. 605; *Robinson v. Bland*, 2 Burrows, 1086; *Holabird v. Burr*, 17 Conn. 563.

In a patent case there can be no right to an accounting unless the infringement be made out; but the infringement may be found and the injunction awarded in favor of a complainant who, upon the proofs, has no right to an accounting. Upon the issue whether or not the complainant is entitled to the accounting, it may not appear that the defendant used or sold the patented device, but merely that he made it; or it may otherwise appear that there were, in fact, no profits, or that an account had already been stated, conditionally or otherwise, by the parties themselves, and that for want of notice, as provided in sec. 4900 of the Revised Statutes of the United States, no damages could be recovered. In such event there could be no award of an accounting in the decree, although the perpetual injunction would be awarded. *Whittemore v. Cutter*, Fed. Cas. No. 17,601; *Elizabeth v. Pavement*, 97 U. S. 127. In a patent case on the equity side the primary and essential contention relates to the ownership of the patent by complainant, the validity of the claims, and the infringement. The final adjudication in favor of complainant on this contention is a perpetual injunction. — *Standard v. Craue*, 76 Fed. 767; 22 C. C. A. 549.

If we could discover any theory upon which a substantial recovery might be had we would not hesitate to direct a reference, but it is plain that such a proceeding will prove abortive, after subjecting both parties to large additional expense and the defendants to unnecessary annoyance. The master would be involved in an inextricable tangle from which it will be impossible to emerge with a substantial recovery based upon a rational rule of damages. The boards sold by the defendants, and which they had a right to sell, were intended to be used in connection with a large number of games in the description of some of which the word "Carrom" might, in certain

aspects, be used innocently. An attempt to segregate the profits, if any, resulting from the illegitimate use of the word would require an excursion into the realms of conjecture and speculation without hope of any tangible result. — *Ludington v. Leonard*, 127 Fed. 155; 62 C. C. A. 269.

Note: It will be observed that this holding grew out of the infringement of a trademark involved in the suit, and not the infringement of the mechanical patent.

That an appellate court may correct the assessment of damages or account of profits (1) send the case back to the Circuit Court for further instruction, or (2) itself proceed to the assessment of profits by dealing with the master's report as affected by the defendant's exceptions, see — *Doten v. City of Boston*, 138 Fed. 406; 70 C. C. A. 308.

Cawood Patent, 94 U. S. 695.

The complaint was for infringement after the date of the assignment (the patent had been owned by one of complainants alone during part of the period of infringement, and was then assigned in part to the other complainants without an assignment of accrued choses in action. Complainants sought to recover for the period prior to assignment as well as after). Even if that were permissible the bill did not seek to recover a several decree in favor of one of the complainants for one part of the profits and a joint decree for another. On the contrary, the complaint was of infringement after the date of assignment. The court below erred in including the profits for this period (prior to the assignment) in the recovery. — *Canda v. Michigan*, 152 Fed. 178; 81 C. C. A. 420.

Distinguishing *Moore v. Marsh*, 7 Wall. 515.

Adams v. Bellaire, 25 Fed. 270.

That the court having decreed infringement of a certain claim, it is not competent for the master on an accounting to include as contributory infringement elements of claims not found to be infringed, see — *Canda v. Michigan*, 152 Fed. 178; 81 C. C. A. 420.

When the order of reference was made, the only infringement established by the decree was defendant's sale of Columbia ladders. We think it better and cleaner-cut practice to require a complainant to set up alleged new infringements in a supplemental bill, (rather than to establish infringement by other types before the master on the accounting). Thereupon, if it should be found that the additional types contained only colorable departures from the adjudged infringing type, the decree for an injunction and an accounting and the order of reference could be extended to cover them specifically; or, if the changes should appear to be so radical that the pending suit ought not to be cumbered and delayed by practically a new issue, the supplemental bill could be dismissed with leave to the complainant to begin an independent suit. — *Murray v. Orr*, 153 Fed. 369; 82 C. C. A. 445.

It was not open to defendant on the question of additional infringements to refer to the prior art to limit the scope of invention to less than we had found it to be in determining the infringement of the Columbia ladder. As the changes from the Columbia type are only colorable, the fact of the decree that is questioned on this appeal must be reversed. — *Murray v. Orr*, 153 Fed. 369; 82 C. C. A. 445.

§ 828. Deductions — General Expenses — Not Proper.

The master's report was based altogether upon the profits actually realized by the defendant from his sales of infringing machines. The defendant

was charged with the amount received by him from sales as stated by himself. Besides a credit for the cost of manufacture, as found by the master, and a credit for advertising, the defendant was allowed for freight and cartage, and discounts to purchasers. We think the master was right in disallowing the lumping sum which the defendant claimed for "clerk hire, selling expenses, rent and insurance." That was a mere estimate unsupported by evidence. We do not see upon what principle the defendant is entitled to an allowance for the sum paid for other patents and the cost of his patterns. They remain his property. These credits were properly disallowed. — *Sayre v. Scott*, 55 Fed. 971; 5 C. C. A. 366.

Crosby v. Consolidated, 141 U. S. 441; *Elizabeth v. Pavement*, 97 U. S. 126.

This item in the exhibit filed by the defendant's bookkeeper may have been the general cost of carrying on the entire business of the defendant, including its manufacturing departments, or it may be a mere approximation of expenses of selling, which would include interest upon the general capital engaged. If this is the fact, this would be wrong. — *Kisinger-Ison v. Bradford*, 123 Fed. 91; 59 C. C. A. 221.

Rubber v. Goodyear, 9 Wall. 789.

§ 829. Deductions — Losses.

Losses incurred by the defendant through its wrongful invasion of the patent are not chargeable to the plaintiff, nor can their amount be deducted from the compensation which the plaintiff is entitled to receive. — *Consolidated v. Crosby*, 141 U. S. 441; 35 L. Ed. 809; 12 S. Ct. 49.

Cawood Pat. 94 U. S. 695; *Elizabeth v. Nicholson*, 97 U. S. 126; *Tilghman v. Proctor*, 125 U. S. 136.

The court below also erred in sustaining defendant's claim of a deduction of the losses incurred by said defendant during the third period of the reckoning and in deducting these losses from the profits which the complainants were otherwise entitled to recover. *Cawood Pat.* 94 U. S. 710, and *Rubber Co. v. Goodyear*, 9 Wall. 788 are cited as authority for the ruling; but these cases only hold that losses occurring concurrently with the gaining of the profits may be taken into account — that is to say, if they are losses directly resulting from the particular transaction on which the profits are allowed. (The fact here being that the loss period was subsequent to and distinguishable from the profit period.) The meaning and authority of such general statements should be limited to the facts of the case in which they were expressed. And it is necessary to impose such limitations in order to make the statements consistent with the law as since declared by the same court. *Callaghan v. Myers*, 128 U. S. 617; *Crosby v. Safety*, 141 U. S. 453; *Walker on Pat.* (4th ed.) sec. 713. — *Canda v. Michigan*, 152 Fed. 178; 81 C. C. A. 420.

§ 830. Deductions — Manufacturer's Profits.

The master correctly refused to allow "manufacturer's profits" and interest on the capital stock. The correct rule is the difference between cost and yield. — *Rubber Co. v. Goodyear*, 76 U. S. 788; 19 L. Ed. 566.

As no countervailing evidence was put in by the defendants and no specific exception was made to the master's calculations, that he made no allowance for a manufacturer's profit, we think there is no foundation on which to base such a claim now. — *Warren v. Keep*, 155 U. S. 265; 39 L. Ed. 144; 15 S. Ct. 83.

When the complainant's damages are measured by the profits of defendants, it is true that credits have been allowed to the latter "as a mere agency for producing a patented article for so-called 'manufacturer's profits.'" This rule has generally been applied in cases where the patented invention is a distinct invention and a part only of the entire structure which was made and sold. In a noted case, where the patent was for an entirely new product of a process, which was not separable into parts, and the infringing defendant made and sold the entire article, manufacturer's profits were not allowed upon the ground that the entire profits, which were the difference between the cost and yield, belonged to the owner of the patent. It is true that the principle of reduction of the profits of the defendant infringer by the deduction of manufacturer's profits, when the patented improvement was a separable part of the entire structure has been thought applicable in two cases to a reduction of damages based upon loss of the complainant's profits, when the patented improvement was a distinct and separable part of the whole structure which the complainant made. The facts of this case have no resemblance to those cases. There is no apparent reason why the loss which was suffered by the deliberate act of the defendant, which deprived the complainant of trade in the special articles of manufacture, every expense of its business going on as before to its full extent, should not be the actual profit which it would have made upon the sale of a number of boxes which it was prevented from selling. — *National v. Elsas*, 86 Fed. 917; 30 C. C. A. 487.

Warren v. Keep, 155 U. S. 265; *Buerk v. Imhauser*, Fed. Cas. 2,107; *Rubber Co. v. Goodyear*, 9 Wall. 788; *Robertson v. Blake*, 94 U. S. 728.

§ 831. Deductions — Rules for.

The proper rule for determining the profits of defendant upon a patented attachment is to deduct from the full profits arising therefrom a proportional amount of the expenses of the business. — *Tremaine v. Hitchcock*, 90 U. S. 518; 26 L. Ed. 97.

Complainant proved from testimony given by defendant in another case the profits that defendant had made in his business. Defendant neither proved any deductions therefrom nor in any way explained that testimony, but on the appeal undertook to show certain deductions. *Held*: The defendant could have made any explanation of his testimony he desired, and had the question been raised before the master the complainants would have had an opportunity to show that the profit was the same during the entire infringing period. — *Cimiotti v. Bowsky*, 143 Fed. 508; 74 C. C. A. 617.

§ 832. Deductions — Salaries.

The master properly refused to deduct extraordinary salaries which appeared on the books, being satisfied they were dividends of profit under another name. — *Rubber v. Goodyear*, 76 U. S. 788; 19 L. Ed. 566.

When and when not to be computed on accounting. — *Seabury v. Am Ende*, 152 U. S. 561; 38 L. Ed. 553; 14 S. Ct. 683.

§ 833. Deductions — Miscellaneous.

While repairs and wear and tear should be taken into account, value of materials bought for the purpose of the infringement are not deductible items. — *Rubber v. Goodyear*, 76 U. S. 788; 19 L. Ed. 566.

Defendants added a twenty per cent. profit to the cost of lumber used in the infringement, and the court said: It is only necessary to state the claims

to show its preposterousness. — *Elizabeth v. American*, 97 U. S. 126; 24 L. Ed. 1000.

The complainant, as territorial assignee, was entitled to a certain proportion of the profit. Defendant, in mitigation of damages undertook to limit recovery to such proportion. *Held*: Not good. — *Elizabeth v. American*, 97 U. S. 126; 24 L. Ed. 1000.

The defendant will not be allowed to diminish the show of profits by putting in the unconscionable claims for personal services or other inequitable deductions. — *Elizabeth v. American*, 97 U. S. 126; 24 L. Ed. 1000.

Rubber Co. v. Goodyear, 9 Wall. 788.

Interest on plant when other manufacture conducted. — *Seabury v. Am Ende*, 152 U. S. 561; 38 L. Ed. 553; 14 S. Ct. 683.

The item of commissions paid on sales was a proper credit. The profits recoverable are only those which were actually made, and the general burden is upon the plaintiff to show what those profits were. The fair and reasonable expenses incident to the sale of the infringing devices should be deducted from the gross profit shown by the evidence. — *Kisinger-Ison v. Bradford*, 123 Fed. 91; 59 C. C. A. 221.

Tremaine v. Hitchcock, 90 U. S. 518; *Tilghman v. Proctor*, 125 U. S. 151.

§ 834. Definition.

“Profits” is the gain made upon any business or investment, when both the receipts and payments are taken into the account. — *Rubber v. Goodyear*, 76 U. S. 788; 19 L. Ed. 566.

People v. Super. Niag. 4 Hill, 23.

In patent nomenclature, what the infringer makes is “profits;” what the owner of the patent loses by such infringement is “damages.” — *Diamond v. Brown*, 166 Fed. 306; C. C. A.

§ 835. Interest.

In making up the decree, interest was added from the date of the master's report on the balances found due after the ascertained deductions had been made and this is assigned as error. As a general rule, a patentee is not entitled to interest on profits made by an infringer. The reason is that profits are regarded in the light of liquidated damages. *Parks v. Booth*, 102 U. S. 106. But in many of the cases it is said that circumstances may arise in which it would be proper to add interest. *Mowry v. Whitney*, 14 Wall. 653; *Littlefield v. Perry*, 21 Wall. 230. Here, as has been seen, in effect, the original decrees rendered were affirmed to the extent of the present recoveries. The cases were only sent back to ascertain how much should be deducted from those decrees for errors in the accounts as then stated. If the decrees had been entered originally for the present amounts the patentee would have been entitled to interest from the date of the decree. *R. R. v. Turrill*, 101 U. S. 836. Under these circumstances, it seems to us not at all inequitable to allow interest on the corrected amounts from the date of the master's report. — *Railroad v. Turrill*, 110 U. S. 301; 28 L. Ed. 154; 4 S. Ct. 5.

Interest is allowed, in the absence of special circumstances from the date of filing the report of the master. — *Consolidated v. Crosby*, 141 U. S. 441; 35 L. Ed. 809; 12 S. Ct. 49.

Silsby v. Foote, 61 U. S. 378; *Mowry v. Whitney*, 81 U. S. 620; *Littlefield v. Perry*, 88 U. S. 205; Act July 8, 1870, Ch. 230, sec. 55; *Parks v. Booth*, 102 U. S. 96; *Root v. Railway*, 105 U. S. 189; *Railroad v. Turrill*, 110 U. S. 301.

§ 836. Master in Chancery.

The conclusions of the master have every reasonable presumption in their favor, and are not to be set aside or modified, unless there clearly appears to have been error or mistake on his part. — *Tilghman v. Proctor*, 125 U. S. 136; 31 L. Ed. 664; 8 S. Ct. 894.

Medsker v. Bonebrake, 108 U. S. 66; *Donnell v. Columbia*, 2 Sumn. 366; *Mason v. Crosby*, 3 Woodb. & M. 258; *Paddock v. Commercial*, 104 Mass. 521; *Richards v. Todd*, 127 Mass. 167.

The report of a master is merely advisory to the court, which it may accept and act upon in whole or in part, according to its own judgement as to the weight of the evidence. Yet in dealing with exceptions to such reports "the conclusions of the master, depending upon the weighing of conflicting testimony, have every reasonable presumption in their favor and are not to be set aside or modified unless there clearly appears to have been error or mistake on his part." — *Boesch v. Gräff*, 133 U. S. 697; 33 L. Ed. 787; 10 S. Ct. 378.

Kimberly v. Arms, 129 U. S. 512; *Tilghman v. Proctor*, 125 U. S. 136.

Exceptions to master's report raised for the first time in the Supreme Court will not be entertained. — *Topliff v. Topliff*, 145 U. S. 156; 36 L. Ed. 658; 12 S. Ct. 825.

McMicken v. Perin, 59 U. S. 507.

The findings of the referee were marked "approved" by counsel for both parties. *Held*: After all this, we perceive no standing ground for an exception to the admission of evidence embodied in the agreed statement of facts. — *Deering v. Kelly*, 103 Fed. 261; 43 C. C. A. 225.

If, in the progress of the references, the parties neglect or omit to bring before the master all the facts bearing upon the matters referred, and necessary to the correct conclusion by the court, they are in default. And by this default the court is deprived of the aid sought in ordering the reference. If the master omit or neglect to report all the facts produced before him bearing upon the matters referred to, he is in default. The parties are put to a disadvantage, and the report should be recommitted, unless the parties supply the omission by stipulation. It is true that in some of the circuit courts a loose practice has grown up, and exceptions to a master's report are entertained, dealing with facts to which his attention was never called. This practice does not commend itself. It frequently operates a surprise, and it shuts the door to any explanation. It gives room for the display of skill and strategy on the part of ingenious counsel. It may secure success at the expense of right. When there exists a rule of practice, inculcated and approved by recognized authority, it should be followed. To prevent misapprehension, it is best to state that we do not require the conclusions of the master on matters of law to be first excepted to before him. This is unnecessary. — *Gay v. Camp*, 68 Fed. 67; 15 C. C. A. 226.

2 Dan. Ch. Pr. 1314, and cases cited.

Every reasonable presumption is in favor of a master's report based on oral testimony, and it will not be set aside or modified unless there clearly

appears to have been error or mistake. — *Fullerton v. Anderson-Barngrover*, 166 Fed. 443; C. C. A.

Tilghman v. Proctor, 125 U. S. 136; *Callaghan v. Myers*, 128 U. S. 666; *Camden v. Stuart*, 144 U. S. 118; *Walk. Pat.* § 725.

The question whether a license fee was established is one of fact, and as the master has found a yearly license fee, and the Circuit Court has overruled defendant's exceptions, we are not disposed to disturb the finding. — *Diamond v. Brown*, 166 Fed. 306; C. C. A.

Warren v. Keep, 155 U. S. 265.

§ 837. Measure of — Actual Gains.

Under instruction from the circuit court, the master charged the defendant, not only with his actual savings, but with all he might possibly have made, and interest thereon. *Held*: that the profits in equity must be limited to the actual profits and must not be regarded as liquidated punitive damages. *Livingston v. Woodworth*, 15 How. 546; 14 L. Ed. 809.

It is clear that a patentee is entitled to recover the profits that have been actually realized from the use of his invention, although, from other causes, the general business of the defendant, in which the invention is employed, may not have resulted in profits, as where it is shown that the use of his invention produced definite saving in the expense of manufacture. On the contrary, though the defendant's general business be ever so profitable, if the use of the invention has not contributed to the profits, none can be recovered. — *Elizabeth v. American*, 97 U. S. 126; 24 L. Ed. 1000.

Mowry v. Whitney, 14 Wall. 434; *Cawood Pat.* 94 U. S. 695.

The infringer is liable for actual, not for possible gains. The profits, therefore, which he must account for, are not those which he might reasonably have made, but those which he did make, by the use of plaintiff's invention; or, in other words, the fruits of the advantage which he derived from the use of that invention, over what he would have had in using other means then open to the public and adequate to enable him to obtain an equally beneficial result. If there was no such advantage in his use of the plaintiff's invention, there can be no decree for profits, and the plaintiff's only remedy is by an action at law for damages. But if the defendant gained an advantage by using the plaintiff's invention, that advantage is the measure of the profits to be accounted for, even if for other causes the business in which the invention was employed did not result in profits. — *Tilghman v. Proctor*, 125 U. S. 136; 31 L. Ed. 664; 8 S. Ct. 894.

Cawood Pat. 94 U. S. 710; *Mevs v. Conover*, 11 O. G. 1112; *Elizabeth v. Pavement*, 97 U. S. 138; *Root v. Railway*, 105 U. S. 189; *Thomson v. Wooster*, 114 U. S. 104.

Upon a bill in equity the plaintiff is entitled to recover the amount of gains and profits that the defendants have made by the use of the invention. — *Tilghman v. Proctor*, 125 U. S. 136; 31 L. Ed. 664; 8 S. Ct. 894.

Livingston v. Woodworth, 56 U. S. 546; *Dean v. Mason*, 61 U. S. 198; *Rubber v. Goodyear*, 76 U. S. 788; *Mowry v. Whitney*, 81 U. S. 620; *Littlefield v. Perry*, 88 U. S. 205; *Mason v. Graham*, 90 U. S. 261; *Railroad v. Turrill*, 94 U. S. 695; *Mevs v. Conover*, 11 O. G. 1111; *Elizabeth v. Pavement*, 97 U. S. 126; *Root v. Railway*, 105 U. S. 189.

It appearing that the defendant's valve derived its entire value from the use of the invention covered by the patent in suit, and that the entire value of the defendant's valve, as a marketable article, was properly and legally

attributable to the invention of plaintiff, he is entitled to recover the entire profit of the manufacture and sale of the valves. — *Consolidated v. Crosby*, 141 U. S. 441; 35 L. Ed. 809; 12 S. Ct. 49.

Elizabeth v. Nicholson, 97 U. S. 126; *Root v. Railway*, 105 U. S. 189; *Garretson v. Clark*, 111 U. S. 120; *Callaghan v. Myers*, 128 U. S. 617; *Hurlbut v. Schilling*, 130 U. S. 456.

In equity the profits which the complainant seeks to recover must be shown to have been actually received by the defendant; in other words, the fruits of the advantage which he derived from the use of that invention over what he would have had in using other means open to the public and adequate to enable him to obtain an equally beneficial result. — *Coupe v. Royer*, 155 U. S. 565; 39 L. Ed. 263; 15 S. Ct. 199.

Tilghman v. Proctor, 125 U. S. 137; *Keystone v. Adams*, 151 U. S. 139.

In a suit in equity for infringement of a patent, the ground upon which profits are recovered is that they are the benefits which have accrued to the defendants from their wrongful use of the plaintiff's invention, and for which they are liable *ex aequo et bono*, to like extent as a trustee would be who had used the trust property for his own advantage. The defendants in any such suit are therefore liable to account for such profits only as they have accrued to themselves from the use of the invention, and not for those which have accrued to another, and in which they have no participation. — *Belknap v. Schild*, 161 U. S. 10; 16 L. Ed. 599; 16 S. Ct. 443.

Elizabeth v. American, 97 U. S. 126; *Root v. Railway*, 105 U. S. 189; *Tilghman v. Proctor*, 125 U. S. 136; *Keystone v. Adams*, 151 U. S. 139; *Coupe v. Royer*, 155 U. S. 565.

We think the evidence fully warrants the conclusion that the entire value of the infringing machine made and sold by the defendant, was due to the invention covered by the patent in suit, and therefore, the plaintiff was entitled to the whole profits realized. — *Sayre v. Scott*, 55 Fed. 971; 5 C. C. A. 366.

Elizabeth v. Pavement, 97 U. S. 126; *Crosby v. Consolidated*, 141 U. S. 441.

Was there evidence of the defendant's actual profit? There is nothing in the record to show that the master could take account in detail in the ordinary way in which accounts are taken, and so a general estimate was necessary. — *Doten v. City of Boston*, 138 Fed. 406; 70 C. C. A. 308.

Suffolk v. Hayden, 3 Wall. 315.

If every employee invariably worked with perfect memory, accuracy, and good judgment, labor-saving devices would be fewer and less important than they now are. That the value of a labor-saving device is based largely, or even wholly, upon the fact that those who work are frail and imperfect human creatures, and not beings of perfect efficiency, wisdom and honesty, does not lessen the value of the device or the profit arising therefrom. The cash register and the watchman's time clock, for example, are deemed patentable, yet they are used to protect an employer not only from negligence, but from the dishonesty of his employees. A labor-saving device is deemed patentable if the weakness or carelessness or dishonesty of the employee, against which the patented device is effective, is recognized as a common failing, and an appreciable source of danger to employers in like case. In the *Cawood Patent*, 94 U. S. 695, the patentee was allowed to recover as profits the saving in repairing broken rails by the patented device; yet these rails had doubtless been damaged by improper operation as well as by ordinary wear and tear. Probably no sharp line can be drawn between

the two cases. Giving the master's report its fair interpretation, his statement that the cause of the defendant's damage was based upon carelessness, imperfect operation, and miscalculation, amounts to a statement that it was based upon human frailty. Under the old system the damage was caused by ordinary wear and tear, sometimes the result of negligence or miscalculation, sometimes the result of wind, current, or tide, setting the ferryboat into an unexpected position or giving it unexpected speed. This damage was frequent and usual, and could be most cheaply prevented by the patent in suit. For these reasons we think that the saving thus made by the defendant was recoverable in this accounting. — *Doten v. City of Boston*, 138 Fed. 406; 70 C. C. A. 308.

For a most remarkable holding on what is not a sufficient showing that, but for the infringement of a defendant, the complainant would have made the actual gains of the defendant, this opinion is commended. The arguments as to "awareness" and that "the field was full of competition selling the drill of other infringers" are supremely unique. Any attempt to excerpt from this opinion of 18 pages would be futile. Attention should be called to the fact that Judge Richards dissents, and also to the opinion of Judge Severens in *Brennan v. Dowagiac*, 162 Fed. 472. — *McSherry v. Dowagiac*, 160 Fed. 948; 89 C. C. A. 26.

Possibly in a case like this, where there have been a number of infringers, in view of the difficulty of proving in a suit against one that the sales made by him were lost to the patentee, if a reasonable royalty is recoverable, the prudent course is to sue for such royalty instead of the profits which would have accrued to the patentee had he made the sales. This course was not taken by the appellee. It staked its case on the right to recover profits lost by it and prepared it along that line. — *McSherry v. Dowagiac*, 163 Fed. 34; 89 C. C. A. 512.

Note: This is from opinion by Cochran, D. J., denying petition for rehearing in *McSherry v. Dowagiac*, 160 Fed. 948, supra. So far as appears from the report of the case, this opinion is by Judge Cochran sitting alone; and it would therefore seem that this pronouncement of a new rule of profits lacks the weight of an appellate decision. The statement above quoted is startling. How a patentee who has preserved his monopoly, granting no licenses, who has been most wantonly and persistently infringed, could "sue for such royalty instead of the profits," is a proposition quite without the experience of the ordinary practitioner.

A patentee may withhold the exploiting of his patent in a particular territory, or he may not be able at the time to extend his business therein. But this gives no right to the infringer to invade the territory and anticipate the sales which the patentee might make when he should desire and be able to carry his invention there for a profit which is legitimately his own. But this, while it might be an answer to the suggestion made by the master, is not relevant to such a proceeding as this. The fact that the owner of a patent does not exercise his right or cannot at the time do so to the full, gives no license to another, and the latter is liable for infringement, to the same extent as if the owner were exercising his right to the utmost. The owner has the same right as he has to any other property, which he may put to use or not as he chooses; and in such case the rule is always that, if a stranger without right seizes and uses it, he is bound to pay for such use, and it is no answer to him to say that the owner was doing nothing with it. If it be true, as has often been declared, that the exclusive right of a patentee is property, for the protection of which the public faith is pledged, it should have the same immunity from invasion, and its violation should be attended

with the same consequences as in the case of other species of property. — *Brennan v. Dowagiac*, 162 Fed. 472; 89 C. C. A. 392.

It seems to have been contended before the master by the appellant, while engaged in the endeavor to ascertain the profits, that in manufacturing and selling the infringing drills it had employed other patents, which had enhanced the value of the drills and the price at which they were sold, and reference was made to certain patents belonging to the plaintiff. These patents had been set out in the bill and infringement thereof charged. But they had been declared void by the circuit court, by a decree which remains unreversed and not appealed from. They should, therefore, have been regarded as a part of the patented art. There was no proof which could have justified the master in the conclusion that any other invention than that of the Peckham patent was present in the drills which constituted the infringement. Nor did the master find that there was any other patent involved in the infringing drills which was entitled to share in the profits than those belonging to the plaintiff which had been held void. He specified those as laying the foundation for applying the doctrine of *Garretson v. Clark*, 111 U. S. 120, and other like cases. The fact is that the conditions assumed for the statement of the rule in the case referred to did not exist. The present case in its facts is in closer analogy to *Elizabeth v. Pavement*, 97 U. S. 126; *Goulds v. Cowing*, 105 U. S. 253; *Crosby v. Safety Valve*, 141 U. S. 441; *Canda v. Michigan*, 152 Fed. 178. — *Dowagiac v. Superior*, 162 Fed. 479; 89 C. C. A. 399.

Wilson v. Rousseau, 4 How. 646; *Grant v. Raymond*, 6 Pet. 218; *Bement v. National*, 186 U. S. 70; *Heaton v. Eureka*, 77 Fed. 288.

§ 838. Measure of — Entire Profits.

When the entire profits of a business or undertaking result from the use of the invention, the patentee will be entitled to recover the entire profits, if he elects that remedy. And in such a case the defendant will not be allowed to diminish the show of profits by putting in unconscionable claims for personal services or other inequitable deductions. — *Elizabeth v. American*, 97 U. S. 126; 24 L. Ed. 1000.

Rubber Co. v. Goodyear, 9 Wall. 788.

If the profits upon the whole article are clearly due to the patented part, which gives to the article its marketable value, they are the measure of recovery. — *Untermeyer v. Freund*, 58 Fed. 205; 7 C. C. A. 183.

Mfg. Co. v. Cowing, 105 U. S. 253.

Two rules governing the question of profits are laid down by the Supreme Court. The first of these rules (*Elizabeth v. Nicholson*, 97 U. S. 126) is as follows: Where profits are made by an infringer, by the use of an article patented as an entirety, the infringer is responsible to the patentee for the whole of such profits, unless it can show — and the burden is on the infringer to show it — that a portion of such profits is the result of some other thing used by him. And the second rule (*Garretson v. Clark*, 111 U. S. 120) is as follows: That where the patent is for an improvement, and not for an entirely new article or product, the burden is on the patentee to show what portion of the infringer's profits is due to the particular patented feature.

Inasmuch as appellant offered no proof, other than the patent itself, tending to show that the profits made by it upon the ladders sold by it were the result of anything else than the use of the ladder patented as an entirety, and inasmuch as no proof was offered by appellee, other than the patent itself, tending to separate or apportion the profits made by the appellant,

by the use of the patent in question, from such profits as might have been due to other features, neither party has attempted to take these cases out of the rule contended for by his adversary — leaving it as the determinative question in these cases whether (the patent only being before us) the rule laid down in the Nicholson case or the rule laid down in the Garretson case, is applicable to the case before us, as the patent has already been upheld and construed by this court.

The new thought in the art of ladder building, embodied in the Murray patent, was the utilizing of the man's weight to adjust the center of gravity. It was a unitary thought, to carry out which the elements already named were only agents; and a unitary thought, though thus carried, makes the ladder thus built a new article within the meaning of the Nicholson case. — *Orr v. Murray*, 163 Fed. 54; 89 C. C. A. 492.

Note: It is thought that this clear and logical statement should prove a contributing factor in the much-needed settlement of the present status of the rule of profits, or, more properly, the rule of evidence of profits.

§ 839. Measure of — Rules.

The decree was entered on the report of the master, for the estimated amount of profits which the defendant, with reasonable diligence, might have realized; not what, in fact he did realize. This instruction was erroneous. The rule in such a case is, the amount of profits received by the unlawful use of the machine, as this in general, is the damage done to the owner of the patent. It takes away the motive of the infringer of patented rights, by requiring him to pay the profits of his labor to the owner of the patent. Generally this is sufficient to protect the rights of the owner; but where the wrong has been done, under aggravated circumstances, the court has the power, under the statute, to punish it adequately, by an increase of the damages. — *Dean v. Mason*, 61 U. S. 198; 15 L. Ed. 876.

Livingston v. Woodworth, 15 How. 546.

The circuit court decreed that the defendant was liable "for all the profits made in violation of the rights of the complainants under the patent aforesaid, by respondents, by the manufacture, use or sale of any of the articles named in said bill." This was in accordance with the rule in equity cases established by this court. — *Rubber v. Goodyear*, 76 U. S. 788; 19 L. Ed. 566.

Livingston v. Woodworth, 15 How. 546; *Dean v. Mason*, 20 How. 198.

For history of rule see *Root v. Ry.*, 105 U. S. 189; 26 L. Ed. 975.

The rule in equity requiring an infringer to account for gains and profits which he has made from the use of a patented invention, instead of limiting the recovery to the amount of royalties paid to the patentee by third persons, has been constantly upheld under the Act of 1870, which expressly affirms the defendant's liability to account for profits, as well as authorizes a court sitting in equity to award and to treble any damages that the plaintiff has sustained in excess of the defendant's profits. — *Tilghman v. Proctor*, 125 U. S. 136; 31 L. Ed. 664; 8 S. Ct. 894.

R. S. 4921; *Birdsall v. Coolidge*, 93 U. S. 64; *Marsh v. Seymour*, 97 U. S. 348; *Root v. Railway*, 105 U. S. 189; *Goulds v. Cowing*, 105 U. S. 253; *Garretson v. Clark*, 111 U. S. 120; *Black v. Thorne*, 111 U. S. 122; *Birdsall v. Shaliol*, 112 U. S. 485; *Thomson v. Wooster*, 114 U. S. 104.

§ 840. Measure of — Savings by Use.

In the ascertainment of profits made by an infringer of a patented invention, the rule is a plain one. The profits are not all he made in the business

in which he used the invention, but they are the worth of the advantage he obtained by such use; or in other words, they are the fruits of that advantage. Nor does it follow that the unprofitableness of the defendant's business in any degree lessens that saving, for without it his loss would have been so much the more. — *Mevs v. Conover*, 131 U. S. cxlii, App.; 23 L. Ed. 1008.

Mowry v. Whitney, 14 Wall. 651.

Method of computation stated and approved in *U. S. v. Berdan*, 156 U. S. 552; 29 L. Ed. 530; 15 S. Ct. 420.

In proving profits, it is necessary to show a saving by the use of the infringing tool over the cost of operating any other tool which defendant was free to use. — *Hohorst v. Hamburg-American*, 91 Fed. 655; 34 C. C. A. 39.

§ 841. Measure of — Trustee ex Maleficio Rule.

An infringer is a trustee ex maleficio for the owner of the exclusive rights protected by the patent; and a trustee who has confused the profits made by the use of the trust property with those made from his own property, and commingled them so that they cannot be segregated, must account for the whole. On the other hand, such a rule would work unjustly in many cases, — as where the patented feature is of an insignificant part of the machine or article; and it is probably because of its manifest inequity in such cases that the courts have placed upon the complainant the burden of proof. — *Wales v. Waterbury*, 101 Fed. 126; 41 C. C. A. 250.

Lupton v. White, 15 Ves. 432; *Hart v. Ten Eyck*, 2 Johns. Ch. 108, *Central v. Connecticut*, 104 U. S. 54.

In the present case the infringer's conduct has been such as to preclude the belief that it has derived no advantage from the use of the plaintiff's invention, as the master well said. In these circumstances, upon whom is the burden of loss to fall? We think the law answers this question by declaring that it shall rest upon the wrongdoer, who has confused his own with that of another so that neither can be distinguished. It is a bitter response for the court to say to the innocent party, "You have failed to make the necessary proof to enable us to decide how much of these profits are your own;" for the party knows, and the court must see, that such a requirement is impossible to be complied with. — *Brennan v. Dowagiac*, 162 Fed. 472; 89 C. C. A. 392.

Hart v. Ten Eyck, 2 Johns. Ch. 62; *Wales v. Waterbury*, 101 Fed. 126; *Wyllie v. Ellice*, 6 Hare. 505; *Bailey v. Bailey*, 67 Vt. 494; *Mast v. Superior*, 154 Fed. 45; *The Idaho*, 93 U. S. 575; *Smith v. Township*, 150 Fed. 257; *Smith v. Motley*, 150 Fed. 266.

Note: This is distinctly and properly a cancellation of the holding of this court in *McSherry v. Dowagiac*, 160 Fed. 948.

The infringement was not accidental. The defendant was all the while informed of the patent, and knew that, if he did not succeed in defeating the patent, it would be obliged to account for the profits and damages. It took the risk of confusion, and the loss must fall upon the wrongdoer, rather than the innocent party. It is as clear a case as could be instanced for the application of the rule stated and applied by this court in previous cases and by other courts in a great variety of instances where the facts indicated the fitness of its application. In another case decided at this session (*Brennan v. Dowagiac*, 162 Fed. 472) we referred to several cases upon this subject, and others are cited in our opinion in *Smith v. Motley*, 150 Fed. 266. — *Dowagiac v. Superior*, 162 Fed. 479; 89 C. C. A. 399.

The defendant put every obstacle in the way of arriving at any measure of profits, failed to produce records and books, and withheld all information possible on examination. The master made the best computation possible, and made all deductions that the evidence disclosed. The appellate court revised these figures, materially increased the amount of the profits found, decreased the allowances for selling, and *held*: His failure or refusal to produce the most satisfactory evidence leaves his case exposed to the presumption that if produced it would tell against him, and compels the court to rely on the less definite and certain evidence which the record may supply. This is a rule by which the courts are governed. If they fail to observe it, the rights of parties may utterly fail of protection. — *Yesbera v. Hardesty*, 166 Fed. 120; C. C. A.

Rubber Co. v. Goodyear, 9 Wall. 788; *Lupton v. White*, 15 Ves. 432; *Hart v. Ten Eyck*, 2 Johns. Ch. 62; *Mast v. Superior*, 154 Fed. 45; *Brennan v. Dowagiac*, 162 Fed. 472; *Dowagiac v. Superior*, 162 Fed. 479; *Wales v. Waterbury*, 101 Fed. 126.

§ 842. Measure of — Miscellaneous Rules.

The profits arising from the infringement of the combination are those of the entire combination, and are not mitigated by the fact of certain elements being old. — *Elizabeth v. American*, 97 U. S. 126; 24 L. Ed. 1000.

It was quite right for the circuit court, when these cases were sent back, to direct the master to ascertain from the old evidence, if possible, and, if not, from new, how much should be deducted from the old decrees on account of the erroneous recoveries. The true way of determining this clearly was to find out what part of the profits for which the original decrees were rendered had been made by the use of the non-infringing machines. — *Railroad v. Turrill*, 110 U. S. 301; 28 L. Ed. 154; 4 S. Ct. 5.

Payments made for infringement are incompetent proof of a fixed royalty. — *Cornley v. Marekwold*, 131 U. S. 159; 33 L. Ed. 117; 9 S. Ct. 744.

Rude v. Westcott, 130 U. S. 152.

If a prior patent existed covering substantially the invention in suit and it was held by a third party, whether it could be regarded as open to the infringer the court declined to say. — *McCreary v. Pennsylvania*, 141 U. S. 459; 35 L. Ed. 817; 12 S. Ct. 40.

Where plaintiff relied on later of two patents covering substantially the same device it was held that the earlier patent must be deemed open to defendant. — *McCoy v. Pennsylvania*, 141 U. S. 459; 35 L. Ed. 817; 12 S. Ct. 40.

In estimating profits made by an infringer the comparison must be between the patented invention and what was known and open to the public at and before the date of the patent. — *McCreary v. Pennsylvania*, 147 U. S. 459; 35 L. Ed. 817; 12 S. Ct. 40.

The profits made by the defendant cannot be increased or diminished by any act on the part of the plaintiff; and the amount of them is not affected by the question whether during the same time the plaintiff did or did not use the patented invention. — *Consolidated v. Crosby*, 141 U. S. 441; 35 L. Ed. 809; 12 S. Ct. 49.

Profits of other manufacturers cannot be taken as a measure between parties to suit. — *Keystone v. Adams*, 151 U. S. 139; 38 L. Ed. 103; 14 S. Ct. 295.

No time for payment being named, payment is due for each article as delivered. — *U. S. v. Berdan*, 156 U. S. 552; 39 L. Ed. 530; 15 S. Ct. 420.

Citing and discriminating, *Packet Co. v. Sickles*, 51 U. S. 440.

When a contract establishing a license fee has been considered and abandoned, and a subsequent agreement is made fixing no license fee the former abandoned contract does not determine the terms or conditions of the new contract entered into. — *U. S. v. Berdan*, 156 U. S. 552; 39 L. Ed. 530; 15 S. Ct. 420.

That evidence to show the difference in cost between a manufacturer using the patent and one not using it, is not competent proof to establish a measure of profits, see — *Robbins v. Illinois*, 81 Fed. 957; 27 C. C. A. 21.

Mfg. Co. v. Adams, 151 U. S. 139; *Coupe v. Royer*, 155 U. S. 565; *Belknap v. Schild*, 161 U. S. 10.

The witness was the president of the complainant and the cost estimate was one made by him as the result of his experience in his own factory; and the principal objection now urged is that the estimate of what the cost would be at the complainant's factory is no criterion of the cost in defendant's factory. Perhaps it would not be the best criterion if the actual cost to defendant had been shown; but the defendant did not offer to prove that, although the proof was under his own control, nor did it offer any evidence to prove that the estimate given by the complainant's witness was incorrect. Under such circumstances we think the proof was admissible. — *Mast v. Superior*, 154 Fed. 45; 83 C. C. A. 157.

The total amount of appellant's crop during the years of infringement was definitely shown by its own books. The market prices during those years were ascertained. Here were definite figures upon which to calculate the profits. The law requires no more than reasonable certainty in such a case. — *Fullerton v. Anderson-Barngrover*, 166 Fed. 443; C. C. A.

Suffolk v. Hayden, 3 Wall. 315; *Doten v. City*, 138 Fed. 406; *Bigelow v. Dobson*, 10 Fed. 386.

In order that the royalty found by the master may be accepted as a measure of damages against a defendant who is a stranger to the license proved before the master, the royalty must be paid before the infringement took place. — *Diamond v. Brown*, 166 Fed. 306; C. C. A.

Rude v. Westcott, 130 U. S. 152.

§ 843. Segregation — Burden of Proof.

The master refused to allow the profits due to elements not patented which entered into the composition of the patented articles. There may be cases in which such an allowance would be proper. This is not one of them. The manner in which defendant's books were kept renders such an account impossible. — *Rubber v. Goodyear*, 76 U. S. 788; 19 L. Ed. 566.

In disallowing the profits upon the combined buckle and lever, he did so apparently in deference to the rule that, where the articles which have been made and sold by the infringer contain not the patented invention alone, but other inventions and improvements, the profits for which he is to account

are not the total profits but those only which are attributable to the presence of the patented invention. This has always been the rule, and it is manifestly a just one upon principle; but it is often difficult of practical application, and the courts have sometimes applied it so that it has not produced an equitable result. In many cases, where it is obvious that the patented invention has contributed a great part of the profits realized from selling the infringing article or apparatus embodying unpatented features, it is practically impossible for the complainant to establish affirmatively the proportionate part. The present case is an illustration. Yet there is no way by which the complainant can establish the proportion. As the rule has been applied in some of the adjudged cases, there could be no recovery against the infringer to account for the whole profits, even though it could not be proved that the commercial value of the article was wholly due to the patented feature. — *Wales v. Waterbury*, 101 Fed. 126; 41 C. C. A. 250.

The respondents urge that these complainants are not entitled to recover the entire profits thus ascertained, because these infringing devices may be said to be not only infringements of complainants' patent but also the Mayo patent, and the burden is on the complainants to separate the profits attributable to respondents' infringements of the patent in suit from those attributable to the use of the Mayo invention. It has been the uniform practice of the courts to refuse to determine such collateral questions in suits where the validity and scope of a third party's patent are not directly put in issue. — *Brinton v. Paxton*, 134 Fed. 78; 67 C. C. A. 204.

McCreary v. Pennsylvania, 141 U. S. 459.

The complainants failed to establish just what portion of the profits were due to the infringing mechanism. — *Brinton v. Paxton*, 134 Fed. 78; 67 C. C. A. 204.

Garretson v. Clark, 111 U. S. 121.

How much of the twenty-eight and one-half cents, the difference between the cost and selling price of defendant's new appliance, was due to the improvement covered by claim 1? The record fails to show. This was necessary. — *Baker v. Crane*, 138 Fed. 60; 70 C. C. A. 486.

Seymour v. McCormick, 16 How. 480; *Garretson v. Clark*, 111 U. S. 120; *Keystone v. Adams*, 151 U. S. 139.

There is no evidence that the improvements introduced any new function or result, nor any satisfactory proof that the machines were by reason thereof more convenient or practical for the user or more commercially successful. In short, there is no evidence that the patented improvements were a dominant feature of the machine, or contributed to its sale, or created a new article, or obviated prior objections in practical operation, or which shows that the sales may not have depended upon advertising, charged accounts, and other mere business methods. Furthermore, there is evidence that other machines, not containing these patented improvements, were on the market, and were salable. In these circumstances, the defendant is only liable for profits realized from the use of that part of the patented invention which is new, and which he has wrongfully appropriated, and the complainant must furnish evidence from which the profits may be thus apportioned, or he cannot recover. — *Force v. Sawyer-Boss*, 143 Fed. 894; 75 C. C. A. 102.

Ingels v. Mast, 6 Fish. P. C. 415; *McCreary v. Pennsylvania*, 141 U. S. 459; *Brickill v. Mayor*, 112 Fed. 65.

But before it (the rule of segregation) can be applied, it is incumbent on the defendant to prove that some substantial part of the peculiarities of

the former patents (prior art) were embodied in the patented articles sold, and that they were of such a character that they probably contributed to the profits. *Elizabeth v. Pavement Co.* 97 U. S. 126. On this being shown, the burden of proof is devolved upon the party seeking to recover the profits to prove what part of the entire profits are due to the use of his own invention. He must make the separation of values and show to the court how much is his rightful proportion. — *Canda v. Michigan*, 152 Fed. 178; 81 C. C. A. 420.

That while the burden is upon complainant to prove that the entire profit upon an infringing article is due to the patented improvement, when such proof has been adduced and the burden of rebutting such proof is taken by the defendant, a finding of a master upon such proofs will not be disturbed in the absence of obvious error, see — *McSherry v. Dowagiac*, 160 Fed. 948; 89 C. C. A. 26.

§ 844. Segregation — Failure to Make.

The bill was taken pro confesso. Defendants made no proofs. Plaintiff failed to segregate or to eliminate common matters under the ordinary rules. Defendant merely objected to master's report and assigned errors. The court seems to hold that the defendant having had his day in court and having failed to defend his rights he is bound by the proofs of plaintiff if they are within the pleadings and pursuant to the decree and not manifestly erroneous; and that affidavits to the contrary will not be heard in this court. — *Thomson v. Wooster*, 114 U. S. 104; 29 L. Ed. 105; 5 S. Ct. 788.

Complainant may show profits of defendant to prove his damages, but where infringed device was only a part of defendant's machine, in the absence of proof and segregation, only nominal damages can be assessed. — *Keystone v. Adams*, 151 U. S. 139; 38 L. Ed. 103; 14 S. Ct. 295.

Seymour v. McCormick, 57 U. S. 480; *Rubber Co. v. Goodyear*, 76 U. S. 788; *Mowry v. Whitney*, 81 U. S. 620; *Elizabeth v. Nicholson*, 97 U. S. 126; *Garretson v. Clark*, 111 U. S. 120; *Tilghman v. Proctor*, 125 U. S. 136.

The complainant claimed as damages the entire profit of defendant and failed and refused to segregate any portion, although he well understood defendant's position. Having taken such position and insisted upon such theory of damages he cannot have the matter referred back to prove his damages under a different theory. — *Mosher v. Joyce*, 51 Fed. 441; 2 C. C. A. 322.

That failure to segregate according to the rule in *Garretson v. Clark*, is fatal, see — *Robbins v. Illinois*, 81 Fed. 957; 27 C. C. A. 21.

§ 845. Segregation — General Rules.

When a patent is for an improvement and not for an entirely new machine or contrivance, the patentee must show in what particular his improvement has added to the usefulness of the machine or contrivance. He must separate its results distinctly from those of the other parts, so that the benefits derived from it may be distinctly seen and appreciated. The rule on this head is aptly stated by Mr. Justice Blatchford in the court below: "the patentee" he says, "must in every case give evidence, tending to separate or apportion the defendant's profits and the patentee's damages between the patented feature and the unpatented features, and such evidence must be reliable and tangible, and not conjectural or speculative; or, he must show, by equally reliable and satisfactory evidence, that the profits and damages are to be calculated on the whole machine, for the reason that the entire

value of the whole machine, as a marketable article, is properly and legally attributable to the patented feature." — *Garretson v. Clark*, 111 U. S. 120; 28 L. Ed. 371; 4 S. Ct. 291.

Where patent covers only a part of an improvement upon a general machine profits must be segregated. — *McCreary v. Pennsylvania*, 141 U. S. 459; 35 L. Ed. 817; 12 S. Ct. 40.

Seymour v. McCormick, 57 U. S. 480; *Mowry v. Whitney*, 81 U. S. 620; *Littlefield v. Perry*, 88 U. S. 205; *Elizabeth v. Nicholson*, 97 U. S. 126; *Garretson v. Clark*, 111 U. S. 120.

The present is a case where the defendant would not, and, as we think, could not, have made any profits from manufacturing the holders if it had not used the patented buckle to command a sale for them; and upon the facts is within the second branch of the rule stated in *Garretson v. Clark*, and within other authorities sanctioning a recovery of the total profits derived from the sale of an infringing article embodying unpatented features, when, but for the patented features, it would not have been a marketable article. — *Wales v. Waterbury*, 101 Fed. 126; 41 C. C. A. 250.

Mfg. v. Cowing, 105 U. S. 255; *Hurlbut v. Schillinger*, 130 U. S. 456; *Crosby v. Consolidated*, 141 U. S. 441; *Mosher v. Joyce*, 51 Fed. 441; *Holmes v. Truman*, 67 Fed. 542.

The complainants established that respondents made a certain profit upon the infringing devices of certain amount upon each and every one of them, separate and apart from the mechanism to which it is intended to be attached, and, it appearing that no other picker mechanism upon the market was open to the respondents to use, the master, under the circumstances, was justified from this evidence, together with other facts and circumstances before him, in finding that the total amount of these profits was the amount of complainants' damages. — *Brinton v. Paxton*, 134 Fed. 78; 67 C. C. A. 204.

Mason v. Graham, 90 U. S. 261; *Lattimore v. Hardsocg*, 121 Fed. 986; *Rob. on Pat. sec. 1062*.

The final rule which renders the recovery of substantial damages or material profits a practical impossibility in the great majority of cases.

The master found that the profits derived by the defendant from the sale of train equipments in connection with the patented quick-action valve (the device infringed) were the sum of \$49,533. He also found that the sale of the defendant diverted an equal number of train equipments from the complainants, upon which the complainants would have realized a profit of \$193,978, and the complainants were entitled to that amount as damages caused by the infringement. Exceptions were filed, and the case recommitted to the master "for the purpose of making a computation of profits and damages based upon the sales by the defendant of the quick-action valves of the patent only, separated from those upon the complete equipments." The master interpreted Judge Wheeler's decision as meaning only that the accounting was to be confined to complainant's profits and damages based upon the sales of the "triple-valve structure dissociated from the accessories necessary to constitute a train equipment." Upon this theory the master found that the profits made by the defendant upon these sales were \$36,945, and that the damages sustained by the complainants by loss of profits on diverted sales were \$128,737. This report was confirmed by the circuit judge, and on appeal the entire recovery was swept aside, and nominal damages only awarded, with the following statement of the law:

The proofs show that there was comparatively little demand by railroad

companies for complete automatic air-brake equipments that were not provided with quick-action triple-valves during the period of the infringement. But it is clear that the quick-action attachment was one of secondary importance in automatic brake equipments. It is apparent that the complainants could not have sold any of the patented valves if there had not been embodied in them the devices of the quick-action triple-valve of the earlier Westinghouse patent, or equivalent devices such as the defendant and the Boyden Brake Co. employed in their quick-action valves, and which did not infringe the earlier patent.

The general rule governing recoveries in infringement cases is stated in *Garretson v. Clark*, 111 U. S. 120, in the following language:

"The patentee must in every case give evidence tending to separate or apportion the defendant's profits and the patentee's damages between the patented features and the unpatented features, and such evidence must be reliable and tangible, and not conjectural and speculative; or he must show by equally reliable and satisfactory evidence that the profits and damages are to be calculated on the whole machine, for the reason that the entire value of the whole machine as a marketable article is properly and legally attributable to the patented feature."

Referring to the first branch of this rule, this court said in *Wales v. Waterbury*, 101 Fed. 126:

"This has always been the rule, and it is a satisfactory and just one upon principle; but it is often difficult of practical application, and the courts have sometimes applied it so that it has not produced an equitable result. In many cases, where it is obvious that the patented invention has contributed a great part of the profits realized from selling the infringing article or apparatus embodying unpatented features, it is practically impossible for the complainant to establish affirmatively the proportionate part."

Referring to the theory that an infringer is a trustee *ex maleficio*, and the rule that a trustee who has confused the profits made by the use of a trust property with those made from his own property, and commingled them so that they cannot be segregated, must account for the whole, this court in that case also said:

"Such a rule would work unjustly in many cases, as where the patented feature is of an insignificant part of a machine or article; and it is probably because of its manifest inequity in such cases that the courts placed upon the complainant the burden of proof."

The adjudications in which the latter branch of the rule in *Garretson v. Clark* has been applied are cited in *Wales v. Waterbury*. In all of them, in which the question was as to the basis of profits upon sales, the rule applied was that the profits upon the whole machine or article were allowable only when, but for the patented feature, the machine or article sold by the infringer would not have commanded a market.

The question whether a machine would or would not have been marketable without the patented part is of course a question of fact, but it is one which depends largely upon opinion evidence. The most satisfactory evidence upon the question is that which is afforded by the nature and intrinsic value of the improvement which it introduces into the art or industry in which the machine is employed. . . .

Inasmuch as the complainants did not attempt to separate or apportion the defendant's profits and their own damages between the patented and the unpatented features of the quick-action triple-valve, it was incumbent upon them to prove that the entire value of the defendant's quick-action valve as a marketable article was properly and legally attributable to the patented features. What they did prove, and all they proved was that purchasers of triple-valves generally demanded some form of quick-action valves, and that, except to a very limited extent, purchasers could not be found for

vaives without these features. This falls short of proof that only the patented form could supply the demand, and does not meet the requirements of the second branch of the rule. — *Westinghouse v. New York*, 140 Fed. 545; 72 C. C. A. 61.

Note: As above indicated, this decision brings the rule in *Garretson v. Clark* to its last limit, and practically inhibits a substantial recovery for infringement. In fact, it may now be said that, in most cases, if the complainant cannot secure protection by injunction, he has no remedy against piracy. For note the situation in the present case: There were but two successful emergency valves of the type demanded by the railroads — the Westinghouse and the Boyden. The defendant could use neither. Consequently and perforce the railroads, when they needed the quick-action triple valve equipment, must buy from either Westinghouse or Boyden — or from this defendant who was an infringer of Westinghouse. The railroads *did* buy the number of quick-action valves reported by the master; and the court holds that, because railroads did buy some air-brakes *without* the quick-action valves, the complainant has not made out a case. It is to be noted that the record in this case was made by one of the greatest patent attorneys in this country; and in these circumstances it is evident that with such a rule, a substantial recovery upon an infringed improvement is next to impossible.

In *Westinghouse v. New York*, 140 Fed. 545, Judge Wallace, delivering the opinion of this court, reviewed the authorities on the question of recoveries in infringement cases, and distinguished between those where the patented part was of such paramount importance that it really created the value of the whole article, and those where such part was relatively an unimportant factor in the normal value of the whole, or where such value depended chiefly upon the presence of the unpatented parts. There the court recognized the well-settled rule that in cases of the former class the infringer should be held accountable for all profits, as trustee *ex maleficio*, by reason of having confused profits made by the use of a trust property with those from his own property, and commingled them so that they could not be separated. The court, however, quoted from the opinion in *Wales v. Waterbury*, 101 Fed. 126 as follows: "Such a rule would work unjustly in many cases — as where the patented feature is of an insignificant part of a machine or article; and it is probably because of its manifest inequity in such cases that the courts have placed upon complainant the burden of proof." — *Force v. Sawyer-Boss*, 143 Fed. 894; 75 C. C. A. 102.

Garretson v. Clark, 111 U. S. 120.

We do not by any means impugn the general rules laid down in *Garretson v. Clark*, 111 U. S. 120, and the cases which have followed it, one of which is that, when the infringement consists in making or using articles improved by his own invention, the plaintiff must prove the extent of the enhancement of profits by the use of his own, as distinguished from those due to the article improved. But we are of opinion that the circumstances of this case, first, in that in the patented combination no other invention inheres, and that the combinations are not for improvements merely, but substitutes for essential congeries in a drill, and, secondly that the infringement has been so conducted as to render a distinction of profits impossible, are controlled by principles quite independent of those involved in *Garretson v. Clark*, and that the plaintiff was entitled to a decree for the profits for the sales of the infringing drills. — *Brennan v. Dowagiac*, 162 Fed. 472; 89 C. C. A. 392.

Note: This is a plain and proper reversal of the holding of this court in *McSherry v. Dowagiac*, 160 Fed. 948.

Mr. Justice Blatchford * * * formulated the rule laid down in *Garretson v. Clark*, 111 U. S. 120. — *Brennan v. Dowagiac*, 162 Fed. 472; 89 C. C. A. 392.

Note: It may be an item of minor interest that this common supposition is not well founded. The rule as stated by Justice Blatchford was copied by him from the report of the master, George J. Sicard, Esq., a law-partner of the late President Cleveland; and Mr. Sicard previously copied the same, almost verbatim, from a written request to find submitted to him by the late Justice Francis A. Macomber, who was at that time counsel for Clark.

For a most sane and salutary construction and limitation of the rule of *Garretson v. Clark*, see *Yesbera v. Hardesty*, 166 Fed. 120; C. C. A.

§ 846. Segregation — Miscellaneous Rules.

The true inquiry is, as to the profits which the defendants have realized as the consequence of the improper use of these improvements. Such profits belong to the plaintiff and should be accounted for to him. — *Littlefield v. Perry*, 88 U. S. 205; 22 L. Ed. 577.

Where the patent covers only a part of or an improvement upon a general device, profits must be segregated. — *McCreary v. Pennsylvania*, 141 U. S. 459; 35 L. Ed. 817; 12 S. Ct. 40.

Seymour v. McCormick, 57 U. S. 480; *Mowry v. Whitney*, 81 U. S. 620; *Littlefield v. Perry*, 88 U. S. 205; *Elizabeth v. Nicholson*, 97 U. S. 126; *Garretson v. Clark*, 111 U. S. 120.

Where defendants did not manufacture and sell the infringing device as a separate article, but manufactured and used it in the manufacture and sale of the article to which it was applicable, obviously the entire profits upon the article sold would not be a proper measure of damages, since the patented device was only an inconsiderable part of such article, and profits upon the entire article are only allowable where such article is wholly the invention of the patentee, or where its entire value is properly and legally attributable to the patented feature. — *Sessions v. Romadka*, 145 U. S. 29; 36 L. Ed. 609; 12 S. Ct. 799.

Seymour v. McCormick, 57 U. S. 480; *Mowry v. Whitney*, 81 U. S. 620; *Littlefield v. Perry*, 88 U. S. 205; *Garretson v. Clark*, 111 U. S. 120.

In the absence of proof showing that the defendant's infringing device derived its whole commercial value from the use of the patented improvement, the court could not have made an order directing the master to find the profits on the entire device. — *Mosher v. Joyce*, 51 Fed. 441; 2 C. C. A. 322.

Littlefield v. Perry, 21 Wall. 205; *Dobson v. Dornan*, 118 U. S. 15.

The well settled doctrine of the Supreme Court was and is, that the profits to be assessed under section 4921 R. S. in suits in equity for the infringement of a patent, are those only which are properly attributable to the patented feature, and that the evidence of the patentee must "apportion the defendant's profits and also the patentee's damages between the patented and unpatented feature." — *Untermeyer v. Freund*, 58 Fed. 205; 7 C. C. A. 183.

Garretson v. Clark, 111 U. S. 120; *Dobson v. Carpet Co.* 114 U. S. 439.

It is also immaterial that a spring bearing plate was superadded to the patented features of the buckle of the defendant, as we are satisfied the organized device did not derive its commercial value to any appreciable extent

from that addition, and would have sold as readily without it. — *Wales v. Waterbury*, 101 Fed. 126; 41 C. C. A. 250.

In such case the infringer is not liable to the patentee for the profit he has made by the use of the entire apparatus. He is liable only for such as has accrued from the use of that part of it which was new, and which he has used without right. — *Brickill v. Mayor*, 112 Fed. 65; 50 C. C. A. 1.

McCreary v. Canal, 141 U. S. 462.

This is not a case where the entire or any considerable value of the article sold is attributable to the patented feature, and profits upon the entire article are only allowable where such article is wholly the invention of the patentee, or where its entire value is properly and legally attributable to the patented feature. — *Lattimore v. Hardsocg*, 121 Fed. 986; 58 C. C. A. 287.

Sessions v. Romadka, 145 U. S. 29; *McCreary v. Penn.* 141 U. S. 459; *Warren v. Keep*, 155 U. S. 265; *Garretson v. Clark*, 111 U. S. 120; *Mowry v. Whitney*, 14 Wall. 620; *Seymour v. McCormick*, 16 How. 480; *Dobson v. Hartford*, 114 U. S. 439; *Littlefield v. Perry*, 21 Wall. 205.

The complainant insists that the strap could not have been sold without the reels (the patented part), and for this reason that it should have been awarded the profits which the defendant made upon the strap sold by him during the period of infringement, together with the damages accruing from loss of complainant's profits upon diverted sales of strap during that period. If the proofs had shown that the strap could not have been sold except with the patented reels, the contention for the appellant would be supported by the authority of cases like *Wales v. Waterbury*, 101 Fed. 126. But the proofs do not show this, and not only the direct evidence, but also presumptions deducible from the small utility of the patented invention, authorize and require a contrary conclusion. That the strap was salable independently of the reels is shown by the fact that during the period of infringement and subsequently the defendant sold it in considerable quantities without reels, as well as with reels which did not infringe the patent. — *Cary v. De Haven*, 139 Fed. 262; 71 C. C. A. 388.

Some of it he treated as the patent directed, and sold the proceeds. Why did he do so? Why did he take the additional trouble to follow the patented process, and risk being prosecuted as an infringer? Why, under those circumstances, he should not account for the profits he made by the patented process we fail to see, and we are referred to no authority which denies such profits to the patentee. — *Hemolin v. Harway*, 166 Fed. 434; C. C. A.

§ 847. Miscellaneous Rules Concerning Profits.

The invalidity of the patent does not render the sales of machines illegal, so as to taint with illegality the obligation of the defendants to account for them, as they had acted under a contract. — *Kinsman v. Parkhurst*, 59 U. S. 289; 15 L. Ed. 385.

The conduct of the defendants has not been such as to commend them to a court of equity. Under the circumstances, every doubt and difficulty should be resolved against them. — *Rubber v. Goodyear*, 76 U. S. 788; 19 L. Ed. 566.

Lupton v. White, 15 Vesey, 432; *Copeland v. Crane*, 9 Pick. 79; *Dexter v. Arnold*, 2 Sumn. 109; *Miller v. Whittier*, 36 Me. 585.

In the reissue, the applicant stated what his improvement would save. If he was correct in this statement, it is not an unfair presumption that if

the profit to the patentee was no greater than he claimed it was, it could not have been more when the invention was used by an infringer. — *Mowry v. Whitney*, 81 U. S. 620; 20 L. Ed. 860.

Where no profits are shown to have accrued, a court of equity cannot give a decree for profits by way of damages, or as a punishment for the infringement. — *Elizabeth v. American*, 97 U. S. 126; 24 L. Ed. 1000.

Livingston v. Woodworth, 15 How. 559.

If an infringer of a patent has realized no profits from the use of the invention, he cannot be called upon to respond for profits; the patentee in such case, is left to his remedy for damages. — *Elizabeth v. American*, 97 U. S. 126; 24 L. Ed. 1000.

The burden of proving the amount of profits that the defendants have made by the use of his invention is upon plaintiff. — *Tilghman v. Proctor*, 125 U. S. 136; 31 L. Ed. 664; 8 S. Ct. 894.

Blake v. Robertson, 94 U. S. 728; *Elizabeth v. Pavement*, 97 U. S. 126; *Dobson v. Hartford*, 114 U. S. 439; *Mowry v. Whitney*, 81 U. S. 620.

The bill cannot be maintained for an account of profits received by the defendant from the use of this patent, because a decree for profits can only proceed upon the ground that the plaintiff is at least the equitable owner of the patent, and there can be neither legal nor equitable ownership of a void patent. — *Kennedy v. Hazelton*, 128 U. S. 667; 32 L. Ed. 576; 9 S. Ct. 202.

The question is whether there was a contract for the use, and not whether all the conditions of the use were provided for in such contract. This is the ordinary rule in respect to the purchase of property or labor. The fact that there was no agreed price was immaterial. — *U. S. v. Berdan*, 156 U. S. 552; 39 L. Ed. 530; 5 S. Ct. 420.

U. S. v. Palmer, 128 U. S. 262; *U. S. v. Russell*, 80 U. S. 623.

That the findings by the lower court are conclusive unless from other findings there was apparent error, see — *U. S. v. Berdan*, 156 U. S. 552; 39 L. Ed. 530; 5 S. Ct. 420.

The invasion of the complainant's right having been established, and an injunction ordered, it may be presumed that there are some profits or damages to be recovered. — *American v. Crosman*, 61 Fed. 888; 10 C. C. A. 146.

The defendants are liable to account for such gains and profits only as accrued to themselves, and not for those which accrued to the manufacturers from whom they bought. — *Kisinger-Ison v. Bradford*, 123 Fed. 91; 59 C. C. A. 221.

Elizabeth v. Pavement, 97 U. S. 126; *Root v. Railway*, 105 U. S. 189; *Tilghman v. Proctor*, 125 U. S. 136; *Coupe v. Royer*, 155 U. S. 565; *Belknap v. Schild*, 161 U. S. 11.

PROTESTS.

General Statement § 848

| See — *Interferences* § 580

§ 848. General Statement.

The practice of filing protests against the allowance of claims, either by a party then or formerly in interference or by a party having knowledge of the content of certain pending claims, is without direct statutory sanction.

and without sanction under the rules of the Patent Office, excepting Rule 12, which says:

No attention will be paid to unverified ex parte statements or protests concerning pending applications to which they are not parties, unless information of the pendency of such applications shall have been voluntarily communicated by the applicants.

It is a proceeding which can be entertained only with reference to a pending application. A protest cannot be heard with reference to an issued patent, since the Commissioner, having no power to cancel or repeal a patent (*McCormick v. Aultman*, 169 U. S. 606; § 26), is not at liberty to put a cloud on the grant after having issued the same. Moreover, a person aggrieved by the issuance of a patent containing claims which he considers as interfering with his activities has the following remedies: First, the right to raise an interference, if he is a competing inventor, by the filing of proper claims; secondly, he has the right under Sec. 4918, if he has a patent which he thinks is interfered with, to obtain a judicial determination of the question; thirdly, he has the right to go about his business, and if he is sued for the infringement of such claims, to defeat them, if he is able, in the courts provided for that purpose.

Protest proceedings appear to relate to questions of non-patentability by reason of prior publication or patent, while a public use proceeding (see § 859), though similar in character, relates to prior use of the subject-matter of the claim. While the Patent Office appears to rest authority for this proceeding upon an office rule, it is thought that the power originates in the general provisions of the statute charging the Commissioner with certain duties and with the determination of questions of novelty and utility in addition to the settlement of priorities; and for the obtaining of that knowledge of the state of the art which will enable him to perform his duty toward the public as well as toward the inventor, such proceedings as protests and public use proceedings are not to be discouraged.

The only instance in which an appellate court has directly considered the subject of protests is the following:

The protest filed by Hall in the Patent Office against the reissue, and the long contest made by him and his attorneys against it, are in the nature of a confession. — *Crown v. Aluminum*, 108 Fed. 845; 48 C. C. A. 72.

PUBLIC USE.

The Statute and General Statement § 849
 Evidence of § 850 (*see* § 388)
 Experiment § 851 (*see* § 412)
 Foreign Use § 852
 General Rules § 853
 Publicity § 854
 Secret Use § 855
 Single Use § 856

Two Years Use § 857
 Miscellaneous Rules § 858
See — Abandonment § 18; *Anticipation* §§ 94, 103-4; *Defenses* § 321; *Experiment* § 415; *Judicial Notice* § 710; *Priority* § 808; *Public Use Proceedings* § 859; *Reissues* § 869; *Secret Process or Machine* § 898; *Unpatented Invention* § 930

§ 849. The Statute, and General Statement.

Section 4886 provides that the invention, in order to be patentable, must not have been in public use or on sale in this country for more than two years prior to the application; and Sec. 4923 provides that a patent shall not be held void by reason of it or any part thereof having been known or used in a foreign country, before the domestic invention or discovery thereof, if it had not been patented or described in a printed publication.

Public use is one of the statutory defenses, which may be made on proper

notice. See *Defenses*. But it is a defense which, like anticipation resting on parol evidence, must be clear and indubitable. See *Evidence*.

§ 850. Evidence of.

No patent shall be held to be invalid on account of sale and public use for more than two years prior to the application, except on proof that the invention was on sale and in public use more than two years before the application thereof was filed in the Patent Office. — *Agawam v. Jordan*, 74 U. S. 583; 19 L. Ed. 177.

McClurg v. Kingsland, 1 How. 209; *Stimson v. R. R.* 4 How. 380.

Evidence to establish prior use must not leave "room for very grave doubt." There must be satisfactory evidence that the article went into public use. — *Hanifen v. Godshalk*, 84 Fed. 649; 28 C. C. A. 507.

Cantrell v. Wallick, 117 U. S. 689.

Proof of public use rests upon the defendant, and every reasonable doubt should be resolved against it. — *Penn v. Conroy*, 159 Fed. 943; 87 C. C. A. 149.

Barbed Wire Pat. 143 U. S. 275.

§ 851. Experiment.

Whilst the supposed machine is in such experimental use, the public may be incidentally deriving a benefit from it. If it be a grist mill, or a carding machine, customers from the surrounding country may enjoy the use of it by having their grain made into flour, or their wool into rolls, and still it will not be in public use, within the meaning of the statute. — *Elizabeth v. American*, 97 U. S. 126; 24 L. Ed. 1000.

When the subject of invention is a machine, it may be tested and tried in a building, either with or without closed doors. In either case, such use is not public use, within the meaning of the statute, so long as the inventor is engaged, in good faith, in testing its operation. He may see cause to alter it and improve it or not. His experiments will reveal the fact whether any and what alterations may be necessary. If durability is one of the qualities to be attained, a long period, perhaps years, may be necessary to enable the inventor to discover whether his purpose is accomplished. And though, during all that period, he may not find that any changes are necessary, yet he may be justly said to be using his machine only by way of experiment; and no one would say that such a use, pursued with a bona fide intent of testing the qualities of the machine, would be a public use within the meaning of the statute. So long as he does not voluntarily allow others to make it and use it, and so long as it is not on sale for general use, he keeps the invention under his own control, and does not lose his title to a patent. — *Elizabeth v. American*, 97 U. S. 126; 24 L. Ed. 1000.

A use by the inventor, for the purpose of testing the machine, in order by experiment to devise additional means for perfecting the success of its operation is admissible; and where, as incident to such use, the product of its operation is disposed of by sale, such profit from its use does not change its character; but where the use is mainly for the purposes of trade and profit and the experiment is merely incidental to that, the principal and not the incident must give character to the use. The thing implied as excepted out of the prohibition of the statute is a use which may be properly characterized as substantially for the purposes of experiment. Where the additional use is not for that purpose, but is otherwise public, and for more than two years

prior to the application, it comes within the prohibition. — *Smith v. Sprague*, 123 U. S. 249; 31 L. Ed. 141; 8 S. Ct. 122.

The use of the invention by the inventor himself, or by another person under his direction, by way of experiment, and in order to bring the invention to perfection, has never been regarded in this court as such a public use as under the statute defeats his right to a patent. — *Smith v. Sprague*, 123 U. S. 249; 31 L. Ed. 141; 8 S. Ct. 122.

Shaw v. Cooper, 32 U. S. 292; *Elizabeth v. Nicholson*, 97 U. S. 126; *Egbert v. Lippmann*, 104 U. S. 333.

Where the evidence shows use for more than two years prior to application for a patent, the proofs that such use were purely experimental should be full, clear, unequivocal and convincing. — *Smith v. Sprague*, 123 U. S. 249; 31 L. Ed. 141; 8 S. Ct. 122.

Where a machine is in the process of legitimate experiment and reduction to practice it is not public use to sell the product of such machine so long as the product is the incident and not the principal factor. — *Smith v. Sprague*, 123 U. S. 249; 31 L. Ed. 141; 8 S. Ct. 122.

Putting an invention into general use to test its utility is not within the statute and cases giving right of experiment. — *Root v. Third Ave R.* 146 U. S. 210; 36 L. Ed. 946; 13 S. Ct. 100.

Elizabeth v. Nicholson, 97 U. S. 126; *Smith v. Sprague*, 23 U. S. 249; *Hall v. MacNeale*, 107 U. S. 90; *Egbert v. Lippmann*, 104 U. S. 333.

But the mere intention of the patentee is not sufficient. Experimental use or sale for experimental purposes is a fact to be proved, and cannot reside in mere intention. If Swain had supplemented his testimony by showing that he at once proceeded, after the Modus machine was installed, to test its efficiency as compared with outward-discharge machines, or inward-discharge machines without his central partition; if he had made such experiments as he has conducted since this suit was begun, or the best tests he was able to under the circumstances, — the case would be different. But it does not appear that the patentee ever conducted any experiments to determine the comparative efficiency of the patented machine until after the beginning of the present suit. Under all the circumstances, there is total failure of proof that the sale of the Modus machine was for such experimental trial as the law contemplates, and which is sufficient to bring the case outside the statutory prohibition. — *Swain v. Holyoke*, 109 Fed. 154; 48 C. C. A. 265.

If the machine, under the circumstances presented in this case, contained the invention in its finished form, the inventor cannot relieve himself from the consequences which follow by showing that it was installed by him with imperfect connections. — *Swain v. Holyoke*, 109 Fed. 154; 48 C. C. A. 265.

In an art requiring extensive experiment to determine results, public experimental use for that purpose does not necessarily work dedication. — *Westinghouse v. Saranac*, 113 Fed. 884; 51 C. C. A. 514.

It is contended that no public use can be a bar to a patent unless there is an element of profit involved or unless the inventor allows the invention to go out of his control. The object of evidence on these points is to distinguish between a use by the public, as in *Elizabeth v. Pavement Co.* 97 U. S. 126, for the purpose of experiment, and a use by any part of the public, as in *Egbert v. Lippmann*, 104 U. S. 333, which is not experimental. The

ultimate question is not whether the public used the invention, but whether the use was directed to a development of the invention or test of its practicality. For the purpose of proving the ultimate fact, evidence as to whether the inventor derived a profit from the use or retained control may be important, but it is not necessarily conclusive. But where a use known to the public is shown, the proof on the part of the patentee who contends that it is not a bar, "because it was for the purpose of perfecting an incomplete invention by tests and experiments . . . should be full, unequivocal, and convincing." — *Thomson-Houston v. Lorain*, 117 Fed. 249; 54 C. C. A. 281. *Mfg. Co. v. Sprague*, 123 U. S. 249.

That the unrestricted use of a machine which from its first operation is a mechanical and commercial success cannot be declared to be a secret and experimental use, even though certain minor improvements are subsequently made; and that the rule in *Elizabeth v. Pavement Co.* 97 U. S. 126 does not apply, see — *Jenner v. Bowen*, 139 Fed. 556; 71 C. C. A. 540.

Mr. Edison testified that "so far as the process is concerned, it is just the same now, in a broad sense, that it was" in 1888. The patent application was not filed until 1898. Between 1889 and 1898 duplicates to the number of 6,000 or 7,000 were made and used commercially. *Held*: Public use continuing more than nine years in commercial operations must be presumed from the testimony, and such fact is neither controverted nor modified by other proof, so that it is immaterial whether experimental use occurred at any stage. The statute invalidates the patent if the invention described therein was in public use or on sale earlier than two years before the application was filed. The use so established was public use, in violation of the statute, and not within the well-defined meaning of experimental use for testing the invention. — *National v. Lambert*, 142 Fed. 164; 73 C. C. A. 382.

Worley v. Tobacco, 104 U. S. 340; *Smith v. Sprague*, 123 U. S. 249; *Eastman v. Mayor*, 134 Fed. 844.

There was, no doubt, an earlier machine (one made and used for more than two years prior to application) more or less complete, which was being experimented with. But the use made of it was purely experimental, and does not count. Nor is it affected by the fact that caramels cut on it were sold. The caramels did not have to be thrown away to escape the charge of public use. — *American v. Mills*, 149 Fed. 743; 79 C. C. A. 449.

Elizabeth v. Pavement, 97 U. S. 126; *Bryce v. Seneca*, 140 Fed. 161.

For a public use which was similar to that in *Elizabeth v. Pavement Co.* 97 U. S. 126, and held not to be abandonment, see *Warren v. City*, 166 Fed. 309; C. C. A.

§ 852. Foreign Use.

It is clear that prior use in a foreign country will not supersede a patent granted here, unless the alleged invention was patented in some foreign country. — *Roemer v. Simon*, 95 U. S. 214; 24 L. Ed. 384.

§ 853. General Rules.

If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; if he should for a long period of years retain the monopoly, and make and sell his invention publicly, and thus gather the whole profits of it, relying upon his superior skill and knowledge of the structure and then, and then only, when the danger of competition

should force him to secure the exclusive right he should be allowed to take out a patent, and thus exclude the public from any further use than what would be derived under it during his fourteen years; it would materially retard the progress of science and the useful arts, and give a premium to those who would be least prompt to communicate their discoveries. — *Pennock v. Dialogue*, 2 Pet. 1; 7 L. Ed. 327.

It is not a public knowledge of his invention that precludes the inventor from obtaining a patent for it, but a public use or sale of it. — *Elizabeth v. American*, 97 U. S. 126; 27 L. Ed. 1000.

It is not public knowledge of an invention but public use or sale which precludes an inventor from obtaining a valid patent. — *Root v. Third Ave. R.* 146 U. S. 210; 36 L. Ed. 946; 13 S. Ct. 100.

Quoting *Elizabeth v. Nicholson*, 97 U. S. 126.

A mechanical invention can be put to use only when embodied in a concrete machine, and it is as much embodied in one such machine, as in a thousand. Whether, when thus put to use, it is put "in public use," is a fact to be determined not by the number of machines in which it is so embodied, nor by the length of time they are run, but by the extent of use to which such inventor allows such embodiment to be put. He may retain his control over the machine which embodied such inventions and reserve to himself the right to select the individuals who shall use it, or secure to himself right of access to it for the purpose of conducting his experiments; but when he parts with such machine unreservedly, so that thenceforth the right to take, and hold, and use, and sell it is free to the public, that machine, and the invention it embodies, is by him put in public use. And he does so part with it when he sells it under a contract which not only allows the individual purchaser to use it, but leaves him free to transfer machine and use to whom he will. Whether the purchaser chooses to resell it or not, is immaterial; he has the power to do so, and that is enough. If the inventor wishes to keep control of the machine which embodies his invention, to secure his own access to it for examination, and to keep it in the friendly hands of those who, he intends, shall aid him by practical experiment, he must make such restrictions a part of the contract of sale and the court cannot assume them to exist in the absence of proof. — *DeLamater v. Heath*, 58 Fed. 414; 7 C. C. A. 279.

Egbert v. Lippmann, 104 U. S. 333.

Instead of laying down a fixed rule, it seems to us that in each case the court should direct its attention to the fundamental inquiry: Under what circumstances and for what purpose did the public use or sale take place? And, where it appears that there has been a public use or sale for more than two years before the application, the burden is thrown upon the patentee to establish, by full, clear, and convincing proofs, that such use or sale was principally and primarily for experimental purposes, and that such purposes were not merely incidental or subsidiary. — *Swain v. Holyoke*, 109 Fed. 154; 48 C. C. A. 265.

Fruit-Jar Co. v. Wright, 94 U. S. 94; *Egbert v. Lippmann*, 104 U. S. 337; *Hall v. Macneale*, 107 U. S. 96; *Elizabeth v. Pavement*, 97 U. S. 126; *Mfg. Co. v. Sprague*, 123 U. S. 256.

A person may obtain his knowledge of an invention direct from the inventor and may practise it publicly without his knowledge or consent, and such use will invalidate a patent unless the application is filed within the statutory period thereafter. In order to relieve the inventor from the consequences of such use, assuming that relief is possible, it must appear that

the knowledge was obtained by deception, and that the use was fraudulent or piratical. The meaning of "fraudulent" is too well known to require definition, but it may be wise to refer to the meaning of the other adjectives used by the Supreme Court. "Surreptitious" means, "Fraudulently obtained. Falsely crept in. Obtained by falsehood, fraud or stealth, by suppression or concealment of facts." "Piratical" means, "Acquired by piracy or robbery." It is entirely clear that when the courts have used these words in patent causes they intended them to apply to acts done mala fide, clandestinely, treacherously and by means of falsehood, fraud or breach of trust. It is equally clear that they have never been used to characterize knowledge obtained openly and in the due course of business or applied to any act which is neither *malum prohibitum* nor *malum in se*.

The question, what constitutes a fraudulent, piratical or wrongful appropriation, sale or use of the invention, is left very much as the earlier authorities leave it, in obscurity. We have been referred to no case since the clear exposition of the law in *Andrews v. Hovey* where a plain case of public use earlier than two years before the application for the patent has been held to be ineffectual as a defense because the use was surreptitious. When the question is fairly presented it may be that the courts will hesitate to introduce exceptions to the rule as broadly stated by the Supreme Court, with the confusion and uncertainty incident thereto. — *Eastman v. Mayor*, 134 Fed. 844; 69 C. C. A. 628.

The patent was applied for and granted in May, 1864. At that time the act of 1839 — explaining, supplementing and superseding the act of 1836 — was in force. The seventh section of that act is as follows:

"Sec. 7 . . . That every person or corporation who has, or shall have purchased or constructed any newly invented machine, manufacture, or composition of matter, prior to the application by the inventor for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition of matter so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held to be invalid by reason of such purchase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public; or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent."

The last clause of this section, which is particularly applicable to this controversy, has been condensed and tersely stated by Mr. Walker as follows:

"A patent is void for the invention covered thereby when in public use or on sale earlier than two years before the application for the patent" (sec. 93).

The entire subject has been thoroughly examined and the conclusion of the Supreme Court stated in *Andrews v. Hovey*, 123 U. S. 267, and reaffirmed after a second exhaustive examination in the same case, 124 U. S. 694. The question now at issue was directly involved in that case. The court says, speaking of the numerous defenses:

"It is necessary to consider only one of them, which, in our view, is fatal to the validity of the patent, and that is, that the invention was used in public at Cortland, in the State of New York, by others than Green (the inventor) more than two years before the application for the patent."

The court says, in construing the section quoted supra:

"The evident intention of Congress was to take away the right (which existed under the act of 1836) to obtain a patent after an invention had for a long time been in public use without the consent or allowance of the inventor; it limited that period to two years, whether the inventor had or had not consented to or allowed the public use."

After an examination of every reported case upon the rehearing the court was confirmed in its opinion that its former decision was correct and closes the elaborate discussion in the following language:

“The second clause of the seventh section seems to us to clearly intend, that, where the purchase, sale, or prior use referred to in it has been for more than two years prior to the application, the patent shall be held to be invalid, without regard to the consent or allowance of the inventor. Otherwise the statute cannot be given its full effect and meaning.”

Among the authorities thus examined and overruled was *Campbell v. Mayor*, 9 Fed. 500, which was the original decision holding the patent in this suit valid. — *Eastman v. Mayor*, 134 Fed. 844; 69 C. C. A. 628.

Note: This case, perhaps, holds the record for long and laborious conflict. The first device was completed and delivered for use March 28, 1860. The application was not filed until May 13, 1864. This action was commenced Nov. 13, 1877; and the decision herein was filed Jan. 16, 1905. The litigation covered, in round numbers, 28 years; between the filing of the application and the final decree of the Circuit Court of Appeals 41 years; a final decree on an invention put in use 45 years before that decree was reached.

The patent was governed by the act of Mar. 3, 1839, as to public use. That act provided that “A patent is void if the invention covered thereby was in public use or on sale earlier than two years before the application for the patent.” (Walker’s paraphrase.) The act was without qualification. The public use was instituted by the inventor on March 28, 1860. Notwithstanding the fact that it was a perfect working device on that day, application was not made until four years, two and one-half months had elapsed. The excuses of experimental use and surreptitious use, to my mind, were the most flimsy. That a case like this could remain in the courts for more than a quarter of a century serves to show the utter inadequacy of our patent courts and the laws governing the trial of patent causes.

§ 854. Publicity.

Whether the use of an invention is public or private, does not necessarily depend upon the number of persons to whom its use is known. If an inventor, having made his device, gives or sells it to another, to be used by the donee or vendee without limitation or restriction, or injunction of secrecy, and it is so used, such use is public, within the meaning of the statute, even though the use and knowledge of the use may be confined to one person. — *Egbert v. Lippmann*, 104 U. S. 333; 26 L. Ed. 755.

Some inventions are by their very character only capable of being used where they cannot be seen or observed by the public eye. An invention may consist of a lever or spring, hidden in the running gear of a watch, or of a ratchet, shaft or cog-wheel covered from view in the recesses of a machine for spinning or weaving. Nevertheless, if its inventor sells a machine of which his invention forms a part; and allows it to be used without restriction of any kind, the use is a public one, within the meaning of the law. So, on the other hand, a use necessarily open to public view, if made in good faith solely to test the qualities of the invention, and for the purposes of experiment is not a public use within the meaning of the patent law. *Elizabeth v. Paving Co.* 97 U. S. 126; *Shaw v. Cooper*, 7 Pet. 292. — *Egbert v. Lippmann*, 104 U. S. 333; 26 L. Ed. 755.

Note: In this case, Justice Woods held that where the inventor had made an improved corset steel and presented it to his ladylove, who used it; and where said inventor subsequently married the donee and subsequently made her a second corset steel — the two articles combined covering more than two years before patent — such use was public and constituted abandonment. To this Justice Miller wisely dissented.

The fact that the improvement was concealed within the safe and could be seen only by the destruction of the safe does not avoid public use. — *Hall v. Macneale*, 107 U. S. 90; 27 L. Ed. 367; 2 S. Ct. 73.

Egbert v. Lippmann, 104 U. S. 333.

The fact that the anticipating device was concealed from view and could not have come to public notice does not constitute a secret device such as would take it outside the law of public use. — *Brush v. Condit*, 132 U. S. 39; 33 L. Ed. 251; 10 S. Ct. 1.

The process was practised by Pettigrew and Gleason, and those who assisted, and was open to the observation of the employees generally, and of all who passed through the plant. We think there was abundant publicity. — *U. S. Mineral v. Manville*, 125 Fed. 770; 60 C. C. A. 288.

Coffin v. Ogden, 18 Wall. 120; *Brush v. Condit*, 132 U. S. 39; *Fornecrook v. Root*, 127 U. S. 180; *Peters v. Active*, 129 U. S. 530.

§ 855. Secret Use.

Inventors may, if they can, keep their invention secret; and if they do for any length of time, they do not forfeit their right to apply for a patent, unless another, in the meantime, has made the invention, and secured by patent the exclusive right to make, use and vend the patented improvement. Within that rule and subject to that condition, inventors may delay to apply for a patent. — *Bates v. Coe*, 98 U. S. 31; 25 L. Ed. 68.

Inventors may, if they can, keep their inventions secret, but if they do not, and suffer the same to go into public use for a period exceeding what is allowed by the patent act they forfeit their right to a patent. — *Parks v. Booth*, 102 U. S. 96; 26 L. Ed. 54.

The unrestricted use of a device, without injunction to secrecy, constitutes public use. — *Manning v. Cape Ann*, 108 U. S. 462; 27 L. Ed. 793; 2 S. Ct. 860.

Egbert v. Lippmann, 104 U. S. 333.

The inventor built and set up and licensed to another a machine, without restriction as to secrecy. Later minor improvements were made, but the machine was a successful one from the start. *Held*: The licensee understood its mechanism and its method of use, and was under no restriction as to the place and manner of operation, and under no obligation of secrecy. When the object of the use is the perfecting of an invention, the sale of the product, if strictly incidental to an experimental use, is not a public use under sec. 4886 R. S., and will not defeat a patent. A use which is impliedly excepted out of the prohibition of the statute is a use which may be properly characterized as substantially for the purposes of experiment. "When the substantial use is not for that purpose, but is otherwise public, and for more than two years prior to the application, it comes within the prohibition." — *Jenner v. Bowen*, 139 Fed. 556; 71 C. C. A. 540.

Smith v. Sprague, 123 U. S. 249; *International v. Gaylord*, 140 U. S. 55; *Root v. Third Ave.* 146 U. S. 210; *Eastman v. Mayor*, 134 Fed. 844.

Distinguishing *Elizabeth v. Pavement Co.* 97 U. S. 126.

§ 856. Single Use.

It follows that a single instance of sale or of use by the patentee may, under the circumstances, be fatal to the patent. — *Consolidated v. Wright*, 94 U. S. 92; 24 L. Ed. 68.

Pitts v. Hall, 2 Blatchf. 235; *Am. v. Am.* 4 Fish. 291; *McMillin v. Barclay*, 5 Fish. 189; *McClurg v. Kingsland*, 1 How. 202; *Agawam v. Jordan*, 7 Wall. 583.

To constitute public use of a patent it is not necessary that more than one of the patented articles should be publicly used. The use of a great number may tend to strengthen the proof of public use, but one well defined case of public use is just as effectual to annul the patent as many. — *Egbert v. Lippmann*, 104 U. S. 333; 26 L. Ed. 755.

Not dependant upon the number of persons using it. — *Root v. Third Ave.*, 146 U. S. 210; 36 L. Ed. 946; 13 S. Ct. 100.

Egbert v. Lippmann, 104 U. S. 333.

A single unrestricted sale proved is sufficient to establish the defense of prior public use. — *DeLamater v. Heath*, 58 Fed. 414; 7 C. C. A. 279.

Fruit Jar Co. v. Wright, 94 U. S. 92; *Egbert v. Lippmann*, 104 U. S. 332; *Hall v. MacNeale*, 107 U. S. 90; *Mfg. Co. v. Sprague*, 123 U. S. 249; *Elizabeth v. Pavement Co.* 97 U. S. 126.

The sale of this machine was absolute, unconditional and for a valuable consideration. As a general rule, a single unrestricted sale by the patentee of his patented device, embodying his completed invention, is a public use or sale within sec. 4886 of the Revised Statutes. — *Swain v. Holyoke*, 109 Fed. 154; 48 C. C. A. 265.

Egbert v. Lippmann, 104 U. S. 333; *Fruit-Jar Co. v. Wright*, 94 U. S. 92; *Hall v. MacNeale*, 107 U. S. 90; *Henry v. Soapstone Co.* 2 Fed. 78; *Sinclair v. Backus*, 4 Fed. 539; *Mfg. Co. v. Mellon*, 58 Fed. 705; *DeLamater v. Heath*, 58 Fed. 414; *Mfg. Co. v. Sprague*, 123 U. S. 249.

We should hesitate to lay down the broad proposition that a single sale of a patented device for experimental purposes works a forfeiture under the statute. We do not understand that it has ever been so expressly decided by the Supreme Court. It is certainly doubtful whether, under such circumstances, the device can be said to be "on sale" within the fair meaning of the statute. It does not follow that, because a machine has been sold, it has passed the experimental stage. — *Swain v. Holyoke*, 109 Fed. 154; 48 C. C. A. 265.

Hall v. MacNeale, 107 U. S. 96.

There are undoubtedly cases where the strict application of this rule (a single unrestricted sale) works great hardship. Some inventions are for large and costly structures, others require a long period of time to test their practical utility, and still others are for small devices which are attached to large machines. It follows that an inventor, from lack of means or other circumstances, may be forced to sell his patented device in order to test its utility or efficiency. For these reasons the courts in some instances have declined to enforce the strict rule where the sale was attended by some exceptional circumstance. — *Swain v. Holyoke*, 109 Fed. 154; 48 C. C. A. 265.

Graham v. McCormick, 11 Fed. 859; *Graham v. Mfg. Co.* 11 Fed. 138; *Harmon v. Struthers*, 57 Fed. 637; *Innis v. Boiler Works*, 22 Fed. 780; *Eastern v. Standard*, 30 Fed. 63; *Draper v. Wattles*, 3 Ban. & A. 618.

§ 857. Two Years Use.

Is fatal to the validity of the patent. — *Worley v. Loker*, 104 U. S. 340; 26 L. Ed. 821.

McClurg v. Kingsland, 1 How. 202; *Consolidated v. Wright*, 94 U. S. 92; *Egbert v. Lippmann*, 104 U. S. 333.

While the act of 1836 made any public use fatal, the act of 1870 makes a public use of two years prior to the application fatal to the granting of a valid patent. — *Manning v. Cape Ann*, 108 U. S. 462; 27 L. Ed. 793; 2 S. Ct. 860.

McClurg v. Kingsland, 1 How. 202; *Egbert v. Lippmann*, 104 U. S. 333; *Fruit v. Wright*, 94 U. S. 92; *Worley v. Tobacco*, 104 U. S. 340.

An invention which has been in public use more than two years, whether with or without the inventor's consent is abandoned. — *Andrews v. Hovey*, 123 U. S. 267; 31 L. Ed. 160; 8 S. Ct. 101.

Statutes and authorities construed. — *Andrews v. Hovey*, 124 U. S. 694; 31 L. Ed. 557; 8 S. Ct. 676.

McClurg v. Kingsland, 42 U. S. 202; *Pierson v. Eagle*, 3 Story. 402; *Hovey v. Stevens*, 1 Wood & M. 290; *Pitts v. Hall*, 2 Blatchf. 223; *McCormick v. Seymour*, 2 Blatchf. 240; *Seymour v. McCormick*, 57 U. S. 489; *Sargent v. Seagrave*, 2 Curt. 553; *Kendall v. Winsor*, 62 U. S. 322; *Fennock v. Dialogue*, 27 U. S. 1; *Shaw v. Cooper*, 32 U. S. 292; *Sanders v. Logan*, 2 Fish. P. C. 167; *American v. American*, 4 Fish. P. C. 284; *McMillin v. Barclay*, 5 Fish. P. C. 189; *Russell v. Mallory*, 10 Blatchf. 140; *Jones v. Sewall*, 3 Cliff. 563; *Klein v. Russell*, 86 U. S. 433; *Henry v. Frankestown*, 2 B. & A. 221; *Consolidated v. Wright*, 94 U. S. 92; *Kelleher v. Darling*, 4 Cliff. 424; *Henry v. Providence*, 3 B. & A. 501; *Draper v. Wattles*, 3 B. & A. 618; *Bates v. Coe*, 88 U. S. 31; *Graham v. McCormick*, 10 Biss. 39; *Brickill v. Mayor*, 18 Blatchf. 273; *Campbell v. Mayor*, 20 Blatchf. 67; *Davis v. Fredericks*, 21 Blatchf. 556.

If an inventor applies for his patent within two years from the time that he first exhibits his completed invention in public, no amount of public use within that two years, either by the inventor or others, will work any forfeiture of his right to a patent or constitute any evidence of abandonment. — *Haines v. McLaughlin*, 135 U. S. 584; 22 L. Ed. 241; 10 S. Ct. 876.

Where an inventor puts his invention into public use for more than two years without controlling his invention and in good faith seeking to perfect the same, such use avoids the patent. — *Root v. Third Ave.*, 146 U. S. 210; 36 L. Ed. 946; 13 S. Ct. 100.

Elizabeth v. Nicholson, 97 U. S. 126; *Smith v. Sprague*, 123 U. S. 249; *Hall v. MacNeale*, 107 U. S. 90; *Egbert v. Lippmann*, 104 U. S. 333.

§ 858. Miscellaneous Rules.

The acquiescence of an inventor in the public use of his invention can in no case be presumed, where he has no knowledge of such use. But this knowledge may be presumed from the circumstances of the case. — *Shaw v. Cooper*, 7 Pet. 292; 8 L. Ed. 699.

Where the employee invents under hire and employer uses, such use, if for more than two years is public use and is not avoided by any part ownership by the employer. — *Worley v. Loker*, 104 U. S. 340; 26 L. Ed. 821.

An inventor cannot relieve himself of the consequences of the prior public use of his patented invention by assigning an interest in his invention or patent to the person by whom the invention was used. — *Worley v. Loker*, 104 U. S. 340; 26 L. Ed. 821.

What constitutes. — *Hall v. MacNeale*, 107 U. S. 90; 27 L. Ed. 367; 2 S. Ct. 73.

Coffin v. Ogden, 18 Wall. 120.

It follows from this principle (rule in *Penna. v. Locomotive*, 110 U. S. 490) that, where the public has acquired in any way the right to use a machine or device for a particular purpose, it has the right to use it for all the like purposes to which it can be applied, and no one can take out a patent to cover the application of the device to a similar purpose. — *Blake v. San Francisco*, 113 U. S. 679; 28 L. Ed. 1070; 5 S. Ct. 592.

It will hardly be contended that the mistaken advice of a patent solicitor can override a statute of the United States. — *Eastman v. Mayor*, 134 Fed. 844; 69 C. C. A. 628.

PUBLIC USE PROCEEDINGS.

General Statement § 859

See — *Interference* § 580; *Public Use* § 849

§ 859. General Statement.

These proceedings are similar to protests (see § 848), and appear to have grown up in much the same way. While a protest proceeding may inform the Commissioner as to prior publication, these proceedings are to inform him as to public use. Both proceedings have as their object the assistance of the Commissioner in performing his duties under sec. 4893. As appears from the case quoted from below, it is not a proceeding which a contestant before the Office can institute without some risk to himself; for the establishment of a prior use to defeat an opponent may operate to defeat both parties.

The public use, therefore, carried back more than two years prior to Beckert's application, antedates the new application of Currier for a still longer period, and prevents not only Beckert's fourth claim, but the claim of the patent in suit, from covering needles with headed pins. — *Dodge v. Jones*, 159 Fed. 715; 86 C. C. A. 191.

REDUCTION TO PRACTICE.

General Statement § 860

Diligence § 861

Essential to Patentability § 862

Experiment § 863 (see § 412)

Last Step Rule § 864

Operativeness § 865

Priority § 866

What Constitutes § 867

See — *Experiment* § 412; *Operativeness* § 781; *Priority* § 811; *Public Use* § 849

§ 860. General Statement.

What has been said with reference to operativeness (§ 781) applies largely to this subject. The statute (sec. 4886) requires that an invention, in order to be patentable, shall not only be new but useful. It is self-evident that an invention which cannot be reduced to practice without further invention is not patentable by reason of non-utility. Moreover, the statute requires that the specification shall recite the manner and process of making, constructing, compounding and using the invention, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle. R. S. 4888.

Since the furnishing of a model (sec. 4891) is not mandatory, and the requirement has fallen into desuetude, the Commissioner has no means of knowing, in many cases, whether the invention is operative, or has been reduced to practice to any extent whatever. One who has had any con-

siderable experience in patent soliciting well knows that many inventions pass directly from the drafting board to the patent specification, without ever having been embodied in a machine. Many of these paper patents are never reduced to practice—many never could be. There is evidently a tendency on the part of the courts, in some cases, to limit the application of such paper patents as showing anticipation (§ 92). It must be borne in mind that failure to reduce to practice or inoperativeness are not questions within the rule of non-user as laid down by the Supreme Court in *Continental v. Eastern*, 210 U. S. 405 (§ 574), but are within the rules stated in *Automatic v. Pneumatic*, under § 613.

The following summary of the law by Judge Holt is instructive:

This is a bill in equity under 4920 R. S. for infringement. The only defense is priority of invention. Under sec. 4920 the defendant contends, first, that Watson was the original and first inventor of the thing patented, and, second, that Thomas unjustly obtained his patent for that which was in fact invented by Watson, who was using reasonable diligence in adapting and perfecting the same. The first defense turns upon the respective dates of the Thomas and Watson inventions, and the second defense raises a question of fact as to Watson's diligence in adapting and perfecting his invention. Thomas filed his application Dec. 17, 1896, and his patent issued July 26, 1904. Watson conceived his invention, illustrated it by a drawing, and disclosed it to others as early as Jan. 10, 1896. He reduced his invention to practice by the building of a machine in Apr., 1897. He filed his application Mar. 11, 1898, and his patent issued Sept. 26, 1899. It may be noted, first, that Thomas' application antedates Watson's reduction to practice by 4 months, and Watson's application by 15 months; and second, that Watson's conception antedates Thomas' application by 11 months. The main controversy with respect to the Thomas invention is whether the date of his invention is the date of his application, Dec. 17, 1896, and the main controversy with respect to the Watson invention is whether the date of his invention is the date of his conception, Jan. 10, 1896.

Under a rule of the Patent Office, the filing of an allowable application is a constructive reduction to practice. In accordance with this rule, the date of the Thomas invention was fixed as of Dec. 17, 1896, the date of his application; and the burden of proof was thrown upon Watson to establish the fact of reasonable diligence from the date of his prior conception, Jan. 10, 1896, to the time Thomas filed his application. Upon this issue of diligence on the part of Watson, the Examiner of Interferences and the Commissioner of Patents, and the Court of Appeals, D. C., found against Watson, and adjudged Thomas the prior inventor, and accordingly a patent was issued to Thomas under sec. 4904. As a result of the interference proceedings, there are two outstanding patents for the same invention issued to independent inventors.

The decision in interference proceedings is not conclusive on the question of priority of invention. The same question may arise in subsequent suits instituted under secs. 4915, 4918 and 4920, R. S. In the present suit, the question of priority is raised under paragraphs 2 and 4 of sec. 4920. In order to determine the question of priority under these paragraphs, we must ascertain the respective dates of the Thomas and Watson inventions. If we find the date of the Thomas invention is prior to the date of the Watson invention, then Thomas is the original and first inventor, unless Watson was using reasonable diligence in adapting and perfecting his invention from the time of his conception. On the other hand, if we find that the date of the Watson invention is prior to the date of the Thomas invention, then Watson is the original and first inventor. No question of diligence arises regarding the Thomas invention, because the complainant does not under-

take to carry the date of the Thomas invention back of his application, while in the case of Watson it is sought to carry the date of invention back to his conception.

In patented inventions there are several distinct stages of the invention. Some patented inventions comprise only three stages, namely, conception (evidenced by drawings, disclosures, or models), application, patent; while other patented inventions comprise four stages, namely, conception, reduction to practice, application, patent.

The date of the first class of patented inventions must be either (1) the date of the patent, or (2) the date of the application, or (3) the date of the conception; while the date of the second class must be either (1) the date of the patent, or (2) the date of the application, or (3) the date of the reduction to practice, or (4) the date of the conception.

When two patents for the same invention have been issued to independent inventors, we understand the rule to be that the dates of their respective inventions are, (1) the dates of the patents; (2) the dates of the applications, provided the application sufficiently describes the invention; (3) the dates of actual reduction to practice; (4) the dates of conception; with this qualification, that, if either patentee seeks to carry the date of his invention back to the date of his conception, he must show reasonable diligence in adapting and perfecting his invention, either by actual reduction to practice or by filing his application.

Applying this rule, it appears that Thomas' application of Dec. 17, 1896, carries the date of his invention back of Watson's application, Mar. 11, 1898, and back of Watson's conception, Jan. 10, 1896. It follows, therefore, that Watson, in order to establish an earlier date than Thomas, must show that between the date of his conception, Jan. 10, 1896, and the date of his actual reduction to practice, Apr., 1897, he was "using reasonable diligence in adapting and perfecting" his invention.

The defendant contends that the courts have adopted another and a different rule for determining the dates of inventions under the patent laws, and that rule is as follows: Inventions are divided into two classes, simple and complicated. Simple inventions may be completed by drawings or disclosure which sufficiently describe the invention, while complicated inventions require for their completion actual reduction to practice. With respect to this theory of the defendant, it is sufficient to say that it is novel and plainly unsound. No such distinction between inventions is found in the statutes, or has ever been recognized by the courts in any adjudicated cases. It may be further observed that any such artificial distinction would lead to hopeless confusion and great injustice.

In the present case the question of priority of invention involves two fundamental inquiries: First, is the date of the patented invention as early as the date of the application? In other words, can Thomas carry back the date of his invention to the date of his application? Second, is the date of a patented invention as early as the date of conception? In other words, can Watson carry back the date of his invention to the date of his drawing and disclosure?

First. With respect to the first proposition it may be said that the law is well settled that the date of a patented invention is at least as early as the date of the application, provided it sufficiently describes the invention to enable those skilled in the art to understand it; and we have found no decision in which this rule is questioned. (Quoting and reviewing *Walk. Pat. 4th ed. § 70*; *Kearney v. Railroad*, 32 Fed. 320; *National v. Brown*, 36 Fed. 317; *Prindle v. Brown*, 155 Fed. 531; *Bates v. Coe*, 98 U. S. 31; *Barnes v. Walworth*, 51 Fed. 88, *affd.* 60 Fed. 605; *Barbed Wire Case*, 143 U. S. 275; *Miller v. Eagle*, 151 U. S. 186; *Westinghouse v. Chartiers*, 43 Fed. 582.)

The rule of the Patent Office that the filing of an allowable application is constructive reduction to practice is only the expression in another form of the rule that the application for a patented invention, if it sufficiently describes the invention, is conclusive evidence that the invention was made at least as early as that date. *Lorraine v. Thurmond*, 51 O. G. 1781.

The rule of the Federal courts respecting an application which has resulted in a patent, and the rule of the Patent Office respecting an allowable application, simply mean that such applications are conclusive evidence of the completeness of the invention. In other words, they are conclusive evidence that the stage of the invention has been reached where it is evidenced by reduction to practice.

The rule of the Patent Office, as pointed out by Commissioner Mitchell in *Lorraine v. Thurmond*, *supra*, is based upon two well-established principles of the patent law:

(1) We have, in the first place, the principle that a statutory invention (except as modified by the doctrine of "diligence in adapting and perfecting") is a completed invention; that is, an invention which is perfected and adapted to use, or, as otherwise expressed, reduced to practice; and an inventor is not entitled to a patent — in other words, has not made an invention in the legal sense — until he has reduced his invention to practice. *Agawam v. Jordan*, 7 Wall. 583; *Seymour v. Osborne*, 11 Wall. 516; *Clark v. Willimantic*, 140 U. S. 481; *Woodcock v. Parker*, Fed. Cas. 1813; *Bedford v. Hunt*, Fed. Cas. 1217; *Reed v. Cutter*, Fed. Cas. 11,645; *Washburn v. Gould*, Fed. Cas. 17,214; *White v. Allen*, Fed. Cas. 17,535; *Winans v. New York*, Fed. Cas. 17,864.

(2) At the same time we have the equally well settled rule that an invention need not be perfected and adapted to use, or reduced to practice, in order to obtain a valid patent, since no such condition is contained in the statute. *Wheeler v. Clipper*, Fed. Cas. 17,493; *Telephone Cases*, 126 U. S. 1.

From these established and seemingly contradictory principles of the patent law, first, that an invention in order to be patentable must be reduced to practice, and, second, that, under the statutes, reduction to practice is not essential either before or after the grant of a patent, it follows that there must be some stage of an invention when it must be presumed as a matter of law that the inventor has reduced his invention to practice; and that stage is presumed to have been reached when he has done all that he is required to do to obtain a valid patent, namely, when he has filed a complete and allowable application; and hence the Patent Office has adopted the rule that the filing of such an application is constructive reduction to practice, and the Federal courts have adopted the rule that such an application is conclusive evidence that the patentee made his invention — that is, reduced his invention to practice — at least as early as that date.

The cases which hold that a rejected application is not sufficient to establish priority of invention under the statutes have no bearing on the question of the legal effect of a complete and allowable application which will result or has resulted in the granting of a patent. *Corn Planter Pat.* 23 Wall. 181; *Lyman v. Lalor*, Fed. Cas. 8632; *Northwestern v. Philadelphia*, Fed. Cas. 10,337.

Second. We have now to consider the question whether Watson can carry the date of his invention back to the time of his conception, Jan. 10, 1896. This question must be viewed from two standpoints: First, can it be said that Watson's conception, drawings and disclosure to others, of themselves, or without regard to his subsequent acts, can constitute a complete invention within the meaning of the patent laws? Second, can Watson as a patentee carry back the date of his invention to the time of his conception?

(1) The law appears to be well established that a conception evidenced

by disclosure, drawings, and even a model, confers no rights upon an inventor unless followed by some other act, such as actual reduction to practice, or filing an application for a patent. A conception of this character is not a complete invention under the patent laws. If it did constitute an invention under the statutes, then an inventor might stop with his drawings and disclosure, and hold the field for all time against a subsequent inventor who had reduced his invention to practice, or who had obtained a patent. The law will not permit this. An inventor must not stop with this stage of his invention, but he must proceed with reasonable diligence to perfect his invention, either by actual reduction to practice, or by filing his application for a patent. (Quoting and reviewing *Detroit v. Renchard*, 9 Fed. 293; *Reeves v. Keystone*, Fed. Cas. 11,660; *Pennsylvania v. Simpson*, 29 Fed. 288; *Winans v. New York*, Fed. Cas. 17,864; *Electric v. Hall*, 6 Fed. 603; *Draper v. Potomska*, Fed. Cas. 4072; *Ellithorp v. Robertson*, Fed. Cas. 4408.)

(2) The next question we have to consider is whether Watson as a patentee can carry back the date of his invention to the date of his conception; that is, to his drawing and disclosure of Jan. 10, 1896. It is conceded that a patentee who has used "reasonable diligence in adapting and perfecting" his invention can carry the date back to his drawings and disclosure; and the only question which arises is whether the law will permit him to do this in the absence of such reasonable diligence. In other words, can a patentee stop with his drawings and disclosure for an unreasonable time, and then, by virtue of his subsequently obtaining a patent, hold this field of invention against a rival inventor whose conception of the same invention was later, and who proceeded with diligence to build a practical machine, or to file an application for a patent? In our opinion, he cannot do this under the patent laws. We understand the true rule to be that a patentee who undertakes to carry back the date of his invention to his drawings and disclosure must show reasonable diligence in adapting and perfecting his invention, either by actual reduction to practice or by filing his application. This rule is supported by the great weight of authority, and we have found no cases which directly hold that this is not the law, though there are some cases in which a patentee has been permitted to carry back his invention to his drawings and disclosure, where the question of diligence was not raised or passed upon. *Loom Co. v. Higgins*, 105 U. S. 580; *Dodge v. Porter*, 98 Fed. 624; *Westinghouse v. Stanley*, 133 Fed. 167. No sound reason has been advanced why the doctrine of diligence should not apply to a patentee as well as an inventor who has not secured a patent. On the other hand, any such distinction in favor of patentees is not in harmony with the patent laws. We have seen that an invention in the sense of the patent law signifies a completed invention, and that the earliest date of an invention is the time of its completion. We have also seen that an invention may be completed either by actual reduction to practice or by filing a complete and allowable application in conformity with the statutes.

This general principle, however, is subject to this qualification: (Here follows a discussion of the acts of July 4, 1836, sec. 15; Feb. 21, 1793, sec. 6; [and a review of the cases bearing thereon: *Reed v. Cutter*, *supra*; *Loom Co. v. Higgins*, *supra*; *Odell v. Stout*, 22 Fed. 159; *Reeves v. Keystone*, *supra*; *Christie v. Seybold*, 55 Fed. 69; *Merrow v. Shoemaker*, 59 Fed. 120; *Detroit v. Renchard*, *supra*; *Pennsylvania v. Simpson*, *supra*; *Electric v. Hall*, *supra*; *Morgan v. Daniels*, 153 U. S. 120).)

We come now to the remaining question, whether Watson was reasonably diligent in adapting and perfecting his invention. Upon this question of fact the decision of the Patent Office tribunals and the Court of Appeals, D. C. is entitled to great weight, if it is not absolutely controlling.

In *Morgan v. Daniels*, 153 U. S. 120, a suit was brought under § 4915,

R. S. by the party who was refused a patent in interference proceedings, to determine the question whether he should not be adjudged entitled to a patent. In this case the court used the following language:

“ Upon principle and authority, therefore, it must be laid down as a rule that, where the question decided in the Patent Office is one between contesting parties as to priority of invention, the decision there made must be accepted as controlling upon the question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction.” — *Automatic v. Pneumatic*, 166 Fed. 288; 92 C. C. A. 206.

§ 861. Diligence.

The settled rule of law is, that whoever first perfects a machine is entitled to the patent, and is the real inventor, although others may have had the idea and made some experiments toward putting it in practice. He is the inventor and is entitled to the patent who first brought the machine to perfection and made it capable of useful operation. — *Agawam v. Jordan*, 74 U. S. 583; 19 L. Ed. 177.

Washburn v. Gould, 3 Story, 133.

A complicated invention, requiring many experiments and much study to give it practical form, would reasonably delay a reduction to practice after the first conception for a greater length of time than where the idea and the machine embodying it were simple in character. Then, too, the sickness of the inventor, his poverty and his engagements in other inventions of a similar kind, are all circumstances which may affect the question of reasonable diligence. — *Christie v. Seybold*, 55 Fed. 69; 5 C. C. A. 33.

Bradford v. Corbin, 6 O. G. 223; *Webster v. Carpet Co.* 5 O. G. 522; *Cox v. Griggs*, 1 Biss. 362; *Munger v. Connell*, 1 O. G. 491; *Proctor v. Ackroyd*, 6 O. G. 603; *Cushman v. Parkam*, 9 O. G. 1108.

§ 862. Essential to Patentability.

Original and first inventors are entitled to the benefit of their inventions if they reduce the same to practice, and seasonably comply with the requirements of the patent law in procuring letters patent for the protection of their exclusive rights. Crude and imperfect experiments are not sufficient to confer a right to a patent; but in order to constitute an invention, the party must have proceeded so far as to have reduced his idea to practice and embodied it in some distinct form. — *Seymour v. Osborne*, 78 U. S. 516; 20 L. Ed. 33.

An invention in order to be patentable must be more than a mere experiment; its utility must have been established by reduction to practice. — *Seymour v. Osborne*, 78 U. S. 516; 20 L. Ed. 33.

This was a problem of the reconciliation of antagonisms, which so often occurs in mechanics and without which practically successful results are not attained. — *Consolidated v. Crosby*, 113 U. S. 157; 28 L. Ed. 939; 5 S. Ct. 513.

A conception of the mind is not an invention until represented in some physical form, and unsuccessful projects or experiments, abandoned by the inventor, are equally destitute of character. — *Clark v. Willimantic*, 140 U. S. 481; 35 L. Ed. 521; 11 S. Ct. 846.

§ 863. Experiment.

What constitutes legitimate experiment in reducing to practice, see — *Smith v. Sprague*, 123 U. S. 249; 31 L. Ed. 141; 8 S. Ct. 122.

§ 864. Last Step Rule.

In the law of patents it is the last step that counts. — *Washburn v. Beat Em All*, 143 U. S. 275; 36 L. Ed. 154; 12 S. Ct. 443.

Loom Co. v. Higgins, 105 U. S. 580; *Safety Valve Co. v. Crosby*, 113 U. S. 157; *Smith v. Goodyear*, 93 U. S. 486; *Magawan v. N. Y.* 141 U. S. 332.

§ 865. Operativeness.

All we know is that he found out that, by changing the intensity of a continuous current so as to make it correspond exactly with the changes in density of air caused by sonorous vibrations, vocal and other sounds could be transmitted and heard at a distance. This was the thing to be done, and Bell discovered the way of doing it. — *Telephone Cases*, 126 U. S. 1; 31 L. Ed. 863; 8 S. Ct. 778.

Although at the time Bell applied for his patent he had never actually transmitted spoken words so that they could be distinctly understood, so long as he had described the device with sufficient precision to enable one skilled in the art thereafter to produce a speaking telephone, it was sufficient. "Where the question is whether a thing can be done or not, it is always easy to find persons ready to show how not to do it." — *Telephone Cases*, 126 U. S. 1; 31 L. Ed. 863; 8 S. Ct. 778.

Loom v. Higgins, 105 U. S. 580.

The law does not require that a discoverer or inventor, in order to get a patent for a process, must have succeeded in bringing his art to the highest degree of perfection. It is enough if he describes his method with sufficient clearness and precision to enable those skilled in the matter to understand what the process is, and if he points out some practical way of putting it in operation. — *Telephone Cases*, 126 U. S. 1; 31 L. Ed. 863; 8 S. Ct. 778.

The patent laws were not designed for the benefit of the man who attempts to originate a useful thing, but rather to reward the one who first achieves success in the production of it. It would be a perversion of the law to hold a machine which can do certain kinds of work to be an infringement of a patent for a different machine, which cannot do the same work. — *Norton v. Jensen*, 49 Fed. 859; 1 C. C. A. 452.

His patent should not be declared void because he was in doubt as to which of the compositions would prove the most satisfactory in a commercial sense, or because he had not practically and finally tested and chemically isolated all the matter or material containing the required cohesive, adhesive and acid resisting qualities. — *American v. Howland*, 80 Fed. 395; 25 C. C. A. 500.

Telephone Cases, 126 U. S. 1.

§ 866. Priority.

However brilliant the discovery of the new principle may be, to make it useful it must be applied to some practical purpose. Short of this no patent can be granted. And it would not seem to be a work of much labor for a man of ingenuity to describe what he had invented. The principle may be

the new and valuable discovery, but the practical application of it to some useful purpose is the test of its value. — *LeRoy v. Tatham*, 63 U. S. 132; 16 L. Ed. 366.

LeRoy v. Tatham, 14 How. 156, 176.

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. — *Whitely v. Swayne*, 74 U. S. 685; 19 L. Ed. 199.

Curt. Pat. 43 and notes.

He who first publishes his device, puts it upon record, makes use of it for a practical purpose, and gives it to the public, by which it is eagerly seized upon should have doubts of invention resolved in his favor. — *Washburn v. Beat Em All*, 143 U. S. 275; 36 L. Ed. 154; 12 S. Ct. 443.

§ 867. What Constitutes.

A machine is said to be complete when the apparatus is attached substantially complete in its operative parts. And it is not necessary that it should be doing work, so long as it is capable of it. — *Troy v. Odiorne*, 58 U. S. 73; 15 L. Ed. 37.

A patentable invention is a mental result. It must be new and shown to be of practical utility. Everything within the domain of the conception belongs to him who conceived it. The machine, process or product is but its material reflex and embodiment. — *Smith v. Nichols*, 88 U. S. 112; 22 L. Ed. 566.

It can hardly be claimed that the rough sketch made by Seybold of his proposed press was a reduction to practice. It has been held in many cases, that drawings much more complete than the one here testified to, are not reductions to practice, as against a subsequent conceiver who first made an actual operative machine. — *Christie v. Seybold*, 55 Fed. 69; 5 C. C. A. 33.

Reeves v. Bridge Co., 5 Fish. P. C. 456; *Lubricator v. Renchard*, 9 Fish. 293; *Drill Co. v. Simpson*, 29 Fed. 288; *Ellithorpe v. Robertson*, 4 Blatchf. 307; *Draper v. Mills*, 13 O. G. 276; *Odell v. Stout*, 22 Fed. 159.

Expression of the means of an alleged invention, in a drawing or sketch, is frequently the best attainable evidence of the needful "representation in physical form," and may rightly be accepted as satisfactory proof of such fact, when fairly authenticated, definite, and reasonable under the circumstances. — *Consolidated v. Adams*, 161 Fed. 343; 88 C. C. A. 355.

REHEARINGS.

General Statement § 868		§§ 138-9; <i>Pleading and Practice</i>
See — <i>Adjudication</i> § 35; <i>Appeals</i>		§ 788; <i>Reopening Case</i> § 890

§ 868. General Statement.

Rules regarding rehearings are rules of practice not peculiar to patent causes. As will be seen from the following citations, the courts apply these general rules to patent causes with no substantial variation.

After the case has been heard and decided upon its merits, the plaintiff could not file a disclaimer in court, or introduce new evidence upon that or any other subject, except at a rehearing granted by the court, upon such terms as it saw fit to impose. The granting or refusal, absolute or conditional, of a rehearing in equity, as of a new trial at law, rests in the discretion of the

court in which the case has been heard or tried, and is not a subject of appeal. The terms imposed are a condition precedent to a rehearing not having been complied with, the disclaimer was not in the case. — *Roemer v. Neumann*, 132 U. S. 103; 33 L. Ed. 277; 10 S. Ct. 12.

In reaching our conclusions of fact in this case, we have not been unmindful of the abuses which the strict rules enforced in the allowing of the rehearings were adopted to prevent. Where an elaborate opinion of the court of last resort upon the evidence is published, and the weaknesses of the losing side are clearly brought out, and the defeated party is thereafter given an opportunity to strengthen the defects of his case by evidence as to transactions long past and machinery long since cast into the scrap heap, there is great danger that the exigencies of the case may lead witnesses to round out evidence beyond that which exact truth would permit. Such evidence must be taken with great caution, and weighed in the light of this danger. — *Potts v. Creager*, 97 Fed. 78; 38 C. C. A. 47.

REISSUES.

The Statute § 869	Different Invention § 881
Abandoned Claim § 870 (<i>see</i> § 1)	Disclaimer § 882 (<i>see</i> § 339)
Broadening	General Rules § 883
Not Permissible — In General § 871	Grounds for § 884
Not Permissible — Omitting Elements § 872	Inadvertence, Accident, or Mistake § 885
When Permissible § 873	Scope of § 886
Miscellaneous Rules § 874	Surrender — Effect of § 887
Delay	Tests of Validity § 888
Excusable § 875	Miscellaneous Rules § 889
Fatal § 876	<i>See — Assignment</i> § 173; <i>Commissioner of Patents</i> § 258; <i>Defenses</i> § 310; <i>Disclaimer</i> § 339; <i>Divisional Patenting</i> § 348; <i>Double Patenting</i> § 356; <i>Fraud</i> § 425; <i>Infringement</i> § 522; <i>Laches</i> § 731
General Rules § 877	
Intervening Rights § 878	
Miscellaneous Rules § 879	
Decision of Commissioner § 880	

§ 869. The Statute.

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

drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. R. S. 4916.

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

§ 870. Abandoned Claim.

Indeed we have heretofore expressed doubts whether reissued letters patent can be sustained in any case where they contain claims that have once been formally disclaimed by the patentee, or rejected with his acquiescence and he has consented to such rejection in order to obtain his letters patent. — *Goodyear v. Davis*, 102 U. S. 222; 26 L. Ed. 149.

Leggett v. Avery, 101 U. S. 256.

When applicant abandoned a claim under pressure of rejection it does not follow that such rejection implies that the claim is otherwise covered. — *Yale v. James*, 125 U. S. 447; 31 L. Ed. 807; 8 S. Ct. 967.

Swain v. Ladd, 102 U. S. 408.

A claim once abandoned in the Patent Office and restored in the reissue cannot be admitted in consistency with numerous decisions by this court. — *Yale v. Berkshire*, 135 U. S. 342; 34 L. Ed. 168; 10 S. Ct. 884.

§ 871. Broadening — Not Permissible — In General.

The practice of the art of broadening claims by reissue to cover subsequent invention is to be condemned, and the reissue to be limited. — *Burr v. Duryee*, 68 U. S. 579; 17 L. Ed. 660.

The new art of expanding patents for machines into patents for "a mode of operation," a function, a principle, a result, so that by an equivocal use of the term "equivalent" a patentee of an improved machine may suppress all further improvements, is to be condemned. — *Case v. Brown*, 69 U. S. 320; 17 L. Ed. 817.

Burr v. Duryee, 1 Wall. 535; *McCormick v. Talcott*, 20 How. 405.

It is clear that the commissioner has no jurisdiction to grant a reissue except for the same invention as the original. — *Seymour v. Osborne*, 78 U. S. 516; 20 L. Ed. 33.

Cahart v. Austin, 2 Cliff. 536; *Curt. Pat.* 276; *Woodworth v. Stone*, 3 Story, 753.

We think it proper to reiterate our disapprobation of these ingenious attempts to expand a simple invention of a distinct device into an all-embracing claim, calculated by its wide generalizations and ambiguous language to discourage further invention in the same department of industry and to cover antecedent inventions. — *Carlton v. Bokee*, 84 U. S. 463; 21 L. Ed. 517.

It appears on the face of the reissue that it is for a different invention, for the reissue is attempted to be sustained only on the ground that it is for a single stage process. — *American v. Fiber*, 90 U. S. 566; 23 L. Ed. 31.

A reissue could only be granted for the same invention embraced in the original patent, the specification could not be substantially changed, either by addition of new matter or the omission of important particulars, so as to enlarge the scope of the invention. — *Russell v. Dodge*, 93 U. S. 460; 23 L. Ed. 973.

Morey v. Lockwood, 8 Wall. 230.

The original covered only the process. In the reissue division was made, one patent covering the process and the other the product. *Held*: Invalid. — *Powder v. Powder*, 98 U. S. 126; 25 L. Ed. 77.

Burr v. Duryee, 1 Wall. 575; *Seymour v. Osborne*, 11 Wall. 516; *Gill v. Wells*, 22 Wall. 1; *Wood Paper Pat.* 23 Wall. 566.

A reissue for a broader claim than the original, especially when it embraces matter previously rejected and disclaimed by amendment or in obtaining an extension, is invalid. — *Leggett v. Avery*, 101 U. S. 256; 25 L. Ed. 865.

Here is a sweeping generalization, which reissue claims taken literally, would give to the patentee a monopoly of all water wheels having simultaneously an effective inward and downward flow and discharge, whatever might be the shapes of the floats, or of the crown.

The mistake of the patentee, or his assigns, seems to have been in supposing that he was entitled to have inserted in a reissue patent all that he might have applied for and had inserted in his original patent. A reissue can be granted only for the same invention which was originally patented. If it were otherwise, a door would be opened to the admission of the greatest frauds. — *Swain v. Ladd*, 102 U. S. 408; 26 L. Ed. 184.

This court has repeatedly held that if, on comparing a reissue with the original, the former appears on its face to be for a different invention from that described or indicated in the latter, it must be declared invalid. — *Ball v. Langles*, 102 U. S. 128; 26 L. Ed. 104.

Seymour v. Osborne, 78 U. S. 516; *Russell v. Dodge*, 93 U. S. 460.

If the reissued patent is to be construed as appellant insists it should be and as it must be to include the defendant's devices it is broader than the original patent and therefore void. — *Hopkins v. Corbin*, 103 U. S. 786; 26 L. Ed. 610.

Wood Paper Patent, 90 U. S. 566; *Powder v. Powder*, 98 U. S. 126; *Ball v. Langles*, 102 U. S. 128; *Russell v. Dodge*, 93 U. S. 460; *Swain v. Ladd*, 102 U. S. 408; *Wicks v. Stevens*, 2 Woods, 312.

The general rule and leading case (quoted § 873) — *Miller v. Brass Co.* 104 U. S. 350; 26 L. Ed. 783.

General rule followed. — *Guidet v. Brooklyn*, 105 U. S. 550; 26 L. Ed. 1106.

General rule applied and followed. — *Johnson v. Flushing*, 105 U. S. 539; 26 L. Ed. 1162.

Giant v. California, 6 Sawy. 508; *Powder v. Powder*, 98 U. S. 126; *Ball v. Langles*, 102 U. S. 128; *James v. Campbell*, 104 U. S. 356.

A reissue for a broader claim than warranted by the original is void. — *Bantz v. Frantz*, 105 U. S. 160; 26 L. Ed. 1013.

Miller v. Brass Co. 104 U. S. 350.

Broadening claim voids patent. — *Matthews v. Boston*, 105 U. S. 54; 26 L. Ed. 1022.

Miller v. Brass Co. 104 U. S. 350.

The specification and first claim of the reissued patent is a plain attempt to include a device which was not and could not be fairly covered by the original patent. The claim is, therefore, for that reason void. — *Moffitt v. Rogers*, 106 U. S. 423; 37 L. Ed. 76; 1 S. Ct. 70.

Gill v. Wells, 22 Wall. 1; *Wood Paper Pat.* 23 Wall. 566; *Powder v. Powder*, 98 U. S. 126; *Ball v. Langles*, 102 U. S. 128; *Miller v. Brass Co.* 104 U. S. 350; *James v. Campbell*, 104 U. S. 356; *Heald v. Rice*, 104 U. S. 737; *Bantz v. Frantz*, 105 U. S. 160; *Johnson v. R. R.* 105 U. S. 539.

It is quite clear that the original patent covered a mechanism to accomplish a specific result, and that the reissued patent covers the process by which the result is attained, without regard to the mechanism used to accomplish it. The reissue is therefore much broader than the original patent, and covers every mechanism which can be contrived to carry on the process. — *Wing v. Anthony*, 106 U. S. 142; 27 L. Ed. 110; 1 S. Ct. 93.

Powder v. Powder, 98 U. S. 126; *Campbell v. James*, 104 U. S. 356; *Heald v. Rice*, 104 U. S. 737; *Gill v. Wells*, 22 Wall. 1; *Wood Paper Pat.* 23 Wall. 566; *Ball v. Langles*, 102 U. S. 128; *Miller v. Brass Co.* 104 U. S. 350; *Johnson v. R. R.* 105 U. S. 539; *Bantz v. Frantz*, 105 U. S. 160.

If so construed it is invalid as being for a different invention from any invention found in the original patent. And if it is so limited as to be no broader than the claim of the original patent, there has been no infringement of it. — *Gosling v. Roberts*, 106 U. S. 39; 27 L. Ed. 61; 1 S. Ct. 26.

The expansions in the reissue were afterthoughts, developed by the subsequent course of improvement, and intended to cover matter appearing in subsequent patents. No excuse is given for the delay and no inadvertence, accident or mistake is shown. — *Clements v. Odorless*, 109 U. S. 641; 27 L. Ed. 1060; 3 S. Ct. 525.

Miller v. Brass Co. 104 U. S. 350; *James v. Campbell*, 104 U. S. 356.

The original patent was issued July 7, 1863. Eleven years after, in 1874, the competition of the appellant's device became apparent and was felt. In 1875, application was made for the reissue; the original patent was surrendered and the patent reissued July 13, 1875. Here is a delay of nearly 12 years, without the offer of an explanation or excuse, without even the suggestion of inadvertence or mistake in the original application. The only inference that can be drawn is, that the discovery and experience of successful competition in 1874 suggested first and led to the discovery that the original claim did not cover everything that might have been embraced and was not broad enough to maintain the monopoly desired but not secured. — *Turner v. Dover*, 111 U. S. 319; 28 L. Ed. 442; 4 S. Ct. 401.

Miller v. Brass Co. 104 U. S. 350; *Clements v. Odorless*, 109 U. S. 641.

If the claim is to be construed so broadly as to cover the defendant's article, it is wider in scope than the original actual invention, and wider than anything indicated in the specification of the original patent, and that, if it is to be so construed as to cover only the product which the process described

in it will produce it is not shown that the defendant's article is that product or can be practically produced by that process. — *Cochrane v. Badische*, 111 U. S. 293; 28 L. Ed. 433; 4 S. Ct. 455.

It is plain that the claims mentioned include many devices not covered by the original patent, and are void. — *McMurray v. Mallory*, 111 U. S. 97; 28 L. Ed. 365; 4 S. Ct. 375.

Gill v. Wells, 22 Wall. 1; *Wood Paper Pat.* 23 Wall. 566; *Powder v. Powder*, 98 U. S. 126; *Ball v. Langles*, 102 U. S. 128; *Miller v. Brass Co.* 104 U. S. 350; *James v. Campbell*, 104 U. S. 356; *Heald v. Rice*, 104 U. S. 737; *Johnson v. R. R.* 105 U. S. 539; *Bantz v. Frantz*, 105 U. S. 160; *Wing v. Anthony*, 106 U. S. 142.

It is clear on the face of the patent that the only object of the reissue was to enlarge the claims. The description was not altered in the least. The claims in the original patent were clear and explicit, one of these being substantially retained in the reissue. Nothing was altered, nothing was changed, but to multiply the claims and to make them broader. And this was done, not for the benefit of the original patentee but for that of his assignee; and was done after the lapse of nearly four years. — *Mahn v. Harwood*, 112 U. S. 354; 28 L. Ed. 665; 5 S. Ct. 174.

Miller v. Brass Co. 104 U. S. 350.

The rule in *Miller v. Brass Co.* 104 U. S. 350, and *James v. Campbell*, 104 U. S. 356, followed and approved. — *Coon v. Wilson*, 113 U. S. 268; 28 L. Ed. 963; 5 S. Ct. 537.

Mahn v. Harwood, 112 U. S. 354.

The first claim of the reissue is bad, not only because it was for something the patentee had expressly disclaimed in the original patent, but because, as the evidence clearly shows, there was nothing new in the dies themselves. — *Beecher v. Atwater*, 114 U. S. 523; 29 L. Ed. 232; 5 S. Ct. 1007.

The suggestion in the second reissue of its adaptability to a certain use, not found in the original patent or in the first reissue is new matter, so far as anything in it can be invoked to confer patentability on the article. — *Gardner v. Herz*, 118 U. S. 180; 30 L. Ed. 158; 6 S. Ct. 1027.

The alterations, it is said in argument, had the effect only of giving a more full, complete, and accurate description of the same mechanism; but, in point of fact, the alterations changed the shape of the specification in such a way as to admit the new and enlarged claim in a manner in which it could not have been made upon the original description. — *Hartshorn v. Saginaw*, 119 U. S. 664; 30 L. Ed. 539; 7 S. Ct. 421.

Broadening by claiming a different thing voids the patent. — *Ives v. Sargent*, 119 U. S. 652; 30 L. Ed. 544; 7 S. Ct. 436.

Broadening the claims voids the patent. — *Newton v. Furst*, 119 U. S. 373; 30 L. Ed. 442; 7 S. Ct. 369.

As the patent is not susceptible of a broad construction, the reissue is a material expansion and enlargement of it. As such expansion appears to be the only object of the reissue, and as the application for the reissue was not made until nearly five years after the original was granted, the case comes within the ruling of *Miller v. Brass Co.* 104 U. S. 350. — *White v. Dunbar*, 119 U. S. 47; 30 L. Ed. 303; 7 S. Ct. 72.

The design manifest is to cover such a structure as that of the defendants. No inadvertence, accident or mistake is shown. This reissue patent is invalid. — *Worden v. Searls*, 121 U. S. 14; 30 L. Ed. 853; 7 S. Ct. 814.

The court adheres strictly to the view, that, under the statute, the commissioner has no jurisdiction to grant a reissued patent for an invention substantially different from that embodied in the original patent, and that a reissue granted not in accordance with that rule is void. — *Parker v. Yale*, 123 U. S. 87; 31 L. Ed. 100; 8 S. Ct. 38.

Burr v. Duryee, 68 U. S. 531; *Seymour v. Osborne*, 71 U. S. 516; *Gill v. Wells*, 87 U. S. 1; *Giant v. California*, 98 U. S. 126; *Mahn v. Harwood*, 112 U. S. 354; *Coon v. Wilson*, 113 U. S. 268; *Ives v. Sargent*, 119 U. S. 652; *Corn Planter Patent*, 90 U. S. 181.

The drawings cannot be used, even on an application for a reissue, much less on a disclaimer, to change the patent and make it embrace a different invention from that described in the specification. — *Hailes v. Albany*, 123 U. S. 582; 31 L. Ed. 284; 8 S. Ct. 262.

Parker v. Yale, 123 U. S. 87.

General rule followed. — *Dryfoos v. Wiese*, 124 U. S. 32; 31 L. Ed. 362; 8 S. Ct. 354.

The general rules of recent cases followed. — *Yale v. James*, 125 U. S. 447; 31 L. Ed. 807; 8 S. Ct. 967.

Miller v. Brass Co. 104 U. S. 350; *Mahn v. Harwood*, 112 U. S. 354; *Parker v. Yale*, 123 U. S. 87; *Matthews v. Iron*, 123 U. S. 347; *Swain v. Ladd*, 102 U. S. 408.

When it does not appear that any attempt has been made to secure by the original patent the inventions covered by the new claims in the reissue, those inventions must be regarded as having been abandoned or waived, so far as the reissue was concerned. — *Hoskin v. Fisher*, 125 U. S. 217; 31 L. Ed. 759; 8 S. Ct. 834.

Parker v. Yale, 123 U. S. 87.

The enlargement of the claims in the reissue, so as to embrace machines not containing that feature, is void. — *Farmer's v. Challenge*, 128 U. S. 506; 32 L. Ed. 529; 9 S. Ct. 146.

It is well settled that a reissue can only be granted for the same invention intended to be embraced in the original patent; and the specification cannot be substantially changed, either by the addition of new matter or the omission of important particulars, so as to enlarge the invention as intended to be originally claimed. — *Pattee v. Kingman*, 129 U. S. 294; 32 L. Ed. 700; 9 S. Ct. 389.

Where it appears that the original specification was not defective or insufficient and that the patent was not inoperative; and where it was apparent that the sole object of the reissue was to obtain an enlarged claim; and where the subject-matter of the renewal had been adjudicated in the Patent Office on the original application and the applicant had acquiesced in such adverse action by the Department, the effect of such an abandonment of a claim upon the validity of a reissue has been often adjudged by this court as fatal. — *Yale v. Berkshire*, 135 U. S. 342; 34 L. Ed. 168; 10 S. Ct. 884.

Leggett v. Avery, 101 U. S. 256; *Mahn v. Harwood*, 112 U. S. 354; *Union v. U. S.* 112 U. S. 624; *Shepard v. Carrigan*, 116 U. S. 593; *Roemer v. Peddie*, 132 U. S. 313.

A reissue is an amendment and cannot be allowed unless the imperfections in the original patent arose without fraud, and from inadvertence, accident or mistake. R. S. 4916. Hence the reissue cannot be permitted to enlarge the claims of the original patent by including matter once intentionally omitted. Acquiescence in the rejection of a claim, its withdrawal by amendment, either to save the application or to escape interference, the acceptance of a patent containing limitations imposed by the Patent Office, which narrow the scope of the invention as at first described and claimed — an instance of such omission. — *Dobson v. Lees*, 137 U. S. 258; 34 L. Ed. 652; 11 S. Ct. 71.

Union v. U. S. 112 U. S. 624; *Shepard v. Carrigan*, 116 U. S. 593; *Roemer v. Peddie*, 132 U. S. 313; *Yale v. Berkshire*, 135 U. S. 342.

The applicant having withdrawn a similar claim in his original application in order to obtain his original patent, and the present claim being for a different invention from that covered by the original patent, it is void. — *Dobson v. Lees*, 137 U. S. 258; 34 L. Ed. 652; 11 S. Ct. 71.

Giant v. California, 98 U. S. 126; *Leggett v. Avery*, 101 U. S. 256; *Swain v. Ladd*, 102 U. S. 408; *Goodyear v. Davis*, 102 U. S. 122.

Where only a single magnet and a single armature were shown, applicant cannot pluralize these terms in an amended claim. — *Electric v. Boston*, 139 U. S. 481; 35 L. Ed. 250; 11 S. Ct. 586.

A reissue where the claims are extended to cover new matter is invalid regardless of the promptness in applying for the reissue. — *Freeman v. Asmus*, 145 U. S. 226; 36 L. Ed. 685; 12 S. Ct. 821.

Mahn v. Harwood, 112 U. S. 354; *Coon v. Wilson*, 113 U. S. 268; *Ives v. Sargent*, 119 U. S. 652; *Parker v. Yale*, 123 U. S. 87; *Matthews v. Ironclad*, 124 U. S. 347; *Hoskin v. Fisher*, 125 U. S. 217; *Flower v. Detroit*, 127 U. S. 563; *Yale v. Berkshire*, 135 U. S. 342; *Electric v. Boston*, 139 U. S. 481; *Topliff v. Topliff*, 145 U. S. 156.

Unless a clear mistake had been made in the wording of the claim, a reissue cannot be had merely to enlarge the claim. — *Huber v. Nelson*, 148 U. S. 270; 37 L. Ed. 447; 13 S. Ct. 603.

Miller v. Brass Co. 104 U. S. 350; *Mahn v. Harwood*, 112 U. S. 354; *Coon v. Wilson*, 113 U. S. 268; *Burr v. Duryee*, 68 U. S. 531; *Gill v. Wells*, 89 U. S. 22.

Expansion of claim to embrace invention not specified in original patent renders claim invalid. — *Leggett v. Standard*, 149 U. S. 287; 31 L. Ed. 737; 13 S. Ct. 902.

Miller v. Brass Co. 104 U. S. 350; *Mahn v. Harwood*, 112 U. S. 354; *Wollensak v. Reiher*, 115 U. S. 96.

Applicant having withdrawn rejected claims and substituted narrow claims cannot insist on construction of reissue claim to cover original claim. — *Corbin v. Eagle*, 150 U. S. 38; 37 L. Ed. 989; 14 S. Ct. 28.

Shepard v. Carrigan, 116 U. S. 593; *Roemer v. Peddie*, 132 U. S. 313; *Royer v. Coupe*, 146 U. S. 524.

Patent Office having rejected a claim and rejection acquiesced in, applicant estopped to claim such construction. — *Morgan v. Albany*, 152 U. S. 425; 38 L. Ed. 500; 14 S. Ct. 627.

Leggett v. Avery, 101 U. S. 256; *Shepard v. Carrigan*, 116 U. S. 593; *Crawford v. Heysinger*, 123 U. S. 589; *Union Cartridge Co. v. U. S.* 112 U. S. 624.

Rule of *Miller v. Brass Co.* 104 U. S. 350 applied. — *Dunham v. Dennison*, 154 U. S. 103; 38 L. Ed. 924; 14 S. Ct. 986.

Miller v. Brass Co. 104 U. S. 350; Mahn v. Harwood, 112 U. S. 354; Topliff v. Topliff, 145 U. S. 156; Huber v. Nelson, 148 U. S. 270; Leggett v. Standard, 149 U. S. 287; Corbin v. Eagle, 150 U. S. 38.

Where in the reissue the construction is made alternative by employing the word "preferably" to cover structures in use, such alternative broadens the claims based thereon and defeats the patent. — Olin v. Timken, 155 U. S. 141; 39 L. Ed. 100; 15 S. Ct. 49.

Huber v. Nelson, 148 U. S. 270.

Had the plaintiff, in his reissue, confined himself to the correction of an error so manifest, we should have found little difficulty in sustaining it; but in his application, which was made four years after the original patent, he makes no claim that his patent "was inoperative or invalid, by reason of a defective or insufficient specification," or by reason of his having claimed "more than he had a right to claim as new," or that any error had arisen, "by inadvertence, accident or mistake," without which the commissioner has no right to grant a reissue, but simply prays that he may be allowed to surrender his original patent, and that, "letters patent may be reissued to him for the same invention, upon the annexed amended specification." He makes no reference at all to the obvious mistakes in his first claim, and although the point is not distinctly made in the briefs, we think it a serious question, whether the commissioner of patents had any jurisdiction under R. S. 4916 to consider the application upon the bare statement that the patentee desired to surrender his patent and obtain a reissue. — Eby v. King, 158 U. S. 366; 39 L. Ed. 1018; 15 S. Ct. 972.

By removing the limitation of the thickness of the material, contained in the original, the claim was broadened so as to void the patent. — American v. Johnston, 52 Fed. 228; 3 C. C. A. 53.

It must appear by the description in the original patent that it was the purpose of the patentee to secure the thing specified in the claim of the reissue, and a patent cannot be lawfully reissued unless there has been a clear mistake, inadvertently committed, in the wording of the claim. — Featherstone v. Bidwell, 57 Fed. 631; 6 C. C. A. 487.

Parker v. Yale, 123 U. S. 99; Hoskin v. Fisher, 125 U. S. 223; Flower v. Detroit, 127 U. S. 571; Mahn v. Harwood, 112 U. S. 354; Plow v. Kingman, 129 U. S. 299.

While in this case it is true, that the fifth claim contains four elements, while its predecessor contained but three, and therefore it is, in a certain sense, a narrower claim, that statement contains but half a truth. The remaining half is that the new claim is for a different and previously unrecognized invention. The patent had been in existence and under repeated examination for nine years, and individuals and the public had acquired adverse interests, which would be destroyed by a reconstruction of a void claim. — Carpenter v. Searle, 60 Fed. 82; 8 C. C. A. 476.

Parker v. Yale, 132 U. S. 87.

This case is thought to mark a new departure by the Supreme Court in the line of strict construction of the right of reissue. It must be interpreted in the light of the special circumstances which gave rise to it, of the evils that had grown up under the loose practice theretofore prevailing, and the remedy required in the interest of the public. The evil to be corrected was this: unscrupulous speculators, watching the development of successful inventions, could, in searching the records of prior inventions, find one which might

embody the same principles, and, availing themselves of the opportunity, given by the reissue law, embody in the older patent claims which it might have had but did not, and the result would be that the owner of the later patent, who had spent time and money in the development of a profitable business, would be confronted with a patent earlier in date than his, but reissued later, which would completely control his business. This evil certainly demanded correction. Again there was a presumption — and generally it was a fact — that what was not claimed was not invented by the patentee and the public had the right to use what was not claimed, either because it had not been invented by the patentee, or because by his own act he had made it public property, if it was not so before. — *Crown v. Aluminum*, 108 Fed. 845; 48 C. C. A. 72.

The introduction in a reissued patent of claims for inventions which are described, but which the patentee neither claimed nor intended to claim by the original patent, is unauthorized by the acts of congress, and such claims are void. — *Ide v. Trorlicht*, 115 Fed. 137; 53 C. C. A. 341.

Topliff v. Topliff, 145 U. S. 156; *Hubel v. Dick*, 28 Fed. 132; *Carpenter v. Searle*, 60 Fed. 82.

It does not appear from the original specification that the patentee had any idea of any novel means for obviating the self-induction resistance of alternating currents. The claims in suit of the reissue cannot be sustained, because the description in the original patent fails to show that the invention covered by said claims was intended to be secured in the original patent. — *Weston v. Stevens*, 134 Fed. 574; 67 C. C. A. 374.

Walker on Pat. sec. 233; *Hoskin v. Fisher*, 125 U. S. 217; *Pattee v. Kingman*, 129 U. S. 294; *Featherstone v. Bidwell*, 57 Fed. 631.

A different doctrine (from that requiring prompt action for reissue upon defect discovered) would go far to defeat the object of the rule which requires the patentee to define his invention with such distinctness that other inventors, and the public as well, may know its scope and limitations. And it is not alone these persons who are shown to have taken action upon the faith that the patent defines the character of the invention who may raise the objection to a change in its claims which makes it cover other ground than that claimed before. The rule does not rest upon the ground of an estoppel in favor of particular persons. — *Milloy v. Thomson-Houston*, 148 Fed. 843; 78 C. C. A. 533.

White v. Dunbar, 119 U. S. 47; *Walker on Pat.* sec. 226.

§ 872. Broadening — Not Permissible — Omitting Elements.

The complainants have split up and divided the elements of their invention and claimed them separately and not in combination. Of course this enlarges the scope of their patent. The separate claims embrace fewer elements in combination than were embraced in the claim of the original patent. No one could infringe the original patent unless he used all the elements of the combination. Anyone will infringe the reissue who uses any of those elements which are now separately claimed. — *Matthews v. Boston*, 105 U. S. 54; 26 L. Ed. 1022.

The reissue was granted 13 years and 8 months after the date of the original patent. The new claim covered only five of the original seven elements. *Held*, invalid. — *Gage v. Herring*, 107 U. S. 640; 27 L. Ed. 601; 2 S. Ct. 819.

Prouty v. Ruggles, 16 Pet. 336; *Vance v. Campbell*, 1 Black. 427; *Gould v. Rees*, 15 Wall. 187; *Miller v. Brass Co.* 104 U. S. 350; *James v. Campbell*, 104

U. S. 356; *Heald v. Rice*, 104 U. S. 737; *Matthews v. Machine*, 105 U. S. 54; *Bantz v. Frantz*, 105 U. S. 160; *Johnson v. R. R.* 105 U. S. 539; *Moffitt v. Rogers*, 106 U. S. 423.

If the effect of omitting the words in question is to extend the claim, the claim is enlarged by omitting an essential element of the patentee's invention and the reissue is invalid. — *Matthews v. Ironclad*, 124 U. S. 347; 31 L. Ed. 477; 8 S. Ct. 639.

Miller v. Brass Co. 104 U. S. 350; *Mahn v. Harwood*, 112 U. S. 354; *Parker v. Yale*, 123 U. S. 87.

The original patent and the first reissue having been distinctly limited to a construction shown, the second reissue, obtained nearly seven years later, omitting such element specifically claimed, is an inwarrantable enlargement. — *Cornell v. Weidner*, 127 U. S. 261; 32 L. Ed. 148; 8 S. Ct. 1152.

Yale v. James, 125 U. S. 447.

When every element of the combination claimed in the original patent is thereby made material to such combination, a reissue omitting one of such elements is for a different combination and void. — *Huber v. Nelson*, 148 U. S. 270; 37 L. Ed. 447; 13 S. Ct. 603.

Prouty v. Ruggles, 41 U. S. 336; *Brooks v. Fiske*, 56 U. S. 212; *Burr v. Duryee*, 68 U. S. 1; *Reckendorfer v. Faber*, 92 U. S. 347; *Gas Light Co. v. Boston*, 139 U. S. 481; *Topliff v. Topliff*, 145 U. S. 156; *Fuller v. Yentzer*, 94 U. S. 288; *Railway Co. v. Sayles*, 97 U. S. 554; *Meter Co. v. Desper*, 101 U. S. 332; *Eames v. Godfrey*, 68 U. S. 78; *Case v. Brown*, 69 U. S. 320; *Gould v. Rees*, 82 U. S. 187; *Gill v. Wells*, 89 U. S. 1; *Powder Co. v. California*, 98 U. S. 126; *Leggett v. Avery*, 101 U. S. 256; *James v. Campbell*, 104 U. S. 356; *Coon v. Wilson*, 113 U. S. 268; *Parker v. Yale*, 123 U. S. 87.

The reissue was saved from the fate of the original because its claims have but four elements whereas the claims of the original were construed to have five. We cannot now read into the claims the very element, the omission of which gave them vitality. If these claims are construed to include a tension device they are void for double patenting; if construed as containing but four elements, it is obvious that they are broader than the claims of the original. — *Thomson-Houston v. Western*, 158 Fed. 813 (2d case); 86 C. C. A. 73.

§ 873. Broadening — When Permissible.

It is the right of the patentee and his representatives to enlarge or restrict the claim so as to give it validity and secure the invention. — *Rubber v. Goodyear*, 76 U. S. 788; 19 L. Ed. 566.

Battin v. Taggart, 17 How. 84.

The general rules are (1) That the reissue cannot cover another invention than that of the original; (2) That the reissue cannot recover what was described but not claimed after long delay; (3) That while a reissue claim may be enlarged it can be done only when actual mistake has occurred and then only without delay; (4) That in reissues for enlarging the scope of a patent the rule of laches should be rigidly applied; (5) That the general purpose of the statute providing for reissues was to correct mistakes and errors, and not to enable the inventor from time to time to extend his monopoly so as to cover progress by others in his art. — *Miller v. Brass Co.* 104 U. S. 350; 26 L. Ed. 783.

If the amended specification does not enlarge the scope of the patent by extending the claim so as to cover more than was embraced in the original,

and thus cause the patent to include an invention not in the original, the rights of the public are not thereby narrowed, and the case is within the remedy intended by the statute. Those cases in which this court has held reissues to be invalid were of a different character, and were cases where by the reissued patent the scope of the original was so enlarged as to cover and claim as a new invention that which was either not in the original specification, as part of the invention described, or if described, was, by not being claimed, virtually abandoned, and dedicated to public use. — *Eames v. Andrews*, 122 U. S. 40; 30 L. Ed. 1064; 7 S. Ct. 1073.

Distinguishing, *Russell v. Dodge*, 93 U. S. 460; *Morey v. Lockwood*, 74 U. S. 230.

To warrant new and broader claims, such claims must not be merely suggested or indicated in original specification, drawings or model, but it must appear that they were constituent parts of the invention sought to be covered.

Nor is the applicant allowed to incorporate in his reissue claims embracing what has been rejected. — *Corbin v. Eagle*, 150 U. S. 38; 37 L. Ed. 989; 14 S. Ct. 28.

Bantz v. Frantz, 105 U. S. 160; *Heald v. Rice*, 104 U. S. 737; *Miller v. Brass Co.* 104 U. S. 350; *James v. Campbell*, 104 U. S. 356; *Topliff v. Topliff*, 145 U. S. 156.

The Supreme Court of the United States has held that while this section (4916) liberally construed, would only authorize reissue to correct specifications or claims defective or inoperative because too broad, it would construe the section liberally to give the commissioner of patents power to grant a reissue to expand claims which had been made too narrow by reason of accident, inadvertence or mistake, without fraud. But it has been held in a number of cases that the commissioner is without power to grant a reissue unless it shall clearly appear that the patent, as originally issued, was defective and inoperative for the invention intended; that this defect and inoperativeness arose through inadvertence and mistake; and, finally, that the patentee had not by lapse of time and laches, abandoned his right to have the correction made. — *Peoria v. Cleveland*, 58 Fed. 227; 7 C. C. A. 197.

A claim which made that which was no part of the invention one of its elements, and consequently essential to its infringement, was therefore clearly defective, which defect was properly cured by omitting the proper element from the reissue. — *Gaskill v. Myers*, 81 Fed. 854; 26 C. C. A. 642.

Where there has been an expansion of the patent to describe inventions substantially different from the original, covering nebulous combinations not exhibited therein, and where there has been protracted and unreasonable delay in face of the manufacture of articles not substantially covered by the original invention, the reissue has been held void; but the courts, recognizing the fact that the ordinary inventor is not usually skilled in technical rules of construction, and is apt to suppose that his claims protect him in the essential elements mentioned in them, and that these claims and specifications are usually drawn by men who are strangers to and ignorant of the art within which they lie, and that even skilled solicitors are not infallible in framing technical documents, have sanctioned reissues which permit the framing of claims adequate to secure the full benefits of the inventions designed to be protected by the patent laws. — *Crown v. Aluminum*, 108 Fed. 845; 48 C. C. A. 72.

Grant v. Raymond, 6 Pet. 243.

This case (*Miller v. Brass Co.* 104 U. S. 350) did not deny that a claim might be enlarged, in a reissued patent, but held that there must be a bona fide mistake, and that there must not be unreasonable delay; any considerable lapse of time affording opportunities and temptations to commit fraud. — *Crown v. Aluminum*, 108 Fed. 845; 48 C. C. A. 72.

The somewhat recent case of *Topliff v. Topliff*, 145 U. S. 56, stated that the power to reissue may be exercised when the patent is inoperative, because the claims were narrower than the actual invention, provided the error arose from inadvertence or mistake. The right, however, is subject to certain limitations, and among them that the reissue shall be for the same invention, as it appears from the specification and claims, and that there must be reasonable diligence in moving. It is also stated as something to be regarded as settled by the Supreme Court that the court will not review the decision of the Commissioner of Patents upon the question of inadvertence, accident or mistake, unless the matter is manifest from the record. The application was made in a little over four months, which ordinarily would be accepted as not an unreasonable time, provided public rights had not intervened. The specification of the original patent, when read in connection with the cuts, manifestly shows that the patentee intended a broader invention than that stated in the claims. — *Houghton v. Whitin*, 153 Fed. 740; 83 C. C. A. 84.

§ 874. Broadening — Miscellaneous Rules.

It would seem, under the old rule and former statute the question of construction of a reissue, whether for the same invention, was one of fact for the jury. — *Battin v. Taggart*, 58 U. S. 77; 15 L. Ed. 37.

When challenged in a court of justice as too broad, the words "substantially as herein described" may be resorted to as qualifying the claim. — *Burr v. Duryee*, 68 U. S. 531; 17 L. Ed. 750.

Parol testimony is not admissible in an application for a reissue to enlarge the scope or effect beyond what was described, suggested or substantially indicated in the original. — *Union v. Vandusen*, 90 U. S. 530; 23 L. Ed. 128.

The fact that the patentee has not been able to establish royalties on his original patent, and after four years obtained a reissue with broader claims which did not enable him to establish such royalties does not take the case outside the rule of reissue patents. — *Eby v. King*, 158 U. S. 366; 39 L. Ed. 1018; 15 S. Ct. 972.

White v. Dunbar, 119 U. S. 47; *Ives v. Sargent*, 119 U. S. 652; *Dunham v. Dennison*, 154 U. S. 103.

The drawings and descriptions of the two patents are identical, as are all the original four claims, except the first, which, in the reissue, is broadened. The scope of the original patent is further broadened by the addition of seven new claims in the reissue. The bill alleges infringement of all the claims of the reissue patent, and the demurrer attacks the validity of the reissued patent as a whole. We are of opinion that the validity of the claims in the reissue which were identical with those of the original patent are not affected thereby. — *Rawson v. Hunt*, 147 Fed. 239; 77 C. C. A. 381.

Walker on Pat. sects. 201, 249; *Gage v. Herring*, 107 U. S. 640; *Yale v. Sargent*, 117 U. S. 536; *Leggett v. Standard*, 149 U. S. 287; *International v. Maurer*, 44 Fed. 618.

§ 875. Delay — Excusable.

The decision of the Patent Office upon the question of delay in applying for a reissue is not final. — *Hoskin v. Fisher*, 125 U. S. 217; 31 L. Ed. 759; 8 S. Ct. 834.

Wollensak v. Reiher, 115 U. S. 96.

The fact that reissue was applied for only 13 days after the grant of the original patent does not establish its validity, as held in *Coon v. Wilson*, 113 U. S. 268. — *Yale v. Berkshire*, 135 U. S. 342; 34 L. Ed. 168; 10 S. Ct. 884.

Ives v. Sargent, 119 U. S. 652; *Parker v. Yale*, 123 U. S. 87.

The part of a sentence which is added in the statement of the object of an invention, states nothing which was not previously obvious. The narrowed and truthful reissue is, therefore, unobjectionable except that it was belated; and upon the point of laches in obtaining a reissue, the Federal courts are now sensitive. Delay in this regard is obnoxious, because, as a rule, individuals and the public have acquired, during such delay, "adverse equities which would be destroyed by a re-construction of a void claim." In this case, the adverse interests, whatever they are, arose after the termination of the Gibson litigation, and as soon as they came into being, they were warned by the reissue of the existence of a patent which covered the attempted infringement. This reissue cannot be declared void by reason of the lapse of time after the original was issued, without establishing a new rule of law upon the subject of reissued patents. — *Maitland v. Goetz*, 86 Fed. 124; 29 C. C. A. 607.

In this class of cases there should not be applied a stricter rule of diligence than that applied by statute in case of public use before application for the patent, even if so strict a limitation as that is applicable. — *Crown v. Aluminum*, 108 Fed. 845; 48 C. C. A. 72.

§ 876. Delay — Fatal.

The patent on its face is notice of defects therein; and unreasonable delay will render the reissue void. — *Wollensak v. Reiher*, 115 U. S. 96; 29 L. Ed. 350; 5 S. Ct. 1137.

Miller v. Brass Co. 104 U. S. 350; *Mahn v. Harwood*, 112 U. S. 354.

The application for the reissue was made nearly eleven years after the original patent was granted, and after machines effecting the shifting by other means had gone into use subsequently to the date of the original patent, and no sufficient excuse is given for the laches and delay. — *Brown v. Davis*, 116 U. S. 237; 29 L. Ed. 659; 6 S. Ct. 379.

The Washington solicitor failed to claim the vital point of the invention although it had been distinctly stated to him in writing. (As a certain class of patent solicitors are liable to do.) The omission was plain and might have been discovered by a single reading of the patent. *Held*, that after three years and after the event of infringement the conduct of the Washington solicitor as an excuse for the fact and their confidence in him as an excuse for the delay in applying for the reissue was insufficient. — *Ives v. Sargent*, 119 U. S. 652; 30 L. Ed. 544; 7 S. Ct. 436.

The reissue was taken out seven years after the original patent, and a year or two after the patentee knew that the defendant was making such an

article as is now alleged to be infringed cannot avail complainant. — *Matthews v. Ironclad*, 124 U. S. 347; 31 L. Ed. 477; 8 S. Ct. 639.

Unexplained delay in applying for a reissue is fatal to its claims. — *Electric v. Boston*, 139 U. S. 481; 35 L. Ed. 250; 11 S. Ct. 586.

Miller v. Brass Co., 104 U. S. 350; *Clements v. Odorless*, 109 U. S. 641; *Mahn v. Harwood*, 112 U. S. 354; *Wollensak v. Reiher*, 115 U. S. 96; *Ives v. Sargent*, 119 U. S. 652; *Hoskin v. Fisher*, 125 U. S. 217.

While it was ruled in *Railway v. Sayles*, 97 U. S. 563; *Clements v. Odorless*, 109 U. S. 649, and *Electric v. Boston*, 139 U. S. 502, that in cases of reissue and enlargement of the claims could not avail against patents granted, or articles made and sold, between the time of the original application and the time of the final granting of the reissued patent, it does not cover a case of reissue where there were new or different claims or any substantial departure from the claims first made. — *Hillborn v. Hale*, 69 Fed. 958; 16 C. C. A. 569.

Every one is constructively bound with notice of the issue of a patent, and, if actual notice of the original issue is to be regarded as binding the possessor of that knowledge with notice of all possibilities of reissue, consistency requires that the same effect be allowed to that constructive notice which all are bound to take of the issue of a patent; and, this being so, there can be no protection for intervenors in an act against a subsequent reissue of a patent, except by license or by conditions which amount to an equitable estoppel. No such meaning is expressed in, or can be fairly implied from the opinion in *Gaskill v. Myers*. — *American v. Swietusch*, 85 Fed. 968; 26 C. C. A. 506.

The original patent was granted April 11, 1893. The application for the reissue was filed Sept. 28, 1900. In the meantime various persons had been acting upon the supposed invalidity of the patent, which was declared invalid by the Circuit Court of Appeals for the Second Circuit in July, 1897. As early as 1895 the attention of the patentee was directly challenged to the specifications of the patent, and they were elaborately canvassed. If any error had been committed in the language employed or in claiming more than was new, it was discoverable then as it ever became, unless, indeed, a patentee has the right to await results which the courts may reach after prolonged litigation and examination of the subject. We cannot think that a patentee may thus experiment with his patent. On the contrary, we think that, when the grounds are disclosed for thinking there may be an error or mistake, he is bound in duty to the public to correct it by obtaining a reissue or to adhere to his original patent; and, if he declines to correct it, he should be deemed to be standing upon it as the measure of his right. — *Milloy v. Thomson-Houston*, 148 Fed. 843; 78 C. C. A. 533.

Section 4916 of the Revised Statutes authorizes a reissue (quoting the words of the statute). But it has been held, on grounds of public policy, that this right must be promptly exercised upon the discovery of the error. — *Milloy v. Thomson-Houston*, 148 Fed. 843; 78 C. C. A. 533.

Miller v. Brass Co., 104 U. S. 350; *Mahn v. Harwood*, 112 U. S. 354; *White v. Dunbar*, 119 U. S. 47; *Ives v. Sargent*, 119 U. S. 652; *Parker v. Yale*, 123 U. S. 87; *Dobson v. Lees*, 137 U. S. 258; *Wollensak v. Sargent*, 151 U. S. 221; *Walker on Pat.* sec. 227.

That where the necessity for applying for a reissue became apparent from a decision of the circuit court of appeals on an appeal from an interlocutory decree granting an injunction, and the complainant waited for over three years until the question could be decided upon appeal from a final decree.

Held: We think the decree in question was, in everything but name, a final decree. The complainant could not have received a more definite or final information regarding the invalidity of the claims. If such reasons for delay as are now advanced are to be sanctioned, the rights of the public will be seriously jeopardized and the door opened to excuses limited only by the ingenuity of counsel. — *Thomson-Houston v. Western*, 158 Fed. 813 (2d case); 86 C. C. A. 73.

§ 877. Delay — General Rules.

The reissue was not applied for until nearly five years after the date of the original patent and not until another inventor had made a substantial advance in the art which was sought to be covered by the reissue. — *Torrent v. Rodgers*, 112 U. S. 659; 28 L. Ed. 842; 5 S. Ct. 501.

Gill v. Wells, 22 Wall. 1; *Wood Paper Pat.*, 23 Wall. 568; *Powder v. Powder*, 98 U. S. 126; *Ball v. Langles*, 102 U. S. 128; *James v. Campbell*, 104 U. S. 356; *Heald v. Rice*, 104 U. S. 737; *Miller v. Brass Co.*, 104 U. S. 350; *Johnson v. R. R.*, 105 U. S. 539; *Bantz v. Frantz*, 105 U. S. 160; *Wing v. Anthony*, 106 U. S. 142; *Clements v. Odorless*, 109 U. S. 641; *McMurray v. Mallory*, 111 U. S. 97; *Mahn v. Harwood*, 112 U. S. 354.

A patent cannot lawfully be reissued for the mere purpose of enlarging the claim unless there has been a clear mistake inadvertently committed in the wording of the claim and the application for a reissue is sued within a reasonably short time. The granting of such reissues after the lapse of long periods of time is an abuse of the power and is founded on a total misconception of the law. The rights of the public here intervene, which are totally inconsistent with such tardy reissues, and the great opportunity and temptation to commit fraud after any considerable lapse of time, when the circumstances of the original application have passed out of mind, and the monopoly has proved to be of great value, make it imperative on the courts, as a dictate of justice and public policy, to hold the patentees strictly to the rule of reasonable diligence in making applications for this kind of reissues.

No precise limit of time can be fixed and laid down for all cases. The courts will always exercise a proper liberality in favor of the patentee. But in any case by such delay as the court may deem unnecessary and unreasonable, the right to a reissue will be regarded as having been abandoned and lost. In *Miller v. Brass Co.* by analogy to the law of public use before an application for a patent, we suggested that a delay of two years should be construed equally favorable to the public. But this was a mere suggestion by the way and was not intended to lay down any general rule. — *Mahn v. Harwood*, 112 U. S. 354; 28 L. Ed. 665; 5 S. Ct. 174; 6 S. Ct. 451.

Where the reissue is for the purpose of expanding the claims, and a delay of two years or more has taken place, which is unexplained, the question of laches is a question of law arising on the face of the bill, which avails as a defense, upon a general demurrer, for want of novelty. — *Wollensak v. Reiher*, 115 U. S. 96; 29 L. Ed. 350; 5 S. Ct. 1137.

When the reissue expands the claims, a delay of two years or more invalidates the reissue. — *Wollensak v. Reiher*, 115 U. S. 96; 29 L. Ed. 350; 5 S. Ct. 1137.

While no general rule can be laid down, an unexcused delay of two years, by analogy to the law of public use, will defeat a reissue. — *Ives v. Sargent*, 119 U. S. 652; 30 L. Ed. 544; 7 S. Ct. 436.

Wollensak v. Reiher, 115 U. S. 96; *Mahn v. Harwood*, 112 U. S. 354.

When there is delay of two years or more in applying for a reissue, the delay unless excused, invalidates the reissue. — *Hoskin v. Fisher*, 125 U. S. 217; 31 L. Ed. 759; 8 S. Ct. 834.

Wollensak v. Reiher, 115 U. S. 96.

The two year rule explained and modified. — *Topliff v. Topliff*, 145 U. S. 156; 36 L. Ed. 658; 12 S. Ct. 825.

Miller v. Brass Co. 104 U. S. 350; *Johnson v. Flushing*, 105 U. S. 539; *Mahn v. Harwood*, 112 U. S. 354; *Matthews v. Boston*, 105 U. S. 54; *Bantz v. Frantz*, 105 U. S. 160; *Wing v. Anthony*, 106 U. S. 142; *Moffitt v. Rogers*, 106 U. S. 423; *Gage v. Herring*, 107 U. S. 640; *Clements v. Odorless*, 109 U. S. 641; *McMurray v. Mallory*, 111 U. S. 97; *White v. Dunbar*, 119 U. S. 47; *Parker v. Yale*, 123 U. S. 87; *Coon v. Wilson*, 113 U. S. 268; *Wollensak v. Reiher*, 115 U. S. 96; *Electric v. Boston*, 139 U. S. 481; *Newton v. Furst*, 119 U. S. 373; *Ives v. Sargent*, 119 U. S. 652; *Worden v. Searles*, 121 U. S. 14; *Matthews v. Iron*, 124 U. S. 347.

It is declared to be settled that while no invariable rule can be laid down, a delay of two years by analogy to the law of public use should be construed equally favorably to the public. — *Wollensak v. Sargent*, 151 U. S. 221; 38 L. Ed. 137; 14 S. Ct. 291.

Ives v. Sargent, 119 U. S. 652; *Wollensak v. Reiher*, 115 U. S. 96; *Mahn v. Harwood*, 112 U. S. 354.

It is fair to presume, therefore, that the reissued patent was applied for and obtained because the patentee himself believed that the claims of his original patent, when fairly construed in connection with other parts of the specification, could not be made to embrace the new form of pump, with a chamber located above the cylinder, which had recently come into use, and that it was necessary to alter certain parts of the original specification, and to recast the original claims, to bring the new pump within the terms of his patent. If this was not the opinion of the patentee, or of those who acted as his advisers, when the reissued patent was taken out, then we fail to see what was the purpose which induced the application for the reissue. It is a self-evident proposition that the invention related to a simple structure, that it was clearly described in the original patent, as issued, was neither inoperative nor invalid by reason of any defect or insufficiency of the specification, but undoubtedly secured to the patentee the exclusive right to manufacture the kind of pump which he had described in his specification, and illustrated in his drawings. In short, if there was a substantial defect in the original specification, it consisted in the fact that it was not so drawn as to bring within its claims another kind of pump, that had come into use subsequent to the date of the original patent, which the patent might have been made to cover, if the patentee had foreseen the later mode of construction. For these reasons, and especially in view of the conduct of the patentee in applying for a reissue when there was no occasion for such application, unless he intended to enlarge the scope of his patent, we concur in the conclusion reached by the trial court touching the construction of the claims of the original Bean patent, and we further concur in the view that the claims of that patent were expanded in the reissue.

We are constrained to believe that the expansion of the claims of the original patent was the sole purpose of applying for a reissue.

It is not an insuperable objection to the validity of a reissued patent that the original claims have been enlarged in the reissue. Under some circumstances, it is doubtless true that a patent may be reissued in such a form as to extend its scope. But it has been held repeatedly that, to warrant such reissues, they must be applied for promptly, and that the application for the reissue must be accompanied with satisfactory proof that, solely through

accident or mistake, the patentee did not originally obtain all that he was fairly entitled to. — *Mast v. Iowa*, 76 Fed. 816; 22 C. C. A. 586.

Miller v. Brass Co., 104 U. S. 350; *Mahn v. Harwood*, 112 U. S. 354; *Coon v. Wilson*, 113 U. S. 268; *Parker v. Yale*, 123 U. S. 87; *Huber v. Mfg. Co.*, 148 U. S. 270; *Peoria v. Cleveland*, 58 Fed. 227.

§ 878. Delay — Intervening Rights.

Where complainant delayed six months, and in the meantime the subject of the reissue claims has gone into general use, such reissue is an attempt to cover what had come into general use by others, and is therefore void. — *Parker v. Yale*, 123 U. S. 87; 31 L. Ed. 100; 8 S. Ct. 38.

Mahn v. Harwood, 112 U. S. 354; *Coon v. Wilson*, 113 U. S. 268; *Ives v. Sargent*, 119 U. S. 652.

We have here the case of an application for the reissue of a patent made after an acquiescence of more than 12 years. The public had been freely using the devices. Upon the facts disclosed by this record, it seems to us that, even if the first claim of the reissue were otherwise sustainable, yet it must be held to be invalid in view of the intervening private and public rights which have sprung up, and the unreasonable delay in the application for the reissue. — *Horn v. Pelzer*, 91 Fed. 665; 34 C. C. A. 45.

Miller v. Brass Co., 104 U. S. 350; *Ives v. Sargent*, 119 U. S. 652; *Eby v. King*, 158 U. S. 366; *Hubel v. Dick*, 28 Fed. 132; *Peoria v. Cleveland*, 58 Fed. 227; *Machine Co. v. Searles*, 50 Fed. 82.

The case would be different if Painter had unreasonably delayed to assert his rights to reissue after such notice was brought home to him, and where his silence and inaction had misled other parties to their injury; and the fact that the original patent contained a statement of his invention which covered the subject matter of the reissued claim, and that a reissue to fully secure the invention disclosed was authorized by law, was sufficient notice that this patent was subject to such right of reissue, which right was liable to be exercised at any time at least within two years. — *Crown v. Aluminum*, 108 Fed. 845; 48 C. C. A. 72.

§ 879. Delay — Miscellaneous Rules.

The question whether the delay has been reasonable or unreasonable is for the court to determine; and it cannot substitute the decision of the patent office for its own. — *Wollensak v. Reiher*, 115 U. S. 96; 29 L. Ed. 350; 5 S. Ct. 1137.

The question of delay in applying for a reissue is a question of law for the court. — *Hoskin v. Fisher*, 125 U. S. 217; 31 L. Ed. 759; 8 S. Ct. 834.

Wollensak v. Reiher, 115 U. S. 96.

§ 880. Decisions of Commissioner.

Where the commissioner accepts a surrender of an original patent and grants a new patent, his decision in the premises, in a suit for infringement, is final and conclusive, and is not re-examinable in such a suit in the circuit court unless it is apparent upon the face of the patent that he has exceeded his authority, that there is such a repugnancy between the old and the new patent, that it must be held, as matter of legal construction, that the new patent is not for the same invention as that embraced and secured in the original patent. — *Seymour v. Osborne*, 78 U. S. 516; 20 L. Ed. 33.

Battin v. Taggart, 17 How. 83; *O'Reilly v. Morse*, 15 How. 111; *Sickes v. Evans*, 2 Cliff. 222; *Allen v. Blunt*, 3 Story, 744.

The action of the Commissioner is final except as to matters of legal construction. — *Union v. Vandusen*, 90 U. S. 530; 23 L. Ed. 128.

The action of the commissioner is final as to question of fraud. — *Brown v. Guild*, 90 U. S. 181; 23 L. Ed. 161.

The Commissioner of Patents has no jurisdiction to grant a reissue for any other or different invention than that of the original. — *Ball v. Langles*, 102 U. S. 128; 26 L. Ed. 104.

We think it is a serious question whether the Commissioner of Patents had any jurisdiction, under R. S. 4916, to consider the application upon the bare statement that the patentee desired to surrender his patent and obtain a reissue. The Commissioner is authorized to reissue patents in certain specified cases, and if the petition makes no pretense of setting forth facts entitling the patentee to a reissue, it is exceedingly doubtful whether he obtain any jurisdiction to act at all. — *Eby v. King*, 158 U. S. 366; 39 L. Ed. 1018; 15 S. Ct. 972.

In the case under consideration the examiner acted upon the application as if it were a new proceeding, and dealt with it as the evidence before him seemed to warrant, but his action in rejecting some of the claims which had been repeated from the original patent did not affect the patent. It is true that it was within his power to reject any claims contained in the application for a reissue which he judged to be invalid, whether contained in the original patent or not. It is also true that the reasons given for the rejection of such claims might apply equally to the same claims contained in the original patent, but with respect to such claims he was *functus officio*. His opinion thereon was but his personal opinion, and, however persuasive it might be, did not oust the jurisdiction of any court to which the owner might apply for an adjudication of his rights, and, as the examiner had no authority to affect the claims of the original patent, no appeal was necessary from his decision. — *McCormick v. Aultman*, 169 U. S. 606; 42 L. Ed. 875; 18 S. Ct. 443.

If by reason of any inadvertence or mistake in the drawings or specifications a patent is rendered in part inoperative, and the patentee promptly applies for a reissue and no substantial rights are affected, or fraudulent intent charged, we think the commissioner has the right, under section 4916 R. S., to cause a new patent to issue, and that under the circumstances, his decision is conclusive. We know of no authority in conflict with this proposition. — *Beach v. Hobbs*, 92 Fed. 146; 36 C. C. A. 248.

It is said that the legal conclusion is closed in favor of the appellants, because it must be presumed that before the reissue was issued, there was before the Patent Office satisfactory evidence that, but for the inadvertence or mistake, the original letters would have taken the form that the reissue now employs. That some such presumption properly attaches itself to the reissue patent we may admit. At most, however, it is a *prima facie* presumption only. It is not a presumption that debars appellant from challenging the validity of the issue by showing facts that would overcome the presumption. The reissue is before us just as it was before the Patent Office before it was allowed, except that while the burden of proof then was upon the appellants, the burden is now upon the appellees. — *Franklin v. Illinois*, 138 Fed. 58; 70 C. C. A. 484.

§ 881. Different Invention.

A patent issued for a process cannot be reissued for a machine. — *Heald v. Rice*, 104 U. S. 737; 26 L. Ed. 910.

Powder v. Powder, 98 U. S. 134.

He entitled his original patent as for a new and useful machine, while with equal explicitness, in his reissue, he declared that he had invented a new and improved process. This is at least a *prima facie* departure from the original patent which would seem to be serious, if not fatal, under a law which limits the power of the Commissioner of Patents so as to issue a new patent only for the same invention. — *Eachus v. Broomall*, 115 U. S. 429; 29 L. Ed. 419; 6 S. Ct. 229.

Powder v. Powder, 98 U. S. 126.

Where the original patent was for a process and the reissue was for the article of manufacture, the new article of manufacture is a product which results from the use of the process described in the patent, and not one which may be produced in any other way. — *Plummer v. Sargent*, 120 U. S. 442; 30 L. Ed. 737; 7 S. Ct. 640.

§ 882. Disclaimer.

It is not competent for the patentee or his assignee, by merely disclaiming all the changes made in the reissue patent, to revive and restore the original patent. This could be done only, if it could be done at all, by surrender of the reissued patent and the grant of another reissue. — *McMurray v. Mallory*, 111 U. S. 97; 28 L. Ed. 365; 4 S. Ct. 375.

We do not think that the reissued patent as it stood after the filing of the disclaimer, was open to the objection that it was not for the same invention as that of the original patent. Whatever there was of objectionable matter inserted in the specification or the first claim of the reissue, when it was granted, was removed by the disclaimer. The reissue was granted within ten months of the original. The single claim of the original patent was repeated in the reissue as the second claim of the latter; and the first claim of the reissue, as it stood after the disclaimer did not expand beyond the claim of the original what was claimed in the reissue. — *Hurlbut v. Schillinger*, 130 U. S. 456; 32 L. Ed. 1011; 9 S. Ct. 584.

§ 883. General Rules.

Patents, when inoperative or invalid, may in certain cases, be surrendered and reissued; but the new patent in such case must be for the same invention as the original patent; and if it is for a different invention, the reissue is invalid, for the reason that it was granted without authority of law. — *Marsh v. Seymour*, 97 U. S. 348; 24 L. Ed. 963.

Sec. 4916 construed in *Powder v. Powder*, 98 U. S. 126; 25 L. Ed. 77.

Reissued letters patent must be for the same invention as that secured in the original patent. — *Bates v. Coe*, 98 U. S. 31; 25 L. Ed. 68.

Seymour v. Osborne, 11 Wall. 546.

The general rules are, (1) that the reissue cannot cover another invention than that of the original; (2) that the reissue cannot recover what was described but not claimed after long delay; (3) that while a reissue claim may be enlarged, it can be done only when actual mistake has occurred and then

only without delay; (4) that in reissues for enlarging the scope of a patent, the rule of laches should be rigidly applied; (5) that the general purpose of the statute providing for reissues was to correct mistakes and errors, and not to enable the inventor from time to time to extend his monopoly so as to cover progress by others in his art. — *Miller v. Brass Co.* 104 U. S. 350; 26 L. Ed. 783.

The case of *Gage v. Herring*, 107 U. S. 640, holds that the invalidity of a new claim in a reissue does not impair the validity of a claim in it which is only a repetition and separate statement of a claim in the original patent. It also holds that a reissue patent is within the letter and spirit of sections 4917 and 4922; and that where a defendant has infringed such a restated valid claim of a reissue, the plaintiff, on filing a disclaimer of the new and invalid claims of the reissue, may have a decree, without costs, for the infringement of such valid claim, where there has been no unreasonable delay in entering the disclaimer. — *Yale v. Sargent*, 117 U. S. 536; 29 L. Ed. 954; 6 S. Ct. 934.

Reissues are subject to the following qualifications:

1. That it shall be for the same invention as the original patent, as such invention appears from the specification and claims of such original.
2. That due diligence must be exercised in discovering the mistake in the original patent, and that, if it be sought for the purpose of enlarging the claim, the lapse of two years will ordinarily, though not always, be treated as evidence of an abandonment of the new matter to the public to the same extent that a failure by the inventor to apply for a patent within two years from the public use or sale of his invention is regarded by the statute as conclusive evidence of an abandonment of the patent to the public.
3. That this court will not review the decision of the Commissioner upon the question of inadvertence, accident or mistake, unless the matter is manifest from the record; but that the question whether the application was made within a reasonable time is, in most, if not in all such cases, a question of law for the court. — *Topliff v. Topliff*, 145 U. S. 156; 36 L. Ed. 658; 12 S. Ct. 825.

It is a mistake to suppose that the case was intended to settle the principle that, under no circumstances, would a reissue containing a broader claim than the original be supported. We have no desire to modify in any respect the views expressed in that and subsequent cases. There is no doubt as was said in *Giant v. California*, 98 U. S. 126, that a reissue can be granted only for the same invention which formed the subject for the original, since the express words of the Act are "a new patent for the same invention." The specification may be amended so as to make it more clear and distinct; the claim may be modified so as to make it more conformable to the exact rights of the patentee, but the invention must be the same. — *Topliff v. Topliff*, 145 U. S. 156; 36 L. Ed. 658; 12 S. Ct. 825.

Explaining and limiting, *Miller v. Brass Co.* 104 U. S. 350; *Giant v. California*, 98 U. S. 126.

The plain purpose of this section is to give the patentee an opportunity to make valid and operative that which was before invalid and inoperative. — invalid, because it claimed as new that which had been previously invented or used by the public; inoperative because the specification was defective or insufficient. New matter cannot be introduced, nor can the scope of the invention be enlarged. All that the applicant can do is to so amend his patent as to enable him to receive some practical and beneficial result from his actual invention, of which he had been deprived by defects or omissions

in the original patent. The object of a patentee applying for a reissue is not to reopen the question of the validity of the original patent, but to rectify any error which may have been found to have arisen from inadvertence or mistake. But until the amended patent shall have been issued the original stands precisely as if a reissue had never been applied for. — *McCormick v. Aultman*, 169 U. S. 606; 42 L. Ed. 875; 18 S. Ct. 443.

Allen v. Culp, 166 U. S. 501.

§ 884. Grounds for.

When a patent was granted to the wrong person, an action by the rightful inventor will lie to compel a surrender and reissue. — *Appleton v. Bacon*, 67 U. S. 699; 17 L. Ed. 338.

Where the applicant has been led into an error or mistake by the commissioner it was ground for a reissue. — *Morey v. Lockwood*, 75 U. S. 230; 19 L. Ed. 339.

Now whilst, as before stated, we do not deny that a claim may be enlarged in a reissued patent, we are of opinion that this can only be done when an actual mistake has occurred; not from a mere error of judgment, for that may be rectified by appeal, but a real bona fide mistake, inadvertently committed; such as a court of chancery in cases within its ordinary jurisdiction will correct. — *Miller v. Brass Co.* 104 U. S. 350; 26 L. Ed. 783.

The patent has been the subject of an earnest contest in the Patent Office for four years; had been put in interference with five other devices, and it was scarcely possible that, after this long litigation, the patentee should not have detected defects in his original application, and have taken this opportunity of correcting them. His experience in this litigation had doubtless appraised him of the weak points in his prior specification and claims, and it was perfectly competent for him to restate them, provided his patent was not essentially broadened to cover intervening devices. — *Hobbs v. Beach*, 180 U. S. 383; 45 L. Ed. 586; 21 S. Ct. 409.

Defendant's argument against the validity of the reissue is ingenious, but the facts are plain, and not unusual. The device of the specification was recognized as an invention by the manufacturers of lighting fixtures. They became licensees, and the patent was acquiesced in and respected for a number of years. The Gibson litigation showed that the principal claim was fatally loose in the opinion of both the circuit and appellate courts. It was reissued so as to make the claim correspond with and be limited to the description in the specification. The claim was narrowed but narrowed to conform to the specification, and to state the same invention which it had described. The reissue is not one of the class of reissues of which *Machine Co. v. Searle*, 60 Fed. 82, is an example, which pretend to narrow a claim but which in fact describe an invention of an independent character and one which the patentee either did not make or omitted to describe, but which he now finds "lurking" somewhere in the structure. — *Maitland v. Goetz*, 86 Fed. 124; 29 C. C. A. 607.

§ 885. Inadvertence, Accident, or Mistake.

The applicant obtained his original, Apr. 14, 1863. He obtained his first reissue Aug. 23, 1864. He obtained his second reissue Aug. 3, 1869. He obtained his fourth reissue Oct. 4, 1870. The invention was a simple stamp cancelling tool. The court held that in view of the simplicity of the patent on the one hand and in view of the remarkable efforts of the inventor to make

his patent cover all future improvements from time to time, he had forfeited his right to what he had originally invented.

For a sharp rebuke to designing reissue applicants, see this case. — *James v. Campbell*, 104 U. S. 356; 26 L. Ed. 786.

An error due to inadvertence or mistake apparent on the face of the patent may be cured by prompt surrender and reissue, but such a right will be abandoned by unreasonable delay. — *Miller v. Brass Co.* 104 U. S. 350; 26 L. Ed. 783.

Two applicants some nine years after issue discover that their solicitor has "mixed those children up," the claims of the one being issued to the other. Therefore they obtained a reissue separately. *Held*, that, (1) As to the patent receiving the broadened claim under the reissue, it is void under the rule of *Miller v. Brass Co.* 104 U. S. 350; and (2) that as to the patent disclaiming the broader claims, that it covered as limited only a mechanical improvement upon the other. — *Hartshorn v. Saginaw*, 119 U. S. 664; 30 L. Ed. 539; 7 S. Ct. 421.

The misapprehension of the applicant as to the efficiency of a claim does not amount to inadvertence, accident or mistake. — *Yale v. James*, 125 U. S. 447; 31 L. Ed. 807; 8 S. Ct. 967.

Swain v. Ladd, 102 U. S. 408.

An alleged error of "omission of claims" where it was evident that the "error" was discovered in subsequent inventions is not ground for reissue. — *Electric v. Boston*, 139 U. S. 481; 35 L. Ed. 250; 11 S. Ct. 586.

Clements v. Odarless, 109 U. S. 641; *Mahn v. Harwood*, 112 U. S. 354; *Coon v. Wilson*, 113 U. S. 268; *Newton v. Furst*, 119 U. S. 373; *Worden v. Scarles*, 121 U. S. 11; *Matthews v. Iron*, 124 U. S. 347.

If the petition does not set forth grounds for reissue under R. S. 4916 the Commissioner does not acquire jurisdiction. — *Eby v. King*, 158 U. S. 366; 39 L. Ed. 1018; 15 S. Ct. 972.

There are cases in which the description of an invention, and the claims sought to be founded upon it, by the applicant for a patent, are so plain and unequivocal upon the face of the application itself, that the judicial mind cannot be convinced that he intended to describe and claim any other invention than that for which the patent was granted; and in such cases the courts ought not to hesitate to review the decision of the commissioner upon the question of inadvertence, accident or mistake, and should refuse to be bound by it when the record upon the application for the reissue discloses that no explanatory facts or circumstances, adequate to account for the error, were brought to his attention. — *Featherstone v. Bidwell*, 57 Fed. 631; 6 C. C. A. 487.

With respect to the proof of inadvertence, accident or mistake, the action of the commissioner is conclusive, if there is any evidence before him tending to show such accident, inadvertence or mistake, as will, in law, warrant a reissue. With respect to whether the original patent is inoperative and defective, the court has always reserved the right to review the action of the commissioner. If it shall appear from an examination of the new and old patents that the old patent was not defective or inoperative but was for a complete invention, and that the reissue was taken out to secure another and different invention, lurking in the mechanical arrangement of parts, the Supreme Court has always held the reissue void. *Parker v. Yale*, 123 U. S.

87. Again, if an examination of the patent office record discloses that there was no evidence before the commissioner of accident, inadvertence or mistake, such as to warrant him in reissuing the patent, or that there was record evidence of a conclusive character, showing that there could have been no accident, inadvertence or mistake, the Supreme Court has not hesitated to hold a reissue void. — *Peoria v. Cleveland*, 58 Fed. 227; 7 C. C. A. 197.

Huber v. Mfg. Co. 148 U. S. 270; *Huber v. Mfg. Co.* 38 Fed. 836; *Mahn v. Harwood*, 112 U. S. 354.

§ 886. Scope of.

If he were the author of any other invention than that which he specifically describes and claims, though he might have asked to have it patented at the same time and in the same patent, yet if he had not done so, and afterwards desired to secure it, he is bound to make a new and distinct application for that purpose, and make it the subject of a new and different patent. When a patent fully and clearly, without ambiguity or obscurity, describes and claims a specific invention, complete in itself, so that it cannot be said to be inoperative or invalid by reason of a defective or insufficient specification, a reissue cannot be had for the purpose of expanding and generalizing the claim so as to make it embrace an invention not described and specified in the original. — *James v. Campbell*, 104 U. S. 356; 26 L. Ed. 786.

Burr v. Duryee, 68 U. S. 577; *Miller v. Brass Co.* 104 U. S. 350.

It would seem on the authority of the Goodyear vulcanized India rubber patent that a patent covering only the process, where both process and product were new, may be reissued to cover both process and product. — *James v. Campbell*, 104 U. S. 356; 26 L. Ed. 786.

It is clearly to be understood, from the entire language, that the things to be included are only the things which properly belonged to the invention as embodied in the original patent; that what the invention was is to be ascertained by consulting the original patent; and that, while the new description may properly contain things which are indicated in the original specification, drawings or patent office model (though not sufficiently described in the original specification) it does not follow that what was indicated in the original specification, drawings or patent office model is to be considered as a part of the invention, unless the court can see, from a comparison of the two patents, that the original patent embodied, as the invention intended to be secured by it, what the claims of the reissue are intended to cover. — *Parker v. Yale*, 123 U. S. 87; 31 L. Ed. 100; 8 S. Ct. 38.

It is well settled that no construction can be given to the claims of the reissue involved in this suit which will include what was covered by the rejected claims under either the original or reissue applications. — *Fox v. Perkins*, 52 Fed. 205; 3 C. C. A. 32.

Shepard v. Carrigan, 116 U. S. 597; *Sutter v. Robinson*, 119 U. S. 530; *Dobson v. Lees*, 137 U. S. 258; *Roemer v. Peddie*, 132 U. S. 313.

§ 887. Surrender — Effect of.

A surrender of the patent within the sense of the provision means, an act which, in judgment of law, extinguishes the patent. It is a legal cancellation of it and hence can no more be the foundation for the assertion of a right after the surrender than could a repealed act of Congress. — *Moffitt v. Garr*, 66 U. S. 273; 17 L. Ed. 207.

The surrender of a patent extinguishes pending suits. — *Moffitt v. Garr*, 66 U. S. 273; 17 L. Ed. 207.

Surrenders take effect when the amended patent is issued, and from that time the original patent ceases to be operative as a franchise to vest in the patentee the exclusive right to make and use the invention, and vend the same to others to be used. — *Reedy v. Scott*, 90 U. S. 352; 23 L. Ed. 109.

Surrendered patents cease to be operative when the new patent is issued; from which it follows that such a patent, after the surrender, is not the proper foundation for an action to recover either damages or profits for the infringement of the invention. — *Reedy v. Scott*, 90 U. S. 352; 23 L. Ed. 109.

The surrender of the patent in suit after final judgment and decree does not affect the judgment or decree. — *Mevs v. Conover*, 131 U. S. cxlii, app.; 23 L. Ed. 1008.

A patent after it is surrendered cannot be the foundation of any suit. The surrender of a patent pendente lite dismisses the suit. — *Meyer v. Pritchard*, 131 U. S. ccix, app.; 23 L. Ed. 961.

Moffitt v. Garr, 1 Black, 282; *Reedy v. Scott*, 90 U. S. 352; *Cleveland v. Chamberlain*, 1 Black, 426; *Lord v. Veazie*, 8 How. 255.

Under the Act of 1837 the surrender of a patent for the purpose of a reissue extinguished the original and all rights or claims thereunder. — *Peck v. Collins*, 103 U. S. 660; 26 L. Ed. 512.

A void reissue does not affect original application on which patent was granted. — *Washburn v. Beat Em All*, 143 U. S. 275; 36 L. Ed. 154; 12 S. Ct. 443.

Where a patent has been surrendered and reissued, and such reissue is held void, the patentee cannot proceed under his original patent nor recover damages thereunder. — *Eby v. King*, 158 U. S. 366; 39 L. Ed. 1018; 15 S. Ct. 972.

Moffitt v. Garr, 66 U. S. 273; *Reedy v. Scott*, 90 U. S. 352; *Peck v. Collins*, 103 U. S. 660; *McMurray v. Mallory*, 111 U. S. 97; *Gage v. Herring*, 107 U. S. 640.

It is true that in making his surrender the patentee declares that his patent is inoperative and invalid; but this is not necessarily so for all purposes, but for the purpose for which he desires to have it reissued. Such a patent might be inoperative and invalid as against certain persons who had pirated the underlying principle of the patent, and avoided infringing the exact language of the claim, and yet be perfectly valid as against others who were making machines clearly covered by their language. — *Allen v. Culp*, 166 U. S. 501; 41 L. Ed. 1093; 17 S. Ct. 644.

When a patent is thus surrendered there can be no doubt that it continues to be a valid patent until it is reissued, when it becomes inoperative; but, if a reissue be refused, it is entirely clear that the surrender never takes effect, and the patent stands as if no application had ever been made for a reissue. Whether, if the reissue be void, the patentee may fall back on his original patent has never yet been decided by this court, although the question was raised in *Eby v. King*, 158 U. S. 366; but, as the original patent was also held to be void, it did not become necessary to express an opinion upon the question. But if the original application for a reissue be rejected, the original patent stands precisely as though a reissue had never been applied for,

unless, at least, the reissue be refused upon some ground equally affecting the original patent. — *Allen v. Culp*, 166 U. S. 501; 41 L. Ed. 1093; 17 S. Ct. 644.

To attempt to cancel a patent upon an application for reissue when the first patent is considered invalid by the examiner would be to deprive the applicant of his property without due process of law, and would be in fact an invasion of the judicial branch of the government by the executive. — *McCormick v. Aultman*, 169 U. S. 606; 42 L. Ed. 875; 18 S. Ct. 443.

The Circuit Court of Appeals certified the following question to the Supreme Court, in *McCormick v. Aultman*, 69 Fed. 371:

If a patentee applies for a reissue of his patent, and includes among the claims under the new application the same claims as those which were included in the old patent, and the examiner of the patent office rejects some of such claims, and allows others, both old and new, does the patentee, by abandoning his application for a reissue, and by procuring a return of his original patent, hold his patent invalidated as to those claims which the examiner rejected?

The Supreme Court answered the question thus:

The fact that the rules of the patent office require that the original patent should be placed in its custody for the purpose of surrendering it upon the issue of an amended patent gives that department no right to the possession of it upon the rejection of the application for a reissue. If the patentee abandoned his application for a reissue, he is entitled to a return of his original patent precisely as it stood when such application was made, and the Patent Office has no greater authority to mutilate it by rejecting any of its claims than it had to cancel the entire patent. — *McCormick v. Aultman*, 169 U. S. 606; 42 L. Ed. 875; 18 S. Ct. 443.

When the patentee came to ask for a reissue, he was confronted with certain conditions on which only could the reissue be permitted. One was that the specifications of his patent, as it (they) stood, were inoperative. He was obliged to aver and prove that they were so. If this was true, the patentee had been exploiting a patent which, though it might have contained the germ of an invention, was practically useless to the public, for a patent which does not disclose a way to work or use the invention does not constitute the expected consideration for the grant. Having averred in a solemn manner, and to induce the granting of a reissue, that the fact was as just stated, he was estopped from claiming otherwise. — *Coffield v. Fletcher*, 167 Fed. 321; C. C. A.

Moffitt v. Garr, 1 Black. 273; *Reedy v. Scott*, 23 Wall. 352; *Peck v. Collins*, 103 U. S. 660; *Gage v. Herring*, 107 U. S. 640; *Coon v. Wilson*, 113 U. S. 268; *Eby v. King*, 158 U. S. 366; *McCormick v. Aultman*, 169 U. S. 606.

Note: This certainly is a holding which will be open to some criticism in view of the decision in *McCormick v. Aultman*, *supra*. To what extent the averments in an application for a reissue may be regarded as an estoppel is a serious question, and one which cannot be regarded as finally settled by this decision for all cases.

§ 888. Tests of Validity of.

The construction of a reissue in a court of equity is a question to be determined by a comparison of the original and reissue; and with the aid of expert testimony in cases where the specification is technical. — *Seymour v. Osborne*, 78 U. S. 516; 20 L. Ed. 33.

Sickles v. Evans, 2 Cliff. 203; *Bischoff v. Wethered*, 9 Wall. 812; *Betts v. Menzies*, 4 B. & S. Q. B. 999.

Equivalents are, doubtless, allowed to a patentee or owner of a patent to shut out infringements, but the patent act furnishes no support to the theory that the patentee may surrender a patent for an invention consisting of a combination of old ingredients and amend the descriptive parts of the specification by striking out the entire description of one of the ingredients of the combination and inserting in lieu thereof a full description of several other devices without any allegation that they are the equivalents of the one whose description is stricken out, or any explanation whatever showing the reason why the change was made. — *Gill v. Wells*, 89 U. S. 1; 22 L. Ed. 699.

When the reissue is clearly void by comparison with the original as a matter of law, extensive evidence is unnecessary; but where such evidence is required it is proper that it should be considered. — *Heald v. Rice*, 104 U. S. 737; 26 L. Ed. 910.

James v. Campbell, 104 U. S. 356; *Miller v. Brass Co.* 104 U. S. 350; *Burr v. Duryee*, 68 U. S. 531; *Powder v. Powder*, 98 U. S. 139; *Battin v. Taggart*, 58 U. S. 77; *Bischoff v. Wethered*, 76 U. S. 812; *Seymour v. Osborne*, 78 U. S. 545.

What was suggested in the original specification, drawings or patent office model is not to be considered as a part of the invention intended to have been covered by the original patent, unless it can be seen from a comparison of the two patents that the invention, which the original patent was intended to cover embraced the things thus suggested, or indicated in the original specification, drawings, or patent office model, and unless the original specification indicated that those things were embraced in the invention intended to have been secured by the original patent. — *Flower v. Detroit*, 127 U. S. 563; 32 L. Ed. 175; 8 S. Ct. 1291.

Parker v. Yale, 123 U. S. 87; *Hoskin v. Fisher*, 125 U. S. 217.

We are of opinion that the circuit court committed an error in excluding the original patent. It was relevant evidence upon the question whether the reissue was "for the same invention" as the original, and the issue on that subject was sufficiently raised by the averment of the complainant and the denial in the answer. — *Oregon v. Excelsior*, 132 U. S. 215; 33 L. Ed. 344; 10 S. Ct. 54.

§ 889. Miscellaneous Rules.

Under the general statute, which did not specifically provide for reissues, the government had the right, incident to its power to grant a patent, to grant a reissue in case of accident or mistake. — *Grant v. Raymond*, 6 Pet. 218; 8 L. Ed. 376.

The second patent being a continuation of the first one, the rights of the plaintiff must be ascertained by the law under which the original application was made. — *Shaw v. Cooper*, 7 Pet. 292; 8 L. Ed. 689.

Moneys recovered on judgments in suits or voluntary payment under the first patent, upon the surrender cannot be recovered back. — *Moffitt v. Garr*, 66 U. S. 273; 17 L. Ed. 207.

A reissue has no connection with or bearing upon antecedent suits; it has as to subsequent suits. — *Moffitt v. Garr*, 66 U. S. 273; 17 L. Ed. 207.

Upon an application for a reissue the commissioner should pass upon the sufficiency of applicant's title to apply for reissue. — *Holloway v. Whiteley*, 71 U. S. 522; 18 L. Ed. 335.

It was held by the court, in view of the Patent Act of 1832, that the fact of the granting of the reissued patent closed all inquiry into the existence of inadvertence, accident or mistake, and left open only the question of fraud to the jury. — *Seymour v. Osborne*, 78 U. S. 516; 20 L. Ed. 33.

R. R. v. Stimpson, 4 How. 384.

Note: Under the later law and more recent rulings, this is regarded too broad.

Reissued patents, in order that they may be valid, must be for the same invention as the surrendered originals. The express provision in the new Patent Act is that no new matter shall be introduced into the specification, and that in the case of a patent for a machine neither the model nor drawings shall be amended, except each by the other. — *Gill v. Wells*, 89 U. S. 1; 22 L. Ed. 699.

Pending suits are defeated when it appears that the patent on which the suit is founded has been surrendered, nor is a supplemental bill setting up the reissued patent a proper pleading to revive such a suit in equity, as nothing can be recovered, either as damages or profits for infringement of the surrendered patent. — *Reedy v. Scott*, 90 U. S. 352; 23 L. Ed. 109.

Moffitt v. Garr, 1 Black, 273.

The reissue together with the corrected specification has the same effect and operation in law on the trial of all actions for causes hereafter (thereafter) arising, as though the same had been originally filed in such correct form. — *Reedy v. Scott*, 90 U. S. 352; 23 L. Ed. 109.

The defendant must overcome the presumption against him arising from the decision of the Commissioner of Patents in granting the reissue. — *Smith v. Goodyear*, 93 U. S. 486; 23 L. Ed. 952.

The statute in force at the time of the issue of the original patent authorized a surrender and reissue whenever any patent was "inoperative or invalid by reason of a defective or insufficient description or specification or by reason of the patentee claiming in his specification as his own invention more than he had a right to claim as new." The statute in force at the time of the reissue made no change in this except by striking out the words "description or" Stat. 4th July, 1836, Ch. 357, sec. 13 (5 Stat. at L, 117): R. S. sec. 4916. — *Gage v. Herring*, 107 U. S. 640; 27 L. Ed. 601; 2 S. Ct. 819.

It was never lawful to cover, by the claims of a reissue, an improvement made after the granting of the original patent. — *Union v. U. S.* 112 U. S. 624; 28 L. Ed. 828; 5 S. Ct. 475.

The combination covered by the claim in the reissued patent is, in law and in fact, merely a mechanical equivalent for that which was already covered by the C. patent, which had the priority of invention. For this reason we hold the reissue invalid. — *Hartshorn v. Saginaw*, 119 U. S. 664; 30 L. Ed. 539; 7 S. Ct. 421.

The patentee having imposed words of limitation upon himself in his claims, especially when so required by the patent office in taking out his reissue, is bound by such limitations, in subsequent suits on the reissued patents. — *Crawford v. Heysinger*, 123 U. S. 589; 31 L. Ed. 269; 8 S. Ct. 399.

Leggett v. Avery, 101 U. S. 256; *Goodyear v. Davis*, 102 U. S. 222; *Fay v. Cordesman*, 109 U. S. 408; *Mahn v. Harwood*, 112 U. S. 354; *U. S. v. Union*,

112 U. S. 624; *Sargent v. Hall*, 114 U. S. 63; *Shepard v. Carrigan*, 116 U. S. 593; *White v. Dunbar*, 119 U. S. 47; *Sutter v. Robinson*, 119 U. S. 530; *Bragg v. Fitch*, 121 U. S. 478; *Snow v. Lake Shore*, 121 U. S. 617.

A reissue applied for subsequent to the expiration of a foreign patent upon the original is invalid. — *Commercial v. Fairbank*, 135 U. S. 176; 34 L. Ed. 88; 10 S. Ct. 972.

Claims of a reissue patent must be limited to the specific mechanism claimed in the original patent. — *Electric v. Boston*, 139 U. S. 481; 35 L. Ed. 250; 11 S. Ct. 586.

Sutter v. Robinson, 119 U. S. 530.

Where an application was made on the ground of a defect in the "omission of claims," and it appears that the real object of the reissue was to cover apparatus covered by subsequent patents, the reissue claim was held invalid. — *Electric v. Boston*, 139 U. S. 481; 35 L. Ed. 250; 11 S. Ct. 586.

Does not invalidate original claim when it is repeated in reissue. — *Leggett v. Standard*, 149 U. S. 287; 37 L. Ed. 737; 13 S. Ct. 902.

Gage v. Herring, 107 U. S. 640

In that case (*Gaskill v. Myers*) too, there was no change whatever in the specification. In this case a change was introduced, which was not only different from, but essentially inconsistent with, the original specification. — *American v. Swietusch*, 85 Fed. 968; 29 C. C. A. 506.

Distinguishing *Gaskill v. Myers*, 81 Fed. 854.

In the original application a part was shown and described as a hole which should have been a slot. This rendered the device absolutely inoperative. The error was caused by oversight and was unconnected with the gist of the invention, though its adoption rendered the machine inoperative. No change was made or needed in the claim. If the patentee made a meritorious invention, he ought not to lose the benefit of it by reason of a defect so narrow and technical. — *Hart v. Anchor*, 92 Fed. 657; 34 C. C. A. 606.

It is urged that the success of the appellee in procuring the reissue is in the nature of a fraud. The defect of this argument is that it assumes that we have before us (on injunction proceeding), in this case, all the facts that the commissioner had before him in the application for a reissue; and that we can, in a collateral proceeding, declare the patent fraudulent, on account of the supposed imposition on the commissioner. — *Justi v. Clark*, 108 Fed. 659; 47 C. C. A. 565.

If the claims in a reissue are valid which were contained in the original, notwithstanding its new claims are invalid, it would seem to follow that, where there are no new claims in the reissue, all the claims should be valid, although in attempting to correct a mistake the commissioner has done nothing more than to introduce unimportant changes into the description. — *Thomson-Houston v. Black River*, 135 Fed. 759; 68 C. C. A. 461.

It suffices for present purposes that the patentee not only described the same invention as is described in the reissue (with amplification now omitted as to the details of construction and arrangement of the tension device) but also endeavored to claim the combination now claimed. Unless a reissue is invalid because unimportant changes are made in the descriptive matter and the language of the claims so as to express beyond any chance of mis-

apprehension what the patentee intended to claim in the original, there is nothing to militate against the present reissue. It is urged for the appellee that there was no statutory ground for a reissue, because the specification for the original was not in any sense defective. If it should be conceded that the changes in the description of the reissue are of no materiality, and that the claims are identically such as some of the claims of the original, the circumstances would not impeach their validity. In many cases where the new claims in a reissue have been held invalid, the claims repeated from the original have been sustained. — *Thomson-Houston v. Black River*, 135 Fed. 759; 68 C. C. A. 461.

Gage v. Herring, 107 U. S. 640; *Mahn v. Harwood*, 112 U. S. 354.

REOPENING CASE.

<p>After Decree on Appeal § 890 Newly Discovered Evidence § 891 Miscellaneous Rules § 892</p>		<p><i>See — Adjudication § 35; Appeals § 109; Decrees § 301; Pleading and Practice § 788; Rehearings § 868</i></p>
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§ 890. After Decree on Appeal.

The question of due diligence, as well as the materiality of the newly discovered evidence, is, we think, a question for decision by this court upon an application for leave to review a decree of the Circuit Court, entered in pursuance of the decree of this court. — *Kisinger-Ison v. Bradford*, 123 Fed. 91; 59 C. C. A. 221.

Society v. Watson, 77 Fed. 512; *Jourolmon v. Ewing*, 85 Fed. 103; *Rubber v. Ewing*, 9 Wall. 805.

That where a case is on appeal, before final decree, the appellate court may dismiss the appeal without prejudice, on request of the court below, for the purpose of further pleading and proofs, see *Mossberg v. Nutter*, 124 Fed. 966; 60 C. C. A. 98.

Distinguishing *Roemer v. Simon*, 91 U. S. 149.

On an interlocutory decree, like the one now before us, the Circuit Court has the case in its own breast, and on the dismissal of an appeal without prejudice can reopen any interlocutory proceedings if justice requires it. — *Greene v. United*, 124 Fed. 961; 60 C. C. A. 93.

That a complainant-appellant may not ask the appellate court to instruct the circuit court to allow complainant to reopen the case and amend so as to bring in the proper parties defendant, see—*National v. Stolts*, 135 Fed. 534; 68 C. C. A. 84.

§ 891. Newly Discovered Evidence.

It is a settled rule in this class of cases “that the matter must not only be new, but such as the party, by the use of reasonable diligence, could not have known; for if there be any laches or negligence in this respect, that destroys the title to the relief.” *Story Eq. Pl. sec. 414.* — *Providence v. Goodyear*, 76 U. S. 805; 19 L. Ed. 828.

Whether such an application shall be granted or refused, rests in the sound discretion of the court. — *Providence v. Goodyear*, 76 U. S. 805; 19 L. Ed. 828.

The decision and decree of this court did not amount, indeed, technically speaking, to a final judgment, because the matter of accounting still remained

to be disposed of. *Humiston v. Stainthorp*, 2 Wall. 106; *Smith v. Iron Works*, 165 U. S. 518. But they constitute an adjudication by this court of all questions, whether of law or of fact, involved in the conclusion that the letters patent of the plaintiff were valid, and had been infringed. Applying the rule stated at the beginning of this opinion, the questions of novelty and infringement were before this court, and disposed of by its decree, and must therefore be deemed to have been finally settled, and could not afterwards be reconsidered by the circuit court. When the merits of the case have been once decided by this court on appeal, the circuit court has no authority without express leave of this court to grant a new trial, a rehearing or a review, or to permit new defenses on the merits to be introduced by amendment of the answer. — *In re Potts*, 166 U. S. 263; 41 L. Ed. 994; 17 S. Ct. 520.

Ex Parte Story, 12 Pet. 339; *Southard v. Russell*, 16 How. 547; *Ex Parte Du Buque*, 1 Wall. 69; *Stewart v. Solomon*, 97 U. S. 361; *Gaines v. Rugg*, 148 U. S. 228.

The refusal of the court of leave to the defendants to take further proof is assigned for error, but this assignment has not been seriously pressed by counsel. The rebuttal proofs in the case had been closed, and leave was denied on the ground of lack of due diligence, and because it was not clear that the new evidence was material. The disposition of the motion was, however, in the discretion of the court, and in general such motions are not appealable. — *Pittsburgh v. Roberts*, 71 Fed. 706; 18 C. C. A. 302.

Stimes v. Franklin, 14 Wall. 22.

While the views which we have expressed in respect to stare decisis, public policy, and laches, do not operate strictly as an estoppel under the circumstances of this case, such considerations have operated to create and sustain the rule which requires that the newly discovered evidence, in order to be controlling, shall fully, clearly and unmistakably establish, in connection with the other evidence in the case, that the former decisions between the same parties were wrong. — *Bresnahan v. Tripp*, 99 Fed. 280; 39 C. C. A. 508.

The decisions (and there are many) all go at least to the extent of saying that the new evidence, to warrant it, must be so cogent and persuasive as to impress the court with the conviction that, if it had been presented and considered on the original hearing, it would have clearly produced a contrary conclusion from the one there reached. There are some cases where it is held that, if the claim is made that the newly discovered evidence or patents anticipate the patent previously sustained upon bona fide and strenuous contest, the anticipation must be described in full, clear and exact terms. — *Bresnahan v. Tripp*, 99 Fed. 280; 39 C. C. A. 508.

That a searcher was sent to examine the Patent Office for the purpose of obtaining all matter which was material to the defense of want of patentable novelty, and that this searcher did not come across these particular patents, is not such an extraordinary circumstance as would justify the review of a decree sustaining the validity of the patent. Such evidence is of a cumulative character. These patents were public records, and accessible if the search had been sufficiently diligent. The discovery of other patents bearing upon the question of anticipation should not be made the basis for a bill of review, in the absence of some very peculiar circumstance. — *Kisinger-Ison v. Bradford*, 123 Fed. 91; 59 C. C. A. 221.

Re Gamewell, 73 Fed. 908.

That a party is entitled to a reasonable time after the discovery of new evidence to verify and substantiate such evidence before moving to reopen the case, see — *Kelley v. Diamond*, 136 Fed. 855; 69 C. C. A. 599.

The petition seems to us to be for leave to open up the case, not so much to introduce evidence newly discovered, as to introduce old evidence the materiality of which has been newly discovered. The disturbance of a final judgment between given parties on such a ground would be contrary to all the adjudged cases. It would destroy the finality of nearly every decree handed down. — *Lafferty v. Acme*, 143 Fed. 321; 74 C. C. A. 521.

§ 892. Miscellaneous Rules.

The decree in this case under consideration is not final, within the decisions of this court. The injunction prayed for was made perpetual, but there was a reference to a master to ascertain the damages by reason of the infringement; the bill was not dismissed, nor was there a decree for costs. No point is better settled in this court, than that an appeal may be prosecuted only from a final decree. The cases are numerous where appeals have been dismissed, because the decree of the circuit court was not final. It is supposed there was a departure from this uniform course of decision, at the last term in case of *Forgay v. Conrad*, 6 How. 201. — *Barnard v. Gibson*, 7 How. 650; 12 L. Ed. 857.

The record contains no warrant for more than nominal damages at any time. We cannot reopen the taking of evidence simply because the complainant has failed to make a case. — *Baker v. Crane*, 138 Fed. 60; 70 C. C. A. 486.

Appellant, after the decision of the case, moved to reopen it, in order to show that it used fire-brick and did not use chamotte, within the meaning given to it by the court in its opinion. This motion was rightly denied. The new evidence sought to be introduced might have been brought before the court at the original hearing. — *Panzl v. Battle Island*, 138 Fed. 48; 70 C. C. A. 474.

RES JUDICATA.

Conclusiveness § 893
Former Suit § 894
Patent Office Decisions § 895
Miscellaneous Rules § 896

See — *Adjudication* § 28 *Comity* § 250; *Estoppel* § 381; *Injunction* §§ 561, 570, 575; *Interferences* § 580; *Pleading and Practice* § 788

§ 893. Conclusiveness.

The judgment rendered in that (the former) suit, while it remains in force, and for the purpose of maintaining its validity, is conclusive of all the facts properly pleaded by the plaintiffs. But when it is presented as testimony in another suit, the inquiry is competent whether the same issue has been tried and settled by it. — *Packet Co. v. Sickles*, 65 U. S. 333; 16 L. Ed. 650.

Merriam v. Whittemore, 5 Gray, 316; *Hughes v. Alexander*, 5 Duer, 488.

A recovery for an infringement of one claim of the patent is not of itself conclusive of an infringement of that other claim and there was no extrinsic evidence offered to remove the uncertainty upon the record; it is left to conjecture what was in fact litigated and determined. The verdict may have been for an infringement of the first claim; it may have been for the infringe-

ment of the second; it may have been for an infringement of both. The validity of the patent was not necessarily involved, except with respect to the claim which was the basis of recovery. — *Russell v. Place*, 94 U. S. 606; 24 L. Ed. 214.

It is undoubtedly settled law that a judgment of a competent court of jurisdiction, upon a question directly involved in one suit, is conclusive as to that question in another suit between the same parties. But to this operation of the judgment it must appear, either upon the face of the record or be shown by extrinsic evidence, that the precise question was raised, and determined in, the former suit. If there be any uncertainty on this head in the record — as, for example, if it appear that several distinct matters may have been litigated, upon one or more of which the judgment may have passed without indicating which of them was thus litigated, and upon which the judgment was rendered — the whole subject-matter of the action will be at large and open to a new contention, unless this uncertainty be removed by extrinsic evidence. — *Russell v. Place*, 94 U. S. 606; 24 L. Ed. 214.

The jury did not find that the alleged infringing machines combined in their "structure and operation the substance of the invention" described in the letters patent. *Curt*, sec. 308; but found the identity of the three exhibits in the case. If the invention of the patent was not used, it is immaterial how similar the two machines were in other respects. The question whether the invention of the patent was used by the defendant was not actually determined by the state court, although it could have been; but it is only in respect to matters actually in litigation and determined that the judgment is conclusive in another action. — *Brusie v. Peck*, 54 Fed. 820; 4 C. C. A. 597.

Cromwell v. Sac, 94 U. S. 351.

A decision of another circuit court of appeals to be *res judicata* and a binding precedent must have been upon the merits of the same patent, and not upon others co-related with it. — *Boyden v. Westinghouse*, 70 Fed. 816; 17 C. C. A. 430.

The decree in the Toledo Case awarded a perpetual injunction, but with an order of reference to a master to ascertain the damages by reason of infringement, and for that purpose the suit, it is conceded, is still pending. It is therefore only an interlocutory decree, and not available as an estoppel in respect to any issue in these suits. *Barnard v. Gibson*, 7 How. 650; *Humiston v. Stainthorp*, 2 Wall. 106; *McGourkey v. Ry. Co.* 146 U. S. 545; *Bradley v. Eagle*, 57 Fed. 980; *Jones v. Munger*, 50 Fed. 785; *Richmond v. Atwood*, 52 Fed. 10; *Marden v. Campbell*, 67 Fed. 809; *Bissell v. Goshen*, 72 Fed. 545. — *Brush v. Western*, 76 Fed. 761; 22 C. C. A. 543.

The decision of this court in the case of *Wheaton v. Norton*, 70 Fed. 833, was upon the merits; and it was there adjudged that the same machine, the use of which constitutes the alleged infringement by the defendant in the present suit, was not an infringement of the patent sued on by the complainants; and the judgment of the trial court, entered in pursuance of the mandate of this court, was an adjudication conclusively binding, not only upon the parties to that suit, but upon their privies. *Johnson Steel v. Wharton*, 152 U. S. 252; *Last Chance v. Tyler*, 157 U. S. 683; *Railroad v. National*, 102 U. S. 14; *Stout v. Lye*, 103 U. S. 66. The judgment is affirmed. — *Norton v. San Jose*, 79 Fed. 793; 25 C. C. A. 194.

While we appreciate fully that the doctrine of *res judicata* is a salutary one, intended to mitigate the evils which follow prolonged and repeated

litigations, still the decisions show that the courts have always restricted its application to cases where, among other identities, the subject matter was the same. — *Norton v. Jensen*, 90 Fed. 415; 33 C. C. A. 141.

Cromwell v. Sac, 94 U. S. 351; *Russell v. Place*, 94 U. S. 606; *Lumber Co. v. Buchtel*, 101 U. S. 638; *Wilson v. Deen*, 121 U. S. 525; *Bissell v. Spring*, 124 U. S. 231.

The defendant here was a mere user. The infringing manufacturer, the Diamond Meter Co., was not a party to the prior adjudication but undoubtedly furnished the defense. *Held*: The proofs as a whole satisfy us that the purpose of the Diamond Meter Co. was to maintain such an attitude with reference to the prior suit that it might have the direct benefit of the decree if favorable to the defendants therein, and yet not be concluded should the decree be adverse to the defendant. But if the Diamond Meter Co. desired that the decree in the prior suit should operate as an estoppel in its favor, it was bound by avowal or open action to place itself in such an unequivocal position that the decree should be mutually binding as *res adjudicata* upon itself and upon the complainant. — *Jefferson v. Westinghouse*, 139 Fed. 385; 71 C. C. A. 481.

Litchfield v. Goodnow's, 123 U. S. 549; *Andrews v. National*, 76 Fed. 166; *Cramer v. Singer*, 93 Fed. 636; *Lane v. Welds*, 99 Fed. 286.

An adjudication that the patent was void would protect defendant against a new attack by plaintiff on the same patent. But an adjudication that the defendant was doing something that did not infringe a valid patent would not justify defendant in doing something else that does infringe. — *Robinson v. American*, 150 Fed. 331; 80 C. C. A. 127.

If courts are to examine defenses in patent cases *de novo*, as often as they are presented, litigation will continue until the resources of the defendants or the patience of the complainant, and possibly the patience of the court, are exhausted. — *Consolidated v. Diamond*, 162 Fed. 892; 89 C. C. A. 582.

§ 894. Former Suit.

It was not necessary as between parties and privies that the record should show that the question upon which the right of the plaintiff to recover, or the validity of the defense, depended for it to operate conclusively; but only that the same matter in controversy might have been litigated, and that extrinsic evidence would be admitted to prove that the particular question was material and was, in fact, contested and that it was referred to the decision of the jury. — *Packet Co. v. Sickles*, 65 U. S. 333; 16 L. Ed. 650.

Although one infringer may succeed in defeating a patent by one of the statutory defenses, such action does not prevent another from being sued, or mulcted, in case he fails to produce the requisite evidence to maintain his defense. — *United States v. Am. Bell*, 128 U. S. 315; 32 L. Ed. 450; 9 S. Ct. 90.

As the prior action was between the same parties, and was based in part at least, and principally, upon the same patent, it would appear that the judgment of the court dismissing the petition would operate as a complete estoppel to the present suit, unless the proceedings subsequent to the judgment in the former suit in some way deprived the judgment of its force and effect *res judicata*. — *Hubbell v. U. S.* 171 U. S. 203; 43 L. Ed. 136; 18 S. Ct. 828.

3 Rob. Pat. sec. 1017.

The presumption is that the issues were the same, and, if they were in part different, it was incumbent upon the claimant to show that the prior case was decided upon questions not involved herein. — *Hubbell v. U. S.* 171 U. S. 203; 43 L. Ed. 136; 18 S. Ct. 828.

The patentee cannot bring suit against an infringer upon a certain state of facts, and, after dismissal of his action, bring another suit against the same party upon the same state of facts, and recover upon a different theory. The judgment in the first action is a complete estoppel in favor of the successful party in a subsequent action upon the same state of facts. — *Hubbell v. U. S.* 171 U. S. 203; 43 L. Ed. 136; 18 S. Ct. 828.

Walker Pat. 468; *DuBois v. Railroad*, 5 Fish. 208, Fed. Cas. 4109; *Bradley v. Eagle*, 57 Fed. 989.

This is a second action upon the same claim or demand, to wit, upon the claim for a monopoly granted by patent; and that the former decree, the question being necessarily involved and at issue in that case, determines conclusively and for all time, as between the parties thereto and their privies, the validity of the patent. It can no more be made the subject of contention between them. — *Bradley v. Eagle Mfg. Co.* 57 Fed. 980; 6 C. C. A. 661.

Cromwell v. Sac. 94 U. S. 351; *Davis v. Brown*, 94 U. S. 423; *Campbell v. Rankin*, 99 U. S. 281; *Block v. Commissioners*, 99 U. S. 686; *Wilson v. Deen*, 121 U. S. 525; *Bissell v. Spring Valley*, 124 U. S. 225; *Nesbit v. Independent*, 144 U. S. 610; *Railroad v. Alsbrook*, 146 U. S. 279; *McComb v. Frink*, 149 U. S. 629; *Lumber Co. v. Buchtel*, 101 U. S. 638; *Insurance Co. v. Bangs*, 103 U. S. 780; *Elgin v. Marshall*, 106 U. S. 578.

The defendant there was the agent of the present appellant in the sale of the infringing machines. The defense of the suit then was assumed and prosecuted by the appellant here. The appellant was in fact the real party to that litigation, and so far as the decree there is *res adjudicata* is as effectively concluded thereby as if it were the actual defendant of record. — *Bradley v. Eagle Mfg. Co.* 57 Fed. 980; 6 C. C. A. 661.

Lovejoy v. Murray, 3 Wall. 1; *Robbins v. Chicago*, 4 Wall. 657.

That the decree was interlocutory at the bringing of this suit, and subsequently ripened into a final decree, does not impair its efficiency or conclusiveness when properly presented in this suit. The relative time of institution of suit, or the relative date of final decree, is not of consequence if the merits of the controversy be thereby fully and finally determined, and the record thereof is properly brought to the attention of the court. — *Bradley v. Eagle Mfg. Co.* 57 Fed. 980; 6 C. C. A. 661.

Duffy v. Lytle, 5 Watts. 120; *Casebeer v. Mowry*, 55 Pa. St. 422; *Child v. Powder Works*, 45 N. H. 547.

The rule of *res judicata* has never been disturbed that where, in a prior suit, it appears of record that any particular question has been actually adjudicated, the prior judgment is to that extent conclusive in any subsequent suit between the same parties or their privies, relating to an instrument which forms the basis of litigation in each. Here we find in the prior judgment a solemn and express adjudication in favor of the validity of the patent. If in that particular the court went beyond its province, its action was not void, and the remedy for the respondents was to apply to have its decree amended. As, therefore, we find in the record here, matter which, as far as we are concerned, conclusively establishes that the court having cognizance of the prior suit had expressly adjudicated the validity of the patent as between the parties in privity with those now before us, we have no power to permit

that question to be litigated again. — *Empire v. American*, 74 Fed. 864; 21 C. C. A. 152.

Bradley v. Eagle, 57 Fed. 980; *Russell v. Place*, 84 U. S. 351; *Bissell v. Spring*, 124 U. S. 225; *Howlett v. Tarte*, 10 C. B. N. S. 813; *Roberts v. Railroad*, 158 U. S. 1; *DeSollar v. Hanscome*, 158 U. S. 216; *Last Chance v. Tyler*, 157 U. S. 883; *Lumber v. Buchtel*, 101 U. S. 638.

The prior suit was brought against defendant company and its agent. The company had the bill dismissed against it for want of jurisdiction, but furnished the funds for the defense. That suit having been decided in favor of the agent, the defendant company now pleads that suit as estoppel on the ground that it sustained the expense of the former suit for its agent. *Held*: The open dismissal of the Singer Company from that suit upon its own motion was significant of its withdrawal from the litigation, and of its purpose not to be bound by the judgment to be rendered therein. — *Singer v. Cramer*, 109 Fed. 652; 48 C. C. A. 588. Reversed, 192 U. S. 265.

The plea does meet the declaration (that of infringement), for it alleges that the acts for which defendant is now sought to be held are merely a continuation of the very same acts which were involved in the former litigation and were adjudged not to constitute a cause of action. But this allegation was expressly denied in the replication. So an issue of fact was framed, for the determination of which plaintiff was entitled to a jury trial. — *Robinson v. American*, 150 Fed. 331; 80 C. C. A. 127.

In the former case Heller testified that he was interested in the defense financially and otherwise. Whether intended to be so or not, there is no doubt that the suit against the N. Y. Baking Powder Co. was, in fact, a test case and is controlling in this court upon all questions there decided. We are of the opinion that their participation in the defense of the test suit made the defendants Heller and the N. Y. Hygienic Co. parties privy to that suit and that the testimony of Clotworthy given therein may properly be read against these defendants — Clotworthy having died prior to the hearing. — *Rumford v. Hygienic*, 159 Fed. 436; 86 C. C. A. 416. Reversed, 215 U. S. 156.

Each plea states with abundant particularity the issues raised, heard, and decided in the prior equity suit referred to between the parties, and specifies their identity with the subject-matter in controversy here. The prior adjudication was clearly brought within the elementary rule which bars a second action upon the same claim or demand. — *Robinson v. American*, 159 Fed. 131; 86 C. C. A. 321.

Cromwell v. County, 94 U. S. 351.

§ 895. Patent Office Decisions.

It would seem that a defendant cannot set up an interference adjudication and rely upon it as *res adjudicata* when sued for infringement. — *Garratt v. Siebert*, 98 U. S. 75; 25 L. Ed. 84.

The question of judicial interpretation of a doubtful question before the Patent Office is not to be regarded as *res judicata* by that department. — *Andrews v. Hovey*, 124 U. S. 694; 31 L. Ed. 557; 8 S. Ct. 676.

In a subsequent suit between the same parties to the decision of the patent office upon the question of priority, the decision there made must be accepted as controlling upon the question of fact in a subsequent suit, unless the

contrary is established by testimony which, in character and amount, carries thorough conviction. — *Ecaubert v. Appleton*, 67 Fed. 917; 15 C. C. A. 73.
Morgan v. Daniels, 153 U. S. 120.

It has not been the tendency of the decisions either of the Supreme Court or of the circuit courts of appeal to extend the effect of interference decisions as final adjudications, and we concur with the circuit court in the conclusion that "while the decision in interference may be *res judicata* as to priority, it does not preclude defendant from raising other questions not in issue in said proceedings." — *National v. Wheeler*, 79 Fed. 432; 24 C. C. A. 663.

No intimation is intended that such decision is *res adjudicata* or conclusive in the present controversy (between the same parties on motion for preliminary injunction) or of other than persuasive effect in reference to the facts thus involved. — *Scott v. Laas*, 150 Fed. 764; 80 C. C. A. 500.

§ 896. Miscellaneous Rules.

To make the judgment available as a plea in bar or as conclusive evidence, it must appear that the parties were the same or in privity. The situation must have been such that the Hanks Dental Association (defendant below) would have been estopped from asserting the validity of the patent had the judgment been against Bennett. The mere fact that Bennett and defendant are members of an association which has contributed to the defense of each, does not warrant the conclusion that a judgment in favor of one inures to the benefit of the other in the absence of knowledge by the plaintiff of the true relations between them. The plaintiff must have known at the time that the Hanks Company was contributing to the defense of the Bennett suit. — *Hanks v. International*, 122 Fed. 74; 58 C. C. A. 180.

The defendant sought, by showing the invalidity of the patent, to terminate the contract. That issue having been raised and merged in the judgment, it is clear that in a suit between the same parties for subsequent installments under the same contract the same question cannot be raised and litigated a second time. — *Wilcox v. Sherborne*, 123 Fed. 875; 59 C. C. A. 363.

ROYALTIES.

General Statement and the Decisions § 897	See — <i>Assignment</i> § 149; <i>Damages</i> § 294; <i>License</i> § 760; <i>Profits</i> § 825
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§ 897. General Statement and the Decisions.

Royalties arise out of contract and agreement. A patent is personal property, and rights arising out of contract and agreement are subject to the general rules relating thereto. So long as it is borne in mind that, unless otherwise specified in the assignment, joint owners are tenants in common, and not by the entirety, there will be little difficulty in applying the general principles underlying contracts to the subject of royalties.

The question of an established royalty furnishes a measure of damages and a factor for the computation of profits. See *Damages* and *Profits*.

To occasionally take promissory notes from licensees in lieu of cash for accrued royalties would, if done in good faith, not be so far out of the course of ordinary business transactions as to render the licensee liable for losses occurring through the insolvency of any of its licensees. In the absence of

any guarantee only diligence and good faith are required. — *Thorn v. Washburn*, 159 U. S. 423; 40 L. Ed. 205; 16 S. Ct. 94.

That where the license is founded upon a pending application which is being prosecuted by the licensee, with the result that some of the claims are rejected by the Patent Office and the licensee notifies the licensor that the claims that can be secured are not "worth a pinch of snuff," but at the same time retains his license privilege and neither surrenders the contract nor the patent application, is bound to account for articles manufactured under the contract and embodying the invention as understood at the time the contract was made, see — *Eclipse v. Farrow*, 199 U. S. 581; 50 L. Ed. 317; 26 S. Ct. 150.

U. S. v. Harvey, 196 U. S. 310.

The decree declares in general terms the rights of the plaintiff to royalties upon all devices manufactured by the defendant and embodying the inventions mentioned in the contract, and directs an accounting in accordance with the decree. We are of opinion that these terms warranted the auditor in charging royalties upon any device found to come within the contract. — *Eclipse v. Farrow*, 199 U. S. 581; 50 L. Ed. 317; 26 S. Ct. 150.

Until the attorney's authority was revoked and the defendants had knowledge of it, their settlements with him were a discharge of liability. — *Union v. Johnson*, 61 Fed. 940; 10 C. C. A. 176.

That where the license contract covered a period extending beyond the term of the patent under which a part of the royalties arose, in the absence of specific agreement to the contrary, the royalties arising out of such patent cease with the expiration of that patent, although the contract continues in force as to other patents, see — *Holmes v. McGill*, 108 Fed. 238; 47 C. C. A. 296.

That the fact that a licensee has inextricably complicated and confused the profits or returns accruing from sub-letting or territorial sales under a specific royalty agreement with a licensor cannot defeat the right of the licensor to his royalties, see — *Western Union v. Am. Bell*, 125 Fed. 342; 60 C. C. A. 220.

Royalties are commonly understood as meaning something proportionate to the use of a patented device; in other words, a kind of excise. *Bouvier's Law Dictionary*, "Royalty." In its more ordinary meaning it would not literally include the shares of stock for which an accounting is demanded. In some of its uses it is a broader word than "rentals," and yet in other aspects "rentals" is a broader word than "royalties." Rentals in their ordinary signification are not limited as royalties in their ordinary signification; that is, something proportionate to the use of the patented device. The word "ordinarily" means specific sums paid annually, or at other stated periods, for the right to use a patented device, whether it is used much or little or not at all. — *Western Union v. Am. Bell*, 125 Fed. 342; 60 C. C. A. 220.

It is argued that although the contract requires the payment of royalties on all machines "sold or delivered," the intent of the parties was that payment should be limited to machines "sold and delivered" and that the court should have so interpreted the contract. We cannot accede to this view. There is no ambiguity about the contract; its language is perfectly plain. In the short clause providing for the payment of royalties the words "sold or delivered" are twice used. There is no room for interpretation. — *Confectioners' v. Panoualias*, 134 Fed. 393; 67 C. C. A. 391.

That in an action to recover royalties under a contract which confined the licensee to manufacture and sell the patented device and no other, it is not necessary for the licensor to prove that the devices made and sold conformed to the claims of the patent, see — *Clifford v. Capell*, 165 Fed. 193; C. C. A.

SECRET PROCESS OR MACHINE.

General Rule § 898

See — *Abandonment* § 1; *Unpatented Invention* § 930

§ 898. General Rule.

One who makes or vends an article which is made by a secret process or private formula cannot appeal to the protection of any statute creating a monopoly in his product. He has no special property in either a trade secret or a private formula. The process or the formula is valuable only so long as he keeps it secret. The public is free to discover it if it can by fair and honest means, and, when discovered, anyone has the right to use it. — *Park v. Hartman*, 153 Fed. 24; 82 C. C. A. 158.

Chadwick v. Covell, 151 Mass. 190; *Tabor v. Hoffman*, 118 N. Y. 30; *Peabody v. Norfolk*, 98 Mass. 452; *Vulcan v. American*, 58 Atl. 290.

SALE OF PATENTED ARTICLE.

General Statement and Holdings
§ 899

See — *Assignment* § 149; *License*
§ 749

§ 899. General Statement and Holdings.

The distinctions between the sale of a patented article and the sale of any right under a patent are to be noted. Since the owner of a patent has a close monopoly, he may, provided he gives the proper notice so that the public is not ensnared, sell or otherwise dispose of articles covered by his monopoly with such restrictions as he may impose. While this subject is related to that of *license*, it differs from it in that a license, generally speaking, deals with some right under the patent, while the sale and purchase of a patented article with restrictions deals with the product of the patent, rather than the patent itself.

The condition against sales to retail dealers who do not sign a similar agreement governing sales by them was imposed by complainant in the exercise of its property right in the monopoly, and for the purpose of rendering it valuable. The complainant had the same right to require that such an agreement be exacted from defendants' vendees that it had to demand it from defendants. Any sale by defendants outside of the terms of their under-license or contract was an invasion of complainant's lawful monopoly. — *National v. Schlegel*, 128 Fed. 733; 64 C. C. A. 594.

Undoubtedly, the general rule is that if a patentee make a structure embodying his invention, and unconditionally make a sale of it, the buyer acquires the right to use the machine without restrictions, and, when such machine is lawfully made and unconditionally sold, no restriction upon its use will be implied in favor of the patentee. By such unconditional sale the machine passes without the limit of the monopoly. *Adams v. Burke*, 17 Wall. 453; *Mitchell v. Hawley*, 16 Wall. 544. That the complainant has attempted to state a case not within this rule is very obvious, for it charges that every sale has been under an express restriction as to the use of the invention

embodied in the machine. In view of the conspicuous character of both the machine and the notice permanently affixed thereon, everyone buying must be conclusively presumed to have notice that the owners of the patents intended by the inscription on the machine to grant only a restricted license for its use, and it is difficult to see why such purchaser is not to be regarded as acquiring and accepting the structure subject to this restriction. The buyer of the machine undoubtedly obtains the title to the materials embodying the invention, subject to a reverter in case of violation of the conditions of the sale. But, as to the right to use the invention, he is obviously a mere licensee, having no interest in the monopoly granted by the letters patent. A license operates only as a waiver of the monopoly as to the licensee, "and estops the licensor from exercising its prohibitory powers in derogation of the privileges conferred by them upon the licensee." Rob. Pat. secs. 806-808. It has been said that the sole matter conveyed in a license is the right not to be sued. *Hawks v. Swett*, 4 Hun. 146. A licensee is one who is not the owner of an interest in the patent, but who has, by contract, acquired a right to make or use or sell machines embodying the invention. *Gaylor v. Wilder*, 10 How. 477; *Oliver v. Chemical*, 109 U. S. 75. All alienations of a mere right to use the invention operate only as licenses. It must follow, therefore, that the purchaser of one of complainant's machines subject to a restricted use takes the structure with a license to use the invention only with staples made by the patentee. That the complainant sells the machine through jobbers and not directly to those who buy or use is immaterial, under the facts stated on the face of the bill. The jobber buys and sells subject to the restriction, and both have notice of the conditional character of the sale, and of the restriction on the use. *Supply Co. v. Bullard*, Fed. Cas. 294; *Cotton v. Simmons*, 106 U. S. 89. That the buyer enters into an implied agreement that he will not use the machine contrary to the terms of his license, and that there is in the agreement a provision for the reverter of the title to the structures, may operate to give the patentee a remedy under general principles of law as for damages for breach of contract or for recovery of the machine. It may be that a suit for breach of contract would not be a suit depending on the patent laws, and would therefore be cognizable by the state courts, as intimated in *Hartell v. Tilghman*, 99 U. S. 547, and *White v. Rankin*, 144 U. S. 628. The remedy of complainant may be a double one; for liability may rest either upon the broken contract, or for the tortious use of the invention. Rob. Pat. secs. 1225-1250 & n. If a patentee may lawfully make and sell machines embodying his invention, and restrict the use of the invention in respect of territory or time or business, or purposes to which it may be put, or material to be used in conjunction therewith, it would seem very obvious that the effect of the restrictions and limitations on the use would operate to prevent the machine from passing, as in the case of an unconditional sale, beyond the monopoly of the patent. The control reserved by the patentee as to the use of the machine has the effect of continuing it within the prohibition of the monopoly. The license defines the boundaries of a lawful use, and estops the licensor from the assertion of his monopoly contrary to its terms. On the other hand, a use prohibited by the license is a use in defiance of the monopoly reserved by the patentee, and necessarily an unlawful invasion of the rights secured to him by his patent. The license would be no defense for a suit for infringement by a use in excess of its terms. The patentee has the exclusive right of use, except in so far as he has parted with it by his license. The essence of the monopoly conferred by the grant of letters patent is the exclusive right to use the invention or discovery described in the patent. This exclusive right of use is a true and absolute monopoly, and it is granted in derogation of the common right, and this right to monopolize the use of the invention or discovery is the substantial property

right conferred by law, and which the public is under obligation to respect and protect. "The rights to make and use or sell, are completely severable rights, and involve the right to confer on others such qualified privilege, whether of making, of selling to others or of using, as he sees fit, whether within specified limits, or under limitations of quantity or numbers, or restricted use." *Dorsey v. Bradley*, Fed. Cas. 4,015. In *Adams v. Burke*, 17 Wall. 453, the court said, "The right to manufacture, the right to sell, and the right to use, are each substantive rights, and may be granted separately, or conferred together by the patentee." — *Heaton v. Eureka*, 77 Fed. 288; 25 C. C. A. 267.

SPECIFICATION.

Statutory Requirements § 900
 General Statement § 901
 Amendment § 902 (see § 52)
 Construction § 903
 Defective § 904
 Sufficiency
 Accuracy § 905
 Alternative Constructions § 906
 Ambiguity § 907
 Distinguishing New from Old § 908
 Equivalents § 909 (see § 373)
 Excessive § 910
 Function § 911 (see § 426)

Immaterial Error § 912
 Old Parts § 913
 Process § 914 (see § 813)
 Rules for Determining § 915
 Scientific Knowledge § 916
 Unambiguousness § 917
 Two Inventions. One Patent § 918
 Miscellaneous Rules § 919
See — Amendment § 52; Attorneys § 178; Claims §§ 212, 223; Defenses §§ 309, 317; Drawings § 362; Oath § 779

§ 900. Statutory Requirements.

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

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

Sections 490 and 491 provide for the printing, publication and depositing of patent specifications in state capitols, district court clerk's offices and the Library of Congress.

§ 901. General Statement.

The term "specification" is used in a two-fold and confusing manner. As used in the statutes it means both the descriptive portion and the claims.

As commonly used by the Patent Office and by patent attorneys it means the descriptive portion alone. The courts use the term in both ways, but the tendency in the more recent decisions is to mark the distinction as the Patent Office has done. Instances will be found, moreover, where the courts have made the term cover description, claim, and drawings as well.

The relation of the descriptive portion — the specification in the more restricted sense — to the claims, may not be established in a brief statement. While it is a general rule that the claims may not be broadened by reference to the specification, it is none the less true that, in applying the doctrine of equivalents in the case of a patent for a generic invention, this rule is often winked at. On the other hand, the large service of the specification is to locate the invention with reference to the prior art, to enable the courts to delimit the claims.

In the examination of a patent it is always to be borne in mind that it is the common practice of patent solicitors to draw the specification in broad terms and to submit to the Patent Office claims of undue scope. The claims are amended, pruned and restricted, and often cover only a fragment of the subject-matter of the specification. The bad practice prevails in the Patent Office of allowing the specification to stand with its broad disclosure; so that it generally remains for the lawyer or the court to discover, by reference to the claims and to the file wrapper contents, the true scope of the specification.

This title, generally speaking, needs to be considered in connection with *Claims* (§§ 187-249) and *Equivalents* (§§ 374-380).

§ 902. Amendment.

The fact that there were changes made in the specification does not imply a different invention disclosed. (This applied to changes in specification on reissue under the old law and does not apply under the act of 1870). — *O'Reilly v. Morse*, 15 How. 62; 14 L. Ed. 601.

A change in the specification as filed in the first instance, on the subsequent filing for a new one, whereby a patent is still sought for the substance of the invention as originally claimed, or a part of it, cannot in any wise affect the sufficiency of the original application or the legal consequence flowing from it. — *Godfrey v. Eames*, 68 U. S. 317; 17 L. Ed. 684.

§ 903. Construction.

Specifications are to be construed liberally, in accordance with the design of the constitution and patent laws, to promote the progress of the useful arts, and allow inventors to retain to their own use, not anything which is matter of common right, but what they have themselves created. — *Winans v. Denmead*, 15 How. 330; 14 L. Ed. 717.

Grant v. Raymond, 6 Pet. 218; *Ames v. Howard*, 1 Sumn. 482; *Blanchard v. Sprague*, 3 Sumn. 535; *Davoll v. Brown*, 1 Wood. & M. 53; *Parker v. Haworth*, 4 McLean, 372; *LeRoy v. Tatham*, 14 How. 181; *Neilson v. Hartford*, 1 Web. P. C. 341; *Russell v. Cowley*, 1 Web. P. C. 470; *Burden v. Winslow*, 15 How. 683.

Doubtless a claim is to be construed in connection with the explanation contained in the specification, and it may be so drawn as in effect to make the specification an essential part of it; but since the inventor must particularly specify and point out the part, improvement or combination which he claims as his own invention or discovery, the specification and drawings are usually looked at for the purpose of better understanding the meaning of the claim, and certainly not for the purpose of changing it and making it

different from what it is. — *Howe v. National*, 134 U. S. 388; 33 L. Ed. 963; 10 S. Ct. 570.

White v. Dunbar, 119 U. S. 47.

Change through disclaimer cannot change interpretation of invention. — *Grant v. Walter*, 148 U. S. 547; 37 L. Ed. 552; 13 S. Ct. 699.

The patent is not addressed to lawyers, or even to the public generally, but to the manufacturers of steel; and any description which is sufficient to apprise them in the language of the art of the definite feature of the invention, and to serve as a warning to others of what the patent claims as a monopoly, is sufficiently definite to sustain the patent. He may assume that what was already known in the art of manufacturing steel was known to them. — *Carnegie v. Cambria*, 185 U. S. 403; 46 L. Ed. 968; 22 S. Ct. 698.

Loom Co. v. Higgins, 105 U. S. 580.

In the reissue this function of the removable cap is omitted from the description. The drawings remain the same, but the retention there of the parts omitted from the description does not help the effect of the omission. — *Adee v. Mott*, 55 Fed. 876; 5 C. C. A. 288.

James v. Campbell, 104 U. S. 356.

While it is admitted, both as to the drawings and as to the written specifications, that such variations in an apparatus, in form, shape and proportions, as common sense or mechanical skill would suggest to one skilled in the art are inferred, still it carries the doctrine to its very verge; and, if the drawings and specifications fail to indicate the device to those conversant with the art and having the mechanical skill peculiar thereto they are insufficient and the patent does not include the device. — *Michigan v. Consolidated*, 67 Fed. 121; 14 C. C. A. 232.

It may not be denied that the specification and the first claim of the patent are couched in unskilful language; but in the case of a novel and useful invention, the terms employed should, if possible, receive a construction which will uphold and not defeat the patentee's right to that which he has in fact invented. — *Red Jacket v. Davis*, 82 Fed. 432; 27 C. C. A. 204.

The language of the Booth patent which we are called upon to consider is of easy comprehension. The following observations of the Supreme Court are here pertinent.

"The words used are not technical, either as having a special sense by commercial usage, nor as having a scientific meaning different from their popular meaning. They are the words of common speech, and, as such, their interpretation is within the judicial knowledge, and therefore matter of law." *Marvel v. Merritt*, 116 U. S. 11, 12, 6 Sup. Ct. 207.

In *Norton v. Jensen*, 49 Fed. 859, the circuit court of appeals for the Ninth circuit well said:

"If the reasons given by the expert witness are deemed reasonable and satisfactory, the court may adopt them; but, if they are unsatisfactory, the court will discard the testimony, and act upon its own knowledge and judgment. It is always the duty of the courts to construe the patent by reference to the language of the claims and an examination of the specification and drawings accompanying the same."

In *National v. Belcher*, 71 Fed. 876, this court speaking by Judge Butler, in refusing to give controlling effect to the testimony of a competent mechanic, who stated that, by following the directions of an earlier patent, he had made a device identical with the one in controversy, said:

“ If a valuable patent might be overthrown in this manner by the testimony of an expert, without careful inquiry into, and virtual demonstration of, its correctness, the rights of patentees would rest upon the testimony of such witnesses, rather than the judgment of the court.”—*Hanifen v. Godshalk*, 84 Fed. 649; 28 C. C. A. 507.

It is well settled that a description in a specification of details which the claim does not make elements of the combination, and which are not essential to it, is to be held as only pointing out the better method of using the combination. — *Boston v. Allen*, 91 Fed. 248; 33 C. C. A. 485.

In the construction of a patent, the omission of the patentee to point out or refer in his specifications or claims, to the special feature which he subsequently maintains is the most important part of his invention, is very significant, and should be carefully scrutinized. — *MacColl v. Knowles*, 95 Fed. 982; 37 C. C. A. 346.

Union v. Keith, 139 U. S. 530; *McClain v. Ortmyer*, 141 U. S. 419; *Deering v. Harvester*, 155 U. S. 286; *White v. Dunbar*, 119 U. S. 47; *Burns v. Meyer*, 100 U. S. 671.

A careful study of the great mass of words with which the draughtsman of the patent seems to have sought to magnify the invention, shows how extremely slight is the improvement upon which complainant relies. — *Lyons v. Drucker*, 106 Fed. 416; 45 C. C. A. 368.

The suggestion that the description commencing with the words “ in carrying out my process practically I proceed as follows,” is only one specific example of the invention is not to be accepted. There is nothing in the patent to support the suggestion. Undoubtedly the specification, as a whole, evinces that the invention is limited to the para product. We cannot see that *Matheson v. Campbell*, 78 Fed. 910, decides anything favorable to the contention of this appellant. The facts there differed radically from the facts in this case. The patent (in suit) unlike the patent involved in *Matheson v. Campbell* is distinctly limited to one individual product, fully described and unmistakably identified. — *Maurer v. Dickerson*, 113 Fed. 870; 51 C. C. A. 494.

Where an alleged element or characteristic feature of an invention is not necessarily inherent in the invention itself, the failure of the patentee to refer to such alleged feature is persuasive evidence that it is not within the scope of his invention, and, not being disclosed to the public, it should not be read into the patent. — *Edison v. Crouse*, 152 Fed. 437; 81 C. C. A. 579.

As he describes only one organization of means for that purpose, he is restricted to that, or substantially that. The liberality of construction which we think may be given to his claim for the purpose of interpreting it cannot be extended to include all means which might be devised to accomplish even a like result, without such a perversion of the rule applied as would disturb other well-settled doctrines of the patent law. — *American v. Cleveland*, 158 Fed. 978; 86 C. C. A. 182.

§ 904. Defective.

The principle is this: the omission to mention in the specification something which contributes only to the degree of benefit, providing the apparatus would work beneficially and be worth adopting without it, is not fatal,

while the omission of what is known to be necessary to the enjoyment of the invention is fatal. — *Sewall v. Jones*, 91 U. S. 171; 23 L. Ed. 275.

Curtis, sec. 248.

If this were a blunder of an ignorant solicitor, they had ample opportunity to correct it by reissue; but, having allowed it to stand in their patent, they must be held to their declaration that reducing agents will produce this result. It has been suggested that since the evidence shows that alpha-naphthaline would not be formed out of the product of the patent by reducing agents, and that persons skilled in the art would know that fact, the entire test may be rejected as nonsensical surplusage. But there must be some limit to a court's functions in rewriting patents. Assuming that all the imperfections in this patent were due to an ignorant solicitor, remote from his clients, — and it may be noted that there is no evidence of this, — it does not follow that all should be disregarded. We held, as to the error and omission of paragraph 4, that the omission was really supplied elsewhere in the patent; that the error was harmless, since the skilled workman would himself substitute "nitrite" for "nitrate;" and that, although the error must stand in the patent where the patentee's careless solicitor had placed it, we would not infer from its presence that it was due to a fraudulent design to mislead, formed and carried out by the patentees. But here there has been an identifying test put into the patent by the solicitor; the patentee accepts such patent, and applies for no reissue, alleging no mistake; and the court is asked to strike out the test altogether, as ridiculous surplusage. In the absence of any authority for such action, we are unwilling to establish the precedent. But what their solicitors do, patentees should abide. If they are dissatisfied with the letters patent their solicitors obtain, they may, in proper cases, apply for a reissue; but when they accept their original patents without objection, they must be assumed to have assented to such changes as were made by their solicitors in specification or claim while their application was on its way through the patent office. — *Matheson v. Campbell*, 78 Fed. 910; 24 C. C. A. 284.

The applicants for this patent were in Europe and their solicitor here evidently knew little, if anything, about the chemistry of azo products; and there is nothing in the record to suggest that the changes which the solicitor made were due to anything except his own ignorance, or that he had any intent to mislead or to conceal. It is not doubted that an applicant is bound by the acts of his solicitor, but this contention seems to go beyond this wholesome rule when it seeks to void a patent, upon the theory of a fraudulent concealment or fraudulent misrepresentation because, through the solicitor's ignorance, the specifications, when describing the process of manufacture, contain some immaterial error or omission, which could not mislead a person skilled in the art. — *Matheson v. Campbell*, 78 Fed. 910; 24 C. C. A. 284.

An immaterial error in the specification of a patent which would not mislead one skilled in the art will not invalidate the patent. — *Matheson v. Campbell*, 78 Fed. 910; 24 C. C. A. 284.

There is a lack of anything in the record showing what is the pith of the alleged invention or what was the real advance in the art, if any, which it accomplished. The specification of the patent was equally lacking. In holding the patent bad, the court said: whether these changes cover anything of a substantial character, or whether they relate to mere detail of form, or to mere convenience, or to mere matter of fancy, the proofs in this record do not show. — *Nutter v. Brown*, 98 Fed. 892; 39 C. C. A. 332.

Mfg. Co. v. Holtzer, 67 Fed. 907; *Masten v. Hunt*, 55 Fed. 78; *Fastener Co. v. Edgerton*, 96 Fed. 489.

No proportions are given, and, indeed, not a word is said in the patent from which any one desiring to use the process described therein can determine the "definite quantity" or the "exact quantity" referred to in the claims. In the absence of specific information upon the subject, the desired quantity can, in the nature of things, be determined only by experiment. — *De Lamar v. De Lamar*, 117 Fed. 240: 54 C. C. A. 272.

Mitchell v. Tilghman, 19 Wall. 287; *Béné v. Jeantet*, 129 U. S. 683; *Howard v. Stove Works*, 150 U. S. 164; *Schneider v. Lovell*, 10 Fed. 666; *Welling v. Crane*, 14 Fed. 571; *Lockwood v. Faber*, 27 Fed. 63; *Chemical v. Raymond*, 71 Fed. 179.

Note: On this proposition, as applied, both Gilbert and Morrow, JJ. dissented from the opinion of Ross, J. There is not the slightest doubt but that the dissent was well founded.

If this information (the volume of air required and what is meant by a practically closed grate) can be obtained only by experiment, as the experts all agree, the defect is fatal to the claim. — *Germer v. Art*, 150 Fed. 141; 80 C. C. A. 9.

Incandescent Lamp Pat. 159 U. S. 465; *Goodyear v. Rubber*, 116 Fed. 363.

If his had been the first of such burners, perhaps this would have been sufficient. But in the then state of the art he was bound to differentiate his structure from those which preceded him; and especially is this so when the whole merit of his invention depends upon some peculiarity in the elements he employs. We think it may be affirmed as a rule resting upon the fundamental principles of patent law that, when the essence of the invention is the location, form, size, or any other characteristic of the means employed, the patentee must distinctly specify the peculiarities in which his invention is to be found. — *American v. Steward*, 155 Fed. 731; 84 C. C. A. 157.

Store Co. v. Store Co. 150 Fed. 141; *Bullock v. Gen. Elect.* 149 Fed. 409.

Note: A questionable decision — refusing to follow C. C. A. 2nd Circ. 128 Fed. 599.

§ 905. Sufficiency — Accuracy.

There are some further and laudable objects in having exactness, to this extent, so as, when the specification is presented, to enable the commissioner of patents to judge correctly whether the matter claimed is new or too broad; to enable courts, when it is contested afterwards before them, to form a like judgement; that the public may be able to understand what the patent is and refrain from its use. — *Hogg v. Emerson*, 6 How. 437; 12 L. Ed. 505.

3 Wheat. 454; 3 Brod. & Bingham, 5; 1 Starkie N. P. 199; 1 Starkie N. P. 192; *Web. on Pat.* 86; 11 East. 105; 3 Merivale. 161; *Evans v. Eaton*, 3 Wash. 453; 4 Wash. 9; *Bovill v. Moore*, *Davis Cas.* 361; *Lowell v. Lewis*, 1 Mas. 182.

When a man supposes he has made an invention or discovery useful in the arts and, therefore, the proper subject of a patent, it is, nine times out of ten, an improvement on some existing article, process or machine, and is useful only in connection with it. It is necessary, therefore, for him, in his application to the Patent Office to describe that upon which he engrafts his invention, as well as the invention itself; and, in cases where the invention is a new combination of old devices, he is bound to describe with particularity all these old devices, and then the new mode of combining them, for which he desires a patent. It thus occurs that, in every application for a

patent, the descriptive part is necessarily largely occupied with what is not new, in order to an understanding of what is new. — *Merrill v. Yeomans*, 94 U. S. 568; 24 L. Ed. 235.

Inventors, before they can receive a patent, are required to file in the Patent Office a written description of their invention, and of the manner and process of making and using the same, in such full, clear, concise and exact terms as to enable a person skilled in the art to make, construct and use the same. — *Bates v. Coe*, 98 U. S. 31; 25 L. Ed. 68.

Accurate description of the invention is required by law for several important purposes. (1) That the government may know what is granted and what will become public property when the monopoly expires. (2) That licensed persons desiring to practise the invention may know, during the term, how to make, construct and use the invention. (3) That other inventors may know what part of the field of invention is unoccupied. — *Bates v. Coe*, 98 U. S. 31; 25 L. Ed. 68.

Gill v. Wells, 22 Wall. 27.

When the question is whether a thing can be done or not, it is always easy to find persons ready to show how not to do it. But it stands composed that the thing has been done; that is to say, the contrivance which Webster claims in his patent has been applied and very successfully so. If the thing could not be understood without the exercise of inventive power, it is a little strange that it should have been so easily adapted to looms on which it has been used and produced such striking results. — *Loom Co. v. Higgins*, 105 U. S. 580; 26 L. Ed. 1177.

The direction given in the patent is, that the flange or lip is to be separated from the valve seat by about one sixty-fourth of an inch for an ordinary spring, with less space for a strong spring and more space for a weak spring, to regulate the escape of the steam, as required. As matter of law, this description is sufficient within the rule laid down in *Wood v. Underhill*, 5 How. 1, and it is not shown to be insufficient, as a matter of fact. — *Consolidated v. Crosby*, 113 U. S. 157; 28 L. Ed. 939; 5 S. Ct. 513.

The provisions of the law regulating the granting of patents, which require an inventor to advise the world of his invention by a specific description thereof, and, by a definite claim, to obtain property in just so much of the invention as he seeks to appropriate, are essential that it may be known how much he has acquired as his own, and how far the public are to be restricted in the use of the invention. This specific description is open to be examined by all having occasion to enter that field of use or invention. — *Ross-Moyer v. Randall*, 104 Fed. 355; 43 C. C. A. 578.

Fay v. Cordesman, 109 U. S. 420.

That in the description of a basic electrical process, mere relative statements of the amount of power required are sufficient, see — *Electric v. Pittsburg*, 125 Fed. 926; 20 C. C. A. 636.

Inasmuch as the term "fire-brick," if used in the patent, would not have sufficiently identified the peculiar product to enable one skilled in the art to produce the patented product, but would have obliged him to experiment with various materials known under said name, we think the patentee was justified in the use of the said word (*chamotte*); that it may even have been necessary to a full disclosure of his alleged invention; and that, in view of the evidence, the court correctly found that fire-brick was not necessarily

the equivalent of chamotte. — *Panzl v. Battle Island*, 138 Fed. 48; 70 C. C. A. 474.

§ 906. Sufficiency — Alternative Constructions.

Accordingly when the inventor says, "I recommend the following method" he does not thereby constitute such method a portion of his patent. His patent may be infringed though the party does not follow his recommendation, but accomplishes the same end and by another method. — *Sewall v. Jones*, 91 U. S. 171; 23 L. Ed. 275.

The fact that the inventor said he preferred one of two methods described and claimed does not limit him to that one method. — *Telephone Cases*, 126 U. S. 1; 31 L. Ed. 863; 8 S. Ct. 778.

It seems to have been the effort of the draftsman to frame the specifications and claims so that any desirable limited or broad construction may be placed upon several of the claims, and thus defeat a defense of anticipation or of noninfringement (a multiplicity of constructions are shown in the drawings). If their enumeration serves any purpose except to point out the adaptability of the cap to use with such parts, it can only be to so restrict the claim that the making of the cap, or its use without them, would not infringe the patent. — *Crown v. Standard*, 136 Fed. 841; 69 C. C. A. 200.

§ 907. Sufficiency — Ambiguity.

Although the specification may describe the invention in technical terms which would be understood only by one skilled in that particular art, and although the specification presupposes a familiarity with the class of machines to which the invention belongs, and does not describe the elements or functions of such machine so long as the specification is technically intelligible it is not open to the attack of ambiguity or insufficiency. — *Loom Co. v. Higgins*, 105 U. S. 580; 27 L. Ed. 1177.

§ 908. Sufficiency — Distinguishing New from Old.

In all cases where his claim is for an improvement on a machine it will be incumbent on him to show the extent of his improvement, so that a person understanding the subject may comprehend distinctly in what it consists. — *Evans v. Eaton*, 3 Wheat. 454; 4 L. Ed. 433.

While it is true that the patentee is not required to point out and describe in express language what he has invented that is new, or the principle of his invention, and that it is sufficient if they can be gathered by implication from what is not set forth, yet the implications ought to be clear, so that it may not be left in obscurity and doubt whether the patentee has in reality invented and produced something new if nothing appears by express declaration or reasonably clear implication, to show that the patentee has made some new and valuable discovery, has thrown a light into a place which before was dark, and illumined what was inert, there is nothing in the patent law to give him any standing. — *Wells v. Curtis*, 66 Fed. 318; 13 C. C. A. 494.

Rob. Pat. sec. 79.

A fatal defect in claim 2 arises out of the words "at or near." We have seen that there is nothing in the specification to limit the indefinite nature of these words. Consequently, there is not enough in the patent to meet the requirements of the statute, pointing out the method by which a successful last can be made in accordance with the claim, and no useful last without

a holder was ever made until the respondent came into the field. — *Miller v. Mawhinney*, 105 Fed. 523; 44 C. C. A. 581.

It is the duty of the patentee to disclose his invention, that the public may be able to practise it when the monopoly expires. This disclosure should include the mode of operation as well as a method of construction. — *Good-year v. Rubber*, 116 Fed. 363; 53 C. C. A. 583.

Bates v. Coe, 98 U. S. 31; *Wells v. Curtis*, 66 Fed. 318; *Kelly v. Clow*, 89 Fed. 297.

If it was an essential part of his invention to so weaken the enclosing head that the entire head will yield, it was his duty under the statute to distinctly so state. — *Neptune v. National*, 127 Fed. 563; 62 C. C. A. 345.

Incandescent Lamp Pat. 159 U. S. 465; *Chemical v. Raymond*, 71 Fed. 179.

Suppose the artisan wishes to construct a device and does not wish to use that of the patent, how shall he know in what manner he shall avoid the patent? Or suppose a purchaser wishes to buy one. He must look out for the patent. By what test or comparison shall he be guided? These inquiries enforce the rule that the patentee must describe with sufficient certainty the particulars of his invention so that the artisan and the public may know the character and limits of it, and how it is to be distinguished from others which the one may name, or the other purchase in safety. — *Bullock v. General*, 149 Fed. 409; 79 C. C. A. 229.

Guidet v. Brooklyn, 105 U. S. 550; *Preston v. Manard*, 116 U. S. 661; *Howard v. Detroit*, 150 U. S. 168; *Incandescent Lamp Pat.* 159 U. S. 465.

§ 909. Sufficiency — Equivalents.

An inventor cannot "speculate on the equivalents of his claimed invention, and thereby oblige the public to resort to experiments in order to determine the scope of the claims of his patent." — *Panzl v. Battle Island*, 138 Fed. 48; 70 C. C. A. 474.

Matheson v. Campbell, 69 Fed. 597; *Matheson v. Campbell*, 78 Fed. 910.

The patentee took pains to point out that "the specific construction of the mechanism shown is not essential." This was unnecessary precaution; the law gave him ample protection in this regard. — *International v. Dey*, 142 Fed. 736; 74 C. C. A. 68.

Machine v. Murphy, 97 U. S. 120.

§ 910. Sufficiency — Excessive.

An excessive description does not injure the patent unless the addition be fraudulent. — *Sewall v. Jones*, 91 U. S. 171; 23 L. Ed. 275.

Curtis, sec. 248.

§ 911. Sufficiency — Function.

If any separate function had been performed by the combination it should have been pointed out in the specification. — *Union v. Keith* 139 U. S. 530; 35 L. Ed. 261; 11 S. Ct. 621.

It is not material that Gorham did not describe in full all the beneficial functions to be performed by the parts of his machine, if those functions are evident in the practical operation thereof, and are seen to contribute to the success of his device. It is difficult to believe that a man of Gorham's inventive genius did not perceive the useful functions which the parts of

his machine so well performed, even though he did not specifically mention them all. — *McCormick v. Aultman*, 69 Fed. 371; 16 C. C. A. 259.

Eames v. Andrews, 122 U. S. 40.

It is not material that the inventor did not describe in full all the beneficial functions to be performed by the parts of his machine, if those functions are evident in the practical operation thereof, and are seen to contribute to the success of his device. — *McCormick v. Aultman*, 69 Fed. 371; 16 C. C. A. 259.

Eames v. Andrews, 122 U. S. 40.

An inventor is not required to describe in full all the beneficial functions to be performed by his machine. If the thing accomplished is a necessary consequence of the improvement made and described, making it obvious that the inventor intended the thing accomplished, though not specifically pointed out, he is entitled to the benefit thereof in construing his patent — *Stilwell-Bierce v. Eufaula*, 117 Fed. 410; 54 C. C. A. 584.

Goshen v. Bissell, 72 Fed. 67; *Dowagiac v. Superior*, 115 Fed. 886.

It is objected that there is no reference in the specification to the fact that the object of the invention was to produce a fabric capable of being fleeced. But it is well settled that the patentee is not obliged to state all the objects of his invention, and that he is protected in all the beneficial uses thereof within its scope; and here no statement as to fleecing was necessary. — *Scott v. Fisher*, 145 Fed. 915; 76 C. C. A. 447.

§ 912. Sufficiency — Immaterial Error.

If the current moves and escapes just as the inventor provided it should, and by the means he had provided, and produces the useful result he intended, can it make any difference in the validity of the patent that he was mistaken in his explanation of the physical causes of the downward direction of the currents? — *Emerson v. Nimocks*, 99 Fed. 737; 40 C. C. A. 87.

§ 913. Sufficiency — Old Parts.

He need not describe particularly and disclaim all the old parts. — *Hogg v. Emerson*, 6 How. 437; 12 L. Ed. 505.

There is nothing in the patent law which compels the applicant to point out what elements are or are not new in the combination claimed. — *Brown v. Guild*, 90 U. S. 181; 23 L. Ed. 161.

§ 914. Sufficiency — Process.

The specification must be in such full, clear and exact terms as to enable one skilled in the art to which it appertains to compound and use the invention; that is to say, to compound and use it without making any experiments of his own. — *Wood v. Underhill*, 5 How. 1; 12 L. Ed. 23.

Now, a machine which consists of a combination of devices is the subject of invention, and its effects may be calculated a priori; while a discovery of a new substance by means of chemical combinations of known materials is empirical, and discovered by experiment. Where patent is claimed for such discovery, it should state the component parts of the new manufacture claimed with clearness and precision, and not leave the person attempting to use the discovery to find out by experiment. — *Tyler v. Boston*, 74 U. S. 327; 19 L. Ed. 93.

A process, though new and useful, in order that the patent thereon may be valid must describe the steps in such full and exact terms, avoiding unnecessary prolixity, as to enable a person skilled in the art to employ the same. — *Mowry v. Whitney*, 81 U. S. 20; 620 L. Ed. 860.

Every patent for a product or composition of matter must identify it so that it can be recognized aside from the description of the process for making it, or else nothing can be held to infringe the patent which is not made by that process. — *Cochrane v. Badische*, 111 U. S. 293; 28 L. Ed. 433; 4 S. Ct. 455.

It is immaterial that the philosophy of this process is better understood to-day than it was when the patent was issued, so long as the requirements of the patent would not be complied with by one skilled in the art unless he did in fact so use the process. — *Edison v. U. S.* 52 Fed. 300; 3 C. C. A. 83.

Patents (such as this) should be so plain under the statute as that an ordinary manufacturer of aniline colors, having such ordinary knowledge as would exist in this country at the date of the patent, should be enabled by the instructions of that patent to carry out successfully its processes. — *Matheson v. Campbell*, 78 Fed. 910; 24 C. C. A. 284.

The statement of a process upon the part of a patentee, to be sustainable, must not only clearly distinguish the old from the new, so that the novelty claimed is obvious, but must point out the new steps so definitely, that one wishing to use the process for the production of the desired product, will have a clear chart before his eyes. — *Cerealine v. Bates*, 101 Fed. 272; 41 C. C. A. 341.

The patentee having fully described one method of conducting the process, it is at least questionable whether that is sufficient to secure them against the invasion of the broad process set forth in the description by a resort to any other methods of practising it. — *Electric v. Carborundum*, 102 Fed. 618; 42 C. C. A. 537.

Tilghman v. Proctor, 102 U. S. 707.

It is well settled that when a patent contains a sufficient disclosure of the claimed invention, it will not be invalidated either by the failure of the patentee to state the causes which produce the operation, or by a mistaken statement as to the reasons therefor. The sufficiency of the disclosure and the novelty and utility of the result are the sufficient considerations for the grant. — *Hemolin v. Hardway*, 138 Fed. 54; 70 C. C. A. 480.

Inasmuch as the discovery of a new substance by means of chemical combination is empirical, and results from experiment, the law requires that the description in a patent should be specially clear and distinct. — *Panzl v. Battle Island*, 138 Fed. 48; 70 C. C. A. 474.

Tyler v. Boston, 7 Wall. 327; *Moody v. Fiske*, 2 Mason, 112; *Matheson v. Campbell*, 69 Fed. 597.

§ 915. Sufficiency — Rules for Determining.

We do not say that the party is bound to describe the old machine; but we are of opinion that he ought to describe what his own improvement is, and to limit his patent to such improvement. — *Evans v. Eaton*, 7 Wheat. 356; 5 L. Ed. 472.

The specification has two objects: one is to make known the manner of construction so as to enable the artisans to make and use it, and thus to give the public the full benefit of the discovery after the expiration of the patent. The other is to put the public in possession of what the party claims as his invention, so as to ascertain if he claims anything that is in common use, or is already known, and to guard against prejudice or injury from the use of an invention, which the party may otherwise innocently suppose not to be patented. It is therefore, for the purpose of warning an innocent purchaser, or other persons using a machine, of his infringement of the patent; and at the same time taking from the inventor the means of practising upon credulity, or the fears of other persons by pretending that his invention is for more than what it really is, or different from its ostensible objects. — *Evans v. Eaton*, 7 Wheat. 356; 5 L. Ed. 472.

The specification is an integral part of the letters patent under our system. — *Hogg v. Emerson*, 6 How. 437; 12 L. Ed. 505.

Whoever discovers that a certain useful result will be produced, in any art, machine, manufacture or composition of matter, by the use of certain means, is entitled to a patent for it; provided he specifies the means he uses in a manner so full and exact that anyone skilled in the science to which it appertains, can, by using the means he specifies, without any addition to or subtraction from them, produce precisely the results he describes. And if this cannot be done by the means he describes, the patent is void. — *O'Reilly v. Morse*, 15 How. 62; 14 L. Ed. 601.

It is evident that the definiteness of a specification must vary with the nature of its subject. Addressed as it is to those skilled in the art, it may leave something to their skill in applying the invention, but it should not mislead them. — *Mowry v. Whitney*, 81 U. S. 620; 20 L. Ed. 860.

It is required by R. S. 4888 that the application shall contain "a written description of the device and of the manner and process of making, constructing, compounding and using it in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains or with which it is most nearly connected, to make, construct, compound and use the same." The object of this is to apprise the public of what the patentee claims as his own, the courts of what they are called upon to construe, and competing manufacturers and dealers of what they are bound to avoid. If the description be so vague and uncertain that no one can tell, except by independent experiments, how to construct the patented device, the patent is void. — *Incandescent Lamp Pat.* 159 U. S. 465; 40 L. Ed. 221; 16 S. Ct. 75.

Grant v. Raymond, 31 U. S. 218; *Wood v. Underhill*, 46 U. S. 1; *Tyler v. Boston*, 74 U. S. 327; *Béné v. Jeantet*, 129 U. S. 683; *Howard v. Detroit*, 130 U. S. 164; *Schneider v. Lovell*, 10 Fed. 666; *Welling v. Crane*, 14 Fed. 571.

It is true that by a practice which seems to have somewhat gained favor in the courts, and which appears to be preferred by some patent solicitors, a description is held sufficient, if from it, aided by the drawings, the model, and the other parts of the application, the invention can be fully ascertained. Rob. Pat. sec. 489, n. 1. In other words, the position seems to be that what can be made certain by any reasonable amount of skill is of itself certain. — *B. & S. Fastener v. B. G. Fastener*, 58 Fed. 818; 7 C. C. A. 498.

He had not, perhaps, discovered all the materials or all the matter, or all the compositions which contained this force, and which were capable of performing the necessary functions, but as to such as he had discovered and

put in operative form, and such as he could describe with reasonable clearness, he was entitled to protection. Some of these compositions stood the test better, made better linings and did the work more successfully than others; and as to such as he used, such as he described, and such as those skilled in the art could understand, he is entitled to protection. — *American v. Howland*, 80 Fed. 395; 25 C. C. A. 500.

§ 916. Sufficiency — Scientific Knowledge.

An inventor may be ignorant of the scientific principle, or he may think he knows it and yet be uncertain, or he may be confident as to what it is and others may think differently. All this is immaterial, if by the specification the thing to be done is so set forth that it can be reproduced. — *Eames v. Andrews*, 122 U. S. 40; 30 L. Ed. 1064; 7 S. Ct. 1073.

The improvement consisted in a successful attempt to simplify the machinery and lessen the large amount of breakage. It is perfectly true that the description in the specification is confined to the purely mechanical feature of construction, and other operative mechanisms, and that the patentee nowhere told why his improvement diminished breakage. He did not know, or he did not tell, why the new method would produce better results. He simply told how to construct a machine which accomplished the end; but he ought not to lose the statutory benefits which would certainly belong to him, if he had seen and described the philosophy of his machine accurately. — *Dixon-Woods v. Pfeifer*, 55 Fed. 390; 5 C. C. A. 148.

If the fact be that his construction does effect the results, and they are beneficial, he is none the less entitled to the benefit of his invention though he may not have correctly understood the principles of its operation. — *Cleveland v. Detroit*, 131 Fed. 853; 68 C. C. A. 233.

Andrews v. Cross, 19 Blatchf. 294; *Eames v. Andrews*, 122 U. S. 40.

The language of the patent fails to state any theory of the patentee as to the presence of air below the screen-plates. But where a patent discloses means by which a novel and successful result is secured, it is immaterial whether the patentee understands or correctly states the theory or philosophical principles of the mechanism which produces the new result. — *Van Epps v. United*, 143 Fed. 869; 75 C. C. A. 77.

Walker on Pat. sec. 175; *Dixon-Woods v. Pfeifer*, 55 Fed. 390; *National v. Thomson*, 106 Fed. 531.

§ 917. Sufficiency — Unambiguousness.

In patents for machines the sufficiency of the description must, in general, be a question of fact to be determined by the jury, and this must also be the case in compositions of matter. — *Wood v. Underhill*, 5 How. 1; 12 L. Ed. 23.

Modern inventions very often consist merely of a new combination of old elements or devices, where nothing is or can be claimed except the new combination. Such a combination is sufficiently described to constitute a compliance with the letter and spirit of the Act of Congress if the devices of which it is composed are specifically named, their mode of operation given, and the new and useful result to be accomplished is pointed out, so that those skilled in the art and the public may know the extent and nature of the claim and what the parts are which cooperate to do the work claimed for the invention. — *Parks v. Booth*, 102 U. S. 96; 26 L. Ed. 54.

Sufficiently clear and descriptive when expressed in terms intelligible to persons skilled in the art. — *Seabury v. Am. Ende*, 152 U. S. 561; 38 L. Ed. 553; 14 S. Ct. 683.

A specification is sufficiently clear and descriptive when expressed in terms intelligible to a person skilled in the art to which it relates. — *Dowagiac v. Superior*, 115 Fed. 886; 53 C. C. A. 36.

Loom Co. v. Higgins, 105 U. S. 580; *Telephone Cases*, 126 U. S. 1.

It is not necessary that the description should be clear to one not skilled in the art. — *Wolff v. Du Pont*, 134 Fed. 862; 67 C. C. A. 488.

Loom Co. v. Higgins, 105 U. S. 580.

§ 918. Two Inventions, One Patent.

That an inventor may include several separate inventions in a single patent — see *Evans v. Eaton*, 3 Wheat. 454; 4 L. Ed. 433.

A patent embracing more than one invention, if the inventions are kindred, is not void. — *Hogg v. Emerson*, 11 How. 587; 13 L. Ed. 824.

§ 919. Miscellaneous Rules.

The invention claimed is an improvement on an old machine, and it is properly taken for granted that the practical mechanic is acquainted with the machine in which the improvement is made. — *Ives v. Hamilton*, 92 U. S. 426; 23 L. Ed. 494.

The patentee did not show the court the real advantages and extent of his alleged improvement, and therefore the court was unable to find infringement in anything which did not respond precisely to the form and letter of the patent. — *B. & S. Fastener v. Edgerton*, 96 Fed. 489; 37 C. C. A. 523.

An inventor is not called upon to state in his specifications or claims for a patent all the functions of his device, or all the uses to which his invention may be put. When he has plainly described and claimed his machine or combination, and has secured a patent for it, he has the right to every use to which his device can be applied, and to every way in which it can be utilized to perform its function, whether or not he was aware of all these uses or methods of use when he claimed and secured his monopoly. — *National v. Interchangeable*, 106 Fed. 693; 45 C. C. A. 544.

Roberts v. Ryer, 91 U. S. 150; *Miller v. Mfg. Co.* 151 U. S. 186; *Goshen v. Bissell*, 72 Fed. 67; *Stearns v. Russell*, 85 Fed. 218; *Mfg. Co. v. Neal*, 90 Fed. 725; *Tire Co. v. Lozier*, 90 Fed. 732.

The specification fails to express the state of the art or the nature or purpose of the invention in any comprehensible manner. It deals with numerous small details of machinery, and points out the purpose in such general terms as not to be practically useful. The record also fails to explain in a clear manner what is thus omitted from the specification. (The patent was held substantially bad). — *U. S. Peg-Wood v. Sturtevant*, 125 Fed. 378; 60 C. C. A. 244.

The brevity and simplicity of his specification and claim do not detract from the merit and validity of his patent, and are a refreshing contrast to the verbosity of the patent in suit. — *Crown v. Standard*, 136 Fed. 841; 69 C. C. A. 200.

An inventor is not called upon to describe every use to which his invention may be put. If he discloses it fully and clearly in one environment, the change requiring no inventive skill, cannot escape infringement. — *Sanitary v. Sprickerhoff*, 139 Fed. 801; 71 C. C. A. 565.

It does not follow that, because the patentee did not state all the advantages of his invention, he was ignorant of them. But if he was, yet if those advantages were really present, they might properly be taken into account in estimating the novelty and utility of the invention. In a number of opinions of this court it has been held that it is not necessary for the patentee to describe in detail all the beneficial functions which he claims will result from his invention. It is enough if those functions are evident and obviously contribute to the success of the invention. — *General v. Bullock*, 152 Fed. 427; 81 C. C. A. 569.

McCormick v. Aultman, 69 Fed. 371; *Goshen v. Bissell*, 72 Fed. 67; *Dowagiac v. Superior*, 115 Fed. 886; *Goodyear v. Rubber*, 116 Fed. 363; *Stilwell v. Eufaula*, 117 Fed. 410.

STATE STATUTES AND REGULATIONS AFFECTING PATENT RIGHTS.

General Statement and Decisions § 920 See — <i>Jurisdiction</i> § 724; <i>Letters</i>		<i>Patent</i> § 746; <i>Sale of Patented Article</i> § 899
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§ 920. General Statement and Decisions.

Since the right to issue patents is specially delegated to the Federal Government by section eight of article one of the Constitution, it follows that no state may grant a patent. But it will be seen from the following decisions that the Supreme Court is generally disposed to leave to the state legislatures and courts the enactment and enforcement of regulations affecting the exercise of the patent monopoly in the protection of business and morals, so long as such action does not interfere with vested rights and the exercise of legitimate activity.

The right conferred upon the patentee and his assigns to use and vend the corporeal thing or article, brought into existence by the application of the patented discovery, must be exercised in subordination to the police regulations which a state has established. It is not to be supposed that Congress intended to authorize or regulate the sale within a state of tangible personal property which the state declares to be unfit and unsafe for use and by statute has prohibited from being sold or offered for sale within its limits. — *Patterson v. Commonwealth*, 97 U. S. 501; 24 L. Ed. 1115.

Gibbons v. Ogden, 9 Wheat. 1; *License Cases*, 5 How. 504; *Gilman v. Philadelphia*, 3 Wall. 713; *Henderson v. Mayor*, 92 U. S. 259; *R. R. v. Husen*, 95 U. S. 465; *Beer Co. v. Mass.* 95 U. S. 25; *U. S. v. Dewitt*, 9 Wall. 41; *Com. v. Alger*, 7 Cush. 53; *Stephens v. Cady*, 14 How. 530; *Stevens v. Gladding*, 17 How. 453; *Miller v. Taylor*, 4 Burr, 2303; *Jordan v. Overseers*, 4 Ohio, 295; *Vasuni v. Paine*, 1 Har. 64; *Livingstone v. Van Ingen*, 9 Johns, 507.

That a state may prohibit by statute the use or sale of an injurious or dangerous product, although the product of a patent is clear. — *Patterson v. Commonwealth*, 97 U. S. 501; 24 L. Ed. 1115.

It is only the right to the invention or discovery, the incorporeal right, which the State cannot interfere with. Congress never intended that the patent laws should displace the police powers of the states, meaning by that

term those powers by which the health, good order, peace and general welfare of the community are promoted. Whatever rights are secured to inventors must be enjoyed in subordination to this general authority of the State over all property within its limits. — *Webber v. Virginia*, 103 U. S. 344; 26 L. Ed. 565.

Patterson v. Kentucky, 97 U. S. 501.

The right conferred by the patent laws to inventors to sell their inventions and discoveries does not take the tangible property, in which the invention or discovery may be exhibited or carried into effect, from the operation of the tax and license laws of the State. The combination of different materials so as to produce a new and valuable product or result, or to produce a well known product or result more rapidly and better than before, which constitutes the invention or discovery, cannot be forbidden by the State, nor can the sale of the article or machine produced be restricted, except as the production and sale of other articles for the manufacture of which no invention or discovery is patented or claimed, may be forbidden or restricted. — *Webber v. Virginia*, 103 U. S. 344; 26 L. Ed. 565.

We can find no objection to the legislation of Virginia in requiring a license for the sale of sewing machines, by reason of the grant of letters patent for the invention; but there is no objection arising from its discriminating against non-resident merchants and their agents. — *Webber v. Virginia*, 103 U. S. 344; 26 L. Ed. 565.

We think the state has the power (certainly until Congress legislates on the subject) with regard to the provision which shall accompany the sale or assignment of rights arising under a patent, to make reasonable regulations concerning the subject calculated to protect its citizens from fraud. And we think Congress has not so legislated by the provisions regarding an assignment contained in the acts referred to. (R. S. 4898.) If there is a special evil, unusually frequent and easily perpetrated when parties are dealing in the sale of rights existing or claimed to exist under a patent, we do not see why a state may not, in the bona fide exercise of its powers, enact some special statutory provision which may tend to arrest such evil, and may omit to enact the same provision concerning the disposal of other property. There is no discrimination which can be properly so-called, against property in patent rights, exercised in such legislation. It is simply an attempt to protect the citizen against frauds and impositions, which can be more readily perpetrated in such cases than in cases of the sale or assignment of ordinary property. — *Allen v. Riley*, 203 U. S. 347; 51 L. Ed. 216; 27 S. Ct. 95.

Pinney v. Bank, 68 Kan. 223; *Brechbill v. Randall*, 102 Ind. 528; *New v. Walker*, 108 Ind. 365; *Tod v. Wick*, 36 Ohio 370; *Haskell v. Jones*, 86 Pa. 173; *Herdie v. Roessler*, 109 N. Y. 27; *Wyatt v. Wallace*, 67 Ark. 575; *State v. Cook*, 107 Tenn. 499. States in which similar legislation has been held unconstitutional, see, *Holliday v. Hunt*, 70 Ill. 109; *Cranson v. Smith*, 37 Mich. 309; *Wilch v. Phelps*, 14 Neb. 134; *State v. Lockwood*, 43 Wis. 405; *Patterson v. Kentucky*, 97 U. S. 501; *Webber v. Virginia*, 103 U. S. 344.

That a state has power to enact laws regulating the sale of patent rights and the giving of evidences of indebtedness therefor, see — *Woods v. Carl*, 203 U. S. 358; 51 L. Ed. 219; 27 S. Ct. 99.

Allen v. Riley, 203 U. S. 347.

That the provisions of a state law cannot affect rights acquired under a patent of the United States, is too plain to require discussion. — *U. S. Consolidated v. Griffin*, 126 Fed. 364; 61 C. C. A. 334.

Columbia v. Freeman, 71 Fed. 302.

A state cannot subtract from the right conferred upon a patentee and his assigns by the Federal laws. *Columbia v. Freeman*, 71 Fed. 302; *U. S. v. Griffin*, 126 Fed. 364. For the protection of the physical or moral health of its citizens a state may restrain the use of "the corporeal thing or article brought into existence by the application of the patented discovery." *Patterson v. Kentucky*, 97 U. S. 501, but such a laying on of hands does not touch the monopoly of the Federal grant. — *Rubber Tire v. Milwaukee*, 154 Fed. 358; 83 C. C. A. 336.

STATUTE OF LIMITATIONS.

General Statement and Decisions | See — *Damages* § 278; *Profits* § 825
§ 921

§ 921. General Statement and Decisions.

Prior to Jan. 1, 1898, there was no statutory limitation as to the time of recovery of profits or damages. By the act of Mar. 3, 1897, in effect Jan. 1, 1898, the following was added to sec. 4921:

But in any suit or action brought for the infringement of any patent there shall be no recovery of profits or damages for any infringement committed more than six years before the filing of the bill of complaint or the issuing of the writ in such suit or action, and this provision shall apply to existing causes of action.

The patent had some twelve years to run after the date of this contract. The substance of this contract is, that the defendants are to pay in money a certain proportion of the ascertained value of the fuel saved at stated intervals throughout the period of twelve years, if the boat to which the cut-off is attached should last as long. The result is that the contract is void, not being in writing. It is a contract not to be performed within the year, subject to a defeasance by the happening of a certain event which might or might not occur within that time. — *Packet Co. v. Sickles*, 72 U. S. 580; 18 L. Ed. 550.

When there is an alleged promise or contract set up, a delay of 15 years brings the case within the statute. — *Leggett v. Standard*, 149 U. S. 287; 37 L. Ed. 737; 13 S. Ct. 902.

McLean v. Fleming, 96 U. S. 245; *Speidel v. Henrici*, 120 U. S. 377; *Galliber v. Cadwell*, 145 U. S. 368.

State statutes of limitations apply to an action at law for infringement. This case is the leading case upon this subject, and for the first time this question has been settled in the affirmative by the Supreme Court. — *Campbell v. Haverhill*, 155 U. S. 601; 39 L. Ed. 280; 15 S. Ct. 217.

Hayden v. Oriental, 15 Fed. 605; *Bricknall v. Hartford*, 49 Fed. 372; *Bauserman v. Blunt*, 147 U. S. 647; *Metcalf v. Watertown*, 153 U. S. 671; *Balkam v. Woodstock*, 154 U. S. 177; *Rudd v. Burrows*, 91 U. S. 426; *Indianapolis v. Horst*, 93 U. S. 291; *Phelps v. Oaks*, 117 U. S. 236; *Keshkonong v. Burton*, 104 U. S. 668; *Wheeler v. Jackson*, 137 U. S. 245; *Adams v. Woods*, 6 U. S. 336; *Bell v. Morrison*, 26 U. S. 351; *Vance v. Campbell*, 66 U. S. 427; *Hauskencht v. Claypool*, 66 U. S. 431; *Wright v. Bales*, 67 U. S. 535; *McElmoyle v. Coehn*, 38 U. S. 312; *Andrea v. Redfield*, 98 U. S. 225; *Barney v. Oelrichs*, 138 U. S. 529; *Barton v. White*, 144 Mass. 281; *Re Keach*, 14 R. I. 571; *Beatty v. Burnes*.

12 U. S. 98; *M'Cluny v. Silliman*, 28 U. S. 270; *Patterson v. Kentucky*, 97 U. S. 501; *Webber v. Virginia*, 103 U. S. 344; *Ager v. Murray*, 105 U. S. 126; *Ashcroft v. Walworth*, 1 Holmes, 152.

We are of opinion that the Court of Claims ruled correctly that the statute of limitations was a bar to any recovery for the use of the patented invention prior to six years before the action was commenced. — *U. S. v. Berdan*, 156 U. S. 552; 39 L. Ed. 530; 15 S. Ct. 420.

STATUTES RELATING TO PATENTS — THE PATENT STATUTE.

General Statement § 922

Decisions Relating to the Statutes
§ 923

*See — The Patent Statute Digested
and Provided With the Patent Office
Annotations, page 849*

§ 922. General Statement.

An elaborate history of the Patent Act will be found in *Root v. Railway*, 105 U. S. 189. While all the more important sections which have been connected with appellate decisions are quoted at the beginning of the several titles, the entire Act has been digested and arranged on the same lines as the decisions, provided with the Patent Office annotations, and added as a separate chapter.

§ 923. Decisions Relating to the Statutes.

The object of 4917 is to enable the patentee to disclaim what he has not invented; and 4922 is to legalize and uphold suits brought on patents mentioned in 4917. — *Hailes v. Albany*, 123 U. S. 582; 31 L. Ed. 284; 8 S. Ct. 262.

A patent statute cannot be judicially settled until passed upon by the Supreme Court. — *Andrews v. Hovey*, 124 U. S. 694; 31 L. Ed. 557; 8 S. Ct. 676.

Wilson v. City, 84 U. S. 473; *Ex Parte Wilson*, 114 U. S. 417.

Sec. 4887 fully discussed historically and construed in *Bate v. Sulzberger*, 157 U. S. 1; 39 L. Ed. 601; 15 S. Ct. 508.

See also *Bate v. Hammond*, 129 U. S. 151.

To hold that a treaty could not abrogate a prior statute regarding patents because this particular legislative power is committed to Congress could not be permitted so long as the general rule as to statutes superseding treaties, and vice versa, declared by the Supreme Court in the way we have pointed out exists. The rules which we have explained with reference to the relation of treaties to statutes, and as to treaties becoming immediately effective are the necessary sequence of the decisions explained in *U. S. v. Lee*, 185 U. S. 213. — *United v. Duplessis*, 155 Fed. 842; 84 C. C. A. 76.

THREATS.

General Statement § 924

§ 924. General Statement.

Notice is one thing, a threat quite another. A threat is never justifiable; a notice may be justifiable or it may amount to a threat. See *Adriance v. National*, 121 Fed. 827, under § 516.

Where notices are given or circulars distributed in good faith to warn against infringement, no wrong whatever is committed; but where as is here averred, they are not made or issued with such intent, but in bad faith, and solely for the purpose of destroying the business of another, a very different case is presented. In such a case property rights are fraudulently assailed, and a court of chancery, whose interposition is invoked for their protection, should not refuse to accord it. — *Farquhar v. National*, 102 Fed. 714; 42 C. C. A. 600.

Emack v. Kane, 34 Fed. 46; *Kelly v. Mfg. Co.* 44 Fed. 23; *Casey v. Union*, 45 Fed. 135; *Toledo v. Penn.* 54 Fed. 730; *Computing v. National*, 79 Fed. 962; *Lewin v. Light Co.* 81 Fed. 904; *Railway v. McConnell*, 82 Fed. 65; *Adriance v. National*, 98 Fed. 118; *In re Debs*, 158 U. S. 564; *Herbert v. Rainey*, 54 Fed. 248.

TITLE.

<p>General Statement § 925 Actionable § 926 Miscellaneous Rules § 927 See — <i>Abatement</i> § 21; <i>Assignment</i> § 149; <i>Bankruptcy</i> § 182; <i>Corporations</i> § 271; <i>Defenses</i> § 306; <i>Injunc-</i></p>	<p><i>tion</i> § 571; <i>Letters Patent</i> § 746; <i>License</i> § 749; <i>Licensor and Licensee</i> § 766; <i>Mortgage</i> § 778; <i>Pleading and Practice</i> §§ 801, 806; <i>Sale of Patented Article</i> § 899</p>
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§ 925. General Statement.

It has been shown under *Assignment* and *License* (§§ 150 and 750) what constitutes a title interest in a patent and what constitutes a license interest under a patent. The rule in the *Waterman Case* there quoted is definitive. The statute makes no specific provision on the subject. Joint owners are tenants in common, and an accounting does not lie between them. — *Blackledge v. Weir*, 108 Fed. 71, *infra*, and cases cited thereunder.

§ 926. Actionable.

The holder of the legal title only can maintain an action against a third party who commits an infringement upon it. — *Gayler v. Wilder*, 10 How. 477; 13 L. Ed. 504.

Nemo dat quod non habet applies to titles to patent interests. — *Mitchell v. Hawley*, 83 U. S. 544; 21 L. Ed. 322.

Foxley's case, 5 Co. 109; 2 Black. Com. 449; 2 Kent's Com. 224; *Williams v. Merle*, 11 Wend. 80; *Syone v. Marsh*, 6 B. & C. 551; *Marsh v. Keating*, 1 Bing. N. C. 198; *Benj. Sales*, 4; *White v. Spettigue*, 13 Mus & W. 603.

Inasmuch as four years have elapsed since the assignment was executed, and the corporation has shown no disposition to question its validity, and inasmuch as the assignment under which the complainant derives title is good and sufficient in form to transfer a legal title to the patent, we think that no third party — not even a person who has a lien on certain stock of the corporation — should be permitted to challenge the validity of the assignment in a collateral proceeding. — *Kansas City v. Devol*, 81 Fed. 726; 26 C. C. A. 578.

2 Morr. Corp. sec. 619, 626 and 631.

In view of the fact that the infringers have no interest or claim to said patent, and that they do not assert any legal or equitable title to said patent is asserted by any one else, or is in fact now outstanding in any one else, it might be sufficient to hold for the purpose of this case, and as against mere infringers, the *prima facie* record title should be sufficient to warrant a decree. — *Goss v. Scott*, 108 Fed. 253; 47 C. C. A. 302.

The assignor was sole patentee. It will be noticed that the assignor is one of the assignees. But no criticism is made upon that circumstance. We think the objection stated is hypercritical, and that the intent and effect of the assignment was to transfer a one-half interest to the other partner, nothing appearing to show that the partners stood upon unequal terms. — *Canda v. Michigan*, 124 Fed. 486; 61 C. C. A. 194.

Suit by an assignee for infringement is authorized only when the assignment is complete within the statutory requirement. The rights of the patentees cannot be adjudicated in their absence, and the claimant of an equitable title or interest cannot maintain suit for infringement upon such title alone. — *Milwaukee v. Brunswick-Balke*, 126 Fed. 171; 61 C. C. A. 175.

Rob. Pat. sec. 771; Curt. Pat. secs. 171-2; *Regan v. Pacific*, 49 Fed. 68; *Waterman v. Mackenzie*, 138 U. S. 252; *Pope v. Gormully*, 144 U. S. 248; Rob. Pat. sec. 1099; *Stimpson v. Rogers*, 4 Blatchf. 333.

Whether the transfer of a title to a patent as a pledge for a debt is such alienation as will prevent the patentee from maintaining an action for infringement, see — *Westmoreland v. Hogan*, 167 Fed. 327; C. C. A.

§ 927. Miscellaneous Rules.

The commissioner should decide upon the sufficiency of the title of the applicant, and having done so, the right of applicant to compel issue is by appeal and not mandamus. — *Holloway v. Whiteley*, 71 U. S. 522; 18 L. Ed. 335.

Difference between right to vend and right to use. Rule (old) stated in *Mitchell v. Hawley*, 83 U. S. 544; 21 L. Ed. 322.

Bloomer v. McQuewan, 14 How. 549; *Chaffee v. Belting Co.* 22 How. 223.

In the nature of things lawful purchase of a patented article carries with it the lawful right to use without restriction of time or place. — *Adams v. Burks*, 84 U. S. 453; 21 L. Ed. 700.

Bloomer v. McQuewan, 14 How. 549; *Mitchell v. Hawley*, 83 U. S. 544.

It does not lie in the mouth of an alleged infringer to set up the right of the assignee as against a title from the bankrupt acquired with the consent of such assignee. — *Sessions v. Romadka*, 145 U. S. 29; 36 L. Ed. 609; 12 S. Ct. 799.

When the patentee has not parted, by assignment, with any of his original right but chooses himself to make and vend a patented article of manufacture, it is obvious that a purchaser can use the article in any part of the United States, and, unless restrained by contract with the patentee, can sell and dispose of the same. It has passed outside of the monopoly, and is no longer under the peculiar protection granted to patented rights. — *Keeler v. Standard*, 157 U. S. 659; 39 L. Ed. 848; 15 S. Ct. 738.

Goodyear v. Beverly, 1 Cliff. 348.

The sale of a patent right contains an implied warranty as to title, and an after acquired title obtained by the vendor inures to the vendee. — *Brush v. California*, 52 Fed. 945; 3 C. C. A. 368.

Faulks v. Kamp, 3 Fed. 989; *Curran v. Burdsall*, 20 Fed. 835; *Gottfried v. Miller*, 104 U. S. 520; *Smith v. Sheley*, 12 Wall. 358.

That a legal title acquired with notice of a prior equitable title, is inferior thereto, see — *Carroll v. Goldschmidt*, 83 Fed. 508; 27 C. C. A. 566.

That the acquirement of a title which would protect a defendant against a charge of infringement committed subsequent thereto, cannot be made to relate back to acts done prior to such acquisition, see — *Keene v. Barratt*, 100 Fed. 590; 40 C. C. A. 571.

Now, it is certainly settled that partners may acquire legal title to personal property under a purchase made in the firm name; and it is not material whether such firm name is wholly fanciful or whether it contains the names of one or more of the members of the firm. — *Fresno v. Fruit*, 101 Fed. 826; 42 C. C. A. 43.

Manghaum v. Sharpe, 17 C. B. (N. S.) 443.

It was stipulated between the parties that if, on the reference, it appeared that the complainant had the full legal title, the balance of the royalty should be then paid. A hearing was had before the referee and he decided, in substance, as the court below held, that the title was not an absolutely perfect title, but was a perfectly good marketable title. *Held*: sufficient. — *Deering v. Kelly*, 103 Fed. 261; 43 C. C. A. 225.

The use of an invention by one of co-owners or by his licensees is not the exercise of the entire monopoly conferred by the patent. That can be effected only by the joint or concurrent action of all owners. The separate action of any one owner or his licensees can be an exercise or use only of his individual right, which, though exclusive of all besides, is not exclusive of the other patentees, their assignees or licensees. On principle, therefore, there can be no accountability on the part of a part owner of an invention to other owners for profits made by the exercise of his individual right, whether it be by engaging in the manufacture and sale, or by granting to others licenses, or by assigning interests in the patent. — *Blackledge v. Weir*, 108 Fed. 71; 47 C. C. A. 212.

Clum v. Brewer, Fed. Cas. 2,909; *Mfg. Co. v. Gill*, 32 Fed. 697; *Bloomer v. McQuewan*, 14 How. 539; *Mathers v. Green*, 34 Beav. 170; *Steers v. Rogers*, 62 Law. J. Ch. 671; *Vose v. Singer*, 4 Allen, 226; *Dunham v. Railroad*, Fed. Cas. 4,151. (See also long list of cases cited in the briefs.)

Joint owners of a patent are at the mercy of each other. Each may use or license others to use the invention without the consent of his fellows and without responsibility to such fellows for the profits arising from such use or license. — *McDuffee v. Hestonville*, 162 Fed. 36; 89 C. C. A. 76.

Clum v. Brewer, 2 Curt. 523; *Aspinwall v. Gill*, 32 Fed. 697; Walk Pat. § 294.

TRADEMARKS.

General Statement and Cases Relating to Patents § 928

§ 928. General Statement and Cases relating to Patents.

The trademark right is one which arises by occupation under the common law, and is a right wholly distinct from the right to a patent, which arises only under the statute and in contravention of the common law right. The Federal law with reference to the registration of trademarks creates no monopoly, but gives the registrant certain advantages in the protection of his right, all being matters with which the patent law is not concerned.

General rule, *held*: The generic right to trademark founded on a patent expires with the patent; but another using it must distinguish his mark to avoid unfair trade. — *Singer v. June*, 163 U. S. 169; 41 L. Ed. 118; 16 S. Ct. 1002.

That the right to a trademark founded upon a patent expires with the patent, see — *Holzapfels v. Rahtjens*, 183 U. S. 51; 46 L. Ed. 49; 22 S. Ct. 6.

It is true that during the life of the patent the name of the thing may also be indicative of the manufacturer, because the thing can then be manufactured only by the single person; but when the right to manufacture and sell becomes universal, the right to the use of the name by which the name is known becomes equally universal. It matters not that the inventor coined the word by which the thing has become known. It is enough that the public has accepted that word as the name of the thing, for thereby the word has become incorporated as a noun into the English language, and the common property to all. Whatever doubts may theretofore have existed on this proposition have been, for the federal courts, put at rest by the recent decision of the Supreme Court in the case of *Singer v. June*, 163 U. S. 169. — *Centaur v. Heinsfurter*, 84 Fed. 955; 28 C. C. A. 581.

Canal Co. v. Clark, 13 Wall. 311; *Chemical Co. v. Meyer*, 139 U. S. 540; *Mfg. Co. v. Nairn*, 7 Ch. Div. 834; *Mfg. Co. v. Shakespear*, 39 Law. J. Ch. 36.

That the right to use a trade name or designation specifically indicating the article made under the patent, terminates with the licensee see — *Stimpson v. Stimpson*, 104 Fed. 893; 44 C. C. A. 241.

The designers of articles of manufacture not otherwise entitled to receive design patents cannot justify the issuance of such patents on any theory that the design is a trade-mark. — *Rowe v. Blodgett*, 112 Fed. 61; 50 C. C. A. 120.

In an action for unfair competition and infringement of trademark the facts were that defendant, while connected with complainant, had obtained a patent relating to the product trademarked by the name of the inventor, but that he had made no assignment of the patent, and that complainant had secured no rights thereunder. The court held that, defendant having established an independent business, complainant could not mark its articles "patented" or "owned by" as referring to such patent, but could use the mark. — *Hygienic v. Way*, 137 Fed. 592; 70 C. C. A. 553.

That a mere assignment of a patent does not carry with it a trade-mark formerly used to advertise the patented article, and that when the patentee's name is some part of such mark, in using his name in connection with subsequent patents on similar articles, he must clearly distinguish from the previous mark, see — *Reed v. Frew* 162 Fed. 887; 89 C. C. A. 577.

UNFAIR TRADE.

General Statement and Cases § 929 | See — *Pleading* § 794

§ 929. General Statement and Cases.

As will be seen from the following cases, this subject is a recent one in connection with patents. Much law is yet to be made upon the subject. It would seem to the writer that it must be decided ultimately that, as in the case of a trademark which is the designation of a patented article, the right to that which relates to appearance must expire with the patent. It would seem, also, that a bill for infringement and for unfair trade would be multifarious, notwithstanding the ruling in *Adam v. Folger*, 120 Fed. 260 (see § 795).

But the trial judge seems to put his conclusion on another ground — unfair competition in trade. What is above said applies to this point in the opinion. Defendants seem to be acting in good faith, and allege their ability to respond in damages, which is not questioned. Bouchat believes he has made an improvement in coat pads entitling him to a patent. He has obtained letters patent therefor. This cost something, and a company has been organized to manufacture coat pads under these letters patent. Is this unfair competition in trade? If so, no improvement in a patented article could ever be made by one versed in the art. Bouchat had worked at the trade of making coat pads, became familiar with the art, experienced in the business, and knew the demands of the trade. True, this was when he was a stockholder, owning one share, and an employee of a corporation using the Goldman patent, when he probably saw the defects in the coat pads manufactured under the patent, and devised what he conceived to be an improvement in coat pads. Is the fact that he was such stockholder and employee of a corporation using a patent to deprive him of the benefit of supposed inventive genius? If so no one would probably ever make any improvements on patented articles. — *American v. Phoenix*, 113 Fed. 629; 51 C. C. A. 339.

Upon the claim made for the appellant, it would be impossible, without invading complainant's right, to construct and sell a book-case having the most desirable characteristics. Nor is it competent for one person to appropriate to his own purposes any common and general characteristics of the goods he manufactures to such an extent that another shall be impleaded or embarrassed in his free right to the use of such characteristics. (The claim was unfair trade in making sectional book-cases which could be used in stack with those of the complainant). — *Globe-Wernicke v. Macey*, 119 Fed. 696; 56 C. C. A. 304.

The name "Victor" was adopted to denote the heater manufactured in accordance with the specifications of the patent. It would be a fraud upon the public, during the life of the patent, to permit a stranger to palm off a spurious article for the patented article by means of the identifying and generic name of the latter. — *Adam v. Folger*, 120 Fed. 260; 56 C. C. A. 540.

Singer v. June, 163 U. S. 169; *Holzapfel's v. Rahtjens*, 183 U. S. 1; *Centaur v. Heinsfurter*, 84 Fed. 955; *Gally v. Mfg. Co.* 30 Fed. 118; *Stimpson v. Stimpson*, 104 Fed. 893.

Of course in this suit for infringement of a patent we cannot inquire into the apparently unfair devices in the way of get up, ornamentation, etc., by which it is suggested that the defendants are seeking to deceive the public into a belief that their bells are those of the complainant. — *New Departure v. Sargent*, 127 Fed. 152; 62 C. C. A. 266.

UNPATENTED INVENTIONS.

Statutory Provision § 930 Assignment § 931 Construction or Sale Before Patent § 932 Employee § 933		Non-Assignable § 934 Miscellaneous § 935 See — <i>Abandonment</i> § 1; <i>License</i> § 756; <i>Secret Process or Machine</i> § 898
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§ 930. Statutory Provision.

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

right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor. R. S. 4899.

In addition to the foregoing certain rights in the nature of shop licenses or implied licenses may arise out of conditions of employment. See § 756, also § 366.

§ 931. Assignment.

While it is, perhaps, not necessary to decide whether in any case a sale of an invention which is never patented carries with it anything of value, we are of opinion that the rights growing out of an invention may be sold, and that in the present case the sale, with the right to use it in connection with the existing patent and its reissues or renewals, protects defendants from liability. — *Hammond v. Mason*, 92 U. S. 724; 23 L. Ed. 767.

A court of chancery cannot decree specific performance of an agreement to convey property which has no existence or to which defendant has no title. — *Kennedy v. Hazleton*, 128 U. S. 667; 32 L. Ed. 576; 9 S. Ct. 202.

§ 932. Construction or Sale Before Patent.

Under section 4899 the following have an implied license to a machine made before patent: (1) every person "who purchases of the inventor" the machine before his application for a patent; (2) every person who "with his knowledge and consent constructs" the machine before application; (3) every person who sells a machine "so constructed," that is to say, which has been constructed with the knowledge and consent of the inventor by another person; (4) every person "who uses one so constructed," that is to say, constructed with the inventor's knowledge and consent by another person.

In order to entitle a person to any of these four classes to use and vend the machine, under this section, the machine must originally have been either purchased from the inventor or else constructed with his knowledge and consent before his application for a patent; and it may well be that a fraudulent or surreptitious purchase or construction is insufficient. — *Wade v. Metcalf*, 129 U. S. 202; 32 L. Ed. 661; 9 S. Ct. 271.

Kendall v. Winsor, 62 U. S. 522; *Andrews v. Hovey*, 124 U. S. 694.

When machine was constructed by partnership, of which inventor was a member, an implied license arises in favor of the machine as constructed. *Quaere*. — *Wade v. Metcalf*, 129 U. S. 202; 32 L. Ed. 661; 9 S. Ct. 271.

§ 933. Employee.

Where the inventor in employ of defendant allowed his unpatented invention to be used with his knowledge and consent, according to the terms of the statute defendant has a right to continue to use those machines without compensation. — *Dable v. Flint*, 137 U. S. 41; 34 L. Ed. 618; 11 S. Ct. 8.

§ 934. Non-Assignable.

The inventor of a new and useful improvement certainly has no exclusive right to it, until he obtains a patent. This right is created by the patent, and no suit can be maintained by the inventor against anyone, for using it before the patent is issued. But the discoverer of a new and useful improvement is vested by law with an inchoate right to its exclusive use, and which he may perfect and make absolute by proceeding in the manner which the law requires. — *Gayler v. Wilder*, 10 How. 477; 13 L. Ed. 504.

The inventor who designedly and with a view to applying it indefinitely and exclusively for his own benefit withholds his invention from the public comes not within the policy or objects of the Constitution. Hence, if, during such concealment, an invention similar to or identical with his own should be made or patented or brought into use without a patent, the latter could not be inhibited nor restricted. Moreover, that which is once given to or is invested in the public cannot be recalled nor taken from them. — *Kendall v. Winsor*, 62 U. S. 322; 16 L. Ed. 165.

In the absence of protection by patent, no person can monopolize or appropriate to the exclusion of others elements of mechanical construction which are essential to the successful practical operation of a manufacture, or which primarily serve to promote its efficiency for the purpose to which it is devoted. Unfair competition is not established by proof of similarity of form, dimensions, or general appearance alone. — *Marvel v. Pearl*, 133 Fed. 160; 66 C. C. A. 226.

§ 935. Miscellaneous.

The right of Duncan to the inventions, if they were inventions, existed prior to, and continued independently of, the issuing of the patents. — *Siemens-Halske v. Duncan*, 142 Fed. 157; 73 C. C. A. 375.

Fuller v. Berger, 120 Fed. 274; *Victor v. The Fair* 123 Fed. 424.

WORDS AND PHRASES.

“Means” § 936
 “Substantially,” etc. § 937
 “Whereby” Clause § 938

See — *Claims* §§ 214, 229; *Equivalents* § 373; *Specification* § 900

§ 936. “Means.”

Of course an inventor cannot by the mere use of the word “means,” in reference to the accomplishment of a designated function in a combination claim, appropriate any and all kinds of mechanism or devices which may perform the specified function, or any other mechanism or device than that which is described in the patent, or which is its equivalent. Reference must be had to the specifications to ascertain the means which are made an element of the claim and are protected by the patent. — *American v. Hickmott*, 142 Fed. 141; 73 C. C. A. 359.

Jones v. Munger, 49 Fed. 61; *Williams v. Steam*, 47 Fed. 322.

While the claims specify the physical elements of the combinations, they do not specify the means whereby those elements perform their intended functions, but call for “means” generally for performing them. By this is not meant all possible means for accomplishing the result. Such comprehensiveness of claim would not be patentable. The claims in question by direct terms refer to the specification for the means by which the function, purpose, or object of the invention is to be accomplished, and to that we must look for them. — *Union v. Diamond*, 162 Fed. 148; 89 C. C. A. 172.

Dryfoos v. Wiese, 124 U. S. 32.

§ 937. “Substantially,” etc.

The words “substantially as set forth,” “substantially as described” refer to the specification, and tend to make the claim specific. — *Seymour v. Osborne*, 78 U. S. 516; 20 L. Ed. 33.

Expressions such as "substantially as described" refer to the specification and make the claim specific. — *Railroad v. DuBois*, 79 U. S. 47; 20 L. Ed. 265.

Qualifies the claim in the light of the specification to the means pointed out. — *Brown v. Guild*, 90 U. S. 181; 23 L. Ed. 161.

The words "substantially as described" found in each of the first two claims of the original patent, properly confined those claims to the shifting mechanism described. — *Brown v. Davis*, 116 U. S. 237; 29 L. Ed. 659; 6 S. Ct. 379.

The clause "substantially as described" are words of limitation, limiting the combination to the specific elements described. — *Pope v. Gormully*, 144 U. S. 248; 36 L. Ed. 423; 12 S. Ct. 641.

Without determining what particular meaning, if any, should be given to these words ("substantially as described or set forth") we are of opinion that they are not to be construed as limiting the patentee to the exact mechanism described; but that he is still entitled to the benefit of the doctrine of equivalents. — *Hobbs v. Beach*, 180 U. S. 383; 45 L. Ed. 586; 21 S. Ct. 409.

Morley v. Lancaster, 129 U. S. 263; *Discussing, Seymour v. Osborne*, 11 Wall. 516; *Cornplanter Pat.* 23 Wall. 181; *Westinghouse v. Boyden*, 170 U. S. 537; *Mitchell v. Tilghman*, 19 Wall. 287.

The words "substantially as described," do not warrant the insertion of an additional element in the claim. The words must relate to the matter designated. — *Boynton v. Morris*, 87 Fed. 225; 30 C. C. A. 617.

Lake Shore v. National, 110 U. S. 229.

The use of the words "to operate substantially as described" did not serve to read into this claim every element of the entire structure set forth in the specification precisely as described, and thus limit the patentee to the exact mechanism described therein. — *General v. International*, 126 Fed. 755; 61 C. C. A. 329.

Hobbs v. Beach, 180 U. S. 383; *Penfield v. Potts*, 126 Fed. 475; *McCarty v. Lehigh*, 160 U. S. 110.

The "spacing members" are not described in the claims except by reference to the specifications by the words "substantially as described" at the end of each claim. This carries to the claims the description of the specification. — *Sanders v. Hancock*, 128 Fed. 424; 63 C. C. A. 166.

Soehner v. Favorite, 84 Fed. 182; *Stilwell-Bierce v. Eufaula*, 117 Fed. 410; *Lamb v. Lamb*, 120 Fed. 267; *Canda v. Michigan*, 124 Fed. 486.

Claims 3 and 8 close with the words "substantially as set forth" and "substantially as described," respectively. This language brings into the claim the particular description of the structure contained in the specifications, and the drawings to which they refer. — *Lackawanna v. Davis-Colby*, 131 Fed. 68; 65 C. C. A. 306.

The words "as set forth" in the claims may grammatically refer to anything which precedes them. Therefore, in view of the just and liberal rules of construction stated in *Reece v. Globe*, 61 Fed. 958, they should not be held as restrictive, or as limiting anything in the claims, so as to render ineffectual

any part of the conception involved in the portion of the specification which we have quoted. — *Westinghouse v. Stanley*, 133 Fed. 167; 68 C. C. A. 523.

Where there are two claims in a patent for two distinct improvements invented to accomplish different results, the words "substantially as specified" mean substantially as specified relative to the subject matter of the claim, and do not necessarily import the description or claim of either improvement into the claim for the other. *Lake Shore v. Car-Brake*, 110 U. S. 229; *Page v. Land*, 49 Fed. 936. But these words ordinarily refer back to and point out elements in the combination claimed which have substantially the construction and operation described in the specification. *Westinghouse v. Boyden*, 170 U. S. 537; *Singer v. Cramer*, 192 U. S. 265. Cases may be found where an element described in the specification which is essential to the operation, in the way portrayed in the specification, of a combination or device claimed, has been read into the claim from the specification. *Westinghouse v. Boyden*, *supra*; *Wellman v. Midland*, 106 Fed. 221. The converse of this proposition, that elements or devices described in the specification may not be imported into the claim, is equally well established. *Boynton v. Morris*, 87 Fed. 227; *General v. International*, 126 Fed. 755; *Walker on Pat.* sec. 182; *Temple v. Mfg. Co.*, 30 Fed. 442. Nor are decisions wanting which have limited the general language of a claim to an element or device, its construction, and operation as set forth in the specification. *White v. Dunbar*, 119 U. S. 47; *Vance v. Campbell*, 1 Black, 427; *Stirrat v. Mfg. Co.*, 61 Fed. 980; *Adams v. Lindell*, 77 Fed. 432. — *Jewell v. Jackson*, 140 Fed. 340; 72 C. C. A. 304.

These words refer to the whole claim, and import nothing into it not already there, either to narrow it, so as to escape anticipation, or to broaden it so as to establish infringement. The words mean "substantially as specified" in regard to the combination which is the subject of the claim. — *American v. Hickmott*, 142 Fed. 141; 73 C. C. A. 359.

Lake Shore v. Car-Brake, 110 U. S. 229.

These words are sometimes used to limit a claim and sometimes to enlarge its operation, but seldom to practically defeat what was the real invention of the patentee. — *Draper v. American*, 161 Fed. 728; 88 C. C. A. 588.

§ 938. "Whereby" Clause.

On referring to the specification we find it there expressly declared that the invention consisted "in the construction and combination of parts hereinafter fully described and claimed, reference being had to accompanying drawing." Nowhere, either expressly or by reasonable inference, is it asserted that simply the best or preferable construction of the whole or any part of the combination is what is described. — *Singer v. Cramer*, 192 U. S. 265; 48 L. Ed. 437; 24 S. Ct. 291.

Note: It would seem that this holding carries the rule of words of limitation farther than any other case, making it include the stock phrases above quoted.

The evidence demonstrates — and quite likely Russell understood — that some cement mixtures, commercially speaking, were more desirable than others; and the word "cement," used in the claims must be understood when considered in connection with the statutory description as referring generally to cementitious mixtures having the qualities which he describes. — *American v. Howland*, 80 Fed. 395; 25 C. C. A. 500.

We are not permitted in litigations of this character, to give any word a particular interpretation when it is fairly capable of another one which will enable the patent to cover the actual invention. — *Hatch v. Electric*, 100 Fed. 975; 41 C. C. A. 133.

To ignore the express functional limitation of the claim, viz. "whereby they are enabled to fold back into the case side by side," would be to create a new claim; not interpret one granted. — *Anthony v. Ginnert*, 108 Fed. 396; 47 C. C. A. 426.

The specification states that they are "preferably" of the same area, and that they are "preferably" to overlap completely, in order to eliminate any limitation that might be implied if these terms had not been used and thus to save the claim from being narrowed so that a can otherwise like that described would not be covered by its terms. — *Ironclad v. Dairyman's*, 143 Fed. 512; 74 C. C. A. 372.

CROSS-REFERENCE TABLE OF PATENT LAWS

Giving sections and amendments to U. S. Revised Statutes and sections of Judicial Code in first column, page references to this work in the second column, and page references to U. S. Compiled Statutes and Supplement in the third column.

U. S. R. S. Sec.	In here, page	U. S. Comp. Stat.
441	906	252
475	906	270
476	907	270
478	907	271
479	869	271
480	877	271
481	869	271
482	878	272
483	912	272
484	906	272
485	904	273
486	906	273
487	868	274
488	909	274
489	907	274
490	909	275
491	909	275
492	901	275
494	869	276
496	906	277
Sub. 496, Sec. 7, Act Mar. 3, 1897	864	3385
892	878	673
893	878	673
894	878	673
973	870	703
1537	902	1056
1673	877	1141
4883	900	Supp. 1452
4884	899	3381
4885	900	Supp. 1453
4886	889	3382
Sub. 4886, Act Mar. 3, 1883	877	3386
4887	882	Supp. 1453
4888	862	3383
4889	876	3383
4890	870	3383
4891	904	3383
4892	905	Supp. 1454
4893	863	3384
4894	863	3384
4895	900	3385
4896	879	Supp. 1455
4897	864	3386
4898	865	3387
4899	913	3387
4900	903	3388
4901	880	3388

856** CROSS - REFERENCE TABLE OF PATENT LAWS

U. S. R. S. Sec.	In here, page	U. S. Comp. Stat.
4903	864	3389
4904	887	3389
4905	887	3390
4906	887	3390
4907	887	3390
4908	887	3390
4909	888	3390
4910	888	3390
4912	888	3391
4913	888	3391
4914	888	3392
4915	858	3392
Sub. 4915, Sec. 9, R. S. D. C. § 780	860	3391
4916	910	3393
4917	876	3393
4918	889	3394
4919	871	3394
4920	873	3394
4921 (see Jud. Code, Sec. 264)	907	Supp. 236
4921, Sec. 2, Act Feb. 16, 1875	908	526
4922	885	3396
4923	882	3396
4929	874	Supp. 1457
4930	875	3399
4931	875	3399
4933	875	3399
Sub. 4933, Act Feb. 4, 1887	875	3398
Sub. 4933, <i>Ibid.</i> , Sec. 2	875	3399
4934 (amended)	880	Supp. 1458
4934 (orig.)	880	3400
4935	881	3400
4936	881	3400
Sub. 5046, Act July 1, 1898, Sec. 70	866	Supp. 1511
A June 25, 1910	883	Supp. 1457
Fed. Jud. Code, Sec.		
9	894	Supp. 131
11	895	Supp. 131
24	896	Supp. 135
48	897	Supp. 149
50	897	Supp. 149
116	893	Supp. 190
117	893	Supp. 190
128	894	Supp. 193
129	893	Supp. 194
239	893	Supp. 228
240	898	Supp. 228
250	892	Supp. 231
251	898	Supp. 232
256	896	Supp. 233
263	896	Supp. 235
264	895	Supp. 236
267	896	Supp. 237
289	892	Supp. 243
291	893	Supp. 243
292	897	Supp. 244
293	894	Supp. 244
294	894	Supp. 244
295	894	Supp. 244
296	898	Supp. 244
297	897	Supp. 244

THE PATENT STATUTE DIGESTED

AND PROVIDED WITH THE PATENT OFFICE ANNOTATIONS.

ABANDONMENT

Application — Delay for One Year.

All applications for patents shall be completed and prepared for examination within one year after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within one year after an action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that the delay was unavoidable. — R. S. 4894 (Amend. Mar. 3, 1897).

Note: The Act of Mar. 3, 1897, changed the period of time from "two years" to *one year*.

Bar to Patent.

Any person who has invented * * * unless the same is proved to have been abandoned, may * * * obtain a patent therefor. — R. S. 4886 (Amend. Mar. 3, 1897).

Delay for One Year — Unavoidable — Excuses.

(In sound discretion of Commissioner). — R. S. 4894.

Renewal Applications — Question of Fact.

* * * And upon the hearing of renewed applications preferred under this section, abandonment shall be considered as a question of fact. — R. S. 4897.

ACTIONS

Equity — Questions of Fact — Trial by Jury.

Sec. 2. That said courts (U. S. district courts) when sitting in equity for the trial of patent causes, may empanel a jury of not less than five and not more than twelve persons, subject to such general rules in the premises as may, from time to time, be made by the Supreme Court, and submit to them such questions of fact arising in such causes as such circuit court shall deem expedient.

And the verdict of such jury shall be treated and proceeded upon in the same manner and with the same effect as in the case

of issues sent from chancery to a court of law and returned with such findings. — R. S. 4921 (Amend. Mar. 3, 1897).

Equity — To Compel Issue of Patent.

Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not. — R. S. 4915. See Jud. Code, Sec. 24.

In what district the bill should be brought considered. — Butterworth v. Hill, 114 U. S., 128-133.

On what questions bill in equity is appropriate. — Butterworth v. Hoe, 112 U. S., 50-60.

Bill in equity is governed by the rules of delay specified in sec. 4894. — Gandy v. Marble, 122 U. S., 432-440.

Invention must be patentable to get favorable decision. — Hill v. Wooster, 132 U. S., 693.

May raise new questions. — Christie v. Seybold, 55 F. R., 69.

Canceled claims, burden of proof of invention. — Durham, 6 App. D. C., 78; 71 O. G., 601.

Expedition of — By Heads of Departments of Government.

(See Application — Expedition of) — (Act Mar. 3, 1897).

Infringement — Action on the Case.

Damages for the infringement of any patent may be recovered by action on the case, in the name of the party interested either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs. — R. S. 4919.

Infringement — Plea.

(See Defenses, R. S. 4920).

Interfering Patents.

(See Interfering Patents, R. S. 4918).

Qui Tam Actions — Jurisdiction — Penalty.

(See Marking Articles Patented, R. S. 4901).

ADMINISTRATOR**Oath by.**(See **Executor**).**AFFIDAVITS AND DEPOSITIONS**(See **Interferences**, R. S. 4905).**AMENDMENT****Application — Reissue.**(See **Reissue**, R. S. 4916).**Disclaimer.**

R. S. 4917.

Duty of Commissioner.

R. S. 481.

Examination of Application.

R. S. 4893.

Requirement — General.

R. S. 4888.

Rules for Patent Office Practice.

R. S. 483.

When to be Made.

R. S. 4894.

ANNUAL REPORT**Commissioner of Patents.**(See **Commissioner of Patents**).**ANTICIPATION****General Provision.**

R. S. 4886.

Prior Foreign Invention — When Not.

Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication. — R. S. 4923.

APPEALS**Applications — Examiners-in-Chief.**

Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal. — R. S. 4909.

Certification — To Supreme Court.

(See Judicial Code, Secs. 239, 251).

Certiorari — Supreme Court.

(See Judicial Code, Sec. 240).

Circuit Court of Appeals.

(See Judicial Code, Secs. 116, 117, 128, 129).

Court of Appeals, D. C.

That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court, of the District of Columbia, in pursuance of the provisions of section 780 of the Revised Statutes of the United States relating to the District of Columbia, shall hereafter be and the same is hereby vested in the court of appeals created by this act.

And in addition any party, aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said court of appeals. — Sec. 9, Act of Feb. 9, 1893.

Court of Appeals, D. C. — Notice of to Commissioner.

When an appeal is taken to the Court of Appeals of the District of Columbia, the appellant shall give notice to the Commissioner, and file in the Patent Office within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing. — R. S. 4912. (See R. S. D. C. 780).

Court of Appeals, D. C. — Notice — Proceedings — Evidence.

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

Court of Appeals, D. C. — Return — Certificate entered in P. O.

The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the

evidence produced before the Commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question. — R. S. 4914.

Examiners-in-Chief — Duties of.

* * * On the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents, and in interference cases * * * — R. S. 482.

Examiners-in-Chief to Commissioner of Patents.

If such party is dissatisfied with the decision of the Examiners-in-Chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person. — R. S. 4929.

Interferences — From Examiner of Interferences — From Examiners-in-Chief.

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

Interferences — To Examiners-in-Chief.

Every applicant for a patent or for the reissue of a patent, any of the claims which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief, having once paid the fee for such appeal. — R. S. 4909.

Interferences — Time Allowed.

(See R. S. 4904).

APPLICANT

Notice to — Of Interference.

(See Interference — Notice of, R. S. 4904).

Oath of — Before whom Taken.

(See Oath, R. S. 4892).

APPLICATION**General Provisions — Requirements.**

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

Application must be made by the inventor. — Kennedy v. Hazelton, 128 U. S., 667.

Claim limited by description. — Mitchell v. Tilghman, 19 Wall., 287; Hailes v. Van Womer, 29 Wall., 353; Fuller v. Yentzer, 94 U. S., 288, 299; Merrill v. Yeomans, 94 U. S., 568; R. R. Co. v. Mellon, 104 U. S., 112; Yale v. Greenleaf, 117 U. S., 554; White v. Dunbar, 119 U. S., 47; Snow v. Lake Shore, 121 U. S., 617; Haines v. McLaughlin, 135 U. S., 584; Howe v. National, 134 U. S., 388; McClain v. Ortmyer, 141 U. S., 419; Knapp v. Morss, 150 U. S., 221; Am. Fibre v. Port Huron, 72 F. R., 516; Gould v. Trojan, 74 F. R., 794; Groth v. International, 61 F. R., 284.

Composition of matter; how identified in claim. — Cochrane v. Badische, 111 U. S., 293.

Claims defined and construed. — Estey v. Burdett, 109 U. S., 633-640; Bussey v. Excelsior, 110 U. S., 131; Railway v. Car Brake, 110 U. S., 229; Consolidated v. Kunkle, 119 U. S., 45; Dryfoos v. Wiese, 124 U. S., 32; Bragg v. Fitch, 121 U. S., 478; Plummer v. Sargent, 120 U. S., 442. Joyce v. Chillicothe, 127 U. S., 557; Sargent v. Burgess, 129 U. S., 19; Crescent v. Gottfried, 128 U. S., 158; Boyden v. Westinghouse, 70 F. R., 816; McCormick v. Aultman, 73 O. G., 1999. National v. Am., 53 F. R., 367; Sayre v. Scott, 55 F. R., 971; Judd v. Fowler, 61

F. R., 821; Le Favour v. Rice, 62 F. R., 393; Kilbourne v. Bingham, 50 F. R., 697; Norton v. Jensen, 49 F. R., 859; Illinois v. Robbins, 52 F. R., 215.

Claims to pioneer invention construed. — Morley v. Lancaster, 129 U. S., 263; Tuttle v. Claffin, 76 F. R., 227; Dederick v. Siegmund, 51 F. R., 233.

Claims construed by prior art. — Washing Mach. v. Tool Co., 20 Wall., 342. Zane v. Soffe, 110 U. S., 200; Thompson v. Boisselier, 114 U. S., 1; Grier v. Wilt, 120 U. S., 412; Wollensack v. Reiher, 115 U. S., 87; Deering v. Winona, 155 U. S., 286; Schuyler v. Elec., 66 F. R., 313; Fox v. Perkins, 52 F. R., 205; West. Elec. v. Sperry, 58 F. R., 186; Blount v. Bardsley, 75 F. R., 674.

Definiteness of Specification. — Mowry v. Whitney, 14 Wall., 620; Sewall v. Jones, 91 U. S., 171; Eames v. Andrews, 122 U. S., 40; Telephone Cases, 126 U. S., 1; Béné v. Jeantet, 129 U. S., 683; Western v. Ansonia, 114 U. S., 447; Lawther v. Hamilton, 124 U. S., 1; Lalance v. Haberman, 53 F. R., 375; Dixon Woods v. Pfeifer, 55 F. R., 390; Long v. Pope, 75 F. R., 835; Edison v. U. S., 52 F. R., 360.

Deceptive patent void. — Carlton v. Bokce, 17 Wall., 463.

Effect of words "substantially as described" considered. — Brown v. Davis, 116 U. S., 237; Columbus v. Robbins, 64 F. R., 384; Westinghouse

v. Edison, 63 F. R., 588; *Campbell v. Richardson*, 76 F. R., 576.

Effect of words "for the purpose set forth" considered. — *Day v. Fair Haven*, 132 U. S., 98.

Elements not imported into a claim by construction to make out a case of novelty or infringement. — *Wollensack v. Sargent*, 151 U. S., 221; *McCarty v. Lehigh*, 160 U. S., 110.

Element positively included in the claim is made essential. — *Fay v. Cordesman*, 109 U. S., 408; *Yale v. Sargent*, 117 U. S., 373; *Watson v. Cincinnati*, 132 U. S., 161; *Wright v. Yuengling*, 155 U. S., 47; *Coupe v. Royer*, 155 U. S., 565.

Indefinite claim, patent invalid. — *Electric v. McKeesport*, 159 U. S., 465.

Interpretation of specification and drawing. — *Caverly v. Deere*, 66 F. R., 305.

Limitations in patent resulting from answer to requirement of Office. — *Sargent v. Hall*, 114 U. S., 63; *Sutter v. Robinson*, 119 U. S., 530; *Shepard v. Carrigan*, 116 U. S., 593; *McCormick v. Graham*, 129 U. S., 1; *Phoenix v. Spiegel*, 133 U. S., 360; *Roemer v. Peddie*, 132 U. S., 313; *Morgan v. Albany*, 152 U. S., 425; *Lehigh v. Kearney*, 158 U. S., 461; *American v. Pennock*, 17 S. C. Reporter, 1; *Reece v. Globe*, 61 F. R., 958.

Must be claimed as well as shown. — *Roemer v. Bernheim*, 132 U. S., 103.

New matter introduced by amendment condemned. — *Eagleton v. Mfg. Co.*, 111 U. S., 490; *Chicago v. Sayles*, 97 U. S., 554; *Michigan v. Consolidated*, 67 F. R., 121; *Long v. Pope*, 75 F. R., 835.

Useful application test of a patent's validity. — *Klein v. Russell*, 19 Wall., 433.

Completion of.

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

Statutes in regard to delay apply to bill in equity under sec. 4915. — *Gandy v. Marble*, 122 U. S., 432-440.

Decision of Office final. — *West. Elec. v. Sperry*, 58 F. R., 186.

Drawings — When Required.

When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or by his attorney in fact, and attested by two witnesses, which shall be filed in the Patent Office; and a copy of the drawing, to be furnished by the Patent Office, shall be attached to the patent as a part of the specification. — R. S. 4889.

Examination of — Novelty — Utility — Importance.

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

Mandamus to compel Commissioner to sign patent, if his judgment and discretion are to issue it — Supervision of

Secretary of Interior not applicable to this matter. — *Butterworth v. Hoe*, 112 U. S., 50-60.

Examination and Rejection — Reconsideration.

Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case. — R. S. 4903.

Amendment may be made by attorney after inventor's death. — De la Vergne | *v. Featherstone*, 147 U. S., 209.

Executor or Administrator — When and How Made.

(See Executor and Administrator, R. S. 4896).

Execution of — Oath.

(See Oath. — By Inventor if Living, R. S. 4895).

Expedition of — Request by Head of Department of Government.

That in every case where the head of any Department of the Government shall request the Commissioner of Patents to expedite the consideration of an application for a patent it shall be the duty of such head of a Department to be represented before the Commissioner in order to prevent the improper issue of a patent. — Sec. 7 of Act of Mar. 3, 1897.

Lapse of — Failure to Pay Final Fee.

* * * If the final fee is not paid within that period (six months from the time at which it was passed and allowed and notice thereof was sent to the applicant or his agent) the patent shall be withheld. — R. S. 4885.

Oath — By Inventor.

* * * And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer, and in all cases of an application for a reissue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living * * * — R. S. 4895.

Reissue — By Whom Made.

* * * And in all cases of an application for a reissue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living * * * — R. S. 4895.

Renewal — Failure to Pay Final Fee.

Any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who fails to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to

the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application. But such second application must be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent was ordered to issue under such renewed application prior to the issue of the patent. And upon the hearing of renewed applications preferred under this section, abandonment shall be considered as a question of fact. — R. S. 4897.

Requirements Regarding — Specifications and Claims.
(See Specifications — Requirements, R. S. 4888).

Right of Purchaser — Before Application is Made.

Every person who purchases of the inventor or discoverer, or, with his knowledge and consent, constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and to vend to others to be used, the specific thing so made or purchased, without liability therefor. — R. S. 4899.

Who May Make — Assignment Before Issue.

* * * In all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer; and in all cases of an application for a reissue for any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living. * * * — R. S. 4895.

ART

Patentability of.
R. S. 4886.

ASSIGNEES

Renewal Applications — Default in Paying Final Fee.
(May make such application under restrictions and limitations, R. S. 4897).

ASSIGNMENT

General Provision.

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

It any such assignment, grant, or conveyance of any patent shall be acknowledged before any notary public of the several States

or Territories or the District of Columbia, or any commissioner of the United States circuit court, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section seventeen hundred and fifty of the Revised Statutes, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant, or conveyance. — R. S. 4898.

Assignment and license defined. — Nicholson v. Jenkins, 14 Wall., 452; Adams v. Burks, 17 Wall., 453; Littlefield v. Perry, 21 Wall., 205; Burdell v. Denig, 92 U. S., 716. Hayward v. Andrews, 106 U. S., 672; Oliver v. Chem. Works, 109 U. S., 75; Laver v. Dennitt, 109 U. S., 90; Solomons v. U. S., 137 U. S., 342; Waterman v. Mackenzie, 138 U. S., 252; St. Paul v. Starling, 140 U. S., 184; Dalzell v. Watch Co., 149 U. S., 315; Lane v. Locke, 150 U. S., 193; Heaton v. Eureka, 78 O. G., 171. Anderson v. Eiler, 50 F. R., 775.

Construction of contract. — National v. Willcox, 74 F. R., 557.

Verbal license is void as against subsequent assignee without notice. — Gates v. Frazier, 153 U. S., 332.

An agreement not to dispute the validity of a patent not directly involved in the agreement is against public policy. — Pope v. Gormully, 144 U. S., 224 et seq.

Authority of attorney to execute assignment. — Chauche v. Pare, 75 F. R., 283.

Assignment for extension. — R. R. v. Trimble, 10 Wall., 367. Nicholson v. Jenkins, 14 Wall., 452.

Conditional assignment. — Atkins v. Parke, 61 F. R., 953.

Future invention, contract to assign. — Regan v. Pacific, 49 F. R., 68.

Implied license, employer and employee. — Hapgood v. Hewitt, 119 U. S., 226-234.

Specific performance of contract to assign invalid patent. — Kennedy v. Hazelton, 128 U. S., 667-673.

Assignment construed. — Rude v. Westcott, 130 U. S., 152.

Effect of subsequent contract on absolute assignment. — Boesch v. Graff, 133 U. S., 697.

Licensee's liability. — U. S. v. Burns, 12 Wall., 246. Paper Bag Cases, 105 U. S., 766.

License, escrow. — Mellon v. R. R. Co., 21 O. G., 1616.

Mortgage, notice. — Waterman v. Shipman, 55 F. R., 982.

One inventor as trustee for another. — Ambler v. Whipple, 20 Wall., 546.

Patented machine is purchaser's property. — Mitchell v. Hawley, 16 Wall., 544. Paper Bag Cases, 105 U. S., 766.

Purchase of article may give license to use process. — Vt. v. Gibson, 56 F. R., 143.

Right to purchase patented article. — Hobbie v. Jennison, 149 U. S., 355.

Recording assignments, effect of; what instruments recorded. — Standard v. Crane, 77 O. G., 811.

Seal. — Gottfried v. Miller, 104 U. S., 521.

Separate claims of a patent are not assignable. — Pope v. Gormully, 144 U. S., 248.

Successors of assignees. — Hammond v. Mason, 92 U. S., 724.

Bankruptcy — Vests Patent Property.

Sec. 70. Title to Property. The trustee of the estate of a bankrupt, upon his appointment and qualification, and his successor or successors, if he shall have one or more, upon his or their appointment and qualification, shall in turn be vested by operation of law with the title of the bankrupt, as of the date he was adjudged a bankrupt, except in so far as it is to property which is exempt, to all (1) documents relating to his property; (2) interests in patents, patent rights, copyrights, and trade-marks. — R. S. 5046, and Sec. 70, Act July 1, 1898.

Before Application — Implied License. (See R. S. 4899).

Before Issue — Application to be made by Inventor.

Patents may be granted and issued or reissued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the Patent Office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer; and in all cases of an application for a reissue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living. * * * — R. S. 4895.

Fees for Recording.

(See Fees).

By Instrument in Writing — Execution and Recording.

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

If any such assignment, grant, or conveyance of any patent shall be acknowledged before any notary public of the several States and Territories or the District of Columbia, or any commissioner of the United States circuit court, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section 1750 of the Revised Statutes, the certificate of such acknowledgment under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant, or conveyance. — R. S. 4898, and Act Mar. 3, 1897.

Note : The last paragraph added by Act Mar. 3, 1897.

By Instrument in Writing — Prima Facie.

(See R. S. 4898 supra).

Recording — Must be Within Three Months.

(See R. S. 4898 supra).

Recording — Must be Recorded in Patent Office — When.

(See Assignment Before Issue, R. S. 4895).

ASSISTANT COMMISSIONER**Appointment of.**

(See R. S. 476).

ATTORNEYS**Recognition Refused — Gross Misconduct.**

For gross misconduct the Commissioner of Patents may refuse to recognize any person as a patent-agent, either generally or in any particular case; but the reasons for such refusal shall be duly recorded, and be subject to the approval of the Secretary of the Interior. — R. S. 487.

BANKRUPTCY**Assignments in — Vests Patent Property in Assignee.**

(See Assignments — Bankruptcy, Sec. 70, Act July 1, 1898).

BILL**In Equity — To Compel Issue of Patent.**

(See Actions — Equity, R. S. 4915).

CERTIFIED COPIES**Foreign Patents.**

(See Evidence — Foreign Letters Patent, R. S. 893).

Records and Papers. — Patent Office.

(See Evidence — Copies of Patents and Records, R. S. 892).

For Court of Appeals, D. C. — Furnished by Whom.

(See Appeals — Court of Appeals, D. C.).

CERTIORARI**Supreme Court — From Circuit Court of Appeals.**

(See Judicial Code, Sec. 240).

CIRCUIT COURT OF APPEALS

(See Appeals).

CLAIM**What to Cover.**

(See Application — Requirements, R. S. 4888).

CLERK OF U. S. COURT**Summoning Witnesses — Interference Cases.**

(See Witnesses, R. S. 4906).

COMMISSIONER OF PATENTS**General Provision.**

There shall be in the Patent Office a Commissioner of Patents, one Assistant Commissioner, and three examiners-in-chief, who shall be appointed by the President, by and with the advice and consent of the Senate. All other officers, clerks, and employes

authorized by law for the Office shall be appointed by the Secretary of the Interior, upon the nomination of the Commissioner of Patents. [See § 169.] — R. S. 476.

Annual Report of — Shall Contain What.

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

Appeal to.

If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person. — R. S. 4910.

Applications — Examination of.

(See Application — Examination of, R. S. 4893).

Bond — Chief Clerk.

The Commissioner of Patents and the chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars and the latter in the sum of five thousand dollars, conditioned for the faithful discharge of their respective duties, and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their office. — R. S. 479.

Duties of.

The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office. — R. S. 481.

Duties of Commissioner. — *Butterworth v. Hoe*, 112 U. S. 50.

Examination Under Oath — Court of Appeals, D. C.

* * * And at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded. — R. S. 4913.

How Appointed.

(See Patent Office — Officers, R. S. 476).

Notice of Hearings — Court of Appeals, D. C.

(See Appeals — Court of Appeals, D. C.).

Rules and Regulations — Established by.

(See Rules and Regulations, R. S. 483).

Rules for Taking Evidence — Patent Office Cases.

The Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States or of the State where the officer resides. — R. S. 4905.

COMPOSITION OF MATTER**Patentability of.**

R. S. 4886.

Specimens to be Furnished — When and How.

When the invention or discovery is of a composition of matter, the applicant, if required by the Commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment. — R. S. 4890.

CONGRESS**Powers of.**

[*The constitutional provision.* — The Congress shall have power * * * to promote the progress of Science and Useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.] — Art. I, Sec. VIII.

COSTS**Complainants — Actions for Infringement.**

(See R. S. 4919).

Defendants — Actions for Infringement.

(See R. S. 4920).

Disclaimer — Failure to File.

When judgment or decree is rendered for the plaintiff or complainant, in any suit at law or in equity, for the infringement of a part of a patent, in which it appears that the patentee, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor, no costs shall be recovered, unless the proper disclaimer, as provided by the patent laws, has been entered at the Patent Office before the suit was brought. (See 4917, 4922). — R. S. 973.

Failure to Disclaim — When.

* * * But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. * * * — R. S. 4922.

COURT OF APPEALS, D. C.**General Act — Jurisdiction &c.**

Be it enacted, &c., That there shall be, and there is hereby, established in the District of Columbia a court, to be known as the court of appeals of the District of Columbia.

SEC. 6. That the said court of appeals shall establish a term of the court during each and every month in each year excepting the months of July and August. Act Feb. 9, 1893.

* * * Except as provided in the next succeeding section (as to certification and certiorari), the judgments and decrees of said court of appeals shall be final in all cases arising under the patent laws * * *. — Jud. Code, Sec. 250.

DAMAGES**General Provision.**

Damages for the infringement of any patent may be recovered by action on the case, in the name of the party interested either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs. — R. S. 4919.

Actual damages, rule in law actions. — Birdsall v. Coolidge, 93 U. S., 64.

Anticipation, question for jury in law action. — Harper & Reynolds Co. v. Wilgus, 56 F. R., 587.

Conspiracy, action at law. — Ambler v. Choteau, 107 U. S., 586.

Infringement. — Fermentation v. Maus, 122 U. S., 413; Safety Valve v. Steam Gage, 113 U. S., 157; Lake Shore v. Nat'l., 110 U. S., 229; Morley v. Lancaster, 129 U. S., 263; Hurlbut v. Schillinger, 130 U. S., 456; Plummer v. Sargent, 120 U. S., 442. Wollensack v. Sargent, 151 U. S., 221; Deering v. Winona, 155 U. S., 286; Dubois v. Kirk, 158 U. S., 58; National v. Boston, 156 U. S., 502; Potts v. Creager, 155 U. S., 597; Belknap v. Schild, 161 U. S., 10; Griswold v. Harker, 62 F. R., 389; Devlin v. Paynter, 64 F. R., 398; Am. v. National, 51 F. R., 229; Gurney v. Oakes, 66 F. R., 1007; Capital v. Natl., 70

F. R., 709; Lalance v. Habermann, 53 F. R., 375; Celluloid v. Arlington, 52 F. R., 740; Adee v. Mott, 55 F. R., 876.

Infringement doubtful, injunction refused. — Ertel v. Stahl, 65 F. R., 517; Schwarzwald v. N. Y., 66 F. R., 152.

Infringement of apparatus which delivers perishable article. — Morgan v. Albany, 152 U. S., 425.

Infringement by purchaser from assignee. — Keeler v. Standard, 157 U. S., 659.

Infringement, pioneer invention. — Westinghouse v. N. Y., 63 F. R., 962; Norton v. Jensen, 49 F. R., 859.

Noninfringement. — Coon v. Wilson, 113 U. S., 268; Blake v. San Francisco, 113 U. S., 679; Thompson v. Boisselier, 114 U. S., 1; Sargent v. Hall, 114 U. S., 63; McMurray v. Mallory, 111 U. S., 97; Voss v. Fisher, 113 U. S., 213; Grier v. Wilt, 120 U. S., 412; Fay v. Cordesman, 109 U. S., 408; Estey v.

Burdett, 109 U. S., 633; Clements v. Excavating, 109 U. S., 641; Bussey v. Excelsior, 110 U. S., 131; Zane v. Soffe, 110 U. S., 200; Shepard v. Carrigan, 116 U. S., 593; Yale v. Sargent, 117 U. S., 373; Consold. v. Kunkle, 119 U. S., 45; California v. Schalieke, 119 U. S., 401; Sutter v. Robinson, 119 U. S., 530; Sharp v. Riessner, 119 U. S., 631; Hartshorn v. Saginaw Co., 119 U. S., 664; Crawford v. Heysinger, 123 U. S., 589; Dryfoos v. Wiese, 124 U. S., 32; Yale v. James, 125 U. S., 447; Clark v. Beecher, 115 U. S., 79; Wollensak v. Reiher, 115 U. S., 87; Field v. De Comeau, 116 U. S., 187; Brown v. Davis, 116 U. S., 237; Worden v. Searls, 121 U. S., 14; McCormick v. Whitmer, 129 U. S., 1; Sargent v. Burgess, 129 U. S., 19; Peters v. Active, 129 U. S., 530; Béné v. Jeantet, 129 U. S., 683; Hendy v. Golden, 127 U. S., 370; Cook v. Sandusky, 15 Brodix, 120; Wright v. Yuengling, 155 U. S., 47; United States v. Berdan, 156 U. S., 552. Miller v. Eagle, 151 U. S., 186; McCarty v. Lehigh, 160 U. S., 110; Elec. v. McKeesport, 159 U. S., 465; Lehigh v. Kearney, 158 U. S., 461; Boyd v. Janesville, 158 U. S., 260; Black Diamond v. Excelsior, 156 U. S., 611; Roller Mill v. Barnard, 156 U. S., 261; Dashiell v. Grosvenor, 162 U. S.,

425; Kinzel v. Luttrell, 67 F. R., 926; Wright v. Clinton, 67 F. R., 790; Bon-sak v. Elliott, 69 F. R., 335; Jensen v. Norton, 67 F. R., 236; Thomson-Houston v. West, 70 F. R., 69; Gould v. Trojan, 74 F. R., 794; Brush v. Western, 76 F. R., 761; Stirratt v. Excelsior, 61 F. R., 980; Cornell v. Bataille, 61 F. R., 684; Pacific v. Cons. Co., 62 F. R., 288.

Noninfringement — Article made by particular process. — Cochrane v. Badische, 111 U. S., 293.

Noninfringement of combination claim. — Rowell v. Lindsay, 113 U. S., 97; Elec. v. Signal, 114 U. S., 87; Bragg v. Fitch, 121 U. S., 478; Snow v. Lake Shore, 121 U. S., 617; Thomson-Houston v. Kelsey, 75 F. R., 1005.

Evidence of novelty; discretion of lower court. — St. Paul v. Starling, 140 U. S., 184.

Patent for improvement does not convey right to use broad invention. — Cantrell v. Wallick, 117 U. S., 689.

Patent rights reached by creditor's bill. — Ager v. Murray, 105 U. S., 126.

Contributory infringement. — Heaton v. Eureka, 77 F. R., 288.

Repairing patented device. — Shickle v. St. Louis, 77 O. G., 2142. (Consult also citations under sec. 4886.)

Designs.

(See Designs).

In Equity — Trebling Damages.

* * * The complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass on the case. * * * — R. S. 4921.

Failure to Mark Articles "Patented" — When a Bar.

* * * And in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the article so patented. — R. S. 4900.

Infringement — Trebling Damages.

(In actions at Law, see R. S. 4919).

DEFENSES

General Provisions.

In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

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

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

Third. That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof, *or more than two years prior to his application for a patent therefor*; or,

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

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect. — R. S. 4920.

Note: Amendment of Mar. 3, 1897, in italics.

Complainants must prove infringement. — Fuller v. Yentzer, 94 U. S., 288, 299; Bates v. Coe, 98 U. S., 31.

Damages must be proved. — Robertson v. Blake, 94 U. S., 728.

Defenses to suit not confined to those mentioned in this statute. — Gardiner v. Herz, 118 U. S., 180.

Defense of priority. — Clark v. Wilimantic, 140 U. S., 481.

Defense of prior patent must be made below. — Andrews v. Thum, 67 F. R., 911.

Defense that complainant has no interest. — Paine v. Trask, 56 F. R., 233.

Delay as an estoppel. — Thorne Co. v. Washburn, 159 U. S., 423.

Denial of utility. — Gandy v. Belt Co., 143 U. S., 587.

Denial of validity. — Western v. La Rue, 139 U. S., 601.

Estoppel by former recovery. — Russell v. Place, 94 U. S., 606.

Estoppel by decree pro confesso. — Thomson v. Wooster, 114 U. S., 104.

Estoppel by assignment. — Babcock v. Clarkson, 63 F. R., 607.

Estoppel of assignor. — Martin v. Martin, 67 F. R., 786.

No estoppel by application for patent. — Haughey v. Lee, 151 U. S., 282.

Exceptions to judge's charge to the jury. — Haines v. McLaughlin, 135 U. S., 584.

Expert testimony necessary. — *Waterman v. Shipman*, 55 F. R., 982.

Estoppel by interference proceedings in Office. — *Shoemaker v. Merrow*, 61 F. R., 945; *Fassett v. Ewart*, 62 F. R., 404.

Fraudulent patents. — *Railroad v. Dubois*, 12 Wall., 47.

General purpose of the statute. — *Root v. Ry.*, 105 U. S., 189; *Albright v. Teas*, 106 U. S., 613; *Dolan v. Jennings*, 139 U. S., 385; *White v. Rankin*, 144 U. S., 628.

Government needs no defense. — *Cammeyer v. Newton*, 94 U. S., 225; U. S. v. *Burns*, 12 Wall., 246. U. S. v. *McKeever*, 23 O. G., 1525-1530. *Hollister v. Benedict*, 113 U. S., 59. *United States v. Palmer*, 128 U. S., 262. *Solomons v. United States*, 137 U. S., 342; *Schillinger v. United States*, 155 U. S., 163; *Belknap v. Schild*, 161 U. S., 10.

Judicial notice. — *Brown v. Piper*, 91 U. S., 37; *Terhune v. Phillips*, 99 U. S., 592. *Slawson v. R. R.*, 107 U. S., 649; *Black Diamond v. Excelsior*, 156 U. S., 611; *Richards v. Chase*, 159 U. S., 477; *Am. Fibre v. Buckskin*, 72 F. R., 508. *Butte City v. Pacific*, 60 F. R., 410.

Jurisdiction in equity, general demurrer. — *McCoy v. Nelson*, 121 U. S., 484.

Infringement is question for jury. — *Tucker v. Spaulding*, 13 Wall., 453.

Licensee estoppel. — *Dueber v. Robbins*, 75 F. R., 17.

Law or equity procedure. — *Cochrane v. Deener*, 94 U. S., 780; *Hayward v. Andrews*, 106 U. S., 672; *Clark v. Wooster*, 119 U. S., 322; *Germain v. Wilgus*, 67 F. R., 597.

New matter in patent need not be specifically set forth in the answer. — *Eagleton v. Mfg. Co.*, 111 U. S., 490.

No suit under original after reissue. — *Reedy v. Scott*, 23 Wall., 352.

Ownership. — *Cammeyer v. Newton*, 94 U. S., 225.

Patentee need not notify intending infringer. — *Railroad v. Dubois*, 12 Wall., 47.

Patentee the original inventor. — *Sewall v. Jones*, 91 U. S., 171; *Loom Co. v. Higgins*, 105 U. S., 580; *Atlantic v. Brady*, 107 U. S., 192.

Patentee bound by his patent. — *Keystone v. Phoenix*, 95 U. S., 274.

Patents not set up in answer may be introduced to aid in construction of claims. — *Grier v. Wilt*, 120 U. S., 412.

Point of void reissue must be made in lower court (Klein v. Russell, 19 Wall., 433), and must be by defendant. — *Smith v. Goodyear*, 93 U. S., 486; *Bates v. Coe*, 98 U. S., 31.

Proof of invalidity upon defendants. — *Seymour v. Osborne*, 11 Wall., 516; *Reckendorfer v. Faber*, 92 U. S., 347; *Roemer v. Simon*, 95 U. S., 214; *Imhaeuser v. Buerk*, 101 U. S., 647.

Questions for court and those for jury considered. — *Market v. Rowley*, 155 U. S., 621; *Coupe v. Royer*, 155 U. S., 565; *Lumber v. Rodgers*, 112 U. S., 659; *Keyes v. Grant*, 118 U. S., 25; *Humiston v. Wood*, 124 U. S., 12. *Royer v. Schultz*, 135 U. S., 319; *Miller v. Eagle*, 151 U. S., 186.

Res adjudicata. — *Johnson v. Wharton*, 152 U. S., 252; *Lyon v. Perrin*, 125 U. S., 698; *Bradley v. Eagle*, 58 F. R., 721; *Elec. v. Brush*, 52 F. R., 130.

Reconstruction may be infringement. — *Am. v. Simmons*, 106 U. S., 89.

Statutes of limitations of the several States apply to patent suits. — *Campbell v. Haverhill*, 155 U. S., 610.

Under general denial prior knowledge may be shown. — *Zane v. Soffe*, 110 U. S., 200.

Validity and infringement must be clear to warrant preliminary injunction. — *Stand. v. Crane*, 56 F. R., 718.

Want of patentability need not be specifically pleaded. — *May v. Juneau*, 137 U. S., 408; *Hendy v. Golden*, 127 U. S., 370; *Richards v. Chase*, 158 U. S., 299.

Technical questions can not be raised on appeal where not raised below. — *Tuttle v. Claffin*, 76 F. R., 227; *Smith v. Mellon*, 58 F. R., 705.

DESIGNS

General Provisions.

Any person who has invented any new, original, and ornamental design for an article of manufacture, not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than two years prior to his application, and not in public use or on sale in this country for more

than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law and other due proceedings had, the same as in cases of invention or discoveries covered by section forty-eight hundred and eighty-six, obtain a patent therefor. — R. S. 4929.

Doubtful patentability. — N. Y. v. N. J., 137 U. S., 445.

Utility in designs. — Smith v. Whitman, 148 U. S., 674.

Novelty determined by ocular comparison. — Braddock v. Macbeth, 64 F. R., 118.

Double use not patentable. — Un-

termeyer v. Freund, 58 F. R., 205.

Invention. — Caldwell v. Powell, 73 F. R., 488.

Lack of invention. — Krick v. Jansen, 61 F. R., 847; Paine v. Snowden, 50 F. R., 776.

Must be ornamental. — Rowe v. Blodgett, 98 O. G., 1286.

The Commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs. — R. S. 4930.

Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect. — R. S. 4931.

All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this Title, shall apply to patents for designs. — R. S. 4933.

Be it enacted, etc., That hereafter, during the term of letters patent for a design, it shall be unlawful for any person other than the owner of said letters patent, without the license of such owner, to apply the design secured by such letters patent, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design or colorable imitation shall; without the license of the owner, have been applied, knowing that the same has been so applied. Any person violating the provisions, or either of them, of this section, shall be liable in the amount of two hundred and fifty dollars; and in case the total profit made by him from the manufacture or sale, as aforesaid, of the article or articles to which the design, or colorable imitation thereof, has been applied, exceeds the sum of two hundred and fifty dollars, he shall be further liable for the excess of such profit over and above the sum of two hundred and fifty dollars; and the full amount of such liability may be recovered by the owner of the letters patent, to his own use, in any circuit court of the United States having jurisdiction of the parties, either by action at law or upon a bill in equity for an injunction to restrain such infringement.

SEC. 2. That nothing in this act contained shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any owner of letters patent for a design, aggrieved by the infringement of the same, might have had if this act had not been passed; but such owner shall not twice recover the profit made from the infringement. — Act Feb. 4, 1887.

Profit meant is total profit. — Untermeyer v. Freund, 58 F. R., 205.

DISCLAIMER

General Provision.

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

[See secs. 973, 4922.] — R. S. 4917.

Costs, effect of disclaimer on. — Sessions *v.* Romadka, 145 U. S., 29.

Disclaimer of reissue claim. — Gage *v.* Herring, 107 U. S., 640; McMurray *v.* Mallory, 111 U. S., 97; Hurlbut *v.* Schillinger, 130 U. S., 456.

Disclaimer made to obviate having included too many devices. — Sessions *v.* Romadka, 145 U. S., 29.

Disclaimer part of specification. — Dunbar *v.* Meyers, 94 U. S., 187; Schwarzwald *v.* N. Y., 66 F. R., 152.

Disclaimer filed after bill. — Smith *v.* Nichols, 21 Wall., 112.

Purpose of disclaimer. — Hailes *v.* Albany, 123 U. S., 582; Union *v.* U. S., 112 U. S., 624-645; Collins *v.* Coes, 130 U. S., 56-69.

Failure to File — Bars Costs.

(See Costs — Disclaimer — Failure to file, R. S. 973).

Laches — When Failure to File is.

* * * But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer. — R. S. 4922.

DISCOVERY

Patentability of.

Any person who has invented or discovered any new and useful art, machine, manufacture or combination of matter, or any new and useful improvement thereof * * * may * * * obtain a patent therefor. — R. S. 4886.

DRAWINGS

General Provision.

When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in

fact, and attested by two witnesses, which shall be filed in the Patent Office; and a copy of the drawing, to be furnished by the Patent Office, shall be attached to the patent as a part of the specification. — R. S. 4889.

In Reissue — How Amended.

(See Reissue — When and How Granted, R. S. 4916).

Part of Patent.

(See Letters Patent — Drawing, R. S. 4884).

DRAWING AND SPECIFICATION

(See Letters Patent — Contents, R. S. 4884).

DIVISION OF PATENT

Reissue.

(See Reissue).

EMPLOYEES

Government — Right to Obtain a Patent.

The Secretary of the Interior and the Commissioner of Patents are authorized to grant any officer of the Government, except officers and employees of the Patent Office, a patent for any invention of the classes mentioned in section 4886 of the Revised Statutes when such invention is used or to be used in the public service, without payment of any fee: Provided, That the applicant in his application shall state that the invention described therein, if patented, may be used by the Government, or any of its officers or employees in prosecution of work for the Government, or by any other person of the United States, without the payment to him of any royalty thereon, which stipulation shall be included in the patent. — R. S. sub. 4886 (Mar. 3, 1883).

Patent Office — Cannot Acquire Interest in Patent.

All officers and employees of the Patent Office shall be incapable during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by the Office. — R. S. 480.

United States — Royalties to — Barred.

No royalty shall be paid by the United States to any one of its officers or employees for the use of any patent for the system, or any part thereof, mentioned in the preceding section, nor for any such patent in which said officers or employees may be directly or indirectly interested. — R. S. 1673.

EQUITY

Damages and Profits.

(See Profits, R. S. 4921).

EQUITY ACTIONS

Jury Trials.

(See Sec. 2, R. S. 4921).

EVIDENCE

Copies of Patents and Records — Certified Copies.

Written or printed copies of any records, books, papers, or drawings belonging to the Patent Office, and of letters patent authenticated by the seal and certified by the Commissioner or Acting Commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor, and paying the fee required by law, shall have certified copies thereof. — R. S. 892.

<i>Certified copy of patent as evidence.</i> — Oregon v. Excelsior, 132 U. S., 215- 216.		<i>Certified copy of record of assignment as evidence.</i> — Am. v. Mayor, 60 F. R., 1016.
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Foreign Letters Patent. — Evidence of What.

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

Printed Copies of Specifications and Drawings — Certified and gratuitously Distributed.

The printed copies of specifications and drawings of patents, which the Commissioner of Patents is authorized to print for gratuitous distribution and to deposit in the capitols of the States and Territories, and in the Clerk's offices of the district courts, shall, when certified by him and authenticated by the seal of his office, be received in all courts as evidence of all matters therein contained. — R. S. 894.

Required by Patent Office — Method of Taking.

The Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides. — R. S. 4905.

EXAMINATION

(See Application).

EXAMINERS-IN-CHIEF

Qualifications — Duties.

The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written application of the appellant, to revise and determine upon the

validity of the adverse decisions of examiners upon applications for patents, and for reissue of patents, and in interference cases; and when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign to them. — R. S. 482.

EXECUTOR, ADMINISTRATOR, OR GUARDIAN

Application by and Oath of.

When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them. The executor or administrator duly authorized under the law of any foreign country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular officer of the United States. — R. S. 4896.

Authority of attorney after death of inventor. — *Eagleton v. Mfg. Co.*, 111 U. S., 490. | *Patent to deceased inventor goes to his heirs.* — *De la Vergne v. Featherstone*, 147 U. S., 209.

The above as amended May 23, 1908.

An act to amend section forty-eight hundred and ninety-six of the Revised Statutes.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section forty-eight hundred and ninety-six of the Revised Statutes be, and the same is hereby, amended so that the section shall read as follows:

“SEC. 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs-at-law of the deceased, in case he shall have died intestate; or if he shall have left a will disposing of the same, then in trust for his devisees in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; *and when any person having made any new invention or discovery for which a patent might have been granted becomes insane before a patent is granted the right of applying for and obtaining the patent shall devolve on his legally-appointed*

guardian, conservator, or representative in trust for his estate in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him while sane; and when the application is made by such legal representatives the oath or affirmation required to be made shall be so varied in form that it can be made by them. The executor or administrator duly authorized under the law of any foreign country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular officer of the United States.

“The foregoing section, as to insane persons, is to cover all applications now on file in the Patent Office or which may be hereafter made.”

Approved, May 23, 1908.

FALSE MARKING

Action for and Penalty.

Every person who, in any manner, marks upon anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor, without the consent of such patentee, or his assigns or legal representatives; or

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

Who, in any manner, marks upon or affixes to any unpatented article the word “patent” or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offense, to a penalty of not less than one hundred dollars, with costs; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed.— R. S. 4901.

FEEES

General Patent Office.

The following shall be the rates for patent fees:

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

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

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

On every application for the reissue of a patent, thirty dollars.
On filing each disclaimer, ten dollars.

* * * * *

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

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

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

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

Certified copies of such drawings and specifications may be furnished by the Commissioner of Patents to persons applying therefor upon payment of the present rates for uncertified copies, and twenty-five cents additional for each certification.

For copies of drawings, the reasonable cost of making them. — R. S. 4934.

Patent fees may be paid to the Commissioner of Patents, or to the Treasurer, or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the Treasury as received, without any deduction whatever. — R. S. 4935.

The Treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the Treasury, or to any receiver or depositary, to the credit of the Treasury, as for fees accruing at the Patent Office, upon a certificate thereof being made to the Treasurer by the Commissioner of Patents. — R. S. 4936.

Final — When Must be Paid.

* * * If the final fee is not paid within that period (six months from the time at which it was passed and allowed and notice thereof sent to the applicant or his agent) the patent shall be withheld. — R. S. 4885.

Required to be Paid — As a Condition to the Grant.

(See R. S. 4886).

Witnesses.

(See Witnesses, R. S. 4907).

FEIGNED ISSUES

Questions of Fact — Special Jury.

(See sec. 2, R. S. 4921).

FOREIGN PATENT

General Provision — When Not a Bar.

No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and four months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and within four months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing. — R. S. 4887.

Identity of the inventions considered. — Siemens v. Sellers, 123 U. S., 276; Commercial v. Fairbank, 135 U. S., 176; Elec. v. Brush, 52 F. R., 130.

Effect of prior foreign patent. — Telephone Cases, 126 U. S., 1-584.

Term of foreign patent. — Bate v. Hammond, 129 U. S., 151; Pohl v. Anchor, 134 U. S., 381-387.

A U. S. patent granted for an invention previously patented abroad, but

which foreign patent has expired, is without validity. — Huber v. Nelson, 148 U. S., 270.

Term of foreign patent — Limitation on face of U. S. patent unnecessary — Certificate of correction. — Edison v. U. S., 52 F. R., 300.

The meaning of "previously patented" considered. — Bate v. Sulzberger, 157 U. S., 1.

When a Bar to Domestic Patent.

(See Invention — Patentable, R. S. 4886).

FOREIGN USE

Not Bar to Patent.

Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and

first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication. — R. S. 4923

FORFEITED APPLICATION

Renewal of.

(See Application → Renewal, R. S. 4897).

FRAUD

Defense of.

(See Defenses, R. S. 4920).

GOVERNMENT

Employees of Patent Office not to Hold Patents.

All officers and employes of the Patent Office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by the Office. — R. S. 480.

Employees Need Not Pay Fees for Patenting — When.

The Secretary of the Interior and the Commissioner of Patents are authorized to grant any officer of the Government, except officers and employes of the Patent Office, a patent for any invention of the classes mentioned in section forty-eight hundred and eighty-six of the Revised Statutes when such invention is used or to be used in the public service, without the payment of any fee: *Provided*, That the applicant in his application shall state that the invention described therein, if patented, may be used by the Government, or any of its officers or employes in prosecution of work for the Government, or by any other person in the United States, without the payment to him of any royalty thereon, which stipulation shall be included in the patent. — Amendment of Mar. 3, 1883, to Sec. 4886.

Infringement by.

That whenever an invention described in and covered by a patent of the United States shall hereafter be used by the United States without license of the owner thereof or lawful right to use the same, such owner may recover reasonable compensation for such use by suit in the Court of Claims: *Provided*, however, That said Court of Claims shall not entertain a suit or award compensation under the provisions of this Act where the claim for compensation is based on the use by the United States of any article heretofore owned, leased, used by, or in the possession of, the United States: *Provided*, further, That in any such suit the United States may avail itself of any and all defenses, general or special, which might be pleaded by a defendant in an action for infringement, as set forth in Title Sixty

of the Revised Statutes or otherwise: And provided, further, That the benefits of this Act shall not inure to any patentee, who, when he makes such claim, is in the employment or service of the Government of the United States; or the assignee of any such patentee; nor shall this Act apply to any device discovered or invented by such employee during the time of his employment or service. — Act June 25, 1910, U. S. Comp. Stat. Supp. p. 1457.

See *Crozier v. Krupp*, 224 U. S., 290.

Royalties Not to be Paid by.

No royalty shall be paid by the United States to any one of its officers or employes for the use of any patent for the system, or any part thereof, mentioned in the preceding section, nor for any such patent in which said officers or employes may be directly or indirectly interested. — R. S. 1673.

IMPROVEMENT

Patentability of.

Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof * * * — R. S. 4886.

INFRINGEMENT

General Provision — Jurisdiction.

The district courts shall have original jurisdiction as follows:

* * * * *

Seventh. Of all suits at law or in equity arising under the patent, the copyright, and the trade-mark laws. — Jud. Code, Sec. 24.

Supreme Court of the District of Columbia in patent causes has circuit court jurisdiction. — *Cochrane v. Deener*, 94 U. S., 780.

Jurisdiction. — *Hartell v. Tilghman*, 99 U. S., 547. *Albright v. Teas*, 106 U. S., 613; *Oliver v. Chem. Works*, 109 U. S., 75; *Marsh v. Nichols*, 140 U. S., 344; *White v. Rankin*, 144 U. S., 628.

Court of Claims. — *U. S. v. Mc-*

Keever, 23 O. G., 1530. *U. S. v. Palmer*, 128 U. S., 262-372. *Hollister v. Benedict*, 113 U. S., 59-73. *Schilling v. U. S.*, 155 U. S., 163; *U. S. v. Berdan Mfg. Co.*, 156 U. S., 552.

Jurisdiction of circuit court. — *St. Paul v. Starling*, 127 U. S., 376-378.

Jurisdiction to annul patents. — *U. S. v. Bell Telephone*, 128 U. S., 315-373; *Mowry v. Whitney*, 14 Wall., 343.

Actions at Law.

Damages for the infringement of any patent may be recovered by action on the case. * * * — R. S. 4919.

Article Made or Purchased Before Application with the Consent of the Inventor.

Every person who purchases of the inventor or discoverer, or, with his knowledge and consent, constructs any newly invented or

discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor. — R. S. 4899.

Claims too Broad — Recovery when — Costs.

Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer. [See secs. 973, 4917.] — R. S. 4922.

Disclaimer filed before rehearing considered. — Roemer v. Bernheim, 132 U. S., 103.

Disclaimer filed after suit begun will prevent recovery of costs. — Sessions v. Romadka, 145 U. S., 29.

Costs — Disclaimer.

(See Costs, R. S. 973).

Damages.

(See Damages, R. S. 4919).

Profits.

(See Profits, R. S. 4921).

Defenses.

(See Defenses, R. S. 4920)

Laches.

(See Laches, R. S. 4897).

Designs.

* * * That hereafter, during the term of letters patent for a design, it shall be unlawful for any person other than the owner of said letters patent, without the license of such owner, to apply

the design secured by such letters patent, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design, or colorable imitation shall, without the license of the owner, have been applied, knowing that the same has been so applied.

* * * — R. S. sub. 4933, Act Feb. 4, 1881.

Disclaimer.

(See Disclaimer, R. S. 4917).

Pleas — Statutory.

(See Defenses, R. S. 4920).

Renewal Applications — Prior to Issue of Patent.

* * * But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent was ordered to issue under such renewed application prior to the issue of the patent. * * * — R. S. 4897.

Rights Secured Before Application.

(See Unpatented Invention, R. S. 4899).

INJUNCTIONS

Power of Equity to Grant — Damages and Accountings.

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

But in any suit or action brought for the infringement of any patent there shall be no recovery of profits or damages for any infringement committed more than six years before the filing of the bill of complaint or the issuing of the writ in such suit or action, and this provision shall apply to existing causes of action. — R. S. 4921.

See Jud. Code, Secs. 263, 264.

INSANE INVENTOR

Application by Committee.

(See Executor, R. S. 4896).

INTERFERENCES

General Provisions.

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

Diligence discussed. — Christie v. Seybold, 55 F. R., 69; Yates v. Huson, 74 O. G., 1732.

Patentee and applicant. — Burr v. Ford, 70 O. G., 275. Porter v. Loudon, 73 O. G., 1551.

Conception and reduction to practice. — Colhoun v. Hodgson, 5 App. D. C., 21; Soley v. Hebbard, 70 O. G., 921.

Constructive reduction to practice. — Porter v. Loudon, 73 O. G., 1551; Croskey v. Atterbury, 76 O. G., 163.

Inoperative invention, priority. — Glidden v. Noble, 5 App. D. C., 480; Hisey v. Peters, 6 App. D. C., 68;

Northal v. Bernardin, 74 O. G., 655; Carty v. Kellogg, 74 O. G., 657; Drawbaugh v. Seymour, 77 O. G., 1313.

Abandonment. — La Flare v. Chase, 74 O. G., 1735.

Priority. — Shellaberger v. Sommer, 74 O. G., 1897.

Foreign patent. — Preliminary statement amended. — Parker v. Appert, 75 O. G., 1201.

Partnership. — Milton v. Kingsley, 75 O. G., 2193.

Presumption as to inventorship. — Hill v. Parmelee, 78 O. G., 170.

The Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States or the State where the officer resides. — R. S. 4905.

The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits, at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him. — R. S. 4906.

Every witness duly subpoenaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States. — R. S. 4907.

Whenever any witness, after being duly served with such subpoena, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpoena may, on proof of such neglect or refusal, enforce obedience to the process,

or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpoena, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret invention or discovery made or owned by himself. — R. S. 4908.

Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected; and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal. — R. S. 4909.

If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person. — R. S. 4910.

Appeal under this section discussed. — *Butterworth v. Hoe*, 112 U. S., 50-60.

When an appeal is taken to the Court of Appeals of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing. — R. S. 4912.

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

The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question. — R. S. 4914.

Review confined to point raised. — *Forg*, 2 App. D. C., 58.

Appeals — Examiners-in-chief.

* * * On the written petition of appellant, to revise and determine upon the adverse decisions of the examiners * * * in interference cases. * * * — R. S. 482.

INTERFERING PATENTS**Suits Affecting — Adjudication in Equity.**

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

Relation of improvements to original invention. — Cantrell v. Wallick, 117 U. S., 689; Robertson v. Blake, 94 U. S., 728.

Decision of Patent Office, effect in suit.

— Appleton v. Ecaubert, 67 F. R., 917.
Devices actually made as well as face of patent should be considered in determining interference. — Thomson-Houston v. Western, 72 F. R., 530.

INVENTION**Patentable — General Provision.**

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

Abandoned experiments. — Seymour v. Osborne, 11 Wall., 516. Corn Planter Patent, 23 Wall., 181; Wood Paper Pat., 23 Wall., 566. Deering v. Winona Works, 155 U. S., 286; West v. Sperry, 58 F. R., 186.

Abandonment of invention. — Rifle v. Whitney, 118 U. S., 22.

Act of invention. — Wells v. Curtis, 66 F. R., 318.

Aggregation. — Hailes v. Van Wormer, 20 Wall., 353. Reckendorfer v.

Faber, 92 U. S., 347; Rubber v. Welling, 97 U. S., 7; Bussey v. Excelsior, 110 U. S., 131; Beecher v. Atwater, 114 U. S., 523; Hendy v. Golden, 127 U. S., 370; Thatcher v. Burtis, 121 U. S., 286; Union v. Keith, 139 U. S., 530. Cluett v. Claffin, 140 U. S., 180; Patent v. Glover, 141 U. S., 560; Derby v. Thompson, 146 U. S., 476; Ide v. Ball, 149 U. S., 550; Giles v. Heysinger, 150 U. S., 627. Richards v. Chase, 158 U. S., 299; Richards v. Chase, 159

U. S., 477; *Palmer v. Corning*, 156 U. S., 342; *Deere v. Case*, 56 F. R., 841; *Griswold*, 78 O. G., 482.

Aggregation and combination distinguished. — *Stephenson v. Brooklyn Co.*, 114 U. S., 149; *Snyder*, 78 O. G., 485.

Anticipation of combination claim. — *Cantrell v. Wallick*, 117 U. S., 689; *Sutter v. Robinson*, 119 U. S., 530; *Flower v. City*, 127 U. S., 563; *Wollensak v. Sargent*, 151 U. S., 221; *Cons. v. Barnard*, 156 U. S., 261; *American v. Pennock*, 17 S. C. Reporter, 1; *Cochrane v. Deener*, 94 U. S., 780; *Roemer v. Simon*, 95 U. S., 214; *Illinois v. Robbins*, 52 F. R., 215.

Art, machine, manufacture or composition of matter — Double use — Aggregation. — *Fond du Lac v. May*, 137 U. S., 395.

Article of manufacture. — *Union v. Van Dusen*, 23 Wall., 530; *Cohn v. U. S.*, 93 U. S., 366; *Andrews v. Thum*, 67 F. R., 911.

Article distinguished from method of making. — *Cochrane v. Badische*, 111 U. S., 293.

Change of material. — *Hicks v. Kelsey*, 18 Wall., 670. *Smith v. Goodyear*, 93 U. S., 486; *Terhune v. Phillips*, 99 U. S., 592. *Brown v. District of Columbia*, 130 U. S., 87; *Florsheim v. Schilling*, 137 U. S., 64; *Cheneau v. Comr.*, 70 O. G., 924. *Kilbourne v. Bingham*, 50 F. R., 697; *Edison v. U. S.*, 52 F. R., 300.

Change of parts. — *Ives v. Hamilton*, 92 U. S., 426; *Werner v. King*, 96 U. S., 218; *Mach. v. Murphy*, 97 U. S., 120; *Thomson-Houston v. Western*, 72 F. R., 530.

Change in shape. — *Butler v. Steckel*, 137 U. S., 21-30.

Degree. — *Planing Mach. v. Keith*, 101 U. S., 479; *Ansonia v. Elec.*, 144 U. S., 11; *Burt v. Evory*, 133 U. S., 349; *Wright v. Yuengling*, 155 U. S., 47.

Double use. — *Tucker v. Spaulding*, 13 Wall., 453. *Brown v. Piper*, 91 U. S., 37; *Roberts v. Ryer*, 91 U. S., 150; *Vinton v. Hamilton*, 104 U. S., 465; *Blake v. San Francisco*, 113 U. S., 679; *Railroad v. Safety Truck*, 110 U. S., 490; *Window Cleaner v. Bosley*, 15 Brodix, 64. *Crescent v. Gottfried*, 128 U. S., 158; *Peters v. Hanson*, 129 U. S., 541; *St. Germain v. Brunswick*, 135 U. S., 227; *Howe v. National*, 134 U. S., 388-398; *Marchand v. Emken*, 132 U. S., 195-200; *Day v. Fair Haven*, 132 U. S., 98-103; *Busell v. Stevens*, 137 U. S., 423; *Lovell v. Cary*, 147 U. S., 623; *Leggett v. Oil Co.*, 149

U. S., 287; *Market v. Rowley*, 155 U. S., 621; *National v. Thompson*, 65 F. R., 427; *Beach v. Inman*, 71 F. R., 420; *New Departure v. Bevin*, 73 F. R., 469; *Steiner v. Adrian*, 59 F. R., 132; *Zinsser v. Krueger*, 48 F. R., 296.

Double use and invention distinguished. — *Potts v. Creager*, 155 U. S., 597; *Taylor v. Sawyer*, 75 F. R., 301.

Equivalents. — *Seymour v. Osborne*, 11 Wall., 516. *Smith v. Nichols*, 21 Wall., 112. *Gould v. Rees*, 15 Wall., 187. *Hyndman v. Roots*, 97 U. S., 224; *Mfg. Co. v. Mfg. Co.*, 12 Brod., 281. *Imhaeuser v. Buerk*, 101 U. S., 647; *Goodyear v. Davis*, 102 U. S., 222; *Wicke v. Ostrum*, 103 U. S., 461; *Guidet v. Brooklyn*, 105 U. S., 566; *Clough v. Gilbert*, 106 U. S., 178; *King v. Gallun*, 109 U. S., 99; *Consolidated v. Walker*, 138 U. S., 124; *Western v. La Rue*, 139 U. S., 601; *McClain v. Ortmayer*, 141 U. S., 419; *Myers v. Shovel*, 141 U. S., 674; *Hoyt v. Horne*, 145 U. S., 302; *Nat'l v. Hedden*, 148 U. S., 482; *Brigham v. Coffin*, 149 U. S., 557; *Erie v. Am.*, 70 F. R., 58; *Hunt v. Cassidy*, 53 F. R., 257; *Briggs*, 78 O. G., 169. *McKay v. Dizer*, 16 F. R., 102; *Jones v. Munger*, 49 F. R., 61.

Extensive use. — *Magowan v. N. Y.*, 141 U. S., 332; *McClain v. Ortmayer*, 141 U. S., 419; *McCreary v. Canal Co.*, 141 U. S., 459; *Gandy v. Belt Co.*, 143 U. S., 587; *Grant v. Walter*, 148 U. S., 547; *Krementz v. Cottle*, 148 U. S., 556; *Duer v. Corbin*, 149 U. S., 216; *Keystone v. Adams*, 151 U. S., 139; *Olin v. Timkin*, 155 U. S., 141; *Seabury v. Am Ende*, 152 U. S., 561; *Holmes v. Truman*, 67 F. R., 542; *Fox v. Perkins*, 52 F. R., 205; *Dueber v. Robbins*, 75 F. R., 17; *Saunders v. Allen*, 60 F. R., 610; *Watson v. Stevens*, 51 F. R., 757.

Foreign publication. — *Rosewasser v. Spieth*, 129 U. S., 47.

Idea not patentable. — *Pencil Co. v. Howard*, 20 Wall., 498.

Inoperative structure. — *Mitchell v. Tilghman*, 19 Wall., 287.

Patent covers other analogous uses. — *Stow v. Chicago*, 104 U. S., 547; *Wire Cloth v. Clinton Co.*, 67 F. R., 790.

Lack of invention generally. — *Lehigh v. Kearney*, 158 U. S., 461. *Belding v. Challenge*, 151 U. S., 100; *Morgan v. Albany*, 152 U. S., 425; *Sargent v. Covert*, 152 U. S., 516; *Haughey v. Lee*, 151 U. S., 282; *Western v. Ansonia*, 114 U. S., 447-453; *Estey v. Burdett*, 109 U. S., 633; *Hartshorn v. Saginaw*, 119 U. S., 664-679; *Preston*

v. Manard, 116 U. S., 661-664; *Weir v. Morden*, 125 U. S., 98-108; *Hailes v. Albany*, 123 U. S., 582-589; *Holland v. Shipley*, 127 U. S., 396; *Peters v. Active*, 130 U. S., 626; *Pattee v. Kingman*, 129 U. S., 294-305; *Dreyfus v. Searle*, 124 U. S., 60; *Munson v. Mayor*, 124 U. S., 601-605; *Goebel v. Goldman*, 64 F. R., 787; *Consolidated v. Holtzer*, 67 F. R., 907; *Andrews v. Thum*, 67 F. R., 911; *Kilmer v. Griswold*, 67 F. R., 117; *Thompson v. Walbridge*, 67 F. R., 1021; *Kilmer v. Griswold*, 74 F. R., 561; *Philadelphia v. Weeks*, 61 F. R., 405.

Mechanical skill. — *Hollister v. Benedict*, 113 U. S., 59-73. *Morris v. McMillin*, 112 U. S., 244; *Pomace v. Ferguson*, 119 U. S., 335-338; *Yale v. Greenleaf*, 117 U. S., 554-559; *Aron v. Manhattan*, 132 U. S., 84; *Shenfield v. Nashawannuck*, 137 U. S., 56; *Phillips v. Detroit*, 111 U. S., 604. *Royer v. Roth*, 132 U. S., 201; *French v. Carter*, 137 U. S., 239; *Giles v. Hey-singer*, 150 U. S., 627; *Black Diamond v. Excelsior*, 156 U. S., 611; *Smith v. Macbeth*, 67 F. R., 137; *Union v. Waterbury*, 70 F. R., 240; *Merritt v. Middleton*, 61 F. R., 680; *Westinghouse v. Edison*, 63 F. R., 588.

Mechanical method and its relation to article produced — *Aggregation.* — Two patents to one inventor for one invention. — *Mosler v. Mosler*, 127 U. S., 354.

Mechanical processes criticised. — *Risdon v. Medart*, 158 U. S., 68; *Glass Co. v. Henderson*, 67 F. R., 930.

Must involve invention as well as novelty and utility. — *Thompson v. Boisselier*, 114 U. S., 1; *Gardner v. Herz*, 118 U. S., 180; *Hill v. Wooster*, 132 U. S., 693.

New and useful result. — *Loom Co. v. Higgins*, 105 U. S., 580.

Operativeness and usefulness, evidence of. — *Dashiell v. Grosvenor*, 162 U. S., 425.

Originality of invention, employer and employee. — *Thompson v. Hall*, 130 U. S., 117-122; *Forgie v. Oil Well*, 58 F. R., 871.

Particular arrangement. — *Pope v. Gormully*, 144 U. S., 238; *Topliff v. Topliff*, 145 U. S., 156; *Dobson v. Cubley*, 149 U. S., 117; *Corbin v. Eagle*, 150 U. S., 38; *Knapp v. Morss*, 150 U. S., 221; *Howard v. Detroit*, 150 U. S., 164; *Magin v. Karle*, 150 U. S., 387.

Public use or sale. — *Consolidated v. Wright*, 94 U. S., 92. *Elizabeth v. Pavement*, 97 U. S., 126. *Parks v. Booth*, 102 U. S., 96; *Egbert v. Lippman*, 104 U. S., 333; *Worley v. Loker*, 104 U. S., 340; *Hall v. Macneale*, 107 U. S., 90; *Manning v. Glue Co.*, 108 U. S., 462; *Miller v. Force*, 116 U. S., 22; *Beedle v. Bennett*, 122 U. S., 71; *Smith v. Sprague*, 123 U. S., 249; *Andrews v. Hovey*, 124 U. S., 694; *Andrews v. Hovey*, 123 U. S., 267-276; *Brush v. Condit*, 132 U. S., 39-50; *Barbed Wire Patent*, 143 U. S., 275; (*in this country*). *Gandy v. Belt Co.*, 143 U. S., 587; *Root v. Third Ave.*, 146 U. S., 210; *Kirk v. United States*, 163 U. S., 49, 911. *Gates v. Frazier*, 153 U. S., 332; *Smith v. Mellon*, 58 F. R., 705; *Gamewell v. Municipal*, 61 F. R., 208; *National v. Quick*, 74 F. R., 236.

Prior knowledge or use. — *Forncrook v. Root*, 127 U. S., 176; *Collins v. Coes*, 130 U. S., 56; *Peters v. Active*, 129 U. S., 530.

Prior publication. — *Eames v. Andrews*, 122 U. S., 40.

Process defined. — *Mowry v. Whitney*, 14 Wall., 620; *Wood Paper Pat.*, 23 Wall., 566. *Cochrane v. Deener*, 94 U. S., 780; *Downtown v. Yeager*, 108 U. S., 466; *Fermentation v. Maus*, 122 U. S., 413-432. *Lawther v. Hamilton*, 124 U. S., 1-11; *International v. Gaylord*, 140 U. S., 55; *Royer v. Coupe*, 146 U. S., 524; *Wells v. Henderson*, 67 F. R., 930; *Schwarzwalder v. N. Y.*, 66 F. R., 152; *Tannage v. Zahn*, 70 F. R., 1003. *Wall v. Leck*, 66 F. R., 552; *Vt. v. Gibson*, 56 F. R., 143; *Heroult*, 5 App. D. C., 90; *Am. v. Buckskin*, 72 F. R., 508.

Process and apparatus claims treated; priority and originality of invention; operative device. — *Telephone Cases*, 126 U. S., 1-584.

Result not patentable. — *Fuller v. Yentzer*, 94 U. S., 288, 299; *Glue Co. v. Upton*, 97 U. S., 3. *Brush v. Western*, 76 F. R., 761; *Browning v. Colorado*, 61 F. R., 845.

Two patents to one inventor for one invention. — *Miller v. Eagle Co.*, 151 U. S., 186; *Underwood v. Gerber*, 149 U. S., 224; *Russell v. Kern*, 69 F. R., 94; *Thomson-Houston v. West. Elec.*, 70 F. R., 69; *Westinghouse v. N. Y.*, 67 F. R., 962; *Fassett v. Ewart*, 62 F. R., 404; *Elec. v. Brush*, 52 F. R., 130; (Consult also citations under sec. 4919.)

Importance — Necessary to Grant.

* * * And if * * * it shall appear * * * that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor. — R. S. 4893.

INVENTOR**Death of — Who may Apply for Patent.**

(See Executor, R. S. 4896).

Who may make Application as.

(See Invention, R. S. 4886).

JUDICIAL CODE

(NOTE: The following is a classification of the sections of the Federal Judicial Code, in effect Jan. 1, 1912, which relate to patents).

Appeals — Circuit Court of Appeals.

(See Circuit Court of Appeals, Secs. 128, 129, Jud. Code).

Appeals — Court of Appeals, D. C.

Sec. 250. Any final judgment or decree of the court of appeals of the District of Columbia may be reexamined and affirmed, reversed, or modified by the Supreme Court of the United States, upon writ of error or appeal in the following cases:

* * * * *

Except as provided in the next succeeding section, the judgments and decrees of said court of appeals shall be final in all cases arising under the patent laws, the copyright laws, the revenue laws, the criminal laws, and in admiralty cases; and except as provided in the next succeeding section, the judgments and decrees of said court of appeals shall be final in all cases not reviewable as hereinbefore provided.

Appeals — Injunction.

(See Circuit Court of Appeals, Sec. 129, Jud. Code).

Certification — To Supreme Court.

(See Circuit Court of Appeals, Sec. 239, Jud. Code).

Certiorari — To Court of Appeals, D. C.

(See Court of Appeals, D. C., Sec. 251, Jud. Code).

Certiorari — To Circuit Court of Appeals.

(See Supreme Court, Sec. 240, Jud. Code).

Circuit Courts — Abolished — Transfer of Records.

Sec. 289. The circuit courts of the United States, upon the taking effect of this Act, shall be, and hereby are, abolished; and there-