

or of any of its parts, independent arts or instruments though tracing their origin to the same fundamental idea, and new matters of any kind, are equally beyond the scope of the original patent and of any correction or enlargement of its terms by a re-issue.²

tonhole, Overseaming, & Sewing Machine Co. (1871), 4 Fisher, 468; *Hoffheins v. Brandt* (1867), 3 Fisher, 218; *Cahart v. Austin* (1865), 2 Clifford, 528; 2 Fisher, 543; *Whitely v. Swayne* (1865), 4 Fisher, 117; *Sickles v. Evans* (1863), 2 Fisher, 417; 2 Clifford, 203; *Poppenhusen v. Falke* (1862), 5 Blatch. 46; 2 Fisher, 213; *Poppenhusen v. Falke* (1861), 2 Fisher, 181; 4 Blatch. 493; *French v. Rogers* (1851), 1 Fisher, 133; *Batten v. Taggart* (1851), 2 Wall. Jr. 101; *Knight v. Baltimore & Ohio R. R. Co.* (1840), Taney, 106; 3 Fisher, 1.

That the re-issue cannot introduce a different principle though it were known to the patentee when he obtained the original patent, see *Dyson v. Danforth* (1865), 4 Fisher, 133.

That a re-issue cannot claim devices used with, but not part of, the original invention, see *Ex parte Barker* (1873), 4 O. G. 155.

That where the original patent accurately defines the invention, a re-issue cannot embrace antecedent improvements not within the limits of the original patent, see *Funck v. Doty* (1877), 13 O. G. 322.

That where the original patent covers but one form of an invention, it cannot re-issue to cover other forms, see *Steam Gauge & Lantern Co. v. Miller* (1882), 11 Fed. Rep. 718; *N. Y. Bung & Bushing Co. v. Hoffman* (1881), 9 Fed. Rep. 199; 20 Blatch. 3; 20 O. G. 1451; *Washburn & Moen Mfg. Co. v. Haish* (1880), 10 Bissell, 83; 7 Fed. Rep. 906; *Manufacturing Co. v. Ladd* (1877), 2 Bann. & A. 488; 11 O. G. 153; *Wicks v. Stevens* (1876), 2 Bann. & A. 318; 2 Woods, 310.

That a patentee is not entitled to a re-issue covering any matter which, according to the records of the Patent Office, he was not the first to disclose, see *Ex parte Platts* (1879), 15 O. G. 827.

That a re-issue will be sustained if the court can see that the patentee only seeks to cover his real invention, see *Crandall v. Parker Carriage Goods Co.* (1884), 28 O. G. 369; 20 Fed. Rep. 851.

² In *Ex parte Seibert* (1879), 16 O. G. 262, Paine, Com. : (265) "Where, however, he makes no discovery of the art of lubricating by hydrostatic pressure at all, but devises and patents a particular mechanism for lubricating by steam pressure, never suspecting the operativeness of that particular mechanism by hydrostatic pressure until after his patent has been granted, he is not entitled on a re-issue to a broad Claim for an art or method of hydrostatic lubrication, for he had not invented or discovered any such art or method when he took out his patent. But he is entitled, on a re-issue, to a Claim for just what he invented, — that is to say, for a machine in a particular form, involving the use of hydrostatic pressure. His monopoly of the method is limited to the method used in the precise construction invented."

In *U. S. & Foreign Salamander Felt-ing Co. v. Haven* (1875), 9 O. G. 253, Treat, J. : (254) "The repeated decisions by the courts, and especially by the United States Supreme Court in the 1st, 17th, and 19th Wallace, indicate with sufficient distinctness that not only no new matter shall be introduced,

§ 662. Defects Amendable by Re-issue are Defects of Statement only, not of Subject-Matter.

It thus appears that the sole office of a re-issue is to correct faults of statement in the description and claim of the origi-

but that an enlargement of the original Claim growing out of the subsequent advance of the art is not to be tolerated. The reason of the rule is obvious. Every patent as to novelty or utility depends on the state of the art at the time of the claim made or patent issued; and, therefore, if a party, after learning from a subsequent advance of the art the worthlessness of his original invention, is to be permitted to claim a re-issue incorporating what was not originally in his mind, and what had been afterward suggested to him only by advances in the art made by others, then he could, it may be, even without any new invention, override all the elements which would serve to test the validity of the new application. In other words, having procured a worthless patent, and having subsequently learned from the advancing art how, by changing the terms of his patent, it could be made of value, he would, if a re-issue including the new matter were permitted, have the re-issue not only relate back to the date of the original patent, but absorb within its privileges all subsequent matters wholly unknown to and unthought of by him originally." 3 Dillon, 131 (134); 2 Bann. & A. 164 (166).

That a re-issue must be for the same invention as the original patent, and cannot be expanded to cover intervening inventions, see Meyer v. Maxheimer (1881), 20 Blatch. 15; 20 O. G. 1162; 9 Fed. Rep. 99.

That matter discovered by using the original invention cannot be embraced in the re-issue, see Andrews v. Hovey (1883), 5 McCrary, 181; 16 Fed. Rep. 387; 26 O. G. 1011.

That where the utility of an invention depends upon some property of matter which is not discovered until after the date of the original patent, no re-issue can claim and appropriate the property of matter as a feature in the invention, see Andrews v. Hovey (1883), 5 McCrary, 181; 16 Fed. Rep. 387; 26 O. G. 1011.

That a re-issue cannot embrace later inventions, no matter how meritorious the original may be, see Manufacturing Co. v. Ladd (1877), 2 Bann. & A. 488; 11 O. G. 153.

That to cover a new invention by suppressing certain features of the old is not allowable, see Matthews v. Iron Clad Mfg. Co. (1888), 124 U. S. 349; 42 O. G. 827; Matthews v. Boston Mach. Co. (1882), 105 U. S. 54; 21 O. G. 1349.

That a patentee cannot expand his Claims in a re-issue so as to cover the patentable invention of another, and if he does so he is liable to lose his own, see Adjustable Window Screen Co. v. Boughton (1874), 10 Phila. 251; 1 Bann. & A. 327.

That a re-issue cannot contain new matter, see Ives v. Sargent (1886), 119 U. S. 652; 38 O. G. 781; Hayes v. Seton (1882), 20 Blatch. 484; 12 Fed. Rep. 120; Kerosene Lamp Heater Co. v. Littell (1878), 3 Bann. & A. 312; 13 O. G. 1009; Gong Bell Mfg. Co. v. Clark (1878), 3 Bann. & A. 211; 13 O. G. 274; Thomas v. Shoe Mach. Mfg. Co. (1878), 3 Bann. & A. 557; 16 O. G. 541; Vogler v. Semple (1877), 11 O. G. 923; 2 Bann. & A. 556; 7 Bissell, 382; Union Paper Collar Co. v. Van Deusen (1874), 23 Wall. 530; 7 O. G. 919; La Baw v. Hawkins (1874), 1 Bann. & A.

nal patent.¹ It is a mere method of relieving the inventor from the disastrous consequences arising out of his want of skill in drawing his specification, and of preventing the public from taking an undue advantage of his errors. Mistakes in his choice or judgment as to what he shall attempt to cover by his patent, it does not undertake to remedy.² His present rights are adequately secured by the power conferred upon him to repeat his statements in varied forms by as many successive re-issues as he desires, until his language corresponds exactly with the actual invention which his patent was intended to protect. If he has other rights beyond the limits of this invention, he must ensure their preservation by an independent application and a separate patent.

428 ; 6 O. G. 724 ; *Whitely v. Swayne* (1865), 4 Fisher, 117.

See also § 668, note 10, *post*.

§ 662. ¹ That a re-issue is intended to cure the inevitable defects of statement, see *Blake v. Stafford* (1868), 6 Blatch. 195 ; 3 Fisher, 294 ; *Burr v. Duryee* (1862), 2 Fisher, 275.

That it is the purpose of a re-issue to make the patent better, see *Jordan v. Dobson* (1870), 4 Fisher, 232 ; 2 Abbott, U. S. 398 ; 7 Phila. 533 ; *Blake v. Stafford* (1868), 6 Blatch. 195 ; 3 Fisher, 294.

That a re-issue may correct, but cannot alter, see *Doane & Wellington Mfg. Co. v. Smith* (1882), 24 O. G. 302 ; 15 Fed. Rep. 459.

² That an error in judgment as to what the patent shall cover, or in conclusions of fact, is no ground for a re-issue, see *Ex parte Mahnken* (1887), 40 O. G. 915 ; *Yale Lock Mfg. Co. v. James* (1884), 28 O. G. 917 ; 20 Fed. Rep. 903 ; 22 Blatch. 294.

That an error in judgment as to the nature of the invention cannot be corrected by re-issue, see *Hubel v. Dick* (1886), 28 Fed. Rep. 656 ; 37 O. G. 1480 ; 24 Blatch. 139.

That if the invention is really broader than the patentee supposes, but he describes and claims it in the original as he understands it, there is no inadvertence, accident, or mistake, and no room for a re-issue, see *American Diamond Drill Co. v. Sullivan Mach. Co.* (1884), 22 Blatch. 298 ; 21 Fed. Rep. 74 ; 28 O. G. 811.

That an error in fixing the term of a patent, so that it fails to conform to that of a foreign patent previously granted, may be corrected by re-issue, see *Buerk v. Valentine* (1872), 9 Blatch. 479 ; 2 O. G. 295 ; 5 Fisher, 366.

That where an American patent claimed several devices covered by separate foreign patents, of which some were expired, the devices covered by the expired patents can be excluded from the American patent by re-issue, and the patent be valid for the rest, see *Ex parte Pulvermacher* (1876), 10 O. G. 2.

That a re-issue cannot claim matters for which the original has expired by reason of its limitation by a foreign patent, see *Ex parte Siemens* (1877), 11 O. G. 1197.

§ 663. Second Proposition: Re-issued Patent must be Confined to the Invention which the Patentee Attempted to Describe and Claim in his Original Patent.

The second proposition, — that a re-issue, being the amendment of an existing patent as distinguished from the grant of a new patent for an amendment in the invention, must be confined to the invention which the patentee attempted to describe and claim in the original patent, — is equally indisputable. The fundamental theory of Patent Law that the complete and exact disclosure of the invention to the public is the consideration paid by the inventor for the monopoly created by the patent, as well as the express provisions of the statutes, require that the invention to be covered by the patent should be entirely and precisely described and claimed by the inventor in his specification; and as the patent could not lawfully have been issued, so it cannot be amended by re-issue, to embrace any subject-matter which the patentee did not endeavor at the outset to describe and claim.¹ Hence, before any amendment of the patent can be

§ 663. ¹ As the principal difficulties which have arisen under the law of re-issues relate to this second proposition, it seems necessary, at the risk of some repetition, to examine more fully the foundation on which it rests, and the exact truth which it expresses. In order to obtain the grant of a monopoly the inventor must, in the first place, have conceived an idea of means and reduced it to practice in some operative art or instrument. In the second place, he must have perceived the essential character of his invention with such clearness and completeness as to be able to reproduce it, and to confer it on the public, in such a form as to make it available for practical use without the further exercise of inventive skill. In the third place, he must determine to patent either the entire invention or some separable part thereof, and must apply for a patent for that which he has thus concluded to secure. In the fourth place, he must incorporate in

his application a specification in which he makes an honest effort to describe and to claim the invention, or separable part, which his expected patent is intended to protect. Until an inventor has taken these four steps he is not entitled to any patent whatever; and if they have been taken he is entitled to a patent only for the subject-matter which he has endeavored to describe and claim. Now if, in the first step, the idea of means which he has conceived has possibilities of development beyond the point to which he has carried it, these lie wholly outside of his invention, whether they are ever thereafter realized or not, and whether, if realized, their realization is due to his own or to another's inventive act. Obviously, therefore, none of these can enter into the subject-matter of his patent, although when the inventive act as to them becomes complete they may be covered by a subsequent and independent patent. Again

properly allowed, it must be made apparent to the Patent Office that every portion of the subject-matter of the pro-

if, in the second step, he apprehends but partially the attributes of his invention, perceiving only its narrower where it has a broader aspect, or seeing in it only a fraction of what it would present to more intelligent or experienced observers, that which he thus perceives and consequently can reproduce or communicate to others alone can be considered as entering into his invention or included in the subject-matter of his patent. If, in the third step, his invention is of such a nature as offers him the opportunity to choose whether he will obtain a monopoly for it as a whole, or for one or more of its separable parts, or for it in one aspect rather than another, he must assume the responsibility of this selection, and having made it, and acted on it in his application for a patent, he cannot reconsider his determination and substitute a different subject-matter in the same application. Finally, in the fourth step, if he does not in good faith endeavor to describe the invention for which he has determined to procure the patent, he is guilty of a fraudulent concealment which renders his patent, if he obtains one, wholly void; and if he does not attempt to claim it, he waives the right to its protection by that patent. These are principles which are not open to dispute and form an invariable guide to the Patent Office in granting patents, and to the courts in construing them and ascertaining their validity.

But if a re-issue is the amendment of an existing patent, as distinguished from the grant of a new patent, it is evident that, in its exercise of the amending power, the Patent Office can bestow on the inventor no other or greater privilege than it could have conferred upon him in the original pat-

ent; in other words, that only that invention which he had fully invented, which he clearly comprehended, which he selected as the subject-matter of the patent, and attempted to describe and to claim in his original application, can be embraced in the re-issue. And it is also evident that this exercise of the amending power cannot extend to any steps in the foregoing series anterior to the one in which the amendable defect may have arisen, to wit; the fourth and last. If the inventor has more fully developed his original idea of means, or if he has more deeply fathomed the character of that which he had then conceived, or if maturer judgment has led him to a different conclusion as to what he should have made the subject of his patent; these are matters entirely antecedent in the order of events to that in which alone, under our Patent Law, any amendable defect can have occurred. Whatever advantage can accrue to him from these later achievements, or more perfect knowledge, must be sought in new and original proceedings, not in a reformation of the old. For neither the language of the statutes, nor the general provisions of the law, permit the surrender and re-issue of a patent for any other purpose than that of curing some defect or insufficiency in the description of the patented invention or in the statement of the inventor's claims.

These considerations are so simple and so elementary that an apology for their frequent repetition would be necessary were not numerous expressions to be found in text-books and reported cases, modern as well as ancient, which misrepresent, or at least do not correctly state, this rule of law. Thus it is not true that an inventor may embrace in his re-issue his entire actual invention; or that it may include whatever the

posed re-issued patent was not only included in the original invention, but that the inventor attempted both to describe it

original patent suggested or described as belonging to the invention; or that it may cover anything which might have been claimed in the original, etc. It is true that whatever he had actually invented, had comprehended, had selected as the subject-matter of his patent, had attempted to describe and claim in his original specification, and through inadvertence, accident, or mistake, had there failed to properly describe and claim, he may now protect in his re-issue, — so much, and no more.

Of the multitude of cases which bear upon this point, a very few state it in its proper form and in intelligible language. Among these are the following: In *Flower v. City of Detroit* (1888), 127 U. S. 563, Blatchford, J. : (571) "It is sought to sustain the validity of the re-issue by attempting to show that the model filed in the Patent Office with the original application exhibited the invention covered by the first claim of the re-issue. It is doubtful whether that fact is satisfactorily established. But, irrespective of this, the case falls directly within the recent decision of this court in *Parker & Whipple Co. v. Yale Clock Co.* (123 U. S. 87; 25 O. G. 290). It was held in that case that what was suggested in the original specifications, drawings, or Patent Office model is not to be considered as a part of the invention intended to have been covered by the original patent, unless it can be seen from a comparison of the two patents that the invention which the original patent was intended to cover embraced the things suggested or indicated in the original specification, drawings, or Patent Office model, and unless the original specification indicated that those things were embraced in the invention intended to have been secured by the original patent. (See

also *Hoskin v. Fisher*, 125 U. S. 217.) In the present case it cannot be seen from a comparison of the two patents that the original specification indicated that what is covered by the first claim of the re-issue was intended to have been secured by the original." 43 O. G. 1348 (1349).

In *Parker & Whipple Co. v. Yale Clock Co.* (1887), 123 U. S. 87, Blatchford, J. : (95) "The appellants contend that the first eight Claims of the re-issue do not specify any invention which is not contained in the clock described in the original patent and embodied in the model originally deposited in the Patent Office, and that the drawings of the original and of the re-issued patent are substantially the same. On these premises, it is argued for the appellants that it is lawful to include in the Claims of a re-issue whatever is suggested or substantially indicated in the specification, model, or drawings of the original patent, if the applicant was the original and first inventor thereof, and that such a re-issue will therefore be for the same invention as that of the original patent. Expressions in some opinions of this court, wrested from their context and interpreted in a different sense from that in which they were used, are cited to support these views; but the language of the court on the subject has steadily been to the contrary; and as the question arises so distinctly in this case and some misapprehension exists in regard to it, it seems proper to discuss it with some fulness." Here the court reviews the statutes, and several decisions, concluding with that of *Seymour v. Osborne* (1870), 11 Wall. 516, from which it quotes Judge Clifford's familiar statement, that a re-issue may contain whatever was "suggested or substantially indicated in the specifications or

and to claim it in the specification annexed to his original patent. And the courts, in construing the re-issued patent

drawings which properly belonged to the invention as actually made and perfected," and then continues:— (98) "In these extracts from the opinion it is seen that the court adheres strictly to the view that under the statute the Commissioner has no jurisdiction to grant a re-issued patent for an invention substantially different from that embodied in the original patent, and that a re-issue granted not in accordance with that rule is void. In what is there said about re-describing the invention, and about including in the new Description and new Claims what was suggested or indicated in the original specification, drawings, or Patent Office model, it is clearly to be understood, from the entire language, that the things so to be included are only the things which properly belonged to the invention as embodied in the original patent; that what that invention was is to be ascertained by consulting the original patent; and that while the new Description may properly contain things which are indicated in the original specification, drawings, or Patent Office model (though not sufficiently described in the original specification), it does not follow that what was indicated in the original specification, drawings, or Patent Office model is to be considered as a part of the invention, unless the court can see from a comparison of the two patents that the original patent embodied as the invention intended to be secured by it what the Claims of the re-issue are intended to cover. In what was thus said in *Seymour v. Osborne* there is no warrant for the view that, *ex vi termini*, what was suggested or indicated in the original specification, drawings, or Patent Office model is to be considered as a part of the invention intended to have been covered by the original patent, un-

less the court can see from a comparison of the two patents that the invention which the original patent was intended to cover fairly embraced the things thus suggested or indicated in the original specification, drawings, or Patent Office model, and unless the original specification indicated that those things were embraced in the invention intended to have been secured by the original patent. . . . (102) There is no evidence of any attempt to secure by the original patent the inventions covered by the first eight Claims of the re-issue, and those inventions must be regarded as having been abandoned or waived, so far as the re-issue in question is concerned, subject however to the right to have made a new application for a patent to cover them; in other words, those eight Claims are not for the same invention which was originally patented." 41 O. G. 811 (812).

In *Yale Lock Mfg. Co. v. Seovill Mfg. Co.* (1880), 18 Blatch. 248, Shipman, J. : (256) "I understand that the Supreme Court, in the case cited and in other cases, intend to declare that in a re-issue the same, and only the same, invention which was attempted to be secured in the original patent, but which was there imperfectly stated, and was not fully secured, through inadvertence, accident, or mistake, can be re-stated, so that the principles or details of the invention may be presented clearly and accurately, but that other inventions of the patentee, or modifications of the patented invention, which had not been attempted to be secured, or had not been applied for, cannot be embraced in a re-issue, but must be the subject of a new application, and that 'courts should regard with jealousy and disfavor any attempt to enlarge the scope of an application

are logically and legally compelled to presume that the Patent Office has performed this duty, and that the monopoly

once filed, or of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alteration.' (Railway Co. v. Sayles, 97 U. S. 554.) But if the patentee has made a palpable mistake, and has limited his real invention by a misstatement of its principles, so that he is about to lose the fruit of his labor, he should be permitted to restate, and, if need be, enlarge his specification, so as to include the same invention which was plainly the subject of, but was not fully secured by, the original patent, although, literally, the enlarged invention is one which he did not apply for in his original specification, because that specification, by a misstatement of his actual invention, applied for a narrower patent than he was entitled to have." 3 Fed. Rep. 288 (296); 5 Bann. & A. 519 (526).

In *Powder Co. v. Powder Works* (1878), 98 U. S. 126, Bradley, J. : (138) "The specification may be amended so as to make it more clear and distinct; the Claim may be modified so as to make it more conformable to the exact rights of the patentee; but the invention must be the same. So particular is the law on this subject that it is declared that 'no new matter shall be introduced into the specification.' This prohibition is general, relating to all patents; and by 'new matter' we suppose to be meant new substantive matter, such as would have the effect of changing the invention, or of introducing what might be the subject of another application for a patent. The danger to be provided against was the temptation to amend a patent so as to cover improvements which might have come into use, or might have been invented by others, after its issue. The legislature was willing to concede to the pat-

entee the right to amend his specification so as fully to describe and claim the very invention attempted to be secured by his original patent, and which was not fully secured thereby in consequence of inadvertence, accident, or mistake, but was not willing to give him the right to patch up his patent by the addition of other inventions, which, though they might be his, had not been applied for by him, or, if applied for, had been abandoned or waived. For such inventions he is required to make a new application, subject to such rights as the public and other inventors may have acquired in the meantime. This, we think, is what the present statute means, and what, indeed, was the law before its enactment, under the previous act of 1836. If decisions can be found which present it in any different aspect, we cannot admit them to be correct expositions of the law." 15 O. G. 289 (292).

In *Brown v. Selby* (1871), 4 Fisher, 363, Drummond, J. : (368) "A re-issue can only be for the invention originally made and intended to be described or claimed, and included in the original patent." 2 Bissell, 457 (462).

In *Knight v. Baltimore & Ohio R. R. Co.* (1840), 3 Fisher, 1, Taney, C. J. : (3) "The plaintiff was not entitled to the patent of 1834, except for the purpose of giving a more perfect description of the invention intended to be claimed by him in the patent of 1829. . . . The patent of 1829 having been cancelled when that of 1834 was granted, the subsequent patent of 1836, upon which this suit is brought, is not valid, unless the improvement described in it is, in its principles and mode of operation, the same with that intended to be described in the patent of 1834, and differing from it only in giving a more perfect description of the improvement intended to be

defined in the re-issued patent was not intended to extend beyond the invention which the patentee endeavored to dis-

secured by that patent. . . . The plaintiff was not entitled in the patent of 1836 to enlarge, change, or modify the improvement intended to be protected by the patent of 1834. . . . The plaintiff is not entitled to recover unless he is the original inventor of the improvement described in the patent of 1836, and unless that improvement is the same in principle and in its mode of operation with the one intended to be described in the patents of 1834 and 1829." Taney, 106 (107). It is worthy of remark that in this case, — the first in which the courts seem to have been called upon to decide what a re-issue might contain — the true rule is stated by Chief Justice Taney, viz. : that the patentee is entitled to claim in his re-issue only what he "intended to" describe and claim in his original patent.

That a re-issue is intended to cover the invention which the inventor actually made and attempted to protect by the original, see *Eames v. Andrews* (1887), 122 U. S. 40 ; 39 O. G. 1319 ; *Parker & Whipple Co. v. Yale Clock Co.* (1883), 21 Blatch. 485 ; 25 O. G. 290 ; 18 Fed. Rep. 43 ; *Yale Lock Co. v. Scoville Mfg. Co.* (1880), 18 Blatch. 248 ; 3 Fed. Rep. 288 ; 5 Bann. & A. 519 ; *Powder Co. v. Powder Works* (1878), 98 U. S. 126 ; 15 O. G. 289.

That if no attempt was made to secure the invention by the original patent, it cannot be embraced in a re-issue, see *Hoskin v. Fisher* (1888), 125 U. S. 217 ; 43 O. G. 509.

That a re-issue cannot claim either another invention or a broader invention than the one attempted to be described and claimed in the original patent, see *Worden v. Searls* (1887), 121 U. S. 14 ; 39 O. G. 359 ; *Ex parte Herr* (1887), 41 O. G. 463 ; *Archer v. Arnd* (1887), 31 Fed. Rep. 475 ; 40 O. G. 1032 ;

Coon v. Wilson (1885), 113 U. S. 268 ; 30 O. G. 889 ; *Dryfoos v. Wiese* (1884), 22 Blatch. 19 ; 26 O. G. 639 ; 19 Fed. Rep. 315 ; *Hart v. Thayer* (1882), 20 Blatch. 315 ; 10 Fed. Rep. 746 ; 21 O. G. 791 ; 22 O. G. 1787 ; *Combined Patents Can Co. v. Lloyd* (1882), 21 O. G. 713 ; 11 Fed. Rep. 149 ; 15 Phila. 481 ; *Miller v. Brass Co.* (1882), 104 U. S. 350 ; 21 O. G. 201 ; *Moffitt v. Rogers* (1882), 106 U. S. 423 ; 23 O. G. 270 ; *Wing v. Anthony* (1882), 106 U. S. 142 ; *Gosling v. Roberts* (1882), 106 U. S. 39 ; 22 O. G. 1785 ; *James v. Campbell* (1881), 104 U. S. 356 ; 21 O. G. 337 ; *Heald v. Rice* (1881), 104 U. S. 737 ; 21 O. G. 1443 ; *Smith v. Merriam* (1881), 19 O. G. 601 ; 6 Fed. Rep. 713 ; *Waring v. Johnson* (1881), 19 O. G. 1068 ; 6 Fed. Rep. 500 ; 19 Blatch. 38 ; *Kells v. McKenzie* (1881), 20 O. G. 1663 ; 9 Fed. Rep. 284 ; *Meyer v. Maxheimer* (1881), 20 Blatch. 15 ; 20 O. G. 1162 ; 9 Fed. Rep. 99 ; *Washburn & Moen Mfg. Co. v. Haish* (1880), 10 Bissell, 65 ; 19 O. G. 173 ; 4 Fed. Rep. 900 ; *Covell v. Pratt* (1880), 18 Blatch. 126 ; 18 O. G. 301 ; 2 Fed. Rep. 359 ; 5 Bann. & A. 380 ; *Manufacturing Co. v. Corbin* (1880), 103 U. S. 786 ; 20 O. G. 297 ; *Ball v. Langles* (1880), 102 U. S. 128 ; 18 O. G. 1405 ; *Garneau v. Dozier* (1880), 102 U. S. 230 ; 19 O. G. 61 ; *Manufacturing Co. v. Ladd* (1880), 102 U. S. 408 ; 19 O. G. 62 ; *American Middlings Purifier Co. v. Atlantic Milling Co.* (1879), 15 O. G. 467 ; 5 Dillon, 127 ; 4 Bann. & A. 148 ; *Cammeyer v. Newton* (1879), 16 O. G. 720 ; 4 Bann. & A. 159 ; *Campbell v. James* (1879), 18 O. G. 979 ; 17 Blatch. 42 ; 4 Bann. & A. 456 ; *Powder Co. v. Powder Works* (1878), 98 U. S. 126 ; 15 O. G. 289 ; *Jones v. McMurray* (1877), 13 O. G. 6 ; 2 Hughes, 527 ; 3 Bann. & A. 130 ;

close and to appropriate in his original patent. Where the re-issued patent will bear no construction which confines its subject-matter to this invention, its Claims are necessarily invalid.

§ 664. Nature and Scope of the Invention which the Inventor Attempted to Describe and Claim in his Original Patent, how Determined.

By what method the Patent Office or the courts shall ascertain the limits of the invention which the patentee originally endeavored to describe and claim, the statutes do not particularly prescribe. The act of 1832 simply required that the re-issue should be for the same invention. The act of 1836 followed in this respect the act of 1832. The act of 1870 further provided that "no new matter shall be introduced into the specification, nor in case of a machine-patent shall the model or drawings be amended except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was part of the original invention and was omitted from the specification by inadvertence, accident, or mistake." The Revised Statutes reproduce these provisions of the act of 1870. Under these, it will be noticed that no limitation is placed to the amendment of the original specification except the prohibition of new matter, and no test is given by which the Office or the courts are to determine what it attempted to describe and

Marsh v. Seymour (1877), 97 U. S. 437; 5 Fisher, 415; Seymour v. Osborne (1870), 11 Wall. 516; Morey v. Lockwood (1868), 8 Wall. 230; Hoffheins v. Brandt (1867), 3 Fisher, 218; Cahart v. Austin (1865), 2 Clifford, 528; 2 Fisher, 543; Burr v. Duryee (1863), 1 Wall. 531.

That where the re-issue does not cover an invention distinct from that described and attempted to be claimed in the original, the re-issue is valid, unless the failure to claim amounted to abandonment, see Eames v. Andrews (1887), 122 U. S. 40; 39 O. G. 1319.

Marsh v. Seymour (1877), 97 U. S. 348; 13 O. G. 723; Vogler v. Semple (1877), 7 Bissell, 382; 11 O. G. 923; 2 Bann. & A. 556; Russell v. Dodge (1876), 93 U. S. 460; 11 O. G. 151; Tucker v. Tucker Mfg. Co. (1876), 4 Clifford, 397; 10 O. G. 464; 2 Bann. & A. 401; Collar Co. v. Van Deusen (1874), 23 Wall. 530; 7 O. G. 919; Gill v. Wells (1874), 22 Wall. 1; 6 O. G. 881; Carlton v. Bokes (1873), 17 Wall. 463; 6 Fisher, 40; 2 O. G. 520; Tarr v. Webb (1872), 10 Blatch. 96; 5 Fisher, 593; 2 O. G. 568; Sarven v. Hall (1872), 9 Blatch. 524; 1 O. G.

claim. In the case of a machine-patent it is assumed that every feature of the invention which the inventor intended to protect will be exhibited either in his drawing or his model, and by prescribing that these can be amended only by each other the statute fairly implies that no part of the actual invention which he made can be regarded as embraced in what he intended to describe and claim unless in one or both of these it is disclosed. Where no model or drawing exists, the Office and the courts are left to the guidance of such regulations concerning the kind and degree of evidence required for the solution of this question as they may, in general, or in reference to particular cases, see fit to establish.¹ The necessity for some permanent and definite rule upon the subject, however, and the manifest danger of fraud and imposition if the fact that by the original patent the inventor intended and attempted to cover the matter now claimed in the re-issue were to be determined in any case upon his mere assertions or other parol testimony alone, early led the courts to declare that the original specification, as illustrated by the model or drawings if any, and as interpreted by a proper explanation of its terms of art and by the examination in connection with it of the invention actually made, must bear upon its face sufficient evidence of the alleged endeavor to describe and claim.² This rule, as usually stated,

§ 664. ¹ That the courts and the Patent Office obey the same rules in ascertaining the character of the invention which the patentee originally attempted to protect, see *Ex parte Aldrich* (1876), 9 O. G. 407.

² The cases in which this rule has been accepted and followed are almost without number, and yet in scarcely any of them has it been completely and accurately stated. The adoption of the incorrect forms mentioned in the text is largely responsible for this, but such has been the history of the rule itself that freedom from obscurity could scarcely be expected. The earliest case in which the courts seem to have established a test for determining the char-

acter of the invention which the original patent was intended to protect, and for ascertaining the identity with this of the invention claimed in the re-issue, was *Knight v. Baltimore & Ohio R. R. Co.* (1840), Taney, 106 ; 3 Fisher, 1. In this case Chief Justice Taney charged the jury that the plaintiff could not recover on his re-issued patent unless the invention which it described and claimed was "the same in principle and in its mode of operation with the one intended to be described in" the original patent, and then left this question of identity (which of course includes the question of the actual character of the invention intended to be covered by the original patent) to be decided by the jury, as a

appears in one of the two following forms: negatively, that a re-issue cannot include any subject-matter which the orig-

matter of fact. In the cases which immediately followed this, the same position was taken by the courts, and the jury were required to pass upon the identity of the inventions on any relevant evidence that might have been presented. See *Carver v. Braintree Mfg. Co.* (1843), 2 Story, 441; *Stimpson v. Westchester R. R. Co.* (1845), 4 How. 404; *Allen v. Blunt* (1846), 2 W. & M. 139; *Batten v. Taggart* (1854), 17 How. 83; *Heilner v. Battin* (1856), 27 Penn. 521; *Poppenhusen v. Falke* (1861), 4 Blatch. 496, etc. While the courts were pursuing this method of investigation a practice appears to have arisen in the Patent Office of confining the applicant for a re-issue to such evidence concerning the invention which he first endeavored to protect, and its identity with that claimed in the re-issue, as was furnished by the original patent and its specification, drawings, and model, when interpreted by the invention itself, — a practice more than once repudiated in the courts, but gradually making its impression upon their decisions. Concurrently with these events, the doctrines that the nature and scope of any patented invention is to be determined by the court as a matter of law upon an inspection of the patent; that consequently the identity of two patented inventions must be ascertained by a comparison of their respective patents with each other by the court; and that the action of the Commissioner in issuing or re-issuing a patent is *prima facie* lawful and valid; — were becoming firmly grounded and universally applied, culminating, at length, in the proposition announced by Clifford, J., in *Sickles v. Evans* (1863), 2 Clifford, 203, and affirmed by him in *Stevens v. Pritchard*, (1876), 4 Clifford, 417, that the action of the Commissioner in granting a re-

issue is "final and conclusive, unless the court is of the opinion, upon comparing the two instruments, that the re-issued patent, as matter of legal construction, is not for the same invention as the original."

In the transition to this doctrine from that of Chief Justice Taney in 1840 decisions of various degrees of incorrectness and inconsistency were rendered, some affirming the right of the patentee to a re-issue in the broadest terms which his original invention would permit, others restricting him in the re-issue to what he had claimed in the original patent; some asserting that the identity of the inventions covered by the original and re-issued patents must be apparent to the court upon a mere inspection of the instruments themselves, others adopting the extreme position of Judge Clifford that this identity must be conclusively presumed unless the patents, when compared with one another, disclosed substantial differences between them; yet all finally agreeing in the rule primarily adopted by the Patent Office, that the original specifications, drawings, and model must afford the ultimate test by which the Office or the courts are to determine what portions and aspects of his actual invention the inventor had intended and attempted to describe and claim.

Having reached this point in the explication of the rule, most of the decisions treat it as sufficiently stated, and proceed to apply it in their own peculiar modes. But it is evident that this explication is not a finality. For though it be established that the subject-matter of a re-issue must be confined to the invention which the patentee originally attempted to secure, and that this attempt must be discoverable in the original specification, drawings, or model,

inal patent, as construed by the court, does not apparently endeavor to protect; affirmatively, that a re-issue may em-

the mode to be pursued in making that discovery is still to be determined. In reference to this mode of inquiry it must be remembered that the specification, in which the discovery is to be made, is confessedly defective, — so defective, indeed, that in consequence of its defects the patent is inoperative or invalid. Manifestly, then, no mere process of interpretation can avoid or cure its imperfections and ascertain what patentable matter it has undertaken to describe and claim, since where interpretation can have this effect the patent cannot be invalid or inoperative. Hence recourse must be had to some exterior source for information as to the true nature of the invention, that in the light afforded by its actual character, as the inventor conceived it and reduced it to practice before his original application for a patent, his defective claims and description may be read. This is evidently the only method in which the fact that the specification is defective can be ascertained, or the nature and degree of the defect can be measured, or the scope of the invention which the defective delineation or assertion attempted to embrace can be explored; and not until the Patent Office or the court is thus informed of what the inventor might have made the subject-matter of his patent, if he had so desired, can it be in any situation to scrutinize the original specification, drawings, or model in order to discover what he did intend and endeavor to describe and claim.

Three sources of information concerning the actual character of the original invention may be accessible for the purpose of this inquiry: (1) The assertions of the inventor or other parol testimony; (2) The specification of the re-issued patent; (3) The inven-

tion itself as originally made and perfected. The first is excluded because unreliable and unnecessary, as well as on grounds of public policy, and demands no further consideration. The specification of the re-issued patent, on the contrary, is in the highest degree authoritative and available. It purports to give, and must be accepted as giving, a complete and exact description of the invention, and as stating fully and clearly the claims of the inventor. It is assumed to be sufficient to acquaint those skilled in the art with the mode of making and using the invention, and to inform the public of the precise line which separates the arts and instruments at their command from that which is embraced in the monopoly. The patentee cannot be permitted to deny that the court or Patent Office, by legally interpreting his re-issue specification, with its drawings and model, will obtain a perfect knowledge of his true invention, as he himself has made it and contemplated its introduction into public use. And hence the Patent Office and the courts have here a ready, permanent, and invariable standard with which to compare the original specification, and thus discover how much of the invention as it now appears in the perfected patent the inventor then attempted to describe and claim. Where no re-issue has as yet been granted, and no re-issue specification on which the patentee insists as the accurate presentation of his invention has been filed, this source of information is, of course, absent, and a resort to the actual invention becomes necessary.

This review of the subject makes it evident that the mode of discovery to be pursued in ascertaining what the original specification attempted to embrace must vary with the different

brace whatever was suggested or substantially indicated in the original specification or drawings as belonging to the invention

stages in the history of the re-issue. When the inventor or his attorney are endeavoring to decide what can be claimed in the proposed re-issue, or when the Patent Office is assisting the inventor to secure all that a re-issue may lawfully include, the actual invention itself must be examined, and by comparing this with the original specification, drawings, and model, they must determine how much of that invention the patentee then intended and attempted to describe and claim, and confine within those limits the invention claimed in the re-issue. This is evidently the proceeding contemplated by that clause of the statutes which authorizes the Commissioner, in certain cases, to consider any proper proof as to the real nature of the actual invention, and the extent to which the inventor failed in his original attempt to disclose and protect it; while in the case of a machine, the original model and drawings, in connection with the specification and the machine itself, are presumed to offer all the information upon these points that, for the purpose of preparing and allowing a re-issue, the inventor or the Office can require.

When the re-issue application is perfected in the Patent Office, according to the intention of the applicant, and he insists upon its correspondence with the actual invention as he originally attempted to secure it, the specification, drawings, and model embraced in this re-issue application become the test by which the intended scope of the original patent is to be judged; and it must therefore be assumed by the Office that whatever parts or features of the invention, as set forth in these amended and presumably correct delineations, are wholly absent from the original specifications were not included in the

invention which the inventor there attempted to describe and claim. At this stage there is, therefore, no occasion for exterior evidence, or for an examination of the actual invention itself, except so far as may be necessary to understand the description and claims of the re-issue application.

When the courts are called upon to enter into this investigation (except in proceedings on appeal, or in equity, supplemental to the re-issue application, and which are consequently governed by the foregoing rules), the re-issued patent has been granted and its specification stands before the public, as well as the court itself, as the complete and accurate exposition of the invention originally made and intended to be patented by the inventor. When construed by the court, with such explanation of technical terms and such reference to the actual invention as may be deemed essential to its true interpretation, it furnishes all needed information concerning the character of the invention as originally made and perfected, and constitutes a standard with which the original specification, drawings, and model may be compared, and from which the court may satisfactorily and sufficiently discover what portions of the invention the patentee endeavored to communicate to the public and to bring within the monopoly created by his original patent. From this as well as the preceding stage of the investigation extrinsic testimony is thus excluded, save for the purpose of aiding the court in its interpretation of the original and re-issued patents with their respective specifications, drawings, and models.

As this inquiry in the courts is instituted after the re-issued patent has been granted, a further question arises which is not encountered in the previous

actually made and embodied in the original patent. These statements are not literally correct, since the rule itself relates

stages in the Patent Office. It has become a settled principle of law that the issue of a patent raises a presumption of its validity and of the existence of all the conditions which the statutes have imposed upon the patentee. Applied to the proceeding now under discussion, this principle would seem to justify the extreme doctrine heretofore referred to, and compel the courts to recognize the judgment of the Patent Office in allowing the re-issue, and thereby deciding that its subject-matter was attempted to be covered by the original patent, as final and conclusive unless the contrary is clearly evident on a comparison of the original and re-issue specification. This doctrine has been held in many cases, among which are *Herring v. Nelson* (1877), 14 Blatch. 293; 3 Bann. & A. 55; 12 O. G. 753; *Tucker v. Tucker Mfg. Co.* (1876), 10 O. G. 464; 4 Clifford, 397; 2 Bann. & A. 401; *Stevens v. Pritchard* (1876), 10 O. G. 505; 4 Clifford, 417; 2 Bann. & A. 390; *Chicago Fruit House Co. v. Busch* (1871), 2 Bissell, 472; 4 Fisher, 395; *Carew v. Boston Elastic Fabric Co.* (1871), 3 Clifford, 365; 5 Fisher, 90; 1 O. G. 91. Later cases manifest a disposition to repudiate this position, and to assert that the presumption arising from the action of the Patent Office in allowing a re-issue does not prevent the courts from re-examining this question of correspondence between the original and re-issue specifications, and affirming the validity or invalidity of the re-issued patent according as this correspondence may or may not appear. In these cases, therefore, it is held that a comparison of the re-issue and original specifications must affirmatively show that the subject-matter of the former was attempted to be stated in the latter, and that the Claims of the re-issue can

embrace no invention unless the court can see that the inventor intended to secure it under the original patent. See *Flower v. Detroit* (1888), 127 U. S. 563; 43 O. G. 1348; *Fisher v. Hoskin* (1888), 125 U. S. 217; 43 O. G. 509; *Parker & Whipple Co. v. Yale Clock Co.* (1887), 123 U. S. 87; 41 O. G. 811, etc. These cases probably represent the law as it will ultimately be established, though at present it is scarcely safe to prophesy whether their doctrine will prove as just and practically beneficial to inventors and the public as the former.

The rule, as stated and explained in the preceding portions of this note, is applicable whenever the descriptive matter of the original specification is imperfect, whether or not the Claims, as measured by such description, are defective or sufficient. But where the description is complete and accurate, and the fault resides in an obscure or too restricted or excessive Claim, the modes of inquiry above delineated are unnecessary. Here the description of the original patent becomes the standard by which the imperfections in its Claims, and the extent to which they can be corrected, must be judged, and neither in the Patent Office nor the courts can the Claims of the re-issue be permitted to embrace any subject-matter which was not adequately portrayed in the original description.

In concluding this prolix discussion the proposition announced in the previous paragraph may be reiterated, — that the object of discovery in the methods before mentioned is the attempt of the inventor not merely to describe the invention now embraced in the re-issue, but also to claim it, and thus bring it within the original monopoly. It is not indeed necessary that it appear expressly in his original Claims.

only to the mode by which the intended scope of the original patent is to be determined, while these forms of expressing it prescribe what a re-issue may or may not contain, — a matter already definitely fixed by the language of the statute, and which the courts have no power to extend or to curtail. From these erroneous forms of statement have arisen serious misapprehensions as to the nature and practical application of the rule itself. Certain decisions may be found which proceed on the assumption that it governs the allowance of re-issues, and which, adopting its affirmative form, therefore declare that anything which might have been claimed in the original patent, under the description therein given of the invention, may be claimed in the re-issue.³ This position, as thus broadly stated, is not correct. That a Claim might have been made in the original does not, *ipso facto*, entitle the inventor to insert it in his re-issue.⁴ Additional circumstances, such as abandonment, estoppel, and the like, are to be regarded; and in view of these, as well as its relation to the original description, is the validity of the amended Claim to be determined. Other decisions are reported which, assuming the rule to be of the same character and following its negative form, have held that nothing can be claimed in a re-issue which was not included in the Claim of the origi-

It may have been so connected with claimed matter in the Description that a Claim for either would impliedly cover both, as where Claims for a process embrace its inseparable product, or Claims for a combination incidentally include its indispensable elements and sub-combinations. But in this or some other manner the attempt to claim must have been so made in the original specification that the Patent Office and the courts, pursuing the appropriate method of inquiry just considered, may satisfy themselves that what the inventor clearly claims in his re-issue, he did endeavor to protect by his original patent.

³ That whatever could have been claimed in the original patent may be claimed in the re-issue, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 10

Bissell, 65; 19 O. G. 173; 4 Fed. Rep. 900; *Draper v. Wattles* (1878), 3 Bann. & A. 618; 16 O. G. 629; *Union Paper Collar Co. v. Van Deusen* (1872), 10 Blatch. 109; 5 Fisher, 597; 2 O. G. 361.

⁴ That the mere fact that matter might have been claimed in the original is not alone enough to warrant its claim in the re-issue, see *Electric Gas Lighting Co. v. Smith & Rhodes Electric Co.* (1885), 31 O. G. 792; 23 Fed. Rep. 195; *Yale Lock Mfg. Co. v. James* (1884), 20 Fed. Rep. 903; 28 O. G. 917; 22 Blatch. 294; *Newton v. Furst & Bradley Mfg. Co.* (1882), 11 Bissell, 405; 14 Fed. Rep. 465; *Kells v. McKenzie* (1881), 9 Fed. Rep. 284; 20 O. G. 1663.

nal patent;⁵ a rule which unwarrantably restricts the rights of the inventor, and is contrary alike to the uniform practice of the Patent Office and the general current of judicial opinion.⁶ Both these errors might have been avoided had the true reason and purpose of this rule been clearly apprehended. It does not pretend to state when a re-issue may be granted or withheld, or what the re-issued patent may or may not contain. The acts of Congress have determined when it shall be granted, and that when granted it may contain whatever may be necessary to render it effectual to protect the invention which the inventor originally attempted to secure. In ascertaining what that invention was, the Patent Office and the courts have properly refused to look beyond the specification, drawings, and model of the original patent, interpreted when necessary by an examination of the invention itself, but have not held, nor had they any authority to hold, that everything which could have been claimed under the original patent, whether a part of the actual invention or not, and whether or not abandoned, might be claimed under the re-issue; nor, on the other hand, that nothing could be covered by the latter patent, although belonging to the actual invention, which was not embraced within the Claims of the former. Considered in its true intent, as a simple rule of evidence, it presents no special difficulty, but is reasonable, intelligible, and in most instances easy of application.

§ 665. The Attempt of the Inventor to Describe and Claim the Invention Embraced in the Re-issue must Appear in the Specification, Drawings, or Model of the Original Patent.

In order to determine what invention the inventor intended and endeavored to secure by the original patent, the specifi-

⁵ That a re-issue cannot be expanded so as to claim matters which the patentee did not see fit to claim in the original, see *Fay v. Fraser* (1882), 11 Bissell, 422; 14 Fed. Rep. 652.

That a re-issue, whose only Claims are not in the original, is void, see *Singer*

Mfg. Co. v. Goodrich (1883), 15 Fed. Rep. 455.

That Claims in a re-issue which expressly enlarge the invention claimed in the original are void, see *Curtis v. Branch* (1879), 15 O. G. 919; 4 Bann. & A. 189.

⁶ See § 656 and note 3, *ante*.

cation, drawings, and model connected with that patent, explained when necessary by comparison with the actual invention or its correct description in the re-issue specifications, must, therefore, be adopted as the final guide.¹ These,

§ 605. ¹ In *Heald v. Rice* (1882), 104 U. S. 737, Matthews, J.: (749) "The principles for determining the validity of re-issued patents have been discussed and formulated so repeatedly and so recently in this court that it is necessary at present only to refer to *James v. Campbell*, *supra*, 356; *Miller v. Brass Company*, *supra*, 350; *Burr v. Duryee*, 1 Wall. 531; and *Powder Company v. Powder Works*, 98 U. S. 126. In the present case the question of the identity of the invention in the original and re-issued patents is to be determined from their face by mere comparison, notwithstanding what was said in *Battin v. Taggart* (17 How. 74), and consistently with *Bischoff v. Wethered* (9 Wall. 812), according to the rule laid down in *Seymour v. Osborne* (11 Wall. 516), and *Powder Company v. Powder Works*, *supra*. That is, if it appears from the face of the instruments that extrinsic evidence is not needed to explain terms of art, or to apply the descriptions to the subject-matter, so that the court is able from mere comparison to say what is the invention described in each, and to affirm from such mere comparison that the inventions are not the same, but different, then the question of identity is one of pure construction, and not of evidence, and consequently is matter of law for the court, without any auxiliary matter of fact to be passed upon by a jury, if the action be at law." 21 O. G. 1443 (1446).

In *Glue Co. v. Upton* (1874), 6 O. G. 837, Clifford, J.: (838) "Power to surrender patents for the purposes suggested in the act of Congress implies that the specification may be corrected to cure the defect and to supply the de-

ficiency, but interpolations in a re-issued patent of new features or ingredients or devices, which were neither described, suggested, nor substantially indicated in the original specification, drawings, or Patent Office model, are not allowed. (*Battin v. Taggart*, 17 How. 86; *O'Reilly v. Morse*, 15 How. 112; *Sickles v. Evans*, 2 Cliff. 222; *Cahart v. Austin*, 2 Cliff. 536.) Nor is parol testimony admissible in an application for a re-issue to enlarge the scope and nature of the invention beyond what was described, suggested, or substantially indicated in the original specification, drawings, or Patent Office model, as the purpose of a surrender and re-issue is not to introduce new features, ingredients, or devices into the patent, but to render effectual the actual invention for which the original patent should have been granted. Whether a re-issued patent is or is not for the same invention as the surrendered original cannot be satisfactorily determined without a comparison of the two, as the decision must necessarily depend very largely upon the question whether the specification and drawings of the re-issued patent are or are not substantially the same as those of the original, and if not, whether the changes or alterations are or are not greater than the act of Congress granting the power of surrender and re-issue allows." 4 Clifford, 237 (239); 1 Bann. & A. 497 (500).

That a re-issue cannot claim matters inconsistent with the specification, drawings, and model of the original, even though the same matters were claimed in the original patent, see *Ex parte Warren* (1876), 10 O. G. 1.

That where the original patent does

taken together and construed as mutually interpreting each other,² constitute the attempt of the inventor to disclose to others the idea of means which he has himself conceived and reduced to practice, and which he has selected as the subject-matter of his patent; and in the very nature of things this attempt must be so far successful as to afford some substantial indication or suggestion of the actual invention which is to be embraced in the proposed monopoly. An idea which the inventor is unable to express in words, or by pictorial representation, or in tangible materials, must either be so far abstract and indefinite as to lie outside the domain of the concrete industrial arts, or the inventor himself must have failed to apprehend it with that clearness and exactness which alone entitles him to claim the complete performance of an inventive act.³ Cases in which an inventor, having conceived the idea of means, having perceived it, and having reduced it to practice in a new art or instrument, honestly attempts to describe and claim it, and yet succeeds in giving no substantial indication of its character and scope, must be so rare, if in-

not describe the real invention, the remedy is by a new application and patent, not by re-issue, see *James v. Campbell* (1881), 104 U. S. 356; 21 O. G. 337; *Sarven v. Hall* (1872), 1 O. G. 437; 9 Blatch. 524; 5 Fisher, 415.

The fact that a device is not mentioned in the original is evidence that a re-issue which claims it is for a different invention, see *Campbell v. James* (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456.

That the question is never how the original might have described the invention but how it did describe it, see *Hammond v. Franklin* (1885), 23 Blatch. 77; 22 Fed. Rep. 833; 30 O. G. 1324.

That the article, as made by the inventor before his application, was the same as that claimed in the re-issue is of no consequence, unless it was so described in the original patent, see *Hammond v. Franklin* (1885), 23 Blatch.

77; 22 Fed. Rep. 833; 30 O. G. 1324.

That a re-issue may claim whatever clearly appears, either by the specification, drawings, or model of the original patent, to have been part of the invention it intended to protect, see *Calkins v. Bertraud* (1875), 6 Bissell, 494; 9 O. G. 795; 2 Bann. & A. 215; *Chicago Fruit House Co. v. Busch* (1871), 2 Bissell, 472; 4 Fisher, 395.

² That a re-issue can cover nothing which is not found either in the specification, drawings, or model of the original, though either of these may be aided by the others, see *Sarven v. Hall* (1872), 9 Blatch. 524; 1 O. G. 437; 5 Fisher, 415.

³ That what an alleged inventor cannot describe he cannot have invented, see *Smith v. Downing* (1850), 1 Fisher, 64; *Boulton v. Bull* (1795), 2 H. Bl. 463; 1 Abb. P. C. 59.

See also § 79 and notes, *ante*.

deed such a case is possible, that the rule is liberal enough toward any careful and diligent patentee, and no indulgence beyond this can be accorded to him without endangering the public interests and unjustly limiting the rights of subsequent inventors.⁴

§ 666. The Attempt of the Inventor to Describe and Claim the Invention may Appear either in the Original Specification, the Drawings, or the Model.

The attempt of the inventor to cover the invention by his original patent may appear either in the specification, the model, or the drawings.¹ If it were contained only in the

⁴ Rev. Stat. Sec. 4916.

That an invention cannot be added to for re-issue purposes by proof that it really included matters not shown, see *Averill Chemical Paint Co. v. National Mixed Paint Co.* (1881), 20 Blatch. 42; 22 O. G. 585; 9 Fed. Rep. 462; *Tarr v. Webb* (1872), 10 Blatch. 96; 5 Fisher, 593; 2 O. G. 568.

That a re-issue cannot be granted on proof where there are no drawings, model, or specifications to show the invention, see *Averill Chemical Paint Co. v. National Mixed Paint Co.* (1881), 22 O. G. 585; 20 Blatch. 42; 9 Fed. Rep. 462.

That a re-issue cannot contain Claims which either the patent or contemporary records show could not have been embraced in the original, see *Combined Patents Can Co. v. Lloyd* (1882), 21 O. G. 713; 11 Fed. Rep. 149; 15 Phila. 481.

That no parol proof is admissible to show that the inventor intended to describe or claim matter not indicated to some extent in his original patent, see *Tarr v. Webb* (1872), 10 Blatch. 96; 5 Fisher, 593; 2 O. G. 568; *Sarven v. Hall* (1872), 9 Blatch. 524; 1 O. G. 437; 5 Fisher, 415; *Cahart v. Austin*, (1865), 2 Clifford, 528; 2 Fisher, 543.

§ 666. ¹ That it is enough if the attempt of the inventor appears in the

drawings, though it is not shown in the specification, see *Smith v. Merriam* (1881), 19 O. G. 601; 6 Fed. Rep. 713; *Washburn & Moen Mfg. Co. v. Haish* (1880), 10 Bissell, 83; 7 Fed. Rep. 906; *Kerosene Lamp Heater Co. v. Littell* (1878), 13 O. G. 1009; 3 Bann. & A. 312; *Bantz v. Elsas* (1874), 6 O. G. 117; 1 Bann. & A. 351; *Booth v. Parks* (1874), 1 Bann. & A. 225; 1 Flippin, 381; *Swift v. Whisen* (1867), 3 Fisher, 343; 2 Bond, 115.

That the attempt may be shown only in the model of the original patent, see *Hendy v. Golden State & Miners' Iron Works* (1883), 17 Fed. Rep. 515; 8 Sawyer, 468; *Meyer v. Goodyear India Rubber Glove Mfg. Co.* (1881), 11 Fed. Rep. 891; 22 O. G. 681; 20 Blatch. 91; *Smith v. Merriam* (1881), 19 O. G. 601; 6 Fed. Rep. 713; *Ex parte Hunt* (1879), 15 O. G. 831; *Reissner v. Anness* (1877), 13 O. G. 870; 3 Bann. & A. 176; *Ex parte Baldwin* (1876), 9 O. G. 639.

That the original patent may be amended by the model in the Patent Office or by the drawings, and the model may be inspected by the court, see *Hendy v. Golden State & Miners' Iron Works* (1883), 8 Sawyer, 468; 17 Fed. Rep. 515; *Reissner v. Anness* (1877), 3 Bann. & A. 176; 13 O. G. 870.

model, and the model has since been destroyed or lost, proper proof of its existence in the model may be offered, if consistent with the original drawings and Description.² And in examining the latter for this purpose, the application for the original patent, with its various amendments and substitutions, may be consulted, as throwing light upon the actual subject-matter which the inventor did endeavor to describe.³

§ 667. How the Attempt of the Inventor to Describe and Claim the Invention Embraced in the Re-issued Patent must Appear in the Original Specification, Drawings, or Model.

The attempt of the inventor to secure by his original patent the invention claimed in the re-issue is sufficiently indicated in his original specification, drawings, or model, whenever the Patent Office or the courts, by examining them in the light of the actual invention or the perfect re-issue specification, can perceive that if the original claims and descriptions had been free from substantive defects of statement the inventions covered by the original and re-issued patents would have been identical. The Patent Office, in endeavoring to afford the inventor the widest protection to which he is entitled, may,

² That it is sufficient if the attempt to cover alleged new matter were shown only in the model of the original, though the model is now lost, see *Meyer v. Goodyear's India Rubber Glove Mfg. Co.* (1881), 20 Blatch. 91 ; 22 O. G. 681 ; 11 Fed. Rep. 891.

That a re-issue cannot include an element not found either in the drawings or specifications, simply on the ground that the model is imperfect and that this may be the missing element, see *Stockwell v. Haines* (1877), 12 O. G. 137 ; *Ex parte Seibert* (1877), 12 O. G. 268.

That a re-issue cannot wholly change the character of the original invention, from what it appears in the specification and drawings, on the strength of a feature shown in the model, see *Parker & Whipple Co. v. Yale Clock Co.* (1883),

21 Blatch. 485 ; 25 O. G. 290 ; 18 Fed. Rep. 43.

That a re-issue will not be granted for what is shown in the model, if it contradicts the drawings and specifications, see *Ex parte Hunt* (1879), 15 O. G. 831.

That the Office model alone is not sufficient basis for a new Claim in the re-issue, unless it also appears that the inventor originally intended to claim the feature in question, see *Flower v. Detroit* (1888), 127 U. S. 563 ; 43 O. G. 1348.

³ That where there have been successive applications for the original patent, these may be examined in order to ascertain what the inventor attempted to claim, see *Ex parte Sexton* (1876), 9 O. G. 251.

in certain cases, explore the history of the art to ascertain what the inventor might have claimed, and give effect to any phrases in the original description which can fairly be construed to cover it.¹ But in the courts the original specification, model, and drawings must speak for themselves, — not, of course, with perfect clearness and completeness, for then no amendment would be needed, but yet so as to render it apparent to the judicial mind, when comparing the original with the re-issue, that the inventions intended to be set forth in each patent are the same.² Thus matter mentioned in the Claims of the original but not consistent with the Description nor found either in the model or in the drawings, and matter merely alluded to as possible and useful but not suggested as a part of the invention to be patented, are alike outside the rule and cannot be embraced in the re-issue.³ But matter stated to belong to the claimed invention, or appearing

§ 667. ¹ See § 664, note 2, *ante*.

² In *Thomas v. Shoe Mach. Mfg. Co.* (1878), 16 O. G. 541, Clifford, J. : (542) "Inquiries in such a case are restricted to a comparison of the terms and import of the two patents in view of the drawings and Patent Office model. If from these it results that the invention claimed in the re-issue is not substantially different from the one described, suggested, or indicated in the specification or drawings of the original patent or Patent Office model, the re-issued patent must be held valid, as all other alterations and amendments plainly fall within the intent and purpose of the provision in the act of Congress which allows a surrender and re-issue; or, in other words, if the re-issued patent does not, upon the face of the instrument, embrace anything not substantially described, suggested, or indicated in the specifications, drawings, or model of the original, the defence that the re-issued patent is not for the same invention as the original must be overruled." 3 Bann. & A. 557 (561). See also *Heald v. Rice* (1882), 104 U. S. 737; 21 O. G. 1443; *Glue*

Co. v. Upton (1874), 6 O. G. 837; 4 Clifford, 237; 1 Bann. & A. 497; and § 664, note 2, *ante*.

That the courts will not explore the history of the art to ascertain what the inventor might have claimed and may have attempted to patent, see *James v. Campbell* (1881), 104 U. S. 356; 21 O. G. 337; *Keystone Bridge Co. v. Phoenix Iron Works* (1877), 95 U. S. 274; 12 O. G. 980.

That the original and re-issued patents are construed according to the state of the art at the date of the application for the original, see *Eachus v. Broomall* (1885), 115 U. S. 429; 33 O. G. 1265; *Garneau v. Dozier* (1880), 102 U. S. 230; 19 O. G. 61.

³ That matter appearing only in the Claim of the original patent, and not consistent with the description, cannot be regarded as belonging to the invention, see *Ex parte Warren* (1876), 10 O. G. 1.

That a re-issue cannot claim what is merely alluded to in the original as a possibility, but is not described therein as part of the invention, see *Ex parte Evans* (1873), 3 O. G. 180.

as a part thereof in the model or the drawings, although as thus described the invention is impracticable, and matter necessarily implied by what is actually described though not itself expressed in any form, are so contained in the original that an amendment by re-issue may include them.⁴ When the original patent has already been before the courts, and it has been judicially determined that its description relates to but a single form of the invention, its model, drawings, and specification must be thenceforth regarded as attempting to describe only that form of the invention, and the re-issue must be limited in a corresponding manner.⁵

§ 668. Variations between the Descriptions and Claims of the Original and Re-issued Patents not Inconsistent with Identity of Subject-Matter.

The restriction of a re-issue to the subject-matter attempted to be covered by the original patent does not require an exact correspondence between the specifications, drawings, and models of the original and re-issued patents, except in machine-patents where the model and drawings can be amended only by each other.¹ The specification of the re-issue may

⁴ That matter which as described is impracticable, may be redescribed and claimed in a practically operative form, see *Wheeler v. McCormick* (1873), 6 Fisher, 551; 11 Blatch. 334; 4 O. G. 692; *Wheeler v. Clipper Mower & Reaper Co.* (1872), 10 Blatch. 181; 6 Fisher, 1; 2 O. G. 442.

That a re-issue may include matters not described or claimed in the original patent if they were really parts of the original invention, and are necessarily implied by what was described, see *Eames v. Andrews* (1887), 122 U. S. 40; 39 O. G. 1319; *Ex parte Siemens* (1877), 12 O. G. 626.

⁵ That a re-issue, after the specification of the patent has been construed by the courts, cannot claim a different form of the invention from that held to have been described in the original, see *Cammermeyer v. Newton* (1879), 4 Bann. & A. 159; 16 O. G. 720.

That a re-issue may extend the patent beyond the judicial interpretation of the original Claims, see *Poppenhusen v. Falke* (1862), 5 Blatch. 46; 2 Fisher, 213.

§ 668. ¹ In *Stevens v. Pritchard* (1876), 4 Clifford, 417, Clifford, J. : (422) "Corrections may be made in such cases by the specifications, drawings, or Patent Office model, and if the alterations do not exceed what was well described before, and what is substantially suggested or indicated in the surrendered specifications, drawings, and Patent Office model, the re-issued patent cannot be held invalid upon the ground that it embodies and secures a different invention from the original." 10 O. G. 505 (507); 2 Bann. & A. 390 (395).

In *French v. Rogers* (1851), 1 Fisher, 133, Kane, J. : (138) "It is not the meaning of the law that the patent-

vary from that of the original in its language,² in its general

tee who applies for a re-issue must, at his peril, describe and claim in his new specification, either in words or idea, just what was described and claimed in his old one. His new specification must be of the same invention, and his Claim cannot embrace a different subject-matter from that which he sought to patent originally. But, unless we narrow down the correction which the statute contemplates till it becomes a mere disclaimer, it is not possible in any case to frame a correct specification which shall not be broader than the one originally filed. To supply a defect, to repair an insufficiency, is to add, — either directly, or by modifying or striking out a limitation; in either form, the effect is to amplify the proposition; in the case of a specification under the Patent Laws, it is to amplify the Description and enlarge the Claim."

That immaterial differences between the original and the re-issue, not affecting the construction or the mode of operation of the invention are permissible, see *Crandall v. Watters* (1881), 20 Blatch. 97; 21 O. G. 945; 9 Fed. Rep. 659; *McCrary v. Penna. Canal Co.* (1880), 5 Fed. Rep. 367; 14 Phila. 441; *Herring v. Nelson* (1877), 14 Blatch. 293; 12 O. G. 753; 3 Bann. & A. 55; *Glue Co. v. Upton* (1874), 4 Clifford, 237; 1 Bann. & A. 497; 6 O. G. 837; *Parham v. American Buttonhole, Overseaming, & Sewing Mach. Co.* (1871), 4 Fisher, 468.

That a re-issue may make definite what was before reached only by inference, see *Hicks v. Otto* (1884), 22 Blatch. 94; 29 O. G. 365; 19 Fed. Rep. 749.

That in the re-issue of other than machine-patents the specification may be made more certain or the Claim made to correspond with the specification, but nothing more, see *Giant Powder Co. v.*

California Powder Works (1875), 3 Sawyer, 448; 2 Bann. & A. 131.

That models and drawings in machine-patents can be amended only by each other, see *Stockwell v. Haines* (1877), 12 O. G. 137.

² In *Kerosene Lamp Heater Co. v. Littell* (1878), 3 Bann. & A. 312, Nixon, J. : (316) "It must be for the same invention; but, subject to this limitation, such changes may be introduced in the Description, specifications, or Claims, as may be deemed necessary to give validity to the invention, and protect it against infringement. Whatever is fairly indicated, either in the schedules, drawing, or model of the original, may be comprehended in the specifications and Claims of a re-issue without subjecting the patentee to the imputation of claiming more than he is entitled to." 13 O. G. 1009 (1010).

In *Herring v. Nelson* (1877), 12 O. G. 753, Johnson, J. : (755) "That in re-describing his invention the patentee is not rigidly confined to what was described before, but that he may include in the new description whatever else was suggested or substantially indicated in the old, provided it was embraced in the invention as actually made and perfected. Differences in the Description and Claims of the old and new specifications are not the tests of substantial diversity, but the Description may be varied and the Claim restricted or enlarged, provided the identity of the subject-matter of the original patent is preserved. Within this range whatever change is required to protect and effectuate the invention is allowable." 14 Blatch. 293 (300); 3 Bann. & A. 55 (62).

In *La Baw v. Hawkins* (1874), 1 Bann. & A. 428, Nixon, J. : (430) "The patentee has a right to change his modes of expressing his specifications

description of the invention,³ in its statement of the best mode

or Claims, — restricting or enlarging them, so as more fully to effectuate his intention. Variations in this respect do not make the two patents different. The precise object of the statute is to authorize such amendments. What he is not allowed to do is to interpolate into the re-issue new features and devices, which were not suggested or substantially indicated in the original specifications, drawings, models, or Claims." 6 O. G. 724 (725).

In *Aultman v. Holley* (1873), 11 Blatch. 317, Woodruff, J. : (319) "It is always to be borne in mind, in considering the validity of a re-issued patent, in the face of the objection before us, that the object of a re-issue, and the purpose of the law in permitting the surrender of a patent and a re-issue thereof, are to correct, or rather perfect, a defective or insufficient description or specification, including the Claim which the patentee makes to the devices described and which he alleges are his invention. The re-issue is, therefore, not to be tested by the mere language of the original specification, for the fact of re-issue proceeds upon the ground that such language is defective or insufficient." 6 Fisher, 534 (538) ; 5 O. G. 3 (5).

That the language of the re-issue specification may differ from that of the original, see *Dunbar v. White* (1883), 23 O. G. 1446 ; 15 Fed. Rep. 747 ; *National Pump Cylinder Co. v. Gunnison* (1883), 17 Fed. Rep. 812 ; *Davis v. Brown* (1881), 20 O. G. 1021 ; 9 Fed. Rep. 647 ; 19 Blatch. 263 ; *Pearl v. Ocean Mills* (1877), 2 Bann. & A. 469 ; 11 O. G. 2 ; *Sprague v. Adriance* (1877), 3 Bann. & A. 124 ; 14 O. G. 308 ; *Putnam v. Yerrington* (1876), 9 O. G. 689 ; 2 Bann. & A. 237 ; *Tucker v. Tucker Mfg. Co.* (1876), 2 Bann. &

A. 401 ; 4 Clifford, 397 ; 10 O. G. 464 ; *Carew v. Boston Elastic Fabric Co.* (1871), 3 Clifford, 356 ; 5 Fisher, 90 ; 1 O. G. 91.

That variances in the title, Descriptions, and Claims of the original and re-issue will not affect the latter, if the inventions are the same, see *Penna. Salt Mfg. Co. v. Thomas* (1871), 5 Fisher, 148 ; 8 Phila. 144.

That general descriptions in the original may be made definite in the re-issue if the invention is unchanged, see *St. Louis Stamping Co. v. Quinby* (1879), 16 O. G. 135 ; 4 Bann. & A. 192.

That the omission in the re-issue of ambiguous words of the original does not enlarge the invention, see *Atlantic Giant Powder Co. v. Goodyear* (1877), 13 O. G. 45 ; 3 Bann. & A. 161.

That the re-issue may contain new words or phrases more accurately descriptive of the invention, see *Draper v. Potomska Mills Co.* (1878), 13 O. G. 276 ; 3 Bann. & A. 214.

That a re-issue may omit words used in the original, see *Allen v. Blunt* (1846), 2 W. & M. 121 ; 2 Robb, 530.

That a re-issue changing one letter in name of patentee, viz., *Denchfield* to *Deuchfield*, is good, see *Bignall v. Harvey* (1880), 18 Blatch. 353 ; 18 O. G. 1275 ; 4 Fed. Rep. 334.

³ In *Potter v. Stewart* (1881), 18 Blatch. 561, Blatchford, J. : (562) "It is of no consequence that the re-issue states that certain combinations are found in the machine, which will act in a certain way and effect certain results, when the original did not state that such combinations were found there, or failed to state that said modes of operation and said results would follow, provided the said combinations in fact existed in a machine made according to the drawings and description in the original patent, or provided the

of using or constructing the invention,⁴ or in the number and

said modes of operation and the said results in fact followed in a machine so made. To supply such defects is the very object and office of a re-issue." 19 O. G. 997 (997) ; 7 Fed. Rep. 215 (216).

That identity and diversity between the original and re-issue depends on the things described, not on the mere descriptions, see *Herring v. Nelson* (1877), 3 Bann. & A. 55 ; 12 O. G. 753 ; 14 Blatch. 293.

That the description of the re-issue may be more full and accurate than the original, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 19 O. G. 173 ; 10 Bissell, 65 ; 4 Fed. Rep. 900 ; *Robertson v. Secombe Mfg. Co.* (1873), 6 Fisher, 268 ; 3 O. G. 412 ; 10 Blatch. 481 ; *Crompton v. Belknap Mills* (1869), 3 Fisher, 536 ; *Poppenhusen v. Falke* (1861), 4 Blatch. 493 ; 2 Fisher, 181.

That a re-issue may describe more fully and set forth distinct functions, or those not before stated, see *Doane & Wellington Mfg. Co. v. Smith* (1882), 24 O. G. 302 ; 15 Fed. Rep. 459.

That in a re-issue enlarging the Claims, the Claims alone are involved, and if the Description covers more than the Claims it is of no consequence, see *Turner & Seymour Mfg. Co. v. Dover Stamping Co.* (1884), 111 U. S. 319 ; 27 O. G. 1131.

That a re-issue may contain a fuller description of the state of the art, of the nature of the improvement, and of the advantages secured by its use, see *Robertson v. Secombe Mfg. Co.* (1873), 3 O. G. 412 ; 6 Fisher, 268 ; 10 Blatch. 481.

That a re-issue may describe a well-known thing differently from the original, see *Tarr v. Folsom* (1874), 1 Bann. & A. 24 ; 5 O. G. 92 ; Holmes 312.

That substances directly indicated in the original may be described in the

re-issue, see *Penna. Salt Mfg. Co. v. Thomas* (1871), 5 Fisher, 148 ; 8 Phila. 144.

That the re-issue may more fully describe surrounding parts, remove false impressions, or show how difficulties may be avoided, see *Kearney v. Lehigh Valley R. R. Co.* (1887), 32 Fed. Rep. 320.

That where the original imperfectly describes what the state of the art shows to have been the real invention, the re-issue may cover it, see *Yale Lock Mfg. Co. v. Scoville Mfg. Co.* (1880), 18 Blatch. 248 ; 3 Fed. Rep. 288.

That the re-issue may describe and claim the invention either with or without the adjuncts described in the original, if the invention in both be really the same, see *National Spring Co. v. Union Car Spring Mfg. Co.* (1874), 6 O. G. 224 ; 12 Blatch. 80.

That a re-issue may redescribe the invention by the original model, drawings, or specification, but it is doubtful if it can go beyond these and include matter shown in the original application only, see *Cahart v. Austin* (1865), 2 Fisher, 543 ; 2 Clifford, 528.

⁴ In *Broadnax v. Central Stock-Yard & Transit Co.* (1880), 4 Fed. Rep. 214, Nixon, J. : (216) "Because one mode only is indicated in the original, the patentee is not shut up to the one mode in the re-issue, as long as it is not of the essence of the invention. The law, indeed, requires him to disclose some mode by which it can be rendered practically useful, but it does not follow that he is confined to that, and may use no other." 5 Bann. & A. 609 (611).

That a re-issue may point out new uses or modes of using the original invention, see *Potter v. Stewart* (1881), 19 O. G. 997 ; 7 Fed. Rep. 215 ; 18 Blatch. 561 ; *Ex parte Palmer* (1880),

scope of its Claims.⁵ The Claims, if previously too narrow,

17 O. G. 976 ; *Do Florez v. Raynolds* (1878), 14 Blatch. 505 ; 3 Bann. & A. 292 ; *Ex parte Donaldson* (1873), 4 O. G. 4.

That a mistake in the original patent, as to the effect produced by the use of the invention, may be corrected by re-issue, not by disclaimer, see *Schillinger v. Gunther* (1878), 14 O. G. 713 ; 15 Blatch. 303 ; 3 Bann. & A. 491.

That the re-issue is good though it expresses different views from the original as to which one of two modes of construction is best, see *American Nicholson Pavement Co. v. Elizabeth* (1873), 3 O. G. 522 ; 6 Fisher, 424.

That a re-issue may depart from the original in matters of mechanical adaptation, see *Decker v. Grote* (1873), 10 Blatch. 331 ; 6 Fisher, 143 ; 3 O. G. 65.

⁵ That a re-issue may explain and modify the Claims of the original, see *Smith v. Merriam* (1881), 19 O. G. 601 ; 6 Fed. Rep. 713 ; *Woodward v. Dinsmore* (1870), 4 Fisher, 163.

That the inventions may be the same though the Claims of the re-issue be entirely unlike those of the original, see *Hussey v. Bradley* (1863), 2 Fisher, 362 ; 5 Blatch. 134 ; *Hussey v. McCormick* (1859), 1 Fisher, 509 ; 1 Bissell, 300.

That the invention can be divided into distinct Claims in a re-issue, see *Brown v. Deere* (1881), 19 O. G. 361 ; 2 McCrary, 422 ; 6 Fed. Rep. 484.

That an improper multiplication of Claims in the re-issue does not affect the patent, the superfluous Claims being void, see *Dederick v. Cassell* (1881), 20 O. G. 1233 ; 9 Fed. Rep. 306 ; 14 Phila. 503.

That the re-issue may contain new Claims founded on the original Description, see *Combined Patents Can Co. v. Lloyd* (1882), 11 Fed. Rep. 149 ; 21 O. G. 713 ; 15 Phila. 481.

That a re-issue may claim matters found in the original Description though the inventor made no attempt to insert them in his Claims, see *Eickemeyer Hat Blocking Mach. Co. v. Pearce* (1873), 3 O. G. 150 ; 10 Blatch. 403 ; 6 Fisher, 219.

That a re-issue may restate the invention and claim such essential features as are not clearly stated in the original, see *Woven Wire Mattress Co. v. Wire Web Bed Co.* (1881), 8 Fed. Rep. 87.

That a re-issue may secure a different feature of the invention from the one claimed in the original patent, if it does not go beyond the invention described or suggested in the original, see *Stevens v. Pritchard* (1876), 4 Clifford, 417 ; 10 O. G. 505 ; 2 Bann. & A. 390.

That the patentee may in a re-issue claim a form of the invention described but not claimed in the original, when its importance has become apparent since the original was granted, see *Atwood v. Portland Co.* (1880), 5 Bann. & A. 533 ; 10 Fed. Rep. 283.

That where an original patent describes two forms of the invention and claims but one, the re-issue may claim the other, see *American Nicholson Pavement Co. v. Elizabeth* (1873), 6 Fisher, 424 ; 3 O. G. 522.

That the re-issue may cover the actual invention made, according to the original specification and drawings, though the specification may not have accurately described it, see *Potter v. Stewart* (1881), 7 Fed. Rep. 215 ; 18 Blatch. 561 ; 19 O. G. 997.

That a re-issue may contain new drawings based on the original specification, see *Union Paper Bag Co. v. Nixon* (1873), 6 Fisher, 402 ; 4 O. G. 31.

That the drawings of the re-issue may contain features not shown in the drawings of the original, see *Union Paper*

may be extended to embrace the entire patented invention, unless the additional features have been abandoned;⁶ or, if excessive, may be so reformed as to exclude the matter hitherto improperly embraced within the patent.⁷ But matter once described in the original specification as essential to the invention cannot be omitted;⁸ and matter once disclaimed —

Bag Co. v. Nixon (1873), 4 O. G. 31 ;
6 Fisher, 402.

That the drawings may be amended in matters outside the model if it does not affect the Claims of the re-issue, see *Pearl v. Appleton Co.* (1880), 3 Fed. Rep. 153.

⁶ That the Claims of a re-issue may be stated in language differing from those of the original, see *Fay v. Fraser* (1882), 11 Bissell, 422 ; 14 Fed. Rep. 652 ; *La Baw v. Hawkins* (1874), 6 O. G. 724 ; 1 Bann. & A. 428 ; *Poppenhusen v. Falke* (1862), 2 Fisher, 213 ; 5 Blatch. 46.

That the re-issue may cover the invention though it is broader than the patentee at first supposed, see *Tuttle v. Loomis* (1885), 24 Fed. Rep. 789 ; 30 O. G. 344.

That in a re-issue the Claims may be either enlarged or restricted as may be necessary to cover the actual invention, see *Dorsey Harvester Rake Co. v. Marsh* (1873), 6 Fisher, 387.

That enlarging Claims is not enlarging the invention, see *Jenkins v. Stetson* (1887), 32 Fed. Rep. 398 ; *Odell v. Stout* (1884), 22 Fed. Rep. 159 ; 29 O. G. 862.

That the re-issue may claim more than the original, see *Robertson v. Secombe Mfg. Co.* (1873), 6 Fisher, 268 ; 3 O. G. 412 ; 10 Blatch. 481.

That an element described but not claimed in the original patent, may be claimed in the re-issue, see *Loring v. Hall* (1879), 15 O. G. 471.

That a re-issue cannot claim other and distinct things from those attempted to be claimed in the original, see *Kells v. McKenzie* (1881), 9 Fed. Rep. 284 ; 20

O. G. 1663. See also *Am. Law Rev.* vol. xv. p. 731.

That where the original patent fully and clearly describes and claims a specific invention so as not to be invalid by reason of an insufficient specification, the re-issue cannot expand and generalize the Claims so as to go beyond the original, see *James v. Campbell* (1882), 104 U. S. 356 ; 21 O. G. 337 ; *Gill v. Wells* (1874), 22 Wall. 1 ; 6 O. G. 881 ; *Burr v. Duryee* (1863), 1 Wall. 531.

That the omission of ambiguous words in the re-issue does not enlarge it, see *Atlantic Giant Powder Co. v. Goodyear* (1877), 3 Bann. & A. 161 ; 13 O. G. 45.

That the opinion of the inventor, stated in the re-issue, as to the character of his invention is not improper if it does not affect the Claims, see *Reed v. Chase* (1885), 25 Fed. Rep. 94 ; 33 O. G. 996.

⁷ That the re-issue may be narrower than the original if the invention is unchanged, see *Gould v. Ballard* (1878), 3 Bann. & A. 324 ; 13 O. G. 1081.

That a re-issue need not claim all matters found in the original, see *Gould v. Ballard* (1878), 3 Bann. & A. 324 ; 13 O. G. 1081 ; *Albright v. Celluloid Harness Trimming Co.* (1877), 12 O. G. 227 ; 2 Bann. & A. 629 ; *Chicago Fruit House Co. v. Busch* (1871), 4 Fisher, 395 ; 2 Bissell, 472 ; *Crompton v. Belknap Mills* (1869), 3 Fisher, 536 ; *Carver v. Braintree Mfg. Co.* (1843), 2 Story, 432 ; 2 Robb, 141 ; *Knight v. Baltimore & Ohio R. R. Co.* (1840), 3 Fisher, 1 ; Taney, 106.

⁸ That a re-issue cannot treat as non-essential what the original treated as es-

whether during the proceedings in the Patent Office in order to avoid an interference or to overcome the objections of an examiner, or in the body of the original patent, or by a subsequent disclaimer filed to save the patent or secure the costs of suit, — cannot be reclaimed, except in cases where the party applying for and obtaining the re-issue could not, according to the principles of equity, be regarded as estopped by the disclaimer.⁹ The legal effect of such amendments, if allowed, would be an enlargement of the patented invention, and an insertion into the re-issue of features wholly distinct from or in addition to the subject of the original patent. Whatever variations may be made in the description or the Claims of the re-issue, neither directly nor indirectly can new matter be introduced into the patent,¹⁰ by embracing parts of the

essential, see *Russell v. Dodge* (1876), 93 U. S. 460 ; 11 O. G. 151.

That an immaterial element may be dropped in the re-issue, see *McWilliams Mfg. Co. v. Blundell* (1882), 22 O. G. 177 ; 11 Fed. Rep. 419 ; *Union Paper Collar Co. v. Van Deusen* (1872), 5 Fisher, 597 ; 10 Blatch. 109 ; 2 O. G. 361 ; *Woodward v. Dinsmore* (1870), 4 Fisher, 163.

That where a difference in the number or quantity of the parts of an invention does not affect its substantial character or mode of operation, a re-issue for less than the original is good, see *Coburn v. Schroeder* (1881), 20 O. G. 1524 ; 8 Fed. Rep. 519 ; 19 Blatch. 377.

That an element apparently material may be omitted in the re-issue if the essence of the invention be unchanged, see *McWilliams Mfg. Co. v. Blundell* (1882), 22 O. G. 177 ; 11 Fed. Rep. 419.

That the re-issue may restrict the invention by omitting minor features described in the original, see *Gould v. Ballard* (1877), 13 O. G. 1081 ; 3 Bann. & A. 324.

⁹ See §§ 680, 687-689, and notes, *post*.

That the re-issue is good where equity

would decree the same correction of the mistake, see *Jones v. Barker* (1882), 11 Fed. Rep. 597 ; 22 O. G. 771 ; *Miller v. Brass Co.* (1881) 104 U. S. 350 ; 21 O. G. 201.

¹⁰ In *Thomas v. Shoe Mach. Mfg. Co.* (1878), 16 O. G. 541, Clifford, J. : (542). " Patents may be surrendered to be corrected, and the power to surrender implies that the specification may be corrected to the extent necessary to cure the defects and to supply the deficiencies to render the patent operative and valid ; but the patentee may not interpolate new features not described, suggested, or substantially indicated either in the specification, drawings, or Patent Office model. Interpolations of the kind, if material, show that the Commissioner exceeded his jurisdiction, and where that is done it clearly becomes the duty of the court to declare the patent void." 3 Bann. & A. 557 (560).

In *Russell v. Dodge* (1876), 93 U. S. 460, Field, J. : (463) " And as a re-issue could only be granted for the same invention embraced by the original patent, the specification could not be substantially changed, either by the addition of new matter or the omission of important particulars, so as to enlarge

invention which the patentee did not attempt to cover by his former patent, or by reviving claims then made and since

the scope of the invention as originally claimed. A defective specification could be rendered more definite and certain so as to embrace the Claim made, or the Claim could be so modified as to correspond with the specification; but except under special circumstances, such as occurred in the case of *Lockwood v. Morey*, 8 Wall. 230, where the inventor was induced to limit his Claim by the mistake of the Commissioner of Patents, this was the extent to which the operation of the original patent could be changed by the re-issue. The object of the law was to enable patentees to remedy accidental mistakes, and the law was perverted when any other end was secured by the re-issue." 11 O. G. 151 (152).

In *Stevens v. Pritchard* (1876), 4 Clifford, 417, Clifford, J. : (421) "Surrenders are allowed in order that what was imperfect before may be made perfect, and in order that what was before ambiguous may be made clear and certain; and for that purpose the patentee may add whatever was substantially suggested or indicated in the original specifications, drawings, or Patent Office model. New features may not be introduced for the reason that every interpolation of the kind is forbidden by the act of Congress. Errors and defects may, however, be corrected under the conditions specified, and the prohibition that new features shall not be introduced must not be understood as taking away the right to include in the re-issue whatever was substantially suggested or indicated in the surrendered specifications, drawings, or Patent Office model." 10 O. G. 505 (506); 2 Bann. & A. 390 (393).

In *Salamander Felting Co. v. Haven* (1875), 3 Dillon, 131, Treat, J. : (134) "The repeated decisions by the courts,

and especially by the United States Supreme Court, in the 1st, 17th, and 19th Wallace, indicate with sufficient distinctness, that not only no new matter shall be introduced, but that an enlargement of the original Claim, growing out of the subsequent advance of the art, is not to be tolerated. The reason of the rule is obvious. Every patent as to novelty or utility depends on the state of the art at the time of the claim made or patent issued, and, therefore, if a party, after learning from a subsequent advance of the art the worthlessness of his original invention, is to be permitted to claim a re-issue incorporating what was not originally in his mind, and what had been afterwards suggested to him only by advances in the art made by others, then he could, it may be, even without any new invention, override all the elements which would serve to test the validity of the new application. In other words, having procured a worthless patent, and having subsequently learned from the advancing art how, by changing the terms of his patent, it could be made of value, he would, if a re-issue, including the new matter, were permitted, have the re-issue not only relate back to the date of the original patent, but absorb within its privileges all subsequent matters, wholly unknown to, and unthought of by him, originally. This rule controls both the Patent Office and the courts. New matter must not be introduced. By new matter is not meant merely the introduction of a new ingredient in a patented composition, but any change in the original specification and Claim whereby a new and substantially different composition and results are secured." 9 O. G. 253 (254).

Further that "new matter" cannot be embraced in a re-issued patent, see

abandoned, or by extending his description to inventions created after the original patent had been granted.

Andrews v. Hovey (1833), 5 McCrary, 181; 16 Fed. Rep. 387; 26 O. G. 1011; *Washburn & Moen Mfg. Co. v. Haish* (1880), 10 Bissell, 65; 19 O. G. 173; 4 Fed. Rep. 900; *Giant Powder Co. v. California Powder Works* (1875), 3 Sawyer, 448; 2 Bann. & A. 131; *Glue Co. v. Upton* (1874), 1 Bann. & A. 497; 4 Clifford, 237; 6 O. G. 837; *Carew v. Boston Elastic Fabric Co.* (1871), 3 Clifford, 356; 5 Fisher, 90; 1 O. G. 91.

That a re-issue blending old matter and new matter in the same Claim is void, see *Cabart v. Austin* (1865), 2 Fisher, 543; 2 Clifford, 528.

That enlarged Claims are to be carefully scrutinized to see that they contain no new matter, see *Tyler v. Welch* (1880), 17 O. G. 1508; 3 Fed. Rep. 636; 18 Blatch. 209.

That new matter cannot be inserted in the re-issue though invented by the patentee and inadvertently omitted by him from the original, see *Atwater Mfg. Co. v. Beecher Mfg. Co.* (1881), 8 Fed. Rep. 608.

That where the original patent had no model or drawing, no new matter can be inserted in the re-issue on the ground that the inventor had it in his mind when the original application was filed, see *Ex parte Dieckerhoff* (1877), 12 O. G. 429.

That the rule as to the insertion of new matter is more strict in re-issues than in amendments to applications, — the former being governed by law, the latter by the discretion of the Commissioner, — see *Ex parte Bragg* (1875), 8 O. G. 985.

That new matter is anything not embraced in the original specifications, drawings, and model, see *Dederick v. Cassell* (1881), 14 Phila. 503; 20 O. G. 1233; 9 Fed. Rep. 306.

That where the same idea is found in the original specification and drawings, there is no new matter, see *Christman v. Rumsey* (1879), 58 How. Pr. 114; 17 Blatch. 148; 17 O. G. 903; 4 Bann. & A. 506.

That "new matter" in a re-issue is such an enlargement or alteration in the original specification and Claims as to include combinations or results which did not necessarily flow from the invention as originally described, see *Putnam v. Yerrington* (1876), 2 Bann. & A. 237; 9 O. G. 689.

That "new matter" in a re-issue is such as changes the invention or introduces what might be the subject of a new patent, see *Seibert Cylinder Oil Cup Co. v. Harper Steam Lubricator Co.* (1880), 4 Fed. Rep. 328; *Powder Co. v. Powder Works* (1878) 98 U. S. 126; 15 O. G. 289.

That nothing can be regarded as "new matter" unless it affects the substance of the invention, see *Christman v. Rumsey* (1879), 17 O. G. 903; 4 Bann. & A. 506; 58 How. Pr. 114; 17 Blatch. 148; *Ex parte Carlock* (1875), 8 O. G. 191.

That where the re-issue seeks to cover an infringing device it will be closely scrutinized, but will be valid if clearly for the same invention as the original patent, see *Crompton v. Knowles* (1881), 7 Fed. Rep. 199.

That unless it clearly appears that the re-issue contains new matters, substantially different from the original, it will be held valid, see *Thomas v. Shoe Machinery Mfg. Co.* (1878), 16 O. G. 541; 3 Bann. & A. 557.

That where the Claim in the re-issue states what the original Claim must have been construed to mean, there is no new matter, see *Gold & Stock Telegraph Co. v. Commercial Telegram Co.*

§ 669. **The Re-issued Patent may Embrace all Inventions which the Original Patent Defectively or Insufficiently Described and Claimed, subject to the Rules Governing the Joinder of Inventions.**

The application of this second proposition to individual cases of re-issue would be comparatively simple and easy were every patent limited to a single invention. Then having ascertained, in view of the state of the art at the date of the original patent, what were the essential attributes of the actual invention which the patentee endeavored to secure, as indicated in his specification, the amendments necessary to set forth and claim it with completeness and exactness could be readily perceived. But under the doctrines which permit the joinder of several distinct though dependent inventions in one patent, the subject becomes more complicated. The specification of a patent may describe and claim several distinct inventions, or it may describe several and claim only a certain number of those described, or it may describe and claim but one. In determining the scope of an original patent, as a basis for its amendment by re-issue, the question as to what invention the inventor has attempted to protect must then be variously answered. When the original specification describes but one invention, this of course is the only matter that can be embraced in the re-issue. But where it has described and claimed one art or instrument, and with that also has described subordinate parts which are distinct inventions, or has set forth additional inventions dependent on or independent of the one specifically claimed, the scope permissible to the re-issue must be subjected to a different test. It cannot be assumed that the original patent attempted to protect nothing except the one invention which it claimed. Nor, on the other hand, can it be supposed that the inventor intended to embrace therein distinct inventions, whose joinder with the principal invention is

(1885), 23 Blatch. 199 ; 23 Fed. Rep. 340 ; 31 O. G. 1559.

That a re-issue is too broad only where it embraces what was not described in the original as part of the invention or being described was aban-

doned, see *Eames v. Andrews* (1887), 122 U. S. 40 ; 39 O. G. 1319.

See further as to the subject of this paragraph, § 656, note 3, and § 661 and notes, *ante*, and § 693 and notes, *post*.

prohibited by law. In such cases, if the patent does not itself indicate the contrary, there seems to be no other practicable method of construing the original patent than to regard it as an attempt of the inventor to secure not only the invention claimed, but all the new results of his inventive skill whose nature and essential attributes he has substantially indicated in his description, and which were dependent on the invention covered by his original patent; and if these have not been abandoned or disclaimed they may all be included in the re-issue.¹ It is apparently upon this method that the courts and

§ 669. ¹ Although no formal statement of this rule may be found in the reported cases, it has nevertheless been too often acted on by the courts to be disputed. The decisions cited in the subsequent paragraphs show that the test applied is not that of the presence of the subordinate or dependent inventions in the Claims of the original patent, but their capability of being claimed therein under the rules of joinder. It is taken for granted, where there are no indications to the contrary, that the patentee intended to secure by his original patent all those dependent and auxiliary inventions which he then described as resulting from his inventive act, and in the absence of any abandonment or estoppel, he is permitted to insert in his re-issue any such inventions which could lawfully have been claimed in the original. The few cases which depart from this rule are so manifestly unjust in their effect, and involve so wide a divergence from the settled principles of Patent Law, that they cannot be regarded as authority against the current practice of the Patent Office and the general position of the courts.

Within the limits of the doctrine thus declared there are, however, certain variations which deserve attention. Inventions capable of joinder may be either (1) mutually separable, or (2) mutually inseparable, or (3) one may be unable to subsist without the other though the

other, on the contrary, could independently exist. Where the inventions are mutually inseparable a patent for one impliedly covers the other and is a bar to any subsequent patent therefor. The same is true where an invention, with which another is inseparably connected, has been patented. As in both these cases the unclaimed invention must either have been within the intended scope of the original patent, or have been abandoned to the public under circumstances which prevented the public from enjoying it by reason of its connection with the matter expressly patented, it is always a fair presumption that the patentee, by describing it in his original specification, endeavored to bring it within his monopoly and consequently has a right to claim it in his re-issue. But where the inventions are mutually separable or the invention sought to be introduced into the re-issue is not inseparable from the one claimed in the original patent, no such presumption can arise. Here it was optional for the inventor to have embraced the inventions in the same or different patents, and from the fact that he describes them in connection with the invention claimed in the original, no inference can be drawn that he did not intend to abandon them to the public or to procure for them a separate patent. In these cases the validity of the Claims by which they are appropriated in the re-issue must de-

the Patent Office have proceeded in affirming or denying the correspondence of re-issues with original patents in the different classes of cases which we now are to consider.

§ 670. Re-issued Combination-Patent cannot Embrace a Combination Essentially Distinct from that Described and Claimed in the Original Patent.

Where the subject-matter of the original patent is a combination, the re-issue may always cover the same combination; in some cases, it may be extended to protect sub-combinations, and in others to secure even the elements of which the combination is composed. The identity of the combination claimed in the re-issue with that which the inventor endeavored to describe and claim in the original specification depends upon the identity of their respective elements and of the co-operative law under which they are associated.¹ If the combination claimed in the re-issue contains less than all the elements of that described in the original, or if it substitutes for any former element an act or substance which is not its true equivalent,²

pend largely on the rules followed by the Office or the courts in comparing the original and re-issued patents. If the rule stated so often by Judge Clifford is adopted, — that the re-issue is valid unless the court can see that its subject-matter was not included in the attempt of the patentee to describe and claim his invention in the original specification, — such a relation between the inventions would, in the absence of any counter indications, relieve the original and re-issued patents from any appearance of repugnancy, and warrant a decision that the claims were valid. But if the rule is, as announced in more recent decisions, that a comparison of the two patents must affirmatively show that the invention claimed in the re-issue was evidently intended by the patentee to be embraced in his original Claims, a contrary conclusion might be reached, since the relation between the inventions is not incompatible with their intentional exclusion from the original patent. See also §§ 464-466 and notes, *ante*.

That a re-issue for separate parts of the invention where the original did not contemplate them as separate inventions, is void, see *Ex parte Powell* (1878), 13 O. G. 911.

§ 670. ¹ That a combination-patent cannot be re-issued to cover a different combination or a combination embracing new elements, see *Washburn & Moen Mfg. Co. v. Fuchs* (1883), 5 McCrary, 236; 16 Fed. Rep. 661.

That a claim for a combination of parts, made in a peculiar way for a peculiar purpose, cannot be expanded by re-issue to include a combination of the same parts without limitation as to construction or uses, see *McMurray v. Malloy* (1884), 111 U. S. 97; 27 O. G. 915.

² In *Gill v. Wells* (1874), 22 Wall. 1, Clifford, J.: (24) "Very different rules, however, apply in a case where the only invention described in the original patent is the one which includes all the ingredients of the machine, provided there is no suggestion, indication, or intimation that any other invention of

or if it adds to the original elements another element per-

any kind has been made. Such a patentee as the one last mentioned may subsequently discover that he can accomplish a new and useful result by a combination embracing less than the whole number of the ingredients included in the prior patented combination, but he cannot secure the right and privilege of a patentee in the combination of the smaller number of the ingredients by a surrender of his first patent and a re-issue of the same which shall include the second combination as well as the first, because the re-issued patent in that event would not be for the same invention as the surrendered original. . . .

(27) Equivalents are doubtless allowed to a patentee or owner of the patent to shut out infringements, but the Patent Act furnishes no support to the theory that the patentee may surrender a patent for an invention consisting of a combination of old ingredients, and amend the descriptive parts of the specification by striking out the entire description of one of the ingredients of the combination and inserting in lieu thereof a full description of several other devices, without any allegation that they are the equivalents of the one whose description is stricken out, or any explanation whatever, showing the reason why the change was made." 6 O. G. 881 (884, 885).

This portion of the above opinion is sometimes referred to as denying the right to cover sub-combinations in a re-issue. But it has no bearing on that question. A combination may be composed of simple elements united under a co-operative law. Or it may be composed of sub-combinations, i. e., of groups of elements, each group being itself a complete combination and entering into co-operative union with the other groups, not as an aggregation of collective elements, but as an organ-

ism governed by its own co-operative law. A combination composed of simple elements contains no sub-combinations, but each one of its elements co-operates with every other and performs its individual and distinctive function in the combination. In such a combination no patentable subject-matter exists except the combination as an entirety and its severable elements. Any union of the elements less than the whole number constitutes a distinct combination, utterly independent of the former and outside the scope of any patent by which the former may have been protected. It is to this class of combinations and this only that the doctrine of *Gill v. Wells*, here cited, and similar decisions, can apply. A combination composed of sub-combinations, on the other hand, contains three forms of patentable matter, — the principal combination, the sub-combinations, and the elements entering into each sub-combination; and all of these are within the scope of the patent for the principal combination, and under proper circumstances may be claimed in its re-issue. But in these cases the line dividing the sub-combinations from each other must be strictly preserved. A combination of one sub-combination with a portion of another is not a part of the original invention but an entirely separate combination, introducing a new grouping of the elements and a new co-operative law. Where a combination is formed by adding a simple element to a complete sub-combination, the principal combination, the sub-combination, and the added element are the sole subjects-matter to which a patent for the principal combination can extend, and to these only while they retain their individual identity.

That a patent for a combination cannot re-issue to cover a less number of elements unless described in the original

forming a new material function in the combination,³ or if it groups the same elements under a different method of co-

as a sub-combination, see *Jenkins v. Stetson* (1887), 32 Fed. Rep. 398.

That a re-issue is void when the original was for a combination only, if it covers a lesser combination of some of the original elements and is issued within four months of the expiration of the original, see *Gage v. Herring* (1882), 107 U. S. 640 ; 23 O. G. 2119.

That a re-issue of a combination-patent is void if it omits one of the essential elements of the original invention, see *Jenkins v. Stetson* (1887), 32 Fed. Rep. 398 ; *Neacy v. Allis* (1882), 22 O. G. 1621 ; 13 Fed. Rep. 874 ; *Cammerer v. Newton* (1879), 16 O. G. 720 ; 4 Bann. & A. 159 ; *Redmond v. Parham* (1879), 16 O. G. 359.

That the re-issue of a combination-patent cannot omit one of the elements on the ground that experience has shown it to be unnecessary, see *Hale v. Stimpson* (1865), 2 Fisher, 565 ; *Vance v. Campbell* (1861), 1 Black, 427.

That an original, covering a combination of four elements, cannot re-issue as covering three only, or the combination of three with a different fourth element, see *Gill v. Wells* (1874), 22 Wall. 1 ; 6 O. G. 881.

That a re-issue is void when the original was for a combination and the re-issue is for another combination, containing only part of the elements of the former and operating in a different way, see *Johnson v. Railroad Co.* (1882), 105 U. S. 539 ; 22 O. G. 329 ; *Johnson v. Railroad Co.* (1878), 15 Blatch. 192 ; 3 Bann. & A. 428.

That when an element formerly claimed as essential is omitted, the Claim is expanded, see *Phillips v. Risser* (1885), 26 Fed. Rep. 308.

That if an inventor allows his solicitor to describe an element as essential and the patent so to issue, he is bound

by it and cannot re-issue to exclude that element, see *Holt v. Keeler* (1882), 21 Blatch. 68 ; 22 O. G. 1291 ; 13 Fed. Rep. 464.

That a combination-patent cannot be re-issued, after fifteen years, so as to drop elements described as essential in the original, and so cover a different invention, see *Johnson v. Railroad Co.* (1882), 105 U. S. 539 ; 22 O. G. 329.

That the re-issue of a combination-patent cannot substitute another element for one of those contained in the original, unless the substituted element be a mere equivalent, see *Blackman v. Hibbler* (1879), 17 Blatch. 333 ; 4 Bann. & A. 641 ; 17 O. G. 107 ; *Gill v. Wells* (1874), 22 Wall. 1 ; 6 O. G. 881 ; *National Spring Co. v. Union Car Spring Mfg. Co.* (1874), 6 O. G. 224 ; 12 Blatch. 80 ; *Decker v. Grote* (1873), 3 O. G. 65 ; 10 Blatch. 331 ; 6 Fisher, 143 ; *Gallahue v. Butterfield* (1872), 10 Blatch. 232 ; 2 O. G. 645 ; 6 Fisher, 203.

³ In *Washburn & Moen Mfg. Co. v. Fuchs* (1883), 16 Fed. Rep. 661, Treat, J. : (668) "The attempt to justify the re-issued patent of May 12, 1874, by invoking the prior application, October 27, 1873, for the patent of November, 1874, falls within the reasoning of the United States Supreme Court, 11 Wall. 516 ; the statement wherein is the *converse* of that now under review. That court said: 'Where the thing patented is an entirety, consisting of a single device or combination of old elements incapable of division or separate use, the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire thing is found in one prior patent or printed publication, or machine, and another part in another prior exhibit, and still another part in a third one, and from the three or any greater num-

operation, — the re-issue has departed from the original patent and cannot be sustained. But if the actual nature of the combination is unchanged, the re-issue may vary widely from the original in its statement of the invention as well as in its Claims.⁴ Non-essential parts which the original specification erroneously described as entering into the combination may be omitted, or equivalents for any of the elements may be introduced, their equivalence being duly pointed out in the re-issue specification.⁵ Though the original purports to describe the invention as a single article, yet if it be a true combination, as shown upon the face of that description, the re-issue may claim it according to its proper character.⁶ But a suggestion, in a patent for an element or a sub-combination, that it is capable of use when combined with others also named, without substantially indicating the nature and essential fea-

ber of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented improvement.' If this be true as to the nature of a combination when an infringer seeks to defeat the same, why is it not equally true where a re-issue is sought to be upheld, under an original patent, by importing into the re-issue devices not suggested in the original, making thereby a new combination, distinct from the original? In other words, the re-issue must be confined to the original 'combination,' and cannot be expanded to make a new combination by introduction therein of devices, new or old, not included in or suggested by the original. *Munson v. Gilbert & Barker Manuf'g. Co.*, 3 Bann. & A. 595. It must be borne in mind that the court is dealing with a 'combination' patent, and that under pretence of a re-issue a new combination cannot be upheld." 5 McCrary, 236 (245). See also *Hayes v. Bickelhaupt* (1885), 32 O. G. 133; 23 Fed. Rep. 183.

⁴ That where the original patent describes and claims two elements, either of which is the equivalent of both, the re-issue may claim either alone, see *Gal-*

lahue v. Butterfield (1872), 6 Fisher, 203; 10 Blatch. 232; 2 O. G. 645.

That where an original patent described and claimed a certain element having two specific properties, which properties constituted the value of that element in the combination, the re-issue may claim any other element then known which had the same properties, see *Dunbar v. White* (1881), 4 Woods, 116; 23 O. G. 1446; 15 Fed. Rep. 747.

⁵ That a re-issue of a combination-patent may omit one or more of the non-essential features described in the original, see *Parham v. American Buttonhole, Overseaming, & Sewing Mach. Co.* (1871), 4 Fisher, 468.

That if such non-essential feature were, however, claimed as an essential element the mistake is irremediable, see §§ 278, 282, 527, and notes, *ante*.

That equivalents may be introduced by the re-issue, provided their equivalence is pointed out in the re-issued patent, see *Gill v. Wells* (1874), 22 Wall. 1; 6 O. G. 881.

⁶ That where the original patent covers an "article" the re-issue may claim it as a combination, see *Middletown Tool Co. v. Judd* (1867), 3 Fisher, 141.

ures of the resulting combination, does not warrant a re-issue covering such combination.⁷

§ 671. Re-issued Combination-Patent may Embrace Sub-Combinations.

When the original patent describes and claims only the combination, but at the same time in its model, drawings, or specifications substantially sets forth any or all of the various sub-combinations which enter into the principal invention, these may be claimed in the re-issue, if not before abandoned or disclaimed, provided they originated from the inventive genius of the same inventor.¹ That the entire combination described

⁷ That where the original merely suggests that the invention can be used with certain other devices, the re-issue cannot claim the combination of the invention with such devices, see *Ex parte Wooten* (1873), 3 O. G. 521.

§ 671. ¹ In *Christman v. Rumsey* (1879), 17 Blatch. 148, Blatchford, J. : (155) "Under the decision in *The Corn Planter Patent* (23 Wallace, 181), which was subsequent to that in *Gill v. Wells*, the re-issue in the present case cannot be held to be void. The drawings of the original and the re-issue being the same, and the two specifications describing the same mechanical structure, with the same mode of operation, it must be held to be lawful to re-issue the patent with Claims to combinations of fewer elements than were contained in the combination claimed in the Claim of the original patent. The original claimed a general and larger combination, and the re-issue claims sub-combinations which enter into such general and larger combination. Such a re-issue was sustained in *The Corn Planter Patent*, on the ground that the re-issue was for things contained within the apparatus described in the original patent, and against the effort to control the case by the decision in *Gill v. Wells*." 17 O. G. 903 (905) ; 58 How. Pr. 114 (123) ; 4 Bann. & A. 506 (513).

In *Herring v. Nelson* (1877), 12 O. G. 753, Johnson, J. : (756) "But upon the doctrine of these cases in respect to actions for infringements, it is sought to establish a distinction between patents for combinations of old elements and all other patents in regard to re-issues, and to deny the power to re-issue such a patent for a combination of any fewer elements than were contained in the original combination. Now the Patent Act makes no such distinction. Its terms are general and relate alike to all patents. The position is set up and rests upon this argument, viz., the re-issue must be for the same invention. This consists in the combination, which disappears when one element is omitted. But this argument, true or unsound, does not apply to a case in which among the old elements some are single and some are sub-combinations entering into the general and larger combination." 14 Blatch. 293 (303) ; 3 Bann. & A. 55 (65).

In *Pearl v. Ocean Mills* (1877), 11 O. G. 2, Shepley, J. : (4) "When in the specification of the original patent the inventor describes a new and useful combination of a number of ingredients, performing in combination certain functions less than he has claimed, he may in the re-issue claim such combination of the less number which he has de-

and claimed in the original was impracticable does not prevent such a re-issue for the sub-combinations if, as suggested in the original patent, these are practically operative arts or instruments, and the re-issue indicates how each one may

scribed, suggested, or substantially indicated as his invention, but failed to include in his Claims; and the re-issue need not describe it in the exact language of the original, but may contain a more full and exact description of the same invention, imperfectly described in the original. There is nothing in the decision in *Wells v. Gill* in conflict with this statement of the principle of Patent Law." 2 Bann. & A. 469 (475).

In *Gill v. Wells* (1874), 22 Wall. 1, Clifford, J. : (24) "Cases arise where a patentee, having invented a new and useful combination consisting of several ingredients which in combination compose an organized machine, also claims to have invented new and useful combinations of fewer numbers of the ingredients; and in such cases the law is well settled that if the several combinations are new and useful, and will severally produce new and useful results, the inventor is entitled to a patent for the several combinations, provided that he complies with the requirement of the Patent Act and files in the Patent Office a written description of each of the alleged new and useful combinations, and of the manner of making, constructing, and using the same. He may give the description of the several combinations in one specification, and in that event he can secure the full benefit of the exclusive right to each of the several inventions by separate Claims referring back to the Description in the specification; and if by inadvertence, accident, or mistake, he should fail to claim any one of the described combinations, he may surrender the original patent and have a re-issue not only for the combination or combinations claimed in the original, but for any which were so omitted

in the Claims of the original patent." 6 O. G. 881 (884).

Further, that sub-combinations, if shown in the original patent, and invented by the same inventor, may be claimed in the re-issue, see *Jenkins v. Stetson* (1887), 32 Fed. Rep. 398; *Hubel v. Dick* (1886), 24 Blatch. 59; 28 Fed. Rep. 132; 36 O. G. 939; *Odell v. Stout* (1884), 22 Fed. Rep. 159; 29 O. G. 862; *Dederick v. Cassell* (1881), 14 Phila. 503; 9 Fed. Rep. 306; 20 O. G. 1233; *Kerosene Lamp Heater Co. v. Littell* (1878), 13 O. G. 1009; 3 Bann. & A. 312; *Turrell v. Spaeth* (1878), 14 O. G. 377; *Miller v. Bridgeport Brass Co.* (1877), 12 O. G. 667; 14 Blatch. 282; 3 Bann. & A. 20; *Stevens v. Pritchard* (1876), 4 Clifford, 417; 10 O. G. 505; 2 Bann. & A. 390.

That where the sub-combinations claimed in the re-issue were shown in the original and the re-issue is applied for within six months after the grant of the original, inadvertence or mistake need not be specially proved, the speedy application being sufficient evidence thereof, see *Jenkins v. Stetson* (1887), 32 Fed. Rep. 398.

That where the original patent suggested only the combination it cannot re-issue to embrace sub-combinations, see *Washburn & Moen Mfg. Co. v. Fuchs* (1883), 5 McCrary, 236; 16 Fed. Rep. 661; *Turrell v. Bradford* (1883), 15 Fed. Rep. 808; 23 O. G. 1623; *Miller v. Bridgeport Brass Co.* (1877), 12 O. G. 667; 14 Blatch. 282; 3 Bann. & A. 20; *Gill v. Wells* (1874), 22 Wall. 1; 6 O. G. 881.

As to the joinder of a combination with its sub-combinations, see §§ 472, 528, and notes, *ante*.

be practically used ;² for every sub-combination is a distinct invention which might have been protected under the original patent, and which does not forfeit its protection by having been joined with another invention, whose unpatentability has been demonstrated by experience. In its description of such

² In *Wheeler v. Clipper Mower & Reaper Co.* (1872), 10 Blatch. 181, Woodruff, J. : (186) "The claim that the original patent of 1854 was void because the invention therein described was not susceptible of being reduced to practical operation gains its importance to this controversy from the inference sought to be drawn therefrom, namely, that the several re-issues are therefore void. These suits are not founded on the original patent, but on the re-issues ; and the claim is that, if the original patent was void because the machine therein described was not capable of reduction to practical use, therefore the re-issues are themselves void. If the premise were here conceded, I do not think that the inference necessarily follows. For example, suppose an inventor of several distinct new devices, or of several new combinations, each capable of being usefully employed in and towards a machine or various machines, and that their separate construction and mode of operation is fully apprehended, and the distinct office or function of each is appreciated, such inventor may, undoubtedly, have a patent for each. Suppose, now, he erroneously conceives that he has arranged a combination of all of them, or a combination of all of them with other known devices, so as to produce a new and useful machine, and for such a machine he applied for and obtains a patent, describing and illustrating all the several new devices or separate combinations of devices, their construction, and operation, but claiming only the aggregate machine. Such aggregate machine may be utterly useless ; the patentee is wholly mistaken in regard to the practical operation of

the whole ; it will not produce the result for which it was intended, nor, in its aggregate form, any other useful result. Does the inventor, in such case, lose the benefit of his skill and ingenuity in producing devices, or combinations of devices, which are of practical value, because he first sought his patent in the form of a useless or impracticable combination ? I apprehend not. He may surrender his original patent and have it re-issued in parts, which shall claim the respective new and useful devices or combinations of devices, pointing out, of course, in his specification, some mode or manner in which they may be reduced to practical use and value. He might have done this in his original patent, and claimed each separate new device as his invention. Not having done so, he may do so in his application for re-issues and his specifications therein ; and the fact, if it be true, that his original patent was defective, because he claimed therein the aggregate combination, and that a useless or impracticable one, no more impairs the validity of the re-issues than any other defect or invalidity which makes a surrender and re-issue necessary to protect the device or devices which are useful, and which were in fact invented." 6 Fisher, 1 (18) ; 2 O. G. 442 (444).

See also *Wheeler v. McCormick* (1873), 6 Fisher, 551 ; 11 Blatch. 334 ; 4 O. G. 692.

So far as the decisions in the above cases assume that the re-issue may embrace sub-combinations or elements which the patentee did not intend and attempt to protect by the original, they are, of course, erroneous.

sub-combinations the re-issue may follow or depart from the language used in the original,—the identity of the sub-combination, both as to its elements and its co-operative law, being, however, always preserved.

§ 672. **Re-issued Combination-Patent may Embrace the Elements of the Combination.**

The re-issue of a patent for a combination may embrace such of its essential elements as are substantially indicated in the original specification, drawings, or model, and were the inventions of the same inventor.¹ As every element of a combination is in itself an operative means, and not a mere part of some patentable article or art, it is a distinct invention and could have been protected by a patent issued for itself alone. Its joinder with the combination in the original patent would have been legitimate, since the inventions are dependent; and hence it may be covered by the re-issue, even although the combination may not actually have been entitled to protection.² The re-issue cannot depart from the original as to the essential character therein given to the element, whatever variation in its language may be permitted; and if the original treats one form of the element as necessary to

§ 672. ¹ In *Wheeler v. Clipper Mower & Reaper Co.* (1872), 10 Blatch. 181, Woodruff, J.: (186) "The original patent embraced, as an aggregate combination, several parts of the entire machine described in the specification, and claimed such aggregate as the invention of the complainant. These parts were all shown in the specification, drawings, and models. I know of no rule which forbids the inventor, who has omitted to claim separate new devices, or severable and distinct combinations, in the original patent, making a surrender, and taking re-issues for the distinct combinations or separate devices. From the fact of surrender and re-issue it is to be inferred that the original patent did not secure to the patentee all that he claims in the re-issue; but that alone does not render the re-issue void. If the devices covered by

the re-issues were, in fact, new and useful, and if they are shown in the original specification, drawings, or model, then the patentee is entitled to secure the exclusive use of each separately, by a re-issue embracing each." 6 Fisher, 1 (18); 2 O. G. 442 (443).

That the re-issue of a combination-patent may cover its elements, see *Smith v. Merriam* (1881), 19 O. G. 601; 6 Fed. Rep. 713; *Gallahue v. Butterfield* (1872), 6 Fisher, 203; 10 Blatch. 232; 2 O. G. 645; *Chicago Fruit House Co. v. Busch* (1871), 4 Fisher, 395; 2 Bissell, 472; *Batten v. Taggart* (1854), 17 How. 74.

² That where the patented combination is impracticable, a re-issue for its elements, if described in the original, may be obtained, see *Wheeler v. Clipper Mower & Reaper Co.* (1872), 10 Blatch. 181; 6 Fisher, 1; 2 O. G. 442.

its performance of its elemental functions in the combination, the re-issue must adhere to that form, though other forms adapting it to other uses and positions are more valuable.³ But when form is not made material by the original description, the re-issue may claim all forms of the element; or when the original describes an element as consisting in a class of acts or substances, the re-issue may confine the element to any single member of that class.⁴ The right to thus bring individual elements within the operation of the patent by re-issue does not authorize the inventor to claim in it any grouping of elements which the original did not describe as a sub-combination.⁵ If any individual element has been disclaimed, unless by mere mistake, the combination-patent cannot be re-issued to reclaim it.⁶

³ That where the original patent is for a combination, one part of which is of peculiar shape so as to serve certain purposes, it cannot be re-issued to cover all shapes of this part whether they serve such purposes or not, see *McMurray v. Mallory* (1884), 111 U. S. 97; 27 O. G. 915.

⁴ That where the original patent describes one form of an element in a combination, the re-issue may cover all forms of the element, unless form was material, see *Gong Bell Mfg. Co. v. Clark* (1878), 13 O. G. 274; 3 Bann. & A. 211.

That where the original patent claimed the use of an entire class of substances as a step in the process, the re-issue may confine the Claim to the use of any particular substance of that class, see *St. Louis Stamping Co. v. Quinby* (1879), 4 Bann. & A. 192; 16 O. G. 135.

⁵ In *Matthews v. Machine Co.* (1882), 105 U. S. 54, Bradley, J. : (57) "But the complainants, in their re-issued patent, have split up and divided the elements of their invention, and claimed them separately, and not as a combination. Of course, this enlarges the scope of their patent. The separate Claims embrace fewer elements in combination

than were embraced in the Claim of the original patent. No one could infringe the original patent unless he used all the elements of the combination. Any one will infringe the re-issue who uses any of those elements which are now separately claimed." 21 O. G. 1349 (1350). See also *Bantz v. Frantz* (1882), 105 U. S. 160; 21 O. G. 2037; *Gill v. Wells* (1874), 22 Wall. 1; 6 O. G. 881.

That a combination-patent cannot re-issue to cover the separate elements after unreasonable delay, see *Archer v. Arnd* (1887), 31 Fed. Rep. 475; 40 O. G. 1032; *Bantz v. Frantz* (1882), 105 U. S. 160; 21 O. G. 2037.

That elements shown in the original drawings only as a connected portion of the mechanism, and so described, cannot be claimed on the re-issue as an invention, see *Ives v. Sargent* (1887), 119 U. S. 652; 38 O. G. 781.

That a re-issue covering additional elements in a combination is improper, see *Hubel v. Dick* (1886), 28 Fed. Rep. 132; 36 O. G. 939; 24 Blatch. 59.

⁶ That where an original patent claimed a series of dies and disclaimed them as separate devices, the re-issue cannot claim them separately, see *At-*

§ 673. **Re-issued Generic Patent may Embrace One Species:
When Re-issued, Species Patent may Embrace the
Genus.**

The relation subsisting between a generic invention and each of the species falling within that genus also leads to certain peculiar modifications of this rule. A generic invention is distinct from each of the specific inventions which it embraces, and each of these specific inventions is equally distinct from every other. Yet inasmuch as a generic invention cannot be fully described without delineating at least one of its included species, the joinder of a single specific invention with the generic is permitted in a patent for the latter. In the re-issue of a generic patent, therefore, the species which the original describes and which might have appropriately been claimed therein may be protected. But if the specification of the original generic patent describes two or more species, one only can be claimed in the re-issue, as only one could have been joined with the generic in the original. An unwise joinder of particular species with the genus in the prior patent cannot be remedied by a re-issue. Where the original describes two or more species with their genus, and claims the genus and one species, its re-issue cannot claim the genus and a different species. The abandonment of the former species, and the substitution for it of the latter, would be an entire departure from the specific invention which the inventor first attempted to secure, and thus would introduce into the re-issued patent such new matter as the rule peremptorily forbids.¹ A patent for a specific invention cannot re-

water Mfg. Co. v. Beecher Mfg. Co. (1881), 8 Fed. Rep. 608.

See also §§ 680, 687-689, and notes, *post*.

As to the joinder of a combination with its elements, see §§ 472, 528, and notes, *ante*.

§ 673. ¹ In *Ex parte McClintock* (1880), 17 O. G. 267, Paine, Com. : (271) "An applicant who makes a generic invention, which he illustrates by describing two species, may, by inadvertence, accident, or mistake, join

with his generic Claim the specific Claim which subsequently proves least desirable. But this is not the inadvertence, accident, or mistake for which the law provides a remedy by re-issue. That provision is not for the case in which the applicant, having the power to choose, selects the wrong invention, but for the case in which he imperfectly describes or claims the right invention. The inventions covered by a generic and specific Claim are distinct, although dependent, inventions. The only ground

issue to embrace the generic, for these are not only distinct inventions, but as the genus covers all possible species, the re-issue would indefinitely extend the scope of the original patent beyond the invention which it first attempted to protect.² An exception is allowed in favor of the inventor of the genus who described and claimed it in his application for the original patent, but was compelled without his fault to forego his claim and accept a patent for the specific invention alone. On the discovery of the error he is entitled to amend his patent by the insertion of the generic invention both in his Description and his Claims.³

§ 674. Re-issued Patent for an Art may Embrace the Same Art, and sometimes the Apparatus or the Product.

The re-issue of a patent for an art or process, whether composed of one or many different acts and operations, must be confined to the same acts and operations which constitute the essential features of the original invention. No new act can be added; no former operation, which has been described and claimed as necessary to the art, can be omitted.¹ Im-

on which one specific Claim can be joined in the same patent with a generic Claim is that the applicant, in order to support his generic Claim, must describe some one of the species, and may claim what he must describe. If he describes several species, as he is permitted but not required to do, and, by inadvertence, accident, or mistake, selects the wrong species, such inadvertence, accident, or mistake consists, not in an imperfect specification or Claim of either of the inventions, but merely in joining in the dual patent the wrong inventions. The remedy for such an error is not to be found in the substitution of another specific invention in the dual patent by a re-issue, but must be sought in an original patent granted on a new application."

That where the original patent describes only one species of a certain genus, it cannot re-issue to cover another

species of the same genus, see *Ex parte McClintock* (1880), 17 O. G. 267.

That where two species were described and but one claimed, and the other species was then struck out of the Description, the specification was still sufficient and required no re-issue, see *Ex parte Ewart* (1880), 17 O. G. 448.

² That a patent for the species cannot re-issue to cover the genus, see *Ex parte Waters* (1875), 8 O. G. 399.

³ That generic Claims may be inserted in the re-issue though they were struck out of the original application, see *Ex parte Ewart* (1880), 17 O. G. 448.

As to the joinder of generic and specific inventions, see §§ 535, 536, and notes, *ante*.

§ 674. ¹ That a re-issue may contain a full description of processes only adverted to in the original, see *Goodyear Dental Vulcanite Co. v. Smith* (1874),

material steps may be abandoned, or equivalents introduced, and such variations in their order be directed as are not inconsistent with the original specification.² When the art as set forth in the original patent is a combination, its sub-processes and elements may be claimed in the re-issue, if they were first devised by the inventor of the art, were indicated in the original specification, and have not lost their patentable character by his disclaimer or abandonment. Besides the art itself, the re-issue may in certain cases cover the apparatus it employs or the product in which it results. Where these have been invented by the same inventor, have been sufficiently described in the original specification, and have neither been abandoned nor disclaimed, the right to cover them by the re-issue depends on their relation to the art, and the propriety of joining them therewith in the original patent. Thus where the process cannot be performed without the apparatus mentioned, or the product uniformly follows the employment of the process, the inventions are inseparably connected with each other, and the product or the apparatus may be covered by a re-issue of the patent for the art.³

5 O. G. 585; Holmes, 354; 1 Bann. & A. 201.

That a re-issue of a patent for a process cannot add a new step, see *American Middlings Purifier Co. v. Atlantic Milling Co.* (1879), 4 Bann. & A. 148; 15 O. G. 467; 5 Dillon, 127.

² That the re-issue of a patent for a process may omit some of the steps described in the original, if the process remains substantially the same, see *Ex parte Wooten* (1872), 3 O. G. 521.

That where an original, in describing a process, mentioned one material which does not answer the purpose, the re-issue may describe another material of the same class which will serve the same desired end, if it had been used by the inventor before his original application for a patent, see *Ex parte Mayall* (1873), 4 O. G. 582.

³ That a process and its apparatus may be claimed in the same patent

where the process is not the mere function of the apparatus, see § 473, and notes, *ante*.

That an original for a "method of doing" a thing may re-issue for the thing done, the inventions being the same, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 19 O. G. 173; 4 Fed. Rep. 900; 10 Bissell, 65.

That where the original describes both process and product, but claims the process only, it may re-issue to cover the product also, see *Tucker v. Dana* (1881), 7 Fed. Rep. 213; *Anilin v. Hamilton Mfg. Co.* (1878), 13 O. G. 273; 3 Bann. & A. 235; *Goodyear v. Wait* (1867), 5 Blatch. 468; 3 Fisher, 242.

That a re-issue for a product is void, where the original was for the process, unless the use of the process always results in the product, and thus both are but one invention, see *Powder Co. v.*

§ 675. Re-issued Patent for a Machine may Embrace the Same Machine, and sometimes the Product, but not the Process.

The re-issue of a patent for a machine, if the machine be not a combination, must be limited to the same parts or their equivalents associated under the same structural law.¹ The re-issue may vary from the original in matters of mechanical adaptation, and may cover any mode of using the machine which has been properly indicated in the former specification.² When the machine is a combination, the re-issue may embrace such of its elements and sub-combinations as are suggested in the original description, if not abandoned or disclaimed, and if due to the inventive genius of the same inventor. A machine-patent cannot, however, be re-issued to include a process which consists in the mere use of the machine, nor a process in which the patented machine performs a necessary though subordinate part. The former is the function of the machine, and though protected by the patent for the machine is not itself a patentable subject-matter. The latter is an invention far broader than the mechanical devices it employs, and though not independent of them, lies outside the scope of any patent which has been originally confined to them. Thus while an original patent for an art

Powder Works (1878), 98 U. S. 126 ; 15 O. G. 289.

That a re-issue cannot cover a product and a process unless both have been substantially described in the original, see *Penn. Salt Mfg. Co. v. Thomas* (1871), 8 Phila. 144 ; 5 Fisher, 148.

That an original patent confined to a product produced by one process only cannot re-issue to cover the product, however produced, see *Vacuum Oil Co. v. Buffalo Lubricating Oil Co.* (1884), 20 Fed. Rep. 850 ; 22 Blatch. 266 ; 28 O. G. 1101.

That a patent for a process cannot re-issue after four years to cover the product also, see *Union Tubing Co. v. Patterson Co.* (1885), 23 Fed. Rep. 79.

As to the joinder of a process with

its product or apparatus, see §§ 472, 529, and notes, *ante*.

§ 675. ¹ That a re-issue can substitute a device for one employed in the original where they are equivalents, and not otherwise, see *Tucker v. Tucker Mfg. Co.* (1876), 10 O. G. 464 ; 2 Bann. & A. 401 ; 4 Clifford, 397 ; *National Spring Co. v. Union Car Spring Mfg. Co.* (1874), 6 O. G. 224 ; 12 Blatch. 80 ; *Decker v. Grote* (1873), 3 O. G. 65 ; 10 Blatch. 331 ; 6 Fisher, 143.

² That a re-issue may claim modes of constructing or operating a machine, where such modes were described, though not claimed, in the original, see *Morris v. Royer* (1867), 3 Fisher, 176 ; 2 Bond, 66.

might be re-issued to embrace any machine which it may use without enlarging the original invention, no patent for a machine could be re-issued to include the process without extending the protection of the patent to new matter which the original patent neither intended nor attempted to secure.⁸

⁸ In *Wing v. Anthony* (1882), 106 U. S. 142, Woods, J. : (145) "It is quite clear that the original patent covers a mechanism to accomplish a specific result, and that the re-issued patent covers the process by which that result is attained, without regard to the mechanism used to accomplish it. The re-issue is, therefore, much broader than the original patent, and covers every mechanism which can be contrived to carry on the process. In the case of *Powder Company v. Powder Works*, 98 U. S. 126, it was held by this court that when original letters-patent were taken out for a process, the re-issued patent would not cover a composition unless it were the result of the process, and the invention of one involved the invention of the other. The converse of this proposition was decided by this court in *James v. Campbell*, 104 Id. 356. In that case the court said that a patent for a process and a patent for an implement or a machine are very different things, and decided, in substance, that letters-patent for a machine or implement cannot be re-issued for the purpose of claiming the process of operating that class of machines, because, if the claim for the process is anything more than for the use of the particular machine patented, it is for a different invention. To the same effect precisely is the case of *Heald v. Rice*, Id. 737. The present case falls within the rule laid down in the authorities cited."

In *James v. Campbell* (1881), 104 U. S. 356, Bradley, J. : (376) "A patent for a process and a patent for an implement or a machine are very different things. (*Powder Company v. Powder Works*, 98 U. S. 126.) Where a

new process produces a new substance, the invention of the process is the same as the invention of the substance, and a patent for the one may be re-issued so as to include both, as was done in the case of Goodyear's vulcanized-rubber patent. But a process and a machine for applying the process are not necessarily one and the same invention. They are generally distinct and different. The process or act of making a postmark and cancelling a postage-stamp by a single blow or operation, as a subject of invention, is a totally different thing in the Patent Law from a stamp constructed for performing that process." 21 O. G. 337 (343).

That where the original is for a machine and the re-issue for a process, there is *prima facie* a departure, see *Eachus v. Broomal* (1885), 115 U. S. 429 ; 33 O. G. 1265.

That where the original patent is for a machine, it cannot re-issue to cover the process performed by the machine, though the process were described in the original, see *Ex parte Pfaudler* (1882), 22 O. G. 1881 ; *Brainard v. Cramme* (1882), 20 Blatch. 530 ; 22 O. G. 769 ; 12 Fed. Rep. 621 ; *Heald v. Rice* (1882), 104 U. S. 737 ; 21 O. G. 1443 ; *New v. Warren* (1882), 22 O. G. 587 ; *Ex parte Hicks* (1879), 16 O. G. 546.

That a re-issue is void where the original patent was for a machine which accomplishes two purposes, one intended, and the other neither intended nor expected, by the inventor, and the re-issue covers the process performed by the machine in effecting the latter purpose, see *Ex parte Seibert* (1879), 16 O. G. 262.

The product of a machine, if inseparably connected with it and otherwise within the rule of joinder so often stated, may also be claimed in the re-issue.⁴

§ 676. Re-issued Patent for a Manufacture may Embrace the Same Manufacture, and Sometimes the Process or the Apparatus.

An original patent for a manufacture can be re-issued only for the same concrete instrument, or for inventions upon which the production of such manufacture may depend. Whatever essential characteristics have been attributed to the manufacture in the original specification must be found in it as described and claimed in the re-issue; and through all variations of language, and all substitutions of equivalents, the identity of the invention must be distinctly traceable.¹ If it were first described as resulting from certain processes and possessing certain properties, the re-issue cannot depart from this delineation by ascribing it to different processes, or attributing to it other properties due to changes in the mode by which it is produced.² But new methods of applying it to practical use or new connections in which it may be employed can be disclosed, since these involve no alteration in the nature of the invention itself.³ Where a manufacture

⁴ That a re-issue cannot claim the occasional result of the device shown in the original, see *Ex parte Seibert* (1877), 12 O. G. 268.

As to the joinder of a machine with its process or product, see §§ 474, 530, and notes, *ante*.

§ 676. ¹ That where an original patent was for an article in a particular form, a re-issue claiming it under whatever form is void, see *Campbell v. Kavanaugh* (1882), 20 Blatch. 256; 11 Fed. Rep. 83; *N. Y. Bung & Bushing Co. v. Hoffman* (1881), 20 Blatch. 3; 20 O. G. 1451; 9 Fed. Rep. 199.

² That a re-issue cannot claim a product however made, when the original claimed it only as made in a certain way, see *Vacuum Oil Co. v. Buffalo Lubricating Oil Co.* (1884), 22 Blatch.

266; 28 O. G. 1101; 20 Fed. Rep. 850.

That where the original patent is for a product as resulting from a certain process, it cannot be re-issued to cover the same product when resulting from different processes and containing not only some of the qualities of the old product but also new qualities not contained in the old product or producible by the old process, see *Cochrane v. Anilin* (1884), 111 U. S. 293; 27 O. G. 813.

³ That a re-issue for a device is good though the machine to which the device is to be applied is differently described in the original, see *Aultman v. Holley* (1873), 5 O. G. 3; 6 Fisher, 534; 11 Blatch. 317.

That a patent for a new device, as

and a machine or process which produces it are inseparable, an original patent for the manufacture may re-issue to protect also the process or machine.⁴

§ 677. **Re-issued Patent for a Composition may Embrace the Same Composition, and sometimes the Ingredients, the Process, or the Apparatus.**

A composition of matter being always a true combination, the patent in which it is originally described can re-issue only for the same or equivalent ingredients, united by the same or equivalent modes of intermixture, and resulting in a compound possessing the same or equivalent properties.¹ Substances which are not ingredients, though described in the original as entering into the composition, may be omitted or others may be added without disturbing the identity of the invention, and variations in the mode of intermixture, which do not alter its substantial character, may be introduced.

adapted to one machine, cannot re-issue for the same device as adapted to other and non-analogous machines, but such device must be the subject of a new patent, see *Holmes v. Plainville Mfg. Co.* (1881), 20 Blatch. 123; 9 Fed. Rep. 757.

⁴ That where the original invention was a new product resulting from a new process, the re-issue of a patent for the process or the product may cover both, either in the same or separate patents, see *Tucker v. Burditt* (1879), 3 Bann. & A. 569; *Anilin v. Hamilton Mtg. Co.* (1878), 3 Bann. & A. 235; 13 O. G. 273; *Anilin v. Higgins* (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462.

As to the joinder of a manufacture with its process or machine, see §§ 475, 531, and notes, *ante*.

§ 677. ¹ In *Dunbar v. White* (1881), 4 Woods, 116, Billings, J.: (117) "Where a patentee in his original Claim and specifications describes his invention in part by specifying a material to be used, but declares that the sole utility or availability of that material in connection

with his device is that it has two properties; and in his re-issued patent, in his Claim and specifications, in the description of his invention, substitutes for his former specification of a material to be used as a part of his device, a description of materials which may be used by specifying only those which have the two properties in which he had formerly declared the utility or availability of the material which he then named consisted, there is no enlargement of the thing patented, and the re-issued patent is, therefore, valid." 23 O. G. 1446 (1446); 15 Fed. Rep. 747 (748).

That a re-issue of a chemical patent is void unless the compound claimed is the same as that described in the original, see *Tarr v. Webb* (1872), 2 O. G. 568; 5 Fisher, 593; 10 Blatch. 96.

That where an original described and claimed a composition of matter as answering a specific purpose, it cannot re-issue to cover the compound as used for all other purposes, see *Francis v. Mellor* (1871), 5 Fisher, 153; 1 O. G. 48.

When the original has sufficiently indicated the nature of the several ingredients, or of their sub-combinations, these may be also claimed in the re-issue if they were discovered by the inventor of the composition and have not already passed from his control into the possession of the public. All arts or instruments invented by the same inventor and necessarily employed in manufacturing the composition, may be joined with it in the re-issue when their essential attributes were suggested in the original patent and they have neither been abandoned nor disclaimed. But no extrinsic matter, such as a mode of packing the compound when completed, or of using it for practical purposes when sold, can be inserted in the patent for the composition either originally or by amendment.² Though these are patentable inventions, the composition is not dependent upon them for its existence, and they are thus incapable of joinder with it in any patent where it forms the principal invention.

§ 678. Re-issued Patent for a Design may Embrace the same Design, and sometimes its Elements and Sub-combinations.

The re-issue of a design-patent must be confined to the design described or suggested in the original specification. The identity of the design is determined by the appearance which it presents to the eye, and the characteristic features of this appearance, as shown in the original, must be preserved in the re-issue. The elements and sub-combinations of the original design, if answering the requirements already mentioned, may be claimed in the re-issue;¹ but where the same article is both a new design and a new manufacture, the inventions are distinct and independent, and a re-issue of a patent for it as the one cannot embrace the article considered as the other.

² That where the original patent describes a composition of matter packed in a certain manner and claims only the compound, it cannot re-issue so as to claim the mode of packing, see *Averill Chemical Paint Co. v. National Mixed Paint Co.* (1881), 22 O. G. 585; 20 Blatch. 42; 9 Fed. Rep. 462.

As to the joinder of a composition with its process or ingredients, see §§ 476, 532, and notes, *ante*.

§ 678. ¹ As to the joinder of designs, their elements and sub-combinations, see §§ 477, 532, and notes, *ante*.

§ 679. Re-issued Patent for an Improvement may Embrace the same Improvement, and sometimes the Apparatus or the Process.

An improvement is an invention subordinate to some existing art, machine, manufacture, composition of matter, or design, and in its essential character corresponds with the invention to which it belongs. The limitations which apply to the re-issue of a patent for an improvement are thus the same that govern a re-issue of the patent for the invention with which the improvement is connected. The re-issue must be confined to the exact improvement, suggested or described in the original patent.¹ It may include processes or implements by which the improvement is produced. It cannot embrace arts or instruments which occupy toward the improvement the relation of either functions or effects.

§ 680. Re-issued Patent cannot Embrace Matter Expressly or Impliedly Excluded from the Invention by the Original Patent.

The nature of the subject-matter which the inventor intended and attempted to describe and claim in his original specifications may be further indicated by the limitations which he has imposed upon it in his original patent; and in consequence of these his re-issue may be confined within narrower boundaries than the character of his invention would otherwise require. As by express disclaimer he may debar himself from covering by re-issue some essential feature of his actual invention, so by a faulty statement of its true scope and attributes in his original description, he may impliedly exclude from the invention matter which but for this he might have claimed in his re-issue.¹ Thus though all

§ 679. ¹ As to the joinder of improvements, see §§ 478, 534, and notes, *ante*.

§ 680. ¹ That matters disclaimed in the original cannot be claimed in the re-issue, see *Beecher Mfg. Co. v. Atwater Mfg. Co.* (1885), 114 U. S. 523; 31 O. G. 1306; *Edgerton v. Furst & Bradley Mfg. Co.* (1881), 21 O. G. 261; 9 Fed. Rep. 450; 10 Bissell, 402; *Leggett v. Avery* (1879), 101 U. S. 256; 17 O. G.

445; *Funck v. Doty* (1877), 13 O. G. 322; *Wicks v. Stevens* (1876), 2 Woods, 310; 2 Bann. & A. 318.

That the statements of an inventor in his original patent, as to the nature and scope of his invention, are binding upon him, see *James v. Campbell* (1881), 104 U. S. 356; 21 O. G. 337.

That the omission from the re-issue of the limitations inserted in the origi-

forms of the invention were really the result of his inventive act, and all the uses of which it is capable belong to him if he desires to hold them, he may so set forth the invention as identified with one form only, or as possessing qualities which fit it for a single definite use, that every other form and use become disclaimed by implication, and even though still patentable in another patent, he cannot introduce them into the existing patent by re-issue.² Again, where he mistakes the nature of his invention, and in the original specification attributes the effects which it produces to erroneous causes, upon whose operation he bases his original claims, his subsequent discovery of the true causes cannot be made available to him by a re-issue of his former patent.³ A different application of the principle involved in these cases arises when the inventor has procured two separate patents, in both of which he has described the subject-matter whose incorporation into his re-issue he endeavors to secure. If he has claimed the matter in but one of these patents, this only

nal, renders the re-issue void, see *Searls v. Bouton* (1892), 12 Fed. Rep. 874 ; 20 Blatch. 528 ; 22 O. G. 946.

That the re-issue cannot claim what the patentee, in the original, professed to dispense with, see *Miller v. Bridgeport Brass Co.* (1882), 104 U. S. 350 ; 21 O. G. 201.

That a re-issue enlarging the invention by omitting words found in the original Claim is invalid, see *Matthews v. Iron Clad Mfg. Co.* (1888), 124 U. S. 347 ; 42 O. G. 827.

² That if the original identifies the invention with one form the re-issue cannot claim other forms, see *Steam Gauge & Lantern Co. v. Miller* (1882), 11 Fed. Rep. 718 ; and other cases cited in § 661, note 1, and § 676, note 1, *ante*.

That if the original limits the invention to matter possessing certain qualities or capabilities for certain uses, the re-issue can claim no other qualities or

capabilities, see *Francis v. Mellor* (1871), 5 Fisher, 153 ; 1 O. G. 48.

That the statement, in the original, that certain things "are in quite common use" is such a disclaimer as prevents their being claimed in re-issue, see *Edgerton v. Furst & Bradley Mfg. Co.* (1881), 21 O. G. 261 ; 9 Fed. Rep. 450 ; 10 Bissell, 402.

That where the original restricts the invention to one use, it cannot re-issue to cover other uses, see *Doane & Wellington Mfg. Co. v. Smith* (1883), 15 Fed. Rep. 459 ; 24 O. G. 302 ; *Ex parte Bragg* (1875), 8 O. G. 985 ; *Ex parte Allen* (1872), 2 O. G. 89.

³ That if the original describes and claims the invention as one cause producing the effect, the re-issue cannot claim subsequently discovered causes, see *Eames v. Andrews* (1887), 122 U. S. 40 ; 39 O. G. 1319 ; *Andrews v. Hovey* (1883), 5 McCrary, 181 ; 26 O. G. 1011 ; 16 Fed. Rep. 387.

can re-issue to embrace it.⁴ If it is claimed in neither, it can be covered by a re-issue of the earliest alone.⁵

§ 681. Identity of the Invention Embraced in the Re-issued Patent with that Attempted to be Covered by the Original Patent Determined by Comparing the Respective Specifications.

The identity of the invention claimed in the re-issue with that which the inventor attempted to describe and claim in the original patent is ascertained, in most cases, by a simple comparison of their respective specifications with each other.¹ Where the invention is of a nature admitting of illustration by drawings or models, this is the only investigation which can be made.² Extrinsic evidence is not admissible except to explain

⁴ That where a device is shown in two or more patents, only one of which claims it and this insufficiently, this patent alone can re-issue for it, see *Ex parte Kirby* (1879), 16 O. G. 1095; *Ex parte Locke* (1879), 16 O. G. 1140.

That where a device is described in two patents, and claimed only in one, the later must re-issue for it, even though the inventor is sole patentee in that patent, and he and his assignee are patentees under the other, see *Ex parte Kirby* (1879), 16 O. G. 1095.

That when a device is described in two patents and claimed only in one, and the earlier cannot re-issue for it, the later may, as where it was omitted on purpose from the earlier but by mistake in the later, see *Ex parte Locke* (1879), 16 O. G. 1140.

⁵ That where a device is shown but not claimed in two or more patents, only the earliest can re-issue for it, see *Ex parte Kirby* (1879), 16 O. G. 1095; *Ex parte Locke* (1879), 16 O. G. 1140.

That an earlier patent cannot re-issue to cover an invention described only in a later one of the same general class, see *Seibert Cylinder Oil Cup Co. v. Harper Steam Lubricator Co.* (1880), 4 Fed. Rep. 328.

§ 681. ¹ In *Collar Co. v. Van Dusen* (1874), 23 Wall. 530, Clifford, J. : (558) "Whether a re-issued patent is for the same invention as the surrendered original or for a different one must very largely be determined by a comparison of the two instruments, as the decision must necessarily depend upon the question whether the specifications and drawings of the re-issued patent are not substantially the same as those of the original; and if not, whether the omissions or additions are or are not greater than the law allows to cure the defects of the original specification." 7 O. G. 919 (920).

See also *Kerosene Lamp Heater Co. v. Littell* (1878), 13 O. G. 1009; 3 Bann. & A. 312; *Tucker v. Tucker Mfg. Co.* (1876), 10 O. G. 464; 4 Clifford, 397; 2 Bann. & A. 401; *Stevens v. Pritchard* (1876), 10 O. G. 505; 4 Clifford, 417; 2 Bann. & A. 390; *Ex parte Evans* (1873), 3 O. G. 180; *Metropolitan Washing Machine Co. v. Providence Tool Co.* (1872), Holmes, 161; *Parham v. American Buttonhole, Overseaming, & Sewing Mach. Co.* (1871), 4 Fisher, 468; *Seymour v. Osborne* (1870), 11 Wall. 516.

² That a comparison of the specifica-

the meaning of technical terms, or to apply the language of the Description to its proper subject-matter.³ If on the face of the two specifications, thus compared, it is apparent that the invention claimed in the re-issue is substantially distinct from that attempted to be covered by the original patent, the re-issue is void.⁴ If the diversity is not apparent, the re-issue, so far as this requirement is concerned, will be sustained, it being

tions, drawings, and model alone can be resorted to in order to ascertain the identity of the re-issue with the original, under Sec. 4916 Rev. Stat., where the original patent has drawings or model, see *Ex parte* Seibert (1877), 12 O. G. 268 ; *Ex parte* Baldwin (1876), 9 O. G. 639.

³ In *Seymour v. Osborne* (1870), 11 Wall. 516, Clifford, J. : (545) "Whether a re-issued patent is for the same invention as that embodied in the original patent or for a different one is a question for the court in an equity suit, to be determined as a matter of construction, on a comparison of the two instruments, aided or not by the testimony of expert witnesses, as it may or may not appear that one or both may contain technical terms or terms of art requiring such assistance in ascertaining the true meaning of the language employed. Where the specification and Claim, both in the original and re-issued patents, are expressed in ordinary language, without employing any technical terms or terms of art, the question whether the re-issued patent is for the same invention as that described in the original patent or for a different one is purely a question of construction ; but where both or either contain technical terms or terms of art the court may hear the testimony of scientific witnesses to aid the court in coming to a correct conclusion. Cases doubtless arise where the language of the specification and Claim, both of the surrendered and re-issued patents, is so interspersed with technical terms and terms of art that the testimony of scien-

tific witnesses is indispensable to a correct understanding of its meaning. Both parties in such a case would have a right to examine such witnesses, and it would undoubtedly be error in the court to reject the testimony ; but the case before the court is not of a character to render it expedient to pursue the inquiry."

See also *Heald v. Rice* (1882), 104 U. S. 737 ; 21 O. G. 1443.

That the identity or diversity of the original and the re-issue are to be ascertained only by inspecting the two patents, not by outside evidence, see *Johnsen v. Beard* (1875), 2 Bann. & A. 50 ; 8 O. G. 435.

That parol evidence is not admissible to show that the subject-matter of the re-issue is within the scope of the original invention, where it does not appear in the original description, see *Union Paper Collar Co. v. Van Deusen* (1874), 23 Wall. 530 ; 7 O. G. 919 ; *Glue Co. v. Upton* (1874), 1 Bann. & A. 497 ; 4 Clifford, 237 ; 6 O. G. 837 ; *Sarven v. Hall* (1872), 1 O. G. 437 ; 5 Fisher, 415 ; 9 Blatch. 524 ; *Seymour v. Osborne* (1870), 11 Wall. 516.

That extrinsic evidence may be resorted to in order to apply the descriptions, etc., to their subject-matter, see *Heald v. Rice* (1882), 104 U. S. 737 ; 21 O. G. 1443.

⁴ That if it appears on the face of the re-issued and original patents that the inventions are not identical, the re-issue is void, see cases cited in § 665, note 1, *ante*.

presumed that it is for the same invention as the original until the contrary appears.⁶ In comparing the two specifications, the question is not what the inventor might have set forth in the original patent, but what he did set forth as his invention.⁶ Differences in the Description and the Claims are not material, provided the inventions are the same.⁷ That the invention claimed in the re-issue would not have been an infringement of the former patent affords no test, since such patent must have stood or fallen by its own Claims, and the re-issue is not limited to these. In construing the respective specifications, their Descriptions, drawings, and models are to be taken together, not separately, and the character of the invention gathered from them as a whole.⁸ Drawings omitted

⁶ That if the specifications of the re-issue are consistent with those of the original, the re-issue is valid, see *Thomas v. Shoe Mach. Mfg. Co.* (1878), 3 Bann. & A. 557; 16 O. G. 541; *Herring v. Nelson* (1877), 14 Blatch. 293; 12 O. G. 753; 3 Bann. & A. 55; *Stevens v. Pritchard* (1876), 10 O. G. 505; 4 Clifford, 417; 2 Bann. & A. 390; *Tucker v. Tucker Mfg. Co.* (1876), 10 O. G. 464; 4 Clifford, 397; 2 Bann. & A. 401; *La Baw v. Hawkins* (1874), 1 Bann. & A. 428; 6 O. G. 724; *Chicago Fruit House Co. v. Busch* (1871), 2 Bissell, 472; 4 Fisher, 495; *Carew v. Boston Elastic Fabric Co.* (1871), 3 Clifford, 365; 5 Fisher, 90; 1 O. G. 91; *Sickels v. Evans* (1863), 2 Fisher, 417; 2 Clifford, 203; and cases cited in § 684, note 2, *post*.

In this paragraph, and in the text generally, the doctrine that a re-issue is presumed to be for the same invention as the original until the contrary appears is adhered to, notwithstanding the apparent change of position in the later cases in the Supreme Court as indicated in § 664, note 2, *ante*. So many subordinate rules as to the construction of specifications, the burden of proof, etc., etc., have grown out of the former doctrine that it has not been considered

prudent to disturb the present harmony of the law by the introduction into its authoritative statement of the new views which may safely be expounded and discussed in the notes.

⁶ That in comparing the re-issue with the original patent, the question is not what the inventor originally intended to patent, but what did he in fact invent and try to patent, see *American Wood Paper Co. v. Hest* (1867), 3 Fisher, 316.

That the question is not how the original might have described the invention, but how it did describe it, see *Hammond v. Franklin* (1885), 23 Blatch. 77; 22 Fed. Rep. 833; 30 O. G. 1324.

⁷ That if the inventions are the same, differences of description are immaterial, see cases cited in § 668, notes 1, 2, 3, *ante*.

That if the description, drawings, and model of the re-issue are identical with those of the original, the re-issue is valid though the Claims may differ, see *Black v. Thorne* (1872), 5 Fisher, 550; 10 Blatch. 66; 2 O. G. 388; and cases cited in § 668, notes 5, 6, 7, *ante*.

⁸ That the identity of the re-issue with the original is ascertained by comparing their drawings and specifications as a whole, not separately, see *Searls v.*

from the original patent by mistake may be inspected, and the model, as first filed in the Patent Office, may be examined.⁹ A dilapidated model may be aided by evidence disclosing its primitive condition, if not inconsistent with the drawings and Description;¹⁰ and when a feature claimed in the re-issue is absent from the specification and drawings, the model will be presumed to contain it unless the model is produced.¹¹ Where the model is lost, and the drawings are said to be incorrect, no change can be permitted in the latter to cure the defect, except upon the most conclusive evidence that the invention, as presented in the model, would have justified the change.¹² In any doubt as to the scope of the re-issue specification the files of the re-issue application may be resorted to for its solution.¹³

Worden (1882), 21 O. G. 1955 ; 11 Fed. Rep. 501.

⁹ That the drawings and model originally filed may be examined in reference to the identity of the re-issue with the original, see *Johnsen v. Beard* (1875), 2 Bann. & A. 50 ; 8 O. G. 435.

That the identity of the original and re-issue may be shown by the original drawing or model, or by some part of the drawings which, by mistake, was omitted from the one shown in the original patent, see *Ex parte Baldwin* (1876), 9 O. G. 639.

¹⁰ That where a model is lost or destroyed it may be established by parol, see *Meyer v. Goodyear's India Rubber Glove Mfg. Co.* (1881), 22 O. G. 681 ; 11 Fed. Rep. 891 ; 20 Blatch. 91.

That a dilapidated model may be aided by evidence showing what it once was, if not inconsistent with the original specifications and drawings, in order to support a re-issue, see *Aultman v. Holley* (1873), 11 Blatch. 317 ; 6 Fisher, 534 ; 5 O. G. 3.

That the Office model alone is not

sufficient basis for a new Claim in a re-issue, changing the character of the invention originally patented, see *Flower v. Detroit* (1888), 127 U. S. 563 ; 43 O. G. 1348.

¹¹ That where the specifications and drawings of the original do not show the feature claimed in the re-issue, only the inspection of the model can determine the matter, and if the model is not produced it will be presumed to contain the feature, see *Hendy v. Golden State & Miners' Iron Works* (1883), 17 Fed. Rep. 515 ; 8 Sawyer, 468.

¹² That where the original model is lost and the drawings are said to be incorrect, the court should not change the position of any part represented in the drawing, except upon the clearest proof, see *Royer v. Russell* (1881), 20 O. G. 1819 ; 9 Fed. Rep. 696.

¹³ That the files of the re-issue application may be examined to show the scope of the re-issue, see *Hopkins & Dickinson Mfg. Co. v. Corbin* (1881), 103 U. S. 786 ; 20 O. G. 297.

See also §§ 665, 666 and notes, *ante*.

§ 682. Identity of Subject-Matter of a Re-issued Machine-Patent, how Determined.

In the case of a machine-patent, the identity of the re-issue with the original is determined by the application of a stricter and more conclusive test. A machine is an organism composed of physical parts so arranged as to operate in accordance with a pre-determined structural law. It is capable of exact representation in a drawing or series of drawings, and of equally exact reproduction in a model. Whatever may be the difficulties which attend its verbal description, the failure to indicate its essential parts and their method of arrangement by means either of the drawing or model cannot result from inadvertence, accident, or mistake. If not fraudulent, such failure would at least be evidence that the inventor did not comprehend the invention which he had undertaken to secure, and therefore could not be entitled to a patent. Hence the propriety of the rule that in a machine-patent the identity of the re-issue with the original is to be ascertained by comparing the models and drawings with each other, and that nothing can be embraced in the re-issue which is not found either in the models or the drawings annexed to the original patent. This rule works no hardship to the inventor, since his original patent protects all equivalent parts and arrangements of parts which can be organized under the same structural law, and at the same time it avoids the danger that through some alteration in the parts or their arrangement, as shown in the original drawings or model, a variation in the structural law might imperceptibly be made, and thus a new machine be claimed by the re-issue.

§ 683. Identity of Subject-Matter of the Re-issued Patent, how Determined when the Invention cannot be Represented by Drawings or Model.

In cases where the invention is incapable of representation by a model or by drawings, necessity requires that this question of identity should be settled by such methods as are most available. Language even at its best is ambiguous, and to compel the inventor to abide by the construction which might be put by others on his words alone, would often deprive him

of the most important fruits of his inventive skill. In determining the nature of the invention indicated in his original specification, and attempted to be covered in his original patent, the disadvantage under which he labors through the impossibility of interpreting his verbal description by pictorial or material representations is overcome, in the hearing on his application in the Patent Office, by permitting him to offer extrinsic evidence as to the true character and attributes of the invention which he has undertaken to describe.¹ The

§ 683. ¹ In *Ex parte Dieckerhoff* (1877), 12 O. G. 429, Doolittle, Act. Com. : (480) "The first part of section 4916, requiring that no new matter shall be introduced into the specification, plainly refers to those cases accompanied by drawing and model ; and, as was held in *Seymour v. Osborne*, this provision necessarily excluded the right in such cases to open the case to new parol testimony ; but the express declaration, in the concluding clause of the section, that where there is neither model nor drawing amendments may be made upon proof satisfactory to the Commissioner that the proposed new matter or amendment was a part of the original invention, establishes a class of certain special cases, as the Supreme Court in the same case admitted. It gives to such applicants the privilege of submitting proof as to matter not embodied in the original patent, and permits the exercise of discretion on the part of the Commissioner in the consideration of such proof. Construing the whole of section 4916 together, as it should be, and keeping in mind the only real and lawful purpose of a re-issue application, to correct accidental mistakes in the original specification and drawing, there is nothing in the last clause, nor any previous one, to authorize a departure from the original invention, and the setting up in a re-issue of a substantially different invention. No amount of proof regarding an entirely

different invention, however satisfactory it might be in showing that the same was within the knowledge of an applicant at the time of applying for his original patent, could justify the Office in allowing its introduction therein by re-issue. To the extent of correcting such errors and omissions as are sometimes supplied by consulting the model and drawing filed with an original application, the clause of the statute under consideration, I think, clearly obtains. It might permit, for instance, of the consideration of all original papers filed in the case, and such other evidence of official action from which the intentions of the parties could be discovered or their rights determined. This practice was illustrated in the case of *Winslow*, 9 Official Gazette, 795, where the patent had been passed upon by the United States Supreme Court, and certain matter was held not to be a part of the patent, but where the Office considered the decisions of inferior courts, a dissenting opinion in the court above, together with numerous affidavits, including one from an examiner in the Patent Office, as showing clearly the fact that the applicant had made the invention and had intended to incorporate the same in his patent and believed that he had done so. No doubt existed in that case as to what the applicant's original invention was, as shown by the records of the Office and the testimony of others relating thereto ;

sources and the weight of this extrinsic evidence have not been definitely fixed by law. The statutes merely provide that in this class of cases the proof, upon which any matter omitted from the original specification may be regarded as a part of the original invention, must be satisfactory to the Commissioner, and under this provision papers filed in the Patent Office in connection with the case, and other evidence of official actions, have been received.² But, upon principle, no evidence should be admitted inconsistent with the original specification, drawings, and model. To allow a re-issue for an invention of which no suggestion appears in the original specification, upon parol evidence alone, sets the whole question at large, and opens the door to the perpetration of the gravest frauds upon the public.³

§ 684. Identity of Subject-Matter of the Re-issued Patent Presumed until the Contrary Appears: Re-issued Patent, how Construed.

The invention claimed in a re-issue is presumed to be identical with that attempted to be patented in the original,¹ and

and that it was not definitely set forth and claimed was clearly an inadvertence that could be supplied by the character of proof mentioned. But I am aware of no decision of the Office or the courts which would justify a radical departure from the invention originally indicated or described by means of entirely extraneous proof."

In *Hussey v. Bradley* (1863), 2 Fisher, 362, Hall, J. : (371) "But it is well settled that in deciding upon these applications for a re-issue and the question whether the invention claimed on the re-issue is the same invention intended to be patented on the original application, the Commissioner of Patents is not confined to the Claims, nor even to the examination of the evidence furnished by the specification, models, and drawings accompanying the original application; and that any legal proof to show it to be the same

invention should be received. *Ex parte Ball*; *Ex parte Dyson*; and *Wilson v. Singer*; *Law's Digest*, 620-622." 5 Blatch. 134 (141).

² That the original papers filed in the Patent Office, as well as other evidence, may serve to show whether the inventions are the same, see *Ex parte Dieckerhoff* (1877), 12 O. G. 429.

³ As to the mode of investigating this question of identity in the courts, see § 664, note 2, *ante*.

§ 684. ¹ In *Spaeth v. Barney* (1885), 22 Fed. Rep. 828; Colt, J. : (829) "The re-issue of letters-patent by the Commissioner is *prima facie* evidence that such re-issue is founded on sufficient cause, and is in accordance with law. It is also presumed that the Commissioner acted within his authority under the statute, until the contrary is proved." 30 O. G. 997 (997).

Further, that the allowance of a

this presumption is rebutted only when, from a comparison of the two specifications, it is evident that a substantial difference exists between them.² In aid of this presumption, the

re-issue raises a presumption of the identity of the subject-matter which can be overcome only by strong and controlling evidence, see *Smith v. Goodyear Dental Vulcanite Co.* (1877), 93 U. S. 486 ; 11 O. G. 246 ; *Birdsell v. McDonald* (1874), 6 O. G. 682 ; 1 Bann. & A. 165 ; *Klein v. Russell* (1873), 19 Wall. 433 ; *Hussey v. Bradley* (1863), 5 Blatch. 134 ; 2 Fisher, 362 ; *Potter v. Holland* (1858), 4 Blatch. 238 ; 1 Fisher, 382 ; *O'Reilly v. Morso* (1854), 15 How. 62 ; *French v. Rogers* (1851), 1 Fisher, 133.

That there is also a strong general presumption in favor of the validity of a re-issue and the consequent identity of the inventions, see *Dederick v. Cassell* (1881), 9 Fed. Rep. 306 ; 20 O. G. 1233 ; 14 Phila. 503 ; *Thomas v. Shoe Mach. Mfg. Co.* (1878), 3 Bann. & A. 557 ; 16 O. G. 541 ; *American Middlings Purifier Co. v. Atlantic Milling Co.* (1877), 3 Bann. & A. 168 ; 4 Dillon, 100 ; *Reissner v. Anness* (1877), 13 O. G. 870 ; 3 Bann. & A. 176 ; *Smith v. Goodyear Dental Vulcanite Co.* (1877), 93 U. S. 486 ; 11 O. G. 246 ; *Miller & Peters Mfg. Co. v. Du Brul* (1877), 12 O. G. 351 ; 2 Bann. & A. 618 ; *Tucker v. Tucker Mfg. Co.* (1876), 10 O. G. 464 ; 2 Bann. & A. 401 ; 4 Clifford, 397 ; *Stevens v. Pritchard* (1876), 10 O. G. 505 ; 4 Clifford, 417 ; 2 Bann. & A. 390 ; *Salamander Felting Co. v. Haven* (1875), 3 Dillon, 131 ; 9 O. G. 253 ; *Doherty v. Haynes* (1874), 4 Clifford, 291 ; 6 O. G. 118 ; 1 Bann. & A. 289 ; *Bantz v. Elsas* (1874), 6 O. G. 117 ; 1 Bann. & A. 351 ; *La Baw v. Hawkins* (1874), 6 O. G. 724 ; 1 Bann. & A. 428 ; *Guidet v. Barber* (1873), 5 O. G. 149 ; *Jordan v. Dobson* (1870), 2 Abbott, 398 ; 7 Phila. 533 ; 4 Fisher, 232 ; *Blake v. Stafford* (1868),

3 Fisher, 204 ; 6 Blatch. 195 ; *Morris v. Royer* (1867), 3 Fisher, 176 ; 2 Bond, 66 ; *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379 ; *Hussey v. Bradley* (1863), 2 Fisher, 362 ; 5 Blatch. 134 ; *Hussey v. McCormick* (1859), 1 Fisher, 509 ; 1 Bissell, 300 ; *Woodworth v. Edwards* (1847), 3 W. & M. 120 ; 2 Robb, 610 ; *Allen v. Blunt* (1846), 2 W. & M. 121 ; 2 Robb, 530.

That the fact that a re-issue was granted after a severe contest raises a strong presumption in its favor, see *Consolidated Bunging Apparatus Co. v. Peter Schoenhofen Brewing Co.* (1886), 28 Fed. Rep. 428 ; 37 O. G. 786.

² In *Thomas v. Shoe Machinery Mfg. Co.* (1878), 3 Bann. & A. 557, Clifford, J. : (560) "Where the Commissioner accepts a surrender of an original patent and grants a new patent, his decision in the premises, *in a suit for infringement*, is final and decisive, and is not re-examinable in such a suit in the circuit court, unless it is apparent upon the face of the patent that he has exceeded his authority, and that there is such a repugnancy between the old and the new patents that it must be held as matter of legal construction that the new patent is not for the same invention as that embraced and secured in the original. *Seymour v. Osborne*, 11 Wall. 543. . . . Courts of justice will avoid such a conclusion, if they can reasonably do so, by a proper application of the maxim that patents are to receive a liberal construction, and, if practicable, be so interpreted as to uphold and not destroy the right of the inventor. *Turrill v. Railroad*, 1 Wall. 491 ; *Ames v. Howard*, 1 Sum. 482 ; *Blanchard v. Sprague*, 3 Sum. 279 ; *Glue Co. v. Upton*, 6 O. G. 837. Slight changes will not sustain such a defence,

Description, drawings, and model of the re-issue are always so construed, if possible, as to confine the re-issue to the original invention.³ Claims apparently in excess of the original inven-

nor will the court in any case declare the patent void on that account, if, by the true construction of the two instruments, the invention secured by the two instruments is not substantially different from that embodied in the original patent. Inquiries in such a case are restricted to a comparison of the terms and import of the two patents in view of the drawings and Patent Office model. If from these it results that the invention claimed in the re-issue is not substantially different from the one described, suggested, or indicated in the specification or drawings of the original patent or Patent Office model, the re-issued patent must be held valid, as all other alterations and amendments plainly fall within the intent and purpose of the provision in the act of Congress which allows a surrender and re-issue; or in other words, if the re-issued patent does not, upon the face of the instrument, embrace anything not substantially described, suggested, or indicated in the specifications, drawings, or model of the original, the defence that the re-issued patent is not for the same invention as the original must be overruled." 16 O. G. 541 (542).

In *La Baw v. Hawkins* (1874), 1 Bann. & A. 428, Nixon, J.: (429) "The act of the Commissioner in accepting a surrender and granting a re-issue, is final and conclusive, and not re-examinable in a suit in the Circuit Court, unless it is apparent, upon the face of the patent, that he has exceeded his authority, or that there is such a repugnancy between the old and the new patent that it must be held as matter of legal construction that the new patent is not for the same invention as that embraced and secured in

the original patent." 6 O. G. 724 (725).

Further, that the re-issue is presumed to be for the same invention until by comparing it with the original patent the want of identity clearly appears, see *Searles v. Bouton* (1881), 21 O. G. 1784; 12 Fed. Rep. 140; 20 Blatch. 426; *Smith v. Goodyear Dental Vulcanite Co.* (1877), 93 U. S. 486; 11 O. G. 246; *Doherty v. Haynes* (1874), 4 Clifford, 291; 6 O. G. 118; 1 Bann. & A. 289; *Seymour v. Marsh* (1872), 6 Fisher, 115; 2 O. G. 675; 9 Phila. 380.

³ That the question of identity between a re-issue and its original is a question of construction, not of evidence, if the court can understand the inventions from the patents, see *Heald v. Rice* (1881), 104 U. S. 737; 21 O. G. 1443; *Seymour v. Osborne* (1870), 11 Wall. 516.

That the Claims of the re-issue should be construed, if possible, so as to cover only the real invention described in the original, see *Brainard v. Cramme* (1882), 12 Fed. Rep. 621; 22 O. G. 769; 20 Blatch. 530; *Swain Turbine & Mfg. Co. v. Ladd* (1877), 11 O. G. 153; 2 Bann. & A. 488.

That a re-issue may be construed by the original, see *Tyler v. Galloway* (1882), 20 Blatch. 445; 22 O. G. 2072; 12 Fed. Rep. 567; *Coburn v. Schroeder* (1882), 22 O. G. 1538; *Tyler v. Welch* (1880), 3 Fed. Rep. 636; 18 Blatch. 209; 17 O. G. 1508; *Manufacturing Co. v. Ladd* (1880), 102 U. S. 408; 19 O. G. 62; *Klein v. Russell* (1873), 19 Wall. 433; *Ely v. Monson & Brimfield Mfg. Co.* (1860), 4 Fisher, 64.

That where one part of the re-issue seems void, it may be construed with the other parts and the whole together

tion are restricted by interpretation,⁴ and void Claims are rejected without prejudice to such as have been properly allowed.⁵ The entire re-issue specification is considered as an

may stand, see *Carew v. Boston Elastic Fabric Co.* (1871), 3 Clifford, 356 ; 5 Fisher, 90 ; 1 O. G. 91.

That where a re-issue broadening the Claims is granted after a delay of four and a half years it will be construed as covering the same matter as the original, see *Albany Steam Trap Co. v. Felthousen* (1885), 32 O. G. 1239.

That where a specific and complete invention is fully described, and all the papers including the application, etc., show that this was what the patentee intended to claim, there can have been no inadvertence, and the re-issue cannot be broadly construed even though the actual invention were wider than that described, see *Yale Lock Mfg. Co. v. James* (1884), 28 O. G. 917 ; 20 Fed. Rep. 903 ; 22 Blatch. 294.

That a re-issue as well as an original patent is to be so construed, if possible, as to cover the real invention according to the construction given to it by the patentee, see *Klein v. Russell* (1873), 19 Wall. 433.

⁴ That the Claims of the re-issue will not be enlarged by construction, but will be confined to the original invention, if capable of that interpretation, see *Tyler v. Welch* (1880), 3 Fed. Rep. 636 ; 17 O. G. 1508 ; 18 Blatch. 209.

⁵ In *Gage v. Herring* (1882), 107 U. S. 640, Gray, J. : (646) "The invalidity of the new Claim in the re-issue does not indeed impair the validity of the original Claim, which is repeated and separately stated in the re-issued patent. Under the provisions of the Patent Act, whenever through inadvertence, accident, or mistake, and without any wilful default or intent to defraud or mislead the public, a patentee in his specification has claimed more than that of which he was the original

and first inventor or discoverer, his patent is valid for all that part which is truly and justly his own, provided the same is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right ; and the patentee, upon seasonably recording in the Patent Office a disclaimer in writing of the parts which he did not invent, or to which he has no valid claim, may maintain a suit upon that part which he is entitled to hold, although in a suit brought before the disclaimer he cannot recover costs. Rev. Stat. Sects. 4917, 4922 ; *O'Reilly v. Morse*, 15 How. 62, 120, 121 ; *Vance v. Campbell*, above cited. A re-issued patent is within the letter and the spirit of these provisions." 23 O. G. 2119 (2120).

Further, that void Claims in a re-issue do not affect the valid Claims, see *Reed v. Chase* (1885), 25 Fed. Rep. 94 ; 33 O. G. 996 ; *American Diamond Rock Boring Co. v. Sheldon* (1885), 25 Fed. Rep. 768 ; 33 O. G. 1598 ; *Giant Powder Co. v. Safety Nitro Powder Co.* (1884), 10 Sawyer, 23 ; 27 O. G. 99 ; 19 Fed. Rep. 509 ; *Reay v. Raynor* (1884), 22 Blatch. 13 ; 26 O. G. 1111 ; 19 Fed. Rep. 308 ; *Dryfoos v. Wiese* (1884), 22 Blatch. 19 ; 26 O. G. 639 ; 19 Fed. Rep. 315 ; *Havemeyer v. Randall* (1884), 21 Fed. Rep. 404 ; *Hayes v. Bickelhaupt* (1884), 21 Fed. Rep. 567 ; 29 O. G. 368 ; 22 Blatch. 463 ; *Worden v. Searls* (1884), 21 Fed. Rep. 406 ; *Odell v. Stout* (1884), 22 Fed. Rep. 159 ; 29 O. G. 862 ; *Gold & Stock Telegraph Co. v. Wiley* (1883), 17 Fed. Rep. 234 ; *Wood v. Packer* (1883), 17 Fed. Rep. 650 ; *Cote v. Moffitt* (1883), 15 Fed. Rep. 345 ; *Starrett v. Athol Mach. Co.* (1883), 23 O. G. 1729 ; 14 Fed. Rep. 910 ; *Schillinger v. Green-*

honest effort to amend the original specification in conformity with the essential character of the invention, as shown by the state of the art at the date of the original patent,⁶ and only when it is incapable of any reasonable construction, without extending it beyond the limits of the actual invention, is it held to be a departure from the original patent, and on that account invalid.⁷

§ 685. Third Proposition: Amendment by Re-issue not Permitted unless the Imperfections in the Original Patent Arose without Fraud, and from Inadvertence, Accident, or Mistake.

The third proposition asserts that a re-issue cannot be allowed for the correction of an error unless it occurred through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.¹ This proposition rests in part

way Brewing Co. (1883), 24 O. G. 495 ; 17 Fed. Rep. 244 ; Fetter v. Newhall (1883), 21 Blatch. 445 ; 25 O. G. 502 ; 17 Fed. Rep. 841 ; Tyler v. Galloway (1882), 12 Fed. Rep. 567 ; 20 Blatch. 445 ; 22 O. G. 2072.

That a void Claim in a re-issue may be disclaimed, see Tyler v. Galloway (1882), 12 Fed. Rep. 567 ; 20 Blatch. 445 ; 22 O. G. 2072.

⁶ In Crandall v. Parker Carriage Goods Co. (1884), 20 Fed. Rep. 851, Coxe, J. ; (852) "Where it can be seen that the patentee seeks, by apt words of description, to secure what he has honestly invented and nothing more, the court should hesitate to regard with favor the accusations now so freely made against re-issued patents." 28 O. G. 369 (370).

That a re-issue should be construed in view of the state of the art at the time the original was granted, see Garneau v. Dozier (1880), 102 U. S. 230 ; 19 O. G. 61.

That the state of the art when the original was filed may be shown on the question of identity between the original and re-issue to interpret the original as

compared with the re-issue, see Eachus v. Broomall (1885), 115 U. S. 429 ; 33 O. G. 1265.

⁷ See § 746 and notes, *post*.

§ 685. ¹ In Coon v. Wilson (1885), 113 U. S. 268, Blatchford, J. : (277) "As the rule is expressed in the recent case of Mahn v. Harwood, 112 U. S. 354, a patent 'cannot be lawfully re-issued for the mere purpose of enlarging the Claim, unless there has been a clear mistake inadvertently committed in the wording of the Claim, and the application for a re-issue is made within a reasonably short period after the original patent was granted.' But a clear mistake, inadvertently committed in the wording of the Claim, is necessary without reference to the length of time." 30 O. G. 889 (891).

In *Ex parte Conklin* (1874), 1 MacArthur, 375, MacArthur, J. : (378) "It will be seen by the terms of the statute that in order to entitle a party to the re-issue of a patent it is incumbent on him to show that it is inoperative or invalid by reason of a defective or insufficient specification, or that the patentee had claimed more than he in-

upon the doctrine of fraud and in part upon the doctrines of estoppel and abandonment. A wilful attempt to deceive the public, whether by express misrepresentation or by obscurity and insufficiency of statement, is a fraud. It violates the fundamental principles of contract, upon which the right of an inventor to his patent privilege depends. If such an attempt be proved, the patent is void *ab initio*; its errors are incapable of remedy by any method of amendment; and the inventor forfeits, as a penalty for his wrong-doing, the entire protection he might otherwise have obtained.² An intentional misrepre-

vented, and that the error had arisen by inadvertence, accident, or mistake, and without any fraudulent intention. Unless these circumstances exist in an application of this character, I can find no authority by which the Commissioner can re-issue a patent; as he is an officer of special and limited power, his action must be restricted to the particular cases mentioned in the statute. I refer to these requirements of law because, if the original patent is neither inoperative nor invalid, and if no error has been occasioned by accident or mistake, there must be a presumption of law and fact that the patentee has abandoned to the use of the public everything which he may have invented, but which he did not include in his Claims and specifications. The law presumes that every one who applies for a patent will embody his invention in specifications sufficiently definite to preserve as much of his discovery as he desires to protect by a patent. If, from mistake, he has overlooked anything within the scope of his invention, he may surrender his patent on that ground, and claim a new one, in accordance with amended specifications. The party asking this relief must be denied it unless he brings himself within the statute. When he knows all the facts relating to his own case, but, through culpable negligence or misconduct, has failed to claim all of his discovery, the law will not extend

its aid to him, but will leave him to enjoy only such limited advantages as he has actually secured. The law reserves its remedies for the careful and vigilant who may have been misled from any of the causes mentioned in the statute." 5 O. G. 235 (236).

In *Jordan v. Dobson* (1870), 4 Fisher, 232, Strong, J.: (237) "If the defect or insufficiency of the specifications of the surrendered patents had not arisen from inadvertence, accident, or mistake, and without fraudulent intention, the Commissioner had no right to re-issue the patent." 2 Abbot, 398 (404); 7 Phila. 533 (535).

See also *Ex parte Whitely* (1886), 36 O. G. 1243; *Bate Refrigerating Co. v. Eastman* (1885), 24 Fed. Rep. 645; 32 O. G. 517; *Clements v. Odorless Excavating Apparatus Co.* (1884), 109 U. S. 641; 26 O. G. 353; *Flower v. Rayner* (1881), 5 Fed. Rep. 793; 19 O. G. 425; *Meyer v. Maxheimer* (1881), 20 O. G. 1162; 20 Blatch. 15; 9 Fed. Rep. 99; *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 18 O. G. 1339; 6 Sawyer, 508; 4 Fed. Rep. 720; *Giant Powder Co. v. California Powder Works* (1875), 3 Sawyer, 448; 2 Bann. & A. 131; *Knight v. Baltimore & Ohio R. R. Co.* (1840), Taney, 106; 3 Fisher, 1; Opinion Atty. Gen. (1836), 3 Op. At. Gen. 165.

² This doctrine rests not merely upon general principles of law, but upon the

sentation or concealment, without fraudulent design, concludes the party making it as to the character and scope of the invention attempted to be covered by the patent. What has been properly described and claimed is regarded as its true subject-matter; what has been voluntarily omitted or misstated is considered as abandoned to the public, or as permanently excluded from that particular patent;³ and though it may sometimes be made the subject-matter of a future patent, it cannot be incorporated into the existing patent by re-issue. An error which occurs through inadvertence, accident, or mistake, is neither intentional nor fraudulent, but is consistent with an honest attempt to describe and claim the complete invention, as the inventor has himself conceived it and rendered it available for public use.⁴ It is for the purpose of correcting this latter error only that an amendment by re-issue is permitted.

express provisions of the statute. An attempt to deceive the public by a suppression of the truth or the suggestion of a falsehood in the description and specification of the patent is therein made a valid defence in any action based upon the patent. The right to amend a defective patent either by disclaimer or re-issue is also conditioned upon the absence of any fraudulent or deceptive intention on the part of the patentee. Diligence and good faith are alike required of him as qualities of conduct and purpose without which no concession of exclusive privileges to him can be allowed. See *Miller v. Brass Co.* (1882), 104 U. S. 350; 21 O. G. 201.

³ That a re-issue cannot claim matter intentionally omitted from the original, see *Ex parte Mahnken* (1887), 40 O. G. 915; *Shirley v. Mayer* (1885), 23 Blatch. 249; 25 Fed. Rep. 38; 34 O. G. 1391.

⁴ That "mistake" as ground for re-issue is not the same thing as "misunderstanding," see *Ex parte Wilkins* (1883), 24 O. G. 1270.

• That it is immaterial by what mistake or inadvertence a re-issue becomes necessary, see *Stimpson v. Westchester*

R. R. Co. (1846), 4 How. 380; 2 Robb, 335.

That the re-issue affords *prima facie* evidence of inadvertence, but may be overcome by other proof, see *Odell v. Stout* (1884), 22 Fed. Rep. 159; 29 O. G. 862.

That "inadvertence, etc.," exists in reference to the application, not the invention, and occurs only where the former does not describe and claim what the inventor intended to protect, see *Ex parte Mahnken* (1887), 41 O. G. 1269.

That a Claim left out of the original because the applicant did not consider its subject-matter patentable cannot be inserted in the re-issue, see *Ex parte Mahnken* (1887), 40 O. G. 915.

That an error in opinion or judgment is not "mistake or inadvertence," see *Ex parte Mahnken* (1887), 40 O. G. 915.

That a re-issue which was evidently procured to cover other later devices and not to cure faults arising from inadvertence or mistake is invalid, see *Newton v. Furst & Bradley Mfg. Co.* (1886), 119 U. S. 373; 38 O. G. 104.

§ 686. Re-issue not Permitted where the Defects in the Original Patent Arose through Fraud.

With reference to this third proposition, defects and insufficiencies in the Description or Claims of a patent may thus be grouped in three classes: (1) Those which are intentional and fraudulent; (2) Those which are intentional but not fraudulent; (3) Those which are neither intentional nor fraudulent, but which arise from inadvertence, accident, or mistake. Concerning the first class, the law is plain and fully settled. The question as to the existence of a fraudulent and deceptive intention is a question of fact to be determined, upon direct or inferential evidence, by whatever tribunal may have jurisdiction of the controversy in which the question is raised. Thus on an application for a re-issue, the Commissioner may inquire into the original good faith of the patentee, and upon satisfactory proof of bad faith may deny the application. The courts, in ascertaining the validity of a re-issue already granted, may pursue the same investigation, and if a fraudulent intent appears to have been entertained by the original patentee, may treat the re-issue as invalid.¹

§ 687. Re-issue not Permitted to Reject Matter Intentionally Inserted in the Original Patent, nor to Restore Matter Intentionally Excluded.

The line between the second and third classes, though sufficiently clear in statement, is not always easy to define in

§ 686. ¹ The extent of the authority of the courts to inquire into the intention of the patentee in omitting or misstating any feature of the invention in his original patent cannot, at present, be precisely defined. That the decision of the Commissioner on the good faith of the patentee in applying for a re-issue, and on the absence of corruption in allowing it, is final, except upon proceedings brought to repeal the re-issued patent, is conceded; and that a patent may be collaterally attacked, on the ground that its Description and Claims are fraudulent and intended to deceive, is beyond question. A disposition to

enlarge the sphere of judicial authority, and permit the courts to go behind the finding of the Commissioner upon the questions of inadvertence, etc., in ordinary actions on the re-issued patent has recently been manifested; and though indulged with great caution, and with perhaps too much regard for the supposed prerogatives of the Commissioner, is so clearly in the interests of a just administration of the law that its result in bringing all these issues into the jurisdiction of the courts in any suit, in which the validity of the patent is involved, may be considered as already certain. See §§ 714, 715, and notes, *post*.

practice. That matter which has once been deliberately embraced within or excluded from a patent can neither be disclaimed nor reclaimed by an amendment, and that matter unintentionally included or omitted may be afterward rejected or inserted, are rules distinct, precise, and exhaustive. The difficulty is found in ascertaining whether the original misstatement was deliberate or unintentional, and in devising and applying tests by which this question may be settled without relying on the evidence of the inventor as to the object which he had in view. The positions generally taken by the Patent Office and the courts in reference to this question are in harmony with those assumed in regard to other aspects of the doctrines of abandonment and estoppel.¹ Abandonment is always a question of intention, to be gathered in all cases from the conduct of the inventor toward his invention or the public. Estoppel rests upon an actual or presumed intention of the inventor, which is made effective by forbidding him to depart from the position he has once assumed. Errors occurring in the Description or Claims of the original patent are thus held to have been deliberate or unintentional according to the indications afforded by the circumstances causing, or connected with, or relating to the occurrence of these errors. Such circumstances may precede or be concurrent with or subsequent to the issue of the original patent. They may appear upon the face of the patent itself, or in the records of the Patent Office, or in the actions or omissions of the inventor; and whenever from these circumstances it is evident that the inventor deliberately made his attempt to describe and claim the invention in the form and with the limitations inserted in the original specification, any endeavor to correct the statement, by changing that form or discarding those limitations in the re-issue, is unlawful. What circumstances have been treated by the Patent Office or the courts as indicative of such intentional exclusion, will be now considered.

§ 687. ¹ That whenever it may be necessary for the protection of either public or private rights, the doctrine of estoppel, as now applied in courts of law and equity to ordinary trans- actions, will be resorted to in the adjudication of patent causes, see §§ 346 and notes, 357, note 3, 390 and notes, *ante*, and §§ 981, 1021, 1046, 1195, and notes, *post*.

§ 688. Re-issue not Permitted to Enlarge the Claims of the Original Patent by Including Matter once Intentionally Excluded.

It may be premised that this question rarely arises except in cases where the alleged error in the original patent consists in an undue restriction of its Claims.¹ An amendment made in the Description, placing the invention more fully in the possession of the public and not enlarging the privileges of the inventor, is not subject to objection unless the original were fraudulent and the patent, therefore, void. An amendment merely limiting excessive Claims in the original patent is also rather for the public interest than that of the inventor, and when attempted without unreasonable delay seldom encounters opposition. But when the inventor endeavors by amendment to extend his Claims, and thus encroaches on a domain previously left open to the public or occupied by rival inventors, his efforts are naturally subjected to severe adverse criticism and his rights are properly confined within the narrowest limits. Hence it is in cases where the re-issue, though not materially altering the description of the original invention, claims for it essential features differing in number or in character from those claimed for it in the former patent, or where subordinate or dependent inventions, described but not claimed in the original patent, are claimed in the re-issue,

§ 688. ¹ It is not, however, true that the right to a re-issue amending the Description or narrowing the Claims can be exercised without limitation. The patentee owes a duty to the public to present them with an accurate delineation of his invention, and to confine his Claims to the essential features which he has created; and he is open to the imputation of bad faith if he fails to amend his patent in these particulars when such amendment becomes evidently necessary. Thus even a disclaimer cannot save a patent unless made without unreasonable delay; and acquiescence in a faulty description may bar the allowance of a re-issue, if it does not furnish evidence of an original intention to de-

ceive. Illustrations of these principles may be found in the following cases:

That while less delay is allowable in expanding Claims than in restricting them, no unreasonable delay as to either can be permitted, see *Ex parte Matthews* (1884), 26 O. G. 823.

That a defect in the Description may be cured by re-issue, even though the right to cure one in the Claim has been lost by delay, see *Miller v. Brass Co.* (1882), 104 U. S. 350; 21 O. G. 201.

That the original Claims may be reproduced in a re-issue without reference to delay, see *Yale Lock Co. v. Sargent* (1886), 117 U. S. 536; 35 O. G. 497; *Steam Gauge Lantern Co. v. Miller* (1882), 11 Fed. Rep. 718.

that the amendment is attacked, and that the question of deliberate or unintentional exclusion from the previous patent is involved.

§ 689. **Intentional Exclusion Shown by Express Disclaimer in the Original Patent or during the Proceedings in the Patent Office.**

A voluntary and intelligent disavowal of any matter which is embraced in the original description of the invention is conclusive evidence of its intentional exclusion from the patent.¹ This disavowal may consist in an express disclaimer embodied in the specification, or filed subsequently

§ 689. ¹ That an intentional disclaimer of any matter in the original patent prevents its claim in a re-issue is apparent from the authorities cited in § 680, note 1, *ante*. But an unintentional or mistaken disclaimer, arising from an erroneous use of language, as distinguished from a misconception of the nature of the invention, has no such effect. On the contrary, it is one of the chief purposes of a re-issue to correct defects of this kind and to cause the patent to embrace what before it had, under the construction given to its terms, apparently excluded. Thus in *Hussey v. Bradley* (1863), 2 Fisher, 362, Hall, J. : (371) "Even a statement, in an original patent, that a part is old, or a disclaimer of a part, does not, it seems, necessarily prevent such part from being claimed in a re-issued patent, though it would have that effect if made advisedly, and not by inadvertence, accident, or mistake. *Ex parte Hayden*; *Laidley v. James*; *Law's Digest*, 616." 5 Blatch. 134 (141). See also *Daniels v. Chesterman* (1877), 13 O. G. 4; *Poppenhusen v. Falke* (1861), 2 Fisher, 181; 4 Blatch. 493.

That a re-issue may omit a disclaimer found in the original, if such disclaimer has no reference to the essence of the invention and does not limit its claim,

see *Ex parte Hermann* (1876), 10 O. G. 865.

That a disclaimer in the original need not be inserted in the re-issue where it has been judicially determined that such disclaimer was unnecessary, see *Eames v. Andrews* (1887), 122 U. S. 40; 39 O. G. 1319.

That a re-issue, re-instating Claims omitted from a former re-issue in order to substitute wider ones, is valid, see *Celluloid Mfg. Co. v. Zylonite Brush & Comb Co.* (1886), 27 Fed. Rep. 291; 35 O. G. 1228.

That where a specification says that the invention consists in combining the elements, this does not abandon the elements themselves, see *Henderson v. Cleveland Co-operative Stove Co.* (1877), 12 O. G. 4; 2 Bann. & A. 604.

That the withdrawal of a Claim in the Patent Office as unnecessary is not an abandonment of the matter, see *Eames v. Andrews* (1887), 122 U. S. 40; 39 O. G. 1319.

That a re-issue upon the application of an assignee cannot cover matter once disclaimed by the original inventor, see *Putnam v. Hutchison* (1882), 11 Bissell, 233; 12 Fed. Rep. 127; *Ashcroft v. Railroad Co.* (1877), 97 U. S. 189; 13 O. G. 865.

to the issue of the patent, or in the conduct of the inventor toward his application during the proceedings in the Patent Office.² A feature of the invention, whose rejection by the examiner is acquiesced in by the applicant without appeal, is thereby excluded as effectually as by express disclaimer.³ A Claim withdrawn by amendment, either to save the application or escape an interference, is also finally repudiated by the patentee.⁴ Even the acceptance of a patent, containing

² That a re-issue cannot include Claims abandoned in the first application, see *Streit v. Lauter* (1882), 11 Fed. Rep. 309.

That an admission by the patentee in his specification or application cannot be contradicted by him, see *Mollitt v. Rogers* (1881), 8 Fed. Rep. 147.

That matter abandoned in the Patent Office cannot be reclaimed by re-issue, see *Yale Lock Mfg. Co. v. James* (1884), 22 Blatch. 294 ; 28 O. G. 917 ; 20 Fed. Rep. 903.

³ In *Ex parte Hatchman* (1884), 3 Mackey, 288, MacArthur, J. : (289) "We are of opinion that on an application for a patent, when one of the Claims presented is covered by previous inventions and the patents therefor are referred to, and the examiner upon such reference decides against such Claim, and the applicant thereupon, by his attorney, orders the same to be erased and withdrawn, and thus obtains and accepts a patent for the residue of his Claims, he is not entitled to a re-issued patent containing the identical Claim which he has so erased and withdrawn. We also hold that under such circumstances no error has arisen by inadvertence, accident, or mistake, within the meaning of the Patent Law, which would authorize the Commissioner to entertain the application for a re-issue." 26 O. G. 738 (738).

That a Claim rejected by the Patent Office and the rejection acquiesced in cannot be re-instated by re-issue, there being in such cases no accident or mis-

take, see *Ex parte Page* (1888), 43 O. G. 1455 ; *Arnheim v. Finster* (1886), 26 Fed. Rep. 277 ; 34 O. G. 700.

That if the Commissioner on an extension-hearing requires certain matters to be disclaimed and the patentee acquiesces, they cannot be inserted in a re-issue, there having been no inadvertence, see *Union Metallic Cartridge Co. v. United States Cartridge Co.* (1884), 112 U. S. 624 ; 30 O. G. 771.

That a Claim abandoned in the original application on an objection by the Patent Office, but afterward allowed to another applicant, may be inserted in the re-issue, see *Yale Lock Mfg. Co. v. Norwich National Bank* (1881), 19 Blatch. 123 ; 6 Fed. Rep. 377.

⁴ That a re-issue cannot contain Claims which were withdrawn from the application for the original in order to secure its issue, see *Shepard v. Carrigan* (1886), 116 U. S. 593 ; 34 O. G. 1157 ; *Leggett v. Avery* (1879), 101 U. S. 256 ; 17 O. G. 445.

That if an applicant is obliged to include an element in order to procure a patent, he cannot afterwards broaden his Claim by dropping it, see *Shepard v. Carrigan* (1886), 116 U. S. 593 ; 34 O. G. 1157.

That a patentee is bound by the limitations imposed on his patent, whether they were voluntary or enforced by the Patent Office, and if he accepts a Claim not covering his entire invention he abandons the residue, see *Toepfer v. Goetz* (1887), 41 O. G. 933.

That where a Claim was withdrawn

limitations imposed by the Patent Office which narrow the scope of the invention as at first described and claimed in the application, is an irrevocable admission that such limitations are of the essence of the invention attempted to be covered by the patent.⁵ In none of these cases can the undue restriction of the Claim be attributed to inadvertence, accident, or mistake.⁶ The patentee, when he receives his

from the application of an original patent, in order to escape an interference, the re-issue cannot contain such Claim, see *Lee v. Walsh* (1879), 15 O. G. 563 ; *Ex parte Gillen* (1877), 11 O. G. 419.

That Claims cannot be restored after a judgment has been rendered in interference in the patentee's favor on his striking them out, see *Ex parte Cobb* (1879), 16 O. G. 175.

That a defeated contestant in an interference, after accepting a limited patent, cannot claim in his re-issue any matter awarded to his opponent, see *Ex parte Burge* (1877), 13 O. G. 498.

That where a device is adhered to in spite of an interference it cannot afterward be claimed that its retention in that application was a mistake, see *Ex parte Kirby* (1879), 16 O. G. 1095.

That it will not be assumed that contesting parties could have overcome objections raised by the Patent Office, see *Puetz v. Bransford* (1887), 39 O. G. 1427 ; 31 Fed. Rep. 458.

That where the original application was for a product and process both, and was amended to cover only the process, the patent cannot be re-issued to claim the product, see *Giant Powder Co. v. California Powder Works* (1875), 3 Sawyer, 448 ; 2 Bann. & A. 131.

That a proposal to limit the Claim, though made by the applicant to the Patent Office, does not bind the patentee unless it was accepted by the Commissioner, see *Pike v. Potter* (1859), 3 Fisher, 55.

⁵ In *N. Y. Belting & Packing Co. v. Sibley* (1883), 15 Fed. Rep. 386, Low-

ell, J. : (389) "It has been several times decided by the Supreme Court that disclaimers, qualifications, and limitations, imposed upon a patentee by the Patent Office, are forever binding upon him if he chooses to accept a patent containing them. Not only are third persons likely to be misled to their injury by any subsequent enlargement by re-issue, or by a broad construction of Claims thus intended to be limited, but these qualifications are conditions precedent, without which there would have been no grant at all, and, of course, the grant must be taken as it is given." 23 O. G. 1444 (1445). See also *Dodds v. Stoddard* (1883), 24 O. G. 799 ; 17 Fed. Rep. 645 ; *Putnam v. Hutchinson* (1882), 12 Fed. Rep. 127 ; 11 Bissell, 233 ; *Goodyear Dental Vulcanite Co. v. Davis* (1880), 102 U. S. 222 ; 19 O. G. 543.

That a disclaimer, by direction of the Commissioner, in an application for a re-issue, of some modification of the original, does not concede that such modification is not covered by the patent, as it might do if in the original patent, see *Union Metallic Cartridge Co. v. United States Cartridge Co.* (1881), 7 Fed. Rep. 344.

That an applicant limiting his Claims upon a re-issue in view of the objections of the Patent Office is bound by the limitations in suits on the re-issue, see *Crawford v. Heysinger* (1887), 123 U. S. 589 ; 42 O. G. 197.

⁶ Two exceptions have sometimes been recognized as existing under this rule : one, where the limitation in the

patent, knows that it does not cover all he had originally claimed. Instead of pressing his original application until

original patent was imposed through a mistake in the Patent Office; the other, where it resulted from the act of an attorney without special authority for that purpose from the applicant. The modern tendency seems to be to disregard these exceptions, and to compel the patentee to abide by the patent as he receives and accepts it. Thus that a re-issue may claim matters which, through a mistake in the Patent Office, were disclaimed in the original, was held in *American Shoe Tip Co. v. National Shoe Toe Protector Co.* (1877), 11 O. G. 740; 2 Bann. & A. 551; *Ex parte Sexton* (1876), 9 O. G. 251; *Morey v. Lockwood* (1868), 8 Wall. 230.

That where the Patent Office gives an erroneous interpretation to a Claim and thereupon rejects it with the assent of the patentee, the Claim bearing a different interpretation may be re-instated in a re-issue, see *Yale Lock Mfg. Co. v. New Haven Savings Bank* (1887), 32 Fed. Rep. 167; 43 O. G. 115.

The opposite doctrine is asserted in *Ex parte Hatchman* (1884), 3 Mackey, 288; 26 O. G. 738; *Putnam v. Hutchinson* (1882), 11 Bissell, 233; 12 Fed. Rep. 127; and cases cited under note 3, *ante*.

That a patentee having acquiesced in the rejection of broad Claims cannot afterward assert them, though the rejection was improper, see *Blodes v. Rand, McNally, & Co.* (1886), 27 Fed. Rep. 93; 37 O. G. 99.

The present state of the second exception is more doubtful, as the following authorities will show:—

That a disclaimer by an attorney without authority from the patentee is no bar to a re-issue covering the matter disclaimed, see *Lee v. Walsh* (1879), 15 O. G. 563; *Ex parte Murdock* (1879), 16 O. G. 957; *Mann v. Bayliss* (1876), 10 O. G. 789.

That a re-issue may embrace a Claim shown in the original application and erased by a misunderstanding of the attorney, see *Stutz v. Armstrong* (1884), 28 O. G. 367; 20 Fed. Rep. 843.

That material matters cannot be disclaimed by an attorney of his own motion, but only by the applicant himself, though immaterial matter may be disclaimed without the signature of the party, see *Ex parte Murdock* (1879), 16 O. G. 957.

But *per contra*,—

That an erasure of a rejected Claim by an attorney shows that there is no inadvertence, see *Ex parte Hatchman* (1884), 3 Mackey, 288; 26 O. G. 738; *Ex parte Hatchman* (1883), 25 O. G. 979.

That matter disclaimed in the Patent Office by the attorney to escape rejection cannot be reclaimed in a re-issue, though the patentee were ignorant of the disclaimer, see *Arnheim v. Finster* (1885), 24 Fed. Rep. 276; 32 O. G. 256.

That a mistake of a solicitor in procuring a patent with Claims narrower than he was instructed to make cannot be cured by re-issue after years of delay, see *Ives v. Sargent* (1887), 119 U. S. 652; 38 O. G. 781.

That where two rivals employ the same attorney who in good faith limits the application of one to allow priority in some matter to the other, and both acquiesce in the patents so granted for nine years and then discover that the other was its real inventor, no re-issue can be had by him to cover it and neither can hold it, see *Hartshorn v. Saginaw Barrel Co.* (1887), 119 U. S. 664; 38 O. G. 540.

That a Claim rejected in the Patent Office, and the rejection acquiesced in by the attorney for the inventor, cannot be inserted in a re-issue after two years'

his rights have been determined by the court of last resort, he has relinquished a portion of the fruits of his inventive skill, at least from the protection of that particular patent, in order to secure the rest, and whether his course in this respect were wise or unwise, he cannot afterward retrace it and by re-issuing his patent claim the matter once excluded.⁷

delay and after intervening rights have arisen, see *Boland v. Thompson* (1886), 23 Blatch. 440 ; 26 Fed. Rep. 633 ; 35 O. G. 1113.

That a claim stricken out of the original application because disallowed in the Patent Office, and whose subject-matter is not covered by the original patent as accepted by the patentee's solicitor, cannot be inserted in a re-issue, see *Dobson v. Lees* (1887), 30 Fed. Rep. 625.

That the inventor is a foreigner who does not understand English cannot save him if duly put upon his guard in reference to such rejection, see *Boland v. Thompson* (1886), 23 Blatch. 440 ; 26 Fed. Rep. 633 ; 35 O. G. 1113.

⁷ In *Leggett v. Avery* (1879), 101 U. S. 256, Bradley, J. : (259) " If, in any case, where an applicant for letters-patent, in order to obtain the issue thereof, disclaims a particular invention, or acquiesces in the rejection of a Claim thereto, a re-issue containing such Claim is valid (which we greatly doubt), it certainly cannot be sustained in this case. The allowance of Claims once formally abandoned by the applicant, in order to get his letters-patent through, is the occasion of immense frauds against the public. It not unfrequently happens that, after an application has been carefully examined and compared with previous inventions, and after the Claims which such an examination renders admissible have been settled with the acquiescence of the applicant, he, or his assignee, when the investigation is forgotten and perhaps new officers have

been appointed, comes back to the Patent Office, and, under the pretence of inadvertence and mistake in the first specification, gets inserted into re-issued letters all that had been previously rejected. In this manner, without an appeal, he gets the first decision of the Office reversed, steals a march on the public, and on those who before opposed his pretensions (if, indeed, the latter have not been silenced by purchase), and procures a valuable monopoly to which he has not the slightest title. We have more than once expressed our disapprobation of this practice. As before remarked, we consider it extremely doubtful whether re-issued letters can be sustained in any case where they contain Claims that have once been formally disclaimed by the patentee, or rejected with his acquiescence, and he has consented to such rejection in order to obtain his letters-patent. Under such circumstances, the rejection of the Claim can in no just sense be regarded as a matter of inadvertence or mistake. Even though it was such, the applicant should seem to be estopped from setting it up on an application for a re-issue." 17 O. G. 445 (446).

In *Wicks v. Stevens* (1876), 2 Woods, 310, Bradley, J. : (312) " The patent of 1866 was confined to portable revolving cotton-presses. I assume that the re-issued patent extends to all cotton-presses, stationary as well as portable, for, if confined to the latter, the defendant does not infringe it. Had this extension to stationary presses been omitted in the original patent by acci-

§ 690. **Intentional Exclusion Shown by Failure to Claim Matter Clearly Described in the Original Patent unless the Claims are Amended by Re-issue without Unreasonable Delay.**¹

The omission from the Claims of the original patent of any feature of the invention, or of any subordinate or dependent

dent or mistake, it might be corrected in the re-issued patent. But its application to revolving presses generally was first claimed and then abandoned in the application for the original patent of 1866, and the Claim as finally made by the patentee, and to secure which alone his patent issued, was for a combination applicable to portable presses only. It cannot be said, therefore, that a neglect to claim the combination as applicable to revolving presses generally was an inadvertence, accident, or mistake. It was an exclusion designed and understood at the time. Attempts to grasp claims by means of re-issued patents, which, while the evidence is fresh at the time of the original application, the patentee would not have the hardihood to make, are getting too frequent, and are too often acquiesced in by the Patent Office. Perhaps this is not to be wondered at when we consider the persistency with which claims once abandoned are pressed upon the department after the evidence of their futility has been forgotten." 2 Bann. & A. 318 (319).

That where the Patent Office rejects a Claim, an appeal or bill in equity, not a re-issue, is the remedy, see *Arnheim v. Finster* (1886), 26 Fed. Rep. 277; 34 O. G. 700; *Shepard v. Carrigan* (1886), 116 U. S. 593; 34 O. G. 1157; *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657; *New York Belting & Packing Co. v. Sibley* (1883), 15 Fed. Rep. 386; 23 O. G. 1444; *Putnam v. Hutchinson* (1882), 12 Fed. Rep. 127; 11 Bissell, 233.

§ 690. ¹ The doctrine discussed in

this and the two succeeding paragraphs is one which all the decisions cited in the notes sustain, and which a few of them clearly and exclusively enunciate. In many of the opinions explaining these decisions, however, other theories are introduced and treated as the grounds on which the judgment of the court is based, thereby tending to obscure a proposition which in itself is sufficiently intelligible. These theories have been echoed by one court to another, sometimes in their entirety, sometimes shorn of their most important qualifications, and sometimes generalized into sweeping rules and applied to cases far beyond their legitimate scope, and thus have reduced the law on this topic to a condition of incoherence and uncertainty which is deplorable. To cite these cases without pointing out the chief errors of statement which are to be encountered, and explaining the relation of the most important of these theories to the true principles by which the subject must be governed, would be fruitless.

One of these theories is that a re-issue for the purpose of enlarging the Claims of a patent occupies a position different from that of a re-issue to restrict the Claims or more clearly describe the invention, both in reference to the time within which such re-issue must be sought, and to the mode in which it is affected by the intervening acts of others. Upon what interpretation of the statutes this position rests is explained at length in § 656, note 2, in a discussion of the case of *Miller v. Brass Co.* (1881), 104 U. S. 350. But if it be true that a re-issue for the purpose

invention, which has been clearly described in the specifica-

of enlarging Claims which were unduly restricted in the original is proper (and this is conceded by the theory under review), such re-issue is authorized by the statute whenever the original restriction arose from inadvertence, accident, or mistake, without any reference to lapse of time, or the acts of other parties. The inventor having actually invented more than his original patent has really secured, can lose the excess only by some form of abandonment, and this can never be inferred from mere delay alone, nor from the conduct of third parties. The intention to abandon (and without such intention no abandonment of any kind is possible) is conclusively disproved if the inventor attempted to cover the matter by his original patent, as it is, on the other hand, conclusively established if no such attempt were made. And as an omission or misstatement in a Claim, through inadvertence, accident, or mistake, presupposes an attempt to claim which has failed to accomplish the intention of the claimant, so it can never be true that matter originally misstated or omitted, through accident, mistake, or inadvertence, can have been then abandoned. But if the invention could not have been abandoned by the failure of an attempt to secure its protection, abandonment is certainly not effected by the mere continuance of the patent in its defective state. If the inventor does not relinquish his right to the invention by taking out his patent in its defective form, he surely cannot relinquish it by holding under the defective patent in the belief that it sufficiently protects his actual invention, whatever period may elapse. Not until he acquires such knowledge of the defects as would have made his original acceptance of the patent in that form incompatible with the idea of inadvertence, accident, or mistake in describ-

ing and claiming the invention, can any want of intention to monopolize the entire invention, as he originally attempted to describe it, be imputed to him. But when this knowledge is obtained, or by the exercise of ordinary vigilance could be obtained, his acquiescence in the defects of his original patent has a grave significance. Such acquiescence indicates an intention to abandon whatever the original patent, because of these defects, fails to secure. Were it not for the peculiar language of the statute and the dependence of the re-issued patent, so far as the patentability of the invention is concerned, upon the state of facts existing at the date of the original, it might indeed be held that this acquiescence is in itself an abandonment of the unprotected matter, and a bar to its reproduction in the re-issue. But the statute governing re-issues contains no provision for their refusal on account of the abandonment of the invention after the grant of the original patent. On the contrary, it makes the actions and attempts of the inventor at the date of the original application the sole criterion of his right to a re-issue, and until the case of *Miller v. Brass Co.* the courts had, with scarcely an exception, followed the same rule. See *Battin v. Taggert* (1854), 17 How. 74, overruling *Battin v. Taggert*, 2 Wall. Jr. 102, and asserting that matter described but not claimed does not become abandoned by lapse of time; also *Hussey v. Bradley* (1863), 5 Blatch. 134; 2 Fisher, 362; *McWilliams Mfg. Co. v. Blundell* (1882), 22 O. G. 177; 11 Fed. Rep. 419. Thus the acquiescence of a patentee in a defective patent can have no other weight, either in a subsequent application for a re-issue or in an action involving the validity of a re-issued patent, than as evidence of the real position of the patentee toward his invention at the date

tion, is always *prima facie* evidence of an intention, on the

of his original patent, and of the origin of his omissions and misstatements in intention rather than in accident, inadvertence, or mistake. His negligence in asserting his rights after he becomes aware that they are not sufficiently protected by his existing patent affords ample proof of his original intention to forego them, and it is only as an element in such negligence that the delay of the patentee in obtaining an amendment by re-issue is open to consideration.

The argument here urged is not intended as a denial that Congress could justly have withheld the privilege of a re-issue on the ground of unreasonable delay alone, without regard to the inference it affords as to the original intent of the inventor. But as neither the acts of 1832 or 1836 or 1870, nor the Revised Statutes, prescribe that diligence *per se* is essential to the right to a re-issue, while in reference to a disclaimer it was made an indispensable condition, and as in numerous instances re-issues have been granted after long periods of time, and have been unhesitatingly sustained by the courts, it is a fair conclusion that the legislature, in which the ultimate power to grant or withhold patents resides, never designed that the mere failure to apply for a re-issue, however prolonged, should operate as a forfeiture of the right to amend a patent whose defects originated in the modes described. Nor is it intended to deny that where legislative enactments are deficient, and inadequate to the protection of rights, the courts may act on general principles of justice and equity, and by a species of judicial legislation provide for cases not covered by the letter of the law. Thus if the removal and prevention of the abuses which had arisen in connection with re-issues could not have been accomplished by a true interpretation and

enforcement of the provisions of the statutes, a resort to the doctrine that vested rights may be forfeited by laches or estoppel might have been excusable. But in the explication herein given of the positive law relating to re-issues, it seems evident that the legislative enactment is sufficient for itself, and that no occasion exists for the importation into this subject of those equitable theories which place the inventor entirely at the mercy of the court, although he may in all respects have fulfilled the express precepts of the law.

The effect of the conduct of third parties upon the right of a patentee to a re-issue amending his defective Claims is subject to still narrower limitations. Until he has knowledge, or is put upon such inquiry as would result in knowledge, that his invention is not fully secured by his patent, the actions and assertions of others cannot deprive him of the privilege of a re-issue when he does discover its necessity, either under the language of the statute or under the doctrines of abandonment or laches or estoppel. As was well said by Bradley, J., in *White v. Dunbar* (1886), 119 U. S. 47 (52): "The circumstance that other improvements and inventions, made after the issue of a patent, are often sought to be suppressed or appropriated by an unauthorized re-issue, has sometimes been referred to for the purpose of illustrating the evil consequences of granting such re-issues; but it adds nothing to their illegality." 37 O. G. 1002 (1003). For if, during his ignorance of the defects of his own patent, the patentee ascertains that others use, under a claim of right, that which is in reality the unprotected part of his invention, he must naturally regard them as infringers, whose tortious acts the law permits him to condone or punish at his pleasure. If a third party obtains a

part of the inventor, to exclude it from the operation of that

patent for what appears to be the same invention or one of its protected elements, without an interference with his patent, he may safely assume that the inventions are essentially distinct, and that no occasion for a vindication of his rights has been created. The conduct of other persons is thus without significance on this question except in connection with knowledge on the part of the patentee that his own patent needs amendment in order to protect his entire invention. But since when he attains this knowledge it is his duty to amend his patent without unreasonable delay if he would avoid the inference that the unprotected matter was at the outset intentionally excluded, whether or not third persons are using or have patented the unsecured invention, it is evident that their conduct can become important only when the reasonableness of his delay is to be determined. A period of inaction after the discovery of the defects in his patent, which might well be permitted were no antagonistic interests involved, would be wholly unwarrantable when other patentees or operators were claiming or enjoying the invention, and in proportion to the number and the value of such interests might greater degrees of diligence in applying for the re-issue be required.

If these views of the questions of delay and intervening rights are correct, the true doctrine in reference to both is this : that the Claims of a re-issue may be altered or enlarged to cover the entire invention which the patentee attempted to embrace in his original patent, provided he applies for a re-issue within such a period after he discovers or ought to have discovered the defect as is consistent with an original intention to protect the invention by his patent ; and that upon the consistency of this period of delay with such original

intention, the existence of antagonistic rights and interests in others is one important matter for consideration. That this is also the real doctrine of the cases in which the theory under discussion is set forth will be evident if the whole current of authority is examined, and the relation of each decision to those which it purports to follow as its guides is carefully traced.

Another theory, sometimes found in connection with the preceding is, that where the Claims of an original patent do not cover the entire invention, the defect is necessarily apparent to the patentee on an inspection of the patent, and hence that he is chargeable with notice of the error from the date of his reception of the patent. If this statement were to be regarded as a rule that no amendment by re-issue should be considered as an enlargement of the patent unless the error amended were apparent on the face of the original, the even balance of justice might not be thereby disturbed. But as the assertion of a fact it is not true. In the great majority of instances a failure to claim may be evident on inspection, but in many the nature of the invention may be so complicated, and its essential features so difficult of expression, that the patentee may fairly and honestly believe that he has embraced it in his Claims, while more mature experience or the subsequent decisions of the courts upon his patent may demonstrate his error. Upon the rule of law that when the discrepancy between the invention and the subject-matter of the Claims appears on an examination of the patent the patentee is chargeable with immediate knowledge and must pursue his remedy without delay, there can be no difference of opinion. But that in cases where the patentee does not discover, and with the employment of such vigi-

patent; and this evidence is regarded as conclusive upon him,

lance as the law requires of every assessor of a right could not discover, that his Claims were narrower than his invention, as he had attempted to secure it, it must be assumed either that he had notice at the issue of his patent, or that the correction of the Claims to make them correspond with the invention was not an enlargement, is alike unnecessary and inconsistent with the ordinary rules of law.

The two foregoing theories obtain especial prominence from their apparent recognition in the noted case of *Miller v. Brass Co.* (1881), 104 U. S. 350. Prior to the decision of this case the law of re-issue had been interpreted with great laxity in favor of patentees, and its application in many instances had been exceedingly abused. The Supreme Court availed itself of the opportunity afforded by this case to restore the administration of the law to its proper limits. It discovered and formulated no new principles, but simply reaffirmed the propositions that a re-issue cannot embrace new matter under any circumstances, nor any matter whose omission or misstatement in the original patent was intentional. But in its statement and explanation of these propositions the court labored under a peculiar embarrassment. The evil which it undertook to remedy was the enlargement of the Claims in a re-issue after individuals or the public had acted on the implied abandonment contained in the original. But as the law expressly conferred upon a patentee the right to claim in his re-issue any matter which he had attempted to describe and claim in the original patent, and which he had therein failed to claim through inadvertence, accident, or mistake, the Supreme Court could not repudiate or qualify this right. The question of identity was settled in favor of the pat-

entee, if the original patent disclosed the subject-matter of the re-issue, and at the same time the decision of the Commissioner that the original defect arose from accident, mistake, or inadvertence was regarded as conclusive; and thus no method of avoiding the re-issue, however flagrant the abuse, appeared without a resort to theories which though familiar to equity jurisprudence were hitherto unknown to Patent Law, except as casual *dicta*, uttered in cases upon whose decision they had exercised no influence. Had the Supreme Court asserted its judicial power to re-examine the question of original inadvertence, etc., as it is now beginning to be recognized, and had it announced the doctrine that an original intention to abandon is indicated by a failure to correct the omission or misstatement as soon as it is brought home to the knowledge of the patentee, its decision would have reached the desired result without producing those evils which are engendered by uncertainties in legal rules and by supposed departures from settled principles of law.

Starting from these two theories, several propositions have been formulated by the courts, — some a direct application of the theories to the facts in controversy, and others evidently based on a misunderstanding of the theories themselves. Thus certain cases state that a re-issue to enlarge Claims after long delay is not permissible, making no mention of the further necessary condition that delay cannot begin until the patentee becomes aware of the defect or is put upon inquiry which would result in knowledge. Among these are *Curran v. St. Louis Refrigerator & Wooden Gutter Co.* (1886), 39 O. G. 590; *Tubular Rivet Co. v. Copeland* (1886), 26 Fed. Rep. 706; 34 O. G. 1277; *White v. Dunbar* (1886), 119 U. S. 47; 37 O. G. 1002; *Asmus v. Alden* (1886), 27

unless he has corrected the omission by a re-issue without un-

Fed. Rep. 684 ; 36 O. G. 231 ; Hubel v. Dick (1886), 28 Fed. Rep. 656 ; 24 Blatch. 139 ; 37 O. G. 1480 ; Phillips v. Risser (1885), 26 Fed. Rep. 308 ; Electric Gas Lighting Co. v. Smith & Rhodes Electric Co. (1885), 23 Fed. Rep. 195 ; 31 O. G. 792 ; Holt v. Kendall (1885), 26 Fed. Rep. 622 ; 35 O. G. 874 ; Arden v. Jowett (1885), 32 O. G. 1241 ; Mahn v. Harwood (1884), 112 U. S. 354 ; 30 O. G. 657 ; Simon v. Neumann (1884), 27 O. G. 918 ; 20 Fed. Rep. 196 ; Vacuum Oil Co. v. Buffalo Lubricating Oil Co. (1884), 22 Blatch. 266 ; 28 O. G. 1101 ; 20 Fed. Rep. 850 ; Flower v. Detroit (1884), 22 Fed. Rep. 292 ; Hayes v. Bickelhaupt (1884), 29 O. G. 368 ; 21 Fed. Rep. 566 ; Turner & Seymour Mfg. Co. v. Dover Stamping Co. (1884), 111 U. S. 319 ; 27 O. G. 1131 ; *Ex parte* Flynn (1883), 23 O. G. 2029 ; Combined Patents Can Co. v. Lloyd (1882), 21 O. G. 713 ; 11 Fed. Rep. 149 ; 15 Phila. 481 ; *Ex parte* Lee (1882), 23 O. G. 342 ; Jones v. Barker (1882), 22 O. G. 771 ; 11 Fed. Rep. 597 ; Sheriff v. Fulton (1882), 22 O. G. 87 ; 12 Fed. Rep. 136.

In some cases the existence of intervening rights, either alone or coupled with delay, is treated as a bar to a re-issue, still without mention of the state of the patentee's knowledge concerning the defect to be amended, as for example, *Asmus v. Alden* (1886), 27 Fed. Rep. 684 ; 36 O. G. 231 ; *Hudnut v. Lafayette Hominy Mills* (1886), 26 Fed. Rep. 636 ; 35 O. G. 1338 ; *Newton v. Furst & Bradley Co.* (1886), 119 U. S. 373 ; 38 O. G. 104 ; *Baltimore Car Wheel Co. v. North Baltimore Passenger Ry. Co.* (1884), 21 Fed. Rep. 47 ; *Wooster v. Handy* (1884), 22 Blatch. 307 ; 21 Fed. Rep. 51 ; 28 O. G. 629 ; *Electric Gas Lighting Co. v. Tillotson* (1884), 22 Blatch. 481 ; 21 Fed. Rep.

568 ; *Flower v. Detroit* (1884), 22 Fed. Rep. 292 ; *Matthews v. Iron Clad Mfg. Co.* (1884), 22 Blatch. 427 ; 21 Fed. Rep. 641 ; 29 O. G. 693 ; *Turner & Seymour Mfg. Co. v. Dover Stamping Co.* (1883), 111 U. S. 319 ; 27 O. G. 1131 ; *Lansburgh v. Hasbrouck* (1883), 21 Blatch. 325 ; 16 Fed. Rep. 566.

Another class of cases may be found in which the judgment of the court is based on the union of one or more of the foregoing propositions with others which would be alone decisive of the controversy. Thus while it is true that new matter can never be claimed in a re-issue, that a re-issue can never be allowed except to cure an unintentional error, that features not disclosed in the original can never be inserted in the re-issue, that an invention once intentionally excluded can never be reclaimed, that the delay of a re-issue for an unreasonable time after the defect was discovered is conclusive evidence of such intentional exclusion, and that any one of these conditions is a complete bar to the allowance or enforcement of a re-issued patent, these cases combine such conditions with each other as if their concurrence were necessary to deprive the patentee of his asserted rights. Among these are the following :

That a re-issue including new matter after unreasonable delay is void, see *Clements v. Odorless Excavating Apparatus Co.* (1884), 109 U. S. 611 ; 26 O. G. 353.

That a re-issue after unreasonable delay cannot claim a new use, thus covering a new mode of use, and a Claim whose novelty rests on such mode of use is invalid, see *Gardner v. Herz* (1886), 118 U. S. 180 ; 35 O. G. 999.

That a re-issue containing new matter is void after eight or nine years, unless the same matter is in some way claimed in the original, see *Electric*

reasonable delay.² The error in this case, if any, consists in a

Gas Lighting Co. v. Smith & Rhodes Electric Co. (1885), 31 O. G. 792 ; 23 Fed. Rep. 195.

That no re-issue can be granted in order to enlarge a Claim unless there is a clear mistake in the wording of the Claim through inadvertence, and no unreasonable delay in applying for a re-issue, see Western Union Tel. Co. v. Baltimore & Ohio Tel. Co. (1885), 25 Fed. Rep. 30 ; Mahn v. Harwood (1884), 112 U. S. 354 ; 30 O. G. 657.

That matter described and intentionally omitted from the Claim is abandoned and cannot be covered by a re-issue, as against the intervening rights of the public, see Railway Register Mfg. Co. v. Broadway & Seventh Ave. R. R. Co. (1886), 26 Fed. Rep. 522 ; 31 O. G. 921.

That a re-issue cannot claim, after fourteen years, an improvement not noticed in the original patent, though it was invented before the original, see Sickels v. Falls Co. (1861), 2 Fisher, 202 ; 4 Blatch. 508.

That a patent for mechanism cannot re-issue eleven years afterward to cover the process, as the inventions are different, see Scrivner v. Oakland Gas Co. (1884), 22 Fed. Rep. 98 ; 10 Sawyer, 390.

That where the original patent describes *inter alia* a part of a machine but states no use for it and makes no claim to it, a re-issue to cover it is invalid, at least after three years, see Reay v. Raynor (1884), 22 Blatch. 13 ; 26 O. G. 1111 ; 19 Fed. Rep. 308.

That where the original patent is limited to a specific device no enlargement of its Claims can be permitted by re-issue after nine years' delay, see Sheriff v. Fulton (1882), 22 O. G. 87 ; 12 Fed. Rep. 136.

Examples of a contrary character in which the independence of these condi-

tions, and the sufficiency of each to prevent the allowance of a re-issue is asserted, may be found in the following : —

That diligence is of no consequence unless the re-issue is for the same invention as the original, see Ives v. Sargent (1887), 119 U. S. 652 ; 38 O. G. 781 ; Russell v. Laughlin (1886), 26 Fed. Rep. 699 ; 35 O. G. 1436 ; Coon v. Wilson (1885), 113 U. S. 268 ; 30 O. G. 889 ; Cowell v. Sessions (1883), 21 Blatch. 421 ; 17 Fed. Rep. 450.

That if the invention is not shown in the original patent there can be no re-issue at any time, see Hammond v. Franklin (1885), 23 Blatch. 77 ; 22 Fed. Rep. 833 ; 30 O. G. 1324.

In addition to the theories herein discussed there are several others which have from time to time found utterance from the bench in reference to this portion of the subject of re-issues. To notice each in detail would be needless. Most of them, if not all, are so far connected with those heretofore considered that it will require little acumen to detect their errors, and little deliberation to correct them. Understanding that no harmony is to be expected between unsound doctrines, and that the only true doctrine is that which fits all cases and distributes justice to all parties, the reader may compare the citations now to follow with each other and with the text, without danger of being misled by epigrammatic *dicta*, or by hastily conceived hypotheses.

² This proposition, be it remembered, is fully true only of cases in which clearly described matter is wholly omitted from the Claims. It is partially true in many cases where the matter has been misstated in the Claims. In those cases of misstatement where the Claim is open to several constructions, some of which would include and others

direct repugnance between the two parts of his specification,

exclude the matter in question, it is, however, false; for here only judicial interpretation can finally determine the real scope of the Claim. Hence the ordinary treatment of omissions and misstatements, as if all stood on equal ground and were to be governed by the same rule, is not correct. To enlarge a Claim by inserting matter which it never before contained or appeared to contain is one thing; to enlarge it by amending a misstatement is quite another. The extracts which follow do not, unfortunately, preserve this distinction, but the mere suggestion that it exists will be sufficient to guard the reader against extending the doctrine of these cases beyond its proper scope, whatever language the judges have seen fit to employ.

In *Wollensak v. Reiher* (1885), 115 U. S. 96, Matthews, J. : (99) "It follows from this that if at the date of the issue of the original patent, the patentee had been conscious of the nature and extent of his invention, an inspection of the patent, when issued, and an examination of its terms, made with that reasonable degree of care which is habitual to and expected of men in the management of their own interests in the ordinary affairs of life, would have immediately informed him that the patent had failed fully to cover the area of his invention. And this must be deemed to be notice to him of the fact, for the law imputes knowledge when opportunity and interest, combined with reasonable care, would necessarily impart it. Not to improve such opportunity under the stimulus of self-interest, with reasonable diligence, constitutes laches, which in equity disables the party who seeks to revive a right which he has allowed to lie unclaimed from enforcing it to the detriment of those who have, in consequence, been led to act as

though it were abandoned. This general doctrine of equity was applied with great distinctness to the correction of alleged mistakes in patents by re-issues in the case of *Miller v. Brass Company*, 104 U. S. 350. It was there declared that where the mistake suggested was merely that the Claim was not as broad as it might have been, it was apparent upon the first inspection of the patent, and, if any correction was desired, it should have been applied for immediately; that the granting of a re-issue for such a purpose, after an unreasonable delay, is clearly an abuse of the power to grant re-issues, and may justly be declared illegal and void; that, in reference to re-issues made for the purpose of enlarging the scope of the patent, the rule of laches should be strictly applied, and no one should be relieved who has slept upon his rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent; and that when this is a matter apparent on the face of the instrument, upon a mere comparison of the original patent with the re-issue, it is competent for the courts to decide whether the delay was unreasonable and whether the re-issue was, therefore, contrary to law and void." 31 O. G. 1301 (1302). *Quere*, whether *Miller v. Brass Co.* does declare that "where the mistake suggested was merely that the Claim was not as broad as it might have been, it was apparent upon the first inspection of the patent?" The author does not so understand the language of Mr. Justice Bradley in that decision. In one part of the opinion he states that in the case at bar the defect was apparent on the first inspection of the patent; and in another portion lays down the general rule that "when, if a Claim is too narrow, — that is, if it does not contain all that the patentee is entitled

and though it might occur through inadvertence, accident, or

to — the defect is apparent on the face of the patent, . . . there can be no valid excuse for delay," etc. But this latter assertion is very far from a declaration that "when Claims are too narrow the defect is apparent on the face of the patent." The construction put by *Wollensak v. Reiher* on this language has sometimes been turned into the rule that when Claims are too narrow the patentee is chargeable with notice of that fact the moment the patent issues, — a rule pregnant with mischief and manifestly contrary to reason and justice. See also *Hoskin v. Fisher* (1888), 125 U. S. 217 ; 43 O. G. 509.

In *Wollensak v. Reiher* (1884), 22 Fed. Rep. 651, Gresham, J. : (652) "When an inventor receives his patent, it is his duty to examine it promptly, see that his invention is properly described, and that his Claims are broad enough to embrace it in all its scope. If, upon a more reading of his patent, it is obvious that he is entitled to a re-issue with broader and more comprehensive Claims, he must make his application speedily. Failure to do this is a dedication to the public of so much of his invention as is not covered by his Claim. The rule of laches is strictly applied in such cases."

In *Mahn v. Harwood* (1884), 112 U. S. 354, Bradley, J. : (360) "The taking out of a patent which has (as the law requires it to have) a specific Claim, is notice to all the world, of the most public and solemn kind, that all those parts of the art, machine, or manufacture set out and described in the specification and not embraced in such specific Claim, are not claimed by the patentee, — at least not claimed in and by that patent. If he has a distinct patent for other parts, or has made application therefor, or has reserved the right to make such application, that is

another matter, not affecting the patent in question. But so far as that patent is concerned, the Claim actually made operates in law as a disclaimer of what is not claimed ; and of all this the law charges the patentee with the fullest notice. Then, what is the situation ? The public is notified and informed, by the most solemn act on the part of the patentee, that his Claim to invention is for such and such an element or combination, and for nothing more. Of course what is not claimed is public property. The presumption is, and such is generally the fact, that what is not claimed was not invented by the patentee, but was known and used before he made his invention. But, whether so or not, his own act has made it public property if it was not so before. The patent itself, as soon as it is issued, is the evidence of this. The public has the undoubted right to use, and it is to be presumed does use, what is not specifically claimed in the patent. Every day that passes after the issue of the patent adds to the strength of this right, and increases the barrier against subsequent expansion of the claim by re-issue under a pretence of inadvertence and mistake." 30 O. G. 657 (659).

In *Miller v. Brass Co.* (1881), 104 U. S. 350, Bradley, J. : (352) "But it must be remembered that the Claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent are, in law, a dedication to the public of that which is not claimed. It is a declaration that that which is not claimed is either not the patentee's invention, or, if his, he dedicates it to the public. This legal effect of the patent cannot be revoked unless the patentee surrenders it and proves that the specification was framed by real inadvertence, accident, or mistake,

mistake, it could not fail to become apparent on inspection

without any fraudulent or deceptive intention on his part; and this should be done with all due diligence and speed. Any unnecessary laches or delay in a matter thus apparent on the record affects the right to alter or re-issue the patent for such cause. If two years' public enjoyment of an invention with the consent and allowance of the inventor is evidence of abandonment, and a bar to an application for a patent, a public disclaimer in the patent itself should be construed equally favorable to the public. Nothing but a clear mistake or inadvertence, and a speedy application for its correction, is admissible when it is sought merely to enlarge the Claim." 21 O. G. 201 (202).

In *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 18 O. G. 1339, Field, J.: (1340) "The statute authorizing a re-issue was intended to protect against accidents and mistakes, and it is only when thus restricted that it can be regarded as a beneficial statute. If a patentee does not embrace by his specifications and Claim all that he might have done, and there has been no clear mistake, inadvertence, or accident in their preparation, the presumption of law is that he has abandoned to the use of the public everything outside of them, or at least has postponed any additional Claim for further consideration." 6 Sawyer, 508 (522); 4 Fed. Rep. 720 (725).

Further, that no re-issue can be allowed to claim matter clearly described in the original patent but evidently omitted from its Claims, unless the re-issue is applied for within a reasonable time after the grant of the original, see *Ives v. Sargent* (1887), 119 U. S. 652; 38 O. G. 781; *Gage v. Kellogg* (1885), 23 Fed. Rep. 891; 32 O. G. 381; *Reed v. Chase* (1885), 25 Fed. Rep. 94; 33 O. G. 996; *Wooster v. Handy* (1884),

22 Blatch. 307; 21 Fed. Rep. 51; 28 O. G. 629; *Scrivner v. Oakland Gas Co.* (1884), 22 Fed. Rep. 98; 10 Sawyer, 390; *Ives v. Sargent* (1883), 17 Fed. Rep. 447; 21 Blatch. 417; *Combined Patents Can Co. v. Lloyd* (1882), 11 Fed. Rep. 149; 21 O. G. 713; 15 Phila. 481; *Streit v. Lauter* (1882), 11 Fed. Rep. 309; *Holt v. Keeler* (1882), 22 O. G. 1201; 13 Fed. Rep. 464; 21 Blatch. 68; *Hayes v. Seton* (1882), 20 Blatch. 484; 12 Fed. Rep. 120.

That an omission to claim matter evidently belonging to the invention is abandonment, unless the patent is amended by re-issue without delay, see *Hill v. Commissioner* (1885), 4 Mackey, 266; 33 O. G. 757; *Ex parte Conklin* (1874), 5 O. G. 235; 1 MacArthur, 375.

That unnecessary delay in re-issuing is acquiescence in the patent as allowed, and an abandonment of the rest of the invention, see *Ex parte Flynn* (1883), 23 O. G. 2029; *Hayes v. Seton* (1882), 20 Blatch. 484; 12 Fed. Rep. 120.

That delay in re-issuing shows original abandonment, see *Tuttle v. Loomis* (1885), 24 Fed. Rep. 789; 30 O. G. 344.

That any long delay in applying for a re-issue raises a presumption against "mistake and inadvertence," see *Newton v. Furst & Bradley Mfg. Co.* (1882), 14 Fed. Rep. 465; 11 Bissell, 405.

That the greater the discrepancy the shorter should be the time, see *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657.

That where a combination-patent fails to claim a sub-combination, the error is an evident one, and the right to the protection of the sub-combination will be abandoned by delay, see *Gage v. Herring* (1883), 107 U. S. 640; 23 O. G. 2119; *Bantz v. Frantz* (1882), 105 U. S. 160; 21 O. G. 2037.

That a re-issue cannot cover a process

of the patent, if examined by the patentee with ordinary care.⁸

after nine years' use of the devices claimed in the original, when the process consists in the use of such devices, see *Brainard v. Crammo* (1882), 22 O. G. 769; 12 Fed. Rep. 621; 20 Blatch. 530.

That the presumption of intentional exclusion from a failure to claim clearly described matter is *prima facie* only, until an unreasonable delay in amending the patent renders such presumption conclusive, appears from the following decisions:—

That a thing not claimed in the original patent is not thereby abandoned *ipso facto* to the public, and may be claimed in a re-issue, see *Selden v. Stockwell Self-Lighting Gas Burner Co.* (1881), 19 Blatch. 544; 20 O. G. 1377; 9 Fed. Rep. 390.

That there is no conclusive presumption, from the absence of Claims from the original covering the matters claimed in the re-issue, that the inventor did not intend to claim them in the original, see *Eickmeyer Hat Blocking Mach. Co. v. Pearce* (1873), 6 Fisher, 219; 3 O. G. 150; 10 Blatch. 403.

That things described but not claimed in the original patent are not thereby abandoned and may be claimed in the re-issue, though they have gone into use, see *Ex parte Conklin* (1872), 2 O. G. 541.

⁸ In *Miller v. Brass Co.* (1881), 104 U. S. 350, Bradley, J.: (351) "It is manifest on the face of the patent, when compared with the original, that the suggestion of inadvertence and mistake in the specification was a mere pretence; or if not a pretence, the mistake was so obvious as to be instantly discernible on opening the letters-patent, and the right to have it corrected was abandoned and lost by unreasonable delay. The only mistake suggested is, that the Claim was not as broad as it might have been. This mistake, if it was a mistake, was apparent upon the first in-

spection of the patent, and if any correction was desired, it should have been applied for immediately." 21 O. G. 201 (201).

That if the inventor clearly perceives the nature of his invention he ought to be able to see whether his Claims protect it, see *Wollensak v. Reiher* (1885), 115 U. S. 96; 31 O. G. 1301. This seems to assume that if an idea is clearly perceived by the mind it can always be so expressed in words as to infallibly present to other minds precisely the same idea, — which is not true, especially in reference to conceptions in science and art. An inventor may believe that his Claims exactly cover his invention, but it does not follow that the judicial mind will arrive at the same conclusion.

That a delay in re-issuing to enlarge Claims is unreasonable if more time is taken than is needed to read the Claims and ascertain the necessity for their correction, see *Hartshorn v. Eagle Shade Roller Co.* (1883), 18 Fed. Rep. 90; 25 O. G. 1191.

That a patentee must examine his patent to see if it covers his invention, and three years' delay in so doing is unreasonable, and a re-issue then is invalid, if the defect is clear, see *Ives v. Sargent* (1886), 119 U. S. 652; 38 O. G. 781.

That where the omission to claim described matter is clear to intelligent persons, but the patentee and assignee were ignorant of it for want of using their means of knowledge, they are chargeable with laches, and if there is any delay in the re-issue, their right is forfeited, see *Ives v. Sargent* (1883), 21 Blatch. 417; 17 Fed. Rep. 447.

That a patentee is chargeable with notice of what the patent contains and is held to reasonable diligence, see *Western Union Tel. Co. v. Baltimore & Ohio Tel. Co.* (1885), 25 Fed. Rep. 30.

That ignorance of law is no excuse

The matter omitted from the Claims being so described in the specification as to place it fully before the public, they have a right to presume that the inventor intended to abandon it altogether, or to withhold it as the subject of a future patent. Under the law, as it existed before re-issues were allowed, such an omission would have operated as an irrevocable dedication of the unclaimed matter to the public, the original patent being unamendable, and the law permitting no new patent for an invention already publicly disclosed. Under the present law, however, these presumptions may be rebutted either by an application for a new patent for the omitted matter before two years of public use or sale have elapsed, or by a timely re-issue of the original patent. In the first case, the new application is independent of the former patent, and must be granted or denied on its own merits. In the second case, the re-issue is invalid when the duration of the period of delay is inconsistent with the idea of an original inadvertence, accident, or mistake.⁴ Upon this question of

for delay in a re-issue, see *Haines v. Peck* (1886), 26 Fed. Rep. 625 ; 35 O. G. 1227.

That a want of knowledge of the language is considered on the question of delay, see *Stutz v. Armstrong* (1884), 28 O. G. 367 ; 20 Fed. Rep. 843 ; *contra*, *Boland v. Thompson* (1886), 23 Blatch. 440 ; 26 Fed. Rep. 633 ; 35 O. G. 1113.

⁴ In *Miller v. Brass Co.* (1881), 104 U. S. 350, Bradley, J. : (355) " Now whilst, as before stated, we do not deny that a Claim may be enlarged in a re-issued patent, we are of opinion that this can only be done when an actual mistake has occurred ; not from a mere error of judgment (for that may be rectified by appeal), but a real *bona fide* mistake, inadvertently committed ; such as a court of chancery, in cases within its ordinary jurisdiction, would correct. Re-issues for the enlargement of Claims should be the exception and not the rule. And when, if a Claim is too narrow, — that is, if it does not contain

all that the patentee is entitled to, — the defect is apparent on the face of the patent, and can be discovered as soon as that document is taken out of its envelope and opened, there can be no valid excuse for delay in asking to have it corrected. Every independent inventor, every mechanic, every citizen, is affected by such delay, and by the issue of a new patent with a broader and more comprehensive Claim. The granting of a re-issue for such a purpose, after an unreasonable delay, is clearly an abuse of the power to grant re-issues, and may justly be declared illegal and void. It will not do for the patentee to wait until other inventors have produced new forms of improvement, and then, with the new light thus acquired, under pretence of inadvertence and mistake, apply for such an enlargement of his Claim as to make it embrace these new forms. Such a process of expansion carried on indefinitely, without regard to lapse of time, would operate most unjustly against the public, and is totally unauthorized by

delay the courts or the Patent Office must decide in view of all the circumstances of the case itself. No unbending rule can be established limiting the time when such amendments must be made.⁵ Analogy seems to require that no

the law. In such a case, even he who has rights, and sleeps upon them, justly loses them. The correction of a patent by means of a re-issue, where it is invalid or inoperative for want of a full and clear description of the invention, cannot be attended with such injurious results as follow from the enlargement of the Claim. And hence a re-issue may be proper in such cases, though a longer period has elapsed since the issue of the original patent. But in reference to re-issues made for the purpose of enlarging the scope of the patent, the rule of laches should be strictly applied; and no one should be relieved who has slept upon his rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent. And when this is a matter apparent on the face of the instrument, upon a mere comparison of the original patent with the re-issue, it is competent for the courts to decide whether the delay was unreasonable, and whether the re-issue was therefore contrary to law and void." 21 O. G. 201 (203).

See also *Hartshorn v. Eagle Shade Roller Co.* (1883), 25 O. G. 1191; 18 Fed. Rep. 90.

⁵ In *Mahn v. Harwood* (1884), 112 U. S. 354, Bradley, J. : (363) "As we have already stated, no invariable rule can be laid down as to what is reasonable time within which the patentee should seek for the correction of a Claim which he considers too narrow. In *Miller v. The Brass Company*, by analogy to the law of public use before an application for a patent, we suggested that a delay of two years in applying for such correction should be construed equally favorable to the public. But this was a mere suggestion by the way,

and was not intended to lay down any general rule. Nevertheless, the analogy is an apposite one, and we think that excuse for any longer delay than that should be made manifest by the special circumstances of the case." 30 O. G. 657 (659).

In *Stutz v. Armstrong* (1884), 20 Fed. Rep. 843, Acheson, J. : (845) "The Supreme Court has laid down no unbending rule by which to determine what is unreasonable delay in applying for the correction of such a mistake as existed here; and it seems to me that each case must be decided upon its special facts and merits. The application here was within two years after the grant of the original letters-patent; the exact lapse of time being one year, ten months, and eight days. Now, while this fact may not be conclusive, it would seem to be entitled to some consideration, in view of that provision of the Patent Laws by which nothing less than two full years' public use of an invention is a bar to an application for a patent. In *Miller v. Brass Co.*, the fact that much more than two years had elapsed between the grant of the original letters-patent and the application for the re-issue was evidently in the mind of Mr. Justice Bradley, and suggested the illustration employed by him on page 352 of the reported case. And in all the like cases in which the Supreme Court has ruled against the validity of the re-issue (so far as I know), the lapse of time has been greatly in excess of two years." 28 O. G. 367 (368).

That no fixed rule determines reasonable time see *Odell v. Stout* (1884), 22 Fed. Rep. 159; 29 O. G. 862.

That reasonable time depends on cir-

longer period should be allowed than that within which a new patent might be issued, and that after two years of public use and sale of the omitted matter its abandonment should be conclusively presumed. But in many instances even this period cannot be properly allowed.⁶ Where the practical importance and commercial value of the omitted matter is evident from the beginning, and where the inventor, therefore, must have known that in its original form the patent did not give him the complete protection which he needed to render all the fruits of his inventive skill available to him, any avoidable delay in the correction of the error is irreconcilable with the hypothesis that the omitted matter was unintentionally excluded. And on the other hand, where the unclaimed invention was not recognized as of material consequence until it had been tested by experience, or where no probability of adverse claims existed, or where the inventor might reasonably have supposed that his original patent would secure to him all that was really valuable in his invention, a delay of some duration is not incompatible with the idea of accident, inadvertence, or mistake in the original omission.⁷ As in all

cumstances, see *Western Union Tel. Co. v. Baltimore & Ohio Tel. Co.* (1885), 25 Fed. Rep. 30.

⁶ That two years is the usual limit for delay, see *Ex parte Flynn* (1883), 23 O. G. 2029.

That two years is in some cases a reasonable time, but not always, see *Mahn v. Harwood* (1884), 112 U. S. 354 ; 30 O. G. 657.

That an excuse for a delay longer than two years must be clearly shown, see *Ives v. Sargent* (1887), 119 U. S. 652 ; 38 O. G. 781.

That where the Claim of the original is clear and its scope plain, nine years' delay is unreasonable, see *Shirley v. Mayer* (1885), 23 Blatch. 249 ; 25 Fed. Rep. 38 ; 34 O. G. 1391.

That where the error, if any, is apparent and the articles claimed in the re-issue have gone into market, twenty-two months is too long a delay, see *Arn-*

heim v. Finster (1886), 26 Fed. Rep. 277 ; 34 O. G. 700.

That a delay of three months in applying for a re-issue is unreasonable when the defect is clear and other claimants intervene, if the only object is to enlarge the original Claims, see *Coon v. Wilson* (1885), 113 U. S. 268 ; 30 O. G. 889.

That a re-issue enlarging Claims within three months is in time, if no rights of others intervene, see *Hammond v. Franklin* (1885), 23 Blatch. 77 ; 22 Fed. Rep. 833 ; 30 O. G. 1324.

That a re-issue in two months is not laches, see *Russell v. Laughlin* (1886), 26 Fed. Rep. 699 ; 35 O. G. 1436.

That a few months' delay is of no consequence, see *Dryfoos v. Wiese* (1884), 22 Blatch. 19 ; 26 O. G. 639 ; 19 Fed. Rep. 315.

⁷ That the question of adverse intervening rights is usually embraced in

other cases where the questions of due diligence or reasonable time are involved, the conduct of the inventor is subject to the interpretation of the courts, and he must abide by their decision whatever may have been his own views as to the reasonableness of his delay.⁸ His delay having been judicially determined to be unreasonable, the inference that he originally intended to exclude the omitted matter from his patent becomes inevitable, and the re-issue cannot be sustained.

that of delay, see *Stutz v. Armstrong* (1884), 28 O. G. 367; 20 Fed. Rep. 843.

That the question whether adverse rights have arisen since the original patent was granted is always important on a re-issue, in reference to the claim of abandonment, see *Stutz v. Armstrong* (1884), 20 Fed. Rep. 843; 28 O. G. 367; *Brainard v. Cramme* (1882), 12 Fed. Rep. 621; 22 O. G. 769; 20 Blatch. 530.

That a patent for a combination issued in 1860, not claiming the sub-combinations, and re-issued in 1876 to cover them after the sub-combinations had been in use by others more than two years, is void for delay, see *Turrell v. Bradford* (1883), 21 Blatch. 284; 23 O. G. 1623; 15 Fed. Rep. 808.

That if sub-combinations are described in the original they may be claimed in the re-issue where there is no unnecessary delay and no injury to intervening rights, see *Hubel v. Dick* (1886), 28 Fed. Rep. 132; 36 O. G. 939; 24 Blatch. 59.

That where delays work an equitable estoppel it is in favor of the public, see *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.* (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That an unavoidable delay in applying for a re-issue does not work an

abandonment, see *Hartshorn v. Eagle Shade Roller Co.* (1883), 18 Fed. Rep. 90; 25 O. G. 1191.

⁸ In *Mahn v. Harwood* (1884), 112 U. S. 354, Bradley, J.: (360) "Conceding that it is for the Commissioner of Patents to determine whether the insertion of too narrow a Claim arose from inadvertence, accident, or mistake (unless where the matter is manifest from the record), the question whether the application for correction and re-issue is or is not made within reasonable time is, in most if not all of such cases, a question which the court can determine as a question of law, by comparing the patent itself with the original patent, and, if necessary, with the record of its inception. The reason for this was fully explained in the case of *Miller v. The Brass Company.*" 30 O. G. 657 (659).

See also *Western Union Tel. Co. v. Baltimore & Ohio Tel. Co.* (1885), 25 Fed. Rep. 30; *Wooster v. Handy* (1884), 28 O. G. 629; 22 Blatch. 307; 21 Fed. Rep. 51; *Miller v. Brass Co.* (1882), 104 U. S. 350; 21 O. G. 201.

That an apparently unreasonable delay in applying for a re-issue renders it invalid, unless the patentee explains the delay by proper evidence, see *Hoskin v. Fisher* (1888), 125 U. S. 217; 43 O. G. 509.

§ 691. Intentional Exclusion not Shown by Failure to Claim Matter not Clearly Described in the Original Patent unless the Defects are Brought to the Knowledge of the Patentee, and he thereafter Unreasonably Delays their Amendment.

An omission from the Claims of the original patent of some feature of the invention, or of some subordinate or dependent invention, which is simply indicated or suggested but not clearly described in the original specification, or a defective statement in the Claims of the original which is consistent with an intention to protect the subject-matter claimed in the re-issue, raises no presumption of intentional exclusion. Such a misstatement or omission is not evident to the inventor upon a mere inspection of the patent, nor does the description so disclose the omitted matter to the public as to warrant any supposition that he has dedicated it to public use. Not until circumstances occur by which his attention is directed to the error, and he becomes aware that his entire invention is not covered by his patent, is he chargeable with negligence in the assertion of his rights.¹ But whenever and by whatever means this knowledge is communicated to him, his obligation to amend his Claims, and so far as necessary his description also, at once arises, and his failure to do this within a reasonable time is sufficient evidence that the original omission did

§ 691. ¹ In *Tuttle v. Loomis* (1885), 24 Fed. Rep. 789, Wallace, J. : (789) "Whether he described in his original patent just the invention he supposed he had made, or whether his invention was really a broader one than he himself supposed it to be, when it became apparent that the real invention was unduly restricted and narrowed by the description, he was entitled to a re-issue if the error arose from inadvertence, accident, or mistake." 30 O. G. 344 (345).

That a mistake not discoverable till after several years may then be corrected, see *Hartshorn v. Eagle Shade Roller Co.* (1883), 18 Fed. Rep. 90 ; 25 O. G. 1191 ; *Poppenhusen v. Falke* (1862), 5 Blatch. 46 ; 2 Fisher, 213.

That a re-issue cannot expand a Claim after eight years except in very peculiar circumstances, see *Tuttle v. Loomis* (1885), 24 Fed. Rep. 789 ; 30 O. G. 344.

That a patentee is always presumed to know what, if vigilant, he could have known, see *Arnheim v. Finster* (1886), 26 Fed. Rep. 277 ; 34 O. G. 700 ; *Ives v. Sargent* (1883), 17 Fed. Rep. 447 ; 21 Blatch. 417.

That to move with alacrity after he discovers the defect does not satisfy the rule, if by due diligence it might have been known earlier, see *Ives v. Sargent* (1883), 21 Blatch. 417 ; 17 Fed. Rep. 447.

not result from any inadvertence, accident, or mistake.² Thus where the omitted matter has actually gone into public use,³ or where another inventor has applied for and obtained a patent which distinctly claims it,⁴ or where the courts interpreting his patent have decided that it does not embrace this feature or subordinate invention,⁵ the inventor may be presumed to

² That upon the discovery of the defect the patentee must act with reasonable diligence or a re-issue cannot be allowed, see *Pope Mfg. Co. v. Marqua* (1883), 15 Fed. Rep. 400; *Turrell v. Bradford* (1883), 15 Fed. Rep. 808; 23 O. G. 1623; 21 Blatch. 284; *Washburn & Moen Mfg. Co. v. Fuchs* (1883), 5 McCrary, 236; 16 Fed. Rep. 661; *Steam Gauge & Lantern Co. v. Miller* (1882), 11 Fed. Rep. 718; *Matthews v. Boston Mach. Co.* (1882), 105 U. S. 54; 21 O. G. 1349; *Sheriff v. Fulton* (1882), 12 Fed. Rep. 136; 22 O. G. 87; *Bantz v. Frantz* (1881), 105 U. S. 160; 21 O. G. 2037; *Johnson v. R. R. Co.* (1881), 105 U. S. 539; 22 O. G. 329; *Miller v. Brass Co.* (1881), 104 U. S. 350; 21 O. G. 201; *In re Conklin* (1874), 5 O. G. 235; 1 MacArthur, 375; *Knight v. Baltimore & Ohio R. R. Co.* (1840), 3 Fisher, 1; Taney, 106.

³ That where matters have been described but not claimed in the original patent, and have gone into use by others, they cannot be claimed in a re-issue after unreasonable delay, see *Wooster v. Handy* (1884), 28 O. G. 629; 22 Blatch. 307; 21 Fed. Rep. 51; *Brainard v. Cramme* (1882), 12 Fed. Rep. 621; 20 Blatch. 530; 22 O. G. 769.

That where an invention has been in use for fifteen years, an original patent cannot be re-issued to cover it, even in favor of the real inventor, but it must be regarded as abandoned, see *Johnson v. R. R. Co.* (1882), 105 U. S. 539; 22 O. G. 329.

That the use of the "new matter," before the original application was filed,

shows that its omission from the application was intentional and was abandonment, see *In re Conklin* (1874), 1 MacArthur, 375; 5 O. G. 235.

That the mode in which the discovery of a mistake in the original was made does not affect the re-issue, see *Poppenhusen v. Falke* (1861), 4 Blatch. 493; 2 Fisher, 181.

⁴ That a re-issue to enlarge Claims, and embrace a new invention which has been patented since the original patent, is not allowable after unreasonable delay, see *Torrent Arms Lumber Co. v. Rodgers* (1884), 112 U. S. 659; 30 O. G. 449.

⁵ In *Poppenhusen v. Falke* (1862), 5 Blatch. 46, Shipman, J. : (53) "It not unfrequently happens that a judicial interpretation of the specification or Claim of a patent, or of both, discloses to the inventor and patentee, for the first time, the defects in the instrument, and shows him that he has unwittingly restricted his rights within narrower limits than his discovery, or has so inartificially described his invention that he has failed to secure any substantial advantage by it. Such a disclosure furnishes a proper occasion for a surrender and re-issue, when the error was inadvertent, and is clearly within the beneficent design of the statute. The judicial mind gives a legal construction to the language of the instrument, and this construction may reveal the fact that the terms used failed to cover the invention. To hold that the inventor should not be allowed to re-state his Claims by the use of new terms, would defeat the object of

have sufficient notice of the defect to make his continued acquiescence in it a conclusive admission that his patent, in its original condition, truly represented and covered the entire invention which he undertook to claim. Concerning the period within which the amendment must be made after such notice can be fairly imputed to the inventor, there is no other rule than that of reasonable time, to be determined by the courts from all the circumstances of the case. Any avoidable delay may prevent him from obtaining a re-issue, not by forfeiting a privilege once possessed, but by proving such an original intentional exclusion that the right to a re-issue could never have existed.⁶

§ 692. Intentional Exclusion not Shown by Mere Delay Alone in the Amendment.

An intention to exclude from the original patent the patentable matter suggested in its description but omitted from its Claims is never inferred from mere delay alone. The

the law, and abridge or strangle the inventor's rights, by reason of the imperfect language in which he had attempted to clothe his discovery." 2 Fisher, 213 (220).

⁶ In *Mahn v. Harwood* (1884), 112 U. S. 354, Bradley, J. : (361) "If any such inadvertence or mistake has really occurred, it is generally easily discernible by an inspection of the patent itself; and any unreasonable delay in applying to have it corrected by a surrender and re-issue is a just bar to such correction. If the specification is complicated and the Claim is ambiguous or involved, the patentee may be entitled to greater indulgence; and of this the court can rightfully judge in each case. No precise limit of time can be fixed and laid down for all cases. The courts will always exercise a proper liberality in favor of the patentee. But in any case, by such delay as the court may deem unnecessary and unreasonable, the right to a re-issue will be regarded as having been abandoned and lost, and

the Commissioner will be held to have exceeded his authority in granting it. Whenever it is manifest from the patent itself, compared with the original patent and cognate documents of record, or from the facts developed in the case, that the Commissioner must have disregarded the rules of law by which his authority to grant a re-issue in such cases is governed, the patent will be considered as void to the extent of such illegality. It is then a question of law, not a question of fact." 30 O. G. 657 (659).

That delay in a re-issue may be explained, see *Wollensak v. Reiher* (1885), 115 U. S. 96; 31 O. G. 1301; *Singer Mfg. Co. v. Goodrich* (1883), 15 Fed. Rep. 455.

That the courts will not assume, without proof, that a re-issue after fourteen years' delay enlarges the original or was sought for that purpose, see *Clark v. Wooster* (1886), 119 U. S. 322; 37 O. G. 1477.

lapse of time, unaccompanied by circumstances from which a purpose to omit what might have been claimed is presumed, cannot affect the right of the inventor to a re-issue of his patent, and to the correction of any error in the description or the Claim that may be necessary to secure the invention which he attempted to protect by his original patent.¹ The amendment of defects occurring through accident, mistake, or inadvertence, and without fraud, may therefore be made at any time when the error is discovered or the amendment may become desirable, provided the amendment does not introduce into the patent any invention not substantially indicated by the original specification.² A patent may thus be

§ 692. ¹ In *Hussey v. Bradley* (1863), 2 Fisher, 362, Hall, J. : (378) " We cannot say, as matter of law, that these re-issues were too late, nor is there any proof of fraud or laches upon which we can, on that ground, declare these re-issued patents void. A re-issue has been upheld when the surrender was made more than sixteen years after the first patent was issued (*Gibson v. Harris*, 1 Blatch. 167), and it was there said that a patent which had been extended to twenty-one years under the general law, and afterward extended to twenty-eight years by special act of Congress, might be surrendered and re-issued after the term of twenty-one years had expired. And see *Woodworth v. Edwards*, 3 W. & M. 120 ; *French v. Rogers*, and *Goodyear v. Day*, Secs. 27-32, Law's Digest, 614, 615 (vol. i. p. 133). The fact that a portion of these inventions was not claimed in the original patent we have already shown does not defeat the present claims of the patentee, and that even a disclaimer in the original patent of an invention claimed in a re-issued one is not, without other proof, enough to avoid the re-issued patent. *Ex parte Hayden*, and *Laidly v. James*. It is true that in the case of *Batten v. Taggart*, 2 Wall. Jr. 102, Judge Kane decided that if a pat-

entee neglects in his specification to assert his invention as to a certain part, omits to claim specifically such part, and suffers his patent so to stand for a number of years, he cannot afterward surrender his patent and take a re-issue claiming such part, as the use under the former patent, without any claim, will be a dedication to the public ; but this decision was overruled by the Supreme Court of the United States in the same case, 17 How. 85, and the cases to which we have already referred are, we think sufficient to show that we cannot, after the action of the Commissioner of Patents in respect to these patents, and without other proof, hold that there has been any abandonment or dedication to the public of the inventions claimed in these re-issued patents." 5 Blatch. 134 (148).

² That a re-issue after a delay of thirteen years is not too late, if the original was defective through a mistake and the re-issue was necessary to cure it, see *Newton v. Furst & Bradley Mfg. Co.* (1882), 11 Bissell, 405 ; 14 Fed. Rep. 465.

That no part of the invention originally described becomes dedicated to the public by lapse of time, but may be always claimed in a re-issue, see *Battin v. Taggart* (1854), 17 How. 74.

re-issued either during its original term, or during an extension regularly allowed by the Patent Office, or during an additional extension granted by a special act of Congress.³

§ 693. Fourth Proposition: Amendment by Re-issue, when Allowable, may be Made in Any Form and to Any Extent Necessary to Secure the Actual Invention.

The fourth proposition, -- that when an amendment by re-issue is allowable it can be made in any form and to any extent that may be necessary to render the patent effective for the original invention, -- is evident from the nature and object of the amendment itself. The former patent being invalid and affording no protection, or being inoperative and affording less protection than the inventor had a right to claim, the re-issued patent is substituted for it in order that a patent, valid and operative for the entire invention attempted to be covered by the original patent, may exist in favor of the inventor.¹ Whatever is required for the attainment of this object may, therefore, be performed by the re-issue. Not only may the language of the specification be indefinitely varied, but new Claims may be added, or the old may be divided and restated, within any limits not embracing patentable matter which is absent from the original description.² If one re-

³ That an extended patent can be re-issued, see *Ex parte Sexton* (1876), 9 O. G. 251; *Wilson v. Rousseau* (1846), 4 How. 646; 2 Robb, 372.

That a patent granted or extended under a special act may be re-issued like an ordinary patent, see *Page v. Holmes Burglar Alarm Telegraph Co.* (1880), 17 O. G. 737; 17 Blatch. 484; 1 Fed. Rep. 304; 5 Bann. & A. 165; *Hussey v. Bradley* (1863), 2 Fisher, 362; 5 Blatch. 134; *Gibson v. Harris* (1846), 1 Blatch. 167.

§ 693. ¹ That if the first patent is defective a good one may be obtained, see *Treadwell v. Bladen* (1827), 4 Wash. 703; 1 Robb, 531.

² That it is the office of a re-issue to make a defective specification clear and a defective Claim sufficient, see *Russell*

v. Dodge (1876), 93 U. S. 460; 11 O. G. 151; *Aultman v. Holley* (1873), 6 Fisher, 534; 11 Blatch. 317; 5 O. G. 3; *Sarven v. Hall* (1872), 5 Fisher, 415; 9 Blatch. 524; 1 O. G. 437.

That a re-issue may contain new Claims based on the old specification, if such Claims were omitted by mistake, and if the patentee has not been estopped to amend, see *Combined Patents Can Co. v. Lloyd* (1882), 21 O. G. 713; 11 Fed. Rep. 149; 15 Phila. 481; *Swift v. Whisen* (1867), 2 Bond, 115; 3 Fisher, 343.

That the Claims may be enlarged in a re-issue if the invention is the same, see *Jones v. Barker* (1882), 11 Fed. Rep. 597; 22 O. G. 771; *Sharp v. Tift* (1880), 17 O. G. 1282; 2 Fed. Rep. 697; 18 Blatch. 132; 5 Bann. & A.

issue fails to accomplish the desired result another may be granted, and thus successive efforts at amendment may be made until the patent meets in all respects the purpose it was first intended to fulfil.³ Each of these successive re-issues is

399 ; *Rubber Co. v. Goodyear* (1869), 9 Wall. 788.

That a re-issue cannot change the invention by narrowing a Claim in one part and expanding it in another, see *Gage v. Kellogg* (1886), 26 Fed. Rep. 242 ; 36 O. G. 234.

That a re-issue unwarrantably expanding the Claims is void, see *Hoe v. Knap* (1886), 36 O. G. 1244 ; 27 Fed. Rep. 204 ; *Pattee Plow Co. v. Kingman* (1885), 23 Fed. Rep. 801 ; *Nye v. Allen* (1883), 23 O. G. 2328 ; 15 Fed. Rep. 114 ; *Doane & Wellington Mfg. Co. v. Smith* (1882), 24 O. G. 302 ; 15 Fed. Rep. 459.

That the original patent cannot be broadened by re-issue so as to include matter anticipated by prior devices, see *Ives & Miller v. Hartford Spring & Axle Co.* (1882), 11 Fed. Rep. 510 ; 20 Blatch. 333 ; 22 O. G. 1037.

That an inexact Claim in the re-issue which if naturally construed would expand the invention is void, see *Tyler v. Galloway* (1882), 20 Blatch. 445 ; 22 O. G. 2072 ; 12 Fed. Rep. 567.

That if a re-issue does not narrow it must of course expand the Claims of the original, see *French v. Rogers* (1851), 1 Fisher, 133.

That where the specification and drawings are the same as those of the original the re-issue is not granted for making the description more full or for disclaiming old matter, see *McMurray v. Mallory* (1884), 111 U. S. 97 ; 27 O. G. 915.

That the case of *Miller v. Brass Co.*, 104 U. S. 350, does not prohibit new Claims, — it applies the doctrine of equitable estoppel to the patentee after unreasonable delay when others may have

acted on his non-claim, — see *Asmus v. Alden* (1886), 27 Fed. Rep. 684 ; 36 O. G. 231.

That the invention may be divided into distinct Claims in the re-issue, see *Brown v. Deere* (1881), 6 Fed. Rep. 484 ; 2 McCrary, 422 ; 19 O. G. 361 ; *Dederick v. Cassell* (1881), 20 O. G. 1233 ; 9 Fed. Rep. 306 ; 14 Phila. 503.

That the division and enlargement of Claims in a re-issue is not favored, though it is allowed if no new matter is introduced, see *Dederick v. Cassell* (1881), 14 Phila. 503 ; 20 O. G. 1233 ; 9 Fed. Rep. 306.

That if the several Claims of the re-issue cover the same invention as the original and no more, the re-issue is valid, see *American Diamond Rock Boring Co. v. Sheldon* (1885), 25 Fed. Rep. 768 ; 33 O. G. 1598.

That the re-issue is valid though its specification differs from that of the original, if they are consistent with each other, though if inconsistent the re-issue is void, see *Sickles v. Evans* (1863), 2 Clifford, 203 ; 2 Fisher, 417.

That the specification and Claims of the re-issue may differ from those of the original provided they claim nothing except what was present, both in fact and function, either in the original drawings or model, see *Stephenson v. Second Avenue R. R. Co.* (1880), 5 Bann. & A. 116 ; 1 Fed. Rep. 416.

That a re-issue cannot contain any change in the original specification or Claim whereby a new and substantially different invention results, or different effects are produced, see *Salamander Felting Co. v. Haven* (1875), 9 O. G. 253 ; 3 Dillon, 131.

³ In *French v. Rogers* (1851), 1

independent of its predecessors, is unprejudiced by their imperfections, and is presumed to be an honest endeavor to effect the object for which the patent was originally issued.⁴

§ 694. **Single Original Patents may Re-issue in Several Divisions.**

In many cases, on account of the number or the intricate relations of the inventions described in the original patent, the object of the amendment cannot be accomplished by a

Fisher, 133, Kane, J. : (137) "There is nothing in the words of the act, or in the policy which it proclaims, that limits the correction of errors to such as may have been the first discovered. On the contrary . . . it is for the public interest that the surrender and re-issue should be allowed to follow each other just as often as the patentee is content to be more specific or more modest in his Claims."

That successive re-issues may be allowed, until the actual invention receives the desired protection, see *Selden v. Stockwell Self-Lighting Gas Burner Co.* (1881), 19 Blatch. 544 ; 20 O. G. 1377 ; 9 Fed. Rep. 390 ; *Union Paper Collar Co. v. White* (1875), 7 O. G. 698, 877 ; 2 Bann. & A. 60 ; 11 Phila. 479 ; *Wells v. Jacques* (1874), 1 Bann. & A. 60 ; 5 O. G. 364.

That a second re-issue must be for the same invention as the first re-issue, see *Giant Powder Co. v. California Powder Works* (1875), 3 Sawyer, 448 ; 2 Bann. & A. 131 ; *Knight v. Baltimore & Ohio R. R. Co.* (1840), 3 Fisher, 1 ; Taney, 106. This doctrine, unless broadly construed, improperly limits the right of the inventor by committing him irrevocably to any mistake he may make in the first re-issue.

That if a re-issue is void the original may be re-issued in its exact language and be valid, see *Giant Powder Co. v. Safety Nitro-Powder Co.* (1884), 19 Fed. Rep. 509 ; 10 Sawyer, 23 ; 27 O. G. 99.

That the original patent cannot be revived by merely disclaiming all changes made by the re-issue, but a new re-issue must be obtained, see *McMurray v. Mallory* (1884), 111 U. S. 97 ; 27 O. G. 915.

That a first re-issue identical with the original is void, but a second re-issue repeating the original is good, see *Celluloid Mfg. Co. v. Zylonite Brush & Comb Co.* (1886), 27 Fed. Rep. 291 ; 35 O. G. 1228.

That the acceptance of a second re-issue with the original Claims restored admits that the original patent was not invalid or inoperative, see *Celluloid Mfg. Co. v. Zylonite Brush & Comb Co.* (1886), 27 Fed. Rep. 291 ; 35 O. G. 1228.

⁴ That a second re-issue is not prejudiced by the faults of a former one, see *American Diamond Rock Boring Co. v. Sheldon* (1879), 17 Blatch. 209 ; 4 Bann. & A. 551.

That where there are several re-issues of the same patent the law always presumes that each was necessary to cure defects, see *Union Paper Collar Co. v. White* (1875), 2 Bann. & A. 60 ; 7 O. G. 698, 877 ; 11 Phila. 479.

That successive re-issues are not approved, see *Union Paper Collar Co. v. White* (1874), 7 O. G. 698, 877 ; 2 Bann. & A. 60 ; 11 Phila. 479.

That three re-issues of the same patent indicate fairness in each, see *Swift v. Whisen* (1867), 3 Fisher, 343 ; 2 Bond, 115.

mere surrender of the original, and the substitution for it of a single re-issued patent. Where the original specification sets forth a new combination containing many new elements and sub-combinations, or where it contains a description not merely of the principal invention but of numerous subordinate or dependent inventions, the endeavor to describe and claim all these in one re-issue might often lead to hopeless confusion and uncertainty. To obviate this, the inventor is permitted to re-issue his original patent in divisions, covering in each so much of the patentable matter contained in the original description as he deems expedient, and thus receiving a separate patent for each separate part of his invention.¹ In this manner an original patent for a combination may re-issue in one patent for the entire combination, in others for its sub-combinations, and in still others for its elements.² A patent for a manufacture, which can be produced only by a given process, may re-issue in one patent for the process and another for the product.³ The same rule applies in other cases of depend-

§ 694. ¹ That a patent may re-issue in divisions for the distinct inventions embraced in the original, see *Giant Powder Co. v. Safety Nitro-Powder Co.* (1884), 19 Fed. Rep. 509; 10 Sawyer, 23; 27 O. G. 99; *New v. Warren* (1882), 22 O. G. 587; *Dederick v. Cassell* (1881), 9 Fed. Rep. 306; 20 O. G. 1233; 14 Phila. 503; *Selden v. Stockwell Self-Lighting Gas Burner Co.* (1881), 9 Fed. Rep. 390; 19 Blatch. 544; 20 O. G. 1377; *Ex parte Lippincott* (1879), 16 O. G. 632; *Wheeler v. McCormick* (1873), 11 Blatch. 334; 6 Fisher, 551; 4 O. G. 692; *Penna. Salt Mfg. Co. v. Thomas* (1871), 8 Phila. 144; 5 Fisher, 148; *Bennet v. Fowler* (1869), 8 Wall. 445; *Goodyear v. Wait* (1867), 5 Blatch. 468; 3 Fisher, 242.

That re-issue divisions are for separable inventions which can be separately patented, see *Ex parte Herr* (1887), 41 O. G. 463.

That a patent may be re-issued in several divisions, either concurrently or successively, and the original is good to

protect each part until it is covered by a re-issue, see *Ex parte Greaves* (1880), 18 O. G. 623.

That a patent may re-issue in divisions, one division containing the original Claims, and another the new Claims, see *Giant Powder Co. v. Safety Nitro-Powder Co.* (1884), 10 Sawyer, 23; 27 O. G. 99; 19 Fed. Rep. 509.

² That where the original patent is for a combination it may re-issue in separate divisions for each sub-combination, and these are not separate patents for the same invention, see *Wheeler v. McCormick* (1873), 6 Fisher, 551; 11 Blatch. 334; 4 O. G. 692.

That sub-combinations, if operative by themselves, may be re-issued in separate patents, based on the same original, see *Ex parte Wheeler* (1873), 4 O. G. 5.

³ That where the original patent was for a new product resulting from a new process the re-issue may cover both process and product, either in the same or separate patents, see *Tucker v. Burditt*

ent inventions, where the joinder, though allowable, would result disadvantageously to the inventor, and where his patent cannot, therefore, be conveniently re-issued in a single instrument to cover all he has described in the original.

§ 695. **Relation of each Re-issue Division to the Original Patent, and to the Other Divisions.**

As these divisions of the re-issue represent a single original patent, they must be granted to the same patentee, and be confined to the inventions indicated in the former specification.¹ The patentable matter claimed in each must be a complete invention in itself, and not merely a different application of the principal invention.² Each may describe the whole invention, if this be necessary to the explanation of the specific portion which it claims, and each may claim its own part in its separate condition and also as connected with the others.³ One division is not affected by errors or excesses

(1879), 4 Bann. & A. 569; *Anilin v. Hamilton Mfg. Co.* (1878), 3 Bann. & A. 235; 13 O. G. 273.

Whether a patent for a process can re-issue in separate patents, one for the process and the other for the product, *quere*, see *Goodyear v. Honsinger* (1867), 3 Fisher, 147; 2 Bissell, 1.

§ 695. ¹ That all the divisions of a re-issue must issue to the same patentees, see *Ex parte Smith* (1879), 16 O. G. 1233.

That a re-issue in divisions must be confined to the original inventions, see *New v. Warren* (1882), 22 O. G. 587.

² That where a patent is divided upon re-issue each division must be for a distinct part of the original invention, see *Giant Powder Co. v. California Vigorit Powder Works* (1875), 3 Sawyer, 448; 2 Bann. & A. 131.

That a patent cannot be divided upon its re-issue unless there are distinct inventions, not merely different applications to a specific invention under the same genus, see *Ex parte Sexton* (1873), 3 O. G. 409.

³ In *Wheeler v. McCormick* (1873), 11 Blatch. 334, Woodruff, J. : (338) "Where a patentee, having patented an aggregate of several devices, is permitted to surrender his patent and receive new letters-patent for the several devices included in it, it does not follow that his new specifications may not be identical in their description of each and all of the devices included in the original aggregate patent. It is the patentee's selecting out of these devices some or one, being separable and capable of use as a distinct device or devices, and making that or those the subject of his specific Claim, that determines what is covered by each re-issue. The description of an entire machine may be convenient, and sometimes necessary, in order to show the adaptation of the separated device to a useful purpose, and illustrate, not its construction alone, but its application in one practical mode to the purpose for which it was designed. Such a description may be given, but that does not make the patent cover all that is included in the description. In this case,

in the others, but is judged on its individual merits as a separate patent for a separate invention.⁴ All the divisions rest upon the original patent, however, as their common foundation, and an incurable defect in the original, such as a false oath or a fraudulent concealment, renders them altogether void.⁵

§ 696. Re-issued Patent Supersedes the Original and Requires its Surrender to the Government.

The amendment of a patent by re-issue is not, in legal effect, a simple addition to or variation of its description or its claims, — it is the grant of a different patent for the same invention;¹ and since during the life of one patent another

then, it was competent for the patentee to amend his original specification, so as fully and minutely to describe all that was shown in the original or in its drawings or model, and receive patents for each separate device shown therein, or each separate and severable combination of devices, capable of distinct use, and while such specification might be annexed, *in totidem verbis*, to each re-issued patent, define and claim in each such separable and distinct part of his original aggregate invention, the specification in each case showing, as it should, the construction of each separate patented device or combination of devices, so as to give the required information to the public, and illustrating the application of each device or combination to actual use in the construction of an aggregate machine. This does not make one re-issue include all that is described in the specification. All that is included in a specification is not necessarily included in the patent. What is claimed in and secured by the patent is secured not only when used in the mode illustrated by the description of other devices with which it may be used in the specification, but it is secured against its use in connection with other devices of an entirely distinct

character." 4 O. G. 692 (694); 6 Fisher, 551 (555).

That where a patent re-issues in divisions and each division claims its distinct part in combination with the rest, they will not be several patents for the same invention, see *Wheeler v. McCormick* (1873), 11 Blatch. 334; 4 O. G. 692; 6 Fisher, 551.

⁴ That where an original patent is re-issued in divisions, the first division may be valid though the others are void, see *Atwood v. Portland Co.* (1880), 5 Bann. & A. 533; 10 Fed. Rep. 283.

That where a patent is divided upon re-issue, each division stands by itself as for a separate invention, see *Brown v. Selby* (1871), 4 Fisher, 363; 2 Bissell, 457.

⁵ That where a patent re-issues in divisions, each division is treated as a separate Claim under one patent, see *Penna. Salt Mfg. Co. v. Thomas* (1871), 5 Fisher, 148; 8 Phila. 144.

That a re-issue must stand or fall by its own Claim, see *Wisner v. Grant* (1881), 7 Fed. Rep. 922; 18 O. G. 192.

§ 696. ¹ That a re-issue is a new contract between the United States and the party who obtains it, see *Goodyear v. Providence Rubber Co.* (1864), 2 Clifford, 351; 2 Fisher, 499.

for the same invention cannot issue to the same patentee, the grant of the re-issue necessitates the previous surrender and cancellation of the original defective patent. The surrender is accomplished by the delivery of the original patent, or in case of its destruction or loss of a certified copy thereof, to the Patent Office, with a request for a re-issue;² and when this is accepted by the Commissioner, the original patent and all the claims accruing from it, in favor of the parties uniting in the surrender, are extinguished.³ Their patent privileges are thenceforth derived from the re-issued patent only, upon which all their efforts to protect or vindicate their rights to the invention must be based.⁴

² That a surrender is not required by the statute to be in writing, see *Dental Vulcanite Co. v. Wetherbee* (1866), 2 Clifford, 555; 3 Fisher, 87.

³ That all rights of action under the original patent expire with its surrender and re-issue, see *Jones v. Barker* (1882), 11 Fed. Rep. 597; 22 O. G. 771; *U. S. Stamping Co. v. King* (1879), 7 Fed. Rep. 860; 17 Blatch. 55; 17 O. G. 1399; 4 Bann. & A. 469; *Mers v. Conover* (1876), 11 O. G. 1111; *Fry v. Quinlan* (1875), 13 Blatch. 205; *Reedy v. Scott* (1874), 23 Wall. 352; 7 O. G. 463; *Brown v. Hinkley* (1873), 3 O. G. 384; 6 Fisher, 370.

That all rights of action are suspended by a surrender and re-issue application, see *Burrell v. Hockley* (1888), 44 O. G. 1400.

⁴ In *Peck v. Collins* (1881), 103 U. S. 660, Bradley, J. : (664) "Since the decision of this case it has been uniformly held that if a re-issue is granted, the patentee has no rights except such as grow out of the re-issued patent. He has none under the original. That is extinguished. And although for the purpose of fixing a date to the title in a question of priority, and of limiting the period for which the patent is to run, the date of the original patent is important, no damages can be recovered

for any acts of infringement committed prior to the re-issue." 19 O. G. 1137 (1138).

In *Mossitt v. Gaar* (1860), 1 Fisher, 610, Leavitt, J. : (613) "In the liberal and benignant spirit in which our patent system has been conceived and carried out, the thirteenth section of the act of 1836 gives to the patentee a right to correct his description or specification, when its imperfection has resulted from inadvertency, accident, or mistake. This is effected by a surrender of his patent, and obtaining a new patent upon an amended specification. By this means he is protected from some of the effects of his error, and secured in the enjoyment of all his rights as an inventor, after the emanation of the new or corrected patent. But the statute gives no right of action for an infringement occurring under the void patent, and before the re-issue of the new patent. In the present case the grounds on which the old patent was surrendered, and a re-issue authorized, are not before the court. But the court must presume that they were such as, by the language of the thirteenth section, authorized the surrender of the old patent, and the granting of a new one. The only condition on which this can be done is that the original patent is '*inoperative*

§ 697. Surrender of the Original Patent takes Effect upon the Grant of the Re-issued Patent.

Since the surrender, when accepted, abrogates all rights of the surrenderors under the original patent, the question as to the time of such acceptance is of great importance, and formerly was surrounded with considerable difficulty. Prior to the act of 1870 the statutes contained no specific answer to this question, and the decisions of the courts were not in harmony. Under the act of 1832, which first authorized this

or *invalid*' by reason of a failure to comply with the requirements of the statute. The proceeding is, therefore, equivalent to a distinct admission, made in the most solemn form, that the patent has no validity in the sense of entitling the patentee to an action for its infringement. The new patent can be operative only from its date, as affording the patentee a remedy for an infringement. The statute expressly negatives the idea that it was intended to give a retrospective operation to the new patent and entitle the patentee to an action for an infringement previously accruing. It was, doubtless, competent for the legislature to have declared that the new patent should have this effect, but the language used imports the opposite intention. The statute provides, in express terms, that the re-issued patent '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 of the original patent.' Now, the allegation of the plea in this case is that after the cause of action accrued, and after the commencement of this action the plaintiff surrendered his patent. The demurrer admits the truth of this averment. The claim of the plaintiff, then, is based on infringement occurring under the old patent, and not for a cause of action accruing after the date of the re-issued

patent. Clearly the statute affords no remedy for such an infringement. Any other construction of the statute would result in the absurdity of conferring on the patentee, as the result of the surrender of what he admits to be an invalid patent, rights and immunities which he could not claim without such surrender. In other words, the legal effect of the re-issued patent would be to give force and vitality to the original patent, in the face of the admission of the patentee that it was inoperative and invalid. This may be illustrated by supposing that the patentee had made no surrender, but had chosen to rest his rights on the original patent. Is it not clear that there could have been no recovery in that case for an infringement? The patentee would have been met with the unanswerable objection that the patent was invalid, from a fatal omission to comply with the requisition of the statute. And there can be no pretence for claiming that by the surrender of the old patent, and the emanation of a second one, the patentee, as to infringements occurring under the original patent, is placed in a better situation than if there had been no surrender and re-issue." 1 Bond, 315 (317).

That a surrender and re-issue make the patent good as to all subsequent causes of action, though the original were invalid, see *Bloomer v. Stolley* (1850), 5 McLean, 158.

method of amendment, the re-issue was to be awarded upon the surrender of the former patent. As no examination of applications was then required, the surrender and re-issue were reciprocal and concurrent acts, and no interval could have elapsed during which neither patent was in force. The act of 1836, while introducing the system of examining applications and thus requiring greater or less delay between the surrender and the grant of the re-issue, did not change the language of the act of 1832 to meet this new circumstance, or by any other provision indicate the time when the surrender was to take effect. Hence the idea seems to have gained recognition that the surrender and re-issue were not dependent parts of the same transaction, but that the surrender was an absolute destruction of the original patent, and that unless the re-issue were granted the rights of the surrenderors were irretrievably lost. Under this doctrine the applicant for a re-issue occupied the same position as an applicant for an original patent. The patentability of his invention, and his relation to it as its first inventor were again open to investigation, as upon his original application, and a refusal of the re-issue operated as a complete repudiation of his claims.¹ The act of 1870 removed at once these difficulties and doubts by providing that the surrender should take effect only upon the issue of the amended patent.² At present, therefore, the rights of the surrenderors are protected by the original patent until the re-issue is awarded; and if the re-issue be refused, the original patent is returned to its owners, who are thus left to sustain it, so far as they are able, in the courts.³

§ 697. ¹ That under the law, as it stood in 1860, a patent surrendered for re-issue was gone in any event, and the patentee must obtain the re-issue or have nothing, see *Peck v. Collins* (1881), 103 U. S. 660 · 19 O. G. 1137.

But *per contra*, —

That while the re-issue supersedes the original, the surrender and application for a re-issue do not, see *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379.

That the surrender and re-issue con-

stitute but one act, and are both alike valid or invalid, see *French v. Rogers* (1851), 1 Fisher, 133.

That if the re-issue is void the original patent still remains valid, see *Woodworth v. Hall* (1846), 1 W. & M. 389; 2 Robb, 517; *Woodworth v. Hall* (1846), 1 W. & M. 248; 2 Robb, 495.

² That before 1870 the surrender took effect from its date, after 1870 from the re-issue, see *Peck v. Collins* (1881), 103 U. S. 660; 19 O. G. 1137.

³ An exception to this rule exists in

§ 698. Surrender of the Original Patent: by Whom Made.

No surrender can be valid and effective unless made with the concurrence of all the owners of the original patent.¹ The patentee, if living and still retaining any undivided interest in the patent, his representatives if he be dead and at his death had not assigned to others his entire patent privilege, and the assignees of any undivided interest in the whole patent, are parties whose consent to the extinguishment of the original patent is absolutely necessary.² The concur-

cases where an examination of the re-issue application on its merits discloses that the invention was originally unpatentable, for want of novelty, priority, or some other essential requisite. In such cases a decision adverse to the re-issue applicant is fatal to the entire patent. Thus in *Peck v. Collins* (1881), 103 U. S. 660, *Bradley, J.*: (664) "It seems to us equally clear that as the law stood when that decision was made, and as it continued to stand in 1866, when the surrender of Mudge's patent took place, a patent surrendered for re-issue was cancelled in law as well when the application was rejected as when it was granted. The patentee was in the same situation as he would have been if his original application for a patent had been rejected. The law declares in terms that 'the specifications and Claim in every such case shall be subject to revision and restriction in the same manner as original applications are.' Act of March 3, 1837, c. 45, Sec. 8, 5 Stat. 193; July 8, 1870, c. 230, Sec. 53, 16 Stat. 205; Rev. Stat. Sec. 4916. The question of his right to any patent at all was opened anew, the same as upon an original application for a patent. Surrender of the patent was an abandonment of it, and the applicant for re-issue took upon himself the risk of getting a re-issue or of losing all. A failure upon the merits, in a contest with other claimants, only gave additional force to the legal effect of the

surrender. Since the surrender of the patent in this case the Patent Laws have undergone a general revision by the act of July 8, 1870, c. 230. In the fifty-third section of that act (being the section relating to the surrender and re-issue of patents), a new clause was introduced, declaring that the surrender 'shall take effect upon the issue of the amended patent;' and this clause is retained in Sec. 4916 of the Revised Statutes. What may be the effect of this provision in cases where a re-issue is refused, it is not necessary now to decide. Possibly it may be to enable the applicant to have a return of his original patent if a re-issue is refused on some formal or other ground which does not affect his original claim. But if his title to the invention is disputed and adjudged against him, it would still seem that the effect of such a decision should be as fatal to his original patent as to his right to a re-issue." 19 O. G. 1137 (1138).

§ 698. ¹ That a surrender is invalid unless all owners of the patent concur, either by consent or ratification, see *Meyer v. Bailey* (1875), 8 O. G. 437; 2 Bann. & A. 73.

² That a surrender for re-issue must be made either by the patentee or by his representatives or assigns, see *Ex parte Wright* (1876), 10 O. G. 587; *Potter v. Holland* (1858), 1 Fisher, 327; 4 Blatch. 206.

That the patentee and the assignee

rence of such owners may be manifested either by joining in the surrender, or by subsequently ratifying it, though under the present practice in the Patent Office the written consent of all the owners must appear upon the face of the application for re-issue in which the surrender of the original patent is embodied.³ Grantees and licensees are not so interested in the original patent as to make their concurrence necessary to the validity of its surrender and re-issue.⁴ Local or individual rights acquired under the former patent remain unaffected by its surrender until the parties in whom such rights are vested voluntarily relinquish them and accept new rights under the re-issue.⁵ The original patent may

of a part interest may join in surrender and application for a re-issue, see *Potter v. Holland* (1858), 1 Fisher, 327; 4 Blatch. 206.

That where the whole interest in a patent has been assigned the surrender should be made by the assignee, or with his consent, and the re-issue granted to him, see *Dental Vulcanite Co. v. Wetherbee* (1866), 3 Fisher, 87; 2 Clifford, 555.

That the assignment of part of a patent does not entitle the assignee to surrender and re-issue that part, see *Ex parte Smith* (1879), 16 O. G. 1233.

That the assignee of an undivided interest in the patent must join with the other owners in a surrender, see *Potter v. Holland* (1858), 4 Blatch. 206; 1 Fisher, 327.

That a surrender by, and a re-issue to, a person other than the owner would not affect the title of the owner, see *Campbell v. James* (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456.

That an assignee has the same rights under the re-issue as under the original, see *Potter v. Holland* (1858), 1 Fisher, 327; 4 Blatch. 206.

³ That if an assignee ratifies a re-issue it becomes valid as to him, see *Campbell v. James* (1879), 18 O. G.

979; 17 Blatch. 42; 4 Bann. & A. 456; *Meyer v. Bailey* (1875), 8 O. G. 437; 2 Bann. & A. 73.

⁴ That the grantee of a territorial interest is not an "assignee," as the word is used in the statute referring to re-issues, and that a surrender and re-issue is valid though a "grantee" does not consent, see *Meyer v. Bailey* (1875), 2 Bann. & A. 73; 8 O. G. 437; *Commissioner v. Whitely* (1866), 4 Wall. 522.

That neither a grantee nor a licensee can join in a surrender, see *Potter v. Holland* (1858), 4 Blatch. 206; 1 Fisher, 327.

That a re-issue is *prima facie* evidence that the surrender was proper, see *Knight v. Baltimore & Ohio R. R. Co.* (1840), Taney, 106; 3 Fisher, 1.

⁵ In *Potter v. Holland* (1858), 4 Blatch. 206, Ingersoll, J. : (214) "It does not follow from this, however, that because a third person, to whom a patentee has passed his interest in a part of a patent, is entitled to the same right to a re-issued patent that he had to the old one, he is compelled to take under the re-issued one, and thereby compelled to give up the right which he had under the old one. If he were, his rights might be injuriously affected without his consent. If he were so compelled,

thus be in force as to grantees and licensees in some portions of the United States, although as to the owners of the patent, and in other sections of the country, the re-issued patent alone survives.⁶ But the holders of these subordinate interests cannot claim under both patents. By authorizing or by taking the benefit of the surrender and re-issue, they abandon the privileges conferred upon them under the original patent and accept the amended patent as the source and measure of their rights.⁷

§ 699. Effect of Surrender and Re-issue upon Rights Accruing under the Original Patent.

The surrender of a patent for re-issue is an admission on the part of the surrenderors that the original patent is defective, and the acceptance of the surrender by the Commissioner is a judgment that its amendment by re-issue is required; but neither the surrender nor its acceptance indicates that the surrendered patent was entirely void.¹ The surrender is a vol-

a grantee under the old patent of an exclusive territorial right would be forced, without his consent, to give up damages which he might be entitled to under the old patent, for a violation of rights secured to him by that patent. And it might so happen that the old patent surrendered was a valid one, and that the re-issued one was invalid; or that the rights secured by the former were important, while the rights secured by the latter were of little consequence."

¹ Fisher, 327 (336).

That the re-issue of a patent is for the purpose of curing defects and perfecting the patent, and cannot destroy vested rights of assignees, etc., see *Harrison v. Ingersoll* (1885), 56 Mich. 36.

⁶ In *Potter v. Holland* (1858), 4 Blatch. 206, *Ingersoll, J.* : (216) "The object of a patent is to secure rights to an invention throughout the whole of the United States. We can discover no good reason why a portion or the whole of the invention, for a particular portion of the United States, may not be secured

by one patent, and the remaining portion of the invention for the residue of the United States be secured by another patent. These two patents would, in effect, constitute together but one patent for the whole invention, for the whole United States. Two patents for separate parts, the separate parts together comprehending only the whole, would in effect be but one patent for the whole; as two separate deeds, for two separate sections of one whole lot of land, would not be, in effect, more than one deed for the whole lot. No more would be secured by the two patents than is authorized by law to be secured, or than could be secured by one. The two, in effect, would constitute but one." 1 Fisher, 327 (338).

⁷ That by asserting rights under a re-issue parties in interest adopt it and to that extent forego their rights under the original, see *Meyer v. Bailey* (1875), 8 O. G. 437; 2 Bann. & A. 73.

§ 699. ¹ That a surrender for re-issue admits that the original is inoperative,

untary extinguishment of former rights, not a concession that such rights never existed, and, therefore, while no suit can be maintained under the original patent nor any infringement of its privileges be made the ground of a recovery, all closed transactions under it remain undisturbed.² Judgments obtained upon it are not vacated.³ Moneys paid under it cannot be reclaimed.⁴ But an infringement which commenced under the original patent is not sanctioned by the surrender, and if it continues in the same or in another form after the grant of the re-issue, an action may be instituted on the latter patent, and damages accruing since the date of the re-issue be obtained.⁵

§ 700. Application for Re-issue: Concurrence of the Inventor therein Necessary, if Living.

An application for the re-issue of a patent granted and assigned before the 8th day of July, 1870, may be made by the owners of the patent with or without the concurrence of the original patentee.¹ Patents granted or assigned since July 8,

see *Moffitt v. Gaar* (1860), 1 Fisher, 310; 1 Bond, 315.

² That a surrender cannot affect rights previously acquired, see *Potter v. Holland* (1858), 4 Blatch. 206; 1 Fisher, 327.

That a contract concerning a patent applies to it after a surrender and re-issue, the re-issue not being a new patent, see *McBurney v. Goodyear* (1858), 11 Cush. 569.

³ That the surrender of a patent for re-issue has no effect upon a right which has passed into a judgment, see *Mers v. Conover* (1876), 11 O. G. 1111.

⁴ That although the surrender extinguishes the original patent, the moneys paid under it cannot be recovered, see *Moffitt v. Gaar* (1861), 1 Black, 273.

⁵ That the acquiescence of the patentee in the use of his invention, under the original patent, does not authorize its use under a re-issue, see *McWilliams*

Mfg. Co. v. Blundell (1882), 22 O. G. 177; 11 Fed. Rep. 419.

That a surrender and re-issue does not deprive the patentee of the right to sue for the unlawful use, after the re-issue, of a machine brought before the re-issue, see *Bliss v. Brooklyn* (1871), 4 Fisher, 596; 8 Blatch. 533; *Carr v. Rice* (1856), 1 Fisher, 198.

§ 700. ¹ That under Sec. 13, act of July 4, 1836, the re-issue was to be granted to the patentee, if he was living and still the owner of the patent; if he was dead and there was no assignment, then to his executor or administrator; and if there was an assignment, to the assignee, see *Potter v. Holland* (1858), 4 Blatch. 206; 1 Fisher, 327.

That under the act of 1836 a re-issue might be granted to an assignee without the knowledge or consent of the patentee, see *Swift v. Whisen* (1867), 3 Fisher, 343; 2 Bond, 115.

1870, can be re-issued only upon the application and oath of the original inventor, if he be living.² Various reasons for this change in the law have been suggested. The oath accompanying the application must aver that the error whose amendment is desired arose through inadvertence, accident, or mistake, and must repeat the allegations of the original oath in reference to priority of invention and the absence of previous public use and knowledge. This oath, after the grant of the re-issue, is *prima facie* evidence upon all the points embraced therein. To permit it to be made by a mere assignee upon his information and belief, when the inventor is living and can, therefore, testify upon his positive knowledge, is an unnecessary relaxation of the ordinary rules of evidence and was properly corrected by the act of 1870. Moreover, the rights of the inventor in his invention are not exhausted by the conveyance of his entire interest in the original patent. Under former laws a re-issue might affect the value of his right to an extension after the expiration of the assigned patent,³ and under present laws an alteration in the description or claims of the existing patent may prejudice his interests in subordinate or dependent inventions which may be indicated in the original specification, but which he did not intend to cover by the original patent or transfer to the assignee. His consent to the re-issue, if he is living and able to accord it, may be, therefore, properly required.

§ 701. Application for Re-issue: by Whom Made.

Under existing laws the application for re-issue must be made by the inventor, if living; on his own behalf if he is still the entire owner of the patent, and on behalf of its real owners if he has assigned the whole or any undivided interest. Where the inventor is dead the owners of the patent, whether his representatives or assignees or both, may make the application, as before the changes in the law.¹ A living inventor

² Rev. Stat. Sec. 4895.

³ That where an assignee has re-issued a patent without the patentee's consent, the latter may apply for an extension of the original, see *Potter v. Braunsdorf* (1869), 7 Blatch. 97.

§ 701. ¹ That an executor may obtain a re-issue, see *Carew v. Boston Elastic Fabric Co.* (1871), 3 Clifford, 356; 5 Fisher, 90; 1 O. G. 91.

That a re-issue to an administrator is presumed to be regular, see *Northwest-*

who refuses to apply for a re-issue on behalf of his assignees, when such an amendment of the patent is legitimate and necessary, may be compelled to do so by a court of equity,—since his assignment of the patent implies a contract on his part to do whatever may be requisite to render the patent effective for the actual invention, and this contract equity will enforce.² But an inventor has no authority to apply for the re-issue of an assigned patent without the consent of his assignees, and his wrongful act in this regard cannot impair their rights.³ A re-issue thus obtained by him is valid or invalid at their election. They may ratify it and enjoy the advantages derived from it, though issued only in his name,⁴

ern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co. (1874), 10 Phila. 227 ; 6 O. G. 34 ; 1 Bann. & A. 177.

² See §§ 1224, 1228-1230, and notes, *post*.

³ That the surrender of an assigned patent is not valid unless made by the assignee or with his consent, see *Ex parte Wright* (1876), 10 O. G. 587 ; *Meyer v. Bailey* (1875), 8 O. G. 437 ; 2 Bann. & A. 73 ; *Barnes v. Morgan* (1875), 3 Hun, 703 ; *Dental Vulcanite Co. v. Wetherbee* (1866), 3 Fisher, 87 ; 2 Clifford, 555.

That a patentee cannot affect the interest of his assignee by any surrender for re-issue, see *Barnes v. Morgan* (1875), 3 Hun, 703.

That an assignment of a patent carries all re-issues if the assignee so elect, see *Littlefield v. Perry* (1874), 21 Wall. 205 ; 7 O. G. 964.

That a re-issue to the patentee is a bar to a re-issue to an unrecorded assignee, see *Whitely v. Fisher* (1870), 4 Fisher, 248.

⁴ In *Potter v. Holland* (1858), 4 Blatch. 206, Ingersoll, J. : (214) " We adopt the rule laid down by Judge Story in the case of *Woodworth v. Stone* (3 Story, 749), that it is not in the power of the patentee, by a surren-

der of his patent, to affect, without their consent, the rights of third persons to whom he has previously passed his interest in the whole or a part of the patent. This consent may be manifested either by joining in the surrender with the patentee, or by previously authorizing it or by subsequently ratifying or approving it. To take advantage and benefit of it would be a ratification. When such consent is given the rights of the party so consenting in and to the old patent are forever gone. It may, too, be considered as a sound and settled principle that a person to whom the patentee has passed his interest in a part of the old patent, is entitled, upon the surrender of the same by the patentee, and the obtaining of a re-issued patent, to the same right under the re-issued patent that he had to the old one. The patentee cannot, by taking a re-issue, deprive him of the same right to it that he had to the old one, if he wishes to take the benefit of such right. *Woodworth v. Hall*, 1 Woodb. & Minot, 248. But when he does take advantage and benefit of the re-issued patent, he consents to give up, and does give up, the right which he had under the old one." 1 Fisher, 327 (335).

See also *Littlefield v. Perry* (1874), 21 Wall. 205 ; 7 O. G. 964, *Dental*

or they may repudiate it and compel him to obtain another, or they may insist upon their privileges under the original patent. To guard against this unauthorized re-issue of an assigned patent, it is the practice of the Patent Office to require proof of the consent of all the owners of the patent, sufficient evidence of which is furnished by the filing of the abstract of their title with the application.⁵

§ 702. Re-issued Patent: to Whom Granted.

The re-issued patent may be granted to assignees of any degree, however remote from the original inventor.¹ The limits within which the original description and claims may be amended, and the consequences of a previous disclaimer or abandonment, are the same as if the application had been made by the inventor. The re-issue is void if any fraud is perpetrated or attempted by the applicant, as where he knows that the original assignor was not the true inventor or that the error whose amendment he desires did not occur in such a manner as alone warrants its correction.² The grant of a re-issue to an assignee is *prima facie* evidence of his title to the patent.³ Parties claiming under the original patent, other

Vulcanite Co. v. Wetherbee (1866), 2 Clifford, 555; 3 Fisher, 87; Burdell v. Denig (1865), 2 Fisher, 588.

That third parties ratify the re-issue by using or selling rights under it, see Meyer v. Bailey (1875), 2 Bann. & A. 73; 8 O. G. 437.

That a re-issue does not *enure* to the benefit of the assignee when obtained by the patentee, the assignee taking by ratification, not by enurement, see Burdell v. Denig (1865), 2 Fisher, 588.

That when the patentee obtains a re-issue at the request of the owners of the patent after an assignment of the original it enures to the benefit of the assignees, see Wing v. Warren (1872), 5 Fisher, 548; 2 O. G. 342.

⁵ That the Commissioner may require sufficient proof that the assignee consents to the re-issue, see *Ex parte* Wright (1876), 10 O. G. 587.

That a certified abstract of title is the proper evidence of the assignee's consent, see *Ex parte* Wright (1876), 10 O. G. 587.

§ 702. ¹ That a re-issue may be granted to an assignee of any degree, see Selden v. Stockwell Self-Lighting Gas Burner Co. (1881), 19 Blatch. 544; 20 O. G. 1377; 9 Fed. Rep. 390; Swift v. Whisen (1867), 3 Fisher, 343; 2 Bond, 115.

That a re-issue may be obtained in his own name by the assignee of the executor of the patentee, see Carew v. Boston Elastic Fabric Co. (1871), Holmes, 45.

² That a re-issue is void if the applicant knew, at the date of the application for it, that he or his assignor was not the true inventor, see Singer v. Walmsley (1860), 1 Fisher, 558.

³ That the grant of a re-issue to an

than its owners, may retain their existing rights or assert them as modified by the re-issue at their option.⁴

§ 703. **Re-issued Patent a Continuation of the Original, and Governed by the Same Law.**

A re-issued patent is a new statement of the contract between the public and the patentee, and binds each of its parties to the same extent as if it were an original patent. It is to be interpreted by the same rules, and is subject to amendment by re-issue or disclaimer in the same manner.¹ Being, however, a continuation in a new form of the original patent, the rights arising under it are governed by the law in force when the original was granted, and the patentability of the invention which it covers is determined by the state of the art as it existed at the date of the original.² The motive for obtaining a re-issue cannot change the rights which it creates, and is not regarded in deciding upon its validity or construing its provisions, except in cases where an actual fraud has been committed.³

assignee is *prima facie* evidence that he has a title to the patent, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 10 Bissell, 65 ; 19 O. G. 173 ; 4 Fed. Rep. 900 ; *American Diamond Rock Boring Co. v. Sheldon* (1879), 17 Blatch. 208 ; 4 Bann. & A. 551.

⁴ That no re-issue of a patent can affect the rights of non-consenting owners or other third parties, see *Potter v. Braunsdorf* (1869), 7 Blatch. 97 ; *Potter v. Holland* (1858), 4 Blatch. 206 ; 1 Fisher, 327.

That a portion or the whole of an invention for a particular part of the United States, and the rest for other parts, may be secured by a re-issue, see *Potter v. Holland* (1858), 4 Blatch. 206 ; 1 Fisher, 327.

That after an extension the re-issue is good for the extended term, see *Gibson v. Harris* (1846), 1 Blatch. 167.

§ 703. ¹ That the Patent Office has

the same power over a re-issue as over the original, see *Ex parte Lippincott* (1879), 16 O. G. 632.

² That the re-issue is a continuation of the original patent, see *Shaw v. Colwell Lead Co.* (1882), 20 Blatch. 417 ; 11 Fed. Rep. 711 ; *Shaw v. Cooper* (1833), 7 Peters, 292 ; 1 Robb, 643.

That a re-issue is governed by the law in force at the date of the original, see *Shaw v. Cooper* (1833), 7 Peters, 292 ; 1 Robb, 643.

That the patentability of the invention claimed in a re-issue is determined by the state of the art at the date of the original application, see *Carroll v. Morse* (1876), 9 O. G. 453 ; *Carlton v. Bokee* (1872), 17 Wall. 463 ; 2 O. G. 520 ; 6 Fisher, 40 ; and § 708, note 2, *post*.

³ That the motive for a re-issue is unimportant, if the inventions are the same, see *Buffum v. Oakland Mfg. Co.* (1879), 4 Bann. & A. 599.

§ 704. Procedure on Applications for Re-issue : The Application.

An application for a re-issue, and the proceedings in the Patent Office thereon, are for the most part governed by the rules which regulate applications for original patents, and which have been already considered in detail. It will be sufficient, therefore, to discuss at this time only the particular points in reference to which the procedure on re-issue applications is exceptional. The application must be based upon a single original patent and must show the original to have been defective through mistake, and point out wherein the mistake consisted.¹ It need not follow the language of the statute.² It comprises a petition, an oath, an abstract of title, and the amended specification, accompanied by such drawings and model as the nature of the case may require. The petition prays for leave to surrender the original patent and for a re-issue upon the amended specification. It may be signed by the true owners of the patent, unless the patent has been granted or transferred since July 8, 1870, in which case the petition must be signed by the inventor if living, and contain the written assent of the present owners.³ If the inventor has deceased, and the petition bears the signatures of the assignees, the fact of his decease must be duly stated. The abstract of title must disclose the names of all persons owning any undivided interest in the original patent ;⁴ and the orig-

§ 704. ¹ That a re-issue can be based on but a single original patent, not on several, see *Washburn & Moen Mfg. Co. v. Fuchs* (1883), 16 Fed. Rep. 661 ; 5 *McCrary*, 236.

² That the application for a re-issue need not follow the language of the statute, see *Gold & Stock Telegraph Co. v. Wiley* (1883), 17 Fed. Rep. 234.

That a re-issue need not be applied for in writing under the statute, though the rules of the Patent Office may require it, see *Dental Vulcanite Co. v. Wetherbee* (1866), 3 *Fisher*, 87 ; 2 *Clifford*, 555.

³ That if the original assignment by the patentee to the first assignee were

made before July 8, 1870, the application for re-issue may be made by the assignee, see *Selden v. Stockwell Self-Lighting Gas Burner Co.* (1881), 19 *Blatch.* 554 ; 20 *O. G.* 1377 ; 9 *Fed. Rep.* 390.

That Sec. 3, act of 1870, proviso 2d, does not require applications for re-issue pending on July 8, 1870, to be made anew, with oath of inventor, etc., see *National Spring Co. v. Union Car Spring Mfg. Co.* (1874), 12 *Blatch.* 80 ; 6 *O. G.* 224.

⁴ That an abstract of title must accompany an application for a re-issue, see *Ex parte Fassett* (1877), 11 *O. G.* 420 ; *Ex parte Wright* (1876), 10 *O. G.* 587.

inal patent, or, if it be lost, a certified copy and an affidavit of the loss, must at the same time be delivered to the Patent Office.

§ 705. Procedure on Applications for Re-issue : The Oath.

Where the petition must be signed by the inventor the oath must also be made by him; in other cases it should be made by the applicants, whoever they may be.¹ In addition to the matters embraced in the oath required in an original application, it must state particularly that the applicant believes the original patent to be inoperative or invalid, with his reasons for such belief, specifying the defects or insufficiencies in the description, or the excessive matter in the Claim, pointing out the errors which constitute the inadvertence, accident, or mistake, with the manner in which they arose, and alleging that such errors occurred without fraudulent or deceptive intention.² It must also disclose the existence of foreign

§ 705. ¹ That under the act of March 3, 1871, the oath of the assignee was sufficient, if the original patent issued before July 20, 1870, but otherwise the oath of the inventor was required, see *National Car Spring Co. v. Union Spring Mfg. Co.* (1874), 6 O. G. 224; 12 Blatch. 80.

That where an assignee filed an application for a re-issue before July 20, 1870, his oath alone was sufficient, see *National Spring Co. v. Union Car Spring Mfg. Co.* (1874), 6 O. G. 224; 12 Blatch. 80.

That an applicant for a re-issue who has assigned his interest, and is still obliged to make oath that the mistake occurred "through inadvertence, etc.," is not merely a formal party and a perfunctory affiant, and his assignee is bound by his statements and declarations, see *Ex parte Mahnken* (1887), 41 O. G. 1269.

² That the oath to a re-issue application must aver that the applicant believes that he is the original and first inventor, and that the invention was never before known or used, and must

allege his citizenship, see *Ex parte Whitely* (1886), 36 O. G. 1243.

That an affidavit, on an application for re-issue, that the original is "not fully valid and available" is not sufficient and the re-issue is void, see *Poage v. McGowan* (1883), 15 Fed. Rep. 398; *Whitely v. Swayne* (1865), 4 Fisher, 117.

That the rule requiring a detailed statement under oath is imperative, and unless observed the application will not be examined, see *Ex parte Whitely* (1886), 36 O. G. 1243; *Ex parte Timken* (1883), 24 O. G. 1088.

That the rule requiring a statement to be filed with a re-issue application, accounting for the defects in the original, is not retroactive, see *Ex parte Pfaudler*, (1882), 23 O. G. 269.

That the statement required to be filed with a re-issue application must set out the facts on which the application is based, not merely the opinions or conclusions of the person who prepares the paper, pointing out the defects which render the original invalid and showing

patents for the same invention, if any have been issued to the applicant or to others by his consent, with their dates and numbers and the extent to which the invention has been used in the United States, in the same manner as on an original application.³

§ 706. Procedure on Applications for Re-issue : The Specification, Drawings, and Model.

The language of the amended specification must correspond with that of the original unless some sufficient reason for a change appears. In an original Description the widest latitude in the use of terms may be permitted, but in the re-issue specification, where the identity of the invention must, at all hazards, be preserved, no unnecessary divergence from the words in which it was originally stated can safely be allowed. New names, new uses, new descriptive matter tend to create uncertainty in this respect, and may easily be made to cover some unwarrantable departure from the original invention. Except where the correction of the errors in the previous description requires the employment of additional or substituted phrasology, the rules followed by the Patent Office in passing upon the formal sufficiency of the amended specification, therefore, restrict it to the statements made in the original.¹ New drawings must accompany the specifica-

how they arose, see *Ex parte* Timken (1883), 24 O. G. 1088; *Ex parte* Wilkins (1883), 24 O. G. 1270; *Ex parte* Pfaudler (1882), 23 O. G. 269.

That a statement of reasons for re-issue, which merely alleges "misunderstanding," is not sufficient, see *Ex parte* Wilkins (1883), 24 O. G. 1270.

That, except for the Patent Office rules, the invalidity of the original need not be sworn to, and though an oath were required its omission would not invalidate the re-issue, see *Hartshorn v. Eagle Shade Roller Co.* (1883), 25 O. G. 1191; 18 Fed. Rep. 90; *Burr v. Duryee* (1862), 2 Fisher, 275.

That it is not imperative on the Patent Office that the fact that the

original is inoperative, should have been judicially ascertained, see *Burr v. Duryee* (1862), 2 Fisher, 275.

³ That under the rules re-issue as well as original applications require an oath disclosing foreign patents and the extent of use in the United States, see *Ex parte* Beck (1880), 17 O. G. 329.

§ 706. ¹ In *Ex parte* Underwood (1872), 1 O. G. 549, Leggett, Com. : (549) "In applications for patents the examiner should interfere as little as possible with the language chosen by the applicant in describing his invention. The largest latitude should be allowed; but in applications for re-issues a different rule does and should prevail. The applicant should be held

tion when the invention is capable of such delineation, conforming in their style, number, and artistic perfection to the regulations governing original drawings. These new drawings are allowed to vary from the old only where the variation appears in the original model or relates to some unimportant matter not affecting the invention claimed. The amendment of the model is, in like manner, limited to features found in the original drawings.

§ 707. Procedure on Applications for Re-issue: Filing of the Application in the Patent Office.

The application, thus composed, is presented to the Patent Office by forwarding it in the usual mode to the Commissioner, accompanied by the statutory fees. This entitles the applicant to the consideration of his case, and if the Commissioner refuses to proceed with its examination, he may be compelled to do so by mandamus.¹ A hearing on an application for re-issue takes precedence over those on ordinary applications, and will be particularly expedited if the term of the original patent has almost expired.² The filing of the

rigidly to the language adopted in his patent, except that a good reason appears for departing from such language. In objecting to the use of new terms, new descriptive matter, etc., the examiner is not bound to give reasons. It is enough that such terms and descriptive matter are new; and it devolves upon the applicant to show good reason for their introduction, or they must be stricken out. A different rule would open a wide door to fraud. A patentee, if allowed to interpolate new uses, new descriptive matter, new names, etc., might, by frequent re-issues, keep full pace with the advancement in the art to which his patent pertains, and might thus appropriate to his own use the improvements and inventions made by others. The rule should be: *liberality with original applications; strict construction with applications for re-issue.*"

See also *Hatch v. Moffitt* (1883), 15 Fed. Rep. 252.

That the specification of the re-issue may be made more full and precise than the original, in order to cover the real invention, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 4 Fed. Rep. 900; 10 Bissell, 65; 19 O. G. 173.

That a re-issue containing a broad Claim binds the patentee even though it does not secure his invention, see *Wisner v. Grant* (1880), 18 O. G. 192; 7 Fed. Rep. 922.

§ 707. ¹ That where an applicant for a re-issue has filed his application and paid his fees and done all he can to make the application effectual, it is the duty of the Commissioner to hear it although he may not have accepted the fees, and if he refuses, a mandamus will lie to compel a hearing, see *Commissioner v. Whitely* (1866), 4 Wall. 522.

² That where a patent has nearly expired, its re-issue may be expedited in the Patent Office, see *Ex parte Evarts* (1874), 5 O. G. 429.

application does not preclude the applicant from resuming his rights under the former patent; but at any time before the re-issue has been granted he may withdraw his application, revoke his surrender, and be restored to his original position.⁸

§ 708. Procedure on Applications for Re-issue: Examination of the Application on the Merits of the Invention.

The specification annexed to a re-issue application is subject to revision, restriction, division, and other formal corrections in the Patent Office, to the same extent as an original specification.¹ An examination of the application on its merits involves an inquiry into the patentability of the invention therein described and claimed, into the identity of such invention with the invention attempted to be covered by the former patent, and into the cause from which

⁸ In *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379, Clifford, J. : (385) "The surrender is, undoubtedly, as is contended by the respondents, the act of the party making the application; but it is a mistake to suppose that the application may not be withdrawn, under leave of the Commissioner, for good cause shown, at any time before the proceedings are fully completed and duly recorded. The re-issued letters-patent, as a general rule, have the effect to supersede the original patent, but a pending application for that purpose cannot receive any such construction, no matter how nearly the proceedings may have approached to a consummation, so long as they are not finally completed. Prior to the issuing of the new patent, what is called a surrender in the case is in general nothing more than a preliminary offer to that effect, as the necessary means of obtaining a re-issue; and even when not so intended in the outset it may be subsequently so treated by the Commissioner, at the request of the party applying for the re-issue."

§ 708. ¹ That the re-issue application will not be examined unless the statement is sufficient, see *Ex parte Timken* (1883), 24 O. G. 1089.

That the Claims of a re-issue application will not be examined on their merits in connection with the sufficiency of the statement, but in their proper order, see *Ex parte Timken* (1883), 24 O. G. 1089.

That in a re-issue application the examiner must first determine the sufficiency of the application itself; and if the applicant is not entitled to a re-issue the proceedings will terminate, but if the application and statement are sufficient an examination on the merits will be had, and if it then appears that the original was not inoperative, etc., or that its defects did not result from mistake, etc., or that the claim of the applicant is barred by the references cited, etc., the application will be rejected, the reasons for the rejection stated, and an opportunity given for an appeal, see *Ex parte Ernst* (1885), 33 O. G. 235.

the alleged error in the original arose. In examining the patentability of the invention the same questions as to its novelty, utility, abandonment, and the priority of the applicant's inventive act, are presented as on original applications, and the claim of the applicant as to any one of these questions is not aided by the fact that the invention has already once received the protection of a patent, and that the validity of the patent has been vindicated in the courts.² Even the repetition in the re-issue application of the exact Claims of the original patent does not exempt them from this examination or from the judgment which may be pronounced upon them by the Patent Office. The novelty of the invention is determined according to the state of the art at the date of the original application, not at that of the re-issue, since if the invention was then new to the public no subsequent advances in the arts can deprive it of the novelty which it possessed when the inventor first endeavored to protect it.³ Its utility is measured by the usual standards. Abandonment is evidenced by more than two years' public use and sale before the original application, by an omission to claim it in the original patent after clearly describing it and an unreasonable delay in curing the omission by a re-issue, and by any other conduct of the inventor, either before or since the issue of the original patent, which proves an intention upon his part to dedicate the invention to the public.⁴ That the invention

² That in an application for a re-issue, its Claims are subject to revision by the Patent Office though they have been sustained by the courts, see *Ex parte Cox* (1873), 3 O. G. 2.

³ That on an application for a re-issue the patentability of the invention will be examined in view of the state of the art at the time when the original patent was applied for, see *Carroll v. Morse* (1876), 9 O. G. 453; *Carlton v. Bokee* (1872), 17 Wall. 463; 2 O. G. 520; 6 Fisher, 40.

That on an application for a re-issue the right of the re-issue applicant to the inventions claimed in his re-issue application will be examined in view of the

state of the art as indicated by inventions made both before and since the original was granted, and by the claims of rival inventors, see *Sargent v. Burge* (1876), 10 O. G. 285.

That the re-issue is void for want of novelty if the original was, see *Jones v. McMurray* (1877), 3 Bann. & A. 130; 2 Hughes, 527; 13 O. G. 6.

⁴ That on an application for a re-issue two years' public use of the invention before the original application may be shown, and will be fatal, see *Fuuck v. Doty* (1878), 14 O. G. 157.

That for all purposes of abandonment by public use and sale, the date of the re-issue is the date of the original,

was first conceived and reduced to practice by the alleged inventor is established *prima facie* by the oath accompanying the application, but may be contradicted by the records of the Patent Office or the personal knowledge of the examiner. The practice in regard to the objections and references of the examiner, as well as to amendments, arguments, rejections, and appeals, is similar to that in cases of original applications.

§ 709. Procedure on Applications for Re-issue: Examination of the Application as to the Identity of the Invention with that Described in the Original Patent.

In examining the identity of the invention claimed in the re-issue application with that attempted to be covered by the original patent, the examiner must be guided, not by his personal judgment or discretion, as in amendments to original applications, but by the rules specifically prescribed in the statutes and the decisions of the courts. The inventions are not identical unless all the essential characteristics of the one described and claimed in the re-issue application were described or attempted to be described in the original specification, drawings, or model as part of the patented invention.¹ In a machine-patent, for reasons hitherto recited, this identity must appear by a comparison of the drawings and models, which can be amended only by each other.² In other cases where drawings and models exist, the identity is determined

see *Shaw v. Colwell Lead Co.* (1882), 11 Fed. Rep. 711 ; 20 Blatch. 417.

That Sec. 32, act of 1870, making two years' delay in prosecuting an application an abandonment of it, does not relate to re-issue applications, see *Ex parte Galusha* (1873), 3 O. G. 321.

That things abandoned before the issue of the original patent cannot be claimed in the re-issue, see *Ex parte Conklin* (1872), 2 O. G. 543.

§ 709. ¹ That on an application for a re-issue, parol evidence is not admissible to enlarge the scope of the invention beyond that shown in the original specification, drawings, and model, see *Glue*

Co. v. Upton (1874), 6 O. G. 837 ; 4 Clifford, 237 ; 1 Bann. & A. 497 ; *Collar Co. v. Van Deusen* (1874), 23 Wall. 530 ; 7 O. G. 919 ; *Cahart v. Austin* (1865), 2 Clifford, 528 ; 2 Fisher, 543.

² That under the act of 1870 the Commissioner, in allowing a re-issue, cannot look outside the original specification, drawings, and model, except that in machine-patents, where the model is no longer in existence, extrinsic proof may be examined to determine what the machine really was, see *Giant Powder Co. v. California Powder Works* (1875), 3 Sawyer, 448 ; 2 Bann. & A. 131.

by comparing the entire descriptions, as contained in these and in the specifications to which they are annexed, with one another. Where there are no drawings or models, and the description in both the original and the re-issue applications, therefore, rests in words alone, extrinsic proof may be offered and received to establish this identity.³

§ 710. Procedure on Applications for Re-issue: Examination of the Application as to the Mode in which the Defects in the Original Arose.

The examination into the cause from which the alleged error in the original arose may be conducted according to the discretion of the Commissioner, provided it be done without prematurely disclosing the pendency of the re-issue application. The affidavit of the applicant is *prima facie* proof that the error occurred through inadvertence, accident, or mistake, and without fraudulent or deceptive intention; but this is open to contradiction or to confirmation by the records of the Patent Office, the affidavits of its officers, or any other evidence satisfactory to the Commissioner which can be obtained without a violation of the secrecy to which the applicant is entitled. The existence of this condition must be established before the re-issue can be legally allowed.¹ But

³ That on an application for a re-issue the Commissioner may examine the original specifications, drawings, model, or any other legal proof, in order to ascertain the identity of the inventions, see *Hussey v. Bradley* (1863), 2 Fisher, 362; 5 Blatch. 134.

That where no model or drawing accompanies the original patent great care should be exercised to exclude new matter from the re-issue, see *Ex parte Gottstein* (1877), 11 O. G. 1061.

That extraneous evidence as to a model destroyed by fire, or other lost records, will not be received on a re-issue application, see *Ex parte Williams* (1878), 14 O. G. 202.

§ 710. ¹ That no re-issue ought to be allowed by the Commissioner unless the applicant shows that the original was

defective through mistake, and not through fraud, and points out in what the mistake consisted, see *Ex parte Conklin* (1874), 1 MacArthur, 375; 5 O. G. 235.

That an assignee cannot re-issue to cover additions unless he proves that the additions were made by the inventor, and were intended to be patented by him, and were omitted by mistake, see *Opinion Atty. Gen.* (1833), 2 Op. At. Gen. 572.

That the testimony of the patentee, who re-issued his patent after thirteen years, that "he thought" the original was defective and ought to cover the additional matter, does not prove original inadvertence or mistake, see *Newton v. Furst & Bradley Mfg. Co.* (1886), 119 U. S. 373; 38 O. G. 104.

the question relates to the intention of the inventor at the date of his original application, not to his conduct since that time, except so far as it throws light on his intention then; and if the error then was unintentional, his subsequent attitude toward individual third parties cannot estop him from asserting his right to amend his patent.²

§ 711. Procedure on Applications for Re-issue : Interferences.

An application for a re-issue is liable to be placed in interference with a pending original application, with another application for re-issue, or with an unexpired patent, whenever the inventions claimed in each are apparently identical. An interference will be declared, under the rules, between an application for a re-issue and a conflicting original application, if the original application was pending when the patent whose re-issue is desired was granted, or if the party presenting the original application makes oath that he performed his own inventive act before the filing of the application for the patent upon which the proceedings in re-issue have been based. An interference will be declared between two or more conflicting applications for re-issue when their respective patents were granted upon applications pending at the same time, or when the applicant for the re-issue of the later patent avers on oath that his inventive act preceded the filing of the application for the earlier patent. An interference will be declared between an application for a re-issue and a conflicting unexpired patent when the original applications for both patents were pending at the same time, and the re-issue applicant makes oath that his inventive act occurred before the original application of the other patentee

² That an applicant for a re-issue is not estopped from claiming it by his conduct toward outside parties, see *Ex parte Roe* (1874), 5 O. G. 397. This case rests upon the doctrine that an estoppel in favor of individual parties does not enure to the public benefit, and is consequently no bar to a re-issue of the patent as against the public. But if it be true, as many cases seem to indicate, that an inventor may estop himself to claim the inven-

tion as against the public, or that estoppel may constitute one step in that series of events which results in an abandonment of the invention to the public by the act of some rival inventor, there is no reason why a re-issue applicant should not be bound by his commissions or omissions to the same extent as any other claimant of an invention. See §§ 346, 357, 390, and notes, *ante*.

was filed, or when the original application for the patent whose re-issue is desired was filed after the other patent had been granted and the re-issue applicant presents an affidavit that his invention was completed before the filing of the application for the earlier patent. Where an interference has been declared between a patent and an application, and pending the interference an application is made for the re-issue of the patent, the re-issue application is examined on its individual merits, and if allowed, will take the place of the original patent in the interference.¹ A re-issue application, describing but not claiming an invention involved in interference, may be amended by the insertion of such Claim and be, thereupon, admitted to the contest. The proceedings upon an interference are the same whether the applications are for a re-issue or for an original patent.

§ 712. Procedure on Applications for Re-issue: Appeals.

From an adverse decision of the examiners upon any question relating to the merits of the application, an appeal lies to the examiners-in-chief, and thence successively to the Commissioner, the Supreme Court of the District of Columbia, and to the Supreme Court of the United States, except in interference cases, where the decision of the Commissioner is final. Although an application for re-issue has been duly allowed and passed by the examiners, the patent is still subject to the control of the Commissioner, and like an original patent may be withheld by him upon sufficient grounds.¹ If

§ 711. ¹ That where the original patent is in interference, and not the re-issue-application, the re-issue-application will be examined, and on the surrender and cancellation of the original patent will be substituted for it, see *Ex parte Zay* (1881), 19 O. G. 1496.

That where the re-issue-application contains no Claim involved in the interference declared with the original, the application should not be placed in interference, see *Ex parte Zay* (1881), 19 O. G. 1496.

That where a patent has been surrendered for re-issue, an interference de-

clared, an adverse decision rendered, and a re-issue refused, the patent is entirely avoided, see *Peck v. Collins* (1881), 103 U. S. 660; 19 O. G. 1137.

§ 712. ¹ That a re-issue patent, though signed, may be withheld on account of a protest against its issue, see *Ex parte Hunt* (1879), 15 O. G. 831.

That after the Patent Office decides to re-issue a patent, a stranger cannot have access to the records of the proceedings in order to discover objections and contest it, see *Dec. Sec. Int.* (1883), 23 O. G. 629.

refused by one Commissioner his successor should not grant it without a careful re-examination of the case, and a clear conviction that the former judgment was erroneous.²

§ 713. Date and Term of Re-issued Patent.

A re-issued patent bears the date of the original for all purposes, except as the foundation of an action for infringement.¹ When the term of the re-issue is expressed in years, the term runs from the grant of the original.² When the original was limited by the duration of a foreign patent, the re-issue is subject to the same limitation.³ The rights of all parties claiming under the re-issue, whether as against the public or against rival claimants, are held to have accrued when the original patent issued, and are interpreted and enforced according to the circumstances then existing.⁴ All rights of action for the infringement of the original patent are, however, extinguished by its surrender, and suits pending at the date of the re-issue are abated.⁵

² That a re-issue withheld by one Commissioner will not be granted by his successor without a careful examination of the case, see *Ex parte Hunt* (1879), 15 O. G. 831.

§ 713. ¹ That the re-issue bears the date of the original, except as to suits for infringement, see *House v. Young* (1867), 3 Fisher, 335; *Hussey v. Bradley* (1863), 2 Fisher, 362; 5 Blatch. 134; *Bloomer v. Stolley* (1850), 5 McLean, 158; *Woodworth v. Hall* (1846), 1 W. & M. 248; 2 Robb, 495; *Stanley v. Whipple* (1839), 2 McLean, 35; 2 Robb, 1; *Shaw v. Cooper* (1833), 7 Peters, 292; 1 Robb, 643; *Grant v. Raymond* (1832), 6 Peters, 218; 1 Robb, 604.

That the decision of the Commissioner that the date of the invention described in the re-issue was the date of the original patent is final, see *House v. Young* (1867), 3 Fisher, 335.

² That a re-issue granted for a specific term begins at the date of the original patent, see *Whitely v. Fisher* (1870), 4 Fisher, 248.

³ That the law, not the language of the patent, decides when a re-issue becomes operative, see *Whitely v. Fisher* (1870), 4 Fisher, 248.

⁴ That the rights of the patentee under the re-issue are governed by the law in force at the date of the original, see *Shaw v. Cooper* (1833), 7 Peters, 292; 1 Robb, 643.

⁵ That the surrender extinguishes the original patent, and all rights of action under it fall with it, see *Jones v. Barker* (1882), 22 O. G. 771; 11 Fed. Rep. 597; *Peck v. Collins* (1880), 103 U. S. 660; 19 O. G. 1137; *Moffitt v. Gaar* (1861), 1 Black, 273.

That as all pending suits fail with a surrender of the patent for re-issue, there can be no continuance to obtain a re-issue, see *Jones v. Barker* (1882), 22 O. G. 771; 11 Fed. Rep. 597.

That a re-issue can affect only suits subsequently begun, see *United States Stamping Co. v. King* (1879), 17 O. G. 1399; 17 Blatch. 55; 7 Fed. Rep. 860; 4 Bann. & A. 469.

§ 714. **Decision of Commissioner in Allowing a Re-issue, how far Conclusive.**

The effect of a decision of the Commissioner in granting a re-issue, and the extent to which his decision is reviewable by the courts, are questions which have given rise to much discussion.¹ Upon principle, the problem seems to be a simple

§ 714. ¹ Upon the effect of the award of a re-issue by the Commissioner the courts are to this day undecided, and the judgments of different tribunals are apparently irreconcilable. In several earlier cases it was held that the action of the Commissioner was conclusive unless fraud in obtaining and allowing the re-issue was alleged and proved. His power to determine the identity of the inventions covered by the re-issued and original patents was treated as final, and except in such palpable and unwarranted enlargements as implied a fraud, the re-issue could not on this ground be impeached. Thus in *Whitely v. Swayne* (1865), 4 Fisher, 117, Leavitt, J. : (123) "It is insisted by the counsel for the complainant, that the decision of the Commissioner of Patents in granting the re-issues is conclusive, and that the court cannot look into anything that transpired antecedently to the grant to impeach the validity of the re-issued patent. This is undoubtedly the settled law in this country, so far at least as to the identity of the original invention, and the invention as described and claimed in the application for the re-issue, unless fraud in the transaction is alleged. The Commissioner is supposed to have all the qualifications necessary to an intelligent decision of that question, and there are strong reasons why his action should be regarded as final. Such I understand to be doctrine of the Supreme Court of the United States, as announced in numerous reported cases. 4 How. 404 ; 15 How. 62 ; 17 How. 84 ; Law's Dig. 617. But I am not aware that the Supreme

Court have decided in any case that it is not competent to inquire whether the Commissioner has exceeded his authority in granting a patent, without a compliance with the requirements of the statute. He has clearly no power to dispense with what the statute declares to be necessary prerequisites to the grant. And if it appears from the papers and records of the Office in evidence that the statutory requirements have not been complied with, it is within the power of a court, and its plain duty, to hold the patent to be void. Such was the doctrine announced by Judge Hall in the case of *Ransom v. Mayor of New York*, Law's Dig. App. 57. The learned judge says : 'Things specified in this section (6th section of the act of 1836) are prerequisites to the granting of a patent, and unless these prerequisites are complied with, a party sued for an infringement of the patent may show that they have not been complied with, and in that mode defeat the action of the supposed inventor.' The soundness of this doctrine cannot be successfully controverted. It would be straining the doctrine of presumptions in favor of the legality of the acts of a public officer to an unreasonable extent to hold that a patent is legal and valid where the records and papers of the Office show conclusively that essential statutory provisions had been disregarded."

Also in *Swift v. Whisen* (1867), 3 Fisher, 343, Leavitt, J. : (351) "But the statute makes it the special duty of the Commissioner of Patents to examine closely every application for a re-

one. The Commissioner is a judicial officer, empowered under

issue, and he is vested with no authority to grant a re-issue except under circumstances where the statute has been complied with. It is to be supposed, in support of the exercise of the authority of the Commissioner of Patents under the law, that all the requisites of the statute have been complied with, and hence it is the uniform doctrine of all the courts of the United States that they will presume that the law has been complied with, and they refuse, except under special circumstances referred to in the act, to go into any inquiry back of the grant by the Commissioner of Patents of these re-issues; in other words, to a certain extent they consider the action of the Commissioner upon the right of parties to a re-issue to be conclusive; presuming that all the requirements of the law have been enforced, have been complied with, in the case. The decisions upon the general doctrine to which I have referred, namely, to the effect that the action of the Commissioner is conclusive upon the question of the identity of the inventions embraced or described in the re-issue and in the original patent, would seem to be harmonious. There is no case, that I am aware of, in conflict with this general proposition; and these decisions rest upon the fact that in deciding whether the re-issue is for the same invention, the Commissioner of Patents, who acts, of course, under the obligation of an oath, acts in that particular in a judicial capacity. His decisions, therefore, on points of that kind, have the force and effect of judicial decisions, and courts are reluctant to go back of those decisions and to inquire whether the re-issue has been properly granted or not, except in cases where it is made apparent that the re-issue was obtained by fraud, or for the purposes of deception and imposition.

But if any facts appear in the progress of a trial, which are sufficient to satisfy a jury that there has been fraud in the procurement of a re-issue, — either actual fraud, or circumstances which may be supposed to amount to constructive fraud, — the re-issued patent will be held invalid. There is a plain distinction between actual fraud and constructive fraud. The statute refers, specially, to cases of collusion, — fraudulent, corrupt collusion between the applicant for the patent and the Commissioner of Patents. If it is apparent that there has been any improper collusion between them, and that the patent has been granted corruptly, then, of course, that is an act of positive fraud that will invalidate any patent to which it applies. And there may be also constructive fraud, where it is made manifest that the re-issued patent is fraudulently extended beyond the claims of the original patent for a deceptive purpose, for the purpose of imposition upon the public, and where there is no just foundation for such a claim in the original patent; where, in fact, the re-issue goes altogether beyond the scope of the original invention and incorporated an element that was not contemplated or intended by the original patentee in his original patent. Cases of this kind have occurred in the progress of the execution of the patent laws of the country where re-issues have been fraudulent, — that is, where they have been tainted with this constructive fraud; where it appeared that, for a deceptive purpose, a party applying for a re-issue had sought to embrace an element in the re-issued patent that was not claimed and did not pertain to the original invention, for the purpose of taking advantage of other parties in the community who were using that element which he had fraudulently

certain circumstances to issue letters-patent, and while acting

made a part of his original invention." 2 Bond, 115 (125).

See also *Jordan v. Dobson* (1870), 2 Abbott, 398 ; 7 Phila. 533 ; 4 Fisher, 232.

It soon, however, became evident that the imputation of such comprehensive powers to the Commissioner on a mere *ex parte* proceeding was at variance with the rights of individuals and with public policy. The position was then adopted by the courts that whenever it appeared on the face of the original and re-issued patents that the inventions embraced therein were not identical, the Commissioner had exceeded the authority conferred upon him by the statutes and that the award of the re-issue might be held invalid ; and, on the other hand, that where the want of identity was not apparent on comparing the two patents, the action of the Commissioner could not be impeached on any ground whatever, except for fraud in allowing the re-issue, and this only in a proceeding instituted for that purpose. This position has been maintained in numerous cases and is still adhered to by many of our courts. Thus in *Seymour v. Osborne* (1870), 11 Wall. 516, Clifford, J. : (543) "Where the Commissioner accepts a surrender of an original patent and grants a new patent, his decision in the premises, in a suit for infringement, is final and conclusive, and is not re-examinable in such a suit in the Circuit Court, unless it is apparent upon the face of the patent that he has exceeded his authority, that there is such a repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the new patent is not for the same invention as that embraced and secured in the original patent."

In *Jordan v. Dobson* (1870), 4 Fish-

er, 232, Strong, J. : (237) "It must be assumed, therefore, he did determine there were defects in the former specifications arising from inadvertence, accident, or mistake, without any fraudulent intention. And having thus determined, his decisions are conclusive. They are not re-examinable, except so far as he decided there was no fraud. It is now settled that the granting of a renewed patent is so far conclusive upon the question of the existence of error in the original patent arising from inadvertency, accident, or mistake, that it leaves nothing open but the fairness of the transaction. *Stimpson v. Westchester R. R. Co.*, 4 Howard, 380 ; *Woodward v. Stone*, 3 Story, C. C. R. 749 ; *Allen v. Blunt*, 3 Story, C. C. R. 742 ; *Curtis on Patents*, 280." 2 Abbott, 398 (404) ; 7 Phila. 533 (536).

In *Collar Co. v. Van Dusen* (1874), 23 Wall. 530, Clifford, J. : (558) "Unless, however, it is apparent upon the face of the new patent that the Commissioner has exceeded his authority, his decision is final and conclusive, as the jurisdiction to re-issue patents is vested in him subject to a single exception, that if there is such repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the re-issued patent is not for the same invention as that embraced and secured in the original patent, then the re-issued patent is invalid." 7 O. G. 919 (920).

In *Wells v. Jacques* (1874), 1 Bann. & A. 60, Nixon, J. : (68) "His application is made to the Commissioner of Patents, and that officer, not this court, is the tribunal in which Congress has vested the power of determining whether sufficient reasons exist to grant the re-issue. His decision in the matter is final, in the sense that there is no appeal from it ; and it does not seem to

within his jurisdiction his judgments are conclusive and can-

be re-examinable here, unless it is evident upon the face of the re-issue that he has exceeded his authority, and that there is such a repugnancy between the old and the re-issued patent that it must be held, as a matter of legal construction, that they are not the same invention. *Seymour v. Osborne*, 11 Wall. 543." 5 O. G. 364 (366).

In *Birdsall v. McDonald* (1874), 6 O. G. 682, Swayne, J. : (683) "The Commissioner of Patents awarded the re-issue. The subject was placed by the law within his jurisdiction. His decision is to be held *prima facie* correct in all cases, and it is conclusive, unless impeached for fraud, or unless it is clear upon the face of the several specifications that the re-issue is not for the same thing as the original patent. Where a remedy is sought for fraud it must be in an independent proceeding had directly for that purpose by a bill in equity in the name and by the authority of the United States." 1 Bann. & A. 165 (170).

In *Russell v. Dodge* (1876), 93 U. S. 460, Field, J. : (464) "The decision of the Commissioner in granting the re-issue is, it is true, so far conclusive as to preclude in the present suit for infringement any inquiry into its correctness outside of the patents themselves. His action, in any case within the limits of his authority, is not open to collateral impeachment. But that authority being limited to a re-issue for the same invention as that embraced in the original patent, a re-issue for anything more is necessarily inoperative and void. To determine the identity of the invention the two patents may be compared. Thus compared, the re-issue here appears on its face to be for a different invention, and the Commissioner, therefore, exceeded his authority in issuing it." 11 O. G. 151 (152).

In *Kells v. McKenzie* (1881), 20 O. G. 1663, Brown, J. : (1663) "Under this section it is now settled that the decision of the Commissioner re-issuing the patent is final and conclusive, and is not subject to review in any court, except as to the identity of the invention. But if it be apparent upon the face of the patent that he has exceeded his authority, and has thus acted without jurisdiction, and that there is a manifest repugnancy between the old and new patent, then it must be held, as a matter of legal construction, that the new patent is not for the same invention as that embraced and secured in the original patent." 9 Fed. Rep. 284 (286).

In *Spaeth v. Barney* (1885), 22 Fed. Rep. 828, Colt, J. : (829) "The authorities are numerous and conclusive to the effect that where the Commissioner accepts the surrender of an original patent, and grants a new patent, his decision is final and conclusive in a suit for infringement, unless it is apparent on the face of the patent that he has exceeded his authority; that there is such a repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the new patent is not for the same invention as that embraced in the original patent." 30 O. G. 997 (997).

To the same effect see *American Diamond Rock Boring Co. v. Sheldon* (1879), 17 Blatch. 208; *Thomas v. Shoe Mach. Mfg. Co.* (1878), 16 O. G. 541; 3 Bann. & A. 557; *Russell v. Dodge* (1876), 93 U. S. 460; 11 O. G. 151; *Union Paper Collar Co. v. White* (1875), 11 Phila. 479; 7 O. G. 698, 877; 2 Bann. & A. 60; *La Baw v. Hawkins* (1874), 1 Bann. & A. 428; 6 O. G. 724; *Miligan & Higgins Glue Co. v. Upton* (1874), 6 O. G. 837; 4 Clifford, 237; 1 Bann. & A. 497; *Nicholson Pave-*

not be collaterally attacked.² If he exceeds the limits of his jurisdiction, as fixed by law, his acts are void.³ The courts

ment Co. v. Elizabeth (1873), 3 O. G. 522 ; 6 Fisher, 424 ; Parham v. American Buttonhole, Overseaming, & Sewing Machine Co. (1871), 4 Fisher, 468 ; Chicago Fruit House Co. v. Busch (1871), 2 Bissell, 472 ; 4 Fisher, 395 ; Blake v. Stafford (1868), 6 Blatch. 195 ; 3 Fisher, 294 ; Middletown Tool Co. v. Judd (1867), 3 Fisher, 141 ; Potter v. Holland (1858), 4 Blatch. 235 ; 1 Fisher, 382.

That a re-issue cannot be attacked by an infringer unless fraudulent or contrary to law or issued to the wrong party, see Dental Vulcanite Co. v. Wetherbee (1866), 3 Fisher, 87 ; 2 Clifford, 555.

The abuses which arose under this doctrine were its inevitable consequence. As any re-issue which the Patent Office could be prevailed upon to grant, whether it were for the original invention or not, and whether the defects which it corrected were intentional or otherwise, became impregnable in the courts unless the repugnancy between it and the original was manifest on the inspection of the two patents, patentees whose original patents covered all they had invented or at that time thought of claiming as their inventions, naturally took advantage of the general and indefinite language of their original specifications, and based upon them re-issue claims far beyond the limits of their own inventive acts, and under this doctrine vindicated their unwarranted assumptions even in the highest tribunal of the nation. In the effort to prevent or thwart these abuses the courts had recourse to various theories, in order, if possible, to remedy the evil without placing a further limitation on the powers of the Commissioner. By holding that the decision of the Patent Office on the origin of the amended defect, as

well as on the identity of the inventions, was reviewable, they would at once have removed all difficulty ; since by permitting an inquiry into the character of the actual invention, and the intentional or unintentional omission or misstatement in the original specification, they would have limited every re-issued patent to the exact inventions which the patentee originally intended to secure. Reverence for the settled course of decisions forbade this heroic remedy and led to the introduction of other doctrines, intended to protect intervening public and private rights, which have in their turn created new difficulties and required perpetual explanation and modification in the courts. The current of legal and judicial opinion, however, seems to be moving steadily toward the only true solution of this question, as set forth in the remainder of this paragraph and in the cases cited in its notes.

² That the Commissioner's action in granting a re-issue is not open to review in cases where he has jurisdiction, see Ball v. Langles (1880), 102 U. S. 128 ; 18 O. G. 1405 ; Wells v. Gill (1872), 2 O. G. 590 ; 6 Fisher, 89.

³ In Odell v. Stout (1884), 22 Fed. Rep. 159, Sage, J. : (161) "The action of the Commissioner of Patents is not *res adjudicata*. Cook v. Ernst, 2 O. G. 89. He is not an officer in whom, under the constitution, judicial power can be vested. Grant v. Raymond, 6 Pet. 242. If he were, the proceedings for procuring original letters and re-issues are *ex parte* and would not estop defendants, charged as infringers, upon questions affecting the validity of the patent. But the statutes, prescribing his powers and duties, vest in the Commissioner of Patents a discretion, which in some matters is final, and in others subject

have power to inquire whether a given act was within his jurisdiction or exceeded it, and according to the result of this inquiry they may treat his act as valid or invalid.⁴ In refer-

to review. The authorities are not uniform; but the later cases, and some of not so recent date, are in harmony with the ruling made by Chief Justice Marshall in *Grant v. Raymond*, that the correct performance of all those preliminaries on which the validity of an original patent or of a re-issued patent depends, is always examinable in the court in which a suit for its violation is brought." 29 O. G. 862 (863).

In *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 18 O. G. 1339, Field, J. : (1340) "The Commissioner is an officer of limited authority, and whenever it is apparent upon inspection of the patents that he has acted without authority or has exceeded it, his judgment must necessarily be regarded as invalid." 6 Sawyer, 508 (522); 4 Fed. Rep. 720 (725).

In *Glue Co. v. Upton* (1874), 6 O. G. 837, Clifford, J. : (838) "Jurisdiction to re-issue patents is vested in the Commissioner, and his decision in such an application is final and conclusive, and not re-examinable in a suit in the Circuit Court, unless it is apparent upon the face of the patent that the Commissioner has exceeded his authority, or that there is such a repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the new patent is not for the same invention as that embraced and secured in the original patent." 4 Clifford, 237 (239); 1 Bann. & A. 497 (499).

That Sec. 4916, Rev. Stat., does not enlarge the powers of the Commissioner on a re-issue, see *Powder Co. v. Powder Works* (1878), 98 U. S. 126; 15 O. G. 289.

That the decision of the Commissioner on a re-issue is not final except within his jurisdiction, see *Flower v.*

Rayner (1881), 19 O. G. 425; 5 Fed. Rep. 793; *Metropolitan Washing Mach. Co. v. Providence Tool Co.* (1872), Holmes, 161.

That no patent, whether re-issue or original, can be legal if the statutory prerequisites are not fulfilled, and where the non-fulfilment appears on the face of the patent or by the records of the Patent Office, the Commissioner has evidently exceeded his jurisdiction and the patent is void, see *Whitely v. Swayne* (1865), 4 Fisher, 117.

⁴ In *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 18 O. G. 1339, Field, J. : (1340) "As the power to accept a surrender and issue new letters is vested exclusively in the Commissioner of Patents, his decision in the matter is not open to collateral attack in a suit for the infringement of re-issued letters. His action, like that of all officers specially designated to perform a particular duty of a judicial character for the government, is presumed to be correct until impeached by regular proceedings to annul or modify it. He must judge, in the first instance, of the sufficiency of the original specification, whether the same is defective in any particular, whether such defect was the result of an unintentional error, and if so, to what extent a new or additional specification should be allowed to describe correctly the invention claimed; and it is to be assumed in every case that he has done his duty. The decisions of the Supreme Court to this effect are numerous, and the doctrine is among the settled rules of Patent Law. But it does not preclude the examination of the original and re-issued patents to see whether or not they disclose on their face a case in which the Commissioner had authority to act or whether

ence to re-issues the statutes confer on the Commissioner the power to amend a defective patent by re-issuing it in a corrected form. At the same time they prohibit the exercise of this power in such a manner as to introduce into the re-issue any new invention,⁵ or to cure any defect which was originally intentional, or fraudulent.⁶ In accepting a surrender and

he has exceeded his authority in issuing letters for an invention different from that described in the original patent. If they disclose a case in which the Commissioner has no jurisdiction to act, or a case in which, by his determination, he has exceeded his jurisdiction, the re-issued letters must fall. His determination can have no greater conclusiveness than that of the judgment of a regular judicial tribunal, and we all know that although such judgment cannot be collaterally attacked by showing that the evidence upon which the court acted was insufficient, that improper testimony was admitted, that the court erred in its rulings upon matters of law, or that the verdict of the jury was against the weight of evidence, yet the record of the judgment can in all cases be examined to see whether the court had jurisdiction of the subject-matter and of the person of the defendant, and if such jurisdiction be wanting the judgment is ineffectual for any purpose. So here upon all matters outside of the patents which the Commissioner was to hear, and upon the weight of which he was to determine, his judgment is conclusive in the present suit; but if the patents disclose a case in which he had no jurisdiction or in which he exceeded it, his determination carries with it no efficacy." 6 Sawyer, 508 (520); 4 Fed. Rep. 720 (723).

That where the Commissioner exceeds his authority in re-issuing a patent, under a mistake of law, the matter may be reviewed in actions for infringement, see *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657.

That the courts presume that in allowing a re-issue the Commissioner has done his duty, see *Spaeth v. Barney* (1885), 22 Fed. Rep. 828; 30 O. G. 997; *Jordan v. Dobson* (1870), 2 Abbott, 398; 7 Phila. 533; 4 Fisher, 232.

⁵ That the Commissioner has exceeded his jurisdiction when the re-issue on its face covers a different invention from that described in the original, see *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 6 Sawyer, 508; 4 Fed. Rep. 720; 18 O. G. 1339; *Bull v. Langles* (1880), 102 U. S. 128; 18 O. G. 1405; *Russell v. Dodge* (1876), 93 U. S. 460; 11 O. G. 151.

That Sec. 4916, Rev. Stat. governs the mode of proof but does not give the Commissioner power to grant a re-issue for a different invention, or to determine conclusively that inventions are the same, see *Averill Chemical Paint Co. v. National Mixed Paint Co.* (1881), 22 O. G. 585; 20 Blatch. 42; 9 Fed. Rep. 462; *Powder Co. v. Powder Works* (1878), 98 U. S. 126; 15 O. G. 289.

⁶ In *Flower v. Rayner* (1881), 5 Fed. Rep. 793, Nixon, J. : (795) "A careful reading of the section shows that the Commissioner has power to grant a re-issue only in special cases and under particular circumstances. The original patent must be inoperative or invalid, either for defective or insufficient specifications, or from claiming as new more than the patentee has the right to claim; and, in addition to this, the error which is sought to be corrected must have arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. If the party in-

granting a re-issue, the Commissioner, who has entire control over the language of a patent, thus acts within his jurisdiction, provided that the defects in the original patent arose without fraud, through inadvertence, accident, or mistake, and that no new matter is embraced in the re-issue. The courts cannot so far review this action as to declare that the original patent was not defective, that the surrender and re-issue were on that account of no effect, and that the original patent is consequently still in force. Nor can they hold that the original operative and valid patent was extinguished by the surrender, but that being originally valid and operative it could not be the subject of re-issue, and, therefore, that no patent in favor of the patentee can now exist. Endless confusion would arise if the jurisdiction of the Commissioner upon these points were not final.⁷ But on the other hand, where the Commissioner, in

interested can bring himself within these conditions and limitations, the Commissioner is authorized to issue a new patent for the same invention. When the original shows upon its face that the grounds and reasons for the re-issue do not exist, or where a comparison of the letters-patent disclose different inventions, the re-issue is void, as an act unauthorized by the law." 19 O. G. 425 (425).

See also *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 4 Fed. Rep. 720; 6 Sawyer, 508; 18 O. G. 1339.

That although other courts declare that the decision of the Commissioner in allowing a re-issue is final, the Supreme Court of the District of Columbia, on appeal from the decision of the Commissioner in refusing a re-issue do not hold such decision conclusive, but require evidence of original inadvertence, accident, or mistake, see *In re Conklin* (1874), 1 MacArthur, 375; 5 O. G. 235.

⁷ The recent disposition to treat the action of the Commissioner in awarding a re-issue as reviewable has, in one case,

carried the court so far that, in appearance at least, it has decided that the inoperativeness or invalidity of the original patent may be re-examined, and if the opinion of the court differs from that of the Commissioner on that question, the re-issue may be declared void. Thus in *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 4 Fed. Rep. 720, Field, J. : (723) "As thus seen, a re-issue can only be had when the original patent is inoperative or invalid from one of two causes, — either by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new; and even then the patentee can only obtain a re-issue where the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. As the power to accept a surrender and issue new letters is vested exclusively in the Commissioner of Patents, his decision in the matter is not open to collateral attack, in a suit for the infringement of re-issued letters. His action, like that of all officers especially designated to per-

accepting the surrender and granting the re-issue, has included in the re-issued patent any new matter, or any matter

form a particular duty of a judicial character for the government, is presumed to be correct until impeached by regular proceedings to annul or modify it. He must judge, in the first instance, of the sufficiency of the original specification, — whether the same is defective in any particular; whether such defect was the result of an unintentional error, and if so, to what extent a new or additional specification should be allowed to describe correctly the invention claimed; and it is to be assumed in every case that he has done his duty. The decisions of the Supreme Court to this effect are numerous, and the doctrine is among the settled rules of Patent Law. But it does not preclude the examination of the original and re-issued patents, to see whether or not they disclose on their face a case in which the Commissioner had authority to act, or whether he has exceeded his authority in issuing letters for an invention different from that described in the original patent. If they disclose a case in which the Commissioner had no jurisdiction to act, or a case in which by his determination he has exceeded his jurisdiction, the re-issued letters must fall. His determination can have no greater conclusiveness than that of the judgment of a regular judicial tribunal; and we all know that although such judgment cannot be collaterally attacked by showing that the evidence upon which the court acted was insufficient, that improper testimony was admitted, that the court erred in its rulings upon matters of law, or that the verdict of the jury was against the weight of evidence, yet the record of the judgment can in all cases be examined to see whether the court has jurisdiction of the subject-matter and of the person of the defendant;

and if such jurisdiction be wanting, the judgment is ineffectual for any purpose. So here, upon all matters outside of the patents which the Commissioner was to hear, and upon the weight of which he was to determine, his judgment is conclusive in the present suit; but if the patents disclose a case in which he had no jurisdiction, or in which he exceeded it, his determination carries with it no efficacy. This is general and universal law, although we find expressions in opinions that the only question left over for the consideration of the court, in a suit for infringement of re-issued letters, is whether the new and the old patent are for the same invention, — the expressions would be more accurate if they were, — that seldom could any other question be raised, for seldom will it appear without the consideration of extrinsic evidence whether or not the original patent was invalid or inoperative from a defect of specifications. Suppose, for illustration, that the specifications in two patents, the original and the re-issued, were identical in their language, — or, differing in phraseology, were identical in meaning, — would it be pretended that, though their identity would be thus manifest on their face from a comparison of the two, and that the Commissioner in granting the re-issue had accordingly acted in a case not warranted by the statute, it must be assumed that the re-issue was properly granted, and that the action of the Commissioner could not therefore be questioned? The decisions support no such conclusion. The Commissioner is an officer of limited authority; and whenever it is apparent upon inspection of the patents that he has acted without authority, or has exceeded it, his judgment must necessarily be regarded

which was fraudulently or intentionally excluded from the

as invalid. His action must be restricted to the particular cases mentioned in the statute. That only authorizes a re-issue when, from an unintentional error in the Description of the invention, the patent is invalid or inoperative, or when the Claim of the patentee exceeds his invention. It is not sufficient that the patent does not cover all that the patentee could have claimed if his specifications had come up to his invention. If he has invented or discovered something beyond his original specifications and Claim, his course is not to endeavor to cover it by a re-issue, but to seek a separate patent for it. The statute authorizing a re-issue was intended to protect against accidents and mistakes, and it is only when thus restricted that it can be regarded as a beneficial statute. If a patentee does not embrace by his specifications and Claim all that he might have done, and there has been no clear mistake, inadvertence, or accident in their preparation, the presumption of law is that he has abandoned to the use of the public everything outside of them, or at least has postponed any additional claim for further consideration." 18 O. G. 1339 (1340); 6 Sawyer, 508 (520). See also *Flower v. Rayner* (1881), 19 O. G. 425; 5 Fed. Rep. 793.

This position has been since discussed and repudiated by Lowell, J., in *Smith v. Merriam* (1881), 6 Fed. Rep. 713, where he says: (715) "A case has been brought to my notice, decided by Mr. Justice Field, on his circuit, which is supposed by the patent lawyers to indicate a new departure in the law of re-issued patents. The high authority and great importance of that decision will be my apology for a discussion, which, a few weeks since, would have been unnecessary. The case is *The*

Giant Powder Co. v. The California Vigorit Powder Co., 18 O. G. 1339; s. c. 4 Fed. Rep. 720. In it the learned judge is understood to declare that if the court can discover, upon a comparison of the two instruments, that there was no defective specification to be amended, and that the Claim was not broader than the invention, the action by the Commissioner in granting a re-issue was in excess of his jurisdiction, and void; and that if the patentee claims too little, instead of too much, his specification is not defective by reason of that mistake, but all which he did not claim was dedicated to the public. I do not mean to say that I consider the decision to be as extensive as this; but it is so understood by some members of the bar; and there are remarks in the opinion which lend a color to such a construction. The Revised Statutes simply re-enact the law upon this subject which has been in force since 1836: 'Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent, and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued.' Section 4916. The most natural construction of this law would perhaps be that if a patent should be inoperative by reason of a defective specification, or invalid for claiming too much, the defect might be supplied, or the excessive Claim be reduced, by re-issue. But the courts have given a very different inter-

original patent, he has exceeded his jurisdiction, and the Claims

pretation, -- much wider in most respects, and narrower in only one. They do not permit a defective specification to be supplied, excepting from the drawings or model; but they do permit the Claim to be varied, provided the same invention is described in both patents, and hold that the decision of the Office that the occasion had arisen for granting a re-issue is final. The law is extremely liberal, perhaps too much so, and has been much abused; but if we change it suddenly we shall make a destruction of titles which it is impossible to contemplate without dismay. If the court is to decide, by inspection of the original patent, that it was not defective, the result is this: that after a patentee, upon the best advice which he can obtain, has been instructed that his specification needs amendment, and obtains a new patent, the court may say, 'We are unable to see any defect, and your re-issue, however honestly obtained, is bad, because your original patent was so good.' The mistake is one of law, and the Commissioner does not usually decide the law finally; but as to the mere question of the necessity for a re-issue, supposing the new patent itself to be unobjectionable, his decision has always been held to be final; and this for an unanswerable reason, that no patentee, however honest or careful, can be safe in obtaining a re-issue, if he is to be informed, when he gets into court, that the judge is unable to see why he should have surrendered his first patent. The slighter and more obviously unobjectionable the change, the stronger will be the argument that there was no occasion to make it; so that honest and careful patentees will be the most likely to suffer. It does not help the matter to call the action of the Commissioner an excess of jurisdiction. I know that the

courts have called these mistakes jurisdictional. They did this to overrule, without positively saying so, the early cases which held the action of the Commissioner within his jurisdiction to be final. It is obvious that the Commissioner has the same jurisdiction to issue a bad patent as to issue a good one. As his action is *ex parte* it does not bind the world, excepting in certain matters which it is both unjust and inconvenient to review. A mistake by him as to the necessity of issuing a new patent is not an excess of jurisdiction, but a mistake in a matter clearly within his jurisdiction; and the real question is whether it is one which the courts will correct by destroying a new patent after the old one has been surrendered. Upon questions of the validity of a patent, or of a re-issue, in all great matters of novelty and construction and patentability, the decision of the Commissioner is not final, though his jurisdiction is undoubted; but I repeat that urgent reasons of justice require that upon the mere question whether the paper called a re-issue shall be given, his finding should be, as it has hitherto always been held to be, conclusive. Again, if it be found that the Claims of the original patent were valid, and that the re-issue for the same invention states the Claim or Claims in a different way, — though it may be a better way for the patentee, — the change does not of itself vitiate the new patent; but, on the contrary, the original Claims are conclusively presumed to have been made as they were through inadvertence, accident, or mistake. The law is so well settled that most of the reports do not contain the Claims of the two patents: but I suppose that no re-issue has ever contained the exact Claims of the original, and this can be discovered, incidentally, in many of

of the re-issued patent must be held invalid so far as such new

the cases, and positively in some, where the very point is passed upon. See *Allou v. Blunt*, 3 Story, 742; *Stimpson v. Westchester R. Co.*, 4 How. 380; *O'Reilly v. Morse*, 15 How. 62; *Batten v. Taggart*, 2 Wall. Jr. 101; s. c. 17 How. 74; *Bennet v. Fowler*, 8 Wall. 444; *The Goodyear Cases*, 2 Wall. Jr. 283, 356; 2 Cliff. 351; 9 Wall. 798; *Seymour v. Osborne*, 11 Wall. 516; *Roberts v. Ryer*, 91 U. S. 150; *Marsh v. Seymour*, 97 U. S. 348; remarks of Bradley, J., in *Powder Co. v. Powder Mills*, 98 U. S. 136, and of the same learned judge in *Carlton v. Bokee*, 17 Wall. 463, where he intimates that a re-issue may be good as to those Claims which agree with the invention, and void as to others which exceed it; *Cochrane v. Deener*, 94 U. S. 780; *Conover v. Roach*, 4 Fisher, 12; *Stevens v. Pritchard*, 10 O. G. 505; *Herring v. Nelson*, 14 Blatch. 298; *Johnson v. Flushing R. Co.*, 15 Blatch. 192; *Anilin Co. v. Higgins*, id. 290; *Pearl v. Ocean Mills*, 11 O. G. 2. None of these cases, unless it be *Batten v. Taggart*, 17 How. 74, — which is perhaps inconsistent with *Leggett v. Avery*, 101 U. S. 256, — has been overruled; and a great many similar cases could be cited. It has been brought out a little more decidedly by the later cases that the invention must be the same; but it has never been held in the Supreme Court, or any circuit court, so far as I can discover, that the Commissioner's decision is not final as to the propriety of a re-issue, as distinguished from its validity upon what may be called its merits; or that the Claims may not be varied to express the real invention. The Claim is part of the specification, and if defective may be amended. *Russell v. Dodge*, 93 U. S. 460, in which the decision is given by Mr. Justice Field, and which is cited by him in

The Powder Co.'s Case, merely decides that a re-issue which claims a different invention is void. A similar decision has been made at this term of the Supreme Court, in giving which Mr. Justice Strong states the law in the old way, that the Commissioner's decision is final as to the mistake, but not as to the identity of invention. *Ball v. Langles*, 18 O. G. 1405. The only cases which he cites are *Seymour v. Osborne*, and *Russell v. Dodge*, which he evidently considers to be consistent with each other." 19 O. G. 601 (602).

Further, that the decision of the Commissioner as to the defectiveness of the original patent and the necessity for a re-issue is final, see *Combined Patent Can Co. v. Lloyd* (1882), 11 Fed. Rep. 149; 21 O. G. 713; 15 Phila. 481; *Selden v. Stockwell Self-Lighting Gas Burner Co.* (1881), 19 Blatch. 544; 20 O. G. 1377; 9 Fed. Rep. 390; *Christman v. Rumsey* (1879), 58 How. Pr. 114; 17 Blatch. 148; 17 O. G. 903; 4 Bann. & A. 506; *Judson v. Bradford* (1878), 16 O. G. 171; 3 Bann. & A. 539; *Kerosene Lamp Heater Co. v. Littell* (1878), 3 Bann. & A. 312; 13 O. G. 1009; *Thomas v. Shoe Machinery Mfg. Co.* (1878), 16 O. G. 541; 3 Bann. & A. 557; *Lorillard v. McDowell* (1877), 11 O. G. 640; 13 Phila. 461; 2 Bann. & A. 531; *Miller & Peters Mfg. Co. v. Du Brul* (1877), 12 O. G. 351; 2 Bann. & A. 618; *Ex parte Conklin* (1874), 5 O. G. 235; 1 MacArthur, 375; *Wells v. Jacques* (1874), 5 O. G. 364; 1 Bann. & A. 60; *Jordan v. Dobson* (1870), 4 Fisher, 232; 2 Abbott, 398; 7 Phila. 533; *Blake v. Stafford* (1868), 3 Fisher, 294; 6 Blatch. 195.

That the decision of the Commissioner that the re-issue is necessary is final, no matter how many times the

matter or intentionally excluded matter is concerned.⁸ Upon

patent has already been re-issued, see *Union Paper Collar Co. v. White* (1875), 7 O. G. 698, 877; 11 Phila. 479; 2 Bann. & A. 60.

Furthermore, that the decision of the Commissioner is final on the collateral questions which must be settled, and the issues of fact which must be determined, before a surrender can be accepted and a re-issue allowed, unless the statute permits defences on these points, see *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657; *Giant Powder Co. v. Safety Nitro-Powder Co.* (1884), 19 Fed. Rep. 509; 10 Sawyer, 23; 27 O. G. 99; *American Diamond Rock Boring Co. v. Sheldon* (1879), 17 Blatch. 208; 4 Bann. & A. 551; *Anilin v. Higgin* (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462; *Judson v. Bradford* (1878), 3 Bann. & A. 539; 16 O. G. 171; *Herring v. Nelson* (1877), 14 Blatch. 393; 12 O. G. 753; 3 Bann. & A. 55; *American Nicholson Pavement Co. v. Elizabeth* (1873), 3 O. G. 522; 6 Fisher, 424; *Hoffheins v. Brandt* (1867), 3 Fisher, 218.

⁸ Although the decision of the Commissioner in accepting a surrender and awarding a re-issue is final so far as the substitution of the re-issued for the original patent is concerned, the courts still have the power to declare the Claims of the re-issued patent invalid for any of those general reasons which apply to original patents, or for the special reason that such Claims contain matter which the Commissioner had no jurisdiction to allow. But, as in all other cases, the courts will so construe the re-issued patent, if possible, as to avoid this latter objection, and will confine it, if its language will reasonably permit, to such subject-matter as constituted the original invention, and was not intentionally omitted or misstated in the orig-

inal patent. Where the re-issued patent repeats, as it usually does, one or more of the original Claims, these may be held valid, though all additional Claims are rejected as beyond the scope of the amending power; and thus, except in a few cases, the duty of the courts is limited to the construction of the re-issued patent. That in constructing a re-issued patent it must be restricted to the subject-matter indicated in the original specifications as belonging to the actual invention is settled by an unbroken current of authority. See §§ 663-669 and notes, *ante*, and § 746 and notes, *post*.

See also *Russell v. Dodge* (1876), 93 U. S. 460; 11 O. G. 151; *Collar Co. v. Van Dusen* (1874), 23 Wall. 530; 7 O. G. 919; *Bridge v. Brown* (1871), Holmes, 53; *Goodyear v. Berry* (1868), 3 Fisher, 439; 2 Bond, 189; *Cahart v. Austin* (1865), 2 Fisher, 543; 2 Clifford, 528; *Hussey v. Bradley* (1863), 2 Fisher, 362; 5 Blatch. 134; *Poppenhusen v. Falke* (1861), 2 Fisher, 181; 4 Blatch. 493.

That the courts may inquire into the origin of the defect for whose amendment the re-issue was obtained, and confine the operation of the re-issued patent to matter not intentionally omitted or misstated in the original, has often been denied, see *Asmus v. Alden* (1886), 27 Rep. Fed. 684; 36 O. G. 231, *Western Union Tel. Co. v. Baltimore & Ohio Tel. Co.* (1885), 25 Fed. Rep. 30; *Thomas v. Shoe Machinery Mfg. Co.* (1878), 3 Bann. & A. 557; 16 O. G. 541; *Blake v. Stafford* (1868), 3 Fisher, 294; 6 Blatch. 195; *Middletown Tool Co. v. Judd* (1867), 3 Fisher, 141.

The contrary has, however, been asserted in recent decisions, and is undoubtedly the correct position. Thus in *Mahn v. Harwood* (1884), 112 U. S.

this latter question the whole field of inquiry should be open to the courts, and while the decision of the Commissioner is *prima facie* correct and the burden of proof rests on those who controvert it, the identity of the invention claimed in the re-issue with that described in the original patent, and the origin of the corrected error in inadvertence, accident, mistake, or fraud, should be exhaustively investigated.⁹

354, Bradley, J. : (359) "The same defence may be established by showing from the record that there was no inadvertence, accident, or mistake in drawing up the specification of the original patent ; for the statute only gives a re-issue when the original is defective by inadvertence, accident, or mistake." 30 O. G. 657 (658).

In *Odell v. Stout* (1884), 22 Fed. Rep. 159, Sage, J. : (161) "The granting of a re-issue is *prima facie* evidence of inadvertence, accident, or mistake, as the granting of original letters is *prima facie* evidence of invention. This evidence may be overcome. It is not conclusive." 29 O. G. 862 (863).

The entire doctrine of abandonment by an unreasonable delay in applying for a re-issue is in reality only another mode of stating that the courts may inquire into the existence of original inadvertence, accident, or mistake; and every decision in favor of that doctrine is an indirect assertion that on this point the decision of the Commissioner is not conclusive. See §§ 690-692, and notes, *ante*, and also *Western Union Tel. Co. v. Baltimore & Ohio Tel. Co.* (1885), 25 Fed. Rep. 30 ; *Wollensak v. Reiher* (1885), 115 U. S. 96 ; 31 O. G. 1301.

⁹ The method of investigation which may be pursued by the courts in reviewing the action of the Commissioner on the two questions here discussed is also as yet undetermined. It has been generally considered that the inquiry must be limited to the documentary evidence afforded by the original and re-issued patents, and by the records of the action

of the Patent Office on the original and re-issue applications ; and in some cases it has been held that unless in these the repugnancy of the inventions, or the intentional omission or misstatement in the original patent, were apparent the decision of the Commissioner was conclusive. Thus in *Blake v. Stafford* (1868), 6 Blatch. 195, Shipman, J. : (199) "As the law now stands, I regard the decision of the Commissioner as final and conclusive, unless impeached for fraud in his or the patentee's acts, or for some irregularity arising on the face of the papers, or for a clear repugnance between the original and re-issued patents. Under the Act, the Commissioner has the power to decide, and in every acceptance of a surrender and every re-issue does decide, that the original patent was inoperative and invalid by reason of a defective specification or by claiming too much, and that the error arose by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention. He is authorized to grant a new patent for the same invention and for no other, and when he grants the new one, the presumption is that it embraces the same invention as the original. The jurisdiction of the Commissioner is final and conclusive, unless, as already stated, fraud or collusion somewhere is proved, or some irregularity is apparent on the face of the papers, or there is a plain repugnance between the old and new specifications." 3 Fisher, 294 (300).

See also *Mahn v. Harwood* (1884), 112 U. S. 354 ; 30 O. G. 657 ; *Giant*

§ 715. **Re-issued Patent not Collaterally Attackable for Fraud in Procuring the Re-issue.**

Neither a re-issued nor an original patent can be collaterally attacked on the ground that it was granted through the fraud either of the applicant or the Commissioner. This question can be raised only on a proceeding to repeal the patent.¹ Evidence of such fraud may be found in grossly

Powder Co. v. California Vigorit Powder Co. (1880), 4 Fed. Rep. 720; 6 Sawyer, 508; 18 O. G. 1339; *Wells v. Gill* (1872), 2 O. G. 590; 6 Fisher, 89.

In several particulars, however, this rule has been necessarily departed from, and there seems no sufficient reason why it should be at all regarded. Evidence outside the record must sometimes be admitted to ascertain the character of the actual original invention and its identity with that embraced in the re-issue; and in determining the question of original inadvertence, etc., by the reasonableness of the delay in obtaining a re-issue, all the circumstances attending the delay may be, as they constantly are, subjected to examination, and the validity or the scope of the Claims of the re-issue be thus indirectly decided by matters appearing only by parol. The reluctance of the courts to formally adopt this position, and throw the whole field of inquiry upon these two questions open for any and every ordinary method of investigation seems to arise from an exaggerated view of the authority of the Commissioner and the effect of his decision in allowing a re-issue. As this fundamental doctrine becomes clearer and more accurately stated it may be confidently expected that these resulting questions will be settled on a rational basis, and that the same latitude of inquiry will be permitted as to the cause of the alleged defect in the original patent, as is now enjoyed in reference to the patentability of the invention and the priority of the inventive act.

§ 715. ¹ In reference to this question also the law has undergone marked alterations. It was formerly held that the question of fraud in obtaining the re-issue was open and might be submitted to the jury. See *Stimpson v. Westchester R. R. Co.* (1846), 4 How. 380; 2 Robb, 335; and § 714, note 1, *ante*. In *Graham v. Mason* (1860), 5 Fisher, 1; 4 Clifford, 88, it was suggested that a re-issue can be collaterally attacked either for fraud or want of identity. The current of authority is, however, to the contrary, and in spite of occasional apparent departures from the doctrine it may be regarded as the settled law that no objection to the re-issued patent on the ground of fraud in the patentee in procuring it, or corruption in the Commissioner in allowing it, can be raised except in a proceeding instituted by the United States for its repeal. Thus in *Giant Powder Co. v. Safety Nitro-Powder Co.* (1884), 10 Sawyer, 23, Sawyer, J. : (25) "The question whether there is a fraud in the surrender and application for a re-issue is one of fact, for the officers of the Patent Office alone to decide, and their determination is conclusive in a collateral proceeding." 27 O. G. 99 (100); 19 Fed. Rep. 509 (511).

In *Thomas v. Shoe Mach. Mfg. Co.* (1878), 3 Bann. & A. 557, Clifford, J. : (559) "Authority to accept the surrender of an original patent and to grant a re-issue is conferred upon the Commissioner, and, in a case arising under the Patent Law then in force, the Supreme Court, more than thirty years

and unwarrantably extended Claims, or in descriptive matter clearly intended to mislead the public, or in extrinsic facts which manifest bad faith on the part of the patentee or corruption on the part of the Commissioner.² This rule does

ago, decided that where an act was to be done or a patent granted upon proofs to be had before a public officer upon which he was to decide, the fact that such officer had done the act or granted the patent was *prima facie* evidence that the proofs had been regularly made and that they were satisfactory, even though the patent did not contain any recitals that the prerequisites to the grant had been fulfilled; and such continued to be the rule until the question came up under a later act, when the Supreme Court held that the granting of a re-issued patent closed all inquiry into the existence of inadvertence, accident, or mistake, and left open only the question of fraud for the jury. *Railroad v. Stimpson*, 14 Pet. 458; *Stimpson v. Railroad*, 4 How. 384. Since that time it has been definitely settled that neither re-issued nor extended patents can be abrogated by an infringer, in a suit against him for damages or profits, upon the ground that the letters-patent were procured by fraud in prosecuting the application for the same before the Commissioner. *Rubber Co. v. Goodyear*, 9 Wall. 797." 16 O. G. 541 (541).

In *La Baw v. Hawkins* (1874), 1 Bann. & A. 428, Nixon, J. : (429) "I take no notice of the denial in the defendant's answer, that the letters-patent were surrendered for good and lawful cause, or that they were inoperative or invalid, or deficient or insufficient in any respect, because that question is not open for examination here. Since the case of *Seymour v. Osborne*, 11 Wall. 516, it seems to be settled that neither re-issued nor extended patents can be abrogated by an

infringer, in a suit against him for an infringement, upon the ground that the letters-patent were procured by fraud in prosecuting the application for the same before the Commissioner." 6 O. G. 724 (725).

In *Johnsen v. Beard* (1875), 2 Bann. & A. 50, Woodruff, J. : (51) "I understand the Supreme Court to have settled, distinctly and finally, that this court cannot enter into the examination of any question of fraud upon the Commissioner who granted the re-issue, or of any matter which is outside of the record; and that the only power which the courts have over re-issues, when their validity is sought to be impeached upon such grounds, is to look at the record of the original patent and of the re-issue, and to determine upon their face whether or not, as matter of law, the re-issue is a lawful one, without inquiring by what means it was procured, and without inquiring what matters of fact were involved *de hors* the record. The act of the Commissioner in granting the re-issue is final and conclusive." 8 O. G. 435 (436).

See to the same effect *Schillinger v. Crawford* (1886), 37 O. G. 1349; 4 Mackey, 450; *Miller & Peters Mfg. Co. v. Du Brul* (1877), 2 Bann. & A. 618; 12 O. G. 351; *Birdsell v. McDonald* (1874), 6 O. G. 682; 1 Bann. & A. 165; *Milligan & Higgins Glue Co. v. Upton* (1874), 6 O. G. 837; 4 Clifford, 237; 1 Bann. & A. 497; *Corn Planter Patent* (1874), 23 Wall. 181; 6 O. G. 392; *Seymour v. Osborne* (1870), 11 Wall. 516.

² In *Goodyear v. Berry* (1868), 2 Bond, 189, *per Curiam* : (202) "If the Claims of a re-issued patent clearly imply an

not forbid the admission, in a suit for the infringement of a re-issued patent, of testimony tending to establish that the alleged defects in the original patent arose from a fraudulent or deceptive intention on the part of the inventor, or prevent the courts from holding that the endeavor to correct such fraudulent defects by the re-issue cannot be sustained.³

expansion of the invention beyond the Claims of the original patent there is always ground for a presumption that there was a fraudulent intent to anticipate and cover subsequent inventions, and thus bar the door against patents for all subsequent discoveries. This is clearly against the policy of our patent-right system, and has been wisely condemned by the uniform decisions of the courts of the United States." 3 Fisher, 439 (449).

That where a re-issue fraudulently misleads the public it is void, see *Aultman v. Holley* (1873), 6 Fisher, 534 ; 11 Blatch. 317 ; 5 O. G. 3 ; *Swift v. Whisen* (1867), 3 Fisher, 343 ; 2 Bond, 115.

That a re-issue is not fraudulent merely because its object was to enlarge the scope of the original patent and was first suggested by judicial construction, see *Poppenhusen v. Falke* (1862), 2 Fisher, 213 ; 5 Blatch. 46.

That fraud, whether actual or constructive, renders a re-issue void, see *Swift v. Whisen* (1867), 3 Fisher, 343, 2 Bond, 115.

That if a re-issue is fraudulent all its Claims are void, see *Odell v. Stout* (1884), 22 Fed. Rep. 150 ; 29 O. G. 862.

³ Fraud in obtaining a re-issue must not be confounded either with a fraudulent attempt to conceal the true nature of the invention from the public, which is a good defence under the statute against any patent, or with a fraudulent and deceptive intention in the omission or misstatement in the original patent now corrected in the re-issue, which according to the authorities cited in the notes to the last paragraph is a valid objection to a re-issue whenever its validity can be inquired into by the courts. The first is a matter between the government and the patentee, and is properly adjudicated only in a proceeding by the government to rescind its own grant. The other two concern the public generally, and the defendant in an infringement suit in particular, and may, therefore, be set up by him in his defence, and so far as the suit against him is concerned be conclusively determined by the courts.

CHAPTER III.

OF THE REPEAL OF LETTERS-PATENT.

§ 716. Three Classes of Persons Interested in the Repeal of Letters-Patent: Infringers: Prior Inventors: The Public.

THREE distinct rights are either limited or suspended by the grant of a patent, and three classes of persons are thus interested in its repeal. The first class embraces those persons who practise the invention in violation of the exclusive privilege conferred upon the patentee, and who thereby become liable to compensate him for the injury unless his patent can be shown to be invalid. The second class consists of prior inventors whose monopoly is denied or restricted in its enjoyment on account of the existence of an antagonistic patent, and whose rights never can be perfectly secured until the adverse patent is repealed. The third class are the general public whose free use of the invention is suspended while the patent is in force, and whose power to grant a later valid patent to a different and more meritorious inventor has been impaired by the mistaken issue of the first. For the protection of the rights of all these persons against unlawful patents the law properly provides measures commensurate with the requirements of the different classes, whereby the patents may either be declared inoperative in reference to certain individuals or may be universally and permanently repealed.

§ 717. Interests of Infringers Protected without Special Proceedings for a Repeal.

The rights of the first class are sufficiently preserved by the protection afforded to the third class, of which they are always members, and by allowing them to defend themselves in any suit for a violation of the patent by showing that, as to all

the points involved in such suit, the patent is invalid. Those who simply practise the invention require no other relief against an unlawful patent than that which frees them from a liability to pay for its infringement. It is not necessary that the validity of the patent in itself, or as a public grant, be called in question, nor that the judgment of the court pronounce it null and void. The statutes in permitting an infringer to attack the patent upon every matter relating to the patentability of the invention and the priority of the patentee's inventive act, and in conferring upon the court the power to declare the patent invalid so far as the pending controversy is concerned, have secured the practical employer of the art or instrument against an undue interference with his rights under color of an unlawful patent, except in cases where the invalidity of the patent arises from the fact that it was originally obtained by fraud. In these cases the infringer is left to the protection accorded to him as a member of the general public. It is true that it might often be to his advantage were he allowed in his defence to show that the patentee had secured his grant by fraud or by corruption, but for obvious reasons such defence cannot be made. The issue of a patent is the decree of a tribunal to whom the duty of awarding patents to the original inventors of patentable arts and instruments has been confided by the law, and its decrees within its jurisdiction, like those of other courts, cannot be collaterally impeached. Thus though an infringer may defeat the operation of the patent, as against himself, on the ground that if it covers the invention which he uses the Patent Office had no jurisdiction to award it, either because the invention was not patentable or because the patentee was not its first inventor, he cannot claim in his defence that a grant within the jurisdiction of the Patent Office is invalid because it was corruptly or fraudulently obtained.¹ This is a question which can be raised only by a proceeding instituted for that pur-

§ 717. ¹ That a patent cannot be collaterally attacked for fraud in procuring it, but may be set aside and repealed on a direct proceeding for that purpose, see *Eureka Co. v. Bailey Wash-* ing Mach. Co. (1870), 11 Wall. 488; *Crompton v. Belknap Mills* (1869), 3 Fisher, 536; *Goodyear v. Providence Rubber Co.* (1864), 2 Clifford, 351; 2 Fisher, 499.

pose on behalf of the authority from whom the grant has been improperly procured; and an infringer can, therefore, avail himself of this mode of relief only as a member of the general public, and through the measures which the law prescribes for their protection.

§ 718. Interests of Prior Inventors Require Special Proceedings for a Repeal.

The second class of persons require for their protection an additional proceeding. A prior inventor has not only the right to use his own invention, and when sued for the infringement of an earlier patent to defend upon the ground of his own previous inventive act, but he also has the right to that monopoly of the invention which the law confers upon him as a recompense for his inventive skill. An out-standing patent to a subsequent inventor cannot take away this right, nor prevent the issue of a later patent to the first inventor whenever his superior title is established; but the later lawful patent does not abrogate the former, nor relieve the true inventor from that cloud upon his title which arises from the existence of the earlier patent to his rival. To the complete enjoyment of his monopoly the extinguishment of the unlawful interfering patent becomes necessary, and as no power has been bestowed upon the Patent Office to recall it, the statutes have provided a specific method for securing its repeal.

§ 719. Interests of the Public Require Special Proceedings for a Repeal.

The third class of these persons, or the general public, possess collective rights beyond those which subsist in individuals, for whose protection against unlawful patents special measures are required. Such members of the public as infringe upon these patents may defend against them in the manner just described. Prior inventors, also members of the public, may remove interfering patents by the mode particularly provided for that purpose. But neither of these methods secures to the collective public the entire enjoyment of their natural and legal rights. The collective public are

entitled to all those benefits, direct or indirect, which flow from the free use of every industrial device that is not covered by a lawful patent; and the enjoyment of these benefits cannot be made conditional upon the willingness of individuals to infringe existing patents or their ability to successfully defend against them. An unlawful patent is practically as complete an obstacle to the public enjoyment of an invention as a lawful patent could be, until by some means the unlawful patent is virtually or actually destroyed; and the public interest thus demands the establishment of such forms of procedure as may lead to its immediate repeal. Moreover, by the issue of one patent for a given invention the public, acting through the government, exhaust their power to confer on any one this particular monopoly. Two conflicting monopolies in the same invention cannot exist, since the idea of a monopoly excludes all competition. Hence, whether the first patent be lawful or unlawful, while it remains in force no second patent can be granted, for the entire monopoly resides in him to whom the first was issued and nothing remains in the public to be bestowed upon another through the second. The practice of the Patent Office in allowing patents to prior inventors, notwithstanding earlier patents to later inventors, is not based on any theory that more than one monopoly can be created by the public, but is a mere device for putting both the claimants on equal ground before the courts, in order that their adverse claims to the monopoly may be determined. Whenever, therefore, an unlawful patent is obtained, the public are unlawfully deprived of their right to grant a lawful patent, and the recovery of this right by the repeal of the unlawful patent becomes a duty not only to themselves collectively but to that individual member of the public upon whom the monopoly ought legally to be conferred.

§ 720. Two Special Proceedings Provided for the Repeal of Unlawful Patents.

This description of the rights invaded by unlawful patents, and of the methods by which alone these rights can be protected, indicates that for two of these three classes of persons

special remedies must exist. Of the protection afforded to infringers by permitting them to avail themselves of any defence against the patent, except that of fraud in its procurement, nothing further need be stated here, — the subject being specially considered later in its proper place. Prior inventors and the general public, however, require each their own modes of redress, resulting in the repeal of the unlawful patent, in one case as to the contending claimant only, and in the other as to all mankind. These are to form the present subjects of examination.

SECTION I.

OF THE REPEAL OF PATENTS IN THE INTEREST OF PRIOR INVENTORS.

§ 721. Proceedings for a Repeal in the Interest of Prior Inventors under the Acts of 1790, 1793, and 1836.

The right of a prior inventor to institute proceedings for the repeal of a patent improperly granted to a subsequent inventor, or to one who simply pirated the invention, has been always expressly recognized by our Patent Law. The acts of 1790 and 1793 contained provisions by virtue of which actions could be instituted by any person, resulting, if successful, in the abrogation of the alleged unlawful patent.¹ The act of 1836, having secured by different methods the protection of the rights of all other individuals, restricted private actions for the repeal of patents to the prior inventor, conferring upon him the power thus to attack conflicting patents, whether the Patent Office had recognized his superior claims by granting him a patent or had refused his application on the ground of the outstanding earlier patent.² In

§ 721. ¹ The act of 1790, Sec. 5, and the act of 1793, Sec. 10, were substantially identical. They provided for the issue of a rule against the owner of any patent, upon the application of any person averring under oath that the patent was obtained surreptitiously by or upon

false suggestion, commanding the owner of the patent to show cause why the patent should not be repealed, and directed that unless such cause were shown a decree of repeal should be entered against the defendant.

² Act of 1836, Sec. 16, " *And be it*

this proceeding the court not only had authority to repeal the unlawful patent, but where the prior inventor had been denied a patent in the Patent Office on account of the unlawful patent, it could adjudicate upon his title to the patent, and in pursuance of this judgment the Commissioner could award it to him as the lawful patentee.³

§ 722. Proceedings for a Repeal in the Interest of Prior Inventors under the Act of 1870.

The act of 1870 still further limited this privilege of instituting private actions for repeal, by requiring the prior inventor to satisfy the government of his superior title, and obtain a patent, before attacking the alleged unlawful patent of his adversary. The act of 1836, as has been seen, afforded the defeated applicant a double remedy, extinguishing the rival patent and reversing the unfavorable judgment of the Patent Office on his individual claims. The act of

further enacted, 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." See also Sec. 10, act of 1839.

³ That a patent can be declared void under Sec. 16, act of 1836, and Sec. 10, act of 1839, only when two patents interfere, or the Commissioner refuses a patent, or the Supreme Court of the district refuses it upon appeal, see *Merserole v. Union Paper Collar Co.* (1869), 3 Fisher, 483; 6 Blatch. 356.

That courts cannot declare a patent void under Sec. 17, act of July 4, 1836, see *Merserole v. Union Paper Collar Co.* (1869), 6 Blatch. 356; 3 Fisher, 483.

1870 separated these proceedings. In cases where the application of the prior inventor was denied on account of the existing patent, it gave him the same opportunity to vindicate his rights to a patent which he enjoyed under the act of 1836, but it did not permit him to join with this proceeding another, having for its object the repeal of the opposing patent.¹ This separation was correct in principle. The grant of a patent raises a strong *prima facie* presumption of its validity. The refusal of a patent by the Patent Office is also *prima facie* evidence that the applicant has no right to a monopoly. To permit a defeated applicant to attack an interfering patent in the face of these two presumptions is inconsistent with a due regard to the rights of the existing patentee. Not until he has overcome the presumption arising from his own defeat by obtaining a reversal of the adverse judgment, and by the allowance of a patent in his favor has put himself on equal ground with the earlier patentee, ought he to be permitted to bring his adversary into court in defence of the prior patent, or compel him to incur the risk of its repeal.² The present law thus adequately protects the

§ 722. ¹ In the act of 1870, Secs. 52 and 58 represent and reproduce the matter contained in Sec. 16 of the act of 1836. Sec. 52 is substantially identical with Sec. 4915 of the Revised Statutes, which is as follows: "Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity, and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his Claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adju-

dications, and otherwise complying with the requirements of law. In all cases where there is no opposing party, a copy of the bill shall be served on the Commissioner, and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not." Sec. 58 appears as Sec. 4918, Rev. Stat., and is quoted in § 723 and notes, *post*. By comparing these with Sec. 16, act of 1836, given in note 2, § 721, *ante*, the precise division in the law effected by the act of 1870 will be perceived.

² That no suit to annul a patent can be brought by a private party unless there are two outstanding interfering patents, see *Mowry v. Whitney* (1871), 14 Wall. 434; 1 O. G. 499; 5 Fisher, 513.

That a suit to defeat another's patent cannot be brought till the plaintiff receives his own, see *Hoeltge v. Hoeller* (1870), 2 Bond, 386.

interests of all parties, and far more accurately than the old preserves a proper order and sequence in its remedies.

§ 723. Proceedings for a Repeal in the Interest of Prior Inventors under the Revised Statutes of 1874.

The relief afforded to the defeated applicant is prescribed by Section 4915 of the Revised Statutes, and has already been discussed in its appropriate connection.¹ Proceedings for the repeal of interfering patents are governed by Section 4918.² According to this section any person interested in one of two or more interfering patents,³ or in the practice of the invention which it claims, may bring a bill in equity against the owners of the adverse patent, praying for relief against the interfering patentee or any party holding under him.⁴ Upon due notice

§ 723. ¹ See §§ 571, 604, and notes, *ante*.

² Rev. Stat. Sec. 4918: "Whenever there are interfering patents any person interested in any one of them, or in the working of the invention claimed under either of them may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment."

³ That Sec. 4918, Rev. Stat., relates only to interfering patents for the same invention, when the plaintiff claims to be the original inventor, see *Celluloid Mfg. Co. v. Goodyear Dental Vulcanite Co.* (1876), 10 O. G. 41; 13 Blatch. 375.

That two patents for distinct articles do not interfere under Sec. 4918, though one is an improvement on the other, see *Pontlarge v. N. Y. Bung & Bushing Co.* (1884), 28 O. G. 370; 20 Fed. Rep. 314.

That two patents interfere under Sec. 16, act of 1836, only when they claim in whole or in part the same invention, as under Secs. 8 and 12, see *Gold & Silver Ore Separating Co. v. United States Disintegrating Ore Co.* (1869), 3 Fisher, 489; 6 Blatch. 307.

That no action lies by a junior patentee to obtain a decision that his patent does not conflict with a prior one, see *Celluloid Mfg. Co. v. Goodyear Dental Vulcanite Co.* (1876), 10 O. G. 41; 13 Blatch. 375.

That patents can be adjudged void only under Sec. 16, act of 1836, and Sec. 10, act of 1839, and then only when two patents interfere or when a patent is refused by the Commissioner or a justice of the Supreme Court of the District of Columbia on appeal, see *Merserole v. Union Paper Collar Co.* (1869), 3 Fisher, 483; 6 Blatch. 356.

⁴ That an assignee before the patent, if his assignment was duly recorded, may sue one to whom the patent issued

to the adverse parties, and after such proceedings according to the usual course of equity as the nature of the controversy requires the court may declare either of the patents void in whole or in part, or inoperative or invalid in any particular portion of the United States, according to the interest of the parties in the patent or the invention patented.⁵ This judgment binds only the parties to the suit and those deriving title under them after such judgment has been rendered.⁶

§ 724. Nature and Effect of the Proceedings for a Repeal in the Interest of Prior Inventors.

The power conferred by this section upon the prior inventor and those claiming under him is broad enough to meet all

after its denial to his assignor, and have the patent annulled and a new one granted to him, see *Gay v. Cornell* (1849), 1 Blatch. 506.

That equity will not entertain a bill to vacate an extension after the extension has expired, but will dismiss it on demurrer, see *Bourne v. Goodyear* (1869), 9 Wall. 811.

⁵ That a proceeding under Sec. 4918, Rev. Stat., is a chancery proceeding and is regulated by chancery practice, as also under Sec. 739, see *Liggett & Myers Tobacco Co. v. Miller* (1880), 5 Bann. & A. 237; 1 McCrary, 31; 17 O. G. 798; 1 Fed. Rep. 203.

That a bill to annul a patent must be brought in the district where the defendant resides or is found, see *Prentiss v. Ellsworth* (1846), 27 O. G. 623.

That in a suit for repeal under Sec. 4918, Rev. Stat., no provision exists for notice to parties outside the district in which the suit is brought, see *Liggett & Myers Tobacco Co. v. Miller* (1880), 1 Fed. Rep. 203; 17 O. G. 798; 1 McCrary, 31; 5 Bann. & A. 237.

That in a suit for repeal under Sec. 4918, Rev. Stat., the defendant is not compelled to file a cross-bill in order to obtain affirmative relief, and if he does

so it may be dismissed without costs, see *American Clay Bird Co. v. Ligowski Clay Pigeon Co.* (1887), 31 Fed. Rep. 466; *Lockwood v. Cleveland* (1881), 6 Fed. Rep. 721.

That in a suit to annul an interfering patent the court may defeat the defendant's patent, although the plaintiff's patent is void, being anticipated by his own prior patents, see *American Clay Bird Co. v. Ligowski Clay Pigeon Co.* (1887), 31 Fed. Rep. 466.

That a delay of five years in instituting proceedings to annul a patent tends to show a want of good faith in the petitioner, see *Sawyer v. Massey* (1885), 25 Fed. Rep. 144.

That on a bill to repeal a patent in the Federal Courts, the preliminary statement as to the date of the invention on an interference in the Patent Office does not bind the assignees of the inventor, see *Union Paper Bag Mach. Co. v. Crane* (1874), Holmes, 429; 6 O. G. 801; 1 Bann. & A. 494.

⁶ That the judgment on a bill to annul an interfering patent binds only the parties to the suit and their subsequent assignees, see *Mowry v. Whitney* (1871), 14 Wall. 434; 1 O. G. 499; 5 Fisher, 513.

conceivable emergencies.¹ Whenever the rights of one person are derived from the lawful patent of the first inventor, and are in any manner limited or violated by another person under cover of the unlawful patent of a subsequent inventor, redress commensurate with the injury may be obtained and the unlawful patent declared void so far as it affects the antagonistic interests of the contending parties.² The judgment of repeal may embrace the whole patent, as in cases where its entire patentable subject-matter was first produced by the inventive genius of the adverse claimant, or may include only the particular inventions which are covered by the rival patent and are found by the court to have been first invented by the rival patentee. Both patents are equally before the court for judgment and either may be repealed, so far as the contending parties are concerned, to any extent which may be necessary in order to secure to the party claiming under the prior inventor of each art or instrument the unqualified enjoyment of the monopoly to which he is entitled.³ In this proceeding the

§ 724. ¹ That in proceedings to annul under Sec. 4918, the courts are not bound by the decisions of the Patent Office, see *Holliday v. Pickhardt* (1887), 24 Blatch. 201; 29 Fed. Rep. 853; *Minneapolis Harvester Works v. McCormick Harvesting Mach. Co.* (1886), 28 Fed. Rep. 565; 37 O. G. 566; *Hubel v. Tucker* (1885), 23 Blatch. 297; 24 Fed. Rep. 701.

² That under Sec. 58, act of 1870, the court may order the defeated patent to be delivered to the clerk and cancelled by him, and sent to the Secretary of the Interior with a copy of the decree, see *Sturges v. Van Hagen* (1873), 6 Fisher, 572; 4 O. G. 579.

That where the court annuls a patent it may enjoin the patentee from instituting actions thereon, see *Sawyer v. Massey* (1885), 25 Fed. Rep. 144.

That a junior patentee cannot be enjoined from suing under his patent on the motion of the prior patentee, pending a suit by the prior patentee to cancel the junior patent, when the

junior patent was granted after a full hearing in the Patent Office, on an interference with the prior patentee, see *Asbestos Felting Co. v. Salamander Felting Co.* (1876), 10 O. G. 828; 13 Blatch. 453.

³ That Sec. 4918, Rev. Stat., allows the court to declare either or both patents void, in whole or in part, see *Foster v. Lindsay* (1875), 8 O. G. 1032; 3 Dillon, 126; 2 Bann. & A. 172; *Foster v. Lindsay* (1874), 7 O. G. 514; 1 Bann. & A. 605.

That on a bill to annul, the court can declare either patent void, but not both, see *American Clay Bird Co. v. Ligowski Clay Pigeon Co.* (1887), 31 Fed. Rep. 466.

That on a petition to annul, if it appears that one patentee abandoned his experiments, and after the issue of a patent to his rival renewed them and patented the invention, the rival patent will be sustained, see *Hutchinson v. Everett* (1885), 35 O. G. 1110; 26 Fed. Rep. 531.

patentability of the inventions described and claimed in the antagonistic patents is not in issue. Priority of invention is the only point in controversy, and judgment, therefore, is awarded to the party who derives his title from the first inventor.⁴

SECTION II.

OF THE REPEAL OF PATENTS IN THE INTEREST OF THE PUBLIC.

§ 725. Proceedings for a Repeal in the Interest of the Public Rest upon Fundamental Principles of Sovereignty, not on mere Legislative Acts.

Whether the public, as a collective body, can institute proceedings for the repeal of letters-patent, under the present provisions of our law, has been a matter of dispute. Adhering to the theory that such proceedings can be authorized only by express acts of legislation, some courts have held that in the absence of a statute conferring this power on the people it did not exist. In obedience to this doctrine it has been

⁴ That the only issues on a petition to annul an interfering patent are interference and priority, see *Sawyer v. Massey* (1885), 25 Fed. Rep. 144; *Pentlarge v. Pentlarge* (1884), 22 Blatch. 10; 19 Fed. Rep. 817; *contra*, *Foster v. Lindsay* (1875), 8 O. G. 1032; 2 Bann. & A. 172; 3 Dillon, 126; *Foster v. Lindsay* (1874), 7 O. G. 514; 1 Bann. & A. 605.

That on a petition to annul an interfering patent, under Sec. 4918, the defendant cannot set up by plea as a defence, if holding under a later patent, that the invention was in use before the plaintiff's inventive act, see *Pentlarge v. Pentlarge* (1884), 22 Blatch. 10; 19 Fed. Rep. 817.

That on proceedings for repeal under Sec. 4918, Rev. Stat., a plea that the plaintiff's patent is void for want of novelty is improper, see *Pentlarge v.*

Pentlarge (1884), 22 Fed. Rep. 412; 22 Blatch. 120.

That when on a suit to repeal under Sec. 4918, Rev. Stat., the defendant pleads that the plaintiff's patent is void for want of novelty, and this plea is overruled as improper, and the plea is amended, the defendant cannot set up the same matter in his answer, it being *res adjudicata* in that case, see *Pentlarge v. Pentlarge* (1884), 22 Blatch. 120; 22 Fed. Rep. 412.

That where, after an interference judgment, patents are granted to both parties, and the party to whom priority was adjudged institutes proceedings to annul the other patent, the latter patentee is not estopped to deny that the invention was new and patentable, see *Holliday v. Pickhardt* (1887), 29 Fed. Rep. 853; 24 Blatch. 201.

decided, in two cases of considerable prominence, that the acts of 1790 and 1793 bestowed this privilege upon the public; that the act of 1836, while enlarging the defences permitted to infringers, withdrew the public privilege of a repeal; and that as subsequent statutes have not revived it, no such privilege now exists.¹ But in the light of principle, as well

§ 726. ¹ In *Attorney-General v. Rumford Chemical Works* (1876), 9 O. G. 1062, Shepley, J. : (1066), "This leads us to the consideration of the protection afforded by the provisions of the patent acts to the rights of the general public, and to the history of the legislation upon that branch of the subject. The fifth section of the act of 1790, the first act of Congress in relation to this subject (1 Stat. at Large, 111), provided a form and mode of proceeding to repeal a patent 'obtained surreptitiously, by or upon false suggestion,' upon complaint made under oath before the judge of the district court where the defendant resided, and motion within a year after the issuing of the patent, but not afterward. The patent issued under this act without any oath of the applicant and any previous examination, and want of novelty and originality are not included in the list of defences authorized by the sixth section. The act of 1793 extended the time of limitation for commencing proceedings to repeal the patent to three years, and enlarged the defences in actions for infringement, opening the defence for want of novelty and originality. These provisions clearly show that it was deemed necessary that authority for proceedings to repeal letters-patent should be conferred by statute. . . . (1067) These acts of 1790 and 1793, including these provisions conferring jurisdiction upon the Federal courts over proceedings for the repeal of letters-patent, were repealed by the act of 1836. That act was substantially re-enacted and codified by the act of 1870, and in the Revised Statutes of

1874. The act of 1836 contained no provision authorizing any proceeding to repeal letters-patent upon the ground that they were obtained 'surreptitiously, by or upon false suggestion,' but the sixteenth section provided a remedy in the case of conflicting patents, and for a repeal of the one which the court should adjudge had been improvidently issued. This takes the place of the remedy to which, in case of conflicting grants, the subject is entitled as matter of right in England. For the protection of the general public, in place of the provision for a proceeding in the nature of a *scire facias* to repeal the patent, to be instituted within three years, as provided in the act of 1793, it sought to provide safeguards against the issue of letters-patent upon false suggestion, and ample security against any injury to the citizen, to whom it opened every possible defence against injury resulting from any mistake or oversight of the Commissioner in issuing the patent. In fact, every defence against a patent that can well be imagined was left open to the citizen whose interests were affected by it, excepting only the one which, in *Whitney v. Mowry*, the Supreme Court decided was not open, -- the question of fraud upon the government in obtaining the grant. To guard against such a fraud it provided for the examination by the Examiner and for a Commissioner and the subsequent proceedings hereinbefore stated, it being made the duty of the Examiner and the Commissioner to protect the rights of the public. The jurisdiction conferred by acts of 1790

as of the recent decisions of the Supreme Court, this position cannot be maintained. The right of the public to withdraw

and 1793 upon the Federal courts to repeal a patent, and which, without express grant, it is believed did not inhere in those courts, is nowhere conferred by the acts of 1836 or 1870, or in the Revised Statutes of 1874. It would seem to be a great stretch of power and assumption of jurisdiction for one circuit court, in the absence of any such express authority conferred by act of Congress, to repeal and vacate a patent which may have been originally granted upon the decree of another circuit court, upon appeal from the Commissioner, and adjudged valid, perhaps, in litigation respecting it in still another circuit court in another circuit. The better opinion upon this brief and imperfect review of the legislation of Congress upon this subject would seem to be that Congress had deliberately transferred the jurisdiction over the question of the protection of the rights of the general public to the *quasi* judicial decision of the Examiner and the Commissioner, or the actual judicial decision of the Federal courts upon appeal from the Commissioner, and fully protected the rights of the individuals against whom patents might be sought to be enforced, by opening to them every defence essential to the preservation of their rights and the protection of their interests. The decisions in the Federal courts sustaining proceedings in equity to vacate letters-patent granting lands obtained by fraud, furnish no precedent in case of letters-patent for inventions. The United States, as an owner of lands, has equal rights and is entitled to equal remedies with an individual owner. In granting lands the United States conveys that in which it has the fee. In issuing letters-patent for inventions, nothing is granted which belonged before to the United States. The issue

of the letters-patent is in compliance with an act of Congress. The rights and remedies of the parties are dependent solely on the statute enactments, and do not grow out of any previous ownership of the supposed subject of the grant, as in the case of a conveyance of lands." 32 Fed. Rep. 608(621).

In *United States v. American Bell Telephone Co.* (1887), 41 O. G. 123; 32 Fed. Rep. 591, the same position is maintained. This case involved one of the most important patents ever issued in this country, and was exhaustively argued on both sides by several of the foremost members of the American Patent Law Bar. In rendering its judgment the court reviewed the history of legislation and judicial decision on this question, and arrived at conclusions which may be summed up as follows:

1. That all rights and remedies of patentees arise out of the Constitution and the acts of Congress, and where these are silent no right or remedy exists.

2. That the power to cancel a patent is not embraced among general equity powers, as in England, — the patent being there a royal grant, but here resting wholly on statute.

3. That a bill to cancel a patent cannot be maintained in the name of the United States in the absence of an express statute to that effect.

4. That the power to cancel a land patent does not extend to patents for inventions, since the government grants the land but not the invention.

5. That under the acts of 1790 and 1793 a patent could be cancelled on *scire facias* if surreptitiously obtained, but under later acts this is a ground of defence in infringement suits, and there only.

Of these conclusions the first and

from the grantee a grant improperly secured rests upon foundations deeper than the current enactments of the legislative

fourth seem to contain the fundamental propositions out of which the others are deduced, and the value of the decision as an authority thus depends on the truth of these premises and the soundness of the logical processes by which the others are inferred from them.

Firstly, then, is it true that all the rights and remedies of patentees arise out of the Constitution and the acts of Congress, and that where these are silent no right or remedy exists? The power to grant a monopoly in an invention was an attribute of sovereignty at common law, and was recognized as such by the courts of common law in the very heat of the contest against odious monopolies. (See § 9 and notes, *ante*.) It was claimed and exercised by the several States as an attribute of their common-law sovereignty, not only before but after the adoption of the Federal Constitution. (See § 45 and notes, *ante*.) The rights created by the grant of such a monopoly were defined and enforced, both in England and in our several States, according to the common principles and methods of law and equity, — in most cases without any statute to declare the right or to prescribe the remedy. When the Federal Constitution was framed it was optional with the people of the United States either to bestow this among other attributes of sovereignty upon the national government or to retain it within the sole possession of the individual States. They chose the former policy, and conferred upon the United States the same power to create monopolies in favor of inventors, throughout the entire country, that was already exercised by the several States within their respective areas, and that had been immemorially known to and sanctioned by the common law. In this provision of

the Constitution they adopted the very words and phrases of the English law, defined the monopoly in terms of established meaning, and evidently contemplated the reproduction on this side the Atlantic of the system which had proved its value in the mother country. Under this clause of the Constitution Congress immediately passed the act of 1790, which is evidently little more than the formulation of the doctrines announced in previous decisions of the British common-law courts, and whose interpretation would have been impossible without constant recourse to the sources from which it was drawn. All later acts of Congress are mere developments and modifications of this earlier act, and bear a similar relation to the common law. Historically, therefore, the rights and remedies of patentees arise, not from the statutes, but from the common law, and though the common law has been to some extent declared and amplified by statutes, it cannot be assumed either that all the rights of patentees have been expressly named in these enactments, or that no remedies exist except those which are there particularly prescribed.

In practical jurisprudence the same fact appears. The earlier cases decided under our acts of Congress were adjudicated with constant reference to the decisions of the English courts. Equity asserted jurisdiction and applied its remedies unhesitatingly before the act of 1819, and when no chancery relief was given by statute. All questions as to the nature and scope of the monopoly, as to the forms of infringement, as to the course of pleading, mode of trial, and (except under the acts of 1790 and 1793) as to the measure of compensation in both tribunals, were settled by well-known law or equity

department of the government. It is a right inherent in the sovereign *jure regio*, and by the common law and in the his-

rules and independently of any express legislation. Whatever injury the patentee may sustain other than by the infringement of his patent, as by the slander of his title, the fraudulent discovery and appropriation of his secret pending his efforts to procure a patent, etc., must be redressed, if at all, according to the ordinary legal or equitable methods without the aid of statutes. The course of applied justice thus contradicts the proposition that all these rights and remedies rest on the Constitution and the acts of Congress, and that no right or remedy exists except as they bestow it.

It is doubtless true that if the Federal Constitution had not contained the clause referred to, or its equivalent, the United States would have received no power to create a monopoly in favor of the inventor. It is also true that if Congress had never passed an act to carry this clause into effect, no patents ever could have been granted by the Federal Government. But it does not thence follow that when Congress has legislated on the subject and established a patent-system clothed with the authority to issue patents for inventions, all rights under such patents and all remedies for their violation must be found declared and specified in the statutes by which this authority is conferred. As in every other instance where express legislation relates to subject-matter already known to the common law, the statute does not exclude what it does not mention or impliedly repeal, but both the written and unwritten law must be construed together and taken as the measure of the rights and remedies with which they deal.

But were it conceded that all the rights and remedies of patentees arise out of the Constitution and the acts of Con-

gress, what inference can from this be drawn that the United States is without remedy against a fraudulent monopoly? Either the patentee has a right to retain a patent which he has procured by fraud, or the government which has been deceived, acting for the public which has been defrauded, has the right to cancel it. It will hardly be pretended that the written law confers such right upon the patentee, and thence according to the line of argument adopted by the court, the right to a repeal is vested in the United States. But neither the common law nor the principles of equity jurisprudence afford an apology for such a claim on behalf of the fraudulent patentee; on the contrary, in both tribunals the power of the government to interfere at once and restore to the public the privileges of which they have been unjustly deprived has constantly been recognized as a part of that same attribute of sovereignty by whose exercise the monopoly has been created. If the United States has not this power it is because the Federal Constitution, in conferring upon the national government the authority to create monopolies, divorced from this authority its necessary correlate, — the authority to rescind unlawful monopolies, — leaving the latter in the States as part of their reserved sovereignty, or extinguishing it altogether, — either of which positions is absurd, though scarcely more so than the claim that such a defect of sovereignty can be removed by any act of Congress.

Not to pursue this criticism further, can there be any serious doubt that the United States has power to repeal unlawful patents, irrespective of any special provision of the Constitution to that effect, or any act of Congress conferring that authority, but solely as a part of

tory of English jurisprudence has always been recognized as embraced in the prerogative by which the grant itself is au-

its sovereignty over the subject-matter of monopolies for inventions as delegated to it by the express language of the Constitution? And if this be not doubted what answer shall be given to the further question, — whether, possessing this power, the Federal government can exercise it for the protection of the public interests in the ordinary modes known to the law from which ours is derived or must await the designation by some act of Congress of a proceeding in which its repealing power could be applied?

It will divest this question of some of its obscurity if we remove from the discussion certain matters which have had great weight with the courts in the two cases now under review, but which have really no bearing whatever on the principle involved. In the acts of 1790 and 1793 provisions for the repeal, by *scire facias*, of patents issued upon false suggestion, were inserted which by later statutes were impliedly annulled, and now have no place in our written Patent Law. Assuming that these provisions were intended by Congress to afford the government a method for rescinding unlawful patents in the interest of the public, their repeal and the failure to provide such methods in the recent statutes has been accepted as a powerful argument in favor of the view that under present laws the government is left without a remedy. This is, in fact, the substance of the reasoning in the first case cited, which is closely followed in the second. But the slightest examination of these provisions will disclose that the remedy afforded by them was a private not a public remedy. The proceeding was to be instituted by a private person who was to be liable for the costs if his effort failed. It was to have been brought

within a limited time after the patent issued, and was particularly designed to afford relief in cases where the patentee was not the first and true inventor of the matter covered by his patent. The awarding of the remedy was entirely at the discretion of the court. The United States could not be made a party to the suit, either originally or by substitution, and was held by the courts to be entirely without interest in the controversy, except as the public may always benefit by a decision that a patent is invalid. (See *Wood v. Williams* (1834), *Gilpin*, 517; *1 Robb*, 717.) Now what possible connection can there be, either in law or logic, between this grant of a private remedy, or the substitution for it of other private remedies under later statutes, and the power of the United States, in its sovereign capacity, to interfere for the rescission of a monopoly unlawfully obtained? As it could not avail itself of this provision, the passage of the statute affords no indication that an act of Congress was necessary to enable it to exercise its power. As the repeal of this provision could not deprive it of any remedy, such repeal is no proof that its remedies do not exist. The arguments derived from these provisions are thus aside from the whole question at issue, leaving it to be determined upon independent grounds of fact and principle.

Stripped of this veil of fallacy the exact question may be stated thus: Either the United States has never had a remedy by means of which it might recall a patent fraudulently obtained; or it has always had and still retains the remedies known to equity and the common law. Each of these alternatives excludes the other, and one or the other of them must be true. Applying to this question the test of fundamental

thorized. Still more essential is it to our own patent system, where the issue of a patent creates a contract between the

principle we then inquire whether a sovereignty, in the exercise of sovereign authority, can ever confer upon an individual a privilege which curtails its own freedom of action and invades the common rights of all its subjects, beyond its own power to revoke the privilege when it discovers that the grant has been obtained by fraud. If so, the nation is more helpless than any private citizen. Through its ignorant or unfaithful servants it may commit itself to the most foolish or injurious measures without the ability to retrace its steps or to correct its errors. Such a condition of affairs is not contemplated by any theory of political society, or any system of civilized jurisprudence. The power to create necessarily embraces the power to destroy, and if modes are provided in which creative power may be exerted, and none for the administration of destructive energy, the latter must be exercised, when needed, in any manner which may have before been known to and sanctioned by the customary law. That this is true whenever the government has been defrauded into a grant of public property, has never been disputed. That it applies equally whenever public right has been unlawfully restrained, follows from the same principles of justice and the inherent nature of the sovereign power.

To avoid this conclusion, the court, in the case now considered, adopts the *dictum* of the earlier judge, that in the issue of letters-patent for an invention nothing is granted which before belonged to the United States, and therefore, although fraudulent, the patent cannot, like a land grant, be recalled. This is the fourth of our formulated propositions, and in it resides whatever real force the arguments on this side of the controversy possess.

That the government never owned

and does not grant the *invention* to the patentee may be at once conceded, but this concession by no means disposes of the point in question. In a land grant the government transfers to private owners the property which it held, not as its own, but in trust for the whole people. By that transfer it decreases the entire amount of public property, and restricts its own power of dominion and conveyance over the land conferred. Thus when such a grant is obtained through fraud, the government and the public both sustain an injury, which known equitable and legal remedies are sufficient to redress. On the other hand, when the government grants a simple franchise it transfers no public property nor does it limit its own rights in any manner or degree. Other franchises of similar character may be indefinitely bestowed, and however numerous they may be, the privileges of the people at large are not affected. In such cases, as there is no injury, even where fraud is practised in procuring the grant, there is no occasion for a remedy, unless, in view of public policy, the government sees fit to inflict upon the fraudulent grantees the penalty of forfeiture. The positions taken by our courts in reference both to land grants and to franchises are, therefore, sound in principle and recognize the government as supplied with all the remedies it can require.

The judges, in the two cases now examined, repudiate all similarity between a patent for an invention and a land grant, and identify it with a franchise both in nature and effect. This is obviously an error. The issue of a patent does not confer a simple franchise; it creates a monopoly. Although the government and the public do not own the invention, they do possess rights in reference to it of the most important

inventor and the public which like all other contracts may

character, which are suspended or relinquished by the grant of letters-patent. The government has the right to bestow upon the first and true inventor of that invention an absolute and undisputed monopoly, free from all doubts as to his title, and this right is relinquished by the actual issue of a patent to any patentee. The public, whom the government represents, have an unquestioned natural right to use the invention freely upon its voluntary publication by the inventor, and to invent and use the art or article for themselves in case he does not see fit to disclose it. This right is immediately suspended by the issue of a patent, and cannot be regained until the patent has expired or been repealed. Both of these rights are of the highest value to the nation, and their invasion by fraudulently obtaining the issue of a patent is an injury equal in enormity and in disaster to the public to that which any fraudulent land grant could occasion. No better illustration of this statement can be needed than the patent whose repeal was sought in the case at bar, — a patent which if fraudulently procured has not only deprived the government of the power to confer a merited monopoly on an illustrious and successful inventor, but has been made an engine of oppression on the public from one end of the country to the other. If this question is to be determined by analogy it is thus evident that the doctrine applied to land grants, and not that to franchises, must furnish us with the desired solution. Though the correspondence in subject-matter is not exact, the rights involved are of the same general character and vest in the same persons, while the wrongs committed by the fraud affect interests of equal importance, and demand as summary relief.

In *United States v. American Bell Telephone Co.* (1888); 128 U. S. 315;

45 O. G. 1311, the principles asserted in this criticism of the two cases before mentioned have just been adopted, in substance, by the Supreme Court of the United States as the grounds of its reversal of the decision in *United States v. American Bell Telephone Co.*, and its consequent rejection of *Atty. Gen. v. Rumford Chemical Works* as a reliable authority upon the point in question. Mr. Justice Miller there presents these considerations in a different arrangement from that here pursued, but reaches his results by the same general methods, unqualifiedly asserting the right of the United States to proceed in equity for the repeal of patents fraudulently obtained, although no statutory power or remedy to that effect has been conferred upon them.

In *United States v. Gunning* (1883), 21 Blatch. 516, Wallace, J.: (517) "Notwithstanding the expression of opinion by Judge Shepley, in *Attorney General v. Rumford Chemical Works* (2 Banning & Arden, 298), in favor of the defendants' position, it is believed there is no sound reason why a bill will not lie in such a case, as well as where the subject of the grant is land or is a franchise or right of a different kind. The learned judge laid much stress upon the consideration that, in issuing letters-patent for inventions, nothing is granted which belonged before to the United States, and that the rights and remedies of the parties to such grants are dependent solely on the statute enactments, and do not grow out of any previous ownership of the subject of the grant; and it was his view that in such a case, express authority for proceedings to annul the grant must be conferred, in order to sanction them. The same reasoning would preclude a State from proceedings to annul the charter of a corporation created by its Legislature, if obtained through fraud. Yet it is a

be rescinded for non-performance of conditions precedent, or avoided when originally obtained by fraud.

§ 726. Patents Repealable at Common Law in the Interest of the Public in Three Classes of Cases.

At common law a grant by the sovereign was revocable in three classes of cases: (1) Where the same subject-matter had been previously granted; (2) Where the grant had been procured by fraud; (3) Where the subject-matter of the grant could not legally be granted.¹ Under our law the first

familiar principle that grants of corporate franchises, obtained through fraud practised upon the Legislature, are void when the State elects to set them aside by a judicial rescission. (Morawetz, Corp. § 148.) He also refers to the provisions of the Patent Acts of 1790 and 1793, which authorized proceedings for the repeal of patents obtained surreptitiously or by false suggestion, as indicating that Congress deemed it necessary that authority for proceedings to repeal letters-patent obtained through fraud should be conferred by statute. These provisions, however, permitted such proceedings to be taken by any person who chose to complain, — a right which did not and does not exist unless expressly conferred. A bill in equity lies to set aside letters-patent obtained by fraud, but only between the sovereignty making the grant and the grantee. (Field v. Seabury, 19 How. 323.) No inference can be justly drawn, therefore, from these provisions, that Congress deemed it requisite to confer express authority upon the United States to maintain such a suit, nor, from the absence of such provisions in the existing laws, that Congress intended to withhold such authority." 26 O. G. 356 (356), 18 Fed. Rep. 511 (512).

In *Mowry v. Whitney* (1871), 14 Wall. 434, Miller, J.: (440) "The 16th section of the Patent Act of 1836 seems to have in view the same distinc-

tion made by the common law in regard to annulling patents, for while it authorizes individuals claiming under conflicting patents, or one whose claim to a patent has been rejected because his invention was covered by a patent already issued, to try the conflicting claim in chancery, and authorizes the court to annul or set aside a patent so far as may be found necessary to protect the right, the suit by individuals is limited to that class of cases. And it is provided that the decree shall be of no validity except between the parties to the suit. The general public is left to the protection of the government and its officers." 1 O. G. 499 (500); 5 Fisher, 513 (515).

§ 726. ¹ In *Mowry v. Whitney* (1871), 14 Wall. 434, Miller, J.: (439) "The ancient mode of doing this in the English courts was by *scire facias*, and three classes of cases are laid down in which this may be done: (1) When the king by his letters-patent has by different patents granted the same thing to several persons, the first patentee shall have a *scire facias* to repeal the second; (2) When the king has granted a thing by false suggestion, he may by *scire facias* repeal his own grant; (3) When he has granted that which by law he cannot grant, he, *jure regis*, and for the advancement of justice and right, may have a *scire facias* to repeal his own letters-patent. . . . It will be observed that in the case of a conflict

class has been modified in character and provided with a special remedy. The common law conclusively presumed the first patent to be valid as against all patents subsequently granted, and thus repealed only the later patent in favor of the former. Our law recognizes no conclusive presumption in the interest of either the prior or the later patent, but sustains the one granted to the first and true inventor and repeals all others. The method by which this is accomplished, without invoking the aid of the public, was discussed in the last section.

§ 727. Proceedings for a Repeal in the Interest of the Public Necessary when the Patent was Obtained by Fraud.

The second class of cases directly involves the interests of the whole people and can be remedied only by governmental interference. A patent procured by fraud not only confers no just rights on the patentee, but as long as it exists it constitutes an unwarrantable limitation on the sovereign power. So far as it affects the interests of individual citizens it is also an act of oppression, in aid of which the sanction of the government has been unlawfully obtained. But no ability to secure himself against its operation resides in any individual. It is a grant within the jurisdiction of the grantor, and therefore cannot be collaterally attacked. Nor is the injury sustained by individuals from the fraud and falsehood of the patentee so distinct from that inflicted on the general public that any private action can be instituted to redress it.¹

under two patents granting the same rights, the *scire facias* may, according to the authorities cited, be brought in the name of one of the patentees; but in the other cases, when the patent was obtained by a fraud upon the king, by false suggestion, or where it was issued without authority, and for the good of the public and right and justice it should be repealed, the writ is to issue in the king's name or his attorney-general's. It is also said that when a patent is granted to the prejudice of the subject, the king of right is to permit

him upon his petition to use his name for the repeal of it, in *scire facias* at the king's suit." 1 O. G. 499 (500); 5 Fisher, 513 (514).

§ 727. ¹ In *Mowry v. Whitney* (1871), 14 Wall. 434, Miller, J.: (441) "The reasons for requiring official authority for such a proceeding are obvious: (1) The fraud, if one exists, has been practised on the government, and as the party injured, it is the appropriate party to assert the remedy or seek relief. (2) A suit by an individual could only be conclusive in result

Hence, as such frauds upon the Patent Office cannot be prevented, and as in the inevitable course of things patents from time to time are granted upon false suggestions or upon concealments which amount to fraud, the revocation of such patents is a duty which the public owes to itself both as a sovereign and as a community of individuals.

§ 728. Proceedings for a Repeal in the Interest of the Public sometimes Necessary where the Subject-matter of the Patent cannot Lawfully be Patented.

How far and when the government is called upon to interfere in cases of the third class is a question of more difficulty. The grant of a subject-matter which is by law incapable of being granted carries upon its face the evidence of its own invalidity. The power of the sovereign is not limited by it even in appearance, nor is the subject estopped from denying its efficiency in a collateral proceeding. Thus while the authority of the government to revoke the grant cannot be doubted, the cases in which this becomes necessary in the interest of the public or for individual protection are comparatively rare. Under our patent system the security af-

as between the patentee and the party suing, and it would remain a valid instrument as to all others. (3) The patentee would or might be subjected to innumerable vexatious suits to set aside his patent, since a decree in his favor in one suit would be no bar to a suit by another party. If, on the other hand, an individual finds himself injured, either specially or as a part of the general public, it is no hardship to require him to satisfy the attorney-general that the case is one in which the government ought to interfere, either directly by instituting the suit, or indirectly by authorizing the use of its name, by which the attorney-general would retain such control of the matter as would enable him to prevent oppression and abuse in the exercise of the right to prosecute such a suit. It would seriously impair the value of the title

which the government grants after regular proceedings before officers appointed for the purpose, if the validity of the instrument by which the grant is made, can be impeached by any one whose interest may be affected by it, and would tend to discredit the authority of the government in such matters." 1 O. G. 499 (500); 5 Fisher, 513 (516). See also § 715 and notes, *ante*.

That the unintentional issue of a patent cannot be set up except in a direct proceeding to vacate the patent, see *Doughty v. West* (1869), 3 Fisher, 580; 6 Blatch. 429.

That the United States cannot sue to repeal a patent on grounds that have been urged against the patent in an infringement suit when the patent was sustained, see *United States v. Colgate* (1884), 32 Fed. Rep. 624.

forded against unlawful patents of this character by the proceedings in the Patent Office, and by the defences permitted to alleged infringers, is usually sufficient, and in such cases the government will not interfere. But where the invalidity of a patent has been established by repeated decisions of the courts, and it is being used as a mere instrument of oppression against citizens who, though aware of its true character, cannot avoid incurring trouble and expense in their defence against it, the public cannot justly refuse to withdraw the appearance of authority, under which the wrong is perpetrated, by the immediate and final revocation of the patent.

§ 729. Proceedings for a Repeal in the Interest of the Public are by Bill in Equity in the Name of the United States.

The proceeding for the repeal of an unlawful patent of the second or third classes is by a bill in chancery in the name of the government or its Attorney-General.¹ Such proceedings are instituted with great caution. The Attorney-General

§ 729. ¹ In *Mowry v. Whitney* (1871), 14 Wall. 434, Miller, J.: (440) "The *scire facias* to repeal a patent was brought in chancery where the patent was of record. And though in this country the writ of *scire facias* is not in use as a chancery proceeding, the nature of the chancery jurisdiction and its mode of proceeding have established it as the appropriate tribunal for the annulling of a grant or patent from the government. This is settled so far as this court is concerned by the case of *the United States v. Stone*, in which it is said that the bill in chancery is found a more convenient remedy. A bill of this character was also sustained in the English chancery in the case of *The Attorney-General v. Vernon*, on the ground of the equitable jurisdiction in matters of fraud. And in the case of *Jackson v. Lawton*, Chancellor Kent says that in addition to the writ of *scire facias* which has ceased to be applicable with us, there is another remedy, by bill

in the equity side of the court of chancery." 1 O. G. 499 (500); 5 Fisher, 513 (515).

That proceedings to repeal a patent under the act of 1793 were in the nature of a *scire facias*, see *Ex parte Wood* (1824), 9 Wheat. 603; 1 Robb, 438; *Stearns v. Barrett* (1816), 1 Mason, 153; 1 Robb, 97.

That only the attorney-general, in the name of the United States can sue to limit or repeal a patent, see *Celluloid Mfg. Co. v. Goodyear Dental Vulcanite Co.* (1876), 10 O. G. 41; 13 Blatch. 375; *United States v. Doughty* (1870), 7 Blatch. 424.

That the power of the attorney-general to sue for a repeal gives no power to a defendant in an infringement suit to bring the matter before the courts, see *New York and Baltimore Coffee Polishing Co. v. New York Coffee Polishing Co.* (1881), 20 Blatch. 174; 9 Fed. Rep. 578.

must be satisfied that sufficient grounds exist for submitting the question to the courts, and if he is in doubt he may be guided by the opinion of the Commissioner.³ In cases where the patent is alleged to have been fraudulently obtained he may act at the instigation of a private party, but not in cases where the matter urged as the reason for refusal could be employed by the relator in his own defence against the patent.³ In whosoever interest and for whatever purpose the proceedings are commenced, they remain always under his control, and can be prosecuted or discontinued by him as his judgment of the merits of the controversy may require.⁴

§ 730. Procedure and Judgment upon a Bill for Repeal.

Upon this bill in equity the process, pleadings, hearing, and decrees follow the usual course of chancery proceedings.¹ All persons to be affected by the repeal of the patent must be made parties, and the grounds of the repeal must be established beyond reasonable doubt. The effect of a judgment in favor of the public is to extinguish the patent and all rights accruing under it, even in the hands of an innocent *bona fide* purchaser; and the owners of the patent must thereupon sur-

³ That the name of the United States should be used in a bill for repeal only when the Commissioner is satisfied that the patent should be repealed, or the courts have doubted the validity of the patent, or the patent was fraudulently obtained, see Opinion Atty. Gen. (1874), 6 O. G. 723.

⁸ That a bill to repeal a patent on the ground of a false oath will not lie in the name of the United States in the interest of private parties, though they file a bond indemnifying the United States, if the same matters could be set up in their defence when sued, see *United States v. Frazer* (1884), 22 Fed. Rep. 106.

⁴ That suits to annul patents are wholly within the control of the United

States attorney, and there is no obligation resting on him to institute or proceed with them, see *New York and Baltimore Coffee Polishing Co. v. New York Coffee Polishing Co.* (1881), 9 Fed. Rep. 578; 20 Blatch. 174.

§ 730. ¹ That pending a suit on behalf of the United States for the repeal of a patent, an injunction to restrain or suspend actions for infringement will not be granted, the United States having no interest in such actions, see *United States v. Colgate* (1884), 22 Blatch. 412; 21 Fed. Rep. 318.

That the institution of a suit to repeal a patent raises no presumption of its invalidity, see *American Bell Telephone Co. v. National Improved Telephone Co.* (1886), 27 Fed. Rep. 663.

render it to the Patent Office that it may be duly cancelled.² Costs may be decreed against any owners of the patent whose false suggestions led to its original issue, but not against an owner who was not a party to the fraud.

² That a patent will be repealed on account of the fraud of the patentee, when he was not the true inventor, although his co-owner was not a party to the fraud, but was a *bona fide* as-

signed for valuable consideration, no costs, however, being decreed against him, see *United States v. Gunning* (1884), 23 Blatch. 31; 22 Fed. Rep. 653.

CHAPTER IV.

OF THE CONSTRUCTION OF LETTERS-PATENT.

§ 731. Nature and Scope of the Patent Monopoly Determined by the Legal Interpretation of the Letters-Patent.

THE character and scope of a patent privilege is determined by the construction given to the letters-patent.¹ The patented invention is not necessarily the art or instrument which has been actually discovered or produced by the inventor, nor that which he endeavored to protect or thinks he has protected by his patent;² it is the art or instrument which his patent really describes and claims, according to its true legal interpretation. Hence all his rights in reference to the exclusive use of his invention, and all the rights of the public to its free enjoyment, depend in the last resort upon the meaning which the law attaches to the language of his patent. The duty of interpreting letters-patent, therefore, imposes vast responsibilities upon the tribunal to which it is confided, and its proper discharge demands a high degree of industrial skill and knowledge.

§ 732. Interpretation of Letters-Patent a Matter of Law for the Court.

The duty of interpreting letters-patent has been committed to the courts.¹ A patent is a legal instrument, to be construed,

§ 731. ¹ That a patent grants just what the courts construe it to grant, see *Serrell v. Collins* (1857), 1 Fisher, 289. to be, but on what the patent covers when properly construed, see *Masury v. Anderson* (1873), 11 Blatch. 162; 6 Fisher, 457; 4 O. G. 55.

² That the opinions of patentees on legal questions connected with their patents are not binding on them, see *Adams v. Edwards* (1848), 1 Fisher, 1.

That the rights of a patentee do not rest on what he supposes the invention

§ 732. ¹ In *Emerson v. Hogg* (1845), 2 Blatch. 1, Betts, J. : (6) "It is the province and the duty of the court to settle the meaning of the patent, and, if that cannot be ascertained satisfac-

like other legal instruments, according to its tenor. Whether its Claims are valid or invalid, whether or not they embrace a given invention, and what may be the actual nature of the invention which they do embrace, are questions of law for the court, to be decided upon an inspection of the instrument itself.² No evidence of any kind, no opinions of other persons, can have any direct influence upon this decision. Where technical terms are used, or where the qualities of substances or operations mentioned or any similar data necessary to the comprehension of the language of the patent are unknown to the judge, the testimony of witnesses may be received upon these subjects, and any other means of information be employed.³ But in the actual interpretation of the patent the

torily upon the face of the specification, the law declares it insufficient for ambiguity and uncertainty. (Godson on Pat. 109, and Supp. 29; Phillips on Pat. 249, 252.) The meaning of the terms employed, in view of the object the inventor had in contemplation, and to ascertain the extent of his claim, must be determined and declared by the court. The specification is laid before the jury as defined and settled by the exposition of the court, and the matters of fact presented by the respective parties to support or defeat the patent are then to be examined and applied as if the construction fixed by the court had been incorporated in the specification."

Further, that the interpretation of a patent is a matter of law for the courts, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 19 Fed. Rep. 514; 28 O. G. 1007; *Jackson v. Allen* (1876), 120 Mass. 64; *Union Sugar Refinery v. Matthiesson* (1865), 2 Fisher, 600; 3 Clifford, 639; *Page v. Ferry* (1857), 1 Fisher, 298; *Parker v. Hulme* (1849), 1 Fisher, 44; *Davoll v. Brown* (1845), 1 W. & M. 53; 2 Robb, 303.

That the construction of the patent is for the court, its application to the facts is for the jury, see *Teese v. Phelps* (1855), 1 McAllister, 48.

That it is for the court to say what the patent covers, and for the jury to say if the patent is sufficiently clear and full to enable the public to practise the invention, see *Parker v. Stiles* (1849), 5 McLean, 44; *Davis v. Palmer* (1827), 2 Brock. 298; 1 Robb, 518.

² That the construction of a specification is for the court as a matter of law, see *Conover v. Roach* (1857), 4 Fisher, 12; *Emerson v. Hogg* (1845), 2 Blatch. 1.

That the construction of the Claims of a patent is matter of law for the court, unless technical terms require evidence to explain them, see *Ransom v. Mayor of N. Y.* (1856), 1 Fisher, 252.

That whether a given element is claimed as essential or not is a question for the court, see *Vance v. Campbell* (1859), 1 Fisher, 483.

That the question as to the validity of the Claims is largely a question of law, see *Burdett v. Estey* (1878), 15 O. G. 877; 15 Blatch. 349.

That the court need not construe the patent for the jury in an action on a contract unless so requested, see *Holiday v. Rheem* (1852), 18 Pa. St. 465.

³ In *Day v. Stellman* (1859), 1 Fisher, 487, Giles, J. : (491) "The court would remark that while the interpretation and construction of all written instru-

court proceeds upon its own responsibility, as an arbiter of the law, giving to the patent its true and final character and force.

§ 733. Advantages of Confiding the Interpretation of Letters-Patent to the Courts as Matter of Law.

Apart from the general principles upon which this duty of interpretation is entrusted to the court, there are advantages attending it which the inventor could not otherwise enjoy.¹ To treat the nature of the patented invention as a matter of fact, to be inquired of and determined by a jury, would at once deprive the inventor of the opportunity to obtain a permanent

ments is for the court, it nevertheless will bring to its aid the testimony of witnesses to explain terms of art, and make itself acquainted with the material with which the contracts deal, and with the circumstances under which they were made; but neither the testimony of witnesses in general, nor of professors, experts or mechanics, can be received, to prove to the court what is the proper or legal construction of any instrument of writing. Such evidence is inadmissible."

That extraneous matters may be considered to aid construction when it becomes necessary, see *Day v. Cary* (1859), 1 Fisher, 424.

That the court is not to be controlled by expert evidence in the construction of the patent nor as to the novelty of the invention, see *Jackson v. Allen* (1876), 120 Mass. 64.

§ 733. ¹ In *Parker v. Hulme* (1849), 1 Fisher, 44, Kane, J.: (46) "The specification being an instrument of writing, and the words of which it is made up having a fixed and plain import, its interpretation is a matter exclusively for the court, who must explain it. This part of the case is not for the jury, who for the purposes of this cause will adopt and act upon the interpretation given to it by the court. There is great reason and im-

portance for this distribution of the respective duties of the court and the jury. The import of the instrument is purely a question of law. The interpretation of complicated instruments of writing is a special occupation, requiring, like all others, special training and practice. The judge, from his training and discipline, is more likely to give a proper interpretation to such instruments than a jury; and he is, therefore, more likely to be right in performing such a duty than a jury can be expected to be. The action of a judge, in such a case as that of interpreting the specification, is moreover open to review and correction, by reconsideration on his part, or by the revisal of a superior or appellate court, where his reasoning can be tested. This is not so with a jury, who assign no reasons for their opinion, cannot be called on and are not permitted to review or reverse their action, and who, passing upon many questions in their private deliberations, do not declare by their verdict upon what particular elements they at last unite in a verdict; and it is impossible for a court to analyze them. The rule is, therefore, established, that on the judge is placed the responsibility, and he must declare the proper interpretation of written instruments." See also §§ 1017, 1174-1184 and notes, *post*.

and universal definition of his rights under the patent, and in each case of infringement it would subject him to the danger of a false interpretation, from the consequences of which he could not escape. By confiding this duty to the court, however, its decision as to the nature of the patented invention becomes reviewable to the same extent as any other legal question, and when his patent has received the interpretation of the Supreme Court of the United States the inventor can maintain his privilege, as thus interpreted, against all opponents without further controversy in reference to its true limitations.²

§ 734. Interpretation of Letters-Patent Governed by both General and Special Rules.

In the construction of letters-patent the courts are guided by certain well-established rules which are intended to secure the reciprocal rights of the inventor and the public. Most of these rules are found in the decisions of the courts themselves, and are characterized by that liberal spirit which our law has always displayed toward the inventor. In discussing them in detail it will be convenient to consider, first, the general rules applicable to all letters-patent, and second, the special rules adopted in particular cases.

SECTION I.

OF THE CONSTRUCTION OF LETTERS-PATENT : GENERAL RULES.

§ 735. First General Rule : Patents are to be Liberally Construed in Favor of the Inventor.

The fundamental rule governing the construction of a patent, and of each of its individual parts, requires that it be liberally interpreted in favor of the patentee.¹ The patent privilege is

² That the construction given to a patent by the Supreme Court is final, see *Goodyear Dental Vulcanite Co. v. Davis* (1877), 3 Bann. & A. 115; 12 O. G. 1. ¹ That a patent will be liberally construed, see *Trader v. Messmore* (1875), 1 Bann. & A. 639; 7 O. G. 385; *Carew v. Boston Elastic Fabric Co.* (1871), 1 O. G. 91; 5 Fisher, 90; 3 Clifford, 356; *Francis v. Mellor* (1871), 5 Fisher, 153; 8 Phila. 157;

§ 735. ¹ That a patent will be liberally construed, see *Trader v. Messmore* (1875), 1 Bann. & A. 639; 7 O. G. 385; *Carew v. Boston Elastic Fabric Co.* (1871), 1 O. G. 91; 5 Fisher, 90; 3 Clifford, 356; *Francis v. Mellor* (1871), 5 Fisher, 153; 8 Phila. 157;

property, and its extent and value are not to be limited, nor is its title to be disturbed, on any doubtful grounds.³ It is created by a grant from the sovereign power, and for that reason every presumption of law is in support of its validity, and such construction must be given to the letter of the grant as will most perfectly secure the proposed benefit to the grantee.³ It is the consideration of a contract made between the inventor and the public, and the instrument describing it must, therefore, be interpreted in the interest of the inventor to whom the consideration moves.⁴ Thus in whatever aspect

1 O. G. 48; *Rubber Co. v. Goodyear* (1869), 9 Wall. 788; *Union Sugar Refinery v. Matthiesson* (1865), 2 Fisher, 600; 3 Clifford, 639; *Imlay v. Norwich & Worcester R. R. Co.* (1858), 1 Fisher, 340; 4 Blatch. 227; *Potter v. Holland* (1858), 1 Fisher, 382; 4 Blatch. 238; *Goodyear v. Railroad* (1853), 2 Wall. Jr. 356; 1 Fisher, 626; *Parker v. Sears* (1850), 1 Fisher, 93; *Davoll v. Brown* (1845), 1 W. & M. 53; 2 Robb, 303; *Ryan v. Goodwin* (1839), 3 Sumner, 514; 1 Robb, 725; *Blanchard v. Sprague* (1839), 3 Sumner, 535; 1 Robb, 734; *Ames v. Howard* (1833), 1 Sumner, 482; 1 Robb, 689; *Whitney v. Emmett* (1831), Baldwin, 303; 1 Robb, 567.

That the specification is to be read in a liberal spirit, see *Hamilton v. Ives* (1873), 6 Fisher, 244; 3 O. G. 30; *Goodyear v. Railroad* (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

That the specification of a patent should be so construed as to sustain it if possible, see *Goodyear v. Berry* (1868), 3 Fisher, 439; 2 Bond, 189; *Johnson v. Willimantic Linen Co.* (1866), 33 Conn. 436.

That a Claim is to be construed liberally by the specifications, drawings, and state of the art, see *Smith v. Prior* (1873), 2 Sawyer, 461; 6 Fisher, 469; 4 O. G. 633.

² In *Blandy v. Griffith* (1869), 3 Fisher, 609, Swayne, J.: (620) "The

rights secured by a patent for an invention or discovery are as much property as anything else, real or incorporeal. The titles by which they are held, like other titles, should not be overthrown upon doubts or objections capable of a reasonable and just solution in favor of their validity. This principle should be steadily borne in mind by those to whom is intrusted the administration of civil justice." See also *Francis v. Mellor* (1871), 1 O. G. 48; 8 Phila. 157; 5 Fisher, 153; *Goodyear Dental Vulcanite Co. v. Gardiner* (1871), 3 Clifford, 408; 4 Fisher, 224.

³ That the presumptions are in favor of a patent and it should be liberally construed, see *Potter v. Holland* (1858), 4 Blatch. 238; 1 Fisher, 382; *Rex v. Mussary* (1738), 1 Web. 41; 1 Abb. P. C. 8.

That Claims will be construed, if possible, to sustain the patentee's right to all he has invented, see *Ransom v. Mayor of N. Y.* (1856), 1 Fisher, 252.

⁴ In *C. A. Yale Cigar Mfg. Co. v. Yale* (1884), 30 O. G. 1183, Dyrenforth, Act. Com.: (1188) "It is a contract between the public and the patentee, to be supported on the ground of mutual considerations, and, being essentially a bargain, is to be construed like other contracts to which there are two parties, each having rights and interests involved in its stipulation."

That the language of a patent must be

the patent privilege may be viewed, justice and legal principle both find expression in this rule, — that the presumption is in favor of the patentee, and that all doubtful points must be resolved in such a manner as to support his claims.

§ 736. **Wherein a Liberal Construction of Letters-Patent Consists.**

A liberal construction is given to the patent when its terms are so interpreted as to sustain the patent and cause it to protect the actual invention.¹ The law recognizes that Claims and Descriptions often are, and in the nature of things often must be, unskillfully drawn, and must, therefore, in many cases fail to represent unequivocally the invention which the patentee endeavored to secure.² To apply such Claims and Descriptions to the invention as it really exists, by giving to each word and phrase that one of its legitimate meanings which makes the whole Claim or Description correspond most accurately with the essential characteristics of the true invention, is to give the patent that liberal construction which the law requires.³

construed so as to effectuate the intention of the parties, and must be limited in scope if the inventor so intended, see *Harris v. Allen* (1883), 15 Fed. Rep. 106.

§ 736. ¹ In *Corning v. Burden* (1853), 15 How. 252, Grier, J. : (269) "It is true that the patentee, after describing his machine, has set forth his Claim in rather ambiguous and equivocal terms, which might be construed to mean either a process or machine. In such case the construction should be that which is most favorable to the patentee, '*ut res magis valeat quam pereat.*' His patent having a title which claims a machine, and his specification describing a machine, to construe his Claim as for the function, effect, or result of his machine, would certainly endanger, if not destroy, its validity. His Claim cannot change or nullify his previous specification with safety to his patent."

That a patent should be liberally construed so as not to limit the invention

beyond the facts, see *Schillinger v. Gunther* (1877), 11 O. G. 831; 14 Blatch. 152.

That a patent will be construed to sustain the Claim, though the specification must be broadly interpreted in order to do it, see *Mallory Mfg. Co. v. Marks* (1881), 20 O. G. 1521; 20 Blatch. 32; 11 Fed. Rep. 887.

That the court should interpret a patent as persons skilled in the art would, see *Tondeur v. Stewart* (1886), 37 O. G. 672; 28 Fed. Rep. 561.

² That in construing patents the court will remember that the specification and Claims are often unskillfully drawn, see *Henderson v. Cleveland Co-operative Stove Co.* (1877), 2 Bann. & A. 604; 12 O. G. 4.

³ That a patent is to be construed by applying its words to its subject-matter, see *Goodyear Dental Vulcanite Co. v. Gardiner* (1870), 4 Fisher, 224; 3 Clifford, 408.

That the construction of patents is to

§ 737. Rule of Liberal Construction does not Authorize a Departure from the Language of the Letters-Patent.

This rule of liberal construction does not, however, confer upon the court the power to change the language of the patent, or to give to words or phrases a meaning wholly different from their own.¹ To interpret the terms of a patent is one act; to create new terms, either directly by substituting other terms or indirectly by adopting new significations for existing terms, is an entirely distinct act; and no authority to perform the latter act has ever been committed to the courts.² If the language of a patent is erroneous, if the inventor has discovered much and described little, if subsequent events have taught him that his patent is narrower than his actual invention, his remedy is by a new patent or by an amendment of his old patent, not by its forced construction.³ The court, interpret-

be practical, not fanciful, see *Davoll v. Brown* (1845), 1 W. & M. 53; 2 Robb, 303.

That a patent for an art cannot be limited to the apparatus used for practising the art, see *Hammerschlag Mfg. Co. v. Bancroft* (1887), 32 Fed. Rep. 585.

§ 737. ¹ That a patent will be interpreted by its own terms, see *Goodyear Dental Vulcanite Co. v. Davis* (1880), 102 U. S. 222; 19 O. G. 543.

That a patentee should be held strictly to the language of his Claim, see *De-long v. Bickford* (1882), 13 Fed. Rep. 32; 22 O. G. 2242.

That a patent is not to be enlarged by construction beyond what is explicitly described and claimed, see *Keystone Bridge Co. v. Phoenix Iron Co.* (1877), 95 U. S. 274; 12 O. G. 980.

² That while a patent is to be fairly construed, no new specification can be made by implication, see *Sickels v. Gloucester Mfg. Co.* (1856), 1 Fisher, 222.

That Claims must be construed by the language which is employed, not by what might have been employed, see *Patent Clothing Co. v. Glover* (1887), 40 O. G. 1135; 24 Blatch. 542.

³ In *Detmold v. Reeves* (1851), 1 Fisher, 127, Kane, J.: (131) "If he has discovered much and discloses little; if there has been revealed to him one of the *arcana* of nature, and he communicates to the world only one or more of its derivatives and secondary truths, he patents no more than he has proclaimed. He will not be allowed afterward, when the extent of his right shall be the subject of controversy, either by expanding into a general expression what was limited before in a particular form, or by tracing out for us the line that leads back from consequences to remote causes, to initiate us, inferentially, into the radical mystery of his invention, and then argue that he had described it by implication from the first, and so claimed ownership of it in his patent."

That the court cannot consider that a Claim might have been broader if it is actually too narrow, see *Becker v. Hastings* (1884), 28 O. G. 98; 22 Fed. Rep. 827.

That if the patentee accepts a patent with narrow Claims they cannot be enlarged by construction, see *Sutter v. Robinson* (1886), 119 U. S. 530; 38