

As to recovering back an amount paid; Hare took out a patent for an apparatus for preserving the essential oil of hops in brewing, and afterwards granted to Taylor the privilege of using the invention for the residue of the term of the patent; and in consideration thereof, Taylor covenanted to pay to Hare, during the term, an annuity of £100. There was no fraud on the part of Hare, who, it seems, supposed the patent to be valid. After Taylor had used the apparatus, and paid the annuity for several years, it was discovered that Hare was not the inventor, but the patent had never been repealed. Taylor then brought an action against Hare to recover back the money. Sir J. Mansfield C. J. “It is not pretended that any action like the present has ever been known. In this case, two persons equally innocent make a bargain about the use of a patent, the defendant supposing himself to be in possession of a valuable patent right, and the plaintiff supposing the same thing. Under these circumstances, the latter agrees to pay the former for the use of the invention, and he has the use of it; *non constat* what advantage he made of it; for any thing that appears, he may have made considerable profit. These persons may be considered, in some measure, as partners in the benefit of this invention. In consideration of a certain sum of money, the defendant permits the plaintiff to make use of this invention, which he would never have thought of using had not the privilege

been transferred to him. How then can we say that the plaintiff ought to recover back all that he has paid? I think that there must be judgment for the defendant." Heath J. "It might as well be said, that if a man lease land, and the lessee pay rent, and afterwards be evicted, that he shall recover back the rent, though he has taken the fruits of the land." Chambre J. "In the case of Arkwright's patent, which was not overturned till very near the period at which it would have expired, very large sums of money had been paid; and though something, certainly, was paid for the use of the machines, yet the main part was paid for the privilege of using the patent right, but no money ever was recovered back which had been paid for the use of that patent." Judgment of nonsuit.<sup>11</sup>

In the above case some stress was laid on the circumstance that the patentee held a patent that was apparently good on the record. In a preceding action to recover the price agreed to be paid for the use of a patent that was void on the record, the decision was against the plaintiff. It was a decision of Lord Kenyon, C. J. and Ashurst, Buller and Grose, Justices, in an action of covenant on articles of agreement. It appeared that the plaintiffs, who were assignees of a patent for a machine to be fixed to a

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<sup>11</sup> Taylor v. Hare, 4 B. & P. 260.

common stocking-frame, for making a sort of net or open work, called point net, had agreed that the defendant might use one stocking-frame with their patent affixed thereto, in case the same should be worked only in the manner described in the specification; and that the defendant had covenanted not to use any of the patent machines, or any machines resembling the same, except the stocking-frame and machine so allowed to be used by him. The action was brought for a breach of this covenant. The defendant pleaded in bar that the specification was not enrolled in time, that the invention was not a new invention, and that the original patentee was not the inventor. The plaintiffs demurred, and contended that he was estopped by his deed from putting those matters in issue. Lord Kenyon. "It is said that the defendant is estopped in point of law from saying that the plaintiffs had no privilege to confer; but the doctrine of estoppel is not applicable here. The person supposed to be estopped is the very person who has been cheated and imposed upon. This does not resemble the case of landlord and tenant; for the tenant is not, *at all events*, estopped to deny the landlord's title; the estoppel only exists *during the continuance of his occupation*; and if he be ousted by a title paramount, he may plead it." Buller J. "If the plaintiffs had the exclusive right to the machine, they might convey it to any other person. It is now discovered that they had no such right; and there-

fore the defendant has not the consideration for which he entered into his covenant ; and notwithstanding which they say he is still bound." Judgment for the defendant.<sup>12</sup>

The distinctions between these two cases are, that in one, the agreed price for the use of the machine was sought to be recovered ; in the other, the agreed price having been paid, was sought to be recovered back ; and in the first case the record showed a prima facie good title in the party agreeing to let the use of the machine ; in the latter, it did not show such a title. In both cases the party professing to be the proprietor of the patent, thought himself entitled to it ; there appears, therefore, not to have been any intentional fraud in either contract.

The question of fraud, and the fact of possession being out of the case, it is obvious that various other considerations might have an influence in determining the decision between parties to a sale of this description. The payment may have been under a judgment, as in some instances, under Oliver Evans's patent for the hopperboy, which was eventually adjudged to be bad ; or a settlement<sup>1</sup> may have been made between the parties with a full, or at least an equal knowledge, of the facts. In general, after payment, the presumptions seem to be in favor of the party to whom the payment is made.

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<sup>12</sup> *Hayne v. Maltby*, 3 T. R. 438.

A patent right, like property of every other description, is liable to be assigned, not only by the agreement of the proprietor, but also by the operation of law independently of any voluntary act of the proprietor for this particular purpose. An instance of this has already been mentioned in the transfer of the right to the executors or administrators, or to the legatee of the proprietor in case of his decease, in the same manner as any other personal property.

In virtue of a general assignment under a bankrupt or insolvent law, of all the property of a proprietor of a patent right, or a share in one, his interest will be transferred with his other property to the assignees for the benefit of his creditors. Of the application of this doctrine to the interest held under a patent issued before such general assignment is made, there is no doubt, and it is unnecessary to cite cases, or to go into any discussions on this point.

The only question in relation to this subject that needs to be considered, is, whether any interest is transferred under such an assignment in an invention for which a patent has not been granted at the time of the assignment being made. It is held under the English bankrupt law that where a bankrupt, after the act of bankruptcy, and after the assignment of his effects by the commissioners of bankruptcy, but before his final discharge, takes out a patent, his

interest in that patent may be disposed of for the benefit of his creditors.<sup>13</sup>

The patent will stand upon the same footing as any other acquisition in the mean time, between the assignment and his final discharge ; as a legacy, for instance, or inheritance.<sup>14</sup> If the bankrupt's earnings and acquisitions from the time of his assignment belong to himself, a patent obtained by him would fall under the same rule. It will depend upon the provisions or construction of the particular bankrupt law what will pass to the assignees for the benefit of the creditors.

By the case above mentioned under the English bankrupt law, one Koops had become bankrupt, and a commission of bankruptcy had issued against him. Eleven months after he was declared bankrupt, he obtained a patent for making paper out of straw and other cheap materials. It seems, from the case, though not distinctly stated, that at the time of Koops's bankruptcy, he had an establishment for carrying on the manufacture of this sort of paper, which manufactory would, of course, pass under the assignment to his creditors. After obtaining his patent, he entered into a composition with a greater part of his

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<sup>13</sup> Hesse v. Stevenson, Gods. Pat. 165.

<sup>14</sup> See cases Chitty's Index to Equity Reports, vol. 1, p. 146, art. Bankruptcy, xi. 2.

creditors, to which the assignees were parties, whereby, upon certain stipulations, his creditors, parties to this composition, agreed to release their demands. Koops did not, however, perform his part of this agreement, so that it proved to be ineffectual and null. But while he expected to be able to fulfil it, calculating, probably, on the success of his manufactory, he sold a share of the patent, and also of the establishment, to Stevenson, and the latter sold a part of the share to Hesse. About a year after making the agreement for a composition, the manufacture having probably proved unsuccessful in the mean time, his assignees took possession of the establishment under the bankruptcy proceedings, and had it disposed of for the benefit of the creditors. Hesse, who had bought his share of Stevenson, then brought an action against Stevenson to recover back what he had paid for the share, on the ground that Stevenson had warranted the title.

The question was thus raised whether the assignees had a right to transfer the property, and it was held that where a patent right is obtained by an *uncertificated* bankrupt, it is affected by the previous assignment of the commissioners, and vests in the assignees. Lord Alvanly. “It is contended, that the nature of the property in this patent was such, that it did not pass under the assignment; and several cases were cited in support of this proposition.

It is said that although, by the assignment, every right and interest, and every right of action, as well as right of possession and possibility of interest is taken out of the bankrupt and vested in the assignees, yet that the fruits of a man's own invention do not pass. It is true that the schemes which a man may have in his own head before he obtains his certificate, or the fruits which he may make of such schemes, do not pass, nor could the assignees require him to assign them over, provided he does not carry his schemes into effect until after he has obtained his certificate. But if he avail himself of his knowledge and skill, and thereby acquire a beneficial interest, which may be the subject of assignment, I cannot frame to myself an argument, why that interest should not pass in the same manner as any other property acquired by his personal industry. Can there be any doubt, that if a bankrupt acquire a large sum of money, and lay it out in land, that the assignees may claim it? They cannot indeed take the profits of his daily labor. He must live. But if he accumulate any large sum, it cannot be denied that the assignees are at liberty to demand it; though until they do so, it does not lie in the mouth of strangers to defeat an action at his suit in respect of such property, by setting up his bankruptcy. We are, therefore, clearly of opinion that the interest in the letters-patent, was an interest of such a nature



as to be the subject of assignment by the commissioners."<sup>15</sup>

Though many of the States in the United States have insolvent laws, no question appears to have been raised under them similar to the one raised in the above case.

The question occurred in an English case, whether the condition of an English patent that it shall be void on its being assigned to more than five proprietors, is forfeited by an assignment under the bankrupt act for the benefit of the patentee's creditors, being more than five in number, and it was held not to be such a forfeiture.<sup>16</sup>

As to an insolvent or bankrupt debtor's interest in machinery, apparatus, and property subject to the patent right, and intended to be used in pursuance of the exclusive privilege given by law, there seems to be no ground of question that it will pass under the assignment of his effects, with the privilege of using it, under the patent, since the patent itself so passes where the debtor is the proprietor of it. It cannot be supposed, that all the property of a bankrupt invested in such articles, could be locked up from his creditors, or that they can avail themselves of such machinery and apparatus only as ma-

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<sup>15</sup> *Hesse v. Stevenson*, 3 Bos. & Pul. 565.

<sup>16</sup> *Bloxam v. Elsec*, 6 Barn. & Cres. 169.

materials to be used for other purposes than the manufacture for which they were intended, and for which, only, they are, perhaps, of any value. At least, if the debtor has an assignable right under his own patent, or that of another, there does not appear to be any ground of doubt that his creditors may avail themselves of the full value of the property, accompanied with the right of using it under the patent.

Very nearly allied to the question just stated is that of the seizure and sale of the patented articles on execution. One question arising in this case, is, whether the sale by the sheriff, in such case, transfers to the purchaser the right which the debtor has to use the machines, under the authority and right of the debtor, as patentee, or as his assignee, or having a license from the proprietor of the patent.

If the debtor has no such right, then, undoubtedly, such a right cannot be transferred under such a sale. If, for instance, the debtor has made the articles with the consent of the proprietor of the patent, to be sold upon certain terms and conditions thereafter to be fulfilled and complied with by the maker on such sale, the purchaser of the articles certainly cannot, at the best, pretend to any greater right than the debtor had. The question would arise, in such case, whether the right of the debtor was assignable and transferable by himself, or by a sale under an execution against him. But in case of a general, unconditional, unrestricted right of the debtor to use the

machines, or to sell them for use, it is obviously a very equitable construction in favor of both the debtor and his creditors, in respect to the proprietor of the patent, where he is a third party, that the privilege should pass with the articles.

A case before Mr. Justice Story suggests, without however deciding, whether the purchaser under such a sale obtains all the right of the debtor to use such machine. It was held that, under the statute, the *sale* by a sheriff of the *complete materials* of a patented machine, while such machine is in operation, on an execution against the patentee, does not render the sheriff liable to an action for an infringement of the patent right. In an action by a patentee against a deputy-sheriff for such a sale, the court said, that “if such a sale were construed to be illegal under the statute, it would be practicable for a party to lock<sup>u</sup>p his whole property from the grasp of his creditors, by investing it in profitable patented machines; and, upon the same construction, this consequence would follow, that every part of the materials of the machine might, when separated, be seized on execution, and yet the whole could not be, when united; for the exemption from seizure is claimed only when the whole is combined and in actual operation under the patent. By the laws of Massachusetts, property like this is not exempted from seizure on execution; and an officer who neg-

lected to seize, would expose himself to an action for damages, unless some statute of the United States should contain a clear exception. No such express exception can be found ; and it is inferred to exist only by supposing that the officer would, by the *sale*, make himself a wrongdoer, within the clause of the statute above recited. But within the very words of that clause, it would be no offence to *seize* the machine in execution. The whole offence must consist in a *sale*. It would therefore follow, that the officer might lawfully seize ; and if so, it would be somewhat strange, if he could not proceed to do those acts which alone, by law, could make his seizure effectual. In the present case, we think that a sale of a patented machine, within the prohibitions of the same clause, must be a sale, not of the materials of a machine, either separate or combined, but of a complete machine, with the right, express or implied, of using the same in the manner secured by the patent. It must be a tortious sale, not for the purpose merely of depriving the owner of the materials, but of the use and benefit of his patent.”

“ There is no pretence, in the case before us, that the officer had either sold or guaranteed a right to use the machine in the manner pointed out in the patent right. He sold the *materials* as such, to be applied by the purchaser as he should by law have a right to apply them. The purchaser must, there-

fore, act at his own peril, but in no respect can the officer be responsible for his conduct."<sup>17</sup>

## CHAPTER XVII.

### *Infringement.*

- Sec. 1. *Definition in the Law. Devising.*  
 2. *Making.*  
 3. *Using.*  
 4. *Selling.*  
 5. *Identity of Thing Used or Sold, and that Patented. Difference in Form and Proportions merely. Infringement of a Combination—of a Part.*

#### Sec. I.—DEFINITION IN THE LAW. DEVSING.

THOUGH an inventor, having a right to take out a patent, may assign such patent before taking it out, so that the assignment may operate on the patent when taken out, yet he has not such a property as can be the subject of an infringement.<sup>1</sup>

The fifth section of the act of 1793, which section

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<sup>17</sup> *Sawin v. Guild*, 1 Gallison, 495.

<sup>1</sup> *Dixon v. Thayer*, 4 Wash. C. C. R.

was repealed in 1800, described it to be an infringement to “make, devise, and use, or sell” the thing invented. There was some ambiguity in this description, which was cleared up in the fourth section of the act of 1800, in which it was provided that, “where any person, without the consent of the patentee, his or her executors, &c. first obtained in writing, should make, devise, use or sell the thing whereof the exclusive right was secured to the patentee by patent, such person so offending should forfeit,” &c.

The act of 1836, by which all the preceding acts have been repealed, gives no description of what shall be an infringement, otherwise than by providing for damages in case of “making, using or selling” the thing patented,<sup>2</sup> nor is any such description necessary, since the patent itself, in the form prescribed by that act, in terms grants to the applicant, “for a term not exceeding fourteen years, the full and exclusive right and liberty of making, using, and vending to others to be used, the invention or discovery.”<sup>3</sup> The form of the patent, under the former law, granted to the patentee the exclusive right of “making, constructing, using and vending to others to be used.” The change made by the law of 1836 is in dropping the word *constructing*, which was immaterial, since its meaning is comprehended in *making*.

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<sup>2</sup> Section 14.

<sup>3</sup> Section 5.

And so the omission of the word *devising*, which was used in the act of 1793, in describing an infringement, is unquestionably an improvement, on account of its ambiguity; and because the only practical meaning that could be given it is comprehended in the word *making*.

### Sec. II.—MAKING.

It has been held by Mr. Justice Story, that the making of a patented machine for use or sale, though it were, in fact, neither used nor sold, is an infringement, for which, however, only nominal damages can be recovered, but that the making merely for experiment or philosophical purposes is not an infringement.<sup>4</sup>

### Sec. III.—USING.

A use of the patented article is a direct and unquestionable infringement. We are here speaking of the use of the thing itself, which is the subject of the patent, not that of its products. A patent is, as has been explained in its place, an exclusive right to the practice or use of a certain art, process, contrivance or principle, combined with, and *embodied in*, material substances. The art, contrivance or design,

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<sup>4</sup> *Whittemore v. Cutter*, 1 Gall. R. 429.

considered abstractly, is not itself patentable, or an infringement of a patent. It is only in its production, in combination with materials, that it is either patentable itself, or a violation of a patent right. In a patented instrument or piece of machinery, the subject of the patent exists, and is visible and tangible, and admits of being possessed and delivered distinctly, and independently of its products. But when a composition of matter is the thing patented, the subject of the patent is identified with its products,—or rather a specimen of the product, or the only vendible thing which it is the object of the invention to supply, is, at the same time, a specimen of the invention itself. Whereas, in the case of an instrument or machine, one object of the invention is to produce the instrument or machine itself, another to produce its products. The inventor of a loom may propose a profit on the sale of it, as well as on the sale of its products. So, again, a steam engine, like a loom, is invented to be used as an instrument until it is worn out; and, in this respect, both differ from a patent medicine or many chemical compositions, which are consumed and destroyed at once in the use.

Now, considering the *use* of the thing patented to be an infringement of the patent right, is there any difference in this respect between these different kinds of articles? Is it equally an infringement to use a patented medicine, which is destroyed in the use, or a



nail-machine, loom or steam engine, which will last a long time? The answer to this question undoubtedly is, that the use in either case is equally an infringement.

What, then, is the *use*; and who may be said to *use* the article? In the case of a patented paint, can the lessee, who occupies a house painted with the patented article, be said to use it? or can the hirer or purchaser of a chaise, varnished with patented varnish, be said to use the varnish? In either case we shall readily answer in the negative. One could not, with propriety, put to such a person the question, What paint or varnish do you use? The question can be properly addressed only to the person who selects and *applies* the article. He is the person who *uses* it. So, in case of a patented medicine prescribed, selected and ministered to the patient by others without any act of his own; the doctor or the apothecary, and not the patient, *uses* the article, in the sense intended by the statute. It is otherwise in regard to lasting articles. The cultivator uses a plough, and a manufacturer a loom, and so they, no less than the vendor, infringe the patent right.

We then come to a long series of patented improvements, which are, to a greater or less extent, incorporated with, or appendages to, other articles of which the subject of the patent is an ingredient or part; such, for instance, as a steam valve. In these

cases it certainly cannot be said that the person who uses the article to which the improvement is attached does not use the improvement; for this construction would deprive the greater number of patentees of all remedy for the use of their inventions, and leave them only to pursue the vendors, which would be, in effect, almost to repeal this part of the statute. Such an appendage seems to stand upon the same footing, in this respect, as an article which may be used independently of others. The party who uses the principal thing uses the accessory; and seems to be liable for an infringement of the patent for it.

A mere contract to purchase the articles, produced by the instrument, is not a constructive use of it by the purchaser, within the statute.<sup>5</sup>

A case of this description occurred in Maryland, in relation to Keplinger's instrument for the manufacture of wire watch chains, which had been assigned to Gray and Osgood. About the time of the patent being taken out, Mr. De Young agreed with Hatch and Kirkner to make five gross of such chains for him; he to furnish stock and materials, to be charged to Hatch and Kirkner, at the cost, and to pay at a certain rate per dozen for the chains when manufactured. A large quantity was manufactured and de-

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<sup>5</sup> This is the rule also in France. Renouard on Patents, c. 5, s. 4, p. 214.

livered under the contract. The makers used Mr. Keplinger's patented instrument, in the manufacture, and it appeared from the evidence, that Hatch and Kirkner intended to use the instrument at the time of making the contract, and that De Young knew of such intention ; and that in the course of the manufacture and delivery of the articles, he knew of their using the instrument, and approved of it.

The question in this case was, whether De Young was a partner with Hatch and Kirkner, in the use of the machine, and the transaction a mere cloak to give De Young the benefit of the use of it ; or, as the contract imported, a mere purchase of the articles by De Young, of Hatch and Kirkner, they being left to manufacture them as they should choose ; upon which latter construction of the facts, the jury were instructed to give their verdict for the defendant, which they did.<sup>6</sup>

There can be no question of the accuracy of this verdict, upon such a construction of the facts, since to hold that every person who buys an article produced by the unlicensed use of a patented instrument, is an infringer of the patent right, would expose every purchaser of an article at the shops, to a suit by some patentee. But if the evidence had shown that the contracting parties were, in fact,

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<sup>6</sup> Keplinger v. De Young, 10 Wheat. 358.

partners, or that the contract was made for the purpose of enabling De Young, by hiring the use of the instrument, or otherwise, to reap the benefit or a part of the benefit of violating the patent right, and at the same time evade the penalty, and leave the patentee to seek his remedy against workmen who had no means of making good the damage, it would, as the court expressly held, have been an infringement on his part.

A use of the patented article merely for philosophical experiment, or for the purpose of ascertaining "the verity and exactness of the specification" is not an infringement.<sup>7</sup>

In a case before Mr. Justice Washington, he seemed to consider the use for the purpose of trying the practical utility, to be an infringement. It was relied upon in the argument, that a machine of one Christian, for moulding biscuit, had never been *used* by the defendant within the true meaning of that expression, in the patent act. He said "It is admitted that an experiment was made with it, but this, it is argued, was not such a using as the act intends. It surely cannot be denied that the act of making crackers with it, amounted to a using of it according to the common and accepted meaning of that phrase; and I am quite at a loss to imagine

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<sup>7</sup> *Whittemore v. Cutter*, 1 Gall. R. 429.

how this meaning can be varied by the particular motive which induced the inventor so to employ the machine. I can discover nothing in the patent act which will authorize the court to depart from the ordinary meaning of this expression, and to declare that a machine which is put into operation for the sole purpose of trying its practical utility, is not used within the meaning and intent of the sixth section of the act of 1793.”<sup>8</sup>

This doctrine is at variance with that laid down by Mr. Justice Story, cited above. Certainly Mr. Justice Washington must be wrong as to the court or jury having nothing to do with the motive for using the machine.

A patent cannot be infringed by any thing done before it is granted ; other persons than the inventor both may, therefore, make and use the machine in the United States before the issuing of the patent, without being liable to damages. But after the granting of the patent, if it be valid, (as it may be, in such case, in the United States, though it would not be so in England,) the party who has thus previously made and used the machine, which is the subject of it, cannot continue to use it, and his continuing to do so will be an infringement.<sup>9</sup>

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<sup>8</sup> *Watson v. Bladen*, 4 Wash. C. C. R. 583.

<sup>9</sup> *Ames v. Howard*, 1 Sumner's Rep. 482.

Upon this subject, Mr. Justice Washington, speaking of the continued use of such previously erected machine, after the issuing of the patent, remarks, that it was objected to the construction, that a party had no right to such continued use ; “ that it would render the law *ex post facto* in its operation, in respect to one who has erected his improvement prior to the granting of the patent to the plaintiff.”

“ It must be admitted that cases of great hardship may occur, if, after a man shall have gone to the expense of erecting a machine, for which the inventor has not then, and never may obtain a patent, he shall be prevented from using it by the grant of a subsequent patent, and its relation back to the patentee’s prior invention. But the law, in this case, cannot be termed *ex post facto*, or even retrospective in its operation, because the general law declares, beforehand, that the right of the patent belongs to him who is the first inventor, even before the patent is granted ; and, therefore, any person, who, knowing that another is the first inventor, yet, doubting whether the other will ever apply for a patent, proceeds to construct a machine, of which it may afterwards appear he is not the first inventor, acts at his peril, and with a full knowledge of the law, that by relation back to the first invention, a subsequent patent may cut him out of the use of the machine thus erected.”

“ Not only may individuals be injured by a liberal construction of the words in the law, but the public

may suffer, if an obstinate or negligent inventor should decline obtaining a patent, and at the same time keep others at arms' length, so as to prevent them from profiting by the invention for a length of time, during which the fourteen years are not running on. But all these hardships must rest with Congress to correct. It is beyond our power to apply a remedy."<sup>10</sup>

So where a patent, first taken out, is void, on account of a formal defect in the specification, and on this account is surrendered and a new one taken out, but previously to the granting of the new patent, a machine is erected by another person, the party so erecting the machine, cannot continue to use it after the second patent is taken out, and his so continuing to use it will be an infringement.<sup>11</sup> That is, he stands upon precisely the same footing as a person who erects and uses a machine before the first patent is taken out, when such first patent is valid.

Nor is any notice necessary, in such case, from the patentee to the party who has erected and begun to use the machine before the granting of the new patent. Where a patent for an improvement in a machine for making paper first taken out, was surrendered, and a new one taken out, and before the

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<sup>10</sup> *Evans v. Weiss*, 3 Hall's Law Journal, 180. Wash. C. C. R. 12; *Fessenden's Patents*, 52.

<sup>11</sup> *Ames v. Howard*, 1 Sumner's R. 482.

second patent was issued, another person had erected the machine, and continued to use it after the second patent was issued ; in an action for an infringement of the patent-right, the defendants objected that they were not liable until after notice from the patentee. Mr. Justice Story, however, ruled otherwise, and, on a motion for a new trial, said, " I am by no means prepared to say that any notice is, in cases of this sort, ever necessary to any party who is actually using a machine in violation of a patent right." But supposing notice to be necessary, he considered the knowledge by the defendants that the first patent had been taken out, to be, in effect, such notice. He said, " whoever erects and uses a patented machine, does it at his peril ; he takes upon himself all the chances of its being originally valid, or of its being afterwards made so, by a surrender of it, and granting of a new patent, which may cure any defects, and is grantable according to the principles of law."<sup>12</sup>

The judges considered that the above construction, as to the use of a machine, erected after the expiration of the old, and before grant of the new patent, was forced upon them by the law.<sup>13</sup> But it does not appear why a doctrine evidently so inequitable, is imposed upon the court, since, on the ex-

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<sup>12</sup> *Ames v. Howard*, 1 Sumner's R. 482.

<sup>13</sup> *Evans v. Weiss*, Fessenden on Patents, 52 ; Wash. C. C. 12 ; 3 Hall's L. J. 180 ; *Evans v. Eaton*, 1 Pet. S. C. R. 337.



piration of a patent, the right is merged in the community, and every man has a license from the public to make, use and vend the article. His right in respect to such article is not distinguishable from that which he has in respect to any other which has been in use immemorially without patent. The reason is not shown why the public should not be entitled, under these circumstances, to use the machines that had been made before the renewal of the patent, at least. The more grave question is, whether the patent could, upon any sound principle of legislation, be renewed under these circumstances. Under the act of 1836, patents cannot be prolonged under the provision of the eighteenth section, unless the grant of prolongation is made before the expiration of the first term.

#### Sec. IV.—SELLING.

What is a sale of the patented article so as to be an infringement of the patent, needs not to be dwelt upon at great length. Though questions may be made as to what amounts to a sale, and as to the party who is to be considered the vendor, it would be a digression to go into a minute investigation of the subject in this place. Undoubtedly, the principal, who authorizes his agent to sell for his benefit, is an infringer of the patent. And so, also, is the

agent, for the orders of the principal are no excuse to him for the violation of another's right.

It has already been noticed, that a sale by operation or authority of law, as in case of bankruptcy, insolvency, and sale on execution, is not an infringement of the patentee's right.<sup>14</sup>

**Sec. V.—IDENTITY OF THING MADE, USED OR SOLD, WITH THAT PATENTED. DIFFERENCE IN FORM AND PROPORTIONS MERELY. INFRINGEMENT OF A COMBINATION—OF A PART.**

The making, using or selling of a thing, is, of course, not a violation of a patent, unless it be the thing, or one of the things patented. If it vary from the patented article, merely in form or proportions, but be substantially and essentially the same, it will be a violation of the patentee's right. This doctrine was directly involved in the provision of the act of 1793, by which a variation merely in form or proportions, was declared not to be a new invention, and so not patentable; that is, conversely, it is, within the meaning of the law, the same thing, and so is an infringement.

“What constitutes form, and what principle,” Mr. Justice Washington remarks, “is often a nice

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<sup>14</sup> *Supra.* ch. xvi.

question to decide ; and upon none are the witnesses who are examined in patent cases, even those who are skilled in the particular art, more apt to disagree. It seems to me that the safest guide to accuracy in making the distinction is, first to ascertain what is the result to be obtained by the discovery ; and whatever is essential to that object, independent of the mere form and proportions of the thing used for the purpose, may generally, if not universally, be considered as the principles of the invention."<sup>15</sup>

In a suit for an infringement of a patent for a carriage wheel, whereby the load was suspended at the circumference on the top, instead of being supported, as usual, at the centre, Mr. Justice Patteson instructed the jury, that it was not enough to constitute an infringement, that the defendant had constructed a wheel on the suspension principle, because that principle might be applied in various ways ; but if the jury thought it was applied in the same way, then a variation in two or three circumstances in the defendant's wheel, from the description in the plaintiff's specification, would not prevent its being an infringement.<sup>16</sup>

On the subject of the infringement of a part of the rights secured by patent, Mr. Justice Story says,

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<sup>15</sup> *Treadwell and Watson, v. Bladen*, 4 Wash. C. C. R. 706. And see *Dixon v. Mayor*, 4 Wash. C. C. R. 68.

<sup>16</sup> *Jones v. Pearce*, Gads. Sup. 11.

“Where the inventor claims several distinct and independent improvements in the same machine, and procures a patent for them in the aggregate, he is entitled to recover against any person who shall use any one of the improvements, so patented, notwithstanding there has been no violation of the other improvements. There is no doubt, that by the law of England, a party who pirates any part of the invention of the patentee, is liable in damages, notwithstanding he has not violated the whole. It may be that the decisions have turned upon the peculiar language of the English patents ; for in all the precedents which I have seen, the patent gives the exclusive right of the whole invention, and prohibits all other persons, “directly and indirectly, to make, use or put in practice, the said invention, or *any part of the same, &c.* or in any wise to counterfeit, imitate, or resemble the same, or make, or cause to be made, any addition thereto, in subtraction from the same.”<sup>17</sup> But as no such intimation is given in the reports, I incline to believe that the doctrine stands upon the general principles of law, that he who has the exclusive right to the whole of a thing, has the same right to all the parts which the general right legally includes ; that is, (in cases like the present,) to all the parts which he has invented.

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<sup>17</sup> Collier on Patents, 54, 57 ; Dav. Patent Cas. 27, 30.

The principal difficulty that arises, is in the application of the doctrine; and that may, in most cases, be removed, by considering the nature and extent of the patent, or rather of the thing invented and patented. Where the patent goes for the whole of a machine as a new invention, and the machine is, in its structure, substantially new, any person who pirates a part of the machine, substantially new in its structure, deprives the inventor, so far, of his exclusive right in his invention, and may, in a great measure, destroy the value of the patent. Where the patent is for several distinct improvements in an existing machine, or for an improved machine, incorporating several distinct improvements, which are clearly specified, then if a person pirates one of the improvements, he violates the exclusive right of the patentee, for the patent is as broad as the invention, and the invention covers all the improvements; and it is a wrong done to the patentee, to deprive him of his exclusive right, in any of his improvements."<sup>18</sup>

A patent for a combination, merely does not, as we have seen, give the exclusive privilege of using the separate things combined,<sup>19</sup> and consequently the use, making or selling of any separate parts, less than the whole combination, is not an infringement.

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<sup>18</sup> *Moody v. Fiske*, 2 Mason 112; and see *Hill v. Thompson*, 2 J. B. Moore, 424; *Bovill v. Moore*, Dav. Pat. Cas. 361.

<sup>19</sup> *Supra.* and see *Brunton v. Hawkes*, 4 B. & Ald. 549.

This doctrine is thus laid down by Mr. Justice Story :  
“ Where a patent is for a *new combination* of existing machinery or machines, and does not specify or claim any improvements or invention, except the combination, unless that combination is substantially violated, the patentee is not entitled to any remedy, although parts of the machinery are used by another, because the patent, by its terms, stands upon the *combination* only. In such a case, proof that the machines, or any part of their structure, existed before, forms no objection to the patent, unless the *combination* has existed before, for the reason, that the invention is limited to the combination. If there be different and distinct improvements constituting parts of the combination, which are specified as such in the patent and specification, and any one of them be pirated, the same rule seems to apply as in other cases, where part of an invention is pirated ; for the patent then shows that the invention is not limited to the mere combination, but includes the particular improvements specified.”<sup>20</sup>

On this subject, Mr. Justice Washington, speaking of the use of the hopperboy, elevator and other machinery, for an improvement in which Evans took out a patent, asks, “ Will it be seriously contended that a person may acquire a right to the exclusive

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<sup>20</sup> Moody v. Fiske, 2 Mason, 112.

use of a machine because, when used in combination with others, a new and useful result is produced, which he could not have acquired independent of that combination? If he can, then if A were proved to be the original inventor of the hopperboy, B of the elevator, and so on as to the other machines, and had obtained patents for their respective discoveries, or chosen to abandon them to the public, the plaintiff, although it is obvious he could not have obtained separate patents for these machines, might, nevertheless, deprive the original inventors, in the first instance, and the public, in the other, of their acknowledged right to use these discoveries, by obtaining a patent for an improvement which consists in a combination of those machines to produce a new result." And he contends clearly that the patentee of the mere combination cannot thus deprive others of the use of the machine or parts combined, or, in other words, that the use of these separately is not an infringement."<sup>21</sup>

A patentee, having taken out a patent for the combined operation of five parts, afterwards took out a separate patent for two of them, as being an improvement on a machine patented by another patentee. Held by Washington J. that this was not taking out two patents for the same thing, one being

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<sup>21</sup> *Evans v. Endon*, 1 Pet. C. C. R. 343, 344, 345, 346.

for a combination, and the other for a part of the things combined.<sup>22</sup> It follows, accordingly, that if the patent is for a combination merely, the use of any one or more of the things combined, but not of the whole, is not an infringement of the patent right for the combination.

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## CHAPTER XVIII.

### *Jurisdiction of Patents.*

By the act of 1836, s. 17, it is provided “that all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions and discoveries, shall be originally cognizable, as well in equity as at law, in the Circuit Courts of the United States, or any District Court having the powers and jurisdiction of a Circuit Court;” which courts have power to grant injunctions to prevent the violation of the rights of any inventor. Provided, however, that a writ of error or appeal shall lie to the Supreme Court in the same manner as on other

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<sup>22</sup> *Treadwell and Watson v. Bladen*, 4 Wash. C. C. R. 709.



judgments and decrees of Circuit Courts, "and in all other cases in which the court shall deem it reasonable to allow the same."

The jurisdiction was in the Circuit Court before the passing of this law, under that of 1800. One alteration is made in giving an appeal where the court shall deem it reasonable.

The State courts have not a concurrent jurisdiction with the Circuit Courts of the United States. In an action brought for an infringement of a patent right in the State courts of New York,<sup>1</sup> the court said, "As the judicial power of the United States extends to all cases of law and equity arising under the laws of the United States, and as the act of Congress on the subject of patent rights, has declared that the suit for the infringement of them shall be brought in the Circuit Court of the United States, and gives the court power in such cases to declare the patent void, the State courts have, of course, no jurisdiction in the case."<sup>2</sup> It had been held in New York, previously to the passing of the above act of 1819, that a case in equity on a patent was cognizable before a State court of equity, as Congress had not then conferred this jurisdiction on the Circuit

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<sup>1</sup> *Parsons v. Barnard*, 7 Johns. R. 144.

<sup>2</sup> See also *Kent's Comm.* vol. 2, p. 368, sect. 36, and *Burral v. Jewett*, 2 Paige's R. 134.

Courts of the United States.<sup>3</sup> All questions of a juridical character relating to patents belong properly to the jurisdiction of the judicial tribunals, in distinction from the legislature, and it has been accordingly doubted whether Congress has a right to decide whether a person is the original inventor of what he claims as his invention, so as to preclude judicial inquiry.<sup>4</sup>

Though the State courts have no direct jurisdiction of patent causes, still the question of the validity of a patent may come incidentally before them,<sup>5</sup> as in case of an application to a chancery court of a State to set aside a contract relating to a patent right, as founded in a mistake,<sup>6</sup> or a suit on a promissory note where the defence is want of consideration, the note having been given for a share in a patent right which the defendant alleges to be void on the ground that the patent was fraudulently obtained.<sup>7</sup>

The State courts have also jurisdiction of cases arising on the grant of patents or other monopolies by the States, as far as valid grants of this descrip-

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<sup>3</sup> *Livingston et al. v. Van Ingen et al.* 4 Hall's Law Journal, 56; Coxe's Digest, 534.

<sup>4</sup> *Story's Comm. on the Constit. v. 3*, p. 49, where is cited *Evans v. Eaton*, 3 Wheat. R. 454.

<sup>5</sup> *Cone v. Baldwin*, 12 Pick. R. 545.

<sup>6</sup> *Burrall v. Jewett*, 2 Paige's R. 134.

<sup>7</sup> *Bliss v. Negus*, 3 Mass. R. 46.

tion can be made by a State. Thus, it having been held by the court of chancery, and, on appeal, by the court of errors, in New York, that the several acts of the legislature of that State, granting to Livingston and Fulton, for a term of years, the sole and exclusive right of using and navigating boats or vessels moved by steam or fire, in the waters of the State, were valid, it was also held, as a consequence of that decision, that an injunction might be issued by the court of chancery of the State to restrain the citizens of another State from navigating the waters of New York by steam boats.<sup>8</sup> But an appeal lies to the Supreme Court of the United States in such case, if the validity of an act of Congress is brought in question and the decision of the State court is against it.

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<sup>8</sup> *Gibbons v. Ogden*, 17 Johns. R. 488.

## CHAPTER XIX.

*Action at Law for an Infringement.*

- Sec. 1. *Form of Action.*  
 2. *Parties.*  
 3. *Declaration.*  
 4. *Plea. Defences. Notice.*

## Sec. I.—FORM OF ACTION.

By the fourteenth section of the act of Congress of 1836, it is provided that in case of an infringement of a patent right, damages “may be recovered by action on the case.” This is merely a provision by statute for the remedy to which the proprietor of a patent would have been entitled by the common law.<sup>1</sup> It is said in an old case that an action for an infringement may be maintained on a defective patent liable to be repealed, as long as it remains unrepealed;<sup>2</sup> but this is not law; if the patent is proved to be void, the action fails.

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<sup>1</sup> Eull. N. P. 76; 1 Chit. Pl. 159, 5th Lond. and 6th Am. ed.; Clements v. Goulding, 11 East, 224; S. C. 2 Camp. N. P. 25; Roworth v. Wilkes, 1 Camp. N. P. 94; 1 Saund. Pl. and Ev. 336, (412.)

<sup>2</sup> Butler's case, 2 Ventr. 344.

## Sec. II.—PARTIES.

The act of 1836, s. 14, provides that an action for an infringement is "to be brought in the name or names of the person or persons interested, whether as patentee, assignees, or as grantees of the exclusive right within and throughout a specified part of the United States."

This provision changes the rule previously adopted by construction of the act of 1793, under which it had been held that an action could not be maintained in the name of an assignee of the exclusive right for a particular district; as this was considered to be a mere license and not an assignment under the fourth section of that act.<sup>3</sup> Though such a party could join in a bill in equity with the other persons interested.<sup>4</sup>

But an action might be maintained under the former law in the name of an assignee of a share, joined with the patentee.<sup>5</sup>

And if the whole patent be assigned, whether the

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<sup>3</sup> *Whittemore v. Cutter*, 1 Gall. R. 429. *Tyler and another v. Tuel*, 6 Cranch, 324. A suit in the name of the party licensed seems to have been sustained in England. *George v. Wackerback*, Rep. of Arts, 2d Series, v. 27, p. 252.

<sup>4</sup> *Whittemore v. Cutter*, 1 Gall. R. 429. *Ogle v. Ege*, 4 Wash. C. C. R. 584.

<sup>5</sup> *Whittemore v. Cutter*, 1 Gall. R. 429. See *Boulton v. Bull*, 2 H. B. 463.

assignment be made before or after taking it out, an action upon it for an infringement must be brought in the name of the assignee and not that of the patentee.<sup>6</sup>

But while the patentee has merely made an agreement for an assignment, and has not made the assignment, he may bring an action in his own name for an infringement of the patent, notwithstanding such agreement, since the assignee is not put in the place of the patentee as to right and responsibility, until the assignment is executed and recorded.<sup>7</sup>

All who join in the same act of infringement may be sued jointly or separately, or some of them may be joined and others sued separately.<sup>8</sup>

An action for a violation of a patent may be maintained against a corporation when, acting in that character, it authorizes an infringement.<sup>9</sup>

<sup>6</sup> *Herbert v. Adams*, 4 Mason's R. 15.

<sup>7</sup> Per Washington J. *Park v. Little and Wood*, 3 Wash. C. C. R. 196.

<sup>8</sup> 1 Saund. R. 291, e. 2 Saund. 396.

<sup>9</sup> *Kneass v. Schuylkill Bank*, C. C. U. S. Oct. 1820. The joint proprietors of a patent are not liable as copartners on a contract by one of their number, on his own account, to construct a certain number of the patented articles. Livingston and Fulton were joint proprietors of a patent right for the application of steam to the purposes of navigation. Fulton contracted with an assignee of such right, "to be responsible for the perfect construction and performance of certain steam boats to be built on the river Ohio, so that they should carry at least one hundred tons burden, and run at least four miles an hour in still water." It was held by the court of chancery of New York, that Livingston, on the mere ground of his joint interest in the patent right, was not re-

## Sec. III.—DECLARATION.

The declaration in an action for an infringement recites, in general, that, at the time of taking out of the letters-patent, the patentee was the true and original inventor of a new and useful invention or improvement, which is concisely described as in the patent, and, thereupon, on such a day, upon application of the patentee, the secretary of state caused letters-patent to be issued in the name of the United States, bearing such a date, under the seal of the patent office, and duly tested, according to the form of the statutes in such case, whereby was granted to the patentee, his heirs, executors, administrators and assigns, for the term of fourteen years, the full and exclusive right and liberty of making, using and vending to others to be used, the new and useful invention or improvement, agreeably to the statutes in such case made and provided, as by the said letters-patent in court to be produced, and the specification therein referred to, will more fully appear ; and that the patent was assigned by the patentee, or by his assignee, to the plaintiff, if such be the fact ; that the assignment was recorded in the

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sponsible for this contract ; it not being connected with the enjoyment and exercise of their common privilege under the patent. *Lawrence v. Dale*, 3 Johns. Ch. R. 23. On an appeal to the Court of Errors, the decree of the Court of Chancery was affirmed. *McNeven v. Livingston*, 17 Johns. R. 437.

patent office; that the plaintiff or the preceding proprietors and the plaintiff successively, always, from the time of granting the letters-patent, or that the plaintiff, from the time of such assignment, has used and enjoyed the right to the time of suing out the writ; that the defendant well knowing the premises, and intending to deprive the plaintiff of the profits and advantages which he might otherwise have derived from the right, at such a place, on such a day, and at other times between that day and the date of the writ, made or used, or sold the said invention, without the permission or license in writing, and against the will of the plaintiff, in breach of the letters-patent, and in violation of the right granted to the plaintiff, or granted to the patentee and assigned to the plaintiff; whereby the plaintiff was deprived of great profits, and has sustained actual damage to such an amount, whereby, and by force of the statute, an action has accrued to the plaintiff to recover damages.<sup>10</sup>

The declaration in this, as in all other cases, must show a cause of action by setting forth the facts necessary for this purpose. These facts, in general, as will appear by the above outline, are—1, the invention by the patentee; 2, description of the invention; 3, the grant of the patent; 4, what the

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<sup>10</sup> See 2 Chit. Pl. 764; 8 Wentw. Pl. 431; 1 Saund. 189; Fessenden on Patents, 406; Davis's Pat. Cas. 162; Boulton v. Bull, 2 H. B. 463.



patent grants ; 5, the assignment, if there were one ; 6, the infringement.

1. In setting forth that the patentee was the inventor, the words of the act are followed.

2. The invention is concisely stated by the mere title or general description in the patent.

3. In stating the grant of the patent in the words of the act, it is alleged that it was signed by the secretary,<sup>11</sup> and issued under the seal of the patent office. So the English practice requires the averment that the letters issued under the great seal, this being requisite to their validity.<sup>12</sup>

It must be averred that the patent was signed by the President. It is not necessary to aver that the requisite preliminary steps, to obtain a patent, were taken : it is enough to aver that the patent was granted in the form prescribed by law. Upon demurrer, the court will presume that every thing was rightly done to obtain it.<sup>13</sup>

Under the act of 1793, it was held that the declaration must aver that the patent *did issue* ; that it was not enough to allege that it was made out in due form, under the seal and in the name of the Uni-

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<sup>11</sup>Fulton's Exr's. v. Myers, Coxe's Dig. 531.

<sup>12</sup>2 Ins. 555 ; Coke's R. 18. To plead letters-patent without saying *suo magno sigillo* is naught, and that because the king has divers seals. Jay v. Bond, 1 Vent. 222.

<sup>13</sup>Cutting and others Exr's. of Fulton v. Myers, Coxe's Dig. 531 ; S. C. 4 Wash. C. C. R. 220.

ted States, by which there was granted, &c. The law prescribed that it should be delivered to the petitioner, and no person could take it till he had taken the oath and made the disclosure required in the second section of the law of 1793. The omission of this averment was held to be fatal on general demurrer.<sup>14</sup>

The phraseology of the act of 1793 differs a little from that of 1836 on this subject: the expressions *made out*, and *issued*, are not contrasted in the latter as in the former. Whether the above construction will be applied to the latter law, remains to be determined.

4. As to the statement of what is granted by the patent, where in an action for an infringement, the patent was recited in the declaration, but the specification, which was referred to in the patent as a part of it, was not recited, it was objected, in arrest of judgment, that the subject of the patent was not sufficiently described. But Mr. Justice Washington said the specification was matter of evidence to be used at the trial, and if a sight of it were necessary to the defence, the defendant might have had it placed upon the record by asking oyer of it, and

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<sup>14</sup> Cutting and others Exr's. of Fulton v. Myers, Coxe's Dig. 531; 4 Wash. C. C. R. 220.

that, at any rate, the defect, if any, was cured by verdict.<sup>15</sup>

5. On the subject of setting forth an assignment, a question respecting the averment of the recording occurred in an action for the infringement of the patent right of Williston's double reflecting bakers, brought by the assignee in his own name, in which case it was averred that Williston obtained a patent and exercised and enjoyed the right under it till June 20, 1831, and that he, by writing, under his hand of that date, sold and conveyed all his right and claim in said patent right to one John Robinson, as by said assignment in writing, in court to be produced, would fully appear, whereby said John Robinson, as assignee of said Williston, became, and was the true and lawful owner of said right, with the full and sole power in him and his assigns to make, use and vend the said improvement agreeably to the statutes aforesaid recited ; and that Robinson exercised, used and enjoyed the right until the 29th of July, 1831, when, by assignment of that date, under his hand and seal, and in court to be produced, he granted, sold and conveyed all his right, title and interest in the said letters-patent, and the improvement therein specified and set forth, to the plaintiff, and that the plaintiff, from the time of making said last mentioned assign-

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<sup>15</sup> Gray & Osgood v. James and others, 1 Pet. C. C. R. 482.

ment had exercised, used and enjoyed the right, by himself, servants and deputies, to the time of bringing the action. The general issue being pleaded, a verdict was rendered for the plaintiff. The defendant then moved, in arrest of judgment, that the recording of neither assignment—the recording of both of which was necessary in order to give the plaintiff the whole right and enable him to bring an action in his own name,—was averred in the declaration.

Story J. “ We are of opinion that the motion in arrest of judgment ought to be overruled. We accede to the doctrine stated at the bar, that a defective title cannot, after verdict, support a judgment, and, therefore, it constitutes a good ground for arresting the judgment. But the present is not such a case, but is merely the case of a good title defectively set forth. The defect complained of is the omission to state, that the assignments, on which the plaintiff’s title is founded, were recorded in the office of the department of state ; which is made essential to pass the title of the original patentee by the fourth section of the patent act of February 21, 1793, ch. 55. The general principle of law is, that where a matter is so essentially necessary to be proved to establish the plaintiff’s right to recovery, that the jury could not be presumed to have found a verdict for him, unless it had been proved at the trial, there the omission to state that matter in express terms in the declaration, is cured by the verdict, if the gen-

eral terms of the declaration are otherwise sufficient to comprehend it. This was the doctrine of Lord Ellenborough in *Jackson v. Pesked*,<sup>16</sup> and it is very elaborately expounded by Mr. Sergeant Williams in his learned note to 1 Saund. R. 28, a. Now it seems to me that taking the whole declaration together, (however inartificially drawn,) the plaintiff sets up a title by the patent right by assignment, and the enjoyment and use of the right under that title, and that he has been injured in that right under that title by the piracy of the defendants. This cannot be true, nor could a verdict have been found by the jury, if the deeds of assignment had not been duly recorded, for unless that was done, nothing would pass by the deeds. The cases of *Hitchins v. Stevens*,<sup>17</sup> and *McMurdo v. Smith*,<sup>18</sup> cited at the bar, seem to us very strongly in point. So is *France v. Tringer*.<sup>19</sup> There are stronger analogous cases in equity, for it has been held that if a feoffment is stated without any averment of livery of seizin, or a bargain and sale without stating an enrollment, it is not a good cause of demurrer, but the court will intend it perfect.<sup>20</sup> As to the livery of seizin, it is far from being certain that if a feoffment is, in terms,

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<sup>16</sup> 1 M. & Selw. R. 234.

<sup>17</sup> 2 Shower R. 233.      <sup>18</sup> 7 T. Rep. 518.

<sup>19</sup> Cro. Jac. 44.

<sup>20</sup> *Harrison v. Hogg*, 2 Ves. Jr. 323, 328.

proved, it is necessary, even at law, to aver it, since it is implied.<sup>21</sup> Upon the whole, judgment must be entered for the plaintiff according to the verdict."<sup>22</sup>

6. As to the averment of the infringement, it is sufficient to allege it in as broad terms as the declaration, and the specification in the patent.<sup>23</sup>

One allegation is necessary in the declaration in England, which we omit; namely, that of the enrollment of the specification in the chancery office within the time prescribed in the letters-patent,<sup>24</sup> since no such subsequent enrollment is made with us, the specification being a part of the patent.

#### Sec. IV.—PLEA. DEFENCES. NOTICE OF DEFENCE.

In defence in an action for an infringement the defendant may deny that the patentee made the invention for which the letters-patent were granted, or that the invention was useful; that such letters-patent were granted; or allege defects in the specification; or deny that the letters-patent were assigned to the

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<sup>21</sup> See Co. Litt. 303—6; *Throckmorton v. Tracey*, Plowd. R. 149. See *Spieres v. Parker*, 1 T. R. 145, per Buller J.; 1 Saund. Rep. 228, a. Williams's note.

<sup>22</sup> *Dobson v. Campbell*, 1 Sumner's R. 319.

<sup>23</sup> *Cutting and others Exr's. of Fulton v. Myers*, Coxe's Dig. 531. S. C. 4 Wash. C. C. R. 220.

<sup>24</sup> 1 W. Saunders, 189, n. 2; and see *id.* 187, 271, and Saund. Pl. & Ev. 635.

plaintiff, if he brings his suit as assignee; or that the assignment is recorded; or that the patentee has infringed the patent right. If any of these grounds of defence appear in the declaration itself, the defendant may demur. Or if he does not demur, he may plead any of these defences specially, except the last; or he may plead the general issue, as usual in cases of this description,<sup>25</sup> and establish any of these grounds of defence by want of evidence on the part of the plaintiff, or by the evidence produced by himself.

If the defendant pleads specially that the patentee was *not the inventor*, he need not set out facts in his plea in support of it.<sup>26</sup>

The fifteenth section of the act of 1836 provides that the defendant, in an action for an infringement, shall be permitted to plead the general issue and to give this act and any matter in evidence, of which notice in writing may have been given to the plaintiff or his attorney thirty days before trial, tending to prove that the description and specification filed by the plaintiff does not contain the whole truth relative to his invention or discovery, or that it contains more than is necessary to produce the described effect; which concealment or addition shall appear to have been made for the purpose of deceiving the public; or that the patentee was not the original

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<sup>25</sup> Gods. Pat. 177.

<sup>26</sup> Evans v. Kremer, 1 Pet. C. C. R. 215.

and first inventor or discoverer of the thing patented, or of a substantial and material part thereof claimed as new ; or that it had been described in some public work anterior to the supposed discovery thereof by the patentee, or had been in public use, or on sale with the consent or allowance of the patentee before his application for a patent ; or that he had surreptitiously or unjustly obtained a patent for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same ; or that the patentee, if an alien at the time the patent was granted, had failed and neglected, for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reasonable terms, the invention or discovery for which the patent issued ; in either of which cases judgment shall be rendered for the defendant with costs ; provided, however, that whenever it shall satisfactorily appear that the patentee, at the time of making his application for the patent, believed himself to be the first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery or any part thereof having been before known or used in any foreign country, it not appearing that the same or any substantial part thereof had before been patented or described in any printed publication. By section eight, of the same act, it is provided “ that nothing in the act contained shall deprive the original and true



inventor of the right to a patent for his invention by reason of his having previously taken out letters-patent therefor in a foreign country, and the same having been published within six months next preceding the filing of his specification and drawings.”

The above provisions of the fifteenth section are mostly adopted from the sixth section of the act of 1793. In that act the provision as to surreptitiously obtaining a patent for the invention of another person, does not add “who was using reasonable diligence in adapting and perfecting the same;” so that, conversely and literally, this part of the act would read, that where a patentee has surreptitiously or unjustly obtained a patent for that which was invented or discovered by another, his patent shall nevertheless be valid, if that other is not using reasonable diligence in adapting and perfecting his invention. But by looking at the former part of the same section, we find that the patentee must be the “*original and first inventor.*” The construction of the two parts of the section taken together, is then, that if the patentee was the original inventor of the thing patented, his patent shall not be defeated by proof that another person had anticipated him in making the invention, unless it also be shown that such person was adapting and perfecting his invention. Or, in other words, if the patentee was an inventor of the thing patented, he shall not, in such case, be considered as having surreptitiously or

unjustly taken out a patent for what was invented by another.

A doubt early arose on the sixth section of the act of 1793, from which the preceding sections are mostly taken, whether any other defence could be made in an action for an infringement, grounded on objections to the novelty of the invention or on the defects in the specification, than those enumerated. That section contained one provision which is omitted in the substituted law of 1836, namely, that if the defendant made out either of the enumerated grounds of defence, not only judgment should be rendered for him with costs, but also "the patent should be declared void." The law of 1836 contains no provision for declaring the patent void as the result of an action for an infringement. The Supreme Court finally decided that the sixth section of the former law did not preclude the defendant from making any defence which he could have made had the act not contained the sixth section, and that he might make any of the defences enumerated in that section without giving the notice, the result being in such case also the same as if the law had not contained that section. The effect of the section was then merely that if the defendant, in an action for an infringement, desired to obtain a declaration that the patent was void, he must give the requisite notice of one of the enumerated grounds of defence, and, if it was made out, the court would declare the patent void.

The ground of defence in the action in which this decision was made, was that the specification did not contain a description of the invention in full, clear and exact terms; though the defect did not appear to have arisen from any intention to deceive the public. Marshall C. J. "Courts did not, perhaps, at first distinguish clearly between a defence which would authorize a verdict and judgment in favor of the defendant in the particular action, leaving the plaintiff free to use his patent, and to bring other suits for its infringement; and one which, if successful, would require the court, under the sixth section of the act, to enter a judgment not only for the defendant in the particular case, but one which declares the patent to be void. This distinction is now well settled. The sixth section is not understood to control the third. The evidence of fraudulent intent is required only in the particular case, and for the particular purpose stated in the sixth section. The act of Parliament concerning monopolies contains an exception on which the grants of patents for inventions have issued in that country. The construction of so much of that exception as connects the specification with the patent, and makes the validity of the latter dependent on the correctness of the former, is applicable, we think, to proceedings under the third section of the American act. The English books are full of cases in which it has been held, that a defective specification is a good bar when pleaded

to, or a sufficient defence when given in evidence on the general issue, on an action brought for the infringement of a patent right."<sup>27</sup>

The ground of a similar interpretation is taken away in the law of 1836, since it contains no provision for declaring the patent void in such an action. The question then comes up under that law, what is the construction and effect of the 15th section? One thing is plain, that it does not preclude all other defences than those enumerated, for it does not provide for the case of an obscure specification from which it is not practicable to say what was patented, and yet the defence must be admissible in such a case, first, because the plaintiff cannot recover for violating a privilege which is not intelligibly described, and so cannot be known; and second, because the sixth section of the same act requires that the patentee shall give a description in full, clear and exact terms, and the court cannot disregard this provision. The notion might be suggested that the commissioner is to decide conclusively on the sufficiency of the specification in this respect, and his making out the patent is a certificate of his decision. But this construction is by no means admissible or practicable, for neither the court or jury can say that a privilege is infringed, of which no intelligible description is given.

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<sup>27</sup> Grant v. Raymond, 6 Peters's S. C. R. 218.

It is another defence not enumerated, that the plaintiff is not assignee; or that his assignment is not recorded.

But what proves conclusively that all the admissible defences are not enumerated in this section of the law of 1836, is, that the defence that the defendant never made, used or sold the thing patented, is not enumerated.

If, then, the section does not preclude all other than the enumerated defences, what is its construction? We shall find an answer to this inquiry in the decisions on the sixth section of the act of 1793, the language of which, in respect to the particular question under consideration was similar, viz. the defendant "shall be permitted" to give in evidence on the general issue such and such grounds of defence, of which notice had been given to the plaintiff. On that section Mr. Chief Justice Marshall, giving the opinion of the court, said, "The 6th section of the act appears to be drawn on the idea that the defendant would not be at liberty to contest the validity of the patent on the general issue. It therefore intends to relieve the defendant from the difficulties of pleading, when it allows him to give in evidence matter which does affect the patent. But the notice is directed for the security of the plaintiff, and to protect him against that surprise to which he might be exposed, from an unfair use of this privilege. The notice is substituted for a special

plea; it is further to be observed, that it is a substitute to which the defendant is not obliged to resort. The notice is to be given only when it is intended to offer the special matter in evidence on the general issue. The defendant is not obliged to pursue this course. He may still plead specially, and then the plea is the only notice which the plaintiff can claim."<sup>28</sup>

So in a later case the same court says, "The defendant is permitted to proceed according to the sixth section, but is not prohibited from proceeding in the usual manner, so far as respects his defence; except that special matter may not be given in evidence on the general issue unaccompanied by the notice which the sixth section requires."<sup>29</sup>

The effect of the fifteenth section of the act of 1836, then, is, that in making the defences enumerated therein, the defendant must either plead specially or plead the general issue and give the notice required.

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<sup>28</sup> *Evans v. Eaton*, 3 *Wheaton*, 454; and see *Evans v. Kremer*, 1 *Pet. C. C. R.* 215, and 3 *Wheat.* 803, n.

<sup>29</sup> *Grant v. Raymond*, 6 *Pet. S. C. R.* 746.

CHAPTER XX.

*Evidence in an Action for an Infringement.*

- Sec. 1. *On the part of the Plaintiff.*  
2. *On the part of the Defendant.*  
3. *Admissibility of Witnesses.*

Sec. I.—ON THE PART OF THE PLAINTIFF.

WHERE the defendant pleads the usual plea of the general issue, the first evidence produced by the plaintiff, in an action for an infringement, is the patent and specification, and the assignment of the patent, if it be assigned. Certified copies of these from the patent office are made evidence.<sup>1</sup> In England the enrollment of the specification in due time must also be proved.<sup>2</sup>

Where the patent was for an improvement on a machine previously patented, Lord Tenterden ruled that the specifications of both inventions must be given in evidence. He said he would not say “what are improvements on a given thing without knowing what the thing was before.”<sup>3</sup> But this must cer-

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<sup>1</sup> Stat. of 1836, s. 4.

<sup>2</sup> *Watson v. Pears*, 2 Camp. R. 294.

<sup>3</sup> *Lewis v. Davis*, 3 C. and P. 502.

tainly depend upon the manner in which the specification of the improvement is drawn up. If it refer to the former specification, so as, in fact, to include and incorporate it in itself, in the same manner as American patents include the specifications, then such former specification should doubtless be produced ; but if the specification is sufficiently intelligible in itself, without recurring to the former one, there would not be the reason given by Lord Tenterden for requiring the production of the former specification.

Where an exemplification—that is, a certified copy under seal—of a patent is admissible, the statutes of 3d and 4th Ed. 6, c. 4, and 13 Eliz. c. 6, provide that an exemplification of only the part which is material, shall be necessary. But a mere extract is not admissible where it might operate as a surprise upon the opposite party, or deprive him of any benefit he might derive in case the whole were produced.<sup>4</sup>

The drawings, being a part of the specification, are produced in evidence with it.

In one case Mr. Justice Washington let unintelligible specifications and drawings—that is, those which he himself professed not to understand—go to the jury, that they might decide upon them for themselves.<sup>5</sup>

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<sup>4</sup> Attorney General v. Taylor, Prac. in Chan. 59 ; See Godson on Pat. 178.

<sup>5</sup> Gray & Osgood v. James & others, 1 Pet. C. C. R. 376.



The same judge ruled that an apparent ambiguity in the patent and specification might be cleared up by reference to the affidavit of the patentee at the time of taking out the patent.<sup>6</sup>

It is an established doctrine that divers valid patents cannot subsist for the same thing to different persons, or even to the same person.<sup>7</sup> The question then arises when divers patents are so issued, whether all, or only a part of them, are void, and if only a part, whether the first or last is in force. It was held in Massachusetts, where a machine was patented by one of two inventors, who at the time of taking out the patent supposed himself to be the sole inventor, and subsequently he joined the other in taking out a joint patent, that, as he had not assigned the first patent, being still proprietor of it, the joining in the second, was, in effect, a cancelling of the first.<sup>8</sup> In a case relating to the same invention, Mr. Justice Story held that a grant of a subsequent patent for an invention, is an estoppel to the patentee to set up any prior one for the same invention; and he adds, "I have very great doubts, whether, when a patent is once granted to any person for an invention, he can legally acquire any right under a subsequent patent for the same invention, unless his first patent be repealed for some original defect, so that

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<sup>6</sup> *Pettibone v. Derringer*, 4 Wash. C. C. R. 215, Coke's Dig. 532.

<sup>7</sup> *Barrett v. Hall*, 1 Mason's R. 429.

<sup>8</sup> *Stearns v. Barrett*, 1 Pick. R. 443.

it might truly be said to be a void patent.”<sup>9</sup> Accordingly, where the patentee has, without first surrendering his patent, taken out a second, either solely or jointly with another, on the fact appearing, he cannot avail himself of the first, if he can of either.

The question occurs whether the production of the patent proves any thing more than the fact of the grant of it, and whether the plaintiff must next proceed to prove his *right* to such a grant, by showing that the invention is his own, is new and useful, and that he has reduced it to practice. On this subject Mr. Justice Buller said, “I do not agree with the counsel who have argued that it was not necessary for the plaintiff to give any evidence to show what the invention was, and that the proof that the specification was improper lay on the defendant; for I hold that a plaintiff must give some evidence to show what his invention was, unless the other side admit that it has been tried and succeeds. He must show in what his invention consists, and that he produced the effect proposed by the patent in the manner specified. Slight evidence of this, on his part, is sufficient.”<sup>10</sup>

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<sup>9</sup> *Barrett & al. v. Hall & al.* 1 Mason’s R. 473.

<sup>10</sup> *Turner v. Winter*, 1 T. R. 606; and see *Gods. on Pat.* 178, who cites *Boville v. Moore*, *Dav. Pat. Cas.* 399, and *Manton v. Manton*, *id.* 348.

According to the practice in England, the inventor on petitioning for a patent, is required to make affidavit to his petition.<sup>11</sup> The act of Congress of 1836, s. 6, requires that the applicant for a patent shall make oath or affirmation that "he does verily believe that he is the original and first inventor or discoverer of the art, machine, composition or improvement for which he solicits a patent, and that he does not know or *believe* that the same was before known or used." The petition in the usual form in England alleges that the petitioner is the true and first inventor of the thing for which he solicits a patent, and that it has never before been used. Now both in England and the United States, this affidavit, where there is no conflicting claim, is the evidence on which the patent is granted. But according to Mr. Justice Buller, though it is evidence in the offices of the executive branch of government, it is not such in a court of justice, and the plaintiff must proceed to prove his case without any presumption in his favor.

In case of proceedings against the patentee for a repeal of the patent, under the act of 1793, s. 10, now repealed, Mr. Justice Story said: "In respect to the proof who was the inventor, the possession of the patent was *prima facie* evidence for the defend-

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<sup>11</sup> Gods. on Pat. 139.

ant, *at least upon this process ;*"<sup>12</sup> thus apparently implying a query whether the same presumption does not arise in favor of the patentee in other actions. But it is not a matter of great practical importance, whether such a presumption exists in favor of the patentee, since the slight *prima facie* evidence requisite may doubtless easily be obtained in support of any patent for which any possible pretence could be made out. The requisition by the law that the applicant shall make affidavit of a fact, seems to be a sufficient ground of presuming his affidavit to be true until the contrary is shown.

The fact of the novelty of the machine or method is not, as has already been suggested, necessarily involved in, and does not necessarily follow from, that of its invention by the patentee, for the same thing may be invented by different persons independently of each other. Proof, therefore, that the patentee invented the thing, does not, of itself, conclusively establish its novelty. Under the former law, the applicant, in the United States, only made affidavit of the invention, not that the thing was before unknown, as in England.

According to the course of proceeding in a case before Mr. Justice Washington, it was assumed that

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<sup>12</sup> *Stearns v. Barrett*, 1 Mason's R. 153.

the patent was not, itself, *prima facie* evidence of the novelty, for he ruled that a statement by a witness, that he had not seen or heard of the manufacture before he saw it at the workshop of the patentees, was sufficient evidence of the novelty, until it was contradicted.<sup>13</sup> This was assuming that the plaintiff must, in the first instance, give evidence of the novelty, for, otherwise, the whole evidence would have been superfluous ; so there would have been no question as to its sufficiency. This doctrine is also assumed as matter of practice in another case before the same judge.<sup>14</sup> By the law of 1836, the applicant makes oath as to the novelty of the invention, so that if the patent is *prima facie* evidence that the patentee was the inventor, it might be so of the novelty of the invention.

It is sufficient if it appear that the thing patented had not been known or used *before the invention* by the patentee; as distinguished from the *time of his application* for a patent.<sup>15</sup>

As to delay to take out a patent, and the extent to which the machine may have got into use in the meantime, this may raise the question of an aban-

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<sup>13</sup> *Pennock and Sellers v. Dialogue*, 4 Wash. C. C. R. 538.

<sup>14</sup> *Dixon v. Moyer*, 4 Wash. C. C. R. 68.

<sup>15</sup> *Supra.* p. 152; *Treadwell and Watson v. Bladen*, 4 Wash. C. C. R. 708; *Evans v. Weiss*, 2 Wash. C. C. R. 342; *Goodyear v. Matthews*, 1 Paine's R. 348; 1 Gallison's R. 438; *Dixon v. Moyer*, 4 Wash. C. C. R. 68.

donment of the invention by the inventor, and his dedication of it to the public, and it is not incumbent on the plaintiff to prove, in the first instance, that he has not abandoned or so dedicated his invention, unless he incurs that burthen by incidentally proving such delay, or other circumstances, as require explanation in order to rebut the inference of such an abandonment and dedication.

Under the act of congress of 1836, the citizenship of the patentee is material only in relation to the amount of the fee he is liable to pay ; and as the payment of the fee is a matter which the court does not take into consideration, this being subject to the superintendence of the executive officer who issues the patent,<sup>16</sup> it seems to follow that no evidence of citizenship need be given by the plaintiff.

The fact of the grant and its extent are proved by the production of the patent. It was contended in one case that where the invention is described in the affidavit of the patentee, he will be limited to the invention so described, however extensive may be his specification ; but this point was not decided by Mr. Justice Washington, before whom the case was pending, who only decided that the affidavit might be resorted to for an explanation of the ambiguity in the

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<sup>16</sup> *Whittemore v. Cutter*, 1 Gall. R. 429.

patent, and this met the object of the defendant.<sup>17</sup> But the position assumed by the defendant in that case, seems not be tenable, for though ambiguities in the patent, of some descriptions, at least, may be cleared up by evidence *aliunde*, this is quite a different thing from holding that the obvious construction and meaning of the instrument may be controlled by such evidence.

The specification will, generally, also show *prima facie*, whether it is sufficient or defective.

The utility, as distinguished from the frivolity or perniciousness, and legality of the invention, will also, generally, appear from the specification.

The invention must be proved to have been reduced to practice;<sup>18</sup> and the plaintiff must show that it effects what the specification professes. In a case that occurred in the English court of Common Pleas in 1834, this is confounded with the utility of the invention. It was the case of a patent for a machine for spreading calicoes to be dried, and taking them up when dried. It was proved by the plaintiff that it would spread and take up calicoes, excepting those stiffened with clay for deceptive purposes. The jury found that it was "not useful in some cases for taking up goods;" meaning, as it seems, that it would not

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<sup>17</sup> *Rattibone v. Derringer*, 4 Wash. C. C. R. 215.

<sup>18</sup> *Supra.* ch. vii. s. 8; see also *Evans v. Eaton*, 1 Pet. C. C. R. 341.

take them up. Tindal J. "We think we are not warranted in drawing so strict a conclusion from this finding of the jury, as to hold that they have intended to negative, or that they have hereby negatived, that the machine was useful in the generality of cases which occur for that purpose. If the jury think it useful in general, because some cases occur in which it does not answer, we think it would be much too strong a conclusion to hold the patent void."<sup>19</sup>

Finally, to make out his case, the plaintiff must prove an infringement, in respect to which, the presumptions are in favor of the defendant. What is an infringement has been already considered.<sup>20</sup>

A patent right cannot be infringed until after the grant of the patent ; it is, therefore, necessary to prove acts of infringement done subsequently to its date.<sup>21</sup>

It must be proved that the defendant has made, used or sold the *same* machine, or other subject for which the plaintiff has a patent. It is not enough that he has sold one that merely resembles it. The law does not require proof that it is precisely the same in form and proportions ; it is sufficient if the distinguishing characteristics are the same.<sup>22</sup> "Machines are the same," says Mr. Justice Washington,

<sup>19</sup> Howorth v. Hardcastle, 1 Bing. N. R. 182.

<sup>20</sup> Supra. c. xvii.

<sup>21</sup> Dixon v. Moyer, 4 Wash. C. C. R. 68 ; S. C. Coxe's Dig. 583.

<sup>22</sup> Dixon v. Moyer, 4 Wash. C. C. R. 68 ; S. C. Coxe's Dig. 532.



“if they operate in the same manner, and produce the same results, upon the same principles.”<sup>23</sup>

It is upon this question of identity that patent cases very often turn. But as to the results, the most perfect similarity of products is not alone sufficient to establish the identity, since precisely similar products may be made by different machines and different processes. But where the products were precisely similar, Lord Tenterden ruled that this circumstance, taken together with acts of the defendant, may be ground to presume that the machines are the same, as where the defendant refused to permit his manufactory to be inspected.<sup>24</sup> In an action for an infringement of a patent for making ropes, in which it was proved that those of the defendant precisely resembled those made by the plaintiff's method, and that the defendant had refused to permit his manufactory to be examined for the purpose of furnishing evidence in the case, Lord Ellenborough remarked to the jury, “when one sees the rope of the defendant agree, in all its qualities, with a rope actually made upon the plaintiff's plan, it is *prima facie* evidence, till the contrary is shewn, that it was made upon his method.”<sup>25</sup>

On this question the machines themselves, or re-

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<sup>23</sup> Gray and Osgood v. James, 1 Pet. C. C. R. 394.

<sup>24</sup> Hall v. Gervas and Boot, Gods. sup. 67.

<sup>25</sup> Huddart v. Grimshaw, Dav. Pat. Cas. 288.

duced models of them, are most frequently produced in court, so that the jury may themselves determine by inspection, whether they are the same, or different. In England the practice has been, in some cases, first to apply to a court of equity to appoint persons to inspect the manufactories, in order to prove the identity of the machines or processes.<sup>26</sup> The Circuit Court of the United States is presumed to have authority under the general equity powers given by the act of 1836, to appoint commissioners for the inspection of manufactories in a patent cause, on the application of a party for that purpose, where it should be made to appear that a comparison of the manufactures could not be satisfactorily made by models or samples, or other testimony. No instance has, however, been reported of the appointment of persons for this purpose, by our courts.

It is a frequent practice to call in witnesses skilled in the art or manufacture to which the invention relates, to testify as to the identity or diversity of the machines or methods in question. On this practice Mr. Justice Story remarks: "As to the opinion of skilful witnesses, whether the principles of two machines are the same, no person doubts that it is competent evidence to be introduced into a patent cause. But although the testimony of witnesses be admis-

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<sup>26</sup> *Bovil v. Moore*, Dav. Pat. Cas. 361, 182.

sible to prove the identity or diversity of machines in principle, yet after all it is but matter of opinion, and its weight must be judged of by all the other circumstances of the case. It is infinitely more satisfactory to ascertain, if we can, the precise differences and agreements ; and, when these can be subjected to the eyes, they almost supersede all the evidence of mere opinion. In all my experience, I can scarcely recollect a single instance, in which the general question, whether the principles of two machines were the same, or different, has not produced from different witnesses, equally credible and equally intelligent, opposite answers. This would result only from the different meanings attached to the word, and from confounding its various senses. And this has been completely shown, when the same witnesses came to explain the precise agreements and differences, in which they have almost uniformly agreed. The case now before the court is a perfect proof in point. The witnesses differed as to the identity or diversity of the principles of the machines, but they all agreed in what were the precise differences and agreements in fact. There seemed, then, nothing left for the jury to decide, but whether these differences were substantial or formal ; if substantial, then the machines were not alike ; if formal only, then they were alike. And the question, whether the principles were the same in both machines, was, in reality, when all the facts were given,

rather a matter of law, than of the opinion of mechanics; at least matter of law was necessarily mixed up with it, which mechanics could not be presumed to be acquainted with.’<sup>27</sup>

So Mr. Justice Washington remarks, that the opinions of such witnesses, in relation to the materiality of apparent differences, are always entitled to great respect, but that, after all, “the jury must judge for themselves, as well upon the information given, as upon their own view, where the articles, or models of them, are brought into court.”<sup>28</sup>

## Sec. II.—ON THE PART OF THE DEFENDANT.

The defendant, in action for an infringement, must, under the general issue, if the plaintiff has made out a *prima facie* case, show, either that the plaintiff is not entitled to an exclusive privilege claimed, or that he has not violated it. The essential requisites to the validity of the patent, have already been stated in the preceding chapters, and it is unnecessary to enumerate them here. If the defendant can render the plaintiff’s title defective in any of these, the action for an infringement must fail; for there can be no violation of a privilege which is shown not to exist.

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<sup>27</sup> *Barrett v. Hall*, 1 Mason, 470, 471.

<sup>28</sup> *Dixon v. Moyer*, 4 Wash. C. C. R. 68.

On the subject of the novelty of the invention, if this is contested, the evidence must come mostly from the defendant, since that introduced by the plaintiff is necessarily of a negative character; and Sir Vicary Gibbs, C. J. says “fifty witnesses, testifying that they never saw the invention before, would be of no avail, if one were called who had seen it and practised it.”<sup>29</sup>

This rule of evidence has, it seems, been subject to abuse in England by means of perjury. In the course of the examination, before the committee of the House of Commons, in 1829,<sup>30</sup> on the subject of patents, Mr. Benjamin Rotch makes a very striking statement as to the subornation of witnesses in trials of patent causes in England. He is objecting to the rule of law whereby a patent is held to be void if the alleged invention, or any part of it, had ever been known or practised at any former period, though dropped from use and not publicly known at the time of the new invention. He says he found, from experience, that the result of this rule is, that “if a clothier in the west of England has a patent, one single man is called from the north of England, who comes down into court, and having read the man’s specification, stands up like a parrot, and will

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<sup>29</sup> *Manton v. Manton*, Dav. Pat. Cas. 250.

<sup>30</sup> P. 114.

be found to swear, fourteen or twenty years ago, I did so and so, and so and so, exactly verbatim, repeating the specification ; the patent is upset ; nobody can provide against such evidence as that : and I do not hesitate to say there is more perjury in that one particular than could be believed by a committee who have not experienced what we have. It is always the interest of the whole trade against the patentee combined ; they combine their money in the first place, and then fight away and procure witnesses at any rate.” Mr. John Farey, in his affidavit, reported by the same committee,<sup>51</sup> states that Durivel’s patent, though his invention was a good one, was defeated by the testimony of one witness.

Mr. Justice Johnson was of opinion that such testimony may be rebutted by circumstantial evidence. In a case for an infringement of Whitney’s patent for his cotton-gin, to prove that it was known before the invention by the patentee, two witnesses were produced, one of whom testified that he had seen a similar machine in England, seventeen years before, called a “teazor or devil ;” the other testified that he had seen a similar machine in Ireland. Upon this point Mr. Justice Johnson remarked : “There are circumstances within the knowledge of all mankind, which prove the originality of this invention

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<sup>51</sup> P. 211.

more satisfactorily to the mind, than the direct testimony of a host of witnesses. The cotton plant furnished clothing to mankind before the age of Herodotus. The green seed is a species much more productive than the black, and by nature adapted to a much greater variety of climate ; but by reason of the strong adherence of the fibre to the seed, without the aid of some more powerful machine for separating it, than any formerly known among us, the cultivation of it could never have been made an object. The machine, of which Mr. Whitney claims the invention, so facilitates the preparation of this species for use, that the cultivation of it has suddenly become an object of infinitely greater importance than that of the other species ever can be. Is it then to be imagined that, if this machine had been before discovered, the use of it would ever have been lost, or could have been confined to any tract of country left unexplored by commercial enterprise?"<sup>32</sup>

The provision in the act of Parliament, 5 and 6 W. 4, c. 83, s. 5, that in an action for an infringement, the defendant shall give notice of the objections to the patent which he intends to rely on at the trial, was intended probably to remedy such abuses. But the provision of the act of Congress of 1836, s. 15, is more effectual to prevent any such abuse, namely,

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<sup>32</sup> *Whitney v. Fort*, 1807; *Fessenden on Patents*, Ed. 1822, p. 134.

that “ whenever the defendant relies, in his defence, on the fact of a previous invention, knowledge or use of the thing patented, he shall state in his notice the names and places of residence of those whom he intends to prove to have possessed a prior knowledge of the thing and where the same had been used.” This notice enables the plaintiff to obtain counter evidence.

The novelty of an invention does not, as we have seen, depend merely upon the conception of it; for it is not considered to be an invention until it has been reduced to practice, and it is a sufficient ground of defence that it was not first reduced to practice by the patentee,<sup>33</sup> or that another had reduced it to practice before the patentee, as in the case of a bleaching process which was proved to have been practised by another six years before the patentee took out his patent.<sup>34</sup> And accordingly, conversely, it is no defence that another was the prior inventor, if he did not reduce the invention to use;<sup>35</sup> or, under the act of Congress of 1836, s. 15, if such other was not using due diligence in adapting and perfecting it. And evidence that the plaintiff’s patent was for an invention made by a journeyman in his shop, with his consent, was held by Mr. Justice Washington not to be proof that the patent was *surreptitiously*

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<sup>33</sup> *Woodcock v. Parker et al.* 1 Gall. R. 436.

<sup>34</sup> *Tenant’s case*, Dav. Pat. Cas. 429.

<sup>35</sup> *Pennock and Sellers v. Dialogue*, 4 Wash. C. C. R. 538.



obtained for the invention of another.<sup>36</sup> But such evidence is doubtless a good defence against a claim for damages for an infringement.

According to Lord Eldon's suggestion in one case, it is to no purpose for the defendant to prove a prior invention by another; for he says, in case of concurrent applications, "I can see no other mode of deciding than by awarding the patent to him who runs the quickest through the process."<sup>37</sup> But in the United States a prior invention by any one in the United States is a good defence, if such other is using due diligence to obtain a patent; but by the law of 1836, s. 1, proof of a prior invention in any foreign country where the invention has not been patented nor described in any public work, is not a good defence.

It is not a ground of defence that the patentee availed himself of the suggestions of another, unless they go to an essential part of the invention.<sup>38</sup> So it is a good defence that the invention itself was pre-

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<sup>36</sup> *Dixon v. Mayor*, 4 Wash. C. C. R. 68.

<sup>37</sup> *Dyer ex parte*, Rep. of Committee of House of Com. 1829, App. B. p. 197, Mr. Farey's Papers; and see *Forsyth v. Reviere*, Chit. Praer. of the Cr. 182. Under the French law, priority is determined by the date of the deposit of the specification. Rep. of Comm. of House of Com. 1829, p. 231.

<sup>38</sup> *Pennock and Sellers v. Dialogue*, 4 Wash. C. C. R. 578. In this case the doctrine on the effect of a suggestion by another is laid down in stronger terms than stated above in the text; but I apprehend that the inventor cannot claim a patent for any thing suggested by another, further than is stated in the text.

viously known, and was only used by the patentee to yield a product from a different material;<sup>39</sup> this is, in one sense, a new result, but it is not a good defence to show that it merely produced a new result, if by result be meant mode of operation or difference of process.<sup>40</sup> M. Perpigna<sup>41</sup> considers new proportions and a new result a good subject of a patent in France; but this ought to depend on the proportions being a material part of the process,<sup>42</sup> for these may constitute the principle of the invention.<sup>43</sup>

So the defendant may prove in defence a subsequent patent by the same patentee, either solely or jointly with another, for the whole or a part of the same invention.

Where a patent was taken out for five things, and subsequently by the same patentee and another for three of them, Mr. Justice Washington seemed to think the second patent a disclaimer of the first, so that the patentee could not recover for an infringement of it.<sup>44</sup> He supposes no surrender to have been made of the first; and so the position is that a

<sup>39</sup> *Supra*, Ch. VII. s. VII.; Perpigna, p. 30.

<sup>40</sup> *Pennock and Sellers v. Dialogue*, 4 Wash. C. C. R. 438.

<sup>41</sup> Published in the Law Library, p. 29; English translation, p. 183.

<sup>42</sup> See *supra*, p. 134, Ch. VII. s. XII.

<sup>43</sup> Rep. of Comm. of House of Com. 1829, p. 732.

<sup>44</sup> *Treadwell and Watson v. Bladen*, 4 Wash. C. C. R. 709.

second patent for the same or a part of the same thing extinguishes the first.<sup>45</sup>

It has been said that different inventions cannot be joined in the same patent,<sup>46</sup> and if so, their being so joined will be ground of defence on the face of the patent itself.

So it is a decisive objection that the invention is unlawful<sup>47</sup> or pernicious.

It is a good ground of defence that the alleged invention is too slight a change to be the subject for a patent, as where by the former practice a roll of cloth was dipped in hot water, and this was the immersing it in steam.<sup>48</sup> But a substitution of gas flame for that of charcoal or paper was held a good subject for a patent. By Hall's patent, cotton fibres were singed from lace by carrying a gas flame by a current of air through the lace. Lace had previously been singed by the flames of charcoal or paper, the lace being stretched on a board or boot. The invention consisted in applying gas flame, in carrying the flame in a current of air, and in passing it *through* instead of *over* the lace. Abbott C. J. ruled the invention to be sufficient.<sup>49</sup>

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<sup>45</sup> See *Morris v. Huntington*, 1 Paine's R. 348.

<sup>46</sup> *Moody v. Fiske*, 2 Mason's R. 112.

<sup>47</sup> *Supra*, Ch. VII. s. XII. p. 128.

<sup>48</sup> *The King v. Russell*, Rep. of Committee of House of Commons, 1829, p. 211.

<sup>49</sup> *Hall and Jervas v. Boot*, Rep. of Com. of H. of Com. 1829, p. 208, App. Mr. Farey's Papers.

The patent is invalid where the patentee, although he may have proved himself to be the inventor, had abandoned his invention and dedicated it to the public before taking out his patent.<sup>50</sup> It is immaterial how the invention came to the knowledge and use of the public, whether by consent of the inventor or by piracy; in either case, if he does not, in reasonable time, take out a patent, but, on the contrary, looks on and acquiesces in the use of his invention by the public, his patent subsequently taken out is void.<sup>51</sup> And he is presumed to acquiesce where he knows or might know of the public use.<sup>52</sup> So if it was on sale with the allowance of the patentee before his application for the patent.<sup>53</sup>

The public use with the acquiescence of the inventor under a prior patent, does not avoid his second patent when the prior one has been surrendered.<sup>54</sup>

The use of a machine prior to the date of the patent having been proved, by the defendant, the plaintiff may show that it was by his license.

In an action for the infringement of a patent, in

<sup>50</sup> See *supra*, Ch. VII. s. XIX. See also *Pennock and Sellers v. Dialogue*, 4 Wash. C. C. R. 544; *Treadwell and Watson v. Bladen*, 4 Wash. C. C. R. 708.

<sup>51</sup> *Shaw v. Cooper*, 7 Pet. S. C. R. 292.

<sup>52</sup> S. C. and see *Whittemore v. Cutter*, 1 Gall. R. 482. Act of 1836, c. 357, s. 6.

<sup>53</sup> Act of Congress, 1836, c. 377 s. 15.

<sup>54</sup> *Morris v. Huntington*, 1 Paine's R. 345; *Shaw v. Cooper*, 7 Wheat. 292; and see 4 Mason's R. 108; 4 Wash. C. C. R. 438, 703.

the Circuit Court for Pennsylvania, the defendant proved that the patented machine had been in use previously to the alleged invention by the plaintiff. The plaintiff then offered to prove that the persons, of whose prior use of the machine the defendant had given testimony, had paid the plaintiff for licenses to use the machine since his patent. This testimony was rejected by the Circuit Court, and the plaintiff thereupon excepted. Marshall C. J. "The testimony offered by the plaintiff was entitled to very little weight, but ought not to have been absolutely rejected. Connected with other testimony, and under some circumstances, even the opinion of a party may be worth something. It is, therefore, in such a case as this, deemed more safe to permit it to go to the jury, subject, as all testimony is, to the animadversion of the court, than entirely to exclude it."<sup>55</sup>

Whether mere delay of the inventor to take out a patent, without any acquiescence on his part in the public use of his invention in the mean time, or without any use or knowledge of it on the part of public in the mean time, is a good ground of defence, is a question on which the cases do not perfectly agree.<sup>56</sup> It is no objection that the inventor took reasonable time to perfect his invention; but some

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<sup>55</sup> *Evans v. Eaton*, 3 Wheaton, 451.

<sup>56</sup> See *supra*, Ch. VII. s. XIX.

cases go much further than this,<sup>57</sup> and consider a use for six or seven years by the inventor himself as no forfeiture of his right to a patent, but this doctrine is very questionable, as already suggested.<sup>58</sup>

A judgment in favor of the patent in a former case for an infringement is not, in a subsequent action for an infringement of the same patent, any estoppel on the defendant against the defence that the patent is void.

Nor is an award of examiners, under the act of 1836, s. 7, in favor of one of the applicants, any estoppel on the other applicant or any other person against contesting the patent.<sup>59</sup> But it has been held that the defendant, in an action against him for infringing a patent which he himself had assigned to the plaintiff, is estopped from giving evidence to prove that the invention was not new.<sup>60</sup>

A material defect in the specification is a ground of defence, whether designed or accidental.<sup>61</sup> Mr. Justice Thompson is reported to have stated, in one case, that specifying the whole machine in a patent for an improvement, does not prevent the patent

<sup>57</sup> *Morris v. Huntington*, 1 Paine's R. 354; *Goodyear v. Mathews*, 1 Paine's R. 301.

<sup>58</sup> *Infra*, Ch. XXIII.

<sup>59</sup> Act of 1836, s. 12; and see remarks of Mr. Justice Story, speaking of the similar provision of the act of 1793. *Stearns v. Barrett*, 1 Mason's R. 174.

<sup>60</sup> *Oldham v. Longmead*, cited 3 T. R. 439, 441.

<sup>61</sup> *Supra*. Ch. XVII. *Rese v. Cutler*, 1 Stark. R. 354.

from being good for the improvement, though it is not distinguished.<sup>62</sup> But the cases seem to be otherwise. The act of congress of 1836, s. 15, in enumerating the defences which may be given under the general issue with notice, does not mention the obscurity or ambiguity, or other defect of the specification through mistake, but the sixth section requires that the specification shall give a description "in full, clear and exact terms," which provision would have no force, if the patentee could recover for an infringement, notwithstanding he had not given such a description, through inadvertency or mistake.

What degree of evidence ought to be required to prove a fraudulent concealment by the patentee in the specification, must rest with the jury to decide. Positive evidence seldom is expected, nor is it necessary. The law requires that such intention should fully appear, but still it may be presumed from circumstances, as if the parts concealed are so essential and so obviously necessary to be disclosed, that no mechanic, skilled in the art, could reasonably be expected to understand the subject, so as from the description given to make the machine, it would be difficult to impute the omission of the patentee to a fair motive.<sup>63</sup>

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<sup>62</sup> *Goodyear v. Mathews*, 1 Paine, 300.

<sup>63</sup> Per Washington J. *Gray and Osgood v. James and others*, 1 Pet. C. C. R. 196, p. 402.

Mr. Justice Johnson, at first, entertained the same opinion with other judges of the Supreme Court,<sup>64</sup> that the patent was not defeated by a concealment in the specification made through mistake.<sup>65</sup>

In a case before Mr. Justice Washington, in 1817, he doubted whether the defendant could, under the general issue, give evidence that the invention was not useful.<sup>66</sup> The ground of his doubt was, that it would be a surprise upon the plaintiff. But no such doubt is intimated in any other case, and it is not apparent that this would be any more a matter of surprise than any other defence that should attack the validity of the patent, and that other defences having that bearing, may be resorted to, is matter of daily practice.<sup>67</sup>

Mr. Justice Washington remarked, in the case first cited, that this defence that the invention was not useful, came with an ill grace from a defendant who was using it.<sup>68</sup> But it is admissible, and its weight is left to the jury.<sup>69</sup>

On the question whether mere delay to take out a patent, may invalidate it, Mr. Justice Washington remarks : “ It is possible that, without any public

<sup>64</sup> *Supra*, Ch. XI. s. X.

<sup>65</sup> *Whitney v. Carter*, 1807, *Fessenden on Pat.*, Ed. 1822, p. 139.

<sup>66</sup> *Gray and Osgood v. James and others*, 1 Pet. C. C. R. 403.

<sup>67</sup> See *Langdon v. De Groot*, 1 Paine, 203.

<sup>68</sup> *Gray and Osgood v. James and others*, 1 Pet. C. C. R. 403; and see *supra*, p. 140.

<sup>69</sup> *Langdon v. De Groot*, 1 Paine, 203; *Howorth v. Hardcastle*, 1 Bing. N. R. 182.



use by others, an unreasonable and causeless, or faulty delay in taking out his patent, might be justly, and upon legal principles, considered as amounting to an abandonment; as to which, however, I avoid giving an opinion."<sup>70</sup>

But, as we have seen, mere delay for the purpose of making an experiment of the invention, will not invalidate the patent,<sup>71</sup> on the defence being urged that the invention had been practised by the inventor, and by another person, before application was made for the patent; Mr. Justice Washington remarked, "If there be any solidity in this argument, the patent law would very nearly become a dead letter, as every inventor uses the machine he invents before he applies for a patent, with a view to satisfy himself whether it answers the purpose for which it was intended."<sup>72</sup> If any doubts existed on this subject before the act of 1836, that act settles them, since the fifteenth section distinctly recognises the right of the inventor to take sufficient time to adapt and perfect his invention, or in other words, to bring it to bear, before taking out his patent.

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<sup>70</sup> *Treadwell and Watson v. Bladen*, 4 Wash. C. C. R. 708. Vide *supra*, Ch. VII. s. XIX.

<sup>71</sup> Ch. VII. s. XIX.

<sup>72</sup> *Treadwell and Watson v. Bladen*, Wash. C. C. R. 707.

Sec. III.—ADMISSIBILITY OF WITNESSES AND TESTIMONY.

It is held that persons who have used the machine for which the patent is taken out, are not thereby rendered incompetent as witnesses, on account of interest ; even where the object of the defence was not merely to defeat the claim for damages, but also to have the patent declared void.<sup>73</sup>

A witness, being patentee in another patent, had sold to the defendant the right to use the machine, the use of which was complained of as an infringement ; held that he was a competent witness notwithstanding, since any verdict that the plaintiff might recover, could not be given in evidence by the plaintiff in a suit against the witness.<sup>74</sup>

On a *scire facias* to repeal a patent for a machine, for the roving, preparing and spinning of wool, on the ground that it was not new ; a witness testified that he had long before the patent, constructed a machine for the same purposes ; and to show that it was similar to the defendant's machine, the counsel for the prosecution put into the hands of the witness a drawing of the machine constructed by him ; the drawing, however, was not made by the witness. It

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<sup>73</sup> *Evans v. Eaton*, 7 Wheat. R. 356 ; *Evans v. Hettich*, 7 Wheat. R. 453.

<sup>74</sup> *Treadwell and Watson v. Bladen*, 4 Wash. C. C. R. 704.

was objected that he ought not to look at it, but should describe the machine he had constructed. Bayley J. "I think the witness may look at the drawing, and you may ask him whether he has such a recollection of the machine he made, as to be able to say that that is a correct drawing of it."<sup>75</sup>

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## CHAPTER XXI.

### *Law and Fact.*

**T**HERE is nothing peculiar to patent causes as distinguishing them from others, as to the respective provinces of the court and jury.

It is a general rule, applicable in trials of actions for the infringement of patents, as well as in other trials, that the construction of a written instrument, is matter for the court, as far as the construction is to be determined by the instrument itself, or by a reference to statutes and principles of law merely, but the meaning of particular words and phrases, as governed by custom, is matter of fact for the jury. This rule applies to the patent and specification.<sup>1</sup>

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<sup>75</sup> *Rex v. Hadden*, 2 Car. and P. 184.

<sup>1</sup> *The King v. Whecler*, 2 B. & A. 348.

Accordingly, where the inquiry is whether the invention be sufficiently described in the specification, where it can be decided only by an examination of the machine, this is a question for the jury.<sup>2</sup> But if the question be, whether the specification is susceptible of any sensible construction, there being no dispute about the meaning of the words and phrases, it should seem to be a matter for the determination of the court, since the court must decide on a construction, and it seems to follow that they must decide whether the instrument admits of any sensible construction. Whether the invention be described with reasonable certainty was accordingly ruled by Mr. Justice Story to be for the court.<sup>3</sup> Though Lord Eldon intimates that the question of the intelligibility of the specification is for the jury.<sup>4</sup> And Mr. Justice Washington, in a case where he professed that he could make no sense of the specification and drawings, submitted them to the jury, to make what they could of them.<sup>5</sup>

Whether a specification be so clear and full, as to enable a person of ordinary skill in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound and use the same, is a question of fact ;<sup>6</sup> since what is, or is not

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<sup>2</sup> *Evans v. Eaton*, 7 Wheat. 428.

<sup>3</sup> 1 Mason's R. 190.

<sup>4</sup> *Hill v. Thompson*, 3 Meriv. 630.

<sup>5</sup> *Gray and Osgood v. James*, 1 Pet. C. C. R. 400.

<sup>6</sup> Per Story J. *Lowell v. Lewis*, 1 Mason, 190.

ordinary skill, is so. But this is a different question from that whether the language in connexion with the drawings and other helps to the meaning which it is allowable to resort to, such as dictionaries and the common usage, is sense or nonsense.

The question of infringement or no infringement is generally, if not invariably, for the jury.<sup>7</sup> Whether the patentee is the inventor of any part, or of the whole machine, is matter of fact ;<sup>8</sup> and the jury must, accordingly, determine on the identity of the machine with, or its diversity from, one before known.<sup>9</sup> So Mr. Justice Story ruled that “whether the principles of a machine are altogether new, or whether the machine be an improvement only, on those which have been in use before the invention, is a question for the jury to decide.”<sup>10</sup>

In an action for an infringement of a patent for an improvement in the construction of pumps, Mr. Justice Story held that the question, whether the differences between the pumps constructed by the plaintiff, and those by the defendant, were mere change of form, without any material alteration in the structure, or whether they were substantially

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<sup>7</sup> *Boulton v. Bull*, 2 H. Bl. 4.

<sup>8</sup> *Whittemore v. Cutter*, 1 Gallis. 478.

<sup>9</sup> *Pennock and Sellers v. Dialogue*, 4 Wash. C. C. R. 538.

<sup>10</sup> *Whittemore v. Cutter*, 1 Gallison, 478.

different combinations of mechanical parts, to effect the same purposes, was a question of fact.<sup>11</sup>

But in a case before Lord Wynford for an infringement of Barton's patent for an improvement in metallic pistons of steam-engines, the court took upon itself to decide that the pistons, which were alleged to be infringements, were not the same invention as that described in the plaintiff's specification.<sup>12</sup> The doctrine of this case is directly inconsistent with that of those above cited.

Whether the invention be useful, has been held, in some cases, to be for the court, in others for the jury. It must depend upon the ground upon which the utility is impeached; if upon the ground that the specification itself, without going further, shows that the invention is against law or good morals, the court decides the question. Mr. Justice Livingston says that, "where it becomes a matter of inquiry whether the benefits of an invention are of sufficient consequence to be protected by the arm of the government, it may be proper to leave such question with the jury. But where the objection raised is, that the invention, on the plaintiff's own showing, is not only of no use, but an imposition on the public, it may be doubted whether a court transcends its

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<sup>11</sup> *Lowell v. Lewis*, 1 Mason, 191.

<sup>12</sup> *Barton v. Hale*, Godson's Supplement, p. 65.

prescribed limits, in taking upon itself a decision of it."<sup>13</sup> The word *imposition* is of doubtful signification as applied to the case under consideration, which was that of a patent for a particular mode of winding cotton thread in balls, and wrapping them, not for the method or process, but for the disposition of the thread in the balls, and the form of wrapping, things which could not, it is evident, like a new composition of matter, be patentable. Admitting that the patentee might have obtained a valid patent for his method or process, he certainly could not for the result, so as to exclude others from effecting the same thing by a different method or process. The patent was, therefore, void, as being for a subject not patentable. But this is not the imposition intended by the judge. If the patentee wound the balls full of interstices by means of crossing the threads so as to make a larger ball of the same quantity, and wrapped the balls in a way to strike the fancy of purchasers, and deceive them with their eyes open, this was a kind of imposition, if such it may be called, which is daily practised in shops and manufactories. It would be going very far to set the patent aside as not being useful on account of its fraudulent character. But the court seemed to view the method or invention, or whatever the subject of this patent is

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<sup>13</sup> Langdon v. De Groot, 1 Paine, 203

to be denominated, in this light, and thus considered it to be a question for the court. The decision, in this view, seems to be very questionable.

But the method might be considered to be too frivolous to be the subject of a patent, and so liable to the objection that it was not useful in this sense of utility, as distinguished from frivolousness. But in this construction, also, it seems rather to have been a question for the jury.

Lord Eldon considers the question of the utility of the invention to belong to the jury.<sup>14</sup>

Lord Eldon considers the question, whether the patent covers too much, to be for the court.<sup>15</sup> But he must have had in his mind the case of its appearing from the specification and patent, that the patentee claimed too much, as where he describes an old machine and his improvement, and claims the whole machine as thus improved ; but if it be necessary to go out of the patent for proof of what was known before, this plainly presents a question for the jury.

It was a question much discussed whether the process for the repeal of a patent under the tenth section of the law of 1793, was to be adjudicated upon by the court alone, or by jury trial ; and after a full

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<sup>14</sup> Hill v. Thompson, 3 Meriv. 632.

<sup>15</sup> Hill v. Thompson, 3 Meriv. 630.



discussion, the decision was in favor of a trial by jury.<sup>16</sup> This decision is highly approved by Mr. Chancellor Kent.<sup>17</sup>

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## CHAPTER XXII.

### *Damages.*

By the act of 1800, in case of an infringement, the jury were to assess the actual damages and these were trebled by the court.<sup>1</sup>

By the act of 1836, s. 14, it is provided, "that whenever, in any action for damages for using or selling the thing whereof the exclusive right is secured by any patent heretofore granted, or which shall hereafter be granted, a verdict shall be rendered for the plaintiff in such action, it shall be in the power of the court to render judgment for any sum above

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<sup>16</sup> *Ex parte, Wood*, 9 Wheat. 603.

<sup>17</sup> *Com. v. 1*, p. 381.

<sup>1</sup> See *Lowell v. Lewis*, 1 Mason's R. 182; *Whittemore v. Cutter*, 1 Gall. R. 484; *Odiorne v. Winkley*, 2 Gall. R. 51. By the French law, the infringing party forfeits the articles made in violation of the patent right. *Renouard c. 10*, s. 3, p. 361, Ed. of 1825. This was the provision of the act of Congress of 1790; also act 1800, c. 25, s. 3.

the amount found by such judgment as the actual damages sustained by the plaintiff, not exceeding three times the amount thereof, according to the circumstances of the case.”

When, on account of some defect in the specification, a patent is surrendered and a new one taken out, damage can be recovered for an infringement only for the time subsequent to the taking out of the new patent.<sup>2</sup>

It has been held, by Mr. Justice Story, that the making of a patented machine for experiment or philosophical purposes merely, and not for use, sale or profit, is not an infringement, but that the making of it for sale, use or profit, though without any sale or use, and though no profit is made, is an infringement, but that the damage, in such case, is only nominal. This decision was made under the law of 1793, but is applicable to that of 1836.

In an action for an infringement, the jury were instructed that the making of the patented machine fit for use, and *with a design to use it for profit*, was an infringement, for which an action was given by the statute. This direction was objected to, on the part of the defendant. Story J. “This limitation of the making, was certainly favorable to the defen-

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<sup>2</sup> Act of Congress, 1836, c. 357, s. 13. See *Ames v. Howard*, 1 Sumner's R. 482.

dant, and it was adopted by the court from the consideration, that it could never have been the intention of the legislature to punish a man who constructed such a machine merely for philosophical experiments, or for the purpose of ascertaining the sufficiency of the machine to produce its described effects. It is now contended by the defendant's counsel, that the making of a machine is, under no circumstances, an infringement of the patent. The first section of the act of 1793 expressly gives to the patentee, &c. 'the full and exclusive right and liberty of making, constructing, using and vending to others to be used,' the invention or discovery. The fifth section of the same act gives an action against any person who 'shall make, devise, and use or sell' the same. From some doubt whether the language of the section did not couple the *making* and *using* together, to constitute an offence, so that making, without using, or using without making, was not an *infringement*; the legislature saw fit to repeal that section; and by the third section of the act of 1800, c. 25, gave the action against any person who should 'make, devise, use or sell' the invention. We are not called upon to examine the correctness of the original doubt, but the very change in the structure of the sentence affords a strong presumption, that the legislature intended to make every one of the enumerated acts a substantive ground of action. It is argued, however, that the words are

to be construed distributively, and that 'making' is meant to be applied to the case of a *composition* of matter, and not to the case of a machine; that it is clear that the use of certain compositions, as patented pills, could not be an infringement, and unless making was so, there could be no remedy in such cases. We cannot feel the force of this distinction. The word 'making' is equally as applicable to machines, as to compositions of matter; and we see no difficulty in holding that the using or vending of a patented composition, is a violation of the right of the proprietor. It is farther argued, that the making of a machine cannot be an offence, because no action lies except for *actual damage*, and there can be no actual damages, or even a rule for damages for an infringement, by making a machine. We are, however, of opinion, that where the law gives an action for a particular act, the doing of that act imports, of itself, a damage to the party. Every violation of a right imports some damage, and if none other be proved, the law allows a nominal damage. We see no reason for departing from the plain import of the language of the statute, and the objection must be overruled."<sup>3</sup>

In the same case the plaintiff argued, that, al-

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<sup>3</sup> *Whittemore v. Cutter*, 1 Gallison, 429.

though there was no evidence of actual damage, the jury ought to give damages either to the full value of the expense of making the machine, or of the price at which such a machine might be sold. Story J. said, that “neither of these estimates could form a rule for damages for the illegal making of the machine. As to the expense of making the machine, it is obvious that it is an expense altogether incurred by the defendant, and is not a loss sustained by the plaintiffs. The latter neither found the materials nor the labor. How then can it be an actual damage sustained by them? As to the price for which such a machine would sell, it is open to the same, and to this farther objection, that the *price* is compounded of the value of the materials and the workmanship, and also of the *right of user* of the machine. Now, admitting the plaintiffs recover in this action, there can be no pretence, that thereby a legal right will pass to the defendant to use the machine made by him. Every future use will be an infringement of the plaintiffs’ patent; and, therefore, if the plaintiffs could, in this suit, recover such price, they not only would recover for materials and labor which they never furnished, and for a right of user which never passed from them, but, also, for that which might lawfully be the subject of another action; to wit, the future user of the defendant’s machine; so that there

might be a double recovery for the same supposed injury.”<sup>4</sup>

Mr. Justice Story says, in regard to the expression, *actual damages*, in the act of congress: “By the term ‘actual damages,’ in the statute, are meant such damages, as the plaintiffs can actually prove, and have, in fact, sustained, as contradistinguished to mere imaginary or exemplary damages, which, in personal torts, are sometimes given. The statute is highly penal, and the legislature meant to limit the single damages to the real injury done, as in other cases of violation of personal property, or of incorporeal right.”<sup>5</sup>

In the case of an infringement by using the machine, there always is *some* damage proved. The very fact of the defendant’s using the machine is a practical admission of the value of the use. Mr. Justice Story laid down the general rule, in one case, that in an action for an infringement the damages should be estimated as high as they can be, consistently with the rule of law on this subject, if the plaintiff’s patent has been violated; that wrongdoers may not reap the fruits of the labor and genius of other men.<sup>6</sup> But in a subsequent case before

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<sup>4</sup> *Whittemore v. Cutter*, 1 Gallison, 483.

<sup>5</sup> *Whittemore v. Cutter*, 1 Gallison, 482.

<sup>6</sup> *Lowell v. Lewis*, 1 Mason, 182.

cited,<sup>7</sup> the same judge, considering the trebling of the damages to be a sufficient discouragement to wrong-doers, seems to limit the rule of single damages more rigidly. His reasoning is as follows :

“ It has been maintained by some learned persons that the price of the invented machine is a proper measure of damages, in cases where there has been a piracy by making and using the machine, because, in such cases, the verdict for the plaintiff entitles the defendant to use the machine subsequently, and, in short, transfers the right to him in the fullest manner, and in the same way, that a recovery in trover or trespass, for a machine, by operation of law, transfers the right to such machine to the trespasser, for he has paid for it. If I thought such was the legal operation of a verdict for the plaintiff, in an action for making and using a machine, no objection would very forcibly occur to my mind against the rule. But my difficulty lies here. The patent act gives to the inventor the exclusive right of making and using his invention during the period of fourteen years. But this construction of the law enables any person to acquire that right, by a forced sale, against the patentee, and compels him to sell, as to persons or places, when it may interfere essentially with his permanent interest, and involve him in the

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<sup>7</sup> *Whittemore v. Cutter.*

breach of prior contracts. Thus the right would not remain exclusive; but the very attempt to enforce it would involve the patentee in the necessity of parting with it. The rule itself, too, has no merit from its universality of application. How could it apply, when the patentee had never sold the right to any one? How, when the value of the right depended upon the circumstance of the right being confined to a few persons? Where would be the justice of its application, if the invention were of enormous value and profit, if confined to one or two persons, and of very small value if used by the public at large; for the result of the principle would be, that all the public might purchase and use it by a forced judicial sale. On the other hand, cases may occur where the wrong done to the patentee may very far exceed the price which he would be willing to take for a limited use by a limited number of persons. These, among others, are difficulties which press on my mind against the adoption of the rule; and where the declaration goes for a user during a limited period, and afterwards the party sues for a user during another and subsequent period, I am unable to perceive how a verdict and judgment in the former case is a legal bar to a recovery in the second action. The piracy is not the same, nor is the gravamen the same. If indeed the plaintiff, at the trial, consents that the defendant shall have the full benefit of the machine for ever, upon the ground



of receiving the full price in damages, and the defendant is content with this arrangement, there may be no solid objection to it in such a case. But I do not yet perceive, how the court can force the defendant to purchase, any more than the plaintiff to sell, the patent right, for the whole period it has to run. The defendant may be an innocent violator of the plaintiff's right; or he may have ceased to use, or to have employment for, such a machine." There are other objections alluded to in the case in *1 Gallison*, 429.\*

"Struck with similar difficulties in establishing any general rule to govern cases upon patents, some learned judges have refused to lay down any particular rule of damages, and have left the jury at large to estimate the actual damages according to the circumstances of each particular case. I rather incline to believe this to be the true course. There is a great difference between laying down a special and limited rule as a true measure of damages, and leaving the subject entirely open, upon the proofs in the cause, for the consideration of the jury. The price of the machine, the nature, actual state and extent of the use of the plaintiff's invention, and the particular losses to which he may have been subjected by the piracy, are all proper ingredients to

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\* *Whittemore v. Cutter.*

be weighed by the jury in estimating the damages, *valere quantum valeant.*<sup>9</sup>

In one of the cases already cited above, the same learned judge remarks that the rule for damages, in an action for an infringement of a patent, is the amount of the profits actually received by the defendant in consequence of his using the plaintiff's invention.<sup>10</sup> This is virtually assuming that the plaintiff's damages shall be considered *at least* equal to the defendant's actual profits by using the machine; that is, that if the defendant had not used the machine without license, it shall be presumed he would have given the plaintiff for the privilege of using it, what he could actually make. Perhaps, however, the plaintiff has a fixed price for a license, in which case it might be said, that if it be less than the profit made by the defendant, the former ought to be the rule, and that is the actual damage of the plaintiff. On the other hand, it would be unjust to the patentee that the defendant should make a profit by the infringement, especially if it was intentional. In this, as in other cases, the circumstances of aggravation or excuse are taken into consideration by the jury, who would, perhaps, be justified in presuming that the plaintiff would have made the same profit which the defendant has, had not the defend-

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<sup>9</sup> Earle v. Sawyer, 4 Mason, 1.

<sup>10</sup> Lowell v. Lewis, 1 Mason, 182.

ant committed the infringement, and accordingly that this is the measure of damages ; for though the rate at which the privilege is ordinarily sold is a less sum, and it is not certain that the plaintiff would not have demanded of him a higher rate, or that he would not have used his invention himself, and thus made the same profit, still it is to be considered that, in these cases, the statute, at the time of the above decision, trebled the actual damage, without any discrimination as to the circumstances of aggravation or extenuation of the infringement ; and this is a sufficient protection to the plaintiff's rights. If the privilege is a matter of frequent sale, and bears a fixed, well-known market value, this has one very material advantage over a computation of the defendant's profit, as a rule of damages, since such a computation is generally one of much difficulty, in which the party directly interested in the result, and who has the best means of calculation, is liable to great mistakes, to which witnesses and jurymen must be still more liable. Another circumstance weighs something in favor of this rule, that the small profit or actual loss made by the defendant, cannot be alleged in reduction of the damage which the plaintiff has actually sustained ; and this is a reason why undue and aggravated weight should not, at least, be allowed to evidence of a profit far exceeding the actual damage which the plaintiff has proba-

bly sustained; and to this he is limited by the words of the statutes both of 1793 and 1836.

In Arkwright's case, the fact that the patentee, after a verdict against him, in 1781, had lain by for four years before bringing another action for an infringement, when many persons were notoriously using the machine, was considered by Lord Loughborough as material in fixing the damages. He said, "It has been said that many persons have acted upon an idea that Mr. Arkwright had no right, he having failed to establish it when this cause underwent an examination in another place, in which the event was unfavorable to him. If the question at present were what damages Mr. Arkwright should have received for the invading that right, I would have allowed the parties to have gone into evidence, to show to what extent persons had acted upon the faith of the former verdict; but the question now is upon the mere right; and if the result of this cause is in favor of the plaintiff, the verdict will be with one shilling damages. A future invasion of this right would entitle Mr. Arkwright to an action for damages, but in the present case they are not asked."<sup>11</sup>

In the United States the express provisions of the statute present a strong objection to any such rule.

The question was made, in a case that came before

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<sup>11</sup> Arkwright v. Nightingale, Dav. Pat. Cas. 55.

Mr. Justice Story, in 1813, whether, in an action for the infringement of a patent right, the expenses incurred by the plaintiff for counsel fees are to be considered as items of actual damage. Story J. "At the trial, we had considered, that it was the established rule to consider counsel fees and the expenses of witnesses beyond the taxable costs, as items of actual damage, in estimating damages in cases of mere tort, whether the action was for the redress of a personal injury, or the vindication of a personal right. Since the trial, however, we have seen the case of *Arcambel v. Wiseman*, 3 Dallas, 306, in which the question as to counsel fees, was directly before the Supreme Court. There can be no doubt that the case was founded on a tort; and we feel ourselves bound by that decision, whatever might have been the opinion we should otherwise have been disposed to entertain."<sup>12</sup>

But in a subsequent case, in 1820, the same judge held that in an action for the infringement of a patent, the jury are at liberty, if they see fit, to allow the plaintiff as part of his "actual damages," any expenditure for counsel fees, or other charges, which were necessarily incurred to vindicate the rights derived under his patent, and are not taxable in the bill of costs. Story J. "I feel myself bound to

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<sup>12</sup> *Whittemore v. Cutter*, 1 Gallison, 429.

declare, that as the authority of *Arcambel v. Wiseman*, 3 Dall. 306, is shaken, so far as it can be considered as containing any general doctrine governing cases of this nature, I return to what I originally considered the true doctrine."<sup>13</sup>

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## CHAPTER XXIII.

### *Effect of a Judgment.*

THE success of the defendant, in an action for an infringement, on the ground of the invalidity of the patent, does not prevent the plaintiff from instituting another suit against any other person for an infringement of his patent. A judgment is conclusive only between the parties to it, and upon the subject matter of the suit, that is, the infringement complained of. It is not conclusive between the same parties, as to the continuation of the same supposed infringement subsequently to the time covered by the first declaration; for the subsequent infringement, if it differs in nothing else, differs at least in time. In *Arkwright's case*, where the patentee, having failed

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<sup>13</sup> *Boston Manuf. Co. v. Fiske*, 2 Mason, 119.

in one suit for an infringement, after lying by four years, brought an action against another person, Lord Loughborough said, "It is said, it is highly expedient for the public that this patent, having been so long in public use after Mr. Arkwright had failed in that trial, should continue to be open ; but nothing could be more essentially mischievous than that questions of property between A and B should ever be permitted to be decided upon considerations of public convenience or expediency. The only question that can be agitated in Westminster Hall is, which of the two parties in law or justice ought to recover."<sup>1</sup> If one defendant has failed by making a bad defence, this is no reason why another should be concluded from making a good one if the case admits it.

So the success of the patentee, in an action for a subsequent infringement, is not necessarily inconsistent with his failure in a former one for a previous infringement, since the evidence in the two cases may be materially different. But a party coming into court to obtain a different result from that in a former suit, to which he was a party, evidently comes under some disadvantage.

By the act of Parliament of 5 and 6 W. 4, c. 83, s. 3, it is provided that in case of a verdict, or final

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<sup>1</sup> Arkwright v. Nightingale, Dav. Pat. Cas. 55.

decree or decretal order, on the merits in favor of the patentee or his assignees, in any action at law or suit in equity in respect to an infringement, or a *scire facias* to repeal the letters-patent, the judge may certify that the validity of the patent came in question, which certificate being given in evidence in any future suit touching the patent, if the verdict or decree shall be in favor of the patentee, he shall be entitled to treble costs, unless the judge shall, in such subsequent suit, certify that the patentee ought not to have treble costs.

In patent causes, as in others, a new trial will not be granted, except in very strong cases; not merely for newly discovered cumulative evidence.<sup>2</sup>

If either party is surprised by evidence produced by the other, which he wishes for an opportunity to obtain other evidence to rebut, he must move for a continuance of the action to give him an opportunity to produce other evidence, he cannot go on and take the chance of a trial upon the evidence he has; and, on the verdict being against him, make the subject of the surprise a ground of motion for a new trial. By going on he makes an election to waive the objection.<sup>3</sup>

Where the court gives an instruction to the jury

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<sup>2</sup> *Ames v. Howard*, 1 Sumner's R. 482. See also *Haworth v. Hardcastle*, 1 Bing. N. R. 182.

<sup>3</sup> *Ames v. Howard*, 1 Sumner's R. 482.



on the *weight* of the testimony, or so instructs them as to convey an opinion as to the weight of the testimony, and a party objects, and thereupon the court withdraws the instruction, this is no ground for a motion for a new trial, for the comment is not presumed to have had any influence upon the verdict.<sup>4</sup>

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## CHAPTER XXIV.

### *Injunction.*

A PROCEEDING whereby an infringement of a patent right may be stopped, is essential to the security of patentees, since the remedy at law for damages will not, in all cases, afford an adequate indemnity.

This preventive remedy is by a bill for an injunction, in which the patentee, or his representative, after setting forth the patent and his right under it, and the infringement, prays the court to enjoin the party complained of to stop the infringement. This proceeding is merely prospective, it does not give

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<sup>4</sup> Ames v. Howard, 1 Sumner's R. 582.

the patentee compensation for the damage previously occasioned, nor does it conclusively try the validity of the patent right. The proceeding is ancillary, merely, to the action at law for damages ; which may be commenced before, or at the same time with, or after the bill for an injunction. And it is frequently made a condition of the continuance of the injunction, that the patentee shall, within a certain time, or as soon as may be, bring his action at law for the infringement.

All persons interested in the infringement, whether as patentees, assignees, or by license, should be joined as plaintiffs in such a bill.<sup>1</sup>

A bill for an injunction lies against a corporation, but where different persons have infringed the same patent, independently of each other, they cannot be joined in the same bill.<sup>2</sup>

The granting of an injunction is, in some degree, a matter of discretion with the court in the particular case ; but this discretion is, as in other cases, governed by certain general rules. The material considerations by which the court is governed in these cases are the clearness of the plaintiff's right to the exclusive privilege, and his possession and use of it. All the cases on injunctions turn upon these considerations.

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<sup>1</sup> *Ogle v. Ege*, 4 Wash. C. C. R. 534.

<sup>2</sup> *Dilly v. Doig*, 2 Ves. Jr. 487.

Mr. Justice Washington says, "I take the rule to be, that where the bill states a clear right to the thing patented, which, together with the alleged infringement, is verified by affidavit; if he has been in possession of it by having used or sold it in part, or in the whole, the court will grant an injunction, and continue it till the hearing or further order, without sending the plaintiff to law to try his right. But if there appears to be a reasonable doubt as to the plaintiff's right, or to the validity of the patent, the court will require the plaintiff to try his title at law; sometimes accompanied by an order to expedite the trial; and will permit him to return for an account in case the trial at law should be in his favor." And he granted an injunction in the case then in hearing on a bill by the patentee, and his assignee, for the state of Pennsylvania, where it was alleged that the patent had been infringed.<sup>3</sup>

In another case, the same judge says: "The rule is, to grant an injunction on filing the bill, and before a trial at law, if the bill state a clear right, and verifies it by affidavit. If it states an exclusive possession of the invention, the injunction is granted, though the courts may entertain doubts as to the va-

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<sup>3</sup> *Ogle v. Ege*, 4 Wash. C. C. R. 534: cites *Hill v. Thompson*, Eden, 260; 14 Ves. 132; 3 Meriv. 624; Coop. Eq. Prac. 158; 1 Madd. C. P. 113; 14 Ves. 130; *Ambler*, 406; 1 Vern. 120; 2 Madd. 175; 6 Ves. 707; 3 Attk 496; 3 Bro. C. C. 376.

lidity of the patent. But if there be glaring defects in the patent, or specification, the rule is refused. When the patent is recent, and objections are made to the patent, or specification, the court will not grant an injunction till the right is established at law, which the court will order. If the bill does not set forth the possession of the invention by the plaintiff, at any particular time, it is defective. If the answer denies that the defendant uses the plaintiff's invention, the injunction will be refused.<sup>4</sup>

Upon a bill for an injunction the court required the plaintiff to subjoin a special affidavit of the truth of the allegations in the same; and "that he was, to the best of his knowledge and belief, the true and original inventor and discoverer of the improvement, for which he had obtained his patent; and that the same had not, to the best of his knowledge or belief, been in use, or been described, in any public work, anterior to his said invention or discovery."<sup>5</sup>

This practice, as to requiring an affidavit, is adopted from that of the English court of chancery. It requires the plaintiff to make affidavit, among other things, of the same facts to which he makes oath at the time of taking out his patent, for the court says, that though at the time of taking out the patent, the

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<sup>4</sup> *Isaacs v. Cooper*, Coxe's Dig. 533; 4 Wash. C. C. R. 259.

<sup>5</sup> *Rogers v. Abbot*, 4 Wash. C. C. R. 514.

patentee may have very honestly sworn, as to his belief, that he was the original inventor, yet circumstances may have subsequently intervened, or information been communicated, sufficient to convince him that it was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect.<sup>6</sup>

It is the practice in England to grant injunctions, in some cases forthwith, *ex parte*, without first hearing the party complained of.<sup>7</sup> In case of a patent which depended upon the proportions of the ingredients, Lord Eldon said, "he doubted whether the injunction ought to have been granted in the first instance, unless the affidavits had stated more particularly, in what the alleged infringement of the patent consisted; and that it should have been shown to be, by working in the *precise proportions* mentioned in the specification, as being of the essence of the invention."<sup>8</sup>

On a bill for an injunction Mr. Justice Washington granted it until answer and further order; and required the plaintiff to institute a suit at law against the defendant to try his right, the writ to be returnable to the next term of the court.<sup>9</sup>

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<sup>6</sup> Thompson v. Foreman, 3 Meriv. R. 622.

<sup>7</sup> Walker v. Congreve, Rep. of Arts, 2d series, v. 29, p. 311; Thompson v. Foreman, 3 Meriv. 622.

<sup>8</sup> Hill v. Thompson, 3 Meriv. 624.

<sup>9</sup> Rogers v. Abbot, 4 Wash. C. C. R. 514.

Applications for injunctions have been much more frequent in England than in the United States. The reason is, that in the United States, the patentee has had a more adequate remedy at law for damages. In the United States the patentee may safely rely upon his remedy, at law, if the parties infringing are able to respond to his claim for damages. In England, the security of the patentee is sometimes increased, and his remedy for indemnity facilitated, by the proceedings in equity, in which the court, instead of enjoining the party complained of to stop the manufacture, frequently orders him to keep an account of it, so that, if the plaintiff shall succeed in establishing his right at law, the rule of damages may be the profits accruing from the manufacture.<sup>10</sup>

According to the rule laid down by Mr. Justice Washington, above cited, the English court of chancery has often refused to proceed in an injunction if there is any palpable and glaring doubt of the patentee's right; as if it be doubtful whether the invention is new.<sup>11</sup>

“I cannot,” said one of the Lord Keepers, “grant an injunction in any case, but where a man has a plain right to be quieted in it.”<sup>12</sup> In regard to

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<sup>10</sup> *Gods. Pat.* 183, 188; *Hill v. Thompson*, 3 *Mer.* 622; *George v. Beaumont, Wackerback and Martineau*, *Rep. of Arts*, 2d series, p. 27.

<sup>11</sup> *Forsyth's Patent*, *Gods. Sup.* 68; *Hill v. Williamson*, *Rep. of Arts*, vol. 30, p. 322.

<sup>12</sup> *Anon.* 1 *Vern.* 120.

granting injunctions, the case of patents is put upon the same ground as waste.<sup>13</sup>

Lord Hardwicke seems to have thought that early after the passing of the statute of monopolies, injunctions were not granted until after the right of the patentee had been established by trial at law.<sup>14</sup> But if this was the original rule, it did not very long continue.<sup>15</sup> The present practice of granting injunctions in cases not yet tried at law, being of very long standing.

Many of the English cases state the rule much more broadly as to granting injunctions, and in patent cases, allowing them, not merely where there is no doubt of the patent right, but even where there may be some doubt, if the patentee has been in the exclusive possession of the privilege. And Mr. Justice Thompson, of New York, in commenting upon the English cases, lays down the general distinction, that where a patent is granted in pursuance of an act of parliament as in the case of patents for inventions, the court will grant an injunction before a trial of the right at law, but not in the case of other patents. He says: "It is the prevailing practice in England, even where the right is doubtful, and the case is sent to be tried at law, to send it *with* an injunction, instead of denying it on that ground. But

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<sup>13</sup> Isaac v. Humpage, 1 Ves. Jr. 430.

<sup>14</sup> Whitchurch v. Hild, 2 Atk. 391.

<sup>15</sup> S. C. also Hicks v. Raincock, 2 Dickens, 647.

where the right is *clear* an injunction is never refused ; as when the right claimed appears on record, or is founded on an act of parliament, it is matter of course to grant an injunction, without first obliging the party to establish his case at law.<sup>16</sup> In the case of *Blanchard v. Hill*,<sup>17</sup> Lord Hardwicke said, “that in cases of monopolies, the rule that the court had governed itself by, was, whether there was any act of parliament, under which the restriction was founded. But the court will never establish a right of this kind, claimed under a *charter only from the crown*, unless there has been an action to try the right at law. This will be found, on examination, to be a governing distinction, running through the numerous cases cited in the argument. And whenever an injunction has been refused, the right was claimed under a patent from the crown, and that right considered doubtful.”<sup>18</sup>

Lord Eldon puts the case not merely upon the circumstances existing between the two parties to the bill, but partly upon that of protecting the patentee against other infringements, whereby he might be ruined by lawsuits in establishing his right. He says : “The ground upon which, where doubt is excited in the mind of the court, an injunction is

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<sup>16</sup> Coop. Eq. Pl. 157 ; Mitf. Pl. in Eq. 129 ; 1 Vesey, 476.

<sup>17</sup> 2 Atk. 485.

<sup>18</sup> *Livingston v. Van Ingen*, 9 Johns. R. 570.



granted until the legal question can be tried, a ground that was acted upon in the case of *Boulton v. Bull*, 2 H. Bl. 453, *Hornblower v. Boulton*,<sup>19</sup> in some cases preceding that, and some that have occurred since, is this ; where the crown, in behalf of the public, grants letters-patent, the grantee entering into a contract with the crown, the benefit of which contract the public are to have, and the public have permitted a reasonably long and undisputed possession, under color of the patent, the court has thought upon the fact of that possession, proved against the public, that there is less inconvenience in granting the injunction, until the legal question can be tried, than in dissolving it at the hazard, that the grant of the crown may, in the result, prove to have been valid. The question is not really between the parties upon the record ; for unless the injunction is granted, any person might violate the patent, and the consequence would be that the patentee must be ruined by litigation. In the case of *Boulton and Watt*, therefore, though a case of great doubt, upon which some of the ablest judges in Westminster Hall disagreed, yet upon the ground of the possession by the patentees against all mankind, the injunction was granted, until the question could be tried ; and the result of the trial being in favor of

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<sup>19</sup> 8 T. R. 95.

the patent, proved, that the conduct of the court, in that instance, was, at least, fortunate."<sup>20</sup>

Mr. Justice Thompson of the Supreme Court of New York, puts the subject of injunction upon the same ground.<sup>21</sup>

But when the subject appeared, on the face of the patent, not to be patentable, Lord Eldon refused an injunction. In case of an application for an injunction on Forsyth's patent for a percussion lock, that judge said, "the application of these combustibles to the discharge of fire-arms by percussion, is not new; and I think it would be difficult to say that the particular method of applying percussion, to ignite such chemical combustibles, for the purpose of discharging fire-arms, is a subject for a patent." He accordingly refused an injunction until the patent should be established by a trial at law.<sup>22</sup>

But the same Lord Chancellor granted an injunction, where the patentee had been in possession under a patent for improvements, upon a machine which was the subject of an expired patent, until the right could be tried, although the patent for the improvements was subject to considerable doubt, as the specification described the original machine with the

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<sup>20</sup> *Harmer v. Plane*, 14 Vesey, 130.

<sup>21</sup> *Livingston v. Van Ingen*, 9 Johns. R. 569.

<sup>22</sup> *Forsyth v. Manton*, July 1815, Rep. of Com. of H. of Com. 1829. App. 198, Mr. Farey's papers.

improvements as one entire machine, and not the improvements distinguished from the original machine.<sup>23</sup>

In another case Lord Eldon said that in the case of patent rights, if the party gets his patent, and puts his invention in execution, and has proceeded to a sale, that may be called a possession under it, however doubtful it may be whether the patent can be sustained. The Court of Chancery have said, possession under a color of title, is ground enough to enjoin, and to continue the injunction, till it is proved at law, that it is only color and not real title.<sup>24</sup>

The weight of the consideration of exclusive possession will depend on its duration in some degree, and, therefore, another distinction, in regard to the exercise of the discretion of the court in granting an injunction, relates to the time during which the patentee has been in possession. Where there has been an exclusive possession of some duration under a patent, the court will, in case of an infringement, interpose its injunction, without putting the party previously to establish the validity of his patent by an action of law. But where the patent is recent, and, upon an application being made for an injunc-

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<sup>23</sup> *Harmer v. Plane*, 14 Vesey, 130.

<sup>24</sup> *Universities of Oxford and Cambridge v. Richardson*, 6 Vesey, 707.

tion, it is endeavored to be shown in opposition to it, that there is no good specification, or otherwise that the patent ought not to have been granted, the court will not, from its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial; but will send the patentee to law and oblige him to establish the validity of his patent in a court of law, before it will give him the benefit of an injunction.<sup>25</sup>

Mr. Chief Justice Kent thus states the law on the subject of injunctions in the United States: He says, "The law has been settled in England, in regard to the granting of injunctions, that statute privileges, no less than common law rights, when in actual possession and exercise, will not be permitted to be disturbed, until the opponent has fairly tried them at law and overthrown their pretension. The federal courts, under the patent laws of Congress, have equally protected the right by injunction. The case of *Morse v. Reid*, decided by C. J. Ellsworth, in the Circuit Court of the United States, was a bill for an injunction filed in 1796, to restrain the defendant from reprinting Winterbotham's History, which the complainant alleged was an invasion of the copyright of his American Geography. The propriety

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<sup>25</sup> *Hill v. Thompson*, 3 Meriv. 622.

of the injunction was not questioned; it issued in the first instance. The complainant recovered fifteen hundred dollars, and the injunction was made perpetual. So, in the late case of *Whitney v. Fort*, which arose in Georgia, upon a violation of the complainant's patent for a machine for cleaning cotton, an injunction was granted, in the first instance, and was afterwards made perpetual, at the Circuit Court, at which Judge Johnson presided. Injunctions are always granted to secure the enjoyment of statute privileges of which the party is in the actual possession, unless the right be doubtful. This is the uniform course of the precedents. I believe there is no case to the contrary; and the decisions in the English chancery, on this point, were the same before as since the American Revolution; and we are consequently bound by them as a branch of the common law."<sup>26</sup>

Accordingly an injunction was granted in the case then under the consideration of the court upon the grant of a monopoly by the legislature of New York, which was subsequently adjudged to be void by the Supreme Court of the United States, but still the grounds of proceeding in the Supreme Court of New York, as to granting an injunction, are not thereby rendered the less illustrative of the law and practice

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<sup>26</sup> *Livingston v. Van. Ingen*, 9 Johns: 585.

upon this subject. An act was passed by the legislature of New York, granting to the plaintiffs, Livingston and Fulton, who were "the possessors of a mode of applying the steam engine, to propel a boat on new and advantageous principles," the sole and exclusive right of constructing and navigating boats by steam, in the waters of that State, for a certain term of years; and by a subsequent grant, passed in 1808, it was provided that if any steam-boats should be used in contravention of the right of the grantees, they should be forfeited to them. These statutes having been adjudged to be constitutional and valid, it was held, by the Court of Errors, that the plaintiffs, who had been in the exclusive enjoyment of their statute privilege for three years, were entitled to an injunction to restrain the defendants from running steam boats on the Hudson, although the plaintiffs had brought an action of detinue against the defendants, by virtue of the statute, for the recovery of the boats which had been so used. Thompson J. said that "the claim of the plaintiffs was founded on acts of the legislature, and if those acts were considered valid, no doubt could exist as to the right. And if any doubt should be thought to exist on that point, yet, according to the established rule in England, this was not sufficient to warrant a denial of the injunction. If it should be necessary to send the cause to be tried at law, it ought to be sent *with* an injunction. But it is said, that the right claimed by

the plaintiffs being created by statute, they are entitled to no other remedy than that which the statute gives. Without examining whether the rule of law, upon which this objection is founded, is not confined to criminal cases altogether, it certainly cannot be applied to the present case; for the forfeiture is not given by the same statute which created and gave the right, nor until the right was actually vested in the plaintiffs, by a fulfilment of the terms and conditions upon which they were to be entitled to the exclusive privilege now claimed by them; and if the right was vested, all existing remedies to enforce it were also vested, and are not to be taken away by implication. The act of 1808, creating the forfeiture, purports to be an act for the *further* encouragement of the plaintiff's steam boats, which plainly shows that the remedies therein provided, were intended as *cumulative*, and in addition to those already existing. This would be the construction in criminal cases, even where the offence is created and the penalty given by the same statute, provided they are in separate clauses."<sup>27</sup>

*Possession* of an exclusive privilege of this description is indicated by the *use*. Accordingly where it did not appear what use the applicant for an injunction had made of the privilege for which he took his

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<sup>27</sup> *Livingston v. Van Ingen*, 9 Johns. 507.

patent, Mr. Justice Thompson considered that there was no support to the application on the ground of possession, and as the right seemed questionable at the same time, the injunction was refused.<sup>26</sup>

Applications for injunctions to protect manufactures not secured by patent, have been generally rejected in England.

In case of an agreement not to disclose the secret of the composition of a medicine, Lord Eldon was averse to sustaining an injunction. A motion was made to dissolve an injunction restraining the defendant from divulging the secrets in the bill mentioned, and from preparing or selling the medicines therein mentioned. The alleged secrets in medicine were unprotected by a patent. Lord Eldon. "So far as the injunction goes to restrain the defendant from communicating the secret, upon general principles, I do not think that the court ought to struggle to protect this sort of secrets in medicine. The court is bound indeed to protect them in cases of patents, to the full extent of what was intended by the grant of the patent, because the patentee is a purchaser from the public and bound to communicate his secret to the public at the expiration of the patent. Then, whether the principle can be extended to such a case as this—whether a contracting party is entitled

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<sup>26</sup> *Sullivan v. Redfield*, 1 Paine R. 441.



to the protection of the court in the exercise of its jurisdiction, to decree the specific performance of agreements, by restraining a party to the contract from divulging the secret he has promised to keep, that is a question which would require very great consideration. But the present case is not one which calls for the determination of it. If the defendant has already disclosed the secret, the injunction can be of no use. If he only threatens to disclose, it then becomes necessary to look at his affidavit; and by that he insists that what he has to disclose is no secret at all. Then how is the court to try this question? Or what can the court do with the case altogether?" The injunction was dissolved.<sup>29</sup>

Lord Hardwicke refused to grant an injunction to protect a stamp for goods. A motion was made, on behalf of the plaintiff, for an injunction to restrain the defendant from making use of the *Great Mogul* as a stamp on his cards, to the prejudice of the plaintiff, upon a suggestion, that the plaintiff had the sole right to this stamp, having appropriated it to himself, conformably to the charter granted to the Card-makers' Company by Charles I. Lord Hardwicke. "There is no foundation for this court to grant such an injunction. Every particular trader has some particular mark or stamp; but I do not

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<sup>29</sup> Williams v. Williams, 3 Meriv. 157.

know any instance of granting an injunction here to restrain one trader from using the same mark with another; and I think it would be of mischievous consequence to do it. There is a clause in the charter, that in order that every card-maker may know his cards from another card-maker, each trader shall lodge his mark or stamp with the receiver, *to prevent any fraud upon our loving subjects.* This is a colorable end; but if any weight was to be laid upon these colorable recitals, it would be establishing every other monopoly. An objection has been made, that the defendant, in using this mark, prejudices the plaintiff, by taking away his customers. But there is no more weight in this, than there would be in an objection to one inn-keeper setting up the same sign with another." The injunction was accordingly refused till the hearing of the cause.<sup>30</sup>

If on a trial at law the plaintiff establishes his right, the injunction on the defendant is, on his motion, made perpetual; if he fails, the injunction will, on motion of the defendant, be dissolved. But where a verdict having been given for the plaintiff, the court of law were equally divided, a writ of error lying to another court, the chancellor refused to dissolve the injunction, until a decision could be had in the court of errors, or in another

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<sup>30</sup> *Blanchard v. Hill*, 2 Atkyns, 484.

action, the plaintiff having been in possession of his privilege seven years.<sup>31</sup> And so if a new trial is proposed to be moved for, this is a ground, on the part of the defendant, for opposing a motion by the plaintiff to make the injunction perpetual, and on the part of the plaintiff, for opposing a motion of the defendant to dissolve it.<sup>32</sup>

If the injunction be granted improvidently, it will be dissolved on motion. But until it is dissolved, a violation of it will be a contempt of court.<sup>33</sup>

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## CHAPTER XXV.

### *Proceedings for the Repeal of Patents.*

THE act of Congress of 1793, s. 10, provided a process for the repeal of a patent in the nature of *scire facias*. The same act, s. 6, provided that in case of notice of certain grounds of defence, in an action for an infringement, and of any of these grounds being made good, the court might declare the patent void. That act has been repealed by the act of 1836, in

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<sup>31</sup> *Boulton v. Bull*, 3 Ves. 140.

<sup>32</sup> *Gods. on Pat.* 631. *Gibbs v. Cole*, 3 P. W. 256.

<sup>33</sup> *Walker v. Congreve*, *Rep. of Arts*, Second Series, v. 24, p. 311.

which no provision has been made for the repeal of patents.

The proceeding for the repeal of patents in England is by *scire facias*.<sup>1</sup>

The provisions of the act of 1793, for proceedings in the nature of *scire facias*, have been subjects of various decisions, which need not be particularly stated, since that act has been repealed.<sup>2</sup>

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<sup>1</sup> Hunt v. Coffin, Dyer, 197, b; 4 Inst. 88; The King v. Butler, 2 Vent. 344; S. C. 3 Vent. 223; S. C. 3 Lev. 220; The King v. Arkwright, Godson on Pat. 192; Com. Dig. Patent, F. 2, 3. 7; 2 Saund. 72, n; Rex v. Dawes, 4 Burr. 2022, 2120; Rex v. Peacock, 4 T. R. 634; Lilly's Ent. 411.

<sup>2</sup> See Stearns v. Barrett, 1 Mass. R. 167; Ex parte Wood v. Brundage, 9 Wheat. 702.

# APPENDIX.

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## PATENT ACTS OF THE UNITED STATES.

*Act of Congress of April 10, 1790, c. 34, Story's Laws of U. S. vol. 1, p. 80. Repealed by act of 21st February, 1793, c. 55.*

### An Act to promote the progress of useful arts.

Sec. 1. Petition. Attestation. Certificate of attorney general. Seal. Recording.  
2. Specification. Models.  
3. Copies.  
4. Penalty for an infringement.

Sec. 5. Repeal of patents.  
6. Patent is prima facie evidence. Plea. Notice. Verdict in case of false specification.  
7. Fees.

§ 1. *Be it enacted, &c.* That upon the petition of any person or persons, to the secretary of state, the secretary for the department of war, and the attorney general of the United States, setting forth, that he, she, or they, hath, or have invented or discovered, any useful art, manufacture, engine, machine, or device, or any improvement therein, not before known or used, and praying that a patent may be granted therefor, it shall and may be lawful to and for the said secretary of state, the secretary for the department of war, and the attorney general, or any two of them, if they shall deem the invention or discovery sufficiently useful and important, to cause letters patent to be made out in the name of the United States, to bear teste by the president of the United States, reciting the allegations and suggestions of the said petition, and describing the said invention or discovery, clearly, truly, and fully, and thereupon granting to such petitioner or petitioners,

nis, her, or their heirs, administrators or assigns, for any term not exceeding fourteen years, the sole and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery; which letters patent shall be delivered to the attorney general of the United States, to be examined, who shall, within fifteen days next after the delivery to him, if he shall find the same conformable to this act, certify it to be so at the foot thereof, and present the letters patent so certified to the president, who shall cause the seal of the United States to be thereto affixed, and the same shall be good and available to the grantee or grantees, by force of this act, to all and every intent and purpose herein contained, and shall be recorded in a book to be kept for that purpose, in the office of the secretary of state, and delivered to the patentee or his agent; and the delivery thereof shall be entered on the record, and endorsed on the patent by the said secretary, at the time of granting the same.

§ 2. That the grantee or grantees of each patent shall, at the time of granting the same, deliver to the secretary of state a specification in writing, containing a description, accompanied with drafts or models, and explanations of models (if the nature of the invention or discovery will admit of a model) of the thing or things, by him or them invented, or discovered, and described as aforesaid, in the said patents; which specification shall be so particular, and said models so exact, as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman or other person skilled in the art or manufacture, whereof it is a branch, or wherewith it may be nearest connected, to make, construct, or use, the same, to the end that the public may have the full benefit thereof, after the expiration of the patent term; which specification shall be filed in the office of the said secretary, and certified copies thereof shall be competent evidence in all courts, and before all jurisdictions, where any matter, or thing, touching or concerning such patent right or privilege, shall come in question.

§ 3. That upon the application of any person to the secre-

tary of state, for a copy of any such specification, and for permission to have similar model or models made, it shall be the duty of the secretary to give such copy, and to permit the person so applying for a similar model or models, to take, or make, or cause the same to be taken or made, at the expense of such applicant.

§ 4. That if any person or persons shall devise, make, construct, use, employ, or vend, within these United States, any art, manufacture, engine, machine, or device, or any invention or improvement upon, or in, any art, manufacture, engine, machine, or device, the sole and exclusive right of which shall be so as aforesaid granted by patent, to any person or persons, by virtue and in pursuance of this act, without the consent of the patentee or patentees, their executors, administrators, or assigns, first had and obtained in writing, every person so offending, shall forfeit and pay to the said patentee or patentees, his, her, or their executors, administrators, or assigns, such damages as shall be assessed by a jury, and moreover shall forfeit to the person aggrieved, the thing or things so devised, made, constructed, used, employed, or vended, contrary to the true intent of this act, which may be recovered in an action on the case, founded on this act.

§ 5. That upon oath or affirmation, made before the judge of the district court, where the defendant resides, that any patent which shall be issued in pursuance of this act, was obtained surreptitiously, by or upon false suggestion, and motion made to the said court, within one year after issuing the said patent, but not afterwards, it shall and may be lawful to and for the judge of the said district court, if the matter alleged shall appear to him to be sufficient, to grant a rule that the patentee or patentees, his, her, or their executors, administrators, or assigns, show cause why process should not issue against him, her, or them, to repeal such patents; and if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued as aforesaid, against such patentee or patentees, his, her, or their executors, administrators, or assigns. And in case no suffi-

cient cause shall be shown to the contrary, or if it shall appear that the patentee was not the first and true inventor or discoverer, judgment shall be rendered by such court, for the repeal of such patent or patents; and if the party at whose complaint the process issued, shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in such manner as costs expended by defendants shall be recovered in due course of law.

§ 6. That in all actions to be brought by such patentee or patentees, his, her, or their executors, administrators, or assigns, for any penalty incurred by virtue of this act, the said patents or specifications shall be prima facie evidence, that the said patentee or patentees, was or were the first and true inventor or inventors, discoverer or discoverers, of the thing so specified, and that the same is truly specified; but that, nevertheless, the defendant or defendants, may plead the general issue, and give this act, and any special matter whereof notice in writing shall have been given to the plaintiff, or his attorney, thirty days before the trial, in evidence, tending to prove that the specification filed by the plaintiff, does not contain the whole of the truth concerning his invention or discovery; or that it contains more than is necessary to produce the effect described; and if the concealment of part, or the addition of more than is necessary, shall appear to have been intended to mislead, or shall actually mislead the public, so as the effect described cannot be produced by the means specified, then, and in such cases, the verdict and judgment shall be for the defendant.

§ 7. That such patentee as aforesaid, shall, before he receives his patent, pay the following fees to the several officers employed in making out and perfecting the same, to wit: For receiving and filing the petition, fifty cents; for filing specifications, per copysheet, containing one hundred words, ten cents; for making out patent, two dollars; for affixing great seal, one dollar; for endorsing the day of delivering the same to the patentee, including all intermediate services, twenty cents.



*Act of Congress of Feb. 21st, 1793, c. 55. Story's Laws of U. S. v. 1. p. 300. Repealed by Act of July 4, 1836, c. 357.*

An act to promote the progress of useful arts; and to repeal the act heretofore made for that purpose.

Sec. 1. Petition. Patent. Teste. Certificate of Attorney General. Seal. Recording.	Sec. 6. Plea. Evidence on notice. Patent declared void.
2. Improvements. Change of form or proportions.	7. Patents before granted by the States
3. Oath. Specification. Drawings. Witnesses. Copies made evidence. Models.	8. Pending applications.
4. Assignment.	9. Interfering applications. Arbitration.
5. Penalty for infringement. Action.	10. Proceedings to repeal patents.
	11. Fees.
	12. Act of 1790 repealed.

§. 1. *Be it enacted, &c.* That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used before the application, and shall present a petition to the secretary of state, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said secretary of state to cause letters patent to be made out, in the name of the United States, bearing teste by the president of the United State, reciting the allegations and suggestions of the said petition, and giving a short description of the said invention or discovery, and thereupon granting to such petitioner, or petitioners, his, her, or their, heirs, administrators, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery; which letters patent shall be delivered to the attorney general of the United States, to be examined; who, within fifteen days after such delivery, if he finds the same conformable to this act, shall certify accordingly, at the foot thereof, and return the same to the secretary of state, who

shall present the letters patent, thus certified, to be signed, and shall cause the seal of the United States to be thereto affixed : and the same shall be good and available to the grantee or grantees, by force of this act, and shall be recorded in a book, to be kept for that purpose, in the office of the secretary of state, and delivered to the patentee, or his order.

§ 2. That any person who shall have discovered an improvement in the principle of any machine, or in the process of any composition of matter, which shall have been patented, and shall have obtained a patent for such improvement, he shall not be at liberty to make, use, or vend, the original discovery, nor shall the first inventor be at liberty to use the improvement : And it is hereby enacted and declared, that simply changing the form or the proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery.

§ 3. That every inventor, before he can receive a patent, shall swear or affirm, that *he does verily believe that he is the true inventor or discoverer of the art, machine, or improvement, for which he solicits a patent* ; which oath or affirmation may be made before any person authorized to administer oaths ; and shall deliver a written description of his invention, and of the manner of using, or process of compounding, the same, in such full, clear, and exact terms, as to distinguish the same from all other things before known, and to enable any person, skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions ; and he shall accompany the whole with drawings and written references, where the nature of the case admits of drawings, or with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is of a composition of matter ; which description, signed by himself, and attested by two witnesses, shall be filed

in the office of the secretary of state ; and certified copies thereof shall be competent evidence in all courts where any matter or thing, touching such patent right, shall come in question. And such inventor shall, moreover, deliver a model of his machine, provided the secretary shall deem such model to be necessary.

§ 4. That it shall be lawful for any inventor, his executor, or administrator, to assign the title and interest in the said invention, at any time ; and the assignee, having recorded the said assignment in the office of the secretary of state, shall thereafter stand in the place of the original inventor, both as to right and responsibility ; and so the assignees of assigns, to any degree.

§ 5. That if any person shall make, devise, and use, or sell, the thing so invented, the exclusive right of which shall, as aforesaid, have been secured to any person by patent, without the consent of the patentee, his executors, administrators, or assigns, first obtained in writing, every person, so offending, shall forfeit and pay to the patentee, a sum that shall be at least equal to three times the price for which the patentee has usually sold or licensed to other persons the use of the said invention ; which may be recovered in an action on the case, founded on this act, in the circuit court of the United States, or any other court having competent jurisdiction.

§ 6. That the defendant in such action shall be permitted to plead the general issue, and give this act, and any special matter, of which notice in writing may have been given, to the plaintiff or his attorney, thirty days before trial, in evidence, tending to prove that the specification filed by the plaintiff does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, or that the thing, thus secured by patent, was not originally discovered by the patentee, but had been in use, or had been described, in some public work, anterior to the supposed discovery of the patentee, or that he had surreptitiously obtained a patent for the discovery

of another person: in either of which cases, judgment shall be rendered for the defendant, with costs, and the patent shall be declared void.

§ 7. That where any state, before its adoption of the present form of government, shall have granted an exclusive right to any invention, the party claiming that right shall not be capable of obtaining an exclusive right under this act but on relinquishing his right under such particular state; and of such relinquishment, his obtaining an exclusive right under this act shall be sufficient evidence.

§ 8. That the persons whose applications for patents were, at the time of passing this act, depending before the secretary of state, secretary of war, and attorney general, according to the act, passed the second session of the first congress, entitled "An act to promote the progress of useful arts," on complying with the conditions of this act, and paying the fees herein required, may pursue their respective claims to a patent under the same.

§ 9. That in case of interfering applications, the same shall be submitted to the arbitration of three persons, one of whom shall be chosen by each of the applicants, and the third person shall be appointed by the secretary of state; and the decision or award of such arbitrators, delivered to the secretary of state, in writing and subscribed by him, or any two of them, shall be final, as far as respects the granting of the patent: And if either of the applicants shall refuse or fail to choose an arbitrator, the patent shall issue to the opposite party. And where there shall be more than two interfering applications, and the parties applying shall not all unite in appointing three arbitrators, it shall be in the power of the secretary of state to appoint three arbitrators for the purpose.

§ 10. That upon oath or affirmation being made before the judge of the district court, where the patentee, his executors, administrators, or assigns, reside, that any patent, which shall be issued in pursuance of this act, was obtained surreptitiously, or upon false suggestion, and motion made to the said court, within three years after issuing the said patent, but not after-

wards, it shall and may be lawful for the judge of the said district court, if the matter alleged shall appear to him to be sufficient, to grant a rule, that the patentee, or his executor, administrator, or assign, show cause why process should not issue against him to repeal such patent. And if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued against such patentee, or his executors, administrators, or assigns, with costs of suit. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent; and if the party, at whose complaint the process issued, shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in due course of law.

§ 11. That every inventor, before he presents his petition to the secretary of state, signifying his desire of obtaining a patent, shall pay into the treasury thirty dollars, for which he shall take duplicate receipts; one of which receipts he shall deliver to the secretary of state, when he presents his petition; and the money, thus paid, shall be in full for the sundry services to be performed in the office of the secretary of state, consequent on such petition, and shall pass to the account of clerk hire in that office. *Provided, nevertheless,* That for every copy, which may be required at the said office, of any paper respecting any patent that has been granted, the person obtaining such copy shall pay at the rate of twenty cents for every copy sheet of one hundred words; and for every copy of a drawing, the party obtaining the same shall pay two dollars: of which payments an account shall be rendered annually, to the treasury of the United States; and they shall also pass to the account of clerk hire in the office of the secretary of state.

§ 12. That the act, passed the tenth day of April, in the year one thousand seven hundred and ninety, entitled "An act to promote the progress of useful arts," be, and the same is hereby, repealed. *Provided always,* That nothing contained

in this act shall be construed to invalidate any patent that may have been granted under the authority of the said act; and all patentees under the said act, their executors, administrators, and assigns, shall be considered within the purview of this act, in respect to the violation of their rights: *Provided*, such violations shall be committed after the passing of this act.

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*Act of Congress of June 7th, 1794, c. 58. Story's Laws of U. S. v. 1, p. 363. Repealed by act of July 4th, 1836, c. 357.*

An act supplementary to the act, entitled "Act to promote the progress of useful arts."

Sec. 1. Suits under act of 1790, stopped by its repeal, revived.

§ 1. *Be it enacted, &c.* That all suits, actions, process, and proceedings, heretofore had in any district court of the United States, under an act, passed the tenth day of April, in the year one thousand seven hundred and ninety, entitled "An act to promote the progress of useful arts," which may have been set aside, suspended, or abated, by reason of the repeal of the said act, may be restored, at the instance of the plaintiff or defendant, within one year from and after the passing of this act, in the said courts, to the same situation in which they may have been when they were so set aside, suspended, or abated; and that the parties to the said suits, actions, process, or proceedings, be, and are hereby, entitled to proceed in such cases as if no such repeal of the act aforesaid had taken place. *Provided always*, That before any order or proceeding, other than that for continuing the same suits, after the reinstating thereof, shall be entered or had, the defendant, or plaintiff, as the case may be, against whom the same may have been reinstated, shall be brought into court by summons, attachment, or such other proceeding as is used in other cases for compelling the appearance of a party.

*Act of Congress of April 17th, 1800, c. 25. Story's Laws of the U. S. v. 1, p. 752. Repealed by act of July 4th, 1836. c. 357.*

An act to extend the privilege of obtaining patents for useful discoveries and inventions, to certain persons therein mentioned, and to enlarge and define the penalties for violating the rights of patentees.

Sec. 1. Alien patentees. Oath by them. 2. Application by representatives of patentee. Oath varied.	Sec. 3. Penalty for infringement (substitute for s. 4 of act of 1793.) Jurisdiction. 4. Repeal of 5th sec. of act of 1793.
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§ 1. *Be it enacted, &c.* That all and singular the rights and privileges given, intended, or provided, to citizens of the United States, respecting patents for new inventions, discoveries, and improvements, by the act, entitled “An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose,” shall be, and hereby are, extended and given to all aliens who, at the time of petitioning in the manner prescribed by the said act, shall have resided for two years within the United States, which privileges shall be obtained, used, and enjoyed, by such persons, in as full and ample manner, and under the same conditions, limitations, and restrictions, as by the said act is provided and directed in the case of citizens of the United States. *Provided, always,* That every person petitioning for a patent for any invention, art, or discovery, pursuant to this act, shall make oath or affirmation before some person duly authorized to administer oaths, before such patent shall be granted, that such invention, art, or discovery, hath not, to the best of his or her knowledge or belief, been known or used either in this or any foreign country; and that every patent which shall be obtained pursuant to this act, for any invention, art, or discovery, which it shall afterwards appear had been known or used previous to such application for a patent, shall be utterly void.

§ 2. That where any person hath made, or shall have made, any new invention, discovery, or improvement on account of which a patent might, by virtue of this or the above mentioned

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act, be granted to such person as shall die before any patent shall be granted therefor; the right of applying for and obtaining such patent, shall devolve on the legal representatives of such person, in trust for the heirs at law of the deceased, in case he shall have died intestate; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations, and restrictions, as the same was held, or might have been claimed or enjoyed, by such person, in his or her life time; and when application for a patent shall be made by such legal representatives, the oath or affirmation, provided in the third section of the before mentioned act, shall be so varied as to be applicable to them.

§ 3. That where any patent shall be, or shall have been, granted, pursuant to this or the above mentioned act, and any person, without the consent of the patentee, his or her executors, administrators, or assigns, first obtained, in writing, shall make, devise, use, or sell, the thing whereof the exclusive right is secured to the said patentee by such patent, such person, so offending, shall forfeit and pay to the said patentee, his executors, administrators, or assigns, a sum equal to three times the actual damage sustained by such patentee, his executors, administrators, or assigns, from or by reason of such offence, which sum shall and may be recovered, by action on the case, founded on this and the above mentioned act, in the circuit court of the United States having jurisdiction thereof.

§ 4. That the fifth section of the above mentioned act, entitled "An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," shall be, and hereby is, repealed.

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*Act of Congress of Feb. 15, 1819, c. 143. Story's Laws of U. S. v. 3, p. 1719. Repealed by act of July 4th, 1836, c. 357.*

An act to extend the jurisdiction of the circuit courts of the United States to cases arising under the law relating to patents.

Jurisdiction. Appeal.

§ 1. *Be it enacted, &c.* That the circuit courts of the Uni-



ted States shall have original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases, arising under any law of the United States, granting or confirming to authors or inventors the exclusive right to their respective writings, inventions, and discoveries; and upon any bill in equity, filed by any party aggrieved in any such cases, shall have authority to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any authors or inventors, secured to them by any laws of the United States, on such terms and conditions as the said courts may deem fit and reasonable: *Provided, however,* That from all judgments and decrees of any circuit courts, rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the supreme court of the United States, in the same manner, and under the same circumstances, as is now provided by law in other judgments and decrees of such circuit courts.

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*Act of July 3d, 1832, c. 162. Repealed by act of July 4th, 1836.*

**An act concerning Patents for Useful Inventions.**

Sec. 1. Publication of the list of expired patents.  
2. Applications to prolong the term of patents.

Sec. 3. Surrender of patents on account of defects in the specification; and taking out new patents.

§ 1. *Be it enacted, &c.* That it shall be the duty of the secretary of state, annually, in the month of January, to report to congress, and to publish in two of the newspapers printed in the city of Washington, a list of all the patents for discoveries, inventions, and improvements, which shall have expired within the year immediately preceding, with the names of the patentees alphabetically arranged.

§ 2. That application to congress to prolong or renew the term of a patent, shall be made before its expiration, and shall be notified at least once a month, for three months before its presentation, in two newspapers printed in the city of Washington, and in one of the newspapers in which the laws of the United States shall be published in the state or territory in which the

patentee shall reside. The petition shall set forth particularly the grounds of the application. It shall be verified by oath; the evidence in its support may be taken before any judge or justice of the peace; it shall be accompanied by a statement of the ascertained value of the discovery, invention, or improvement, and of the receipts and expenditures of the patentee, so as to exhibit the profit or loss arising therefrom.

§ 3. That wherever any patent which has been heretofore, or shall be hereafter, granted to any inventor in pursuance of the act of congress entitled “An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose, passed on the twenty-first day of February, in the year of our Lord one thousand seven hundred and ninety-three, or of any of the acts supplementary thereto, shall be invalid or inoperative, by reason that any of the terms or conditions prescribed in the third section of the said first mentioned act, have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, been complied with on the part of the said inventor, it shall be lawful for the secretary of state, upon the surrender to him of such patent, to cause a new patent to be granted to the said inventor for the same invention for the residue of the period then unexpired, for which the original patent was granted, upon his compliance with the terms and conditions prescribed in the said third section of the said act. And, in case of his death, or any assignment by him made of the same patent, the like right shall vest in his executors and administrators, or assignee or assignees: *Provided, however,* That such new patent, so granted, shall, in all respects, be liable to the same matters of objection and defence as any original patent granted under the said first mentioned act. But no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be a free public use thereof, shall, in any manner, prejudice his right of recovery for any use or violation of his invention after the grant of such new patent as aforesaid.

*Act of July 13th, 1832, c. 202. Repealed by act of July 4th, 1836.*

An act concerning the issuing of patents to aliens, for useful discoveries and inventions.

Sec. 1. Alien patentees.

§ 1. *Be it enacted, &c.* That the privileges granted to the aliens described in the first section of the act, to extend the privilege of obtaining patents for useful discoveries and inventions to certain persons therein mentioned, and to enlarge and define the penalties for violating the rights of patentees, approved April 17th, 1800, be extended, in like manner, to every alien, who at the time of petitioning for a patent, shall be resident in the United States, and shall have declared his intention, according to law, to become a citizen thereof. *Provided,* That every patent granted by virtue of this act and the privileges thereto appertaining, shall cease and determine and become absolutely void, without resort to any legal process to annul or cancel the same in case of the failure on the part of any patentee, for the space of one year from the issuing thereof, to introduce into public use in the United States, the invention or improvement for which the patent shall be issued; or in case the same for any period of six months after such introduction shall not continue to be publicly used and applied in the United States; or in case of failure to become a citizen of the United States, agreeably to notice given at the earliest period within which he shall be entitled to become a citizen of the United States.

*Act of July 4th, 1836, c. 357.*

An act to promote the progress of useful arts, and to repeal all acts and parts of acts heretofore made for that purpose.

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| <p>Sec. 1. Commissioner.</p> <p>2. Other officers and clerks.</p> <p>3. Oath and bonds of officers.</p> <p>4. Seal. Certified copies of records and papers to be evidence.</p> <p>5. The patent.</p> <p>6. The specification. Drawings. Models. Oath.</p> <p>7. When the commissioner shall grant a patent. When he shall refuse. Reasons to be given for refusal. Return of part of fee if application withdrawn. Board of examiners appointed if the application is persisted in. Proceedings. Fees of examiners.</p> <p>8. Applications interfering with others, or with existing patents, referred to examiners. A patent taken out abroad within six months before the filing the specification, for the same invention, is no ground of objection. Patent to be dated at time of filing specification, not over six months back, in case of request. Specification to be filed in secret archives of patent office, on request, not more than one year.</p> <p>9. Fees to be paid by patentees.</p> <p>10. Representatives of patentee entitled to take out pa-</p> | <p>tent in case of his de-<br/>cease.</p> <p>Sec. 11. Assignments.</p> <p>12. Caveat.</p> <p>13. Surrender of patent on account of defective specification. New patent issued.</p> <p>14. Damages for an infringement.</p> <p>15. Plea of general issue. Notice of grounds of defence. Evidence. Notice of names of persons who have known or used the invention, and places where. Use in a foreign country of an invention not patented or described in any printed publication. Costs in case of judgment against plaintiff on ground of his claiming too much, and of a violation of the part rightfully claimed and truly described.</p> <p>16. Remedy in equity in case of applications interfering with others or with existing patents.</p> <p>17. Jurisdiction of patent causes.</p> <p>18. Prolongation of the term of a patent.</p> <p>19. Library of patent office.</p> <p>20. Arrangement of the models in the patent office.</p> <p>21. Repeal of former acts. Suits pending at the time of passing this act, to be prosecuted.</p> |
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§ 1. *Be it enacted, &c.* That there shall be established and attached to the department of state, an office to be denominated the patent office; the chief officer of which shall be called the commissioner of patents, to be appointed by the president, by and with the advice and consent of the senate, whose duty

it shall be, under the direction of the secretary of state, to superintend, execute, and perform, all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions, and improvements, as are herein provided for, or shall hereafter be, by law, directed to be done and performed, and shall have the charge and custody of all the books, records, papers, models, machines, and all other things belonging to said office. And said commissioner shall receive the same compensation as is allowed by law to the commissioner of the Indian department, and shall be entitled to send and receive letters and packages by mail, relating to the business of the office, free of postage.

§ 2. That there shall be, in said office, an inferior officer, to be appointed by the said principal officer, with the approval of the secretary of state, to receive an annual salary of seventeen hundred dollars, and to be called the chief clerk of the patent office; who, in all cases during the necessary absence of the commissioner, or when the said principal office shall become vacant, shall have the charge and custody of the seal, and of the records, books, papers, machines, models, and all other things belonging to the said office, and shall perform the duties of commissioner during such vacancy. And the said commissioner may also, with like approval, appoint an examining clerk, at an annual salary of fifteen hundred dollars; two other clerks, at twelve hundred dollars each, one of whom shall be a competent draughtsman; one other clerk at one thousand dollars; a machinist at twelve hundred and fifty dollars, and a messenger at seven hundred dollars. And said commissioner, clerks, and every other person appointed and employed in said office, shall be disqualified and interdicted from acquiring or taking, except by inheritance, during the period for which they shall hold their appointments, respectively, any right or interest, directly or indirectly, in any patent for an invention or discovery which has been, or may hereafter be, granted.

§ 3. That the said principal officer, and every other person to be appointed in the said office, shall, before he enters upon

the duties of his office or appointment, make oath or affirmation, truly and faithfully to execute the trust committed to him. And the said commissioner and the chief clerk shall also, before entering upon their duties, severally give bonds with sureties to the treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, with condition to render a true and faithful account to him or his successor in office, quarterly, of all moneys which shall be by them respectively received for duties on patents, and for copies of records and drawings, and all other moneys received by virtue of said office.

§ 4. That the said commissioner shall cause a seal of office to be made and provided for the said office, with such device as the president of the United States shall approve; and copies of any records, books, papers, or drawings, belonging to the said office, under the signature of the said commissioner, or, when the office shall be vacant, under the signature of the chief clerk, with the said seal affixed, shall be competent evidence in all cases in which the original records, books, papers, or drawing, could be evidence. And any person making application therefor, may have certified copies of the records, drawings, and other papers deposited in said office, on paying, for the written copies, the sum of ten cents for every page of one hundred words; and for copies of drawings, the reasonable expense of making the same.

§ 5. That all patents issuing from said office shall be issued in the name of the United States, and under the seal of said office, and be signed by the secretary of state, and countersigned by the commissioner of the said office, and shall be recorded, together with the descriptions, specifications, and drawings, in the said office, in books to be kept for that purpose. Every such patent shall contain a short description or title of the invention or discovery, correctly indicating its nature and design, and in its terms grant to the applicant or applicants, his or their heirs, administrators, executors, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, using, and vending to

others to be used, the said invention or discovery, referring to the specifications for the particulars thereof, a copy of which shall be annexed to the patent, specifying what the patentee claims as his invention or discovery.

§ 6. That any person or persons having discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used by others before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer, and shall desire to obtain an exclusive property therein, may make application in writing to the commissioner of patents, expressing such desire, and the commissioner, on due proceedings had, may grant a patent therefor. But before any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of any machine, he shall fully explain the principle and the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions; and shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery. He shall, furthermore, accompany the whole with a drawing or drawings, and written references, where the nature of the case admits of drawings, or with specimens of ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention or discovery is of a composition of matter; which descriptions and drawings, signed by the inventor and attested by two witnesses, shall be filed in the patent office; and he shall moreover furnish a model of his invention,

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in all cases which admit of a representation by model, of a convenient size to exhibit advantageously its several parts. The applicant shall also make oath or affirmation that he does verily believe that he is the original and first inventor or discoverer of the art, machine, composition, or improvement, for which he solicits a patent, and that he does not know or believe that the same was ever before known or used, and also of what country he is a citizen; which oath or affirmation may be made before any person authorized by law to administer oaths.

§ 7. That, on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. But whenever, on such examination, it shall appear to the commissioner that the applicant was not the original and first inventor or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented, or described in any printed publication in this or any foreign country, as aforesaid, or that the description is defective and insufficient, he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification to embrace only that part of the invention or discovery which is new. In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars, part of the duty required by this act, on filing



a notice in writing of such election in the patent office, a copy of which, certified by the commissioner, shall be a sufficient warrant to the treasurer for paying back to the said applicant the said sum of twenty dollars. But if the applicant in such case shall persist in his claim for a patent, with or without any alteration of his specification, he shall be required to make oath or affirmation anew, in manner as aforesaid. And if the specification and claim shall not have been so modified as, in the opinion of the commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the secretary of state, one of whom, at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains; who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate, in writing, of the opinion and decision of the commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, as well as to the commissioner, of the time and place of their meeting, that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision; and it shall be the duty of the commissioner to furnish to the board of examiners such information as he may possess relative to the matter under their consideration. And on an examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the commissioner, either in whole or in part, and their opinion being certified to the commissioner, he shall be governed thereby, in the further proceedings to be had on such application: Provided, however, That before a board shall be instituted in any such case, the applicant shall pay to the credit of the treasury, as provided in the ninth sec-

tion of this act, the sum of twenty-five dollars, and each of said persons so appointed shall be entitled to receive for his services in each case, a sum not exceeding ten dollars, to be determined and paid by the commissioner out of any moneys in his hands, which shall be in full compensation to the persons who may be so appointed, for their examination and certificate as aforesaid.

§ 8. That whenever an application shall be made for a patent which, in the opinion of the commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the commissioner to give notice thereof to such applicants, or patentees, as the case may be; and if either shall be dissatisfied with the decision of the commissioner on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had, to determine which or whether either of the applicants is entitled to receive a patent as prayed for. But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters-patent therefor in a foreign country, and the same having been published, at any time, within six months next preceding the filing of the specification and drawing. And whenever the applicant shall request it, the patent shall take date from the time of the filing of the specification and drawings, not however exceeding six months prior to the actual issuing of the patent; and on like request, and the payment of the duty herein required, by any applicant, his specification and drawings shall be filed in the secret archives of the office until he shall furnish the model and the patent be issued, not exceeding the term of one year; the applicant being entitled to notice of interfering applications.

§ 9. That before any application for a patent shall be considered by the commissioner as aforesaid, the applicant shall pay into the treasury of the United States, or into the patent

office, or into any of the deposite banks to the credit of the treasury, if he be a citizen of the United States, or an alien and shall have been resident in the United States for one year next preceding, and shall have made oath of his intention to become a citizen thereof, the sum of thirty dollars; if a subject of the king of Great Britain, the sum of five hundred dollars; and all other persons the sum of three hundred dollars; for which payment duplicate receipts shall be taken, one of which to be filed in the office of the treasurer. And the moneys received into the treasury under this act, shall constitute a fund for the payment of the salaries of the officers and clerks herein provided for, and all other expenses of the patent office, and to be called the patent fund.

§ 10. That where any person hath made, or shall have made, any new invention, discovery, or improvement, on account of which a patent might by virtue of this act be granted, and such person shall die before any patent shall be granted therefor, the right of applying for and obtaining such patent shall devolve on the executor or administrator of such person, in trust for the heirs at law of the deceased, in case he shall have died intestate; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations, and restrictions, as the same was held, or might have been claimed or enjoyed by such person in his or her lifetime; and when application for a patent shall be made by such legal representatives, the oath or affirmation provided in the sixth section of this act, shall be so varied as to be applicable to them.

§ 11. That every patent shall be assignable in law, either as to the whole interest, or any undivided part thereof, by any instrument in writing; which assignment, and also every grant and conveyance of the exclusive right under any patent, to make and use and to grant to others to make and use the thing patented within and throughout any specified part or portion of the United States, shall be recorded in the patent office within three months from the execution thereof, for which the assignee or grantee shall pay to the commissioner the sum of three dollars.

§ 12. That any citizen of the United States, or alien who shall have been resident in the United States one year next preceding, and shall have made oath of his intention to become a citizen thereof, who shall have invented any new art, machine, or improvement thereof, and shall desire further time to mature the same, may, on paying to the credit of the treasury, in manner as provided in the ninth section of this act, the sum of twenty dollars, file in the patent office a caveat, setting forth the design and purpose thereof, and its principal and distinguishing characteristics, and praying protection of his right, till he shall have matured his invention; which sum of twenty dollars, in case the person filing such caveat shall afterwards take out a patent for the invention therein mentioned, shall be considered a part of the sum herein required for the same. And such caveat shall be filed in the confidential archives of the office, and preserved in secrecy. And if application shall be made by any other person within one year from the time of filing such caveat, for a patent of any invention with which it may in any respect interfere, it shall be the duty of the commissioner to deposite the description, specifications, drawings, and model, in the confidential archives of the office, and to give notice, by mail, to the person filing the caveat, of such application, who shall, within three months after receiving the notice, if he would avail himself of the benefit of his caveat, file his description, specifications, drawings, and model; and if, in the opinion of the commissioner, the specifications of claim interfere with each other, like proceedings may be had in all respects as are in this act provided in the case of interfering applications: Provided, however, That no opinion or decision of any board of examiners, under the provisions of this act, shall preclude any person interested in favor of or against the validity of any patent which has been or may hereafter be granted, from the right to contest the same in any judicial court in any action in which its validity may come in question.

§ 13. That whenever any patent which has heretofore been granted, or which shall hereafter be granted, shall be inoperative or invalid, by reason of a defective or insufficient descrip-

tion or specification, or by reason of the patentee claiming in his specification as his own invention, more than he had or shall have a right to claim as new; if the error has, or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the commissioner, upon the surrender to him of such patent, and the payment of the further duty of fifteen dollars, to cause a new patent to be issued to the said inventor for the same invention, for the residue of the period then unexpired for which the original patent was granted, in accordance with the patentee's corrected description and specification. And in case of his death, or any assignment by him made of the original patent, a similar right shall vest in his executors, administrators, or assignees. And the patent, so reissued, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all actions hereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form, before the issuing out of the original patent. And whenever the original patentee shall be desirous of adding the description and specification of any new improvement of the original invention or discovery which shall have been invented or discovered by him subsequent to the date of his patent, he may, like proceedings being had in all respects as in the case of original applications, and on the payment of fifteen dollars, as herein before provided, have the same annexed to the original description and specification; and the commissioner shall certify, on the margin of such annexed description and specification, the time of its being annexed and recorded; and the same shall thereafter have the same effect in law, to all intents and purposes, as though it had been embraced in the original description and specification.

§ 14. That whenever, in any action for damages, for making, using, or selling the thing whereof the exclusive right is secured by any patent heretofore granted, or by any patent which may hereafter be granted, a verdict shall be rendered for the plaintiff in such action, it shall be in the power of the

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court to render judgment for any sum above the amount found by such verdict as the actual damages sustained by the plaintiff, not exceeding three times the amount thereof, according to the circumstances of the case, with costs; and such damages may be recovered by action on the case, in any court of competent jurisdiction, to be brought in the name or names of the person or persons interested, whether as patentee, assignees, or as grantees of the exclusive right within and throughout a specified part of the United States.

§ 15. That the defendant in any such action shall be permitted to plead the general issue, and to give this act and any special matter in evidence, of which notice in writing may have been given to the plaintiff or his attorney, thirty days before trial, tending to prove that the description and specification filed by plaintiff does not contain the whole truth relative to his invention or discovery, or that it contains more than is necessary to produce the described effect; which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, or that the patentee was not the original and first inventor or discoverer of the thing patented, or of a substantial and material part thereof claimed as new, or that it had been described in some public work anterior to the supposed discovery thereof by the patentee, or had been in public use, or on sale with the consent and allowance of the patentee before his application for a patent, or that he had surreptitiously or unjustly obtained the patent for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same; or that the patentee, if an alien at the time the patent was granted, had failed and neglected for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reasonable terms, the invention or discovery for which the patent issued; in either of which cases judgment shall be rendered for the defendant, with costs. And whenever the defendant relies in his defence on the fact of a previous invention, knowledge or use of the thing patented, he shall state in his notice of special matter the names and places

of residence of those whom he intends to prove to have possessed a prior knowledge of the thing and where the same had been used: Provided, however, That whenever it shall satisfactorily appear that the patentee, at the time of making his application for the patent, believed himself to be the first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery or any part thereof having been before known or used in any foreign country, it not appearing that the same or any substantial part thereof had before been patented or described in any printed publication. And provided, also, That whenever the plaintiff shall fail to sustain his action on the ground that in his specification of claim is embraced more than that of which he was the first inventor, if it shall appear that the defendant had used or violated any part of the invention justly and truly specified and claimed as new, it shall be in the power of the court to adjudge and award as to costs as may appear to be just and equitable.

§ 16. That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative and invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant,

shall authorize the commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. Provided, however, That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment.

§ 17. That all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions or discoveries, shall be originally cognizable, as well in equity as at law, by the circuit courts of the United States, or any district court having the powers and jurisdiction of a circuit court; which courts shall have power upon bill in equity filed by any party aggrieved, in any such case, to grant injunctions according to the course and principles of courts of equity, to prevent the violation of the rights of any inventor as secured to him by any law of the United States, on such terms and conditions as said courts may deem reasonable: Provided, however, That from all judgments and decrees from any such court rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the supreme court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of circuit courts, and in all other cases in which the court shall deem it reasonable to allow the same.

§ 18. That whenever any patentee of an invention or discovery shall desire an extension of his patent beyond the term of its limitation, he may make application therefor, in writing, to the commissioner of the patent office, setting forth the grounds thereof; and the commissioner shall, on the applicant's paying the sum of forty dollars to the credit of the treasury, as in the case of an original application for a patent, cause to be published in one or more of the principal newspapers in the city of Washington, and in such other paper or papers as he may deem proper, published in the section of country most interested adversely to the extension of the patent, a notice of such application and of the time and place when and



where the same will be considered, that any person may appear and show cause why the extension should not be granted. And the secretary of state, the commissioner of the patent office, and the solicitor of the treasury, shall constitute a board to hear and decide upon the evidence produced before them both for and against the extension, and shall sit for that purpose at the time and place designated in the published notice thereof. The patentee shall furnish to said board a statement, in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of said invention. And if, upon a hearing of the matter, it shall appear to the full and entire satisfaction of said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the commissioner to renew and extend the patent, by making a certificate thereon of such extension, for the term of seven years from and after the expiration of the first term; which certificate, with a certificate of said board of their judgment and opinion as aforesaid, shall be entered on record in the patent office; and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years. And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interest therein: Provided, however, That no extension of a patent shall be granted after the expiration of the term for which it was originally issued.

§ 19. That there shall be provided for the use of said office, a library of scientific works and periodical publications, both foreign and American, calculated to facilitate the discharge of the duties hereby required of the chief officers there-

in, to be purchased under the direction of the committee of the library of congress. And the sum of fifteen hundred dollars is hereby appropriated, for that purpose, to be paid out of the patent fund.

§ 20. That it shall be the duty of the commissioner to cause to be classified and arranged, in such rooms or galleries as may be provided for that purpose, in suitable cases, when necessary for their preservation, and in such manner as shall be conducive to a beneficial and favorable display thereof, the models and specimens of compositions, and of fabrics and other manufactures and works of art, patented or unpatented, which have been, or shall hereafter be deposited in said office. And said rooms or galleries shall be kept open during suitable hours for public inspection.

§ 21. That all acts and parts of acts heretofore passed on this subject be, and the same are hereby repealed: Provided, however, That all actions and processes in law or equity, sued out prior to the passage of this act, may be prosecuted to final judgment and execution, in the same manner as though this act had not been passed, excepting and saving the application to any such action, of the provisions of the fourteenth and fifteenth sections of this act, so far as they may be applicable thereto. And provided, also, that all applications or petitions for patents pending at the time of the passage of this act, in cases where the duty has been paid, shall be proceeded with and acted on in the same manner as though filed after the passage hereof.

## BRITISH PATENT ACTS—IN FORCE.

*An Act concerning Monopolies and Dispensations with penal laws, and the forfeitures thereof. 21 James I. c. 3. A. D. 1623.*

Sect. 1. Monopolies abolished.

5. Letters patent for new manufactures excepted.

Sect. 6. Letters patent to be granted, in future.

1. Be it enacted, &c. That all monopolies, and all commissions, grants, licenses, charters, and letters patent heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of any thing within this realm, or the dominion of *Wales*, &c. are altogether contrary to the laws of this realm and so are and shall be utterly void and of none effect, and in nowise to be put in ure or execution.

5. That any declaration before mentioned shall not extend to any letters patents and grants of privilege for the term of one and twenty years or under, heretofore made, of the sole working or making of any manner of new manufacture within this realm, to the first and true inventor or inventors of such manufactures, which others at the time of the making of such letters patents and grants did not use, so they be not contrary to the law, nor mischievous to the state, by raising of the prices of commodities at home, or hurt of trade, or generally inconvenient, but that the same shall be of such force as they were or should be, if this act had not been made, and of none other: and if the same were made for more than one and twenty years, that then the same for the term of one and twenty years only, to be accounted from the date of the first letters patents and grants thereof made, shall be of such force as they were or should have been, if the same had been made

but for term of one and twenty years only, and as if this act had never been had or made, and of none other.

6. That any declaration before-mentioned shall not extend to any letters patents and grants of privilege for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures, within this realm, to the true and first inventor and inventors, of such manufactures, which others at the time of making such letters patents and grants shall not use, so as also they be not contrary to the law, nor mischievous to the state, by raising prices of commodities at home, or hurt of trade, or generally inconvenient: the said fourteen years to be accounted from the date of the first letters patents, or grant of such privilege hereafter to be made, but that the same shall be of such force as they should be, if this act had never been made, and of none other.

*An Act to amend the law touching Letters-Patent for Inventions. 2 Stat. 5 & 6 Will. IV. c. 83. Sept. 10, 1835.*

Sec. 1. Disclaimer of a part of the specification.

Entry of a memorandum of an addition to the specification.

Caveat.

Disclaimer not to affect pending actions.

Disclaimer to be advertised in case, &c.

2. Mode of proceeding where the patentee proves not to be the original inventor, though he believed himself to be so.

Sec. 3. Certificate of a verdict in favor of a patentee in a former suit to entitle him to treble costs.

4. Prolongation of the term of patents.

5. Notice of objections to patent, to be given before trial.

6. Costs in actions for infringement.

7. Penalty for using unauthorized the name of patentee, his stamp or mark.

Whereas it is expedient to make certain additions to and alterations in the present law touching letters patent for inventions, as well for the better protecting of patentees in the rights intended to be secured by such letters patent, as for the more ample benefit of the public from the same: be it enacted by the king's most excellent majesty, by and with the advice and consent of the lords spiritual and temporal, and commons, in this present parliament assembled, and by the authority of the

same, that any person who, as grantee, assignee, or otherwise, hath obtained or who shall hereafter obtain letters patent, for the sole making, exercising, vending, or using of any invention, may, if he think fit, enter with the clerk of the patents of England, Scotland, or Ireland, respectively, as the case may be, having first obtained the leave of his majesty's attorney general or solicitor general in case of an English patent, of the lord advocate or solicitor general of Scotland in the case of a Scotch patent, or of his majesty's attorney general or solicitor general for Ireland in the case of an Irish patent, certified by his fiat and signature, a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer, or may, with such leave as aforesaid, enter a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent; and such disclaimer or memorandum of alteration being filed by the said clerk of the patents, and enrolled with the specification, shall be deemed and taken to be part of such letters patent or such specification in all courts whatever<sup>1</sup>: provided always, that any person may enter a caveat, in like manner as caveats are now used to be entered, against such disclaimer or alteration; which

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<sup>1</sup> The nature of the mischiefs to be remedied in this section will be very clearly understood by a reference to the extracts from the evidence of Mr. Taylor and Mr. Farey, given in this Appendix: they consisted mainly in the necessity under which inventors found themselves of keeping their inventions secret until the sealing of the patent, which, coupled with the difficulty of specifying correctly without the aid of experiments incompatible with the secrecy observed up to the time of sealing, and equally incompatible with the shortness of the time allowed for specifying after the sealing, occasioned sometimes deficiencies in the specification, sometimes discrepancies between it and the title, either of which faults was sufficient to avoid the patent. It was held even before the passing of this act, that the inventor might embody in his specification any improvements which occurred to him between the periods of sealing the patent and enrolling the specification. *Crossley v. Beverley*, 9 B. & C. 63. But then the improvements must not have been such as to render the title in the patent inapplicable to the specification, for that would have been fatal to the rights of the patentee. [*Smith's Epitome of Law relating to Pat. Ed. 1836. Lond. p 42, n.*]

caveat being so entered shall give the party entering the same a right to have notice of the application being heard by the attorney general, or solicitor general, or lord advocate, respectively : provided also, that no such disclaimer or alteration shall be receivable in evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time when such disclaimer or alteration was enrolled, but in every such action or suit the original title and specification alone shall be given in evidence, and deemed and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted : provided also, that it shall be lawful for the attorney general, or solicitor general, or lord advocate, before granting such fiat, to require the party applying for the same to advertise his disclaimer or alteration in such manner as to such attorney general, or solicitor general, or lord advocate shall seem right, and shall, if he so require such advertisement, certify in his fiat that the same has been duly made.

2. That if in any suit or action it shall be proved or specially found by the verdict of a jury that any person who shall have obtained letters patent for any invention or supposed invention, was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same, or some part thereof, before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, it shall and may be lawful for such patentee or his assigns to petition his majesty in council to confirm the said letters patent or to grant new letters patent, the matter of which petition shall be heard before the judicial committee of the privy council ; and such committee, upon examining the said matter, and being satisfied that such patentee believed himself to be the first and original inventor, and being satisfied that such invention or part thereof had not been publicly and generally used before the date of such first letters patent, may report to his majesty their opinion that the prayer of such pe-

tion ought to be complied with, whereupon his majesty may, if he think fit, grant such prayer; and the said letters patent shall be available in law and equity to give to such petitioner the sole right of using, making, and vending such invention as against all persons whatsoever, any law, usage or custom to the contrary thereof notwithstanding: provided, that any person opposing such petition shall be entitled to be heard before the said judicial committee: provided also, that any person, party to any former suit or action touching such first letters patent, shall be entitled to have notice of such petition before presenting the same.<sup>1</sup>

3. That if any action at law or any suit in equity for an account shall be brought in respect of any alleged infringement of such letters patent heretofore or hereafter granted, or any *scire facias* to repeal such letters patent, and if a verdict shall pass for the patentee or his assigns, or if a final decree or decretal order shall be made for him or them, upon the merits of the suit, it shall be lawful for the judge before whom such action shall be tried to certify on the record, or the judge who shall make such decree or order to give a certificate under his hand, that the validity of the patent came in question before him, which record or certificate being given in evidence in any

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<sup>1</sup> Hitherto, if an inventor could have managed to use his discovery in such a manner as to enjoy the benefit of it without laying his process open to discovery, he might have enjoyed all the advantages of a patentee without obtaining a patent, and of course without putting the public in possession of his discovery through the medium of a specification; and yet although the same idea might subsequently occur to some other person, who might be anxious to obtain a patent for it, the previous user by the first discoverer would have been sufficient to prevent the grant or to avoid the instrument if granted, so that the public would have been altogether deprived of the advantage arising from a specification. A singular instance of this kind of mischief seems to have occurred in Mr. Watt's case, whose specification, though upheld by the courts, is stated in the evidence before the select committee to have been totally useless and unintelligible in practice. The consequence of which was, that the enjoyment of Mr. Watt's exclusive privileges continued for nearly thirty years after the expiration of the patent. [*Smith's Epitome of Law relating to Pat. Ed. 1835. Lond. p. 44, n.*]

other suit or action whatever touching such patent, if a verdict shall pass, or decree or decretal order be made, in favor of such patentee or his assigns, he or they shall receive treble costs in such suit or action, to be taxed at three times the taxed costs, unless the judge making such second or other decree or order, or trying such second or other action, shall certify that he ought not to have such treble costs.

4. That if any person who now hath or shall hereafter obtain any letters patent as aforesaid, shall advertise in the London Gazette three times, and in three London papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of any thing made according to his specification, or near to or in which he resides, in case he carried on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to apply to his majesty in council for a prolongation of his term of sole using and vending his invention, and shall petition his majesty in council to that effect, it shall be lawful for any person to enter a caveat at the council office ; and if his majesty shall refer the consideration of such petition to the judicial committee of the privy council, and notice shall first be by him given to any person or persons who shall have entered such caveats, the petitioner shall be heard by his counsel and witnesses to prove his case, and the persons entering caveats shall likewise be heard by their counsel and witnesses ; whereupon, and upon hearing and inquiring of the whole matter, the judicial committee may report to his majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years ; and his majesty is hereby authorized and empowered, if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom, or usage to the contrary in anywise notwithstanding : provided that no such extension shall be granted, if the application by petition shall not be made and prosecuted with



effect before the expiration of the term originally granted in such letters patent.<sup>1</sup>

5. That in any action brought against any person for infringing any letters patent, the defendant on pleading thereto shall give to the plaintiff, and in any *scire facias* to repeal such letters patent the plaintiff shall file with his declaration, a notice of any objections on which he means to rely at the trial of such action, and no objection shall be allowed to be made in behalf of such defendant or plaintiff respectively at such trial, unless he prove the objections stated in such notice : provided always, that it shall and may be lawful for any judge at chambers, on summons served by such defendant or plaintiff on such plaintiff or defendant respectively, to show cause why he should not be allowed to offer other objections whereof notice shall not have been given as aforesaid, to give leave to offer such objections, on such terms as to such judge shall seem fit.

6. That in any action brought for infringing the right granted by any letters patent, in taxing the costs thereof regard shall be had to the part of such case which has been proved at the trial, which shall be certified by the judge before whom the same shall be had, and the costs of each part of the case shall be given according as either party has succeeded or failed therein, regard being had to the notice of objections, as well as the counts in the declaration, and without regard to the general result of the trial.

7. That if any person shall write, paint, or print, or mould, cast, or carve, or engrave or stamp, upon any thing made, used, or sold by him, for the sole making or selling of which he hath not or shall not have obtained letters patent, the name or any imitation of the name of any other person who hath or shall have obtained letters patent for the sole making and vending of such thing, without leave in writing of such patentee or his assigns, or if any person shall upon such thing, not having been purchased from the patentee or some person who purchased it from or under such patentee, or not having had the license or

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<sup>1</sup> Heretofore a patent could only have been prolonged by act of parliament.

consent in writing of such patentee or his assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "patent," the words "letters patent," or the words "by the king's patent," or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee, or shall in any other manner imitate or counterfeit the stamp or mark or other device of the patentee, he shall for every such offence be liable to a penalty of fifty pounds, to be recovered by action of debt, bill, plaint, process, or information in any of his majesty's courts of record at Westminster or in Ireland, or in the court of session in Scotland, one half to his majesty, his heirs and successors, and the other to any person who shall sue for the same; provided always, that nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping or in any way marking the word "patent" upon any thing made, for the sole making or vending of which a patent before obtained shall have expired.

#### FRENCH LAW OF PATENTS.

*For an Abstract of the French law of patents, see supra, p. 27.*

## PATENT LAWS OF THE NETHERLANDS.

### *Law of January 25th 1817.<sup>1</sup>*

ARTICLE 1st.—Exclusive rights may be granted by us, for a limited time, by letters patent, under the title of patents of invention, on petitions which shall be made to us for the same, to those who, in the kingdom, shall have made an invention or essential improvement in any branch of arts or manufactures; and also to those who shall first introduce, or practise in the kingdom, an invention or improvement made in foreign countries.

2d.—The grants of patents of invention shall not interfere with any rights previously acquired by others; and the grant shall be void, if it is proved that the invention, or the improvement for which any one shall have obtained a patent, have been employed, put in operation, or exercised by another in the kingdom, before the grant of the patent.

3d.—Patents of invention shall be granted for the terms of five, ten, or fifteen years. The tax to be paid for obtaining a patent, shall be proportionate to the duration of the patent and to the importance of the invention or improvement; but shall never exceed the sum of 750 *francs*, nor be less than 150 *francs*.

4th.—A patent of invention granted for the term of five or ten years, may also be prolonged at the expiration of that term, if there are strong reasons to support the petition made to that effect; but its total duration can never exceed the term of fifteen years.

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<sup>1</sup> This translation of the patent laws of the Netherlands, is copied from the Appendix to the Report of the Commissioners of the British House of Commons of June 8th, 1829. It was supplied to the Commissioners, by Mr. John Farey.

5th.—Patents of invention for the introduction or application of inventions or improvements made in foreign countries, and for which the inventors have patents in those countries, shall not be granted for a longer time, than that during which the exclusive right granted in such foreign country for those objects shall last; and they shall contain an express clause, that the objects named shall be manufactured in the kingdom.

6th.—Patents of invention shall give to their possessors the right, or their agents, the right.

(a) Of making and selling exclusively throughout the kingdom, during the time fixed for the duration of the patent, the objects named in it; or of causing them to be made, and sold, by others whom they shall authorize to do so.

(b) Of citing before the courts of law those persons who shall infringe upon the exclusive right which has been granted to them, and of proceeding against such persons at law, in order to obtain the confiscation, for their own advantage, of those objects named in the patent, which have been made by such persons, but not yet sold; and also, of the price obtained for those objects which shall have been already sold; as well as to institute an action for damages, as far as there are grounds for the same.

7th.—Whoever shall present a petition, in order to obtain a patent of invention, shall be bound to join thereto, sealed up, an exact and detailed description, and signed by him, of the object or the secret, for which the patent is solicited, together with the necessary plans and drawings; that description shall be published after the expiration of the term of the patent of invention, whether it be the original term, or a prolonged term; or even sooner, in case the patent, for any of the causes assigned hereinafter, shall be declared void.

The government, may nevertheless, defer that publication, if it should be judged necessary, for important reasons.

8th.—A patent of invention shall be declared void, for the following causes:—

(a) When the patentee shall have fraudulently omitted, in the description joined to his petition, to make mention of any part of his secret, or shall have stated it in a false manner.

(b) If it should appear that the object for which a patent has been granted, was already described, prior to the date of the patent, in any work printed and published.

(c) When the patentee shall not have made use of his patent, within the space of two years, reckoning from the date of his patent; unless there have been strong reasons for that delay, of which reasons the government shall judge.

(d) If the person who has obtained a patent of invention, should obtain one subsequently for the same invention in a foreign country.

(e) If it should appear that the invention for which a patent of invention shall have been granted, is in its nature, or in its application, dangerous to the security of the kingdom, or its inhabitants.

9th.—A separate account shall be kept, of the taxes paid by those who obtain patents for inventions; and the produce shall be employed in premiums, or in rewards, for the encouragement of the arts, and of the national manufactures.

*Regulation of January 25th 1817.*

5th.—When the king shall judge fit not to grant the petition, or to refer it to the opinion, either of the Royal Institute of the Netherlands, or of the Royal Academy of sciences and Literature of Brussels, notice thereof shall be given to the petitioner.

6th.—The patent shall contain the description of the invention: it shall define the rights that it gives to the patentee, conformably to Article 6, of the law of the 25th January inst. and shall mention expressly, that the government, in granting the patent, guarantees, in no way, either the pri-

ority or the merit of the invention, and reserves to itself the right of declaring it void for any of the causes stated in Article 8, of the law. The patent of importation, for an object already patented abroad, shall contain, besides, the express mention that the government does not guarantee the assertion of the petitioner, as to the duration of the patent granted abroad; it shall contain also, the clause prescribed by the Article 5, of the law, that the objects mentioned shall be manufactured in the kingdom.

8th.—Every proprietor of a patent who, by other new discoveries, shall have improved upon the discovery for which the patent was granted, may obtain a new patent for the exercise of those new means.

9th.—To obtain such a patent, the same forms must be fulfilled, as for the other patents. Respecting the duties to be paid, they will be regulated by the length of time during which the exclusive privilege is to last, and by the importance of the means of improvement.

10th.—If any person announces a means of improvement upon an invention already appropriated by a patent, he may obtain a patent for the exclusive use of the said means of improvement; but he shall not be permitted, under any pretext whatsoever, to execute, or cause to be executed, the principal invention, so long as the patent granted for that invention shall not have expired; and reciprocally, the first inventor shall not be permitted to execute alone the new means of improvement. Changes of form, or of proportions, or ornaments of any kind whatsoever, shall not be held as improvements in manufactures.

## PATENT LAWS OF AUSTRIA.<sup>1</sup>

*Laws of December 8th 1820.*

§ 1.—ALL new discoveries, inventions and improvements in every branch of industry, made either in the country or in a foreign country, are entitled to obtain an exclusive privilege in the Austrian monarchy, whether the petitioner for the privilege is a native or a foreigner.

§ 2.—Whoever desires to obtain an exclusive privilege for any discovery, invention or improvement in a branch of industry, must present his petition to the *Direction* of the circle in which he resides. He must therein state the substance of his discovery, invention or improvement; the number of years for which he desires to obtain the privilege, (which term can, in no case, exceed the term of fifteen years.) He must deposit one half of the duty payable for the patent, according to the regulations stated hereinafter, and he must join, thereto, sealed up, an accurate description of his discovery, invention or improvement; in which description the following qualifications will be required:—

(a) The description must be written in the German language, or in the language used for business in the province in which the petition is made.

(b) It must be drawn up so clearly that every person who understands the subject, may be able to manufacture the object, by means of the description, without

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<sup>1</sup> These provisions of the Austrian Patent laws are taken from the Appendix to the Report of the Commissioners of the British House of Commons, June 12th, 1829. The law was furnished to the Commissioners by Mr. J. Farey. Only the sections of a general nature are copied, the omitted sections relate mostly to forms and judicial proceedings.

being obliged to supply any further inventions, additions or improvements.

(c) That which is new, and which consequently constitutes the object of the privilege, must be accurately distinguished and set forth in the description.

(d) The discovery, invention or improvement must be clearly and distinctly described, and without any ambiguities that can mislead, or that are contrary to the object stated at (b.)

(e) Nothing must be kept secret, either in the materials or the method of execution; therefore more expensive means, or means not producing an entirely similar effect, must not be described; nor must any manipulations, which are essential to the success of the operation be concealed. If it is practicable, drawings and models are to be added, for the better understanding of the description, but these are not strictly required, if the object can be made sufficiently clear by the description alone, according to the requisites stated at (b.)

§ 10.—The exclusive privilege secures and guarantees to the privileged person, the exclusive use of his invention, discovery or improvement, in that manner in which it is set forth in the description he has delivered, and during the term of years which his privilege is to last.

§ 11.—The privileged person has a right to erect all necessary workshops, and to take into them all kinds of assistants, and work people, who may be necessary for the full practice of the object of his privilege, to the greatest extension that he may choose; consequently, to form establishments and depôts all over the monarchy for the manufacture and sale of the object of his privilege, and to empower others to practise his invention, under the protection of his privilege; to take such partners as he may choose, in order to increase the profits of his invention to any scale; to dispose of his privilege itself; to bequeath it, to sell it, to let it out, or assign it away at his pleasure; and also to take out a privilege in a foreign country or his invention.



§ 12.—A privilege for an improvement, or change, in an invention already privileged, is confined, solely and only to the particular improvement or change itself, and does not give to the privileged improver, or changer, any right to the other parts of the invention already privileged, or of a method or process already known; on the other hand the original inventor must not make use of the privileged improvement, or change, made by another person, unless he has agreed for the same with that person.

§ 13.—The duties upon privileges are to be paid in proportion to the time granted for their duration (which, however, must not exceed 15 years;) and the petitioner for a privilege must determine for himself, for how many years, within the limits of the longest term, he desires to obtain the privilege.

§ 19.—The longest term for privileges, as stated in § 2 and § 13, is fixed at 15 years.

§ 20.—The term of a privilege begins from the date of the patent deeds; nevertheless the efficacy of the privilege, in respect to the punishment of illegal imitations of the privileged object, can only begin from the day of the announcement of the privilege in the public papers.

§ 21.—The force of the privilege extends, without exception, throughout the whole monarchy.

§ 23.—Privileges become void:—

(a) If the accurate description of the discovery, invention or improvement, for which the privilege was petitioned, is wanting in the requisites above stated in § 2. (a—e) or in only one of those requisites.

(b) If any one proves legally, that the privileged discovery, invention or improvement, could not be considered new in the monarchy, previous to the date of the official certificate drawn up according to the regulations hereinafter stated in § 27. (d).

(c) If the possessor of a privilege in force for a discovery, invention or improvement, proves that the privilege subsequently granted, is identically the same as his own discovery, invention or improvement, which

was regularly described and privileged at an earlier date.

(*d*) If the privileged person has not begun to practise his discovery, invention or improvement within the term of one year, from the delivery of his privilege, whether he is a native or a foreigner.

(*e*) If he discontinues that practice for the space of a year, during the term of the privilege, without showing sufficient grounds for the same.

(*f*) If the second half of the tax is not paid, in the above stated annual rates.

(*g*) Lastly, by the expiration of the original term for which the privilege was granted, or of the prolongation subsequently obtained. It is to be understood, as a matter of course, that these causes for the cessation of a privilege, apply as well to any one who acquires a privilege (by transfer,) as to the original privileged person (patentee.) After the extinction of a privilege, the use of the discovery, invention or improvement, for which the privilege was granted, will become open to every one.

§ 27.—For the prevention and uniform settlement of disputes, the following regulations are enacted:—

As the privilege is founded upon the description of the discovery, invention or improvement which is delivered by the possessor thereof (§ 10.); in case of disputes, the discovery, invention or improvement shall be judged according to the manner in which it is set forth in that description.

(*a*) Every new finding out of a process in industry, which although practised in former times, has been since entirely lost, or which although still practised in foreign countries, is unknown in the monarchy, shall be held a discovery.

(*b*) Every production of a new object by new means; or of a new object by means already known; or the production of an object already known by means differ-

ent from those which have hitherto been used for that object, shall be held an *invention*.

(c) Every addition of a preparation, arrangement, or method of working, to a process, already known or privileged, by which more complete success, or greater economy shall be attained in the result of that process, or in its mode of operation and application, shall be held an improvement.

(d) Every discovery, invention, improvement, or change, shall be held as new, if it is not known in the monarchy, either in practice, or by a description of it contained in a work publicly printed. But the novelty of a discovery, invention or improvement, shall not be called in question, on account of its being described in a work publicly printed, unless that description is so accurate and clear, that any person acquainted with the subject, can, by means of that description, manufacture the object, or practise the process for which the privilege has been granted.

**SPECIFICATION.***To all persons whom it may concern.*

Be it known that I, the undersigned, S. C. of V. in the county of H. in the state of M. have invented [or discovered], a new and useful machine [invention or improvement, or composition of matter,] called [here give the title of the invention] of which the following is a full and exact description :

[Description of the invention.]

In testimony whereof, I the said S. C. hereto subscribe my name in the presence of the witnesses whose names are hereto subscribed, on the        day of        A. D. 18 .

Signed in our presence,

S. C.

A. B.

C. D.

**ATTESTATION TO THE DRAWINGS.**

The above is the drawing of [description of the invention] referred to in my specification, of the said improvement [machine or invention] dated at V. on the        day of  
A. D. 18 .

In testimony whereof, I hereto subscribe my name on said day and year        S. C.

Signed in presence of

A. B.

C. D.

**FORM OF THE OATH.**

State of M. County of H. ss.

On the        day of        A. D. 18 , before the subscriber, a justice of the peace in and for said county, and authorized by

law to administer oaths, personally appeared S. C. and made oath [or affirmation] that he verily believes that he is the first and original inventor of the [improvement, machine, or composition of matter, &c.] above mentioned and described in the specification by him subscribed, and that he does not know or believe that the same was ever before known or used, and that he is a citizen of the United States.<sup>1</sup>

**FORM OF THE PETITION.**

*To the Honorable Henry L. Ellsworth, Commissioner of Patents of the United States.*

The petition of S. C. of V. in the county of H. and state of M. engineer, respectfully represents

That your petitioner has invented a new and useful [machine, improvement, composition of matter,] which he verily believes was not known or used prior to his invention thereof; which has not heretofore been and is not now in public use or on sale with his consent or allowance as inventor thereof, an exclusive property wherein he is desirous of securing to himself and his legal representatives. He therefore prays that letters patent of the United States may be granted to him therefor, vesting in him and his legal representatives the exclusive right to the same upon the terms and conditions expressed in the act [or acts] of congress in such case made and provided; the petitioner being a citizen of the United States, and having paid thirty dollars into the treasury of the United States, and having otherwise complied with the provisions of said act [or acts.]

S. C.

V. Dec. 18 .

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<sup>1</sup> If he is an alien resident in the United States, who has made his declaration, &c. it should be so stated; or if an alien not domiciled in the United States, the country of which he is a subject should be stated.

**DECLARATION IN CASE FOR THE INFRINGEMENT OF  
A PATENT.**

To answer to A. of B. in the county of S. in the district of \_\_\_\_\_, manufacturer, in a plea of trespass on the case, for that the plaintiff was the original and first inventor [or discoverer] of a certain new and useful art [machine, manufacture, composition of matter, or improvement on any art, machine, &c. taking the words of the statute most applicable to the subject of the invention] in the letters-patent hereinafter mentioned and fully described, the same being a new and useful [here, insert the title or description given in the letters-patent] which was not known or used before his said invention [or discovery], and which was not, at the time of his application for a patent as herein after mentioned, in public use or on sale with his consent or allowance; and the plaintiff being so, as aforesaid, the inventor [or discoverer] thereof, and being also a citizen of the United States [if the fact is so],<sup>1</sup> on the \_\_\_\_\_ day of \_\_\_\_\_ [here, insert the date of the patent] upon due application therefor did obtain certain letters-patent therefor in due form of law under the seal of the patent office of the United States, signed by the secretary of state and counter-

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<sup>1</sup> It has been suggested, in a preceding part of this work, p. 408, that the citizenship of the patentee need not be proved by the plaintiff, and, if so, it need not be averred. This will, however, depend upon the construction that shall be given to the 15th section of the act of 1836, c. 357, by which, if the patentee be an alien, the defendant is permitted to give matter in evidence tending to show that the patentee has "failed and neglected for the space of eighteen months from the date of the patent to put and continue on sale to the public, on reasonable terms, the invention or discovery." The position referred to in p. 408 assumes that the burthen on this point is, in conformity to the language of the statute, in the first instance on the defendant. But to go on the safer side, the above form of declaring assumes the burden to be on the plaintiff to aver and prove, in the first instance, that the patentee is a citizen of the United States, or, if an alien, and the eighteen months have expired before the date of the writ, that he has put and continued the invention on sale in the United States on reasonable terms.

signed by the commissioner of patents of the United States, bearing date the day and year aforesaid, whereby there was secured to him, his heirs, administrators, executors or assigns,<sup>1</sup> for the term of fourteen years from and after the date of the patent, the full and exclusive right and liberty of making, using and vending to others to be used, the said invention [machine, improvement or discovery] as by the said letters-patent, in court to be produced,<sup>2</sup> will fully appear.<sup>3</sup> And the plaintiff further says that from the time of the granting to him of the said letters-patent, hitherto, he has made, used and vended to others to be used, [or he has made, *or* has used, *or* has vended to others to be used, as the case may be] the said invention [machine, improvement or discovery,] to his great advantage and profit [or if he has not made, used or vended, then, instead of the above averments, may be substituted after the word "hitherto," "the said exclusive right has been and now is of great value to him, to wit of the value of \$ ."]<sup>4</sup>

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<sup>1</sup> Act of 4th of July, 1836, ch. 357, s. 5.

<sup>2</sup> Which the plaintiff brings here into court. Chit. Pl. v. 2, p. 765, 5th ed.

<sup>3</sup> The English precedents here state the making and filing of the specification, the assignment of the patent and the recording of the assignment, if the action be in the name of an assignee, or if an assignee of a part of the right is joined.

If the patentee is an alien and the counsel chooses to declare very cautiously, if eighteen months have expired from the date of the patent, he may here introduce the averment that within eighteen months from the date of the patent, viz. on, &c. at, &c. he (or his assignees, or he and his assignees,) put the invention on sale in the United States, on reasonable terms, and from that time always afterwards to the time of purchasing the writ, he (or they, or he and they) had continued the same on public sale in the United States, on reasonable terms.

<sup>4</sup> The principle upon which these averments are made is the same as that upon which, in an action for trespass upon personal property, the value of the property is alleged, by way of showing that it was a thing in respect to which the plaintiff might sustain damage. Mr. Gould says of this averment, "As he [the plaintiff] is not obliged to state the true value, the rule requiring it to be stated would seem to be of no great practical use." Gould's Pl. c. 4, s. 37, p. 167. Mr. Chitty says the above averments as to profit, by making, using and vending, are sometimes omitted.

## 522 *Declaration for the Infringement of a Patent.*

Yet the said D. well knowing the premises, but contriving to injure the plaintiff,<sup>1</sup> did on the [some day after the date of the patent] and at divers times before and afterwards, during the said term of fourteen years mentioned in said letters-patent, and before the purchase of this writ, at C. in the county of M. in said district of \_\_\_\_\_, unlawfully and wrongfully, and without the consent or allowance, and against the will of the plaintiff, make [use and vend to others to be used, or did make, or did use, or did vend to others to be used, as the case may be,] the said invention [machine, improvement or discovery] in violation and infringement of the exclusive right so secured to the plaintiff by said letters-patent as aforesaid, and contrary to the form of the statute of the United States in such case made and provided,<sup>2</sup> whereby the plaintiff has been greatly injured and deprived of great profits and advantages which he might and otherwise would have derived from said invention; and has sustained actual damage to the amount of \_\_\_\_\_, and by force of the statute aforesaid, an action has accrued to him to recover the said actual damage, and such additional amount, not exceeding in the whole three times the amount of such actual damages,<sup>3</sup> as the court may see fit to order and adjudge, yet the said D., though requested, has never paid the same, or any part thereof, to the plaintiff, but hath refused, and yet refuses so to do.

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The propriety of making the averment of the value seems to depend upon the question whether the allegation of ownership of an article or species of personal property, or interest in it, and possession of it, imports a value to the plaintiff without specifically alleging its value; for if it does, then a ground of action distinctly appears without any such specific allegation.

<sup>1</sup> "Contriving and wrongfully intending to injure the plaintiff, and to deprive him of the profits, benefits, and advantages, which he might and otherwise would have derived and acquired from the making, using, exercising and vending of the said invention, after the making of the said letters-patent and within the said term of fourteen years in said letters-patent mentioned." Chit. Pl. 5th ed. v. p. 766.

<sup>2</sup> There is now but one statute. In case of others being passed, the averment should be in the plural, "the statutes."

<sup>3</sup> Act of 4th of July, 1836, ch. 357, s. 14.



FORM OF THE PATENT.

WHEREAS L.

has alleged that he has invented a new and useful improvement [or machine, composition of matter &c.] which he states has not been known or used before his application ; has made oath that he is a citizen of the United States, [or subject of some foreign government,] that he verily believes that he is the original and first inventor or discoverer of the said improvement, and that the same hath not, to the best of his knowledge and belief, been previously known or used ; has paid into the treasury of the United States the sum of           dollars, and presented a petition to the commissioner of patents, signifying a desire of obtaining an exclusive property in the said improvement and praying that a patent may be granted for that purpose.

These are therefore to grant, according to law, to the said L. his heirs, administrators, or assigns, for the term of fourteen years from the           day of           one thousand eight hundred and           the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said L. in the schedule hereunto annexed, and is made a part of these presents.

In testimony whereof, I have caused these letters to be made Patent, and the seal of the Patent Office has been hereunto affixed.

Given under my hand at the city of Washington, this           day of           in the year of our Lord one thousand eight hundred and           and of the Independence of the United States of America the

*J. F. Secretary of State.*

*Countersigned and Sealed with the }  
Seal of the Patent Office.        }*

*Commissioner of Patents.*

H. L. E.

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