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THE LAW OF PATENTS.

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THE

LAW OF PATENTS

FOR

USEFUL INVENTIONS.

BY

called
WILLIAM C. ROBINSON, LL.D.,

PROFESSOR OF LAW IN YALE UNIVERSITY.

IN THREE VOLUMES.

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BOOK IV.
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VOL. III. — 1

TREATISE
ON
THE LAW OF PATENTS.

BOOK IV.

OF WRONGS AND REMEDIES.

PRELIMINARY ANALYSIS.

§ 846. **Laws for the Protection and Vindication of the Rights of Owners of Patented Inventions Liberally Construed and Applied.**

THE various rights created by the exercise of inventive skill, by the grant of letters-patent, and by the contract relations entered into between patentees and other parties, are subject to invasion by numerous wrongs, differing widely in their character and in the nature and application of the remedies by which they are redressed. The law aims to afford complete protection to those from whom the public receive such signal benefits as are conferred upon them by inventors; and where, from the intrinsic difficulties of the case, adequate protection cannot be secured, it endeavors to compensate them fully for the injuries they have sustained. In this department of remedial justice, therefore, is the liberal spirit of our modern jurisprudence toward inventors especially displayed. Not only are their rights clearly and minutely defined and each variety of wrong against them met by an appropriate remedy, but in administering these remedies the courts are uniformly governed by the principle that an inventor, having performed his part of his agreement with the public, is entitled to a perfect

vindication of his rights and to an exhaustive satisfaction for his wrongs. The operation of this principle is particularly apparent in the adjustment of protective measures to actual or threatened injuries, in the flexibility with which the rules of practice are adapted to the exigencies of each individual controversy, in the weight given to the presumptions in favor of the inventor, and in the methods by which damages are ascertained; but every detail of procedure is characterized by the same leaning toward the inventor and against those by whom his rights have been infringed. In that discussion of these various wrongs and remedies, which is to form this concluding portion of our treatise, it will be necessary to consider separately the rights arising from the exercise of inventive skill alone, the rights created by the grant of letters-patent, and the rights resulting from contracts between the owner of the patent and third persons, with the wrongs by which each is invaded, and the remedies by which those wrongs may be redressed.

§ 847. Protection of the Rights of an Inventor in his Unpatented Invention.

By the performance of an inventive act the inventor acquires a property in the invention which he thus creates, irrespective of its future protection by a patent. This property vests in him by the law of nature, and by the same law may be divested in any manner which places it in the possession of the public. Before the establishment of patent systems the knowledge of the public was equivalent to the possession of the public, and an inventor could retain the property in his invention only while he preserved his secret. Under the Patent Law he can disclose the nature and the mode of use of his invention without surrendering it until his patent has expired; and under our American law he can use it publicly for a certain period before applying for a patent without the risk of thereby forfeiting his exclusive rights. The property which thus vests in him by the law of nature, enlarged in its enjoyment by the provisions of our Patent Law, is recognized as entitled to the same protection as any other form of property; and whether attacked by force or

fraud his rights therein are vindicated by the courts, and the wrongs committed against them are adequately redressed.

§ 348. Protection of the Rights of an Inventor in his Patented Invention.

The issue of a patent confers on the inventor additional rights of extraordinary scope and value. Not only is he now empowered to use his invention in public, and to permit others to use it, without abandoning his own dominion over it, but he is clothed with an authority whereby he can prohibit the enjoyment of the invention to all persons whomsoever, even although they are original inventors like himself. The monopoly created by his patent prevails over all the rights which later inventors of the same invention would otherwise acquire by the exercise of their inventive skill, and renders their use of their own inventions, whether openly or in secret, equally an infringement of his rights as if they were mere imitators of his results. The patentee, under a valid patent, thus owns the invention as his exclusive property, whose value is capable of being lessened or destroyed by any act which impairs its commercial importance, or converts the proceeds of its enjoyment into other channels; and for any such injury, of whatever character, the law provides a remedy as ample and efficient as it is in the nature of human jurisprudence to afford.

§ 349. Protection of the Contract Rights of the Inventor and his Transferees.

An invention, whether patented or unpatented, being, like other property, subject to conveyance by its owner in such interests and upon such terms as he may deem expedient, various relations may arise between him and his transferees, to each of which attach certain rights and obligations, susceptible of violation in numerous modes and requiring protection and vindication according to the nature of the injuries threatened or received. These relations are divisible into two groups, — one characterized by a conveyance which transfers the monopoly as well as the invention, and embracing assignors and assignees and grantors and grantees; the other by a conveyance which operates upon the invention alone, leav-

ing the monopoly unaffected in the hands of its former owner except by an estoppel in favor of the transferee, and includes all such parties as are known by the general names of licensors and licensees. The rights and duties of the different members of each of these two groups are so far similar that they may be properly treated together with reference to the wrongs by which they are invaded and the remedies applied for their redress.

§ 850. Protection of the Contract Rights of Assignors and Assignees.

The rights of the assignor against the assignee and of the grantor against the grantee are few and simple. The principal one is the right to recover the price which the assignee or grantee has agreed to pay for the interests transferred to him. The others grow out of special stipulations contained in the conveyance, or from the general law which limits the enjoyment of the transferee to the precise privileges conferred upon him by the owner of the invention. The rights of the assignee against the assignor, and similarly of the grantee against the grantor, are more numerous and complex. He has a right to the transfer to him of the invention and the patent according to the terms of the contract made between them. Upon a total failure of the consideration moving toward him he has a right to recover back the purchase-money which he has already paid. If the conveyance contains covenants of warranty he is entitled to their fulfilment, or to damages for their breach, as well as that of the implied warranty of title which enters into all transfers of property. He has a right also to good faith and fair dealing on the part of his grantor or assignor, and to a remedy for any fraud that may be practised upon him.

§ 851. Protection of the Contract Rights of Licensors and Licensees.

The rights of the licensor against the licensee resemble those of assignors against their assignees. He is entitled to the license fee or royalties which the licensee agrees to pay for the enjoyment of his privilege, and to the compliance of

the licensee with those restrictions which the license or the law itself imposes on him. The licensee, under certain circumstances, has a right to repudiate the license and to recover back the license-fees which he has paid. He has a right to be defended by the licensor against infringers whose practice of the invention is injurious to his interests. He acquires rights also under the covenants in his license, whether express or implied, and to the estoppel by virtue of which he is protected against an assertion of the monopoly by the licensor in derogation of the privilege that his license has conferred. For a violation of any of these rights, and for any fraud or imposition of which the licensor is guilty in obtaining his submission to the patent, he has his remedy in an appropriate and effective form.

§ 852. General Division of the Subject of Wrongs and Remedies.

This outline of the rights connected with inventions indicates the topics to which a discussion of wrongs and remedies must relate and the order in which they must be pursued. Hence we shall consider in the following pages : —

- I. Wrongs against the owners of unpatented inventions.
- II. Wrongs against patentees.
- III. Wrongs between contracting parties.

And in connection with each class of wrongs the remedies provided by the law for their redress.

§ 853. Remedies for Certain Wrongs Afforded by Federal Courts: for Other Wrongs by State Courts: this Distinction Preliminary.

Before entering upon this discussion a collateral topic, affecting to a certain extent the details of each of these main topics, must, however, be examined. In the United States every person resides under two different governments, and is subject to two different systems of jurisprudence. His rights are protected by two distinct bodies of law, and his wrongs are redressed in the courts of two independent sovereignties. In reference to every group of wrongs and remedies the question, therefore, arises whether the wrongs invade the rights

protected by the State or by the Federal law, and whether the remedies are to be applied by the Federal or by the local courts. This question is particularly important in connection with the rights in patented inventions, since some of these rights depend upon the laws of the United States, and others on the laws of individual States; and thus in instituting any action for a violation of these rights it must be first determined whether the cause is one of State or Federal jurisdiction. To avoid the discussion of this question in connection with each wrong and its remedy, the entire subject will be here considered in a preliminary chapter.

CHAPTER I.

OF THE JURISDICTION OF THE FEDERAL AND STATE COURTS OVER ACTIONS WHICH RELATE TO PATENTED INVENTIONS.

§ 854. Federal Jurisdiction where Parties are Citizens of Different States: this Jurisdiction not Exclusive.

Courts derive their jurisdiction over actions either from the residence of the parties or from the subject-matter of the controversy. The Federal courts having no jurisdiction other than that conferred upon them by the Acts of Congress in pursuance of the Constitution, the State courts retain sole cognizance of all actions not thus specifically placed under the jurisdiction of the Federal courts. Jurisdiction has been bestowed upon the Federal courts in certain cases, on the ground of the residence of the parties, if the plaintiff and defendant are citizens of different States. In such cases the nature of the subject-matter of the controversy is of no importance.¹ The rules which determine whether jurisdiction on this ground exists, being common to all wrongs and remedies, will not be here discussed, the reader having access to them in works particularly devoted to that subject. In the following examination of the other ground of jurisdiction it will be assumed that the citizenship of the parties to the controversy is the same.

§ 855. Federal Jurisdiction Exclusive over all Cases Arising under the Patent Laws.

Jurisdiction, on the ground of subject-matter, has been vested in the Federal courts over all cases arising under the

§ 854. ¹ That where the parties on one side of the controversy differ in citizenship from the parties on the other side, the Federal courts have jurisdiction, see *Campbell v. James* (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354.

Patent Laws.¹ This jurisdiction is exclusive, and hence no suit arising under the Patent Laws, whatever may be the residence of the parties, can fall within the cognizance of any local court.² In any given case, therefore, the jurisdictional question is determined as soon as it is ascertained whether or not the case itself is included in the class above described. The line which divides this class from all that lie outside it is now clearly defined, both upon principle and by the concurrent decisions of the State and Federal courts.

§ 856. Cases Arising under the Patent Laws are Cases Affecting the Monopoly Created by such Laws.

The purpose and effect of the Patent Laws is to create and preserve a monopoly in the patented invention in favor of the patentee. They are not concerned with the invention as dis-

§ 855. ¹ That the Federal courts have exclusive jurisdiction over all cases arising under the Patent Laws, see *Willis v. McCollin* (1886), 38 O. G. 1017; *Brown v. Texas Cactus Hedge Co.* (1885), 64 Tex. 396; *Page v. Dickerson* (1871), 28 Wis. 694; *Slemmer's Appeal* (1868), 58 Pa. St. 155.

That under the act of 1819 the jurisdiction of the Federal courts was not exclusive, see *Burrall v. Jewett* (1830), 2 Paige (N. Y.) 134; qualified by *Gibson v. Woodworth*, 8 Paige (N. Y.), 132.

² That the Federal courts have exclusive jurisdiction over any controversy as to the patent right without regard to the citizenship of the parties, see *Duke v. Graham* (1884), 19 Fed. Rep. 647; *Campbell v. James* (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354; *Allen v. Blunt* (1849), 1 Blatch. 480.

That where the subject-matter confers jurisdiction any issue as to citizenship is immaterial, see *Fischer v. Neil* (1881), 6 Fed. Rep. 89; 19 O. G. 603.

That the act of March 3, 1875, changed the law of 1789, and gave jurisdiction to the Circuit Court over all

patent cases wherever the parties may reside, see *Colluloid Mfg. Co. v. Good-year Dental Vulcanite Co.* (1876), 10 O. G. 41; 13 Blatch. 375; 2 Bann. & A. 334.

That the jurisdiction of the Federal courts over patent cases is not dependent on the amount involved, see *St. Paul Plow Works v. Starling* (1888), 127 U. S. 376; 43 O. G. 1350.

That under the act of March 3, 1887, the \$2,000 limitation does not apply to jurisdiction over patent cases, see *Miller Megee Co. v. Carpenter* (1887), 43 O. G. 1118.

That the object of conferring jurisdiction over all patent cases on the Federal courts was to secure uniformity in the law on all points as to rights and remedies, see *Read v. Miller* (1867), 3 Fisher, 310; 2 Bissell, 12.

That the Supreme Court will not reverse a decree for want of jurisdiction in the court below, if the court had jurisdiction, though on narrow grounds, when the bill was filed, and the defendant did not then except, see *Clark v. Wooster* (1886), 119 U. S. 322; 37 O. G. 1477.

tinguished from the monopoly, nor with the mode and extent of the enjoyment of the privileges which the monopoly confers. They vest in the patentee an exclusive right to practise the invention and thereby forbid all other persons to employ it except with his consent; and while this right exists and remains uninvaded by the wrongful use of the invention their object is accomplished. The rights of the patentee in the patented invention considered as an article of property, and the obligations into which he enters with others as to its ownership or enjoyment, are matters collateral to the existence and continuance of the monopoly, dependent upon it indeed but not affecting it, and capable of assertion or repudiation without impairing the exclusive privilege which it bestows. Until, therefore, a controversy arises involving the existence or preservation of the monopoly, there can be no case under the Patent Laws.¹ All other controversies relate to property rights or contract rights which fall within the purview of the general laws, and are thus to be determined by the tribunals having ordinary jurisdiction over such subjects.²

§ 856. ¹ That the Federal courts have no jurisdiction unless the rights of the patentee under the Patent Laws of the United States are directly in issue, see *Teas v. Albright* (1882), 22 O. G. 2069; 13 Fed. Rep. 406.

That a patent matter, conferring jurisdiction, is a matter regulated by the Patent Laws of the United States, see *Blanchard v. Sprague* (1859), 1 Clifford, 288.

That the Federal courts do not have jurisdiction over a suit merely because it may become necessary in it to attack or defend a patent, see *Merserole v. Union Paper Collar Co.* (1869), 3 Fisher, 483; 6 Blatch. 356.

That the existence and validity of the monopoly, as claimed under the patent, are the only questions arising under the Patent Laws, see *Blakeney v. Goode* (1876), 30 Ohio St. 350; *Cellu-*

loid Mfg. Co. v. Goodyear Dental Vulcanite Co. (1876), 10 O. G. 41; 13 Blatch. 375; 2 Bann. & A. 334.

² That a question of contract concerning a patent-right or a patented invention is not a question under the Patent Laws, see *Ingalls v. Tice* (1882), 14 Fed. Rep. 352; *Hartell v. Tilghman* (1878), 99 U. S. 547; *Tilghman v. Hartell* (1876), 9 O. G. 886; 2 Bann. & A. 260; *Hill v. Whitcomb* (1874), 5 O. G. 430; 1 Bann. & A. 34; *Holmes*, 317; *Green v. Wilson* (1870), 6 C. E. Green, (N. J.) 211; *Bloomer v. Gilpin* (1859), 4 Fisher, 50; *Goodyear v. Union Rubber Co.* (1857), 4 Blatch. 63; *Nesmith v. Calvert* (1845), 1 W. & M. 34; 2 Robb, 311.

That a bill to subject a patent to an execution does not present a case under the Patent Laws, see *Ryan v. Lee* (1882), 10 Fed. Rep. 917.

§ 857. **Three Classes of Cases Affect the Monopoly.**

Controversies involving the existence and preservation of the monopoly may assume any one of three forms: (1) An affirmation and denial as to the legal existence of the monopoly in favor of any person; (2) An affirmation and denial as to the existence of the monopoly in favor of the patentee; (3) An affirmation and denial concerning the character of the matters embraced in the monopoly. In the first form, the patentability of the invention is the subject of dispute; in the second, the title of the patentee or his assignee; in the third, the scope of the monopoly, or in other words its existence as to certain instruments or operations claimed by the patentee to lie within it.¹ None of these controversies can be decided

§ 857. ¹ That any issue concerning the validity of a patent, the title of the alleged owner of the patent, or the fact of infringement, involves the monopoly itself, and is consequently under the exclusive jurisdiction of the Federal courts, has been recognized in a multitude of cases, both Federal and State, of which the following are examples:—

As to validity:

Dale Tile Mfg. Co. v. Hyatt (1888), 125 U. S. 46; 43 O. G. 249; *Brown v. Texas Cactus Hedge Co.* (1885), 64 Tex. 396; *Maurice v. Devol* (1883), 23 W. Va. 247; *Rawson v. Harger* (1878), 48 Iowa, 269; *Green v. Willard Improved Barrel Co.* (1876), 1 Mo. Ap. 202; *Page v. Dickerson* (1871), 28 Wis. 694; *Mer-serole v. Union Paper Collar Co.* (1869), 3 Fisher, 483; 6 Blatch. 356; *Tomlinson v. Battell* (1857), 4 Abb. Pr. 266; *Rich v. Atwater* (1844), 16 Conn. 409.

As to title:

In *Duke v. Graham* (1884), 19 Fed. Rep. 647, Hill, J. : (648) "If this had been a transaction accruing after the issuance of the letters-patent, the parties both being citizens of this State, it is clear that this court would have no jurisdiction of the subject-matter of the suit; but it is a question involving the property rights, so to speak, of the

defendant in the letters-patent themselves, and as between the co-partners themselves. The bill seeks to set aside the rights conferred upon defendant as one of the partners, and to vest the entire right in complainant. This, it seems to me, affects the patent, and also seeks to restrain the defendant from using in any way the rights conferred under the Swift patent, and which, by the understanding of the parties, was to become, in connection with complainant's improvement thereon, the joint property of complainant and defendant,—the rights secured by the letters-patent issued by the government Nov. 16, 1880,—and is essentially different from rights growing out of contracts between the patentees and third parties. I am of opinion that this court has jurisdiction to determine the question as to the right of the parties to the rights and benefits conferred by the patent issued to them by the government, and enforce their rights by a proper decree."

In *Hyatt v. Ingalls* (1883), 49 Sup. Ct. (N. Y.), 375, Freedman, J. : (378) "A grant to a patentee of an exclusive right to manufacture and vend an article described therein is a grant of property; and if the validity of the

without affecting the monopoly and enforcing, enlarging, or curtailing the rights created and bestowed under the Patent Laws; while if the patentability and scope of the invention and the title of the patentee are conceded, there can be no question in relation to the existence and continuance of the monopoly. Cases not presenting one or more of these three forms of controversy are, therefore, not cases arising under the Patent Laws.

patent is unquestioned, State courts will protect the owner of such property in the enjoyment thereof, by means of a decree of injunction, to the same extent as they would do were the subject-matter of the litigation of any other description. But where the validity of the plaintiff's patent is put in question by the pleadings in a State court, and the defendants present such proofs upon the trial as render it necessary for the court to examine and pass upon conflicting patents or claims of priority in invention, in order to determine whether the plaintiff has such a property in the subject-matter of the grant as entitles him to the exclusive and unmolested use of it, and an objection is taken to the jurisdiction of the court for that reason, the bill must be dismissed; for in such cases the jurisdiction is in the courts of the United States exclusively. (*Hovey v. Rubber Tip Pencil Co.*, 33 Sup. Ct. 522; affirmed 57 N. Y. 119.)"

In *Campbell v. James* (1880), 18 O. G. 1111, Wheeler, J. : (1113) "It is quite obvious from this statement that all these questions are questions of title to the patent which arise under the Patent Laws. . . . It has never been doubted but that the Circuit courts have jurisdiction of all such questions, whatever the doubts and decisions may have been when neither the title itself nor any question as to whether there was an infringement was before the court. (*Hartell v. Tilghman*, 99 U. S.

547.)" 2 Fed. Rep. 338 (344); 18 Blatch. 92 (98); 5 Bann. & A. 354 (360).

That the Federal courts have jurisdiction over a controversy as to what patents are covered by the assignment of an invention before patent, see *Puetz v. Bransford* (1887), 41 O. G. 353; 32 Fed. Rep. 318.

As to infringement :

That the jurisdiction of the Federal courts over the question of infringement is exclusive, see *Kayser v. Arnold* (1886), 41 Hun, 275; *Continental Store Service Co. v. Clark*, (1885), 100 N. Y. 365; *Kelly v. Kelly Scroll Mfg. Co.* (1884), 15 Bradwell (Ill.), 547; *Smith v. Standard Laundry Mach. Co.* (1882), 22 O. G. 587; 20 Blatch. 360; 19 Fed. Rep. 825; *Campbell v. James* (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354; *Satterthwait v. Marshall* (1872), 4 Del. Ch. 337; *Merserole v. Union Paper Collar Co.* (1869), 3 Fisher, 483; 6 Blatch. 356; *Bloomer v. Gilpin* (1859), 4 Fisher, 50.

That actions under the Patent Laws are only for the purpose of protecting the patentee from infringements, see *Celluloid Mfg. Co. v. Goodyear Dental Vulcanite Co.* (1876), 10 O. G. 41; 13 Blatch. 375; 2 Bann. & A. 334.

That a proceeding to enforce a contract is totally different from an infringement suit, see *Brown v. Shannon* (1857), 20 How. 55.

§ 858. **Controversies Collateral to Cases not Embraced in one of these Three Classes are not Cases Affecting the Monopoly.**

Furthermore, a case or cause is a controversy in which the rights of the parties are judicially determined. The affirmations and denials constituting the controversy must result in one or more issues which by the judgment of the court are to be conclusively and permanently settled, so far as the parties and their privies are concerned. A controversy which arises collaterally to some other controversy, and whose decision enters into the adjudication of the latter only as a matter of evidence and not as an essential element in the judgment, is not a cause, nor is its decision binding even on the same parties when engaged in a different litigation. Subordinate controversies of this character constantly arise in the course of legal proceedings, such as the controversy as to title in actions *quare clausum*, or as to the truth of the publication in actions for slander, but they are no part of the cause itself, and the finding of the court concerning them is simply the determination of a fact which serves as the basis of an inference regarding some essential matter covered by the issue. The mere presence in the cause of a controversy relating to the patentability or the scope of an invention, or the title of the patentee, does not bring the case among those which arise under the Patent Laws. The existence or continuance of the monopoly must be put in issue, and submitted to the judgment of the court for permanent and conclusive settlement between the parties, and not as a subordinate or collateral matter whose decision paves the way to that of the real controversy.¹

§ 858. ¹ In *Tomlinson v. Battell* (1857), 4 Abb. Pr. 266, Duer, J. : (268) "It is not necessary to deny that when a question as to the construction, and, perhaps, as to the validity, of a patent arises, collaterally, in the progress and upon the trial of a cause, the necessity of its determination will not oust a State court of the jurisdiction which it derived from the nature of the action and the state of the pleadings. But here the existence and validity of a

patent concerning the process, by which are produced the pictures to which alone the name of ambrotypes can properly be given, lie at the very foundation of the plaintiff's claim. They are facts constituting, in part, the cause of action; as such they are averred in the complaint, and as such are put at issue by the answer. It is upon an exclusive right secured by a patent that the action is founded. It is this exclusive right that the answer denies, and it is

§ 859. An Action to Repeal a Patent is a Case Affecting the Monopoly.

The principal, if not the only, cases in which the existence or continuance of the monopoly are directly in issue and determined by the judgment are actions brought to repeal a patent, actions to annul an interfering patent, and actions for infringement. An action to repeal a patent is instituted for the purpose of destroying the monopoly. It is an effort of the sovereign power to frustrate the creative act in which the monopoly originated, and to return the invention to its former unpatented condition. It puts in issue the right of the government to grant or of the patentee to receive the patent, and if successful terminates in a judgment which conclusively and permanently deprives the patentee of his exclusive rights. Such actions are, therefore, pre-eminently cases arising under the Patent Laws, and consequently are within the exclusive jurisdiction of the Federal courts.¹

§ 860. An Action to Annul an Interfering Patent is a Case Affecting the Monopoly.

An action to annul an interfering patent does not aim at the entire destruction of all monopoly in the invention, but at the discontinuance of that created in favor of the defendant patentee. It can be instituted only between parties who concede the patentability of the invention and the right to a monopoly in some one as against the public, but each of whom claims for himself the right to that monopoly to the exclusion of the others. Before its institution at least two patents covering the same invention must have been granted to two inde-

this denial which raises a question that, when thus raised, neither this nor any other State court, in my judgment, has authority to determine, — a question which I have no right to determine, and must refuse to consider."

Further, that the Federal courts obtain jurisdiction, on the ground of the subject-matter of the controversy, only when validity, title, or infringement are put in issue by the pleadings and must enter into the judg-

ment, see *Teas v. Albright* (1882), 22 O. G. 2069; 13 Fed. Rep. 406; *Blake-ney v. Goode* (1876), 30 Ohio St. 350; *Satterthwait v. Marshall* (1872), 4 Del. Ch. 337; *Green v. Wilson* (1870), 6 C. E. Green (N. J.), 211; *Rich v. Atwater* (1844), 16 Conn. 409.

§ 859. ¹ That a suit for the repeal of a patent is within the exclusive jurisdiction of the Federal courts, see *Merserole v. Union Paper Collar Co.* (1869), 3 Fisher, 483; 6 Blatch. 356.

pendent patentees, thereby apparently creating two distinct concurrent monopolies in the same art or article, one of which only can be valid, the prior inventor having the sole right to a patent protecting him in its exclusive use.¹ This proceeding, being intended to avoid the patents granted to his later rivals, denies the legal existence of the monopolies which they appear to have received, and seeks the cancellation of their letters-patent in order to deprive them of their *prima facie* title to the invention, and to remove the cloud which their possession of these patents casts upon his own. The fact in issue is the title of the patentee to his monopoly, and the judgment rendered, in accordance with the issue, conclusively confirms or destroys this monopoly as between the parties to the action. An action to annul a patent is thus a case arising under the Patent Laws, and hence is within the exclusive jurisdiction of the Federal courts.³

§ 861. **An Action for Infringement is a Case Affecting the Monopoly.**

An action for infringement, though an action of tort demanding compensation for the past invasion of the patentee's exclusive rights, nevertheless directly involves the existence or the scope of the monopoly or the title to the patent. An infringement can be committed only by the practice of the patented invention without the permission of the patentee. An allegation of infringement, therefore, includes an averment that the invention is the proper subject of a monopoly, an averment that the monopoly has been properly conferred upon the patentee as the first and true inventor, and an averment that the monopoly embraces the invention practised by the alleged infringer. A denial of infringement controverts the patentability of the invention, or the title of the patentee, or the scope of the monopoly, and thus puts in issue the exist-

§ 860. ¹ As to the nature of an action to annul an interfering patent, &c., see §§ 721-724, and notes, *ante*.

² That the Federal courts have exclusive jurisdiction over actions to annul an interfering patent, see *Rice v. Garnhart* (1874), 34 Wis. 453; *Gibson*

v. Woodworth (1840), 8 Paige (N. Y.), 132.

That the Federal courts have exclusive jurisdiction over all actions between adverse patentees as to infringement or priority, see *Rice v. Garnhart* (1874), 34 Wis. 453.

ence of the monopoly so far forth as the acts of the alleged infringer are concerned. A judgment on this issue determines, as between the parties, either that the monopoly does or does not legally exist at all; or does or does not legally exist in favor of the patentee; or does or does not legally exist as against the acts performed by the defendant; none of which questions can arise except under the Patent Laws, or be decided elsewhere than in the Federal courts.¹

§ 861. ¹ That the Federal courts have exclusive jurisdiction over all actions for infringement, see *De Witt v. Elmira Nobles Mfg. Co.* (1876), 66 N. Y. 459; *Smith v. McClelland* (1875), 11 Bush, 523; *Rice v. Garnhart* (1874), 34 Wis. 453; *Stone v. Edwards* (1872), 35 Tex. 556; *Slemmer's Appeal* (1868), 58 Pa. St. 155; *Kendall v. Winsor* (1860), 6 R. I. 453; *Elmer v. Pennel* (1855), 40 Me. 430; *Dudley v. Mayhew* (1849), 3 Comst. (N. Y.), 9; *Burrall v. Jewett* (1830), 2 Paige (N. Y.), 134; *Parsons v. Barnard* (1810), 7 Johns. 144; and cases cited in § 857, note 1, *ante*.

That one co-owner of a patent cannot sue for compensation for its use by an infringer in a State court, the cause of action not being contract but infringement, see *De Witt v. Elmira Nobles Mfg. Co.* (1876), 66 N. Y. 459.

That the purchaser of an exclusive right to sell must sue an infringer in the Federal courts, see *Stone v. Edwards* (1872), 35 Tex. 556.

That the Federal courts have jurisdiction over a suit for infringement by a licensor against his licensee though both are citizens of the same State, and the licensee denies that the license is terminated and that he infringes, see *Smith v. Standard Laundry Mach. Co.* (1882), 19 Fed. Rep. 825; 20 Blatch. 360; 22 O. G. 587.

That the Federal courts have juris-

isdiction over a suit for infringement brought by the licensee against the licensor, see *Stanley Rule & Level Co. v. Bailey* (1878), 14 Blatch. 510; 3 Bann. & A. 297.

That when a licensor annuls the license and obtains a decree for a rescission and an account to that date, a future use of the invention by the licensee will be an infringement of which only the Federal courts can take cognizance, see *Hyatt v. Ingalls* (1883), 49 Sup. Ct. N. Y. 375.

That a State Court cannot restrain a licensee from using the invention pending a suit by the patentee against him for royalties, see *Hat Sweat Mfg. Co. v. Remoehl* (1886), 102 N. Y. 167.

That a State court cannot enjoin against a suit for infringement in the Federal courts, see *Kendall v. Winsor* (1860), 6 R. I. 453.

That a State statute cannot deprive a Federal court of jurisdiction by conferring power on local officers to adjust claims against their local governments, see *May v. Saginaw Co.* (1887), 32 Fed. Rep. 629.

That in a suit for infringement in the Federal courts the rights of the parties will be determined under the Patent Laws without regard to the decision of a State court in a suit concerning their contract relations, see *Oliver v. Rumford Chemical Works* (1883), 109 U. S. 75; 25 O. G. 784.

§ 862. **Cases Affecting the Monopoly are within the Exclusive Jurisdiction of the Federal Courts though Involving Collateral Controversies not Arising under the Patent Laws.**

The exclusive jurisdiction of the Federal courts over all cases which involve the existence or continuance of the monopoly is not affected by the complication of this question with others which, if presented independently, these courts would have no power to decide.¹ Claims of infringement growing out of contract relations between the parties are no less proper subject-matter for the Federal Courts than similar claims based on wanton and malicious interference with the patented invention. Where, for example, a co-owner, under an agreement to procure a re-issue in the names of all, accepts the title to the patent and fraudulently obtains a re-issue to himself, under the color of which he employs infringing articles, his breach of contract and of trust, though affording his co-owners other grounds of action, do not deprive them of their right to sue him for infringement in the Federal courts.² Or where a licensor, who should protect his licensee against infringement, himself becomes the infringer and consequently cannot vindicate the rights he has conferred, the licensee, although he has a remedy upon his contract, is not deprived of his right to have the infringer punished or restrained, and is permitted to proceed against him in his own name, *ex necessitate rei*, in the Federal tribunals.³ Or again, where a

§ 862. ¹ That the Federal courts have exclusive jurisdiction over all questions of validity, title, or infringement, though other matters are collaterally involved, see *Teas v. Albright* (1882), 22 O. G. 2069; 13 Fed. Rep. 406; *Smith v. Standard Laundry Mach. Co.* (1882), 22 O. G. 587; 20 Blatch. 360; 19 Fed. Rep. 825; *Brooks v. Stolley* (1845), 3 McLean, 523; 2 Robb, 281.

That the Federal courts have jurisdiction over a suit to prevent the violation of a patent though the defence may rest on a contract between the parties, see *Seibert Cylinder Oil-Cup*

Co. v. Manning (1887), 32 Fed. Rep. 625.

² That the Federal courts have jurisdiction over a bill to enjoin a co-owner from using the invention, under an agreement to re-issue in their joint names as such co-owners, see *Duke v. Graham* (1884), 19 Fed. Rep. 647.

³ In *Stanley Rule & Level Co. v. Bailey* (1878), 14 Blatch. 510, *Shipman, J.*: (511) "It is not necessary in this case, the patentee and legal owner of the patent being the alleged infringer, to determine whether, under the recited agreement, the plaintiff is the grantee of such an exclusive right

license has existed but has been annulled and the licensee continues to practise the invention, or where the licensor alleges that the license has expired and the licensee insists that it is still in force,⁴ and in all other cases where the existence and scope of the monopoly are put in issue and decided, whatever may have been the circumstances out of which the alleged infringement has arisen and by whatever implications or agreements it may now be justified or excused, the controversy is a cause under the Patent Laws of the United States, and the exclusive jurisdiction of the Federal courts on this issue draws after it the power to decide all other matters which are necessary to its full determination.⁵

§ 863. Cases Affecting the Monopoly not Brought within the Jurisdiction of State Courts by Consent of Parties.

Where jurisdiction is exclusively conferred on one tribunal on the ground of subject-matter, no other tribunal can in any manner obtain cognizance thereof. Neither the convenience nor consent of the parties can bestow a power which the law has expressly or impliedly withheld, and though for want of this the interests of parties are imperilled, it is a defect in practical jurisprudence which the law itself and not the courts

that it can bring suit in its own name alone against strangers who are infringers, or is, as is claimed by the defendant, merely a licensee. In this case the patentee is the alleged infringer, and the Circuit Court has jurisdiction of the cause, whether the plaintiff is grantee or licensee. When the patentee has infringed his license, and, while holding the legal title to the patent in trust for his licensee, has been faithless to his trust, 'Courts of equity are always open to the relief of such a wrong. This wrong is an infringement. Its redress involves a suit, therefore, arising under the Patent Laws, and of that suit the Circuit Court has jurisdiction.' *Littlefield v. Perry*, 21 Wall. 205, 223." 3 Bann. & A. 297 (299).

⁴ That when a licensee continues to practise the invention after his license

is expired, claiming it to be still in force, the question is one for the Federal courts, being a question of infringement, see *Smith v. Standard Laundry Mach. Co.* (1882), 20 Blatch. 360; 22 O. G. 587; 19 Fed. Rep. 825.

That an action for royalties in which the validity of the patent and the fact of infringement are in issue and must be decided, is within the jurisdiction of the Federal courts, see *St. Paul Plow Works v. Starling* (1888), 127 U. S. 376; 43 O. G. 1350.

⁵ That jurisdiction having been once acquired on the ground of infringement, the court may grant complete relief and settle all other matters, though they are not original grounds of jurisdiction, see *Bloomer v. Gilpin* (1859), 4 Fisher, 50; *Brooks v. Stolley* (1845), 3 McLean, 523; 2 Robb, 281.

must remedy.¹ Thus in regard to cases which arise under the Patent Laws, and over which exclusive jurisdiction has been vested in the Federal courts, no State court can under any circumstances assume to exercise its judicial powers. Under whatever guise an action may be brought, if in reality it is a case which puts in issue and requires a judgment upon the existence or continuance of the monopoly created by a patent, it is the duty of the local court to dismiss it or provide for its removal to the courts by whom alone such issues can be lawfully determined.

§ 864. Actions for Breach of Contract or for Tort to the Patented Article are not Cases Affecting the Monopoly.

The existence and scope of the monopoly conferred by letters-patent rest entirely upon the provisions of the Patent Law. Whether or not the invention possesses the several requisites for patentability, whether or not the patentee is the first and true inventor, and whether or not the monopoly embraces any given art or article are facts which no act of the patentee or other parties can in any manner change; and when the law acting in view of these facts has bestowed the monopoly and defined its limits, its existence and its scope are fixed beyond the power of individuals to alter. Hence no contract entered into between the patentee and other persons, either before or after the issue of the patent, can in any degree affect the nature or extent of the monopoly. No injury to the property of the patentee in the invention, other than its unauthorized appropriation in violation of the patent, is an invasion of the monopoly. Neither the breach of such a contract, nor the commission of such an injury, can, therefore, form the basis of an action arising under the Patent Laws, although the subject-matter of the one and the property affected by the other is a patented invention. The wrongs

§ 863. ¹ That a defendant cannot waive an objection to the want of jurisdiction of a State court over an action for infringement, see *Dudley v. Mayhew* (1849), 3 Comst. (N. Y.), 9.

That a State court cannot assume jurisdiction on the ground that the

parties can be witnesses under State laws, see *Kendall v. Winsor* (1860), 6 R. I. 453.

That no laches of the defendant can waive an objection to the jurisdiction over the subject-matter, see *Creamer v. Bowers* (1887), 30 Fed. Rep. 185.

are in both cases wrongs at common law, and are to be redressed in the tribunals and by the methods ordinarily provided for such injuries. Over these, therefore, the State courts have exclusive jurisdiction, unless a difference in the citizenship of the opposing litigants confers it also on the Federal courts.

§ 865. **Actions for Breach of Contract, and for Torts to the Patented Article, are within the Jurisdiction of State Courts.**

Citizenship being the same, the State courts have sole cognizance of all actions based on contracts between the parties, whether to compel their performance, to rescind them, or to award damages for their violation.¹ Actions for breach of warranty, for fraud, for royalties or purchase-money, and for

§ 865. ¹ That an action to compel specific performance is within the exclusive jurisdiction of State courts unless the parties are of different citizenship, see *Wren v. Annin* (1888), 34 Fed. Rep. 435; *Perry v. Littlefield* (1879), 4 Bann. & A. 624; 17 O. G. 51; 17 Blatch. 272; *Brown v. Shannon* (1857), 20 How. 55.

That the fact that the subject-matter of the suit is a contract concerning a patent-right does not give the Federal courts jurisdiction, and that a bill for specific performance of such a contract must contain averments showing other grounds of jurisdiction, see *Nesmith v. Calvert* (1845), 1 W. & M. 34; 2 Robb, 311; *Burr v. Gregory* (1828), 2 Paine, 426.

That a breach of contract between assignor and assignee as to the mode of enjoying the patent is not within Federal jurisdiction, see *Williams v. Star Sand Co.* (1888), 35 Fed. Rep. 369.

That a suit to cancel or enforce a license is not within the jurisdiction of the Federal courts unless the parties reside in different States, and this must be alleged in the bill, see *Merserole v. Union Paper Collar Co.* (1869), 3 Fisher,

483; 6 Blatch. 356; *Goodyear v. Union Rubber Co.* (1857), 4 Blatch. 63.

That the Federal courts have no jurisdiction of a bill to enforce a contract as to the use of a patent where both of the parties are citizens of the same State, though they may protect the patentee from infringement by injunction, see *Brooks v. Stolley* (1845), 3 McLean, 523; 2 Robb, 281.

That Federal courts have no jurisdiction by virtue of the Patent Laws over a suit to enforce or rescind a license-contract, see *Dale Tile Mfg. Co. v. Hyatt* (1888), 125 U. S. 46; 43 O. G. 249; *Hammacher v. Wilson* (1886), 36 O. G. 233; 26 Fed. Rep. 239; *Hartell v. Tilghman* (1878), 99 U. S. 547.

That if a subsisting license is proved, and the parties are citizens of the same State, the Federal courts have no jurisdiction, see *Jencks v. Langdon Mills* (1886), 36 O. G. 347; 27 Fed. Rep. 622.

That the Federal courts may decide whether there is a subsisting license, or whether a license has been forfeited, but cannot enforce or avoid it where citizenship is the same, see *Hammacher v. Wilson* (1886), 36 O. G. 233; 26 Fed. Rep. 239.

the non-fulfilment of other collateral contracts, are also within their exclusive jurisdiction.² In such actions the validity of the patent, and consequently the existence of the monopoly, may be disputed and incidentally decided as preliminary to some point in issue, and thus the court may pass upon the same matters as are involved in cases arising under the Patent Laws; but upon these the judgment has no effect even between the parties, and the same questions are still open in any other litigation in which they may engage.³ An action

² That where the validity of the patent and the use by the defendant are admitted, and all the rights are covered by contracts, the case does not arise under the Patent Laws, and the Federal courts have no jurisdiction unless the citizenship of the parties is different, see *Ingalls v. Tice* (1882), 14 Fed. Rep. 352; *Hartell v. Tilghman* (1878), 99 U. S. 547; *Tilghman v. Hartell* (1876), 9 O. G. 886; 2 Bann. & A. 260; *Lockwood v. Lockwood* (1871), 33 Iowa, 509; *Green v. Wilson* (1870), 6 C. E. Green (N. J.), 211; *Bloomer v. Gilpin* (1859), 4 Fisher, 50.

That Federal courts have no jurisdiction over suits for royalties, see *Albright v. Teas* (1883), 106 U. S. 613; 23 O. G. 829.

That the Federal courts have no jurisdiction over contracts between patentees and their licensees, see *Willis v. McCollin* (1886), 38 O. G. 1017; *Hill v. Whitcomb* (1874), 5 O. G. 430; *Holmes*, 317; 1 Bann. & A. 34.

That one holding an exclusive license may be protected against injuries by injunction in a State court, unless the patent is in question, see *Hyatt v. Ingalls* (1883), 49 Sup. Ct. N. Y. 375.

³ In *Hyatt v. Ingalls* (1883), 49 Sup. Ct. N. Y. 375, *Freedman, J.* : (378) "There is, however, a class of cases in which the defendant cannot question the validity of the plaintiff's patent, because by his contract he has estopped himself from so doing, and of these a

State court may take cognizance. In them the question concerning the validity of the patent is merely a question collateral to the main issue, and goes only to the question whether there is a consideration to support the promise to pay. A case arising on a contract to pay royalties, or, in other words, a case between patentee and licensee, falls generally within the class last referred to."

In *Merserole v. Union Paper Collar Co.* (1869), 3 Fisher, 483, *Blatchford, J.* : (487) "A State court has jurisdiction to decree the license and agreement to be void and inoperative for fraud, or any other adequate reason; and the fact that in the investigation the State court will be obliged to inquire whether there was anything new in the patents which could operate as a consideration for the license and the agreement, cannot deprive the State court of jurisdiction, or confer it on this court. It is true that a State court cannot take cognizance of a suit brought for the infringement of a patent, nor of a direct suit brought to decree a patent to be void. But, as is well said by Chief Justice Williams, in *Rich v. Atwater*, 16 Conn. 409, 414, "That the validity of patent rights is a subject peculiarly within the jurisdiction of the courts of the United States is true; but it is equally true that when they come in question collaterally their validity must become a subject of inquiry in the State courts. Thus, in a suit upon a note, if

for the purchase-money of a patent right, for instance, may be defeated by proving that the patent was invalid and the con-

it is claimed that the note was given for a patent-right, and the patent is invalid, and so there was no consideration for the note, the State courts constantly exercise jurisdiction.' In *Rich v. Atwater* the plaintiff owned a patent for a machine which the defendant was infringing. The defendant, by a covenant, agreed not to use the infringing machine any longer, but nevertheless went on using it, and the plaintiff brought a suit founded on the agreement for an account and an injunction. The defendant offered to prove that the patent was invalid for want of novelty. The plaintiff objected to the evidence, and took the point before the full court, which held that the evidence was admissible. In *Cross v. Huntley*, 13 Wend. 385, the suit was brought on a note given on the sale of the patent for a machine. In defence it was proved that the machine was not new, and that the specification of the patent was so defective as to avoid the patent. Mr. Justice Nelson, in delivering the opinion of the court, says: "It is insisted by the defendant below that the patent is void, on the grounds (1), that the machine, for the making and vending of which the patent was granted, is not a new invention; and (2) if new in parts the patent is void, inasmuch as it is for the whole machine and not for the improvement. If either of these positions were sustained by the proof, the defendant was entitled to judgment in the court below, as in such case a failure of the consideration of the note was shown. From the evidence, there cannot be a doubt but that the patent, in both respects, is defective and void. . . . The patent being void, nothing passed to the plaintiff in error, and the note was given without consideration.' The case of *Head v. Stevens*, 19 Wend.

411, was one of the same character. It can make no difference whether the payee of the note, or the licensor in the license, brings the suit to enforce the note or the license, or whether the suit is brought by the maker of the note, or the licensee in the license, to cancel the instrument. The State court has jurisdiction in either case to inquire collaterally into the validity of the patent. It is true that a State court cannot entertain jurisdiction of a direct suit to repeal a patent. Every citizen has, abstractly, the same interest with every other citizen that a void patent shall not be in existence. Yet such interest is not sufficient to warrant the maintenance of a suit to repeal a patent. Such a suit cannot be brought in a State court." 6 Blatch. 356 (360).

Further, that validity, title, and infringement may be collaterally questioned in a State court, see *Continental Store Service Co. v. Clark* (1885), 100 N. Y. 365; *Brown v. Texas Cactus Hedge Co.* (1885), 64 Tex. 396; *Keith v. Hobbs* (1878), 69 Mo. 84; *Green v. Wilson* (1870), 6 C. E. Green (N. J.), 211; *Slemmer's Appeal* (1868), 58 Pa. St. 155; *Billings v. Ames* (1862), 32 Mo. 265; *Lindsay v. Roraback* (1858), 4 Jones Eq. (N. C.), 124; *Tomlinson v. Battell* (1857), 4 Abb. Pr. 266; *Vannini v. Paine* (1833), 1 Harr. (Del.) 65.

That a State court may collaterally inquire into identity of purpose and result, and into the utility of the invention, see *Hunt v. Hoover* (1868), 24 Iowa, 231.

That if the plaintiff must show the validity and existence of a patent in order to make out his case, the State courts have no jurisdiction, see *Tomlinson v. Battell* (1857), 4 Abb. Pr. 266; *Rich v. Atwater* (1844), 16 Conn. 409.

That a State court cannot go behind

tract therefore without consideration, but the judgment rendered affects only the contract, not the patent, and leaves the latter to stand or fall by the decision of the Federal courts.⁴ The same rules apply to actions *ex delicto*, as for a libel on a patent, — whatever the defendant may deem it expedient to allege, in excuse or justification of his acts, concerning the patentability of the invention, or the title of the patentee, being but collateral matter belonging to the field of evidence rather than to that of pleading, and in no wise determined by the judgment in that cause.

§ 866. Original Jurisdiction over Cases Arising under the Patent Laws is Vested in the Circuit Courts, and other Courts having Circuit Court Powers.

The entire original jurisdiction of the Federal courts over cases arising under the Patent Laws is vested in the Circuit courts, in the Supreme Court of the District of Columbia, and in such District courts as are endowed with Circuit court powers.¹ The Supreme Court of the United States obtains its jurisdiction by appeal from the Circuit Court.² These courts

a patent to inquire into its validity, see *Cowan v. Mitchell* (1872), 11 Heisk. (Tenn.) 87.

That it is doubtful whether a State court can pass upon novelty, see *Rawson v. Harger* (1878), 48 Iowa, 269.

That it is doubtful whether State courts of equity have concurrent jurisdiction where the Patent Laws are collaterally questioned, or where the relief would not invalidate the patent, see *Gibson v. Woodworth* (1840), 8 Paige (N. Y.), 132; qualifying *Burrall v. Jewett* (1830), 2 Paige (N. Y.), 134.

That a State court may punish for contempt in interfering with the receiver of a corporation appointed by the court, though the interference consists in the purchase of a new license by a member of the corporation for the making of an article which the corporation had an exclusive right to make, and which the receiver is making under order

of the court, and though such contempt is also an infringement, see *In re Woven Tape Skirt Co.* (1877), 12 Hun, 111.

⁴ That actions for royalties or purchase-money are within the jurisdiction of State courts though the validity of the patent, and the consequent want of consideration for the contract, are denied, see note 3, *ante*, and § 1257 and notes, *post*. But see *contra*, *St. Paul Plow Works v. Starling* (1888), 127 U. S. 376; 43 O. G. 1350.

§ 866. ¹ That the jurisdiction of the Circuit courts in patent cases is not changed by the Revised Statutes, see *Cochrane v. Deener* (1876), 94 U. S. 780; 11 O. G. 687.

That the Supreme Court of the District of Columbia has the same powers in patent cases as a Circuit court, see *Cochrane v. Deener* (1876), 94 U. S. 780; 11 O. G. 687.

² That the Supreme Court has no

will always consider the question of their jurisdiction, and a case improperly instituted will be dismissed or remanded to the appropriate tribunal.³ Objections to jurisdiction must be taken before the pleadings are closed and the evidence published, or they will be waived as far as the parties have power to waive them; but the want of jurisdiction on the ground of subject-matter is incurable by any laches of the parties, and whenever it may be discovered the case will be dismissed.⁴

original jurisdiction over questions of fact, such as infringement, &c., see *Wilson v. Barnum* (1850), 8 How. 258.

That the Supreme Court of the United States has no jurisdiction over a bill to enforce a contract for a patent unless the amount is over two thousand dollars, see *Brown v. Shannon* (1857), 20 How. 55.

³ That the Federal courts will always consider the question of their jurisdiction, see *Spring v. Domestic Sewing Mach. Co.* (1882), 22 O. G. 1445; 13 Fed. Rep. 446.

That a case erroneously brought from a State court will be remanded, on mo-

tion, where the want of jurisdiction appears, see *Teas v. Albright* (1882), 22 O. G. 2069; 13 Fed. Rep. 406.

⁴ That an objection to jurisdiction should be taken before the pleadings are closed and the evidence is published, see *Nesmith v. Calvert* (1845), 1 W. & M. 34; 2 Robb, 311.

That when the court has no jurisdiction the cause will be dismissed, see *Blanchard v. Sprague* (1859), 1 Clifford, 288.

That laches of the defendant cannot confer jurisdiction over the subject-matter, see *Creamer v. Bowers* (1887), 30 Fed. Rep. 185.

CHAPTER II.

OF WRONGS AGAINST UNPATENTED INVENTIONS.

§ 867. The Right of an Inventor to Preserve the Secret of his Invention Rests on Natural Law.

Whatever rights an inventor may possess in his unpatented invention vest in him by virtue of his inventive act alone. The conception of an idea of means makes that idea the absolute and exclusive property of its conceiver until in some manner he communicates it to others.¹ Although he embodies it in tangible materials and reduces it to practical operation it still belongs to him, unless its embodiment or operation discloses its essential characteristics to his fellow-men. In this condition of affairs the security of the inventor's property depends upon his preservation of his secret. While he successfully conceals the principle of his invention it is incapable of imitation, and his exclusive enjoyment of the fruits of his inventive skill must be as perfect and as certain as if sheltered under the most rigorous provisions of positive law.

§ 868. Forcible or Fraudulent Discovery of a Secret Invention Violates the Inventor's Rights.

The only wrong which an inventor can sustain in respect to his entirely undisclosed inventions, is that by which his secret is wrested from him against his will. This wrong may be committed either by force or fraud. Through physical compulsion, in the form of violence or threats, he may be driven to divulge the idea which he would otherwise have concealed, and be thus deprived of that exclusive knowledge which rendered his property in this idea secure. Or by a

§ 867. ¹ That an inventor preserving a right to its undisturbed enjoyment, his secret has, under the law of nature, see § 24 and notes, *ante*.

forcible invasion of his premises, or the asportation of the device in which his idea is embodied, the same result may be effected. Or by deceit and imposition he may be induced to yield the secret which he intended to preserve, and lose beyond recovery that dominion over it which, in the nature of things, was previously his.

§ 869. Remedies for the Forcible or Fraudulent Discovery of the Inventor's Secret.

The remedies for this wrong, in whatever way it may be committed, must be sought in the local courts having jurisdiction over the defendant, and in the ordinary forms of civil or equity procedure. The tort involved in either of its methods calls for compensation in damages, which are to be measured by the ordinary rules followed in other civil actions, and into which the violation of the inventor's secret may enter as a necessary element. The power which the wrong-doer has acquired to work him further injury through the possession and employment of his idea of means demands the interference of a court of equity, enjoining the defendant against the use of the invention and the communication of its principles to others. By these remedies, although the secret cannot be restored to the inventor nor the knowledge of it be obliterated from the memory of the wrong-doer, the disastrous consequences of the wrong to the inventor may be averted, and his practical enjoyment of his property be henceforth secured.¹

§ 869. ¹ Although direct authorities in support of these positions cannot be adduced, analogy and principle both require that this protection should be afforded to inventors who are not yet patentees. The case of an inventor whose process or device is wrongfully appropriated by another, without any prior contract between himself and the wrong-doer, so closely resembles that of an author whose productions are forcibly or fraudulently converted, that the rights and remedies of the latter may properly be predicated of the for-

mer. That the author has his remedies both at law and in equity is undoubted, see *Jeffreys v. Boosey* (1854), 4 H. L. 815, and other cases cited in *Kerr on Injunctions*, 182, &c. On principle, also, an inventor whose rights have been invaded by force or fraud without contract is certainly entitled to protection and redress, although courts of equity, in adherence to the ancient theories concerning their own jurisdiction in matters of tort, have formerly been inclined to refuse their assistance unless a trust relation of some character

§ 870. The Right of an Inventor to the Preservation of his Secret by those to whom he has Confidentially Communicated it.

Not every voluntary disclosure of his secret impairs the right of the inventor to an exclusive property in his unpatented invention. His confidential communication of it to others, through motives of friendship or of business, does not make it any less his secret or deliver it from his personal control.¹ It may be necessary to his practical enjoyment of its benefits that he should impart it to his co-partners or his employees, and if he does this under pledges of their secrecy, or with restrictions as to their power of using it or revealing it to others, he is entitled to have his confidence respected, and the limits he has fixed to the disclosure faithfully observed. An invention thus communicated does not cease to be a secret invention, however numerous the individuals may be on whom the knowledge of its essential characteristics is bestowed. They hold their knowledge in trust for the uses and purposes for which it was received, and are responsible to the inventor for their exact compliance with the conditions that he has imposed upon them.

§ 871. The Disclosure or Misuse of an Inventor's Secret by those to whom it was Confidentially Communicated is a Breach of Trust and Actionable.

The rights of an inventor in a secret invention, confidentially communicated to others, are capable of violation either on the part of those to whom it has never been disclosed by the inventor or on the part of those to whom he has entrusted it. With reference to the first class of persons it is still an entire secret, the knowledge of which they can obtain only by force or fraud. The wrongful acts by which they acquire possession of the secret are, therefore, as was stated in a preceding paragraph, torts to be compensated for in an action at

was discernible between the inventor and the defendant. See § 872 and notes, *post*.

§ 870. ¹ That an inventor may communicate his secret to others, in con-

fidence, without losing his exclusive rights therein, see *Salomon v. Hertz* (1886), 35 O. G. 1109; *Peabody v. Norfolk* (1868), 98 Mass. 452.

law for damages, while the practical enjoyment of the stolen secret is prevented by injunction.¹ With reference to the second class of persons the invention, though no longer secret, is known only for certain definite purposes, within the scope of which their employment of their knowledge must be confined. Any use of their knowledge for a different purpose, and any communication of it to others beyond the limits of the authority conferred upon them by the inventor, is a breach of trust, and an invasion of the rights expressly or impliedly reserved to him in the disclosure through which their own knowledge of the invention was obtained.

§ 872. Remedies for the Disclosure or Misuse of the Inventor's Secret.

The remedy for wrongs already committed against an inventor by persons entrusted with his secret is an action at law for damages in the State courts, or, where citizenship confers the necessary jurisdiction, in the Federal courts. This action has been variously regarded as one of tort based on the fraud involved in the breach of trust or as one of contract on the express or implied agreement to respect the reserved rights of the inventor, but in one form or the other adequate compensation is awarded for the injury sustained. Against a future and expected invasion of the inventor's rights equity will interpose an injunction, forbidding the unauthorized use of the knowledge of the defendant or his disclosure to others of the secret of the invention.¹ The latter remedy is open to the personal representatives of a deceased inventor, and to

§ 871. ¹ See § 869, *ante*.

§ 872. ¹ That equity will protect an inventor who preserves his secret against its fraudulent disclosure by another, see *Peabody v. Norfolk* (1868), 98 Mass. 452.

That the contract of a workman to preserve his employer's secret can be enforced in equity, see *Peabody v. Norfolk* (1868), 98 Mass. 452.

That an injunction will issue to prevent an employee from fraudulently dis-

closing the secret invention of his employer, see *Salomon v. Hertz* (1886), 35 O. G. 1109.

That whenever the disclosure of a secret invention involves a breach of trust or contract, equity will prevent it by injunction, see *Morison v. Moat* (1851), 9 Hare, 241; 21 L. J. Ch. 248; *Green v. Folgham* (1823), 1 S. & St. 398; *Yovatt v. Winyard* (1820), 1 J. & W. 394; *Williams v. Williams* (1817), 3 Mer. 157; *Smith v. Dickenson* (1804),

those whose fiduciary relations toward the defendant are derived from and identical with his.²

§ 873. **The Right of an Inventor to his Secret Protected though the Secret Invention is not Patentable.**

As the rights of an inventor to his secret invention, and to a remedy for the wrongs by which his property therein is injured, are not dependent upon the provisions of Patent Law, they exist equally whether the invention is or is not in its nature patentable. It must indeed be the product of inventive skill, for otherwise no title to it could vest in its inventor. But numerous products of inventive skill lie outside the field of those six classes of inventions which the Patent Law has undertaken to protect, and these are often as meritorious and valuable as those for which a patent can be legally granted. If the creator of these unpatentable inventions chooses to preserve his secret he has a right to do so, as also to communicate it confidentially under such restrictions as he deems expedient, and for an invasion of his rights he has the same redress as if the subject-matter of his invention were entitled to the protection of a patent.¹

3 Bos. & Pul. 630 ; Kerr on Injunctions, 181 ; Coryton on Patents, 30 ; Phillips on Patents, 333-341 ; Godson on Patents, 170.

Contra, *Newberry v. James* (1817), 2 Mer. 446.

² That an executor may maintain a bill in equity to protect the secret of his decedent, see *Peabody v. Norfolk* (1868), 98 Mass. 452.

§ 873. ¹ In *Peabody v. Norfolk* (1868), 98 Mass. 452, Gray, J. : (458) "If he invents or discovers, and keeps secret a process of manufacture, whether a proper subject for a patent or not, he has not indeed an exclusive right to it as against the public, or against those who in good faith acquire knowledge of it ; but he has a property in it which a

court of chancery will protect against one who, in violation of contract and breach of confidence, undertakes to apply it to his own use, or to disclose it to third persons. The jurisdiction in equity to interfere by injunction to prevent such a breach of trust, when the injury would be irreparable and the remedy at law inadequate, is well established by authority."

That a secret scientific invention improving a process may be protected by an injunction in the State courts, though it is not of a patentable nature, and persons who are intrusted with the secret may be enjoined from disclosing it, see *Hammer v. Barnes* (1863), 26 How. Pr. 174.

§ 874. The Right of an Inventor to his Unpatented Invention Forfeited by its Unrestricted Disclosure to Others unless Protected by Statute.

In the absence of any provision of positive law relating to the subject, the unrestricted disclosure of his secret by the inventor is destructive to his property therein. His idea of means then passes into the possession of mankind, becomes a portion of the common stock of knowledge, is open to the enjoyment of all who choose to use it, and thus escapes entirely from the ownership and control of the inventor.¹ It is immaterial whether such disclosure be made to one person or to many, since an unrestricted communication to a single individual gives him the right to disseminate his information without limit and thereby effectually and permanently deprives the inventor of his dominion over the invention. Nor is the method by which the disclosure is accomplished of any consequence provided that it be complete and voluntary. Verbal descriptions, drawings, models, the practical employment of the invention, the gift or sale of articles in which it is embodied, alike render it accessible to the general public and terminate the exclusive rights of its inventor.

§ 875. The Right of an Inventor to his Unpatented Invention, Notwithstanding its Unrestricted Disclosure to Others, Protected by Statute during, and for Two years Prior to, his Application for a Patent.

Under the laws of the United States, however, an exception to this general rule has been established. A patentable invention may be used openly by the inventor, and freely communicated by him to others, for the space of two years before his application for a patent as well as during the pendency of his application, without the dedication of his invention to the public, and consequently without forfeiting his right to its protection by a patent. Concerning the effect of this provision upon the right of the inventor to a patent and upon the completeness of the protection afforded him after the patent has been granted, there can be no question. In reference to these points, his situation is the same as if he had preserved

§ 874. ¹ See §§ 24, 71, 345-360 and notes, *ante*.

his secret until his patent had been issued. But concerning the nature of his property in the invention during this period of open use before the patent, the mode by which his rights in it are vindicated, and the forum in which his remedies for their invasion must be sought, some doubts exist which only future decisions or legislation can resolve. Yet reason and analogy indicate, sufficiently to warrant their discussion, the principles upon which these doubts must be settled, and the results at which the legislatures and the courts must eventually arrive.

§ 876. Three Views of the Inventor's Right to his Disclosed Invention, under this Statute, During and Prior to his Application for a Patent.

As to the nature of the inventor's property in his unpatented invention during this period of unrestricted disclosure, three views are possible: (1) That such disclosure deprives him of his vindicable property in the invention until the patent issues, leaving it open meanwhile to the public use, without power on his part to prevent it or liability on theirs for its employment, and that the issue of the patent reverts in him this property with all the other rights of the monopoly; (2) That such disclosure does not affect the property of the inventor nor confer upon the public the right to use the invention, but suspends his power to protect and vindicate it until his patent has been granted, the remedies then afforded relating back and covering the wrongs committed before the issue of the patent; (3) That notwithstanding such disclosure the invention still possesses all the attributes of a secret invention, remaining under the inventor's entire control and entitled to the same protection as if it continued undisclosed.

§ 877. First View, — Temporary Abandonment and Resumption, — Untenable.

The first of these views is evidently untenable. A temporary abandonment of the invention, followed by its resumption at the issue of the patent, is in opposition to the fundamental notion of abandonment, which consists in an irrevocable dedication to the public. It confers no important benefit on the

community at large to allow them to enjoy an invention of which they may, at any moment, be deprived, while it imposes an unnecessary and unreasonable burden on the inventor as the condition of his own privilege of public use and sale. It was, of course, within the power of Congress to separate, for the time being, the right to a patent from the property in the invention, and permit its disclosure to suspend the latter in favor of the public, though it preserved the former in full force against them. But nothing in the spirit of the law, or in the language or the object of this particular provision, is in harmony with this position. Before the insertion of this clause in the statutes the inventor was, as he still is, completely protected in his ownership of the invention, unless he voluntarily and without restrictions communicated it to others, in which case his invention was abandoned without the possibility of a recovery. This clause prevents the public from taking advantage of such unrestricted disclosure as an abandonment of the invention, except when it has continued beyond a certain period or was accompanied by other circumstances which established an intention to abandon; and though the principal relief expected was undoubtedly to be afforded by still permitting the inventor to obtain a patent, there is no indication that in other respects the invention was to lie at the mercy of the public. On the contrary, the whole doctrine of public use and sale, as expounded by the courts, regards the invention as within the dominion of the inventor, however freely he may part with his control over the articles in which it is embodied. Until, therefore, this first view has been explicitly adopted by competent authority as truly presenting the rights of the inventor during this period of unrestricted disclosure, it must be presumed to be erroneous and deserving of no serious attention.

§ 878. Second View, — that Violations of this Right are Infringements for which an Action will lie after the Patent is Granted, — Objectionable.

According to the second view, the property of the inventor is not affected by his disclosure, but his pursuit of a remedy for its invasion is postponed until his patent has been granted.

In support of this view certain reasons may be urged which are entitled to consideration. The first grows out of the uncertainty whether the inventor will procure, or even attempt to procure, a patent, and the injustice of allowing him to retain, for any period, his control over an invention which he has fully communicated to the public and for which he is unable, or does not purpose, to secure the exclusive privileges of a patentee. Opposed to this reason, however, is the rule that the presumption that the inventor does not intend to abandon his invention can be rebutted only by conclusive evidence that he has such an intention, that his disclosure unaccompanied by other acts within the period prescribed is not such evidence, and therefore that until this period has elapsed he must be regarded as expecting to obtain a patent and perpetuate his rights. Another reason rests upon the fact that his rights after disclosure subsist only by virtue of the positive provisions of the Patent Laws, under which he can have no remedy until the patent has been granted. This reason cannot prevail; first, because wherever the law creates or declares a right and does not provide a remedy, the owner of the right may have recourse to any appropriate existing remedy, — of which in this case there are several, both at law and equity; second, because although this right depends upon the Patent Law, it is not a right under or collateral to a patent, but the prolongation and enlargement of a natural right, which is capable of protection and vindication in the same manner as if no disclosure had been made. Other reasons of less weight than the foregoing might be suggested in support of this view, but to each of them the answer is so clear that in the absence of express decisions in its favor adherence to it as the true statement of the inventor's rights must be withheld.

§ 879. **Third View, — that the Right of the Inventor under this Statute is a Continuation of his Natural Right and Entitled to the same Protection, — Probable.**

According to the third view the inventor's property in his invention and his right to an immediate remedy in case of its actual or threatened invasion are not affected by its unrestricted disclosure, unless such disclosure is protracted

beyond the lawful period or is accompanied by other acts establishing his intention to abandon it. In other words, his invention, though universally known, has all the legal attributes of a secret invention until the lapse of time or other circumstances make it apparent that the inventor has dedicated it to the public. This view is the most simple, the most intelligible, and the most consistent with the liberal spirit of our laws toward the inventor. That it is also the correct one is shown by the purpose and character of this provision of the law itself, and by its agreement with the other rights which are already recognized as vesting in him. At the time of the introduction of this provision into our Patent Law, the inventor did not lose his property in his invention, nor his right to protect it by immediate remedies and to secure for it the ultimate protection of a patent, by any involuntary disclosure or by any voluntary disclosure in the confidence of business or of friendship. As this provision was evidently not intended to restrict the rights of the inventor it must have been intended to extend them, and to extend them in such directions as would relieve him from existing difficulties. His principal difficulties at that time were these: the difficulty of proving that a given disclosure was confidential or restricted by conditions; the difficulty of ascertaining whether his invention had sufficient commercial value to warrant him in patenting it, unless it could be, to some extent, subjected to the test of public use; and the difficulty of determining whether the instrument or operation produced by the inventor were original with him, and due to his inventive rather than his imitative skill, until it had been submitted to those acquainted with the art, among whom alone its prior existence and its patentable merit could be known. Congress removed these difficulties by fixing a period within which it should be immaterial whether the disclosure were confidential or unrestricted, and during which the commercial importance of the invention and its patentable merit could be fully ascertained. But it had no occasion to interfere with the property or the remedies already conferred on the inventor, or to introduce new theories of ownership, or to establish new relations between him and the public. The simple provision that two

years of unrestricted disclosure should be allowed to the inventor without affecting his rights in his invention was sufficient to accomplish all the objects for which this alteration in our law was then designed.

§ 880. Third View Alone Consistent with the Other Rights of the Inventor in his Unpatented Invention.

Moreover, the character of this provision itself indicates that this view is correct. It fixes a limit only to use or sale with the inventor's knowledge and consent. Under it an unauthorized use or sale for any period of time, however long, confers no rights upon the public and curtails no rights of the inventor.¹ Although a single instance of authorized use or sale may place the invention within the knowledge of the public, the possession of such knowledge does not empower them to employ it without the inventor's acquiescence or consent. The language of this provision thus contemplates a complete dominion of the inventor over the enjoyment of his invention except so far as he relinquishes it in favor of individual vendees or licensees, — a dominion which would be practically valueless were he not able to assert it by the immediate application of remedies for its invasion.

§ 881. Third View Alone Consistent with the Contract Rights of the Inventor in Reference to his Unpatented Invention.

Again, during this period of unrestricted disclosure, the law recognizes the contract rights of the inventor over his invention as unimpaired, and affords him ample and immediate remedies for their violation. He can assign it with or without the right to obtain a patent; he can license its employment in such a manner as to bind him as well after as before the patent has been granted; and the obligations growing out of these conveyances can be enforced irrespective of the issue of a patent. It would be indeed a strange anomaly in our law if property thus the subject of a contract were not also

§ 880. ¹ It will be perceived that which was recognized in all our courts in this connection the author adheres prior to the new departure discussed in to the view of public use and sale § 357 and notes, *ante*.

regarded as liable to tortious injury, or if the remedies for the latter class of wrongs were suspended while the remedies for the former were applied. Analogy requires that the ownership of the inventor should be protected against invasion by the tort-feasor as well as against breaches of contract, and that his action for either injury should be at once available.

§ 882. Third View Indicates that the Inventor's Right, under this Statute, is Subject to the same Violations and Entitled to the Same Redress as his Right to his Secret Invention.

It may, therefore, be safely predicted that when the law on this point becomes settled, the third view of the inventor's rights will be the one adopted by the courts, and that pending this period of unrestricted disclosure his invention will be treated as within his own control as fully as while he still preserved his secret. In this event the wrongs by which his property in it may be violated, and the remedies by which those wrongs may be redressed, must be the same as those already discussed with reference to secret inventions. For its unauthorized employment an action for damages must lie at law, the damages being computed on the same general basis as if the suit were brought for the infringement of a patent. For a threatened infraction of his rights an injunction must be obtainable in equity.¹

§ 883. Inventor's Right in his Unpatented Invention not Violated by the Independent Inventive Acts of Others, nor by the Enjoyment of their Results.

It is to be remembered that the wrongs considered in this chapter can be committed only by the unauthorized appropriation of the fruits of the inventor's own inventive skill. His property vests in him by virtue of his inventive act, and is invaded only when the results of that inventive act are

§ 882. ¹ That an infringement after the patent has been applied for, and pending proceedings in the Patent Office, may be prevented by injunction, see *Butler v. Ball* (1886), 28 Fed. Rep. 754; 38 O. G. 420.

That an injunction will lie to prevent the unauthorized use of an uncopyrighted production, see *Goldmark v. Kreling* (1885), 25 Fed. Rep. 349; 11 Sawyer, 215; *Kerr on Injunctions*, 182.

forcibly or fraudulently converted to the use of others. An independent exercise of inventive skill by a different inventor, though developing and embodying the same idea of means, is not a violation of his rights, but on the contrary confers on that inventor the same property and privileges that he enjoys. Rival inventors in their use of their own inventions are, therefore, not tort-feasors as against each other, nor is the invader of the rights of one necessarily a transgressor against the other. To be liable to either, the wrong-doer must not only have appropriated the invention, but appropriated it from him. It is not until a patent has been granted that the question of priority of invention can be settled, and the first and true inventor can monopolize the invention against all mankind.

CHAPTER III.

OF WRONGS AGAINST PATENTEES.

§ 884. Wrongs against a Patentee are Violations of his Right in his Monopoly.

By the issue of letters-patent the inventor is endowed with a monopoly in the invention against all other persons, — rival inventors as well as mere imitators, — and is entitled to its uninterrupted enjoyment, without loss, diminution, or control, except by due process of law. Any act of others by which its value to him is wrongfully decreased is an injury to his rights as patentee for which the law, whereby these rights are created or declared, is bound to provide an ample and appropriate remedy. No act, however, constitutes a wrong against the patentee unless it embraces both elements of a tort, the *damnum* and *injuria*. A lawful act, such as the original invention of a superior art or instrument, may entirely destroy the commercial importance of his patent and render all his labor and expenditure in connection with it utterly unproductive. This is *damnum absque injuria*, for which of course no action lies. In order to invade his rights as patentee such acts must be directed against the monopoly conferred upon him by the patent, attacking the franchise which it purports to bestow, and destroying or curtailing the privileges which, by virtue of it, he alone is authorized to enjoy.¹

§ 884. ¹ Injuries to a patented article by force or negligence, and injuries to a patented art or instrument by acts or representations creating doubts as to its industrial value, are simple torts, not affecting the existence or title to the monopoly, and are remediable, if at all, under the provisions of the common law, in the courts having jurisdiction over the parties.

§ 885. Rights in a Monopoly Violated by Injuring the Reputation of the Patented Invention or by its Unauthorized Use.

The rights conferred by a patent are subject to two forms of injury. One is committed by maliciously and publicly injuring the reputation of the patented invention, and does not involve the use of the invention itself; the other consists in an unauthorized use of the invention in violation of the exclusive privilege granted by the patent, with or without a denial of its validity. The latter wrong, commonly called infringement, is by far the most important, and is the occasion of nearly all the actions brought by patentees in vindication of their rights. But the former is of not infrequent occurrence and is often sufficiently disastrous in its consequences to the patentee to warrant his pursuit of the remedies which, in such cases, the law affords. These two wrongs we shall now consider, giving attention first to slander or libel against a patented invention, and second, to infringement.

SECTION I.

OF SLANDER OR LIBEL AGAINST A PATENTED INVENTION.

§ 886. Nature of the Injury Inflicted by Slander or Libel against a Patented Invention.

The commercial value of his patent to the patentee depends, in a great degree, upon the opinion entertained by other men concerning its validity. A patent is valid when its subject-matter is patentable and when the patentee is the first and true inventor. An opinion that the subject-matter is not patentable tends to promote infringements of the patent and to deprive the patentee of that dominion over his invention which it is the purpose of the patent to secure. An opinion that the patentee is not the first and true inventor destroys that confidence in his power to confer indisputable titles on his assignees and licensees without which it is often impossible for him to profit by his own invention. The dissemination of either of these opinions is thus an injury to the patentee,

and if malicious and unlawful is a wrong for which he is entitled to receive redress.¹

§ 887. Slander or Libel against a Patented Invention by Denying its Patentability.

The publication, verbal or in writing, of statements impugning the validity of a patent on the ground of the non-patentability of its subject-matter, are *prima facie* wrongful. The issue of a patent constitutes presumptive evidence that the invention comes in all respects within the purview of the law and is entitled to protection, and any private individual who publicly avers the contrary does so at his peril.¹ Like other slanders against business interests this is actionable only when it causes special damage, and it may be justified or excused by the defendant in the usual modes pertaining to this class of injuries.²

§ 888. Slander or Libel against a Patented Invention by Denying that the Patentee was the First and True Inventor.

Statements derogatory to the title of the patentee, as the first and true inventor, occupy a somewhat different position. When made by persons having no claim of right to the invention as the product of their own creative skill, they are slanders or libels for which a proper remedy may be obtained.¹

§ 886. ¹ That a libel or slander against a patent right is an injury for which the courts will afford an adequate redress, see *Palmer v. Travers* (1884), 20 Fed. Rep. 501; 22 Blatch. 185; *Bell v. Singer Mfg. Co.* (1880), 65 Ga. 452; *Whitehead v. Kitson* (1876), 119 Mass. 484.

That it is a libel to charge a man with infringing a patent, see *Watson v. Trask* (1834), 6 Ohio, 531.

That an infringer will not be protected against circulars warning the public, and the burden of proof as to his non-infringement is on him, see *Barney v. United Telephone Co.* (1884), L. R. 28 Ch. D. 394.

§ 887. ¹ That a public denial of the

title to a patented invention, if malicious, is actionable, see *Bigelow Leading Cas. Torts*, 42; 2 *Addison on Torts*, § 1137, p. 969, ed. 1876.

² That a libel or slander against the title to an invention is not actionable unless causing special damage, see 2 *Addison on Torts*, § 1137, p. 969, ed. 1876; 1 *Hill. Torts*, 342, *note*.

§ 888. ¹ That the public denial that the patentee or his assignor was the first and true inventor, if malicious and causing special damage to the owner of the patent, is actionable, see *Emack v. Kane* (1888), 34 Fed. Rep. 46; *Halsey v. Brotherhood* (1879), L. R. 15 Ch. D. 514; 19 Ch. D. 386; *Wren v. Weild* (1869), L. R. 4 Q. B. 730.

But rival inventors, whether patentees or not, may protect their own interests and warn the public against infringing on their rights by giving notice of their claims and denying the validity of a rival patent.² Such notices, however, must be couched in moderate language, and having conferred upon the public the necessary information must refrain from superfluous adverse commentary on the existing patent.³ Any excess, even in this case, becomes a libel for which the patentee may have redress.

§ 889. **Remedy for Slander or Libel against a Patented Invention.**

The remedy at law for slander against a patent is an action on the case praying damages according to the injury actually sustained. Whether equity affords relief by interfering to prevent the repetition of the wrongful publication has been variously held, — in some States the patentee being left to his legal remedy, in others being protected by injunction.¹ Where

² That a patentee may circulate notices warning the public not to buy the invention except from him, see *Hovey v. Rubber Tip Pencil Co.* (1871), 33 Sup. Ct. N. Y. 522.

That parties claiming rights under patents may publish their own claims and warn others, and if they act in good faith they will not be restrained, see *Croft v. Richardson* (1880), 59 How. Pr. 356.

That a circular forbidding persons to buy articles claimed to be infringements is not a libel calling for damages or injunction if in good faith, and the circulator's patent is apparently valid, see *Société Anonyme v. Tilghman's Patent Sand Blast Co.* (1883), L. R. 25 Ch. D. 1; *Halsey v. Brotherhood* (1879), L. R. 19 Ch. D. 386.

That a patentee will not be enjoined from circulating notices that his patent is infringed where the question of infringement had never been decided, and the patentee was guilty of no fraud, see

Chase v. Tuttle (1886), 27 Fed. Rep. 110.

That it is doubtful whether the Circuit Court has power to enjoin the publishing of circulars warning the public against certain infringements, see *Chase v. Tuttle* (1886), 27 Fed. Rep. 110.

That equity cannot restrain a plaintiff from publishing the fact that the defendant has been enjoined, see *Westinghouse Air Brake Co. v. Carpenter* (1887), 32 Fed. Rep. 545.

³ That in publishing the claims of patentees excessive language must not be used, beyond what is necessary to give the proper information, and any excess will be enjoined, see *Croft v. Richardson* (1880), 59 How. Pr. 356.

§ 889. ¹ That equity will enjoin against a libel on a patent right, see *Emack v. Kane* (1888), 34 Fed. Rep. 46; *Bell v. Singer Mfg. Co.* (1880), 65 Ga. 452. *Contra*, *Baltimore Car Wheel Co. v. Bemis* (1886), 29 Fed. Rep. 95; 38

the alleged offender is a rival inventor, but not a patentee, good faith requires him to make a speedy application for a patent in order that the question of priority between himself and the subsisting patentee may be determined; and his failure so to do deprives him of the excuse for his attack upon the patent which a diligent protection of his interests would otherwise afford.² The forum in which these remedies of the patentee are to be sought is that of the State having jurisdiction of the defendant, the Federal courts having no cognizance of such actions except in cases between citizens of different States.³

SECTION II.

OF INFRINGEMENT.

§ 890. Infringement Defined.

The issue of a patent confers upon the patentee the exclusive right to make, use, and vend the patented invention, throughout the United States and the Territories thereof, during the period for which the patent has been granted. The infringement of a patent, being the invasion of this exclusive right, therefore consists in the manufacture, use, or sale of the invention protected by the patent within the area and time described in the patent, by any person not duly author-

O. G. 1132; *Kidd v. Horry* (1886), 28 Fed. Rep. 773.

That equity has no jurisdiction of libel or slander affecting the title to a patent right, and cannot interfere unless a repetition is threatened and preventive measures become necessary, the remedy for past injuries being at law, see *Palmer v. Travers* (1884), 20 Fed. Rep. 501; 22 Blatch. 185.

That equity has no jurisdiction over a libel or slander or false representations that the plaintiffs are infringing a patent, unless there is a breach of trust or contract, the remedy, if any, being at law, see *Boston Diatite Co. v. Florence Mfg. Co.* (1873), 114 Mass. 69.

That no injunction will issue against one who falsely represents that the patentee's invention is an infringement of his, and thus deters purchasers, see *Whitehead v. Kitson* (1876), 119 Mass. 484.

² That one who claims that a patented invention is in fact his own discovery, must apply for a patent, if entitled to one, in order to justify his claims, see § 722 and notes, *ante*.

³ That the Federal courts have no jurisdiction over actions for libel or slander against patent rights where the parties are citizens of the same State, see *Prime v. Brandon Mfg. Co.* (1879), 16 Blatch. 453; 4 Bann. & A. 379.

ized to do so by the patentee.¹ As this is the principal wrong which an inventor is able to sustain, and as it forms the cause of action in by far the greater proportion of the suits to which the inventor is a party, it demands and will receive an extended consideration. In discussing it three topics require attention: (1) The invention whose manufacture, use, or sale constitutes the act of infringement; (2) The nature of the act of infringement, with the time when, the place where, the persons by whom, and the knowledge or intent with which it must be performed; (3) The application of the foregoing propositions to each of the six classes of inventions.

§ 891. No Infringement Exists unless the Invention Unlawfully Used is Identical with that Protected by the Patent.

The invention whose manufacture, use, or sale constitutes the infringement of a patent is the invention covered and protected by the patent.¹ The theory of the patentee as to the nature and scope of his invention is immaterial; its actual character as it exists practically in the arts is equally unimportant; the patent protects only the patentable subject-matter which it specifically claims, and is capable of infringement only by an invasion of the inventor's rights in that invention.² Hence, as no invention can be claimed in a patent unless it has been so described that any person skilled in the

§ 890. ¹ That infringement is a question of mixed law and fact, see *California Artificial Stone Paving Co. v. Molitor* (1885), 113 U. S. 609; 31 O. G. 1044.

§ 891. ¹ That an infringement is a copy made after and agreeing with the principle laid down in the patent, see *Page v. Ferry* (1857), 1 Fisher, 298.

That a device not covered by the patent does not infringe though it effects the same purpose as the patented invention, see *Toohy v. Harding* (1880), 1 Fed. Rep. 174; 4 Hughes, 253; 5 Bann. & A. 195.

That an article is not an infringement unless it is to be used as pointed out in the patent, see *Campbell v. Kav-*

anaugh (1882), 11 Fed. Rep. 83; 20 Blatch. 256.

That a person who licenses others to use certain improvements of his own does not infringe the original patent, see *Hussey v. Bradley* (1863), 2 Fisher, 362; 5 Blatch. 134.

² That the theory of the patentee as to his invention is of no consequence on the question of infringement, see *Foss v. Herbert* (1856), 2 Fisher, 31; 1 Bissell, 121.

That whether a device is an infringement is determined by the Claims of the patent, not by the actual invention, see *Meissner v. Devos Mfg. Co.* (1872), 2 O. G. 545; 9 Blatch. 363; 5 Fisher, 285.

art could practise it without a further exercise of the inventive faculties, an invention which is not disclosed in the patent, or is only partially disclosed, although alluded to and indispensable to the enjoyment of the inventions properly claimed, is not susceptible of an infringement.³ But every invention lawfully described and claimed is covered by the patent, and where a patent includes two or more inventions the wrongful manufacture, use, or sale of either one is an infringement of the patent.⁴

§ 892. Identity, how Determined.

The identity of the invention made, used, or sold by the alleged infringer with that described and claimed in the patent

That the use of one form of old devices is no infringement of a patent which claims only a new form of them, see *Barker v. Todd* (1882), 13 Fed. Rep. 473 ; 22 O. G. 1448.

That an invention which would not anticipate will not infringe, see *Cook v. Sandusky Tool Co.* (1884), 26 O. G. 1114. This can be true only where the scope of each invention is the same, not where the infringing device is merely included in the patented invention.

³ In *Page v. Ferry* (1857), 1 Fisher, 298, Wilkins, J. : (309) "An infringement will not have taken place unless the invention can be practised completely by following the specifications. An infringement is a copy made *after*, and agreeing with the principle laid down in, the patent ; and if the patent does not fully describe *everything* essential to the making of the thing patented, there will be no infringement by the fresh invention of processes which the patentee has withheld from the public."

That if the patented invention is not operative it cannot be infringed by one that is, see *Royer v. Coupe* (1886), 29 Fed. Rep. 358 ; 39 O. G. 239.

⁴ In *Lee v. Blandy* (1860), 2 Fisher,

89, Leavitt, J. : (92) "There can be no question but that there may be a claim for two inventions in the same patent, if they both relate to the same machine or structure ; and an action can be sustained for the infringement of either one or the other of these separate inventions where claimed as separate and distinct in their character. There can be no doubt if one of these be infringed it is properly a subject for an action." 1 Bond, 361 (365).

See also *Matthews v. Spangenberg* (1883), 23 O. G. 1624 ; 15 Fed. Rep. 813 ; *Singer v. Walmsley* (1860), 1 Fisher, 558 ; *Waterbury Brass Co. v. N. Y. & Brooklyn Brass Co.* (1858), 3 Fisher, 43 ; *Emerson v. Hogg* (1845), 2 Blatch. 1 ; *Moody v. Fiske* (1820), 2 Mason, 112 ; 1 Robb, 312.

That two patents cannot supplement each other, but each by itself is the sole subject of infringement, see *Blades v. Rand, McNally, & Co.* (1886), 27 Fed. Rep. 93 ; 37 O. G. 99.

That one valid Claim in a re-issue may be infringed though the other Claims are not valid, see *Cote v. Moffitt* (1883), 15 Fed. Rep. 345 ; and § 684, note 5, *ante*.

is determined by the same tests which are applied in ascertaining the novelty of an invention when comparing it with things already known.¹ Novelty and infringement are not precisely the same questions, since an invention, however new, may include some patented instrument or operation and thus be an infringement.² But into both these questions that of identity enters as an essential factor, and in each it is settled by a reference to the same standards and in accordance with the same rules. As these have been discussed at great length in connection with the subject of novelty, a general review of them in this place will be sufficient.

§ 893. Identity must be Identity in the Idea of Means.

In the first place, the identity sought and found must reside in the idea of means embodied in each invention.¹ Whether the purpose intended, the effect produced, or the functions performed are the same is of no consequence, except that functions and effects which are essentially distinct indicate

§ 892. ¹ That identity is determined by comparing the two inventions, see *Fuller v. Yentzer* (1876), 94 U. S. 288; 11 O. G. 551.

That inventions which are the same in fact are the same in law, see *Ex parte Merrill* (1874), 5 O. G. 120; 1 MacArthur, 301.

That expert evidence may aid in determining identity, see *Page v. Ferry* (1857), 1 Fisher, 298.

See also §§ 228-314 and notes, *ante*.

² That novelty and infringement are in some respects different questions so far as the relations of different inventions to each other are concerned, see *Union Sugar Refinery Co. v. Matthieson* (1865), 2 Fisher, 600; 3 Clifford, 639; *Judson v. Cope* (1860), 1 Fisher, 615; 1 Bond, 327.

§ 893. ¹ In *Burr v. Cowperthwait* (1858), 4 Blatch. 163, Ingersoll, J.: (167) "The end or result produced is not secured by the patent, but only the substantial means used and specified to produce the end or result, — these, and

nothing more. The same end or result may be produced by means other than those substantially described in the specification without infringing the patent."

In *American Pin Co. v. Oakville Co.* (1854), 3 Blatch. 190, Ingersoll, J.: (192) "The rules thus laid down must govern this case. The patent does not secure to the patentee the result or effect produced, but only the means described by which such result or effect is produced. The means which he specifies to produce the result or effect are secured, and nothing more. And all other means to produce the same result or effect, and not patented to any one, are open to the public."

See also *Dryfoos v. Wiese* (1888), 42 O. G. 490; *Dryfoos v. Wiese* (1884), 26 O. G. 639; 22 Blatch. 19; 19 Fed. Rep. 315; *Hall v. Stern* (1882), 15 Fed. Rep. 463; 24 O. G. 206; *Anilin v. Levinstein* (1883), L. R. 24 Ch. D. 156.

essential differences in the means.² In comparing these ideas of means it must be borne in mind that identity, with reference to infringement, does not require that each idea shall be the exact counterpart of the other. The idea covered by the patent must be completely embraced in the idea expressed in the infringement, but the latter may be far more comprehensive than the former.³ A familiar instance occurs where a patented invention is employed as an element in a later combination, — the combination being no less an infringement of the patent because it includes many other subordinate ideas of means. Identity exists, therefore, with reference to the question of infringement, if the idea of means protected by the patent is found, substantially existing, in the invention practised by the alleged infringer.⁴

§ 894. Identity in Ideas of Means, how Determined.

Identity in the ideas of means subsists where the compared inventions perform the same functions by the same modes of

² That where the same advantages are gained by substantially the same means there is an infringement, see *Wallicks v. Cantrell* (1882), 15 Phila. 446; 21 O. G. 1878; 12 Fed. Rep. 790; *California Artificial Stone Paving Co. v. Perine* (1881), 8 Fed. Rep. 821; 20 O. G. 813; 7 Sawyer, 190.

That if the principle of an invention is pirated there is an infringement, see *Page v. Ferry* (1857), 1 Fisher, 298.

That identity of ideas, though different in appearance, is infringement, see *Smith v. Higgins* (1859), 1 Fisher, 537.

³ That a device employing an essential feature of the patented invention is an infringement, see *Forehand v. Porter* (1883), 15 Fed. Rep. 256.

That wherever the defendants' devices require the use of those patented there is an infringement, see *Sayles v. Chicago & Northwestern R. R. Co.* (1871), 4 Fisher, 584; 3 Bissell, 52.

That the test of infringement is whether the defendant uses anything

which the plaintiff invented, see *Crompton v. Knowles* (1881), 7 Fed. Rep. 199; *Crompton v. Knowles* (1881), 7 Fed. Rep. 204.

That a device may be an infringement though it constitutes a new invention, see *Zeun v. Kaldenberg* (1883), 16 Fed. Rep. 539; 23 O. G. 2514.

⁴ That the infringing art or article must embrace the substance of the patented invention, see *Sessions v. Romadka* (1884), 28 O. G. 721; 21 Fed. Rep. 124; *Morgan Elevated R. R. Co. v. Pullman* (1882), 14 Fed. Rep. 648; *Henderson v. Cleveland Co-operative Stove Co.* (1877), 12 O. G. 4; 2 Bann. & A. 604; *Sewall v. Jones* (1875), 91 U. S. 171; 9 O. G. 47; *Converse v. Cannon* (1873), 9 O. G. 105; 2 Woods, 7; *McComb v. Brodie* (1872), 2 O. G. 117; 5 Fisher, 384; 1 Woods, 153; *Carter v. Baker* (1871), 4 Fisher, 404; 1 Sawyer, 512; *Smith v. Higgins* (1859), 1 Fisher, 537; *Smith v. Downing* (1850), 1 Fisher, 64.

operation. If the effects produced are substantially different, there is no identity.¹ If the effects are the same and the functions are essentially distinct, there is no identity.² If the functions are the same and the modes of operation by which they are performed are radically unlike, there is no identity.³ Contrariwise, where the effects are identical, the functions identical, and the modes of operation identical, the ideas embodied in the two inventions must also be identical.⁴ Identity being thus established, all variations in shape, size, capacity, arrangement, and materials become unimportant.⁵ The sub-

§ 894. ¹ That difference in the nature of the result shows that there is no infringement, see *May v. County of Fond du Lac* (1886), 27 Fed. Rep. 691.

That identity of result is *prima facie* evidence of identity of process where both are new, see *Pickhardt v. Packard* (1884), 30 O. G. 179; 22 Fed. Rep. 530; 23 Blatch. 23.

See also § 117 and notes, *ante*.

² That infringement does not exist unless there is identity of function as well as of parts, see *Racine Seeder Co. v. Joliet Wire Check Rower Co.* (1886), 27 Fed. Rep. 367; 37 O. G. 452; *Pelham v. Demarest* (1882), 12 Fed. Rep. 494; 22 O. G. 772.

That an article incapable of performing the functions of a patented device cannot be an infringement, see *Railway Register Mfg. Co. v. Broadway & Seventh Ave. R. R. Co.* (1887), 30 Fed. Rep. 238; 40 O. G. 1243.

See also § 235 and notes, *ante*.

³ That identity in mode of operation is necessary to infringement, see *Evory v. Burt* (1883), 15 Fed. Rep. 112; 23 O. G. 2121; *Lull v. Clark* (1882), 13 Fed. Rep. 456; 22 O. G. 1535; 21 Blatch. 95.

See also §§ 235, 236, and notes, *ante*.

⁴ That to obtain the same result by the same mode of operation is infringement, see *Shaver v. Skinner Mfg. Co.* (1887), 30 Fed. Rep. 68; 41 O. G. 232;

Collignon v. Hayes (1881), 8 Fed. Rep. 912; 20 O. G. 447; *Singer Mfg. Co. v. Stewart Mfg. Co.* (1881), 8 Fed. Rep. 920; 20 O. G. 524.

⁵ That an infringement is committed whenever the defendant avails himself of the patented invention without such variations as constitute a different invention, see *May v. County of Fond du Lac* (1886), 27 Fed. Rep. 691; *Carter v. Baker* (1871), 4 Fisher, 404; 1 Sawyer, 512.

That a mere formal change is infringement, see *Strobridge v. Landers, Frary, & Clark* (1881), 11 Fed. Rep. 880; 20 Blatch. 73; 21 O. G. 1027; *McKesson v. Carnrick* (1881), 9 Fed. Rep. 44; 19 Blatch. 158; 21 O. G. 137.

That variations in size, form, and degree, do not prevent infringement, see *Asmus v. Alden* (1886), 27 Fed. Rep. 684; 36 O. G. 231; *Lull v. Clark* (1882), 13 Fed. Rep. 456; 22 O. G. 1535; 21 Blatch. 95; *Judson v. Cope* (1860), 1 Fisher, 615; 1 Bond, 327.

That an invention limited to certain forms is infringed only by the use of those forms, see *Wright v. Yuengling* (1888), 42 O. G. 829; *Dosh v. A. J. Medlar Co.* (1887), 40 O. G. 1242; *Toepfer v. Goetz* (1887), 41 O. G. 933; 31 Fed. Rep. 913.

That a patent limiting the invention to certain materials is infringed only by

stitution of equivalents, whether greater or less in number than the discarded elements, and though performing additional functions;⁶ the capability of fewer or more numerous uses by reason of its new connections;⁷ the increase or dimi-

the use of such materials, see *Western & Wells Mfg. Co. v. Rosenstock* (1887), 30 Fed. Rep. 67; 41 O. G. 354.

That a change of arrangement may be infringement, see *Belle Patent Button Fastener Co. v. Lucas* (1887), 37 O. G. 1004; 28 Fed. Rep. 371.

That where the same result is accomplished, the same function performed, and the mode of operation is the same, a mere difference in the location of parts will not avoid infringement, see *Kirk v. Du Bois* (1887), 42 O. G. 297.

That a mere formal modification affecting only the quantity of the result does not avoid infringement, see *Coupe v. Weatherhead* (1883), 23 O. G. 1927; 16 Fed. Rep. 673.

That the function and mode of operation of the plaintiff's and defendant's devices being identical, the latter is an infringement, though the means of communicating power may differ, see *Piper v. Shedd* (1885), 26 Fed. Rep. 151; 35 O. G. 256.

See also as to formal diversities §§ 237-244, and notes, *ante*.

⁶ That a device though employing equivalents may be an infringement, see *Barnes v. Ruthenberg* (1887), 40 O. G. 693; 32 Fed. Rep. 159; *Kimball v. Hess* (1883), 26 O. G. 107; 15 Fed. Rep. 393; *Carter v. Baker* (1871), 4 Fisher, 404; 1 Sawyer, 512.

That the substitution of one known device for another, though complex, is infringement, see *Foster v. Moore* (1852), 1 Curtis, 279.

That the use of part of a mechanical device, invented to produce a particular general effect, in connection with a substituted device to produce another part

of the same effect, is a use of the patented invention, see *Johnson v. Willimantic Linen Co.* (1866), 33 Conn. 436.

That to make new devices which are equivalents of the patented device, but go beyond it and include more, is infringement, see *Loercher v. Crandall* (1881), 11 Fed. Rep. 872; 20 Blatch. 106; 21 O. G. 863.

That the use of an equivalent is not an infringement where the specification says it is not within the patent, see *Byam v. Farr* (1852), 1 Curtis, 260.

That there is no infringement when an essential element is omitted and another substituted accomplishing the same result in a different manner, see *Schmidt v. Freese* (1882), 12 Fed. Rep. 563; 21 O. G. 1876.

See also as to equivalents, §§ 245-258, and notes, *ante*.

⁷ That a difference in the purpose for which the invention is used will not prevent an infringement, see *Thompson v. Gildersleeve* (1888), 43 O. G. 886; *Stegner v. Blake* (1888), 45 O. G. 126.

That a device may be an infringement though it can be used in a way in which the patented device cannot, see *Yale Lock Mfg. Co. v. Norwich National Bank* (1881), 6 Fed. Rep. 377; 19 Blatch. 123.

That a device so incorporated into the infringer's machine as to do more effective and better work, or even different work, is still an infringement, see *Hartford Woven Wire Mattress Co. v. Peerless Wire Mattress Co.* (1885), 23 Blatch. 227; 23 Fed. Rep. 587; *Buerk v. Valentine* (1872), 2 O. G. 295; 5 Fisher, 366; 9 Blatch. 479.

That a device may be an infringe-

nation of simplicity and expensiveness;⁸ the separation of the invention into several parts or the consolidation of many parts in one;⁹ the addition of new features, whether with or without improvement in the operation of the means;¹⁰ all these are changes consistent with the preservation of the identity of the patented invention, and with its wrongful appropriation by the alleged infringer.

ment though it is less useful than the patented invention, see *Sewall v. Jones* (1875), 91 U. S. 171; 9 O. G. 47; *Union Paper Bag Mach. Co. v. Binney* (1871), 5 Fisher, 166.

That a device may be an infringement though it only accomplishes in part the result attained by using the patented invention, see *Coupe v. Weatherhead* (1883), 16 Fed. Rep. 673; 23 O. G. 1927; *Sewall v. Jones* (1875), 91 U. S. 171; 9 O. G. 47.

See also as to diversity of use §§ 259-271, and notes, *ante*.

⁸ That a device affecting the same thing in the same way is an infringement though it be simpler and cheaper, see *Evory v. Burt* (1883), 15 Fed. Rep. 112; 23 O. G. 2121.

That a device though more expensively fitted up may be an infringement, see *Brown v. Guild* (1874), 23 Wall. 181; 6 O. G. 392.

That difference in degree may be infringement, see *May v. County of Fond du Lac* (1886), 27 Fed. Rep. 691.

⁹ That to divide or consolidate parts does not prevent infringement, see *Thompson v. Gildersleeve* (1888), 43 O. G. 886; *Wheeler v. Clipper Mower & Reaper Co.* (1872), 2 O. G. 442; 10 Blatch. 181; 6 Fisher, 1; *Baldwin v. Bernard* (1872), 2 O. G. 320; 9 Blatch. 509, note; 5 Fisher, 442.

That if material parts of the patented invention are omitted there is no infringement, see *Snow v. Lake Shore & Mich. Southern R. R. Co.* (1883), 25 O. G. 1280; 18 Fed. Rep. 602.

¹⁰ That an improvement may be an

infringement, see *Shaver v. Skinner Mfg. Co.* (1887), 41 O. G. 232; 30 Fed. Rep. 68; *Filley v. Littlefield Stove Co.* (1887), 39 O. G. 1203; 30 Fed. Rep. 434; *Wilson v. Cubley* (1886), 35 O. G. 257; 26 Fed. Rep. 156; *Hoff v. Iron Clad Mfg. Co.* (1886), 35 O. G. 1230; 27 Fed. Rep. 307; 23 Blatch. 481; *Reed v. Street* (1885), 34 O. G. 339; *Tate v. Thomas* (1885), 35 O. G. 258; 27 Fed. Rep. 306; *Filley v. Littlefield* (1885), 25 Fed. Rep. 282; *Bostock v. Goodrich* (1884), 21 Fed. Rep. 316; 29 O. G. 278; *Frost v. Marcus* (1882), 13 Fed. Rep. 88; *Union Stone Co. v. Allen* (1882), 14 Fed. Rep. 353; *Cross v. Mackinnon* (1882), 22 O. G. 586; 11 Fed. Rep. 601; 20 Blatch. 395; *Foye v. Nichols* (1882), 13 Fed. Rep. 125; 22 O. G. 2243; 8 Sawyer, 201; *Brainard v. Cramme* (1882), 12 Fed. Rep. 621; 22 O. G. 769; 20 Blatch. 530; *White v. Heath* (1882), 10 Fed. Rep. 291; 22 O. G. 500; *Star Salt Caster Co. v. Alden* (1882), 10 Fed. Rep. 555; *Maxheimer v. Meyer* (1881), 20 Blatch. 17; 9 Fed. Rep. 460; 20 O. G. 1162; *Pennington v. King* (1881), 7 Fed. Rep. 462; 19 O. G. 1568; *Turrell v. Spaeth* (1878), 14 O. G. 377; 3 Bann. & A. 458; *De Florez v. Reynolds* (1878), 14 Blatch. 505; 3 Bann. & A. 292; *Holbrook v. Small* (1876), 10 O. G. 508; *Jackson v. Allen* (1876), 120 Mass. 64; *Robertson v. Blake* (1876), 94 U. S. 728; 11 O. G. 877; *Carstaedt v. U. S. Corset Co.* (1876), 10 O. G. 3; 13 Blatch. 371; 2 Bann. & A. 331; *Richardson v. Noyes* (1876), 10 O. G. 507; 2

§ 895. Identity may Result from Use as well as from Original Construction.

The identity of the alleged infringement with the patented invention is not to be determined by its condition merely at

Bann. & A. 398 ; *Westinghouse v. Gardner & Ranson Air Brake Co.* (1875), 9 O. G. 538 ; 2 Bann. & A. 55 ; *La Baw v. Hawkins* (1874), 6 O. G. 724 ; 1 Bann. & A. 428 ; *Baldwin v. Bernard* (1872), 2 O. G. 320 ; 5 Fisher, 442 ; 9 Blatch. 509, note ; *Woodward v. Morrison* (1872), 2 O. G. 120 ; 5 Fisher, 357 ; Holmes, 124 ; *Goodyear Dental Vulcanite Co. v. Evans* (1868), 3 Fisher, 390 ; 6 Blatch. 121 ; *Roberts v. Harnden* (1865), 2 Clifford, 500 ; *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379 ; *Howe v. Morton* (1860), 1 Fisher, 586 ; *Carr v. Rice* (1856), 1 Fisher, 198 ; *Pitts v. Wemple* (1855), 6 McLean, 558 ; *Woodworth v. Rogers* (1847), 3 W. & M. 135 ; 2 Robb, 625 ; *Gray v. James* (1817), Peters C. C. 476 ; 1 Robb, 140.

That an improvement and its original are separate inventions, and the inventor of one infringes by the use of the other, see *Royer v. Coupe* (1886), 39 O. G. 239 ; 29 Fed. Rep. 358 ; *American Bell Telephone Co. v. Dolbear* (1883), 23 O. G. 535 ; 15 Fed. Rep. 448 ; *Robertson v. Blake* (1876), 94 U. S. 728 ; 11 O. G. 877 ; *Fales v. Wentworth* (1872), 2 O. G. 58 ; Holmes, 96 ; 5 Fisher, 302 ; *Whipple v. Baldwin Mfg. Co.* (1858), 4 Fisher, 29 ; *Pitts v. Wemple* (1855), 6 McLean, 558.

That where the patentee of the original invention and the patentee of the improvement make a contract allowing each to use both patents in a different way, if either uses them contrary to the agreement he infringes, see *Star Salt Caster Co. v. Crossman* (1878), 4 Clifford, 568 ; 3 Bann. & A. 281.

That a device may be an infringement though additional elements are

employed increasing its utility, see *Waterbury Brass Co. v. N. Y. & Brooklyn Brass Co.* (1858), 3 Fisher, 43.

That an improver may infringe though his improvement gives to the invention all its value, see *Gray v. James* (1817), Peters C. C. 476 ; 1 Robb, 140.

That an improvement has supplanted the patented device in the trade does not prevent it from being an infringement, see *Turrell v. Spaeth* (1878), 14 O. G. 377 ; 3 Bann. & A. 458.

That evidence that the defendant's device is better than the plaintiff's is only admissible to show substantial difference, see *Alden v. Dewey* (1840), 1 Story, 336 ; 2 Robb, 17.

That if an alleged original invention is not operative, the improver does not infringe by embodying it in his own, see *Royer v. Coupe* (1886), 39 O. G. 239 ; 29 Fed. Rep. 358.

That a device may be an infringement though it works better than the patented invention, see *Howes v. McNeal* (1878), 15 O. G. 608 ; 15 Blatch. 103 ; 3 Bann. & A. 376 ; *Odiorne v. Denney* (1878), 13 O. G. 965 ; 3 Bann. & A. 287 ; *Miller's Falls Co. v. Ives* (1877), 14 O. G. 203 ; 14 Blatch. 169 ; 2 Bann. & A. 574 ; *McComb v. Brodie* (1872), 2 O. G. 117 ; 5 Fisher, 384 ; 1 Woods, 153 ; *Carter v. Baker* (1871), 4 Fisher, 404 ; 1 Sawyer, 512 ; *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379 ; *Cox v. Griggs* (1861), 2 Fisher, 174 ; 1 Bissell, 362 ; *Whipple v. Middlesex Co.* (1859), 4 Fisher, 41 ; *Foss v. Herbert* (1856), 2 Fisher, 31 ; 1 Bissell, 121.

That an invention may be an infringement though it does more than

the time of its original construction. The cunning of infringers is not allowed to circumvent the provisions of the law for the protection of inventors. An instrument which in itself may not resemble the patented invention, even in its idea of means, may when employed in practice develop new features that perform the functions of the patented invention by the same mode of operation. If such a result is intended by the maker, user, or seller of the instrument, or follows necessarily from its employment, the instrument thereby becomes identical with the patented invention, and such identity, by virtue of the intention now accomplished, is imputed to the instrument in its original condition.¹ But the develop-

the patented invention, see *Shaver v. Skinner Mfg. Co.* (1887), 30 Fed. Rep. 68 ; 41 O. G. 232 ; *Wilson v. Cubley* (1886), 26 Fed. Rep. 156 ; 35 O. G. 257 ; *Zeun v. Kaldenberg* (1883), 16 Fed. Rep. 539 ; 23 O. G. 2514 ; *Wilt v. Grier* (1881), 19 O. G. 427 ; 5 Fed. Rep. 450 ; *California Artificial Stone Paving Co. v. Perine* (1881), 20 O. G. 813 ; 8 Fed. Rep. 821 ; 7 Sawyer, 190 ; *Strobridge v. Lindsay* (1880), 18 O. G. 62 ; 2 Fed. Rep. 692 ; 5 Bann. & A. 411 ; *Williams v. Boston & Albany R. R. Co.* (1879), 16 O. G. 906 ; 17 Blatch. 21 ; 4 Bann. & A. 441 ; *Hart, Bliven, & Mead Mfg. Co. v. Sargent* (1878), 14 O. G. 45 ; 3 Bann. & A. 263 ; *Converse v. Cannon* (1875), 9 O. G. 105 ; 2 Woods, 7 ; *New York Rubber Co. v. Chaskel* (1875), 9 O. G. 923 ; *Foss v. Herbert* (1856), 2 Fisher, 31 ; 1 Bissell, 121.

That one invention may include others and yet infringe the patent which protects them, see *Cochrane v. Deener* (1876), 94 U. S. 780 ; 11 O. G. 687.

That a device may be an infringement though used in connection with other devices not included in the patent, see *Wirt v. Brown* (1887), 30 Fed. Rep. 188 ; 41 O. G. 236 ; *Tate v. Thomas* (1885), 30 O. G. 345 ; 22 Fed. Rep. 660 ; *Roemer v. Simon* (1884), 20 Fed. Rep. 197 ; 28 O. G. 194 ; *Andrews*

v. Eames (1883), 15 Fed. Rep. 109 ; 23 O. G. 1123 ; *Union Stone Co. v. Allen* (1882), 14 Fed. Rep. 353 ; *Turrell v. Spaeth* (1878), 14 O. G. 377 ; 3 Bann. & A. 458 ; *Herring v. Nelson* (1877), 12 O. G. 753 ; 14 Blatch. 293 ; 3 Bann. & A. 55 ; *Jackson v. Allen* (1876), 120 Mass. 64 ; *Cochrane v. Deener* (1876), 94 U. S. 780 ; 11 O. G. 687 ; *McComb v. Brodie* (1872), 2 O. G. 117 ; 5 Fisher, 384 ; 1 Woods, 153 ; *Chicago Fruit House Co. v. Busch* (1871), 2 Bissell, 472 ; 4 Fisher, 395 ; *Imlay v. Norwich & Worcester R. R. Co.* (1858), 1 Fisher, 340 ; 4 Blatch. 227 ; *Johnson v. Root* (1858), 1 Fisher, 351 ; *Carr v. Rice* (1856), 1 Fisher, 198 ; *Pitts v. Wemple* (1855), 6 McLean, 558.

That a device may be an infringement though connected with useless additional parts, see *Poppenhusen v. Falke* (1862), 2 Fisher, 213 ; 5 Blatch. 46 ; *Poppenhusen v. Falke* (1861), 2 Fisher, 181 ; 4 Blatch. 493 ; *Waterbury Brass Co. v. N. Y. & Brooklyn Brass Co.* (1858), 3 Fisher, 43.

§ 895. ¹ That where a device is intentionally so constructed as in use to become the patented invention, it is identical therewith and an infringement, see *Page v. Ferry* (1857), 1 Fisher, 298.

See also § 903 and note 7, *post*.

ment of such new features without the intention of the alleged infringer, as by accident or wear and tear, does not produce an identity which can be regarded on the question of infringement.²

§ 896. **Identity not Controverted by the Issue of a Later Patent for the Infringing Invention.**

The fact that the invention made, used, or sold by the alleged infringer is itself the subject of a later patent does not conclusively establish the absence of identity.¹ Every patent is *prima facie* evidence of the novelty of the invention which it claims, and every patented invention is thus presumed to be essentially different from every other until the contrary appears.²

² That an article which is not an infringement when constructed cannot become such by accident, or wear and tear, or usage, unless so intended, see *Page v. Ferry* (1857), 1 Fisher, 298.

That a device which may be forced to operate like the plaintiff's device is not an infringement if such use was not an object of its construction, see *Buzzell v. Andrews* (1885), 25 Fed. Rep. 822; 34 O. G. 830.

See also § 903 and note 7, *post*.

§ 896. ¹ That a patented invention may infringe a prior patent, see *Holliday v. Pickhardt* (1882), 12 Fed. Rep. 147; 22 O. G. 420; *Brainard v. Cramme* (1882), 12 Fed. Rep. 621; 20 Blatch. 530; 22 O. G. 769; *Star Salt Caster Co. v. Alden* (1882), 10 Fed. Rep. 555; *Pennington v. King* (1881), 7 Fed. Rep. 462; 19 O. G. 1568; *Maxheimer v. Meyer* (1881), 20 Blatch. 17; 20 O. G. 1162; 9 Fed. Rep. 460; *Holly v. Vergennes Mach. Co.* (1880), 4 Fed. Rep. 74; 18 O. G. 1177; 18 Blatch. 327; *Nathan v. N. Y. Elevated R. R. Co.* (1880), 2 Fed. Rep. 225; 5 Bann. & A. 280; *Robertson v. Blake* (1876), 94 U. S. 728; 11 O. G. 877; *Cochrane v. Deener* (1876), 94 U. S. 780; 11 O. G. 687; *Converse v. Cannon* (1875), 9

O. G. 105; 2 Woods, 7; *Goodyear Dental Vulcanite Co. v. Gardiner* (1871), 3 Clifford, 408; 4 Fisher, 224; *Goodyear Dental Vulcanite Co. v. Evans* (1868), 3 Fisher, 390; 6 Blatch. 121; *Smith v. Pearce* (1840), 2 McLean, 176; 2 Robb, 13.

That where a later patent includes the subject-matter of a prior patent neither patentee can use the other's invention without his consent, see *Cantrell v. Wallick* (1886), 117 U. S. 689; 35 O. G. 871.

That where a later patent includes an earlier, a stranger cannot defend against the second patent by setting up the first, see *Cantrell v. Wallick* (1886), 117 U. S. 689; 35 O. G. 871.

² That it is presumed that use under one patent does not infringe another, see *Smith v. Woodruff* (1874), 4 O. G. 635; 6 Fisher, 476; 1 MacArthur, 459.

That the grant of a second patent is *prima facie* evidence that the inventions are different, and that the later patented invention is not an infringement of the former, see *La Baw v. Hawkins* (1874), 6 O. G. 724; 1 Bann. & A. 428; *American Pin Co. v. Oakville Co.* (1854), 3 Blatch. 190.

Where two patents apparently describe and claim the same art or article the question of identity is open for examination, with the presumption in favor of their diversity; but when this presumption has been overcome, through the application of the tests by which identity must in all cases be finally determined, the later patent affords no protection to its patentee in the practice of the invention, and does not in any degree relieve him from liability for infringement to the owner of the only valid patent.

§ 897. Nature of the Act of Infringement.

The nature of the act of infringement is indicated by that of the exclusive right which it invades. Hence an infringement may be committed either by making, using, or selling the patented invention.¹ These words, however, are interpreted as comprehending every method by which the invention can be made available for the benefit of the infringer, and any person who participates in any wrongful appropriation of the invention becomes thereby a violator of the rights protected by the patent.² Such participation may be direct or indirect; it is sufficient if it promotes in any degree the

§ 897. ¹ In *Haselden v. Ogden* (1868), 3 Fisher, 378, Sherman, J. : (380) "An infringement is a copy made after and agreeing substantially and in principle with the article described in the letters-patent. The act of Congress confers upon the patentee and his assigns the exclusive right to make, to use, or to sell to others to be used, the article patented. It is, therefore, an infringement to make or manufacture a patented article though it is never used by the maker. It is likewise an infringement to use a patented article though made by another. It is also an infringement to sell to others the article when it is manufactured by another. The law vests the exclusive right to do all these three things in the patentee, and hence for another to do one or all of them is an infringement."

See also *Tuttle v. Matthews* (1886), 28 Fed. Rep. 98; 36 O. G. 694; *Slesinger v. Buckingham* (1883), 17 Fed. Rep. 454; 8 Sawyer, 469; *Allis v. Stowell* (1881), 19 O. G. 727; *Carter v. Baker* (1871), 4 Fisher, 404; 1 Sawyer, 512; *Waterbury Brass Co. v. N. Y. & Brooklyn Brass Co.* (1858), 3 Fisher, 43; *Boyd v. Brown* (1843), 3 McLean, 295; 2 Robb, 203.

² That any party making profits by an infringement is a wrongdoer, and is liable to the patentee, see *Vaughn v. East Tennessee, Virginia, & Georgia R. R. Co.* (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537.

That to share in the fruits of an infringement is such complicity as renders the parties jointly liable, see *Wells v. Jaques* (1874), 5 O. G. 364; 1 Bann. & A. 60.

unauthorized manufacture, use, or sale of the invention.³ Thus when a patented invention is inseparably annexed to other property without permission of the patentee, any one who owns or uses or buys or sells or leases such property, either as principal or agent, is guilty of infringement.⁴ But if the interest of the alleged participant is not dependent on the invention, though casually enhanced by its wrongful use, the enjoyment of such interest is not infringement. Thus where a landlord in consideration of the occupation of his premises by manufacturers, who employ infringing devices in their business, receives part of the profits of their business in addition to the sums paid to him as rent, he is not *ipso facto* an infringer, although he would infringe were this arrangement a mere cover for his participation in the operations of his tenants.⁵ For while the law does not impose unwarrantable burdens on the public by holding every one who derives a benefit from the prohibited manufacture, use, or sale of an invention responsible as an infringer of the patent, it does not permit any one, under any color or pretence, to employ the patented invention as a means of advancing his own interest, except in due subordination to the wishes of the patentee.

§ 898. No Act an Infringement unless it Affects the Pecuniary Interests of the Owner of the Patented Invention.

Moreover, the interest to be promoted by the wrongful employment of the invention must be hostile to the interest of

³ That no one can infringe unless he has some interest in the making, selling, or using the invention, see *United Nickel Co. v. Worthington* (1882), 13 Fed. Rep. 392; 23 O. G. 939.

⁴ That persons owning, renting, or occupying premises on which an infringing well is used, or buying or letting such premises without occupying them, are infringers, and liable to injunction and account, see *Green v. Gardner* (1882), 22 O. G. 683.

⁵ That one who leases to persons who infringe by making tools for their

own use, and who pay him rent and part profits of their business, is not an infringer, see *Starrett v. Athol Machine Co.* (1883), 14 Fed. Rep. 910; 23 O. G. 1729.

That where several parties infringe, some by making, others by selling, the infringing articles, the infringement is joint and several, and judgment may be rendered against each, though only one satisfaction can be had, see *Jennings v. Dolan* (1887), 29 Fed. Rep. 861; 38 O. G. 1018.

the patentee. The interest of the patentee is represented by the emoluments which he does or might receive from the practice of the invention by himself or others. These, though not always taking the shape of money, are of a pecuniary character, and their value is capable of estimation like other property. Hence acts of infringement must attack the right of the patentee to these emoluments, and either turn them aside into other channels or prevent them from accruing in favor of any one. An unauthorized sale of the invention is always such an act. But the manufacture or the use of the invention may be intended only for other purposes, and produce no pecuniary result. Thus where it is made or used as an experiment, whether for the gratification of scientific tastes, or for curiosity, or for amusement, the interests of the patentee are not antagonized, the sole effect being of an intellectual character in the promotion of the employer's knowledge or the relaxation afforded to his mind.¹ But if the products of the experiment are sold, or used for the convenience of the experimenter, or if the experiments are conducted with a view to the adaptation of the invention to the experimenter's business, the acts of making or of use are violations of the rights of the inventor and infringements of his patent.² In reference to

§ 898. ¹ That to experiment with a patented article to gratify scientific tastes, or for curiosity or amusement, is not infringement, see *Poppenhusen v. Falke* (1861), 2 Fisher, 181; 4 Blatch. 493; *Sawin v. Guild* (1813), 1 Gallison, 485; 1 Robb, 47.

That to make and exhibit at a fair, but not for use or sale, is not an infringement, see *Standard Measuring Machine Co. v. Teague* (1883), 15 Fed. Rep. 390.

That to make a patented article in order to experiment with it as a basis for proposed improvements by the maker is not an infringement, see *Frearson v. Loe* (1878), L. R. 9 Ch. D. 48.

That to use for the experimental instruction of pupils may be an infringe-

ment, see *United Telephone Co. v. Sharples* (1885), L. R. 29 Ch. D. 164.

² In *Poppenhusen v. New York Gutta Percha Comb Co.* (1858), 2 Fisher, 62, Ingersoll, J.: (72) "The next question, gentlemen, is, Has there been a violation or infringement? It is said, gentlemen, that there has not been, for the reason that whatever use was made of it was an experimental use, — a use merely for experiment, and not with a view to profit; and when there has been no profit and no sale, it will not make a party liable, because the patentee would not be injured by it. But where, gentlemen, it is done as a matter of business, where the product of that experiment has been thrown into the market to compete with the products of the plaintiff, although he

such employments of a patented invention the law is diligent to protect the patentee, and even experimental uses will be sometimes enjoined though no injury may have resulted admitting of positive redress.⁸

§ 899. Infringement not Committed by Possessing, Exposing for Sale, Advertising, &c.

A further distinction is to be made between acts which, in themselves or constructively, are acts of making, use, or sale, and acts which though collateral to these are after all only evidence that these acts have been performed. Among the latter are the mere possession of the patented invention when such possession does not constitute its use, its exposure for sale, its exhibition to others as meritorious and effective, advertising it, and the like; none of which, taken alone, disturb the enjoyment of his property by the patentee, however strong a presumption they may raise of its invasion by acts of real infringement.¹

§ 900. Infringement not Committed by Use of Part of the Patented Invention.

The acts of manufacture, use, and sale must, of course, relate to the precise invention claimed in the patent. To

may call it an experiment, yet, if it is a matter of business, and thrown into the market for the purpose of being sold, and is sold with his other products, why, that will be such a use as will make the party liable."

See also *Poppenhusen v. Falke* (1861), 2 Fisher, 181; 4 Blatch. 493; *Frearson v. Loe* (1878), L. R. 9 Ch. D. 48.

⁸ That experimental making and use is an infringement and may be restrained by injunction, though no account will be ordered, see *Albright v. Celluloid Harness Trimming Co.* (1877), 12 O. G. 227; 2 Bann. & A. 629.

That to make for use in order to see whether the use will be profitable, and using for that purpose, is an act demanding compensation to the patentee,

see *Palmer v. United States* (1885), 20 Ct. of Claims, 432.

§ 899. ¹ That the possession of infringing articles by a defendant who bought them for use, but has not yet used them, is an infringement, see *United Telephone Co. v. London & Globe Telephone Co.* (1884), L. R. 26 Ch. D. 766; *Adair v. Young* (1879), L. R. 11 Ch. D. 136; 12 Ch. D. 13.

That exposure for sale is not infringement, see *Minter v. Williams* (1835), 4 A. & E. 251; 1 Web. 135.

That advertising the invention is not infringement, see *Allis v. Stowell* (1881), 19 O. G. 727.

That advertising the device is strong evidence of infringement, see *Allis v. Stowell* (1881), 19 O. G. 727.

make or use or sell a part of the invention, especially a part covered by a different patent or disclaimed in the patent which protects the entire invention, is not an infringement of the latter patent.¹ An apparent exception to this rule exists in reference to machine patents, which are infringed by acts that involve so much of the invention as embraces the complete expression of its structural law; but this exception is apparent only, for such acts in reality appropriate the whole idea of means, although excluding unessential matters of construction.² As more explicitly stated in preceding paragraphs, the invention made or used or sold must be the exact patented invention, — identical in effect, identical in function, identical in mode of operation.

§ 901. Intention of Actual Infringer Immaterial: When Intention may Evidence Infringement.

As a general proposition, the intention with which an act of infringement is performed is immaterial.¹ The rights of the patentee are equally invaded whether or not the infringer purposes to violate them, and even though he may be ignorant of their existence;² and the duty of the law to redress his in-

§ 900. ¹ That to employ a distinct part of a patented invention is not an infringement, unless such part is also patented, see §§ 923, 924, and notes, *post*.

That the use of the essential parts of an invention, or their equivalents, is an infringement, see *Sessions v. Romadka* (1884), 28 O. G. 721; 21 Fed. Rep. 124.

That it is no infringement of a patent to make and sell that part of the patented invention which is not covered by the Claims of the patent, see *Simon v. Neumann* (1884), 20 Fed. Rep. 196; 27 O. G. 918.

That there is no infringement where the device was intended to be a reproduction of a device made two years before the patented invention, see *Delamater v. Woodruff* (1882), 11 Fed. Rep. 414.

That to make and improve upon a disclaimed part of the invention is not an infringement, see *Hatch v. Moffitt* (1883), 15 Fed. Rep. 252.

² That a machine-patent is infringed whenever the structural law of the machine is employed, though the parts vary in number or appearance, see § 926 and notes, *post*.

§ 901. ¹ That the motive with which an infringement is committed is immaterial, see *Parker v. Hulme* (1849), 1 Fisher, 44.

² That there may be an infringement though the infringer does not work by the patent or even know of the patent, see *Royer v. Coupe* (1886), 39 O. G. 239; 29 Fed. Rep. 358; *Matthews v. Skates* (1860), 1 Fisher, 602; *Parker v. Hulme* (1849), 1 Fisher, 44.

That all persons are bound to take notice of a patent duly issued, see

juries is not affected by the mental condition of the person by whom they are inflicted.³ But there are many actions, equivocal in character so far as the external operation is concerned, which are or are not acts of infringement according to the object contemplated by their actor, — actions otherwise innocent thus being regarded as violations of the rights secured by the patent, when intended as parts of a transaction which taken as a whole would be an infringement.⁴ Like the specific intent in certain criminal cases, the intention of the infringer thus becomes an element in the act of infringement, the mental and physical operations concurring to complete the wrong by which the exclusive privileges of the patentee are violated.⁵

§ 902. Infringement through Ignorance of the Patent, how Prevented.

To guard as far as possible, however, against an ignorant infringement, the law imposes on the patentee the obligation of notifying the public of his claims at the same time that he informs them of the existence and the mode of practising his invention. In the case of an art this is sufficiently accomplished by the patent itself, since without recourse to the specification, or to some one who had learned the art therefrom or

National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co. (1884), 28 O. G. 1007 ; 19 Fed. Rep. 514.

³ In *Hogg v. Emerson* (1850), 11 How. 587, Woodbury, J. : (607) "The intent not to injure, also, never exonerates, as is contended in these cases, from all damages for the actual injury or encroachment, though it may mitigate them."

That the fact that an infringement serves the public does not excuse it, see *American Bell Telephone Co. v. Cushman Telephone & Service Co.* (1888), 45 O. G. 1193.

⁴ That an act of making with intent to sell or use, an act of making a part with intent that others shall make the remainder and unite them, an act of making a different article with intent

that in its use it shall become the patented invention, &c., &c., are infringements, though the act of making without such intent would not be, see §§ 903, 924, and notes, *post*.

That acts of user or sale may thus be changed in character by their intent, see §§ 903-905, 924, and notes, *post*.

⁵ That infringement is deliberate where the infringer knows of the patent, though he supposes that a patent of his own gives him the right to use the invention, see *Burdett v. Estey* (1880), 3 Fed. Rep. 566 ; 19 Blatch. 1 ; 5 Bann. & A. 308.

That a person who wrongfully uses the invention under claim of ownership of the patent is an infringer, see *Continental Store Service Co. v. Clark* (1885), 100 N. Y. 365.

from the inventor, the public could not gain the knowledge necessary to its use. But in the case of a patented article the article itself, being permanent and susceptible of examination, discloses its own nature, and being found in open market communicates to the public such knowledge as enables them to make and use it, and may thus be manufactured, used, and sold by others without any intimation of the exclusive privileges of the patentee. In reference to patented articles, therefore, the law provides that notice of the inventor's claims shall be given to the public by stamping the word "patented" with the date of the patent upon each article itself or on the package which contains it;¹ and that upon his failure so to do the owner of the patent shall not recover substantial damages for its infringement against any person who was not otherwise actually notified of the existence of the patent and his own violation of its claims.

§ 903. Infringement by Unlawful Making.

The act of making can be predicated only of an article as distinguished from an art, — the latter being intangible and fugitive, capable of use but not of manufacture or of sale. Making may consist in the construction of the article, or in such repairs upon it as amount to an entire or partial reconstruction.¹ The act of making is complete when the article exists in a condition fit for use, though still in parts which

§ 902. ¹ That a defendant cannot be held in damages as an infringer if the patentee put his invention on the market unstamped, unless he had notice of the patent, see *Allen v. Deacon* (1884), 10 *Sawyer*, 210; 21 *Fed. Rep.* 122.

See also, on the duty of stamping, etc., § 628 and notes, *ante*.

§ 903. ¹ That an infringement may be committed by repairing as well as making the invention, if repairing involves reconstruction either in whole or in part, see *Goodyear Dental Vulcanite Co. v. Preterre* (1878), 14 *O. G.* 346; 15 *Blatch.* 274; 3 *Bann. & A.* 471.

To replace a part where the patent

specially claims that part is infringement, see *Gottfried v. Conrad Scipp Brewing Co.* (1881), 8 *Fed. Rep.* 322; 10 *Bissell*, 368.

That where the different parts of a machine are covered by different patents a purchaser of the machine from the patentee cannot replace one of the parts separately patented when worn out, see *Singer Mfg. Co. v. Springfield Foundry Co.* (1888), 34 *Fed. Rep.* 393.

That a machine wrongfully sold by an infringer cannot be repaired without further infringement, see *Graham v. Mason* (1872), 1 *O. G.* 609; *Holmes*, 88; 5 *Fisher*, 290.

are to be united by the user.² To make a patented article is not *ipso facto* an infringement.³ The intent of the maker here determines the legal complexion of his act, the purpose of the manufacture being an essential element of the transaction. To make as an experiment only, or for exhibition as a specimen of the manufacturer's mechanical skill, is not infringement.⁴ To make for practical use or for sale is an infringement although the article be never used or sold, or be sold or used outside the territorial limits within which it is protected by the patent.⁵ To make a single part of the invention with intent to use it in connection with the other parts already made, or to sell it to others by whom it will be united with the remaining portions of the article elsewhere obtained, is also an infringement.⁶ To make a different article intending that by use it shall become the patented article, is likewise an infringement, — the maker being responsible for such changes as he contemplates in making it, though not for those which without his co-operation are subsequently introduced by those who use it.⁷ On the other hand, to make the same tangible

² That to construct the parts ready for union by the purchaser is making, see § 924 and notes, *post*.

³ That a mere making, without intent to sell or use, is not infringement, see § 898 and notes, *ante*.

⁴ That to make for experiment, or amusement, or exhibition merely, is not an infringement, see *Standard Measuring Machine Co. v. Teague* (1883), 15 Fed. Rep. 390; *Poppenhusen v. Falke* (1861), 2 Fisher, 181; 4 Blatch. 493.

See also § 898 and notes, *ante*.

⁵ That it is an infringement to make an article for use, though it is never used or sold, see *Haselden v. Ogden* (1868), 3 Fisher, 378; *Whittemore v. Cutter* (1813), 1 Gallison, 429; 1 Robb, 28.

That to make for sale abroad is an infringement, see *Ketchum Harvester Co. v. Johnson Harvester Co.* (1881), 8 Fed. Rep. 586; 19 Blatch. 367.

⁶ That to make a part with intent

to use it, or to sell it to be used, in connection with the other parts of the invention, is infringement, see *Celluloid Mfg. Co. v. American Zylonite Co.* (1887), 30 Fed. Rep. 437; 40 O. G. 1453; *Travers v. Beyer* (1886), 26 Fed. Rep. 450; 23 Blatch. 423; *Snyder v. Bunnell* (1886), 29 Fed. Rep. 47; 38 O. G. 1130; *Schneider v. Pountney* (1884), 21 Fed. Rep. 399; 29 O. G. 84.

See also § 901 and notes, *ante*, and § 924 and notes, *post*.

⁷ That to make a device with a view to a result produced by its use which would make it the same as the patented device is infringement, see *N. Y. Bung & Bushing Co. v. Hoffman* (1881), 20 Blatch. 3; 20 O. G. 1451; 9 Fed. Rep. 199; *American Diamond Rock Boring Co. v. Sullivan Mach. Co.* (1877), 14 Blatch. 119; 2 Bann. & A. 522; *Renwick v. Pond* (1872), 2 O. G. 392; 10 Blatch. 39; 5 Fisher, 569.

That an innocent manufacturer does

article for use or sale but as the embodiment of a distinct idea of means, or to make a single part not intended by the maker for use in union with the other parts, or to replace a part not covered by the patent, are not infringements.⁸ A patent for the use of an article is not invaded by the act of making it, nor is the maker liable for its use by those to whom he sells it.⁹ To make by the agency of others, whether workmen or co-partners, is infringement, and though the maker pays for the articles only by the piece and when completed and delivered.¹⁰

§ 904. Infringement by Unlawful Using.

To use a patented art or article for purposes of experiment only is not an infringement. But to employ it in any manner for beneficial uses of a pecuniary character is an invasion of the privileges of the patentee. It is immaterial that the article was made by others and has been purchased by the user, or now subsists in an altered condition, or is divided into parts

not infringe through changes made in his device after it leaves his hands and control, see *De Long v. Bickford* (1882), 13 Fed. Rep. 32 ; 22 O. G. 2242.

That it is not an infringement to make a device which can be forced to operate like the patented invention if such was not the intention of the maker, see *Buzzell v. Andrews* (1885), 25 Fed. Rep. 822 ; 34 O. G. 830.

That to make an article, not intended to resemble the patented invention, but which becomes like it by accident, wear and tear, or usage, is not an infringement, see *Page v. Ferry* (1857), 1 Fisher, 298.

⁸ That if the article embodies a distinct idea of means and was so intended, though apparently similar to the patented invention, its manufacture is not infringement, see *National Car Brake Shoe Co. v. D., L. & N. R. Co.* (1880), 4 Fed. Rep. 224 ; *Pitts v. Wemple* (1855), 1 Bissell, 87 ; 2 Fisher, 10.

See also § 230 and notes, *ante*.

That to make an article which may be used in combination with others to form a patented invention is not infringement, unless intended for such use, see *Campbell v. Kavanaugh* (1882), 11 Fed. Rep. 83 ; 20 Blatch. 256.

See also §§ 900, 901, and notes, *ante*, and § 924 and notes, *post*.

⁹ That a patent covering only the "use" of a certain thing is not infringed by "making" or "selling" it, nor are the maker or seller responsible for its use, see *Keystone Bridge Co. v. Phoenix Iron Co.* (1872), 5 Fisher, 468 ; 1 O. G. 471.

¹⁰ That it is an infringement to employ a workman to infringe, see *Lightner v. Brooks* (1864), 2 Clifford, 287.

That a manufacturer infringes if his men work by the piece in making the device, see *Wooster v. Marks* (1879), 17 Blatch. 368.

which are successively employed, or is applied to different purposes from those intended by the inventor or to but one of several purposes for which it was designed, or is joined with new elements which enable it to perform additional functions, or is divested of its non-essential features, — the use is still an infringement of the patent, however meritorious may be the new uses or improvements discovered and made available by the infringer.¹ To use in part with intent that others shall complete the operation, or to use only through the agency

§ 904. ¹ That to use an infringing device made by another is an infringement, see *Haselden v. Ogden* (1868), 3 Fisher, 378.

That the use of the device in an altered condition is infringement, see *Illinois Central R. R. Co. v. Turrill* (1876), 94 U. S. 695 ; 12 O. G. 709.

That to divide a single part into two parts, doing the same thing in the same way, is infringement, see *Wheeler v. Clipper Mower & Reaper Co.* (1872), 2 O. G. 442 ; 10 Blatch. 181 ; 6 Fisher, 1.

That to use two dies instead of one may be an infringement, see *Baldwin v. Bernard* (1872), 2 O. G. 320 ; 9 Blatch. 509 note ; 5 Fisher, 442.

That to take an invention for one purpose only is an infringement, see *Adair v. Thayer* (1880), 4 Fed. Rep. 441 ; 17 Blatch. 468 ; 5 Bann. & A. 118.

That to use a patented device for a new purpose is infringement, see *Zinn v. Weiss* (1881), 7 Fed. Rep. 914.

That the use of an invention for a purpose not specified nor contemplated by the inventor is infringement, see *Cincinnati Ice Mach. Co. v. Foss-Schneider Brewing Co.* (1887), 31 Fed. Rep. 469.

That to use an invention for a part of an operation, instead of the whole, is infringement, see *Eames v. Andrews* (1887), 122 U. S. 40 ; 39 O. G. 1319.

That to use a less quantity of a patented material is infringement, see *Celuloid Mfg. Co. v. Chrolithion Collar & Cuff Co.* (1885), 31 O. G. 519 ; 23 Fed. Rep. 397.

That the use of the essential features of the invention or their equivalents is infringement, see *Sessions v. Romadka* (1884), 28 O. G. 721 ; 21 Fed. Rep. 124.

That the use of a device which is an equivalent for the patented device and more, though in a way in which the patented device cannot be used, is infringement, see *Yale Lock Mfg. Co. v. Norwich National Bank* (1881), 6 Fed. Rep. 377 ; 19 Blatch. 123.

That the use of a separable patented part of the invention is an infringement, see *Fetter v. Newhall* (1883), 21 Blatch. 445 ; 17 Fed. Rep. 841 ; 25 O. G. 502.

That it is not infringement for the purchaser of a device to use it in a way forbidden to his vendor, see *Goodyear v. Beverly Rubber Co.* (1859), 1 Clifford, 348. But see §§ 824, 826, and notes, *ante*.

That a purchaser from a later inventor cannot use the device, pending an injunction against such inventor, without infringing, see *Woodworth v. Edwards* (1847), 3 W. & M. 120 ; 2 Robb, 610.

That the use of an invention involving a patented process is a continuing infringement, see *Beadle v. Bennett* (1887), 122 U. S. 71 ; 39 O. G. 1326.

of others who furnish to their principal the finished product resulting from such use, is likewise an infringement.²

§ 905. Infringement by Unlawful Selling.

To sell a patented article without authority from the patentee is always an infringement. A sale, in its true legal sense, imports a transfer of the ownership of property, accompanied by its delivery to the vendee, in consideration of a price or recompense in value. But any form of transfer, under whatever disguise concealed, which directly or indirectly passes the apparent title from one person to another, is a sale within the purpose and construction of the Patent Laws, and makes the transferor an infringer of the patent.¹ To sell a part of the invention with the intent that it shall be united or used in connection with its other parts, to sell a different article with the intent that in its use it shall become the one claimed in the patent, to transport knowingly for use and sale in collusion with infringing makers or vendors, are also acts of infringement.² But a sale pro-

² That a partial use to be completed by others is an infringement, see § 901 and notes, *ante*, and § 924 and notes, *post*.

That a merely colorable contract for the product by one who procures the infringing machine or process to be used for his benefit is an infringement, see *Keplinger v. De Young* (1825), 10 Wheaton, 358; 1 Robb, 458.

That a person who makes a *bona fide* contract with an infringer to take the entire product of the infringing process or machine is not *per se* an infringer himself, though he knows that the machine or process is an infringement, see *Keplinger v. De Young* (1825), 10 Wheaton, 358; 1 Robb, 458.

That where the users of an infringing machine lease it to others who use it in complicity with the lessors, they may be joined as defendants, being joint infringers, see *Wells v. Jaques* (1874), 5 O. G. 364; 1 Bann. & A. 60.

§ 905. ¹ That any transaction, whether it assume the form of a sale proper or an exchange or a judgment and recovery, or any other transfer of ownership, is a sale within the intent of the Patent Laws, see § 1252 and notes, *post*.

That to sell an infringing article is an infringement whoever may have been the maker, see *Haselden v. Ogden* (1868), 3 Fisher, 378.

That it is not infringement to make and sell to one who has a license to use, where the invention is a mere appendage and the patentee has agreed to license all makers who apply, see *Saxe v. Hammond* (1875), 7 O. G. 781; Holmes, 456; 1 Bann. & A. 629.

² That the manufacture and sale of a part of the device, with intent that it shall be used in infringing the patent, is itself an infringement, see *Travers v. Beyer* (1886), 26 Fed. Rep. 450; 23 Blatch. 423; *Schneider v. Pountney*

cured by the patentee or his agent is not an infringement, although it furnishes evidence of other sales which are infringements.³ The sale of a part covered by one patent is not an infringement of a different patent for the entire article,

(1884), 21 Fed. Rep. 399; 29 O. G. 84.

That a sale of a machine to be used in infringing a patented combination is an infringement, see *Holly v. Vergennes Mach. Co.* (1880), 4 Fed. Rep. 74; 18 Blatch. 327; 18 O. G. 1177.

That sale of part of an article is not *ipso facto* an infringement, see *American Cotton Tie Co. v. Simmons* (1882), 106 U. S. 89; 22 O. G. 1976.

That the sale of an article which can be used only for the purpose of an infringement is itself an infringement, see *Snyder v. Bunnell* (1886), 29 Fed. Rep. 47; 38 O. G. 1130; *Alabastine Co. v. Payne* (1886), 27 Fed. Rep. 559; 35 O. G. 1438.

That mere capability of use for infringing purposes does not make the seller an infringer, see *Snyder v. Bunnell* (1886), 38 O. G. 1130; 29 Fed. Rep. 47.

That to make and sell an instrument capable of being used, and designed to be used, to effect the result of the patented invention by the means described in its claims is an infringement, see *Renwick v. Pond* (1872), 2 O. G. 392; 10 Blatch. 39; 5 Fisher, 569.

That to make and sell a device which in using it will become the same device covered by the patent is infringement, see *N. Y. Bung & Bushing Co. v. Hoffman* (1881), 20 Blatch. 3; 20 O. G. 1451; 9 Fed. Rep. 199; *American Diamond Rock Boring Co. v. Sullivan Mach. Co.* (1877), 14 Blatch. 119; 2 Bann. & A. 522.

That to sell with such directions as to use as, by the use, to copy the patented invention, is an infringement, see *Boyd v. Cherry* (1883), 4 McCrary, 70.

That to make and sell materials, knowing and intending their use for infringing purposes, makes the seller a joint infringer, see *Celluloid Mfg. Co. v. American Zylonite Co.* (1887), 30 Fed. Rep. 437; 40 O. G. 1453.

That knowingly to transport an invention to be used by consignees in violating a patent is an infringement, see *American Cotton Tie Supply Co. v. McCready* (1879), 17 O. G. 565; 17 Blatch. 291; 4 Bann. & A. 588.

That infringement by complicity must be clearly proved both as to act and intent, see *Snyder v. Bunnell* (1886), 38 O. G. 1130; 29 Fed. Rep. 47.

³ In *De Florez v. Reynolds* (1878), 14 Blatch. 505, Wheeler, J.: (509) "The infringement shown is by proof of the sale of a can by the defendants, purchased for and by the direction of the orators. It is claimed that the orators so participated in this transaction that the defendants cannot be liable on account of it. This is probably true, and if this was all the defendants have done the orators would not be entitled to a decree. But this can was purchased of the defendants in the usual course of their business, which is some evidence that they are dealing in those articles. This evidence they have not met and denied, but have rather supported. From it it is found that they are dealing in these infringing cans in such a manner that, except as to this one purchased for the orators, they are liable to account, and to prevent which they should be restrained." 3 Bann. & A. 292 (296).

See also *Byam v. Bullard* (1852), 1 Curtis, 100.

nor is the sale of a part not intended for use in the infringing article, though capable of such use as well as others.⁴ A sale by a sheriff, under legal process, of the materials of a patented article, though ready to be united and practically used, is not infringement.⁵ A patent for the use of the article is not infringed by selling it, nor is the vendor responsible for its use by his own vendees.⁶ An infringing sale may be effected through the agency of others, for whose acts the principal must answer as if they were committed by himself.⁷ But acts of agents outside their authority implicate themselves alone; and personal representatives, by wrongful sales of patented articles found among the assets of the decedent, create no liability against his estate.⁸

§ 906. Infringement a Single Tort though Embracing Acts of Making, Use, and Sale.

Although a complete infringement is committed by a single act of either making, use, or sale, yet when the same person performs two or more of these, the number of the infringements is not thereby increased. To make and use, or to make and sell, or to make and use and sell are the same tort, perpetrated through the medium of different acts, and constituting a single cause of action.¹ The measure of damages may

⁴ That to sell a part covered by one patent does not infringe another patent covering the whole, see *Buerk v. Imhaeuser* (1876), 11 O. G. 112; 2 Bann. & A. 465.

That to make and sell a useless part of a structure, not sold to be used nor used in an infringing structure, is not an infringement, see *Campbell v. Kavanaugh* (1882), 11 Fed. Rep. 83; 20 Blatch. 256.

⁵ That a sale of the materials of a patented device by a sheriff on legal process is not infringement, see *Sawin v. Guild* (1813), 1 Gallison, 485; 1 Robb, 47.

⁶ That a patent for the "use" is not infringed by a "sale," nor is the seller liable for the use by the vendee, see

Keystone Bridge Co. v. Phoenix Iron Co. (1872), 5 Fisher, 468; 1 O. G. 471.

⁷ That a sale by an agent is infringement by the principal, see *Jones v. Sewall* (1873), 3 Clifford, 563; 6 Fisher, 343; 3 O. G. 630; *Poppenhusen v. N. Y. Gutta Percha Comb Co.* (1858), 2 Fisher, 62.

⁸ That a sale of infringing articles by an administrator does not make the estate liable for infringement, see *Thompson v. Canterbury* (1881), 2 McCrary, 332.

§ 906. ¹ In *Steam Stone Cutter Co. v. Sheldon* (1884), 21 Fed. Rep. 875, Wheeler, J. : (877) "The orator could not in any mode recover both for the profits of the sale for use and the profits

differ, as will be hereafter seen, as one or more of these acts enter into the infringement, but for all purposes of compensation to the patentee, and of judicial restraint on the infringer, they are one wrong demanding but one redress.²

§ 907. No Infringement can be Committed before the Issue of the Patent.

No act of making, use, or sale can be an infringement of a patented invention unless it be performed during the life of the patent. An infringement may indeed be committed by the use, after the patent issues, of a device constructed before the creation of the monopoly, notwithstanding the good faith of its purchaser or maker and his belief that it will never be protected by a patent.¹ But an unauthorized appropriation of the invention, before the patent issues, although a tort for which the inventor has his remedy, is not an infringement

of the use. Each was a trespass upon the orator's exclusive rights, but not a separate and distinct trespass. A recovery for one would include a recovery for a part, at least, of the other, so that a recovery could be had for either, but not for both. The orator having had a recovery for one, cannot now have another for the other." 22 Blatch. 484 (487).

² That acts of making by one person and of use or sale by another are distinct infringements, see *Blake v. Greenwood Cemetery* (1883), 16 Fed. Rep. 676; 25 O. G. 89; 21 Blatch. 222.

That as determining the measure of damages, acts of making, use, and sale are essentially distinct, and vary in their effect according to the patentee's method of enjoying his monopoly, see *Colgate v. Western Electric Mfg. Co.* (1886), 28 Fed. Rep. 146; 37 O. G. 893.

That where one party makes and another sells they are liable jointly and severally, see *Jennings v. Dolan* (1887), 38 O. G. 1018; 29 Fed. Rep. 861.

§ 907. ¹ In *Evans v. Weiss* (1809), 2 Wash. 342, Washington, J. : (344) "It must be admitted, that cases of great hardship may occur, if, after a man shall have gone to the expense of erecting a machine, for which the inventor has not then, and never may obtain a patent, he shall be prevented from using it by the grant of a subsequent patent, and its relation back to the patentee's prior invention. But the law in this case cannot be termed *ex post facto*, or even retrospective in its operation; because the general law declares, beforehand, that the right to the patent belongs to him who is the first inventor, even before the patent is granted; and, therefore, any person, who, knowing that another is the first inventor, yet doubting whether that other will ever apply for a patent, proceeds to construct a machine, of which it may afterwards appear he is not the first inventor, acts at his peril, and with a full knowledge of the law that, by relation back to the first invention, a subsequent patent may cut him out of the use of the machine thus erected.

capable of redress under the Patent Law.² In the English courts a contrary view has been taken and the relief due to the patentee has been extended to wrongs committed after the filing of the specification and before the patent had been sealed.³ But under our system the privilege created by the patent is alone subject to infringement, and the invasion of the right has uniformly been held to be impossible until the right itself has been conferred. The date of the patent is thus the earliest moment at which an infringement can occur; and this is true not only in original patents but in re-issues also, which for this purpose are considered new patents and cannot be infringed by acts performed before they have been granted.⁴

§ 908. Infringement after the Patent has Expired.

As a general rule, the act must also be committed before the term, for which the patent issued or was extended, has expired. The termination of the exclusive privileges of the

Not only may individuals be injured by a literal construction of the words of the law, but the public may suffer, if an obstinate or negligent inventor should decline obtaining a patent, and at the same time keep others at arm's length, so as to prevent them from profiting by the invention for a length of time during which the fourteen years is not running on. But all these hardships must rest with Congress to correct. It is beyond our power to apply a remedy." 1 Robb, 10 (12).

² That no infringement can take place before the issue of the patent, see *Lyon v. Donaldson* (1888), 34 Fed. Rep. 789.

That an injunction will not be granted where the evidence shows that the defendant is using the same devices or process which he employed before the patent was granted, see *Dorlan v. Guie* (1885), 25 Fed. Rep. 816; 34 O. G. 702.

That there can be no infringement

by using an invention invented but withheld from the public by the patentee, see *Page v. Ferry* (1857), 1 Fisher, 298.

³ That an infringement may be committed at any time after a complete specification is filed, see 15 & 16 Vict. c. 83.

⁴ That a re-issue is not infringed by acts committed under the original patent, see § 696 and notes, *ante*.

That a re-issue with a broader Claim is not infringed by the use of devices made before the original patent, though they are covered by the new Claim, see *Ives & Miller v. Hartford Spring & Axle Co.* (1882), 11 Fed. Rep. 510; 20 Blatch. 333; 22 O. G. 1037.

That a device which does not infringe the original cannot infringe the re-issue, if the scope of original is measured by its description and not by its Claims alone, see *Cammeyer v. Newton* (1879), 18 O. G. 720; 4 Bann. & A. 159.

patentee is contemporaneous with the expiration of the patent which creates them, and the right to make, and use and sell the invention is then vested in the public beyond the control or interference of the inventor. To this rule there is one exception. As before stated, the making of the invention is not *ipso facto* an infringement, though it becomes such when coupled with an intent that the invention shall be used or sold in violation of the patent. Under this doctrine there is nothing to prevent the manufacture of the patented article in unlimited quantities during the life of the patent, to be put upon the market or into operation as soon as the patent expires to the possible injury of the business of the patentee or his licensees. The law regards such a transaction as a fraud upon the rights of the patentee, and an evasion of the rules by which those rights are protected; and the courts have therefore treated the use and sale, after the patent has expired, of articles made for that purpose without due authority while the patent was in force as infringements of the patent and as rendering the parties liable in the same manner and to the same extent as if the acts of use and sale, as well as that of making, had been committed during the existence of the patent.¹ The expiration of one among a series of connected

§ 908. ¹ In *American Diamond Rock Boring Co. v. Sheldon* (1880), 1 Fed. Rep. 870, Wheeler, J. : (872) "The defendants have machines made during the term of the patent, and which were infringements when made. If they could be made then and used now, in defiance of the owner of the patent, the exclusive right granted would not be fully enjoyed. The grant of the exclusive right is substantially the same in this country as it is in England. The question raised here arose there in *Crossley v. Derby Gas-light Co.*, Webst. Pat. Cas. 119. The case is more fully reported in 4 Law Jour. N. S. Chan. 25. There the patent would expire on the ninth of December, 1829; and on the twenty-eighth of November before a bill was filed praying for an injunction

against using infringing machines and for an account, the vice chancellor granted the injunction, and directed the account, and the defendants appealed. After argument, the lord chancellor, Lyndhurst, said: "This is an appeal from his honor, the vice chancellor, and is a case for an injunction against the invasion of a patent-right by preventing the use of certain gas-meters. This case is very peculiar, and is distinguishable from all other cases in the books. It appears that the plaintiff obtained his patent on the ninth of December, 1815, and that on the twenty-eighth of November, 1829, only a few days before the patent expired, he filed a bill. It was objected that the court would not interfere, just on the eve of the expiration of the patent, and grant an injunction

patents does not release to the public any invention covered by the others, and if the instrument or operation it protected cannot be enjoyed without the employment of the associated inventions, the public must postpone its appropriation to their use until the patents for these have also terminated.²

which would only last a week. The point has never yet been decided; but I am of opinion that the court would interfere after a patent had expired to restrain the sale of articles manufactured previous to its expiration in infringement of a patent-right, and that a party would not be allowed to prepare for the expiration of a patent by illegally manufacturing articles, and immediately after its expiration to deluge the markets with the products of his piracy, and thus reaping the reward of his improbus labor in making it. The court would, I say, in such case restrain him from selling them, even after the expiration of the patent.' This doctrine does not appear to have been denied or questioned afterwards, and was frequently carried out, in effect, by decreeing the destruction of infringing machines. *Betts v. De Vitre*, 34 Law Jour. Ch. 289; *Needham v. Oxley*, 11 Weekly Rep. 852. In *Curtis on Pat.* § 436, it is laid down as clear law that, 'if the patent has expired, the account and the injunction will extend to all the articles piratically made during the existence of the patent, though some of them may remain unsold.' The illegality attaches to the things themselves. The person making them has no right to make them — no right to them when made; he can impart none, and none will accrue by their passing into time when they might be made. The ordinary injunction in such cases, in effect, restrains all infringement of the patent, and is, in form, perpetual. It would, doubtless, cover an illegal sale or use after the expiration of the patent." 18 Blatch. 50 (52); 5 Bann. & A. 292 (294).

See also *New York Belting & Packing Co. v. Magowan* (1886), 27 Fed. Rep. 111; 34 O. G. 1278.

That the sale of an article after the patent expires is not an infringement though it were made under the patent, if the patentee consented to the making, see *Reay v. Rau* (1883), 23 O. G. 1928; 15 Fed. Rep. 749.

² In *McKay v. Dibert* (1881), 5 Fed. Rep. 587, *Nixon, J.*: (590) "Taking the case, then, as we find it, the naked question presented is: If an inventor embody in a machine a new mechanism to accomplish a desired and express purpose, does the Patent Law authorize him to procure (1) a patent for the machine, (2) a patent for the process by which the result was achieved, and (3) a patent for the product of the process as a new article of manufacture; and if such patents expire at different times has the court the power to decree that the younger patents in the series shall die when the older one runs out? Or, to state the proposition more succinctly, is there authority in the law to continue to an inventor the monopoly in the product of a machine after the machine itself has become public property by falling into the domain of public use? In determining such a question reference must be had, of course, to the law as it stood when the several patents were issued. These were the acts of July 4, 1836, and March 3, 1839, which were substantially the same as the present statute in regard to patentable subjects. By the sixth section of the first recited act the Commissioner of Patents was authorized to grant letters-patent to any person who had dis-

§ 909. Infringement can be Committed only within the Area of the United States.

A patent purports to protect the invention throughout the United States and the territories thereof. This protection

covered or invented 'any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement in any art, machine, manufacture, or composition of matter, not known or used by others before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use or on sale with his consent or allowance as the inventor or discoverer.' By the seventh section of the later act such public use or sale shall not avoid the patent, unless the same has continued for two years prior to the application for the patent. It is here we find the scope and extent, as well as the limitation, of the power of the Commissioner of Patents in regard to granting or withholding letters-patent. If the inventor, after obtaining his first patent for the machine, had waited for more than two years before applying for the process and product patents, there may have been such disclosure and public use of the invention that the limitation would have applied, and the Patent Office been compelled, under the provisions of the supplement of 1839, to have rejected the subsequent application. But no such time elapsed, and I am of the opinion that it was competent for the patentee, within the two years, to take out his process and product patents, and thus to guard himself against the danger and loss that might arise from others using the process to accomplish other results, or securing the product by the agency of other means and instrumentalities. Two reasons were forcibly presented by the learned counsel for the defendant why the act should not have the above interpreta-

tion: (1) Because it was asking the court, by judicial construction, to extend the monopoly and life of a patent for two years beyond the time prescribed by the law; (2) because the machine patent having expired, and belonging to the public, it was a contradiction in terms to hold that its use could be restrained on the ground that by its use other patents were infringed. These reasons need not be considered separately, and I think the difficulties which they suggest grow out of a misapprehension of what the court is supposed, in fact, to do in the case. The argument was that if an inventor procures a patent for a machine, and, after holding it for any length of time less than two years, is permitted, without the surrender of the original and a re-issue, to apply for a patent for the process employed, and the product obtained from the use of the machine, and then, after the expiration of the machine patent, may restrain its use by the public until the process and product patents run out, it is practically extending the life of the first patent, and giving the owner a monopoly beyond the period of time to which the law in express terms limited it. But the court does not propose to restrain generally the use of the machine but only such unlawful use of it as infringes the vested rights of others. As long as separate patents for a machine, and the process and the product, are allowable, they represent distinct inventions (*Kelleher v. Darling*, 14 O. G. 673), and each one may live, without interference or molestation, its whole life, without regard to the death of the others. While the product patent continues in existence, the manufac-

exhausts the powers of Congress, so far as the place of its exercise is concerned. It also marks the limits within which acts of infringement must occur.¹ The area of the United States for this purpose as well as others is held, however, to include not only all the waters which embrace its shores but American vessels sailing upon whatever seas.² To make, use, or sell the patented invention within the area thus defined, or to make within the United States for sale abroad, is an infringement.³ Foreign vessels, though within our territory, are

ture of the product by any instrumentality is prohibited, and it is no answer to the charge of infringement to say, 'I had the right to use the particular mechanism by which I obtained the product.' But the defendant insists that the machine belongs to the public to use, and that nothing can be manufactured from it except the product, of which the complainant has yet the monopoly. If this be true, then the public must find out some other use to put it to, or abstain from its use until the time comes in which it may be used without infringing the rights of others." 19 O. G. 1351 (1352).

But see *McKay v. Jackman* (1882), 12 Fed. Rep. 615; 22 O. G. 85; 20 Blatch. 466.

§ 909. ¹ That a purchaser in England from the vendee of the patentee, who has sold the article without restrictions, is not an infringer when he uses or sells in the United States, see *Holliday v. Matheson* (1885), 23 Blatch. 239; 24 Fed. Rep. 185; 31 O. G. 1444.

That the use in England of infringing apparatus purchased abroad is infringement under English laws, see *United Telephone Co. v. Sharples* (1885), L. R. 29 Ch. D. 164.

² In *Gardiner v. Howe* (1865), 2 Clifford, 462, Clifford, J.: (464) "Reference is made by the defendant to the case of *Brown v. Duchesne*, 2 Cur. 371, and *Same v. Same*, 19 How. 183; but

these cases do not apply where, as in this instance, the vessel where the act of infringement took place was American. Were it to be held that in cases like the present the plaintiff is not entitled to recover, patents for improvements in the tackle and machinery of vessels, or in their construction, would be valueless. The Patent Laws of the United States afford no protection to inventions beyond or outside of the jurisdiction of the United States; but this jurisdiction extends to the decks of American vessels on the high seas, as much as it does to all the territory of the country, and for many purposes is even more exclusive."

³ In *Ketchum Harvester Co. v. Johnson Harvester Co.* (1881) 8 Fed. Rep. 586, Blatchford, J.: (586) "Although the patent could give no protection abroad in the sale of machines abroad, it gave protection in the United States in making machines in the United States for sale abroad. The patent prevented all persons but the patentee from making in the United States. The privilege of making in the United States, for sale abroad, was valuable, as was shown by the fact that the defendant made in the United States for sale abroad. The plaintiff was entitled to that privilege exclusively, and to damages for its violation. It may be that in the case of manufacture in the United States, without sale anywhere, nominal damages only are to be allowed; but where such

not within the jurisdiction of the United States, and the use thereon of articles procured abroad is not an infringement.⁴ Articles procured here for use upon such vessels would involve an act of infringement on the part of the person by whom they were furnished, although their use may be beyond the reach of our judicial powers.

§ 910. Infringement by the Government and its Officials.

Any person, whether natural or artificial, who without due authority from the patentee performs an act of making, using, or selling a patented invention, or procures such an act to be performed, or adopts it and accepts its benefits when performed, is guilty of an infringement. Even the government of the United States, from whom the patent emanates, can neither grant to others the right to practise the invention, nor itself employ it, without the permission of the patentee.¹ Though

manufacture is followed by sale abroad, it cannot be said that the damages ought to be only nominal. It is true that the sale is the fruition and gives the profit, and that the sale is abroad, and the patent does not cover the sale abroad. But the unlawful act of making is made hurtful by a sale, wherever made. The legal damages for making and selling here may be, in some cases, greater than the legal damages for making here and selling abroad; but to deprive the patentee of all damages for unlawful making here, because the article is sold abroad, is to deprive him of part of what his patent secures to him." 19 Blatch. 367 (367).

⁴ In *Brown v. Duchesne* (1856), 19 How. 183, Taney, J.: (198) "And the court are of opinion that the rights of property and exclusive use granted to a patentee does not extend to a foreign vessel lawfully entering one of our ports; and that the use of such improvement in the construction, fitting out, or equipment of such vessel while she is coming into or going out of a port of the United States, is not an infringement of

the rights of an American patentee, provided it was placed upon her in a foreign port, and authorized by the laws of the country to which she belongs."

§ 910. ¹ In *James v. Campbell* (1882), 104 U. S. 356, Bradley, J.: (357) "That the Government of the United States, when it grants letters-patent for a new invention or discovery in the arts, confers upon the patentee an exclusive property in the patented invention, which cannot be appropriated or used by the Government itself without just compensation any more than it can appropriate or use without compensation land which has been patented to a private purchaser, we have no doubt. The Constitution gives to Congress power 'to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries,' — which could not be effected if the government had a reserved right to publish such writings or to use such inventions without the consent of the owner." 21 O. G. 337 (337).

See also *Palmer v. United States*

the invention be of no utility except for governmental purposes, or pertain to an art over which another grantee of the United States has an exclusive control, it is no less within the entire dominion of the patentee, and cannot be appropriated to such uses without incurring liability to him.² Officers of the United States, contractors on its public works, and others acting upon its behalf but guided by their own volition as distinguished from superior authority, are also responsible for acts committed by them in violation of the patent, although the ultimate benefit of the infringement accrues not to themselves but to the government for which they act.³ In cases of great

(1885), 20 Ct. of Claims 432; *Campbell v. James* (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354; *Cammeyer v. Newton* (1876), 94 U. S. 225; 11 O. G. 287; *Brady v. Atlantic Works* (1876), 2 Bann. & A. 436; 10 O. G. 702; 4 Clifford, 408; *United States v. Burns* (1870), 12 Wall. 246; *quere*, *Heaton v. Quintard* (1869), 7 Blatch. 73.

That the government cannot grant the right to use a patented invention, see *Colgate v. International Ocean Telegraph Co.* (1879), 17 O. G. 194; 17 Blatch. 308; 4 Bann. & A. 609.

That a grant by the government of exclusive rights to carry on a certain business does not authorize the use of a patented invention in that business, see *Colgate v. International Ocean Telegraph Co.* (1879), 17 O. G. 194; 17 Blatch. 308; 4 Bann. & A. 609.

² In *James v. Campbell* (1882), 104 U. S. 356, Bradley, J.: (358) "Many inventions relate to subjects which can only be properly used by the government, such as explosive shells, rams, and submarine batteries, to be attached to armed vessels. If it could use such inventions without compensation, the inventors could get no return at all for their discoveries and experiments. It has been the general practice, when inventions have been made which are

desirable for government use, either for the government to purchase them from the inventors and use them as secrets of the proper department, or if a patent is granted, to pay the patentee a fair compensation for their use. The United States has no such prerogative as that which is claimed by the sovereigns of England, by which it can reserve to itself, either expressly or by implication, a superior dominion and use in that which it grants by letters-patent to those who entitle themselves to such grants. The government of the United States, as well as the citizen, is subject to the Constitution; and when it grants a patent the grantee is entitled to it as a matter of right, and does not receive it, as was originally supposed to be the case in England, as a matter of grace and favor." 21 O. G. 337 (337).

³ That it is not held in *James v. Campbell*, 104 U. S. 356, that an United States official is not liable for an infringement, see *Forehand v. Porter* (1883), 15 Fed. Rep. 256.

That a postmaster is liable if he uses an infringing device in the postal service, see *Campbell v. James* (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354. But see *James v. Campbell* (1882), 104 U. S. 356; 21 O. G. 337.

That the employees and contractors

public emergency, however, inventions may be taken by the government without the consent of the inventor under a right akin to eminent domain, and in these cases the officers through whom it acts are not infringers, although the patentee is entitled to compensation from the United States.⁴ In suits against the United States, and in proceedings instituted in pursuance of an act of Congress for determining its liability for the use of patented inventions, its measure of responsibility is the same as that of private individuals.⁵

§ 911. Infringement by Public Corporations.

A municipal corporation is responsible for acts of infringement performed by its officers and agents for its benefit.¹ It is immaterial whether such officers are appointed by itself or constitute an independent corporation acting on its behalf by virtue of legislative authority; it is sufficient if it reaps the

of the government are liable if they infringe, see *Brady v. Atlantic Works* (1876), 10 O. G. 702; 4 Clifford, 408; 2 Bann. & A. 436.

That a patent for the application or employment of armor on war vessels is not infringed by a mere workman who applies it to a vessel of the United States, see *Heaton v. Quintard* (1869), 7 Blatch. 73.

⁴ In *Brady v. Atlantic Works* (1876), 4 Clifford, 408, Clifford, J.: (412), "Private property, the Constitution provides, shall not be taken for public use without just compensation, and it is clear that that provision is as applicable to the government as to individuals, except in cases of extreme necessity, in time of war, and of immediate and impending public danger. Exigencies of the kind do arise where the prohibition does not apply to the public, and in such cases it must be conceded that the officer in the public service is not a trespasser, but it is equally true that the government is bound to make full compensation to the owner. *Mitchell v. Harmony*, 13

How. 134; *United States v. Russell*, 13 Wall. 627." 10 O. G. 702 (702); 2 Bann. & A. 436 (436).

⁵ That the remedy against the United States is to be sought in the Court of Claims, where adequate compensation for the injury inflicted on the patentee may be obtained, see § 1258 and notes, *post*.

That it is doubtful whether a government official who uses an invention solely for the benefit of the government can be sued for infringement, and whether the case is not one solely for the Court of Claims, see *James v. Campbell* (1882), 104 U. S. 356; 21 O. G. 337.

§ 911. ¹ That a city may be sued for infringement, see *Bliss v. City of Brooklyn* (1871), 4 Fisher, 596; 8 Blatch. 533.

That a city is liable in its corporate capacity for an infringement by its officers for its benefit, see *Munson v. Mayor of New York* (1880), 3 Fed. Rep. 338; 18 Blatch. 237; 5 Bann. & A. 486.

actual or supposed advantages of their infringement.² But a municipal corporation is not liable for infringements com-

² In *Brickill v. Mayor of New York* (1880), 7 Fed. Rep. 479, Wheeler, J.: (482) "It is urged that an infringement by the fire department of the city is not an infringement by the defendant, because that department was, under the law, a corporation of itself, over which the officers of the city had no control. It is understood, however, as was said in *Allen v. The Mayor, etc.*, that the fire department was a mere agency of the city, having no funds of its own, and making no profits for itself apart from those of the city. If there are any gains and profits in the hands of any party to be accounted for, under these circumstances, on account of an infringement, they must be in the general treasury of the city, and the city itself must be liable to account for them." 18 O. G. 463 (464); 18 Blatch. 273 (276); 5 Bann. & A. 544 (547).

In *Allen v. City of New York* (1879), 17 O. G. 1281, Wheeler, J.: (1281) "The proof in respect to infringement is to the effect that seats embodying this invention were bought by the Board of Education of the city of New York for the use of the schools of the city, and have been in use in those schools under the direction of the Board of Education and the Department of Public Instruction, which has superseded the Board of Education. It is argued that upon this proof the city is not liable in this suit for two reasons. One is because these instrumentalities having charge of the schools are corporations themselves over which the city has no control; the other is that the use is under sovereign authority delegated by the State of New York in its sovereign capacity, for which the city or the Board of Education or the Department of Public Instruction can no more be held liable to suit than the State itself. It is under-

stood that the Board of Education was, and that the Department of Public Instruction is, a corporation under the laws of the State, recognized and treated as such by the courts of the State, and having exclusive charge and control of the schools of the city, without whose action the city cannot be made liable for anything connected with the schools, and for whose contracts the city cannot be held liable otherwise than through proceedings against them. *Ham v. The Mayor, etc.*, 70 N. Y. 459; *Dannatt v. The Mayor, &c.*, 6 Hun, 88. But still the schools are the schools of the city, the Board of Education or Department of Public Instruction takes charge of them for the city, they are paid for with the money of the city, and whatever is saved in providing for them is to the advantage of the city. The corporation which that department or board constitutes is within that of the city, and is an instrumentality through which the educational interests of the city are cared for the same as if done by officers having the same powers, except that the officers could have only a personal and official period of existence, while that of the corporation is, under the law, theoretically perpetual. One principal ground of a suit in equity for the infringement of a patent is to compel an account of the gains or profits accrued to those proceeded against by means of the infringement. Obviously the proper party to proceed against is the one that has received the profits, or to whom the gains have accrued. If any party has saved or made anything by this infringement, it is the city, and the city seems clearly to be a proper party to account for these savings or profits. The board and department are proper parties also, for they have been directly engaged in the

mitted by a contractor on its public works, nor for the use of articles furnished to it by him although they are the product of infringing processes; nor can any agreement between the contractor and the patentee shift the responsibility for the infringement from the contractor to the corporation.³ Public bodies which are not corporations, although composed of sev-

infringement. It is argued that the city as such could not stop the infringement nor control it, and therefore could not be guilty of any tort by which to acquire profits to account for. Probably the city could not, independently of this board or department, stop the infringement; but that is on account of the mode in which the law requires the educational matters of the city to be attended to, and not because the city has any just right to advantages which the wrongful acts of its board or department may acquire. Officers might be able to do the same, but, if so, the city would not be shielded. That the acts constituting the infringement were committed in the exercise of authority derived from the State cannot shield the defendant from liability. The grant of the exclusive right to this invention came from the sovereign power of the general government, and the right is a species of property secured to the inventor by law. It is not subservient to public uses without just compensation, ascertained and furnished upon being taken in a regular and lawful mode, any more than other property of any kind is. It has not been taken by any regular proceeding, but only by mere wrong-doing, which could of itself furnish no legal right. *Cammeyer v. Newton*, 4 Otto, 234." 17 Blatch. 350 (350); 5 Bann. & A. 57 (59).

Contra, that a city is not liable for the acts of a public board of education over whom it has no control, see *Allen v. City of Brooklyn* (1871) 4 Fisher, 598; 8 Blatch. 535.

³ In *Lightner v. Brooks* (1864), 2

Clifford, 287, Clifford, J.: (293) "Where parties contract for implements, machines, or structures to contain any of the modern patented improvements, without any knowledge that the contractor is an infringer, or intends to use the improvement without authority, it is not the just and legal implication from the contract that the party ordering the article contemplates that the contractor will violate the rights of the patentee, or that he thereby commands or directs an infringement. Such contracts are now of daily occurrence, and unless there is some proof of concert, or something in the terms of the contract to indicate a contrary intent, the presumption must be that the person ordering the article either supposed that the contractor had the right to use the improvement, or, as part of the price to be paid by the purchaser of the article ordered, would procure the right of use from some person authorized to grant it for that purpose."

That a public body, employing a contractor to furnish articles for its buildings, is not liable for infringements by the contractor in supplying patented articles without authority, see *May v. Juneau Co.* (1887), 30 Fed. Rep. 241; 41 O. G. 578.

That where a contractor acting under a license does not pay his royalties, the principal hiring him does not infringe, see *Stow v. Chicago* (1877), 8 Bissell, 47; 3 Bann. & A. 83.

That a city using the product made by an infringing process by a contractor does not infringe, see *Brown v. District of Columbia* (1884), 3 Mackey, 502.

oral individuals exercising certain statutory powers, are not capable of committing an infringement or any other wrong except those specified in the statute which creates them.⁴ Contractors and officials acting for such bodies are alone answerable for their unauthorized appropriation of a patented invention.⁵

§ 912. Infringement by Private Corporations: Liability of Officers and Stockholders.

A private corporation infringes by any act of its agents or employees, authorized or ratified by it, which wrongfully appropriates the patented invention. By procuring infringing devices and permitting its workmen to use them, by hiring contractors to practise the invention for its benefit, and in similar ways, it may commit a direct act of infringement; but it is not permitted to escape responsibility by any disguise of its transactions, and to accept, however indirectly, the benefit of the infringing acts of its officers and servants renders it liable to the patentee.¹ It cannot avoid this liability although

⁴ That a county may be liable for infringements, see *May v. Saginaw Co.* (1887), 32 Fed. Rep. 629; *May v. County of Logan* (1887), 30 Fed. Rep. 250; 41 O. G. 1387; *May v. County of Rolls* (1887), 31 Fed. Rep. 473; 40 O. G. 575; *May v. Mercer Co.* (1887), 41 O. G. 815; 30 Fed. Rep. 246.

Contra, *May v. Juneau Co.* (1887), 30 Fed. Rep. 241; 41 O. G. 578.

That where a county is a municipal corporation, it is liable for infringements by contractors, see *May v. Mercer Co.* (1887), 41 O. G. 815; 30 Fed. Rep. 246.

That a State cannot exempt counties from liability for infringement, see *May v. County of Rolls* (1887), 31 Fed. Rep. 473; 40 O. G. 575.

That a board of county commissioners in Ohio is not a corporation and has no other liability than that imposed by statute, and can neither commit a wrong nor be liable for one, see

Jacobs v. Board of Commissioners of Hamilton Co. (1862) 4 Fisher, 81; 1 Bond, 500.

Contra, *May v. County of Logan* (1887), 30 Fed. Rep. 250; 41 O. G. 1387.

⁵ That a contractor working for a body which cannot be liable for infringement is himself liable and cannot justify under his contract, though ignorant that he did infringe, see *Jacobs v. Board of Commissioners of Hamilton Co.* (1862), 4 Fisher, 81; 1 Bond, 500.

§ 912. ¹ In *Poppenhusen v. New York Gutta-Percha Comb Co.* (1858), 2 Fisher, 62, Ingersoll, J.: (72) "A corporation can act only by their agents. It can act only by those who are in their employ. And when one in the employ of a corporation, in the business of his employment, does an act for their benefit, and which they adopt and approve and take advantage of, they will be deemed to have authorized

its stockholders constitute another corporation organized under the jurisdiction of a different State, and carrying on its business with their own employees and machinery, — the corporation whose affairs are thus conducted is still the actual infringer and is answerable therefor.² How far the officers, stockholders, and employees of a private corporation participate in its infringing acts and thereby share its liability is still an open question. That they may be enjoined whenever this is necessary to protect the patentee against future infringements is universally conceded;³ but whether they can

the act, and will be as much bound by it as though expressly authorized. You are here to determine, gentlemen, whether these articles, manufactured by their agent, he being in the employment of the corporation, whether he did it in the business or employment of the corporation, whether it was for their benefit, and if they adopted and approved of it, by selling it in the market, and thereby took advantage of it, they will be deemed to have authorized the act, and will be bound by it." See also *Jacobs v. Commissioners of Hamilton Co.* (1862), 4 Fisher, 81; 1 Bond, 500.

That a corporation infringes by procuring the patented devices and permitting its employees to use them, see *Ransom v. Mayor of New York* (1856), 1 Fisher, 252.

That where the contractor is hired to work for the corporation and to use the infringing device, the hirer is probably liable, see *Lightner v. Brooks* (1864), 2 Clifford, 287.

That corporations cannot escape their liability by any disguise, see *York & Maryland Line R. R. Co. v. Winans* (1854), 17 How. 30.

² That where a railroad company was organized in one State, and all its stock was owned by a railroad company in another State, the latter company operating the road with its own agents and cars, the former company infringes by the use of a patented device on such

cars, see *York & Maryland Line R. R. Co. v. Winans* (1854), 17 How. 30.

³ In *Goodyear v. Phelps* (1853), 3 Blatch. 91, Nelson, J. : (91) "A point has been made, that the defendants are not liable for the infringement charged, as the only participation alleged in the same is as stockholders of an incorporated company, which company is engaged in manufacturing and selling the patented article. However that may be, it appears that the defendants are either directors of the company, who have the management and superintendence of the business, and under whose direction the articles are manufactured and sold, or are the agents of the same, concerned in conducting the business. On this ground, I am of opinion that they are responsible, and are properly made parties defendants." This was a bill for an injunction; the question of liability for damages not being raised.

That officers of an alleged infringing corporation may be joined with the corporation as defendants in an application for an injunction, see *Consolidated Safety Valve Co. v. Ashton Valve Co.* (1886), 26 Fed. Rep. 319.

That the officers of an infringing corporation may be enjoined, even if not liable for damages, see *United Nickel Co. v. Worthington* (1882), 23 O. G. 939; 13 Fed. Rep. 392.

That the managing officers of an in-

be held in damages for past infringements has been variously decided. One opinion, following the doctrine of limited liability as usually applied to private corporate bodies, regards the infringing act as the act of the corporation alone, and declares that none of its members or officials legally participate therein.⁴ Another, affirming the rule that every vol-

fringing corporation may be made co-defendants and individually enjoined, see *Iowa Barb Steel Wire Co. v. Southern Barbed Wire Co.* (1887), 30 Fed. Rep. 123 ; 40 O. G. 577.

That an officer of a corporation acting on its behalf in renting infringing machines to users is a proper party defendant with such users, in a bill for an injunction, see *Nichols v. Pearce* (1869), 7 Blatch. 5.

⁴ In *United Nickel Co. v. Worthington* (1882), 13 Fed. Rep. 392, Lowell, J. : (393) "The question, then, is whether the directors, stockholders, and workmen of the corporation are liable. It has been held that a mere workman who makes a patented article is not an infringer. *Delano v. Scott*, Gilp. 489 ; *Heaton v. Quintard*, 7 Blatch. 73. The reason given by Hopkinson, J., in the first of these cases goes far to decide the present. He says that the statute does not mean to class mere agents, servants, etc., as makers and venders of the patented improvement, but the principals, for whose account and benefit they act. It was conceded, but without being decided, in *Lightner v. Brooks*, 2 Clifford, 287, and in *Lightner v. Kimball*, 1 Low. 211, that a director who has acted affirmatively, so to speak, and ordered an infringement by the corporation, would subject himself to an action. But, upon further examination, I think the law is not so. Infringement is not a trespass. The form of action is case ; and this is because the act done is not of itself a direct interference with the tangible property of the plaintiff, but an indirect inter-

ference with his paramount right. It is like the building of a house upon a man's own land, which shuts out a light which his neighbor has a prescriptive right to enjoy. The person who is to pay damages for a disturbance is not every one who has had anything to do with the building, but he who owns it. It would be a great hardship if the directors of a railway or manufacturing corporation were bound, at their personal peril, to find out that every machine which the company uses is free of all claim of monopoly. No case precisely in point has been cited ; but the practice certainly is to ask for damages only against the corporation. Joinder in equity for purposes of discovery and injunction is another matter ; but I have not known damages to be asked for against the directors of a corporation, excepting in one case, which did not come to trial, but was discontinued as to the directors. I am of opinion that the only persons, who can be held for damages are those who should have taken a license, and that they are those who own or have some interest in the business of making, using, or selling the thing which is an infringement ; and that an action at law cannot be maintained against the directors, shareholders, or workmen of a corporation which infringes a patented improvement." 23 O. G. 939 (939).

That where a railroad company contracted for cars on which a patented invention was to be put, and the contract was signed by its president, who did not contemplate any infringement of the patent, he is not liable as an in-

untary perpetrator of a wrongful act of manufacture, use, or sale is an infringer, considers its directors, agents, and other servants, actually employing or authorizing the employment of the patented invention, as guilty of the infringement and personally answerable to the patentee.⁵ A third, viewing the acceptance of the benefit of the infringing act as furnishing the test of liability, treats its stockholders as infringers, whether or not they are its officers or agents, and exempts the latter unless they are also members of the corporation.⁶ The first opinion is scarcely consistent with a due regard to the rights of the patentee, whose invention might then be practised with impunity by an insolvent corporation, nor with the general tenor of the Patent Laws, which permit no voluntary and unauthorized act of manufacture, use, or sale, direct or indirect, to pass unpunished. The third confuses the benefit derived by the stockholders with that accruing to the corporation, — the benefit of the former being no more closely related to the infringement than that of creditors or

fringer, see *Lightner v. Brooks* (1864), 2 Clifford, 287.

That a liability for infringement is not a "debt" for which the officers of a corporation may be liable because it was improperly contracted, see *Child v. Boston & Fairhaven Iron Works* (1884), 137 Mass. 516.

⁵ That all who join in an infringement are liable for damages as defendants though some are mere officers of corporations, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 19 Fed. Rep. 514 ; 28 O. G. 1007.

That the president of a defendant corporation named as one of the defendants, but not personally served, who owns all the stock and swears to and signs the answer, and enters a general appearance without naming the other defendants, is personally liable for the infringement, see *Smith v. Standard Laundry Mach. Co.* (1883), 19 Fed. Rep. 826 ; 25 O. G. 393 ; 21 Blatch. 184.

⁶ In *Tyler v. Galloway* (1882), 22

O. G. 1294, Blatchford, J. : (1294) "It is shown that the infringing cheese-hoop was owned by the association, and was used by its agents in making cheese in its business at its works for the benefit of its stockholders. Galloway, Durfee, and Billings were shareholders. The use aforesaid was a use by each of them quite as much as if there had been a co-partnership without shares of stock, or one with shares belonging to less than seven shareholders in number. The use by each was a tort, and each is liable to be enjoined." 13 Fed. Rep. 477 (478) ; 21 Blatch. 66 (67).

That the stockholders of an infringing incorporation may be held individually as infringers, see *St. Louis Stamping Co. v. Quinby* (1880), 18 O. G. 571 ; 5 Bann. & A. 275.

That a secretary of an infringing corporation is not liable unless he is also a stockholder, see *Tyler v. Galloway* (1882), 13 Fed. Rep. 477 ; 22 O. G. 1294 ; 21 Blatch. 66.

innocent employees, or that of dealers in or users of the products of infringing processes ; and is pregnant with evil and unjust consequences to all members of private corporations, especially to minorities who neither acquiesce in the infringement nor in the appointment of the officers or agents by whom it is committed. The second is in harmony with other doctrines of the law, sufficiently protects the patentee, and justly punishes those whose wilful acts place them on the same footing with individual infringers. Under this opinion, all agents who perform acts of infringement, and all stockholders, directors, and other officers who in the prosecution of the business of the corporation authorize them, participate in the infringement and are personally responsible to the patentee.

§ 913. Infringement by a Joint-Owner of the Patent.

One of two or more co-owners of a patented invention may be guilty of infringement as against the others. The field of such infringement is of course comparatively narrow, since in the present condition of our law his right to profit by the patented invention is unlimited. While he restricts himself to the manufacture, use, or sale of this invention he does not, therefore, incur any liability to his co-owners. But his employment of other arts or articles, embracing the substance of the patented invention, and yet possessing different or additional features whereby he gains an advantage over his co-owners, is prohibited. The practice of such inventions by non-owners of the patent would be an infringement equally with that of the precise and separate invention which the patent claims, but would often strike more deeply at the interest of the patentee by driving his invention from the market through the superior utility of the infringing instrument or operation. If a co-owner were permitted to avail himself of these by virtue of his ownership of part of the patented invention, the property of the other owners might easily be rendered worthless ; and hence the courts have held that his departure from the patented invention, as described and claimed in the patent, puts him in the same position as a non-owner, and renders him liable in the same manner to the other owners

for his infringing acts.¹ The measure of his liability, however, differs, since the infringement is committed not only against their interest in the patented invention but against his own also, and the injury inflicted and the compensation awarded is consequently apportioned to the other owners according to their respective shares.

§ 914. **Infringement by Assignors, Grantors, and Grantees.**

An assignment either transfers the entire interest of the assignor in a patented invention, or makes him a co-owner with the assignee. In the former case, the assignor becomes a stranger to the patent and capable of infringement by any act of unauthorized manufacture, use, or sale.¹ In the latter case, he is liable to the same extent and for the same acts as an ordinary co-owner, and has the same right to protection against his assignee. A grantor is a stranger to the patent within the territory exclusively conveyed to his grantee, while

§ 913. ¹ In *Herring v. Gas Consumers' Association* (1878), 9 Fed. Rep. 556, Treat, J.: (157) "Can a part-owner infringe the common patent and escape all liability" If he can, it is obvious that, however small his aliquot part, he can make the enjoyment of the patent valueless to his joint-owner. He has, by virtue of the joint-ownership, a right to use the patent, but he has no right more than a stranger to infringe the same. If there is an infringement, the right of recovery is in the party wronged. All the joint-owners should ordinarily be parties plaintiff; but if the wrong-doer is one who is guilty to the damage of the other joint-owner, the latter should not be left remediless. As to such infringement they are strangers. All the joint-owners are on the record, and the amount of the recovery determines their respective interests. The infringer cannot escape the consequences of his wrong to his joint-owner by averring that he was by his infringement injuring not his joint-owner alone, but him-

self also. In other words, he cannot, under cover of his interest in the common patent, shield every wrong-doer who may infringe that patent. He can, as to the other part-owners, by infringing, become liable to them for the wrong done. The amount of recovery will be in proportion to their respective interests. Were this not so, the door would be open to the grossest frauds by one joint-owner against all other joint-owners." 13 O. G. 637 (637); 3 McCrary, 206 (206); 3 Bann. & A. 253 (254).

That an owner infringes if he uses or sells as to the right of his co-owner, see *Pitts v. Hall* (1854), 3 Blatch. 201.

That one co-owner cannot sue his co-owner for infringement by using the patented invention, see *Aspinwall Mfg. Co. v. Gill* (1887) 32 Fed. Rep. 697.

§ 914. ¹ That an assignor may become liable to his assignee for an infringement, see *Onderdonk v. Fanning* (1880), 4 Fed. Rep. 148; 5 Bann. & A. 85.

the grantee is a stranger outside the limits of such territory ; and each may thus invade the other's rights by any of the usual methods of infringement.² When the effect of the grant is to make them territorial co-owners, their liabilities to each other for acts performed within such territory are the same as those of other co-owners of a patent.

§ 915. Infringement by Licensees.

A license transfers an interest in the invention and estops the licensor from interfering with the enjoyment of such interest by asserting his monopoly against the licensee. If the license is an express license, the rights of the licensee and the estoppel against the licensor are defined by its specific terms. If the license is implied, the duties and obligations of the parties are defined by law.¹ No license can convey an interest in the invention or work an estoppel unless the licensor was an owner of the patent at the time the license was granted. While acting under his license, and within the scope of the interest it confers, the licensee does not infringe the patent, and on a failure to perform his own part of the agreement is liable only to an action on the contract in the local courts.² If the license is granted on conditions, it affords no protection to the licensee unless the conditions are fulfilled, though late authorities declare that it must be rescinded by agreement, or by a decree in equity, before an action for infringement by

² That a grantor reserving the right to use is not guilty of infringement by such use, see *Hobbie v. Smith* (1886), 27 Fed. Rep. 656.

That a grantee infringes by making outside his territory for use outside it, see *American Paper Barrel Co. v. Laraway* (1886), 37 O. G. 674 ; 28 Fed. Rep. 141.

That a sale of patented articles in the ordinary course of business beyond the territory of the grantee by his vendee is an infringement, see *Hatch v. Adams* (1884), 29 O. G. 776 ; 22 Fed. Rep. 434.

§ 915. ¹ As to the nature of a license and the reciprocal rights and duties of licensors and licensees, see §§ 806-834 and notes, *ante*, and §§ 979, 1044, 1243-1252, and notes, *post*.

That the scope of an implied license to make and sell is fixed by the circumstances out of which the license arises, see *Montross v. Mabie* (1887), 30 Fed. Rep. 234 ; 41 O. G. 931.

² That a party acting under a license is not an infringer, and is only liable for fees, not in United States courts for infringement, see *Kelly v. Porter* (1883), 17 Fed. Rep. 519 ; 8 Sawyer, 482.

acts done under color of the license can be maintained.³ A licensee repudiating the license, or abandoning it, or claiming his right against the licensor on other grounds, forfeits the privilege which it confers and can no longer set up its estoppel against the licensor.⁴ Notwithstanding the existence of a license, therefore, the apparent licensee will be in reality a stranger to the patent, and will be guilty of infringement by any act of manufacture, use, or sale, if the license were originally invalid, or through his default never took effect, or being once effective has now ceased to operate.

§ 916. Infringement by a Licensee under an Express License.

A licensee, having an express license, infringes by the practice of any other patented invention than the one covered by his license, or by employing that in any other manner than

³ That licensees under conditions infringe unless they fulfil the conditions, see *Steam Cutter Co. v. Sheldon* (1872), 5 Fisher, 477; 10 Blatch. 1.

That the use of the licensed invention beyond the limits of the license and against the reserved rights of the licensor is an infringement, see *Chambers v. Smith* (1870), 5 Fisher, 12.

That where a licensee had the option to use during the extension upon paying new fees, he will be an infringer if he uses without first exercising his option and paying the new fees, see *England v. Thompson* (1869), 3 Clifford, 271.

That a licensee may be sued for an infringement if his license were rescinded by a notice to that effect given in the mode prescribed by the license itself, see *Hammacher v. Wilson* (1886), 26 Fed. Rep. 239; 36 O. G. 233.

That a licensor cannot sue his licensee for infringement upon a failure to pay royalties unless the license contains a clause of forfeiture, see *Consolidated Middlings Purifier Co. v. Wolf* (1886), 28 Fed. Rep. 814; 37 O. G. 567.

That though it is agreed in a license that it is to be void in a certain event,

and that the licensee may then be treated as an infringer, the license must be annulled by a separate proceeding in equity before a suit for infringement can be brought, see *Adams v. Meyrose* (1881), 7 Fed. Rep. 208; 2 McCrary, 360.

⁴ That a licensee abandoning his license, or defending on other grounds, forfeits its protection, see *Bell v. McCullough* (1858), 1 Fisher, 380; 1 Bond, 194.

That a licensee having repudiated his license may be treated as an infringer, and his license will be no defence, see *Hat Sweat Mfg. Co. v. Porter* (1888), 34 Fed. Rep. 745; *Cohn v. National Rubber Co.* (1878), 3 Bann. & A. 568; 15 O. G. 829; *Moody v. Taber* (1874), 5 O. G. 273; *Holmes*, 325; 1 Bann. & A. 41.

That a licensee making the licensor's invention under a different name, must pay the agreed license fees, and if he repudiates the license may be sued as an infringer, see *Starling v. St. Paul Plough Works* (1887), 41 O. G. 318; 32 Fed. Rep. 290.

his license specifies.¹ If he appropriates a different invention belonging to his licensor, whether protected by the same or by a different patent, and not essential to the enjoyment of the licensed invention;² or if he makes, or sells, or uses inventions of his own or of some other patentee which in themselves are infringements of the one that he is licensed to employ;³ or if he performs an act in reference to the licensed invention which his license does not authorize, as by selling or using under a license to manufacture only;⁴ or if he per-

§ 916. ¹ That a licensee acting outside his license is an infringer, see *Fetter v. Newhall* (1883), 17 Fed. Rep. 841; 25 O. G. 502; 21 Blatch. 445; *Wood v. Wells* (1873), 6 Fisher, 382; *Goodyear v. Providence Rubber Co.* (1864), 2 Clifford, 351; 2 Fisher, 499.

That a licensee merely refusing to pay his royalties cannot be treated as an infringer, see *Seibert Cylinder Oil-Cup Co. v. Detroit Lubricator Co.* (1888), 34 Fed. Rep. 216.

That a licensee violating the terms of his license by doing acts not authorized thereby, at once infringes the patent and breaks his contract, see *Pope Mfg. Co. v. Owsley* (1886), 27 Fed. Rep. 100; 37 O. G. 781.

That a licensee infringes if he exceeds the number of patented articles covered by his license, see *Aspinwall Mfg. Co. v. Gill* (1887), 32 Fed. Rep. 697.

That the covenants in a license cannot deprive the licensee of the right to show that his acts do not infringe, see *White v. Lee* (1882), 23 O. G. 1621; 14 Fed. Rep. 789.

² That a license under one patent affords no protection against another, see *Stuart v. Shantz* (1872), 6 Fisher, 35; 2 O. G. 524; *Blanchard v. Puttnam* (1869), 8 Wall. 420.

That a plaintiff may recover for the infringement of one Claim of a patent though the defendant is licensed under other Claims, and though his infringement is accomplished by using the li-

icensed inventions, see *United Nickel Co. v. California Electrical Works* (1885), 11 Sawyer, 250; 25 Fed. Rep. 475.

That the license to make an article described in the patent does not protect the licensee if he makes one different from the one described, see *Miller's Falls Co. v. Ives* (1877), 14 O. G. 203; 14 Blatch. 169; 2 Bann. & A. 574; *Magic Ruffle Co. v. Elm City Co.* (1875), 8 O. G. 773; 13 Blatch. 151; 2 Bann. & A. 152.

That a licensee authorized to sell materials, to be used in a patented process, to the licensees of such process, infringes by selling to others who are known not to be licensees, see *Willis v. McCullen* (1886), 29 Fed. Rep. 641; 38 O. G. 1017.

³ That if the licensee practices his own infringing invention under cover of the license, he is an infringer, see *Miller's Falls Co. v. Ives* (1877), 14 O. G. 203; 14 Blatch. 169; 2 Bann. & A. 574.

That under a license to use six or more of the patented machines upon certain conditions, the licensee using one under the patent and five under an infringing patent infringes as to the five, see *Steam Cutter Co. v. Sheldon* (1872), 5 Fisher, 477; 10 Blatch. 1.

⁴ That a license to use does not give the right to make or sell, see *Aiken v. Manchester Print Works* (1865), 2 Clifford, 435. See also §§ 812, 827, and notes, *ante*.

forms the licensed act outside the territory or the period for which his license has been granted;⁵ or in any other way exceeds the power conferred upon him,— he is guilty of infringement.⁶ Where a license is assignable, the assignee rests under the same limitations as the original licensee, and may infringe the patent by the same modes of action.⁷ A licensee may infringe not only by his own personal misappropriation of the patented invention, but through the agency of any others who unlawfully practise it with his consent.⁸

⁵ That where a license permits use in only one place it is an infringement to use elsewhere, see *Steam Cutter Co. v. Sheldon* (1872), 5 Fisher, 477; 10 Blatch. 1.

That a licensee, having a right to sell the product of the patented device only in the section where made, infringes by selling outside it, see *Wilson v. Sherman* (1850), 1 Blatch. 536.

That a licensee to sell within certain territory infringes if he sells in that territory to those who he knows will sell outside it, see *Hatch v. Hall* (1887), 30 Fed. Rep. 613; 40 O. G. 1342.

That a licensee practising the invention after his license has expired is an infringer, see *Wetherill v. Passaic Zinc Co.* (1872), 9 Phila. 385; 6 Fisher, 50; 2 O. G. 471.

That the use of two machines in succession under a license to use one is an infringement, see *Bloomer v. Gilpin* (1859), 4 Fisher, 50.

⁶ That it is not an infringement to use a second time an article marked, "Licensed to use once only," see *American Cotton Tie Co. v. Simmons* (1878), 13 O. G. 967; 3 Bann. & A. 320.

Contra, *American Cotton Tie Co. v. Simmons* (1882), 106 U. S. 89; 22 O. G. 1976; *American Cotton Tie Supply Co. v. Bullard* (1879), 17 O. G. 389; 17 Blatch. 160; 4 Bann. & A. 520.

⁷ That where a license is assignable, the assignee is not an infringer, see *Wilson v. Stolly* (1849), 5 McLean, 1.

That a railroad company being licensed to use a device on their cars, the transfer of their rolling stock and revenues to a preferred creditor gives him the same right, he being the agent of the company and not a purchaser, and his use is not an infringement, see *Ernigh v. Chamberlain* (1861), 2 Fisher, 192; 1 Bissell, 367.

That an assignee of a license is under the same restrictions and subject to the same liabilities as the original licensee, see *Moody v. Taber* (1874), Holmes, 325; 1 Bann. & A. 41; 5 O. G. 273.

That under a personal and unassignable license to make and sell, the articles on hand at the death of the licensee may be sold by his representatives, see *Montross v. Mabie* (1887), 30 Fed. Rep. 234; 41 O. G. 931.

That an optional contract to purchase a patent does not operate as a license to the vendee's licensees to make infringing articles, see *Iowa Barb Steel Wire Co. v. Southern Barbed Wire Co.* (1887), 30 Fed. Rep. 615; 40 O. G. 578.

⁸ That a licensee infringes by an unlawful use of his machine by others with his consent, see *Steam Cutter Co. v. Sheldon* (1872), 5 Fisher 477; 10 Blatch. 1.

§ 917. Infringement by a Licensee under an Implied License.

A license is implied by law in various cases, its scope being determined by the nature of the circumstances from which it arose. A patentee who acquiesces in the practice of his invention by another person, receiving compensation or the promise of compensation therefor, or looking to a different source for his reward, cannot thereafter deny the right of such other person to practise the invention in the manner and to the extent established by this actual enjoyment.¹ The law here implies a license whose limits are indicated by the past conduct of the licensee as acquiesced in by the licensor, and in these cases acts outside such customary employment of the invention are infringements.² Again, a person who, before the patent has been issued, or before the grant of a re-issue or extension, has constructed the patented article for his own use with the permission of the patentee, acquires the right to use such article until it ceases to exist;³ though to replace

§ 917. ¹ That a long use, with the acquiescence of the patentee and an agreement to pay license fees, raises an implied license, see *Blanchard v. Sprague* (1859), 1 Clifford, 288.

That a patentee by taking compensation for the right to make, use, or sell the invention, impliedly licenses these acts and cannot enjoin them, see *Gilbert & Barker Mfg. Co. v. Bussing* (1875), 8 O. G. 144; 12 Blatch. 426; 1 Bann. & A. 621.

That where a patentee gave permission to the contractors for a city to use an invention, saying to them that he would look to the city for his royalty, the city received an implied license and was not liable for any royalty, see *Rigelow v. City of Louisville* (1869), 3 Fisher, 602.

That an absolute release *in presenti* to an infringer, and a contract by him to pay royalties for past infringements in pursuance of such release, relieves him from accountability for practising the invention in future, except as to the

royalties, until the release is set aside, see *Seibert Cylinder Oil-Cup Co. v. Detroit Lubricator Co.* (1888), 34 Fed. Rep. 216; *Loercher v. Crandall* (1881), 11 Fed. Rep. 872; 21 O. G. 863; 20 Blatch. 106.

² A license by acquiescence in the practice of an invention rests either in implied contract or in estoppel. That in both cases the limits of the license are determined by the conduct of the parties, under the ordinary principles governing estoppels and implied agreements, and any use of the invention beyond these limits has the same legal aspect as an infringing use by an express licensee, see *Montross v. Mabie* (1887), 30 Fed. Rep. 234; 41 O. G. 931; also § 834 and notes, *ante*.

³ That a person who with the consent of the inventor has constructed the invention before the patent issued, may use it after the patent is granted, see Sec. 4899, Rev. Stat.; *Wade v. Metcalf* (1889), 129 U. S. 202; *Brickill v. Mayor of New York* (1880), 18 O. G.

it with another, or to make such repairs upon it as practically amount to reconstruction, is infringement.⁴ Again, an employee by applying his invention to the business of his employers and annexing it to their apparatus, or otherwise incorporating it into their property, confers on them a license to enjoy it which neither he nor his subsequent assignees can revoke.⁵ This license gives to the employers a right to use

463 ; 7 Fed. Rep. 479 ; 18 Blatch. 273 ; 5 Bann. & A. 544 ; also § 831 and notes, *ante*, and §§ 979, 1044 and notes, *post*.

That a person who has constructed the invention under a defective patent with the consent of the inventor, may employ it after a re-issue, see §§ 698, 699, 831 and notes, *ante*.

That a person who has constructed the invention during the original term, by consent of the inventor, may use it during an extension, see *Wooster v. Sidenberg* (1875), 10 O. G. 244 ; 13 Blatch. 88 ; 2 Bann. & A. 91 ; *Wood v. Michigan Southern & Northern Indiana R. R. Co.* (1868), 3 Fisher, 464 ; 2 Bissell, 62.

See also § 831, 843 and notes, *ante*.

That where a patentee had publicly authorized all persons to use his invention, in connection with certain others, one who did this under the original term may use up, during the extension, whatever he had on hand at the end of the term, see *Wooster v. Sidenberg* (1875), 13 Blatch. 88 ; 2 Bann. & A. 91 ; 10 O. G. 244.

That the use of the patented invention with impunity, before the patent was amended, does not work a license to use it, see *Howe v. Williams* (1863), 2 Fisher, 395 ; 2 Clifford, 245.

That an unauthorized use under a defective patent confers no license to use under an amended one, see *McWilliams Mfg. Co. v. Blundell* (1882), 11 Fed. Rep. 419 ; 22 O. G. 177 ; *Stimpson v. Westchester R. R. Co.* (1846), 4 How. 380 ; 2 Robb. 335.

⁴ That under Sec. 7, act of 1839, and

the act of 1870, the license is to use only the precise thing after patent which was made or purchased before it, and to make and use others is infringement, see *Brickill v. Mayor of New York* (1880), 18 O. G. 463 ; 7 Fed. Rep. 479 ; 18 Blatch. 273 ; 5 Bann. & A. 544.

That the act of 1839, protecting the use of inventions which were used before the patent, does not cover the whole patented invention, but only such parts of it as were in use, see *Brickill v. Mayor of New York* (1880), 7 Fed. Rep. 479 ; 18 Blatch. 273 ; 18 O. G. 463 ; 5 Bann. & A. 544.

That though an assignee of the original term may use the articles constructed during the term after the extension, he has no implied license to make them for any purpose, see *Wood v. Michigan Southern & Northern Indiana R. R. Co.* (1868), 3 Fisher, 464 ; 2 Bissell, 62.

⁵ That an employer has an implied license to use such inventions of his employee as were by the latter applied to the business of the former during the term of employment, see *Herman v. Herman* (1886) 37 O. G. 892 ; 29 Fed. Rep. 92 ; *Whiting v. Graves* (1878) 13 O. G. 455 ; 3 Bann. & A. 222 ; *Continental Windmill Co. v. Empire Windmill Co.* (1871), 8 Blatch. 295 ; 4 Fisher 428.

See also §§ 832, 833 and notes, *ante*.

That where a partner patents a design and applies it to articles made in the business of the firm, the firm may use the design until the partnership is dissolved, and after dissolution may sell by receiver or otherwise the articles on

the invention in the manner in which their employee, the inventor, has applied it, and until it is no longer capable of use. But to rebuild it, or supply its place with others of the same character, or to appropriate it to different uses, are acts beyond their implied authority and are infringements of the patent. Finally, the purchaser of a patented article from one who had a right to sell it, or who, having sold it wrongfully, has compensated the owner of the patent for the injury inflicted by the wrongful sale, has an implied license to use it for any purpose and in any place until it is destroyed, unless the terms of his purchase have otherwise provided.⁶ But such a licensee cannot reconstruct the article, nor procure and use a new one in its stead, nor, if the purchase be restricted by conditions, use it in violation of his contract, without committing an infringement.⁷ These are the principal cases in which a license is implied, and the tests of infringement em-

hand containing such design, see *Mon-tross v. Mabie* (1887) 30 Fed. Rep. 234 ; 41 O. G. 931.

⁶ That the purchaser of a patented material without restrictions, from one who had a right to sell it, may use it for any purpose, see *Metropolitan Washing Mach. Co. v. Earle* (1861), 2 Fisher, 203 ; 3 Wall. Jr. 320.

See also §§ 824, 826 and notes, *ante*.

That such purchaser may use the article in any place, see *Roosevelt v. Western Electric Co.* (1884), 20 Fed. Rep. 724 ; 28 O. G. 812.

That a purchaser of articles with knowledge of prior grants cannot use the articles within the granted territory, see *Sheldon Axle Co. v. Standard Axle Works* (1889), 37 Fed. Rep. 789.

That a purchaser of articles cannot sell them in the way of trade in another's exclusive territory, see *Standard Folding Bed Co. v. Keeler* (1889), 37 Fed. Rep. 693.

See also §§ 824, 826 and notes, *ante*.

That a purchaser from an infringing seller acquires no license to use, see *Gilbert & Barker Mfg. Co. v. Bussing*

(1875), 8 O. G. 144 ; 12 Blatch. 426 ; 1 Bann. & A. 621.

See also §§ 824-830 and notes, *ante*.

That a purchaser from a licensee, who has previously repudiated his license, acquires no right to use if he knew of such repudiation, see *Moody v. Taber* (1874), 1 Bann. & A. 41 ; Holmes, 325 ; 5 O. G. 273.

That a purchaser from a wrongful seller, who has compensated the owner of the patent for the wrongful sale, has an implied license to use, see *Steam Stone Cutter Co. v. Sheldon* (1884), 22 Blatch. 484 ; 21 Fed. Rep. 875 ; *Allis v. Stowell* (1883), 16 Fed. Rep. 783 ; *Gilbert & Barker Mfg. Co. v. Bussing* (1875), 8 O. G. 144 ; 12 Blatch. 426 ; 1 Bann. & A. 621 ; *Eunson v. Dodge* (1873), 18 Wall. 414 ; 5 O. G. 95.

See also §§ 829, 830 and notes, *ante*.

That a vendee, under an unlawful but subsequently legalized sale, may himself resell, see *Alabastine Co. v. Richardson* (1886), 26 Fed. Rep. 620 ; 35 O. G. 1225.

⁷ That his implied license to use gives the purchaser no right to rebuild,

ployed in these will furnish a sufficient guide for cases of less frequent occurrence.

§ 918. Infringement by Common Carriers.

A common carrier may participate in the infringing acts of others by aiding in their perpetration or in securing their unwarranted reward.¹ Thus if he conspires with an infringing manufacturer of the invention to transport his products to a market though beyond the limits of the United States, or with

see *Gottfried v. Philip Best Brewing Co.* (1879), 17 O. G. 675; 5 Bann. & A. 4.

See also § 827 and notes, *ante*.

That the purchaser's license does not authorize him to replace the purchased articles with new ones, see *Aiken v. Manchester Print Works* (1865), 2 Clifford, 435.

See also § 825 and notes, *ante*.

§ 918. ¹ In *American Cotton Tie Supply Co. v. McCready* (1879), 17 O. G. 565, Blatchford, J.: (567) "It is contended for the defendants that the steamship company, as it acts solely in the capacity of common carrier of these ties, does not come within the meaning of the statute as an infringer of the patents; that it has nothing to do with the rights of the plaintiff or the invasion of those rights by others; that it does not use or aid others in using the ties, because such use cannot be had until after transportation and delivery; that the company, by transporting the ties, does not sell them to others to be used, or aid in selling them to others to be used; that as a common carrier the company is bound to receive and carry all goods offered by any person; that it would be against public policy to restrain the company; that it would impede its business and inflict injury on the whole community; that the suit is improperly brought against the defendants, and should be brought against the company; that the defend-

ants are only officers of the company, with distinct duties, and have no control over the goods and no power to refuse to receive them; that the company ought not to be compelled, at its own expense, to protect the plaintiff's business; and that it owes no duty to the plaintiff to answer for the diligence which the plaintiff ought to use in the protection of its own interests. It is entirely clear that the owners of the infringing and unlicensed cotton ties, who are causing them to be transported by the vessels of the Old Dominion Steamship Company, are sending them for sale and use, and are employing said company and its officers as agents and servants in promoting and effecting such sale and use. It would seem, on principle, that there ought to be no difficulty in restraining by injunction all persons, whether officers of a corporation or not, who are aiding in the promotion of the infringing sale and use, whether such persons would be liable for profits or damages or not. It has been so held by this court. (*Goodyear v. Phelps*, 3 Blatch. C. C. R. 91; *Poppenhusen v. Falke*, 4 Blatch. 493)." 17 Blatch. 291 (298); 4 Bann. & A. 588 (595).

That a steamship company transporting infringing articles, after due notice from the patentee, act as an agent of the infringer, and are liable to injunction unless they disclose the names of the shipper, see *American Cotton Tie*

persons who desire to use or sell the invention in violation of the patent to procure it and deliver it to them, he makes himself an agent in the wrong and is responsible as a direct infringer. Whether he is accountable for the injury resulting to the patentee from the infringing manufacture, use, or sale, and if so in what measure, is not yet determined, though he thereby subjects himself to the restraining process of a court of equity. But in these cases the assistance given must have been wilful and collusive; for service rendered in the ordinary course of business and without illegitimate intent is merely a fulfilment of his duty, and does not make him liable for wrongs committed through his means by shippers or consignees.

§ 919. Infringement by Contractors.

The obligations under which a private individual may rest, either to other individuals or to the public, do not authorize him to practise any patented invention without permission from the patentee, even though his obligations were created in ignorance of the existence of the patent.¹ A contractor, in

Supply Co. v. McCready (1879), 17 O. G. 565; 17 Blatch. 291; 4 Bann. & A. 588.

That importation and transshipment by custom-house agents of the importers, having no possession nor control of the infringing articles, does not make them liable for infringement, see Nobel's Explosives Co. v. Jones (1881), L. R. 17 Ch. D. 721; 8 App. Cas. 5.

§ 919. ¹ In *Jacobs v. Commissioners of Hamilton Co.* (1862), 4 Fisher, 81, Leavitt, J.: (85) "There can be no question that if the contractor, in the fulfilment of his obligation, violates the patent-right of another, he is answerable for the infringement. He cannot defend himself against the claim of the patentee by asserting that he committed the wrong under a contract with the county commissioners. It was his own folly to have imposed on himself such an obligation, and he alone is

responsible for the injury which another may sustain as the consequence. If he had foreknowledge that the work he had bound himself to perform involved an infringement of a patent-right, it was his business to have procured a license for the use of the improvement; and, failing to do so, he takes on himself the responsibility of a violation of the patent. If he entered into the contract in ignorance of the fact that the work he has agreed to do would violate a patent-right, he is not therefore protected from liability. This fact may have a bearing on the question of the amount of damages to be recovered, but does not destroy the right of action by the injured party. And it is no answer to this view of the subject that cases may occur in which the patentee may fail in the enforcement of his just rights by the insolvency or irresponsibility of the contractor. This is an incident,

entering into an agreement to perform certain services or supply certain articles, assumes the risk of being prevented from the fulfilment of his contract by the assertion of the rights of some unknown patentee; and if he violates those rights he cannot screen himself under the duty which he owes to others. Where the public are interested in the fulfilment of the contract the remedies applied may be less peremptory than where the individual contractor or his promisee are alone concerned, and the completion of the contract may be permitted, leaving the patentee to seek his compensation from the contractor after his contract obligations are discharged;² but this lenity is not extended on account of the contractor, who in some form of remedy is compelled to pay the full penalty of his infringement.

§ 920. Infringements by Agents, and Workmen.

Agents who, of their own volition, participate in an infringing act thereby become infringers, although in the performance of the act itself they have no pecuniary interest.¹ No act of a mere agent is infringement, unless it would be such if personally perpetrated by his principal.² But salesmen selling on commission, and other servants who derive a distinct and independent benefit from their invasions of the patent, incur a separate liability upon their own account, as well as in the capacity of employees.³ A workman acting

often connected with cases of legal liability, which can have no influence upon the application of known and settled legal principles. Such a result may be a great misfortune to a losing party, but cannot furnish a reason for casting responsibility upon another party not legally chargeable with it." 1 Bond, 500 (504).

² That a contractor may be allowed to finish a work of importance to the public, though enjoined as to all other uses of the invention, see § 1200 and notes, *post*.

§ 920. ¹ That a sale by a salesman having no interest in the sale is an in-

fringement, see *Potter v. Crowell* (1866), 3 Fisher, 112; 1 Abbott, 89.

That an accommodation partner, who takes no part in the business and allows his co-partner to receive all its benefits, is liable as joining in and inducing the infringement and may be sued alone or jointly with the active infringer, see *American Bell Telephone Co. v. Albright* (1887), 32 Fed. Rep. 287.

² That unless the parties who are primarily liable infringe, those who are secondarily liable do not, see *Bigelow v. City of Louisville* (1869), 3 Fisher, 602.

³ In *Steiger v. Heidelberger* (1880), 4 Fed. Rep. 455, Blatchford, J. : (457)

under orders and exercising no choice as to the objects upon which his energies are expended does not infringe by manufacturing or using patented inventions.⁴

§ 921. Infringement by Private Individuals.

All private individuals who voluntarily engage in the unauthorized manufacture, use, or sale of the patented invention, whether by itself or as a part of some more comprehensive instrument or operation, are guilty of infringement.¹ Neither the motive prompting the infringing act, nor the knowledge of his own wrong-doing on the part of the offender, are elements to be considered.² Where a specific intent is necessary

“As to the first branch of the plea, or the first plea, whichever it may be, . . . the plea must be overruled. The substance of it is that the defendant is not liable in this suit for what the plea sets forth as having been done by him. This is not so. The plea shows that the defendant has made a separate and independent profit to himself out of the sale of such goods as he has been instrumental in selling, by receiving a commission thereon, in which commission Loeb & Schoenfeld have no interest; that his commission is dependent on the sales; that he has made the sales for the purpose of receiving the commission; and that he obtains the commission by making the sales. This is a distinct profit from any profits made by Loeb & Schoenfeld. The commission to this defendant would not be included in any profits to be accounted for by Loeb & Schoenfeld, and such commission is a direct profit to this defendant from the sale of the goods. Moreover, this defendant, although selling only under the circumstances set forth, is liable to be restrained in this court by an injunction from selling the infringing goods, and this suit is properly brought against him for that purpose. This court has obtained jurisdiction over his person. The plaintiff has a

right to restrain the defendant, by injunction, from participating in the way set forth in such sales, although a bill will also lie against Loeb & Schoenfeld to restrain them from participating in the way they do in the same sales (*Malthy v. Boto*, 14 Blatch. 53).” 18 O. G. 1463 (1463); 18 Blatch. 426 (428).

⁴ That workmen, having no option, do not infringe by obeying orders, see *Young v. Foerster* (1889), 37 Fed. Rep. 203; *United Nickel Co. v. Worthington* (1882), 23 O. G. 939; 13 Fed. Rep. 392; *Heaton v. Quintard* (1869), 7 Blatch. 73; *Delano v. Scott* (1834), Gilpin, 489; 1 Robb, 700.

That a son acting under his father cannot be sued for infringement if he has no interest in the business, see *McDonald v. Whitney* (1885), 24 Fed. Rep. 600; 32 O. G. 1465.

That a father may be liable for the infringements of a minor son in his employ, see *Dunks v. Grey* (1880), 3 Fed. Rep. 862; 5 Bann. & A. 634.

§ 921.¹ That the voluntary maker is an infringer though he is employed by another to do so, see *Bryce v. Dorr* (1845), 3 McLean, 582; 2 Robb, 302.

² That knowledge and intent are immaterial, see § 901 and notes, *ante*.

That ignorance of the patent does

to constitute the infringing act, it must of course be present, but otherwise the exterior action is alone regarded.³ The injury to the patentee and not the moral guilt of the infringer is the basis and the measure of responsibility, and though the infringer were a lunatic the rights and remedies of the patentee would be the same.⁴

§ 922. Infringement of a Patent for a Combination.

In applying the foregoing propositions to the different classes of inventions, the fundamental distinction between combinations and simple inventions must be first considered. A combination is a group of instruments or operations united under a co-operative law. Its identity depends upon the presence in the combination of each one of these elements or its equivalent, and upon their co-operation in this specific manner to produce the ultimate result. Hence any change in the number of its elements, or in their essential character, or in their mode of co-operation, is a departure from the substance of the combination, and constitutes a different invention. A patented combination is the combination described and claimed in the patent which protects it. Of whatever elements it may actually be composed and whatever may be the method of their union as the inventor conceived and practises his invention, the elements specified in the patent, and the co-operative law there prescribed, are those which characterize the patented combination and form the subject of the exclusive privileges of the patentee.¹ The infringement of a combination-patent

not excuse, see *Royer v. Coupe* (1886), 29 Fed. Rep. 358; 39 O. G. 239.

³ That a specific intent to infringe may qualify acts otherwise innocent, see § 901 and notes, *ante*, and § 924 and notes, *post*.

⁴ That a lunatic may infringe and be liable for profits and costs, see *Avery v. Wilson* (1884), 20 Fed. Rep. 856.

§ 922. ¹ That the patentee of a combination cannot aver that any one of its claimed elements is useless and may be dispensed with, see *Rowell v. Lindsay* (1881), 6 Fed. Rep. 290; 19

O. G. 1565; 10 Bissell, 217; *Coolidge v. McCone* (1874), 5 O. G. 458; 2 Sawyer, 571; 1 Bann. & A. 78; *Westlake v. Cartter* (1873), 6 Fisher, 519; 4 O. G. 636; *Vance v. Campbell* (1861), 1 Black, 427; and §§ 278, 282, 527, 670, and notes, *ante*.

That the courts cannot decide that any element in a combination is immaterial, but merely whether an omitted part is supplied by an equivalent, see *Water Meter Co. v. Desper* (1879), 101 U. S. 332.

That if an inventor regards an ele-

therefore, consists in the manufacture, use, or sale of any combination in which precisely the same elements or their equivalents are united under the same co-operative law.² To make or use or sell a combination in which the same elements are differently combined,³ or a combination which comprises only a portion of these elements, though the discarded elements are practically useless, and though the combination thus created was suggested by the former, is not an infringement.⁴

ment as material, those who claim under him cannot assert that it is immaterial, see *Lo Fever v. Remington* (1882), 13 Fed. Rep. 86; 22 O. G. 1537; 21 Blatch. 80.

² That a combination is infringed when the same elements and plan of co-operation are employed, see *Dederick v. Cassell* (1881), 9 Fed. Rep. 306; 20 O. G. 1233; 14 Phila. 503.

That a combination is infringed if equivalents are used, see *Dederick v. Whitman Agricultural Co.* (1886), 36 O. G. 570; 26 Fed. Rep. 763; *Wheeler v. Morris* (1886), 36 O. G. 822; 26 Fed. Rep. 918; *Reyn v. Raynor* (1884), 26 O. G. 1111; 22 Blatch. 13; 19 Fed. Rep. 308; *Mundy v. Lidgerwood Mfg. Co.* (1884), 20 Fed. Rep. 114; 27 O. G. 718; and § 254 and notes, *ante*.

That a combination is not infringed by a union of different mechanical devices accomplishing the same result, see *Good v. Bailey* (1887), 41 O. G. 935; 33 Fed. Rep. 42.

³ That a different combination of the same elements is not an infringement, see *Pattee v. Moline Plow Co.* (1881), 9 Fed. Rep. 821; 22 O. G. 173; 10 Bissell, 377; *Byam v. Eddy* (1853), 2 Blatch. 521; 24 Vt. 666.

That a change of arrangement may be infringement, see *Belle Patent Button Fastener Co. v. Lucas* (1886), 37 O. G. 1004; 28 Fed. Rep. 371.

⁴ In *Rowell v. Lindsay* (1881), 6 Fed. Rep. 290, Dyer, J.: (297) "It follows, therefore, from these state-

ments of the law, that if the defendants omit entirely one of the elements of the complainants' combination without substituting any other, or if they substitute another which is new, or which performs a substantially different function, or if it is one that is old, but was not known at the date of the complainants' patent as a proper substitute for the omitted ingredient, or if their machine consists in a new combination of the same ingredients, then the defendants do not infringe." 19 O. G. 1565 (1567); 10 Bissell, 217 (225).

Further, that the use of less than all the elements of a combination does not infringe a patent for the combination alone, see *Byerly v. Cleveland Linseed Oil Works* (1887), 31 Fed. Rep. 73; *Thoens v. Israel* (1887), 31 Fed. Rep. 556; *Newark Mach. Co. v. Hargett* (1886), 36 O. G. 692; 28 Fed. Rep. 567; *Newark Mach. Co. v. Gaar* (1886), 37 O. G. 1250; 29 Fed. Rep. 322; *Tobey Furniture Co. v. Colby* (1885), 34 O. G. 1276; 26 Fed. Rep. 100; *Rowell v. Lindsay* (1885), 113 U. S. 97; 31 O. G. 120; *Saladee v. Racine Wagon & Carriage Co.* (1884), 20 Fed. Rep. 685; 27 O. G. 1133; *Sharp v. Reissner* (1883), 23 O. G. 1530; 15 Fed. Rep. 919; *Doane & Wellington Mfg. Co. v. Smith* (1882), 24 O. G. 302; 15 Fed. Rep. 459; *Goss v. Cameron* (1882), 14 Fed. Rep. 576; 11 Bissell, 389; 23 O. G. 741; *Hammerschlag v. Garrett* (1882), 21 O. G. 1199; 10 Fed. Rep. 479; *Fuller v. Yentzer* (1876), 94 U. S. 238; 11

To select the most available elements in two distinct patented combinations, and unite them in a third, does not invade the

O. G. 551 ; *Sands v. Wardwell* (1869), 3 Clifford, 277 ; *Case v. Brown* (1862), 2 Fisher, 268 ; 1 Bissell, 382 ; *Singer v. Walmsley* (1860), 1 Fisher, 558 ; *Byam v. Eddy* (1853), 2 Blatch. 521 ; 24 Vt. 666 ; *Foster v. Moore* (1852), 1 Curtis, 279 ; *Evans v. Eaton* (1816), Peters C. C. 322 ; 1 Robb, 68 ; and other cases cited in § 282, note 1, *ante*.

That a combination is not infringed unless all its elements, as they are claimed, are used, whether they are essential or not, see *Royer v. Schultz Bolting Co.* (1886), 38 O. G. 898 ; 28 Fed. Rep. 850.

That a combination is not infringed by the use of less than all its elements unless the elements used were new and patentable to the same inventor, see *Thoens v. Israel* (1887), 31 Fed. Rep. 556.

That a combination is not infringed if one of its elements is omitted where the omitted element performs a function of its own not discharged by the remaining elements, see *Tobey Furniture Co. v. Colby* (1885), 26 Fed. Rep. 100 ; 34 O. G. 1276.

That a patent for a combination of old elements is not infringed by using less than all the elements, where the two combinations are not the same in operation, see *Faurot v. Hawes* (1880), 3 Fed. Rep. 456.

That a Claim for a combination of three elements is not infringed by the use of two only, though the third is useless, for the patentee must stand by his Claim, see *Coolidge v. McCone* (1874), 5 O. G. 458 ; 2 Sawyer, 571 ; 1 Bann. & A. 78.

That it is no infringement to use less than all the elements of a combination, though nearly all the material parts of the alleged infringing device were suggested by the other, see *Snow v. Lake Shore & Mich. Southern R. R.*

Co. (1883), 18 Fed. Rep. 602 ; 25 O. G. 1280.

That a combination is not infringed where one essential element is omitted and another is substituted accomplishing the same result in a different way, see *Schmidt v. Freese* (1882), 21 O. G. 1876 ; 12 Fed. Rep. 563.

That a combination of old elements is not infringed by substituting a new element not known at the date of the patent, see *Rowell v. Lindsay* (1881), 6 Fed. Rep. 290 ; 19 O. G. 1565 ; 10 Bissell, 217 ; *American Bell Telephone Co. v. Spencer* (1881), 8 Fed. Rep. 509 ; 20 O. G. 299.

That the combination may be infringed though some of the elements now used were unknown at the date of the patent, see *Potter v. Stewart* (1881), 19 O. G. 997 ; 7 Fed. Rep. 215 ; 18 Blatch. 561. For an explanation of the principle on which this doctrine rests, see § 256, note 2, *ante*.

That the substitution of a new element in a combination makes it a different combination, not an infringement, see *Babcock v. Judd* (1883), 15 Fed. Rep. 160 ; *Babcock v. Judd* (1880), 1 Fed. Rep. 408 ; 17 O. G. 1351 ; 5 Bann. & A. 127. This can be true only where the old combination loses its identity by the substitution of the new element.

That a combination is not infringed by using certain of its elements in connection with others which are not equivalents for those omitted, see *Archer v. Arnd* (1887), 31 Fed. Rep. 475 ; 40 O. G. 1032.

That a combination is not infringed where the elements used by the defendant will not make the patented combination in a practical form, see *Gray v. Bangs* (1887), 40 O. G. 812 ; 31 Fed. Rep. 342.

That where a Claim covers several

rights of either patentee.⁵ But where the patented combination is employed, either alone or with improvements or as an element in a new combination, the patent which protects it is infringed.⁶ A useless combination, although patented in violation of the law, is not patentable subject-matter, and if appropriated by one who so improves or adds to it as to produce a useful combination, he may practise it or patent it as his own invention.⁷

§ 923. Infringement of a Patent for a Combination : Unauthorized Use of its Elements and Sub-combinations.

A patent claiming a combination only does not protect the elements of which it is composed.¹ If these are old, they are

old parts and one new part, it is not infringed if the new part is not used, see *Bragg v. Fitch* (1887), 121 U. S. 478 ; 39 O. G. 829.

⁵ That where two patents for combinations are both assigned to the same person, his rights are not infringed by a combination distinct from either, but containing elements of both, see *Washburn & Moen Mfg. Co. v. Griesche* (1883), 16 Fed. Rep. 669 ; 5 McCrary, 246.

That a patent for a combination and a process is not infringed by the use of part of each, see *Howe v. Abbott* (1842), 2 Story, 190 ; 2 Robb, 99.

That Claims for a method and a combination are not infringed by a different method and fewer elements, see *Goss v. Cameron* (1882), 23 O. G. 741 ; 14 Fed. Rep. 576 ; 11 Bissell, 389.

⁶ That the use of a patented invention as an element in a new combination is an infringement, see *Cleveland v. Towle* (1869), 3 Fisher, 525.

That the use of a combination in a different machine from that in which it was first described is an infringement, see *La Rue v. Western Electric Co.* (1886), 28 Fed. Rep. 85 ; 36 O. G. 453.

That to use the entire patented com-

bination is an infringement though some of its details may be improved, see *White v. Heath* (1882), 22 O. G. 500 ; 10 Fed. Rep. 291 ; *Foster v. Moore* (1852), 1 Curtis, 279.

That where an element in a combination is improved, and yet performs the same functions in the same way, the use of the combination is an infringement, see *Potter v. Stewart* (1881), 19 O. G. 997 ; 7 Fed. Rep. 215 ; 18 Blatch. 561.

⁷ That to use a useless patented combination as part of a new one is not infringement, the old patent being invalid, see *Bliss v. Brooklyn* (1873), 3 O. G. 269 ; 6 Fisher, 289 ; 10 Blatch. 521.

That the addition to a combination of an element which alone makes it an operative combination, and the use of the whole so constituted, is not an infringement, see *Robertson v. Hill* (1873), 6 Fisher, 465 ; 4 O. G. 132.

As to various points concerning identity, equivalence, etc., in combinations, see §§ 156, 241, 242, 254, 256, 267, 268, 277-282, and notes, *ante*.

§ 923. ¹ That a combination is not infringed unless used as an entirety, see *Fuller v. Yentzer* (1876), 94 U. S. 288 ; 11 O. G. 551.

already the property of the public ; if they are new inventions of the patentee, his failure to claim them is a concession, so far as this patent is concerned, that they are old.² It has indeed been sometimes stated that a combination-patent covers such of its elements and sub-combinations as are original with the patentee, but this opinion is not consistent with the strictness of the rules which require the inventor to distinctly claim whatever the patent is intended to secure.³ The rea-

² That unless claimed as new in the patent, the elements of a combination are regarded as old, see *Rowell v. Lindsay* (1881), 6 Fed. Rep. 290 ; 19 O. G. 1565 ; 10 Bissell, 217.

³ In *Lee v. Blandy* (1890), 2 Fisher, 89, Leavitt, J. : (93) " There are two classes or kinds of combinations recognized by our Patent Laws, which are properly the subject of a patent. The first may be defined to be one in which all the parts were before known, and where the sole merit of the invention consists in such an arrangement of them as to produce a new and useful result ; or where, by adopting parts of a machine which may have been known for ages, an inventor has succeeded in making such an arrangement of them as that they produce a result never before obtained, and have in that point of view the merit of originality, and are, therefore, patentable. There is another class of combinations, where some of the parts or elements of the combination are new, and their invention claimed, but where they are used in combination with parts or elements that were known before. It is well settled that a patent may be obtained for the first class of combinations, but it is a principle well recognized that there is no infringement unless the party has used all the elements. If the combination consists of A, B, C, — three mechanical structures long known, — and if the party sued has only the parts B, C, and not A, he is not regarded as

an infringer ; he must use all to subject himself to liability. If the combination have the other character to which I have referred, being, to a certain extent, new, but embracing some old parts or elements, then there is an infringement by the use of that part which is new and the invention of the patentee." 1 Bond, 361 (365).

In *Moody v. Fiske* (1820), 2 Mason, 112, Story, J. : (117) " Where the patent goes for the whole of a machine as a new invention, and the machine is in its structure substantially new, any person who pirates a part of the machine, substantially new in its structure, deprives the inventor so far of his exclusive right in his invention, and may in a great measure destroy the value of the patent. Where the patent is for several distinct improvements in an existing machine, or for an improved machine, incorporating several distinct improvements which are clearly specified, then if a person pirates one of the improvements, he violates the exclusive right of the patentee, for the patent is as broad as the invention, and the invention covers all the improvements ; and it is a wrong done to the patentee to deprive him of his exclusive right in any of his improvements. Where a patent is for a new combination of existing machinery or machines, and does not specify or claim any improvements or invention except the combination, unless that combination is substantially violated the paten-

sonable and generally acknowledged doctrine recognizes that elements and sub-combinations, being inventions entirely distinct from the combination into which they enter, must be separately claimed in order to make their appropriation an infringement of the patent.⁴

tee is not entitled to any remedy, although parts of the machinery are used by another, because the patent, by its terms, stands upon the combination only. In such a case proof that the machines, or any part of their structure, existed before forms no objection to the patent, unless the combination has existed before, for the reason that the invention is limited to the combination. And yet if the combination itself be not wholly new, but up to a certain point has existed before and the patentee claims the whole combination as new instead of his own improvements only, as by taking out a patent for the whole machine, doubtless his patent is void, for it exceeds his invention. But if there be different and distinct improvements constituting parts of the combination, which are specified as such in the patent and specification, and any one of them be pirated, the same rule seems to apply as in other cases where part of an invention is pirated, for the patent then shows that the invention is not limited to the mere combination but includes the particular improvements specified." 1 Robb, 312 (317).

See also *Thoens v. Israel* (1887), 31 Fed. Rep. 556; *Rowell v. Lindsay* (1881), 6 Fed. Rep. 290; 19 O. G. 1565; 10 Bissell, 217; *Holly v. Vergennes Mach. Co.* (1880), 18 O. G. 1177; 4 Fed. Rep. 74; 18 Blatch. 327; *Sharp v. Tiffit* (1880), 2 Fed. Rep. 697; 17 O. G. 1282; 18 Blatch. 132; 5 Bann. & A. 399; *Adair v. Thayer* (1880), 4 Fed. Rep. 441; 17 Blatch. 468; 5 Bann. & A. 118.

Although the foregoing cases are

often referred to as authorities for the position that a patent for a combination embraces such new elements and sub-combinations as are due to the same inventor's creative acts, yet in some of them, if not in all, the Claims of the patent were actually construed to cover the subordinate parts as well as the entire combination, and thus made the patent one for the elements as well as for the combination. In that view these cases are really in harmony with the proper and generally accepted rule.

⁴ In *McCormick v. Manny* (1855), 6 McLean, 539, McLean, J. : (547) "A patent which claims mechanical powers or things in combination, is not infringed by using a part of the combination. To this rule there is no exception."

In *Barrett v. Hall* (1818), 1 Mason, 447, Story, J. : (474) "In the next place, a patent may be for a new combination of machines to produce certain effects; and this, whether the machines constituting the combination be new or old. But in such case, the patent being for the combination only, it is no infringement of the patent to use any of the machines separately, if the whole combination be not used; for in such case the thing patented is not the separate machines, but the combination; and the statute gives no remedy, except for a violation of the thing patented. This was the doctrine of Mr. Justice Washington in his most able opinion in *Evans v. Eaton*; and it has not been in the slightest degree shaken in the Supreme Court. I hesitate not one moment in adopting it, as established on solid foundations. It has indeed

§ 924. Infringement of a Patent for a Combination: Unauthorized Use of Part of the Combination.

The acts by which a combination-patent is infringed thus involve the making, use, or sale of the complete combination. A combination is complete when all its elements, with their connecting parts, are finished ready to be united. But here, as elsewhere, the specific intent may supply in some degree the place of the exterior act. To make or sell a single element with the intent that it shall be united to the other elements, and so complete the combination, is infringement.¹

been said, that where there is a patent for the whole of a machine, whoever imitates it, either in whole or in part, is subject to an action at the suit of the patentee. But supposing this doctrine to be true in any case and under any qualifications (which may well be doubted), it can apply only where the whole machine is entirely new, and cannot apply where the patent is limited, by its very terms, to the combination of several machines." 1 Robb, 207 (235).

In *Evans v. Eaton* (1816), Peters C. C. 322, Washington, J.: (346) "If the plaintiff is not the inventor of the parts, he has no right to complain that they are used, if not in a way to infringe his right to their combined use. If he is the original inventor of the different machines constituting the whole discovery, or any of them, he might have obtained a separate patent for those of which he was the original inventor; in which case, the objections stated would not have been in his way." 1 Robb, 68 (94).

See also §§ 527, 670-672, and notes, *ante*.

That a combination-patent containing a Claim for each element is infringed by the use of any one element alone, see *Henderson v. Cleveland Co-operative Stove Co.* (1877), 12 O. G. 4; 2 Bann. & A. 604.

§ 924. ¹ In *Saxe v. Hammond* (1875),

7 O. G. 781, Shepley, J.: (782) "Different parties may all infringe by respectively making or selling, each of them, one of the elements of a patented combination, provided those separate elements are made for the purpose and with the intent of their being combined by a party having no right to combine them. But the mere manufacture of a separate element of a patented combination, unless such manufacture be proved to have been conducted for the purpose and with the intent of aiding infringement, is not, in and of itself, infringement." Holmes, 456 (459); 1 Bann. & A. 629 (632).

In *Barnes v. Straus* (1872), 2 O. G. 62, Blatchford, J.: (64) "The pair of springs of the patent—that is, the two springs connected by the clasps—constitutes, as a whole, a patentable combination. The two springs and the clasps connecting them are all required to make the article as a 'corset-spring' at all useful in performing the functions which it performs when the springs are actually combined by the clasps when the corset is worn. The combination does not have its full effects developed until it is in the corset. Yet it exists, *pro tanto*, so as to be an infringement, when the springs and clasps are made, ready to be inserted in a corset." 5 Fisher, 531 (536); 9 Blatch. 553 (558).

In *Wallace v. Holmes, Booth, & Haydens* (1871), 1 O. G. 117, Woodruff,

But to sell elements suitable for several different patented combinations does not make the vendor a partaker in the in-

J.: (122) "The rule of law invoked by the defendants is this: that where a patent is for a combination merely, it is not infringed by one who uses one or more of the parts, but not all, to produce the same results either by themselves or by the aid of other devices. This rule is well settled, and is not questioned in the trial. The rule is fully stated by Chief Justice Taney in *Prouty et al. v. Ruggles et al.*, 16 Peters, 341, and in other cases cited by the counsel: *Ryan v. Fearn*, 1 Curtis, 265; *Foster v. Moore*, 1 Curtis, 292; *Vance v. Campbell*, 1 Black, 427; *Godfrey v. Eames*, 1 Wallace, 79. But I am not satisfied that this rule will protect the defendants. If, in actual concert with a third party, with a view to the actual production of the patented improvement in lamps, and the sale and use thereafter, they consented to manufacture the burner, and such other party to make the chimney, and in such concert they actually make and sell the burner, and he the chimney, each utterly useless without the other, and each intended to be used and actually sold to be used with the other, — it cannot be doubtful that they must be decreed to be joint infringers of the complainants' patent. It cannot be that when a useful machine is patented as a combination of parts, two or more can engage in its construction and sale, and protect themselves by showing that, though united in an effort to produce the same machine, sell, and bring it into extensive use, each makes and sells one part only which is useless without the other, and still another person, in precise conformity with the purpose in view, puts them together for use. If it were so, such patents would indeed be of little value. In such cases all are tort-feasors, engaged in a common pur-

pose to infringe the patent, and actually, by their concerted action, producing that result. . . . Here the actual concert with others is a certain inference, from the nature of the case, and from the distinct efforts of the defendants to bring the burner in question into use, — which can only be done by adding the chimney. The defendants have not, perhaps, made an actual pre-arrangement with any particular person to supply the chimney to be added to the burner, but every sale they make is a proposal to the purchaser to do this, and his purchase is a consent with the defendants that he will do or cause it to be done. The defendants are therefore active parties to the whole infringement, consenting and acting to that end, manufacturing and selling for that purpose." 5 Fisher, 37 (46); 9 Blatch. 65 (75).

See also, *Maynard v. Pawling* (1880), 18 O. G. 244; 3 Fed. Rep. 711; 5 Bann. & A. 551; *Richardson v. Noyes* (1876), 10 O. G. 507; 2 Bann. & A. 398; *Coolidge v. McCone* (1874), 1 Bann. & A. 78; 2 Sawyer, 571; 5 O. G. 458; *Renwick v. Pond* (1872), 5 Fisher, 56^o; 2 O. G. 392; 10 Blatch. 39.

That to divide a device into two parts, and so sell it to be combined by the user, is an infringement, see *Strobridge v. Lindsay* (1881), 6 Fed. Rep. 510; 19 O. G. 1285.

That a sale of the materials of a patented combination with an intent that the purchaser should combine them is an infringement, see *Bowker v. Dows* (1878), 15 O. G. 510; 3 Bann. & A. 518.

That to make and sell part of a combination, with intent that it be used in connection with the other parts, is infringement, and such intent may be inferred when the part sold is appar-

fringement of any one of them in which it may eventually be used, unless he and the infringer were in concert with each other.²

§ 925. Infringement of a Patent for an Art.

An art is an invention distinct alike from the apparatus by which it is practised and the product in which it results, and hence, if patented, it can be infringed neither by making and selling the one nor by the sale and use of the other.¹ The infringement of a patented art consists only in the performance of all the acts of which it is composed or their equivalents, in the manner and in the order in which they are claimed in the patent.² If one of the steps claimed as essen-

ently capable of no other use, see *Schneider v. Pountney* 1884), 29 O. G. 84; 21 Fed. Rep. 399.

² That the seller of parts of a patented combination which are also useful in other connections does not infringe unless acting in concert with others, see *Bliss v. Merrill* (1887), 42 O. G. 97; *Maynard v. Pawling* (1880), 18 O. G. 244; 3 Fed. Rep. 711; 5 Bann. & A. 551; *Saxe v. Hammond* (1875), 7 O. G. 781; *Holmes*, 456; 1 Bann. & A. 629.

That it is not an infringement to make and sell elements which are useful in various combinations though the seller may expect them to be used in the patented combination, see *Millner v. Schofield* (1881), 4 Hughes, 258.

See also §§ 900, 903, and notes, *ante*.

§ 925. ¹ That the purchaser of the product of a process does not infringe the process, see *Brown v. District of Columbia* (1884), 3 Mackey, 502.

That where there are three patents, one for a machine, the second for a process, and the third for a product, and the machine patent first expires, the use of the machine may infringe the patent for the process or the product, see *McKay v. Dibert* (1881), 5 Fed. Rep. 587; 19 O. G. 1351. But see

McKay v. Jackman (1882), 12 Fed. Rep. 615; 22 O. G. 85; 20 Blatch. 466.

That identity of product shows identity of process, *prima facie*, where both are new, see *Pickhardt v. Packard* (1884), 30 O. G. 179; 23 Blatch. 23; 22 Fed. Rep. 530.

² That to use a patented process to perform part of an act which it usually performs entirely is infringement, see *Eames v. Andrews* (1887), 122 U. S. 40; 39 O. G. 1319; *Andrews v. Eames* (1883), 15 Fed. Rep. 109; 23 O. G. 1123.

That the use of an invention involving a patented process is a continuing infringement, see *Beedle v. Bennett* (1887), 122 U. S. 71; 39 O. G. 1326.

That the sale of materials to be used in an infringing process is infringement, see *Willis v. McCollin* (1886), 38 O. G. 1017; 29 Fed. Rep. 641.

That a patent for a process arriving at a known result is not infringed by another process attaining the same result, see *Anilin v. Levinstein* (1883), L. R. 24 Ch. D. 156.

That the use of a patented process is an infringement whether or not the infringer made or set up the apparatus, see *Andrews v. Cross* (1881), 8 Fed.

tial is omitted, and its place is left unsupplied, or if for it is substituted a step which the patentee intended to avoid, or if the succession of the acts is changed in any material degree, the identity of the invention practised with the patented invention is destroyed and the former is not an infringement.³ In that class of arts which express the idea of a force directed through the process upon a specific object, and thus involve the material to be treated as an essential element, the performance of the acts described in reference to other objects or materials is not infringement.⁴

Rep. 269 ; 19 O. G. 1705 ; 19 Blatch. 294.

That whenever one avails himself of another's patented discovery and process an infringement exists, see *American Bell Telephone Co. v. Dolbear* (1883), 15 Fed. Rep. 448 ; 23 O. G. 535.

That a patent for a process is infringed though an equivalent is used, see *Kimball v. Hess* (1883), 15 Fed. Rep. 393 ; 26 O. G. 107.

That when a patent describes a composition for producing a certain effect in a process, but does not give its ingredients as essential nor claim them, the process is infringed by the use of any equivalent composition, see *Johnson v. Willimantic Linen Co.* (1866), 33 Conn. 436.

That a patent for a process is infringed only where the same mode of reaching the result is followed as is described in the specification, see *Royer v. Chicago Mfg. Co.* (1884), 20 Fed. Rep. 853.

³ That a process is infringed only when every step claimed as essential is used, see *Arnold v. Phelps* (1884), 29 O. G. 538 ; 20 Fed. Rep. 315 ; *Hammerschlag v. Garrett* (1882), 10 Fed. Rep. 479 ; 21 O. G. 1199 ; 15 Phila. 474.

That a patent for a process is not infringed by the use of all except the first and last steps, all the steps used

being well known, see *Heller v. Bauer* (1884), 19 Fed. Rep. 96.

That a process omitting a patented step, and including a step which the patentee intended to avoid, is not an infringement, see *Cotter v. New Haven Copper Co.* (1882), 13 Fed. Rep. 234 ; 23 O. G. 740.

That a patent for a process and a combination is not infringed by the use of part of the combination and part of the process, see *Howe v. Abbott* (1842), 2 Story, 190 ; 2 Robb, 99.

That a process may be infringed though the order of the steps is varied, where the order is not essential, see *Hammerschlag Mfg. Co. v. Bancroft* (1887), 40 O. G. 1339 ; 32 Fed. Rep. 585.

That a process consisting in doing certain acts at a certain stage of events is not infringed by doing the same acts at a different stage, see *Boneless Fish Co. v. Roberts* (1882), 12 Fed. Rep. 627.

That a process may be infringed though its mode of use is varied, see *Cary v. Wolff* (1885), 32 O. G. 257 ; 24 Fed. Rep. 139 ; 23 Blatch. 92.

⁴ That where a process and its material both enter into an invention there is no infringement unless both are used, see *Goodyear Dental Vulcanite Co. v. Davis* (1880), 102 U. S. 222 ; 19 O. G. 543.

§ 926. Infringement of a Patent for a Machine.

A machine is a mode of operation permanently embodied in tangible materials. The *modus operandi*, or structural law of the mechanism, is the essence of the invention, and its identity is never lost while this remains. Differences in its form and construction, in the number and relation of its parts, and in the uses to which it may be adapted, are all compatible with the preservation of this essential characteristic. A patented machine is thus infringed by any other which embodies the same structural law.¹ It is immaterial whether it resembles the patented invention in appearance or in the nature and arrangement of its different members, or whether it is less perfect or more perfect, or serves the same or additional purposes, or employs the same parts or equivalent ones, — if the structural law of the patented machine is found oper-

§ 926. ¹ In *Foss v. Herbert* (1856), 2 Fisher, 31, Drummond, J. : (36) “An infringement of a patent takes place whenever a party avails himself of the invention of the patentee without such variation as will constitute a new discovery. A man may improve a patented machine so as to entitle him to a patent for his improvement, but that will not give him a right to use the invention of the first patentee without his license. A machine is an infringement of another if it incorporate in its structure and operation the substance of the invention, — that is, by an arrangement of mechanism which performs the same service, or produces the same effect, in the same way, or substantially the same way. Mere colorable alterations, or adroit evasions by substituting one mechanical equivalent for another in the combination which constitutes the machine, should never be allowed to protect a party.” 1 Bissell, 121 (126).

In *Sickels v. Borden* (1856), 3 Blatch. 535, Nelson, J. : (541) “However different, apparently, the arrangements and combinations of a machine

may be from the machine of the patentee, it may in reality embody his invention, and be as much an infringement as if it were a servile copy of his machine. According to the Patent Law, if the machine complained of involves substantial identity with the one patented, it is an infringement. If the invention of the patentee be a machine, it is infringed by a machine which incorporates, in its structure and operation, the substance of the invention, — that is, an arrangement which performs the same service, or produces the same effect, in the same way, or substantially the same way.”

Further, that a machine patent is infringed by every machine which operates under the same structural law, see *Cantrell v. Wallick* (1886), 117 U. S. 689 ; 35 O. G. 871 ; *Grier v. Castle* (1883), 17 Fed. Rep. 523 ; 24 O. G. 1176 ; *Brett v. Quintard* (1882), 10 Fed. Rep. 741 ; 20 Blatch. 320 ; *Waterbury Brass Co. v. Miller* (1871), 5 Fisher, 48 ; 9 Blatch. 77 ; *Cahoon v. Ring* (1861), 1 Clifford, 592 ; 1 Fisher, 397.

That a machine whose mode of

ating unchanged in the other, the latter is an infringement.³ An act of infringement is committed by the manufacture of the machine though it is never used or sold, the intent to put it to the practical use for which it is designed being inferred from its construction.³ The use of the machine in any manner or for any beneficial purpose is infringement, and where one of several co-owners of an infringing machine operates it with their consent the infringing act is theirs as well as his.⁴

operation is substantially different does not infringe, see *Schmidt v. Freese* (1882), 12 Fed. Rep. 563 ; 21 O. G. 1876 ; *Brett v. Quintard* (1882), 10 Fed. Rep. 741 ; 20 Blatch. 320.

That a particular device is infringed only by a copy thereof, see *Singer v. Walmsley* (1860), 1 Fisher, 558.

That a machine intended to be different does not infringe merely because it may be forced to operate like the patented machine, see *Buzzell v. Andrews* (1885), 34 O. G. 830 ; 25 Fed. Rep. 822.

That a machine patent is not infringed by the use of a different machine for the same purpose, see *Opinion Atty. Gen.* (1873), 14 Op. At. Gen. 209.

² That the structural law being the same, differences in form are of no consequence, see *Grier v. Castle* (1883), 17 Fed. Rep. 523 ; 24 O. G. 1176 ; *Brett v. Quintard* (1882), 10 Fed. Rep. 741 ; 20 Blatch. 320 ; *Dederick v. Cassell* (1881), 14 Phila. 503 ; 9 Fed. Rep. 306 ; 20 O. G. 1233 ; *Potter v. Wilson* (1860), 2 Fisher, 102.

That a machine may infringe although it is less perfect, see *Pitts v. Wemple* (1855), 2 Fisher, 10 ; 1 Bissell, 87.

That the use of the substantial features of a machine is an infringement, though certain parts are omitted or equivalents are used, see *Wheeler v. Clipper Mower & Reaper Co.* (1872), 2 O. G. 442 ; 10 Blatch. 181 ; 6 Fisher,

1 ; *Waterbury Brass Co. v. Miller* (1871), 5 Fisher, 48 ; 9 Blatch. 77 ; *Rich v. Close* (1870), 4 Fisher, 279 ; 8 Blatch. 41 ; *Foss v. Herbert* (1856), 2 Fisher, 31 ; 1 Bissell, 121 ; *Wyeth v. Stone* (1840), 1 Story, 273 ; 2 Robb, 23.

That a patent covering two machines is infringed by the use of either one of them, see *Wyeth v. Stone* (1840), 1 Story, 273 ; 2 Robb, 23.

That on the question as to the infringement of a machine, attention is to be directed to the parts which do the work, not to matters of construction, see *Holly v. Vergennes Mach. Co.* (1880), 18 O. G. 1177 ; 4 Fed. Rep. 74 ; 18 Blatch. 327.

³ That it is an infringement to make a patented machine though it is neither used nor sold, see *Butz Thermo Electric Regulator Co. v. Jacobs Electric Co.* (1888), 45 O. G. 833 ; *Bloomer v. Gilpin* (1859), 4 Fisher, 50.

⁴ That a machine capable of serving two uses, at the option of its user, is an infringement on the same device intended for one use only, though it has been improved, see *Holbrook v. Small* (1876), 10 O. G. 508 ; 2 Bann. & A. 396.

That where one runs an infringing machine owned by himself and two others, all claiming under a patentee who was previously enjoined, all are infringers, see *Woodworth v. Edwards* (1847), 3 W. & M. 120 ; 2 Robb, 610.

The sale of the machine is also an infringement; but neither the use nor the sale of its manufactured products violates the patent unless the user or the seller are in collusion with the infringing operator of the machine.⁵

§ 927. Infringement of a Patent for a Manufacture.

The essential characteristics of a manufacture are not capable of any accurate general statement. They are embraced in the idea of means which the inventor has conceived and expressed in the article itself, and are in each case to be determined by an examination of its effects, its functions, and its method of performing them. Notwithstanding the difficulty of ascertaining it, however, its real nature is as definite and exact as any other species of invention, and any variation in its necessary attributes involves the loss of its identity. A patented manufacture is infringed by the making, use, or sale of any manufacture which possesses the same essential characteristics, although in other qualities the inventions may be totally dissimilar.¹ The method of producing the infringing manufacture is not important, the article being the same though made by a different process or machine.² Its use or

⁵ In *Boyd v. McAlpin* (1844), 3 McLean, 427, *per Curiam*: (429) "A sale of the product of the machine is no violation of the exclusive right to use, construct, or sell the machine itself. If, therefore, the defendant has done nothing more than purchase the bedsteads from Brown, who may manufacture them by an unjustifiable use of the patented machine, still the person who may make the purchase from him has a right to sell. The product cannot be reached, except in the hands of one who is in some manner connected with the use of the patented machine." 2 Robb, 277 (279).

See also *Goodyear v. Railroad* (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

That where a manufacture is in the market, purchasers are not obliged to find out whether it was made by a patented machine or a patented pro-

cess, see *Goodyear v. Railroad* (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

§ 927. ¹ That the patent for a manufacture is infringed by the use or the sale of it, see *Goodyear v. Railroad* (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

That a patented hotel register is infringed by the landlord who uses it, see *Hawes v. Washburn* (1872), 5 O. G. 491; *Hawes v. Cook* (1872), 5 O. G. 493; *Hawes v. Gage* (1871), 5 O. G. 494.

That the use of equivalents in a manufacture is an infringement, see *Singer v. Walmsley* (1860), 1 Fisher, 558.

² That a patent for a manufacture is infringed in whatever way the article is made, see *Celluloid Mfg. Co. v. American Zylonite Co.* (1887), 40 O. G. 1453; 30 Fed. Rep. 437; *Anilin v. Hamilton Mfg. Co.* (1878), 13 O. G.

sale may be restricted or extensive and for the same or other purposes than those intended by the inventor, since in every use of which it is capable it still belongs to him.³

§ 928. **Infringement of a Patent for a Composition of Matter.**

A composition of matter is a true combination whose elements are the ingredients of which it is composed, and whose co-operative law determines the mode in which each ingredient operates upon the others to develop the properties that characterize the finished composition. Two compositions are identical when they possess the same or equivalent ingredients, united together in the same manner to produce the same result.¹ If one of these compositions is protected by a patent the other will infringe it, whether or not it is prepared by the same process or is known in the market by the same appellation;² though where a composition is patented as the product

273 ; 3 Bann. & A. 235 ; Woodward v. Morrison (1872), 2 O. G. 120 ; Holmes, 124 ; 5 Fisher, 357.

That where a product is patented as the result of a certain process it is infringed only when made by that process, see Van Camp v. Maryland Pavement Co. (1888), 43 O. G. 884 ; Cochran v. Anilin (1884), 111 U. S. 293 ; 27 O. G. 813.

That where a patent covers an article only when made of certain materials it is not infringed by the same article made of different materials, see Western & Wells Mfg. Co. v. Rosenstock (1887), 30 Fed. Rep. 67 ; 41 O. G. 354.

That a patent for a new result is infringed by any process producing that result, see Anilin v. Levinstein (1883), L. R. 24 Ch. D. 156.

That identity of product is *prima facie* evidence of identity of process where both are new, see Pickhardt v. Packard (1884), 30 O. G. 179 ; 23 Blatch. 23 ; 22 Fed. Rep. 530.

³ That a valid patent for a fabric is infringed by any one who uses the fabric in any manner or degree, see

Celluloid Mfg. Co. v. Chrolithion Collar & Cuff Co. (1885), 23 Blatch. 205 ; 23 Fed. Rep. 397 ; 31 O. G. 519.

§ 928. ¹ That the use of chemical equivalents, though better, is an infringement, see Woodward v. Morrison (1872), 2 O. G. 120 ; Holmes, 124 ; 5 Fisher, 357.

That a patent for a composition of matter is infringed if the new element does the same thing as the one for which it is substituted, though otherwise it is different, see Woodward v. Morrison (1872), 2 O. G. 120 ; Holmes, 124 ; 5 Fisher, 357.

That a composition of matter is not infringed, if elements are substituted producing different results, see Smith v. Murray (1886), 27 Fed. Rep. 69 ; 36 O. G. 1045.

² That a composition of matter is infringed by making, using, or selling the same composition though made by a different process, see Woodward v. Morrison (1872), 2 O. G. 120 ; Holmes, 124 ; 5 Fisher, 357.

That a patent for the composition of old ingredients is not infringed by the

of a specific process the patented composition is not appropriated unless the prescribed process is employed.⁸ A patented composition is infringed not only by its unauthorized manufacture, but also by its wrongful use or sale.

§ 929. Infringement of a Patent for a Design.

A design is an appearance presented to the eye, and created by imposing upon physical substances some peculiar shape or ornamentation. Two designs are identical when they appear to be the same to the eye of an ordinary observer, though the lines or images of which they are formed are seen, on close inspection, to be different.¹ Design-patents are infringed by the same acts which violate the rights of other patentees, — the making, use, or sale of the physical substance bearing the design being the manufacture, use, or sale of the design itself. Where the physical substance is a patented invention of another class, the same act may thus violate the rights of different patentees and render the infringer liable for double compensation.

use or sale of any one of them, see *Geis v. Kimber* (1888), 444 O. G. 108.

⁸ That where a patent claims a process and the composition as made by that process, the same composition, if made by a different process, is not an infringement, see *Van Camp v. Maryland Pavement Co.* (1888), 43 O. G. 884; *Dittmar v. Rix* (1880), 1 Fed. Rep. 342; 17 O. G. 973; 5 Bann. & A. 240.

§ 929. ¹ In *Miller v. Smith* (1880), 18 O. G. 1047, Clifford, J. : (1048) "Speaking in the general sense, it is doubtless true that the test of infringement in respect to the Claims of a design-patent is the same as in respect to a patent for an art, machine, manufacture, or composition of matter; but it is not essential to the identity of the design that it should be the same to the eye of an expert. If in the eye of an ordinary observer, giving such at-

tention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer and sufficient to induce him to purchase one supposing it to be the other, the one first patented is infringed by the other." 5 Fed. Rep. 359 (365).

See also *Ex parte Gerard* (1888), 43 O. G. 1235; *Dreyfus v. Schneider* (1885), 25 Fed. Rep. 481; *Tomkinson v. Willetts Mfg. Co.* (1884), 23 Fed. Rep. 895; 31 O. G. 918; 32 O. G. 382.

That a patent for a design is infringed by copying a part thereof, if that part is covered by the patent, see *Dryfoos v. Friedman* (1884), 18 Fed. Rep. 824; 21 Blatch. 563.

That a design may be infringed though a different name be given it, see *Perry v. Starrett* (1878), 14 O. G. 599; 3 Bann. & A. 485.

§ 930. Infringement of a Patent for an Improvement.

An improvement is a development of the idea of means embodied in the original invention, and may relate to the entire idea or to one or more of its subordinate factors. Where it affects the whole invention its scope may be extensive and produce a great advancement in the art. Where it concerns only a single feature of the invention it is frequently confined within the narrowest limits. Its measure is found in the difference between the invention or the improved feature in its former state, and its condition since the improvement has been made. Applying to this difference the usual test, the improvement will be found to be that specific change in the invention or subordinate member by which its mode of operation in the performance of its functions is rendered more advantageous to the user. Other changes in the same part may have the same effect upon its mode of operation and be different improvements, but the essential attributes of this specific change belong to its inventor, and when protected by a patent are infringed by every other change which is substantially the same.¹ An improvement in an art can be infringed by practising the art in the peculiar manner discovered by the inventor of the improvement, but not by practising it in a different manner though the result of the two methods is the same. An improvement in an article can be infringed by making, using, or selling the improved device, but not by the appropriation of some different device improving the original invention in the same direction and to the same degree. An improver acquires thereby no right to practise the original invention, nor is the original inventor entitled to the use of the improvement.²

§ 930. ¹ For a discussion of the nature and scope of an improvement, see §§ 210-218, 307-313, and notes, *ante*.

That one improvement does not infringe a patent for a different one, see *Seymour v. Osborne* (1869), 3 Fisher, 555.

² That neither the original patentee nor the improver can employ the inven-

tion of the other, see *Cantrell v. Wallick* (1886), 117 U. S. 689; 35 O. G. 871; *Robertson v. Blake* (1876), 94 U. S. 728; 11 O. G. 877; *Fales v. Wentworth* (1872), 2 O. G. 58; *Holmes*, 96; 5 Fisher, 302; *Whipple v. Baldwin Mfg. Co.* (1858), 4 Fisher, 29; *Pitts v. Wemple* (1855), 6 McLean, 558.

That the improvement infringes the original though it gives the invention

SECTION III.

OF INFRINGEMENT: REMEDY AT LAW.

§ 931. Remedy for Infringement at Law : Action on the Case.

Prior to the Act against Monopolies (21 Jac. I., c. 3) the remedy for an infringement of the rights conferred by letters-patent was administered in the court of Star Chamber under its general jurisdiction over all offences not covered by the common or the statute law.¹ By that Act, however, it was provided that violations of such patents as were thereafter to be lawful should be redressed according to the common law and not otherwise, — thus bringing the infringement of a patent within that class of wrongs which had immemorially been remedied by the courts of ordinary jurisdiction.² Being a tort involving consequential damage only to the patentee, the form of action applicable to it was trespass on the case, through which from that time to the present the injured party has pursued his remedy at law.³

all its value, see *Gray v. James* (1817), *Peters C. C.* 476 ; 1 *Robb*, 140.

And though it has superseded the original in the trade, see *Turrell v. Spaeth* (1878), 14 *O. G.* 377 ; 3 *Bann. & A.* 458.

§ 931. ¹ That infringements of patent rights were cognizable in the Star Chamber, see 3 *Inst.* 183 ; *Godson*, 175 ; *Coryton*, 262. That the reason for this jurisdiction seems rather to reside in the unwillingness of the courts of common law to protect the owners of monopolies than in their inability to extend relief, see *Darcy v. Alleyn* (1602), *Noy*, 173 ; *Clothworkers of Ipswich* (1615), *Godbolt*, 252 ; both which were cases in King's Bench, where the patents were defeated, and the validity of letters-patent, except for new inventions, was denied. The Stat. Jac. I. not so much conferred jurisdiction over

infringements on the courts of common law as it abolished the jurisdiction of the royal tribunal and made that of the common law courts exclusive.

² Stat. 21 Jac. I., c. 3, Sec. 2. "And be it further declared . . . that all monopolies . . . letters-patent, . . . and all other matters and things tending as aforesaid, and the force and validity of them and every of them, ought to be and shall be forever hereafter examined, heard, tried, and determined by and according to the common laws of this realm and not otherwise."

³ That the action at common law for the infringement of letters-patent was trespass on the case, see *Godson*, 176 ; *Coryton*, 266 ; and all the English cases prior to our act of 1790. In the act of 1790 this form of remedy was directly prescribed (Sec. 4), and the same provision has been repeated in all

§ 932. **Remedy at Law Insufficient: Equitable Jurisdiction Established.**

The redress afforded by an action at law consisting simply in an award of damages for past infringements was early found to be inadequate for the protection of the patentee. In most instances the wrong is a continuing one, not capable of complete redress in any single proceeding but requiring numerous successive suits as new grounds of action may arise. It is also in many cases a secret injury which the patentee can neither discover by any of the usual methods of investigation nor establish under the common rules of evidence. For these and other reasons, inherent in the nature of the injury, the aid of courts of equity was first invoked to prevent the continuance of the wrong by injunction, to compel the alleged infringer to disclose the character and extent of his supposed infringement, and to bestow such other special relief as might be necessary to secure to the plaintiff at law the entire vindication and protection of his rights.¹ The assistance of equity

subsequent statutes. (Rev. Stat., 1874, Sec. 4919.) See also *May v. Mercer Co.* (1887), 41 O. G. 815; 30 Fed. Rep. 246; *Stein v. Goddard* (1856), 1 McAllister, 82.

That no previous notice is needed in order to sue for an infringement, see *Ames v. Howard* (1833), 1 Sumner, 482; 1 Robb, 689.

That a contract stipulating for an arbitration before suit is binding, and a plaintiff must show that he has made all reasonable efforts to arbitrate, see *Perkins v. United States Electric Light Co.* (1883), 24 O. G. 204.

That State laws may require claims against a county for infringement to be presented and payment demanded before suit, see *May v. Buchanan Co.* (1886), 39 O. G. 120; 29 Fed. Rep. 469.

That a patentee will not be enjoined from suing at law when the bill for an injunction shows a good defence at law, see *Hapgood v. Hewitt* (1886), 119 U. S. 226; 37 O. G. 1247.

§ 932. ¹ Such was the stringency of the provision in the Stat. Jac. I. confining jurisdiction to the courts of common law, and the influence of the language of Lord Coke, 3 Inst. 181, expressly declaring that this provision excluded chancery jurisdiction, that for many years the aid of equity was not invoked, and when invoked was not accorded unless the patentee had already established his right in an action at law. See *Blanchard v. Hill* (1742), 2 Atk. 484. The earliest reported case in which equity afforded relief without a previous trial at law was *Hicks v. Raincock* (1783), 1 Abb. P. C. 23; 2 Dick. 647. In *Boulton v. Bull* (1796), 1 Abb. P. C. 97, the same position was taken, the issues of fact being tried on separate proceedings in the common law courts. For a discussion of the attitude of courts of chancery toward patent causes prior to A. D. 1800, see *Coryton*, 319, 320; *Godson*, 183.

in actions at law being thus shown to be not only effective but often indispensable, original proceedings were at length commenced in chancery by a petition for an injunction or discovery, and under the jurisdiction so obtained complete redress was given to the patentee, the aid of a court of law being sought only where issues of fact required the verdict of a jury.² The complicated and technical questions embraced in these issues frequently rendering them unfit for disposition by the common law tribunal, this last link between the two procedures was finally abandoned, and courts of equity assumed entire control over all actions instituted before them, thus giving to the injured patentee two distinct methods of redress,—an action at law upon the case for damages, and a bill in equity for an injunction, discovery, account, or any other relief to which he might in justice be entitled.³ These gradual changes have been effected partly by judicial, partly

² In *Harmer v. Plane* (1807), 1 Abb. P. C. 166, after the issue of an injunction restraining the defendant until the merits could be tried at law, a case was stated by the chancellor and sent to King's Bench for a disposition of the issues of fact arising on the prayer for an injunction. These issues were duly tried (see *Harmer v. Plane* (1809), 1 Abb. P. C. 171), and the decision certified to the chancellor for the final disposition of the cause. This practice was followed in *Manton v. Manton* (1815), 1 Abb. P. C. 189; *Wood v. Zimmer* (1815), 1 Abb. P. C. 202; *Cochrane v. Smethurst* (1816), 1 Abb. P. C. 228. In other cases the patentee was ordered to institute independent proceedings in the courts of law, and the injunction was continued, or a bond and account was ordered, until the verdict could be obtained. See also *Godson*, 187.

³ See *Coryton*, 321, etc. In *Wilson v. Tindal* (1841), 1 Web. 730, n., on an application for an injunction, Lord Langdale, M. R., treated the entire matter of a trial at law as within the

discretion of the court of chancery before which the petition for equitable relief was pending. He says: "It is not the right of parties in every case to have an action tried in a court of law; it is a question of convenience, and the court is to exercise a fair discretion. I have no doubt whatever of the competency of this court to grant an injunction *simpliciter*." In *Young v. Fernie* (1866), 1 App. Cas. 63; 33 L. J. Ch. 192; 35 L. J. Ch. 523, after a trial had been once ordered at law without final result, the cause was heard and determined in equity without a jury. In *Bovill v. Hitchcock* (1868), L. R. 3 Ch. App. 417, the court refused to allow a trial at law, and this refusal was on appeal sustained. In *Patent Marine Inventions Co. v. Chadburn* (1873), L. R. 16 Eq. 447, Lord Selborne refusing a jury states that causes involving questions of Patent Law are generally unfit for a jury trial, and are more properly disposed of by a single judge. These cases mark the gradual steps by which complete jurisdiction in equity has been acquired.

by legislative, action. In England after the courts of equity had asserted, and for a considerable period had exercised, their peculiar authority for the protection of the patentee, an act of Parliament conferred equity powers upon the courts of law in patent cases, enabling them to prevent future infringements by injunction and to compel defendants to make discovery of their alleged unlawful acts.⁴ In this country the earlier statutes provided only for an action on the case, but under these the courts of equity interfered by injunction and otherwise when the circumstances demanded it, until in 1819 another statute bestowed original jurisdiction as well in equity as at law upon the Federal courts over all patent cases, and opened both methods of relief to the patentee, as far as the nature of his injury required. This statute has been re-enacted with varied phraseology at different periods in the history of our patent-system, and in its present form permits the patentee to sue at law for damages in all cases of past infringement, invoking the aid of equity wherever it may be required, or to resort originally to equity if the redress to which he is entitled necessitates the exercise of chancery powers.⁵ The

⁴ 17 & 18 Vict. c. 125 (1854). Under this act, injunctions could be ordered by the common law court at any stage in the case, either before or after judgment; an inspection of books and infringing inventions could be compelled, and an accounting could be decreed.

⁵ Prior to the act of 1819 the only remedy afforded under the statutes of the United States was the common law action on the case. That the Federal courts possessed no original equity powers in patent cases where the parties to the suit were citizens of the same State was conceded, though in *Livingston v. Van Ingen* (1811), 1 Paine, 45, Livingston, J., doubted whether these courts could not, when necessary, exercise chancery jurisdiction in aid of actions at law. In *Isaacs v. Cooper* (1821), 4 Wash. 259; 1 Robb, 332, Washington, J., speaks of the practice of giving such aid as if it were frequent,

and within the ordinary operations of the court, while in *Sullivan v. Redfield* (1825), 1 Paine, 441; 1 Robb, 477, Thompson, J., discusses the act of 1819 and declares that it neither enlarges nor alters the powers of the court to interfere, as a court of equity, but simply extends its jurisdiction to patent cases where the citizenship of the parties is the same. Thus it would appear always to have been the doctrine in this country that equity powers might be appropriately exercised in aid of a suit at law, without reference to the question of original jurisdiction over patent causes themselves. Comparatively few of the cases occurring before 1840 were, however, instituted in courts of equity, perhaps because of the construction given to the act of 1819 by Thompson, J., in *Sullivan v. Redfield*, *ante*. But after the passage of the act of 1836, the provisions of that statute, though couched

principal practical differences between these two remedies reside in their modes of procedure, and in the rules by which the compensation awarded to the plaintiff for the injury sustained by the infringement is determined. In considering each in detail the action at law will be first discussed, including all those topics which are common to both remedies, except that of Injunctions, whose intricacy and importance merit for it a separate examination. In this discussion the following order will be pursued:—

- I. Jurisdiction of Courts.
- II. Parties.
- III. Process, Pleadings, and Evidence.
- IV. Trial and Verdict.
- V. New Trial, and Writ of Error.
- VI. Costs.

§ 933. Jurisdiction over Actions for Infringement in General.

Jurisdiction over all cases arising under the Patent Laws is, as we have seen, vested exclusively in the Federal courts. The acts of Congress have further limited this jurisdiction to

in language closely resembling that of 1819, were held to confer full equity powers upon the Federal courts, as courts of original jurisdiction, over all cases arising under the Patent Laws, and to give the patentee an option either to seek his legal redress in one tribunal or his equitable remedy in the other. Actions in equity then became more frequent, but in these, as in actions at law, resort to a jury was considered necessary to determine any issue of fact involving the matter of infringement. This was accomplished by a feigned issue, according to the usual course of chancery practice. See *Brooks v. Bicknell* (1843), 3 McLean, 250; 2 Robb, 118; *Brooks v. Bicknell* (1845), 4 McLean, 70. Such a trial was nevertheless regarded as within the discretion of the court, which might substitute therefor a hearing before a master (*Parker v. Hatfield* (1845), 4 McLean,

61), or even before the chancery judge himself (*Van Hook v. Pendleton* (1846), 1 Blatch. 187; *Woodworth v. Rogers* (1847), 3 W. & M. 135; 2 Robb, 625). These modes of proceeding were found especially convenient, since a trial by jury must take place in the same court and involve nearly the same labor on the part of the judge as would his personal investigation and decision of the issues. Hence the transition was easy and rapid from the more ancient and complex to the later and more simple method of ascertaining the facts in controversy, and together with the growing distrust of juries in intricate cases has resulted in the almost entire substitution of actions in equity for actions on the case in courts of law where equity jurisdiction can be claimed.

As to the limits of equity jurisdiction and the line dividing it from law, see §§ 1082-1097, and notes, *post*.

the Circuit courts, to District and Territorial courts endowed with Circuit court powers, and to the Supreme Court of the District of Columbia, with an appellate jurisdiction in the Supreme Court of the United States. Every action for the infringement of a patent, whether at law or in equity, must, therefore, be instituted in one of the Circuit courts of the United States or in one of these equivalent tribunals. In determining what particular Circuit court has jurisdiction of any individual case, the question of locality is of paramount importance. An action for damages for past infringements is not a local action, and any court of competent jurisdiction may hear and determine all the matters in controversy between the parties, and render a judgment upon which process in the nature of an execution or of an action of debt upon the record may issue for the collection of the damages awarded to the plaintiff. As all Circuit courts and their equivalent tribunals have jurisdiction over the subject-matter in such actions for past infringement, the particular court before which any given case should be brought must be that court whose local jurisdiction embraces the parties to the suit; and any Circuit court obtaining jurisdiction over these may thus take complete cognizance of all matters properly in issue in any action at law between them.¹ An action in equity, as will hereafter more fully appear, stands on somewhat different ground. For the enforcement of the orders and decrees which may be necessary in the prosecution of this remedy, a more direct and permanent control over the parties and the subject-matter may be required than is afforded by that general jurisdiction over the subject and that temporary jurisdiction over the parties, which are sufficient for the purposes of an action at law; and a particular Circuit court may thus decline to take cognizance of such proceedings in cases where a suit at law would be unhesitatingly entertained.² This dis-

§ 933. ¹ That an action at law may be brought in any district where the defendant can lawfully be served with process, see *Thompson v. Mendelsohn* (1871), 5 Fisher, 187; *Allen v. Blunt* (1849), 1 Blatch. 480.

² That an action in equity praying

for an injunction can be brought only in the district where the defendant resides or does business, or where the infringement takes place, see *Wilson Packing Co. v. Clapp* (1878), 8 Bissell, 154; 3 Bann. & A. 243; 13 O. G. 368; *Hodge v. Hudson River R. R. Co.* (1868), 3

tion must be kept in mind in examining the decisions upon these questions of local jurisdiction, lest the sweeping propositions applicable to all actions at law, and to some actions in equity, be regarded as in conflict with apparently different rules which govern only certain special cases.

§ 934. Jurisdiction over Actions at Law Vests in the Court for the Circuit in which the Defendant Resides or is Found.

An action at law for infringement may be brought before any Circuit court which has jurisdiction over the persons of the plaintiff and defendant. A plaintiff places himself within the jurisdiction of the court by instituting his action therein. Hence where a plaintiff has the capacity to sue, no question as to the jurisdiction of the court over him can properly arise. This is the case with all natural persons, and with all corporations also unless restrictions in their charters or in the local laws otherwise provide.¹ In the absence of such restrictions, any corporation or individual, whose rights under a patent have been violated, may institute legal proceedings for redress in any Circuit court whose jurisdiction extends to the person of the defendant. A Circuit court has jurisdiction over a defendant when he resides or is lawfully served with process in either of the districts which are included in

Fisher, 410 ; 6 Blatch. 85 ; Goodyear *v. Chaffee* (1855), 3 Blatch. 268. *Contra* : Thompson *v. Mendelsohn* (1871), 5 Fisher, 187 ; Wilson *v. Sherman* (1850), 1 Blatch. 536 ; Boyd *v. McAlpin* (1844), 3 McLean, 427 ; 2 Robb, 277.

That an injunction may issue against an infringer in the district where he lives forbidding him to infringe anywhere, see Hatch *v. Hall* (1884), 22 Fed. Rep. 438 ; 30 O. G. 1096.

That an action in equity for an accounting or damages, etc., can be brought in any district where the defendant can lawfully be served with

process, see Allen *v. Blunt* (1849), 1 Blatch. 480 ; and §§ 1096, 1097, and notes, *post*.

§ 934. ¹ That the Patent Laws do not change the rules established by the judiciary acts as to territorial jurisdiction over parties, or the service of process, see United States *v. American Bell Telephone Co.* (1886), 29 Fed. Rep. 17 ; 38 O. G. 1237.

That a corporation may maintain a suit in the district where its rights are infringed, though it is created under the laws of another State, see Elm City Co. *v. Wooster* (1873), 4 O. G. 83 ; 6 Fisher, 452.

the circuit.² A resident defendant is always within the jurisdiction of the court, and the rules which require personal service of process upon him can at all times be fulfilled. Upon a non-resident defendant, however, process can be served only when he is personally within the territorial limits of the circuit.³ Service by publication or by the attachment of property, though often sufficient under State laws to confer

² In *Thompson v. Mendelsohn* (1871), 5 Fisher, 187, McKennan, J. : (188) "The Patent Laws confer exclusive jurisdiction upon the circuit courts of all suits, in law or equity, for invasion of the rights of inventors under them, and the judiciary act expressly authorizes such suits to be brought and process to be served upon defendants in any district in which they may be found. The conclusion is inevitable that where these conditions are complied with, the court has power to afford such measure of protection to the plaintiff's rights as it is competent to afford in any case, of the subject-matter of which it has jurisdiction, and in which the parties are before it by the due service of process. Certainly by no act of Congress is this power restricted by the fact of the defendant's residence in another district ; or that the wrong imputed to him was not committed in the district in which the suit is brought. The process of the court is primarily directed against the person of the wrong-doer, and it is no sufficient reason against the power of the court to award it, that it may not furnish to the plaintiff's effectual relief, or that its operation may be evaded by the defendant."

³ The law as stated in the text and illustrated in the notes of this and succeeding paragraphs is that of the judiciary acts, and the decisions under them, prior to the act of March 3, 1887. The latter act provides that "no civil suit shall be brought before" the circuit courts of the United States "against any person by any original process of

proceeding in any other district than that whereof he is an inhabitant." Whether this provision applies to cases arising under the Patent Laws may well be doubted. In *Preston v. Fire Extinguisher Co.* (1888), 46 O. G. 124, *Gornully Mfg. Co. v. Pope Mfg. Co.* (1888), 34 Fed. Rep. 818, and *Halstead v. Manning* (1888), 44 O. G. 344, it was held that patent causes were within the statute, and that a defendant must thus be sued in the district of his residence. On the other hand, it has been decided that another equally universal provision of the same act, limiting the jurisdiction of the circuit courts to controversies involving \$2,000 or upwards, does not apply to patent cases. See *Miller-Megee Co. v. Carpenter* (1887), 43 O. G. 1118, where it is also intimated that the act of 1887 does not relate to suits under the Patent Laws. Patent rights and their invasions, as well as patent litigations, being matters *sui generis*, the consequences of embracing them under the sweeping provisions of general statutes cannot always be foreseen ; but many reasons will suggest themselves to any person familiar with industrial affairs in this country in favor of the retention of the former rule of practice in suits against infringers. Until the new position has been fully discussed and finally adopted by the courts, or more specifically defined by Congress, its soundness may, therefore, be regarded as an open question, and the doctrine built up by a century of legislation and judicial explanation be still treated as at least possibly correct and

jurisdiction over him for the purposes of the action thus commenced, does not answer the requirements of the Federal law.⁴ Personal service within the circuit must be made upon him, and this must affirmatively appear upon the marshal's return, or the court acquires no jurisdiction over him.⁵ Such service must be lawful and not be procured by fraud or imposition. Service on a non-resident defendant attending court within the circuit, or present at an examination of witnesses by stipulation, or inveigled by any means within the circuit in order that service may be made upon him, is fraudulent and void, and will be set aside on motion by the court.⁶ But such a defendant, either without service or after improper service, may appear and submit himself to the jurisdiction of the court, whose authority thereafter over him will be as complete as if it had been regularly obtained.⁷

ultimately to prevail. In that view it is here considered as if the act of 1887 had not been passed.

That a circuit court has no jurisdiction unless the defendant is served in his own district, or is found and served where sued, see *Day v. Newark India Rubber Mfg. Co.* (1850), 1 Blatch. 628.

That suit may be brought in any district where the defendant can be served, whether either party lives there or not, but the defendant must be personally served therein, see *Allen v. Blunt* (1849), 1 Blatch. 480.

That service upon one co-partner does not give personal jurisdiction over a non-resident partner, see *United States v. American Bell Telephone Co.* (1886), 29 Fed. Rep. 17 ; 38 O. G. 1237.

That service cannot be made on an agent created by implication against the will of the parties and not actually appointed, see *United States v. American Bell Telephone Co.* (1886), 38 O. G. 1237 ; 29 Fed. Rep. 17.

⁴ That the existence of property rights or pecuniary interests within the district are not alone enough to confer jurisdiction, see *United States v. Ameri-*

can Bell Telephone Co. (1886), 29 Fed. Rep. 17 ; 38 O. G. 1237.

That a service by attaching the defendant's goods gives no jurisdiction over him, see *Chaffee v. Hayward* (1857), 20 How. 208.

⁵ That when a person is sued out of his own district it must affirmatively appear by the marshal's return that process was served on him in the district where the suit is brought or the court will acquire no jurisdiction, see *Thayer v. Wales* (1872), 5 Fisher, 448.

⁶ That service upon a defendant while attending court in another State as a party defendant, or witness, is not lawful, see *Wilson Sewing Mach. Co. v. Wilson* (1885), 23 Blatch. 51.

That a service of process on a party attending an examination of witnesses by stipulation out of his own district will be set aside on motion, see *Plimpton v. Winslow* (1881), 22 O. G. 1207 ; 20 Blatch. 82 ; 9 Fed. Rep. 365.

⁷ That a party appearing submits to the jurisdiction, see *Macauley v. White Sewing Mach. Co.* (1881), 21 O. G. 496 ; 9 Fed. Rep. 698.

That the judiciary acts, limiting

§ 935. Jurisdiction over Actions at Law against Domestic and Foreign Corporations.

A defendant corporation, like an individual, is always within the jurisdiction of the Circuit court in whose territory it is located by the act of its creation, and may there at any time be served with process. A corporation organized under the laws of a State is located at all places within the limits of the State, and may be sued in any Circuit court whose jurisdiction embraces any portion of such State.¹ Whether a corporation can be served with process outside the State of its location has been doubted.² Service within the circuit upon the officers of a non-resident corporation is clearly ineffectual, and does not become valid though the corporation appears by an attorney in order to plead to the jurisdiction.³ But where State laws provide that foreign corporations doing business in

jurisdiction to cases where the defendant resides or is found within the district, confer only a personal privilege which may be waived by voluntary appearance or by accepting general conditions which impose a liability to suit, see *United States v. American Bell Telephone Co.* (1886), 29 Fed. Rep. 17 ; 38 O. G. 1237.

That an appearance in order to move to quash or to plead to the jurisdiction does not waive objections thereto, see *United States v. American Bell Telephone Co.* (1886), 29 Fed. Rep. 17 ; 38 O. G. 1237.

That where a defendant appears by attorney and files his plea to the jurisdiction by attorney, this admits and submits to the jurisdiction of the court, and the same result follows from the entry of a special appearance on the order-book at the request of the defendant's attorney without special leave of the court, see *Thayer v. Wales* (1872), 5 Fisher, 448.

That irregularities in service are waived unless objected to before answer, see *Goodyear v. Chaffee* (1855), 3 Blatch. 268.

That the privilege of freedom from service while attending a trial must be insisted on at the proper time or it will be waived, see *Matthews v. Puffer* (1882), 22 O. G. 332 ; 20 Blatch. 233.

§ 935. ¹ That a corporation created by State laws resides in all parts of the State, and may be sued in any court whose jurisdiction embraces any part of such State, see *Locomotive Engine Safety Truck Co. v. Erie Railway Co.* (1872), 6 Fisher, 187 ; 3 O. G. 93 ; 10 Blatch. 292.

² That whether a suit can be brought against a corporation outside the district where it is located is doubtful, see *Jones v. Osgood* (1869), 3 Fisher, 591 ; 6 Blatch. 435.

³ That a Circuit court does not acquire jurisdiction over a corporation organized under the laws of another State by serving process in its district on an officer of the corporation, nor is the objection waived though the corporation appears by attorney and pleads to the jurisdiction, see *Decker v. New York Belting & Packing Co.* (1873), 3 O. G. 441 ; 6 Fisher, 374.

that State shall appoint certain resident officials upon whom service of process may be made on behalf of the corporation, such corporation is found within that State for all purposes of jurisdiction both of the local and the Federal Courts.⁴

⁴ That the Federal courts must decide whether a corporation is so "found" within a district as to be liable to be sued there, see *St. Louis Wire Mill Co. v. Consolidated Barb Wire Co.* (1887), 32 Fed. Rep. 802.

That a foreign corporation transacting business in a State is "found within the State" for the purposes of suit, if it can be served with process under State laws, see *Williams & Albright v. Empire Transportation Co.* (1878), 14 O. G. 523; 3 Bann. & A. 533.

That a corporation is "found" within a State when it has established an office or agency there for carrying on the business for which it was incorporated, see *Carpenter v. Westinghouse Air Brake Co.* (1887), 32 Fed. Rep. 434.

That a Circuit court has no jurisdiction of an action against a corporation organized in another State, unless it carries on business within the district through some agent appointed by and representing the corporation in such district, and would thereby, under the local law, be amenable to suit in such district, as an implied or express condition of its right to do business therein, see *Carpenter v. Westinghouse Air Brake Co.* (1887), 32 Fed. Rep. 434; *United States v. American Bell Telephone Co.* (1886), 29 Fed. Rep. 17; 38 O. G. 1237.

That whether business is carried on is determined by what is done or has been done, not by what the corporation may have power to do, see *United States v. American Bell Telephone Co.* (1886), 29 Fed. Rep. 17; 38 O. G. 1237.

That a corporation does not become an "inhabitant" of a State, nor is it

"found there," for service of process merely by owning property there or by the fact that its officers reside there, see *Carpenter v. Westinghouse Air Brake Co.* (1887), 32 Fed. Rep. 434.

That a corporation doing no regular business and having no established agency within the district is not "found" there, simply because it sends there to purchase raw material, see *St. Louis Wire Mill Co. v. Consolidated Barb Wire Co.* (1887), 32 Fed. Rep. 802.

That to supply the means to do business is not the doing of business, see *United States v. American Bell Telephone Co.* (1886), 38 O. G. 1237; 29 Fed. Rep. 17.

That licenses rest on the common law, and a corporation licensor is not domesticated in the district of its licensees any more than any private person would be, see *United States v. American Bell Telephone Co.* (1886), 38 O. G. 1237; 29 Fed. Rep. 17.

That a "managing agent" is one who carries on the corporate business, or a substantial part thereof, see *United States v. American Bell Telephone Co.* (1886), 38 O. G. 1237; 29 Fed. Rep. 17.

That in New York service on the managing agent of a corporation organized in another State is service on a person "found" within the district, see *Hat Sweat Mfg. Co. v. Davis Sewing Mach. Co.* (1887), 31 Fed. Rep. 294.

That a "managing agent" of a foreign corporation need not have control of its entire business in the State, see *Hat Sweat Mfg. Co. v. Davis Sewing Mach. Co.* (1887), 31 Fed. Rep. 294.

That where a foreign corporation is amenable to suit under the local law, it

§ 936. Jurisdiction over Actions at Law where a Circuit Embraces Two or More Districts.

Where a Circuit court or its equivalent tribunal has jurisdiction over two or more districts, each district becomes the local unit of jurisdiction, and the rules hitherto applied to the territorial limits of the circuit are predicable of the district also. Thus a defendant must be sued in his own district or in a district where he can lawfully be served with process. Where there are several joint defendants resident in different districts proceedings may be properly commenced in either.¹ If the area of any district is identical with that of a State, a corporation created by that State is located within that district only and must there be sued, unless under the laws of other States where it does business it is also located within their borders.² On the other hand, if the State contains two or more districts, a corporation created by the State is located in all such districts and can be sued in that one which the plaintiff may elect.³ Where districts are subdivided for judicial purposes, each subdivision forms the local boundary of jurisdiction, within which all defendants must reside or be personally found and served.

§ 937. Plaintiff in Actions at Law Must be the Legal Owner of the Patent at the Date of the Infringement.

With a single exception the plaintiff in an action at law must be the person or persons in whom the legal title to the patent resided at the time of the infringement.¹ An infringe-

may be also sued in the Federal courts for infringement, see *Hussey Mfg. Co. v. Deering* (1884), 28 O. G. 193; 20 Fed. Rep. 795.

§ 936. ¹ That if joint infringers are living in different districts, suit may be commenced in either district against the defendant there residing, see *Goodyear v. Toby* (1868), 6 Blatch. 130.

² See § 935, notes 3, 4, *ante*.

³ That where a State has more than one district, and the statute provides that the defendant be sued in his own district, a corporation may be sued in

either, for it resides in all, see *Locomotive Engine Safety Truck Co. v. Erie Railway Co.* (1872), 6 Fisher, 187; 3 O. G. 93; 10 Blatch. 292.

§ 937. ¹ That the legal title must be in the plaintiff, see *Gamewell Fire Alarm Telegraph Co. v. City of Brooklyn* (1882), 14 Fed. Rep. 255; 22 O. G. 1978.

That no one can sue for damages for infringement except the patentee, the assignee, or the owner of a territorial interest exclusive of the patentee, see *Gordon v. Anthony* (1879), 16 O. G.

ment is an invasion of the monopoly created by the patent, and the law which defines and authorizes this monopoly confers only upon its legal owners the right to institute proceedings for its violation. These owners are the patentee, his assignee, his grantee, or his personal representatives; and none but these are able to maintain an action for infringement in a court of law. Moreover, the injury inflicted by an act of infringement falls upon the individual who owns the monopoly at the date of the infringement.² It does not affect former owners whose interest had terminated before the infringement was committed, nor does it so directly prejudice a future owner that the law can recognize his loss and give him a pecuniary redress. Hence the plaintiff must not only have a legal title to the patent, but must have also been its owner at the time of the infringement. The exception above referred

1135; 16 Blatch. 234; 4 Bann. & A. 248; *Hill v. Whitcomb* (1874), 5 O. G. 430; *Holmes*, 317; 1 Bann. & A. 34.

That owners of patents granted before the act of July 8, 1870, may maintain suits for infringements committed afterwards, see *Union Paper Bag Mach. Co. v. Newell* (1873), 6 Fisher, 582; 11 Blatch. 379.

That where a second original patent has been granted to the same inventor for the same invention, he can sue only on the first patent, see *Jones v. Sewall* (1873), 3 Clifford, 563; 6 Fisher, 343; 3 O. G. 630; *Odiorne v. Amesbury Nail Factory* (1819), 2 Mason, 28; 1 Robb, 300.

That parties equitably interested in the patent need not be joined as plaintiffs, see *Graham v. McCormick* (1880), 11 Fed. Rep. 859; 21 O. G. 1533; 10 Bissell, 39; 5 Bann. & A. 244.

That assignees are indispensable parties, see *Nellis v. Pennock Mfg. Co.* (1882), 22 O. G. 1131; 13 Fed. Rep. 451; 15 Phila. 493.

That one to whom the "exclusive right to the use of the improvement"

is transferred for the whole term of the patent, "by way of license and not as a transfer of a title," is the proper plaintiff in equity, see *Herman v. Herman* (1886), 29 Fed. Rep. 92.

² That a suit by "a party interested" means one interested in the patent when the infringement was committed, see *Moore v. Marsh* (1868), 7 Wall. 515.

That an interest in the proceeds of a suit for an infringement is not an interest in the patent, see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628.

That suit will lie to recover damages for infringement though the plaintiff assigned his interest in the patent before suit was brought, see *Spring v. Domestic Sewing Mach. Co.* (1882), 22 O. G. 1445; 13 Fed. Rep. 446.

That a patentee may sue an infringer though he has granted an exclusive license to another to make and sell, see *Freese v. Swartchild* (1888), 35 Fed. Rep. 141.

That the legal owner cannot sue the equitable owner for an infringement, see *Aspinwall Mfg. Co. v. Gill* (1887), 40 O. G. 1133; 32 Fed. Rep. 697.

to arises where an assignment of a patent is coupled with an assignment of a right of action for past infringements. In this case the present owner of the monopoly may institute proceedings for its violation during the ownership of his assignor as well as for infringements committed since the transfer of the title to himself.

§ 938. Licensees and Owners of Equitable Interests cannot be Plaintiffs in Actions at Law.

Two classes of persons having interests in patented inventions are, by this rule, debarred from suing for infringement in their own names in courts of law. These are licensees, and those who, under contracts with the legal owners, have acquired an equitable title to the patent. A licensee has no standing in a court of law as plaintiff in an action for infringement.¹ He does not own the monopoly or any part thereof, however widely the interest transferred to him in the invention may estop the owner of the patent from asserting the monopoly against him. Though possessing an exclusive territorial right to sell the invention, or an exclusive right to use it for a special purpose, or an exclusive right to use it and to license others to use it for a definite period of time, or an exclusive right to make the manufacture or machine in which it is contained, and though protected by a guaranty from his licensor, which guaranty his licensor and others are jointly violating, he is still only a mere licensee, and whatever relief equity may be able to afford him, a court of law cannot regard him as entitled to vindicate the monop-

§ 938. ¹ In *Birdsell v. Shaliol* (1884), 112 U. S. 485, Gray, J.: (486) "A licensee of a patent cannot bring a suit in his own name, at law or in equity, for its infringement by a stranger. An action at law for the benefit of the licensee must be brought in the name of the patentee alone." 30 O. G. 261 (261).

See also *Bogart v. Hinds* (1885), 33 O. G. 1268; 25 Fed. Rep. 484; *Wilson v. Chickering* (1883), 14 Fed. Rep. 917; 23 O. G. 1730; *Union Paper Bag Mach.*

Co. v. Nixon (1882), 105 U. S. 766; 21 O. G. 1275; *Gamewell Fire Alarm Telegraph Co. v. Brooklyn* (1882), 22 O. G. 1978; 14 Fed. Rep. 255; *Nellis v. Pennock Mfg. Co.* (1882), 22 O. G. 1131; 13 Fed. Rep. 451; 15 Phila. 493; *Ingalls v. Tice* (1882), 22 O. G. 2160; 14 Fed. Rep. 297, and other cases cited in note 2, *post*.

That the non-joinder of licensees is no ground of abatement, see *Forbes v. Barstow Stove Co.* (1864), 2 Clifford. 379.

only against its infringers.² Suits at law for the redress of injuries committed by infringement against licensees must be brought in the name of the real owner of the patent.³ It is a part of the implied agreement between a licensor and licensee that the former will protect the latter against these wrongful invasions of his rights by instituting such proceedings as may become necessary for that purpose, and if the legal owner of the monopoly refuses to perform this duty, or is inaccessible, the licensee may sue at law for damages in his name.⁴ A

² That a licensee having an exclusive right to sell for certain territory is not a proper plaintiff in infringement suits, but only the owner of the patent, see *Ingalls v. Tice* (1882), 22 O. G. 2160; 14 Fed. Rep. 297.

That a patentee, having transferred an exclusive right to use the invention for a particular purpose, is the only proper plaintiff, see *Blanchard v. Eldridge* (1849), 1 Wall. Jr. 337; 2 Robb, 737.

That a patentee having granted an exclusive right to use and to license others to use for five years has still a right to sue for infringements, see *Still v. Reading* (1881), 4 Woods, 345; 20 O. G. 1025; 9 Fed. Rep. 40.

That a suit at law to protect the licensee in his right to use a patented process for a particular manufacture should be brought in the name of the patentee, see *Goodyear v. Bishop* (1860), 2 Fisher, 96; 4 Blatch. 438.

That the owner of a patent having granted a license and agreed not to license any one else, and reserving a right to one half the damages for infringement, is a necessary party to a suit for infringement, see *North v. Kershaw* (1857), 4 Blatch. 70.

That the owner of a right to use and sell, but not to make, is a mere licensee and cannot sue, though protected by a guaranty from the patentee, and though the patentee with third parties are the infringers, see *Hill v. Whitcomb* (1874),

5 O. G. 430; Holmes, 317; 1 Bann. & A. 34.

³ That the patentee may sue in behalf of the licensee, see *Goodyear v. McBurney* (1853), 3 Blatch. 32.

That a licensee can sue for infringement in the name of his licensor, see *Birdsell v. Shaliol* (1884), 112 U. S. 485; 30 O. G. 261; *Wilson v. Chickering* (1883), 14 Fed. Rep. 917; 23 O. G. 1730; *Nellis v. Pennock Mfg. Co.* (1882), 22 O. G. 1131; 13 Fed. Rep. 451; 15 Phila. 493; *Union Paper Bag Mach. Co. v. Nixon* (1882), 105 U. S. 766; 21 O. G. 1275; *Gamewell Fire Alarm Telegraph Co. v. City of Brooklyn* (1882), 22 O. G. 1978; 14 Fed. Rep. 255; *Nelson v. McMann* (1879), 16 O. G. 761; 16 Blatch. 139; 4 Bann. & A. 203; *Littlefield v. Perry* (1874), 21 Wall. 205; 7 O. G. 964; *Potter v. Wilson* (1860), 2 Fisher, 102; *Gayler v. Wilder* (1850), 10 How. 477.

That a licensee can sue only for infringements which affect his own rights under the patent, see *Hayward v. Andrews* (1883), 106 U. S. 272; 23 O. G. 533.

⁴ That a stipulation by the licensor to sue infringers does not compel the licensees to look to him on his covenants, but they may institute suits in his name against infringers, see *Goodyear v. Bishop* (1860), 2 Fisher, 96; 4 Blatch. 438.

That if the owner of the patent will not sue or cannot be found, the licensee

suit thus brought is under the control of the licensee, and though the nominal plaintiff may claim indemnity against the costs and expenses of the suit, he cannot discontinue it or settle with the infringer in derogation of the rights of the real party in interest.⁵ This privilege does not extend to the personal representatives of licensees, the license and all obligations under it, except those of contract, expiring at the death of the licensee.⁶ To equitable owners of the patent, or of interests therein, relief can be afforded only in a court of equity.⁷

may use his name in a suit at law, and probably in equity also, see *Wilson v. Chickering* (1883), 14 Fed. Rep. 917; 23 O. G. 1730.

That the patentee is not obliged to sue after an assignment of his rights, see *Bicknell v. Todd* (1851), 5 McLean, 236.

⁵ In *Miller v. Liggett & Myers Tobacco Co.* (1881), 7 Fed. Rep. 91, McCrary, J.: (92) "I think that a party who contributes money for the purpose of employing counsel and carrying on a litigation, under a contract with a party to the record, must of necessity be held to have the right to take such action in the case as will protect his own interest in it. As, for example, suppose there is a case which is understood to be a test case, involving the validity of a patent, or anything else, against a particular individual, but involving a subject-matter concerning which a large number of other persons are equally interested with the particular defendant in that case, and suppose all the parties who are interested, or a number of them, come together, enter into a contract that they will raise a fund to carry on that litigation, that they will unite for the purpose of employing counsel, and combine to carry it on in the name of the party to the record,— it seems to me that the persons, who under such a contract as that actually contribute money for the purpose of carrying on a suit, are authorized to go into that

court and use the name of the party to the record in making such motions, and taking such steps as are necessary for the protection of their particular interest in it." 2 McCrary, 375 (377); 19 O. G. 1138 (1139).

That a nominal plaintiff cannot discontinue the suit brought to protect his licensee, and if he does so the real parties in interest will be permitted to make their rights apparent, see *Goodyear v. Bishop* (1860), 2 Fisher, 96; 4 Blatch. 438; *Goodyear v. McBurney* (1860), 3 Blatch. 32.

That a nominal plaintiff may claim indemnity against costs, see *Goodyear v. Bishop* (1860), 2 Fisher, 96; 4 Blatch. 438.

⁶ That the executor of a licensee cannot sue for infringement in the name of the licensor, the license being personal and expiring at the death of the licensee, see *Oliver v. Rumford Chemical Works* (1883), 109 U. S. 75; 25 O. G. 784.

⁷ In *Sanford v. Messer* (1872), 5 Fisher, 411, Shepley, J.: (413) "Unquestionably a contract for a purchase of a portion of the patent right may be good as between the parties as a license, and enforced as such in the courts of justice; but the legal right in the monopoly remains in the patentee, and he alone can maintain an action against a third party who commits an infringement upon it." Holmes, 149 (150); 2 O. G. 470 (471).

§ 939. **Patentee when Plaintiff in Actions at Law.**

The primary legal owner of a patent is the patentee, and until it is assigned or granted by him, or at his death is vested in his administrator or executor, all suits at law upon it must be brought in his name alone.¹ After he has transferred it he may still maintain an action for infringements committed during his ownership, and if the transfer covers only an undivided interest he must join with the transferee in suits arising out of subsequent infringements.² A patentee who has conveyed his patent and afterward regained it may sue for violations of the monopoly during either period of his ownership, but not for those committed while the patent was the property of others.³ In suits on a joint patent all the

§ 939. ¹ That a patent once granted authorizes a patentee to sue on it, see *Asbestos Felting Co. v. Salamander Felting Co.* (1876), 10 O. G. 828; 13 Blatch. 453; 2 Bann. & A. 369.

That no legal title exists in any one until the patent issues, see *Pontiac Knit Boot Co. v. Merino Shoe Co.* (1887), 31 Fed. Rep. 286.

That a patentee is presumed to be the owner of the patent if no assignment is alleged or proved, see *Fischer v. Neil* (1881), 6 Fed. Rep. 89; 19 O. G. 603.

That a patentee having contracted to sell portions of his right still owns the patent, and he alone can sue for infringement, see *Wheeler v. McCormick* (1873), 4 O. G. 692; 6 Fisher, 551; 11 Blatch. 334; *Sanford v. Messer* (1872), 5 Fisher, 411; 2 O. G. 470; *Holmes*, 149; *Park v. Little* (1813), 3 Wash. 196; 1 Robb, 17.

² That a patentee, excluded from certain business in certain places, may nevertheless maintain suit for the use of his invention by others in such places, see *Colgate v. International Ocean Telegraph Co.* (1879), 17 O. G. 194; 17 Blatch. 308; 4 Bann. & A. 609.

That patentees, having reversionary interests after those of their grantees

expire, may maintain a suit to protect their interests, see *Freese v. Swartchild* (1888), 35 Fed. Rep. 141; *Otis Bros. Mfg. Co. v. Crane Bros. Mfg. Co.* (1886), 27 Fed. Rep. 550; *Still v. Reading* (1881), 20 O. G. 1025; 9 Fed. Rep. 40; 4 Woods, 345.

That a patentee and licensor should be joined with the assignee of the licensor in a suit against the licensee if he is still interested in the patent, see *Woodworth v. Cook* (1850), 2 Blatch. 151.

That a former owner of the patent who has sold it, reserving certain special uses, is not a proper party plaintiff, see *Frankfort Whiskey Process Co. v. Pepper* (1885), 26 Fed. Rep. 336.

That the former owner of the patent may sue, after he has assigned it, for infringements committed against him during his ownership, see *Moore v. Marsh* (1868), 7 Wall. 515.

³ That a patentee taking a release of all outstanding rights may sue in his own name for all future, but not for past, infringements, see *Wheeler v. McCormick* (1873), 4 O. G. 692; 6 Fisher, 551; 11 Blatch. 334.

That a patentee cannot recover for damages arising since he assigned the patent, see *Wheeler v. McCormick*

patentees must be made plaintiffs, and the same rule applies in all cases of joint-ownership whether of assignees, grantees, or representatives.⁴ That one of the joint owners has conveyed his interest in the patent since the infringement does not dispense with the necessity of joining him as plaintiff in a suit therefor.⁵

§ 940. Assignee when Plaintiff in Actions at Law.

An assignee of the entire interest in the patented invention must sue alone for any infringement committed during his sole ownership.¹ It is immaterial whether the assignment was made before or after the issue of the patent, provided the legal title of the assignee has been perfected as the law requires; but while the title remains imperfect, or resides in contract only, a court of law cannot take cognizance of any action brought by the assignee in his own name.² The motive of the assignment is also of no consequence,—it being sufficient that the legal title is duly vested in him.³ An assignee of an

(1873), 4 O. G. 692; 6 Fisher, 551; 11 Blatch. 334.

⁴ That joint patentees and all other co-owners must be made plaintiffs, see *Moore v. Marsh* (1868), 7 Wall. 515; *Stein v. Goddard* (1856), 1 McAllister, 82; *Whittemore v. Cutter* (1813), 1 Gallison, 429; 1 Robb, 28.

⁵ That one of two joint owners of a patent having assigned his interest after infringement, both may still sue at law for the injury, and no equitable interference is required, see *Spring v. Domestic Sewing Mach. Co.* (1882), 22 O. G. 1445; 13 Fed. Rep. 446.

§ 940. ¹ That the assignee of the entire monopoly may sue in his own name, see *Nellis v. Pennock Mfg. Co.* (1882), 13 Fed. Rep. 451; 15 Phila. 493; 22 O. G. 1131; *Moore v. Marsh* (1868), 7 Wall. 515.

That an assignee can maintain a suit at law or in equity without joining the patentee, see *Brooks v. Bicknell* (1843), 3 McLean, 250; 2 Robb, 118.

That an assignee can sue in his own name only by force of the statute, see *Suydam v. Day* (1846), 2 Blatch. 20.

² That where an assignment was made before the patent was granted only the assignee can sue for infringements, see *Herbert v. Adams* (1825), 4 Mason, 15; 1 Robb, 505.

That an assignee before patent, with request that the patent issue to him, may sue in his own name though the patent actually issued to the inventor, see *Consolidated Electric Light Co. v. McKeesport Electric Light Co.* (1888), 34 Fed. Rep. 335; *Consolidated Electric Light Co. v. Edison Electric Light Co.* (1885), 25 Fed. Rep. 719; 23 Blatch. 412; 33 O. G. 1597.

³ That an assignee may sue, no matter what may have been the motive for the assignment, see *Seibert Cylinder Oil Cup Co. v. Phillips Lubricator Co.* (1882), 10 Fed. Rep. 677.

undivided interest cannot sue alone, but must join his co-owners; and where an assignment is conditional, and interests of the assignor are liable to be affected by the suit, he must be made a party also, or if this is impracticable under the rules of pleading, recourse must be had to equity in which the rights of all parties can be secured.⁴ An assignee in trust, though not entitled to the proceeds of the suit, is nevertheless the proper plaintiff until the trust has been fulfilled.⁵

§ 941. Grantee, when Plaintiff in Actions at Law.

The grantee of an exclusive territorial interest in the patented invention must sue alone for any infringement committed within his territory.¹ Under our earliest statutes grantees were not regarded as real owners of any part of the monopoly, and, therefore, could not sue at law for an infringement of the patent.² Since that power was conferred upon them, the close resemblance between many licenses and grants has caused some difficulty in determining whether given suits

⁴ In *Moore v. Marsh* (1868), 7 Wall. 515, Clifford, J. : (520) "Where the patentee has assigned his whole interest, either before or after the patent is issued, the action must be brought in the name of the assignee, because he alone was interested in the patent at the time the infringement took place; but where the assignment is of an undivided part of the patent, the action should be brought for every infringement, committed subsequent to the assignment, in the joint names of the patentee and assignee, as representing the entire interest."

See also *Stein v. Goddard* (1856), 1 McAllister, 82; *Whittemore v. Cutter* (1813), 1 Gallison, 429; 1 Robb, 28.

That unless an assignment is absolute and unconditional and passes the legal title, the interests of the assignor may be affected by the suit, and he is a necessary party to it, see *Cook v. Bidwell* (1879), 20 O. G. 1083; 8 Fed. Rep. 452.

⁵ That pending a trust conveyance

to the plaintiff, he may bring suit for infringement, having a title in him, see *Campbell v. James* (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456.

That the receiver of a corporation in Pennsylvania has no title to its patents, and cannot sue thereon in his own name, see *Dick v. Struthers* (1885), 34 O. G. 131; 25 Fed. Rep. 103.

§ 941. ¹ That a grantee may sue alone for an infringement in territory where his right is exclusive, see *Hobbie v. Smith* (1886), 27 Fed. Rep. 665; *Moore v. Marsh* (1868), 7 Wall. 515; *Gayler v. Wilder* (1850), 10 How. 477.

That where a grantee never performs the conditions of his grant or avails himself of it, but recognizes his grantor's exclusive rights, the grantor may sue for infringement in that territory after the grantee's death without naming him, see *Railroad Co. v. Trimble* (1870), 10 Wall. 367.

² That territorial grantees cannot sue under the act of 1793, Secs. 4 and

were properly instituted, and this difficulty is likely to continue as long as ambiguous agreements and conveyances afford room for doubt as to their true legal effect. But where the transferee is an actual grantee, as distinguished from a licensee, his right to sue for violations of the monopoly within his territory is as well established as that of an assignee.³ Joint grantees like joint assignees must unite as plaintiffs in an action for infringement.

§ 942. **Personal Representatives of Deceased Owner when Plaintiffs in Actions at Law.**

The personal representatives of the deceased owner of a patent must be the plaintiffs in an action for infringement committed either during their own ownership or that of their decedent. The heirs or devisees, though beneficially entitled to the proceeds of the suit, are mere *cestuis que trust* and cannot appear as plaintiffs in a court of law.¹ Where there are several executors, some of whom take no part in the administration of the estate, those who act should be sole plaintiffs; and where a patent issues or re-issues to one of several executors, he only has the legal title and can maintain a suit

5, not being true assignees, see *Tyler v. Tuel* (1810), 6 Cranch. 324; 1 Robb, 14.

That the grantee of an exclusive territorial right could maintain a suit in equity in his own name under the act of 1793, whether he could at law or not, see *Ogle v. Ege* (1826), 4 Wash. 584; 1 Robb, 516.

³ In *Hill v. Whitcomb* (1874), 5 O. G. 430, Shepley, J. : (431) "To enable the purchaser to sue, the assignment must undoubtedly convey to him the entire and unqualified monopoly which the patentee held in the territory specified, excluding the patentee himself as well as others. Any assignment short of this is a mere license, and the legal right in the monopoly remains in the patentee, and he alone can maintain an action against a third party who commits an infringement upon it."

1 Bann. & A. 34 (36); Holmes, 317 (321).

That a grantee of all right, title, and interest within certain territory may sue for infringement, see *Perry v. Corning* (1870), 7 Blatch. 195.

That an assignee of an exclusive right to use, but not to make, the invention within certain territory may sue an infringer in his own name, see *Chambers v. Smith* (1870), 5 Fisher, 12.

That the assignee of an exclusive territorial right to use two machines can sue in his own name even against the patentee, see *Wilson v. Rousseau* (1846), 4 How. 646; 2 Robb, 372.

§ 942. ¹ That the next of kin are not to be joined with the executor or administrator as plaintiffs in a suit for an infringement or an account, see *Hodge v. North Missouri R. R. Co.* (1869), 4 Fisher, 161; 1 Dillon, 104.

thereon.² An administrator or executor can sue in any district without qualifying in the probate courts of the State in which the district is comprised, his relation to the patented invention being that of a trustee under the acts of Congress, and not dependent upon any local law.³

§ 943. Assignee of Claim for Past Infringements, when Plaintiff in Actions at Law.

The law permits the owner of a patent who has been injured by its infringement to assign his right of action for

² That where one alone of several executors of the patentee acts, he alone can sue at law for infringement, see *Rubber Co. v. Goodyear* (1869), 9 Wall. 788.

That when a patent issues or re-issues to one of several executors, he is the sole patentee and the others need not join in the suit though the damages when recovered belong to the estate, see *Rubber Co. v. Goodyear* (1869), 9 Wall. 788; *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351.

³ In *Goodyear v. Hullihen* (1867), 3 Fisher, 251, Jackson, J. : (253) "It does not appear to me that this point is well taken; the reasons which exist for requiring an administrator, in ordinary cases, to qualify in the State in which he sues, do not apply to suits brought by an administrator to whom a patent has been granted for the invention of his intestate, for infringement of the rights thus granted. Under the act of Congress patents are granted, in case of the decease of the inventor, to the executor or administrator of such person, in trust for the heirs-at-law of the deceased, in case he shall have died intestate, but if otherwise, then in trust for his devisees (act of July 4, 1836, § 10); and re-issues are also granted to the executor or administrator (act of July 4, 1836, § 13). In such cases

the administrator is a trustee holding the legal title, and the patent is not assets in his hands belonging to the personal estate of the intestate, but is a franchise granted to the administrator for the benefit of the heirs-at-law or devisees of the deceased inventor. There is, therefore, no reason for requiring him to qualify in this State; besides which, the question may be considered as set at rest by the authority of the following cases, cited in argument by complainant's counsel: 'It is not necessary in an action by an administrator that he should produce his letters of administration. The patent being renewed to him, as administrator, is proof that he had satisfied the officer authorized to grant a renewal of his being administrator, and it is not competent for the court to go behind that decision.' *Woodworth v. Hall*, 1 W. & M. 254. 'An administrator of a patentee, residing in one State, may commence an action in the United States Circuit Court of another State for the recovery of damages for an infringement of a patent, without taking out letters of administration in the latter State.' *Smith v. Mercer*, 5 Penn. Law Jour. 531." 2 Hughes, 492 (495).

See also *Hodge v. North Missouri R. R. Co.* (1869), 4 Fisher, 161; 1 Dillon, 104.

such injury in conjunction with an assignment of the patent, and thus to transfer to the assignee not only the monopoly itself, but also the power to recover compensation for its past infringements.¹ These assignments must expressly include the right of action,² and are made subject to all the equities existing between the alleged infringer and the assignor.³ The right of action cannot be conveyed separately from the patent, since this would confer the ability to sue for an infringement on other persons than those named in the statute as the legal owners of the monopoly.⁴ An assignee of this character may maintain an action in his own name for these infringements

§ 943. ¹ That a right to damages for past infringements is assignable, see *Hamilton v. Rollins* (1877), 3 Bann. & A. 157; 5 Dillon, 495.

That an assignment of a right to sue for the profits of an infringement is not an assignment of unliquidated damages, see *Jenkins v. Greenwald* (1857), 2 Fisher, 37; 1 Bond, 126.

That a right of action for past infringements vests in the administrator of the patentee, and may be sued on or assigned by him, see *May v. County of Logan* (1887), 30 Fed. Rep. 250; 41 O. G. 1387.

² That an assignment of a right of action for past injuries must be clearly expressed, see *Emerson v. Hubbard* (1888), 34 Fed. Rep. 327; *Knowlton Platform & Car Coupling Co. v. Cook* (1879), 70 Me. 143.

That the mere assignment of the patent does not transfer the right to sue for past infringements, see *Kaolatype Engraving Co. v. Hoke* (1887), 30 Fed. Rep. 444; 39 O. G. 589; *May v. Juneau Co.* (1887), 30 Fed. Rep. 241; 41 O. G. 578; *N. Y. Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 18 Fed. Rep. 638; 25 O. G. 1076; 21 Blatch. 519; *Merriam v. Smith* (1882), 11 Fed. Rep. 588.

That the assignment of a patent by an administrator does not cover claims for past infringements, especially where

only a nominal price is paid by the assignee, see *May v. Juneau Co.* (1887), 30 Fed. Rep. 241; 41 O. G. 578.

That the assignment of "all right, title, interest, claims, and demands whatsoever which the estate has in, to, by, under, and through" letters-patent carries rights of action for past infringement, see *May v. Logan Co.* (1887), 30 Fed. Rep. 250; 41 O. G. 1387.

That the assignee of claims for damages must allege and prove an assignment of such claims themselves, see *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 18 Fed. Rep. 638; 25 O. G. 1076; 21 Blatch. 519.

³ That the assignee of damages for past infringements takes his title subject to all the equities against the assignors, see *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 18 Fed. Rep. 638; 25 O. G. 1076; 21 Blatch. 519.

That laches of an assignor of rights of action binds his assignee, see *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1885), 24 Fed. Rep. 604; 32 O. G. 1356.

⁴ That a claim for past infringements cannot be severed from the title to the patent by assignment so as to give a right of action contrary to the statutes, see *Gordon v. Anthony* (1879), 16 O. G. 1135; 16 Blatch. 234; 4 Bann. & A. 248.

under the former owner, either during the life of the patent or after it has expired.⁵ Transfers of title and of rights of action, *pendente lite*, do not affect the litigation unless the interests of the parties may require it, but notice of such transfer must be given to the defendant or he will be protected in his *bona fide* payments to the record plaintiff.⁶

§ 944. Plaintiff in Actions at Law must Sue in His Own Name.

The proper plaintiff in an action for infringement must institute the suit in his own name, according to the character imposed upon him by the local law.¹ Persons *sui juris* appear as the assertors of their legal rights. Married women must sue alone or jointly with their husbands, and infants by guardian or otherwise, as the State legislation fixing their capacity may indicate.² A corporation sues by its corporate

⁵ That an assignee of a patent and of all claims for past infringements may sue at law or for an injunction in his own name, see *May v. Logan Co.* (1887), 30 Fed. Rep. 250; 41 O. G. 1387; *Adams v. Bellaire Stamping Co.* (1885), 25 Fed. Rep. 270; 33 O. G. 623; *Spring v. Domestic Sewing Mach. Co.* (1882), 22 O. G. 1445; 13 Fed. Rep. 446; *Merriam v. Smith* (1882), 11 Fed. Rep. 588; *Campbell v. James* (1880), 2 Fed. Rep. 338; 18 O. G. 1111; 18 Blatch. 92; 5 Bann. & A. 354.

That in a suit at law, after a patent has expired, if the assignment does not cover claims for past infringements, the assignors must be joined as plaintiffs, see *Adams v. Bellaire Stamping Co.* (1885), 25 Fed. Rep. 270; 33 O. G. 623.

That where the plaintiff, when the suit begins, owns the patent and the entire interest in the claim for past infringements, he may recover for the infringements committed before he owned the patent, see *Consolidated Oil Well Packer Co. v. Eaton, Cole, & Burnham Co.* (1882), 12 Fed. Rep. 865.

⁶ In *Campbell v. James* (1880), 18 O. G. 1111, Wheeler, J. : (1113) "Conveyances *pendente lite* do not at all affect the litigation as between the parties to the original controversy unless there are special statutes or circumstances to control; but courts of justice, even courts of law, and especially courts of equity, often protect the rights of the real owners to the fruits of a recovery as against those who are nominal but not real owners whenever their rights may have been acquired." 2 Fed. Rep. 338 (345); 18 Blatch. 92 (98); 5 Bann. & A. 354 (361).

That on an assignment of a claim pending suit notice must be given to the defendant that he may not pay the wrong party, see *Gear v. Fitch* (1878), 16 O. G. 1231; 3 Bann. & A. 573.

§ 944. ¹ That the local law may determine who the real party in interest is, see *Lorillard v. Standard Oil Co.* (1880), 17 O. G. 1507; 18 Blatch. 199; 2 Fed. Rep. 902; 5 Bann. & A. 432.

² That in New York a married woman may sue alone in her own name for an infringement, she being by the State law a *feme sole* as to such matters,

name as determined by its charter, and an unincorporated association in the names of its individual members.³ No plaintiff can commence or prosecute a suit in the name of his attorney or any other delegate.⁴

§ 945. **Non-joinder or Misjoinder of Plaintiffs in Actions at Law.**

Objections for the non-joinder or misjoinder of plaintiffs are not favored by the courts where the plaintiffs of record have a legal title, and must be made in due season or they cannot be regarded.¹ A misjoinder cannot be noticed after a final judgment in the Supreme Court of the United States.² A non-joinder is cured by a disclaimer of title, on the part of the alleged omitted parties, in favor of the actual plaintiffs.³

see *Lorillard v. Standard Oil Co.* (1880), 2 Fed. Rep. 902; 17 O. G. 1507; 18 Blatch. 199; 5 Bann. & A. 432.

³ That in Pennsylvania the receiver of a corporation has no title to its property, and cannot sue on its letters-patent, see *Dick v. Struthers* (1885), 25 Fed. Rep. 103; 34 O. G. 131; *Dick v. Oil Well Supply Co.* (1885), 25 Fed. Rep. 105.

That the suit of an unincorporated company should be prosecuted in the names of the individual parties, not the company, see *Metal Stamping Co. v. Crandall* (1880), 18 O. G. 1531.

⁴ In *Goldsmith v. American Paper Collar Co.* (1880), 18 Blatch. 82, Blatchford, J. : (83) "The party in interest must bring the suit, whether at law or in equity, in his own name, and cannot delegate the right to another person to bring the suit in the name of such other person when the suit is not for the benefit in any way of such other person. It is a question of public policy. The defendant has a right to require that the real owner or party in interest shall be in court, so that the court may exercise a control over him in the course of the suit, if necessary, to require him to do something which the rights of the defendant may require to be done." 18

O. G. 192 (192); 2 Fed. Rep. 239 (240); 5 Bann. & A. 300 (301).

See also *Lorillard v. Standard Oil Co.* (1880), 17 O. G. 1507; 2 Fed. Rep. 902; 18 Blatch. 199; 5 Bann. & A. 432.

§ 945. ¹ That in equity an objection for non-joinder of plaintiffs is not favored if any of the parties to the suit have a legal title, see *Graham v. McCormick* (1880), 11 Fed. Rep. 859; 21 O. G. 1533; 10 Bissell, 39; 5 Bann. & A. 244; *Graham v. Geneva Lake Crawford Mfg. Co.* (1880), 11 Fed. Rep. 138; 21 O. G. 1536.

That an objection for non-joinder may be waived either at law or in equity, see *Adams v. Howard* (1884), 23 Blatch. 27; 22 Fed. Rep. 656.

² That a misjoinder of parties cannot be objected to after final decree and in the Supreme Court, see *Livingston v. Woodworth* (1853), 15 How. 546.

That defect of parties cannot be urged after a hearing on the merits, unless they are indispensable to a decree, see *Adams v. Howard* (1884), 23 Blatch. 27; 22 Fed. Rep. 656.

³ That a disclaimer of title in favor of the plaintiffs by persons not joined will cure the non-joinder, see *Graham v. Geneva Lake Crawford Mfg. Co.* (1880), 11 Fed. Rep. 138; 21 O. G. 1536.

§ 946. Defendant in Actions at Law must be the Person Guilty of the Act of Infringement.

Any person who has been guilty of an act of infringement may be made a defendant in an action at law. An act of infringement is committed by making, using, or selling the patented invention without authority from the owner of the patent; or by employing others to make, use, or sell it for the benefit of the employer; or by accepting and enjoying the direct advantage flowing from the infringement; or by acting in complicity with others under any cover or pretence the practical effect of which is an invasion of the monopoly created by the patent.¹ All who perform or who unite in the performance of an act of infringement, by any of these methods, may be sued jointly or severally at the option of the plaintiff, provided they can lawfully be served with process in the territory over which the court has local jurisdiction.²

§ 947. All Infringers Liable as Defendants in Actions at Law.

No exemption from this liability to suit exists in favor of any person on the ground of infancy, lunacy, or coverture.¹ The government of the United States when practising a patented invention without permission from its lawful owner, though not technically guilty of an act of infringement or capable of being reached by ordinary process, may be sued in the Court of Claims for compensation in pursuance of the Federal statutes enacted for that purpose.² An officer of

§ 946. ¹ See §§ 897-921 and notes, *ante*.

That infringements by the maker and the user are separate trespasses, see *Blake v. Greenwood Cemetery* (1883), 16 Fed. Rep. 676; 25 O. G. 89; 21 Blatch. 222.

² See §§ 947, 948, and notes, *post*.

That where defendants are jointly sued their relation to each other should be stated in the declaration, see *Shickle v. South St. Louis Foundry Co.* (1884), 22 Fed. Rep. 105.

That where several parties infringe,

some by making and the others by selling, the wrongs are both joint and several, and judgment can be obtained against each, though there can be only one satisfaction, see *Jennings v. Dolan* (1887), 29 Fed. Rep. 861; 38 O. G. 1018.

§ 947. ¹ That infants, married women, and lunatics are liable for damages for infringement, see § 921 and notes, *ante*.

² That the United States is liable, see § 910 and notes, *ante*, and § 1258 and notes, *post*.

the government infringing a patent in its service cannot be made defendant in an action for infringement when the judgment in such action would indirectly be a judgment against the United States, but he may be sued upon his personal account if his act of infringement has arisen from his own volition or has redounded to his individual benefit.³ Cities and other true municipal or private corporations are liable to actions for the infringements of their officers or agents, whether these were previously authorized or subsequently ratified by them; and with them may be joined as co-defendants such officers and agents when they have directed, or have voluntarily performed, or have immediately and personally profited by, the infringing act.⁴ All private individuals not acting under lawful obedience to their superiors are also liable to suit for their invasions of the monopoly, whether they are part owners, licensees, or strangers to the patent.⁵ The amenability of an infringer to another court, or upon different proceedings, is no bar to a suit against him for the infringement in a court of law.⁶

§ 948. Non-joinder and Misjoinder of Defendants in Actions at Law.

The misjoinder or non-joinder of defendants is immaterial unless the act of alleged infringement was inseparable and could not have been performed by the record defendants alone,—in which case the plaintiff may fail in his cause through inability to prove his allegations. As in other actions of tort, persons improperly joined as defendants may have a verdict and recover costs, while the plaintiff may

³ That government officials are liable, see § 910 and notes, *ante*.

⁴ That corporations, their officers and agents, are liable, see §§ 911, 912, and notes, *ante*.

⁵ That all private infringers are liable, see §§ 913-921 and notes, *ante*.

⁶ That a defendant who has violated an injunction and is liable for contempt may still be sued for infringement, see

Roemer v. Neumann (1885), 23 Fed. Rep. 447.

That a party who elects to take a judgment for the profits cannot have an action for damages for the same infringement while the former judgment is unreversed, since only one action will lie for a given tort if the damages can be ascertained in one, see *Child v. Boston & Fairhaven Iron Works* (1884), 19 Fed. Rep. 258.

prevail against the actual infringers.¹ No obligation rests upon the plaintiff to join all the defendants in one action. Like all wrong-doers each is liable for the entire loss occasioned by the infringement, and judgment may be obtained against each successively in different suits or against all collectively in one.² The plaintiff can, however, have but one satisfaction, and when he has received full compensation for his injury from one or more of the defendants, the judgments in all subsequent proceedings are restricted to the amount of taxable costs.³ The death of a defendant does not abate the action, nor does his bankruptcy or the marriage of a *feme sole* defendant affect the suit, except to introduce new parties to the record.⁴

§ 949. **Process in Actions at Law: The Declaration: Allegation of Inventive Act.**

The process in an action at law for infringement does not differ from that employed in the Federal courts, within the district, to secure the appearance of the defendant in other civil actions. The declaration must contain all the averments which are necessary to support the evidence of the plaintiff's right and its violation.¹ Of these essential averments there

§ 948. ¹ That a plaintiff may prove infringement against one of several defendants and recover against him alone, see *Reutgen v. Kanowrs* (1804), 1 Wash. 168; 1 Robb, 1.

² That non-joinder of defendants is no defence by joint infringers since each is liable for all, see *Wallace v. Holmes, Booth, & Haydens* (1871), 1 O. G. 117; 5 Fisher, 37; 9 Blatch. 65.

That whether joint infringers *must* be joined even in equity is doubtful, see *Goodyear v. Toby* (1868), 6 Blatch. 139.

³ That recovery and satisfaction against one joint tort-feasor is a bar to a recovery against the others, except as to the costs in pending suits, see *Sheldon v. Kibbe* (1819), 3 Conn. 214.

That recovery from one tort-feasor

is no bar to a suit against the others unless the judgment is satisfied or released, see *American Bell Telephone Co. v. Albright* (1887), 32 Fed. Rep. 287.

⁴ That a suit survives against a deceased infringer's estate, see *Kirk v. DuBois* (1886), 37 O. G. 102; 28 Fed. Rep. 460; *Smith v. Baker's Admr.* (1874), 10 Phila. 221; 1 Bann. & A. 117; 5 O. G. 496.

§ 949. ¹ That the allegations of the declaration must be as broad as the evidence needed to establish the plaintiff's right to recover, see *Stanley v. Whipple* (1839), 2 McLean, 35; 2 Robb, 1.

That an ordinary declaration on the case is sufficient, see *May v. Mercer Co.* (1887), 41 O. G. 815; 30 Fed. Rep. 246.

are five: (1) The invention of the patentable subject-matter by the patentee or his assignor; (2) The grant of letters-patent covering the invention; (3) The legal title of the plaintiff; (4) The infringement by the defendant; (5) The resulting damage to the plaintiff. Under the first averment the plaintiff must allege the performance of an inventive act on the part of the patentee or his assignor, producing a new and useful art or article not before known or used in this country, and not in public use or on sale more than two years before his application for a patent.² The date of this inventive act need not be stated, if it appears to have preceded that of the application.³ The art or article may be described in this averment by the title given to it in the patent.⁴ Though it is customary to allege the citizenship of the patentee it is not generally held to be essential.⁵

§ 950. The Declaration: Allegation of Grant of Letters-Patent.

Under the second averment the plaintiff must allege and describe the application of the inventor for a patent, its allowance by the Patent Office, and the issue of letters-patent thereon, specifying the nature of the invention which it purports to protect and making profert of the patent.¹ The compliance of the applicant with the preliminary requirements or of the officials of the department with their prescribed duties need not be stated, these being presumed from the

² That the declaration must tender an issue upon every point essential to the patentability of the invention, see *Wilder v. McCormick* (1846), 2 Blatch. 31; *Gray v. James* (1817), Pet. C. C. 476; 1 Robb, 140.

³ That the declaration need not aver the date when the invention was made, except that it was before the application, nor allege the taking of the required preliminary steps, all these being presumed from the grant of the patent, see *Wilder v. McCormick* (1846), 2 Blatch. 31.

⁴ That in averring the patentability of the invention it need not be particularly set forth, see *Turrell v. Cammer-*

rer (1868), 3 Fisher, 462; *Gray v. James* (1817), Pet. C. C. 476; 1 Robb, 140.

⁵ That citizenship is not in issue though alleged, see *Fischer v. Neil* (1881), 19 O. G. 603; 6 Fed. Rep. 89.

§ 950. ¹ That the declaration must set out the attestation of the President, and allege that the patent was delivered, or it may be demurred to, see *Cutting v. Myers* (1818), 4 Wash. 220; 1 Robb, 159.

That the declaration must allege the improvement and show in what it consists, see *Peterson v. Wooden* (1843), 3 McLean, 248; 2 Robb, 116.