

the part of a patentee, when claiming materially more than that of which he was the first inventor, or when claiming that which was not patentable, will rightly prevent him from receiving any benefit from a disclaimer. This statutory provision is in harmony with the principles of equity; a system which always declines to extract persons from trouble which arose from their own moral turpitude.

§ 203. The statement in Section 4917, that under the circumstances therein mentioned, a patentee's patent shall be valid as to all that part of the invention which is truly and justly his own, is to be construed in connection with the provision in Section 4922, that the patentee shall not be entitled to recover in any suit, if he unreasonably neglects or delays to enter a disclaimer. When so construed, the two sections enact that where a patentee claims materially more than that which he was the first to invent, his patent is void, unless he has preserved the right to disclaim the surplus, and that he may fail to preserve that right, by unreasonable neglect or delay to enter a disclaimer in the Patent Office.

§ 204. Unreasonable neglect or delay to file a necessary disclaimer, begins when knowledge is brought home to the patentee, that the inventor upon whose account the patent was granted, was not the first inventor of a particular thing claimed in the patent and material to the subject of the patent as a whole.¹ If, however, there is reasonable ground for difference of opinion relevant to the question whether the prior patent, or the prior process, or the prior thing, so brought home to the knowledge of the patentee, really negatives the novelty of anything claimed by him; then unreasonable delay to file a disclaimer will not begin until that question is finally settled by the courts.² The question whether the delay to enter a disclaimer, in a particular case, was or was not unreasonable, is a mixed question of law and fact, to be decided by the jury in accordance with proper instructions

¹ *Singer v. Walmsley*, 1 Fisher, 558, 1860; *Parker v. Stiles*, 5 McLean, 44, 1849; *O'Reilly v. Morse*, 15 Howard, 121, 1853.

² *Seymour v. McCormick*, 19 Howard, 106, 1856; *Potter v. Whitney*, 1 Lowell, 87, 1866.

from the court.¹ In the case of *Seymour v. McCormick*,² the Supreme Court, when speaking of the question of the necessity for a disclaimer in that case, and of the question of unreasonable delay in entering one, said: "Under the circumstances, the question is one of law." The peculiar collocation of the paragraph, has caused some courts,³ to suppose that the question thus characterized, was the question of delay; but really it must have been the question of necessity. The latter depended wholly upon the construction of the patent, and was therefore a question of law. Whether or not a particular instance of delay was unreasonable, must largely depend upon the circumstances which surrounded the person chargeable therewith. What those circumstances were is a question of fact. Whether they constituted an excuse for the delay, is a question of law. Whether or not a particular instance of delay to enter a necessary disclaimer, was unreasonable, is therefore a mixed question of law and of fact.

§ 205. No costs can be recovered in any infringement suit, the final decision of which shows a necessity for a disclaimer, unless such a disclaimer was entered in the Patent Office before the commencement of the suit.⁴ This rule applies even to cases where the delay to enter the disclaimer was not unreasonable.⁵ But a verdict on all the claims of a patent, entitles the plaintiff to costs, even if, after that verdict, he files a disclaimer to one or more of the claims of that patent.⁶

Judge LOWELL has said that where a plaintiff sues on a part of the claims of his patent only, the defendant will not be permitted to raise any issue relevant to the validity of any other claim, with intent to show a necessity for a disclaimer,

¹ *Brooks v. Jenkins*, 3 McLean, 449, 1844; *Washburn v. Gould*, 3 Story 122, 1844; *Burden v. Corning*, 2 Fisher, 477, 1864.

² *Seymour v. McCormick*, 19 Howard, 106, 1856.

³ *Singer v. Walmsley*, 1 Fisher, 558, 1860; *Parker v. Stiles*, 5 McLean, 44, 1849.

⁴ Revised Statutes, Section 4922; *Reed v. Cutter*, 1 Story, 591, 1841; *Burdett v. Estey*, 5 Bann. & Ard. 309, 1880. *Proctor v. Brill*, 16 Fed. Rep. 791, 1883.

⁵ *O'Reilly v. Morse*, 15 Howard, 121, 1853.

⁶ *Peek v. Frame*, 5 Fisher, 212, 1871.

and thus to escape costs.¹ His Honor based this opinion on the fact that more expense might be incurred litigating such a collateral issue, than would be justified by the amount of the costs depending upon its decision. But general rules of law can hardly be based on considerations of what is expedient in a part only of the cases to which those rules purport to apply. It may happen that the costs involved in a particular litigation are large, while the expense involved in proving a necessity for a disclaimer of some one claim of the patent is small. The difference between the two sums may sometimes be measured by thousands of dollars. A judgment or a decree may be largely lessened and justly lessened, if a defendant is permitted to prove a necessity for a disclaimer of a claim not sued upon. In view of these considerations, it is possible that the law will finally be settled otherwise than as Judge LOWELL's remark would seem to forecast.

§ 206. Disclaimers are required to state the extent of the interest which is held by the disclaimant in the patent involved.² If, however, the disclaimant is the original patentee, and the disclaimer states that fact, and is silent respecting any transfer of any part of it, the fair implication is that he still owns the whole, and that implication is a sufficient statement of the interest of the patentee.³ So also, if an executor or administrator, in whose name a patent has been extended, states in his disclaimer, that he is the patentee, and refers to the patent as showing his interest, that is a sufficient statement of his interest in the patent.⁴ But if one only, of several joint owners or owners in common, of a patent, should file a disclaimer, no other owner could avail himself of its benefits, nor could it affect a suit brought by all the owners jointly.⁵

§ 207. The construction of a patent after a disclaimer has been properly entered, must be the same that it would have

¹ American Bell Telephone Co. v. Spencer, 8 Fed. Rep. 512, 1881.

² Revised Statutes, Section 4917.

³ Silsby v. Foote, 14 Howard, 221, 1852.

⁴ Brooks v. Jenkins, 3 McLean, 432, 1844.

⁵ Wyeth v. Stone, 1 Story, 294, 1840.

been if the matter so disclaimed had never been claimed.¹ No disclaimer, in order to be effectual, needs to eliminate anything from the description ; though no harm will follow from such elimination if it is confined to matter which is disclaimed, and which is not needed to show the nature of the invention which, after disclaimer, the patent continues to cover.²

§ 208. Disclaimers may be filed pending a suit on the patent, but in that event, the plaintiff, even if he prevails in the suit, can recover no costs.³ The filing of a disclaimer, at that stage of affairs, does not affect the pending action, except so far as it may bear upon the question whether or not there was unreasonable delay before filing it.⁴ That question is an open one, until decided on its merits, regardless of whether the disclaimer was filed before or after the bringing of the suit.⁵ The sooner a necessary disclaimer is filed, the less danger exists that the preceding delay will be held unreasonable. For that reason, and for that reason alone, it is sometimes wiser to file a disclaimer pending a suit, than to wait till the case is heard, or still longer, till it is decided.

§ 209. An important question arises, when a Circuit Court, before any disclaimer has been filed, decides that a part of the claims of the patent in suit are valid, and have been infringed by the defendant, while another part are void for want of novelty, or for want of invention, and ought therefore to be disclaimed. Ought the chancellor, in such a case, to enter a decree for an injunction and an account on the valid claims, and allow the complainant to disclaim the others or not, as he deems most prudent ? Or ought the chancellor to refuse both the injunction and the account, till the complainant shall have filed a disclaimer ? Or ought the chancellor to grant an injunction whether the complainant disclaims or not, while refusing an account till after he shall have done so ? Or ought the chancellor in case the complainant declines to disclaim, to

¹ *Dunbar v. Myers*, 94 U. S. 187, 1874.
1876.

² *Schillinger v. Gunther*, 17 Blatch. 69, 1879.

³ *Smith v. Nichols*, 21 Wallace, 117,

1874.

⁴ Revised Statutes, Section 4917 ;
Tuck v. Bramhill, 6 Blatch. 95, 1868.

⁵ *Reed v. Cutter*, 1 Story, 590,
1841.

refuse an injunction, and grant a decree for an account? The second of these courses has been the practice followed by Justice BLATCHFORD;¹ and by Judge WALLACE;² Judge SHIPMAN³ and Judge WHEELER.⁴ The third was that adopted by Judge CADWALLADER.⁵ The point has never been decided by the Supreme Court, though the action of that tribunal, in *O'Reilly v. Morse*;⁶ appears to favor the first of the four suggested views. The subject is a complex one, and when the law relevant thereto is finally settled, a number of considerations will require to be weighed which appear not to have been heretofore considered.

The second view of the law operates to deny an appeal from the Circuit Court upon the question of the necessity for a disclaimer. If the patentee submits to the condition imposed by the chancellor, and if, in order to secure an injunction and an account on his confessedly valid claims, he disclaims the others, and if the Supreme Court, on an appeal by the defendant, holds that no disclaimer was necessary in the case, it will be impossible to rectify the error, for there is no way to recall a disclaimer.

The third view is open to the same objections as the second, but in a diminished degree; a degree diminished, in any particular case, in the same proportion that the value of an injunction, bears to the value of an injunction and an account. It is also open to the objection of inconsistency, for there is probably no reason for refusing an account, which does not apply with equal force to an injunction.

The fourth view seems still less reasonable than the third, because an account is incidental to an injunction, and if no injunction is granted, the power to enter a decree for an account is probably wanting.

¹ *Myers v. Frame*, 8 Blatch. 446, 1871; *Burdett v. Estey*, 15 Blatch. 349, 1878; *Christman v. Rumsey*, 17 Blatch. 148, 1879.

² *Brainard v. Cramme*, 12 Fed. Rep. 621, 1882.

³ *Tyler v. Galloway*, 12 Fed. Rep.

567, 1882.

⁴ *Matthews v. Spangenberg*, 14 Fed. Rep. 350, 1882.

⁵ *Aiken v. Dolan*, 3 Fisher, 207, 1867.

⁶ *O'Reilly v. Morse*, 15 Howard, 121, 1853.

The first view would probably be found to be more consistent with convenience and with justice than either of the others. Whenever a Circuit Court decides, that while some of the claims of a patent are valid and have been infringed, others are void and should be disclaimed ; that decision is right or it is wrong. If it is wrong, the patentee ought to have an opportunity to get it corrected by the Supreme Court. On the other hand, if that decision is right, it will be either obviously right or questionably right. If it is obviously right, and if the patentee insists on taking a decree without filing a disclaimer, he will do so at his peril ; for the Supreme Court will probably hold, on the defendant's appeal, that the omission to disclaim was unreasonable, and the whole patent therefore void. If the decision is questionably right ; that is to say, if there is room for difference of intelligent opinion upon the point, then the patentee ought not to be forced to disclaim till the Supreme Court shall have decided that question against him. No ultimate injustice would result to either litigant, were the first of the four courses adopted by the Circuit Courts ; whereas the adoption of either of the others, involves a denial of the right of appeal : a right provided by the statute in all cases touching patents.¹

¹ Revised Statutes, Section 699.

CHAPTER IX.

REISSUES.

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§ 210. IN 1821 James Grant, of Providence, Rhode Island, received letters patent of the United States for an improved mode of manufacturing hat bodies. In 1825 he presented a petition to Henry Clay, Secretary of State, stating that the specification of his patent was defective, and praying that his patent might be cancelled, and a new and correct one granted, embracing the same improvements, so far as they were set forth in certain new specifications, drawings and explanations which accompanied the petition. Though there was, at that time, no statute which authorized any such proceeding; yet, on the advice of William Wirt, the Attorney-General, and in the name of John Quincy Adams, the President of the United States, Mr. Clay cancelled the letters patent of Mr. Grant, and thereupon issued to him new letters patent, for the same invention, and for the residue of the term covered by the original document. Annexed to the new letters, and forming part thereof, were the new specifications, drawings and explanations, which had accompanied Mr. Grant's petition.

In the case of *Grant v. Raymond*¹ the validity of this proceeding was called in question in the Supreme Court; and was argued in the negative by Daniel Webster. The Supreme Court sustained the validity of the reissued patent, on the general spirit and object of the patent law; not on its letter.

¹ *Grant v. Raymond*, 6 Peters, 243, 1832.

In delivering the opinion Chief Justice MARSHALL said : “ If the mistake should be committed in the Department of State, no one would say that it ought not to be corrected. All would admit that a new patent, correcting the error, and which would secure to the patentee the benefits which the law intended to secure, ought to be issued. And yet the act does not in terms authorize a new patent, even in that case. Its emanation is not founded on the words of the law, but it is indispensably necessary to the faithful execution of the solemn promise made by the United States. Why should not the same step be taken for the same purpose, if the mistake has innocently been committed by the inventor himself ?” And his Honor further said : “ If, by an innocent mistake, the instrument introduced to secure his privilege fails in its object, the public ought not to avail itself of this mistake, and to appropriate the discovery without paying the stipulated consideration. The attempt would be disreputable in an individual, and a Court of Equity might interpose to restrain him.”

§ 211. In accordance with the spirit of the decision in *Grant v. Raymond*, and within a few months after that decision was made, Congress enacted a statute to regulate the granting of reissued letters patent.¹ That statute provided, in effect, that whenever any patent should be invalid or inoperative, because the inventor, by inadvertence, accident or mistake, and without any fraudulent or deceptive intention, failed to conform his specification to the then existing statutory requirements ; it should be lawful for the Secretary of State, upon the surrender to him of such patent, and the delivery to him of a sufficient statutory specification, to cause a new patent to be granted to the same inventor, for the same invention, and for the residue of the term of the original patent. That statute also provided that the right to receive a reissue, should extend to executors, administrators or assigns ; and that the reissue patent should be liable to the same defences as the original ; and that no public use of the invention, after the grant of the original patent, should prejudice the right of the patentee to

¹ 4 Statutes at Large, Ch. 162, Section 3, p. 559.

recover for infringement of the reissue patent, committed after the grant thereof.

§ 212. The Patent Act of 1836¹ repealed all prior statutes relevant to patents, and provided a more elaborate system in place of the repealed laws. Section 13 of that Act referred to reissues, and provided, in effect, that whenever any patent should be inoperative or invalid because the inventor had, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, made his description or specification defective or insufficient, or had claimed in his specification more than he had a right to claim as new; it should be lawful for the Commissioner of Patents, upon the surrender to him of such patent, to cause a new patent to be issued to the same inventor, for the same invention, in accordance with the inventor's corrected description and specification, and for the residue of the term of the original patent. This statute also provided that the right to receive a reissue should extend to executors, administrators and assigns, and that the reissued patent, together with the corrected description and specification, should have the same effect in law, on the trial of all actions thereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form before the issuing of the original patent.

§ 213. The Patent Act of 1837² made some additions to the statute of 1836, relevant to reissues. Section 5 recognized a right in a patentee to demand and receive several reissued patents for distinct parts of the subject-matter of his surrendered patent. And Section 8 provided, that whenever a patent should be returned for reissue, the claims thereof should be subject to revision and restriction, in the same manner as were original applications for patents; and that the Commissioner should not grant any reissue, until the applicant should have entered a disclaimer, or altered his claim, in accordance with the decision of the Commissioner; and that the applicant, if dissatisfied with such decision, should have the same remedy

¹ 5 Statutes at Large, Ch. 357, p. 117.

² 5 Statutes at Large, Ch. 45, p. 191.

by way of appeal, that the law provided in cases of original applications.

§ 214. The Patent Act of 1870¹ substantially re-enacted the law of reissues as it had been embodied, for more than thirty years, in the statutes of 1836, and 1837; but re-enacted that law with a few modifications and additions. Where the old law used the phrase "defective or insufficient description or specification," the new law used the words "defective or insufficient specification." Where the old statute made it lawful for the Commissioner to reissue a patent, the new statute made it obligatory upon him to do so. Where the old law recognized a right in a patentee to demand and receive several reissue patents in the place of one surrendered patent, the new law provided that the Commissioner might, in his discretion, cause several such patents to be issued upon the demand of the applicant. The provision of the old statute, that the applicant, if dissatisfied with the decision of the Commissioner, should have the same remedy and be entitled to the same privileges and proceedings, as were provided by law in the case of original applications for patents, was omitted in the new statute; but its effect was retained, by expressly mentioning reissues in those sections of the new statute, which provided for that remedy, and for those privileges and proceedings.² Section 33 of the new statute provided further, that where a patent was to be reissued to an assignee of the inventor, the application should be made, and the specification be sworn to, by the inventor, if he be living. The Patent Act of March 3, 1871,³ prescribed, that the provision of Section 33, just mentioned, should not be construed to apply to any patent, issued and assigned before July 8, 1870: the date of the approval of the Act of which that section formed a part. Another new provision of the Statute of 1870, was as follows: "No new matter shall be introduced into the specification, nor in case of a machine patent shall

¹ 16 Statutes at Large, Ch. 230, p. 198. Sections 46 to 52, p. 204.

² 16 Statutes at Large, Ch. 132, p.

³ 16 Statutes at Large, Ch. 230, 583.

the model or drawings be amended, except by each other ; but where there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.”¹

§ 215. Section 4916 of the Revised Statutes is substantially a copy of Section 53 of the Statute of 1870. Section 4895 of the Revised Statutes, re-enacted the provision above cited from Section 33 of the Act of 1870, coupled with the statutory construction of that provision, which was contained in the Patent Act of 1871, and which was above explained. Sections 46 to 52 of the Act of 1870, were re-enacted as Sections 4909 to 4915 of the Revised Statutes. Thus the law of reissues underwent no change when the Revised Statutes were approved. The reissue provisions which were embodied in the Act of 1870, are still the statutes which govern the subject.

The meritorious ground for reissues, as stated by the Supreme Court in *Grant v. Raymond*, has now been set forth ; and the subsequently enacted and gradually developed statutory law on the subject has been explained. To explore the great mass of relevant adjudicated cases, and to extract from those cases the detailed doctrines of the law of reissues, is the engaging work upon which it is now in order to enter.

§ 216. To be the lawful subject of a reissue, a patent must be invalid, or it must be at least inoperative.² All patents that are invalid, are also inoperative. If the two words had, in the statutes, been always connected with the word “ and ;” there would be ground for an argument that they were used synonymously. In fact, however, they have always been connected with the word “ or ;” thus indicating that they were not intended to signify the same thing. What they do respectively mean, is to be ascertained by considering other provisions of the statute ; namely those provisions which indicate

¹ 16 Statutes at Large, Ch. 132, Section 53, p. 206.

1836, Section 13 ; Act of 1870, Section 53 ; Revised Statutes, Section

² Act of 1832, Section 3 ; Act of 4916.

the causes from which either invalidity or inoperativeness must have sprung, in order to make patents reissuable. To have that effect, either of those faults must have resulted from a defective or insufficient specification, or from the patentee claiming more than he had a right to claim as new. This last cause of fault, was first mentioned in the statute of 1836. In the following year, Congress provided that patents should no longer be held to be invalid, on that ground, provided proper disclaimers were reasonably entered.¹ Ever since 1837, therefore, faults in patents, arising from patentees claiming more than they had a right to claim, have been as curable by disclaimers as by reissues; and, as the remedy by disclaimer is both cheaper and better than the other, the remedy by reissue has seldom or never been sought as a cure for a fault of that class. The case law on the subject of reissues, is therefore substantially confined to reissues which were granted because the surrendered patents were alleged to be invalid or inoperative, by reason of defective or insufficient specifications.

§ 217. The meaning of the word "specification" is that of the words "description and claim" when it is used, in the statutes, separately from both those words.² In the reissue section of the statute of 1836, the word "description" was used in connection with the word "specification" and thus limited the meaning of the latter to the signification of the word "claim."³ On the other hand, in the fourth sentence of Section 4916 of the Revised Statutes, the word "specification" is used in immediate connection with the word "claim," and is therefore limited, in that place, to the meaning of the word "description."

The word "defective" and the word "insufficient" are not synonymous in this statute, as at first thought they may appear to be. The former word means "bad," and the latter means "lacking." A description may be complete, while it is obscure in some of its parts. In such a case, it is defective. On the

¹ 5 Statutes at Large, Ch. 45, Sections 7 and 9, p. 193. 1880.

² Wilson v. Coon, 18 Blatch. 535, 1880.

³ Wilson v. Coon, 18 Blatch. 536,

other hand, it may be perfectly clear, as far as it goes, while omitting all reference to some parts of the thing described. In such a case, it is insufficient. So also, a claim may mistily cover the whole invention described, but being liable to be misunderstood, it is defective. On the other hand it may be entirely clear, while it is narrower than the invention, and therefore insufficient to cover and secure the latter.

§ 218. From the foregoing it follows, that ever since 1836, those patents have been reissuable which were invalid or inoperative, by reason of defective or insufficient descriptions or claims; provided their faults arose from inadvertence, accident or mistake, and without any fraudulent or deceptive intention. This proviso is equally imperative in all cases. Assuming it to be satisfied in all, and disregarding the nugatory provisions relevant to reissues when the patentee has claimed too much, it appears that the faults which make patents reissuable are four in number. 1. Invalidity arising from defective description. 2. Invalidity arising from insufficient description. 3. Invalidity arising from defective claims. 4. Inoperativeness arising from insufficient claims.

The nature of the first three of these faults, is explained in the chapter on letters patent. Whether or not a particular patent was or is invalid for either of those reasons, may be determined, by the application thereto of the relevant rules and doctrines set forth in that chapter. Specifications have, for many years, been generally written with such a degree of skill and care, that comparatively few letters patent have, in recent times, been characterized by either of the first two faults. Those which have possessed the third fault, have, in many cases, been made to possess it, in order to deceive or defraud the public, and not from inadvertence, accident or mistake. Defective claims are frequently nebulous claims, intended to mean much or to mean little, according to the exigencies of future events. To the public, they are intended to convey a signification so wide as to deter others than the patentee, from accomplishing the same result by other means than those which the patentee is entitled to claim. To the courts, they are intended to convey a meaning so narrow as

to enable them to successfully run the gauntlet of litigation. For such purposes of duplicity, nebulously defective claims are more useful than clear and perfect ones would be. Those who secure such patents, therefore seldom surrender them for reissue, except in cases where the defect arose from the absence of verbal skill, in the writers of the claims, rather than from the presence of intent to deceive, in the owners of the patents. The considerations stated in this paragraph, account for the well-known fact, that most of our reissued patents were reissued because of alleged inoperativeness arising from alleged insufficiency of claims.

§ 219. Claims are the only operative parts of specifications. If an inventor has produced two or more inventions, so allied that they may properly be secured to him in one letters patent; and if he fully describes all of those inventions in the descriptive part of his specification, but covers only one of them by his claims; then his patent is operative as to one of those inventions, and inoperative, as to the others. Inoperativeness of that kind, is sufficient to lay the foundation of a right to a reissue.¹ Reissues granted in such cases are called broadened reissues. Though the statute does not, under that name, authorize reissues of that kind, they are authorized by the general terms of the law;² and have been upheld by the Supreme Court in many cases.³

§ 220. Inadvertence, accident or mistake must have been the source of the fault in letters patent, in order to make them reissuable.⁴ Such inadvertence or accident may have been suffered, or such mistake may have been committed, by the patentee, or by the Commissioner of Patents.⁵ The statute is satisfied on this point, where the patent was inoperative by

¹ *Anilin v. Higgin*, 15 Blatch. 291, 1878; *Wilson v. Coon*, 18 Blatch. 535, 1880.

² *Miller v. Brass Co.* 104 U. S. 354, 1881.

³ *Battin v. Taggart*, 17 Howard, 74, 1854; *Morey v. Lockwood*, 8 Wallace, 230, 1868; *Rubber Co. v.*

Goodyear, 9 Wallace, 788, 1869; *Corn-Planter Patent*, 23 Wallace, 217, 1874; *Marsh v. Seymour*, 97 U. S. 356, 1877.

⁴ Revised Statutes, Section 4916.

⁵ *Grant v. Raymond*, 6 Peters, 218, 1832.

reason of insufficient claims, if those claims were made too few or too narrow because the patentee was mistaken about the state of the art,¹ or because the patentee or his solicitor, when concerting the claims, inadvertently failed to make them as extensive as the invention.² So also, the statute is satisfied, where the patent was inoperative by reason of insufficient claims, if those claims were made too narrow because the Commissioner, on account of an erroneous opinion entertained by him, refused to allow them to be made as broad as they ought to have been ;³ or because of an erroneous decision made by him in an interference proceeding.⁴

§ 221. The Supreme Court has recognized the fact, that patents have been reissued by the Commissioner, in some cases where there was no statutory ground therefor ;⁵ that is to say, in some cases where the patents surrendered were neither invalid nor inoperative ; or if invalid or inoperative, were not so by reason of a defective or insufficient specification ; or if invalid or inoperative by reason of a defective or insufficient specification, were not so because of inadvertence, accident or mistake. It is, however, still an unsettled question whether any of these matters can be investigated in courts. The point is so important, and involves so many cases and considerations, that it deserves and must receive an extensive explanation in this book. To that explanation it is now convenient to proceed.

§ 222. It has several times been said by divers justices of the Supreme Court, that the Commissioner, when granting a reissue, is presumed to have decided that some statutory ground for a reissue existed ; and that his decision, on that point, is not subject to review, in any suit for infringement.⁶

¹ *National Spring Co. v. Mfg. Co.* 12 Blatch. 89, 1874.

² *Miller v. Brass Co.* 104 U.S. 352, 1881.

³ *Morey v. Lockwood*, 8 Wallace, 230, 1868.

⁴ *American Shoe-Tip Co. v. Protector Co.* 2 Bann. & Ard. 551, 1877.

⁵ *Burr v. Duryee*, 1 Wallace, 531, 1863 ; *Leggett v. Avery*, 101 U. S. 259, 1879.

⁶ Story, J., in *Philadelphia and Trenton Railroad Co. v. Stimpson*, 14 Peters, 448, 1840 ; McLean, J., in *Stimpson v. Railroad Co.* 4 Howard, 404, 1846 ; Clifford, J., in

In the first of these cases, the point was not before the court for decision. The question at bar was whether the re-issued patent needed to contain any recitals of the particular statutory faults on account of which it was granted. The decision on that point was in the negative. In stating the grounds upon which that decision was based, Justice STORY overstepped the issue, and, when speaking of the evidence of reissuability laid before the Commissioner, remarked: "No other tribunal is at liberty to re-examine or controvert the sufficiency of such proof, if laid before him, when the law has made such officer the proper judge of their sufficiency and competency."

In the second case, the Supreme Court found a number of errors in the charge to the jury which had been given by the judge in the court below. The first two of those errors, had no relevancy to the point now under inspection. On that point the judge had told the jury that the original patent was inoperative and invalid by reason of non-compliance with the requisites of the statute; but that the plaintiff had not made out such a case of inadvertence, accident, or mistake as justified a reissue. In delivering the opinion of the Supreme Court, Justice McLEAN did not expressly characterize this part of the charge as erroneous, as he had expressly done relevant to the first two points. The following paragraph contains what he said on the subject:

"By the thirteenth section of the Act of 1836, 'if the patent shall be inoperative or invalid, by reason of a defective or insufficient description or specification,' &c., 'if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful' to surrender it, &c. Now, as in granting the renewed patent, the officers of the government act under the above provisions, their decision must at least be considered *prima facie* evidence that the claim for a renewal was within the

Seymour v. Osborne, 11 Wallace, 516, 1870; and in Collar Co. v. Van Dusen, 23 Wallace, 558, 1874, and

Strong, J., in Ball v. Langles, 102 U. S. 129, 1880.

statute. But this would not be conclusive against fraud in the surrender and renewal, which, on the evidence, would be a matter for the jury. And we suppose that the inquiry in regard to the surrender is limited to the fairness of the transaction. In whatever manner the mistake or inadvertence may have occurred is immaterial. The action of the government in renewing the patent must be considered as closing this point, and as leaving open for inquiry, before the court and jury, the question of fraud only."

What his Honor said about *prima facie* evidence, is undoubtedly the law; but what he said about fraud, has since been decided to be incorrect. It is now settled that questions of fraud, in obtaining reissues, cannot be raised in any infringement suit.¹

In the third case cited, the defendant did claim, in its answer, that the reissued letters patent were void, because no evidence was produced before the Commissioner, to show that the originals were inoperative or invalid. The defendant, however, introduced no proof to support that statement of his pleading, and the point was, for that reason, necessarily overruled. The case furnished no means of reviewing the Commissioner's decision, and therefore there was no occasion for the court to decide whether it was, in law, reviewable. Justice CLIFFORD however proceeded to say, that: "Where the Commissioner accepts a surrender of an original patent and grants a new patent, his decision in the premises, in a suit for infringement, is final and conclusive, and is not re-examinable in such a suit in the Circuit Court, unless it is apparent upon the face of the patent that he has exceeded his authority, that there is such a repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the new patent is not for the same invention as that embraced and secured in the original patent." *Battin v. Taggart* and *O'Reilly v. Morse* were cited by Justice CLIFFORD to support the foregoing *obiter dictum*. There was, however, no such question decided in either of those cases. In *Battin v. Tag-*

¹ *Eureka Co. v. Bailey Co.* 11 Wallace, 492, 1870.

gert, Justice McLEAN casually remarked that in *Stimpson v. Railroad Co.* it was held "that the proceeding before the Commissioner, in the surrender and reissue of a patent, is not open for investigation, except on ground of fraud." In *O'Reilly v. Morse*, the question was raised by the defendant whether Morse's reissued patent was not void because his surrendered patent was neither inoperative nor invalid. The court decided that the reissued patent was not void, but in so deciding the court did not explain whether it agreed in opinion with the Commissioner touching the invalidity or inoperativeness of the surrendered patent, or whether it found itself without power to review his decision on that point.

In the case of *Collar Co. v. Van Dusen*, the question was, whether the reissued patent and the surrendered patent were for the same invention. That question was readily and rightly decided in the negative, and the patent therefore held void. But Justice CLIFFORD said in passing: "Unless, however, it is apparent upon the face of the new patent that the Commissioner has exceeded his authority, his decision is final and conclusive, as the jurisdiction to reissue patents is vested in him subject to a single exception, that if there is such repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the reissued patent is not for the same invention as that embraced and secured in the original patent, then the reissued patent is invalid."

In the case of *Ball v. Langles* the question was also whether the surrendered patent and the reissued patent were for the same invention. Here also that question was quickly decided in the negative and the patent held void. But Justice STRONG also said in an *obiter dictum* that: "The commissioner was invested with authority to determine whether the surrendered patent was invalid by reason of a defective or insufficient specification, or because the patentee had claimed more than he had a right to claim as new; and if he found such to be the case, and found also that the error had been due to inadvertence, accident, or mistake, without fraud, his decision was conclusive, and not subject to review by the courts."

In accordance with the *obiter dicta* of the Supreme Court,

in the five cases thus reviewed, the same doctrine has been announced in other *obiter dicta* by Circuit Courts in many cases ; and in a few Circuit Court cases it has been judicially decided to be law.¹

§ 223. But the other side of the question, stated in Section 221 of this book, is also supported by several *obiter dicta* of the Supreme Court, and by several strong arguments in decisions of several of the Circuit Courts.

In *Burr v. Duryee*,² Justice GRIER said, that the patentee, in his original patent, claimed all he had a right to claim, and claimed no more ; and that there was no error from inadvertences, accident or mistake. Now these statements of fact, were contrary to the decision of the Commissioner, which was involved in his having reissued that patent. In this instance, therefore, the Supreme Court did in fact review that decision, and did in fact pronounce it wrong.

In *Goodyear v. Rubber Co.*,³ Justice SWAYNE said that, “ The surrender was made by the executor, for the reason that the specification was defective and required amendment. This the law permitted, if the facts brought the case within the provisions of the statute. The Commissioner was charged with the duty of examining the facts and deciding upon the application. His judgment is shown in the result. Upon comparing the context of the specifications of the surrendered and reissued patent, and giving to each a reasonable interpretation, we are satisfied that the decision was correct, and we see no reason to reverse it.” This therefore was an instance in which the Supreme Court appears to have reviewed the decision of the Commissioner relevant to the defective character of the specification of the original patent, and to have pronounced that decision to be right. In saying that they saw no reason to reverse it, they implied that they had jurisdiction to reverse it, had any such reason been seen.

¹ *Smith v. Merriam*, 6 Fed. Rep. 1863.
713, 1881 ; *Selden v. Gas Burner Co.*
9 Fed. Rep. 390, 1881.

² *Rubber Co. v. Goodyear*, 9 Wallace, 795, 1869

³ *Burr v. Duryee*, 1 Wallace, 571,

In *James v. Campbell*,¹ Justice BRADLEY said that, "Where it is apparent on the face of the patent, or by contemporary records, that no such inadvertence, accident, or mistake, as claimed in a reissue of it, could have occurred, an expansion of the claim cannot be allowed or sustained." This is a declaration that courts will review and reverse the decision of the Commissioner, on the question of the existence of inadvertence, accident, or mistake, in certain cases where certain kinds of documentary evidence shows that decision to have been wrong.

In *Whitely v. Swayne*,² Judge LEAVITT decided that the original patent was not inoperative or invalid by reason of a defective or insufficient specification; and that the reissues were therefore not granted in accordance with the statute; and that when the statutory requirements relevant to reissues are not complied with, it is within the power of the court and its plain duty to hold the reissue void.

In *Wicks v. Stevens*,³ Justice BRADLEY, when sitting in the Circuit Court for the Eastern District of Texas, decided that neither inadvertence, accident, nor mistake, did in fact cause the particular omission, in the claim of the original patent, which the claim of the reissued patent supplied; and that therefore the latter claim could not be sustained.

In *Giant Powder Co. v. Vigorit Powder Co.*,⁴ Justice FIELD, when sitting in the Circuit Court for the District of California, delivered a long opinion upon this subject. The substance of that opinion appears to be, that the Commissioner has no jurisdiction to reissue any patent, unless the original was chargeable with some of the faults which, according to the statute, make patents reissuable; and that if an original patent shows on its face, that it did not have either of those faults, it is the duty of the court to hold any reissue thereof to be void.

¹ *James v. Campbell*, 104 U. S. 371, 1881.

² *Whitely v. Swayne*, 4 Fisher, 123, 1865.

³ *Wicks v. Stevens*, 2 Bann. & Ard. 318, 1876.

⁴ *Giant Powder Co. v. Vigorit Powder Co.* 6 Sawyer, 508, 1880.

In *Flower v. Rayner*,¹ Judge NIXON decided that where an original patent shows upon its face, that no statutory ground for a reissue existed therein, any reissue of that patent is void, because unauthorized by law ; and that, though the decision of the Commissioner on this point is presumed to be correct, yet the courts are not obliged to accept it as final.

In *Searls v. Bouton*,² Judge WHEELER entered a final decree adjudging, among other things, that original letters patent No. 150,195 was not inoperative or invalid by reason of a defective or insufficient specification, and that the Commissioner had no jurisdiction to accept the surrender of said original letters patent, and to grant reissue No. 9297 thereon ; and that said reissue was therefore void.

§ 224. Great interests are involved in the question stated in Section 221 and discussed in Sections 222 and 223. So many patents have doubtless been reissued in cases where the originals were not in fact reissuable, that many hardships will surely follow the settlement of the law upon the point, and whether it is settled for or against the finality of the Commissioner's decision. If settled for that finality, the public will have to pay tribute in a class of cases, relevant to which it has never consented thus to be taxed : will have to submit to a class of patents which have no deeper foundation than the will of the Commissioner of Patents. If the question is finally settled against the finality of the Commissioner's decision, many meritorious inventors will have been misled by the *obiter dicta* of Justices STORY, McLEAN, CLIFFORD, and STRONG into surrendering their valid patents, and receiving for them nothing but worthless parchment. In view of this dilemma, it was a misfortune that the Supreme Court did not decide the question, when it arose in the case of *O'Reilly v. Morse*. A single sentence of decision in that case, would have obviated pages of *dicta* which have since been scattered through many others, and would have authoritatively guided the citizens upon a point which no amount of *dicta* can settle.

¹ *Flower v. Rayner*, 5 Fed. Rep. 793, 1881.

² *Searls v. Bouton*, 12 Fed. Rep. 626, 1881.

§ 225. To the present text writer, the question stated in Section 221 appears to admit of a plain and unassailable answer ; and that answer is the following. The decision of the Commissioner relevant to the existence of a statutory ground for a reissue, is not conclusive in any court ; because he has no jurisdiction to grant any reissue in the absence of such a statutory ground ; and because the statute does not make him the final judge of his own jurisdiction.

§ 226. *Miller v. Brass Co.*¹ is a celebrated case, which introduced a new doctrine into the patent laws of the United States. That doctrine is precisely this. The right to obtain a broadened reissue, is lost by a long lapse of time, after the date of the original, and before the application for that reissue. If that doctrine has any prototype in any prior deliverance of any United States judge, that prototype must be found in a charge which Chief Justice TANEY delivered to a jury somewhat early in his judicial career.² In that case, the third paragraph of his Honor's instruction was as follows : " The plaintiff, at the time of his application for the patent of 1834, had a right to surrender the patent of 1829, and take out a corrected one, if the said patent was invalid, either by reason of the defective description of the improvement, or by reason of his having claimed, as new, more than he was entitled to ; provided, the error had arisen from inadvertence or mistake, and the plaintiff proceeded to correct it within a reasonable time after it was discovered." The last proviso of this instruction, differs from the doctrine of *Miller v. Brass Co.*, in that, the latter makes the fatal lapse of time to begin at the date of the original patent, whereas the former makes it to begin when the fault of the original patent is discovered. This difference is a substantial one ; because reissuable faults in letters patent are often, and perhaps generally, of such a character that they can be detected only by persons learned in the patent law ; and because a patentee may honestly keep his patent by him for years, without subjecting it to profes-

¹ *Miller v. Brass Co.* 104 U. S. 350, 1881.

² *Knight v. Railroad Co.* Taney's Circuit Court Decisions, 107, 1840.

sional scrutiny. The doctrine of *Miller v. Brass Co.*, must therefore find its foundation and genesis elsewhere than in the opinion of Chief Justice TANEY; and elsewhere than in any United States decision made and reported before that doctrine was promulgated in that case in January, 1882.¹

§ 227. The length to which delay must be drawn out, in order to lose the right to apply for a broadened reissue, is as yet unknown. No clearer light can, at present, be thrown upon that inquiry, than can be thrown by stating the various spaces of time, which in various cases, have already been found long enough to be fatal. In *Miller v. Brass Co.* itself, the delay continued for fifteen years. In three later Supreme Court cases, the delay was for fifteen, fourteen, and thirteen years, respectively.² In each of two cases on the circuit, the delay was thirteen years;³ and in another, it was ten years;⁴ and two others, it was nine years;⁵ and in another, it was five years;⁶ and in one it was only twenty months;⁷ and in all of them, it was held to have been long enough to lose the right to a broadened reissue, and therefore to have made void the broadened claims of the respective reissues at bar.

§ 228. Reissued patents sought for and granted for other faults than insufficient claims, will perhaps hereafter be subjected to a doctrine of delay. If so, more delay will probably be required to kill such patents, than is required to kill a broadened claim, for it was said in *Miller v. Brass Co.* that the correction of a patent, by means of a reissue, where it is invalid or inoperative for want of a full and clear description of the invention, cannot be attended with such injurious results, as follow from the enlargement of a claim; and hence a

¹ *Battin v. Taggart*, 17 Howard, 85, 1854.

² *Johnson v. Railroad Co.* 105 U. S. 539, 1881; *Matthews v. Machine Co.* 105 U. S. 54, 1881; *Bantz v. Frantz*, 105 U. S. 160, 1881.

³ *Combined Patents Can Co. v. Lloyd*, 11 Fed. Rep. 149, 1882; *Newton v. Mfg. Co.* 14 Fed. Rep. 470, 1882.

⁴ *Sheriff v. Fulton*, 12 Fed. Rep. 137, 1882.

⁵ *Hayes v. Seton*, 12 Fed. Rep. 123, 1882; *Holt v. Keeler*, 13 Fed. Rep. 464, 1882.

⁶ *Streit v. Lawter*, 11 Fed. Rep. 309, 1882.

⁷ *New v. Warren*, 22 Off. Gaz. 538, 1882.

reissue may be proper in such cases, though a longer period has elapsed since the issue of the original patent.

§ 229. The statutory provision which makes a patent void, if the invention it covers was in public use or on sale more than two years before that patent was applied for, is a matter which does not apply to reissued patents, and the applications therefor.¹ The reissue application is considered as appended to the original application,² and the two years ceases to run with the filing of the latter.

§ 230. A surrender of a patent, when made with an application for a reissue, need not be made in writing; and therefore the statement in a reissue that it is a reissue of a surrendered former reissue, is not negatived by the production of a document purporting to be a surrender of the original patent, and apparently intended to have been a surrender of the former reissue.³ The presumption that the proper patent was surrendered, by parol if not otherwise, is not negatived by proof of an ineffectual attempt to surrender it in writing.

§ 231. Patents surrendered prior to July 8, 1870, were thereby cancelled in law, whether a reissue was granted thereon or not.⁴ Patents surrendered since July 8, 1870, were also cancelled thereby if reissues were granted thereon, but not otherwise.⁵ No damages or profits can ordinarily be recovered, for any infringement of a surrendered patent committed prior to its cancellation, by means of any judgment or decree entered after that time; but money recovered or voluntarily paid, on account of such infringement, prior to such cancellation, cannot be recovered back.⁶ Nor will any such cancellation have any effect upon any unpaid judgment or decree which was entered before that cancellation took effect. The right of the patentee, in such a case, rests upon his judgment

¹ *Shaw v. Lead Co.* 11 Fed. Rep. 714, 1882.

² *Grant v. Raymond*, 6 Peters, 218, 1832.

³ *Dental Vulcanite Co. v. Wetherbee*, 2 Clif. 563, 1866.

⁴ *Moffitt v. Garr*, 1 Black. 273,

1863; *Peck v. Collins*, 103 U.S. 664, 1880.

⁵ 16 Statutes at Large, Ch. 132, Section 53, p. 206; Revised Statutes, Section 4916.

⁶ *Moffitt v. Garr*, 1 Black. 273, 1861.

or decree, and not on his patent.' The decision just cited, is a decision of the Supreme Court, delivered by Justice STRONG, but it was never inserted in the Supreme Court reports.

The only exception, yet established, to what the last paragraph states is the ordinary rule relevant to profits and damages which accrued from the infringement of a surrendered patent before its cancellation, was established in a case where the defendant infringer was himself the patentee, and where the plaintiffs were his equitable grantees, as to that part of the territory of the United States, included within the boundaries of Connecticut and New York. In that case, the patentee infringed his grantee's rights, and afterward surrendered and reissued the patents involved. The Supreme Court decided that the defendant held his patents, all the time in trust for the plaintiffs, to the extent of their territory; and that he must therefore account to them for the profits which he had made from the use of the trust property, within that territory, regardless of the fact that he had surrendered and reissued those patents, after making a part of those profits.²

§ 232. A reissued patent may be surrendered and again reissued, under the same circumstances as those which make an original patent reissuable.³ So also, a patent might be reissued during its extended term, as well as during its first term, when, as formerly, extensions of patents were provided for by law.⁴ But patents reissued during their respective extended terms will be more likely to suffer from the doctrine of *Miller v. Brass Co.*⁵ than those reissued during their first terms, because of the generally longer lapse of time after the dates of the originals. No reissue can be granted of a patent after its final expiration; even where that expiration resulted from the fact that the same invention had been patented in a foreign country before it was patented in the United States;

¹ *Mevs v. Conover*, 11 Off. Gaz. 1111, 1876.

² *Littlefield v. Perry*, 21 Wallace, 205, 1874.

³ *French v. Rogers*, 1 Fisher, 136, 1851; *Selden v. Gas Burner Co.* 9

Fed. Rep 390, 1881.

⁴ *Wilson v. Rousseau*, 4 Howard, 646, 1846; *Gibson v. Harris*, 1 Blatch. 167, 1846.

⁵ *Miller v. Brass Co.* 104 U. S. 350, 1881.

and from the fact that the foreign patent has expired, though the United States patent sought to be reissued, does not appear, on its face, to have done so.¹

§ 233. Only "the same invention" can be covered by a reissued patent.² This quoted phrase occurs, in this relation, in all the relevant statutory provisions, now or heretofore in force in the United States. But neither of those statutes obviously indicates whether the phrase refers to whatever invention was made by the patentee, and actually described in his original application; or refers to whatever invention was substantially suggested, indicated or described in the patentee's original letters patent, drawing or model; or refers to whatever invention was described or indicated in the original letters patent or drawing of the patentee; or refers to whatever invention was described by him in his original letters patent; or refers only to whatever invention was actually claimed by him in that original document. Information on this subject, is however to be had in the decisions of the courts. As the question is almost as complex as it is important, and as the adjudged cases, and judicial *obiter dicta*, which bear upon it, lack something of harmony; it is necessary in this place to engage in an extensive search among the precedents, and in a careful comparison of conflicting arguments and opinions.

§ 234. To show that a given invention was actually made by a patentee, before applying for his original patent, and was intended by him to be incorporated into that patent; is not enough to entitle the patentee to such a reissue of the patent, as will cover that invention.³ In the case cited, Alfred Nobel appeared to be the inventor of several processes and compositions of matter, useful in the business of blasting. His original application for a patent described and claimed mixtures of gunpowder, and of gun-cotton, and of rocket powder, with nitro-glycerine; and described and claimed sev-

¹ C. W. Siemens' Appeal, 11 Off. Gaz. 1107, 1877.

² Patent Act of 1832, Section 3; Patent Act of 1836, Section 13; Pat-

ent Act of 1870, Section 53; Revised Statutes, Section 4916.

³ Powder Co. v. Powder Works, 98 U. S. 126, 1878.

eral processes for exploding pure nitro-glycerine. This application was amended by Nobel's solicitor, in such a way as to eliminate the mixtures, and confine it to the processes; and on the specification so amended a patent was granted. That patent was surrendered and reissued in four divisions; the last being for the mixtures described and claimed in the original application, but not mentioned in the specifications of the original letters patent. This last divisional patent was in its turn surrendered and reissued in two subdivisions, one being for the mixture of gunpowder with nitro-glycerine, and the other being for the mixture of rocket-powder with nitro-glycerine. It was not denied that these two patents were for the same inventions that were covered by the reissued patent upon the surrender of which they were granted; but it was claimed, by the defendant, that the inventions covered by them were unlike any inventions described or claimed in the original patent. To this the complainant argued in confession and avoidance, claiming that the inventions covered by the last two reissues, were invented by Nobel, and were described and claimed in the original application, and that reissues can lawfully be granted for the same inventions so described, whether they are described in the specification of the original letters patent or not. The Supreme Court decided the case against the complainant, holding that reissues can only be granted for the same inventions that formed the subject-matter of the original patents; and that the statute does not give any inventor a right to amend his patent, by the addition of other inventions, which though they might be his, had not been inserted in the application for his original patent, or if so inserted, had been eliminated therefrom.

In a still later case evidence tending to show that the patentee, before obtaining his original patent, had invented everything covered by the reissue, was held to be immaterial.¹

§ 235. The claims of a reissue need not to be confined to the invention actually claimed in the original; for it has been

¹ *Mfg. Co. v. Ladd*, 102 U. S. 413, 1880.

expressly decided by the Supreme Court, that a patentee may in a reissue include in his claims whatever was described in the specification of his original letters patent.¹ In the case just cited, and also in an earlier Supreme Court opinion,² delivered by the same justice of that tribunal, doctrine much broader than this was stated in *obiter dicta*. In that earlier opinion Justice CLIFFORD remarked, that : “ Power is unquestionably conferred upon the commissioner to allow the specification to be amended if the patent is inoperative or invalid, and in that event to issue the patent in proper form ; and he may, doubtless, under that authority, allow the patentee to redescribe his invention and to include in the description and claims of the patent not only what was well described before but whatever else was suggested or substantially indicated in the specification or drawings, which properly belonged to the invention as actually made and perfected.” In *Marsh v. Seymour*, Justice CLIFFORD repeated this *obiter dictum*, but repeated it with an interpolation. He inserted after the word “ drawings ” the words “ or patent office model.” The still later case of *Powder Co. v. Powder Works*³ settled the inaccuracy of the last clause of the former *dictum*.

§ 236. But the Supreme Court has never really decided whether an invention, shown only in the drawings of an original patent ; or an invention shown only in the original Patent Office model, may be covered by the claims of a reissue. Those two questions are very important ones. They have no necessary connection with each other. One may be decided in the affirmative and the other in the negative, without violence to any statute, or to the symmetry of the patent system. Upon few questions in the patent law do the books contain so much *obiter dicta* as upon these ; but disregarding all such extrajudicial utterances, let attention now be paid to those statutes and decisions which bear upon the two questions respectively.

¹ *Marsh v. Seymour*, 97 U. S. 356, 516, 1870.
1877.

² *Seymour v. Osborne*, 11 Wallace,

³ *Powder Co. v. Powder Works*,
98 U. S. 126, 1878.

§ 237. The statute provides that where the nature of the case admits of drawings, the applicant for letters patent shall furnish one copy, which shall be filed in the Patent Office, and that a copy thereof shall be attached to the patent, as a part of the specification.¹ The drawings of all letters patent, issued since 1871, and containing drawings, are published in the Official Gazette of the Patent Office, by means of exact photolithographic reproductions; and are similarly published in the certified copies of specifications and drawings of letters patents, which are distributed among the States, and among the Federal courts.² There seems therefore to be no reason why a claim in a reissued patent, may not as properly be based upon a representation in a drawing, as on a description in a specification. Several Circuit Courts have accordingly decided the question in that way, in cases where the fate of the suit depended upon that decision.³ Judge H. B. BROWN has, indeed, decided the point the other way,⁴ but he did not support that decision by any citation of authorities bearing directly upon the question, nor by any necessary logical deduction from the cases which he did cite.

§ 238. It is probable that no reissue claim was ever sustained in any case where the thing covered by it was neither referred to in the original specification, nor indicated in the original drawing, and was shown only in the original Patent Office model. The present text writer has made careful search through the reports, and has never found any report of such a case; though he has found two cases in which the original model was considered in aid of the original specification;⁵ and has found one where the model was spoken of as agreeing with the drawings in showing the device in controversy;⁶ and has found several which contain *obiter dicta* to

¹ Revised Statutes, Section 4889.

² Revised Statutes, Section 490.

³ *Bantz v. Elsas*, 1 Bann. & Ard. 351, 1874; *Kerosene Lamp Heater Co. v. Littell*, 3 Bann. & Ard. 312, 1878; *Atwood v. Portland Co.* 10 Fed. Rep. 286, 1880.

⁴ *Kells v. McKenzie*, 9 Fed. Rep. 284, 1881.

⁵ *Aultman v. Holley*, 11 Blatch. 317, 1873; *Reissner v. Anness*, 3 Bann. & Ard. 148, 1877.

⁶ *Calkins v. Bertraud*, 2 Bann. & Ard. 215, 1875.

the effect that original models are proper foundations for reissued claims. Such passing remarks were, however, founded upon other *obiter dicta*, if founded upon anything, and are therefore of no more weight than the reasons which underlie them. The question whether a reissue claim can be based wholly on a Patent Office model, is therefore an open one; and it is proper in this place to state the arguments that may be considered, when it is finally decided. Those arguments appear to fall naturally into the following classification.

FIRST: It is an established rule of patent law, that where the court is able to say from a comparison of an original and a reissued patent, what are the inventions described in each, then the question of identity is one of pure construction, and consequently is matter of law for the court, without any auxiliary matter to be passed upon by the jury, if the action be at law.¹ This rule is inconsistent with the idea that a valid reissued claim may be based on a thing shown only in the original model; because the question as to what a model does or does not contain, is a pure question of fact. If reissued claims could be sustained on original models alone, the opinion of the court on the question of sameness of invention would never be conclusive in any case where a model was originally deposited in the Patent Office. In that event, there would still be an auxiliary matter of fact to be passed upon by the jury; no matter how plainly the original and reissued specifications appeared, on their face, to be for different inventions; and no matter how exempt both specifications might be from terms of art calling for expert explanation.

SECOND: The original model is furnished to the Commissioner of Patents;² and becomes the property of the United States. It is not allowed to be taken from the Patent Office except in the custody of some sworn employé, specially authorized by the Commissioner, with the written approval of the Secretary of the Interior.³ No court could compel its production therein, against the will of the authorities of the Pat-

¹ *Heald v. Rice*, 104 U. S. 737, 1881.

² Revised Statutes, Section 4891.

³ Patent Office Rule 59.

ent Office. If Congress had intended that reissue claims should be sustained on models alone, it would therefore have made some provision for proving those models by certified copies. So far from doing so, Congress has always omitted models from the lists of things, belonging to the Patent Office, which according to the statutes are thus provable.¹ Certified copies of models have sometimes been made by the Commissioner, and used in evidence by consent ; but no such copy was ever admitted against the objection of counsel ; or if so admitted, it was admitted without authority of law. If reissue claims could be based on original models, therefore, it would seldom be possible for a defendant to technically prove that such a patent was for a different invention from any shown in such a model. The practical operation of such a rule, would be to make the Commissioner's decision conclusive on the question of sameness of invention, in many cases where an original model was filed, unless the patentee should please, by waiving all objections, to submit that question to the courts. It would often be in the power of one party to an action to take away from the courts a power which undoubtedly belongs to them ; the power to pass upon the validity of reissue patents, as against an objection of want of sameness of invention with the originals.

THIRD : The public has ample opportunity of learning all the contents of drawings and specifications, by means of the copies which are contained in the widely distributed Patent Office Gazette, or of the printed certified copies which are to be found in every State capitol, and in many other places, or of the complete uncertified printed copies which are purchasable from the Commissioner of Patents for about ten cents each. But no person has any reliable means of learning the characteristics of the Patent Office models, except that of going to the Patent Office to inspect them, or sending an agent thither for that purpose. Indeed eighty-seven thousand

¹ Patent Act of 1836, Sec. 4 ; Patent Act of 1837, Sec. 2 ; Patent Act of 1861, Sec. 15 ; Patent Act of 1870,

Sec. 57 ; Revised Statutes, Section 892.

of those original models no longer exist, having been destroyed in the Patent Office fire of 1877. To allow a reissue claim on a model alone, would operate as a surprise upon persons who had no actual notice, and no fair constructive notice, of the contents of that model. It is true that such persons would not be liable to any action for accrued profits or damages, on account of having made used or sold the subject-matter of such a reissue claim before it was granted; but they would be liable to an injunction, restraining them from future making, using or selling of specimens of that thing, though it was not covered by any patent, or otherwise published, till after they had perhaps embarked their capital in machinery for making such specimens, or in such specimens themselves.

FOURTH : To allow reissued claims to be based on models alone, would be to give an extensive opportunity to fraud. Specifications or drawings can never be surreptitiously changed without leaving ample means for certain detection. Thousands of exact copies thereof are made before the letters patent are issued; and before the letters patent reach the patentees, hundreds of those copies are being transported in the mails throughout the United States. Patent Office models, on the contrary, are never duplicated, except in special cases; and it is not practicable for the Commissioner to keep them in such close custody as to insure against fraudulent changes being made in their parts, or in the arrangement of those parts.

FIFTH : On the other side of the question, it can truly be said, that the original model is sometimes more likely to be a perfect representation of the inventor's actual invention, than either the specification or the drawings. The answer to that suggestion is, that such is not always the fact, and that even if it were so, reissues are not granted for everything the inventor actually invented, and intended to patent.¹ They ought to be grantable only for those inventions, of the existence of which the inventor gave the public fair notice when he filed his original application; and fair notice of an inven-

¹ Powder Co. v. Powder Works, 98 U. S. 126, 1878.

tion cannot be given to fifty millions of people, by simply depositing a model in the Patent Office at Washington, where, if it is not destroyed by fire, it is likely to be broken by accident or altered by dishonesty.

§ 239. The last clause of Section 4916, of the Revised Statutes, provides, that “when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake.” The meaning of that clause is not perfectly known; but it is known not to enlarge the power of the Commissioner, in reference to the invention for which a reissue may be granted. That power is still restricted to the same invention that was originally patented.’ That is to say, it is restricted to the same invention which was originally made manifest to the public in the specifications or drawings of the original letters patent.

§ 240. The provision, first enacted in 1870,¹ that “no new matter shall be introduced into the specification” is merely another way of saying that a reissued patent shall be for the same invention as the original.² That provision, therefore, neither enlarged nor restricted the reissuability of letters patent; and, accordingly, it is not new matter, within its meaning, to state a new use of the invention shown in the original;³ nor to explain, in a reissue, the operation of a device which in the original was only described;⁴ nor to vary the description of anything described in the original;⁵ nor to claim anything which was described in the original specification,⁶ or shown in the original drawings.⁷

¹ Powder Co. v. Powder Works, 98 U. S. 138, 1878.

² 16 Statutes at Large, Ch. 230, Section 53, p. 206.

³ Powder Co. v. Powder Works, 98 U. S. 138, 1878.

⁴ Broadnax v. Transit Co. 5 Bann. & Ard. 611, 1880.

⁵ Putnam v. Yerrington, 2 Bann.

& Ard. 243, 1876; Potter v. Stewart, 18 Blatch. 561, 1881.

⁶ O'Reilly v. Morse, 15 Howard, 62, 1853.

⁷ Rubber Co. v. Goodyear, 9 Wallace, 788, 1869; Powder Co. v. Powder Works, 98 U. S. 136, 1878.

⁸ Bantz v. Elsas, 1 Bann. & Ard. 351, 1874; Kerosene Lamp Heater

§ 241. The rule, that whatever was described or shown in an original specification or drawing, may be claimed in a reissue, is qualified by another rule, which provides that if the thing in question was disclaimed in the original, it cannot be claimed in any reissue thereof.¹ Not only express disclaimers, but also disclaimers which are implied by the law, operate to foreclose a reissue for the thing disclaimed. Where, for instance, a specification states that a certain described device is in common use, no reissue claim can lawfully be allowed for that device;² or where a specification described a contrivance which it characterizes as old and faulty, that contrivance cannot be made the subject of a valid reissue claim.³

§ 242. Reissued patents, which were granted on the surrender of former reissues, must be able to endure comparison, on the point of identity of invention, not only with the original letters patent, but also with the surrendered reissues, which preceded them.⁴

§ 243. There is a legal presumption that the necessary identity of invention exists in all reissued patents; and that presumption controls the point, unless the contrary is shown to be true.⁵ That can be done only by introducing the original letters patent in evidence;⁶ and by showing the court, from a comparison of the original specification and drawings, with the description and claims of the reissue, that the former do not embody what is described and claimed in the latter.⁷ If, on comparing a reissue with its original, the former appears on its face to be for a different invention from any described or indicated in the latter, that reissue is void.⁸

§ 244. To omit from a reissue, anything which the original

Co. v. Littell, 3 Bann. & Ard. 312, 1878; Atwood v. Portland Co. 10 Fed. Rep. 286, 1880.

¹ Leggett v. Avery, 101 U. S. 256, 1879.

² Edgerton v. Mfg. Co. 9 Fed. Rep. 451, 1881.

³ Streit v. Lauter, 11 Fed. Rep. 309, 1882.

⁴ Knight v. Railroad Co. Taney's

Circuit Court Decisions, 106, 1840.

⁵ O'Reilly v. Morse, 15 Howard, 62, 1853; Klein v. Russell, 19 Wallace, 433, 1873.

⁶ Seymour v. Osborne, 11 Wallace, 516, 1870.

⁷ Smith v. Dental Vulcanite Co. 93 U. S. 499, 1876.

⁸ Ball v. Langles, 102 U. S. 130, 1880.

specification stated to be essential to the invention, is fatal to identity of invention.¹ Indeed, it has been held in one case that the omission of one bolt from a reissue patent for a reaper and mower, was enough to negative identity with the original, because with the bolt, the machine was a reaper only, and not a mower.² A process consisting of one stage, is not the same invention as a process consisting of that stage and one or more others.³ Where, however, an original patent described and claimed several different inventions, one or more of those inventions may be omitted from the claims of a reissue of that patent.⁴ It is necessary to the requisite identity of invention, that the reissue should claim no invention not described or shown in the original; but it is not necessary to that identity, that the original should describe or claim no invention not described or shown in the reissue.

§ 245. A sub-combination may be claimed in a reissue, if it was shown in the original as performing the same function; even though it was claimed in the original only as a part of a larger combination.⁵ But a sub-combination cannot be legally claimed in a reissue, if it is there shown to perform a substantially different function from any which it could perform in its original environment.⁶ In the former case the invention, consisting of the sub-combination, existed in the original specification. In the latter case, the sub-combination may have existed in the original, but it did not compose, in that place, the same invention which it constitutes in the reissue.

¹ Gill v. Wells, 22 Wallace, 1, 1874; Russell v. Dodge, 93 U. S. 460, 1876; Atwood v. Portland Co. 10 Fed. Rep. 286, 1880.

² Kirby v. Mfg. Co. 10 Blatch. 307, 1872.

³ Wood-Paper Patent, 23 Wallace, 599, 1874.

⁴ Rubber Co. v. Goodyear, 9 Wallace, 788, 1869.

⁵ Battin v. Taggert, 17 Howard, 74, 1854; Corn-Planter Patent, 23

Wallace, 181, 1874; Jordan v. Dobson, 4 Fisher, 232, 1870; Pearl v. Ocean Mills, 2 Bann. & Ard. 469, 1877; Herring v. Nelson, 3 Bann. & Ard. 55, 1877; Kerosene Lamp Heater Co. v. Littell, 3 Bann. & Ard. 312, 1878; Turrell v. Spaeth, 3 Bann. & Ard. 461, 1878.

⁶ Gill v. Wells, 22 Wallace, 24, 1874; Johnson v. Railroad Co. 105 U. S. 539, 1881.

§ 246. A single device may also be made the subject of a separate claim in a reissue, though in the original it was claimed only in combination with other devices ; provided that device was a new and useful invention of the patentee, and might have been separately claimed by him in the original patent.¹

§ 247. Whether a patentee, in effecting a reissue, may strike out from the original specification, the description of one of the ingredients of the patented combination, and may insert, as a substitute therefor, in the new specification, the description of an equivalent for the omitted ingredient, is an unsettled question. That he may do so, has been denied by Justice CLIFFORD in an *obiter dictum*,² but in point of principle the question seems to call for an affirmative answer ; because two combinations are identical in the eye of the patent law, not only where they contain the same number and the same arrangement of the same parts, but also where one of those combinations omits some of the parts of the other, and substitutes equivalents for the parts omitted.³

§ 248. Reissue patents are not to be held void for want of identity with the originals, where a liberal construction of the two documents can avoid that result.⁴ Courts are accordingly inclined, where claims apparently too broad are inserted in reissue patents, to narrow those claims by construction, in order to make them conform to the inventions shown in the original patents.⁵ This inclination is not sufficient, however, to be relied upon, in a case where a patent was surrendered and reissued solely to broaden its claim, and where the broadened claim is clearly void for want of novelty, as well as for want of identity with the original invention.⁶

§ 249. Where some, but not all, of the claims of a reissue

¹ Gallahue v. Butterfield, 10 Blatch. 237, 1872.

² Gill v. Wells, 22 Wallace, 30, 1874.

³ Seymour v. Osborne, 11 Wallace, 516, 1870 ; Gould v. Rees, 15 Wallace, 187, 1872.

⁴ Milligan & Higgins Glue Co. v. Upton, 1 Bann. & Ard. 505, 1874.

⁵ Mfg. Co. v. Ladd, 102 U. S. 412, 1880 ; Brainard v. Cramme, 12 Fed. Rep. 624, 1882.

⁶ Wisner v. Grant, 7 Fed. Rep. 922, 1880.

patent are void, because they are obnoxious to the doctrine of *Miller v. Brass Co.*, or because they are not for the same invention as the original ; that fact does not vitiate the other claims of that patent. The reissue will, in either of those cases, have whatever validity it would have had if it had not contained the invalid claims.¹

§ 250. Executors, administrators or assigns have the same right to surrender and reissue a patent, that the patentee himself has ;² except that in the case of assigns of patents which were assigned by the patentee after July 8, 1870, the application must be made, and the new specification be signed, by the inventor himself if living.³ The exemption from this law, of all patents granted and assigned before July 8, 1870, is not to be found in the Patent Act of that date. It was first enacted March 3, 1871 ;⁴ but it expressly applied, by retroactive operation, to all reissues of the kind, that were granted between July 8, 1870, and March 3, 1871. Of course, it applies by prospective operation, to all reissues of the kind granted since the latter date. In cases where the patent was granted and assigned by the patentee, before July 8, 1870, the inventor need take no part in the application for a reissue, even though the applicant received his assignment from an intermediate owner after that day.⁵ It however always was, and still is, proper for the patentee to make the application for a reissue, instead of his assignees doing so ; provided it be done with the knowledge and consent of the latter, or provided the latter ratifies the application, after it is made.⁶ The title to the reissued patent will, in such a case, vest at once in the assignee, by operation of the assignment of the original patent, and without the execution of any new document.⁷

¹ *Gage v. Herring*, 107 U. S. 640, 1882 ; *Gould v. Spicer*, 15 Fed. Rep. 344, 1882 ; *Cote v. Moffitt*, 15 Fed. Rep. 345, 1882 ; *Schillinger v. Brewing Co.*, 24 Off. Gaz. 495, 1883.

² Revised Statutes, Section 4916.

³ Revised Statutes, Section 4895.

⁴ 16 Statutes at Large, Ch. 132, p.

583.

⁵ *Selden v. Gas-Burner Co.* 9 Fed. Rep. 390, 1881.

⁶ *Dental Vulcanite Co. v. Wetherbee*, 2 Clif. 563, 1866 ; *Wing v. Warren*, 5 Fisher, 548, 1872.

⁷ *Woodworth v. Hall*, 1 Woodbury and Minot, 248, 389, 1846 ; *Mc-*

§ 251. Where several executors are appointed in a will but only one of them receives letters testamentary, a patent of the testator may be lawfully reissued to that executor, and the legal title to the reissued patent will thereupon vest exclusively in him.¹ A grant of a reissue to a person as administrator, is conclusive evidence in an infringement suit that the person was in fact administrator;² and the same rule doubtless applies as well to executors. A reissue to a person in trust for the heirs at law of the patentee, will confer the legal title to the reissue upon that person, and the equitable title upon the persons beneficially interested, whoever they may be.³

§ 252. An assignee of a patent is a person to whom the entire legal interest, or an undivided part of the entire legal interest, in a patent, has been duly assigned by an instrument in writing. A grantee differs from an assignee, in that the rights conveyed to him, are confined to a part, or to parts of the territory of the United States. A licensee is one who receives either an exclusive or a concurrent right to make or to use or to sell the thing covered by the patent.⁴ A reissue may be granted to an assignee of the executor or administrator of the patentee;⁵ or to an assignee of an assignee;⁶ or indeed to an assignee of any degree, however far removed from the original patentee by mesne assignments;⁷ and if the reissued patent recites those assignments it becomes at least *prima facie* evidence thereof, in an infringement suit.⁸ If a patent is owned jointly by two or more patentees, or by two or more assignees, or by one or more patentees and one or

Burney v. Goodyear, 11 Cushing (Mass.), 569, 1853.

¹ Rubber Co. v. Goodyear, 9 Wallace, 788, 1869.

² Woodworth v. Hall, 1 Woodbury & Minot, 248, 389, 1846; Goodyear v. Hullihen, 3 Fisher, 251, 1867.

³ Woodworth v. Stone, 3 Story, 752, 1845; Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co. 1 Bann. & Ard. 177, 1874.

⁴ Sections 274, 287, and 296 of this book.

⁵ Carew v. Fabric Co. 1 Holmes, 45, 1871.

⁶ Swift v. Whisen, 2 Bond, 115, 1867.

⁷ Selden v. Gas-Burner Co. 9 Fed. Rep. 390, 1881.

⁸ Middletown Tool Co. v. Judd, 3 Fisher, 141, 1867; Hoffheins v. Brandt, 3 Fisher, 218, 1867.

more assignees, all the owners must join in a reissue, or must ratify it, or it will be void ; but neither grantees nor licensees are required to do either.¹ The right of a patentee or assignee to receive a reissue is not affected by his having made grants, or issued licenses under his patent ;² but where a patentee grants away his rights in a part of the territory of the United States, and afterward conveys the residue to another vendee, it is doubtful whether that vendee is entitled to apply for a reissue.³

§ 253. Grantees may continue to hold their rights under an original patent after it is surrendered and reissued by the patentee or assignee ; or they may take corresponding rights under the reissued patent. They have their choice between the two.⁴ It follows from this rule, that in theory at least, a given invention may be the subject of letters patent in one part of the United States, at the same time that it is free to the public in other parts of the country. If this were a practical result, it would be highly unjust, because it would operate to prohibit given manufactures in one State, while in another State the same pursuits would be free to all. In fact however, patentees or assignees seldom surrender any claims which it is worth while for any interested person to retain ; and, on the other hand, grantees are generally ready to ratify and adopt broadened reissues. It may hereafter happen, that in order to retain his rights of action for accrued damages or profits, or in order to avoid the risk of exchanging a valid original patent for a reissue patent of uncertain validity, now and then a grantee will elect to continue to hold under the original, while the patentee holds under a reissue patent. If such cases become numerous and important they will probably lead to a change of the statute. The remedy would be to prohibit reissues of original patents relevant to which any as-

¹ *Potter v. Holland*, 4 Blatch. 206, 1858 ; *Forbes v. Stove Co.* 2 Clif. 379, 1864 ; *Meyer v. Bailey*, 2 Bann. & Ard. 73, 1875.

² *Smith v. Mercer*, 3 Penn. L. J. Reports, 529, 1846.

³ *Commissioner of Patents v. Whiteley*, 4 Wallace, 522, 1866.

⁴ *Washburn v. Gould*, 3 Story, 122, 1844 ; *Woodworth v. Stone*, 3 Story, 749, 1845 ; *Potter v. Holland*, 4 Blatch. 206, 1858.

signment or grant shall have been made, or to enact that in such cases, all the assignees and grantees shall join in the surrender.

§ 254. The legal effect of a valid reissue patent has always been the same, under the different statutes, which have from time to time been in force. The phraseology of the Act of 1832 in this respect was as follows. "Such new patent, so granted, shall, in all respects, be liable to the same matters of objection and defence as any original patent. But no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be a free public use thereof, shall, in any manner, prejudice his right of recovery for any use or violation of his invention after the grant of such new patent as aforesaid."¹ The language of the Act of 1836 on this point was as follows: "The patent, so reissued, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all actions hereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form."²

It follows from these provisions, that reissued patents cannot be affected, in point of novelty, by anything done after the date of the original application. Novelty still dates from the original invention.³ Nor will any invention produced after that time, be taken into account as showing the state of the art, and therefore as being relevant to the question of construction of the reissued patents.⁴ On the other hand, when reissued patents are introduced in evidence to negative the novelty or limit the scope of other patents, they operate as of their own date, and not as of the date of the originals.⁵

It follows also from the foregoing statutory provisions, that persons who use or sell, after the date of a reissued patent,

¹ 4 Statutes at Large, Ch. 162, Section 3, p. 559.

² 5 Statutes at Large, Ch. 357, Section 13, p. 122.

³ *Grant v Raymond*, 6 Peters, 218,

1832.

⁴ *Carroll v. Morse*, 9 Off. Gaz. 453, 1876.

⁵ *United States Stamping Co. v. King*, 17 Blatch. 64, 1879.

specimens of the thing covered by it, are liable as infringers ; even though those persons made, or bought, or used those specimens before that date, and when, on account of the omission to cover them by the original patent, they had a legal right to appropriate the invention.¹

¹ *Stimpson v. Railroad Co.* 4 Howard, 380, 1846 ; *Agawam Co. v. Jordan*, 7 Wallace, 609, 1868 ; *Carr v.*

Rice, 1 Fisher, 211, 1856 ; *Bliss v. Brooklyn*, 8 Blatch. 534, 1871.

CHAPTER X.

EXTENSIONS.

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| <p>255. Constitutional foundation of extensions.</p> <p>256. Congressional extensions.</p> <p>257. Mode of Congressional extension.</p> <p>258. Effect of Congressional extensions.</p> <p>259. Patent Office extensions.</p> <p>260. Statutory foundation of Patent Office extensions.</p> <p>261. Who might apply for Patent Office extensions.</p> <p>262. Points of time whereon Patent Office extensions were grantable.</p> <p>263. Patent Office extension might be granted to an inventor-patentee, even if he had parted with all interest in the first term of his patent.</p> | <p>264. Patent Office extensions grantable only where inventors would possess, or at least participate in, the benefit thereof.</p> <p>265. Patent Office extension, how effectuated.</p> <p>266. Force of the Commissioner's decision in extension cases.</p> <p>267. Facts which justify extensions.</p> <p>268. Proceedings preliminary to extensions.</p> <p>269. Remedy for fraud in procuring or in granting extensions.</p> <p>270. "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."</p> <p>271. Adjudged meaning of the statute quoted in the last section.</p> |
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§ 255. THE constitutional provision relevant to the duration of patent rights, is that such rights, when granted, shall be granted for limited times.¹ The Patent Act of 1790² provided, that under the circumstances and conditions prescribed therein, the Secretary of State, or the Secretary of War, or the Attorney-General, or any two of them, might issue letters patent for an invention, for any term not exceeding fourteen years. The same provision was made in the Patent Act of 1793.³ Under that law, patents were generally, if not uni-

¹ Constitution of the United States, Article I., Section 8.

² 1 Statutes at Large, Ch. 7, Sec-

tion 1, p. 109.

³ 1 Statutes at Large, Ch. 11, Section 1, p. 321.

versally, granted for the full fourteen years ; but whether so granted or not, there was, prior to 1832, no mention in the statutes of any way in which any patent, once granted, could be extended, and its duration thus prolonged. In July of the last-mentioned year, it was enacted : “ That application to Congress to prolong or renew the term of a patent, shall be made before its expiration.”¹ The same section also provided a method of proceeding, to be followed by applicants in such cases. The entire section was, however, merely a self-imposed limitation on a constitutional power of Congress : the power to promote the progress of science and useful arts, by securing for limited times, to inventors the exclusive right to their respective inventions. Inasmuch as Congress could disregard that limitation in any particular case, the section was not one of great importance, even while it remained on the statute book ; and it was repealed by the Patent Act of July 4, 1836.² Since that date, the extending of patents by Congress, has been regulated by no other law than the Constitution.

§ 256. Patents may be extended by Congress at any time, either before or after their expiration.³ This power was exercised as early as 1808.⁴ In one later case such an extension was granted nearly three years before the then existing exclusive right was to expire ;⁵ and in another, more than twenty-one years intervened between the expiration of the original term of the patent, and the granting of the extension.⁶ Congressional extensions, when granted, are usually granted for the term of seven years ; but they may lawfully be granted for any limited length of time, whether longer or shorter than that.

§ 257. Some special acts, for the extension of patents,

¹ 4 Statutes at Large, Ch. 162, Section 2, p. 559.

² 5 Statutes at Large, Ch. 357, Section 21, p. 125.

³ *Bloomer v. Stolley*, 5 McLean, 161, 1850 ; *Jordan v. Dobson*, 2 Abbott, 407, 1870.

⁴ *Evans v. Jordan*, 9 Cranch, 199, 1815.

⁵ *Bloomer v. McQuewan*, 14 Howard, 539, 1852.

⁶ *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868.

merely extend their duration by a simple legislative edict, and do no more.¹ Others instruct the Commissioner of Patents to ascertain the truth relevant to sundry questions of fact mentioned therein; and authorize him to decide whether in view of those facts, and of sundry considerations of justice and of public policy, the patent ought to be extended; and direct him to extend it, if his decision is in the affirmative.² When patents are extended in this latter method, those provisions of the special act which limit the operation of the extension, need not to be recited in the certificate of extension which the Commissioner indorses upon the patent or otherwise puts forth. The law reads the certificate in the light of that statute, without any such recital.³

§ 258. Special Acts of Congress granting or authorizing extensions of patents, come within the general rule, that the validity of a statute cannot be questioned in courts, on any allegation that its passage was procured by fraud or bribery.⁴ Such Acts are considered as engrafted on the general patent laws, and are to be construed in connection with them.⁵ Although the Constitution authorizes Congress to grant exclusive rights in inventions only to inventors, Congress may provide, when exercising its power in particular cases, that assignees of the inventors shall have the same rights under the extended term, that they had under the original term of the patent extended.⁶

§ 259. Patent Office extensions of patents, were first authorized by the Patent Act of July 4, 1836.⁷ By the Patent Act of March 3, 1861, they were prohibited, as to all patents thereafter granted.⁸ The last extension of the kind, was

¹ *Bloomer v. McQuewan*, 14 Howard, 539, 1852; *Woodworth v. Edwards*, 3 Woodbury and Minot, 123, 1847.

² *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868.

³ *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868.

⁴ *Gibson v. Gifford*, 1 Blatch. 529, 1850.

⁵ *Bloomer v. McQuewan*, 14 Howard, 1852; *Jordan v. Dobson*, 2 Abbott, 408, 1870.

⁶ *Blanchard's Gun-Stock Turning Factory v. Warner*, 1 Blatch. 259, 1848.

⁷ 5 Statutes at Large, Ch. 357, Section 18, p. 124.

⁸ 12 Statutes at Large, Ch. 88, Section 16, p. 249.

granted in 1875, and expired in 1882. It is improbable that any general law, authorizing such extensions, will ever again be enacted in the United States. Inasmuch, however, as actions are still liable to be brought for past infringements of many of those formerly in force, and also because part of the rules and doctrines of law established in suits for infringements of Patent Office extensions, are equally applicable to suits based on Congressional extensions, it is expedient to explain those rules and doctrines in this book.

§ 260. The Patent Act of 1836 provided,¹ that whenever any patentee of an invention should desire an extension of his patent, he might make application therefor in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof; and that the Commissioner should thereupon, and on the payment of a specified fee, cause to be published a notice of the application, and of the time and place when and where the same would be considered. The Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury, were constituted a board to hear and decide upon the evidence produced before them both for and against the extension. If, upon such hearing in any particular case, it appeared to the board, having a due regard to the public interest, that it was just and proper that the term of the patent should be extended, by reason of the patentee without neglect or fault on his part, having failed to obtain from the use and sale of his invention, a reasonable remuneration for the time, ingenuity and expense bestowed upon the same, and upon its introduction into public use; the statute made it the duty of the Commissioner to extend the patent, by making a certificate thereon of such extension, for the term of seven years from and after the expiration of the first term. The statute also provided that no such extension should be granted after the expiration of the term for which it was originally issued; and that when so extended a patent should have the same effect in law as though it had been originally granted for the term of twenty-one years; and that the benefit of such re-

¹ 5 Statutes at Large, Ch. 357, Section 18, p. 124.

newal should extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein.

The Patent Act of 1848¹ amended the above provisions by vesting the power of the board, in the Commissioner of Patents alone; and by directing him to take into consideration the original patentability and novelty of the inventions covered by patents sought to be extended, as well as to be governed by the rules and principles that had theretofore governed the board.

No other change was ever made in the statute relevant to the subject, until in 1861 it was repealed as to future patents. As to patents granted before March 2, 1861, it was re-enacted in the Patent Act of 1870,² and again re-enacted in the Revised Statutes.³ In both these re-enactments, one provision is found, which did not exist in the former law, namely the provision that the application should be filed not more than six months nor less than ninety days before the expiration of the original term of the patent.

§ 261. The statutes relevant to extensions have all mentioned "patentees" as being persons entitled to apply for extensions, and have mentioned no others. When the first of those statutes was enacted in 1836, nobody but an inventor or his executor or administrator, could be a patentee. In 1837, however, Congress enacted, that any patent thereafter issued, might be made and issued to the assignee or assignees of the inventor.⁴ In all subsequent cases, where that course was pursued, the inventors and the patentees were not the same persons; but no corresponding change was ever made in the statute relevant to extensions. The question has therefore arisen, whether, in such cases, it was the inventor who had a right to apply for an extension, or whether the patentee was the person who had that right, or whether both the inventor and the patentee must have joined in such an application.

¹ 9 Statutes at Large, Ch. 47, Section 1, p. 231.

² 16 Statutes at Large, Ch. 230, Section 63 to 67, p. 208.

³ Revised Statutes, Sections 4924 to 4928.

⁴ 5 Statutes at Large, Ch. 45, Section 6, p. 193.

Where the inventor would have an equitable interest in the extension if granted, it was proper for him to apply for that extension alone.¹ When granted, the legal title to such an extension, would vest in the patentee, because such an extension was in the nature of an amendment of his patent; but the equitable title might vest wholly in the inventor, or vest partly in the inventor and partly in the patentee, or vest partly in the inventor and partly in third persons, according to the equitable facts of each case. When the inventor would have no equitable interest in the extension if granted, no extension could be obtained, either on his application, or on that of the patentee, or on that of both together; because it was not the intention or scope of the statute to grant extensions of patents for the sole benefit of others than the inventors of the things secured thereby.²

Whether the executor or administrator of an inventor-patentee, had a right to apply for an extension, was the first of the ten questions which were submitted to the Supreme Court in the celebrated case of *Wilson v. Rousseau*. That question was argued in the affirmative by Webster, Seward and Latrobe, and decided in the affirmative by the court.³

Where a joint patent was taken out by joint inventors, all had to join in an application for an extension of that patent, if all were a living; and if any were dead, the legal representatives of the deceased had to unite in such an application.⁴

§ 262. No Patent Office extension was ever grantable after the expiration of the original term.⁵ Such extensions could be granted at any time before the midnight at the end of the last day of that term; because fourteen-year patents did not expire till the last hour of the fourteenth anniversary of the day of their respective dates.⁶ Patents limited in law to the

¹ *Sayles v. Dubuque and Sioux City Railroad Co.* 3 Bann. & Ard. 220, 1878.

² *Wilson v. Turner*, Taney's Circuit Court Decisions, 292, 1845.

³ *Wilson v. Rousseau*, 4 Howard, 673, 1846.

⁴ *Wickersham's Case*, 4 Off. Gaz. 155, 1873.

⁵ Act of 1836, Section 18; Act of 1870, Section 63; Revised Statutes, Section 4924.

⁶ *Johnson v. McCullough*, 4 Fisher, 170, 1870.

term of fourteen years from the date of earlier foreign patents, were extendible, at the discretion of the Commissioner of Patents, as well as those not so limited ;¹ but in such a case the extension had to be granted before the expiration of the foreign patent, even though the extended patent purported on its face to run for some time longer.²

§ 263. Whether an inventor-patentee needed to possess any interest in the first term of his patent at the time of applying for an extension thereof, was the fifth question submitted to the Supreme Court in the case of *Wilson v. Rousseau*.³ That question was decided in the negative. Even where the assignee of the first term of a patent surrendered and reissued it ; the inventor-patentee had a right to ignore the reissue, and to apply for, and receive an extension of the original patent.⁴

§ 264. It was against the policy of the law, if not against its letter, to extend any patent, in the extension of which, if granted, the inventor would have no property right. The right to an extension was given by the law, chiefly with a view to the advantage of the inventor, and not of his assignee or grantee.⁵ It never was necessary, however, that the inventor should be in a condition to receive the legal title to the extension, or even that the entire equitable estate in it, should belong to him. An interest in the proceeds of the exclusive right during the extended term, was enough to satisfy the policy of the law in this respect.⁶ Even where the original patent was granted to an assignee, and where the extension was, therefore, in point of legal title, a prolongation of his patent ; the extension was held to be valid, because the inventors had interests in its proceeds.⁷ Moreover, inventors are presumed in law to have had a sufficient interest to support extensions act-

¹ *Tilghman v. Mitchell*, 9 Blatch. 27, 1871.

² *New American File Co. v. Nicholson File Co.* 8 Fed. Rep. 816, 1881.

³ *Wilson v. Rousseau*, 4 Howard, 673, 1846.

⁴ *Potter v. Braunsdorf*, 7 Blatch. 97, 1869 ; *Crompton v. Belknap*

Mills, 3 Fisher, 536, 1869.

⁵ *Wilson v. Turner*, Taney's Circuit Court Decisions, 292, 1845.

⁶ *Gear v. Grosvenor*, 1 Holmes, 215, 1873.

⁷ *Sayles v. Dubuque and Sioux City Railroad Co.* 3 Bann. & Ard. 220, 1878.

usually granted, unless the contrary is proven to have been the fact.¹

§ 265. The certificate of extension which was provided for by the statute,² was generally indorsed on the original parchment letters patent; but where the original document was lost or was out of the control of the person applying for the extension, that certificate was indorsed upon a certified copy of the letters patent and was equally valid.³

§ 266. Jurisdiction to extend a particular patent, was acquired by the Commissioner, under the statutes in force prior to July 8, 1870, whenever the proper person filed an application for such an extension, and paid the requisite fee;⁴ provided the application was filed, and the fee paid, long enough before the expiration of the original term of the patent, to enable the Commissioner to investigate the matter in the way prescribed by statute.⁵ After July 8, 1870, the law remained the same on this point, except that under the statute of that date, and under the Revised Statutes, the application had to be filed not more than six months, nor less than ninety days before the first term of the patent would expire.⁶ The jurisdiction always depended, therefore, upon the application being filed and the fee paid by the proper person at the proper time. The decision of the Commissioner, relevant to the existence of his jurisdiction, was never conclusive in any case.⁷ The validity of a Patent Office extension, is therefore open to inquiry in an infringement suit; when it is questioned on the theory that the person who applied for it, was not such a person as had the legal right to do so. In deciding that question, however, the courts regard with respect the practical construction of the statute, which was necessarily involved in the grant-

¹ *Ruggles v. Eddy*, 10 Blatch. 56, 1872.

² Patent Act of 1836, Section 18.

³ *Potter v. Braunsdorf*, 7 Blatch. 108, 1869.

⁴ *Gear v. Grosvenor*, 1 Holmes, 218, 1873.

⁵ *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868.

⁶ 16 Statutes at Large, Ch. 230, Section 63, p. 208, Revised Statutes, Section 4924.

⁷ *Wilson v. Rousseau*, 4 Howard, 687, 1846.

ing of the extension.¹ Indeed the Supreme Court has held that the practical construction given to a statute, by the executive branch of the government charged with its execution, is entitled to great weight, when the true meaning of that statute is drawn into judicial inquiry.²

§ 267. The meritorious facts which entitled an inventor-patentee to a Patent Office extension were, that without fault or neglect on his part, he had failed to obtain from the use and sale of his invention, a reasonable remuneration for the time, ingenuity and expense bestowed upon it, and upon its introduction into public use.³ Unlike the foundation facts which entitle a patentee to a reissue, these points are not required by the statute to exist absolutely. The statutory provision is that they shall appear to the satisfaction of the Commissioner of Patents. It is therefore immaterial whether the courts are satisfied of their existence or not. The fact that a particular extension was granted, shows that the Commissioner was satisfied of the existence of those facts in that case; and evidence that they did not in fact exist, is therefore inadmissible in a suit for infringement of the patent during that extension.⁴

§ 268. The statute made it the duty of the Commissioner to advertise all applications for extensions, and to refer such cases to the principal examiner having in charge the class of inventions to which the patent sought to be extended belonged, and having received the report of the examiner, to hear and decide each particular case at the time and place designated in the advertisement. All these provisions were directory, and none of them were jurisdictional. The validity of no extension could therefore be affected by proof, in an infringement suit, that some or all of those acts were omitted by the Commissioner, or were irregularly performed.⁵

¹ *Brooks v. Bicknell*, 3 McLean, 250, 1843.

² *Grant v. Raymond*, 6 Peters, 244, 1832.

³ Patent Act of 1836, Section 18; Patent Act of 1870, Section 66; Revised Statutes, Section 4927.

⁴ *Clum v. Brewer*, 2 Curtis, 506, 1855; *Jordan v. Dobson*, 2 Abbott, 408, 1870.

⁵ *Brooks v. Jenkins*, 3 McLean, 435, 1844; *Colt v. Young*, 2 Blatch. 473, 1852; *Tilghman v. Mitchell*, 9 Blatch. 27, 1871.

§ 269. No fraud, practised upon or by the Commissioner, relevant to securing or granting an extension, can ever become the subject of inquiry in any suit for infringement. The decision of the Commissioner, in granting an extension, does not, however, foreclose all inquiry into allegations of fraud; as it does into allegations of inadvertence, error, or ministerial irregularity. The law is not so absurd as to make a man's own decision that he has committed no fraud, and suffered none to be committed upon him, a conclusive adjudication of that point. But charges so grave deserve a special proceeding for their investigation. They are not to be bandied about as collateral makeweights in infringement suits. When investigated, they must be investigated in a special proceeding brought to repeal the grant of the extension.¹

§ 270. "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."² This enactment, in almost precisely the same words, has always found a place in statutes relevant to extensions of patents.³ The meaning of this law was never learned from its perusal. It is one of the cases in which persons who could neither think nor write with precision or with clearness, were put to penning statutes for a nation. It is an instance in which Congress made a law for millions, without having any accurate idea of the nature of the law it was making. The duty of ascribing a definite meaning to the enactment devolved, therefore, upon the courts. But the clause was so ambiguous that the judges could not agree in regard to it. A provision which should have been put beyond question by a competent and faithful Congress, when it was enacted in 1836, was still a subject of controversy in the Supreme Court more than thirty-seven years later. Now that forty-seven years have passed since its enactment, the text writer can collate the

¹ *Rubber Co. v. Goodyear*, 9 Wallace, 796, 1869; *Mowry v. Whitney*, 14 Wallace, 434, 1871.

² Revised Statutes, Section 4928.

³ Patent Act of 1836, Section 18; Patent Act of 1870, Section 67.

adjudicated cases, and can deduce and state the adjudicated meaning of the clause. That meaning is as follows.

§ 271. Every person who, at the beginning of any extended term of any patent, has a right to use a particular specimen of any thing covered by that patent, has the same right to use that specimen during that extended term, unless his right was expressly limited so as not to include that term; and if such a person is the owner of such a specimen, he may sell it to be used by others during that extension.¹

The limitations expressed in this rule are not to be overlooked. 1. It applies only to persons whose right to use existed at the time of the extension. It has therefore been the practice of some patentees to avoid the rule altogether, by making their licenses expire a day or more before the end of the existing terms of their respective patents. 2. The rule confers no right upon any person on account of his having had a right to make or to sell specimens of the patented thing. 3. The rule does not apply to any patent for a process.² 4. The rule confers no right under an extension, that did not exist under the former term. Accordingly, if the former right was subject to a royalty, the right under the extension will be subject to the same royalty.³ 5. The rule confers no right to make or use or sell any new specimen of the patented thing; though it does confer a right to repair the articles to which it applies.⁴ 6. The rule does not apply where the right to use, when granted by the patentee, was expressly limited to the

¹ *Wilson v. Rousseau*, 4 Howard, 677, 1846; *Bloomer v. McQuewan*, 14 Howard, 539, 1852; *Chaffee v. Belting Co.* 22 Howard, 217, 1859; *Bloomer v. Millinger*, 1 Wallace, 340, 1863; *Mitchell v. Hawley*, 16 Wallace, 544, 1872; *Eunson v. Dodge*, 18 Wallace, 414, 1873; *Paper-Bag Cases*, 105 U. S. 766, 1881; *Woodworth v. Curtis*, 2 Woodbury and Minot, 524, 1847; *Goodyear v. Rubber Co.* 1 Clif. 349, 1859; *Wooster v. Sidenberg*, 13 Blatch. 88, 1875;

Black v. Hubbard, 3 Bann. & Ard. 40, 1877.

² *Wetherill v. Zinc Co.* 6 Fisher, 50, 1872.

³ *Union Mfg. Co. v. Lounsbury*, 41 New York, 363, 1869.

⁴ *Hodge v. Railroad Co.* 6 Blatch. 165, 1868; *Wood v. Railroad Co.* 2 Bissell, 62, 1868.

⁵ *Wilson v. Simpson*, 9 Howard, 109, 1850; *Aiken v. Print Works*, 2 Clif. 435, 1865; *Farrington v. Detroit*, 4 Fisher, 216, 1870.

existing term of the patent.¹ The right provided by the rule of this section is a property right; and the specimens to which it refers, and the right to use those specimens, may therefore be transferred by sale, devise, levy of execution, or assignment in insolvency.²

¹ *Mitchell v. Hawley*, 16 Wallace, 544, 1872.

² *Woodworth v. Curtis*, 2 Woodbury and Minot, 524, 1847.

CHAPTER XI.

TITLE.

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| 272. The nature of titles, and the methods of their acquisition. | 284. Express warranties of validity. |
| 273. Title by occupancy. | 285. Equitable titles ; how created. |
| 274. Title by assignment. | 286. Equitable titles ; how treated. |
| 275. Characteristics, authentication, and effect of assignments. | 287. Title by grant. |
| 276. Dormant assignments. | 288. Extra-territorial rights conveyed by grants. |
| 277. Assignments of rights of action for past infringements. | 289. Title by creditor's bill. |
| 278. Construction of assignments. | 290. Title by bankruptcy. |
| 279. Reformation of assignments. | 291. Title by death. |
| 280. Assignments of extensions. | 292. Tenancy in common. Joint-tenancy. |
| 281. Recording and notice. | 293. Joint-tenancy ; how severed. |
| 282. Warranty of title. | 294. Rights of tenants in common as against each other. |
| 283. No implied warranty of validity. | 295. Partition. |

§ 272. TITLES to patent rights are capable of two independent classifications. One relates to the nature of title ; and the other relates to the methods by which title may be acquired. In the first of these aspects, titles are divisible into those which are purely legal, those which are purely equitable, and those which are both legal and equitable. In the second aspect, they are divisible into these : 1. By occupancy. 2. By assignment. 3. By grant. 4. By creditor's bill. 5. By bankruptcy. 6. By death. Titles which are both legal and equitable may be acquired in either of these methods. Titles which are purely equitable may be acquired by either, except the first ; and those which are purely legal may be transferred by either, except the first, fourth and fifth. It is the plan of this chapter, to treat the subject of title under this sixfold division ; and, in general, to treat it with a view to title which is both legal and equitable, and is therefore com-

plete ; but also, to incorporate into that treatment, such statements as may show the relations which purely legal and purely equitable titles bear to each other, and to the law ; and to conclude the whole with a discussion of such points as relate to patent rights owned contemporaneously by a plurality of persons.

§ 273. Title by occupancy is that title to a patent, which a person may acquire by inventing any new and useful process, machine, manufacture, or composition of matter. During the space of time between the day of invention and the date of letters patent therefor, that title is inchoate, but is nevertheless recognized by both law and equity.¹ Such an inchoate right may be assigned ; and an assignment thereof will convey the legal title to the letters patent, as soon as the letters patent are granted.² This rule applies not only to cases where the assignments are recorded before the granting of the patents, but also to cases where, though executed before, they are not recorded till after that event.³ So also it applies to cases where the assignments are executed after applications for patents are rejected, and before those rejections are reversed.⁴ The inchoate right to a Patent Office extension of a patent, when such a right was provided by law,⁵ was also a proper subject of assignment, even while it remained inchoate ;⁶ and such an assignment also operated to convey the legal title to such an extension, whenever such an extension was granted by the Commissioner of Patents.⁷

The title by occupancy, which an inventor acquires when he invents, is not affected by the fact that he is at the time in the employ of another ;⁸ for persons employed, as much as

¹ *Gayler v. Wilder*, 10 Howard, 493, 1850 ; *Hendrie v. Sayles*, 98 U. S. 551, 1878.

² *Gayler v. Wilder*, 10 Howard, 493, 1850.

³ *United States Stamping Co. v. Jewett*, 7 Fed. Rep. 869, 1880.

⁴ *Gay v. Cornell*, 1 Blatch. 510, 1849.

⁵ From July 4, 1836, to March 2, 1861.

⁶ *Nicholson Pavement Co. v. Jenkins*, 14 Wallace, 456, 1871.

⁷ *Railroad Co. v. Trimble*, 10 Wallace, 380, 1870.

⁸ *Whiting v. Graves*, 3 Bann. & Ard. 222, 1878 ; *Hapgood v. Hewitt*, 11 Fed. Rep. 422, 1882.

employers, are entitled to their own independent inventions.¹ The original title of a patentee to a patent issued to him, is presumed to continue till he is shown to have parted with it;² and the grantee named in a reissue patent is presumed to be the lawful owner of that patent, until he is shown not to have owned the patent which he surrendered in order to obtain that reissue, or is shown to have parted with the title to the reissue after that date.³

§ 274. An assignment of a patent is an instrument in writing, which, in the eye of the law, purports to convey the entire title to that patent, or to convey an undivided share in that entire title.⁴ Such assignments usually purport to convey the entire right secured by the patent; and therefore they cover the exclusive right to make, to use, and to sell the patented invention throughout the United States. It has, however, been held that an assignment which purports on its face to convey the exclusive right to make and sell the invention covered by the patent is a full assignment of that patent, because an expressed exclusive right to make and sell, carries with it an implied exclusive right to use, the subject-matter of the patent.⁵ Assignments of legal titles to patents must be in writing, because the statute provides no other method of effecting such an assignment;⁶ and because since patent rights are creatures of statute and not of common law, the transfer of the legal title thereto cannot be regulated by the rules of the latter system.⁷ It seems, however, that an equitable title may be created by parol,⁸ and if such a title can be created by parol, it may, perhaps, by parity of reasoning, be transferred by the same method.

§ 275. The patent assigned ought to be described in an as-

¹ *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868.

² *Fischer v. Neil*, 6 Fed. Rep. 89, 1881.

³ *Washburn & Moen Mfg. Co. v. Haish*, 4 Fed. Rep. 900, 1880.

⁴ *Gayler v. Wilder*, 10 Howard, 477, 1850; *Potter v. Holland*, 4 Blatch.

211, 1858.

⁵ *Nellis v. Mfg. Co.* 13 Fed. Rep. 451, 1882.

⁶ Revised Statutes, Section 4898.

⁷ *Gayler v. Wilder*, 10 Howard, 498, 1850.

⁸ *Whiting v. Graves*, 3 Bann. & Ard. 225, 1878.

signment by its number and its date, and by the name of the patentee, and the name of the invention which it purports to cover ; but an assignment will be valid, though it is lacking or erroneous in one or more of these particulars, if the description which it contains really excludes doubt as to the patent intended to be conveyed.¹ An assignment of an invention or patent for a machine, will not convey any patent for a process in the performance of which that machine finds its only utility.² An assignment by a natural person requires no other authentication than the assignor's signature. Such papers are sometimes acknowledged before a magistrate ; but if such an acknowledgment is of any value, it is so merely because it obviates the necessity of proving the signature of the assignor, and if it obviates that necessity, it does so by virtue of the law of the particular State in which it is acknowledged.³ An assignment by a corporation needs not to be authenticated by its corporate seal, but is properly executed, if executed in the name and by the authority of the corporation, and by a proper officer, who signs for the corporation, and signs as an officer thereof.⁴ An assignment to a corporation confers no title upon any stockholder therein ;⁵ and an assignment to a corporation which is not organized till after the date of the assignment will, at least by way of estoppel, inure to its benefit when organized, and will be good as against the assignor.⁶

§ 276. An assignment for which the consideration was never paid, and which was never acted upon by either of the parties thereto, conveys no title to the assignee ;⁷ but no assignment which has been acted upon by the parties thereto

¹ *Case v. Morey*, 1 New Hampshire, 349, 1818 ; *Holden v. Curtis*, 2 New Hampshire, 63, 1819 ; *Harmon v. Bird*, 22 Wendell, (N. Y.) 113, 1839 ; *Hill v. Thuermer*, 13 Indiana, 351, 1859.

² *Downton v. Mfg. Co.* 9 Fed. Rep. 402, 1879 ; *Downton v. Allis*, 9 Fed. Rep. 771, 1881.

³ New York Pharmaceutical Association

v. Tilden, 14 Fed. Rep. 740, 1882.

⁴ *Gottfried v. Miller*, 104 U. S. 527, 1881.

⁵ *Gottfried v. Miller*, 104 U. S. 528, 1881.

⁶ *Dyer v. Rich*, 1 Metcalf (Mass.) 180, 1840.

⁷ *Railroad Co. v. Trimble*, 10 Wallace, 380, 1870.

can be revoked on the ground of a partial failure to pay the promised price.¹

§ 277. Rights of action for past infringements of a patent are not conveyed by any mere assignment of that patent ;² but they may be conveyed by any assignment which purports to convey them, whether that document purports also to convey the patent,³ or purports to convey the rights of action alone.⁴

§ 278. The construction of assignments depends primarily upon the meaning of all the language in which they are composed, rather than upon that of any particular words they contain ;⁵ and if that language is clear in the eye of the law, its effect cannot be varied by any parol evidence ;⁶ but if that language is ambiguous, it may be construed in the light of certain classes of parol proof. The parties will never be permitted to testify what they intended to signify by the language they used, because if they were, assignors might narrow, and assignees might widen, the scope of the rights conveyed, by simply making oath to alleged former states of their own minds. Perjury could seldom be detected in such a case ; and such a rule would put property at the mercy of avarice. Nor is any evidence admissible which merely shows that one of the parties to an assignment made such declarations, or did such acts, in pursuance of that assignment, as indicate that he understood the document in a sense most favorable to himself. If such evidence were admissible, the honest mistake of an assignor, in construing his contract, would often deprive an assignee of rights which he had honestly bought ; and the honest mistake of an assignee would often deprive an assignor of rights which he never had sold. But parol evidence is admissible to construe an ambiguous assignment, if that evi-

¹ *Hartshorn v. Day*, 19 Howard, 222, 1856 ; *Mackaye v. Mallory*, 12 Fed. Rep. 328, 1882.

² *Moore v. Marsh*, 7 Wallace, 515, 1868.

³ *Hamilton v. Rollins*, 3 Bann. & Ard. 160, 1877.

⁴ *Hayward v. Andrews*, 12 Fed. Rep. 786, 1882.

⁵ *Washburn v. Gould*, 3 Story, 122, 1844.

⁶ *Railroad Co. v. Trimble*, 10 Wallace, 367, 1870.

dence shows the existence of such collateral documents, or surrounding circumstances, attending the execution of that assignment, as throw light upon the meaning of its words ;¹ or shows that both parties to that assignment, practically construed it, after its execution, and in so doing construed it alike.² If ambiguities still remain in an assignment after all other recognized methods of solving them have been employed, they are to be solved against the grantor, as he is supposed to have written the document, and therefore to be chargeable with the obscurity.³

§ 279. Reformation of an assignment may be had by means of a bill in equity filed for that purpose, if that assignment does not conform to the mutual intention of the parties to its execution ; but neither party can secure such reformation on proof of what his intention was, unless he also proves that the intention of the other party was the same.⁴ But no reformation of an assignment can affect the right of any innocent purchaser, for a valuable consideration, who had no notice, at the time of his purchase, that the mutual intention of the parties was different from the assignment which passed between them.⁵

§ 280. No extension of a patent is conveyed by any assignment of the first term thereof.⁶ Nor is any extension, which is not provided for by the general law when an assignment is made, covered by the word "renewal" in such an assignment. In such a case, that word is held to mean "reissue" and not to mean "extension."⁷ But if, at the time such an assignment is made, the patent statutes do provide for exten-

¹ *Read v. Bowman*, 2 Wallace, 591, 1864 ; *Phelps v. Classen*, 1 Woolworth, 212, 1868 ; *Witherell v. Zinc Co.* 6 Fisher, 50, 1872.

² *Wilcoxon v. Bowles*, 1 Louisiana An'l, 230, 1846 ; *Parrott v. Wikoff*, 1 Louisiana An'l, 232, 1846 ; *Coleman v. Grubb*, 23 Penn. St. 409, 1854.

³ *Smith v. Selden*, 1 Blatch. 475, 1849 ; *May v. Chaffee*, 2 Dillon, 385, 1871 ; *Falley v. Giles*, 29 Indiana,

114, 1867.

⁴ *Downton v. Allis*, 9 Fed. Rep. 771, 1881.

⁵ *Gibson v. Cook*, 2 Blatch. 149, 1850 ; *Woodworth v. Cook*, 2 Blatch. 151, 1850.

⁶ *Wilson v. Rousseau*, 4 Howard, 646, 1846.

⁷ *Wilson v. Rousseau*, 4 Howard, 646, 1846.

sions of patents of the class to which the assigned patent belongs, then the word "renewal" is a sufficient word to convey such an extension.¹ An assignment of an invention, without limitation or qualification, will convey, not only the original term, but also any Patent Office extension, of the patent granted for that invention.² Whether such an assignment will convey any Congressional extension, is an undecided point. An affirmative decision upon it will not necessarily follow the rule in *Hendrie v. Sayles*, but it is not improbable that the Supreme Court will take the step required to pass from the one doctrine to the other, whenever the question arises in that tribunal.

§ 281. Recording in the Patent Office, within three months after its date, is necessary to the validity of any assignment of a patent right, as against any subsequent purchaser or mortgagee, for a valuable consideration, without notice.³ This statutory provision does not apply to any assignment executed prior to the granting of letters patent, unless that assignment is one upon which a patent is to be issued to the assignee; and in such a case the invention must be so identified in the assignment, that there can be no mistake as to the particular invention intended to be conveyed.⁴ Nor does the provision apply to any assignment made by a judge or register in bankruptcy under Title LXI. of the Revised Statutes; and such an assignment though unrecorded more than three months after its date and delivery, will prevail against a subsequently executed but previously recorded assignment of the bankrupt or his executor or administrator.⁵ Neither does the provision apply to any assignment which conveyed accrued rights of action only.⁶ In such a case, the assignee, in order to protect his right, should give the infringer notice of the assignment;

¹ *Pitts v. Hall*, 3 Blatch. 201, 1854; *Goodyear v. Cary*, 4 Blatch. 303, 1859; *Chase v. Walker*, 3 Fisher, 122, 1866.

² *Hendrie v. Sayles*, 98 U. S. 554, 1878.

³ Revised Statutes, Section 4898.

⁴ *Wright v. Randel*, 8 Fed. Rep. 599, 1881.

⁵ *Prime v. Mfg. Co.* 16 Blatch. 456, 1879.

⁶ *Gear v. Fitch*, 3 Bann. & Ard. 573, 1878.

so that if the infringer afterward pays the assignor, or pays some subsequent assignee, for that right of action, he will do so at his peril, and will not discharge his liability to the first assignee.¹ Recording an assignment of a patent, is not necessary to its validity, as between the parties to that assignment ;² nor as against an infringer of the patent ;³ nor as against an innocent purchaser for a valuable consideration without notice, who takes his assignment within three months after the date of the prior unrecorded assignment ;⁴ nor as against any subsequent purchaser who had actual notice thereof, when purchasing ;⁵ nor as against any subsequent purchaser who paid no valuable consideration for the assignment which he took.⁶ A merely good consideration will, therefore, not support an assignment as against any prior unrecorded assignment of the same patent given for a valuable consideration.

The notice which will protect a prior unrecorded assignment, against a subsequent assignment for a valuable consideration, may be actual, or it may be constructive only. Such constructive notice may be based on the fact that the subsequent assignee was informed, at the time of his purchase, that the prior assignee was making, using or selling specimens of the invention covered by the patent involved. Such making, using or selling is such a possession of the invention, as charges all purchasers who are cognizant thereof, with notice

¹ Woodbridge v. Perkins, 3 Day (Connecticut) 364, 1809 ; Vanbuskirk v. Hartford Fire Insurance Co. 14 Connecticut, 144, 1841 ; Campbell v. Day, 16 Vermont, 558, 1844 ; Clodfelter v. Cox, 1 Sneed (Tenn.) 330, 1853 ; Loomis v. Loomis, 26 Vermont, 198, 1854 ; Murdoch v. Finney, 21 Missouri, 138, 1855 ; McWilliams v. Webb, 32 Iowa, 577, 1871.

² Holden v. Curtis, 2 New Hampshire, 61, 1819 ; Case v. Redfield, 4 McLean, 527, 1849 ; Black v. Stone, 33 Alabama, 327, 1858 ; Moore v. Bare, 11 Iowa, 198, 1860 ; Turnbull v. Plow Co. 6 Bissell, 229, 1874.

³ Brooks v. Byam, 2 Story, 525, 1843 ; Pitts v. Whitman, 2 Story, 609, 1843 ; Boyd v. M'Alpin, 3 McLean, 427, 1844 ; Case v. Redfield, 4 McLean, 526, 1849 ; McKernan v. Hite, 6 Indiana, 428, 1855 ; Sone v. Palmer, 28 Missouri, 539, 1859.

⁴ Gibson v. Cook, 2 Blatch. 144, 1850.

⁵ Peck v. Bacon, 18 Connecticut 377, 1847 ; Continental Windmill Co. v. Empire Windmill Co. 8 Blatch. 295, 1871 ; Ashcroft v. Walworth, 1 Holmes, 152, 1872.

⁶ Saxton v. Aultman, 15 Ohio State, 471, 1864.

of whatever title the maker, user or seller may possess.¹ Such constructive notice may also be based on the fact that the subsequent purchaser was a corporation in which the assignor was a director. The assignor's actual knowledge of his own prior assignment, becomes in such a case, constructive notice of that assignment, to the corporation one of whose directors the assignor is.² Where title has once vested in a subsequent purchaser, for a valuable consideration, without notice of a prior unrecorded assignment more than three months old ; that title becomes absolute, and may be purchased by persons who had actual knowledge of the prior assignment.³ If this rule were otherwise, titles thus derived might become valueless for want of qualified purchasers.⁴

The foregoing parts of this section contemplate cases where the things covered by several assignments of the same assignors, are unquestionably identical ; and where there is no ground for controversy relevant to the respective dates of the conflicting transactions. Where either or both of those circumstances are otherwise, other points of law will also arise. Where, for example, the subsequent assignment purported to convey no more than the right, title, and interest of the assignor, in the specified patent, that assignment can never prevail against any prior unrecorded assignment which left any interest in the assignor ;⁵ if indeed it can prevail against one which left no such interest.⁶

The date of an assignment is the day of its delivery, and not the date which appears upon its face, if the latter differs from the former ;⁷ and the three months within which, after that

¹ *Primo v. Mfg. Co.* 16 Blatch. 455, 1879.

² *Continental Windmill Co. v. Empire Windmill Co.* 8 Blatch. 295, 1871 ; *Cutter Co. v. Sheldon*, 10, Blatch. 1, 1872.

³ *Wright v. Randel*, 8 Fed. Rep. 599, 1881.

⁴ *Varick v. Briggs*, 6 Paige, (N. Y.) 329, 1837 ; *Story's Equity Jurispru-*

dence, Section 1503*a*.

⁵ *Brown v. Jackson*, 3 Wheaton, 449, 1818 ; *Ashcroft v. Walworth*, 1 Holmes, 152, 1872 ; *Turnbull v. Plow Co.* 6 Bissell, 230, 1874.

⁶ *Oliver v. Piatt*, 3 Howard, 363, 1845 ; *May v. Le Claire*, 11 Wallace, 232, 1870.

⁷ *Dyer v. Rich*, 1 Metcalf (Mass.), 180, 1840.

date, an assignment is required to be recorded, are lunar, and not calendar months.¹

§ 282. Warranty of title is implied in every assignment of a patent right unless that assignment purports to convey merely the right of the assignor; or unless it is otherwise limited to narrower ground than the entire patent right which it describes. Every such assignment will therefore transfer whatever title the assignor may subsequently acquire by purchase or otherwise.² But an assignment of the right, title and interest of the assignor without anything more, will not operate to convey any title which is subsequently acquired by him.³

§ 283. No warranty of validity is implied in any assignment of a patent right. If the assignor knows the patent to be invalid, at the time he makes the assignment, he is guilty of fraud, and the assignee may have relief against him, on that ground; but if both parties are equally innocent of knowledge of invalidity, the loss consequent on any invalidity afterward brought to light, must fall upon the then owner of the patent.⁴

Some State courts have held, that when sued by an assignor for the purchase price of a patent, any assignee may defend on any ground of invalidity which he can prove to exist. This view is based on the theory that in such a case there is a failure of consideration. This theory is not correct, because an assignor may lose, and an assignee may gain as much on account of the assignment of an invalid patent as on account of a valid one. An assignment of an invalid patent is a sufficient consideration to support a promissory note, in any case where there is neither warranty nor fraud.⁵ To allow an assignee, who has made profit from the patent assigned, to defend against a suit for the promised price, on the ground of

¹ Section 125 of this book.

² *Faulks v. Kamp*, 17 Blatch. 433, 1880.

³ *Perry v. Corning*, 7 Blatch. 195, 1870.

⁴ *Hiatt v. Twomey*, 1 Devereux &

Battle's Equity Cases (N. C.), 315, 1836; *Cansler v. Eaton*, 2 Jones' Equity Cases (N. C.), 499, 1856.

⁵ *Thomas v. Quintard*, 5 Duer (N. Y.), 80, 1855.

some defect he has been able to discover in the patent, would be very unjust. Such a rule might enable an assignee to reap enormous gains from practically exclusive rights, and then to avert payment for those rights, on some far-fetched ground of invalidity, which never for one moment had disturbed his exclusive possession of the patented privilege. Even where an assignee is not shown to have derived any benefit from the assignment of a particular patent, he ought not to be permitted to defend against a suit for the price he promised to pay therefor; because that assignment operated, at least to prevent the assignor from making, using or selling specimens of the patented thing. It is perfectly well settled that loss or disadvantage to the promisee, is a sufficient consideration to support a contract, even where that contract resulted in no benefit to the promisor.¹

§ 284. Express warranties of validity may of course be incorporated in assignments of patents; and, where so incorporated, they will subject assignors to actions for damages, if the patents assigned are found to be in fact invalid.² Parol warranties of validity, when they accompany written assignments of patents, are inadmissible as foundations for actions for damages based on alleged invalidity of those patents;³ but such parol statements may be admissible as aiding to prove fraud, in a case where other evidence shows that the assignor knew the patent to be invalid, when he made the assignment.⁴ In such a case, however, the assignee's right of action rests upon the fraud and not upon the parol warranty.⁵ It follows, therefore, that the parol warranties of validity which sometimes accompany assignments of patents, have little legal value.

§ 285. Equitable titles to patent rights may arise in a number of different ways. Such a title accrues to an assignee when

¹ Parsons on Contracts, Book 2, Ch. 1, Sec. 2.

² Wright v. Wilson, 11 Richardson (S. C. Law Reports), 151, 1856.

³ Van Ostrand v. Reed, 1 Wendell, (N. Y.) 432, 1828; Jolliffe v. Collins,

21 Missouri, 341, 1855.

⁴ McClure v. Jeffrey, 8 Indiana, 83, 1856.

⁵ Rose v. Hurley, 39 Indiana, 78, 1872.

a patent is granted to an inventor, for an invention made or completed after the execution of an assignment adapted to convey it.¹ Such a title accrues to an inventor when a patent is granted to his assignee, in pursuance of an assignment, which was accompanied by a contract providing that the assignee should pay to the inventor all or some portion of the proceeds of the patent.² Such a title accrues to an assignee of a term for years, in a patent right, if that term is limited to expire before the expiration of the existing term of the patent.³ And such a title will doubtless arise out of any contract which purports to give a person a beneficial interest in a patent right ; but which does not amount to an assignment or grant of legal title, nor to a license to make, to use, or to sell the invention. So also, any facts which would create a constructive or a resulting trust, if they related to other kinds of intangible personal property, will doubtless have the same effect upon property in patents, when they relate thereto.

§ 286. In whatever way an equitable title to a patent right may be found to have arisen, it will be upheld by a court of equity, as against the naked legal title. But if the holder of the legal title assigns the patent to a purchaser for a valuable consideration, without notice of the equitable title ; such a purchaser will take the entire ownership of the patent, freed from the prior equitable incumbrance.⁴ One district judge has decided this point the other way, holding that the maxim *caveat emptor* applies to such a case.⁵ But that decision was rendered before that in *Hendrie v. Sayles* ; and was made in evident forgetfulness of the really applicable maxim that, “between equal equities the law will prevail ;” and of the well established doctrine, that, if a purchaser for a valuable consideration without notice of a prior equitable right, obtains a

¹ *Littlefield v. Perry*, 21 Wallace, 226, 1874 ; *Nesmith v. Calvert*, 1 Woodbury & Minot, 34, 1845 ; *Continental Windmill Co. v. Empire Windmill Co.* 8 Blatch. 295, 1871.

² *Sayles v. Dubuque & Sioux City Railroad Co.* 5 Dillon, 563, 1878.

³ *Cook v. Bidwell*, 8 Fed. Rep. 452, 1881.

⁴ *Hendrie v. Sayles*, 98 U. S. 549, 1878.

⁵ *Consolidated Fruit Jar Co. v. Whitney*, 2 Bann. & Ard. 385, 1876.

legal estate at the time of his purchase, he will be entitled to priority in equity, as well as in law.¹ The maxim of *caveat emptor* applies where a seller has no title whatever.² When a seller has the legal title, but not the equitable, then the other maxim governs the rights of assignees.

§ 287. A grant, from one person to another, of a patent right is a conveyance in writing of the entire right, or of an undivided interest therein, within and throughout a certain specified portion of the territory of the United States.³ The subject matter of a patent right is not divisible in any other category than a territorial one;⁴ and therefore grants cannot be made to convey one of several inventions covered by a patent; nor to convey an exclusive right to make, use and sell a patented invention for one of several purposes to which it is applicable. The rules which relate to the form, authentication, construction, revocation, reformation and effect of assignments, refer with equal force to grants; except as otherwise stated or implied in this section, and except as the explained nature of a grant clearly indicates otherwise. In addition to those rules, there are several which refer to grants and not to assignments; and to the latter, it is now in order to attend.

A grant is not void for ambiguity where it purports to convey all of the territory of the United States except a number of counties theretofore conveyed to others, but not specified in the grant; because the reservation is such an one as is capable of being made certain by competent evidence.⁵ It is not inconsistent with the character of a document as a grant, that it contains a clause of forfeiture in case of non-payment of royalties, or a clause providing that the grantor shall prosecute and defend suits relating to the exclusive right granted.⁶

¹ Bispham's Principles of Equity, Section 40.

² *Abbett v. Zusi*, 5 Bann. & Ard. 38, 1879.

³ *Gayler v. Wilder*, 10 Howard, 494, 1850; *Moore v. Marsh*, 7 Wallace, 521, 1868; *Littlefield v. Perry*, 21 Wallace, 219, 1874.

⁴ *Goodyear v. Railroad Co.* 1 Fisher, 627, 1853; *Suydam v. Day*, 2 Blatch. 21, 1846; *Washing Machine Co. v. Earle*, 3 Wallace, Jr. 320, 1861.

⁵ *Washburn & Moen Mfg. Co. v. Haish*, 4 Fed. Rep. 908, 1880.

⁶ *Littlefield v. Perry*, 21 Wallace, 220, 1874.

Nor is it inconsistent with a grant, that the document limits the exercise of the exclusive right, to the making, using and selling of a particular number of specimens of the patented invention involved.¹ But no instrument can be a grant which reserves a right to the grantor, to sell specimens of the patented thing within the territory covered thereby; though it reserves him no right to make or to use any such specimen within that territory.²

§ 288. A grant of an exclusive right to make, use, and sell a particular patented invention within a particular part of the United States, confers the right to use, anywhere within the United States, those specimens of that invention which are made and sold under the grant, and within the territory covered thereby.³ This point was established in a case where the patented article was capable of being used but once; but in the other case which supports it, the rule was applied, though the thing covered by the patent was capable of repeated uses. It was a remark of Sir Francis Bacon, that: "It is the vice of subtle minds to attach too much importance to slight distinctions." Such a mind may possibly hold that Judge SAWYER was not justified in disregarding the distinction just mentioned. But Judge SAWYER took still a further step in the case last cited. He refused to enjoin the defendant from selling, west of the Rocky Mountains, those specimens of the patented invention which were lawfully made and sold east of that landmark; though the complainant was the sole grantee of all the territory which he sought to protect from intrusion. It is probable that this practice and the doctrine upon which it is founded will also be approved by the Supreme Court when the question arises in that tribunal, for it has said, that: "Power to sell the machine and transfer the accompanying right of use is an incident of unrestricted ownership."⁴

¹ *Wilson v. Rousseau*, 4 Howard, 646, 1846; *Washburn v. Gould*, 3 Story, 122, 1844; *Ritter v. Serrell*, 2 Blatch, 379, 1852.

² *Pitts v. Jameson*, 15 Barbour (N. Y. Supreme Court), 315, 1853.

³ *Adams v. Burke*, 17 Wallace, 453, 1873; *McKay v. Wooster*, 2. Sawyer, 373, 1873.

⁴ *Paper-Bag Cases*, 105 U. S. 771, 1881.

§ 289. A creditor's bill may operate to transfer a complete title, or an equitable title, to a patent right, whenever a judgment is obtained against its owner, and an execution issued on that judgment, is returned *nulla bona*; and the court in which the creditor's bill is filed may appoint a trustee to execute a proper assignment.¹ But a suit, instituted by the filing of such a bill, is not a patent suit in such a sense as to confer jurisdiction on a Federal court.² Where jurisdiction is not conferred upon those courts by variant citizenship, or other cause known to the law, it will be necessary to proceed in the courts of the States. In such of the States as have preserved equity pleadings and proceedings, a creditor's bill is the proper document to file in such a court, when pursuing such relief; but in the States which have adopted codes of civil procedure, in place of the common law and equity plans of judicature, the end in view may be reached by what are called proceedings supplementary to executions.³

§ 290. Adjudication of bankruptcy and appointment of an assignee, operated, under the bankrupt law of 1867, to vest in such assignee, all patent rights of the bankrupt and all *choses in action* based thereon, except such as were held in trust by him, and except such as were exempted from attachment, or seizure, or levy on execution by virtue of the laws of the United States, or by virtue of the laws of the State in which the bankrupt had his domicile at the time of the commencement of the bankruptcy proceedings.⁴ Though this bankruptcy law was repealed in 1878, many titles, to patent rights now in force, were transferred by its operation; and it is therefore still a law of practical importance. Whenever new bankruptcy statutes are hereafter enacted, it is probable that similar provisions will be inserted also in them. Corresponding proceedings in insolvency under State laws, do not have the operation of bankruptcy proceedings in this particular. They do not confer upon the assignee in insolvency, any

¹ *Ager v. Murray*, 105 U. S. 126, 1881.

² *Ryan v. Lee*, 10 Fed. Rep. 917, 1882.

³ *Pacific Bank v. Robinson*, 57 California, 522, 1881.

⁴ Revised Statutes, Sections 5046, 5053, 5045.

title to the patent rights of the insolvent.¹ But it is probable, that courts which have jurisdiction of such proceedings, may compel the insolvent to execute such an assignment to the assignee in insolvency as will convey the same rights to the latter, as those which, without such a document, were conveyed to an assignee in bankruptcy under the bankrupt law of 1867.²

§ 291. Death of an inventor, before the grant of a patent for his invention, causes a transfer of his inchoate title, to his executor or administrator, in trust for the heirs at law of the deceased in case he dies intestate, or in trust for his devisees in case he leaves a will disposing of the invention.³ Such an inchoate title has several of the same qualities, in the hands of the executor or administrator, that it had in the hands of the deceased. If it was an unassigned inchoate title in the hands of the inventor, it is likewise so in the hands of his legal representative. If the deceased had parted with the equitable title, and had, at his death, only the inchoate legal title, the equitable title will be unaffected by the death of the inventor, and will remain the property of its purchaser.⁴ So also, if the inventor had parted, prior to his death, with the inchoate legal title, and retained the equitable title, then the latter, and not the former, will devolve upon his executor or administrator. Death of the owner of any legal or equitable title to a patent right already in existence, causes a transfer of that title to his executor or administrator, in like manner as it causes the transfer of any other intangible personal property of the deceased.⁵ Such a legal representative may convey the title by assignment or by grant, by means of any suitable instrument in writing, and in pursuance of such general or special authority from the probate court as is prescribed, in that behalf, by the laws of the particular State whose court that tribunal is.⁶

¹ *Ashcroft v. Walworth*, 1 Holmes, 154, 1872.

² *Ager v. Murray*, 105 U. S. 131, 1881.

³ Revised Statutes, Section 4896.

⁴ *Northwestern Extinguisher Co. v. Philadelphia Extinguisher Co.* 1

Bann. & Ard. 177, 1874.

⁵ *Brooks v. Jenkins*, 3 McLean, 441, 1844; *Hodge v. North Missouri Railroad Co.* 1 Dillon, 104, 1870.

⁶ *Brooks v. Jenkins*, 3 McLean, 441, 1844.

Where there are several joint executors or administrators, the assignment or grant of one of them, is legally the assignment or grant of them all ;¹ and if an administrator denominates himself an executor, or if an executor calls himself an administrator, in such a document, that document will be none the less efficacious to convey the title which he holds in his true capacity.²

§ 292. Tenancy in common, in a patent right, will arise whenever the sole owner of such a right, in all or in part of the territory of the United States, conveys to another an undivided interest in the whole or in part of the right which he owns. Mutual ownership of some sort arises when a plurality of persons are joint inventors of a process or thing, for which they obtain a joint patent ; and also when a plurality of persons obtain, by one assignment or grant, the undivided ownership of a patent, or the undivided ownership of a patent right in a part of the territory of the United States. Whether such mutual ownership constitutes tenancy in common, or constitutes joint-tenancy is a question upon which no positive answer can at present be given. The text writer can do no more than to state the considerations upon which each of the two possible answers, if given, must be based, and to state which of those sets of considerations appear to be the more convincing.

In favor of the hypothesis of joint-tenancy, it may be said that joint-tenancy is a doctrine of the common law which is as applicable to personal property as to real estate ;³ and that such mutual ownership of patent rights, as those now under inspection, are characterized by all of the four unities which constitute joint-tenancy ; the unity of interest ; the unity of title ; the unity of time ; and the unity of possession.⁴ In answer to this it may be said that the doctrine of survivorship is the distinguishing characteristic of joint-tenancy ; and that the reasons which gave rise to that description of estate in

¹ *Wintermute v. Redington*, 1 Fisher, 239, 1856.

² *Newell v. West*, 13 Blatch. 114, 1875.

³ Blackstone, Book 2, Ch. 25, last paragraph.

⁴ Blackstone, Book 2, Ch. 12.

England, never existed in the United States ; and that those reasons were founded on the feudal idea that the services due to the superior lord, should be kept entire ; and that the doctrine of survivorship was invented to secure that feudal end ; and that it has no foundation on any principle of natural justice, or on any point of public policy relevant to American patent rights ; and that, therefore, joint-tenancy and its incident, survivorship, are not such doctrines of the common law as are entitled to be incorporated into our American patent system. To this argument against joint-tenancy, it may be replied that it has as reasonable an application to American patent rights, as it has to American real estate ; and that the Supreme Court of the United States has applied it to the latter sort of property.¹ To this it may be rejoined that though the question was involved, it was not argued, in the case last cited ; and that the Supreme Courts of several of the States have decided that joint-tenancy is not a part of American common law.² And it may be further rejoined that even if applicable to American real estate, it is not applicable to American patent rights, because, if it were, it would often operate to defeat the reward to inventors which it is a purpose of American patent law to secure ; and because the same reasons which in England excluded the doctrines of joint-tenancy from personal property used in agriculture or in commerce,³ should in America exclude those doctrines from personal property created by invention and used in manufactures. And it may be further rejoined that, even if, in the absence of contrary legislation, the doctrines of joint-tenancy would apply to American patent rights, yet those doctrines have been substantially abrogated throughout most of the United States, by means of those State statutes which have repealed or emasculated those doctrines within the several States, and by virtue of Section 721 of the Revised Statutes, which had adopted those State statutes. To the last re-

¹ *Mayburry v. Brien*, 15 Peters, 37, 1841.

² *Phelps v. Jepson*, 1 Root (Connecticut), 48, 1769 ; *Sergeant v.*

Steinberger, 2 Ohio, 306, 1826 ; *Harris v. Clark*, 10 Ohio, 5, 1840.

³ Blackstone, Book 2, Ch. 25, last paragraph.

joinder it may be surrejoined that Section 721 of the Revised Statutes does not adopt the State statutes on this subject; because that section is identical with Section 34 of the Judiciary Act of 1789, and because the latter provision has been held by the Supreme Court, to apply only to cases arising out of the laws of the States.¹ To this surrejoinder, there may be a rebutter that this part of the decision in the *United States v. Reid*, has apparently been overruled in later Supreme Court cases.² To the mind of the text writer it appears that those of the foregoing arguments which deny joint-tenancy in patent rights, are on the whole more convincing than those which affirm it. All mutual ownership of such rights, will therefore be treated in the following pages, as though it were, undeniably, tenancy in common.

Inasmuch, however, as the question has never been decided by the Supreme Court, it would be prudent to avoid, as far as possible, the circumstances which created a joint-tenancy at English common law; for if joint-tenancy should be held to exist in any patent right, its doctrine of survivorship would deprive the heirs or devisees of a dying joint-tenant, of their just inheritance, and would confer that inheritance upon the joint-tenant who survived.³

§ 293. The circumstances, which, unless avoided, may be held to create a joint-tenancy in a patent, can, where joint inventors become joint patentees, be avoided by means of a joint assignment of the patent to a third person, and a separate reassignment to the patentees, of their respective undivided interests. Such an operation will turn any joint-tenancy into a tenancy in common, because it destroys the unity of title, and if the separate reassignments are executed and delivered on different days, it also destroys the unity of time. Where a sole inventor sells an undivided interest in his invention or his patent, the objectionable circumstances can be avoided by sim-

¹ *United States v. Reid*, 12 Howard, 363, 1851.

² *Vance v. Campbell*, 1 Black. 427, 1861; *Hausknecht v. Claypool*, 1

Black. 431, 1861; *Wright v. Bales*, 2 Black. 535, 1862.

³ Blackstone, Book 2, Ch. 25, last paragraph.

ply assigning that undivided interest to the purchaser ; instead of doing the common, but unscientific, thing of assigning the whole invention, or the whole patent, to himself and to that purchaser jointly. And in a case where a sole patentee assigns his patent, or grants a territorial right therein, to a plurality of purchasers, those circumstances can be avoided by simply executing and delivering a separate paper to each purchaser for his undivided share ; instead of making one document convey the whole right to all the purchasers together. Indeed any device which will destroy either of the four unities of a joint-tenancy, will destroy that tenancy, and at the same instant will destroy the right of survivorship. If the unity of possession is destroyed, the ensuing estate of each owner is an estate in severalty ; but if that unity is preserved, while either or all of the others are destroyed, the joint-tenancy is converted into a tenancy in common.¹

§ 294. One tenant in common of a patent right may exercise that right to any extent he pleases without the consent of any co-tenant. He may make, use, and sell, specimens of the patented invention to any extent, and may license others to do so, and neither he nor his licensees can be enjoined from a continuance in so doing.² Nor can any recovery of profits or damages be had against any such licensee, at the suit of any co-tenant of any such licensor.³ It seems to logically follow that no recovery of profits or damages can be had against one co-tenant, who, without the consent of the others, has made, used or sold specimens of the patented thing. That doctrine has however been denied by one federal judge ;⁴ and doubted by another ;⁵ though it has been enforced by a third,⁶ and by the Supreme Court of Massachusetts ;⁷ and by the Supreme Court of New York.⁸ Either one of several co-tenants in a

¹ Blackstone, Book 2, Ch. 12.

² *Clum v. Brewer*, 2 Curtis, 523, 1855.

³ *Dunham v. Railroad Co.* 7 Bissell, 223, 1876.

⁴ *Pitts v. Hall*, 3 Blatch. 207, 1854.

⁵ *Dunham v. Railroad Co.* 7 Bissell,

223, 1876.

⁶ *Whiting v. Graves*, 3 Bann. & Ard. 225, 1878.

⁷ *Vose v. Singer*, 4 Allen, (Mass.) 232, 1862.

⁸ *De Witt v. Mfg. Co.* 5 Hun, (N. Y.) 301, 1875.

patent right, may of course sell his right independently of the others ;¹ but where joint trustees are appointed to hold the legal title to a patent, and to manage it according to their mutual judgment and discretion, a joint deed of all those trustees is necessary to convey that right to another.²

§ 295. Partition of a patent right, held by tenancy in common, may of course be made by the common consent and mutual action of all the owners of that right ; but no such partition can be made against the will of either owner. This rule follows from the fact that no partition of estates held by tenancy in common was compellable at common law ;³ and from the fact that no United States statute has provided for any such partition ; and from the fact that the State statutes relevant to partition of real estate do not apply even to personal property which is held under the laws of the States, and surely cannot apply to any personal property which is created by the laws of the nation.

¹ *May v. Chaffee*, 2 Dillon, 388, 11 Fed. Rep. 302, 1882.
1871.

³ Blackstone, Book 2, Ch. 12.

² *Wiscott v. Agricultural Works*,

CHAPTER XII.

LICENSES.

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§ 296. ANY conveyance of a right under a patent, which does not amount to an assignment or to a grant, is a license. It is a license, if it does not convey the entire and unqualified monopoly, or an undivided interest therein, throughout the particular territory to which it refers.¹ Consistently with this definition, the following have been held to constitute licenses only: an exclusive right to make and sell, but not to use:² an exclusive right to make and use, but not to sell:³ an ex-

¹ *Gayler v. Wilder*, 10 Howard, 494, 1850; *Sanford v. Messer*, 1 Holmes, 149, 1872; *Hill v. Whitcomb*, 1 Holmes, 321, 1874.

² *Hayward v. Andrews*, 106 U. S.

673, 1882; *Dorsey Rake Co. v. Mfg. Co.* 12 Blatch. 203, 1874.

³ *Mitchell v. Harley*, 16 Wallace, 544, 1872.

clusive right to use and sell, but not to make :¹ an exclusive right to make, to use, and to sell to be used, for certain purposes, but for no other.” “The right to manufacture, the right to sell, and the right to use, are each substantive rights, and may be granted or conferred separately by the patentee.”² Any one or two of these rights may be expressly conveyed by a patentee, while the other is expressly retained by him. In the absence of express reservation, however, some licenses are extended by implication, so as to convey, not only what they expressly cover, but also some other right which is necessary to the full enjoyment of the right expressly conveyed. This doctrine is not in conflict with the rule which prohibits the enlargement of an instrument in writing by parol evidence ; because that rule is directed only against the admission of oral evidence of the language, used by the parties in a contract which was reduced to writing.⁴ This doctrine relates to the legal effect of the language actually written, and is based on that maxim of the common law which prescribes, that any one granting a thing, impliedly grants that, without which, the thing expressly granted would be useless to the grantee.⁵

§ 297. An express license to make specimens of a patented thing, is without value, unless it implies a right to use, or a right to sell, the specimens made thereunder. It is not to be presumed that a right so nugatory as a bare right to make, was the only subject of a license for which a valuable consideration was paid. Whether the implied right, which accompanies such a license, is a right to use or a right to sell, can best be determined by ascertaining the circumstances which surrounded the giving of the particular license in question. If the licensee was engaged in a business which made it convenient for him to use the thing involved, then the right to use will be implied in preference to the right to sell, because it is the more natural

¹ *Hamilton v. Kingsbury*, 17 Blatch. 265, 1873.

² *Gamewell Telegraph Co. v. Brooklyn*, 14 Fed. Rep. 255, 1882.

³ *Adams v. Burke*, 17 Wallace, 456,

⁴ *Greenleaf on Evidence*, Section 277.

⁵ *Steam Stone Cutter Co. v. Short-sleeves*, 16 Blatch. 382, 1879.

implication in such a case. On the other hand, if the licensee had no occasion to use the thing in view, but was engaged in making and selling similar things, for the use of others, then a right to sell will be implied from a right to make.¹ Rights to both use and sell will not be implied from an express license to make, because only one of those rights is necessary to the beneficial enjoyment of such a license. An express license to make specimens of a particular thing does not imply a license to use a particular patented machine for that purpose, even where the patent on that machine was owned by the licensor, at the time of the license, and even where that machine was then the best-known means of making the thing licensed.²

§ 298. An express license to use a limited or unlimited number of specimens of a patented article, implies a right to make those specimens, and to employ others to make them, and will protect those others in making them for the use of the licensee.³ If the license to use, covers a greater length of time than one specimen of the thing to be used will last; then there is an implied right in the licensee to repair or to rebuild that specimen, or to replace it by another specimen made or purchased for that purpose.⁴

§ 299. An express license to sell specimens of a patented thing, does not imply any right to make those specimens, because it is to be presumed that they may be obtained by purchase, and because no person requires any license to enable him to lawfully buy an article covered by any patent. But a license to sell does imply that a right to use and to sell again shall be conferred on the vendees of the licensee, for otherwise no persons would buy except for exportation, and sales for exportation are seldom sufficiently practicable to raise a presumption that they alone were contemplated by the parties to a license to sell.

¹ *Steam Cutter Co. v. Sheldon*, 10 Blatch. 8, 1872.

² *Troy Nail Factory v. Corning*, 14 Howard, 193, 1852.

³ *Steam Stone Cutter Co. v. Short-sleeves*, 16 Blatch. 381, 1879.

⁴ *Wilson v. Stolley*, 4 McLean, 275, 1847; *Bicknell v. Todd*, 5 McLean, 236, 1851; *Woodworth v. Curtis*, 2 Woodbury & Minot, 524, 1847; *Steam Cutter Co. v. Sheldon*, 10 Blatch. 8, 1872.

§ 300. A license to make and use does not authorize any sale of the thing so made, nor authorize any purchaser of that thing to use the same.¹ Nor does a sale, coupled with an express license to use, give any right to use after the license has been forfeited.² The purchaser of a patented thing gets no other right to use it than such right as the seller had an express or an implied right to convey.³ And the purchaser of a thing which is useful only in producing a patented article, gets thereby no right to use his purchased thing for that purpose.⁴

§ 301. A license to make and sell, or a license to use and sell, implies a right in the purchaser to use, and to sell again, the thing thus lawfully sold to him. When a specimen of a patented invention is sold with the authority of the owner of the patent which covers it, and without any restriction on the ownership or use of the thing conveyed, then that specimen passes out of the exclusive right which is secured by the patent, and may be used as long, or sold as often, as though it had never been subject to a patent.⁵ The same result also follows from a sheriff's sale of a patented article, where that sale was made in pursuance of an execution, issued against the owner of the patent right, and lawfully levied on that article, as the property of that owner.⁶ But no person acquiring the ownership of mutilated portions of a specimen of a patented thing, can lawfully reconstruct that specimen by adding the missing parts, and still less can he lawfully use or sell the entire article when reconstructed.⁷

§ 302. Express licenses which, if unrestricted, would convey

¹ *Wilson v. Stolley*, 4 McLean, 277, 1847.

² *Wortendyke v. White*, 2 Bann. & Ard. 25, 1875.

³ *Chambers v. Smith*, 5 Fisher, 14, 1870.

⁴ *Stevens v. Cady*, 14 Howard, 528, 1852; *Stevens v. Gladding*, 17 Howard, 447, 1854.

⁵ *Bloomer v. McQuewan*, 14 Howard, 539, 1852; *Chaffee v. Belting*

Co. 22 Howard, 217, 1859; *Adams v. Burke*, 17 Wallace, 453, 1873; *Paper-Bag Cases*, 105 U. S. 771, 1881; *McKay v. Wooster*, 2 Sawyer, 373, 1873; *May v. Chaffee*, 2 Dillon, 385, 1871; *Detweiler v. Voegel*, 8 Fed. Rep. 600, 1881.

⁶ *Wilder v. Kent*, 15 Fed. Rep. 217, 1883.

⁷ *American Cotton Tie Co. v. Simons*, 106 U. S. 89, 1882.

implied rights, may be so restricted that they will not have that effect.¹ A license to make and sell may be so restricted that the things made and sold under it cannot be lawfully used in certain specified parts of the United States; or so restricted that the licensee cannot make and sell the patented thing anywhere in the United States, with intent to have it exported to a foreign country.² A license to use and sell may likewise be restricted in the same way. A license to make and use may be so restricted that the patented thing cannot be used in certain specified parts of the United States,³ and cannot be used anywhere in the United States, during certain specified spaces of time.⁴

§ 303. Licenses may be written, or they may be oral. The former have no advantage over the latter, except that they can usually be proven with more ease and more certainty, and except that the latter may sometimes be invalid because obnoxious to some statute of frauds. Those exceptions, however, constitute an abundant reason for embodying all such contracts in plain black and white documents, rather than committing them to the "slippery memory of man."

§ 304. No license is required to be recorded,⁵ and no record of a license affects the rights of any person; for a license is good against the world, whether it is recorded or not.⁷ So also, if a license is embodied in two papers, one of which limits the scope of the other, an assignee of the broader document will take subject to the limitations of the narrower, even if he had no notice of its provisions, or even of its existence. Nor will the fact that the broader document was recorded, and the narrower one unrecorded, alter or affect the

¹ *Hamilton v. Kingsbury*, 15 Blatch. 64, 1878; *Hamilton v. Kingsbury*, 17 Blatch. 264, 1879.

² *Dorsey Rake Co. v. Mfg. Co.* 12 Blatch. 204, 1874.

³ *Wicke v. Kleinknecht*, 1 Bann. & Ard. 608, 1874.

⁴ *Mitchell v. Hawley*, 16 Wallace, 544, 1872.

⁵ *Brooks v. Byam*, 2 Story, 525, 1843; *Consolidated Fruit Jar Co. v. Whitney*, 2 Bann. & Ard. 38, 1875; *Buss v. Putney*, 38 N. H. 44, 1859.

⁶ *Chambers v. Smith*, 5 Fisher, 14, 1870.

⁷ *Farrington v. Gregory*, 4 Fisher, 221, 1870.

operation of this rule.¹ It follows, that where two licenses conflict, the first must prevail even though the taker of the second, had no notice of the existence of the first; and it also follows that any license will prevail as against the claims of any subsequent assignee or grantee of the patent right involved.²

§ 305. A license from one of several owners in common of a patent right, is as good as if given by all those owners;³ and a license given to one of several joint makers or users of a patented thing is as good as if given to all, if the licensor gives it with the understanding that the thing licensed to be done is to be done jointly, or is to be done by the express licensee on behalf of the other party.⁴

§ 306. The construction of a license in writing, depends upon the same general rules as the construction of other written contracts.⁵ For example, it is to be construed in the light of the circumstances which surrounded its execution.⁶ Accordingly, where the owner of several patents licenses a person to make, use or sell a particular class of things which, if made, used or sold without a license, would infringe all those patents, then that license confers a right under them all.⁷

§ 307. No warranty of validity of the letters patent is implied in any license given thereunder, and unattended proof of invalidity is therefore no defence to any suit for promised royalties.⁸ As long as a licensee continues to enjoy the benefit of the exclusive right, he must pay the royalty which he promised to pay, and he cannot escape from so

¹ *Hamilton v. Kingsbury*, 17 Blatch. 264 and 460, 1880.

² *Continental Windmill Co. v. Empire Windmill Co.* 8 Blatch. 295, 1871.

³ *Dunham v. Railroad Co.* 7 Bissell, 224, 1876.

⁴ *Bigelow v. Louisville*, 3 Fisher, 603, 1869.

⁵ *Witherell v. Zinc Co.* 6 Fisher, 50, 1872.

⁶ *Burdell v. Denig*, 92 U. S. 722, 1875.

⁷ *Day v. Stellman*, 1 Fisher, 487, 1859.

⁸ *Birdsall v. Perego*, 5 Blatch. 251, 1865; *Sargent v. Larned*, 2 Curtis, 340, 1855; *Marsh v. Dodge*, 4 Hun, (N. Y.) 278, 1875; *Bartlett v. Holbrook*, 1 Gray (Mass.), 118, 1854; *Marston v. Sweet*, 66 N. Y., 207, 1876.

doing by offering to prove the patent to be void.¹ But a license does imply that the licensee shall not be evicted from its enjoyment, and such an eviction is a defence to a suit for royalties accruing after it occurred.²

Such an eviction occurs whenever the patent is adjudged void in an interference suit prosecuted in equity in pursuance of Section 4918 of the Revised Statutes. In one case it was held that such an eviction occurs whenever the Patent Office decides against the patent, in an interference between it and an application filed after it was granted.³ That holding was wrong, because it was based on the statement that the decision of the Patent Office, in the interference case, rendered the unsuccessful patent void. That statement was entirely erroneous; for that result can only be obtained by an action in equity under Section 4918 of the Revised Statutes.⁴ The decision of the New York Court of Appeals in *Peck v. Collins*,⁵ was cited as the authority for that statement; but on turning to *Peck v. Collins*, we find that it was the surrender of the patent that annulled it, and the Supreme Court of the United States so decided, when the case reached that tribunal.⁶ Such eviction will also occur, whenever the patent is repealed, by the decree of a court in which an action is brought by the United States for that purpose. This statement is ventured on the analogy of what was meant to be decided in the case of *Marston v. Sweet*; namely, that a licensee is evicted from the enjoyment of his license whenever the patent is judicially annulled. Such eviction also occurs, whenever the licensee is enjoined from acting under it, at the suit of the owner of a senior patent;⁷ and by parity of reasoning, it occurs whenever a judgment or decree is obtained by the owner of a senior

¹ *Burr v. Duryee*, 2 Fisher, 285, 1862.

² *White v. Lee*, 14 Fed. Rep. 791, 1882.

³ *Marston v. Sweet*, 82 N. Y. 526, 1880.

⁴ *Union Paper-Bag Machine Co. v. Crane*, 1 Holmes, 429, 1874; *Wire*

Book Sewing Machine Co. v. Stevenson, 11 Fed. Rep. 155, 1882.

⁵ *Peck v. Collins*, 70 N. Y. 376, 1877.

⁶ *Peck v. Collins*, 103 U. S. 664, 1880.

⁷ *Pacific Iron Works v. Newhall*, 34 Connecticut, 67, 1867.

patent, against the licensee for an infringement which consisted of acting under the license. Such an eviction will also probably be held to occur whenever the patent is defied by unlicensed persons, so extensively and so successfully as to deprive the licensee of the benefit of his share in the exclusive right which it was supposed to secure.

§ 308. Forfeiture of a license does not follow from the single fact that the licensee has broken some covenant which was made by him when accepting the license ; unless the parties expressly agreed that such a forfeiture should follow such a breach.¹ And even where such an agreement is made, it will not always be enforced. For example, non-payment of royalty on the very day it becomes due, will not work a forfeiture, if that non-payment arose from lack of certainty relevant to the place of payment, and from lack of demand from the licensor.² Nor will forfeiture of a license result from the fact that the licensee has infringed the patent by doing acts, with the invention, which were unauthorized by the license. The license will not protect him in such doings, but it will continue to protect him in doing the acts which it did authorize.³ Indeed forfeitures are not favored by the law ; and courts are always prompt to seize upon any circumstance which indicates an agreement or an election to waive one.⁴

§ 309. Where a license is really forfeited, and the licensee continues to work under it as though it were still in force, the licensor has an option to sue him as an infringer, or to sue him for the promised royalties.⁵ If he selects the first of these remedies, the infringer may generally interpose any defence that he could have set up in the absence of a license.⁶ If there is an exception to this rule, that exception exists where

¹ *White v. Lee*, 5 Bann. & Ard. 572, 1880.

² *Dare v. Boylston*, 6 Fed. Rep. 493, 1880.

³ *Wood v. Wells*, 6 Fisher, 383, 1873 ; *Steam Cutter Co. v. Sheldon*, 10 Blatch. 1, 1872.

⁴ *Insurance Co. v. Eggleston*, 96 U. S. 572, 1877.

⁵ *Woodworth v. Weed*, 1 Blatch. 166, 1846 ; *Cohn v. Rubber Co.* 3 Bann. & Ard. 572, 1878 ; *Union Mfg. Co. v. Lounsbury*, 42 Barbour, (N. Y.) 125, 1864.

⁶ *Woodworth v. Cook*, 2 Blatch. 160, 1850 ; *Burr v. Duryee*, 2 Fisher, 283, 1862.

the license contained an agreement on the part of the licensee not to contest the validity of the patent. Whether or not there is such an exception to the general rule, has never yet been settled, though it is likely to be decided at an early day.¹ The question seems to be whether a forfeited contract is binding upon the party that suffered the forfeiture; and if so, whether a party can make a valid contract to omit a legal defence when brought into court in response to the suit of another party.

§ 310. No license is assignable by the licensee to another, unless it contains words which show that it was intended to be assignable.² The most suitable phrase with which to express such an intention, would include the word "assigns;" but in one case it was held that the words "legal representatives" would answer the purpose, because the license fairly indicated that the parties understood that phrase to include "assigns" as well as "executors or administrators."³ But even unassignable licenses may sometimes be invoked by persons who are not exactly identical with the licensees. A railroad company which was formed by the consolidation of prior railroad companies, may invoke the licenses which were given to either of its constituent corporations; because the consolidated company is a successor rather than an assignee of those companies.⁴ So also, a license to a corporation, will protect a receiver who is authorized to manage its business during its embarrassments.⁵ Where a license is given to a partnership, composed of several persons, and where that partnership is dissolved, and its business is continued by one of the partners, that partner is entitled to that license;⁶ but a license to one person gives no right to any partner of that person; and if it author-

¹ *Wooster v. Mfg. Co.* 23 Off. Gaz. 2513, 1883.

² *Troy Factory v. Corning*, 14 Howard, 193, 1852; *Rubber Co. v. Goodyear*, 9 Wallace, 788, 1869; *Baldwin v. Sibley*, 1 Clifford, 150, 1858; *Searls v. Bouton*, 12 Fed. Rep. 143, 1882; *Bull v. Pratt*, 1 Connecticut, 342, 1815.

³ *Hamilton v. Kingsbury*, 15 Blatch. 69, 1878.

⁴ *Lightner v. Railroad Co.* 1 Lowell, 338, 1869.

⁵ *Emigh v. Chamberlin*, 2 Fisher, 192, 1861.

⁶ *Belding v. Turner*, 8 Blatch. 321, 1871.

izes the licensee to act only at a particular place, it will not protect any doings of his elsewhere.¹ The non-assignability of a license, may be waived by the licensor, and will be so waived if he accepts the promised royalty from the assignee of the licensee ;² or ratifies the transfer of the license, by otherwise treating the assignee as the licensee was entitled to be treated.³

Assignable licenses are assignable only in their entirety, unless they expressly authorize their assignment in parts, and to a plurality of persons.⁴ The purchaser of a license, takes it subject to all the restrictions connected therewith, whether he has notice of those restrictions or not ;⁵ and subject to liability for the same rate of royalty for his doings, that the licensee would have had to pay for similar acts ; but not subject to any royalty, or other money, due from the licensee to the licensor, at the time of the assignment of the license.⁶

§ 311. Purely implied licenses may arise from the conduct of patentees and grantees of patents, or from recoveries by them, of profits or damages for certain classes of infringements. Many of the rules which have thus far in this chapter, been stated and explained in connection with purely express licenses, and in connection with express licenses having implied incidents ; are also applicable to licenses which are purely implied. Little or nothing remains to be said about the latter, except to state the classes of circumstances out of which they are found to spring.

§ 312. Implied licenses, from conduct of owners of patent rights, may arise out of any one of a considerable number of classes of facts ; but, when analyzed, those facts will probably always be found to thus operate by virtue of the doctrines of acquiescence, or the doctrines of estoppel. Where the owner of a patent right acquiesces in the doings of one who

¹ Rubber Co. v. Goodyear, 9 Wallace, 788, 1869.

² Bloomer v. Gilpin, 4 Fisher, 55, 1859.

³ Hammond v. Organ Co. 92 U. S. 724, 1875.

⁴ Brooks v. Byam, 2 Story, 545,

1843. Consolidated Fruit Jar Co. v. Whitney, 1 Bann. & Ard. 356, 1874.

⁵ Chambers v. Smith, 5 Fisher, 12, 1870.

⁶ Goodyear v. Rubber Co. 3 Blatch. 449, 1856.

makes, uses or sells specimens of the patented invention, and where that owner also accepts partial compensation for such doings, a license will be implied unless the case also presents other facts which negative such an implication.¹ Payment of full compensation would be a still more convincing ground upon which to base an implied license ; and such a license may be based on a clear case of acquiescence, even if no payment whatever is proven to have as yet been actually received. But acquiescence in unpaid-for use, does not always imply that no compensation is to be expected. Where the user knew of the patent, and the patentee knew of the use, and did not object thereto ; it is more reasonable to imply an agreement for a *quantum meruit*, than to imply that the patentee donated the use of his invention to the user, or to imply that the user unlawfully seized upon the invention of the patentee.² But acquiescence cannot exist without knowledge of the thing acquiesced in, nor can it be predicated even of knowledge and omission to interfere with the doings of the infringer, if that omission is fairly accounted for on other grounds.

§ 313. The estoppel which will work an implied license is that sort which is most accurately denominated estoppel by conduct ; and all of the following elements are necessary to its existence. 1. There must have been a representation or a concealment of material facts. 2. The representation must have been made with knowledge of the facts. 3. The party to whom it was made must have been ignorant of the truth of the matter. 4. It must have been made with the intention that the other party should act upon it. 5. The other party must have been induced to act upon it.³ 6. That act must be hurtful to the party acting, in case the estoppel is not enforced in his favor.⁴

¹ Blanchard v. Sprague, 1 Clif. 297, 1859.

² McKeever v. United States, 23 Off. Gaz. 1527, 1883.

³ M'Millin v. Barclay, 5 Fisher, 201, 1871 ; Bigelow on Estoppel, Ch.

18, p. 437.

⁴ Railroad Co. v. Duboise, 12 Wallace, 64, 1870 ; Hill v. Epley, 31 Penn. State, 334, 1858 ; Dezell v. Odell, 3 Hill (N. Y.), 215, 1842 ; Patterson v. Lyttle, 11 Penn. State, 53, 1849.

If the owner of a patent right were to explain the patented invention to a person ignorant of the patent ; and were to advise him to make, to use, or to sell a specimen of that invention, with intent to induce him to infringe the patent unknowingly ; and if that person were thereby induced to incur expense in infringing or in preparing to infringe that patent, then it would follow from these doctrines of estoppel, that an implied license would result to a person thus misled. The same result would follow, if the owner of a patent right were to conceal the existence of the patent from a person who, to his knowledge, was about to infringe it unknowingly ; if that concealment were done with intent to allow that person to infringe ; and if that person incurred expense in infringing or in preparing to infringe, which he would not have incurred if he had known of the patent. So also, where a person sells a patented machine to another without having any interest in or under the patent, he will be estopped from prosecuting his vendee for infringement on the basis of any after acquired title.

§ 314. An actual recovery of money in an infringement suit for unlicensed making and selling a specimen of a patented thing, operates as an implied license to the purchaser of that specimen, to use it to the same extent that he could lawfully have done, if the infringer had been licensed to make it and to sell it.¹ But to effect such a result, something more than a judgment or decree is necessary. There must be a satisfaction of that decree or judgment.² Recoveries based on unlicensed use of a patented process or thing, are necessarily confined to such use as occurred before the suit was brought, if the action be at law, or to such as occurred before the final decree, if the action is in equity ; and it therefore follows that no such recovery can operate to license any one to continue such use, or to begin a new use of that thing or that process.³

¹ *Spaulding v. Page*, 1 Sawyer, 709, 1871 ; *Perrigo v. Spaulding*, 13 Blatch. 391, 1876 ; *Steam Stone Cutter Co. v. Mfg. Co.* 17 Blatch. 31, 1879 ; *Booth v. Seevers*, 19 Off. Gaz.

1140, 1881.

² *Gilbert and Barker Mfg. Co. v. Bussing*. 12 Blatch. 426, 1875.

³ *Suffolk Co. v. Hayden*, 3 Wallace, 315, 1865.

CHAPTER XIII.

INTERFERING PATENTS.

315. Causes and characteristics of interfering patents.	Commissioner of Patents on a prior interference in the Patent-Office.
316. Actions in equity between interfering patents.	319. Injunctions in interference actions.
317. The proper issue in such actions.	320. The proper decrees in such actions.
318. The force of the decision of the	

§ 315. PATENTS which contain one or more claims in common, are interfering patents. All but one of several such patents are necessarily void, as to the interfering claim or claims; though all may be valid as to the other claims which they respectively contain.¹ There are two causes which lead to the granting of interfering claims. Such claims may be granted because of inadvertence or erroneous judgment on the part of the Patent Office; and they may be granted because applications do not always happen to be made in the order of invention. The first cause may operate when the Patent Office examiners overlook an anticipating patent, while examining an application in point of novelty; or when they form an erroneous opinion that an existing patented claim is substantially different from the claim under immediate inspection. The second cause may operate when one person who is an original, but not the first, inventor of a particular thing, applies for and receives a patent thereon, before another person, who is an original and the first inventor of that thing, files his application in the Patent Office. Under such circumstances, it is the duty of the Commissioner to declare an interference between the patent and the unpatented application,

¹ Gold and Silver Ore Co. v. Disintegrating Ore Co. 6 Blatch. 311, 1869.

and if, in that interference proceeding, the later applicant is adjudged to be the prior inventor, and if the application is otherwise unobjectionable, it becomes the duty of the Commissioner to grant him a patent.¹ The Commissioner has however no authority to recall the patent thereto be granted to the wrong party. That patent can be set aside by the courts alone.

§ 316. A suit in equity is the prescribed proceeding by means of which the interfering claims of two or more patents may be adjudicated upon, in point of comparative novelty.² The complainant in such a suit may be the patentee or assignee of either of the interfering patents, or a grantee or licensee thereunder; for all of these persons fall within the category mentioned in the statute: a category which includes every person interested in any one of the patents, or in the working of the invention claimed under any of them. The defendant may be any patentee, assignee or grantee who owns an interest in another of the interfering patents; for all such persons are "owners" thereof. It is neither necessary that all the possible complainants should join in a suit, nor that all the possible defendants should be brought before the court. The statute provides that no decree entered in such a suit shall affect either patent, except so far as the patent affected is owned by parties to the suit, or by persons deriving title under them after the rendition of such decree. The proper practice is to make all persons complainants who have a right, and who are willing, to be so made; and to make all persons defendants who are liable to be made so, and who reside or may be found in the district where the suit is brought. No person who neither resides nor is found in that district can be made a party defendant to a suit of this kind, any more than to any other equity suit in a Federal court.³

A bill cannot be filed in an interference suit, until the complainant's patent is actually granted;⁴ and until the defend-

¹ Revised Statutes, Section 4904.

Miller, 1 McCrary, 31, 1880.

² Revised Statutes, Section 4918.

⁴ Hoeltge v. Hoeller, 2 Bond, 388,

³ Liggett & Myers Tobacco Co. v. 1870.

ant's patent is actually granted, there is no occasion for such a bill. No cross-bill is either necessary or proper in a suit of this kind, because the statute provides that in such a suit, the court may adjudge either of the patents to be void. The defendant may therefore obtain all rightful affirmative relief without becoming himself a complainant in a cross-bill.¹

§ 317. There is but one issue of fact in an interference suit. That issue relates to the dates wherein the interfering matter was respectively invented by the interfering inventors. If the complainant's invention is the older, the defendant's interfering claim is void for want of novelty. And the complainant's interfering claim is void for want of novelty, if the defendant's invention is found to antedate the other. Evidence that a third person anticipated both inventors, is not admissible in an interference suit; because such evidence is not relevant to any decree the court has jurisdiction to make in such a case. Such evidence, if acted upon, would result in a decree voiding both patents. The statute authorizes a decree voiding either patent, but authorizes none voiding both. A decree voiding one, is not a decree impliedly validating the other. Such a decree leaves the successful patent open to every possible objection save want of novelty; and leaves it open to every possible objection of want of novelty, save such as might otherwise have been based on the existence of the unsuccessful patent; and leaves it open also to that objection, as between all persons, except the parties to the interference suit and their privies. If a defendant in an interference suit may attack the complainant's patent on the ground that a third person anticipated the complainant's invention, he may, with equal propriety attack it on any or all of the numerous other grounds upon which patents may be attacked in point of validity. To suppose that the statute of interference suits authorizes any such extended litigation, is apparently to misapprehend its purpose and misconstrue its language. These views are ventured, notwithstanding one district judge has decided the point in the opposite direction.²

¹ Lockwood v. Cleaveland, 6 Fed. Rep. 721, 1881.

² Foster v. Lindsay, 3 Dillon, 126, 1875.

§ 318. The evidence upon which interference suits are decided, consists of the best evidence on the question in issue. On this question the Commissioner's decision is *prima facie* evidence in favor of the patent last granted; because he would not have granted it if he had not decided it to be entitled to priority in point of date of invention.¹ The Commissioner's decision is not conclusive; because, if it were, the court would have no function but to enforce that decision; and because, if it were conclusive in law, it would bind nobody but the senior patentee. In such a case the operation of a decree based on a Commissioner's decision, if wrong in fact, would be to deprive a patentee of all right to make, use or sell the thing which he was the first to invent and the first to patent; and to throw that invention open to all the residue of the world.²

§ 319. Injunctions are not expressly authorized by the statute which provides for interference suits. Justice NELSON once decided that a preliminary injunction could be granted in such a case on the ground that "the power conferred upon the Circuit Court to entertain bills in equity, in controversies arising under the Patent Act, is a general equity power, and carries with it all the incidents belonging to that species of jurisdiction."³ Justice BLATCHFORD was of counsel for defendant in that case, and was its reporter; but when he came to the bench he declined to follow the precedent, saying, "I am not aware of any principle which would authorize the Court, in a suit of this character, to restrain a defendant from bringing suits on his patent, before that patent is adjudged to be invalid."⁴ Of course Justice BLATCHFORD was aware of what Justice NELSON had decided. He must therefore have held that the reason Justice NELSON gave was not a good one; unless there is a substantial difference between the forms of injunction asked for in the two cases. The injunction prayed before Justice NELSON was that the defendant be restrained

¹ Wire Book Sewing Machine Co. v. Stevenson, 11 Fed. Rep. 155, 1882.

² Union Paper-Bag Machine Co. v. Crane, 1 Holmes, 429, 1874.

³ Potter v. Dixon, 5 Blatch. 165, 1863.

⁴ Asbestos Felting Co. v. Salamander Felting Co. 13 Blatch. 454, 1876.

from using or selling his interfering patent; and the injunction prayed in the other case was that the defendant be restrained from bringing suits upon his interfering patent. In both cases the thing sought to be enjoined was an attempted enjoyment of the patented right. The two decisions seem therefore to be in conflict, and the law upon the point cannot be said to be settled.

§ 320. The hearing of an interference case may disclose that there is no interference between the patents before the court; or that there is such an interference. In the former event, the proper decree to enter is one dismissing the complainant's bill; and in the latter event, the proper decree is one adjudging the patent issued on the later of the inventions, to be void, so far as it secures the interfering matter, and so far as the title of the parties to the suit extends.¹ Such a decree should be entered regardless of whether the patent to be voided is that of the defendant or that of the complainant. If it is the latter, a decree merely dismissing the complainant's bill will not answer the purpose; because such a decree does not necessarily involve any such conclusion.² It may mean only that there is no interference; or it may merely mean that the complainant has no proper title to the patent which he invokes.

¹ *Gilmore v. Golay*, 3 Fisher, 522, 1869; *Sturges v. Van Hagen*, 6 Fisher, 572, 1873.

² *Tyler v. Hyde*, 2 Blatch. 310, 1851.

CHAPTER XIV.

REPEAL OF PATENTS.

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| 321. Patents obtained by fraud, or granted by mistake. | | patents so obtained or so granted. |
| 322. Jurisdiction of equity to repeal | | 323. Practice in such cases. |

§ 321. PATENTS and reissues may sometimes be obtained by fraud; and sometimes be granted by mistake. The facts which constitute the fraud, or which make the granting a mistaken one, may generally be interposed as one of the defences to an infringement suit; but where those facts are such that no one of those defences can be based upon them, they cannot be interposed merely because they constitute a fraud,¹ or constitute a mistake.² Nor can any individual bring any action to repeal or otherwise set aside a patent, on any ground of fraud; or indeed on any ground whatever, except that of an interference.³ Where frauds are ingenious enough to keep clear of all known defences to infringement suits, the wrongs which they cause are without a remedy, unless the United States can repeal a patent which its officers have fraudulently been induced to grant, or to reissue. So also, where a patent is granted by mistake, instead of being refused, as it ought; and where the ground of refusal does not constitute ground of defence to a suit for infringement; the wrongs which such a mistake will occasion must be remedied by a repeal of the patent, or they are remediless.

§ 322. Equity has jurisdiction to repeal letters patent for land, where they were obtained by fraud, or issued by mistake;

¹ Railroad Co. v. Duboise, 12 1869.
Wallace, 64, 1870.

² Mowry v. Whitney, 14 Wallace,

³ Doughty v. West, 6 Blatch. 433, 439, 1871.

whenever the United States files a bill stating the facts, and praying that the letters may be annulled.¹ This doctrine is equally applicable to patents for inventions, unless the Supreme Court mistook the law, when concerting its *obiter dictum* in *Mowry v. Whitney*.² Judge SHIPLEY was apparently of opinion that the Supreme Court did deviate on that occasion ; and in an *obiter dictum* of his own, he stated his reasons for taking the opposite view.³ Those reasons are not without weight ; and inasmuch as the point has never been adjudicated, it is at present impossible to know whether any court has jurisdiction, on any ground of fraud or mistake, to repeal letters patent for inventions. Assuming, however, that such a jurisdiction does inhere in some class of courts, it is possible to outline its character ; and to base that outline upon adjudicated cases of undoubted authority. That therefore is the remaining function of this short chapter.

§ 323. A bill to repeal a patent must be filed by the United States ;⁴ acting through the United States district attorney of the district wherein it is filed ;⁵ and it must be filed in the Circuit Court of the United States for that district ;⁶ and be filed before the expiration of the patent which it seeks to repeal.⁷ No citizen has any power to compel the United States or the district attorney to file such a bill ; or to control its prosecution after such a bill is filed.⁸ The filling in of this outline must await the passage of time, and the development of jurisprudence ; if indeed the whole subject of repeal of patents does not require to be founded on future legislation.

¹ *United States v. Stone*, 2 Wallace, 535, 1864.

² *Mowry v. Whitney*, 14 Wallace, 440, 1871.

³ *Attorney-General v. Rumford Chemical Works*, 2 Bann. & Ard. 308, 1876.

⁴ *Mowry v. Whitney*, 14 Wallace, 440, 1871.

⁵ *Attorney-General v. Rumford*

Chemical Works, 2 Bann. & Ard. 308, 1876.

⁶ Revised Statutes, Section 629, p. 9.

⁷ *Bourne v. Goodyear*, 9 Wallace, 811, 1869.

⁸ *New York & Baltimore Coffee Polishing Co. v. New York Coffee Polishing Co.* 9 Fed. Rep. 580, 1881.

CHAPTER XV.

QUI TAM ACTIONS.

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| <p>324. <i>Qui tam</i> actions, defined and described as they exist in the patent laws.</p> <p>325. The wrongs which are the foundations of such actions.</p> <p>326. The first two of those three classes of wrongs.</p> <p>327. The third of those three classes of wrongs.</p> <p>328. Wrongs of either class are completed when the articles are illegally marked, without any subsequent using or selling.</p> | <p>329. The amount of the recoverable penalty.</p> <p>330. The plaintiff must be one natural person.</p> <p>331. The forum for <i>qui tam</i> actions.</p> <p>332. The form of the suit, and the requisites of a declaration, in such an action.</p> <p>333. Injunctions to restrain the commission of wrongs of either of the first two classes.</p> <p>334. Appeals in <i>qui tam</i> cases.</p> |
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§ 324. THESE are certain actions at law, which derive their name from the Latin words *qui tam*, used at the beginning of the declaration in such an action, in times when all declarations were written in the Latin language. No such action was known to the common law of England; but several actions of the kind have long been prescribed by statute, in that country, and in this. *Qui tam* actions relevant to patents are authorized by Section 4901 of the Revised Statutes. That statute forbids certain classes of acts; and provides that whoever commits an act of either of those classes, shall be liable to a penalty of not less than one hundred dollars, with costs; and that any person may sue for that penalty, in any District Court of the United States within whose jurisdiction the offence was committed; and that one half of the penalty, when recovered, shall go to the plaintiff, and the other half to the United States.

§ 325. The forbidden acts are: 1. Unauthorized marking, upon any patented article, of the name, or any imitation of the

name, of the patentee. 2. Unauthorized marking, upon any patented article, of 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. 3. Marking upon any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public.

§ 326. The first two of these three classes of acts are injurious to the public, and to the patentees. They are injurious to the public in that they are adapted to mislead persons into buying and using articles which were made and sold in violation of patents, and which therefore cannot be lawfully used even by innocent purchasers. The law provides that those who have a right to make and sell patented articles shall mark those articles with the word "patented;"¹ and that other persons shall not so mark such articles.² When buying anything which is not so marked, a purchaser properly concludes that it is not patented, and that he may therefore use it without risk of a suit for infringement; and when buying anything that is so marked, the purchaser concludes, with equal propriety, that it was made and sold by the patentee or some one lawfully authorized by him, and that therefore it may be lawfully used to any extent desired. It is clear, that on these accounts, the first two of the forbidden acts are detrimental to public security, and therefore opposed to public policy. The same acts are also injurious to patentees, and they will be considered in that aspect in a subsequent section.

§ 327. The last of the three forbidden classes of acts is injurious to the public, in that it is adapted to mislead persons into an opinion that they have no right to make and use, or make and sell, other specimens of the thing marked as being patented. When an unpatented thing is so marked, it is immaterial whether it is a patentable thing or not.³ This point is so clear that it would not be thought to require or admit

¹ Revised Statutes, Section 4900.

² Revised Statutes, Section 4901.

³ *Oliphant v. Salem Flouring Mills Co.* 5 Sawyer, 128, 1878.

elaboration, had not a judge in one case expressed a contrary opinion.¹ Whether a thing is patentable or not depends on considerations of which the public as a whole are necessarily ignorant. They may therefore be deceived by seeing the word "patented" upon an unpatentable unpatented article, as readily as by seeing the same word on a patentable unpatented article. That word warns them not to copy that article. They are as reluctant to disregard that warning on a supposition that the article is not patentable, as they are on the hypothesis that it is not patented; and they are as effectually diverted from exercising their right to copy it in the one case as in the other.

Intent to deceive the public is a necessary element of the forbidden act now under consideration; and that intent does not exist when the person marking, is himself mistaken relevant to his right so to mark;² or where the word "patented" is accompanied by other words or characters which indicate that the article was once the subject of a patent, but that the patent has expired at the time of the marking.³ Inasmuch as all persons are presumed to intend the natural consequences of their acts, proof of an act which was adapted to deceive the public, is sufficient proof of the intent to deceive, unless the doer establishes his innocence of that intent. The burden of proof therefore lies upon the defendant, in this particular.⁴

§ 328. Proof that the article illegally marked patented was afterward sold, or was otherwise presented to the notice of the public, is not a necessary element in either of the acts which are forbidden by the statute; but proof that the intent to deceive the public existed when the marking was done is such an element. Accordingly, if a person illegally marks an article, his offense is complete, and is not condoned by a subsequent omission to profit by that offense; but where a person marks

¹ *United States v. Morris*, 2 Bond, 27, 1866.

² *Walker v. Hawxhurst*, 5 Blatch. 494, 1867.

³ *Wilson v. Mfg. Co.* 12 Fed. Rep. 57, 1882.

⁴ *Brig Struggle v. United States*, 9 Cranch, 74, 1815.

an article without any intent to deceive, and afterward uses the article so marked, for purposes of deception, he does not violate the statute.¹

§ 329. The penalty prescribed by the statute for either of the forbidden acts is “not less than one hundred dollars;” and Justice CURTIS well decided that such language must, in a penal statute like this, be strictly construed, and that, when so construed, it authorizes a penalty of precisely one hundred dollars and no more.² The district judge in the same district, in a later case, instructed a jury to assess the “damages” not less than one hundred dollars and as much more as they thought proper.³ That instruction was not accompanied by any reasoning on the subject, and was apparently made in ignorance of the elaborate contrary decision of Justice CURTIS. The latter decision may therefore safely be said to embody the law on this point.

§ 330. The plaintiff in a *qui tam* action for illegally marking a patented or unpatented article, may be any “person.”⁴ It was decided under a similar statute relevant to copyrights, that a plurality of persons could not join as plaintiffs in an action of the kind.⁵ The language of that copyright statute was identical with that of the present patent statute in this particular; and the same good reasoning which carried the court to its conclusion in the copyright case, will probably carry any court to the same conclusion in any *qui tam* action under the patent statute. The person who sues must be a natural and not an artificial person; and he must sue in his own name and not in that of the United States.⁶

§ 331. Jurisdiction in *qui tam* actions, unlike that in other kinds of patent suits, is conferred upon District Courts, not upon Circuit Courts, of the United States, and is conferred upon the particular court within the district of which the forbidden

¹ Nichols v. Newell, 1 Fisher, 647, 1853.

² Stimpson v. Pond, 2 Curtis, 502, 1855.

³ Nichols v. Newell, 1 Fisher, 659, 1853.

⁴ Revised Statutes, Section 4901.

⁵ Ferrett v. Atwill, 1 Blatch. 153, 1846.

⁶ United States v. Morris, 2 Bond, 27, 1866.

act was committed, rather than upon the court of any district within which the defendant resides or may be found.¹ There is, however, another section of the Revised Statutes which provides that "All pecuniary penalties and forfeitures may be sued for and recovered either in the district where they accrue or in the district where the offender is found."²

§ 332. The proper form of common law action, in *qui tam* cases, is that of debt.³ Inasmuch, however, as no particular form is prescribed by the Federal statute, the code forms of complaints or petitions are to be used in code States.⁴ The declaration, complaint, or petition, as the case may be, ought to state all the elements of the forbidden act upon which it is based;⁵ and to charge that the act was contrary to the form of the statute in such cases made and provided.⁶ It is not enough to charge that the act was contrary to the law in such cases made and provided;⁷ but to aver it to have been contrary to the form of the statutes in such cases made and provided, though inartistic, is not fatal.⁸ It is not necessary to aver the uses to which the penalty when recovered, is to be applied.⁹

§ 333. The first two of the classes of acts, forbidden by Section 4901 of the Revised Statutes, are not only injurious to the public, in the manner already explained; but they are also injurious to the rightful patentees. Such acts enable infringers to increase the amount of their infringements, by inducing the public to believe that the articles they sell were lawfully made, and may be lawfully sold and used. So also, such acts may enable infringers to palm off on the public an inferior article, the using of which will disappoint the pur-

¹ Revised Statutes, Section 4301.

² Revised Statutes, Section 732.

³ *Stimpson v. Pond*, 2 Curtis, 505, 1855; *Jacob v. United States*, 1 Brockenbrough, 520, 1821.

⁴ Revised Statutes, Sections 721, 914.

⁵ *Ferrett v. Atwill*, 1 Blatch. 155, 1846.

⁶ *Sears v. United States*, 1 Gallison, 259, 1812.

⁷ *Smith v. United States*, 1 Gallison, 264, 1812.

⁸ *Kenrick v. United States*, 1 Gallison, 273, 1812.

⁹ *Sears v. United States*, 1 Gallison, 259, 1812.

chaser, and thus operate to injure the reputation of the genuine thing. For these reasons, it has been held that a person who is guilty of an act of either of the first two classes, may be restrained by an injunction from any repetition of such an act.¹

§ 334. A writ of error lies to the Circuit Court for the same district, from the final judgments of a District Court, in a *qui tam* patent case, because such a case is a civil case,² and because the matter in dispute in every such case exceeds the sum of fifty dollars ;³ but no such writ of error lies from the Circuit Court to the Supreme Court, unless at least fifty penalties can be recovered in one action, and a judgment for five thousand dollars thus be obtained ;⁴ for a *qui tam* patent case is not a case touching a patent right.⁵ Such actions are based on pretensions of patent rights, where no such right exists.

¹ Washburn & Moen Mfg. Co. v. Haish, 4 Bann & Ard. 571, 1879.

² Jacob v. United States, 1 Brock-enbrough. 525, 1821.

³ Revised Statutes, Section 633.

⁴ Revised Statutes, Section 692, 18 Statutes at Large, Part 3, Ch. 77, Sec. 3, p. 316.

⁵ Revised Statutes, Section 699.

CHAPTER XVI.

INFRINGEMENT.

335. Infringement of process patents, illustrated by the case of *Tilghman v. Proctor*.
336. Illustrated by the case of *Mowry v. Whitney*.
337. Illustrated by the case of *Cochrane v. Deener*.
338. Equivalents in processes.
339. Infringement of patents for machines or manufactures.
340. Comparative results.
341. The test of comparative modes of operation.
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344. As illustrated by *Blanchard's* patent for turning irregular forms.
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347. Addition.
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354. Question of the necessity of age in equivalents, stated and considered in the light of the views of Justice CLIFFORD.
355. The same question considered in the light of the cases of *Mason v. Graham* and *Clough v. Mfg. Co.*
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366. Illustrated by the case of *Morey v. Lockwood*.
367. Illustrated by the case of the *American Diamond Rock Boring*

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| <p>Co. v. The Sullivan Machine Co.</p> <p>368. Illustrated by the case of Elizabeth v. Pavement Co.</p> <p>369. Infringement of patents for compositions of matter.</p> <p>370. Substitution of ingredients.</p> <p>371. Substitution of ingredients as illustrated by the Giant-Powder cases.</p> <p>372. Disclaimers of particular equivalents.</p> | <p>373. Changes of the proportions in compositions of matter.</p> <p>374. The various classes of compositions of matter.</p> <p>375. Infringement of patents for designs.</p> <p>376. Comparative utility not a criterion of infringement.</p> <p>377. Knowledge of a patent not a necessary element in its infringement.</p> |
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§ 335. A PATENT for a process is infringed by him, who, without ownership or license, uses substantially the process which the patent claims; whether or not he uses substantially the apparatus which the patent describes.¹ Infringement of a process patent may occur even where precise identity does not exist in respect of the process claimed by the patent, and that used by the infringer. In the leading case just cited, the apparatus used by the infringer was totally unlike that described by the patent; and the process used by the infringer differed from the patented process in several particulars. The claim of the patent was: "The manufacturing of fat acids and glycerine from fatty bodies by the action of water at a high temperature and pressure." The description of the process which was contained in the specification of the patent, stated that the water should be mixed with the fatty body in the proportion of two or three parts of fat, to one of water; and that the mixture should be heated to about 612° Fahrenheit; and should be subjected to a pressure sufficient to prevent the heat from converting the water into steam.

The infringer mixed from four to seven per cent of lime with the water and the fat; and heated the mixture to only about 310° Fahrenheit; and subjected it to a pressure correspondingly lower than what would have been necessary to prevent the conversion of the water into steam, if he had used the higher degree of heat. So also, he heated his mixture by means of superheated steam introduced into the vessel con-

¹ *Tilghman v. Proctor*, 102 U. S. 730, 1880.

taining it, instead of applying heat to the outside of the vessel ; and he maintained the intimacy of the mixture by continuously pumping the water from the bottom to the top of the mingled mass, instead of continuously forcing the mixture through a coil of tubes. Notwithstanding all these differences, the Supreme Court held the defendant's process to substantially include that of the patent, and therefore to be an infringement of the latter. This holding was not inconsistent with the opinion that the addition of the lime to the mixture, was a useful addition to the patented process, nor with the possibility that the defendant's method of maintaining the intimacy of the mixture, was superior to that of the patent, nor with the probability that the heating by the introduction of superheated steam, was more perfect than by conducting the heat into the mixture through the walls of the inclosing vessel, nor with the fact that the lower degree of heat and of pressure used by the defendant was more safe, and perhaps more economical, than the higher degree of each, which was suggested in the patent.

§ 336. Similar circumstances characterized the question of infringement in the case of *Mowry v. Whitney*.¹ The patent in that case covered a process, which consisted in taking cast iron car-wheels from their moulds as soon as they become solid enough to retain their shape ; and in immediately placing the wheels in a furnace or chamber, previously heated to about the temperature of the wheels when taken from the moulds ; and in thereupon reheating those wheels ; and then in causing them to finally cool with a great degree of slowness.

The infringer's process consisted in taking the wheels red hot from the moulds ; and in thereupon putting them in an unheated chamber, interlaying them with charcoal, and covering the whole with a perforated metal plate ; and in then causing the charcoal to burn so as to reheat the wheels to a somewhat indefinitely high temperature ; and in so adjusting the draft, as to make the charcoal burn out and the wheels to consequently cool down, with a great degree of slowness.

¹ *Mowry v. Whitney*, 14 Wallace, 620, 1871.

The Supreme Court found all of the steps of the complainant's process in the defendant's doings, though confessedly the reheating was done by different means, and the slow cooling regulated on different principles, from those which caused and controlled the corresponding parts of the complainant's process.

§ 337. The case of *Cochrane v. Deener*¹ involved the infringement of a patent for a process of winnowing impurities out of ground wheat, while the flour is being separated from the other parts of the meal by means of fine cloth sieves, commonly called "bolts." The patent described a suitable apparatus by means of which to practice this process. It consisted of a series of cylindrical sieves, covered with cloth of progressively finer meshes, and having within them a series of air pipes, so disposed that when the ground wheat was in the sieves, and the sieves were revolving, air blasts were blown from the ends of those pipes, into and among the particles of ground wheat. Those air blasts operated to blow the impurities through the opening in the top of the bolting chamber, at the same time that the revolutions of the sieves operated to separate the flour from the middlings. The result of the whole operation was to separate the ground wheat into three sorts of matter, and to place those three sorts in three different receptacles.

The defendant accomplished the same result, by winnowing the impurities out of the ground wheat, while the flour was being separated from the other parts of the meal, by means of fine cloth sieves. But the defendant's sieves were flat, and the air blasts were blown through those sieves from below and reached the impurities through the cloth, instead of reaching them from the ends of pipes located on the same side of the cloth, as that occupied by the ground wheat. The Supreme Court, however, held that process to infringe the complainant's patent, notwithstanding these differences.

§ 338. No process patent is infringed where any one of the series of acts which constitute the process is omitted by the

¹ *Cochrane v. Deener*, 94 U. S. 787, 1876.

supposed infringer, unless some equivalent act is substituted for the one omitted.¹ Precisely what constitutes equivalency, as between acts, has never been decided or stated by the Supreme Court. Reason seems to indicate that one act is the equivalent of another when it works in substantially the same way to accomplish the same result. Accordingly, it has been held that tamping oil wells with benzine, is equivalent to tamping them with water in respect of the series of acts which constitute the process covered by the Roberts torpedo patent.²

§ 339. Machines and manufactures may well be treated together in respect of infringement, because no exact line can be drawn between them, and because the same rules of infringement are applicable to both those classes of tangible things. A patent for a machine or manufacture is infringed by him, who, without ownership or license, makes, or uses, or sells any specimen of the thing covered by any claim of that patent. It is not an infringement of a patent, to make, use or sell any specimen of any invention described but not claimed therein ;³ because a patent covers only what it claims. But whoever infringes any one claim of a patent infringes the patent, whether or not it contains other claims which he does not infringe.⁴

Whether a particular thing made or used or sold by a particular person, infringes a particular claim of a particular patent, is always a question of fact. In some cases that question can readily be decided by the application of one rule of law, and sometimes by the application of another, and some-

¹ *Dittmar v. Rix*, 1 Fed. Rep. 542, 1880 ; *Hammerschlag v. Garrett*, 10 Fed. Rep. 479, 1882 ; *Cotter v. Copper Co.*, 13 Fed. Rep. 234, 1882.

² *Roberts v. Rotor*, 5 Fisher, 296, 1872.

³ *Howe v. Williams*, 2 Clif. 262, 1863 ; *Waterbury Brass Co. v. Miller*, 9 Blatch. 93, 1871 ; *Toohy v. Harding*, 4 Hughes, 253, 1880.

⁴ *Moody v. Fiske*, 2 Mason, 115,

1820 ; *Wyeth v. Stone*, 1 Story, 273, 1840 ; *Pitts v. Whitman*, 2 Story, 609, 1843 ; *Colt v. Arms Co.*, 1 Fisher, 108, 1851 ; *Pitts v. Wemple*, 2 Fisher, 10, 1855 ; *Foss v. Herbert*, 1 Bissell, 121, 1856 ; *Morris v. Barrett*, 1 Bond, 254, 1859 ; *Singer v. Walmsley*, 1 Fisher, 558, 1860 ; *McComb v. Brodie*, 1 Woods, 153, 1871 ; *McComb v. Ernest*, 1 Woods, 195, 1871.

times it can be decided only by the judicial sagacity of the tribunal before which the question is tried. Such relevant rules of law as are well established, will now be stated, and, as far as necessary, will be illustrated by describing the leading cases which embody them.

§ 340. The respective results of a machine or manufacture covered by the claim of a patent, and of a machine or manufacture alleged to infringe that claim, do not furnish a criterion by which to decide the question of infringement. Those results may be identical, while the things which produce them are substantially different. Any person may accomplish the result performed by a patented thing without infringing the patent, if he uses means substantially different from those of the patent.¹ To hold the contrary of this rule would be to retard, and not to promote the progress of the useful arts.² So also, on the other hand, the respective results of patented and alleged infringing machines or manufactures may be entirely different without causing the latter to escape the charge of infringement even when that charge is based on unlicensed using. This rule results from the well-established point of law that it is an infringement of a patent to use any machine or manufacture claimed therein, though such use is for a purpose which is not mentioned in the patent.³

§ 341. Mode of operation is a criterion of infringement on one side of that question, but not on the other. If the mode of operation of an alleged infringing thing is substantially different from that covered by the claim alleged to be infringed, it follows that the charge of infringement must be negatived;⁴ but if the mode of operation is substantially the same it does not follow that the charge of infringement must be affirmed. In that case the question must be decided by some additional criterion. To establish an infringement of a

¹ O'Reilly v. Morse, 15 Howard, 62, 1853.

² Smith v. Downing, 1 Fisher, 84, 1850.

³ Mabie v. Haskell, 2 Clif. 511, 1865; McComb v. Brodie, 1 Woods,

159, 1871; Zinn v. Weiss, 7 Fed. Rep. 916, 1881; Union Stone Co. v. Allen, 14 Fed. Rep. 353, 1882.

⁴ Smith v. Downing, 1 Fisher, 83, 1850; Eames v. Cook, 2 Fisher, 149, 1860.

claim, the facts must be subjected to several successive tests. If the case fails on either of those tests, no further inquiry need be made ; but an infringement cannot be affirmed till all those tests have been applied and have been withstood. The first of these is that which relates to identity of mode of operation. It is therefore important to know wherein this requisite identity consists. A dogmatic statement on that point has probably never been ventured by any court. The nature of the question seems not to admit of an answer which shall be at once short and sufficient. The best way to investigate the subject is probably to reason by analogy from precedents ; and accordingly several of the sections which immediately follow, are devoted to an analysis of cases, with a view to furnishing the investigator with data for such reasoning.

§ 342. The Cawood patent¹ covered a machine which combined the mode of operation of an anvil, with the mode of operation of a vise. A drawing of the machine is printed on page 492 of 1 Wallace. The railroad rail mended upon it, was supported by it as by an anvil ; and at the same time was clasped by it as by a vise. The Supreme Court held that the "Michigan Southern" machine did not infringe the Cawood patent, because while that machine did clasp the rail as a vise, it did not support the rail as an anvil. The same tribunal also held that the Beebe and Smith machine did not infringe the Cawood patent, because its mode of operation was different. It both supported and clasped the rail, but it clasped it by holding it between two jaws, which jaws, when in position, rested in a V-shaped notch in the anvil. The exterior of the jaws were also V-shaped, in order to fit the notch, and they clasped the rail because of their gravity, and not in the manner of a vise. They also supported the rail, but in a manner peculiar to themselves, and not in the manner of an anvil.

§ 343. The driven-well patent, reissue No. 4372, covers an interesting invention. That invention is practised by driving into the ground a long tube closed and pointed at its lower

¹ Cawood Patent, 94 U. S. 706, 1876.

end, and having perforations through its sides just above that end ; and by attaching a pump to its upper end ; and by working that pump whenever water is desired. The mode of operation of that well is as follows : The working of the pump creates a vacuum in the tube, and that vacuum in turn creates a vacuum outside of the tube in the neighborhood of its lower end, and the latter vacuum draws to itself all the water in several millions of cubic feet of the surrounding earth.

The alleged infringer in one case,¹ followed the patent in every particular except that instead of driving the tube into the earth, or into a hole previously made by driving down a rod smaller than the tube, he bored a hole into the earth with an augur larger than the tube which he placed in the hole after the augur was withdrawn. This apparently slight change caused the well to have a substantially different mode of operation from that covered by the patent. The pump, indeed, created the vacuum in the tube as before, but that vacuum created no vacuum around outside of the tube, because the space outside of the lower end of the tube was in direct communication with the external air, through the annular space which surrounded the tube throughout its entire length and which was due to the fact that the tube was smaller than the hole in which it was placed. Because of this difference, Judge McCrary, with excellent discrimination, held that the well of the defendant did not infringe the driven-well reissue.

Judges Shiras and Love afterward decided that reissue to be void, because they found it to be for a different invention from that covered by the original patent.² They based this finding on the fact that the original directed the hole to be made in the ground by driving down a rod, having a swell thereon, and directed the insertion, in the hole, of a tube somewhat smaller than the diameter of the swell of the rod ; and on the further fact that the original did not state that the pump must be attached to the tube by an air-tight

¹ *Andrews v. Long*, 12 Fed. Rep. 871, 1880.

² *Andrews v. Hovey*, 16 Fed. Rep. 396, 1883.

connection. The finding cannot be thought to stand on this last fact, because the original patent did state that water, when not flowing naturally, might be drawn from the tube by any of the known forms of pump, and because it could not be so drawn without an air-tight connection between the pump and the tube. But the first fact stated by the judges to support their finding was alone sufficient to have that effect. That fact showed the original patent to be confined to an invention identical with that which, in the former case, Judge McCrary had held to be substantially different from the invention covered by the reissue, and which was substantially different because it had a different mode of operation.

§ 344. Blanchard's patent for a machine for turning and cutting irregular forms, consisted of a combination of a model, a guide, and a cutter wheel. When the machine was in operation the guide followed the irregularities of the model, as the model revolved, and the guide also caused the cutter to follow the same irregular curves while the rough block was revolved under the cutting edges. Both model and block had a continuous lateral motion, as well as a continuous rotary motion, and therefore the guide and the cutter wheel proceeded in corresponding spiral courses. In that way the guide traversed all parts of the surface of the model, and the cutter-wheel traversed all portions of the rough block, and thus reduced the latter to conformity with the shape of the model. An infringer in one case¹ so combined the parts of the machine, that the model and rough block both rotated by an intermittent motion, and moved laterally by a rectilinear reciprocating motion. Justice Grier held that this mode of operation was substantially unchanged from that of the patent.

§ 345. Hayden's patent for a machine for making brass kettles consisted of two general divisions. 1. An engine lathe with its mandrel to revolve the pulleys and the gearing, and having special devices for the special work in hand. 2. A furnishing or spinning tool and tool carriage, secured to the frame of the lathe, and having special devices to make it work

¹ Blanchard v. Reeves, 1 Fisher, 103, 1850.

harmoniously with the lathe in producing the kettles which the two divisions of the machine jointly operated to manufacture. These two divisions were operated by one motive power, like a shaft, which might be connected with a water wheel, or with a steam engine, or with any other suitable source of motion.

The infringer in one case¹ operated the first division of the machine by one such motive power; but he operated the second division by another, namely by the hand of a workman turning a crank. Judge WOODRUFF held that this was not such a change of mode of operation as amounted to enough to negative infringement.

§ 346. The Wells hat-body machine consisted of a revolving brush to separate and throw fibres of fur; a perforated vacuum cone to receive the fur on its exterior surface; and an intermediate tunnel, to guide the fur from the brush to the cone. The patent which was granted for that invention was three times surrendered and reissued. The second reissue was involved in a celebrated Supreme Court case.² That reissue described the machine which Wells invented, and it claimed the mode of operation, substantially as described, of forming bats (hat bodies) of fur fibres. The object of this claim was to cover the machine of Seth Boyden, a machine which had the same general mode of operation as that of Wells, but which was substantially different from the latter in one of its parts. This attempt to base a charge of infringement on sameness of "mode of operation" alone, was occasioned by the fact, that Justice CURTIS, in delivering the opinion of the Supreme Court in the case of *Winans v. Denmead*,³ had used the phrase with great frequency. He used it exactly twenty times in that case; and the counsel for the Wells patent, when arguing the case of *Burr v. Duryee*, formulated seven doctrines which they stated were deducible from that score of instances. Among those doctrines, the fourth was this:

¹ *Waterbury Brass Co. v. Miller*, 9 Blatch. 94, 1871.

² *Winans v. Denmead*, 15 Howard,

³ *Burr v. Duryee*, 1 Wallace, 531 330, 1853.

That copying a mode of operation is an infringement. But Justice GRIER, who was one of the majority of the court which decided *Winans v. Denmead*, was convinced that the latter decision was erroneous, or that it did not mean what it was generally understood to signify, for in *Burr v. Duryee* he delivered the unanimous opinion of the Supreme Court rejecting the complainant's contention in terms bordering on those of contempt. The case of *Winans v. Denmead* cannot therefore be fairly cited as an authority on this point, for if it is not consistent with *Burr v. Duryee*, it was overruled by the latter, and if it is consistent with the latter case, its expressions are likely at least to mislead the reader, as they misled the counsel for the Wells patent. Harmoniously with its decision in *Burr v. Duryee*, the Supreme Court has ever since had a positive tendency to disregard whatever is abstract and intangible in questions of infringement, and to base its conclusions upon the concrete features of the issues at bar.

§ 347. Addition to a patented machine or manufacture does not enable him who makes, uses or sells the patented thing with the addition, to avoid a charge of infringement.¹ This is true even where the added device facilitates the working of one of the parts of the patented combination, and thus makes the latter perform its function with more excellence and greater speed.² But there is a necessary qualification of this rule, which must not be overlooked; a qualification founded as yet upon no adjudicated case exactly in point, but based on considerations of justice which cannot be ignored nor disputed. If a patented combination differs from some older combination, only in the omission of one of the parts of the latter, and in a resulting difference of mode of operation, the restoration of the older structure by adding the part which the patented combination omitted, would not constitute an infringement of the latter.

§ 348. Changing the relative positions of the parts of a machine or manufacture does not avert infringement where

¹ *Carr v. Rice*, 1 Fisher, 209, 1856.

² *Cochrane v. Deener*, 94 U. S. 786, 1876.

the parts transposed perform the same respective functions after the change as before.¹ In the first of the cases just cited, the thing transposed was a beater shaft in a corn-sheller; both in its original and in its new position, its function was to force the ears of corn into the throat of the sheller. In the second case, the thing transposed was the outlet vapor flue of a quicksilver furnace; and that flue operated in the same way to perform the same function in the infringing apparatus that it did in the patented furnace.

But changing the relative positions of the parts of a machine does avert infringement, where the changing of those positions so changes the functions of the parts, that the machine acquires a substantially different mode of operation, even though the result of the machine remains the same.² A suit for infringement cannot be sustained against him who makes, uses or sells a substantially different combination, even though it includes exactly the same ingredients as those claimed in combination by the patent in suit.³ The owner of a patent for a combination cannot suppress a newer, better and substantially different combination of the same ingredients.⁴

§ 349. Omission of one ingredient of a combination covered by any claim of a patent, averts any charge of infringement based on that claim.⁵ A combination is an entirety. If one of its elements is omitted, the thing claimed disappears. Every part of the combination claimed is conclusively presumed to be material to the combination, and no evidence to the contrary is admissible in any case of alleged infringement.⁶ The patentee makes all the parts of a combination material, when he claims them in combination and

¹ *Adams v. Mfg. Co.*, 3 Bann. & Ard. 1, 1877; *Knox v. Quicksilver Mining Co.* 6 Sawyer, 438, 1878.

² *Brooks v. Fisk*, 15 Howard, 221, 1853.

³ *Gill v. Wells*, 22 Wallace, 14, 1874.

⁴ *Seymour v. Osborne*, 11 Wallace, 555, 1870.

⁵ *Prouty v. Ruggles*, 16 Peters, 341, 1842; *Eames v. Godfrey*, 1 Wallace, 78, 1863; *Case v. Brown*, 2 Wallace, 320, 1864; *Dunbar v. Myers*, 94 U. S. 187, 1876; *Fuller v. Yentzer*, 94 U. S. 297, 1876.

⁶ *Vance v. Campbell*, 1 Black, 430, 1861; *Le Fever v. Remington*, 13 Fed. Rep. 86, 1882.

not separately.¹ A patentee may, however, describe all the devices in his machine or manufacture, and instead of claiming all or any particular portion of them in combination, may claim so much of the described mechanism as produces a particular described result. Such a claim is infringed by him who, without ownership or license, makes, uses or sells any apparatus made up of enough of the described devices to produce the specified result, by the specified mode of operation.² The rule stated at the head of this section is perhaps the best known and most frequently applied of all the rules which pertain to infringement; but it has no application to anything which depends upon a particular form for patentability, and which for convenience may be made in several sections. A shoe last, for example, even if made in only two sections, may infringe a patent for a last of the same shape, but which is made in three sections instead of in two.³

§ 350. No substitution of an equivalent for any ingredient of a combination covered by any claim of a patent can avert a charge of infringement of that claim.⁴ But like substitution of something which is not an equivalent, will have that effect.⁵ The doctrine of equivalents may be invoked by any patentee whether he claimed equivalents in his claim,⁶ or described any in his specification,⁷ or omitted to do either or both of those things. But where a patentee states in his specification that a particular part of his invention is to be constructed of a particular material, and states or implies that he does not contemplate any other material as being suitable for the purpose, it is not certain that any other material will be treated by a court as an equivalent of the one recommended in the patent.⁸ Combination patents would generally be

¹ *Water-Meter Co. v. Desper*, 101 U. S. 332, 1879.

² *Silsby v. Foote*, 14 Howard, 218, 1852.

³ *Mabie v. Haskell*, 2 Clif. 511, 1865.

⁴ *O'Reilly v. Morse*, 15 Howard, 62, 1853; *Imhaeuser v. Buerk*, 101 U. S. 655, 1879.

⁵ *Railway Co. v. Sayles*, 97 U. S.

562, 1878.

⁶ *Dental Vulcanite Co. v. Davis*, 102 U. S. 229, 1880.

⁷ *Union Metallic Cartridge Co. v. United States Cartridge Co.* 2 Bann. & Ard. 594, 1877.

⁸ *Aiken v. Bemis*, 3 Woodbury & Minot, 348, 1847; *Harris v. Allen*, 15 Fed. Rep. 106, 1883.

valueless in the absence of a right to equivalents, for few combinations now exist, or can hereafter be made, which do not contain at least one element; an efficient substitute for which could readily be suggested by any person skilled in the particular art.¹

§ 351. To define an equivalent is at present a weighty and difficult undertaking. It is weighty because many rights of property now depend, and always will depend, upon the definition. It is difficult because the deliverances of the Supreme Court upon the subject are inharmonious, and because none of those deliverances are accompanied by elementary reasoning on the merits of the question. The primary points are plain. The difficulties arise in the latter part of the problem; but the plain points require to be stated in order that the others may be methodically reached and intelligently discussed.

§ 352. One thing, to be the equivalent of another, must perform the same function as that other.² If it performs the same function, the fact that it also performs another function is an immaterial one.³ Therefore, it sometimes happens that a junior device is an equivalent of a senior device in a sense that will constitute it an infringement of a patent for the latter; at the same time that the senior device is not an equivalent of the junior device in a sense that will cause the former to negative the novelty of the latter.⁴ One thing may accordingly be an equivalent of another, though it does more than that other, but it cannot be such an equivalent if it does less.⁵ But the test of function is only the first of several tests of equivalency. The fact that one thing performs the same function as another, though necessary, is not sufficient to make it an equivalent thereof.⁶

¹ *Turrell v. Spaeth*, 3 Bann. & Ard. 458, 1878.

² *Machine Co. v. Murphy*, 97 U. S. 125, 1877.

³ *Foss v. Herbert*, 2 Fisher, 31, 1856; *Sarven v. Hall*, 9 Blatch. 524, 1872; *Wheeler v. Reaper Co.*, 10 Blatch. 195, 1872; *Kendrick v. Em-*

mons, 3 Bann. & Ard. 623, 1878.

⁴ *Loercher v. Crandal*, 11 Fed. Rep. 878, 1881.

⁵ *Bliss v. Haight*, 3 Fisher, 626, 1869.

⁶ *Eames v. Godfrey*, 1 Wallace, 78, 1863; *Conover v. Roach*, 4 Fisher, 12, 1857; *Merriam v. Drake*, 5 Fisher, 259, 1872.

§ 353. Function must be performed in substantially the same way by an alleged equivalent, as by the thing of which it is alleged to be an equivalent, in order to constitute it such.¹ This substantial sameness of way is not necessarily a theoretical scientific sameness. In a purely scientific sense, a screw always performs its function in a substantially different way from a lever, and in substantially the same way as a wedge. Screws and wedges are equally inclined planes, while a lever is an entirely different elementary power. But screws and levers can practically be substituted for each other in a larger number of machines, than screws and wedges can be similarly substituted. When a lever and a screw can be interchanged and still perform the same function with a result that is beneficially the same, they are said to perform the same function in substantially the same way.² But one thing may be an equivalent of another in one environment, and not such an equivalent in another situation.³ Springs and weights are generally equivalents ;⁴ but when the environment is such that a spring will operate successfully while a weight will not so operate, then they are not equivalents.⁵ While in most cases a mere handle is not an equivalent of a lever, it is such an equivalent where its connections are such that it performs the same function in substantially the same way.⁶ Indeed, in one case, the Supreme Court went to the length of deciding a confined column of water in a cylinder, worked by a pump and working a piston, to be an equivalent of a combination of a vibrating arm, toggle joint, and other mechanical devices, when used to transmit vibratory power.⁷

In view of the foregoing adjudications, and of the nature of the question, it is at present impossible to say precisely wherein the required sameness of way of performing a function really

¹ Sickels v. Borden, 3 Blatch. 535, 1856; Burr v. Duryee, 1 Wallace, 573, 1863; Werner v. King, 96 U. S. 230, 1877.

² Turrell v. Spaeth, 3 Bann. & Ard. 458, 1878.

³ Cochrane v. Deener, 94 U. S. 789, 1876.

⁴ Imhaeuser v. Buerk, 101 U. S. 656, 1879.

⁵ Cross v. Mackinnon, 11 Fed. Rep. 601, 1882.

⁶ Corn-Planter Patent, 23 Wallace, 235, 1874.

⁷ Blake v. Robertson, 94 U. S. 732, 1876.

consists ; and in view of the vast variety of present and future mechanical devices and modes of operation, it will probably be always impossible to formulate a criterion which will be applicable to every case. The safest reliance is upon the analogies of precedents, and upon the instructed sagacity of those who are called upon to advise and to decide in new cases.

§ 354. Whether a device, in order to be an equivalent of another, must have been known at the time of the invention or of the patent, is the final inquiry relevant to the characteristics of equivalents. It is a point of large importance. The affirmative view seems to have originated in the mind of Justice CLIFFORD, and to have originated there in the Fall of 1865. In November of that year he instructed a jury that a thing to be an equivalent of an article in a patent, must have been known at the date of the invention, and of the patent.¹ The rule of the Supreme Court, at that time, seems to have been that a thing might be an equivalent of a thing in a patent, if known to be such at the time of the infringement.² Indeed, Justice CLIFFORD himself, in 1861, had delivered a carefully prepared instruction to a jury, in which he said : “ You will regard the substantial equivalent of a thing as being the same as the thing itself, so that, if two machines do the same work, in substantially the same way, and accomplish substantially the same result, they are the same ; and so if parts of the two machines do the same work, in substantially the same way, and accomplish substantially the result, those parts are the same, although they may differ in name, form, or shape.”³ Engaged, as he then was, in defining an equivalent, he wholly omitted the element of age. Indeed, as late as October, 1865, he found a defendant's device to be an equivalent of a thing in a patent, because it performed the same function, in substantially the same way, and produced substantially the same result.⁴ Here is no allusion to any element of age in the characteristics of an

¹ *Union Sugar Refinery v. Matthiesen*, 2 Fisher, 629, 1865.

² *O'Reilly v. Morse*, 15 Howard, 123, 1853.

³ *Cahoon v. Ring*, 1 Clif. 620, 1861.

⁴ *Roberts v. Harnden*, 2 Clif. 506, 1865.

equivalent. That element was introduced into the definition later in the Fall. But no statute relevant to the subject was enacted in the interval, nor indeed at any other time, either before or since Justice CLIFFORD changed his views. Nor did Justice CLIFFORD ever announce the reasons which carried him to his altered definition. He, however, repeated the later proposition in several subsequent cases.

In *Seymour v. Osborne*,¹ he said, that in order to be an equivalent of a thing in a patent, a device must have been known at the date of the patent. In support of that statement he cited two cases, neither of which appears to relate to the precise point.² But after formulating the doctrine he was content to ignore it, and he reasoned out the question of infringement in the case with sole reference to the character of the defendant's machines, and without any regard to the point of time when any parts of those machines first became known. Indeed he expressly said that questions of infringement are best determined by a comparison of the machines. Now, it is evident that a comparison of two machines has no tendency to show whether a particular device in one of them, was or was not known when the other was patented.

In *Gould v. Rees*³ Justice CLIFFORD delivered the opinion of the Supreme Court, reversing a judgment in an action at law, because the judge had charged the jury that the omission of one of the elements of a combination, and the substitution of another mechanical device to perform the same function, will not avoid infringement. Now that instruction was clearly wrong, because it did not provide, as it ought, that the substitute must perform the same function in substantially the same way, in order to be an equivalent for the thing for which it is substituted.⁴ The Supreme Court, therefore, decided that the instruction was erroneous, but Justice CLIFFORD, in delivering the opinion, said, in effect, that it ought also to

¹ *Seymour v. Osborne*, 11 Wallace, 556, 1870.

² *Prouty v. Ruggles*, 16 Peters, 341, 1842; *Johnson v. Root*, 2 Clif. 123, 1862.

³ *Gould v. Rees*, 15 Wallace, 193, 1872.

⁴ *Burr v. Duryee*, 1 Wallace, 573, 1863; *Sickels v. Borden*, 3 Blatch. 535, 1856.

have been limited by the proviso that the thing substituted should have been known at the date of the patent. The case did not call for any decision on that point, because the undoubted error in the charge was enough to require a reversal of the judgment. Nor is the *dictum* supported by any reasoning, or by any citation of authority other than the previous *dictum* of the same justice in the case of *Seymour v. Osborne*. It is true that the doctrine is repeated on page 194, in the same paragraph with an undeniable doctrine of the patent law, and the whole paragraph purports to be supported by nine cited cases. But none of those cases has any relevancy to the point now under examination, though they do support the other doctrine of the paragraph.

In *Gill v. Wells* Justice CLIFFORD repeated his revised definition of an equivalent, and stated that it was based on repeated Supreme Court decisions. He cited seven precedents to sustain this statement. Five of them have no apparent relevancy to the point,² and the other two are his own *dicta* in *Seymour v. Osborne*, and *Rees v. Gould*. He also cited his own prior decision in *Roberts v. Harnden*,³ but he who turns to that case will find that its definition of an equivalent is the former one; the one which omits the element of age. The repetition of the later *dicta* in *Gill v. Wells*, was also *obiter*, because, before repeating it, Justice CLIFFORD had delivered the opinion of the Court holding the instructions which the judge below gave to the jury on the question of the validity of the patent as a reissue, to have been erroneous instructions. In proceeding further Justice CLIFFORD was proceeding merely as a moot judge. Indeed, after laying down his rules on the subject of equivalents and of infringement, his Honor said that: "Inconveniences past estimation would result if those rules should be applied in defining the rights

¹ *Gill v. Wells*, 22 Wallace, 31, 1874.

² *Prouty v. Ruggles*, 16 Peters, 341, 1842; *Carver v. Hyde*, 16 Peters, 514, 1842; *Stimpson v. Railroad*, 10

Howard, 329, 1850; *Brooks v. Fisk*, 15 Howard, 212, 1853; *Vance v. Campbell*, 1 Black, 428, 1861.

³ *Roberts v. Harnden*, 2 Clif. 506, 1865.

of a patentee to make amendments to the specification of an original patent when applying for a reissue.”

Union Paper-Bag Machine Co. v. Murphy,¹ decided two years later than *Gill v. Wells*, was an equity suit which turned on the question of infringement. The court below found non-infringement, but the Supreme Court reversed that decision. In delivering the opinion Justice CLIFFORD returned to his earlier definition of an equivalent; to that definition which he gave sixteen years before in *Cahoon v. Ring*, and enforced twelve years before in *Roberts v. Harnden*. He now formulated his views as follows: “Authorities concur that the substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself; so that if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape.”

But in *Imhaeuser v. Buerk*² Justice CLIFFORD once more repeated his second and revised definition of an equivalent: the definition which he originated in the case of the *Union Sugar Refinery v. Matthiesen*. But after repeating it he ignored it, and reasoned out the question of infringement in the case, on the basis of his earlier definition: the definition in *Cahoon v. Ring*: the definition which ignores age, and confines itself to function and to character.

§ 355. No other Supreme Court justice has ever inserted just such doctrine as that of Justice CLIFFORD's second definition of an equivalent, into any opinion of that tribunal. Several cases have been adjudicated in that court, which called for the application of that doctrine, if it is a true one, but it has never been applied to any necessary issue pending therein. On the contrary, that court, subsequent to the case of *Gill v. Wells*, expressly decided that two things are equivalents where they perform the same function, in substantially the same manner.³ On the other hand Justice

¹ *Machine Co. v. Murphy*, 97 U. S. 656, 1879.
125, 1877.

³ *Mason v. Graham*, 23 Wallace,

² *Imhaeuser v. Buerk*, 101 U. S. 275, 1874.

BLATCHFORD said in a recent Supreme Court case, that the complainant at bar was "entitled, under decisions heretofore made by this Court, to hold as infringements all valve regulations applied to such combination which perform the same office in substantially the same way as, and were known equivalents for, his form of valve regulation."¹ But in so saying, Justice BLATCHFORD did not say that the complainant would not have been entitled to hold as infringements all valve regulations, applied to such a combination, which performed the same office, in substantially the same way. Nor is such a denial deducible by any fair implication from the facts of the case. Those facts could not only endure the milder test, but could also endure the other and severer one which results when the element of age is inserted in the definition of an equivalent. But the opinion contains no finding and no statement that the milder test would not have been sufficiently severe for the purpose in hand, if the facts had been unable to endure the more exacting criterion.

§ 356. Nearly all the Circuit Courts have uniformly ignored the element of age when inquiring about equivalents, and several of them have decided or stated that one thing is an equivalent of another where it performs substantially the same function, in substantially the same way.² Indeed, Justice CLIFFORD himself decided the third of these cases, the case of *Graham v. Mason*, and in doing so said that "It is a well-settled law that if one device is employed in a similar combination as another, and performs the same function in the same way, the two are substantially the same, although they may be different in form, and may be known among mechanics by different names." Probably only three Circuit Court cases,³ except a part of those decided by Justice CLIF-

¹ *Clough v. Mfg. Co.* 106 U. S. 178, 1882.

² *Conover v. Roach*, 4 Fisher, 26, 1857; *Conover v. Rap*, 4 Fisher, 61, 1859; *Graham v. Mason*, 5 Fisher, 11, 1869; *Harwood v. Mfg. Co.* 3 Fisher, 530, 1869; *Vogler v. Semple*,

7 Bissell, 382, 1877; *Evory v. Burt*, 15 Fed. Rep. 112, 1883.

³ *King v. Cement Co.* 6 Fisher, 341, 1873; *Webster v. Carpet Co.* 1 Bann. & Ard. 90, 1874; *Babcock v. Judd*, 5 Bann. & Ard. 130, 1880.

FORD, have ever recognized any such definition of an equivalent as embodies the element of age; and in only two of the three did any issue depend upon the soundness or unsoundness of that definition.

§ 357. Justice BLATCHFORD has had on the circuit a legitimate occasion to decide whether a thing, in order to be an equivalent of a device in a patent, must have been known at the date of the invention covered by that patent. That question arose and was argued before him in the case of the Batchelder Sewing Machine, and was decided in the negative.¹ Each claim of the Batchelder patent was for a combination. Among them the fourth consisted of four ingredients, and among those ingredients was a so-called perpetual feed.² That perpetual feed consisted of a belt armed with points and passing around rollers. The defendant substituted for that device a four-motion feed which was never known till long after the date of the Batchelder invention, and long after the date of the Batchelder patent. That fact of newness was urged as a reason for finding non-infringement, but Justice BLATCHFORD held it to constitute no ground for such a finding. The principle of his decision in this case, was also applied by the same judge to a question of electro-chemical equivalents in another.³

§ 358. The question, stated at the head of Section 354, has thus far been treated in the light of the precedents without regard to the reasons which must underlie the true answer. None of these precedents, save those established by Justice BLATCHFORD, seem to contain any argument on the point. The judges appear generally to have contented themselves with following such decisions or *obiter dicta* on the point, as were called to their attention, or as arose in their memory, and accordingly their deliverances are so diverse that they cannot be harmonized. But it may not be impossible to reach the true answer by a process of reasoning. Until such a process

¹ Potter v. Stewart, 18 Blatch. 563, 105, 1869.
1881.

³ United Nickel Co. v. Pendleton,

² Potter v. Braunsdorf, 7 Blatch. 15 Fed. Rep. 745, 1883.

is found to lead in another direction, it is probably best to rely upon the decision of the Supreme Court in *Mason v. Graham*, and upon that of Justice BLATCHFORD in *Potter v. Stewart*, rather than upon the *obiter dicta* of Justice CLIFFORD in *Seymour v. Osborne*, *Gould v. Rees*, *Gill v. Wells*, and *Imhaeuser v. Buerk*. Until such a process is found to establish another doctrine, it is safe to define an equivalent as a thing which performs the same function, and performs that function in substantially the same manner, as the thing of which it is alleged to be an equivalent.

§ 359. Primary inventions are entitled to a somewhat looser application of this definition of an equivalent, than those inventions which are secondary. A primary invention is one which performs a function never performed by any earlier invention. A secondary invention is one which performs a function previously performed by some earlier invention, but which performs that function in a substantially different way from any that preceded it. There are but two Supreme Court cases which have clearly attended to the distinction now under treatment.¹ In the first of these cases the court said: "If he [the patentee] be the original inventor of the device or machine called the divider, he will have a right to treat as infringers all who make dividers operating on the same principle, and performing the same functions by analogous means or equivalent combinations, even though the infringing machine may be an improvement of the original, and patentable as such. But if the invention claimed be itself but an improvement on a known machine by a mere change of form or combination of parts, the patentee cannot treat another as an infringer who has improved the original machine by use of a different form or combination performing the same functions. The inventor of the first improvement cannot invoke the doctrine of equivalents to suppress all other improvements which are not mere colorable invasions of the first."

In the last of these cases the court said: "In such cases, if

¹ *McCormick v. Talcott*, 20 Howard, 405, 1857; *Railway Co. v. Sayles*, 97 U. S. 556, 1878.

one inventor precedes all the rest, and strikes out something which includes and underlies all that they produce, he acquires a monopoly, and subjects them to tribute. But if the advance toward the thing desired is 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 theirs.”

The exact thought which resides in the breasts of the judges, probably cannot be learned from any mere reading of those two deliverances. They require analysis, and that analysis must be made in the light of several considerations which do not appear upon the face of the language used by the court. Let the mind be therefore directed a while to such an inquiry, before dropping the point and proceeding to another branch of the subject of infringement.

§ 360. Consider first the case of the primary patent. Such a patent is said in *McCormick v. Talcott* to be infringed by things “which operate on the same principle,” and “perform the same functions” by “analogous means” or “equivalent combinations.” Now, “operating on the same principle” doubtless means having the same “mode of operation ;”¹ and the signification of the latter phrase is now fairly well established in the patent law. “Performing the same functions” is a phrase still clearer in meaning, and equally just in its application to the matter in hand. But the expression “analogous means” leaves that important branch of the rule very much at large. “Analogous” signifies “bearing some resemblance.” Analogies are sometimes detected in things which on the whole are decidedly unlike. What proportion the likeness of two things must bear to their unlikeness, in order that they may constitute “analogous means” is a point upon which it is evident the court did not mean to be precise. “Equivalent combinations” doubtless signifies the same as “combinations of equivalents,” and

¹ *Burr v. Duryee*, 1 Wallace, 531, 1863.

therefore that branch of the rule gives to primary patents the benefit of the doctrine of equivalents heretofore explained.¹ All patents are entitled to that doctrine in some shape, but not all patents are entitled to suppress everything that could be called "analogous means" for performing its functions. Turning now to *Railway Co. v. Sayles*, it appears there to be stated that a primary patent is infringed by whatever it "includes and underlies." The emphasis here must be placed on the conjunction, because no patent is infringed by any combination of the parts it includes, unless that combination embraces all of the parts included in some one claim of the patent.² The word "underlie" is doubtless used metaphorically in this phrase. It cannot mean that one thing infringes the patent for another merely because it is mechanically placed upon that other, and is kept from falling to the ground by it. But the metaphorical meaning of the word "underlie" as applied to inventions, is not a precise meaning. It leaves scope to discretion in its application, and was doubtless so intended.

§ 361. Now consider the case of the secondary patent. *McCormick v. Talcott* states that such a patent is infringed only by "colorable invasions." That also is a metaphor. Its meaning seems to be "plain appropriation," or "undeniable infringement," undeniable, of course, in the eye of the law, and not necessarily undeniable by persons unacquainted with the established criteria, by means of which substantial identity or substantial difference is ascertained to exist in a given case. Turning again to *Railway Co. v. Sayles*, it is found there to be stated that a secondary patent is entitled only to its "specific form of device." But that statement is qualified near the bottom of page 561 by the addition of the words "or that which is substantially the same."

§ 362. The two cases seem therefore to teach general doc-

¹ Sections 350 to 358 inclusive.

² *Prouty v. Ruggles*, 16 Peters, 341, 1842; *Eames v. Godfrey*, 1 Wallace, 78, 1864; *Case v. Brown*,

2 Wallace, 320, 1864; *Dunbar v. Myers*, 94 U. S. 187, 1876; *Fuller v. Yentzer*, 94 U. S. 297, 1876.

trines rather than precise rules; and those general doctrines appear to be about as follows:

There are two tests of equivalency. 1. Identity of function. 2. Substantial identity of way of performing that function. Primary as well as secondary patents are infringed by no substitutions that do not fully respond to the first of these tests. The second of these tests is somewhat elastic, because it contains the word "substantial." That word is allowed to condone more and more important differences in the case of a primary patent, than in the case of a secondary one. In the case of a patent narrowed in construction by an extensive state of the preceding art, the word "substantial" will give but little elasticity to the application of the doctrine. If fewer inventions preceded the one at bar, the word will have somewhat more of carrying power. When the invention at bar is strictly primary, and especially if it is extremely useful, then the word substantial will be made to cover differences alike numerous and important, and even highly creditable to the infringer who invented them. Probably the most striking instances of the latter sort which are to be found in the books, are to be found in the telephone cases.¹

§ 363. A change of form does not avoid an infringement of a patent, unless the patent specifies a particular form as the means by which the effect of the invention is produced.² Even where a change of form somewhat modifies the construction the action or the utility of a patented thing, non-infringement will seldom result from such a change. The best way to show the scope and meaning of these rules is to collect and explain the instances in which changes of form have been held to be immaterial to questions of infringement.

§ 364. *Strobridge v. Lindsay*³ was a case, the patent involved in which, covered a coffee mill. The hopper and grinding shell of that mill were formed in a single piece, and

¹ *American Bell Telephone Co. v. Spencer*, 8 Fed. Rep. 509, 1881; *American Bell Telephone Co. v. Dolbear*, 15 Fed. Rep. 448, 1883.

² *O'Reilly v. Morse*, 15 Howard, 122, 1853.

³ *Strobridge v. Lindsay*, 6 Fed. Rep. 510, 1881.

were suspended within the box, by the upper part of the hopper, or by a flange thereon. The defendant's mill was like the complainant's, except that the hopper and the grinding shell were separate constructions, but were firmly fastened together before they were suspended in the box. That change of form resulted in a change of construction, but in no change of action or of utility. It was of course held not to avoid infringement.

§ 365. *Ives v. Hamilton*¹ was a case wherein the patent covered a combination of a saw-mill saw, with a pair of curved guides at the upper end of the saw; and a lever, connecting rod of a pitman, straight guides, pivoted cross-head, and slides or blocks, and crank-pin, or their equivalents, at the opposite end; whereby the toothed edge of the saw was caused to move unequally forward and backward at its two ends, while sawing. The result was a rocking or vibratory motion in the saw, instead of the straight reciprocating motion theretofore characteristic of saw-mill saws. The defendant substituted for the curved guides of the patent, similar guides made crooked by a broken line. But the Supreme Court held this change of form not to avoid infringement, saying that a curve is often treated even in mathematical science as constituting a succession of very short straight lines, or as one broken line constantly changing its direction.

§ 366. *Morey v. Lockwood*,² was a case in which the bill was based on the patent for the Davidson syringe; an invention which furnishes a good illustration of one of the rules which relate to infringement, as well as of one of those which relate to novelty. In it, the bulb was placed in an axial line with two flexible tubes, and received enema at one of its ends, from one of those tubes, and discharged the same, from its other end, into and through the other of those tubes. The Supreme Court held the patent to have been infringed by the Richardson syringe, in which the bulb was placed above the axial line of the two flexible tubes, and received the enema

¹ *Ives v. Hamilton*, 92 U. S. 431, 1875.

² *Morey v. Lockwood*, 8 Wallace 230, 1868.

from one of those tubes near the point where it discharged the same into the other.

§ 367. *The American Diamond Rock Boring Co. v. The Sullivan Machine Co.*,¹ was a case involving a patent for a rock-boring implement, consisting of a hollow metal boring head armed with diamonds, and which when moved with a combined rotary and forward motion, bored an annular hole into rock, leaving a central core to be subsequently broken by a wedge and then readily removed. The defendant used a rock-boring tool, consisting of a hollow metal boring head, but having its bottom partially plugged so as to leave two holes elsewhere than in the centre of the head, and having a convex surface armed with diamonds. This tool bored a simple hole into rock without leaving any core to be afterward removed. The change of form involved a modification of the action, and perhaps a modification of the utility of the implement, but it was held not to avoid infringement.

§ 368. *Elizabeth v. Pavement Co.*,² was a case based on the Nicholson pavement patent. That pavement consisted primarily of rows of parallel-sided wood blocks, set endwise, on a continuous foundation, the rows being separated by parallel-sided strips of board, set edgewise between them, and resting on the same foundation, and about half as wide as the blocks were long. The defendant made a pavement differing from the Nicholson in nothing, except that the sides of the strips were not parallel with each other, the strips being thicker at the top than at the bottom edge, and except that the upper angles of the strips were let into corresponding notches cut in the sides of the blocks. The Supreme Court held that though this change in the form of the blocks and of the strips might constitute an improvement in point of utility, it did not operate to avoid infringement.

§ 369. Patents for compositions of matter give rise to questions of infringement somewhat peculiar to themselves. In-

¹ *American Diamond Rock Boring Co. v. Sullivan Machine Co.* 14 Blatch. 119, 1877.

² *Elizabeth v. Pavement Co.* 97 U. S. 137, 1877.

fringement depends, in such cases, upon sameness or equivalence of ingredients, and upon substantial sameness of the proportions of those ingredients. Omission of one or more of the ingredients of a patented composition of matter, avoids infringement, as truly as omission of one of its parts avoids infringement of a patent for a combination of mechanical devices. Addition to a patented composition of matter, of an ingredient which the patent purposely avoided, and which when added substantially changes the character of the composition, also avoids infringement.¹ But an addition which results in no substantial change of character, and which was made merely for the purpose of an attempt to evade the patent, will not have that effect.²

§ 370. Substitution of one equivalent for another, in a patented composition of matter, is generally as ineffectual to avoid infringement as is like substitution in a machine. An equivalent for one ingredient of a patented composition of matter is anything which in that composition performs the same function as that ingredient.³ In the case cited, it was held that chloride of zinc in solution was an equivalent of common dry salt, in the composition of matter covered by the patent at bar, "because in the process of manufacture they practically produce the same results." No attention was given to the question whether they produced that result in substantially the same way. So also the Supreme Court has held that the term "equivalent" means "equally good" when it refers to the ingredients of compositions of matter.⁴ Where the composition of matter involved, is a compound of metals, an equivalent of either of those, is another metal having similar properties, and producing substantially the same effect in that composition.⁵

§ 371. A substituted ingredient may perform the required function better than the patented ingredient, and may perform

¹ *Byam v. Eddy*, 2 Blatch. 521, 131, 1872.
1853.

² *Rich v. Lippincott*, 2 Fisher, 6, 1853.

³ *Woodward v. Morrison*, 1 Holmes, 609, 1860.

⁴ *Tyler v. Boston*, 7 Wallace, 330, 1868.

⁵ *Matthews v. Skates*, 1 Fisher,

that function in a somewhat different manner, and still be an equivalent for the latter.¹ In the case cited the patent covered a compound of nitro-glycerine and absorbent matter, of which infusorial earth was stated to be the preferred variety. The absorbent matter, when mixed with three times its weight of nitro-glycerine, absorbed the whole, and still retained the form of a powder. This compound made dynamite. The defendant's compound consisted of nitro-glycerine and mica scales mixed in nearly equal proportions, the mica scales not absorbing the nitro-glycerine, but merely holding it in suspension upon their surfaces. This compound was called mica powder. Its use at the Hoosac Tunnel demonstrated its superiority over dynamite, in point of efficiency, economy, and safety; and there is evidently a difference between a powder which absorbs a liquid as in minute capillary tubes, and one which does not absorb, but which carries a liquid upon the surfaces of its particles. But notwithstanding these differences Judge SHEPLEY in an accomplished opinion, held the mica powder to infringe the dynamite patent. So also, in a later case on the same patent,² the same judge held a certain gunpowder to be an equivalent of the infusorial earth, because it performed every function of the latter substance, though it also performed the additional function, at the time of the explosion of the compound, of co-operating with the nitro-glycerine in rending the rock, instead of remaining, like infusorial earth, an inert substance. The doctrine which results from this case is that one ingredient is an equivalent of another in a composition of matter, if it performs the same function, even though it also performs another function, which that other is wholly incompetent to accomplish.

§ 372. When a patent expressly states that the composition of matter which it covers, does not include a specified ingredient of similar compositions, the substitution of that ingredient for one of those covered by the patent, is enough to avoid infringement, even though the two ingredients perform

¹ Atlantic Giant Powder Co. v. Mowbray, 2 Bann. & Ard. 447, 1876.

² Atlantic Giant Powder Co. v. Goodyear, 3 Bann. & Ard. 161, 1877.

the same function in that composition of matter. But this does not amount to saying that the two things are not equivalents. It merely amounts to the doctrine that a patentee may disclaim a particular equivalent if he chooses.¹

§ 373. Changes of the proportions of the ingredients of a composition of matter will not avoid infringement of a patent for such a composition, where those changes do not affect its essential character in any way more important than to increase its bulk more than they increase its cost.²

§ 374. The doctrines of the last five sections appear to be applicable to compositions of matter in general, whether they consist of chemical unions, or of mechanical mixtures, or of metal amalgams. Jurisprudence will doubtless follow science, if science hereafter shows any reason for distinguishing between the different classes of compositions of matter in respect of questions of infringement ; but no such distinctions are yet traceable in the adjudicated cases.

§ 375. A design patent is infringed by any design which, to observers in general, has the same appearance as that of the design covered by the patent.³ The fact that an analysis of two forms of design discloses differences between them, is therefore insufficient to show lack of that substantial identity of appearance, which constitutes infringement. Such a question of identity is to be decided on the basis of the opinions of average observers, and not upon the basis of the opinions of experts.

§ 376. The comparative utility of the plaintiff's and the defendant's process, machine, manufacture, or composition of matter, is not alone a criterion of infringement ; because the observed superiority of one over the other may have arisen from superiority of the materials or of the workmanship used in constructing the specimens under inspection. Indeed it was been held that the superiority or inferiority of utility in a defendant's machine, does not necessarily import non-infringe-

¹ *Byam v. Farr*, 1 Curtis, 260, 1852.

² *Eastman v. Hinckel*, 5 Bann. & Ard. 1, 1879.

³ *Gorham v. White*, 14 Wallace, 528, 1871 ; *Perry v. Starrett*, 3 Bann. & Ard. 485, 1878.

ment, even where it can be traced to slight differences in mode of operation.¹ No man is permitted to evade a patent by simply constructing the patented thing so imperfectly that its utility is diminished.² On the other hand, a defendant's machine may be better than that covered by the patent in suit; but if that superiority resulted from some addition to the latter, it will have no tendency to avoid infringement.³ Nor is infringement avoided by the fact that the defendant constructed and used his machine to produce one of the simpler of the forms of things produced by the machine of the plaintiff, and was thus enabled to produce a larger number in an equal space of time.⁴ The superiority or inferiority of a defendant's process, machine, manufacture or process of matter, as compared with that covered by a patent upon which he is sued, can generally be traced to its cause. When that can be done, attention should be taken from the difference in utility, to the cause of that difference. Non-infringement will result if that cause is such a difference in function, mode of operation, or character of construction, as is of itself sufficient to justify that conclusion. In some cases, however, it may not be possible to ascertain the cause of the observed difference of utility between two inventions, or to detect the existence of any such cause otherwise than by its effects. In such a case, a decided difference of utility is evidence tending to show substantial difference between the characters of the two inventions.⁵ When evidence of difference of utility between a plaintiff's invention and a defendant's doings, is introduced on an issue of infringement, it must be considered only in connection with all the other evidence upon that subject.⁶ If considered alone, it is likely to mislead, because difference of utility often springs from causes which do not constitute substantial difference of invention.

¹ *Waterbury Brass Co. v. Miller*, 9 Blatch. 77, 1871.

² *Chicago Fruit House Co. v. Busch*, 2 Bissell, 472, 1871; *Roberts v. Harnden*, 2 Clif. 506, 1865.

³ *Pitts v. Wemple*, 1 Bissell, 87, 1855; *Carter v. Baker*, 1 Sawyer,

512, 1871.

⁴ *Blanchard v. Beers*, 2 Blatch. 420, 1852.

⁵ *Many v. Sizer*, 1 Fisher, 27, 1849.

⁶ *Singer v. Walmsley*, 1 Fisher, 585, 1860.

§ 377. To constitute an infringement of a patent, it is not necessary that the infringer should have known of the existence of the patent at the time he infringed it ;¹ or, knowing of its existence, it is not necessary that he should have known his doings to constitute an infringement.²

¹ Parker v. Haworth, 4 McLean, 373, 1848 ; Matthews v. Skates, 1 Fisher, 608, 1860.

² Parker v. Hulme, 1 Fisher, 54, 1849.

CHAPTER XVII.

COURTS PARTIES AND CAUSES.

378. Introductory explanation.
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380. Question of the jurisdiction of State courts in patent cases stated.
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382. Supported in the negative from Justice STORY.
383. Supported in the affirmative from Justice WASHINGTON.
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385. Supported in the negative from Justice FIELD.
386. Considered in the light of all the foregoing opinions.
387. Supported in the negative by the text-writer.
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| <p>403. Agents, salesmen, and employees as defendants.</p> <p>404. Employers as defendants.</p> <p>405. Persons as defendants who have caused others to infringe.</p> <p>406. Joint infringers as defendants.</p> <p>407. What facts constitute joint infringement.</p> <p>408. Partners as defendants.</p> <p>409. Private corporations as defendants.</p> <p>410. Officers, directors, and stockholders of corporations as defendants.</p> | <p>411. The same subject continued.</p> <p>412. Stockholders of corporations.</p> <p>413. Officers of corporations.</p> <p>414. Directors of corporations.</p> <p>415. Statutory liability of officers, directors, and stockholders of corporations.</p> <p>416. Consolidated corporations as defendants in actions based on infringements committed by their constituent corporations.</p> <p>417. Causes of action based on a plurality of patents, or on both terms of an extended patent.</p> |
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§ 378. THE foregoing part of this text-book treats of the rights of inventors and patentees, and of their assignees, grantees, licensees, and legal representatives; and also treats of the wrongs which are committed when those rights are infringed. The remaining part explains the remedies which may be invoked, sometimes to prevent, and sometimes to repair such wrongs of infringement. The present chapter is devoted to the courts which may originally administer those remedies; and to the parties who may invoke them, and against whom they may be invoked; and to the causes of action which justify patent litigation between those parties in those courts.

§ 379. The Circuit Courts of the United States have original jurisdiction of all suits at law or in equity arising under the patent laws of the United States.¹ The District Courts of the United States for the Western District of Arkansas; the Eastern District of Arkansas at Helena; the Northern District of Mississippi; the Western District of South Carolina; and the District of West Virginia; have the same jurisdiction in patent cases that the Circuit Courts have in other districts.² The same jurisdiction belongs also to the District Courts of the Territories of Arizona, Dakota, Idaho, Montana, New

¹ Revised Statutes, Section 629.

² Revised Statutes, Section 571, as

amended January 31, 1877, 19 Statutes at Large, Ch. 41, p. 230.

Mexico, Utah, Wyoming,¹ and Washington;² and to the Supreme Court of the District of Columbia.³

§ 380. Whether State courts have any jurisdiction of actions for infringements of patents, is a question of great interest, upon which it is not possible, at this writing, to give a positive answer. Under the Revised Statutes, the question was clearly answerable in the negative;⁴ but in 1875 Congress enacted a statute which provided: "That the circuit courts of the United States shall have original cognizance, concurrent with the courts of the several States, of all suits of a civil nature at common law or in equity, where the matter in dispute exceeds, exclusive of costs, the sum or value of five hundred dollars, and arising under the Constitution or laws of the United States."⁵ The constitutional provision relevant to the subject is that: "The judicial Power of the United States, shall be vested in one Supreme Court, and in such inferior Courts as the Congress may from time to time ordain and establish."⁶ In view of this organic law, it is certain that Congress cannot confer any judicial power upon any other than Federal courts.⁷ Therefore the statute of 1875 could not have such an operation, even if it purported to do so, and it does not so purport. What it says about concurrent jurisdiction of the State courts, is by way of recital, rather than by way of grant. It appears to assume, that in the absence of congressional prohibition, the State courts would inherently have concurrent jurisdiction, and it removes the prohibition contained in the Revised Statutes.⁸

The real question therefore is, whether, in the absence of congressional prohibition, State courts have jurisdiction of

¹ Revised Statutes, Section 1910.

² Revised Statutes, Section 1911, as amended June 29, 1876. 19 Statutes at Large, Ch. 154, p. 62.

³ Sections 760 and 764 of the Revised Statutes relating to the District of Columbia. *Cochrane v. Deener*, 94 U. S. 782, 1876.

⁴ Revised Statutes, Section 711.

⁵ 18 Statutes at Large, Part 3, Ch. 137, Section 1, p. 470.

⁶ Constitution of the United States, Article 3, Section 1.

⁷ *Martin v. Hunter's Lessee*, 1 Wheaton, 330, 1816; *Houston v. Moore*, 5 Wheaton, 27, 1820.

⁸ Revised Statutes, Section 711.

actions arising under the constitution and laws of the United States. Upon that question, the great constitutional lawyers who have treated it, differ in opinion.

§ 381. The first in point of time, was that author whose opinions on law points never had the technical force of judicial decisions, but whose intellect was so extensive in its grasp, and so powerful in its operation, that whatever he wrote in the *Federalist*, is worthy to be cited on the most weighty occasions. In the eighty-second number of that splendid work, ALEXANDER HAMILTON treated the subject now under review, and treated it in the following terms :

“ The only thing in the proposed constitution, which wears the appearance of confining the causes of federal cognizance to the federal courts, is contained in this passage : ‘ The judicial power of the United States shall be vested in one supreme court, and in such inferior courts as the congress shall from time to time ordain and establish.’ This might either be construed to signify, that the supreme and subordinate courts of the union should alone have the power of deciding those causes, to which their authority is to extend ; or simply to denote, that the organs of the national judiciary should be one supreme court, and as many subordinate courts as congress should think proper to appoint ; in other words, that the United States should exercise the judicial power with which they are to be invested, through one supreme tribunal, and a certain number of inferior ones, to be instituted by them. The first excludes, the last admits, the concurrent jurisdiction of the state tribunals : and as the first would amount to an alienation of state power by implication, the last appears to me the most defensible construction.”

“ But this doctrine of concurrent jurisdiction, is only clearly applicable to those descriptions of causes, of which the state courts have previous cognizance. It is not equally evident in relation to cases, which may grow out of, and be peculiar to, the constitution to be established ; for not to allow the state courts a right of jurisdiction in such cases, can hardly be considered as the abridgement of a pre-existing authority. I mean not therefore to contend that the United States, in the course

of legislation upon the objects intrusted to their direction, may not commit the decision of causes arising upon a particular regulation, to the federal courts solely, if such a measure should be deemed expedient : but I hold that the State courts will be divested of no part of their primitive jurisdiction, further than may relate to an appeal ; and I am even of opinion that in every case in which they were not expressly excluded by the future acts of the national legislature, they will of course take cognizance of the causes to which those acts may give birth. This I infer from the nature of judiciary power, and from the general genius of the system. The judiciary power of every government looks beyond its own local or municipal laws, and in civil cases lays hold of all subjects of litigation between parties within its jurisdiction, though the causes of dispute are relative to the laws of the most distant part of the globe. Those of Japan, not less than of New York, may furnish the objects of legal discussion to our courts. When in addition to this we consider the State governments and the national governments, as they truly are, in the light of kindred systems, and as parts of one whole, the inference seems to be conclusive, that the State courts would have a concurrent jurisdiction, in all cases arising under the laws of the union, where it was not expressly prohibited.”

§ 382. Justice STORY, on the other hand, delivered an opinion of the Supreme Court in 1816, in which he said that : “ It can only be in those cases where, previous to the constitution, State tribunals possessed jurisdiction independent of national authority, that they can now constitutionally exercise a concurrent jurisdiction.”¹ The same great jurist also held the same opinion in his Commentaries on the Constitution.²

§ 383. Justice WASHINGTON, on the contrary, held to the views of HAMILTON. When delivering the leading opinion of the Supreme Court, in a case which was decided in 1820, he cited HAMILTON’s opinion and said : “ I can discover, I confess, nothing unreasonable in this doctrine ; nor can I perceive any

¹ *Martin v. Hunter’s Lessee*, 1 Wheaton, 337, 1816.

² *Story on the Constitution*, Section 1754.

inconvenience which can grow out of it, so long as the power of Congress to withdraw the whole, or any part of those cases, from the jurisdiction of the State courts, is, as I think it must be, admitted.”¹

§ 384. Chancellor KENT, in his Commentaries, reviewed the opinions of HAMILTON, STORY and WASHINGTON, and in conclusion stated his own view on the subject to be that : “ Without an express provision to the contrary, the State courts will retain concurrent jurisdiction, in all cases where they had jurisdiction originally over the subject-matter.”² Inasmuch as patent suits are outside of this category, the opinion of KENT is fairly citable with that of STORY on the negative side of the question now under review.

§ 385. Justice FIELD, in delivering a Supreme Court opinion in 1866, quoted extensively from the opinion delivered by Justice STORY in 1816, and said that the court agreed fully with his conclusion, that the judicial power of the United States is, in some cases, unavoidably exclusive of all State authority, and that in all other cases, it may be made so at the election of Congress.³ In a later case the same justice said, that : “ In some cases, from their character, the judicial power is necessarily exclusive of all State authority ; in other cases it may be made so at the option of Congress, or it may be exercised concurrently with that of the States.”⁴ In a still later case the same Justice covered the point in explicit terms, saying that : “ Some cases there are, it is true, in which, from their nature, the judicial power of the United States, when invoked, is exclusive of all State authority. Such are cases in which the United States are parties, cases of admiralty and maritime jurisdiction, and cases for the enforcement of the rights of inventors and authors under the laws of Congress.”⁵

§ 386. But neither of the foregoing five Supreme Court cases, is a true precedent on the question ; for though that

¹ *Houston v. Moore*, 5 Wheaton, 429, 1866.
26, 1820.

² 1 Kent's Commentaries, Lecture XVIII. p. 400.

³ *The Moses Taylor*, 4 Wallace, 1875.

⁴ *Railroad Co. v. Whitton*, 13 Wallace, 288, 1871.

⁵ *Gaines v. Fuentes*, 92 U. S. 17,

question was recognized and answered in them all, it was not necessarily involved in either. The remarks which those cases contain upon the subject must therefore rest for their weight as authority, upon the high character of the judges who delivered them, and not on that of the court which decided the cases.¹ On the affirmative of the issue we have the opinion and the reasons of HAMILTON, indorsed by Justice WASHINGTON. On the negative, we have the opinions of Justice STORY, Chancellor KENT and Justice FIELD; but those opinions are not accompanied by the reasoning out of which they arose. Therefore it may not be amiss to examine the point fundamentally.

§ 387. It cannot be claimed that the Constitution of the United States confers any jurisdiction on any State court; and it is clear that Congress has no power to do so.² Therefore, if such courts have jurisdiction of patent suits, that jurisdiction must be founded on some general principle of jurisprudence, existing outside of written edicts, or upon the general genius of our composite republic. HAMILTON inferred the jurisdiction from both these considerations, and he assigned no other ground therefor.

He stated his first premise in the following terms: "The judiciary power of every government looks beyond its own local or municipal laws, and in civil cases lays hold of all subjects of litigation between parties within its jurisdiction, though the causes of dispute are relative to the laws of the most distant part of the globe. Those of Japan, not less than of New York, may furnish the objects of legal discussion to our courts." But this premise seems to be broader than the principles of private international law will warrant. It is a maxim of that law, that whatever force the laws of one country have in another, depends solely upon the jurisprudence and polity of the latter.³ Rights originating in Japan, may be enforced by the courts of New York, provided similar rights exist under

¹ United States v. Lee, 106 U. S. Moore, 5 Wheaton, 27, 1820.
217, 1882.

² Martin v. Hunter's Lessee, 1 Wheaton, 330, 1816; Houston v.
³ Story on Conflict of Laws,
Section 23.

the laws of that State ; but HAMILTON was for once in error, when he wrote that the judiciary power of every government lays hold of all subjects of litigation between parties within its jurisdiction. No rights are more universally recognized throughout the world, than those which grow out of private contracts ; but not every private contract, made in Japan, and legally enforceable there, is enforceable in the courts of New York. For example, those courts can enforce no contract which is contrary to what the citizens and government of New York regard as good morals ; but the standard of good morals in New York is different from that which prevails in Japan. There is said to be a statute in Japan regulating the price at which girls are sold by their parents. There is no such statute in New York, and no right of action growing out of any such statute, can be enforced in the courts of that State, because the polity of that State does not include rights of property in daughters. Though for an entirely different reason, it is equally true that the polity of the State of New York does not include rights of property in inventions ; and such rights, being outside of its polity, are outside of the judicial cognizance of its courts. Consistently with these reasons, Justice FIELD remarked that cases for the enforcement of rights of inventors and authors, are, from their nature, exclusively cognizable in the United States courts.¹

HAMILTON stated his second premise in the following terms : “ When we consider the State governments and the national government, as they truly are, in the light of kindred systems, and as parts of one whole, the inference seems to be conclusive, that the State courts would have concurrent jurisdiction, in all cases arising under the laws of the union, where it was not expressly prohibited.” This reason appears to be faulty in both of its branches. It is not certain that kindred governments will always enforce each other’s statutes. Governments, like persons, may be kindred and still be substantially different in the polity which controls their conduct. So also, the fact that the State and national governments form parts of one whole,

¹ *Gaines v. Fuentes*, 92 U. S. 17, 1875.

does not lead to the conclusion that each part can naturally do whatever any other part can accomplish. We are indeed one republic, but we are a republic of departments. Some public business belongs to the national, and some to the State governments, and some can be performed by either. The fact of the unity of the republic has no tendency to prove what are the details of that distribution. No State can perform the functions of the nation, and logically allege the fact that it is a part of the nation to be a sufficient warrant for its exercise of national jurisdiction.

If the argument of this section is correctly drawn from correct foundations, it will follow that HAMILTON'S opinion is not supported by his reasons ; and as no other reasons seem ever to have been given for the jurisdiction of State courts over patent suits, it is probably safe to conclude that those courts have no such jurisdiction.

§ 388. Actions brought to enforce contracts between private parties, relevant to patent rights, are not actions arising under the patent laws of the United States ; and therefore are not cognizable as such, in the United States courts.¹ And actions to set aside such contracts fall in the same category.² These rules of law are well established, and are unchallenged. But a bare majority of a small quorum of the Supreme Court has gone further, and in spite of a vigorous dissent from the minority, has held another doctrine which it is more difficult to vindicate by reasoning. That doctrine is as follows. Where a complainant files a bill, in which he states a patent right, and states its use by the defendant ; and, in a charging part, recites the particulars of an alleged license claimed by the defendant to be a justification of that use, and avers that there is no such license in existence, and prays for an injunction, and an account of infringer's profits ; and where the defendant files an answer, admitting the patent right, and admitting the use, and defending only on the ground of the alleged license ;

¹ *Brown v. Shannon*, 20 Howard, 56, 1857 ; *Albright v. Toas*, 106 U. S. 613, 1882.

² *Wilson v. Sandford*, 10 Howard, 101, 1850.

then the action is not one arising under the patent laws of the United States.¹ This doctrine was held by Justices CLIFFORD, MILLER, FIELD, and HARLAN; and was dissented from by Chief Justice WAITE and Justices SWAYNE and BRADLEY. The dissenting opinion of the latter, is one of the most perfect specimens of judicial reasoning to be found in the Supreme Court reports. It seems to the text writer to be perfectly unanswerable, and he cannot forbear to praise it, while yielding a loyal submission to the conclusion of the majority. But there is no warrant for pressing that conclusion any further than it necessarily goes: no warrant for applying its doctrine to any case which lacks any of the elements upon which it was based.

Where a complainant files a bill in which he states a patent right, and states its use by the defendant, and says nothing about any contract or license, and prays for an injunction and an account of infringer's profits; and where the defendant thereupon files an answer in which he does not traverse any part of the bill, but pleads, by way of confession and avoidance, that he has a license which covers his use of the patent, it will not do to apply the rule in *Hartell v. Tilghman*. If that rule were applied to such a case, it would result in a dismissal of the bill for want of jurisdiction. Then if the complainant should file a new bill in a State court, precisely like the other, and if the defendant should thereupon file an answer saying nothing about any license, but denying the validity of the patent, that suit would also have to be dismissed, because it would present no controversy except one touching the validity of a patent for an invention. Any infringer of a patent could thus defeat every suit based on his infringement, by simply making one defence in one court, and another defence in another court, no matter how weak both of those defences might be. A consequence so unjust cannot be tolerated; and to prevent such a consequence it is necessary to hold, that where a plaintiff decides to sue a defendant as a naked infringer, the Federal courts have jurisdiction, and that such

¹ *Hartell v. Tilghman*, 99 U. S. 547, 1878.

jurisdiction cannot be ousted by any answer which the defendant may decide to interpose.

§ 389. Actions for infringement of patents, being transitory in their nature, may generally be brought in any district in which the defendant is an inhabitant or can be found.¹ Wherever the defendant is a natural person, he can therefore be sued in any district wherein he can be served with process; provided he is not decoyed or forced into that district for that purpose, nor caught there when attending court as a party or a witness. But where the defendant is a corporation, the matter of finding the defendant is not always so simple. Being intangible, a corporation cannot be seen with the eyes, as a natural person can. It exists ideally throughout the territory of the State which created it, and it exists nowhere else.² It can be found wherever, within that territory, one of its officers directors or agents can be discovered. Unless prohibited by its charter, or excluded by local law, a corporation may transact business in States wherein it has no corporate existence.³ For example, a Pennsylvania corporation may do business in New Jersey, and in the course of that business may infringe a patent there. Whether, under such circumstances, a corporation is "found" in New Jersey, by a United States marshal who serves process upon one of its officers or agents in that State, is a question which depends upon New Jersey law, and one which that law answers in the affirmative.⁴ A corresponding question is answered in the same way by the law of Illinois, though the Illinois statute which bears upon the subject, is general and not special, like that of New Jersey.⁵ In the case last cited, the business which the defendant Missouri corporation did in Illinois, included infringement of the complainant's patent. After that case was argued, and before it was decided, the present text writer argued a case before the same

¹ 18 Statutes at Large, Part 3, Chapter 137, Section 1, p. 470.

² *Bank of Augusta v. Earle*, 13 Peters, 519, 1839; *Railroad Co. v. Wheeler*, 1 Black, 286, 1861.

³ *Ex parte Schollenberger*, 96 U.

S. 378, 1877.

⁴ *Williams v. Empire Transportation Co.* 3 Bann. & Ard. 533, 1878.

⁵ *Wilson Packing Co. v. Hunter*, 4 Bann. & Ard. 184, 1879.

distinguished judge, in which still more advanced ground was held by the court. In that case the United States Circuit Court for the Northern District of Illinois held that it had jurisdiction of a bill, filed against the Grand Trunk Railway Co. of Canada, and based on infringement committed by that corporation in Michigan; service having been made on an agent of the corporation in its office in the Northern District of Illinois, although neither that agent, nor the business transacted in that office, had any connection with the infringement.¹

It does not follow from either of the foregoing cases, that every corporation is found wherever one of its officers or agents is caught. On the contrary, it is not possible to get jurisdiction of any corporation by serving process on even its president, unless the corporation exists under the laws of the State wherein the service is made, or is then doing some corporate business in that State.² Nor does it follow, from anything in this section, that every corporation can be sued in the Federal courts in every State wherein it does business. Whether that is the case in a particular instance, depends upon the statute of the State in which the business is done. It is probable that no State allows foreign corporations to do business within its territory without making them suable in its own courts. In effecting the latter result, most of the States have probably used statutory language broad enough to make those corporations equally suable in those Federal courts which sit within their boundaries. But it is also probable that some States have specified the particular State courts in which foreign corporations, doing business within their limits, shall submit to be sued, and have not used language broad enough to cover the Federal courts. Wherever that is found to be the fact, it is an omission which ought to be remedied by the State legislature, for it is clear that no State ought to permit any foreign corporation to come into its territory, and infringe the patents of its citizens, without providing that such a corporation shall consent to be "found" within that State,

¹ *Sayles v. Grand Trunk Railway Co.*, Manuscript, 1879.

² *Wilson Packing Co. v. Hunter*, 4 Bann. & Ard. 187, 1879.

in order to give the proper courts jurisdiction to administer a remedy.

§ 390. A number of exceptions exist to sundry of the rules stated in the last section ; and this section is devoted to stating and explaining those exceptions.

Where a State contains more than one district, every patent action brought in that State against a single defendant, who is an inhabitant of that State, must be brought in the district where he resides ; and where there are two or more defendants residing in different districts of a State, such an action, if brought against them in that State, must be brought in one of those districts.¹

Where a district contains more than one division, every such action brought in that district, against a single defendant who is an inhabitant of that State, must be brought in the division where he resides ; and where there are two or more defendants residing in different divisions of a district, such an action, if brought against them in that district, must be brought in one of those divisions. The districts to which this exception applies are the Southern of Georgia ;² the District of Iowa ;³ the Western of Michigan ;⁴ the Northern of Ohio ;⁵ the Southern of Ohio ;⁶ the Eastern of Tennessee ;⁷ the Western of Tennessee ;⁸ and the Western of Missouri.⁹

The Circuit Court for the Southern District of New York has no jurisdiction of any action based on any infringement committed in the Northern District of the same State.¹⁰ It has been held in one case that where such a suit is brought in the Southern District, the court will proceed to judgment

¹ Revised Statutes, Section 740.

² 21 Statutes at Large, Chap. 17, Sec. 4, p. 63.

³ 21 Statutes at Large, Chap. 120, Sec. 2, p. 155.

⁴ 20 Statutes at Large, Chap. 326, Sec. 3, p. 176.

⁵ 20 Statutes at Large, Chap. 169, Sec. 3, p. 102.

⁶ 21 Statutes at Large, Chap. 18,

Sec. 4, p. 64.

⁷ 21 Statutes at Large, Chap. 203, Sec. 5, p. 176.

⁸ 20 Statutes at Large, Chap. 359, p. 236.

⁹ 20 Statutes at Large, Chap. 20, Sec. 3, p. 263.

¹⁰ Revised Statutes, Section 657 ; *Hodge v. Railroad Co.* 6 Blatch. 85, 1868.

unless the defendant sets up the want of jurisdiction in his pleadings.¹ But this was apparently an error, because the Supreme Court has decided that no waiver or admission of the parties can give a court jurisdiction of any cause of which the law gives it no jurisdiction.² Courts cannot sit as arbitrators. Proceedings outside of their jurisdiction are void, and no waiver, neglect, or admission of parties can make them valid.

§ 391. The Court of Claims is the tribunal which has jurisdiction of all actions brought by owners of patent rights against the government of the United States, for compensation for implied licenses to the government, to make and use patented inventions.³ The case in which this point of law is established was decided by the Court of Claims in 1879, and affirmed by the Supreme Court November 20th, 1882. No opinion was delivered in the latter tribunal, though the questions involved in the case were both new and important. This omission to review the reasoning of the court below, was a deserved compliment to Judge NOTT, who delivered the opinion in the lower tribunal. That opinion is one of the most able patent case opinions ever rendered in the United States ; and not the least of its merits resides in the fact that the decision is confined to the precise issues at bar. The case being founded on an implied contract of license between the patentee and the government, no attempt is made in the decision to show whether the court would have had jurisdiction, if the doings of the government had been tortious.

§ 392. What remedy a patentee has when the government makes or uses specimens of his patented invention without his consent, is a question to which no positive answer can at present be given. All claims founded upon any law of Congress are cognizable in the Court of Claims.⁴ Claims for infringements of patents are founded on the patents infringed, and those patents are founded upon a law of Congress. Therefore a claim for an infringement is ultimately founded on a

¹ *Black v. Thorn*, 10 Blatch. 84, 1872.

² *Hipp v. Babin*, 19 Howard, 278, 1856.

³ *McKeever v. United States*, 23 Off. Gaz. 1525, 1879.

⁴ Revised Statutes, Section 1059.

law of Congress. It might thus appear that the Court of Claims has jurisdiction in such cases; but Justice BRADLEY has remarked that, "As its jurisdiction does not extend to torts, there might be some difficulty, as the law now stands, in prosecuting in that court a claim for the unauthorized use of a patented invention."¹ But perhaps a distinction may be drawn between torts upon ordinary property and torts upon patent rights, in respect of this question of jurisdiction. Torts upon ordinary property are outside the jurisdiction of the Court of Claims, because they cannot be said to be founded upon any law of Congress, and because the jurisdictional statute contains no other language suitable to cover them. But torts upon patent rights are ultimately founded upon the patent laws, and those laws are laws of Congress.

§ 393. But whether or not the Court of Claims has jurisdiction of a case based upon an unauthorized making or using by the government, of a patented invention, it is important to inquire whether, in such a case, an action will lie against those agents of the government who personally committed the infringement. On this point also Justice BRADLEY stated his opinion in an *obiter dictum* in the case last cited, saying: "The course adopted in the present case, of instituting an action against a public officer, who acts only for and on behalf of the government, is open to serious objections. We doubt very much whether such an action can be sustained. It is substantially a suit against the United States itself, which cannot be maintained under the guise of a suit against its officers and agents except in the manner provided by law. We have heretofore expressed our views on this subject in *Carr v. United States*, 98 U. S. 433." But the opinion in *Carr v. United States* was also delivered by Justice BRADLEY, and this part of it was afterward held by the Supreme Court to be an *obiter dictum*, and to be unsound.² The reasoning which, in the Lee case, carried the majority of the Supreme Court to the conclusion that agents of the government who unlawfully seize

¹ *James v. Campbell*, 104 U. S. 358, 1881.

² *United States v. Lee*, 106 U. S. 216, 1882.

and hold the lands of the citizen may be sued in the Circuit Courts, must ultimately carry that tribunal to the same conclusion, relevant to governmental agents who appropriate, on behalf of the government, the patent rights of an individual.

§ 394. The plaintiff or complainant in an action based on an infringement of a patent may be the patentee, or the sole assignee of that patent; or any grantee under a patent may sue alone, for any infringement committed within his territory.¹ It is not necessary for the plaintiff, in an action at law, to own any interest in the patent at the time he brings his action. It is enough if he was the patentee, assignee, or grantee of the rights infringed, at the time the infringement sued upon was committed.² But this rule does not generally apply to actions in equity, for such actions are generally dependent upon an injunction, and no injunction can be granted to restrain future infringements of a patent, on the suit of a person who has no interest in the patent threatened to be infringed.

§ 395. Actions at law brought by assignees or grantees, for infringements committed prior to the time they obtained title, must generally be brought in the name of the person who held the legal title to the patent right when and where it was infringed by the defendant. This common law rule was not abrogated by the federal statute which permitted suits to be brought by assignees, because the assignees which are contemplated by that statute are assignees of patents, and not assignees of rights of action under patents.³ Actions in equity, on the other hand, if maintainable at all in such a case, may be brought in the name of the assignee; and such an action will be maintainable where the suit is based on infringements and threatened infringements, committed after the complainant obtained title, as well as upon infringements committed before that event.⁴ An action in equity will also be main-

¹ Revised Statutes, Section 4919; 1868.
Wilson v. Rousseau, 4 Howard, 646,
1846; Stein v. Goddard, 1 McAlis-
ter, 82, 1856.

² Moore v. Marsh, 7 Wallace, 515,
1868.

³ Moore v. Marsh, 7 Wallace, 515, 1868;
⁴ Dibble v. Augur, 7 Blatch. 86,
1869; Henry v. Stove Co., 2 Bann.

tainable in such a case, if the assignor of the right of action was a corporation and has been dissolved or has expired ;¹ or if for any reason it is impossible for the assignee of the right of action to sue in the name of the assignor.² Where the assignor is dead at the time the assignee desires to bring an action at law, and where no legal representative of the assignor exists, or is likely to exist unless the appointment of one is obtained for the special purpose of using his name as nominal plaintiff in the assignee's suit, it would seem no great stretch of equity jurisdiction to allow the assignee to file a bill in his own name, and thus avoid the useless and expensive circuitry of compelling him first to secure the appointment of an administrator, and then to bring an action at law in the name of the latter. No principle adverse to such a proceeding was perceived by Chief Justice MARSHALL, when, in a similar case of expensive circuitry at law, the more direct and less expensive methods of equity were invoked before him.³

§ 396. Where a patentee, assignee, or grantee, who was entitled to sue for an infringement of a patent, died before beginning an action thereon, such an action may be brought by his executor or administrator, upon his fulfilling the conditions, and giving the guarantees of fidelity and solvency required by the law of the State wherein the court is established in which the action is proposed to be brought.⁴ But it is not certain, that, when beginning a patent action in a Federal court in a State other than that of his appointment, an executor or administrator must conform to the conditions, or give the guarantees, prescribed by the local laws.⁵

& Ard. 224, 1876; *Gordon v. Anthony*, 16 Blatch. 234, 1879; *Merriam v. Smith*, 11 Fed. Rep. 589, 1882; *Shaw v. Lead Co.*, 11 Fed. Rep. 715, 1882; *Consolidated Oil Well Packer Co. v. Eaton*, 12 Fed. Rep. 870, 1882.

¹ *Lenox v. Roberts*, 2 Wheaton, 373, 1817.

² *Hayward v. Andrews*, 106 U. S. 675, 1882.

³ *Riddle v. Mandeville*, 5 Cranch, 329, 1809.

⁴ *Rubber Co. v. Goodyear*, 9 Wallace, 791, 1869; *Wilkins v. Ellett*, 108 U. S. , 1882; *Picquet v. Swan*, 3 Mason, 472, 1824.

⁵ *Hodge v. Railroad Cos.* 4 Fisher, 162, 1870; *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 1 Bann. & Ard. 177, 1874.

Whether the various State laws, relevant to foreign executors or administrators suing in State courts, are binding in such cases as these, is a point upon which there appears to be a conflict of authority. The cases last cited appear to support the negative of the question, while those cited just before seem to sustain the affirmative view. It is possible that a distinction may be drawn on this point between actions based on patents, and actions arising out of local law and brought into Federal courts on grounds of diverse citizenship. If that distinction is found to be important, it may lead to a decision that executors and administrators may begin and prosecute patent cases in Federal courts in States other than that of their appointment, without any regard to the probate or other analogous laws of those States. If it is held otherwise, then the laws of the States relevant to the conditions upon which foreign executors or administrators are permitted to sue in their courts will require the attention of the practitioner in such cases. In some States those conditions amount to local probate, and in others they amount to no more than the giving of a bond for costs. But whether onerous or easy, and whether necessary or unnecessary to be regarded in patent cases, an omission to regard them cannot be availed of by a defendant, unless availed of in his pleadings.¹

§ 397. Where an executor or administrator of a deceased patentee, or assignee or grantee of a patent right, assigns that right to another, or assigns to another a right of action for its infringement; that other can sue thereon in any State without any proceedings in the nature of local probate; provided he can sue in his own name.² Whether he can sue in his own name will depend upon whether he is entitled to an injunction, or if not entitled to an injunction, it will depend upon whether equity can take jurisdiction on some other ground; or if not entitled to sue in equity at all, it will depend upon

¹ *Rubber Co. v. Goodyear*, 9 Wallace, 791, 1869.

² *Harper v. Butler*, 2 Peters, 238, 1829; *Trecothick v. Austin*, 4 Mason, 36, 1825; *Leake v. Gilchrist*, 2 Dev-

ereaux (N. C.) 73, 1829; *Peterson v. Chemical Bank*, 32 N. Y. 21, 1865; *Riddick v. Moore*, 65 N. C. 382, 1871.

whether the laws of the particular State authorize assignees of rights of action to bring actions at law in their own respective names.

§ 398. Patentees and other persons entitled to bring actions for infringements of patents, may appoint attorneys in fact to bring those actions in the names of the appointors ; but not in the names of the attorneys in fact.¹

§ 399. Owners in common of patent rights must sue jointly for their infringement, or the defendant may plead in abatement. This rule applies where a patentee has assigned an undivided part of his patent,² and also to cases where the owner of the patent has granted an undivided interest therein, in that part of the territory of the United States wherein the infringement sued upon was committed. In the first of these cases the action must be brought by the patentee and assignee jointly ; and in the other case it must be jointly brought by the owner of the patent and his grantee. Indeed the rule necessarily applies to every case where a plurality of persons own the undivided interest in a patent right, whether in the whole, or only in a part of the territory of the United States.

§ 400. Licensees under patents cannot bring actions for their infringement.³ Where a person has received an exclusive license to use or to sell a patented invention within a specified territory, all actions at law against persons who, without right, have done anything covered by the license, must be brought in the name of the owner of the patent right, but generally for the use of the licensee ;⁴ and all actions in equity must be brought by the owner of the patent right and

¹ *Goldsmith v. Collar Co.* 18 Blatch. 82, 1880.

² *Moore v. Marsh*, 7 Wallace, 515, 1868.

³ *Gayler v. Wilder*, 10 Howard, 477, 1850, *Paper-Bag Cases*, 105 U. S. 766, 1881 ; *Blanchard v. Eldridge*, 1 Wallace, Jr. 337, 1849 ; *Potter v. Holland*, 4 Blatch. 206, 1858 ; *Sanford v. Messer*, 1 Holmes,

149, 1872 ; *Nelson v. McMann*, 4 Bann. & Ard. 203, 1879 ; *Gamewell Telegraph Co. v. Brooklyn*, 14 Fed. Rep. 255, 1882 ; *Ingalls v. Tice*, 14 Fed. Rep. 297, 1882 ; *Wilson v. Chickering*, 14 Fed. Rep. 917, 1883.

⁴ *Littlefield v. Perry*, 21 Wallace, 223, 1874 ; *Goodyear v. McBurney*, 3 Blatch. 32, 1853.

the licensee suing together as joint complainants.¹ Actions at law brought in the name of the owner of a patent right, but actually begun by an exclusive licensee, may be maintained by the latter, even against the will of the nominal plaintiff.² And where an exclusive licensee brings an action in equity in the name of himself and the owner of the patent right, that action may be maintained without the co-operation and even against the objection of the latter.

Where the owner of a patent is himself an infringer of a licensee's exclusive right to use or to sell the invention covered thereby, no action at law can remedy the wrong. The licensee cannot bring such an action in his own name in that case, any more than in another; and he cannot sue in the name of the wrong-doer, for he would thus make the latter both plaintiff and defendant. Such a state of facts constitutes such an impediment to an action at law as authorizes the licensee to sue the owner of the patent in a court of equity.³ Where an exclusive licensee, who pays royalties in proportion to the extent of his use or his sales of the patented invention, allows infringers to use or to sell that invention without interference from him, the owner of the patent right may sue those infringers in his own name and for his own use.⁴

§ 401. The defendant in an action for an infringement of a patent may be a natural person. A private corporation may also be held liable as defendant in such an action.⁵ Among public corporations, the liability of a city for infringing a patent has been affirmed,⁶ and that of a county has been denied.⁷ The ground of this distinction is the fact that cities are created and exist mainly for the special use of the people who compose them; while counties are subdivisions of

¹ *Hammond v. Hunt*, 4 Bann. & Ard. 113, 1879.

² *Goodyear v. Bishop*, 4 Blatch. 438, 1860.

³ *Littlefield v. Perry*, 21 Wallace, 223, 1874; *Root v. Railway Co.*, 105 U. S. 216, 1881.

⁴ *Still v. Reading*, 20 Off. Gaz.

1026, 1881.

⁵ *York & Maryland Line Railroad Co. v. Winans*, 17 Howard, 30, 1854.

⁶ *Bliss v. Brooklyn*, 4 Fisher, 596, 1871.

⁷ *Jacobs v. Hamilton County*, 4 Fisher, 81, 1862.

States, made for the purposes of political organization, and civil and judicial administration.' The same reasons seem to indicate that organized villages are generally liable for infringements, while ordinary townships are not. The general rule on the subject appears to be that cities and villages are liable for infringements of patents, unless the charters or statutes which created or which regulate them otherwise require or provide, while counties and townships are not so liable unless they are made so by the legislative power which called them into being. School districts probably fall in the same category as townships in respect of this sort of liability.² Of course, no State can be sued for any infringement of a patent;³ and the nation cannot be sued except by its own consent.⁴ Whether that consent has been given in the statute establishing the Court of Claims, and whether agents of the national government are liable to actions for infringements committed by them in its behalf, are questions which are treated in Sections 392 and 393 of this book.

§ 402. Natural persons cannot escape liability for their infringements of patents on the ground that they are minors, married women, or lunatics.⁵ A minor is not less liable to an action because the act of infringement was done at the command of his father;⁶ but if a married woman commits an infringement in the presence of her husband, she is not liable to an action therefor, unless it can be shown that she did it without his influence or consent.⁷ In the absence of such evidence, the husband is alone liable for the torts of the wife which are committed in his presence;⁸ and for the infringements which are committed jointly by both.⁹ The only dis-

¹ *Ward v. County of Hartford*, 12 Connecticut, 406, 1838; *Commissioners of Hamilton County v. Mighels*, 7 Ohio State, 118, 1857.

² *Wilson v. School District*, 32 New Hampshire, 118, 1855.

³ Eleventh Amendment to the Constitution of the United States.

⁴ *United States v. Lee*, 106 U. S. 204, 1882.

⁵ *Cooley on Torts*, Chapter IV.

⁶ *Humphreys v. Douglass*, 10 Vermont, 71, 1838; *Scott v. Watson*, 46 Maine, 362, 1859.

⁷ *Bishop's Law of Married Women*, Volume 2, Section 258.

⁸ *Bishop's Law of Married Women*, Volume 1, Section 43.

⁹ *Green v. Austin*, 22 Off. Gaz. 683, 1882.

inction between the liability of lunatics and of sane persons, for such torts as infringements of patents, seems to be that the former can never be held liable for more than actual damages.¹

§ 403. An agent or salesman who sells specimens of a patented thing on commission is liable as an infringer for so doing.² But a mechanic who, when working for wages, makes or uses a patented thing, or uses a patented process, at the command of his employer, is not liable to an action at law on that account,³ though he may doubtless be restrained by an injunction from continuing such making or using.⁴ A decree for an account of profits would not be proper in such a case, because a mechanic cannot be said to make any profits from such an infringement. Nor would a decree for damages be any more proper in an action in equity, than would a judgment for damages in an action at law.

§ 404. Whoever directs or requests another to infringe a patent is himself liable to an action for the resulting infringement on the plain principle that what one does by another he does by himself.⁵ So, also, if an infringement is committed by A. B., for the benefit of C. D., but without the knowledge or authority of the latter, the latter will still be liable as an infringer, if he approves the tort after its commission.⁶ An infringement which is committed by an employee in the regular course of his employer's business will also render the latter liable to an action, even if the employer forbade the acts which constituted the infringement,⁷ or even if the employer did not know that such was the character of those acts.⁸

§ 405. It is a general principle of law, that whoever does an

¹ Cooley on Torts, page 102.

² Potter v. Crowell, 3 Fisher, 112, 1866; Maltby v. Bobo, 14 Blatch. 53, 1876; Steiger v. Heidelberger, 4 Fed. Rep. 455, 1880.

³ Delano v. Scott, Gilpin, 498, 1834; United Nickel Co. v. Worthington, 13 Fed. Rep. 393, 1882.

⁴ Goodyear v. Mullee, 5 Blatch. 437, 1867.

⁵ Green v. Gardner, 22 Off. Gaz. 683, 1882.

⁶ See Judson v. Cook, 11 Barbour (N. Y.), 642, 1852; Allred v. Bray, 41 Missouri, 484, 1867.

⁷ See Philadelphia & Reading Railroad Co. v. Derby, 14 Howard, 468, 1852.

⁸ Wooster v. Marks, 17 Blatch. 368, 1879.

act which naturally causes another to commit a tort is himself liable to an action therefor.¹ The applicability of this doctrine to patent suits is a subject which is as yet almost wholly unexamined by the courts. When so examined, it will probably be found to have its limitations. If A. B. unlawfully makes a specimen of a patented thing, and sells it to C. D., a man whose business it is to use things of that class, there seems to be no injustice in holding the former responsible, not only for his own illegal making and selling, but also for the illegal using committed by the latter, for that making and selling naturally resulted in that using. On the other hand, if E. F., a merchant, gives G. H., a manufacturer, an order for a quantity of articles which may be made either with or without a particular patented machine, and if G. H. makes those articles with that machine because he ordinarily and naturally uses that machine for such purposes, it seems to be clear that E. F. is not liable for that unlawful making.² But if I. J. unlawfully makes a patented machine and leases it to K. L. to be used, it seems right to hold the former liable to an action for that use.

§ 406. Where several persons co-operate in any infringement, all those persons are of course liable therefor. In that, as in all cases of torts for which several persons are liable, all may be sued jointly, or any of them may be sued alone.³ So, also, an action may be brought against several joint defendants, and sustained against such of them as the evidence shows to be liable, even though not sustained against all.⁴ Where an action at law is sustained against several joint infringers, the judgment will be entered against all, regardless of whether the benefits of the infringement were confined to part of them, or extended to the whole;⁵ but a decree for profits in an action in equity will be entered only against those of

¹ *Guille v. Swan*, 19 Johnson (N. Y.), 381, 1822; *Brooks v. Ashburn*, 9 Georgia, 297, 1851; *Lewis v. Johns*, 34 California, 629, 1868; *Smith v. Felt*, 50 Barbour (N. Y.), 612, 1868.

² *Keplinger v. De Young*, 10

Wheaton, 358, 1825.

³ *Hilliard on Torts*, Vol. 2, p. 242.

⁴ *Reutgen v. Kanowrs*, 1 Washington, 172, 1804.

⁵ *Cooley on Torts*, p. 136.

the defendants who are proven to have actually realized profits from the infringement.¹

§ 407. The facts which will constitute co-operative joint infringement fall, when analyzed, into a large number of classes. A few of them may be mentioned in this section, but a much larger number must be left to the reflections of the reader, or to the development of litigation.

Where one man owns and others operate an infringing machine, all are jointly liable to an action therefor.² Where one person makes and sells a part of a patented combination, and another person independently makes and sells the residue of that combination, both intending that the purchaser shall assemble the parts, and use the combination, there the maker and seller of either of the parts is liable to an action as infringer.³ So, also, where a person makes and sells a composition of matter, which is described in a patent, and which is useful only for the purpose of performing a process covered by that patent, there also the maker and seller is liable to an action at law or in equity.⁴ In the two cases last cited, the things made and sold by the defendants were not only intended to be combined with other things so as to infringe the patent, but they were in fact useless for any other purpose. Where both of these elements are absent, there is no infringement in making and selling a part of a patented combination, and therefore no liability to any action for an infringement.⁵ But if there was an intention that the thing made and sold should be incorporated into the patented combination, an action for infringement cannot be defeated by showing that it could have been used for some purpose alone, or in unpatented combinations.⁶

§ 408. A partnership is liable to an action for an infringe-

¹ *Elizabeth v. Pavement Co.* 97 U. S. 140, 1877.

² *Woodworth v. Edwards*, 3 *Woodbury & Minot*, 121, 1847.

³ *Wallace v. Holmes*, 9 *Blatch.* 73, 1871.

⁴ *Rumford Chemical Works v.*

Hecker, 2 *Bann. & Ard.* 363, 1876.

⁵ *Maynard v. Pawling*, 5 *Bann. & Ard.* 551, 1880; *Millner v. Schofield*, 4 *Hughes*, 261, 1881.

⁶ *Saxe v. Hammond*, 1 *Holmes*, 456, 1875; *Bowker v. Dows*, 3 *Bann. & Ard.* 518, 1878.

ment committed in the regular course of the partnership business, by one or more of the partners, or under his or their orders; and also for any infringement committed outside of that regular course of business, if it was previously authorized or afterward adopted as the act of the partnership by all the partners. But no partnership is liable for any infringement committed outside of the regular course of the partnership business, unless it was so authorized or adopted.¹

§ 409. Private corporations are responsible for infringements committed, authorized, or ratified by them, under substantially the same rules as those which govern the similar responsibility of natural persons. It was formerly supposed that corporations could not be held liable for torts, because torts are never authorized by corporate charters, and are therefore *ultra vires*. But this idea was soon found to produce gross injustice in its practical operation; and was therefore abandoned by the courts.² The law is, that every private corporation is liable for all the torts which were authorized by that corporation, and for all torts done in pursuance of any authority to act on its behalf, on the subject to which the torts relate, and for all torts ratified by the corporation after they are committed. And in deciding upon this liability, the courts consider corporate officers, agents, and servants as possessing a large discretion, and they accordingly hold the corporation liable for all their acts within the most extensive range of the corporate powers.³ The agent of a corporation in committing an infringement may be another corporation; and the relation of agency exists and binds the principal, where the agent infringes a patent in authorized pursuance of the business which the principal was chartered to transact.⁴ Unless their charters otherwise provide, public corporations which are liable at all for infringements of patents are doubt-

¹ See Story on Partnership, Sections 166 and 168.

² Baltimore and Potomac Railroad Co. v. Fifth Baptist Church, 108 U. S. 317, 1882.

³ See Cooley on Torts, p. 119.

⁴ York and Maryland Line Railroad Co. v. Winans, 17 Howard, 38, 1854.

less liable under the same circumstances and to the same extent as private corporations are.

§ 410. Under what circumstances and to what extent an officer, director, or stockholder of a corporation is personally liable for infringements committed by it, are questions heretofore but seldom and but slightly examined by the courts. It has been adjudicated that where persons actively and personally conduct infringements of patents, they cannot avert an injunction by proving that they acted under the charter of a corporation, and as officers, directors, or stockholders thereof. This point was decided by Justice NELSON¹ and by Judge W. D. SHIPMAN.² Judge LOWELL has held that an action at law cannot be maintained against the officers, directors, or shareholders of a corporation which infringes a patent, even where such persons personally conducted the business which constituted the infringement.³ If that is the law upon the point, it must also be the law that no damages can be recovered by an action in equity against any such person. But it will not follow, where profits have been realized by persons from infringements committed by them in the disguise of a corporation, that they can lawfully retain those profits, and leave the patentee remediless. And it is possible that Judge LOWELL is wrong in his opinion. His examination of the point does not appear to have been characterized by all that thoroughness with which his judicial opinions are generally developed; and he himself remarks that his conclusion is contrary to what counsel had conceded in several earlier cases. The point is one of much importance. Upon it may often depend the just reward of invention, and the just punishment of tort. An examination of the subject in the light of analysis and of analogies may therefore be acceptable to the profession, and not useless to the courts.

§ 411. Wrongs are divisible, in one aspect, into two classes: wrongs of commission and wrongs of omission. Where an officer, director, or stockholder of a corporation is engaged in

¹ *Goodyear v. Phelps*, 3 Blatch. 495, 1861.
91, 1853.

² *Poppenhusen v. Falke*, 4 Blatch.

³ *United Nickel Co. v. Worthington*, 13 Fed. Rep. 393, 1882.

managing its business, and as a part of that business manages and directs the infringement of a patent, that person is chargeable with a wrong of commission. Where such a person has power to prevent his corporation from infringing a patent, and omits to exercise that power, and where the corporation therefore infringes that patent, then that person is chargeable with a wrong of omission. Where a person is an officer, director, or stockholder of a corporation, but has no personal power to cause it to infringe a particular patent, nor to restrain it from so doing, that person is chargeable with no wrong of either sort.

§ 412. Stockholders seldom have any power, merely as stockholders, to control the action of their corporation in such a matter of detail as the infringement of a particular patent. Unless it can be shown that the stockholder whom it is sought to hold liable in a particular case did possess power of that kind, it is clear that the common law will not compel him to respond in damages for any infringement with which he was not personally connected. If the law were otherwise a man could lawfully be made to suffer for wrongs which he did not commit, and could not prevent, and from which he received no advantage. Indeed it is the general rule of the common law, that mere stockholders in a corporation are not liable for its debts,¹ and if not liable for its debts, they surely ought not to be liable for its torts.

§ 413. The officers of a corporation are the persons who are charged with the superintendence and control of its transactions. It is doubtless their duty to refrain from directing infringements to be committed; and also to prevent the agents and servants of their corporations from committing infringements of patents, when prosecuting the corporate business. If such an officer directs and causes a specific thing to be done which turns out to constitute an infringement, it is extremely difficult to see why he should be permitted to shift all the responsibility for the tort upon the intangible corporation, that is to say upon the innocent stockholders as a body.

¹ *Shaw v. Boylan*, 16 Indiana, 386, 1861.

If an agent or a servant of a corporation commits an infringement in the course of the corporate business, the officers whose function it is to control that agent or that servant are chargeable with a wrong of omission. They are guilty of *non-feasance* in the performance of their official duties. If their omission to prevent the infringement is the result of gross inattention on their part, they are liable to the corporation for any loss it may incur on account of the infringement; but it is otherwise if the omission resulted from an error of judgment.¹ Whether such an officer is liable at common law to the owners of the patent infringed seems to depend upon other considerations.

If an officer, in pursuance of his general authority, directs a servant of a corporation to make a machine for a particular purpose, which machine may be made so as to infringe a patent, or may be made so as not to have that effect, it seems that the officer is bound to see that it is not made so as to infringe, and that if the servant makes it in that way, the officer is liable to the patentee.² But if a servant of a corporation, without any special orders to do so, makes or uses or sells a thing which turns out to be an infringement of a patent, it seems that no superior officer is personally liable therefor at common law.³ It appears reasonable that officers of corporations should be bound to see that whatever they cause to be done is done lawfully; but it would perhaps not be ordinarily right to make them personally responsible to strangers for acts spontaneously committed by their subordinates.

§ 414. Directors of corporations, unlike other officers, act only in a collective capacity. Where an entire board of directors unanimously orders a particular thing to be done which will constitute an infringement of a patent, and where that thing is accordingly done by the corporation's agents or servants, there seems to be no reason why those directors should not be held personally liable to an action for that in-

¹ Spring's Appeal, 71 Pennsylvania State, 11, 1872.

(Mass.) 425, 1862.

² See Hewett v. Swift, 3 Allen

³ See Bath v. Caton, 37 Michigan, 202, 1877.

fringement. If the corporation is alone liable in such a case, then crafty and dishonest men may often manage to divide the spoils of infringement, and leave nothing but an insolvent or dormant corporation to be sued by the patentee. It would evidently be a reproach to our laws if such a scheme could be made to work. Whoever attempts to defend the legal safety of such a mode of reaping the harvest of another, should have his attention called to the following sentence, written by Justice CAMPBELL, and approved by the Supreme Court, and worthy to be quoted in every law-book, and remembered by every man. "It is certainly true that the law will strip a corporation or individual of every disguise, and enforce a responsibility according to the very right, in despite of their artifices."¹

Where the action of a board of directors in ordering an infringement results from the votes of a majority only, the relations of the minority voters to the resulting infringement must be different from that of the others. The members of the minority ought not, in such a case, to be held liable for the action of the board, or for its results, unless they afterward adopt it by ratification. Where an infringement is ordered by a quorum of a board of directors, in the absence of the residue, the residue will be free from common law liability for the wrong unless they afterward ratify it, or unless they are chargeable with such gross non-attendance upon the meetings of the board as justly causes them to be held responsible for whatever is done by their colleagues in their absence. The mere fact of being a director in a corporation is not sufficient to render a person liable at common law for any tort committed by that corporation or its managers or agents.²

§ 415. But there is a statutory liability in such cases as those which we are considering. Most of the States have statutes which provide that, under various circumstances therein specified, the officers, directors, or stockholders of a

¹ York and Maryland Line Railroad Co. v. Winans, 17 Howard, 40, 1854.

² Arthur v. Griswold, 55 New York, 406, 1874.

corporation shall be personally liable for its debts or liabilities. Section 721 of the Revised Statutes of the United States provides that "The laws of the several States, except where the Constitution, treaties, or statutes of the United States otherwise require or provide, shall be regarded as rules of decision in trials at common law, in cases where they apply." Under this section of the Revised Statutes, these laws of the States will probably have the same effect in a patent suit in a United States court, that they would have in any action of trespass on the case in a State court.¹ Such of the State statutes referred to as make stockholders, officers, or directors responsible for the "liabilities" of their corporations are clearly broad enough to cover liabilities arising out of infringements of patents. Indeed Justice Story decided that such liabilities were covered by the word "debts" in such a statute.² In most of the States the statutory individual liability of officers, directors, and stockholders of corporations is more limited than it was in Massachusetts when Justice Story made that decision. It is outside the scope of this text-book to set forth the details of the State statutes which bear upon the point. It will frequently happen that the controlling legislative edicts which relate to the matter will be found in the special charters of particular corporations, rather than in the general statutes of the several States. The general principle which runs through all such laws seems to be that where a corporation is so managed that it cannot be made to respond to lawful claims based on its contracts or torts, those officers or directors who caused that inability, or those officers, directors, or stockholders who profited thereby, shall be made to respond in its place.

§ 416. A consolidated corporation is liable to actions in

¹ *M'Cluny v. Silliman*, 3 Peters, 270, 1830; *M'Neil v. Holbrook*, 12 Peters, 84, 1838; *Vance v. Campbell*, 1 Black, 427, 1861; *Haussknecht v. Claypool*, 1 Black, 431, 1861; *Wright v. Bales*, 2 Black, 535, 1862; *Lefingwell v. Warren*, 2 Black, 599, 1862; *Hanger v. Abbott*, 6 Wallace,

537, 1867; *Parker v. Hall*, 2 Fisher, 62, 1857; *Parker v. Hawk*, 2 Fisher, 58, 1857; *Rich v. Ricketts*, 7 Blatch. 230, 1870; *Hayden v. Oriental Mills*, 15 Fed. Rep. 605, 1883.

² *Carver v. Mfg. Co.*, 2 Story, 448, 1843.

equity for infringements committed before the consolidation, by each of its constituents, if the property and franchises which the consolidated corporation acquired from that constituent, were of sufficient value, over and above all paramount claims, to equal the profits or damages sought to be recovered in such actions.¹ This proposition results from the fact that equity regards the property of a corporation as held in trust for the payment of its debts, and recognizes the right of creditors to pursue that property into whosoever possession it may be transferred, unless it has passed into the hands of a *bona fide* purchaser.²

The liability of consolidated corporations to actions at law, for infringements committed by its constituent corporations, before the consolidation, is a matter which does not rest on common law principles, so much as upon the statutes of the States wherein those consolidated corporations came into being, or upon the private Acts which authorized the consolidations, or upon the charters of the constituent or of the consolidated companies. Whenever occasion arises to hold a consolidated corporation liable to an action at law for such a cause, a proper authority for so doing can probably always be found in one or another of these sources.

§ 417. A plurality of patents may be sued upon in one action, where the inventions covered by those patents, are embodied in one infringing process, machine, manufacture, or composition of matter;³ but not otherwise.⁴ But any action based on alleged infringement, in one process or thing, of a plurality of patents, may be sustained by evidence that

¹ Sayles v. The Lake Shore and Michigan Southern Railway Co., Manuscript, 1878.

² Mumma v. Potomac Co. 8 Peters, 286, 1834; Curran v. Arkansas, 15 Howard, 311, 1853; Railroad Co. v. Howard, 7 Wallace, 409, 1868.

³ Seymour v. Osborne, 11 Wallace, 516, 1870; Bates v. Coe, 98 U. S. 48, 1878; Nourse v. Allen, 3 Fisher, 63, 1859; Gillespie v. Cummings,

3 Sawyer, 259, 1874; Horman Patent Mfg. Co. v. Railroad Co. 15 Blatch. 444, 1879; Gamewell Fire-Alarm Telegraph Co. v. Chillicothe, 7 Fed. Rep. 351, 1881; Nellis v. Mfg. Co. 13 Fed. Rep. 451, 1882.

⁴ Nellis v. McLanahan, 6 Fisher, 286, 1873; Hayes v. Dayton, 8 Fed. Rep. 702, 1880; Barney v. Peck, 16 Fed. Rep. 413, 1883.

one of those patents was so infringed, though the others were not ;¹ and an action brought for alleged unlawful making, using and selling may be sustained by evidence of either of those three sorts of infringement.² So also, an action may be based on infringement committed during the first term, and on infringement committed during an extended term, of any patent, and may be sustained on proof of either or both of those infringements.

¹ *Matthews v. Mfg. Co.* 18 Blatch. 86, 1880.

² *Locomotive Truck Co. v. Railway Co.* 10 Blatch. 293, 1872.

CHAPTER XVIII.

ACTIONS AT LAW.

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 515. The eighth defence.
 516. The ninth defence.
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§ 418. An action of trespass on the case, is prescribed by the United States statutes, as the proper legal remedy, for infringements of patents.¹ Patent rights are not based upon the common law; but are founded wholly upon the Constitution and statutes of the United States.² Where a statute creates a right, and prescribes a legal remedy for its enforcement; it is

¹ Revised Statutes, Section 4919.

² Section 149 of this book.

the general rule, that no other common law remedy can be used for that purpose.¹ Unless patent rights are exempt from this rule, it will follow that an action of trespass on the case is the only action which United States courts can entertain, when sitting as common law courts in patent cases. Whether patent rights are thus exempt, is a question which once arose in a Supreme Court case, but which was not decided because it was apparently overlooked by the counsel and by the court.

The case was that of the *Packet Co. v. Sickles*. It was originally an action of assumpsit, based on an alleged contract between the parties, relevant to compensation for the use of a patented machine. A recovery was adjudged on that contract in the court below ; but the Supreme Court reversed the judgment on the ground that the contract was not in writing, and was not to be performed within one year, and was therefore void under the statute of frauds.² On the case being remanded, the plaintiff amended the declaration by adding two counts in assumpsit for money had and received. The case was thus changed from an action of assumpsit on a contract, to an action of assumpsit to recover compensation for the infringement of a patent. The defendant did not notice the questionable propriety of an action of assumpsit for that purpose, and therefore pleaded non-assumpsit. The jury found for the plaintiff, and having been instructed by the court to assess the damages on the basis of the value of the use of the machine, it rendered a verdict for \$11,333, with interest from the day when the suit was brought.

Now if an action of assumpsit had been proper, it would be difficult to show any impropriety in the charge of the court, though in an action of trespass on the case it would have been clearly wrong.³ When the case again reached the Supreme Court, it was again reversed ; this time because the charge did not conform to the precedents relevant to the measure of damages in actions at law for infringements of patents. But

¹ *Wiley v. Yale*, 1 Metcalf (Mass.) 554, 1840 ; *Elder v. Bemis*, 2 Metcalf (Mass.) 604, 1841 ; *Smith v. Woodman*, 8 Foster (28 N. H.) 528, 1854.

² *Packet Co. v. Sickles*, 5 Wallace, 580, 1866.

³ *Seymour v. McCormick*, 16 Howard, 480, 1853.

no due notice appears to have been taken of the fact that the case at bar was an action of assumpsit, while those precedents had been established in actions of trespass on the case.' Had that distinction been attended to, the court could hardly have sustained the propriety of the form of action, and at the same time have reversed the case for error in the charge. The suit was treated precisely as though it had been an action of trespass on the case. If the court had meant to affirm the propriety of actions of assumpsit for infringements of patents, it would not have so treated the suit; for its ruling would seem to be inappropriate to that form of action. The precedent is therefore not fairly citable on either side of the question of the propriety of an action of assumpsit for the infringement of a patent.

§ 419. That an action of assumpsit may be based on an infringement of a patent, has been stated to be the law by at least two United States judges.²

In the first case cited, Judge HUGHES said: "Let us now suppose the case of a person who takes possession of and uses another's horse, wagon and team, or threshing-machine, without his knowledge, consent, or authority. . . . In such a case, the owner may recover damages in trespass for the tort; or he may waive the tort, and sue in assumpsit on the implied promise to pay what is equitably due for the use and possession of the property. . . . The case I have supposed is, in principle, precisely the case we have at bar, for there is no magical quality in the property of a patentee in his patent to distinguish this case from the one just supposed, where ordinary property had been taken and used without the owner's consent. . . . The act of the defendant was nothing but the simple one of a person taking and using another's property, without authority, to his own advantage, and incurring a liability to compensate the owner for such use of the property.

¹ Packet Co. v. Sickles, 19 Wallace, 617, 1873.

² Sayles v. Richmond, Fredericksburg & Potomac Railroad Company,

4 Bann. & Ard. 245, 1879; Steam Stone Cutter Co. v. Sheldons, 15 Fed. Rep. 609, 1883.

The case is, in principle, precisely identical with that of such a use of a horse, or a boat, or a wagon and team, or threshing-machine—giving a right of action in *assumpsit*.”

In the second case Judge WHEELER said: “When the Windsor Manufacturing Company sold machines, embodying these inventions, to the defendants for use, it invaded the orator’s rights and converted the orator’s property to its own use. These acts were tortious, and an action would lie for these wrongs. As that company received money for the orator’s property, the orator could waive the tort, and sue in *assumpsit* for the money, or, what is the same in effect, proceed for an account of the money received. In an action or proceeding for the money, the measure of damages would be the amount of money received, not the amount of damage done, and all right of recovery beyond that would be waived.”

§ 420. It is against the policy of the law that the owner of a patent right should lose by reason of its infringement. To prevent such a result, the action of trespass on the case is well adapted, because it measures the plaintiff’s recovery by the plaintiff’s loss. But it is also against the policy of the law that an infringer should gain by reason of his infringement. To prevent such a result, the action of trespass on the case is not well adapted, because an infringer may often gain far more than the patentee loses by reason of the wrongful act of the former. Patents are peculiar property in this respect. A horse or a wagon is worth about as much to one man as to another, but the use of a patent may be worth ten times as much to a rich infringer as to a poor patentee. It would be a reproach to the patent laws if any infringer could unlawfully make, use, and sell specimens of his neighbor’s patented invention, and, when called to account in a court of justice, could cancel his liability by paying one tenth of the proceeds of his tort to the owner of the patent. No complete system of law offers such a premium for its own violation. To prevent such failures of justice, it was long the theory and the practice of the United States courts, that equity had jurisdiction to enforce a patentee’s right to recover an infringer’s profits, independently of all other equitable titles, rights, and

remedies.¹ But that theory was overruled, and that practice was stopped by the Supreme Court, in the case of *Root v. Railway Co.*² The new rule which was stated and enforced in that case, calls aloud upon courts of law to entertain actions of assumpsit for infringements of patents, if by any means they can find authority for so doing. If no such authority can be deduced from the common law, then it ought to be conferred by legislation; for unless it exists or is supplied, it must often happen in the future that infringers will profit by their infringements far more than inventors can profit by their inventions.

§ 421. A majority of the States have abolished all common law actions, and have substituted for the whole of them a single form of proceeding which they call a civil action. The United States statutes provide that "The practice, pleadings, and forms and modes of proceeding in civil causes, other than equity and admiralty causes, in the circuit and district courts, shall conform, as near as may be, to the practice, pleadings, and forms and modes of proceeding existing at the time in like causes in the courts of record of the State within which such circuit or district courts are held, any rule of court to the contrary notwithstanding,"³ and that "Damages for the infringement of any patent may be recovered by action

¹ *Stevens v. Kansas Pacific Railway Co.*, 5 Dillon, 486, 1879; *Nevins v. Johnson*, 3 Blatch. 80, 1853; *Sickles v. Mfg. Co.* 1 Fisher, 222, 1856; *Jenkins v. Greenwald*, 2 Fisher, 41, 1857; *Imlay v. Railroad Co.* 4 Blatch. 228, 1858; *Perry v. Corning*, 6 Blatch. 134, 1868; *Howes v. Nute*, 4 Clif. 174, 1870; *Cowing v. Rumsey*, 8 Blatch. 36, 1870; *Packet Co. v. Sickles*, 19 Wallace, 611, 1873; *Smith v. Baker's Administrators*, 1 Bann. & Ard. 117, 1874; *Wetherill v. Zinc Co.* 1 Bann. & Ard. 485, 1874; *Burdell v. Denig*, 92 U. S. 720, 1875; *Birdsall v. Coolidge*, 93 U. S. 68, 1876; *Vaughan v.*

East Tennessee, Virginia & Georgia Railroad Co. 2 Bann. & Ard. 537, 1877; *Vaughan v. Central Pacific Railroad Co.* 3 Bann. & Ard. 28, 1877; *Sayles v. Dubuque & Sioux City Railroad Co.* 3 Bann. & Ard. 219, 1878; *Gordon v. Anthony*, 16 Blatch. 234, 1879; *Hendrie v. Sayles*, 98 U. S. 546, 1879; *Bignall v. Harvey*, 18 Blatch. 353, 1880; *Atwood v. Portland Co.* 10 Fed. Rep. 283, 1880; *Stevens v. Baltimore & Ohio Railroad Co.* 6 Fed. Rep. 283, 1881.

² *Root v. Railway Co.* 105 U. S. 189, 1881.

³ Revised Statutes, Section 914.

on the case.''¹ Both these apparently inconsistent provisions are contained in the same enactment. They must therefore be construed together; and effect must be given to both. When so construed, it will be seen that Section 914 does not oust nor affect the operation of the other. Both can harmoniously stand, when Section 914 is held to be a general provision covering no case which is specially provided for; or when it is held to cover no cause save such as are "like" the causes litigated in State courts. To hold that Section 914 is the one which prescribes what forms of action are to be used in patent causes would involve a decision that there are "like causes" in State courts, and a further decision that the enactment quoted from 4919 is wholly nugatory. The conclusion appears to be, that the proper action at law by means of which to recover damages for infringements of patent is the same throughout the United States and is an action of trespass on the case.

§ 422. The declaration in an action of trespass on the case, for an infringement of a patent, ought to be in proper common law form, as distinguished from the complaints and petitions prescribed for other actions by the codes of sundry of the States. The proper parts of such a declaration are the following: 1. The title of the court. 2. The title of the term. 3. The venue. 4. The commencement. 5. The statement of the right of action. 6. The conclusion.

The true title of the United States Circuit Court established in Connecticut is "Circuit Court of the United States, for the District of Connecticut," and the title of the circuit court which is established in any other district is the same, except as to the name of the district.²

The proper term of the court in which to entitle the declaration is the term at which the appearance of the defendant is due.³ It is unnecessary to entitle a declaration in the name of the case in which it is filed; though it is convenient to indorse that name on the back of the declaration, for the

¹ Revised Statutes, Section 4919.

² Revised Statutes, Section 608.

³ 1 Chitty on Pleading, 15 American Edition, p. 263.

purpose of enabling the document to be readily found in a file.

The venue should be laid in the district where the action is commenced, regardless of the district or districts wherein the infringement was committed.¹ An infringement suit, being based on a transitory cause of action, the place laid in the declaration draws to itself the trial of all questions of infringement, wherever committed; except in the single case where the United States statutes otherwise provide.²

The commencement contains a statement of the names of the parties to the action, and of the capacity in which they respectively sue or are sued, if it is other than a natural personal capacity. Though it is probably unnecessary, it is undoubtedly prudent to state the nation of which the parties are respectively citizens, and if that nation is the United States, to allege also the particular State of which the parties are citizens respectively. Where either party is a corporation, that fact must be stated, and the name of the State or other sovereignty wherein it was created and exists should also be alleged. The commencement properly closes with a brief recital that the form of action is that of trespass on the case.

§ 423. The statement of the right of action should contain the name and residence of the inventor, in order to identify him, and to enable the defendant to make inquiries into the history of the alleged invention. If that name or that residence were concealed from the defendant, he might thereby be deprived of the means of learning of several perfect defences. As the statutes stand at present, there is no necessity for stating the citizenship of the inventor in any declaration, unless the inventor is also a party to the action. Such a necessity will however arise whenever Congress discriminates between citizens of the United States and citizens of other countries, in respect of the terms upon which it may authorize patents to be granted.

§ 424. The novelty and the utility of the invention must be

¹ *McKenna v. Fisk*, 1 Howard, 248, 1843.

² Revised Statutes, Section 657; Section 390 of this book.

put in issue by proper averments in the declaration ; but it is not necessary to state the particular time at which the invention was made, so that it appears to have been made before the application for the patent was filed.¹ The circumstance that letters patent are themselves *prima facie* evidence of novelty and utility, does not render unnecessary a proper allegation of those facts in the declaration. Evidence cannot take the place of pleading, and proper pleading is necessary to make any kind of evidence admissible in support of the right of a patentee to recover for an infringement of his patent.

§ 425. The statement of the right of action must also aver that the invention was not in public use or on sale for more than two years before the inventor's application for the patent ; because that fact is one of those which are necessary to give the Commissioner of Patents jurisdiction to grant such a document.² It is a fact which is of the essence of the right of action, and it must therefore be stated in the declaration.³

But the rule of this section is qualified by another, in every case where public use or sale of an invention, more than two years before an application for a patent, must have occurred with the consent of the inventor, in order to invalidate the patent.⁴ In every such case it is necessary and is sufficient to allege in the declaration that the invention was not in public use or on sale with the consent or allowance of the inventor, for more than two years before his application for a patent therefor.

§ 426. If the patentee is neither a party to the action, nor the inventor of the thing or process covered by the patent, it is natural and proper to separately state his name in order to fully and surely identify the patent. It is well also to state his residence and his citizenship, though there is at present no requirement of law on either of those points.

§ 427. It is not necessary to state in a declaration the partic-

¹ *Wilder v. McCormick*, 2 Blatch. 31, 1846.

² Revised Statutes, Section 4886.

³ *Gray v. James*, 1 Peters' Circuit Court Reports, 482. 1817.

⁴ Section 102 of this book.

ulars of the application for the letters patent, nor the particulars of the proceedings of the Patent Office in considering that application, because the courts will presume that everything was rightly done which the law required to be done in order to authorize the Commissioner to issue the patent.¹ It is customary and proper to say in a declaration that the inventor made due application for letters patent, but not even that general allegation appears to be required.²

§ 428. The declaration may describe the patent in the language of the grant, and it is not necessary to set out the specification either verbatim or substantially ;³ though it is not improper, except in point of prolixity, to incorporate the whole of the patent and specification into the declaration.⁴

The declaration must state that the letters patent were issued in the name of the United States of America, under the seal of the Patent Office, and were signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and that they were delivered to the patentee.⁵ Inasmuch as patents are granted for various spaces of time, it is necessary to state the particular terms for which the letters patent in suit were issued. It is necessary also to plead the legal effect of the patent, by saying that it did grant to the patentee, his heirs or assigns, the exclusive right to make, use, and vend the invention covered thereby, throughout the United States and the Territories thereof.⁶

§ 429. Where the patent upon which the action is based, is a reissue, the original letters patent should be set forth precisely as though no surrender and reissue had occurred ; and in addition thereto, it is necessary to state the particular kind of defect which made the original a proper subject of a reissue ; and to state also that such defect arose from inadvertence, accident or mistake, as the case may be, and without

¹ Cutting v. Myers, 4 Washington, 221, 1818.

² Wilder v. McCormick, 2 Blatch. 31, 1846.

³ Cutting v. Myers, 4 Washington, 223, 1818.

⁴ Wilder v. McCormick, 2 Blatch. 35, 1846.

⁵ Revised Statutes, Section 4883. Cutting v. Myers, 4 Washington, 222, 1818.

⁶ Revised Statutes, Section 4884.

any fraudulent or deceptive intention ; and to state that the original patent was surrendered, and who surrendered it ; and to state that the Commissioner of Patents caused a new patent to be issued for the same invention ; and to state finally the name of the person to whom such new patent was granted. These particulars lie at the foundation of the right of the grantee of a reissue patent to receive such a grant ; and although the reissue is *prima facie* evidence that the truth on all these points is favorable to the validity of the patent, it is none the less necessary to put those facts in issue by proper pleading. The statements of this section are made subject to the condition that, if the Supreme Court shall decide any of these points of fact to be conclusively settled by the decision of the Commissioner in granting a reissue, it will then be unnecessary to state such fact or facts in a declaration.

§ 430. Where a disclaimer has been filed, that fact ought to be stated in the declaration and its legal effect ought to be indicated, because disclaimers constitute amendments of original patents, and operate to vary their scope.¹ In such a case also, the declaration ought to state that the disclaimer was filed without unreasonable delay, because that fact is necessary to the right of a patentee to maintain a suit on a patent which required a disclaimer.²

§ 431. Where the patent in suit was extended by the Commissioner of Patents, and where the action is based partly or wholly on its extended term, the declaration must state that the extension was made in due form of law, and must show that it was made before the expiration of the original term. It ought to state also that the extension was for the term of seven years from the expiration of the first term ; but as that is true of all such extensions, it is possible that the omission would be an immaterial one.

Where the patent has been extended by a special Act of Congress, and where the suit is partly or wholly based on such extension, the declaration must state the legal effect of the Act of extension, and it must especially show the particular space of time covered thereby.

¹ Revised Statutes, Section 4917.

² Revised Statutes, Section 4922.

§ 432. Where the plaintiff is an assignee or grantee of the patentee, it is safer to set forth all the mesne assignments or grants down to him, than merely to state that the exclusive right which was infringed by the defendant, came to the plaintiff by assignment or by grant. This point of pleading seems deducible by analogy from the rule relevant to declaring on an assigned term for years of real estate.¹ Title papers should, however, be set forth by their legal effect, rather than incorporated bodily into the declaration.

§ 433. No profert need be made in any declaration, of any letters patent, disclaimer, reissue, or certificate of extension, because all such documents are matters of record in the Patent Office.² Nor is any profert necessary of any assignment or grant of any interest under letters patent, because, although those instruments are sometimes under seal, they are not required to be so,³ and therefore do not fall within the definition of a deed.⁴ If, however, the title of the plaintiff is founded upon letters testamentary or letters of administration, he must make profert of the same, because they constitute exceptions to the general rule that profert is necessary only of deeds.⁵ If profert is made of any document of which it is not necessary, it will be treated as mere surplusage, and will not entitle the defendant to oyer.⁶

§ 434. Infringement may be stated in a declaration in general terms. Such a statement is sufficiently specific if it plainly alleges that the defendant, without the leave or license of the owner of the patent, did use, or that he did make, or that he did sell, a specimen or specimens of the thing or process covered by the patent, within the territory covered by the plaintiff's title thereto, and within the time during which the plaintiff held the title within that territory, and contrary to the form of the Act of Congress in such cases made and provided, and against the privileges granted by the patent.⁷

¹ 1 Chitty on Pleading, 368.

⁶ Gould's Pleading, Ch. VIII. Sec.

² 1 Chitty on Pleading, 366 ; Smith
v. Ely, 5 McLean, 90, 1849.

43.

⁶ 1 Chitty on Pleading, 366.

³ Revised Statutes, Section 4898.

⁷ Cutting v. Myers, 4 Washington,

⁴ Stephen on Pleading, Ninth
American Edition, 437.

223, 1818.

This last statement, indeed, seems hardly necessary, for it is but a conclusion of law from the facts stated ; and the allegation that the infringement was contrary to the statute is unnecessary, unless the plaintiff seeks to recover exemplary as well as actual damages.¹ Nor is it generally necessary in a declaration to negative the hypothesis of a license ; for licenses, where they exist, may more properly be first mentioned in the pleadings of the defendant.² But where the declaration shows that strangers to the suit have an exclusive United States license, it must also show that the defendant is not lawfully operating thereunder.³ While an allegation of either making, using, or selling will be sufficient in a declaration to show a cause of action, no allegation of any one of these kinds of infringement will support evidence of either of the others. A declaration ought therefore to allege as many of them as the plaintiff has any expectation of being able to prove.

§ 435. The time of the infringement is properly stated by alleging that it occurred on a specified day, and on divers other days between that day and some later specified date ; and no plaintiff will be permitted to prove infringement outside of the space of time which he specified in his declaration.⁴ Repeated infringements may be sued for in one action ;⁵ but all the infringements complained of in one declaration, must have been committed after the plaintiff obtained title to the patent, and before the beginning of the action. Where the plaintiff is an assignee, and where he not only has rights of action against the defendant, for infringements committed after the date of his assignment, but also has purchased rights of action against the same party, for infringements committed before such purchase, he must, if he sues at law, bring a separate action for the latter causes, and must bring that action in the name of the person who owned the patent at the time they accrued.

¹ *Parker v. Haworth*, 4 McLean, 373, 1848.

² *Gelpeke v. Dubuque*, 1 Wallace, 222, 1863 ; *Catlin v. Insurance Co.* 1 Sumner, 440, 1833 ; *Fischer v. Hayes*, 6 Fed. Rep. 79, 1881.

³ *Still v. Reading*, 20 Off. Gaz. 1026, 1881.

⁴ *Eastman v. Bodfish*, 1 Story, 530, 1841.

⁵ *Wilder v. McCormick*, 2 Blatch. 32, 1846.

§ 436. The damages incurred by the plaintiff on account of a defendant's infringement must be stated specially, because no particular damage necessarily arises from infringements of patents, and therefore none is implied by the law.¹ The special damages to be alleged in any particular case depend upon the circumstances of that case: depend upon the particular criterion of damages upon which the plaintiff relies. The various measures of damages in patent cases are stated and explained in the nineteenth chapter of this book. One or more of them will be found to be applicable to every case which is likely to arise. From among them, the pleader may select those which he expects to be able to prove to be pertinent, and may then draw his special statement of damages accordingly. Such a special statement is required by the substantial principles of pleading, as well as by its technical rules. Without it, the defendant would not be apprised of all the issues of the case. He would not know, till the day of trial, whether the plaintiff would prove an established royalty, or prove interference with his business, or prove what would be a reasonable royalty, as the criterion of his damages. The defendant would therefore have to go to court provided with witness on all these points, or would have to trust his sagacity, and guess which of these points he would be called upon to meet. It was to prevent such inconveniences that written pleadings were originally designed; and for the same purpose among others, they are still retained as a part of actions in courts.

§ 437. The conclusion of a proper declaration in a patent case alleges that, by force of the statutes of the United States, a right of action has accrued to the plaintiff, to recover the actual damages which the declaration specifies, and such additional amount, not exceeding in the whole three times the amount of such actual damages, as the court may see fit to adjudge and order, besides costs. The conclusion ends with the ancient allegation of bringing suit.

§ 438. A declaration, though not drawn in due form, is sufficient for practical purposes, if it contains all that is essen-

¹ 1 Chitty on Pleading, 396.

tial to enable the plaintiff to give evidence of his right and of its violation by the defendant, and affords to the defendant the opportunity of interposing every defence allowed to him by law.¹ Courts do not encourage merely technical objections to pleadings, and even on special demurrer will seek to sustain those which, though not technically accurate, are substantially sufficient for the real purposes of pleading.

At this point the attention may turn from the first pleading of a plaintiff in a patent action, and may engage itself for a while with pleadings which are appropriate to defendants in such cases.

§ 439. Dilatory pleas in patent actions are not materially different in their nature and operation from corresponding pleas in other common law cases. It is therefore unnecessary to treat those preliminary defences in this book. Recourse may be had to the standard works on common law pleading, for whatever information the patent pleader may require upon the subject.

§ 440. The defences which are pleadable in bar to an action, are very numerous in the patent law, and most of them are peculiar to that branch of jurisprudence. Where the facts appear to sustain him in so doing a defendant may plead: 1. That the matter covered by the original letters patent, was not a statutory subject of a patent: or 2. That it was not an invention: or 3. That it was not novel at the time of its alleged invention: or 4. That it was not useful at that or any other time: or 5. That the inventor actually abandoned the invention, before any application was made for a patent therefor: or 6. That he constructively abandoned it, by allowing it to be in public use or on sale more than two years before such application: or 7. That the invention claimed in the original patent is substantially different from any indicated, suggested, or described in the original application therefor: or 8. That the patentee surreptitiously or unjustly obtained the patent for that which was in fact the invention of another, who was using reasonable diligence in adapting and perfecting the same: or

¹ *Wilder v. McCormick*, 2 Blatch. 37, 1846.

9. That the invention was made by another jointly with the sole applicant : or 10. That it was made by one only of two or more joint applicants : or 11. That for the purpose of deceiving the public the description and specification filed in the Patent Office was made to cover less than the whole truth relevant to the invention, or was made to cover more than was necessary to produce the desired effect : or 12. That the description of the invention in the specification, is not in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same : or 13. That the claims of the patent are not distinct : or 14. That the patentee unreasonably delayed to enter a needed disclaimer : or 15. That the original patent was surrendered and reissued in the absence of every statutory foundation therefor : or 16. That the claims of the reissue patent in suit are broader than those of the original, and that the reissue was not applied for till a long time had elapsed after the original was granted : or 17. That the reissue patent in suit covers a different invention from any suggested, indicated, or described in the original specification or drawings : or 18. That the patent was extended without any statutory application therefor : or 19. That the patent was repealed : or 20. That the patent legally expired before the alleged infringement began, or before it ended : 21. That the patentee made or sold specimens of the invention covered by his patent, without marking them "patented," and without notifying the defendant of his infringement : or 22. That the plaintiff has no title to the patent, or no such title as can enable him to maintain the action : or 23. That the defendant has a license, which authorized part or all of the doings which constitute the alleged infringement : or 24. That the defendant has a release, discharging him from liability on account of part or all of the alleged infringement : or 25. That the defendant is not guilty of any infringement of the patent upon which he is sued : or 26. That the plaintiff is estopped from enforcing his right of action : or 27. That the cause of action sued upon is partly or wholly barred by some statute of limitation.

§ 441. The first fourteen of these defences assail the validity of original patents ; and either of them, if successfully maintained, will defeat any such patent, and therefore defeat any action based thereon. All of the fourteen are also applicable to actions based upon reissue patents, for though a defective or insufficient specification, or a defective or insufficient claim, or an excessive claim, can be cured by surrender and reissue ; those faults are sometimes retained and sometimes introduced in reissues.¹

The fifteenth, sixteenth, and seventeenth of these defences assail reissues as reissues. To what extent those defences, if successful, will affect the patent, or the action, are points which are explained in the chapter on reissues.²

The eighteenth defence applies only to the extended terms of such patents as were extended by the Commissioner of Patents. If maintained with success on the trial of an action for infringement of such an extended term, such a defence would be completely efficacious ; because the Commissioner never had jurisdiction to extend any patent without such an application therefor as the statutes required.

The nineteenth defence, when true, will certainly be a full one, to any action based on alleged infringements which were committed after the repeal of the patent. Whether it will be a defence to any infringement committed before that time, will depend upon whether the patent is repealed *ab initio*, or only *in futurum*. As no United States patent for an invention was ever yet reported to have been repealed, no further information on this point can at present be conveyed.

The twentieth defence will be available where the defendant can prove that the invention was patented with the knowledge and consent of the inventor in some foreign country before it was patented in the United States, and that such foreign patent expired before the United States patent purported to terminate. This defence, if successful, will not affect the validity of the patent. It will merely limit the time wherein it is capable of being infringed.³

¹ Revised Statutes, Section 4916.

³ Section 163 of this book.

² Sections 225 and 249 of this book.

The twenty-first defence, if successful, will bar the action, but it will not affect the patent. Any oral or written notice of infringement, if given to the defendant without stopping his infringement, will have some effect upon this defence.¹ Whether it will entirely oust the defence, or will oust it only as to subsequent infringements, is a point which appears not to have been much considered. The decision in the case last cited was based on the latter opinion, though an argument could be deduced from the statute which would favor the former.²

The last six of the twenty-seven defences are all without relevancy to the validity of the patent. Either of them may be partly or wholly successful, according to the circumstances of each action, regardless of the success or want of success which may attend the other twenty-one.

§ 442. The ancient rules of common law pleading would require a special plea for either of the twenty-seven defences, which are enumerated in Section 440, save only the defense of non-infringement, and sometimes that of want of title.³ But a loose and unscientific relaxation of that part of those rules, crept at one time into practical pleadings, both in England and America. The abuse was reformed in England in the fourth year of William the Fourth ;⁴ but in the United States it has continued, except so far as it has been limited or enlarged by legislation in particular States. But there was never any principle which guided this departure from the ancient law, and therefore no foundation or any science of the subject. Where an authoritative precedent can be found for a particular relaxation, that particular relaxation must be regarded. In the absence of such a precedent, the safe and proper course is to conform to the ancient common law rules, unless the pleader is willing to risk his defence upon the theory that State statutes relevant to pleadings are binding on Federal courts when trying patent actions of trespass on the case. The

¹ New York Pharmaceutical Association
v. Tilden, 14 Fed. Rep. 740, 1882.

² Revised Statutes, Section 4900.

³ Stephen on Pleading, 160.

⁴ Stephen on Pleading, 158.

text writer believes that they are not binding under such circumstances, because actions of trespass on the case were first prescribed by Congress for patent suits in 1790,¹ and because the law has never since been changed in that particular, and because, therefore, there seems to be no authority for holding that such an action under the Revised Statutes, is a different proceeding from what it was under the earliest of the statutes at large.

§ 443. The patent statute provides that five of the twenty-seven defences may be made under the general issue, accompanied with a certain statutory notice of special matter.² Those are the defences which, in Section 440 of this book, are numbered three, five, six, eight, and eleven, respectively. In the statute, they are mentioned in a different order; and indeed the fifth and sixth are there grouped together, and the third is there separated into two parts. The reasons for changing the classification in those particulars are probably obvious to the reader. The fifth and sixth defences are entirely distinct from each other; while the third is sustained by evidence of anticipating matter, whether that matter is a prior patent or printed publication as contemplated by one division of the statute, or is a prior knowledge or use as contemplated by another. Either of these five defences may also be made under a special plea, instead of under the general issue accompanied by notice, if the defendant so determines.³ But if any defendant uses both these forms of pleading for any one defence, the court will on motion call upon him to select the one which he prefers, and to abandon the other.⁴

§ 444. Notices of special matter must be in writing, and must be served on the defendant or his attorney at least thirty days before the trial of the case.⁵ No such notice requires any order of court as a prerequisite thereto; and depositions taken before the service of such a notice, are as admissible

¹ 1 Statutes at Large, Ch. 7, Sec. 4, p. 111.

² Revised Statutes, Section 4920.

³ *Evans v. Eaton*, 3 Wheaton, 454, 1818; *Grant v. Raymond*, 6 Peters,

218, 1832; *Day v. Car-Spring Co.*, 3 Blatch. 181, 1854.

⁴ *Read v. Miller*, 2 Bissell, 16, 1867.

⁵ Revised Statutes, Section 4920.

under it as if taken afterward.¹ It is not the purpose of the statute to oblige the defendant to give notice of anticipating matter before taking testimony, and thus to enable the plaintiff to tamper with the witnesses. Its only purpose is to give the plaintiff thirty days before the trial, in which to secure evidence to contradict the testimony of the defendant's witnesses, in case the latter is untrue.

Notices of want of novelty must state the names of the prior patentees, and the dates of their patents, where prior patents are relied upon ; and where prior knowledge or use is relied upon, such a notice must state the names and residences of the persons alleged to have had the prior knowledge of the thing patented, and where and by whom it was used.² Where prior printed publications are relied upon as negating the novelty of the patented invention, the statute does not say how such publications are to be identified in such notices. But the Supreme Court has decided that they must be pointed out with sufficient definiteness to relieve the plaintiff from making an unnecessarily laborious search therefor.³ In the case just cited, a notice was held to be insufficient, which stated that the patented thing was described in a certain book therein mentioned, but did not state in what part of that book it was so described. Notices of prior knowledge or use are sufficiently specific, when they specify the city in which that knowledge or use existed or occurred, and give the names of persons who had that knowledge, or who engaged in that use, and state in what city those persons reside.⁴ That is to say: the word "where" and the word "residence," as those words are used in the statute, refer to cities, villages, or towns, as the case may be, and do not refer to particular houses, factories or farms.

The names of witnesses as such need not be mentioned in a notice, yet it is often necessary to use as witnesses, persons who are named in the notice as having been engaged in the prior use to be proved, or as having known of the anticipating

¹ Teese v. Huntingdon, 23 Howard, 1852.
2; 1859.

⁴ Wise v. Allis, 9 Wallace, 737,
1869.

² Revised Statutes, Section 4920.

³ Silsby v. Foote, 14 Howard, 218,

process or thing. Accordingly where a notice alleges that A. B. used an anticipating machine in a certain city, and that C. D. had knowledge of that prior use, those facts may both be proved by E. F. without mentioning his name in the notice.¹ But if A. B. is the only available person by whom to prove his prior use, or if his testimony on that point is to be taken together with that of others, his name must still be mentioned in the notice : mentioned not as a witness to be called to prove a fact, but as the person who transacted that fact.

Notices need not state the particular time when an anticipating printed publication was published, nor when an anticipating process or thing was known or used ;² but they must state the dates of all alleged anticipating patents.³ If a notice does unnecessarily state a particular time, that statement will be regarded as harmless surplusage, and a variance therefrom in the evidence, will not render the latter inadmissible.⁴

§ 445. Where any defence to a patent action can be based upon a fact of which the court will take judicial notice without evidence, that defence may be made under the general issue without any special pleading. This point has perhaps never been adjudicated in an action at law, but the principle upon which it rests is fully established in actions in equity ;⁵ and there is probably no reason to doubt that it will also be enforced on the law side of the Federal courts. In the case last cited, Justice Woods, in delivering the opinion of the Supreme Court, made the following remark : “ Every suitor in a cause founded on letters patent should, therefore, understand that the question whether his invention is patentable or not is always open to the consideration of the court, whether the point is raised by the answer or not.” Now it has been shown that in order to be “ patentable” a process or thing must have four charac-

¹ *Planing-Machine Co. v. Keith*, 101 U. S. 492, 1879 ; *Many v. Jagger*, 1 Blatch. 376, 1848.

² *Phillips v. Page*, 24 Howard, 164, 1860.

³ Revised Statutes, Section 4920.

⁴ *Phillips v. Page*, 24 Howard, 164, 1860.

⁵ *Brown v. Piper*, 91 U. S. 37, 1875 ; *Slawson v. Railroad Co.* 107 U. S. 649, 1882.

teristics. It must be a statutory subject of a patent. It must be an invention. It must be novel. It must be useful.¹ But Justice Woods used the word "patentable" in the first and second of these senses only. It was long ago settled that special pleading, or a statutory notice, is necessary to the defence of want of novelty,² and alleged want of utility is so plainly a question of fact, depending upon evidence, that plaintiffs ought not to be liable to be surprised with that defence, on the trial of an action at law. But Justice Woods' remark, even when thus limited, requires also to be read in the light of the case then at bar. In that case, the patents were held void for want of invention. To find them so, the court had only to take judicial notice that windows had therefore been placed in opposite walls of rooms, and that rays of light had theretofore been reflected through apertures.

§ 446. The first and second defences are those which come within the doctrines of the last section relevant to judicial notice. The first defence is applicable only when a "principle" has been patented, as for example by the eighth claim of Morse,³ or by the anæsthesia patent of Morton and Jackson.⁴ The applicability of those doctrines to that defence is perhaps invariable. But where a patent is assailed for want of invention on account of prior facts which must be proved by evidence in order to be acted upon by courts, there appears to be no warrant for saying that the second defence need not be pleaded. Justice requires that the plaintiff be notified beforehand of such a defence, as truly as of the defence of want of novelty; for it may equally be based on facts outside of the patent, and outside of the knowledge of the inventor and of the plaintiff.

§ 447. The third defence may be based upon a special plea, instead of on the general issue accompanied by notice, and when that practice is adopted, that plea is the only notice which the

¹ Chs I. to IV. of this book.

112, 1853.

² *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868.

⁴ *Morton v. Infirmary*, 5 Blatch. 116, 1862.

³ *O'Reilly v. Morse*, 15 Howard,

plaintiff can claim.¹ Federal courts of equity, without any statute prescribing that course, have always followed the law relevant to notices of want of novelty; and have uniformly rejected evidence on that point, unless the defendant, in his answer, gave the plaintiff the same kind and degree of information thereof, that the statute calls upon a defendant, who pleads the general issue at law, to give in his notice.² Courts of law will probably follow this salutary example, and will call upon defendants who elect to plead specially, to make their special pleas as full in this respect, as the statute requires notices to be when the general issue is adopted. So also, it has been held that special pleas, when used instead of notices, must be filed at least thirty days before the term of trial, or the plaintiff will be entitled to a continuance.³ This holding was so reasonable that it can be supported on the ground that every court has power to make reasonable rules to regulate the time of filing pleas.⁴ A special plea which has been stricken out by order of court, cannot operate as a notice and thus furnish the foundation of a defence which requires a notice in the absence of a special plea.⁵

§ 448. The fourth defence is not among those which can be made under the general issue accompanied by notice. There is probably no case in which it has been successfully made in equity, without being set up in the answer; or at law, without being set up in a special plea. In the absence of such precedents, it would be unsafe for a pleader to attempt such an innovation on the rules of the common law.

§ 449. The fifth and sixth defences always require evidence outside of the patent, and outside of the doctrines of judicial notice. They may be made under the general issue accompanied by the statutory notice,⁶ or under a special plea, but

¹ *Evans v. Eaton*, 3 Wheaton, 504, 1818.

² *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868.

³ *Phillips v. Comstock*, 4 McLean, 525, 1849.

⁴ *Packet Co. v. Sickles*, 19 Wallace, 611, 1873.

⁵ *Foot v. Silsby*, 1 Blatch. 445, 1849.

⁶ Revised Statutes, Section 4920.

there is no reason to suppose that they can lawfully be made under the general issue alone.

§ 450. The seventh defence is not based on any express statute. Its foundation is the general spirit of the patent laws, re-enforced by the *dicta* of the Supreme Court in the case of *Railway Co. v. Sayles*.¹ Evidence to support it must always be drawn from outside of the patent, and must be regularly introduced into the case. This defence is therefore to be made by a special plea, when it is made at all. But its applicability will always be very infrequent.

§ 451. The eighth defence may be made either by the general issue accompanied by notice,² or by a special plea. It applies to cases where another than the patentee preceded him in the first conception of the patented thing, but did not precede him in adapting it to actual use. If that other stopped with that conception, the validity of the patent is not affected thereby, but if he used reasonable diligence in adapting and perfecting the invention so conceived, no subsequent inventor can have a valid patent, surreptitiously or unjustly obtained by him for the same invention. Such a patent is surreptitiously obtained, where the patentee appropriates the idea from the first conceiver, and, exceeding him in speed, reduces the invention to proper form, and secures the patent, while the first conceiver is diligently laboring to adapt the invention to use. Such a patent is unjustly obtained, if it is issued to a subsequent inventor, without notice to the first conceiver, when a caveat of the first conceiver is on file in the Patent Office.³ Where this defence is pleaded, all its elements must be incorporated in the plea. The allegation of unjust or surreptitious obtaining of the patent, must be accompanied by an allegation that the first conceiver was at the time using reasonable diligence in adapting and perfecting the invention.⁴

§ 452. The ninth and tenth defences are based on the fact

¹ *Railway Co. v. Sayles*, 97 U. S. 1859.
563, 1878.

² Revised Statutes, Section 4920.

³ *Phelps v. Brown*, 4 Blatch. 362,

⁴ *Agawam Co. v. Jordan*, 7 Wallace,
583, 1868.

that patents can lawfully be granted to no one but the inventors of the things covered thereby, or to those who represent them as assigns or legal representatives.¹ Neither of those defences can ever receive any support from the face of the patent, or from any fact of which any court can take judicial notice. Both depend upon evidence *aliunde*, and either must be interposed in a special plea, for the statute does not include either among those defences which may be made under the general issue accompanied by notice.

§ 453. The eleventh defence may be set up under the general issue accompanied by notice,² or in a special plea. It is a defence which is oftener put in by pleaders who are at a loss how to defend, than it is by those who assail patents intelligently. It has seldom or never been made with success, because patents are seldom or never obnoxious to the objection which it involves. Even where a patent does contain too much or too little, this defence does not apply, unless the fault was intended, and was intended to deceive the public.³

§ 454. The twelfth defence is somewhat similar to the first member of the eleventh; but unlike that, it cannot be based on the general issue accompanied by notice; and it does not require the element of intention to deceive. It is based upon that provision of the statute which makes a full, clear, concise, and exact description of the invention a prerequisite to the jurisdiction of the Commissioner to grant a patent.⁴ If a patent falls below the statutory requirement in that respect, that patent is void.⁵ Whether a given patent does so fall, is a question of evidence and not of construction.⁶ This defence must be interposed in a special plea; for neither the statute nor any precedent contemplates its being based on the general issue, either with or without notice; and still less does any rule of law provide for its being made on the trial of an action without being pleaded at all.

¹ Sections 50 and 51 of this book.

² Revised Statutes, Section 4920.

³ *Hotchkiss v. Oliver*, 5 Denio (N. Y.) 314, 1848.

⁴ Revised Statutes, Section 4888.

⁵ *O'Reilly v. Morse*, 15 Howard, 62, 1853.

⁶ *Loom Co. v. Higgins*, 105 U. S. 580, 1881.

§ 455. The thirteenth defence is based on the statute which requires, that before any inventor shall receive a patent for his invention, he shall particularly point out, and distinctly claim, the part, improvement, or combination which he claims as his invention.¹ It is a defence of decided merit, aimed by the policy of the law at nebulous claims. The courts have not heretofore gone quite so far in upholding this defence, as the statute would perhaps justify. Probably the strongest judicial language heretofore used on the subject, is that of the Supreme Court in the case of *Carlton v. Bokee*.² In that case, Justice BRADLEY, in delivering the opinion, said that: "Where a specification by ambiguity and a needless multiplication of nebulous claims, is calculated to deceive and mislead the public, the patent is void." A special plea is also the best and safest means of interposing this defence; though there is less meritorious necessity for special pleading in support of it, than in support of any other defence which assails the validity of a patent. The question of such validity, as against this defence, is a question of construction of the document, to decide which, a judge will seldom require aid from outside the letters patent themselves.

§ 456. The fourteenth defence is based upon the statute which provides that where a new invention and an old one are both claimed in a patent, the patentee may sustain an action on the former, but not unless he disclaims the latter without unreasonable delay.³ That the old invention was old, and that the delay to disclaim it was unreasonable, are matters of fact depending upon evidence. There is therefore no reason to suppose that this defence can be made in any action at law, without a special plea to give it entrance.

§ 457. The fifteenth defence goes to the jurisdiction of the Commissioner to reissue the patent in suit. In the chapter on reissues, the defence is discussed with some fulness.⁴ Whatever doubt may exist relevant to its validity, it is clear that

¹ Revised Statutes, Section 4888.

² *Carlton v. Bokee*, 17 Wallacoe, 472, 1873.

³ Revised Statutes, Section 4922.

⁴ Sections 221 to 225 of this book.

the questions which are involved in its applicability to a particular case, are mainly questions of fact, depending upon evidence *in pais*, and that a special plea is therefore the proper means of bringing it to the attention of the court.

§ 458. The sixteenth defence originated in the year 1882,¹ and though not based on the letter of any statute, it has already been many times enforced. The first element in its foundation is a point of comparative construction of the original and the reissued patent. But inasmuch as a plaintiff, suing on a reissue, need not introduce the original in evidence, even that element depends upon proof by the defendant of the contents of the original. The second element is a variable quantity, for the particular length of time, between the date of an original and the application for a reissue patent, which will be fatal to a broadened reissue, depends upon the circumstances of each case, and those circumstances can be made known to the court through evidence alone. These considerations point to the propriety of disregarding this defence, in an action at law, unless it is set up in a special plea, and the plaintiff thus notified of what he must meet on the trial.

§ 459. The seventeenth defence is among the most common in patent litigation. It also depends upon proof of the original patent, and requires at least that amount of evidence to support it. In cases where the question of sameness or difference of invention is a complicated one, courts will generally require the benefit of evidence on that subject to aid them in deciding the point.² In order to give both sides an opportunity to produce such evidence, a special plea is necessary to be insisted upon. Such a requirement is consistent also with the practice in equity, where this defence has been interposed on that side of the courts.

§ 460. The eighteenth defence has seldom been made, and has never been made successfully in any reported case. It will probably never again be applicable to any extension, for extensions capable of being sued upon are rapidly diminishing

¹ *Miller v. Brass Co.*, 104 U. S. 350, 1882.

² *Powder Co. v. Powder Works*, 98 U. S. 134, 1878.

in number. If an occasion should arise for its interposition, it ought to be set up in a special plea, for it depends upon a point of fact, and one upon which evidence outside of the patent is likely to be required.

§ 461. The nineteenth defence will of course require evidence of the record of the court which repealed the patent. But as that record cannot be contradicted by any evidence, and as no repeal could have been had without the knowledge of the plaintiff or his privies, there seems to be no meritorious reason why a special plea should be insisted upon to sustain this defence. But in the absence of a precedent, that will be the safest pleading for the defendant to file.

§ 462. The twentieth defence demands a special plea, because the evidence to prove it must come from outside of the patent, and when produced it must generally be supported by expert testimony that the foreign patent produced is really one for the same invention as the United States patent in suit. Indeed the defence may fail even then, for it cannot stand against proof that the foreign patent was surreptitiously taken out by another than the United States patentee, and without his knowledge or consent. It would be highly unjust to allow a plaintiff to be surprised on the trial of an action at law, with proof of a foreign patent for his invention granted to another after his invention was made, but before the date of his patent. Such a piece of evidence, if unexplained, would limit the duration of the United States patent, and thus perhaps defeat the suit.¹ But if the plaintiff could have time to prove that it was granted without the knowledge or consent of the inventor or patentee, it would have no unfavorable effect upon his rights. It is clear, therefore, that no such issue ought to be sprung upon a plaintiff when before the court. A special plea is requisite to give him notice of a fact apparently so unfavorable, but which may really be harmless when explained.

§ 463. The twenty-first defence is *prima facie* made out, by proof that the plaintiff made or sold specimens of his invention

¹ Revised Statutes, Section 4887.

without marking them "patented." But it can be at least partly, and perhaps wholly, overthrown by proof that the defendant continued to infringe, after he was duly notified of the patent and of his infringement.¹ It is therefore certain that the *prima facie* evidence ought not to be admitted without a special plea, because if it were, a verdict might be based on only half of the truth, even where the other half would have led to a contrary conclusion if the plaintiff had been notified of the necessity of producing the evidence to prove it.²

§ 464. The twenty-second defence can be made under the general issue, where the defendant merely proposes to argue that the plaintiff's evidence does not make out any title, or makes out no such title as enables him to sue in an action at law. But where the defendant attacks the plaintiff's title on the basis of a paramount assignment to another, he ought to plead the defence specially, for otherwise the plaintiff might be surprised on the trial with evidence which, with a little time for preparation, he could perhaps explain away, or perhaps overthrow.

§ 465. The twenty-third and twenty-fourth defences both required to be pleaded specially according to the pleading rules of the ancient common law.³ But under the relaxation which obtained in England, late in the last century, they could, in ordinary cases, have been proved under the general issue.⁴ That relaxation does not, however, deserve to be extended by any process of reasoning by analogy; and it is possible that the courts will hold that it does not apply to patent litigation in the United States.

§ 466. The twenty-fifth defence is one to which the plea of the general issue is, and always was, appropriate, for it is a defence which consists simply in a denial of the alleged infringement.⁵ And even where a proper defence of non-infringement involves evidence of the state of the art, the general issue is a sufficient plea under which to make such a

¹ Revised Statutes, Section 4900.

² Rubber Co. v. Goodyear, 9 Wallace 801, 1869.

³ Stephen on Pleading, 158.

⁴ 1 Chitty on Pleading, 491.

⁵ Stephen on Pleading, 160.

defence, because no notice to the plaintiff is necessary to render such evidence admissible.¹

§ 467. The twenty-sixth defence is as proper in an action at law as it is in an action in equity.² Estoppels in patent cases are like those in other cases, in that they are divisible into three classes: Estoppels by matter of record; by matter of deed; and by matter *in pais*. The principles of estoppel constitute a systematic department of the law, to the development and delineation of which a number of text-writers have devoted careful and thorough consideration. No extensive discussion of the subject is therefore to be expected in this book. Something has already been written about estoppel *in pais*, in connection with the subject of implied licenses.³ Something more may be added in this place, about estoppels by matter of record, and by matter of deed, for the patent precedents contain a few cases in which those doctrines have been applied to controversies touching letters patent for inventions. But the investigator will often need to resort to the standard text-books on estoppel, when seeking for the law applicable to such matters, as they may hereafter arise in patent litigation; for the instances in which the doctrines of estoppel have heretofore been applied to patent cases are comparatively few. Those doctrines may, however, be deduced from other kinds of causes, and then applied in patent litigation with all their inherent force.⁴

§ 468. Estoppel by matter of record arises out of the doctrine of *res judicata*; and indeed that sort of estoppel generally and properly passes under the name of that doctrine. It is a requirement of public policy and of private peace, that each particular litigation shall duly come to an end, and that when once ended, it shall not be revived. The law therefore properly requires that things adjudicated, shall not again be drawn in question between the same parties, or be-

¹ *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868; *Blanchard v. Putnam*, 8 Wallace, 420, 1869; *Dunbar v. Myers*, 94 U. S. 198, 1876.

² *Dickerson v. Colgrove*, 100 U. S.

584, 1879; *City of Concord v. Norton*, 16 Fed. Rep. 477, 1883.

³ Section 313 of this book.

⁴ *Duboise v. Railroad Co.* 5 Fisher, 208, 1871.

tween any persons whose connection with the adjudication is such that they ought not to be permitted to gainsay its result. But things are not adjudicated in this sense till they are adjudicated finally. Interlocutory decrees, therefore, furnish no foundation for a plea of *res judicata*.¹ A final decree is pleadable, in a subsequent action, notwithstanding the defendant may have new defences to interpose: defences, which he did not deem it necessary to make to the former suit, or did not learn of in time to set them up in the former litigation.² And final decrees or judgments are not only binding on the parties to the actions from which they resulted, but they are also binding upon all persons who purchase interests in the subject-matter of litigation after such decrees or judgments are entered;³ and upon all persons who assumed the control and expense of the former litigation, even though not parties thereto.⁴ So also, judgments by default and decrees *pro confesso* are pleadable as *res judicata*, if they are final in their nature, with the same effect as are judgments or decrees which were rendered after a long-contested litigation.⁵ But in order to be binding on either party to a new action, a former judgment or decree must be binding on both. No former adjudication is pleadable in favor of either party to a suit unless it would have been pleadable against him, if it had been rendered the other way.⁶

§ 469. Estoppel by matter of deed may also arise in patent affairs. Where, for example, an assignor or grantor of a patent right, afterward infringes the right which he conveyed, he is estopped, by his conveyance, from denying the validity of the patent, when sued for its infringement.⁷

¹ Rumford Chemical Works v. Hecker, 2 Bann. & Ard. 359, 1876.

² Duboise v. Railroad Co. 5 Fisher, 210, 1871.

³ Consolidated Fruit-Jar Co. v. Whitney, 2 Bann. & Ard. 33, 1875.

⁴ United States Felting Co. v. Asbestos Felting Co. 4 Fed. Rep. 816, 1880.

⁵ Bradford v. Bradford, 5 Connecticut, 131, 1823; Davis v. Murphy, 2 Rich. (S. C.), 560, 1846.

⁶ Ingersoll v. Jewett, 16 Blatch. 378, 1879; Dale v. Roosevelt, 1 Paige (N. Y.) 35, 1828; Paynes v. Coles, 1 Munford (Va.) 394, 1810.

⁷ Consolidated Middlings Purifier Co. v. Guilden, 9 Fed. Rep. 156, 1881.