

the original patent unless he used all the elements of the combination

Any one will infringe the reissue who uses any of those elements which are now separately claimed. * * * . It cannot be denied that each of these separate claims is broader than he claimed in the original patent, as they are put forth in the reissue fourteen years after the original patent was granted. The latter showed on its face that these broad claims were not made, and if the patentees were really the inventors of an independent jacket standing loosely on the elbow of the main, when apprised that it was not claimed in the patent, they ought to have used all diligence in surrendering it and having the mistake corrected." "There is a wide departure from the original invention, in this ; that the subject of the latter was a jacket or casing whose top was enclosed in and covered by a flange projecting from the hydrant, which effectually prevented the removal of the jacket without removing the hydrant also, and which caused the hydrant to be raised when the jacket was lifted by the frost. In the reissued patent nothing is said of this arrangement of the top of the jacket and the claims ignore it altogether, so that, as already intimated, the patent as it now stands would cover such a jacket as that described and claimed in the complainant's patent of 1869, which slides like a sleeve over the hydrant at the top as well as the bottom. The reissue is not only for a broader claim made many years after the original was granted, but is for a different invention ; therefore so far as the jacket is concerned, we think it cannot be sustained."

In the case of *Heald v. Rice*,¹ which followed soon

¹21 O. G. 1443.

after the case last mentioned, the original patent was for an improvement in return flue boilers with a casual mention of a straw-feeding attachment for the furnace, and in the reissue a claim was procured for a combination of the straw-feeding attachment with a return flue boiler: the Supreme Court held the reissue void as being for a different invention from the original and said: "In the present case the extent of the identity of the invention in the original and reissued patents is to be determined from their face by mere comparison notwithstanding what was said in *Batten v. Taggart*, (17 Howard, 74), and consistently with *Bischoff v. Wetherelt* (9 Wallace, 812), according to the rule laid down in *Seymour v. Osborne* (11 Wallace, 545), and the *Powder Co. v. Powder Works* (19 U. S. 134), that is, if it appears from the face of the instrument that extrinsic evidence is not needed to explain the terms of art or to apply the description to the special matter so that the court is able from mere comparison to say what are the inventions described in each, and to affirm from such mere comparison that they are not the same but different, then the question of identity is one of pure construction, and not of evidence, and consequently is matter of law for the court without any auxiliary matter of fact to be passed upon by a jury if the action be at law."

The Supreme Court has not specifically said, as it cannot specifically say, how long a patentee shall be allowed to wait, after the issue of his original patent before making application for a reissue which shall broaden his claim, and has said in substance that unreasonable delay will not be permitted. What constitutes unreasonable delay, in any particular case will depend upon the facts

of that case; and a time which would be permissible under one set of circumstances obviously will not be permissible under another and different set of circumstances; for instance, it is obvious that a longer time would be allowed for the procurement of the reissue in the case where no interfering interests arise in the meantime, than in that case where the reissue is obviously desired for the sake of covering modifications or improvements which have been introduced into the market by others since the issue of the original patent. One or more of these decisions of the Supreme Court make an allusion to the two years allowed by law wherein an inventor may permit his invention to go into public use without invalidating his right to the original patent, but it is not to be inferred therefrom that the same delay of two years is to be allowed in all cases for procuring reissues of original patents: a circuit judge in speaking of this question says that the Supreme Court "does not seem to hold that two years are to be allowed in which to reclaim what is so described,"¹ and another circuit judge, in speaking of what Justice Bradley said in *Miller v. Brass Co.*, says: "He intimates that two years, in analogy to the law of forfeiture, would be the utmost limit of time, but as I understand the opinion that anything like two years would be inadmissible in ordinary cases."²

It does not follow that a reissue is valid from the fact that its claim is narrowed as compared with the original claim, for in the reissue in question in the case of *Heald*

¹*Mackay v. Jackman*, 12 Fed. Rep. 615.

²*Jones v. Barker*, 11 Fed. Rep. 597.

v. *Rice*, before mentioned, the claim was of that class; the original claim being for an improvement in a return flue boiler, the reissue claim was narrowed by making it to cover a combination of the return flue boiler and a straw-feeding attachment, yet the claim was held void as being a claim for a different invention from that described in the original patent: and the point is one easily understood, for the original patent set out that the improvement pertained to a return flue boiler, mention of the straw-feeding attachment being merely incidental and casual; and when the patentee brought in the straw-feeding attachment as a feature of the invention, he departed by a palpable interval from the statement of his original.



CHAPTER XIV.

EXTENSION.

The Extension Statute. The statute enacts:—
“*Sec. 4924.* Where the patentee of any invention or discovery, the patent for which was granted prior to the second day of March, eighteen hundred and sixty-one, shall desire an extension of this patent beyond the original term of its limitation, he shall make application therefor in writing to the Commissioner of Patents, setting forth the reasons why such extension should be granted; and he shall also furnish a written statement under oath of the ascertained value of the invention or discovery, and of his receipts and expenditures on account thereof, sufficiently in detail to exhibit a true and faithful account of the loss and profit in any manner accruing to him by reason of the invention or discovery. Such application shall be filed not more than six months nor less than ninety days before the expiration of the original term of the patent; and no extension shall be granted after the expiration of the term.

Sec. 4925. Upon the receipt of such application and the payment of the fee required by law, the Commissioner shall cause to be published in one newspaper in the city of Washington, and in such other papers pub:

lished in the section of the country most interested adversely to the extension of the patent as he may deem proper, for at least sixty days prior to the day set for hearing the case, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted.

Sec. 4926. Upon the publication of the notice of an application for an extension, the Commissioner shall refer the case to the principal examiner having charge of the class of inventions to which it belongs, who shall make the Commissioner a full report of the case, stating particularly whether the invention or discovery was new and patentable when the original patent was granted.

Sec. 4927. The Commissioner shall, at the time and place designated in the published notice, hear and decide upon the evidence produced both for and against the extension; and if it shall appear to the satisfaction of the Commissioner that the patentee, without neglect or fault on his part, has failed to obtain from the use and sale of his invention or discovery a reasonable remuneration for the time, ingenuity, and expense bestowed upon it, and the introduction of it into use, and that it is just and proper, having due regard to the public interest, that the term of the patent should be extended, the Commissioner shall make a certificate thereon, renewing and extending the patent for the term of seven years from the expiration of the first term. Such certificate shall be recorded in the Patent Office; and thereupon such patent shall have the same effect in law as though it had been originally granted for twenty-one years.

Sec. 4928. The benefit of the extension of a patent shall extend to the assignees and grantees of the right to use the thing patented, to the extent of their interest therein.

Sec. 4934. The following shall be the rates for patent fees :

* * * * *

On every application for the extension of a patent, fifty dollars.

On the granting of every extension of a patent, fifty dollars."¹

That part of the statutes relating to extensions was formerly of great importance ; but, aside from design patents, it has no present application to any existing patents, for the statute allowing extensions refers only to patents granted prior to March 2, 1861, which ran for fourteen years only, and the last of them expired March 2, 1875. Patents, are, however, sometimes extended by virtue of special acts of Congress ; and in such cases, the applicant is generally sent to the Commissioner of Patents to have the merits of his case tried under the old law : for this reason, and for the additional reason that the statute allowing extensions may possibly be applicable to design patents granted for fourteen years prior to the Act of July 8th, 1870, the matter is yet of interest.

Extensions in the Patent Office. It is impracticable here to more than indicate from the past record of the Patent Office its action upon an application for extension, for that office has never had the stability of a court

¹Rev. Stat. Title LX. Chap. 1.

as to any matters, and has practically held that an application for extension is a purely equitable proceeding, wherein each case stands on its own footing, with but little regard to precedent. It is, however, well settled, that when a patent is before the Patent Office for extension, any claim found to lack novelty must be disclaimed before the patent will be extended ;¹ it is tolerably well settled that reissued patents unduly expanded will not be extended,² and that the inventor must hold either the whole or a substantial interest in the extension.³

It is also settled that lack of novelty, or the presence of but slight novelty coupled with less than large utility, is a bar to extension. On the question of adequate remuneration the Office holds that small remuneration is adequate in the case of an unimportant invention, \$7,000 having been held adequate in a case where the patented thing was a nipple shield ;⁴ but that very much larger remuneration is inadequate in the case of a valuable invention, \$73,000, and probably more, being held inadequate in the case of a tuck marker.⁵ On the question of public policy the Office holds that to extend an American patent when a foreign patent on the same thing has ex-

¹ *Humiston's Ext.* C. D. 1869, p. 47 ; *... ne's Ext.* C. D. 1869, p. 48 ; *Williams' Ext.* C. D. 1871, p. 93 ; *Munger's Ext.* C. D. 1871, p. 203 ; *Robbins' Ext.* C. D. 1873, p. 46.

² *Krake's Ext.* C. D. 1869, p. 100 ; *Hunt's Ext.* C. D. 1870, p. 29 ; *Lyman's Ext.* C. D. 1872, p. 262 ; *Floyd's Ext.* C. D. 1874, p. 104.

³ *Hayes' Ext.* C. D. 1870, p. 77 ; *Boynton's Ext.* C. D. 1870, p. 125 ; *Gleason & Crossman's Ext.* C. D. 1870, p. 158 ; *Mason's Ext.* C. D. 1871, p. 182 ; *Baker's Ext.* C. D. 1872 p. 127.

⁴ *Needham's Ext.* C. D. 1871, p. 3.

⁵ *Fuller's Ext.* C. D. 1874, p. 54.

pired, and thus subject home manufacturers to a tax not imposed on the foreign, makes against extension,¹ and at different times has refused to extend patents which control improvements of general importance where the right was not very clear.

Constructions of the Extension Statute. Patents can be extended upon an application of the executors or administrators of deceased inventors for the benefit of the heirs.²

“Congress have not only secured to the inventor this absolute and indefeasible interest and property in the subject of the invention for the fourteen years, but has also agreed that upon certain conditions occurring and to be shown, before the expiration of this period, * * * *, this right of property in the invention shall be continued for the further term of seven years. Subject to this condition, the right of property in the second term is as perfect to the extent of the interest, as the right of property in the first.”³ A patent extended by special Act of Congress, stands upon the same footing as if extended by the Commissioner of Patents under the statute.⁴ When a patent has been extended by the Commissioner of Patents, his action is conclusive as to all the facts he is required to find, and cannot afterward be disputed except on proof of fraud in the allowance of the exten-

¹*Bessemer's Ext.* C. D. 1870, p. 9.

²*Brooks v. Bicknell*, 3 McLean, 436; *Woodworth v. Wilson*, 4 How. 716.

³*Wilson v. Rousseau*, 4 How. 646.

⁴*Evans v. Eaton*, 3 Wheaton, 518.

sion.¹ An extended patent cannot be impeached at all collaterally ; that is, for instance, as a defence to an infringement suit ; but the impeachment must be by a suit specially brought for that purpose.² No assignment, grant, or license, made during the existence of the original term will have any force or effect upon an extended term, unless the instrument expressly applies to the extended term, or unless the instrument contains a strong implication to that effect.³ "The right of an owner of a patented machine, without any conditions attached to his ownership, to continue the use of his machine during an extended term of the patent, is well settled."⁴ Where a person has the right to use a machine under restrictions during the original term of a patent, he has a right to continue the use of the machine during the extended term of the patent under the same restrictions unless there is some express provision to the contrary.⁵

Extension of Design Patents. The Patent Office has decided that design patents granted subsequent to the Act of March 2, 1861, and prior to the Act of July 8, 1870, are not, since the passage of the latter Act, extensible.⁶ The statute of March 2, 1861, enacts :

¹ *Colt v. Young*, 2 Blatch. 473 ; *Clum v. Brewer*, 2 Curtis, 518 ; *Goodyear v. P. R. Co.*, 2 Fisher's Pat. Cases, 499.

² *Tilghman v. Mitchell*, 4 Fisher's Pat. Cases, 615 ; *Rubber Co. v. Goodyear*, 9 Wall. 788.

³ *Woodworth v. Sherman*, 3 Story, 174 ; *Brooks v. Bicknell*, 4 McLean, 66 ; *Day v. Candee*, 3 Fisher's Pat. Cases, 9.

⁴ *Union Pap. Bag Machine Co. v. Nixon*, 21 O. G. 1275 ; *Chaffee v. Belting Co.*, 22 How, 217.

⁵ *Day v. Union Rubber So.*, 3 Blatch. 491.

⁶ *Sperry's Ext. C. D.* 1870, p. 139.

Sec. 2. "And be it further enacted, * * * * * that the patentees of designs, under this Act, shall be entitled to the extension of their respective patents, for the term of seven years from the day on which said patents shall expire, upon the same terms and restrictions as are now provided for the extension of letters patent."

This Act of March 2, 1861, was repealed by the Act of July 8, 1870, with the following saving clause in *Sec. 3.* "*Provided, however,* that the repeal hereby enacted shall not affect, impair, or take away any right existing under any of said laws." As a patent is a bargain between the patentee and the public;¹ as one of the considerations moving from the public to the patentee of a design under the Act of March 2, 1861,—and prior to the Act of July 8, 1870—was, that such patents should be, under the usual conditions, extensible; as there is no express prohibition in the Act of July 8, 1870, against such extensibility, but rather a preservation of the right; and as the Supreme Court has expressly decided that the right to extension, when the proper conditions are fulfilled, is indefeasible,² the decision of the Patent Office is probably erroneous. If erroneous, any design patent granted prior to the Act of July 8, 1870, still in life, is regularly extensible. As some of those design patents were granted for a term of fourteen years, this question will not cease to be of interest until July 8, 1884. Design patents granted since the passage of the Act of July 8, 1870, are clearly not extensible.

¹ *Page v. Ferry*, 1 Fisher's Pat. Cases, 298.

² *Wilson v. Rousseau*, 4 How. 646.

CHAPTER XV.

THE TITLE.

THE statute enacts: "*Sec. 4898.* Every patent or any interest therein shall be assignable in law by an instrument in writing; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof."¹

There are three instruments conveying interests in patents, specified in the above quoted section,—assignments, grants, and mortgages; there is a fourth instrument, conveying an interest in a patent, not specified in the statute, but born of the common law,—a license. This chapter will be devoted to the discussion and explanation of these instruments, the interests acquired by them and kindred matters.

An Assignment is an instrument in writing—not

¹Rev. Stat. Title LX. Chap. 1.

excluding print—conveying either the whole interest in the entire patent, or an undivided part thereof.

“An assignee is one who has transferred to him in writing the whole interest of the original patent, or an undivided part of such whole interest in every portion of the United States, and no one, unless he has such an interest transferred to him, is an assignee.”¹ An assignment must convey to the assignee *all*, or an undivided part of *all*, the rights which were before vested in the original patentee. These rights are, the right to make, the right to use, the right to vend to others to use, the right to convey any and all of the first three rights mentioned, by assignment, grant, and license, to other parties, and such rights of reissue as pertain to the owner of a patent. Any instrument which does not convey *all*, or any undivided part of *all*, these rights, and put the assignees into the shoes of the patentee in all these particulars, is not an assignment. An assignor must place an “assignee upon equal footing with himself for the part assigned. The assignment must undoubtedly convey * * * * the entire and unqualified monopoly which the patentee held in the territory specified, excluding the patentee himself as well as others. An assignment short of this is a mere license.”² From this, it follows that if a patentee convey to another the exclusive right to make, vend, and use under a patent, and yet does not give such other persons the right to convey any and all of these rights to others, freely and unqualifiedly, or retains his reissue rights, then the conveyance is a mere license.

¹*Potter v. Holland*, 1 Fisher's Pat. Cases, 327.

²*Gaylor v. Wilder*, 10 How. 477.

No particular form of words is necessary to constitute either an assignment or a grant ; if the meaning is clear, that the maker intended to convey either of the interests defined herein as constituting an assignment or a grant, the courts will construe the writing accordingly. Although the statute specifies an instrument in writing, an instrument which is partly written and partly printed, or wholly printed with a written signature, will suffice. An assignment, grant, or license does not need sealing, witnessing, or acknowledging, to make it valid ; but witnesses to such a paper are always advisable. A party must be the sole owner of the whole patent, or a grantee under the patent, to be able to bring a suit in his own name for infringement. A mere licensee can not bring such suit. A grantee can only bring such suit for infringement in the district owned by him.

An assignment, and probably a grant, can be made as well before the issue of a patent as after, and, if the conveyance contains a request to that effect, the patent will issue in the name of the assignee. A contract to assign future inventions in a given field is a contract that the courts will enforce.¹

When an assignment or grant of a patent has been made, it extends to the end of the original term of the patent, and includes all reissues of the patent during that term.² But an assignment of a patent will not include the right to an extension of the same beyond the original term, without the presence of the clearest wording to that effect.³ To assign the patent for the "term

¹ *Nesmith v. Calvert*, 1 Wood and Minn., 34.

² *Wyeth v. Stone*, 1 Story, 273 ; *Brooks v. Bicknell*, 4 McLean, 64.

³ *Brooks v. Bicknell*, 4 McLean, 64.

for which the said letters-patent are or may be granted," is sufficient.¹

An assignment which covers and includes "improvements to be subsequently invented or patented * * in or of, or in aid of, the inventions and improvements patented" does not cover subsequently invented devices which are not infringements of the original patent.² He to whom a patent issues is to be deemed to be the owner of the patent in the absence of evidence to the contrary.³ The absence of the seal of a corporation from an assignment made by it, does not invalidate the assignment, for such an instrument does not require a seal.⁴ "The mere assignment of a patent would give the assignee no right to damages or profits already accrued."⁵

Assignment by Insolvent. Almost or quite all the States have insolvent laws ; and, as persons owning patents sometimes come under the operation of such laws, it becomes important to know whether an assignment of the patent of an insolvent person, signed by his assignee or trustee by the court, will pass the legal title. Judge Blatchford held that a receiver can not give an assignment of a patent owned by him for whom he is receiver.⁶ In Massachusetts, the insolvent law authorized the the judge, "by an instrument under his hand, to assign and convey

¹ *Thayer v. Wales*, 5 Fisher's Pat. Cases. 448 ; *Nicolson Pavement Co. v. Jenkins*, 5 Fisher's Pat. Cases, 491.

² *Stebbins H. E. Mfg Co. v. Stebbins*, 4 Fed. Rep. 445.

³ *W. & M. Mfg Co. v. Haish*, 4 Fed. Rep. 900.

⁴ *Gottfried v. Miller*, 21 O. G. 711.

⁵ *Merriam v. Smith*, 11 Fed. Rep. 588.

⁶ *Gordon v. Anthony*, 16 O. G. 1135.

to the assignee all the estate, real and personal, of the debtor"; and it also provides that such "assignment shall vest in the assignee all the property, real and personal, which he could lawfully have sold, assigned, or conveyed, or which might have been taken in execution upon a judgment against him." Judge Shepley held that an assignment of an insolvent debtor's patent by the assignee in insolvency, under such law, does not pass the legal title to such patent, but that the debtor must be made by the court to make an assignment in person.¹ There would seem to be no good reason why the same course would not be necessary with a bankrupt patent owner under a general United States bankrupt law, unless such law itself specifically provided otherwise.

Undivided Interests in Patents. The relations that exist at law between joint owners of patents is a matter of importance. Assignments of undivided interests are very common, but a knowledge of their effect is not so common. Joint owners of undivided interests in a patent are not partners, in any sense, merely from the fact of their joint ownership of the patent. Either owner can sell the whole of his share without the consent of the other, or he can work the patent without any liability to contribute any part of his profits to another owner; and it would seem, on principle, that either of the joint owners can grant all the licenses he pleases and keep all the money he gets therefor. Neither of the joint owners of a patent, nor any number of them short of the owners, can grant or give an *exclusive* right of any kind.

¹ *Ashcroft v. Walworth*, 5 Fisher's Pat. Cases, 528.

The relative rights of joint owners of a patent are those of tenants in common : one joint owner has as good right to use and license others to use the thing patented as another joint owner. Neither has a superior right over another, and one such owner can not prevent another from using the patented thing or licensing others to use it.¹

In commenting on this question a learned judge said : "None of the parties interested has any right to control the action of the other parties or to exercise any supervision over them. It is difficult to see how an equitable right of contribution can exist among any of them, unless it includes all the parties interested and extends through the whole term of the patent right. And if there be a claim for contribution of profits, there should also be a correlative claim for losses, and an obligation upon each party to use due diligence in making his interest profitable. It is not and cannot be contended that these parties are copartners ; but the idea of mutual contribution for profits and losses would require even more than copartners."² In one place it was held that a joint owner of a patent can not use a device differing from the device described in the patent but covered by its claim ; it is difficult to see how such a decision is reconcilable with the previous decisions carrying the weight of authority.³

A Grant is an instrument, in writing, conveying the whole monopoly and rights, as to a patent, originally

¹ *Clum v. Brewer*, 2 Curtis, 524.

² *Vose v. Singer*, 4 Allen, 226 : Mass. 1862.

³ *Herring v. Gas Consumers' Association*, 9 Fed. Rep. 556.

vested in a patentee, throughout a specified portion of the United States. A grant is practically a territorial assignment, and a grant must convey the same rights as an assignment, as to the territory specified; otherwise the conveyance is only a license. Assignments and grants are generally spoken of indiscriminately as assignments; but the law recognizes a technical difference. "The terms assignee and grantee are not used in the patent law as synonomous terms, though courts, without having their attention particularly called to the subject, have sometimes used them indiscriminately and in their popular sense."¹ The distinction between an assignee and a grantee is this: "An assignee is one who has transferred to him, in writing, the whole interest of the original patent, or an undivided part of such whole interest, in every portion of the United States. And no one, unless he has such an interest transferred to him, is an assignee. A grantee is one who has transferred to him, in writing, the *exclusive* right, under the patent, to make and use, and to grant to others to make and use, the things patented, within and throughout some specified part or portion of the United States."²

When a grantee of a territorial right under a patent sells the patented articles to another, without any restrictions, such other person may take the articles outside the grantee's territory and sell or use them, without he or the seller being liable as an infringer.³ This decision is a most important one, as affecting the interests of patent owners; all grants should be made upon the express

¹ *Potter v. Holland*, 1 Fisher's Pat. Cases, 327.

² *Potter v. Holland*, 1 Fisher's Pat. Cases, 327.

³ *Adams v. Burke*, 4 Fisher's Pat. Cases, 392; *Adams v. Burke*, 17 Wall. 414.

condition, that the grantee shall not sell the patented article to be sold again or used outside his territory, and that the grantee shall, when selling the patented article, sell with the restriction that such articles shall not be sold outside his territory. On principle, no distinction can be seen, as regards this point, between a territorial grantee, and a territorial licensee.

A License is a conveyance of an interest in a patent, less than an assignment or grant. It need not, necessarily, be in writing,¹ though otherwise it might be very hard to prove; and it does not need to be recorded.² It is not a creature of the statute, but of the common law. A license is usually a permit to make, or use, or sell the thing patented, or to do two or more of these three things; and it may be an exclusive right to do all these things throughout the whole United States, and yet not amount to assignment, unless it convey the right to convey all of these rights to others, and all rights of re-issue. A conveyance, to amount to an assignment or grant, must put the person to whom a right is thereby conveyed into the very standing and shoes of the patentee, as to the portion of the patent conveyed. Anything that conveys a less right is a license. No particular form of words is necessary to constitute a license; the expressed intent of the maker of the conveyance will suffice, no matter what words he uses, though it is customary and proper to use the word "license" in distinction from "assign" or "grant," as the operating word in

¹ *Potter v. Holland*, 1 Fisher's Pat. Cases, 327.

² *Chambers v. Smith*, 5 Fisher's Pat. Cases, 12,

a license. A licensee cannot bring a suit for infringement in his own name, while the grantee of a particular district, or the assignee of the whole patent can.

By means of licenses, a patent owner may erect many distinct and separable interests under a patent. He may give one person the exclusive right to *make* the patented article in a certain district or through the whole United States; he may give to another the exclusive right to *use*, and to still another the exclusive right to *sell*; or he may give to different persons a common right to *make*, or to *use*, or to *sell*, one or all, in a certain territory or through the whole United States.

A license to a party which does not, in terms, or by equivalent words, showing that it was meant to be assignable, give the right to the licensee to assign the same, is a mere personal privilege and not transferable by the act of the licensee.¹ A license which is not expressed to be for the whole term of the patent, is revocable by the maker, and, being so revoked, the right of the licensee comes to an end; but if the license is expressed to be for the whole term of the patent, then it is not revocable, and, if a shop-license is paid for, in advance, by a gross sum of money, then the license would not be revocable, unless expressly stated to be.

Licenses may be granted with conditions of forfeiture attached, such as the payment of a royalty or the use of due diligence in carrying on business under the patent; and, if such condition is broken by the licensee, he forfeits his right to the license, and he may be proceeded

¹ *Troy Iron and Nail Factory v. Corning*, 14 How. 216,

against like any other infringer subject to conditions expressed shortly hereinafter.¹

A licensee is not estopped, merely by his action in taking a license, from denying the validity of the patent or setting up any defense that any other person might make,² but he is bound and estopped by recitals and covenants contained in the license.³

If an inventor, before procuring a patent, allows another person to make the article afterward patented, or acquiesce in such making or in a use of the invention, this the law construes as a license, from the inventor to such other person, to use the patented thing after the grant of the patent.⁴ Assignees of patents take the patents assigned subject to all prior licenses;⁵ in the case of a revocable license, the assignment of the patent works a revocation of license.⁶

A license to use an invention by a person only at "his own establishment" does not authorize a use at an establishment owned by the licensee and another.⁷

If a party who has a license repudiates it he cannot afterwards, when sued as an infringer, justify under the license.⁸

¹ *Woodworth v. Cook*, 2 Blatch. 160; *Bell v. McCullough*, 1 Fisher's Pat. Cases, 380.

² *Burr v. Duryee*, 2 Fisher's Pat. Cases, 275.

³ *Wooster v. Taylor*, 8 O. G. 644.

⁴ *McClurg v. Kingsland*, 1 Howard, 202.

⁵ *McClurg v. Kingsland*, 1 Howard, 202.

⁶ *Faulks v. Kamp*, 3 Fed. Rep. 898; *Shaw v. Colwell Lead Co.*, 11 Fed. Rep. 711.

⁷ *Rubber Co. v. Goodyear*, 9 Wall. 788.

⁸ *Cohn v. Nat'l Rubber Co.*, 15 O. G. 829.

When a license contains a condition the breach of which works a forfeiture of the license, the mere breach does not of itself work the forfeiture or revocation, but a court must pass upon the question, and decide that the breach has occurred, and that the forfeiture or revocation is consummated; if, however, a license contains an express provision that the mere breach of a condition or the mere happening of an event, shall work a forfeiture or revocation of the license, in that case the decision of a court might not be requisite to the perfection of the forfeiture or revocation: in the case where a license is forfeitable or revocable, a suit for infringement will not lie against a license after the breach of a condition until a court, in a suit instituted for that purpose has decreed that the forfeiture has been consummated; unless, as before stated, the express terms of the license are such that the breach itself works and perfects the forfeiture.¹

A license which authorizes the licensee to use the patent "for his own proper business" does not authorize the licensee to permit another to use the patent.²

Where the license is granted to use a certain machine the patented part whereof is a combination, parts of the machine which become worn out may be replaced, and the use of the machine continued under the license. If the patented part had been a single part of the structure, and that part had worn out, the user would have no right to replace it.³

¹*Pentlarge v. Beeston*, 1 Fed. Rep. 862; *White v. Lee*, 3 Fed. Rep. 222; *Hartell v. Tilghman*, 99 U. S. 547; *Adams v. Meyrose*, 7 Fed. Rep. 208; *Adams v. Meyrose*, 10 Fed. Rep. 671.

²*Putnam v. Hollender*, 6 Fed. Rep. 882.

³*Gottfried v. C. S. Brewing Co.*, 8 Fed. Rep. 322.

A decree for damages, where the complainants have an established license fee, for the amount of such fee, gives the defendants—in some cases—a license to use the invention during the life of the patent.¹

Mortgage of Patents. Although the statute does not expressly state that patents may be legally mortgaged, it is clear, from the reference, in the section quoted at the beginning of this chapter, to “a mortgagee for a valuable consideration,” that a mortgage, properly made and recorded at the Patent Office, would be held valid by the courts. As no specific formula is necessary to constitute an assignment, or grant, or license, the same is, on principle, true as to a mortgage, and any instrument clearly expressing the idea that the maker intended to give a mortgage on his patent, would probably be held sufficient. It is probable that, if any form, which is legal and proper under the practice of any of the states, were followed, that would answer the requirements of the law. As an assignment does not need to be sealed, witnessed, or acknowledged, it would seem that a mortgage, which conveys a less interest, would not need these formalities; yet, in the absence of any statutory directions or adjudications upon this point, it might be advisable, and certainly not harmful, to follow the formalities prescribed for mortgages by the laws of the state where the patent mortgage is executed, and, in case an acknowledgement is taken, to have it taken by the clerk of a court of record having a seal. The mortgage would need to be recorded at the Patent Office.

¹*Emerson v. Simm*, 3 O. G. 293.

Warranty. If an assignment, grant, license, or any other conveyance under a patent contains no warranty of title, and no warranty as to the validity of the patent, it would seem that the assignee would take the interest pretended to be conveyed at his own risk as to the title of the assignor or grantor, and as to the validity of the patent. In the case where the paper simply transfers the right, title, and interest of the assignor, it is certainly a paper in the nature of a quit-claim, and if the title fail, or the patent prove invalid, the assignee or grantee can not recover back any money paid for the assignment or grant.¹ But it has been held—in the absence of a special warranty—that “whosoever assumes to sell a patent assumes to sell that property and assumes that he has it to sell.”²

Recording. The statute *directs* that an assignment or grant shall be recorded within three months from its date. This clause is merely directory. An assignment or grant is good and valid, as against the assignor or grantor, and all other persons whatever, except a subsequent *bona fide* purchaser or mortgagee for a valuable consideration, not having notice or knowledge of the prior assignment or grant, even if never recorded;³ though it would not, probably, be held valid, if unrecorded, against a creditor proceeding against the assignor or grantor by means of the insolvent or bankrupt laws. If a patentee were to assign his patent to a

¹ *Jolliffe v. Collins*, 21 Missouri, 341; *McClure v. Jeffrey*, 8 Indiana, 83.

² *Faulks v. Kamp*, 17 O. G. 851.

³ *Turnbull v. Weir Plow Co.*, 7 O. G. 173.

person who did not, within three months, put the same upon the Patent Office records, and then the patentee should sell the patent to a second purchaser who knew nothing of the prior assignment, and the second purchaser should have his assignment properly recorded, he would take a legal title, and the first purchaser would have no interest in the patent; but, if the second purchaser knew, at the time he took his assignment, of the prior assignment, then the second purchaser would get no title.¹ Licenses do not need to be recorded,² and it is of no legal avail to record any paper which is not required to be recorded by statute. Judge Blatchford said upon this topic: "Fees are prescribed * for recording every assignment, agreement, power of attorney, or other paper; but it does not follow from this that the record of every paper which may happen to be recorded is to be taken as constructive notice of its contents to every person subsequently dealing with a party to it with respect to its subject-matter. The record of an instrument is not constructive notice to a subsequent purchaser unless the statute requires the instrument to be recorded."³

Employer and Employee. An employer is not necessarily entitled to an invention made by a workman in his employ. It would require a distinct contract or

¹ *Holden v. Curtis*, 2 N. H. 63; *Brooks v. Byam*, 2 Story, 542; *Pitts v. Whitman*, 2 Story, 615; *Boyd v. McAlpin*, 3 McLean, 429; *Case v. Redfield*, 4 McLean, 527; *Gibson v. Cook*, 2 Blatchford, 148.

² *Hamilton v. Kingsbury*, 4 Fed. Rep. 428.

³ *Wright v. Randel*, 8 Fed. Rep. 591.

understanding to that effect, to entitle the employer to the patent. A simple contract for the labor of a man at any ordinary trade, profession, or occupation, does not include a right to the inventions made by the employee whether relating to the business at which the person is employed or not; but if a man is employed for the purpose, wholly or partially, of making improvements in any branch of trade or manufacture, then his inventions would belong to the employer. Where, in the absence of any specific understanding or contract, a man makes an invention in the time of his employer, using his tools and materials in experiments and construction, this would furnish strong evidence that the improvement was intended to be for the benefit of the employer. In any case, the application for patent must be made by the inventor, and, if it belongs to the employer, assigned to him. If an employee, after making an invention which would equitably belong to the employer, were to refuse to apply for a patent and to assign the same, the employer's remedy would lie in an application to a court of equity, to compel the inventor to take these steps. In one case it was held that where an inventor practically developed his improvement in the employ of another, and saw such other put the improvement in practice without objection and without demand for consideration, the acts of the inventor amounted to a license to the other party which remained in force after the inventor procured the patent.¹

In another case it was held that where an ordinary employee, not hired to invent, made and patented an improvement during his employment at the expense of

¹*McClurg v. Kingsland*, 1 How. 202.

the employer, that such employer did not thereby acquire a title to the patent ; also that if this state of facts constitute a license, such a license was not transferable ; and in case such license was a corporation, the right would die with the dissolution of the corporation.¹

Various Points Relating to Title. Upon the question as to whether patents may be directly attached and sold in execution the Supreme Court said : "There would certainly be great difficulty in assenting to the proposition that patent and copyrights held under the laws of the United States are subject to seizure and sale on execution. Not to repeat what is said in 14 Howard, 531, it may be added that these incorporeal rights do not exist in any particular state or district, they are co-extensive with the invention. There is nothing in any Act of Congress, or in the nature of the rights themselves, to give them locality anywhere, so as to subject them to the process of courts having jurisdiction limited by a line of states and districts."² But the Supreme Court afterward held that a patent right may be ordered by a court of equity to be sold, and the proceeds applied to the payment of a judgment debt of the patentee ;³ a patent can not only be made available in this way for the payment of a debt, but under the insolvent law of a state, or a general bankrupt law, the insolvent or bankrupt may be compelled by the court having jurisdiction to assign the patent to the trustee for the benefit of the creditors.

¹*Hapgood v. Hewett*, 11 Fed. Rep. 422.

²*Stevens v. Gladding*, 14 How. 447.

³*Ager v. Murray*, 21 O. G. 1196.

The fact that a machine is patented does not prevent its being levied upon and sold under state laws ; but such a levy only passes right to the *materials* of which the machine is composed ; it gives no right to work the machine.¹

“Patented implements or machines sold to be used in the ordinary pursuits of life become the private individual property of the purchasers, and are no longer specifically protected by the patent laws of the state where the implements or machines are owned and used. Sales of the kind may be made by the patentee with or without conditions, as in other cases, but where the sale is absolute, and without any conditions, the rule is well settled that the purchaser may continue to use the implement or machine purchased until it is worn out, or he may repair it or improve upon it as he pleases, in same manner as if dealing with property of any other kind.”

“The right of an owner of a patented machine, without any conditions attached to his ownership, to continue the use of his machine during an extended term of the patent, is well settled.”²

Skilled Aid to Inventors. It is not irrelevant to the general topic now under consideration to inquire to what extent a person, who has conceived the main principle or characteristic of an invention, is entitled to employ the services of scientific men or skilled workmen in putting his ideas into practice, without violating his right to a patent for the resultant product.

¹ *Sawin v. Guild*, 1 Gall. 487 ; *Stevens v. Cady*, 14 Howard, 530.

² *Union P. B. Machine Co. v. Nixon*, 21 O. G. 1275.

Upon this point, Chief Justice Taney, speaking for the Supreme Court, said in a case where Morse's telegraph patent was under consideration: "Neither can the inquiries he made, or the information or advice he received from men of science, in the course of his researches, impair his right to the character of an inventor. No invention can possibly be made, consisting of a combination of different elements of power, without a thorough knowledge of the properties of each of them, and of the mode in which they operate on each other; and it can make no difference in this respect, whether he derives his information from books or from conversation with men skilled in the science. If it were otherwise, no patent in which a combination of different elements is used, could be obtained; for no man ever made an invention without having first obtained this information, unless it was discovered by some fortunate accident. And it is evident, that such an invention as the electromagnetic telegraph could never have been brought into action without it; for a very high degree of scientific knowledge and the nicest skill in the mechanic arts are combined in it, and were both necessary to bring it into successful operation. And the fact that Morse sought and obtained the necessary information and counsel from the best sources, and acted upon it, neither impairs his rights as an inventor, nor detracts from his merits."¹

The following excerpt from the decision of Judge Betts, in another case, gives the facts and the law applied to them: "It is contended that Berry was the inventor, and not the plaintiffs; which position, if established,

¹ *O'Reilly v. Morse*, 15 Howard, 62.

would be a good ground to dissolve the injunction. The defendants lay before the court the declaration of Berry, in connection with his working without any draft, design, or model before him, which, the defendants insist, proves him to be the inventor. But, on the other hand, Mr. Kelsey details very minutely the suggestions he made, his superintendence, his suggesting alterations in a design got up, his disapproving that, and the adoption of his views in the design now patented. And Mr. Berry gives his own account of the matter, and explains the declarations attributed to him, as referring to his working without a copy before him, and to the design being an original and not a copy. He does not intimate that he did not receive suggestions, alterations, and directions from Mr. Kelsey, which were carried out in his design. To constitute an inventor, it is not necessary he should have the manual skill and dexterity to make the drafts. If the ideas are furnished by him, for producing the result aimed at, he is entitled to avail himself of the mechanical skill of others, to carry out practically his contrivance. Here the devising of the pattern, in this sense, appears to have been by the plaintiffs." ¹ Excerpt from a Supreme Court case: "Where a person has discovered an improved principle in a machine, manufacture, or composition of matter, and employs others to assist him in carrying out that principle, and they, in the course of experiments arising from that employment, make valuable discoveries ancillary to the plan and preconceived design of the employer, such suggested improvements are in general to be regarded as the property of the party

¹ *Sparkman v. Higgins*, 1 Blatchford, 205.

who discovered the original improved principle, and may be embodied in his patent as a part of his invention.

Suggestions from another, made during the progress of such experiments, in order that they may be sufficient to defeat a patent subsequently issued, must have embraced the plan of the improvement, and must have furnished such information to the person to whom the communication was made that it would have enabled an ordinary mechanic, without the exercise of any ingenuity and special skill on his part, to construct and put the improvement in successful operation.

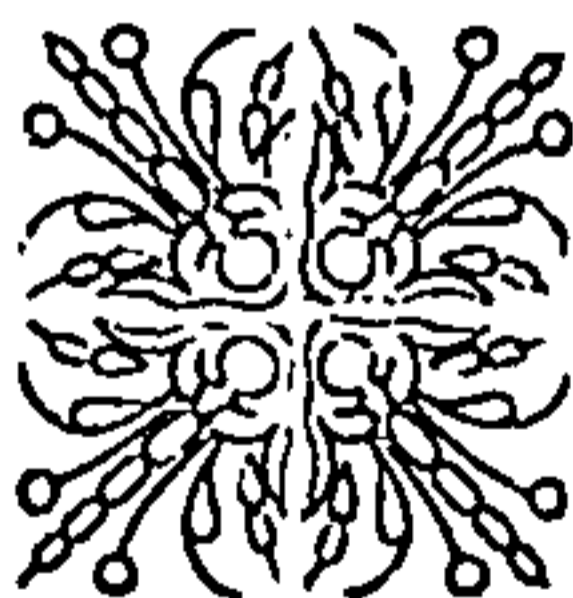
Persons employed, as much as employers, are entitled to their own independent inventions; but where the employer has conceived the plan of an invention and is engaged in experiments to perfect it, no suggestions from an employee, not amounting to a new method or arrangement, which, in itself, is a complete invention, is sufficient to deprive the employer of the exclusive property in the perfected improvement. But where the suggestions go to make up a complete and perfect machine, embracing the substance of all that is embodied in the patent subsequently issued to the party to whom the suggestions were made, the patent is invalid, because the real invention or discovery belonged to another."¹

From these and other cases, it appears that, when a person has in his mind the main features of an invention, or has grasped the general principles upon which it is to operate, he is entitled to the aid, counsels, and experiments of scientific men, and to the efforts and suggestions of skilled mechanics in reducing his invention to

¹*Agawan Company v. Jordan*, 2 *Whitman*, 202.

practice, and in embodying it in tangible materials, without forfeiting his right to the title of inventor. In one, and that a leading case, it was held, that, to invalidate a patent, suggestions made to the patentee by others, must furnish *all* the information necessary to construct the improvement, and that, if such suggestions fall short of suggesting a complete machine or other invention they are only suggestions and not inventions.¹

¹*Pitts v. Hall*, 2 Blatchford, 236; *Treadwell v. Parrott*, 3 Fisher's Pat. Cases, 124.



CHAPTER XVI.

DESIGN PATENTS.

THE statute enacts: "*Sec. 4929.* Any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, patent, [pattern,] print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the fee prescribed, and other due proceedings had, the same as in cases of inventions or discoveries, obtain a patent therefor."¹

The Patent Office does not require that models shall accompany applications for design patents. Design patents are granted for three and a half years upon a fee

¹Rev. Stat. Title LX. Chap. 1.

of ten dollars, or for seven years upon a fee of fifteen dollars, or for fourteen years upon a fee of thirty dollars, as the applicant, *in his application*, may elect.¹

Design patents granted prior to March 2, 1861, are made extensible, like other patents, by section 4932 of the Act of June 18, 1874. The Patent Office has decided that design patents granted subsequent to, and under the Act of March 2, 1861, are not, since the passage of the Act of July 8, 1870, extensible;² but this is believed to be a mistake.³ Design patents granted since and under the Act of July 8, 1870, are clearly not extensible.

Design patents are subject to the same provision, as to allowance of two years' public use, as other patents.⁴

Patentable Design The law creating design patents is of later origin than, and in some sort supplementary to, the law creating other patents. The first design patent law was the Act approved August 29, 1842. Such other patents, in view of the purposes they serve, may, not inappropriately, be called *utility* patents in distinction from these design patents, for it is evident that the design patent law is directed to the end of the protection of the appearance of a thing rather than the utility it is designed to subserve; the Supreme and other courts have agreed upon this much. It is true that the Act hereinbefore quoted specifies as patentable "any new, *useful*,

¹Sections 4930-4931, 4934, Chapter 1, Title LX. Rev. Stat.

²*E. W. Sperry's Case*, Commissioner's Decisions, 1870, p. 139.

³See Chapter on "Extension."

⁴*Root v. Ball*, 4 McLean, 177; *Booth v. Garelly*, 1 Blatch. 247.

and original shape or configuration of any article of manufacture," but it is not at all unreasonable to suppose that the legislator who drafted the clause, meant that the word "useful" should have substantially the same meaning here that it has in the part of the Act creating utility patents, this is, that the things presented for patent shall be designed for some useful purpose in distinction from a hurtful, frivolous, or immoral purpose.

For a time it was the practice of the Patent Office to grant these design patents for almost any subject matter presented, and with little or no inquiry as to whether any degree of patentable origination had been exercised. It is now tolerably well settled that design patents stand on as high a plane as utility patents, and require as high a degree of exercise of the inventive or originative faculty. In patentable designs a person can not be permitted to select an existing form, and simply put it to a new use, any more than he can be permitted to take a patent for a mere double use of a machine; but the selection and *adaptation* of an existing form may amount to patentable design, as the adaptation of an existing mechanical device may amount to patentable invention.

As most mechanical devices are combinations of mechanical elements, so designs are in general terms, combinations of the simpler elements of form; and as mere union of mechanical elements, where no resulting co-operation is brought into play, is not a patentable combination but a lifeless aggregation, so in designs, the mere juxtaposition of old forms or elements of form with no resulting harmony or unity does not give patentability. But the parallel between utility patents and design patents does not obtain in all directions: for instance, in

mechanical devices it is a vital matter in the determination of the question of substantial identity, that the same result is attained by substantially the same mechanisms; two mechanisms are not substantially the same, unless they use substantially the same means, operating in substantially the same manner, while in the case of designs result is the vital matter; if the things have substantially the same *appearance* it is not a vital matter that different things are used in the compared things to produce the sameness of result. Again, in determining substantial identity, the opinion of an expert is the test of substantial identity in mechanisms, while the eye of an ordinary observer is the test in designs.

Illustrative cases: Of a case where the patent was for a design for a reel, the court said: "Now, although it does not appear that any person ever before applied this particular shape to this particular article, I cannot think that the Act quoted above was intended to secure to the complainant an exclusive right to use this well-known figure in the manufacture of reels. The act, although it does not require utility in order to secure the benefit of its provisions, does require that the shape produced shall be the result of industry, effort, genius, or expense, and must also, I think, be held to require that the shape or configuration sought to be secured, shall at least be new and original as applied to articles of manufacture. * * * * * Its selection can hardly be said to be the result of effort even; it was simply an arbitrary, chance selection of one of many well-known shapes, all equally well adapted to the purpose. To hold that such an application of a common form can be secured by letters-patent, would be giving the Act of

1861 a construction broader than I am willing to give it." ¹

The Supreme Court said in another case :

"The Acts of Congress which authorize the grant of patents for designs, were plainly intended to give encouragement to the decorative arts. They contemplate not so much utility as appearance, and that not an abstract impression or picture, but an aspect given to those objects mentioned in the acts." * * * * *

"The thing invented or produced, for which a patent is given, is that which gives a peculiar or distinctive appearance to the manufacture or article to which it may be applied or to which it gives form. * * * * *

Manifestly, the mode in which these appearances are produced has very little, if anything, to do with giving increased salableness to the article. It is the appearance itself which attracts the attention and calls out favor or dislike. It is the appearance itself, therefore, no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense."

"The appearance may be the result of peculiarity of configuration, or of ornament alone, or of both conjointly ; but, in whatever way produced, it is the new thing or product which the patent law regards. I speak of the invention as a combination or process, or to treat it as such, is to overlook its peculiarities." * * * * *

"We do not say that in determining whether two designs are substantially the same, differences in the lines, the configuration, or the modes by which the aspects they exhibit are not to be considered ; but we think the controlling consideration is the resultant effect." ²

¹ *Wooster v. Crane*, 2 Fish. P. C. 583.

² *Gorham Mfg Co. v. White*, 14 Wall. 511.

Another court said in another case: "It is now well understood that the same degree of originality is required in both design and functional patents. That is, the claim must not be for a copy or imitation of what is already in existence. If, for instance, the applicants should manufacture their iron ware with a figure of the statue of the Three Graces, it might improve the appearance of the article, but would scarcely entitle them to the benefits of a patent. To manufacture it with enamel is a change of the same kind, for the same thing has been performed with metals from time immemorial. To give the enamel any particular color is a matter of ordinary skill and taste. The coloring substances have always been fused with the enamel in the heat of the furnace. We can, therefore, observe nothing in the present specification to which the term invention can be applied."¹

Another court, in another case, speaking of the sections of statute which create utility and design patents, said:

"The same general principles of construction extend to both. To entitle a party to the benefit of the Act, in either case there must be originality and the exercise of the inventive faculty. In the one, there must be novelty and utility; in the other, originality and beauty. Mere mechanical skill is insufficient. There must be something akin to genius—an effort of the brain as well as the hand. The adaptation of old devices or forms to new purposes, however convenient, useful, or beautiful they may be in their new role, is not invention." * * * *

"If a combination of old designs be patentable at all, of

¹*Niedringhaus Case*, 8 O. G. 279.

which I have some doubt, the combination must be such as to produce a new appearance. If the effect produced be simply the aggregation of familiar designs, it would not be patentable. For example, if one should paint upon a familiar vase a copy of Stuart's portrait of Washington it would not be patentable, because both elements of the combination, the portrait and the vase, are old ; but if 'any new and original impression or ornament' were placed upon the same vase, it would fall within the express language of the section."¹

In this last case the patented design for a cheese-safe consisted of an ordinary wooden safe, with ordinary wire cloth panels, the only novelty being an ogee moulding about the top and bottom, the combination of this with the paneled sides being claimed as the invention : the so-called design was held destitute of patentable novelty.

In another case where a design for stoves was in question, the court said : "Upon these similarities it is argued for the defendant that the patentees have only taken those parts of the other designs and put them together, in mere aggregation, to produce their design, and that in so taking them and putting them together they did not accomplish anything patentable. It is quite clear that anyone who should take pages or leaves from several books and put them together into a new book, or take parts of several musical compositions and put them together in a composition by themselves, would not be entitled to a copyright for these productions. (*Reed v. Carusi*, Dist. of Md. 1845, 8 Law Rep. 410.) And if all the patentees did was to take the legs of the Smith stove, the base of the Lighthouse, the ash-pit and

¹ *Northrup v. Adams*, 12 O. G. 431.

mica sections of the Smith stove, the reservoir and top of the American, and the urn of the Oriental, and join them together, it is also clear that they did nothing entitling themselves to a patent. (*Binns v. Woodruff*, 4 Wash., 48; *Wooster v. Crane*, 2 Fisher, 584.) Or, if they did no more than to join them together with such adaptations to each other as would be made by the exercise of the ordinary skill of workmen in that trade, probably they did not. But the evidence shows that they did much more than either. Although the legs of the Argand and of the Smith stove are *cyna reversa* in general form, those of the Argand are quite different from the others in proportion and style. The base of the Argand is not exactly like that of the Lighthouse. The curves of its ash-pit section are different from those of that section of the Smith stove. The lower mica section of the Smith stove is convex below and concave above in outward form, while that of the Argand is slightly convex throughout. The lines and curves of the mica section of the Argand are different from those of the Smith stove, and in the Argand the rear extension, to include the exit-pipe, is carried upward on that section, while in the Smith stove it is not. And the top and the urn of the Argand differ somewhat from those of either the Lighthouse or the Oriental."

"All these parts were made symmetrical of themselves and in respect to each other, and connected together with appropriate devices, and formed into a harmonious whole, in a manner that could not be done without creative genius and inventive skill. The result was different from anything used or known before."¹

¹*Perry v. Starrett*, 14 O. G. 600.

Infringement of Designs. In determining whether two mechanisms are substantially identical, the testimony of experts as to their opinion in the matter is admissible evidence, while in determining the identity of two designs expert testimony is not admissible, the test of sameness being the eye of an ordinary observer giving such attention as he would ordinarily give, such, for instance, as that of a casual purchaser of the goods bearing the design ; if the ordinary observer, giving ordinary attention, would mistake one design for the other, the two are substantially identical, otherwise not.

Cases in point :

In the first design patent case ever tried in this country, where a design for a stove was in question, the court said : "To infringe a patent right, it is not necessary that the thing patented should be adopted in every particular ; but if, as in the present case, the design and figures were substantially adopted by the defendants, they have infringed the plaintiff's right. If they adopt the same principle the defendants are guilty. The principle of a machine is that combination of mechanical powers which produces a certain result ; and, in a case like the present, where ornaments are used for a stove, it is an infringement to adopt the design so as to produce, substantially, the same appearance."¹

In a Supreme Court case already referred to in this chapter the court said : "We are now prepared to inquire what is the true test of identity of design. Plainly it must be sameness of appearance ; and mere difference of lines in the drawing or sketch, a greater or smaller

¹*Root v. Ball & Davis*, 4 McLean, 177.

number of lines, or slight variances in configuration, if insufficient to change the effect upon the eye, will not destroy the substantial identity. An engraving which has many lines may present to the eye the same picture and to the mind the same idea or conception as another with much fewer lines. The design, however, would be the same. So a pattern for a carpet or a print may be made up of wreaths of flowers arranged in a particular manner. Another carpet may have similar wreaths arranged in a like manner, so that none but very acute observers could detect a difference; yet in the wreaths upon one there may be fewer flowers, and the wreaths may be placed at wider distances from each other; surely, in such a case the designs are alike."

"The same conception was in the mind of the designer, and to that conception he gave expression."

"If, then, identity of appearance, or, as expressed in *McCrea v. Holdsworth*, sameness of effect upon the eye is the main test of substantial identity of design, the only remaining question upon this part of the case is, whether it is essential that the appearances should be the same to the eye of an expert. The court below was of opinion that the test of a patent for a design is not the eye of an ordinary observer. The learned judge thought there could be no infringement unless there was 'substantial identity' 'in view of the observation of a person versed in designs in the particular trade in question; of a person engaged in the manufacture or sale of articles containing such designs, of a person accustomed to compare such design, one with another, and who sees and examines the articles containing them side by side.'

There must, he thought, be a comparison of the features which make up the two designs. With this we can not concur. Such a test would destroy all the protection which the Act of Congress intended to give.

There never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another, so like that an expert could not distinguish them.

No counterfeit bank note is so identical in appearance with the true that an experienced artist cannot discern a difference. It is said an engraver distinguishes impressions made by the same plate. Experts, therefore, are not the persons to be deceived.

Much less than that which would be substantial identity in their eyes, would be undistinguishable in the eyes of men generally, of observers of ordinary acuteness, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give.

It is persons of the latter class who are the principal purchasers of the articles to which designs have given novel appearances ; and if they are misled and induced to purchase what is not the article they suppose it to be ; if, for example, they are led to purchase forks or spoons, deceived by an apparent resemblance into the belief that they bear the 'Cottage' design, and, therefore, are the production of the holders of the Gorham, Thurber, and Dexter patent, when, in fact, they are not, the patentees are injured, and that advantage of a market which the patent was granted to secure, is destroyed.

The purpose of the law must be effected, if possible ; but plainly, it cannot be if, while the general appearance

of the design is preserved, minor differences of detail in the manner in which the appearance is produced, observable by experts, but not noticed by ordinary observers, by those who buy and use, are sufficient to relieve an imitating design from condemnation as an infringement.

We hold, therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same—if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other—the first one patented is infringed by the other.”

It has been held that claims may be made for parts of a design and for the whole combination in the same patent¹ and it has been said “it might be questionable whether the first claim could stand for the parts of a design separately, as a design, from its nature, is an entirety, if it is anything.”²

There would seem to be no reason why a part of a design, which is itself an entirety, cannot be claimed by itself as well as in a combination of other parts: for instance, where a figure in the panel of a stove is, separately considered, complete and ornamental, it would seem to be claimable by itself as well as a factor in the design of the stove, as a whole.

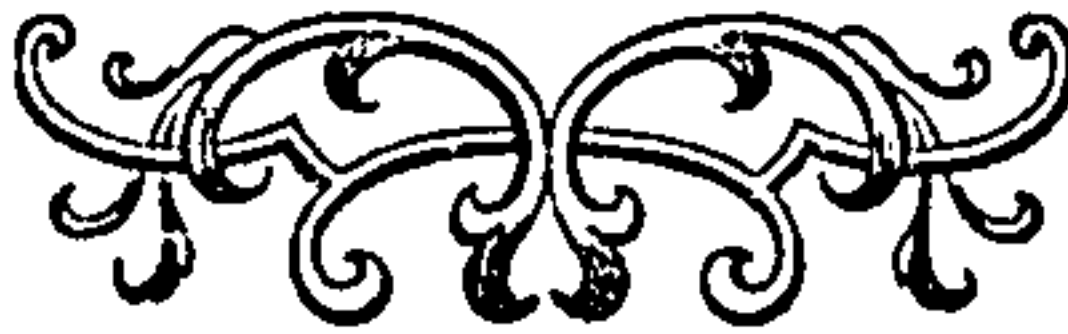
It has been intimated that the claim in a design patent may cover a genus or class of ornaments,³ but it is

¹*Root v. Ball*, 4 McLean, 177, A. D. 1846.

²*Perry v. Starret*, 14 O. G. 601, Wheeler, 1877.

³*Booth v. Garelly*, 1 Blatchford, 247, Nelson, 1847.

not readily to be seen how this can be done except in the sense that the originator and patentee of a design is entitled to have treated as infringements all other designs which are in appearance so much like his as to deceive an ordinary observer.



CHAPTER XVII.

INFRINGEMENT.

IT is an infringement of a patent, to either *make*, or *sell*, or *use*, without legal permit, anything which forms the subject-matter of any claim or clause of claim in a valid patent; for a patent conveys to the patentee the exclusive right to do *each* and *all* of these three things during the existence or life of the franchise.

A person cannot *make*, for his own use or for exportation from the country, without infringing. Judge Story once intimated that a person might make a patented thing for the purpose of philosophical experiment merely, or to verify the correctness of the specification, but not for profit without being held an infringer. There seems to be no other excuses which would thus avail.¹

The intent to infringe is not even necessary,² and the patentee need not notify an infringer before bringing suit;³ for the patent is, in the eye of the law, notice of the patentee's rights, to all the world.

A mere workman for the real party in interest is not an infringer,⁴ though, if one party were to hire another

¹ *Whittemore v. Cutter*, 1 Gallatin. 429.

² *Parker v. Hulme*, 1 Fisher's Pat. Cases, 44.

³ *Ames v. Howard*, 1 Sumner, 482.

⁴ *Delano v. Scott*, 1 Gilpin 489.

to make or use patented things, both would be held infringers.¹

The sale of the *materials* of a patented machine, as such, and with no license, express or implied, to use the machine as a machine, is not an infringement.²

An assignee, grantee, or licensee can be sued for infringement as well as any one else, if he attempts to exercise rights under the patent not contained in his assignment, grant, or license.³

The use of patented articles upon foreign vessels coming into our ports, when such articles were acquired with proper intent at foreign ports, does not constitute infringement.⁴

Sales of patented articles by persons acting as agents for other real owners, the salesmen having no interest, does not make the salesmen infringers.⁵

It has been held, that a purchase, from a wrongful seller, of a patented article, by the patentee or for his account, does not constitute an infringement.⁶

To constitute an infringement, it is not always necessary that a person should technically infringe the claim. Where a party had a patent for a combination of a lamp-burner and a lamp-chimney, another party made and sold only the burner,—the judge held such makers of the burners

¹ *Keplinger v. De Young*, 10 Wheaton, 358; *Woodworth v. Hall*, 1 Wood & Min. 248.

² *Sawin v. Guild*, 1 Gallatin, 485.

³ *Fudson & Goodyear v. Union Rubber Co.*, 4 Blatchford.

⁴ *Brown v. Ducherne*, 19 Howard, 183.

⁵ *Potter v. Crowell*, 3 Fisher's Pat. Cases, 112.

⁶ *Sparkman v. Higgins*, 2 Blatchford, 30; *Byam v. Bullard*, 1 Curtis, 102.

infringers ;¹ and, where one party had a patent on a cartridge, and another party made and sold guns designed for firing this cartridge, the gun-maker was held an infringer.² In these and similar cases, the *intent* is of importance.

Where a product is claimed as made by a certain process another similar product not made by such process is not an infringement.³ Where infringing articles are *made* during the life of the patent their *use*, can be enjoined after the expiration of the patent.⁴ A father is liable for the infringement of a patent by his non-emancipated minor son where the infringement is with the father's knowledge even if it be not with his consent.⁵ "Where it is obvious that defendant's device was intended for an entirely different purpose and was not intended as an evasion of the plaintiff's patent, the infringement, if any exists, being purely accidental * the evidence of actual infringement should be so clear as to admit of no other reasonable construction."⁶

A salesman on commission—of infringing articles—can be enjoined and his profits recovered. A suit against the salesman's employer is no bar to a suit against the salesman.⁷

A mere variation in the use of the patented device will

¹ *Wallace & Son v. Holmes, Booth & Haydens*, 5 Fisher's Pat. Cases, 37.

² *Renwick v. Pond*, 5 Fisher's Pat. Cases, 569.

³ *Dittmar v. Rix*, 1 Fed. Rep. 342.

⁴ *Am. Diamond Rock Boring Co. v. Sheldon*, 1 Fed. Rep. 870 ; *Am. Diamond Rock Boring Co. v. Rutland Marble Co.*, 2 Fed. Rep. 356.

⁵ *Dunks v. Grey*, 3 Fed. Rep. 862.

⁶ *Nat'l Car Brake Shoe Co. v. D. L. & N. R. Co.*, 4 Fed. Rep. 224.

⁷ *Steiger v. Heidelberger*, 4 Fed. Rep. 455.

not avoid infringement ; for instance, where the patent was for a ratchet-wrench and the defendant used the ratchet-wheel with the spring, pawls, and lever, precisely like those of the patented wrench, in a bit-stock adapted to various tools, the defendant was held to infringe ;¹ “the patent grants to plaintiff the exclusive right to use the improvement patented for any purpose” ;² in one case defendants sought to escape the charge of infringement by showing that they had not used the patented lock in the way contemplated by the patent ; the lock had the capacity of use contemplated by the patent and defendants were held to infringe.³

It seems that where a patent owner causes a party to specially order from a manufacturer, whom the patent owner holds to be an infringer, the intermediate party cannot be held as an infringer.⁴ A man who employs a workman to make an infringing article cannot escape responsibility by attempting to throw it upon the workman.⁵ Where a structure was not, when originally made, an infringement but become such through use and wear, the party making it cannot be held to be an infringer.⁶

A “patent secures the combination or machine therein described without regard to the purposes for which the patented thing is intended,” though the claim may, in terms, cover it for a specific purpose.⁷ When a license is granted to use a certain machine the patented part

¹ *Sinclair v. Bacus*, 4 Fed. Rep. 539.

² *Fischer v. Hayes*, 6 Fed. Rep. 76.

³ *Wheeler Lock Mfg. Co. v. Norwich Nat'l Bank*, 6 Fed. Rep. 377.

⁴ *Tucker v. Dana*, 7 Fed. Rep. 213.

⁵ *Andrews v. Creegan*, 7 Fed. Rep. 477.

⁶ *Woven Wire Matt. Co. v. Simmons*, 7 Fed. Rep. 723.

⁷ *Zinn v. Wiess*, 7 Fed. Rep. 914.

whereof is a combination, parts of the machine which become worn out may be replaced and the use of the machine continued under the license. If the patented part had been a single part of the structure and that part had worn out the user would have no right to replace it.¹ It was held in one case that the owner of an undivided interest in a patent cannot use a machine different from that described in the patent, but covered by it;² but this decision does not seem to be reconcilable with the general course of decisions upon the same general topic.

The Supreme Court has doubted that a suit for infringement of a patent can be sustained against a public officer who has acted "only for and in behalf of the government."³

In proceeding to determine whether a certain article is an infringement of a patent it must be compared separately with each clause of claim in the patent; for if any clause of claim is infringed the patent is infringed.

The claim is the vital part of the patent and no matter whether the actual invention be greater or less the question of infringement is to be determined upon the claim, for the patentee must stand or fall by the claim he makes.⁴

A patent is infringed by making, using, or selling the thing as described and claimed in the patent; and the thing described and claimed and another thing are held to be substantially identical when the same result is attained by the same means or equivalents for them.

¹*Gottfried v. C. & S. Brewing Co*, 8 Fed. Rep. 322.

²*Herring v. Gas Consumers' Ass'n*, 9 Fed. Rep. 556.

³*James v. Campbell*, 21 Of. Gaz. 337.

⁴*Meissner v. Devoe Mfg Co.*, 5 Fisher's Pat. Cases, 285.

A claim will generally, if not always, be either to a specific thing or to a combination of different elements, whatever be the actual wording ; and this whether the invention be an art, a machine, a manufacture, or a composition of matter ; and having determined what the claim is for, it must then be determined whether the thing to be compared with the patent has all the parts or qualities which the claim makes essential ; and if such thing has not all these parts then it does not infringe. Form, size, and materials, are not generally essential ; but they may be.¹

But in any case it matters not what names are given to parts of a device,² the real question is : Do the parts compared perform the same office in substantially the same way ?

It is not an infringement of the claim for a combination, to make, or use, or sell any of the elements of the combination less than the whole,³ though this proposition has sometimes been qualified by courts as follows : “ It is not necessary in order to constitute infringement of a combination, patented as such, that the whole combination should be used. If a part of it only, that, separate from the rest, was new and patentable to the inventor, is used, taking that part is an infringement *pro tanto*. * . Here the whole of this part of the patented invention is taken for one purpose but not for all. It is none the less taken, however, and the taking is none the less an infringement because it is not taken for all purposes.”⁴

¹ *Adams v. Edwards*, 1 Fisher's Pat. Cases, 1.

² *Graham v. Mason*, 5 Fisher's Pat. Cases, 1.

³ *Cahoon v. Ring*, 1 Fisher's Pat. Cases, 397.

⁴ *Adair v. Thayer*, 4 Fed. Rep. 441.

Additions to a combination will not avoid infringement,¹ and a man cannot use another's patented invention simply because he has made an improvement upon it. That a device works better or worse than the patented device is not always, nor generally, decisive of substantial difference.² A device may embody a very high degree of ingenuity and yet not be substantially unlike some prior patented thing.

Suppose a person to have invented and patented a machine having four distinct parts or elements; another person, desiring to effect the same result, might make another machine having none of the exact parts of the first, but having four other parts which are mechanical equivalents for the four parts used by the patentee. In the selection and arrangement of his parts, the latter person may have shown great ingenuity, especially if he has, as is often the case, been all the while aiming to avoid the appearance of the prior machine; yet, if the parts of the latter machine operate upon the same principle as the parts of the prior machine,—are equivalents for them,—then, no matter how unlike the two machines may be in appearance, the latter is substantially identical with the former, and is not patentable, unless it should happen to produce a better or cheaper product than the prior machine, and then only as an improvement on the former; and, in such case, the later patent would be tributary to the earlier, and could not be put in practice without the permission of the owner of the former patent.

¹ *Johnson v. Root*, 1 Fisher's Pat. Cases, 351.

² *McCormack v. Talcott*, 20 Howard, 405.

The question of substantial identity is presented in a patent suit in a different aspect from the presentation of the question of novelty in the Patent Office when an applicant seeks a patent; a device may be patentable and yet be an infringement of a prior patent. When a man makes a new and useful invention, he is entitled to a patent for it. Another man may improve upon the same invention so as to produce a better result of the same kind or a cheaper result, or he may simplify the invention, so that he will be entitled to a patent for the improvement. In such case the later patent is subordinate and tributary to the earlier, and can not be worked except by license from the earlier patentee. Whether a man has made a patentable improvement on a former patent, is often a question at the Patent Office; but the question does not come up in this shape in infringement suits in the courts,—there the question is, whether two things are substantially identical, without reference to whether one works better or worse than the other.

Mere change of form in a machine or its parts does not destroy the substantial identity of the parts changed, if such part still performs the same duty or function as before; and it must not be supposed that because one machine looks entirely unlike another, they are therefore substantially different. After one man had invented a steam engine and patented it, another man undertook to evade the patent; he produced an engine which *looked* entirely unlike the first,—yet, when some one thought to turn the later machine “upside down,” the resemblance came out at once. When one recalls the scores, if not hundreds, of different styles of steam engines, all operating on the same general principle,—that is by the ex-

pansive force of steam,—he can readily comprehend, that though things may be very unlike in appearance, yet they may be the same in operating principle.

There are certain things in mechanics and in chemistry, known to the patent law as equivalents,—that is, different mechanical or chemical elements which will accomplish the same result. On looking into a book containing a compilation of mechanical movements,—and there are such books,—one part will be found devoted to a class of devices for converting rotary into regular rectilinear reciprocating motion: another part will be devoted to devices for converting regular reciprocating motion into intermittent reciprocating motion,—and so on; each of these parts or chapters contains a number of different devices for effecting the same purpose. All the devices in the same part or chapter are equivalents for each other, known and recognized as such. Now if, in a patented machine, one of these devices is made use of to accomplish a certain movement or purpose, it is not a substantially different thing to use another of the devices which is a known and recognized substitute for the device shown in the patent.

A learned judge says that: “By equivalents in machinery is usually meant the substitution of merely one mechanical power for another, or one obvious and customary mode for another, of effecting a like result.”¹

Another judge says: “A mechanical equivalent, I suppose, as generally understood, is where one may be

¹*Smith v. Downing*, 1 Fish. P. Cases, 87.

adopted instead of the other, by a person skilled in the art, from his knowledge of the art;”¹

Another judge says: “When, in mechanics, one device does a particular thing, or accomplishes a particular result, every other device *known* and *used* in mechanics, which skillful and experienced workmen know will produce the same result or do the same particular thing, is a known mechanical substitute for the first device mentioned for doing the same thing or accomplishing the same result. It is sufficient to constitute a known mechanical substitute, that when a skillful mechanic sees one device doing a particular thing, that he knows the other device, whose use he is acquainted with, will do the same thing.”²

The same rules, by which may be determined what constitutes an equivalent in machinery, are applicable in determining what constitutes an equivalent in an “art,” or, in other words, in a “process,” in a “manufacture,” or a “composition of matter.” Where a process consists of a single step or a succession of steps, it is an equivalent for one of these steps to substitute another step, or way, or manner of action, that a person, skilled in the branch of business to which the process appertains, knows, simply from past experience or accumulated knowledge, will effect the same result.

And in “composition of matter”—or, generally speaking, in medicinal, chemical, and food compounds—it is an equivalent to use, in the place of one of the substances, of which the preparation is composed, another

¹ *Johnson vt Root*, 1 Fisher's Pat. Cases, 363.

² *Carter v. Baker*, 4 Fisher's Pat. Cases, 409.

substance which a person of competent knowledge (in this case generally a chemist) knows, from his knowledge of ingredients, will serve the same purpose. Upon this subject a learned judge says : "Where a patent is granted for a composition made of several ingredients, it covers and embraces known equivalents of each of the ingredients. An equivalent of any substance is another substance having similar properties and producing substantially the same effect."¹

In comparing "manufactures,"—that is, generally speaking, two finished products,—it is to be determined whether or not they are identical, by ascertaining if they have similar parts or properties, if they will answer the same end, and if they answer the same end by means of similar properties. If they do, then they are substantially identical ; otherwise not.

In proceeding to determine the question whether a claim of a patent is infringed, regard is to be had not only to actual wording of the claim but also to the state of the art to which the invention under consideration appertains as it existed at the time the patented invention was made ; for although a thing may come within the *terms* of a claim, yet the prior art may be such that the terms of the claim must be so narrowed by construction that the thing under inquiry may not really be an infringement ; for courts pay all possible attention to the question of what constitutes a patentee's real invention as compared with such prior art, and having found in

¹*Matthews v. Skates*, 1 Fisher's Pat. Cases, 609.

what the actual invention resides, will, if possible, construe the claim so as to give the claim life and vitality and yet restrict it to the actual invention.

It is a settled rule of construction that where an inventor is the first, the pioneer in a certain field, his claim shall receive the broadest construction consistent with the language of the claim, but that if the patented invention be one in a field which has been before worked, if it be only a step in a preceding series, then his claim is to be construed, if its language will possibly permit, so as to cover and include just what the invention is and nothing more.

“If one inventor precedes all the rest and strikes out something which excludes and underlies all they produce, he acquires a monopoly and subjects them all to tribute.

But if the advance toward the thing desired be gradual and proceeds step by step, so that no one can claim the complete whole, then each is entitled only to the specific form of device which he produces, and every other inventor is entitled to his own specific form so long as it differs from those of his competitors and does not include them.”¹

Illustrative cases :

Complainant's invention was a whip-tip provided with a screw-socket by which it was attachable to the whip-stock, and the claim was : “As a new article of manufacture, a whip-tip provided with a socket, so as to be attached to the stock proper, as and for the purposes set forth.”

¹*Railway Co. v. Sayles*, 97 U. S. 555. See also *Worth v. Browning*, 17 Of. Gaz. 624; *Whitnum v. Seaman*, 17 Of. Gaz. 626; *Garnau v. Dozier*, 19 Of. Gaz. 62; *Stebbins H. E. M. Co. v. Stebbins*, 17 Of. Gaz. 1351.

Defendant's [patented] device was a whip-tip having a socket provided with teeth to be pressed into the stock. The idea of making separate tips for whips was original with complainant and its practical merits were great. Fishing rods had previously been made with socketed joints, and whips had been made in sections for transportation. *Held*, that if complainant could hold a broad claim to the independent tip there was no doubt of the infringement, but that the patent was for little more than the application of an old art to a new but analogous use and that it must be confined to the screw-threads, the defendant's device not being an infringement.¹

In another case the court said of complainant's patented self-closing faucet that "the valve is pushed downward, from its seat, against a spring, by a steep, quick-threaded screw turned by hand with a swivel to prevent turning the valve with the screw, which lets the valve back when the screw is released." In some prior self-closing faucets "the valves were lifted from their seats by stems, having projections on the upper ends working against steep inclines, as cams." "In the faucet of defendant the valve is lifted against a spring by a stem, with projections near the valve working against inclines inside the shell of the faucet." *Held*, to be no infringement in view of the narrow construction of claim—a combination of the screw and valve—necessitated by the prior art.²

In another case the complainant patented a machine for "closing the seams of metallic cans" which, in mak-

Am. Whip Co. v. Hampden Whip Co., 1 Fed. Rep. 87, Lowell, Feb. 1880.

²*Zane et al v. Loffe*, 2 Fed. Rep. 229.

ing a can with corners, or angles, had the stock notched at the corner so that there was no excess of metal at that point to be disposed of in the operation. In the reissue he inserted a clause looking toward a method of use which would operate on stock not thus notched. Defendant's machine came within the terms of the claim, but, as a matter of fact, seamed the cans without notching the stock, having a recess to dispose of the excess of stock. *Held*, that if the claim were construed to cover defendant's machine it would be invalid, and if limited to complainant's real invention defendants did not infringe.¹

In another place complainant's patent was for a combination of parts in a machine for applying flock to belt-rubber goods. A prior patent showed a machine for the same purpose, having a corresponding number of parts, performing the same functions, but differing in form. *Held*, that complainant could "hold only the improvement in form of the different parts and that defendant's machine, differing in the form of the parts, was not an infringement."²

In another case, coal scuttles being old, complainant patented an improvement thereon, consisting of a bottom stamped out of one piece and extending upwards outside of the body. Defendant made a scuttle substantially the same way except that the bottom extended inside the body. Defendant's structure *held* not to be an infringement.³

¹ *Covell v. Pratt et al*, 2 Fed. Rep. 359.

² *Williams v. Barker et al*, 2 Fed. Rep. 649.

³ *Whitnum v. Seaman et al*, 4 Fed. Rep. 436.

Where the patented invention is a combination of old elements courts hold that if a person substitutes for an element of the combination—which of itself was old—another element, which was not known at the date of the patent, as a substitute for the element the place of which it takes, in such case the structure containing such substituted element, is not an infringement: the Supreme Court has stated this doctrine thus: “Inventors of a combination cannot suppress subsequent improvements which are substantially different, whether the new improvement consists in a new combination of the same ingredients, or of a substitution of some newly discovered ingredient, or of some old one performing some new function, not known at the date of the letters-patent as a proper substitute for the ingredient withdrawn.”¹ In a case where this doctrine was applied, complainant’s bolt for window-catch had a plain round stem at the rear end reciprocating in a round bolt in the rear end of the case which held the bolt: defendants used a stem which did not pass out of the rear end of the case but was furnished with short radial arms extending to and reciprocating upon the inside of the case; defendant’s stem was held to be a newly discovered substitute and the whole structure, therefore, not an infringement.²

It will thus be seen that in attempting to settle the question whether a thing infringes a claim of the patent

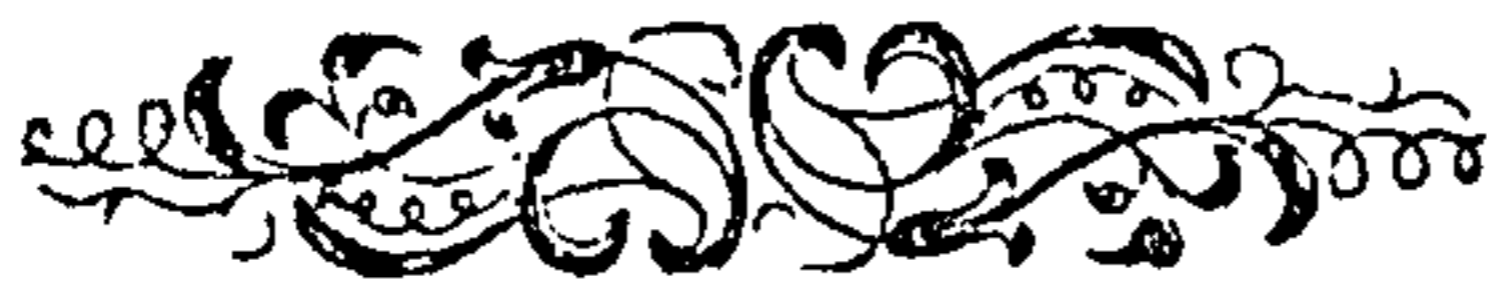
¹ *Seymour v. Osborn*, 11 Wall, 516. See also *Gould v. Rees*, 15 Wall. 187; *Gill v. Wells*, 22 Wall. 1.

² *Babcock v. Fudd*, 1 Fed. Rep. 408.

one important question is whether or not *it* comes within the terms of the claim, (understanding the words "or its equivalent" to be inserted after the mention of each part,) fairly and candidly read: if it does not, then of course there is no question of infringement. If the thing does come within the terms of a claim the next question to be considered is the construction to be given to the claim in view of the prior art; that is, to determine whether the invention is broadly new so that a broad construction must be given to the claim or whether the invention is one of small degree as compared with the prior art. And in considering this question the closer the prior art approaches the patent the narrower the construction of the claim must be. Of course, if the prior art fully anticipates the claim there is an end to the whole question, for the claim is then without validity. If the prior art is such that the invention is found to be broadly new then the claim will have a construction broad enough to cover all manner of equivalents; but if the invention be narrowed down by the prior art, then the claim must receive a correspondingly narrow construction and only those things will be found to infringe which are either identical with what is described and claimed in the patent or were at the date of the patent known substitutes.

It is also to be understood that courts will sustain patents where they reasonably can; that they will construe claims in such a manner as to give them life and vitality, if this can be done without doing violence to language or to reason; and that mere technicalities will never avail to destroy the force of a claim or to permit him who really uses the substance of an invention of another, to do so with impunity.

The question of substantial identity is to be determined by ascertaining whether the two things compared attain the same result by substantially the same means operating in substantially the same manner : results are to be compared and the means used and the manner of their operation are to be compared ; and if all are found to be the same in substance the things compared must be found to be substantially identical.



CHAPTER XVIII.

INFRINGEMENT SUITS.

SUITS for infringement may be either on the case at law or by bill of complaint in equity. Such suits are now almost always brought to the equity side of the court for the reason that the complainant can in an equity suit recover defendant's profits as well as damages while in a suit at law damages only are recoverable, and for the reason that complainant is not compelled to go into the question of damages until the court has settled the question of the validity of the patent and the question of infringement; it is exceedingly inconvenient to complicate the trial of a case, as is necessary in actions at law, with the question of damages.

Jurisdiction of Patent Suits. The statute enacts: "*Section 629.* The Circuit Courts shall have original jurisdiction as follows: * * Ninth. Of all suits at law or in equity arising under the patent or copyright laws of the United States."¹

All suits for infringement, all suits in the nature of interferences, and all suits to vacate or repeal patents, mus

¹Rev. Stat. Title 13, Chap. 7.

be brought in the United States courts, as must ordinarily all suits intended to pass upon the validity of patents, though state courts have authority to enforce contracts relating to patents, such as contracts to assign or covenants contained in a license; and it would seem that, where a state court has parties properly before it, and a patent comes in question collaterally, its validity may be inquired into.¹

A question arising under a contract relating to a patent does not ordinarily give a federal court jurisdiction. It is very clear that a state court has jurisdiction of questions of contract relating to patents unless the question is one which concerns the scope of the patent or its validity, and even when the question at issue does concern the scope or validity of the patent a state court may try and decide such questions if they are simply collateral to the main issue in the case although it has been held that questions of title to a patent are questions "which arise under the patent laws and give a United States court jurisdiction."²

In a suit brought to a federal court the complainant alleged that he had assigned his patent under an agreement of the assignee to render certain accounts and pay certain royalties, that his accounts had not been properly rendered nor the royalties properly paid: he sought relief in both these particulars and also sought for a construction of the question whether certain articles made by him from whom the royalty was due, came within the scope of the patent: the court held that the questions at

¹ *Meserole v. Union Paper Collar Co.*, 3 Fisher's Pat. Cases, 483.

² *Campbell v. James*, 2 Fed. Rep. 338.

issue were not such as gives a federal court jurisdiction. The court in this case went over the ground of jurisdiction so thoroughly that it is transferred bodily to these pages. The court said : " Looking carefully into the second section of the act, which sets forth the causes that are removable from the state to the federal courts, it is clear that the removal cannot be justified unless the matter in dispute between the parties has arisen 'under the laws of the United States.' The character of the controversy must be determined by the record. Turning to that, I find that the suit was commenced by filing a bill in the Court of Chancery of New Jersey for an account of business transactions growing out of a written contract between the parties. This contract embraced the transfer or assignment of certain patents from the complainant to the defendants, Cahoon and Albright, and their agreement to pay a specified royalty from the profits of their business on all goods manufactured and sold which embraced the patented improvements. The gravamen of the action was the failure of the defendants to perform their personal covenants, and was not to vindicate any rights which had been vested in the complainant under a law of the United States. All rights that men have in patents are secured to them by federal laws, and all controversies which directly involve the validity of patents, or which are for the recovery of damages and profits for their infringements, are exclusively cognizable in the federal courts. This is elementary knowledge. But when a patentee sells out all his interest in the patent, how can any right remain which is secured to him by an act of Congress? Some confusion on this subject has doubtless arisen from the fact that the courts of the United States

have often exercised jurisdiction over contracts for license to use patented inventions, granting relief to licensors where the licensees have failed to perform their covenants; but it will be found in all such cases that not only has the ownership of the patent been retained by the licensor, but the right of the licensee to use the patent has been conditioned on his performing certain acts or paying certain royalties. *Brooks & Morris v. Stolley* (3 McLean, 523) affords a good illustration of a case of this kind. The complainants were the assignees of the Woodworth planing patent for Hamilton county, State of Ohio, and as such licensed the defendants to run a machine in that county under a sealed contract, in which the licensee's right to use the machine was expressly conditioned on his paying one dollar and twenty-five cents for every thousand feet of boards planed, to be paid on Monday of each week; and further, that he should render an account, if required, under oath, and also keep books to which the complainants should have access, and in which all boards planed should be entered. After complying with the contract for some time by paying according to its terms, the licensee refused to make any further payments, although he continued to use the machine. The bill was filed for an injunction restraining its further use. Objection was raised to the jurisdiction of the court, but Mr. Justice McLean overruled the objection on the ground that the suit was not to enforce the contract but to secure to the licensor the rights in the patent which he had reserved on the failure of the licensee to perform his covenants; that his only authority for using the machine grew out of the contract, and that the court could not allow him to repudiate the contract and still use the machine.

'If [he added] the object of the bill were merely to enforce a specific execution of the contract, the Circuit Court of the United States could exercise no jurisdiction in the case.'

In *Hartell v. Tilghman* (99 U. S. 555) an intimation is thrown out that Mr. Justice McLean went too far in this case in maintaining the jurisdiction of the courts of the United States; but we may safely concede all that is claimed and then find ample ground for denying the jurisdiction in the present case.

There is no pretence in the present suit that the complainant reserved any interest, absolute or contingent, in the patents which he assigned. He only retained certain royalties in the profits, and a bill is filed to have an account taken of them.

The case cannot be distinguished in principle from those of *Goodyear v. Day* (1 Blatchf. 565) and *Goodyear & Judson v. The Union Rubber Company*, (4 Blatchf. 63.) The last named case was very similar to the one under consideration in all its facts and aspects, except that the defendants were licensees and not grantees. The owner of a patent granted a license, with covenants that the licensee should pay certain tariffs and keep correct accounts and permit his books to be examined; but there was no express provision that, if the covenants were broken, the rights granted should revert to the licensor. A bill was filed by the licensor against the licensee, praying for a decree that the covenants should be performed, and for an injunction to prevent the use of the patent under the license until the covenants should be performed. The citizenship of the parties not giving the court jurisdiction, the question was raised and argued whether the action could be maintained.

It was held that the subject-matter did not give a federal court jurisdiction ; that the suit was not one to prevent the violation of any right of the licensor secured by any laws of the United States, but to prevent the violation of the rights secured by the covenants of the license, and that the court had no jurisdiction of the case. The reasoning of the learned judge seems quite conclusive.

‘ If, [says he] in the use of the thing granted, the licensee does not perform his covenants, although there is by such non-performance a violation of the rights of the patentee, such violation is not a violation of the rights of the patentee as secured by a law of the United States, but a violation of his rights as secured by the covenants. He has, by the license or grant, parted with a portion of that which was secured to him by the laws of the United States, and has, in lieu thereof, taken a right secured by a covenant. If a patentee parts with the whole right secured by his patent, either for cash or upon the purchaser’s entering into a covenant to pay him a certain sum of money, or to do certain other things, the patentee has, after such sale, no right vested in him secured by any act of Congress. A suit to enforce the covenant would not be a case arising under a law of the United States.

The use of the whole thing sold cannot be a violation of any rights of the patentee secured by the laws of the United States so long as the deed of sale remains in full force, for he has parted with all such rights ; and, when a portion of the right is parted with, the rule must be the same as it respects such portion.’

See also *Blatchford v. Sprague*, (1 Cliff. 289) and *Mersevole v. The Union Paper Collar Company*, (6 Blatchf. 356,) in which the ground is distinctly taken that the subject-matter of contracts made in relation to patent rights does not give the courts of the United States jurisdiction in suits to enforce them. But without dwelling upon

these cases, determined in the subordinate courts of the United States, the Supreme Court, in *Wilson v. Sanford*, (10 How. 99) put the question at rest by refusing to entertain jurisdiction of a suit which was brought by the grantor of a license to avoid a license on the ground that the grantee had not complied with the terms of the contract. As neither the citizenship of the parties nor the amount involved in the litigation gave the court jurisdiction, the only question was whether it was 'a case arising under any law of the United States granting or confirming to inventors the exclusive right to their inventions or discoveries.' The court, speaking by Chief Justice Taney, said it was not such a case; that the dispute did not arise under act of Congress, nor did the decision depend upon the construction of any law in relation to patents.

'It arises [he continues] out of the contract stated in the bill, and there is no act of Congress providing for or regulating contracts of this kind. The rights of the parties depend altogether upon common law and equity principles.'

The ground for the removal alleged in the petition to the chancellor was that—

'The suit arose under the patent laws of the United States, and that the substantial controversy was one depending upon the construction of said laws'

This view was doubtless taken because the pleadings and the evidence tend to reveal that the dispute between the parties arose about the manufacture and sale of certain saddle-trees and gig-saddles, the complainant insisting that they embraced the inventions and improvements of the letters-patent which he had assigned to the defendants, and they in their turn maintaining that they

were not subject to the royalties and percentages of the agreement because they were constructed under other letters-patent in which the complainant never had an interest. Questions of infringement and the construction of the claims of patents were thus necessarily involved, and it was assumed that they could only be adjudicated by the courts of the United States. But the decision of the courts do not justify any such assumption. Thus, in *Rich v. Atwater*, (16 Conn. 409,) where a bill was filed for a discovery, account, and an injunction, and where the question of the validity of the Woodworth patent was raised by the pleadings, the Supreme Court of Errors of Connecticut held that though the validity of a patent, when directly involved, was within the exclusive jurisdiction of the federal courts, yet when it came in question collaterally it was the proper subject of inquiry and adjudication in the state courts.

In *Middlebrook v. Brodbent*, (47 N. Y. 443,) the Court of Appeals of New York, after a very full argument, decided that a state court had jurisdiction of an action founded upon a contract although the validity of a patent was involved therein. And in *Mersevole v. The Paper Collar Company*, *supra*, Judge Blatchford held that a state court had jurisdiction to decree a license under a patent to be void, and if, in the investigation, that court was obliged to inquire collaterally into the novelty and validity of the patent as a consideration for the license, such inquiry would not deprive the state court of jurisdiction or confer it on a court of the United States.

Being, then, clearly of the opinion that the removal here was without the authority of law, I remand the cause to the state court."¹

¹ *Teas v. Albright et al*, 22 O. G. 2069.

Parties to an Infringement Suit. Suits for infringement can only be brought in the name of the owner or owners of a patent-right for the district or territory where the infringement is committed. Patentees, assignees of the whole patent, or grantees of particular districts, may bring suits in their own names but licensees cannot. The licensor is the proper person to bring suit for an injury in the nature of infringement to the right of the licensee.

While a licensee cannot bring a suit for infringement in his own name against infringers generally, he can maintain a suit in equity substantially in the nature of an infringement suit against the licensor for any injury in the nature of infringement of the licensee's right in the patent by the licensor. A court has said that: "Any person to whom a part of a patent has been assigned may maintain the suit alone for the protection of his own interests.¹ The right of a partial owner will not be disputed subject, nevertheless, to the limitation that in such a case he must make his co-partners in the ownership defendants in the suit."² A married woman may bring suit in equity in a United States court for infringement of her patent without joining her husband, in states the laws of which permit a married women to hold property of all sorts the same as an unmarried women.³ A patent owner who has assigned his patent to others in trust need not be joined as co-complainant in a suit for infringement of the patent.⁴

¹ *Kerr Inj.* 404.

² *Spring v. Domestic Sewing Machine Co.*, 13 Fed. Rep. 446.

³ *Lorillard v. Standard Oil So.*, 2 Fed. Rep. 902.

⁴ *Wescott v. Wayne Agr'l Works*, 11 Fed. Rep. 298.

“The right to recover for infringement of a patent, like other choses in action, is assignable in equity and the real owner of the right is entitled to maintain a suit upon it in equity in his own name.”¹ This language refers to the profits and damages recoverable on account of infringement.

A tolerably full specification of parties who may be sued as infringers was made in the first part of the chapter upon “Infringement,” to which there is but little to be added.

A city is liable in its corporate capacity for infringing acts committed by its officers;² and a corporate board, forming a part of a city government, like the Board of Education, or the Fire Department of the city of New York, may properly be made a defendant in an infringement suit.³ A postmaster is not an “officer of the revenue,” within the meaning of Sec. 989, of the Rev. Statutes, and is not entitled to receive the certificate provided for in that section, making the government responsible for the payment of the recovery for infringement of patent had against the postmaster.⁴ Members of a partnership can be sued individually as infringers.⁵ The secretary of a voluntary association, in the nature of a co-partnership, who is not a shareholder in the associa-

¹ *Shaw v. Colwell Lead Co.*, 11 Fed. Rep. 711.

² *Munson v. Mayor of New York*, 3 Fed. Rep. 338.

³ *Brickell v. New York*, 7 Fed. Rep. 479; *Allen v. New York*, 7 Fed. Rep. 483.

⁴ *Campbell v. James*, 3 Fed. Rep. 513.

⁵ *Tyler v. Galloway* 13 Fed. Rep. 477.

tion, is not individually liable for an infringement committed by the partnership.¹

Perpetual Injunctions. When in the course of an equity suit, the court, on final hearing upon pleadings and proofs, finds that the patent is valid, and that it has been infringed, the court grants, as a matter of course, a perpetual injunction against the infringer, enjoining and restraining him from any further infringement, and, if the party thus enjoined does further infringe in defiance of such injunction, he can be committed to jail for contempt of court or fined, or both. The same kind of injunction will be issued by the equity side of a court when a like finding has been made in a suit at law.

Provisional Injunctions. There is another kind of injunction, other than the perpetual, which is often applied for by the plaintiff or complainant in a patent suit, and which may be granted or withheld, as the judge in his sound discretion may decide. These injunctions are asked for at the commencement or during the progress of a suit, with the intent that the defendant may be restrained from infringing until the final determination of the case and the plaintiff's right to a perpetual injunction is determined.

Strictly speaking, there are no such things as precedents in the practice of granting or withholding provisional injunctions ;² for every petition for one is addressed to the sound discretion of the judge, as applied to the

¹ *Ibid.*

² *Earth Closet Co. v. Fenner*, 5 Fisher's Pat. Cases, 15.

facts of the case, yet there are some recognized and general rules with regard thereto. Courts will not, as a rule, grant a provisional injunction, unless—

First,—There has been some previous adjudication on (and sustaining) the patent, where the same points of validity and infringement were in issue, or unless—

Second,—There has been a long and undisputed enjoyment of the patent privilege under the patent, and the plaintiff is able to make it appear that the defendant's device and his own are substantially identical. Where there has been no previous adjudication on the patent, and the defendant is able to raise a doubt in the mind of the judge as to the validity of the patent, or as to whether his device is substantially identical with the plaintiff's (questions of fact, for the court can at one time as well as another, determine questions of law) a provisional injunction will be refused.

When a provisional injunction would operate unjustly upon the defendant, or when it would cause him irreparable injury, while the plaintiff could have ample satisfaction in money damages, the provisional injunction will be refused.¹

In a case where such reasons were urged against the grant of a provisional injunction, the court said: "We decline to grant this motion therefore; *first*, because upon the character of the evidence furnished, we are not prepared to determine the extent or validity of complain-

¹*Earth Closet Co. v. Fenner*, 5 Fish. Pat. Cases, 15; *Thayer v. Wales*, 5 Fish. Pat. Cases, 130; *Union Paper Bag Co. v. Binney*, 5 Fish. Pat. Cases, 166; *Fales v. Wentworth*, 5 Fish. Pat. Cases, 302; *Miller v. Andoscoggin Pulp Co.*, 5 Fish. Pat. Cases, 340; *Cook v. Ernest*, 5 Fish. Pat. Cases, 396; *Mowry v. Grand Street & North River Railroad Co.*, 5 Fish. Pat. Cases, 586.

ant's patent or their infringement ; *second*, because there is, in our judgment, no case presented of such threatened immediate and irreparable damages as would warrant us in depriving the defendant before final hearing of the use of the cars it has built ; and *third*, because, in the judgment of the court, whatever damages the complainants may suffer between the filing of this bill and a final decree can easily be ascertained upon reference, for which damages, when determined, the defendant company is abundantly responsible."¹

Where the plaintiffs are in the habit of granting licenses, under their patent, the court will sometimes refuse a provisional injunction, unless the defendants refuse to take and pay for a license.²

As a lesser hardship upon the defendants, and especially when a provisional injunction would work great harm to the defendants, or when the court is not clear that an injunction should issue, the court will sometimes order that the defendants keep an account of profits, and give bond for payment of damages, pending the continuance of the suit.

"Whether restraining orders come out in patent cases or any other cases, they are framed according to the circumstances of each case, to wit : in one case there may be such circumstances as require an injunction *simpliciter*, but ordinarily a bond and order for accounting suffices and sometimes simply an order for accounting."³

Defenses. The statute enacts : " *Sec. 4920.* In any

¹*Pullman v. B. & O. Railroad Co.*, 5 Fed. Rep. 72.

²*Baldwin v. Bernard*, 5 Fish. Pat. Cases, 442.

³*Kirby Bung Mfg Co. v. White*, 1 Fed. Rep. 604.

action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove, on trial, any one or more of the following special matters :

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect, or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same ; or,

Third. That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof ; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented ; or,

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used ; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in

equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect."¹

The defense permitted by the second clause is that of "prior invention," that of the third clause "prior patent or publication," that of the fourth clause "prior use," and that of the fifth clause "public use for more than two years prior to application," and "abandonment,"—all of which topics have been discussed in preceding chapters.

There are other defenses that can be set up. The defendant may charge that the specification is uncertain and ambiguous in the description or the claim or both, that a combination claimed is a mere aggregation, that he has a license, that the plaintiff has unreasonably delayed to file a disclaimer, that there is a total lack of utility in the alleged invention, that the patent, if a re-issue, is void because not for the same invention as the original, and any other special defense.

It would seem, on general principles, proper for a defendant, under the general issue—in an action at law—or under a general denial of the validity of the patent and of infringement thereof—in a suit in equity—to make any defense not mentioned in the statute last quoted (barring of course matters proper for abatement or demurrer)² subject to the exception that any defense consistent with the allegations of the declaration or bill of complaint, should be set up specially in defendant's plea

¹ Rev. Stat. Title LX. Chap. 1.

² *Blanchard v. Puttman*, 3 Fisher's Pat. Cases, 186; 8th Wall. 420; 2d Bond, 84; *Evans v. Hettick*, 3 Wash. C. C. 408; 7th Wheaton, 453; *Gray v. James*, Peters C. C. 394.

or answer; but the courts are not in harmony in this matter and the safer mode of pleading is for defendant to specially mention all his defenses in his answer or plea.

The above statute does not compel a defendant at law to plead the general issue and give notice, for he may plead specially.¹ Evidence as to the state of the art in question, prior to the patentee's invention, may be taken without notice;² but such evidence can only be considered in construing the patent, that is, in determining how broad a construction can be given to the claim. The statute does not call for the names of witnesses who are to testify but only for the names, &c., of those persons who had the prior knowledge.³

Questions of Law and Fact. As between a judge and a jury, it is the province of the judge to pass on questions of law, and that of the jury to pass on questions of fact, although in equity cases (which comprise the great majority of all patent cases) it is customary for the judge to pass on questions of fact as well as of law.

Without attempting anything fine and subtle in distinction, the following is a classification in a general way of the questions which usually arise in patent causes.

Questions of Law. It is for the court to say what

¹ *Evans v. Eaton*, 3d Wheaton, 454.

² *Brown v. Piper*, 91 U. S. 37.

³ *Wilton v. Railroad Co.*, 1 Wall. Jr. 195.

the patentee claims and what he does not claim,¹ and it follows that it is for the court to say whether the claim is so drawn that there can be gathered from it what is meant to be claimed; or, in other words, to determine whether there is ambiguity in the claim.² It is for the court to say whether or not two patents—originals or reissues—claim the same thing upon their faces, and it is for the court to say whether the actual invention is one kind of patentable subject-matter, as a process, while another kind, as a machine, is claimed;³ and, also, whether the invention has statutory utility,—that is, *any* utility, in contradistinction from being frivolous, or insignificant, or pernicious in its purpose.⁴

Questions of Fact. Abandonment is a question of fact.⁵ It is a question for the jury, whether two things are substantially identical, and this question may arise when it is attempted to show that the patented thing is anticipated by some prior thing, or in determining whether one thing infringes a certain patent.⁶ It is for the jury to say whether a specification is in such full, clear, and exact terms as to enable a properly skilled person to put the invention in practice, working by the specification,—that is, to determine whether there is ambiguity in the description.⁷ It is for the jury to say, under the issue

¹ *Washburn v. Gould*, 3 Story, 122.

² *Davis v. Palmer*, 2 Brockway, 388; *Emerson v. Hogg*, 2 Blatchford, 6.

³ *Kay v. Marshall*, 2 Webster's Pat. Cases, 34.

⁴ *Langdon v. Degroot*, 1 Paine's C. C. Reports, 203; *Lorwell v. Lewis*, 1 Mason, 182.

⁵ *Whittemore v. Cutler*, 1 Gallatin, 482.

⁶ *Smith v. Higgins*, 1 Fisher's Pat. Cases, 537.

⁷ *Wood v. Underhill*, 5 Howard, 4.

of "prior patent or publication," whether the patent or publication is a full anticipation. It is a question of fact, to determine the meaning of technical terms or words of art in a specification ;¹ also whether one device has superior utility over another.

Novelty is a question of fact as it is also to determine whether a concealment or a redundancy in a specification is with fraudulent intent ;² also whether an original and a reissued patent are for the same invention when facts not disclosed by the patents affect that question.³

Whether an alleged inventor ever conceived, and when he conceived an invention, whether he ever reduced it to practice, and when, whether the alleged invention was ever in public use, or whether in public use for more than two years prior to application, and whether an invention was sole or joint,—are all questions of fact.

Limitation of Infringement Suits in Equity. Formerly the weight of authority, so far as the United States Circuit Courts were concerned, was overwhelmingly in favor of the rule that an equity suit will lie to recover damages and profits after the expiration of a patent, the basis of the rule usually being that an infringer is to be considered as a trustee of the profits which he has received through his infringement of the patent ;⁴ but this

¹ *Washburn v. Gould*, 3 Story, 122.

² *Gray v. James*, Peters' C. C. Reports, 476.

³ *Carver v. Braintree Mfg Co.*, 2 Story, 441.

⁴ *Nevins v. Johnson*, 3 Blatchford, 80 ; *Vaughan v. E. Tenn. Va. & Ga. R. R. Co.*, 9 Legal News, 255 ; *Vaughan v. South & North Alabama R. R. Co.*, Middle Dist. of Ala. ; *Vaughan v. Wallace*, Northern Dist. of Georgia ; *Sayles v. Dubuque & Sioux City R. R. Co.*, 5 Dillon, 562 ; *Sayles v. South Carolina R. R. Co.*, Southern Dist. So. Carolina ; *Sayles v. Lake Shore & Michigan Southern R.*

matter came to be argued before the Supreme Court which held otherwise and said :—

“ Our conclusion is that a bill in equity for a naked account of profits and damages against an infringer of a patent cannot be sustained ; that such relief ordinarily is incidental to some other equity, the right to enforce which, secures to the patentee his standing in court ; that the most general ground for equitable interposition is to insure to the patentee the enjoyment of his specific right by injunction against the continuance of the infringement ; but that grounds of equitable relief may arise other than by way of injunction as where the title of the complainant is equitable merely, or equitable interposition is necessary on account of the impediments which prevent a resort to remedies purely legal ; and such an equity may arise out of and inhere in the nature of the account itself springing from special and peculiar circumstances which disable the patentee from a recovery at law altogether or render his remedy in a legal tribunal difficult, inadequate and incomplete ; and as such cases cannot be defined more exactly each must rest upon its own particular circumstances as furnishing a clear and satisfactory ground of exception from the general rule.”¹

Limitation of Infringement Suits at Law.—
The statute of limitations contained in the 55th section of the Act of July 8, 1870, and preserved by section

R. Co., Northern Dist. of Ill. ; *Stevens v. Kansas Pacific R. R. Co.*, 5 Dillon, 486 ; *Gordon v. Anthony*, 16 Blatchford, 234 ; *Sayles v. Mobile & Spring Hill R. R. Co.*, South. Dist. of Ala. ; *Root v. Denver & Rio Grande R. R. Co.*, Dist. of Col.

¹*Root v. L. S. & M. S. R. R. Co.*, 21 O. G. 1112.

5599 of the Revised Statutes means that actions for infringement must be brought within the original term of the patent, or within six years thereafter; or—in case of an extended term and infringement occurring thereon—within said extended term or within six years thereafter.¹

Costs.² It will be remembered, as mentioned in the chapter on Disclaimers, that where a claim of the patent in suit is put in issue and is found invalid for lack of novelty—no disclaimer thereto having been made before the suit was brought—no costs are to be allowed although the party suing prevail upon other claims in the patent;³ and this loss of costs applies to the whole case even though the complainant files a suitable disclaimer during the progress of the suit; “the provision is not that no cost shall be recovered until after disclaimer but it is as extensive as the whole existence of the case and prohibits the recovery of any costs at all in the case”⁴; this provision has considerable importance for when an equity suit goes to an accounting in damages the costs are often considerable.

Although it is the general rule in equity to allow costs to the prevailing party it is not a rule without exceptions, and whenever the allowance of costs would be inequit-

¹ *Sayles v. L. C. R. R. Co.*, 9 Fed. Rep. 512; *Same v. L. S. & M. S. R. R. Co.*, 9 Fed. Rep. 515; *Same v. Dubuque & Sioux City R. R. Co.*, 9 Fed. Rep. 516.

² The fees allowed to Attorneys, Solicitors, Clerks of Courts, Marshals, Commissioners, &c., may be found in Chapter 16, Title 13, Revised Statutes.

³ Section 4922, Chapter 1, Title LX. Rev. Stat.; *Seymour v. McCormick*, 19 How. 96.

⁴ *Burdett v. Estey*, 3 Fed. Rep. 566.

able the court will exercise its sound discretion as to granting, or refusing, or dividing, or denying them.¹

“Costs, generally, in proceedings in equity, do not follow as matter of right as in proceedings at law, but are subject to the discretion of the court and are to be awarded as a part of the decree or they cannot be recovered although they may be and generally are, taxed after the decree. The determination as to costs must ordinarily be made upon the hearing in chief. * . The costs cannot be taxed fully and no execution can properly issue until after the final decree. * . They are awarded as issued unless there are special circumstances to govern them”²

“The statute does not mean that claims not in issue should be contested for the mere purpose of settling the costs,”³ and a case will not be reviewed on appeal by the Supreme Court merely to settle the question of costs.⁴

The fees of a master who attends to an accounting in damages are to be borne in the first instance by complainant;⁵ and this rule applies to all costs which accrue to the court and its officers.

In a case where the complainant brought a suit upon two patents, prevailed upon one and was defeated as to the other, the court said: “As the complainant succeeds as to one patent and is defeated as to the other, I sup-

¹*Hovey v. Stevens*, 2 Robb. 567; *Hathaway v. Roach*, 2 W. & M. 63; *Smith v. Woodruff*, 4 O. G. 635; *Coburn v. Schroeder*, 20 O. G. 1085.

²*Coburn v. Schroeder*, 8 Fed. Rep. 521.

³*American Bell Telephone Co. v. Spencer*, 8 Fed. Rep. 509.

⁴*Union Paper Bag Mach. Co., v. Nixon*, 21 O. G. 1275.

⁵*Macdonald v. Shepard*, 10 Fed. Rep. 919.

pose it will be fair that neither party shall recover costs." ¹

In an another case where the complainant insisted on an accounting after the defendants offered to pay the net profits realized by defendants through their infringement the court said: "The conclusion is justified by the record that the defendants were willing at the outset, and through their attorney offered to pay to the complainant the amount of the net profits realized by them, but the plaintiff was desirous of mulcting them in damages under circumstances not calling for such a course. Costs have been unnecessarily accumulated and I think it just that the parties be required to pay their own costs, and each party must pay one-half of the master's fee." ²

The cost of models generally does not seem to be taxable even though made by order of court; ³ but models of the invention described in the complainant's patent and procured by the defendant in good faith may be included in the taxation of costs. ⁴

It seems that in computing the mileage of a witness the distance is to be computed by an air line; ⁵ it has been held that mileage may be allowed even for travel of a witness outside of the district; ⁶ but in a later case it was held that witnesses in civil cases who live out of the district and more than one hundred miles from the place of holding court, cannot be lawfully summoned and that their attendance is necessarily voluntary even if a sub-

¹ *Elfelt v. Steinhart*, 11 Fed. Rep. 896.

² *Ford v. Kurtz*, 12 Fed. Rep. 789.

³ *Parker v. Sigler*, 1 Fisher's Pat. Cases, 285.

⁴ *Woodruff v. Barney*, 2 Fisher's Pat. Cases, 244.

⁵ *Parker v. Bigler*, 1 Fisher's Pat. Cases, 285.

⁶ *Woodruff v. Barney*, 2 Fisher's Pat. Cases, 244.

poena is in fact served :¹ and the principle of this decision goes to the extent that the fees of a witness living within the district, who voluntarily attends without a subpoena, cannot be taxed ; but in the case last referred to where the court was that for the district of California, and the parties for their mutual convenience entered into an agreement to take testimony for both parties residing in Vermont and New Hampshire before a commissioner in the city of New York without the formality of a commission, wherein many witnesses voluntarily attended and testified, the court allowed the prevailing party reasonable compensation for traveling expenses of his witnesses and adopted the amount fixed by the Act of 1853 as the measurement of the compensation ; and in this same case (referring to 1st Blatchford, 17) the court held that costs cannot be allowed for printing testimony ; however, at the present writing Circuit Courts generally make rules requiring such printing and allow costs therefor.

In a case before the Supreme Court where the decree of the lower court was confirmed as to injunction and reversed as to the accounting, the costs in the Supreme Court were taxed against the appellee.²

In a case where the master made a finding of substantial profits and damages in complainant's favor, but the court refused to confirm the master's finding and held that only nominal damages should be awarded, costs were allowed to the complainant except as to the reference before the master, and the costs accruing on the reference were allowed to defendant.³

¹ *Spaulding v. Tucker*, 4 Fisher's Pat. Cases, 633.

² *McLean v. Fleming*, 13 O. G. 913.

³ *Ingersoll v. Musgrove*, 13 O. G. 966 ; see also *Fisk v. The W. B. & C. Mfg Co.*, 19 O. G. 545.

Where complainant commences his case with a non-joinder of parties, only those costs accruing after such non-joinder is cured, will be allowed.¹

The right to tax the docket fee, where the case is one of the number embraced by stipulation in a single hearing, the decree in that one case to stand for the decree in all, has been judicially said to be clear; also that if, after the issue of an interlocutory decree involving a decision upon the merits, the case is finally dismissed by final decree upon motion of complainants, the docket-fee is to be taxed;² but it is also held that the docket-fee is not to be allowed unless the case goes to final hearing.³

When costs are equitably taxed and consented to by both parties, neither party can be allowed to withdraw its consent upon the coming in of the master's report.⁴

¹ *Frese v. Bachof*, 13 O. G. 635.

² *Goodyear Dental Vulcanite Co. v. Osgood*, 13 O. G. 325.

³ *Coy v. Perkins*, 13 Fed. Rep. 111.

⁴ *Holbrook v. Small*, 17 O. G. 55.



CHAPTER XIX.

DAMAGES AND PROFITS.

THE statute enacts : "*Section 4919.* Damages for the infringement of any patent may be recovered by action on the case, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs."

Section 4921. The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunction according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable ; and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby ; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to in-

crease such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case."¹

On comparing these two sections of the statute it is to be seen that the money recovery in an equity suit may be something different from that in a suit at law. In the case of a suit at law damages only are recoverable while in an equity suit the complainant may recover defendant's profits as well as any damages in excess of such profits. Courts have sometimes spoken of damages and profits as if they were convertible terms, but such is not the case; courts have now come to distinguish clearly between the two.²

The whole subject is a difficult and abstruse one; each case stands to a great extent, upon its own circumstances although there are general rules of substantially universal application.

Defendant's Profits. The law intends to give to him whose patent is infringed, the profits actually made by the infringer, through his infringement, without any addition thereto in the shape of punishment; and means that the patentee shall prove what these profits are, giving him to that end a power which is substantially inquisitorial over the infringer—after a court has pronounced him such—and over his papers and books of account.

In an equity suit, after the court has decided that the defendant has infringed the complainant's patent, the

¹ Rev. Stat. Title LX, Chap. I.

² *Goodyear D. Vulcanite Co. v. Van Antwerp*, 9 O. G. 497.

court makes an interlocutory decree stating that the patent is infringed and referring the case to a master in chancery to ascertain and report to the court the gains and profits which the defendant has made through his infringement as well as the damages which the complainant has sustained thereby. The mode of procedure—substantially alike in all courts—which Judge Lowell of the first district has approved, is as follows: “The master appoints a day for proceeding with the reference and gives notice by mail or otherwise to the parties or their solicitors. We think the solicitor should be notified whether the party is or not; though probably under rule 75 notice to the party is a good notice. If the defendant does not appear the master proceeds *ex parte* and makes out the profits and damages, if he can, from the evidence produced by the plaintiff. If it appears that the account of profits is necessary to a just decision of the cost and is desired by the plaintiff he makes an order that the defendant furnish an account by a certain day and adjourns the hearing to that day.

The defendant should be served personally with a notice of this adjournment and of the order to produce his account if it is intended to move for an attachment in case he fails to appear. The service may be made by any disinterested person and need not be by the marshal. If the defendant then fails to appear and account he will be in contempt.”¹

When the master is ready he makes a report called a “draft report” which is submitted to the counsel of both parties for their objections and suggestions after which

¹*Kerosene L. Heater Co. v. Fisher*, 1 Fed. Rep. 91.

the master prepares the report in form and files it in court: then the parties may take exceptions thereto and upon the hearing for a confirmation of the report the exceptions are argued before the court which then confirms or otherwise acts upon the report in its sound discretion.

The following references to adjudicated cases will give a general idea of the principles involved in arriving at defendant's profits.

In a case which came before the Supreme Court, where the patented invention was a process for annealing chilled cast iron car wheels, the master awarded to the complainant substantially the whole profits which defendant had made upon the manufacture and sale of its wheels; the court refused its assent to such a finding and said: "The question to be determined in this case is, what advantage did defendant derive from using complainant's invention over what he had in using other processes then open to the public and adequate to enable him to obtain as clearly beneficial result. The fruits of that advantage are his profits. * . They are all the benefits he derived from the existence of the * invention. * . That advantage is the measure of the profits. * . The patent is for an entire process made up of several constituents. The patentee does not claim to have been the inventor of the constituents. The exclusive use of them singly is not secured to him. What is secured is their use when arranged in the process. Unless one of them is employed in making up the process, and as an element of it, the patentee cannot prevent others from using it. As well might the patentee of a machine, every part of which is an old and well known device, appropriate the

exclusive use of each device though employed singly and not combined with the others as a machine."¹

In another case where the patent before the Supreme Court was for an apparatus for repairing railroad rails, the court authorized the finding of profits on the basis of the savings made in using the patented apparatus compared with the cost of using the common apparatus.²

The following excerpt from another case gives the facts and the court's action thereon; "The decree directed the master to report the profits received by the defendant from the manufacture, use, or sale of the patented improvement. It is those profits alone which the plaintiff can recover. He cannot recover anything more as profits. He cannot recover the profits of the manufacture, sale or use of anything but the patented improvement. He cannot recover the profits of the manufacture, use, or sale of anything found in the pavement or of any part of the pavement except the patented improvement. Whatever distinctive profits belongs to the use of 'the arrangement of tar paper or its equivalent between adjoining blocks of concrete, substantially as and for the purpose set forth' in the patent, is the profit to be recovered. If he fails to show it, he can recover nothing as profits. The plaintiff has proved no license fee as showing the value of the patented improvement. No evidence on the subject was given before the master. The reference proceeded on principle that all the value as usefulness there was in the pavement laid by the defendant was due to the permanent or temporary interpo-

¹*Mowry v. Whitney*, 14 Wallace, 620.

²*Railroad Co. v. Turrill*, 12 O. G. 709.

sition in the joint during the process of laying of something external to make a separation into blocks or sections. This was clearly a mistake. The plaintiff's invention contributed but a small part of the usefulness of the pavement. As a concrete pavement, with all the advantages due to the smoothness and durability of such pavement, it was a valuable pavement, without being in blocks or sections made by the use of the patented improvement. The advantage of being in blocks made by the use of the patented improvement was an advantage which does not give to the plaintiff the right to recover the profits of laying the entire pavement. These principles are well settled. (*Mowry v. Whitney*, 14 Wallace, 620, 649; *Philip v. Knock*, 17 Wallace, 460; *Gould's Mfg Co. v. Cowing*, 12 Blatch. C. C. R. 243; *Gould's Mfg Co. v. Cowing*, 12 Of. Gaz. 942; *Black v. Munson*, before Mr. Justice Hunt in the Circuit Court of the United States for the Northern District of New York, June, 1877; *Buerk v. Imhaueser*, 10 Of. Gaz. 907; *Blake v. Robertson*, 4 Otto, 728; *Garretson v. Clark*, 14 Of. Gaz. 285.) Exceptions 19, 20 and 22 are allowed so far as they claim that the master should not have reported any sum as profits under the interlocutory decree."¹

In another case "complainant's patent was for the combination of a swing truck with a locomotive;" the judge held that "in estimating profits the comparison of advantages should be made between complainant's invention and an engine having a rigid truck and forward driving wheels without flanges" which last structure had never been used by defendant but was open to the public to use: thus compared the court then found no advantage in the patented structure and awarded no profits; and as to

¹ *Schillinger v. Gunther*, 14 O. G. 713.

the character of the evidence by which savings were to be determined, the court said: "Some witnesses it is true have given estimates of savings made by the use of a swing truck. But an examination of their testimony convinces me that their estimates are mere guesses without any reliable basis."¹

In another case the court said: "It is now well settled that if the complainant in a suit for an injunction and profits fails to show that the use of his invention in connection with other machinery of which his invention is an improvement, has produced a definite part of the whole profits his recovery must be nominal only."² In this same case the master gave complainant "the entire profits of the business on the ground that the defendant failed to separate the profits traceable to the complainants from the general profits"; but the court held that the complainant must offer proof properly apportioning the profits due to the use of the invention as distinguished from the other profits, or have only a nominal award.

It will be seen from these cases that in ascertaining defendant's profits the breadth of the claim infringed is not necessarily a matter of great weight, the real question to be determined in that regard being what the patented invention really is as compared with the prior art; it is also to be seen that defendant's profits are to be computed not upon the whole structure made and sold by defendants—unless the whole structure is new and is so patented to complainant—but only upon that part of the structure which is new; also that complainant must fur-

¹*Locomotive S. T. Co. v. P. R. Co.*, 2 Fed. Rep. 677.

²*Kirby v. Armstrong*, 5 Fed. Rep. 803.

nish evidence to properly apportion the profits so as to separate those which are due to the invention from those which are due to the remainder of the structure, failing which complainant will have a nominal award only ; and that this evidence must not be in the nature of conjecture or estimate but must have a solid basis of fact. Furthermore, the profit to be awarded is not the gross profit but the net profit, making proper allowances for such matters as rent, clerk hire, bad debts, royalties paid under other patents, improvements made by defendant, and the other legitimate expenses incidental to the carrying on of defendant's business.¹

As to interest to be allowed upon defendant's profits "it is doubtless the general rule that interest prior to the final decree is not to be allowed upon profits or damages, because until the decree they are unliquidated ;"² though this rule is not invariable ; for instance, interest may be allowed on profits realized by defendant through infringement committed while defendant had knowledge of complainant's patent.³ When interest on defendant's profits is allowable it does not begin to run till after disclaimer filed in a case where a disclaimer is necessary.⁴

Neither is the rule that an invention of a part of a structure will not carry with it the profits on the whole structure an invariable rule, the Supreme Court having held in a case where a patented pump for oil wells—new only in part—had only a local and very limited market,

¹ *Hitchcock v. Tremaine*, 5 Fish. Pat. Cases, 310 ; *Troy Factory v. Corning*, 3 Fish. Pat. Cases, 497 ; *Am. Pavement Co. v. Elizabeth*, 6 O. G. 764.

² *Mowry v. Whitney*, 14 Wall. 620.

³ *Burdett v. Estey*, 3 Fed. Rep. 566.

⁴ *Ibid.*

and controlled that market, that defendant's whole profits should be allowed, saying: "This is an exceptional case."¹

"The right to recover for infringement of a patent like other choses in action, is assignable in equity and the real owner of the right is entitled to maintain a suit upon it, in equity, in his own name."²

Damages. In a suit at law damages only are recoverable. In a suit in equity both profits and damages are recoverable but complainant can only recover such damages as are in excess of the amount of the profits.

The general principles for the ascertainment of damages will be understood from the following *resumé* of cases.

Upon this point the Supreme Court said in one case: "Actual damages must be actually proved, and cannot be assumed as a legal inference from any facts which amount not to actual proof of the fact. What a patentee 'would have made, if the infringer had not interfered with his rights, is a question of fact and not a judgment of law.' The question is not what, speculatively, he may have lost, but what he actually did lose. It is not a 'judgment of law' or necessary legal inference, that if all the manufacturers of steam engines and locomotives who have built and sold engines with a patented cut-off, or steam whistle, had not made such engines, that therefore all the purchasers of engines would have employed the patentee of the cut-off, or whistle; and

¹ *Goulds Mfg Co. v. Cowing*, 21 O. G. 1277.

² *Shaw v. Colwell Lead Co.*, 11 Fed. Rep. 711.

that, consequently, such patentee is entitled to all the profits made in the manufacture of such steam engines by those who may have used his improvement without his license. Such a rule of damages would be better entitled to the epithet of 'speculative,' 'imaginary,' or 'fanciful,' than that of 'actual.'

If the measure of damages be the same, whether a patent be for an entire machine or for some improvement in some part of it, then it follows that each one who has patented an improvement in any portion of a steam engine or other complex machine, may recover the whole profits arising from the skill, labor, material and capital employed in making the whole machine, and the unfortunate mechanic may be compelled to pay treble his whole profits to each of a dozen or more several inventors of some small improvement in the engine he has built. By this doctrine even the smallest part is made equal to the whole, and 'actual damages' to the plaintiff may be converted into an unlimited series of penalties on the defendant."¹ And again: "The measure of the damages to be recovered against infringers, prescribed by the Act of 1836, as well as by the Act of 1870, is the actual damages sustained by the plaintiff. * * In arriving at these conclusions, the profit made by the defendant and that lost by the plaintiff are among the elements which the jury may consider. When the infringement is confined to a part of the thing sold, the recovery must be limited accordingly. It cannot be as if the entire thing were covered by the patent."²

¹ *Seymour v. McCormick*, 16 Howard. 480.

² *Phillip v. Nock*, 17 Wallace, 460.

In a later case : The master, after computing defendant's profits, arrived at complainant's damages by multiplying complainant's net profit by the number of infringing watches sold by defendant. The court, in rejecting the master's report, said : "It is only actual damages which are proved to have been sustained by the plaintiff that he can in any event recover. It is not enough that he may have suffered loss, for he cannot have compensation for conjectural losses ; the losses must be proved and not guessed at. (*Philp v. Stark*, 17 Wall. 462.)

It was not made to appear that the plaintiff could have sold his watches to the persons who purchased from the defendants. The watches have been adjudged to be identical in principle, but they differ in structure and appearance, and it cannot be known that those who bought the infringing article would have bought the plaintiff's watches, under any circumstances. The difference in structure, as well as the difference in price, enter into that question, and no means are afforded for determining it by the proofs. (*Smith v. O'Connor*, 6 Fisher, 469 ; *Carter v. Barker*, 4 Fisher, 410.)

The inquiries suggested by these cases, as pertinent to the assessment of a plaintiff's damages, do not warrant the adoption of the result stated in the report. The damages in such a case must be confined to the direct and immediate consequences of the infringement, and not embrace those which are both remote and conjectural.

There is another error involved in this assessment of damages, and that is that the estimated profit of the patentee embraces not only that derived from the sale of the patent privileges, but also the whole manufacturer's

profits upon the materials and workmanship of the whole article. * * *

In cases where the patent is for a distinct improvement, separable from the rest of the article, as in the case put by the plaintiff's counsel, of a wagon with a patent pole, the rule is admitted and settled. (*Seymour v McCormick*, 16 How. 491; *Gould Mfg Co. v. Cowing*, 8 Of. Gaz. 277; *Mozery v. Whitney*, 14 Wall. 620; *American N. P. Co. v. Elizabeth*, 6 Of. Gaz. 764; *Littlefield v. Perry*, 21 Wall. 228.) The same principle is, I think, applicable to a case of this kind. The watch is open to the manufacture of every one, and it is common to both the plaintiff's patented article and to the infringing article of the defendant. The wrong which the case shows the plaintiff to have sustained is the use of his invention in the making by the defendants of the infringing watches.

They have taken his invention and used it in making the infringing watches; and it is the value of that use the right to which belonged to the plaintiff that they have appropriated to themselves. For this the plaintiff is entitled to recover in damages; but this rule has been disregarded, and the case does not furnish any evidence which can either support the actual finding or form the basis for a correction in this respect by the court. The burden in this respect was upon the plaintiff."¹

In another case the master reported that the complainant was compelled to reduce his prices through defendant's competition; also that complainant was entitled to the profit he would have made if he had sold the infringing articles which defendant sold; and of this find-

¹ *Buerk v. Imhaeuser*, 10 O. G. 907.

ing the court said : "The question whether the prices which the plaintiff received for his cuspadores were less than those which he would have received but for the infringements by the defendants is a question of fact.

Such also is the question as to the amount of the reduction, and as to how much of it was occasioned by the acts of the defendants ; and as to how much of it was attributable to the fact that the infringing articles contained the patented feature of the plaintiff's patented cuspadores. Such also is the question as to whether, if the infringing cuspadores had not been sold, the plaintiff would have sold any greater number of the patented cuspadores than he did sell, and what profit he would have made on them, and what part of such profit is to be assigned to the defendant's patented feature of the cuspadores.

It is for the plaintiff to establish, by satisfactory evidence, not only that a reduction of his prices was caused by the infringements, but how much such reduction was ; and how much of it was occasioned by the acts of the defendants ; and how much was due to the fact that the infringing articles contained the patented feature of the plaintiff's patented cuspadores.

I am not satisfied with the conclusions of the master on this subject. The evidence on which those conclusions were reached was in the shape of estimate, and conjecture, and opinion, and afforded no proper basis for a report of actual damages by a forced reduction of prices. The allotment of thirty per cent. of such reduction to the infringements by the defendants, and to the fact that the infringing articles contained the patented features of the plaintiff's patented cuspadores, and of

seventy per cent. of such reduction to other causes, is founded only on the conjectures, estimates, and assertions of witnesses, and not on any sound and safe basis of calculation. * * * *

So, also, it is for the plaintiff to establish, by satisfactory evidence, that he would have sold more of the patented cuspadores than he did sell if the infringing cuspadores had not been sold; and what profit he would have made on them; and what part of such profit is to be assigned to the distinctive patented features of the cuspadores. I see no proper foundation in the evidence for the conclusion that, if the defendant in the first case had not sold the 1,003 infringing cuspadores, the plaintiff would have sold 1,003 more of the patented cuspadores than he did sell. The conclusion has no other basis than conjecture and speculation. Only nominal damages should have been reported in each case.”¹

The same court made substantially the same finding in another case which followed shortly after the one last cited,² and in still another case following shortly after, the court said: “The master also reports that ‘the complainant is entitled to recover from the defendant a further sum as special damages, on account of the laying of the pavement for Andrew Dold, which pavement was laid in the same manner as the City Hall-pavement, above referred to, the proofs showing that said pavement was contracted for and laid by the defendant in October, 1876, but is not included in any of the accounts tendered by him, and that it is shown that the complainant gave

¹*Ingersoll v. Musgrove*, 13 O. G. 966.

²*Garretson v. Clark*, 14 O. G. 485.

Dold a bid or estimate for the said work, and that he was underbid by the defendant, and thus was damaged to the amount of \$900.' Exception 21 excepts to the report because it finds 'that the complainant is entitled to recover from the defendant special damages on account of the laying of a pavement for Andrew Dold, and that the proofs show that said pavement was laid in the same manner as the City Hall pavement.' So much of exception 21 as excepts to the report of the \$900, as special damages, is allowed. Exception 22, before cited, is broad enough to be an exception to the report of the \$900, as damages. The remarks before made as to the allowance of profits, apply to this \$900. If entitled, in any event, to any allowance of damages in respect to the Dold pavement, the plaintiff must show the value of the patented invention as distinct from the value of the rest of the Dold pavement, and can in no event recover as damages the entire \$900."¹

In a case which followed the one last mentioned the same court said: "The plaintiff excepts to the finding of the master that the testimony of the witnesses, Munger and Cady, does not form a basis upon which the master can make a computation of the money value of the device which the defendant should pay to the plaintiff, for the reason that the estimate and opinion of experts is competent evidence of the value in cases like the present. The plaintiff also excepts, in that the master * * does not take into consideration not only the same circumstance, but the opinions of the witnesses, Munger and Cady, and the other circumstantial evidence in the case

• ¹ *Schillinger v. Gunther*, 14 O. G. 713.

relating to the requirements of the market, the effect of the plaintiff's picking of the defendant's lock, the impossibility of substituting any other device except the patented device, to serve the same purpose, during the period when said patented device was used by the defendant, and all the other evidence introduced by the plaintiff. * * * I think the master was right in rejecting the estimate of the witness, Munger, and the general evidence of the witness Cady."¹

It is to be seen from this *resumé* of cases upon damages that it cannot be presumed that those who purchased goods from defendant would have purchased the same goods from complainant if defendant's had not been in the market; complainant must make actual proof on this point: nor can it be presumed that a decrease in complainant's sales is caused by defendant's competition. It is also to be seen that it cannot be presumed that a lowering of complainant's prices is caused by defendant's competition. It is also to be seen that where the patented thing is a mere improvement in part of the device, the proof of resulting damages must be apportioned as to that part and complainant must furnish that proof: it is also to be seen that opinions and estimates, even of experts, cannot be accepted as evidence upon any of these points.

In view of the general rules deduced from the foregoing *resumé* of cases upon damages there are two or three cases to which some little attention may not be inadvisable. In one case where the patented improvement was a series of perforations in a circular saw, the

¹*Sargent v. Yale Lock Mfg Co.*, 17 O. G. 106.

circuit judge gave complainant as damages the defendant's entire profit;¹ this case is not entirely reconcilable with the other decisions but it proceeded upon the ground "that there was or should be only one perforated saw in the art."

In another case where the patented invention was a design for carpets² the same circuit judge who decided the last case gave to complainant as damages a product arrived at by multiplying defendant's sales by complainant's profits; in this case, however, the patented thing was new as an entirety, the defendants took it as an entirety, and the infringement was willful.

Where complainant has a settled and fixed royalty or license fee for the use of his invention, courts will accept that as a measure of damages to be awarded.³ The same rule as to interest prevails with damages as with profits; that is, in general, interest does not begin to run until after the decree fixing them; for, until that time, they are unliquidated; an exception to this rule, in the case of damages, would be where a royalty is settled upon as the basis therefor, the interest in such a case beginning with the infringing use.⁴ The statute authorizes an increase of damages to triple the amount of actual damages (which is not the case with profits), but such an increase is only presumable in case that the infringement is wanton or malicious; in a case where this point arose the

¹*Am. Saw Co. v. Emerson*, 8 Fed. Rep. 806.

²*Bigelow Carpet Co. v. Dobson*, 10 Fed. Rep. 385.

³*Locomotive S. T. Co. v. Penn. Railroad Co.*, 2 Fed. Rep. 677.

⁴*Ibid.*

court said: "The infringement by defendants of complainant's patent was neither willful nor malicious. The case does not justify a decree against them beyond the net profit realized from the manufacture and sale of the patented article."¹

¹*Ford v. Kurtz*, 12 Fed. Rep. 789.



CHAPTER XX.

MISCELLANEOUS MATTERS.

Marking Patented Articles. The statute enacts :
“*Section 4900.* It shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented ; either by fixing thereon the word ‘patented,’ together with the day and year the patent was granted ; or when, from the character of the article, this cannot be done, by fixing to it, or to the package wherein one or more of them is enclosed, a label containing the like notice ; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the articles so patented.”¹

Formerly the statute affixed a direct penalty for an omission to duly mark patented articles with the date of the patent, but under the present statute the only penalty is a loss of damages previous to actual notice in a suit for infringement. This omission does not affect the patentee’s right to an injunction either perpetual or provisional.²

¹Rev. Stat. Title LX, Chap. 1.

²*Goodyear v. Allyn*, 3 Fisher’s Pat. Cases, 374.

In putting on the patent stamp the day of the month as well as the year must appear, but the word "patented" may be abbreviated.¹ The burden of proof is upon defendant to show that complainant has failed to mark the patented articles as required by law; but that being shown, the burden of proof is then on complainant to show that before the suit was brought the defendant was notified of his infringement and thereafter continued to infringe.²

Where there are different owners in the patent, each having right to bring suit for infringement, and one of them fails to duly mark the patented articles sold by him, his failure in this respect does not affect the other patent owners.³

Fraudulent Patent Marks. The statute enacts:
 "Section 4901. Every person who, in any manner, marks upon anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor, without the consent of such patentee, or his assigns or legal representatives; or,

Who, in any manner, marks upon or affixes to any such patented article the word 'patent' or 'patentee,' or the words 'letters-patent,' or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or,

¹ *Harvey v. Bigley*, Mss. Bates. Jr. N. Y.

² *Goodyear v. Allyn*, 3 Fisher's Pat. Cases, 374; but see *contra McComb v. Brodie*, 5 Fisher's Pat. Cases, 384.

³ *Goodyear v. Allyn*, 3 Fisher's Pat. Cases, 374.

Who, in any manner, marks upon or affixes to any unpatented article the word 'patent' or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offense, to a penalty of not less than one hundred dollars, with costs; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed."¹

The action provided for in this statute "must be prosecuted by an informer, or if the name of the United States can be properly used, it must be in connection with a person to be named as informer who shall be responsible in case the action is not sustained, for costs or other consequences resulting from its failure."² It was held in this case just quoted from that "although the statute, without much show of reason, on any ground of public policy, affixes a penalty for placing the word 'patented' on an unpatented article, yet it must be construed to mean that such article, if not patented, was patentable. As the statute, under which this action is brought is highly penal it must receive a strict construction or cannot be held to embrace any act which, though within the strictness of its letter, is against reason and common sense. It would be doing injustice to the framers of this law to suppose they intended to include in its prohibitions, and to visit with a penalty the mere act of putting the word 'patented' on an article not patented nor patentable. * . And it is clear to my mind

¹Rev. Stat. Title LX, Chap. I.

²*United States v. Morris*, 3 Fisher's Pat. Cases, 72.

that to justify a judgment for a penalty for putting the word *patented* on an article, the declaration must allege and there must be proof on the trial, that it was legally the subject of a patent."

In order to prevail in a suit of this kind the plaintiff must prove beyond a reasonable doubt that the defendant affixed the word "patented" to his article; also that defendant had no patent; also that such use was with the intent to deceive; for if defendant affixed the word "patented" to his articles without that intent, as, for instance, under a well founded expectation of a patent to be obtained then the penalty would not be incurred.¹ This action may be brought at any time within five years after the offense is committed.²

Maintaining upon articles a stamp denoting a patent and its date after the expiration of a patent does not make the party thus acting liable to the penalty inflicted by the statute.

Rights of States as to Patents. As already mentioned in discussing the topic of jurisdiction in the chapter upon Infringement Suits, the State courts have no direct jurisdiction in patent suits pure and simple, although such courts have jurisdiction in questions of contracts and the like affecting patents, and may inquire into the scope and validity of patents when such questions come in question collaterally to the main issue in a case.

While the United States have the dominant power as to patents when exercised within that clause of the Consti-

¹ *Nichols v. Newell*, 1 Fisher's Pat. Cases, 647.

² *Stimpson v. Pond*, Curtis, 502.

tution which gives Congress power "to promote the progress of science and the useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries," the States have important powers relating to patents outside of this grant for this clause does not take away from the States the right to grant patents—of course effectual only within the State making the grant—so long as the grant does not come in conflict with a grant made by the United States or with any of the patent laws of the United States warranted by the clause quoted from the constitution. Within such limitations the States may grant patents, or may enlarge the terms of those granted by the United States. In one respect the States have a larger power than the federal government, for while the latter can grant patents only to inventors, the States may, if they please, grant patents to introducers of inventions.¹

While the States may not, as we shall shortly see more at length, make laws intended to have special restrictive application upon patents granted by the United States, yet articles made under such patents come within the operation of State laws which are of general application; and it does not follow that because a person has a patent for a thing, he may use that thing without regard to State laws; for instance, if a man patent a machine for use in drawing lotteries, he cannot use that machine in a State which forbids lotteries; or if a person has a patent for a particular medicine that patent does not give him the right to practice as a physician in contravention of the

¹ *Gibbins v. Ogden*, 9 Wheaton, 186; *Livingston v. Van Ingen*, 9 Johnston, 560.

State law.¹ And property in patents is doubtless subject to State taxation provided the tax law does not discriminate against patents.

State Restrictive Laws. It is not uncommon for States to attempt to pass laws which have special restrictive application as regards patents granted by the United States. All such State laws are null and void. The form which these State restrictive laws generally take is to provide that certain formalities shall be observed before a man may sell a patent-right within the State, or that a promisory note given for a patent shall express upon its face such fact or be invalid. A single case will answer upon this point. The legislature of Indiana provided by statute as follows: "That it shall be unlawful for any person or persons to sell or barter or offer to sell or barter any patent right, or any right which such person shall allege to be a patent right, in any county within this State, without filing with the clerk of the court of such county, copies of the letters-patent duly authenticated, and at the same time swearing or affirming to an affidavit before such clerk that such letters-patent are genuine, and have not been revoked or annulled, and that he has full authority to sell or barter the rights so patented; which affidavit shall also set forth his name, age, occupation, and residence, and if an agent, the name, occupation, and residence of his principal. A copy of this affidavit shall be filed in the office of said clerk, and said

¹*Gibbins v. Ogden*, 9 Wheaton, 186; *Jordon v. Overseer of the Poor*, 4 Ohio 310; *Thompson v. Staats*, 15 Wend. 395; *Van Natick v. Paine*, 1 Harrington, 68.

clerk shall give a copy of said affidavit to the applicant, who shall exhibit the same to any person on demand.

Sec. 2. Any person who may take any obligation in writing, for which any patent right, or right claimed by him or her to be a patent right, shall form the whole or any part of the consideration, shall, before it is signed by the maker or makers, insert in the body of said written obligation above the signature of said maker or makers, in legible writing or print, the words 'given for a patent right.'

Sec. 3. Any person who shall sell or barter or offer to sell or barter within this State, or shall take any obligation or promise in writing, for a patent right, or for what he may call a patent right, without complying with the requirements of this act, or shall refuse to exhibit the certificate when demanded, shall be deemed guilty of a misdemeanor, and on conviction thereof before any court of competent jurisdiction, shall be fined in any sum not exceeding one thousand dollars, or be imprisoned in the jail of the proper county not more than six months, at the discretion of the court or jury trying the same; and shall be liable to the party injured, in a civil action, for any damages sustained."

The federal court said of this Act: "This is an attempt on the part of the legislature to direct the manner in which patent rights shall be sold in the State; to prohibit their sale altogether if these directions are not complied with, and to throw burdens on the owners of this species of property which Congress has not seen fit to impose upon them. I have not time to elaborate the subject, nor even to cite the authorities bearing on the question, and shall, therefore, content myself with stating the conclusion which I have reached.

It is clear that this kind of legislation is unauthorized. The Congress is given, by the constitution, the power 'to promote the progress of science and the useful arts by securing, for limited times, to authors and inventors, the exclusive rights to their respective writings and discoveries.' This power has been exercised by Congress, who have directed the manner in which patents shall be obtained, and when obtained how they shall be assigned and sold.

The property in inventions exists by virtue of the laws of Congress, and no State has a right to interfere with its enjoyment, or to annex conditions to the grant. If the patentee complies with the law of Congress on the subject, he has a right to go into the open market anywhere within the United States and sell his property. If this were not so, it is easy to see that a State could impose terms which would result in a prohibition of the sale of this species of property within its borders, and in this way nullify the laws of Congress, which regulate its transfer, and destroy the power conferred upon Congress by the constitution. The law in question attempts to punish, by fine and imprisonment, a patentee for doing, with his property, what the national legislature has authorized him to do, and is therefore void."¹

¹ *Robinson ex parte*, 4 Fisher's Pat. Cases, 186.

FORMS.

FORMS.

Assignment of Entire Interest Before Issue of Patent.

KNOW ALL MEN that I, John Doe, of Hartford, in the County of Hartford and State of Connecticut, for the consideration of one dollar, the receipt whereof is hereby acknowledged, do hereby sell, and assign to Richard Roe, of New Haven, in the County of New Haven and State of Connecticut, the whole right and title in and to an invention of an improvement in plows described in my application for letters-patent of these United States therefor, executed by me January 1, 1883 (if application has been filed add, "and filed in the Patent Office on or about January 2, 1883,") together with all the rights and privileges granted by said letters-patent to be issued.

I authorize and request the Commissioner of Patents to issue said letters-patent to said assignee for the sole use and behoof of said assignee, his heirs and assigns.

I promise to and covenant with said assignee, his heirs and assigns, that I will, whenever the legal counsel of said assignee, his heirs or assigns, advises me, that a re-issue of said letters-patent is lawful and desirable, sign

all papers, take all rightful oaths, and do all acts necessary or convenient to the procurement of such reissues without charge to said assignee but at his expense.

I, for myself, my heirs and assigns, covenant with said assignee, his heirs and assigns, that I have the lawful right to assign said invention and letters-patent in manner and form as herein expressed and that the interest herein conveyed is free from all prior assignment, grant, mortgage, license, or other incumbrance whatever.

In witness whereof I hereto set my hand as of and for the third day of January, A. D. 1883.

JOHN DOE.

Witnesses :

JOHN SMITH,
CHARLES BROWN.

(If it is not desired that the patent shall issue to the assignee the request to that effect can be omitted. Likewise the warranty of title can be omitted.)

Assignment of Undivided Interest Before Issue of Patent.

KNOW ALL MEN that I, John Doe, of Hartford, in the County of Hartford and State of Connecticut, for the consideration of one dollar, receipt whereof in full is hereby acknowledged, do hereby sell and assign to Richard Roe, of New Haven, in the County of New Haven, and State of Connecticut, one undivided half of the whole right and title in and to an invention of an im-

provement in plows described in my application for letters-patent of these United States therefor, executed by me January 1, 1883, (if application has been filed, add, "and filed in the Patent Office on or about January 2, 1883,") together with one undivided half of the whole right and title in and to said letters-patent to be issued.

I authorize and request the Commissioner of Patents to issue said letters-patent to said assignee and myself jointly for the sole use and behoof of said assignee and myself and our heirs and assigns.

I, for myself, my heirs, and assigns, covenant to and with said assignee, his heirs and assigns, that I have full right to sell and assign said invention and letters-patent in manner and form as herein written and that the interest herein conveyed is free from all prior assignment, grant, mortgage, license or other incumbrance whatever.

This assignment is made upon the following express condition forming an integral part of this assignment, to which condition I, for myself, my heirs and assigns, assent, and to which said condition said assignee for himself his heirs and assigns, assents by his acceptance of this assignment, said condition being as follows, to wit. :

Neither he nor I have or shall have any right or power to grant any license under or relating to said patent unless both and all the owners of said patent join in the same in writing and neither he nor I have or shall have separately the right to make, or sell, or use any part of the invention claimed in said letters-patent without that the party thus making, or selling, or using, shall secure and pay to the other party or parties part owners of said patent, such part of the net profits arising from such manufacture, sale, or use as the part of the said patent

owned by such other party or parties last mentioned bears ratio to the whole patent.

In witness whereof I hereto set my hand as of and for the third day of January, 1883.

JOHN DOE.

Witnesses :

JOHN SMITH,
CHARLES BROWN.

(Of course, the last provision can be omitted if desired.)

Assignment of Entire Interest After Issue of Patent. By the Inventor.

KNOW ALL MEN that I, John Doe, of Hartford, in the County of Hartford and State of Connecticut, for the consideration of one dollar, the receipt whereof is hereby acknowledged, do hereby sell and assign to Richard Roe, of New Haven, in the County of New Haven and State of Connecticut, the whole right and title in and to an invention of an improvement in plows, described in letters-patent of these United States, No. 100,000, issued to me and dated January 4, 1883, and in and to all the rights and privileges granted and secured by said letters-patent, the same to be held and enjoyed by said assignee, his heirs and assigns, for his and their sole use and behoof.

I promise to and covenant with said assignee, his heirs and assigns, that I will, whenever the legal counsel of said assignee, his heirs and assigns, advises me that a re-issue of said letters-patent is lawful and desirable, sign

all papers, take all rightful oaths, and do all acts necessary or convenient to the procurement of such reissues, without charge to said assignee his heirs or assigns but at his or their expense.

I, for myself, my heirs and assigns, covenant with said assignee, his heirs and assigns, that I have the lawful right to assign said invention and letters-patent in manner and form as herein expressed, and that the interest herein conveyed is free from all prior assignment, grant, mortgage, license, or other incumbrance whatever.

In witness whereof I hereto set my hand as of and for the fifth day of January, A. D. 1883.

JOHN DOE.

Witnesses :

JOHN SMITH,

CHARLES BROWN.

Assignment of Undivided Interest After Issue. By the Inventor.

KNOW ALL MEN that I, John Doe, of Hartford, in the County of Hartford and State of Connecticut, for the consideration of one dollar, receipt whereof in full is hereby acknowledged, do hereby sell and assign to Richard Roe, of New Haven, in the County of New Haven and State of Connecticut, one undivided half of the whole right and title in and to an invention of an improvement in plows, described in letters-patent of the United States No. 200,000, issued to me and dated January 4, 1883, and together with an undivided half of all the rights and privileges granted by said letters-patent.

I, for myself, my heirs and assigns, covenant to and

with said assignee, his heirs and assigns, that I have full right to sell and assign an interest in said invention and letters-patent in manner and form as herein expressed, and that the interest herein conveyed is free from all prior assignment, grant, mortgage, license or other incumbrance whatever.

This assignment is made upon the following express condition forming an integral part of this assignment, to which condition I, for myself, my heirs and assigns, assent, and to which said condition said assignee, for himself his heirs and assigns, assents by his acceptance of this assignment, said condition being as follows, to wit : neither he nor I have or shall have any right or power to grant any license under or relating to said patent unless both and all the owners of said patent join in the same in writing, and neither he nor I have or shall have separately the right to make or sell, or use, any part of the invention claimed in said letters-patent without that the party thus making or selling, or using, shall secure and pay to the other party or parties, part owners of said patent, such part of the net profits arising from such manufacture, sale or use as the part of the said patent owned by such other party or parties last mentioned, bears ratio to the whole patent.

In witness whereof I hereto set my name as of and for the fifth day of January, 1883.

JOHN DOE.

Witnesses :

JOHN SMITH,

CHARLES BROWN.

Assignment Without Warranty or Protective Provision.

KNOW ALL MEN that I, John Doe, of Hartford, in the County of Hartford and State of Connecticut, for the consideration of one dollar, the receipt whereof is hereby acknowledged, do hereby sell and assign to Richard Roe, of New Haven, in the County of New Haven and State of Connecticut, one undivided half of the whole right and title in and to an invention in plows, described in letters-patent of these United States, No. 300,000, dated February 1, 1883, issued to William Williams and subsequently assigned to me, together with one undivided half of all the rights and privileges granted and secured by said letters-patent. The same to be held and enjoyed by said assignee for the sole use and behoof of said assignee, his heirs and assigns.

In witness whereof I hereto set my hand as of and for the first day of March, 1883.

JOHN DOE.

Witnesses:

JOHN SMITH,

CHARLES BROWN.

Grant of a Territorial Right.

KNOW ALL MEN that we, John Doe and Richard Roe, of Hartford, in the County of Hartford and the State of Connecticut, for the consideration of one dollar, receipt whereof in full is hereby acknowledged, do hereby sell and grant—upon the condition hereinafter expressed—to William Williams, of New Haven, in the County of

New Haven and State of Connecticut, the whole right, title and interest in and to all the rights and privileges granted and secured to us by letters-patent of these United States, for an improvement in plows, No. 200,000, issued to us and dated January 1, 1883, within and for the State of Connecticut, and in no other place or places, the same to be held and enjoyed by said assignee, for the sole use and behoof of himself, his heirs and assigns.

We, for ourselves, our heirs and assigns, covenant to and with said grantee, his heirs and assigns, that we have the lawful right to make a grant under said letters-patent in manner and form as herein expressed, and that the interest herein conveyed is free from all prior assignment, grant, mortgage, license or other incumbrance whatever.

This grant is made upon the following express condition, a willful infraction of which by said grantee, his heirs, assigns, grantees, or licensees, shall work a forfeiture to the present grantors, their heirs and assigns, of all rights and privileges under or relating to said letters-patent possessed by the person or party guilty of such infraction; to wit.: Said grantee, his heirs, assigns, grantees, and licensees, shall not knowingly sell or part with any article, bearing or embodying any material part of the invention forming the subject-matter of said patent, which is to be carried, sold, or used without the territory covered by this grant, and said grantee, his heirs, assigns, grantees, and licensees, shall use their utmost endeavor to comply with the spirit of this condition, and to prevent any infraction thereof; and a gift, lease, loan, or sale of any such patented article, to a person or party whom said grantee, his heirs, assigns, grantees, or licensees, being such seller or giver, knows to have once car-

ried, or used, or sold such patented article without the territory covered by this grant, in violation of the spirit of this condition, shall be conclusive evidence of a willful violation of this condition on the part of such seller or giver

In witness whereof we hereto set our hands as of and for the first day of March, 1883.

JOHN DOE.

RICHARD ROE.

Witnesses :

JOHN SMITH,

CHARLES BROWN.

Mortgage of Patent.

KNOW ALL MEN that I, John Doe, of Hartford, in the County of Hartford and State of Connecticut, for the consideration of one dollar, receipt whereof is hereby acknowledged, do hereby sell and assign to Richard Roe, of New Haven, in the County of New Haven, and State of Connecticut, the whole right and title in and to all the rights and privileges granted and secured by letters-patent of these United States, No. 200,000, issued to me and dated January 1, 1883, for improvement in plows.

I promise to and covenant with said assignee, his heirs and assigns, that I will, whenever the legal counsel of said assignee, his heirs or assigns, advises me that a re-issue of said letters-patent is lawful and desirable, sign all papers, take all rightful oaths, and do all acts necessary or convenient to the procurement of such reissues, without charge to said assignee, but at his expense.

I, for myself, my heirs and assigns, covenant with said assignee, his heirs and assigns, that I have the lawful right to assign said invention and letters-patent, in manner and form as herein expressed, and that the interest herein conveyed is free from all prior assignment, grant, mortgage, license or other incumbrance whatever.

The condition of this assignment and mortgage is such that whereas I am justly indebted to said Richard Roe in the sum of \$1,000, as evidenced by my promisory note of even date herewith, payable to said mortgagee or order, one year from date, without interest; now if said note shall be well and truly paid according to its tenor, this assignment shall be null and void, but otherwise to be of full force and effect.

In witness whereof I hereto set my hand as of and for the second day of April, A. D. 1883.

JOHN DOE.

Witnesses :

JOHN SMITH,
CHARLES BROWN.

(If the laws of the State wherein such a mortgage is executed require an acknowledgement of a mortgage of personal estate it is advisable to append such acknowledgement.)

License—Shop-Right.

KNOW ALL MEN that I, John Doe, of Hartford, in the County of Hartford and State of Connecticut, in consideration of five hundred dollars, the receipt whereof in full is hereby acknowledged, do hereby sell to the Hartford

Manufacturing Company, a joint stock corporation organized under the laws of the State of Connecticut, and located at New Britain, in the County and State aforesaid, the right and license to make, at a single foundry and machine shop in said New Britain, and in no other place or places, the improvement in harrows, for which letters-patent of the United States, No. 200,003, dated January 1, 1883, were granted to me, with the right and license to sell the same throughout these United States to the full end of the term of said patent.

And I, for myself, my heirs and assigns, covenant to and with said corporation, that I have full right and title to make this license in manner and form as herein expressed, and that there is no prior assignment, grant, mortgage, license or other conveyance incumbrance under or relating to said patent, that can prevent said licensee from enjoying the privileges conveyed by this license to the full extent herein stated.

In witness whereof I hereto set my hand as of and for the second day of April, 1883.

JOHN DOE.

Witnesses :

JOHN SMITH,
CHARLES BROWN.

License—(Shop-Right)—Assignable and Limited.

KNOW ALL MEN that I John Doe, of Hartford, in the County of Hartford, and State of Connecticut, for the consideration of one dollar, the receipt whereof is hereby acknowledged, do hereby license and empower Rich-

ard Roe, of New Haven, in the County of New Haven, and State of Connecticut, and his heirs and assigns, to manufacture at a single foundry and machine shop, the improved seed-sower, for which letters patent of these United States, No. 75,603, dated December 26, 1870, were granted to me, to the number of 500 of said patented seed-sowers in each year, to the full end of the term for which said letters-patent were granted, and to sell such seed-sowers throughout the States of Maine, New Hampshire, Vermont, Massachusetts, Rhode Island and Connecticut, and in no other place or places.

And, I for myself, my heirs and assigns, do covenant to and with said assignee, his heirs and assigns, that I have full right and title to make this license in manner and form as herein expressed and that there is no prior assignment, grant, mortgage, license or other conveyance under or relating to said patent that can prevent said licensee from enjoying the privileges conveyed by this license to the full extent herein given and stated.

In witness whereof I hereto set my hand as of and for the second day of April, 1877.

JOHN DOE.

Witnesses :

JOHN SMITH,
CHARLES BROWN.

Exclusive Territorial License.

KNOW ALL MEN that I, John Doe, of Hartford, in the County of Hartford, and State of Connecticut, for the consideration of one dollar, receipt whereof in full is

hereby acknowledged, do hereby sell and grant to Richard Roe, of New Haven, in the County of New Haven, and State of Connecticut, the exclusive license to make and use and vend to others to use, within and throughout the States of Maine, New Hampshire, Vermont, Massachusetts, Rhode Island, and Connecticut, and in no other place or places, the improved seed-sower, for which letters-patent of these United States, No. 75,603, dated December 26, 1870, were granted to me; this license to extend to the full end of the term for which said letters-patent were granted.

I, for myself, my heirs and assigns, covenant to and with said licensee, his heirs and assigns, that I have full right and title to make this license in manner and form as herein expressed, and that there is no prior assignment, grant, mortgage, license or other conveyance under or relating to said patent that can prevent said licensee from enjoying the privileges conveyed by this license to the full extent herein given and stated.

This license is given to said licensee upon the express condition that neither he nor his heirs or assigns, shall sell any of said patented seed-sowers, to be used outside the six New England States hereinbefore mentioned; that said licensee, his heirs and assigns, shall use their utmost endeavors to prevent any infraction of this provision; and that a gift, lease, loan, or sale of any such to patented article by said licensee, his heirs or assigns, to a person or party whom said licensee, his heirs or assigns, knows to have once carried, or used, or sold, any such patented seed-sower without the territory covered by this license, in violation of the spirit of this condition, shall be conclusive evidence of a willful violation of this con-

dition on the part of such licensee, his heirs and assigns ; and an infraction of this condition by said licensee, his heirs or assigns, shall, of itself and without the adjudication of a court, work a revocation of this license to said licensor his heirs and assigns.

In witness whereof I hereto set my hand as of and for the second day of April, 1874.

JOHN DOE.

Witnesses :

JOHN SMITH,
CHARLES BROWN.

License (Not Exclusive) with Royalty.

This agreement, made this twelfth day of September, 1868, between A. B., party of the first part, and C. D., party of the second part, witnesseth : that whereas, letters-patent of the United States for an improvement in *horse-rakes* were granted to the party of the first part, dated October 3, 1865 ; and whereas the party of the second part, is desirous of manufacturing horse-rakes containing said patented improvement,—now, therefore, the parties have agreed as follows :

I. The party of the first part hereby licenses and empowers the party of the second part to manufacture, subject to the conditions hereinafter named, at their factory in (———), and in no other place or places, to the end of the term for which said letters-patent were granted, *horse-rakes* containing the patented improvements, and to sell the same within the United States.

II. The party of the second part agrees to make full and true returns to the party of the first part, under oath, upon the *first* days of *July* and *January* in each year, of all *horse-rakes* containing the patented improvements manufactured by them within the half year last past.

III. The party of the second part agrees to pay to the party of the first part, one dollar as a license fee upon every *horse-rake* manufactured by said party of the second part, containing the patented improvements; provided that, if the said fee be paid upon the days provided herein for semi-annual returns, or within ten days thereafter, a discount of *fifty* per cent. shall be made from said fee for prompt payment.

IV. Upon a failure of the party of the second part to make returns, or to make payment of license fees as herein provided, for thirty days after the days herein named, the party of the first part may terminate this license, by serving a written notice upon the party of the second part; but the party of the second part shall not thereby be discharged from any liability to the party of the first part for any license fees due at the time of the service of said notice.

In witness whereof the parties above named have hereunto set their hands the day and year first above written.

A. B.

C. D.

Exclusive License with Contract for Royalty.

This agreement, made this tenth day of June, 1871, between George B. Matthewson, of Hartford, Connecticut, party of the first part, and The Excelsior Iron Works, a corporate body under the laws of said State, located and doing business at New Britain, in said State, party of the second part, witnesseth :

That whereas letters-patent of the United States, were, on the twenty-ninth day of January, 1871, granted to said party of the first part, for an improvement in stove-hooks which said patented article said party of the second part is desirous to make and sell ; now, therefore, the parties have agreed as follows :

I. The party of the first part hereby gives to the party of the second, the exclusive right to manufacture and sell said patented improvements, to the end of the term of said patent, subject to the conditions hereinafter named.

II. The party of the second agrees to make full and true returns, on the first days of January, April, July, and October in each year, of all of said patented stove-hooks, made by them in the three calendar months then last past ; and, if said party of the first part shall not be satisfied, in any respect, with any such return, then he shall have the right, either by himself or his attorney, to examine any and all of the books of account of said party of the second part, containing any items, charges, memoranda, or information relating to the manufacture or sale of said patented stove-hooks, and, upon request made, said party of the second part shall produce all such books for said examination.

III. The party of the second part agrees to pay the party of the first part, two cents as a license fee upon

every one of said patented stove-hooks made by them ; the whole of said license fee for each quarterly term of three months, as hereinbefore specified, to be due and payable within fifteen days after the regular return day for that quarter. And said party of the second part agrees to pay to the party of first part at least fifty dollars, as said license fee, upon each of said quarterly terms, even though they should not make enough of said patented stove-hooks to amount to that sum at the regular royalty of two cents apiece.

IV. Said licensee shall cast or otherwise permanently place upon every such stove-hook, made under this license, the word "Matthewson," and in close relation thereto the word "Patented" and the date of said patent.

V. Said licensee shall not, during the life of his license, make or sell any article which can compete in the market with said patented stove-hook ; and said licensee shall, through its officers and agents, use its utmost reasonable endeavors to create and maintain as large a trade as is possible in said patented stove-hooks.

VI. Upon the failure of said licensee to keep each and all of the conditions of this license, said licensor may, at its option, terminate this license, and such termination shall not release said licensee from any liability due at such time to said licensor.

VII. I, said to be of the first part, do covenant to and with said party of the second part, its successors and assigns, that I have full right and title to make this license in manner and form as above written and that there is no prior assignment grant, mortgage, license, or other conveyance, under or relating to said patent, that can pre-

vent said licensee from enjoying the privileges conveyed in this license to the full extent herein given and stated.

In witness whereof, the above named parties (the said Excelsior Iron Works, by its president) have hereunto set their hands the day and year first above written.

GEORGE B. MATTHEWSON,

Excelsior Iron Works:

BY JOHN HARTSHORN, PRESIDENT.

Power of Attorney to Sell Rights. By the Patentee.

I, John Haight, of Hartford, Connecticut, patentee and owner of letters-patent of the United States, No. 100,001, for an improvement in mouse-traps, dated May 25, 1870, do hereby appoint Hiram Handsome, of said Hartford, my attorney, with full power to make assignments, grants, or licenses, of any kind, under said patent, with full power to sign my name to all such instruments, and to receive and receipt for all considerations received in exchange for any of said rights, but with no power to bind me in any manner further than to make binding and legal all such assignments, grants, and licenses.

This power to remain in force till a revocation in writing shall be duly recorded upon the records of the United States Patent Office, where this power of attorney will be found duly recorded.

Witness my hand this fourteenth day of June, A. D.
1871.

JOHN HAIGHT.

Witnesses :

CHARLES HAWSER,
HENRY CABLE.

Power of Attorney with Restrictions. By the Assignees of Entire Right.

We, William Noble and Hugh Ransom, of Hartford, Connecticut, assignees and owners of the entire right in and to letters-patent of the United States, No. 100,666, for an improvement in garden hoes, dated May 24, 1873, do hereby appoint Robert Roberts, of said Hartford, our attorney, with full power to make assignments, grants, or licenses of any kind, under said patent, with full power to sign our names to all such instruments, and to receive and receipt for, in our name, all considerations received in exchange for any of said rights, but with no power to bind us, or either of us, further than to make binding all such assignments, grants, and licenses; he to exercise all power herein conferred, under the following conditions, without which no act of his under this authority shall be valid:

I. He shall sell at no less than the following prices:

For the whole patent, twenty thousand dollars;

For any State, such part of twenty thousand dollars as the population of the State in question bears ratio to the whole population of the United States,—this result to be doubled to find the price for said State;

For any county, such part of the price for the State, as determined by the foregoing directions, as the population of the said county bears ratio to the population of the State,—this result to be doubled to find the value of said county ;

For any town, such part of the price of the county in which it is situated, determined as hereinbefore directed, as the population of the town bears ratio to the population of the county,—this result to be doubled to find the value of said town.

All sales of licenses, and all territorial sales at less than the prices given above, to be subject to our approval by letter or telegram.

II. All payments for rights thus sold shall be made either in cash wholly, or in not less than one-half cash and one-half in good promisory notes, to mature within six months from day of sale, and either signed or endorsed by a person or persons of ample pecuniary responsibility. All such cash shall be deposited by the payer thereof with the nearest bank or responsible private banker, payable to the joint order of our said attorney and ourselves, and all such promisory notes shall be made in three notes of equal amount, payable to the joint order of ourselves and our said attorney, and delivered to him. Any payment aforesaid in anywise deviating from these provisions, to be subject to our approval by letter or telegram.

This power shall remain in force till a written revocation thereof shall be recorded on the records of the Patent Office of the United States, where this power will be found recorded.

Witness our hands, this tenth day of June, A. D.,
1871.

WILLIAM NOBLE,
HUGH RANSOM.

Witnesses :

SAMUEL SIMMONS,
THOMAS TOMPKINS.

Private Agreement to Accompany Power of Attorney.

This agreement made this tenth day of June, 1874, between William Noble and Hugh Ransom, party of the first part, and Robert Roberts, party of the second part, all of Hartford, Connecticut, witnesseth :

I. That the party of the second part agrees to use his best endeavors to sell rights under letters-patent No. 100,666, dated May 24, 1871, for the party of the first part, under the terms and conditions of a power of attorney of even date herewith, from the party of the first part to the party of the second part ; such endeavors to continue until said power of attorney is revoked, or until the party of the second part notifies the party of the first part, in writing, that he no longer wishes to be bound by this agreement.

II. The party of the first part agrees to pay to the party of the second part, one-third part of all the proceeds from said sales, as remuneration for his services in this behalf, and this remuneration shall be due and payable from cash received, as soon as deposited as provided

in said power of attorney, and from promissory notes received, as soon as they are delivered to the party of the second part, the party of the second part to retain as his property one of the three said equal promissory notes, and to immediately forward the other two to the party of the first part. This allowance to be in full of all charges whatsoever in this behalf against the party of the first part; and the said party of the second part is to bear his own expenses, of whatever nature.

In witness whereof, the said parties have hereto set their hands this tenth day of June, A. D. 1871.

WILLIAM NOBLE.

HUGH RANSOM.

ROBERT ROBERTS.

Witnesses :

SAMUEL SIMMONS,

THOMAS TOMPKINS.

Revocation of Power of Attorney.

Having, on the tenth day of June, 1871, appointed Robert Roberts, of Hartford, Connecticut, our attorney to sell rights, under letters-patent No. 100,666, dated May 24, 1871, for us, we do hereby revoke said power of attorney to him, and declare his authority to act for us in any manner to be at an end.

Witness our hands, this fourth day of July, A. D. 1871,
at Hartford, Connecticut.

Witnesses :

SAMUEL SIMMONS,
THOMAS TOMPKINS.

WILLIAM NOBLE.
HUGH RANSOM.

Power of Attorney to Sell Rights—C. O. D.

I, William M. Bjoerkman, of Bridgeport, Connecticut, owner of letters-patent of the United States, No. 135,543, dated February 30, 1873, hereby authorize William H. Marsh, of Bridgeport, to sell assignments, grants and licenses under said patent, such sales to be approved by me before becoming valid, upon which approval, in each case, I will send the necessary assignment, grant, or license, duly executed by me, by express to said Marsh, accompanied with instructions to the carrier to allow said Marsh, and the buyer or buyers of any such right, to examine such conveyance, and upon delivery of the same, to collect for return to me such money, notes, or articles as I am to receive in consideration of such sale.

Signed and sealed by me, this thirty-first day of June,
A. D. 1873.

WILLIAM M. BJOERKMAN.

Contract for Future Grant.

Whereas letters-patent of the United States, for improvements in ox-yokes, No. 49,695, dated May 6, 1869, were issued and granted to Isaac Johnson; and whereas Henry Henderson, of Chicago, Illinois, desires to acquire all the rights granted by said letters-patent within the State of Illinois: now in consideration of the present payment to me of five hundred dollars in current funds, and in further consideration of the delivery to me of three promissory notes of even date herewith for five hundred dollars each, made and signed by the said Henderson, payable to my order, one due three months from date, one due six months from date, and one due nine months from date,—all with interest:

I, the said Isaac Johnson, do hereby grant to the said Henderson, but not to his assigns, for the term of nine months, from the date hereof, the exclusive license to make, to use, and to vend to others to use, within said State of Illinois, the articles forming the subject-matter of said letters-patent; provided, that if either of the two notes, coming due at three and six months respectively, shall not be paid at maturity, then, when said default of payment is made, this license shall immediately determine, without notice or action on my part;

But, if payment of each and all of the said three notes shall be made at the time of their maturity, then, by such payment, the said Henderson shall become the sole owner of each and all of the privileges and rights granted and secured by said patent, within and for the whole of the State of Illinois, without further action on my part.

And I covenant and agree, that, when all three of said notes are fully paid at maturity, I will execute and de-

liver to said Henderson a full and complete grant and transfer of the whole interest in said patent, within and for the State of Illinois ; and I hereby make this agreement a lien and mortgage upon said interest in said patent for the faithful performance of my contract herein contained.

(Insert here covenant of title from previous form.)

In witness whereof, I hereto set my hand, this eighth day of June, A. D. 1874.

ISAAC JOHNSON.
By AMOS AMES, Agent.

 BILL OF COMPLAINT—IN EQUITY.

United States Circuit Court.

 DISTRICT OF CONNECTICUT.

JOHN DOE AND RICHARD ROE, <i>vs.</i> CHARLES BROWN AND JOHN SMITH.	}	<i>In Equity.</i>
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To the Honorable the Judges of the United States Circuit Court, within and for the Second Circuit and the District of Connecticut :

John Doe and Richard Roe, citizens of the State of Connecticut, and residents of the city of Middletown, in the County of Middlesex, in said State, partners in business at said Middletown under the style of John Doe & Company, bring this their bill of complaint against Charles Brown and John Smith, citizens of the State of Connecticut, and residents of the city of New Britain, in the County of Hartford, in said State, partners in business in said New Britain, under the style of Brown & Smith, and thereupon your orators complain and say :

That prior to the 29th day of September, A. D. 1868, said John Doe, a citizen of these United States was the original and first inventor of a certain new and useful improvement in a Window Spring Catch, not known or used by others before his invention thereof, and not in public use or on sale with his knowledge or allowance for more than two years prior to his hereinafter mentioned application for letters-patent therefor; and thereupon said John Doe made proper and lawful application for letters-patent of these United States for said invention, whereupon such due and legal proceedings were had that letters-patent of these United States, signed, countersigned, and sealed, dated September 29, A. D. 1868, and numbered 82,580, were granted and delivered to said John Doe for said invention, whereby there was granted and secured to said John Doe, and his heirs or assigns, for the term of seventeen years from and after the 29th day of September, A. D. 1868, the exclusive right to make, use, and vend the said invention throughout these United States and the territories thereof. And said John Doe, by written assignment, dated September 29, A. D. 1868, and duly recorded in the Patent Office, assigned and conveyed to said Richard Roe, an undivided half part interest and ownership in and to said invention and letters-patent, and the rights and privileges granted and secured by said letters-patent; and your orators have ever since remained the sole and exclusive owners of said letters-patent and of all the rights and privileges granted and secured thereby.

Your orators further show that, they, for good and lawful cause, surrendered said letters-patent to the Commissioner of Patents, and made due application for reissued

letters-patent in lieu thereof, and having in all things complied with the requirements of the Acts of Congress in such case made and provided, they did obtain new and reissued letters-patent, in lieu of said surrendered letters-patent, for the same invention, but upon an amended description, which said reissued letters-patent were granted and dated and delivered to your orators July 20, A. D. 1880, and are numbered 9,301, duly signed, countersigned and sealed, for the residue of said term of seventeen years, as by said reissued letters-patent, or a duly authenticated copy thereof, ready in court to be produced, will fully appear.

Your orators further complain and say that said invention is of great value and utility and that they have made it profitable to themselves and to the public by making and selling large numbers of window spring catches embodying said invention.

Your orators further complain and say that said defendants have, since the grant of said reissued letters-patent, at said New Britain, within said district and at other places within these United States, unlawfully infringed upon said letters-patent and your orators' exclusive rights thereunder by making, using, and vending without your orators' leave or license, large numbers of window spring catches embodying the construction and improvement described and claimed in said reissued letters-patent; whereby said defendants have unlawfully realized large profits, and your orators have unlawfully suffered large damages, all of which said doings of said defendants are contrary to equity.

In consideration whereof, and for as much as your orators can only have adequate relief in this court of

equity ; to the end therefore that said defendants may, if they can, show why your orators should not have the relief herein prayed and, may, upon their corporal oaths, and, to the best and utmost of their knowledge, remembrance, information and belief, full, true, direct and proper answer make to all the matters and things stated and charged :

And that said defendants may answer the premises, and that they may be decreed to account with and pay over to your orators their said unlawfully realized profits and your orators' said unlawfully suffered damages, with the costs of this suit.

May it please your Honors to grant unto your orators the writ of injunction of this court, provisionally enjoining and restraining said defendants and their clerks, attorneys, agents, servants and workmen from making, and using, and vending, any window spring catches embodying said patented improvements, during the pendency of this suit, and also the writ of injunction of this court perpetually enjoining and restraining said defendants and their clerks, attorneys, agents, servants and workmen from making, and using, and vending any window spring catches embodying said patented improvements ; and that your orators may have such other or further relief as the nature of the case may require and to your Honors may seem meet.

May it please your Honors, to grant unto your orators not only the writ of injunction conformable to the prayer of this bill, but also a writ of subpoena directed to said defendants commanding them on a day certain, therein to be named, to be and to appear in this court, then and there to answer the premises and to stand to, perform,

and abide by such further order, direction and decree as may be made against said defendants.

And your orators, as in duty bound, will ever pray, &c.

WM. H. MARSH,
*Complainants' Solicitor
and of Counsel.*

JOHN DOE
RICHARD ROE.

DISTRICT OF CONNECTICUT, }
COUNTY OF HARTFORD. } ss.

At Hartford, in said County of Hartford and State of Connecticut, personally appeared said John Doe and Richard Roe, and severally deposed that they are the said complainants named in the foregoing bill of complaint; that they have read said bill and know the contents thereof, and that the allegations thereof are true of their own knowledge, except as to those matters therein stated on information and belief, and as to such matters they believe it to be true.

Before me this 5th day of July, A. D. 1883.



ALBERT C. TANNER,
Notary Public.

DEFENDANTS' ANSWER—IN EQUITY.

United States Circuit Court.

DISTRICT OF CONNECTICUT.

JOHN DOE & COMPANY,	}	<i>In Equity.</i>
vs.		
BROWN & SMITH.		

The Answer of Charles Brown and John Smith, Defendants, to the Bill of Complaint of John Doe and Richard Roe, Complainants.

These defendants, saving and reserving to themselves all and all manner of benefit of exception which may be had or taken to said Bill of Complaint, on account of its errors and insufficiencies, make answer to said Bill of Complaint, as follows :

These defendants admit that pretended letters-patent of these United States, No. 82,580, and dated September 29, A. D. 1868, for an alleged improvement in Window Spring Catches, were issued to said John Doe, and that said pretended letters-patent were surrendered and re-issued in and by pretended reissued letters-patent No. 9,301, dated July 20, A. D. 1880, but whether an interest in said letters-patent was ever assigned to said Richard Roe, these defendants are not informed save by the allegations of said bill of complaint, and these defendants leave said complainants to make due proof thereof.

These defendants, on information and belief, deny that said John Doe was the first or original inventor of any patentable improvement forming the subject-matter of either said original or said reissued letters-patent, and aver that said original letters-patent and said reissued letters-patent were and are therefore null and void.

These defendants, on information and belief, and in view of the state of the art in question, as that art existed at the time said John Doe made his said alleged improvements, deny that either of the matters or things said to have been originated by said Doe and now claimed in said reissued letters-patent, amounts to a patentable invention, and aver that the said alleged improvements were the product of mere mechanical skill; and that said reissued letters-patent are, therefore, null and void.

These defendants, on information and belief, deny that there is any utility whatever, in any matter or thing, described and claimed as an invention in said reissued letters-patent, and aver that said reissued letters-patent are, therefore, null and void.

These defendants, on information and belief, aver that each of the alleged combinations claimed in said reissued letters-patent is not a legal, actual and patentable combination, but is a mere aggregation of mechanical features; and that each clause of claim of said reissued letters-patent is, therefore, null and void.

These defendants, on information and belief, aver that said original letters-patent were not inoperative or invalid by reason of such a defective or insufficient specification as was or could be lawfully corrected or amended by the surrender and reissue thereof as aforesaid; that said original letters-patent were not surrendered to correct any error which had arisen by inadvertence, accident or mistake; that new matter, not constituting any substantial part of the alleged invention for which said original letters-patent were granted, was introduced and interpolated into the specification and claim of said reissued letters-patent; that said reissued letters-patent are not for the same invention as were said original letters-patent; that said reissued letters-patent contain broader claims of invention than were contained in said original letters-patent; that said reissued letters-patent were not applied for with due diligence after the issue of said original letters-patent; and that therefore said reissued letters-patent are null and void.

These defendants, on information and belief, aver that said reissued letters-patent and said original letters-patent are and were null and void because that the alleged improvement forming the subject-matter thereof was in public use and on sale in this country more than two years prior to said Doe's application for said original letters-patent, by the following mentioned persons and parties, at the following mentioned places, to wit. :

Alfred Harkness, of Bristol, Connecticut, at said Bristol.

Thomas Jones, of Winsted, Connecticut, at said Winsted.

These defendants, on information and belief, aver that said reissued letters-patent are null and void because that said Doe was not the true and first inventor of the alleged improvement therein described and claimed, but that the same and all the material and substantial parts thereof were, long prior to any supposed invention thereof by said Doe, patented and described in and by the following mentioned, printed publications and letters-patent, to wit. :

• United States patent No. 42,411, to James Sheridan, granted and dated April 19, 1864.

Letters-patent of the Kingdom of Great Britain and Ireland, No. 10,000, to Thomas Thomas, granted and dated March 3, 1867.

These defendants further assuming, on information and belief, aver that said reissued letters-patent are null and void because that said Doe was not the original and first inventor of the alleged improvements set forth and claimed therein, but that the same and all the material and substantial parts thereof were, long prior to any supposed invention thereof by said Doe, known to and in public use by the following named persons and parties, at the following mentioned places to wit. :

Henry Adams, of Plainville, Connecticut, at said Plainville.

William Friday, of East Hartford, Connecticut, at said East Hartford.

These defendants, on information and belief, aver that

said original letters-patent, No. 82,580, and said reissued letters-patent, were and are null and void because that the said original letters-patent, No. 82,580, were surreptitiously and unjustly obtained for that which was in fact invented by another and by others who were using, and did use, reasonable diligence to adapt and perfect the same, to wit. :

Charles Clark, of Southington, Connecticut, at said Southington.

Alfred Smith, of Stonington, Connecticut, at said Stonington.

These defendants, on information and belief, aver that said original letters-patent, No. 82,580, and said reissued letters-patent are and were null and void because that the alleged inventions described therein were not originated or discovered by said Doe, but were communicated to him by other persons.

These defendants, on information and belief, further answer and say, that said original letters-patent, No. 82,580, and said reissued letters-patent are and were null and void because that said Doe, prior to his making his said application for his said original letters-patent, abandoned and dedicated to the public his said alleged invention.

These defendants, on information and belief, further answer and say that said complainants have no right to recover any damages from these defendants by reason of any infringement by these defendants of said original letters-patent, No. 82,580, or of said reissued letters-patent because that said complainants have made and sold window spring catches, such as are described in the two patents last mentioned, but have never given sufficient

notice to the public that said window spring catches are patented, by fixing thereon or upon the packages containing the same the word "patented" together with the day and year the patent was granted, and have never notified these defendants that these defendants infringe said original letters-patent No. 82,580, or said reissued letters-patent.

These defendants further answer, on information and belief, and say that the window spring catches made and sold by these defendants are made under the sanction and by the permission of the owners of letters-patent of these United States, as hereinafter mentioned, which describe and claim inventions which are substantially different from the said alleged inventions of said Doe, to wit. : •

Patent to C. C. Elliot, No. 62,535, granted and dated March 5, 1867.

Patent to G. A. Otis, No. 78,537, granted and dated June 2, 1868.

These defendants further answering, on information and belief, deny that they have ever infringed said reissued letters-patent ; deny that they have ever infringed upon any rights whatever of said complainants ; deny said complainants' right to any account of damages, of profits, or costs to be recovered from these defendants ; deny said complainants' right to any injunction, provisional or perpetual, against these defendants ; and deny that said complainants are entitled to any other or further relief whatever against these defendants.

All of which matters and things these defendants are ready to aver, maintain and prove, as this Honorable Court shall direct, and they hereby pray to be hence dis-

missed with their reasonable costs and charges wrongfully sustained in this behalf.

And, as in duty bound, these defendants will ever pray, &c.

CHARLES BROWN,
JOHN SMITH.

THOMAS HASTINGS,
Solicitor and of
Counsel for Defendants.

STATE OF CONNECTICUT, }
COUNTY OF NEW HAVEN. } ss.

Charles Brown and John Smith, being sworn, severally depose and say that they are the defendants named in the foregoing answer ; that they have read the same and know the contents thereof, and that the same is true of their own knowledge, except as to those matters therein stated on information and belief, and as to such matters they believe it to be true.

Before me, at New Haven, in the county of New Haven, and State of Connecticut, this 7th day of July, 1883.

EDWIN F. DIMOCK,
U. S. Commissioner.

 EQUITY REPLICATION.

United States Circuit Court.

 DISTRICT OF CONNECTICUT.

JOHN DOE AND RICHARD ROE, <i>vs.</i> CHARLES BROWN AND JOHN SMITH.	}	<i>In Equity.</i>
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These repliants saving and reserving to themselves, now and at all times hereafter, all and all manner of benefit and advantage of exception which may be had or taken to the manifold errors and insufficiencies of the said answer, for replication thereunto, say that they will aver, maintain, and prove their bill of complaint to be true, certain and sufficient in the law to be answered unto; and that the said answer of the said defendants is uncertain, and untrue, and insufficient to be replied unto by repliants without this; that any other matter or thing whatsoever in the said answer contained, material or effectual in the law to be replied unto and not herein and hereby null and sufficiently replied, confessed, and avoided, traversed, or denied, is true; all which matters and things these repliants are, and will be ready to aver, maintain, and prove as this Honorable Court shall direct, and pray as in and by their said bill they have already prayed.

WILLIAM H. MARSH.

Solicitor for Complainants.

NOTICE FOR TAKING TESTIMONY.

United States Circuit Court.

DISTRICT OF CONNECTICUT.

JOHN DOE AND RICHARD ROE,

vs.

CHARLES BROWN AND JOHN SMITH.

}

ss.

SIR :

You will please take notice that said complainants desire the evidence, which is to be adduced in this cause, to be taken orally under the 67th Rule of the United States Supreme Court, in equity, as amended : and you will further take notice that by an order, made in said cause by Charles Harper, Esq., one of the examiners of said court, the examination of witnesses on the part of said complainants will take place before said examiner, at No. 2 Central Row, (Room No. 22) in the City of Hartford, within the State of Connecticut, on the 16th day of July, A. D. 1883, at ten o'clock in the forenoon and proceed as said examiner may direct.

Dated at Hartford, Connecticut, July 7th, 1883.

WILLIAM H. MARSH,

Solicitor for Complainants.

To THOMAS HASTINGS, Esq.,

Solicitor for Defendants.

ANOTHER FORM OF NOTICE FOR
TAKING TESTIMONY.

United States Circuit Court.

DISTRICT OF CONNECTICUT.

JOHN DOE AND RICHARD ROE, }
 v's. } *In Equity.*
 CHARLES BROWN AND JOHN SMITH }

TO THOMAS HASTINGS, Esq.,
Defendants' Solicitors,
 No. 500 Main St.,
 Hartford, Conn.

SIR :

Take notice that on the 16th day of July, A. D. 1883, beginning at 10 o'clock in the forenoon, at No. 2 Central Row, (Room No. 22) in the city of Hartford and the State of Connecticut, evidence will be taken in behalf of said complainants under the 67th Rule in equity of the United States Supreme Court, as amended.

You have the right to attend and cross-examine.

Dated at Hartford, Connecticut, July 7, 1883.

Respectfully,

WM. H. MARSH,

Solicitor for Complainants.

EXAMINER'S FORM FOR TAKING
TESTIMONY.

United States Circuit Court.

DISTRICT OF CONNECTICUT.

JOHN DOE AND RICHARD ROE,

vs.

CHARLES BROWN AND JOHN SMITH.

In Equity.

Testimony taken on the part of the complainants in the above entitled cause, before Charles Harper, an examiner of said court, at Room No. 22, No. 2 Central Row, Hartford, Connecticut, pursuant to the annexed notice, commencing on the 16th day of July, A. D. 1883, at ten o'clock in the forenoon.

Present—

THOMAS JONES, Esq.,

Counsel for Complainants.

HENRY HARRISON, Esq.,

Counsel for Defendants.

WILLIAM OSGOOD, being called and sworn as a witness in complainants' behalf, deposes as follows in answer to interrogatories proposed to him by complainants' counsel.

* * * * *

(Certificate at end.)

I, Charles Harper, an examiner of said court, do hereby certify that on the several days named in the depositions hereto annexed, I was attended at Room No 22, in the building No. 2, Central Row, at Hartford, in the State of Connecticut, by the counsel and witnesses aforesaid; that the said witnesses were each duly sworn and examined, and the deposition of each witness was reduced to writing and read to him by me and by him subscribed in my presence; and that the following exhibits, to wit. :

Defendants' Exhibit, Hodge's Patent,

Defendants' Exhibit, Smith's Patent

were introduced in evidence and identified by my signature.

Dated at Hartford, Connecticut, this 21st day of August, A. D. 1883.

CHARLES HARPER,

Examiner.

INTERLOCUTORY DECREE—IN EQUITY—
REFERRING CAUSE TO MASTER FOR
AN ACCOUNTING.

At a stated term of the Circuit Court of the United States of America, for the District of Connecticut, held at Hartford on the third Tuesday of September, 1883.

Present—

HON. JARVIS JOHNSON,
District Judge.

JOHN DOE AND RICHARD ROE,	}	<i>In Equity.</i>
<i>vs.</i>		
CHARLES BROWN AND JOHN SMITH.		

This case having been heard on the pleadings and proofs and arguments by counsel for the respective parties, and the court having considered the same, doth hereby order, adjudge, and decree :

First. Complainants' reissued letters-patent, No. 9.301, on which this suit is brought, are good and valid letters-patent, and are owned by the complainants as charged in the bill of complaint

Second. Said defendants have infringed upon said reissued letters-patent by making and selling window spring catches such as are described in said reissued letters-patent and referred to in the first claim thereof.

Third. Complainants are entitled to have the perpetual injunction of this court, restraining said defendants, their agents, servants, clerks, attorneys, and workmen from making, vending, or using window spring catches such as are described in said reissued letters-patent, and referred to in the first claim thereof, and said injunction is hereby ordered to issue.

Fourth. This case is hereby referred to Charles Harper, Esq., a master in chancery of this court, to ascertain and report the use, gains, and profits which said defendants have realized through their unlawful infringement of said reissued letters-patent and the damages which complainants have sustained through defendants' said unlawful infringement of said reissued letters-patent.

JARVIS JOHNSON,
District Judge.

THE MASTER'S REPORT—IN EQUITY.

United States Circuit Court.

DISTRICT OF CONNECTICUT.

JOHN DOE AND RICHARD ROE,

vs.

CHARLES BROWN AND JOHN SMITH.

} *In Equity.*

To the Honorable the Judges of said Court:

The above entitled cause having been referred to me

as master by a decreetal order, made at the stated term of said court, held on the third Tuesday in September, 1883, with instructions to ascertain and report to the court an account of the gains, profits, and advantages which said defendants have realized through their unlawful infringement of complainants' reissued letters-patent No. 9,301, together with the damages which the complainants have sustained thereby, I beg leave to report :

* * * * *

All of which is respectfully submitted.

CHARLES HARPER,

Dated July 17th, 1884.

Master in Chancery.

EXCEPTIONS TO MASTER'S REPORT—IN
EQUITY.

United States Circuit Court.

DISTRICT OF CONNECTICUT.

JOHN DOE AND RICHARD ROE,

vs.

CHARLES BROWN AND JOHN SMITH.

} *In Equity.*

Exceptions taken by defendants to the report made herein, dated July 17, 1884, by Charles Harper, Esq., master in chancery of this court, to whom this cause was referred by an order of this court, made at a stated term

of this court, held the third Tuesday of September, 1883.

First Exception. For that the master in his report *
* * *

THOMAS HASTINGS,
Dated Dec. 25, 1884. *Defendants' Solicitor.*

FINAL DECREE—IN EQUITY.

At a stated term of the Circuit Court of the United States of America for the District of Connecticut, in the Second Circuit, held at New Haven on the fourth Tuesday of April, 1885.

Present— The Hon. JARVIS JOHNSON,
District Judge.

JOHN DOE AND RICHARD ROE,
vs.
CHARLES BROWN AND JOHN SMITH. } *In Equity.*

This cause having been heard upon the report of Charles Harper, Esq., master in chancery of this court, to whom it was referred to ascertain and report to the court an account of the gains, profits, and advantages which said defendants have realized as well as the damages which complainants have suffered through the unlawful infringement by defendants of the complainants' reissued letters-patent, No. 9,301, which report bears date the 25th day of December, 1884, and also upon ex-

ceptions taken to said report by said defendants and the said cause having been argued by counsel, and due deliberations having been had thereon :

It is adjudged and decreed, and this court doth hereby adjudge and decree that said exceptions of the defendants be and the same hereby are overruled, and said report of the said master be and the same is hereby accepted ; and that the complainants recover of the said defendants their damages as stated and assessed in said report of said master, to wit. : "The sum of four thousand two hundred and fifty-nine dollars and seven cents and their costs."

It is further ordered, adjudged, and decreed that said defendants pay to the said complainants the sum of four thousand two hundred and fifty-nine dollars and seven cents and their costs in this suit, to be taxed, and that said complainants have execution therefor, and that the injunction heretofore granted in said cause be continued and made perpetual.

JARVIS JOHNSON,
District Judge.

**EQUITY—APPEAL TO THE U. S. SUPREME
COURT.**

JOHN DOE AND RICHARD ROE,

vs.

CHARLES BROWN AND JOHN SMITH.

In Equity.

To the Honorable, the Supreme Court of the United States :

The Appeal of Charles Brown and John Smith, co-

partners, under the name of Brown & Smith, said defendants and appellants, respectfully showeth :

That on the 7th day of May, 1881, John Doe, and Richard Roe, co-partners, under the name of John Doe & Company, said complainants, filed their bill of complaint in the Supreme Court of the United States for the District of Connecticut, against the above named defendants and appellants therein alleging that on the 29th day of September, 1868, said John Doe obtained letters-patent of these United States, bearing that date, and numbered 82,580, for a new and useful improvement in window spring catches, securing to him and his heirs and assigns the exclusive right to said improvement for the term of seventeen years from and after said date last mentioned ; that a one-half interest and ownership in said letters-patent and all its rights and privileges, were assigned to said Richard Roe September 30, 1868 ; that said original letters-patent, were lawfully surrendered to the Commissioner of Patents and reissued in and by reissued letters-patent of these United States, No. 9,301, dated July 20, 1880, and further alleging that said defendants had unlawfully infringed upon the exclusive rights secured to said complainants by said reissued letters-patent and praying for a decree of injunction and account as by reference to said bill of complaint will more fully appear. And said defendants, on the 7th day of June, 1881, filed their answer to said bill of complaint admitting the issue of said letters-patent to said Doe, as alleged in said bill of complaint, not denying that an interest in the same was assigned to said complainant, Richard Roe, but denying that said reissue was a lawful reissue, and also denying that said Doe was the original and first inventor of the improvement described in said

letters-patent, and denying that the said improvement had patentable novelty, and denying that said defendants had infringed said reissued letters patent, as by reference to said answer will more fully appear. To which answer said complainants filed their replication, and the cause being at issue, the parties proceeded to take testimony in support of their respective allegations, and at the September term of said Circuit Court, A. D. 1883, were fully heard by their counsel, and at the said September term of said court a decretal order for an injunction and account was rendered referring said cause for the taking of the account to a master, and the cause was continued for the master's report and thereafter at the April term of said Circuit Court, A. D. 1885, the master's report came in. To which said report said defendants made exceptions, which exceptions were duly argued before said Circuit Court. That at said stated term of said Circuit Court, held at New Haven on the fourth Tuesday of April, 1885, a final decree was made and pronounced in the case wherein it was ordered, adjudged, and decreed as follows :

“That said exceptions of the defendants be and the same are hereby overruled, and said report of the said master be and the same is hereby accepted, and that the complainants recover of the said defendants their damages as stated and assessed in the report of the said master, to wit. : The sum of four thousand two hundred and fifty-nine dollars and seven cents and their costs. It is further ordered, adjudged, and decreed that the said defendants pay to the said complainants the sum of four thousand two hundred and fifty-nine dollars and seven cents and their costs in this suit, to be taxed, and that said complainants have execution therefor, and that the

injunction heretofore granted in said cause, be continued and made perpetual." Whereupon said appellants appeal from the whole of said final decree of said Circuit Court, and respectfully pray that the decree of said Circuit Court and the bill, answer, pleadings, depositions, evidence, and proceedings in the cause may be sent to the Supreme Court of the United States without delay, and that the said Supreme Court will proceed to hear the said cause anew, and that the said decree of the Circuit Court and every part thereof may be reversed and a decree made reversing said decree with costs, or such other decree as to the said Supreme Court may seem fit.

Dated at Hartford, Conn., this 18th day of May, A. D. 1885.

THOMAS HASTINGS,
*Solicitor, and of Counsel for said
Defendants and Appellants.*

SUPERSEDEAS BOND.

Supreme Court of the United States.

IN EQUITY.

JOHN DOE AND RICHARD ROE,

vs.

CHARLES BROWN AND JOHN SMITH.

Know all men by these presents, That we, Charles

Brown and Pliny Olmstead, of Hartford, in the state and district of Connecticut, are held and firmly bound unto John Roe and Richard Roe, partners, under the name of John Doe & Company, in the sum of nine thousand three hundred and fifteen dollars and twenty-eight cents, to be paid to the said John Doe & Company, their heirs and assigns, to which payment well and truly to be made, we bind ourselves, and each of us, jointly and severally, and our heirs, and each of our heirs, executors, and administrators firmly by these presents.

Sealed with our seals and dated this 18th day of May, 1885.

Whereas, Charles Brown and John Smith, co-partners under the name of Brown & Smith, the said defendants in the above entitled cause, have taken an appeal to the Supreme Court of the United States to reverse the decree rendered in said cause by the Honorable Circuit Court of these United States, for the District of Connecticut, at its April term, 1885 :

Now, therefore, the condition of this obligation is such that if the above named Brown & Smith shall prosecute said appeal to effect and answer all costs and damages, if they shall fail to make good their plea ; and shall pay to said obligees the money decreed to be so paid in the final decree of said Circuit Court in this cause, including just damages for delay and costs and interest on this appeal, then this obligation shall be void ; otherwise it shall remain in full force and virtue.

CHARLES BROWN,

L. S.

PLINY OLMSTEAD.

L. S.

United States of America, District of Connecticut, at Hartford, in said District, on this 18th day of May, 1885, personally appeared the said Charles Brown and Pliny Olmstead and acknowledged the execution of the foregoing bond as their free act and deed.

HENRY HARRINGTON,

Approved :

United States Commissioner.

JARVIS JOHNSON,

District Judge.

INTERFERENCE—BILL OF COMPLAINT— IN EQUITY.

TO THE JUDGES OF THE CIRCUIT COURT OF THE
UNITED STATES FOR THE DISTRICT
OF MASSACHUSETTS.

In Equity.

Horace G. Butler, of the town of West Hartford, in the County of Hartford, and State of Connecticut, a citizen of said State of Connecticut, and the Eureka Farm Machine Company, a joint stock corporation organized under the laws of the State of Vermont, and located at Bellows Falls, in said State of Vermont, bring this their bill against Jane H. Shaw, of Rockland, in the State and district of Massachusetts, a citizen of said State of Massachusetts, and thereupon your orators com-

plain and say : that in the month of November, 1876, your orator, said Horace G. Butler, became and was the first and original inventor of certain new and useful improvements in milk cans, or vessels, and thereafter, to wit, on or about the 20th day of November, 1878, your orator, Horace G. Butler, made application, in due form of law, for letters-patent of these United States, upon and for said improvements in milk cans or vessels, which said invention and all rights of patent for the same were assigned to said Eureka Farm Machine Company by said Butler's written assignment, dated December 16, A. D. 1878, and duly recorded in the Patent Office ; and while said application was pending in the Patent Office, your orator, Horace G. Butler, made certain specific claims of invention therein, to wit. :

“ I claim :

“ 1. A milk vessel having an adjustable faucet that
' can be set to automatically discharge any predeter-
' mined quantity of milk, to leave in the vessel a certain
' quantity of cream, and provided with a glass pane to
' ascertain the degree or place of adjustment of the
' faucet.”

“ 3. A can for milk and cream separation having an
' adjustable automatic discharge faucet, and a transpar-
' ent pane by which the place or degree of faucet
' adjustment may be determined,”—and your orator's
said application for a patent upon said improvements,
containing said claims, was finally refused and rejected
by the Commissioner of Patents, on or about the 28th
day of December, 1881, on the ground that Thomas
Shaw (deceased at the date last mentioned) was the prior
inventor of said improvements in milk cans or vessels de-

scribed in your orators' said application for letters-patent and referred to in said two clauses of claim.

Your orators further show to your Honors that said Thomas Shaw, in his life time, filed with the Commissioner of Patents, on or about the 4th day of February, 1878, an application for letters-patent for improvements in apparatus for separating cream from milk, which eventuated in the issue of letters-patent of these United States, dated September 10, 1878, and numbered 207,822 ; that in response to a notification from the Commissioner of Patents made while your orators' said application was pending in the Patent Office, an application for reissue of said Shaw's original patent was filed in the Patent Office, on or about April 5th, 1880, wherein the said Jane H. Shaw, appeared as the owner by mesne assignment, of all of said Thomas Shaw's rights in the premises ; that an interference was declared and had in the Patent Office, between your orators' said application for letters-patent and said application for said reissued patent upon an issue stated by the Commissioner of Patents, as follows, to wit. :

“A can for milk and cream separation having an adjustable automatic discharge faucet, and a transparent pane by which the place or degree of faucet adjustment may be determined,”—and thereupon priority of invention was awarded to said Thomas Shaw.

Your orators further show unto your Honors that the said refusal of the Commissioner of Patents to allow your orators' said application for patent containing the said two clauses of claim, was based upon said decision, by the Commissioner of Patents, awarding priority of invention as aforesaid, to said Thomas Shaw.

And your orators, on information and belief, aver that said Thomas Shaw was not the original or first inventor of said improvements in milk cans or vessels, described in your orators' said application for letters-patent and referred to in either or both of said two clauses of claim contained therein; but that your orator, Horace G. Butler, was the original and first inventor of the same, that the same are patentable, and that your orators are entitled to letters-patent of these United States therefor.

And your orators, on information and belief, aver that neither said original patent to Thomas Shaw, No. 207,822, dated September 10th, 1880; nor the application therefor; nor any model filed with said application last referred to, describes, shows, or suggests the improvements described in your orators' said application for letters-patent, and referred to in either of said two clauses of claim therein contained.

And your orators, on information and belief, aver that the Commissioner of Patents erred and made a wrongful and unlawful decision in refusing your orators' said application for letters-patent as aforesaid; also that the Commissioner of Patents erred and made a wrongful and unlawful decision in awarding priority of invention to said Thomas H. Shaw, as aforesaid.

Your orators further show unto your Honors that said application for the reissue of said Shaw's said original patent eventuated in the grant and issue to said Jane H. Shaw, of letters-patent, No. 9,899, dated October 18th, 1881; and your orators, on information and belief, aver that said Shaw's original patent, No. 207,822, dated September 10th, 1878, did not contain any claim to the improvements in milk vessels described in your orators'

said application for letters-patent, and referred to in either of said two clauses of claim therein contained ; that said application for said reissued letters-patent was not warranted by law ; that said reissued letters-patent are not warranted by law and are null and void because they describe and claim as the invention of said Thomas Shaw matters and things which were not described or claimed in said Shaw's original patent, and because said reissue was not applied for with due diligence ; and that nothing contained in said Shaw's said original patent lawfully warranted an application for reissue thereon, at the time said reissue was applied for, containing any claim to any invention or improvement which could or might lawfully interfere with your orators' said application for letters-patent, and said interference was therefore unlawful and wrongful.

And your orators pray your Honors to enquire into the premises and thereupon order, adjudge, and decree, your orators are entitled to have letters-patent of these United States for the said improvements in milk vessels described in your orators' said application for letters-patent and referred to in said two clauses of claim ; and to grant to your orators such other relief, or such further relief, as the nature of the case may equitably require.

In consideration whereof, and to the end that Jane H. Shaw may, if she can, show cause why your orators should not have the order, judgement, and decree of this court, as hereinbefore prayed, and that your orators may have such other, or such further relief in the premises as the nature of the case may require, and shall be agreeable to equity ; and that said defendant may answer all and singular the premises : may it please your Honors to

grant unto your orators the writ of subpoena to be directed to said defendant commanding her by a day certain, and under certain penalty, to be and appear before the Judges of the United States Circuit Court, in and for the District of Massachusetts, and then and there to answer the premises and further to stand to, and abide by, such order and decree herein, as shall be agreeable to equity and good conscience, and your orators will ever pray, &c.

HORACE G. BUTLER.

JAMES VAN ALSTINE,
Solicitor and of Counsel.

EUREKA FARM MACHINE COMPANY,
By CHARLES WORK,
Secretary.

OATH.

DISTRICT OF CONNECTICUT, }
COUNTY OF HARTFORD. } *ss.*

Personally appeared, Horace G. Butler, and made oath that he is the person of that name mentioned in the foregoing bill; that he has read the same and knows the contents thereof; and that the same is true of his own knowledge except as to those matters therein stated on information and belief, and as to all such matters he believes it to be true.

Before me at Hartford, in the County of Hartford, and State of Connecticut, on the 15th day of August, 1882.

CHARLES L. BURRAGE,

[SEAL]

Notary Public.

DEFENDANT'S EQUITY ANSWER TO
 FOREGOING BILL OF COMPLAINT.

Circuit Court of the United States.

DISTRICT OF MASSACHUSETTS.

HORACE G. BUTLER,	}	<i>In Equity.</i>
vs.		
JANE H. SHAW.		

THE ANSWER OF JANE H. SHAW TO THE BILL OF
 COMPLAINT OF HORACE G. BUTLER AND THE
 EUREKA FARM MACHINE COMPANY.

This defendant, now and at all times saving and reserving to herself all benefit and advantage of exception, which can or may be had or taken to the many errors, uncertainties and other imperfections in the said complainants' bill of complaint contained, for answer thereunto, or unto so much and such parts thereof as she is advised it is material or necessary for her to make answer unto, answering says :

She admits the citizenship and residence of the parties complainants and defendant, as in said bill of complaint set forth.

She also admits that the said complainant, on or about the 20th day of November, 1878, claiming to be the first and original inventor of certain new and useful improvements in milk cans or vessels, made application for letters-patent therefor as in said bill of complaint set forth ; but she denies, on information and belief, that he was in fact the first and original inventor of the subject matter claimed by him in said application, as set forth in said bill of complaint.

She also admits that said application, containing said claims in said bill of complaint set forth, was finally refused and rejected by the Commissioner of Patents on or about the 28th day of December, 1881, on the ground that Thomas Shaw, deceased, was the prior inventor of the improvements in milk cans or vessels, described in said complainant's said application and claimed in said two clauses of claim set forth in said bill of complaint.

And this defendant, further answering, admits that the said Thomas Shaw in his lifetime, filed with the Commissioner of Patents, on or about the 4th day of February, 1878, an application for letters-patent for improvements in apparatus for separating cream from milk, which eventuated in the issue of letters-patent of the United States, dated September 10, 1878, and numbered 207,822, as in said bill of complaint alleged, and that in response to a notification from the Commissioner of Patents, made while said complainants' said application was pending in the Patent Office, an application for re-issue of said Shaw's original patent was filed in the Patent Office on or about the 5th day of April, 1880, by this defendant, who was then the owner, by assignment, of the said letters-patent originally granted to the said

Thomas Shaw as aforesaid, who was then deceased : that an interference was declared and had in the Patent Office between the said complainants' aforesaid application and said application of this defendant for the reissue of said original patent granted to the said Thomas Shaw in his lifetime, upon an issue stated by the Commissioner of Patents as in said bill of complaint set forth: and thereupon it was decided that said Thomas Shaw was the prior inventor of the subject-matter in issue as aforesaid ; and thereupon said original patent was reissued to this defendant October 18, 1881, with claims embracing the subject-matter of said issue.

And this defendant avers, that in said interference cause a decision that the said Thomas Shaw was the prior inventor as aforesaid was first rendered by the Examiner of Interferences, which decision was affirmed by the Board of Examiners-in-Chief and by the Commissioner of Patents in person, respectively on successive appeals to them by the said complainants.

And this defendant, further answering, avers, on information and belief, that the said Thomas Shaw was the original and first inventor of the subject-matter put in issue, as aforesaid, in said interference cause, and all of the invention claimed in said reissued patent, and denies that the said complainants was the original and first inventor of the subject-matter involved in said issue, or in the said two clauses of claim set forth in their said bill of complaint, or either of them, or any part thereof ; and she avers, on like information and belief, that the said Thomas Shaw was the original and first and prior inventor of all the invention embraced or described in said two clauses of claim, or either of them, or any part thereof.

And this defendant further answering avers, on information and belief and advice of counsel, that said original patent No. 206,822, granted to the said Thomas Shaw on the 10th day of September, 1878, and the specification and drawings of the same clearly describe and show all the inventions and improvements claimed by the said complainants in said two clauses of claim set forth in their said bill of complaint, or the full equivalents thereof : and that neither of said clauses of said claim embraces any patentable invention not described or shown in the specification and drawings of said original patent.

And this defendant further answering denies, on information and belief and advice of counsel, that the Commissioner of Patents erred or made a wrongful or unlawful decision in refusing the complainants' said application for letters-patent or in awarding priority of invention to the said Thomas Shaw, as aforesaid.

And this defendant further answering admits that said original patent, No. 207,822, did not contain any sufficient claims to the improvements in milk vessels described in the complainants' said application and referred to in said two clauses of claim therein contained, but avers that the specification and drawings of said original patent did fully and clearly describe and show said improvements and invention, and that the failure to make sufficient claims thereto arose from inadvertence and mistake, and without any fraudulent intention.

She further avers that said reissue was applied for as soon as she was advised that the claims of said original patent were defective, in not being commensurate with the invention described and shown in the specification and drawings thereof ; and in fact said reissue was ap-

plied for within one year and seven months from the grant of said original patent.

She further states that she was first advised of the insufficiency of the claims of said original patent by a letter from the Commissioner of Patents, after which she lost no time in filing her said application for reissue. She denies that said reissued letters-patent were not warranted by law, or are null and void, and avers that the same are good and valid in law.

And this defendant further answering says, on information and belief, that after a decision in the Patent Office in her favor, in the aforesaid interference cause, to wit., on the 8th day of November, 1881, the said complainants filed in the Patent Office another application for letters-patent describing and showing the same alleged invention described and shown in said application so put in interference as aforesaid, and on said application letters-patent were granted and issued to them January 31, 1882, with a claim fully covering and embracing all the patentable invention of the said complainants, described and shown in said application, or in said prior application so put in interference as aforesaid, and she is advised by counsel, learned in the law, that by applying for and accepting said last mentioned letters-patent, the said complainants were estopped from claiming, as against this defendant, any invention that was involved or embraced in said interference ; and she prays the same benefit and advantage as if the said matter had been specially pleaded in estoppel.

And now having fully answered said bill of complaint, this defendant submits to this Honorable Court, that the said complainants are not entitled to the relief prayed for,

nor to any other relief, in the premises, and she prays to be hence dismissed with her reasonable costs and expenditures in this behalf most wrongfully sustained.

JANE H. SHAW.

HENRY HALE,

Solicitor and Counsel for Defendant.

STATE OF MASSACHUSETTS, }
COUNTY OF PLYMOUTH. } ss.

Jane H. Shaw, the above named defendant, being duly sworn, deposes and says, that she has heard read the foregoing answer and understands the same, and that all the several matters and things therein alleged as of her own knowledge are true, and all alleged and set forth as on information and belief, she believes to be true.

JANE H. SHAW.

Sworn to and subscribed before me this 20th day of October, 1882.

C. W. HARRINGTON,
Notary Public.

[L. S.]

REPLICATION TO FOREGOING ANSWER.

(Substantially same as the last Replication.)

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