

adjudication, if made, authorizes the Commissioner to issue such a patent, on the applicant's filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of the law;<sup>1</sup> and it then becomes the duty of the Commissioner to issue the patent.<sup>2</sup> But no court has any jurisdiction to restrain the Commissioner from issuing a patent to the defendant, in any such case as those treated in this section.<sup>3</sup>

In order to decide the issues of such a bill in equity as is treated in this section, the court where the bill is pending will take testimony, and any other admissible evidence, according to the course of courts of equity; and will also consider whatever was before the Patent Office in the proceedings which resulted in the refusal to grant a patent; and, if the case has been before the Court of Appeals of the District of Columbia, will also consider the proceedings which took place in that tribunal.<sup>4</sup> The burden is on the complainant to prove the truth of his bill, by evidence that is clear and conclusive.<sup>5</sup> The litigation explained in this section is therefore original, and not appellate litigation. But it may not be resorted to as a concurrent remedy with an appeal to the Court of Appeals of the District of Columbia in any case where such an appeal lies; because, where that remedy exists, it must be exhausted before the ultimate redress of a bill in equity can be invoked.<sup>6</sup>

Where the Commissioner withholds a patent by virtue of his general supervisory authority, the remedy now under consideration is the only one to which the applicant can resort, for no appeal lies to the Court of Appeals of the District of Columbia, nor can any writ of mandamus be

<sup>1</sup> Revised Statutes, Section 4915.

<sup>2</sup> *Butterworth v. Hoe*, 112 U. S. 62, 1884; *Vermont Farm Machine Co. v. Marble*, 20 Fed. Rep. 118, 1884.

<sup>3</sup> *Whipple v. Miner*, 15 Fed. Rep. 117, 1883; *Illingworth v. Atha*, 42 Fed. Rep. 141, 1890.

<sup>4</sup> *Butterworth v. Hoe*, 112 U. S. 61, 1884; *Gandy v. Marble*, 122 U. S. 439, 1886.

<sup>5</sup> *Durham v. Seymour*, 71 Off. Gaz. 604, 1895.

<sup>6</sup> *Kirk v. Commissioner of Patents*, 37 Off. Gaz. 451, 1886.

granted by that tribunal, to compel the Commissioner to issue a patent in such a case.<sup>1</sup>

Where a patent is refused because of an adverse decision of an interference, and where an applicant files a bill in equity to procure a patent, on the ground that the decision of the question of priority in the interference was wrong; the court will dismiss the bill if it finds the alleged invention to have been not patentable to either of the parties in the interference, regardless of any question of priority between those parties.<sup>2</sup>

The remedy delineated in this section must be invoked within two years after the last official action on the application; unless the complainant satisfies the court in which it is invoked, that the longer delay was unavoidable.<sup>3</sup>

§ 135. The right to amend applications for patents is one of great value and frequent exercise, but it has never been expressly established by any statute. No statute prior to that of 1836 even mentioned the subject, and that statute only provided that whenever it appeared to the Commissioner, that one or more of the claims of an application were inadmissible for want of novelty, or that the description was defective and insufficient, he should notify the applicant thereof, and should furnish him with such information as might be useful in judging of the propriety of altering his specification, so as to exclude that part of the subject-matter found not to be new.<sup>4</sup> No change relevant to this point was made in the statute till 1870, when, in the place of the foregoing provision, it was enacted that whenever any claim was rejected, for any reason whatever, the Commissioner should notify the applicant thereof, and should furnish him with such information as might be useful in judging of the propriety of altering his specification.<sup>5</sup> The

<sup>1</sup> *Hull v. Commissioner of Patents*, 7 Off. Gaz. 559, 1875; 8 Off. Gaz. 46, 1875.

<sup>2</sup> *Hill v. Wooster*, 132 U. S. 693, 1890.

<sup>3</sup> *Gandy v. Marble*, 122 U. S. 439,

1886.

<sup>4</sup> 5 Statutes at Large, Ch. 357, Section 7, p. 120.

<sup>5</sup> 16 Statutes at Large, Ch. 230, Section, 41, p. 204.



present statute on the subject is substantially identical with that of 1870.<sup>1</sup>

There is no apparent material difference, at this point, between any of the three statutes, unless the provision in that of 1836, relevant to the nature of the amendment contemplated by that section, constitutes a limitation not found in either of the others. The two later statutes provide that the Commissioner shall furnish the applicant with such information as may be useful in judging of the propriety of altering his specification. The earlier statute adds to that provision the words: "to embrace only that part of the invention or discovery which is new." All three of the statutes recognize the right of an applicant to alter his specification, after rejection of any claim therein. They differ from each other only in regard to the kind of information which they require the Commissioner to furnish the applicant, to guide him in the exercise of that right. Neither of them furnishes the foundation of that right, nor limits that right to cases where the application has been rejected. They all provide a proceeding for such cases, but neither of them negatives the existence of such a right in other cases.

§ 136. The real foundation of the right to amend applications for patents, is found in Section 4888 of the Revised Statutes, a section substantially identical with Section 26 of the Patent Act of 1870, and with the second sentence of Section 6 of the Patent Act of 1836, and with the middle part of Section 3 of the Patent Act of 1793. Ever since 1793, one or another of these four enactments has been in force, and has provided, in substance, that before any inventor shall receive a patent for his invention, he shall file in the Patent Office a full, clear, and exact written description of that invention. Ever since 1836, one or another of the three statutes first mentioned has been in force, and has additionally provided that before any inventor shall receive a patent, he shall particularly point out and claim the part or combination which he claims as his

<sup>1</sup> Revised Statutes, Section 4903.

invention. Now when a statute enacts that a thing shall be done before a particular event can occur, it implies that it can be done prior to such an event. An inventor may therefore do those things before he receives a patent. If he fails in his first attempt to furnish a proper and adequate description, or to furnish proper and adequate claims, he may try again, and, if necessary, still again and again. If he finally succeeds in both, the Commissioner acquires jurisdiction to grant him a patent, provided all the other requirements of the law are also complied with. The statute does not attend to the details of this matter. It only provides that at some time before a patent is issued, a proper description and a proper claim shall be filed in the Patent Office. To what extent these things must be done at first, and to what extent and under what circumstances they may be done by way of amendment of the original papers, are questions which are to be determined in the light of the decisions of the courts, made under general judicial authority; and of the rules of the Patent Office, made under Section 483 of the Revised Statutes. To ascertain, therefore, what may and what may not be done by way of amendments of applications, the true recourse is to those decisions and those rules.

§ 137. The applicant may amend before or after the first rejection, and he may amend as often as the examiner presents any new references or reasons for rejection; but after such action on all the claims as entitles the applicant to an appeal to the board of examiners-in-chief, no amendment is allowed, unless the applicant convinces the examiner or the Commissioner, that there was a sufficient excuse for the delay in presenting it.<sup>1</sup> Amendments not affecting the merits may be made after the patent is allowed, and even after the final fee is paid, provided those amendments are approved first by the examiner, and then by the Commissioner.<sup>2</sup>

<sup>1</sup> Patent Office Rule 68.

<sup>2</sup> Patent Office Rule 78.



§ 138. It was formerly held, that whenever an inventor files an application for a patent, he was regarded as applying for such a patent as would cover every patentable thing represented in the specification, drawing or model of that application.<sup>1</sup> If, therefore, his claims as first submitted to the Commissioner did not cover every such thing, he was allowed to amend them to whatever extent was necessary to make them do so, or he was allowed to add other claims to accomplish that purpose. But the law of the subject has more lately been laid down on stricter lines, though those lines have not yet been accurately delineated, in all their parts, in the decisions.

The general rule is that no amended or new claim can be allowed, unless it is for the "same invention" as the original application.<sup>2</sup> It has been decided that this quoted phrase is not confined in its meaning to whatever invention was actually claimed by the inventor in his original application, and that claims may be broadened, while applications are pending.<sup>3</sup> And it has also been decided, that a drawing may be amended in the light of the specification, even to the extent of inserting in it, the distinguishing characteristic of the invention, when that was accidentally omitted from the original drawing.<sup>4</sup> But it has not been decided whether "the same invention" refers to whatever invention was described, indicated, or shown in the applicant's original specification, drawing, or model; or refers to whatever invention was described or indicated in the original specification or drawing; or refers to whatever invention was described in the original specification; or refers to whatever invention was described in the original specification, and appeared therein to have been intended to be secured by

<sup>1</sup> *Singer v. Braunsdorf*, 7 Blatch. 532, 1870.

<sup>2</sup> *Railway Co. v. Sayles*, 97 U. S. 554, 1878; *Eagleton Mfg. Co. v. West Mfg. Co.* 111 U. S. 490, 1884; *Beach v. Box Machine Co.* 63 Fed. Rep. 604, 1894; *Michigan Central*

*R. R. Co. v. Car-Heating Co.* 67 Fed. Rep. 126, 1895.

<sup>3</sup> *Rocker Spring Co. v. Thomas*, 68 Fed. Rep. 200, 1895.

<sup>4</sup> *Consolidated Brake Shoe Co. v. Detroit S. & S. Co.* 59 Fed. Rep. 903, 1894.

the original application. The latter signification of the phrase, is that which the same phrase has been finally decided to bear in the law of roissues.<sup>1</sup> But there are reasons why a more liberal meaning should be ascribed to it in the law of amendments of applications ; and it is therefore probable that the courts will finally establish one or another of the more liberal significations, as being the true meaning of the phrase in the latter law.

An amendment which does not add or broaden any claim, may be made by the attorney of the applicant, even after the death of the latter ;<sup>2</sup> but in case the applicant seeks, by amendment, to introduce any claim not substantially embraced in the statement of invention or any claim originally presented, he is required to file a supplemental oath that the subject of the proposed amendment, was part of his invention, and was invented before he filed his original application.<sup>3</sup>

§ 139. An applicant must amend his specification, whenever such amendment is required to correct inaccuracy or unnecessary prolixity therein, or to secure correspondence between the claim and the other parts of the specification.<sup>4</sup> So also, unless the original drawings and model conform to certain standards of artistic and mechanical excellence set forth in the rules, the applicant must furnish amended drawings and an amended model which do conform to those requirements.<sup>5</sup>

§ 140. An interference is a proceeding carried on in the Patent Office, for the purpose of determining the question of priority between two or more parties, each of which is seeking a patent for the same invention ; or between two or more parties, at least one of which is seeking a patent for an invention already covered by a patent which has not yet expired.<sup>6</sup> The proceedings in interferences are governed by

<sup>1</sup> Section 233 of this book.

<sup>2</sup> *De La Vergne Machine Co. v. Featherstone*, 147 U. S. 229, 1893.

<sup>3</sup> Patent Office Rule 48.

<sup>4</sup> Patent Office Rule 71.

<sup>5</sup> Patent Office Rules 49 to 59.

<sup>6</sup> Revised Statutes, Section 4904; Patent Office Rule 93; *United States v. Commissioner of Patents*, 7 Off. Gaz. 603, 1875; *Hisey v. Peters*, 71 Off. Gaz. 893, 1895.



an elaborate code of Patent Office rules, which are as binding as the law itself,<sup>1</sup> and to which the practitioner, in such cases, will necessarily resort for detailed information.<sup>2</sup> It is unnecessary to explain those rules in this text-book, but it is expedient to set down in this connection the relevant rules of law, which rest directly upon the statutes and decisions for their sanction.

§ 141. There is no limit to the number of interferences to which an application may be subjected; and if a patent is issued without going through every such proceeding, previously ordered by the Commissioner, that patent will be void.<sup>3</sup> The ordinary rules of evidence which are applied in United States courts are used in interference cases.<sup>4</sup> This includes the rules which relate to dispensing with evidence of facts of public notoriety.<sup>5</sup> The doctrines of estoppel also apply in these contests, in the same manner in which they apply in other litigious proceedings.<sup>6</sup>

But a witness who is not a party to the interference, is protected, by a statute, from being compelled to disclose any secret invention made or owned by himself;<sup>7</sup> but that statute does not allow a party to an interference to refuse to answer any question relevant to the invention in interference.<sup>8</sup>

In deciding an interference, priority is awarded to the party who first conceived the invention, provided he used due diligence in reducing it to practice, or in applying for a patent thereon; but if laches intervened between his conception on the one hand, and his reduction to practice, or his application for a patent, on the other hand; then priority is awarded to the party who first reduced the

<sup>1</sup> *Arnold v. Bishop*, 1 McArthur's Patent Cases, 31, 1841; *United States v. Marble*, 2 Mackey, 12 1882.

<sup>2</sup> Patent Office Rules 93 to 132, and 146 and 147.

<sup>3</sup> *Potter v. Dixon*, 2 Fisher, 381, 1863.

<sup>4</sup> *Berry v. Stockwell*, 9 Off. Gaz.

404, 1876.

<sup>5</sup> *Anson v. Woodbury*, 12 Off. Gaz. 1, 1877.

<sup>6</sup> *Berry v. Stockwell*, 9 Off. Gaz. 404, 1876.

<sup>7</sup> Revised Statutes, Section 4908.

<sup>8</sup> *Dorman v. Keefer*, 49 Fed. Rep. 462, 1892.

invention to practice, or applied for a patent, as the case may be.<sup>1</sup>

§ 142. No decision of the Commissioner, in any interference case, is pleadable as *res judicata* in any action in any court;<sup>2</sup> but such a decision will be followed by the courts, unless it is shown to be wrong, by evidence which puts the point beyond a reasonable doubt.<sup>3</sup> Where such a decision is made between two or more applications, a patent is granted to the inventor decided to be first, and no patent is granted to either of the others. If it is made between an application and a patent, and is made in favor of the application, the Commissioner will grant a patent thereon, but he cannot recall the patent already issued. In such a case, the rival inventors may litigate their interference controversy anew, on the equity side of any United States Circuit Court which has or can acquire jurisdiction of the parties.<sup>4</sup> That kind of litigation constitutes the subject of the chapter on interfering patents; the thirteenth chapter of this book. Or the question of priority between the two inventors may be litigated afresh in any infringement suit, brought by one of them against the other. If, in such a case as that under present consideration, it had happened that the successful applicant had filed his application before the interfering patent was granted, that patent would not have been granted at all, unless the Patent Office decision on the interference had been reversed by some higher authority. In that event, the successful applicant would not have been liable to any interference suit, nor any infringement suit, brought against him by his rival; for his rival would, in that event have no patent upon which to base a suit of either of those kinds.

<sup>1</sup> Reed v. Cutter, 1 Story, 598, 1841; McCormick Mach. Co. v. Minneapolis Harvester Works, 42 Fed. Rep. 154, 1890; Burr v. Ford, 70 Off. Gaz. 275, 1894.

<sup>2</sup> Union Paper Bag Machine Co. v. Crane, 1 Bann & Ard. 494, 1874; Gloucester Isinglass Co. v. Brooks,

19 Fed. Rep. 427, 1884; Hubel v. Tucker, 24 Fed. Rep. 701, 1885; Kirk v. DuBois, 33 Fed. Rep. 252, 1887.

<sup>3</sup> Morgan v. Daniells, 153 U. S. 123, 1894; Hisey v. Peters, 71 Off. Gaz. 894, 1895.

<sup>4</sup> Revised Statutes, Section 4918.



For this reason, as well as for others, every inventor who desires to secure a patent for an invention, should make his application therefor soon after making that invention. If, however, that invention requires time in reaching maturity, the inventor may prevent the issuing of any interfering patent in the meantime, by filing a caveat in the Patent Office.

§ 143. A caveat is a document in which an inventor states the function, and the distinguishing characteristics, of the invention to which it refers, and prays protection for his right thereto, until he shall have matured that invention. A caveat remains in force only one year; and while it is in force, its only statutory function is to prevent the issuing of any patent to another, for the same invention, until after the caveator has notice of the interfering application, and has thus had an opportunity to file an application himself, and so delay the issuing of a patent to his competitor until an interference proceeding in the Patent Office shall have decided the question of priority.<sup>1</sup> If an invention is fully described in a caveat, then that caveat will constitute evidence showing that invention to have been made at least as early as the caveat was filed. This, however, is an incidental and not a statutory function of such a document, and it cannot be performed by any caveat which is not complete enough in its description to enable a skilful mechanic, without inventing anything himself, to construct a specimen of the invention to which the caveat refers. But even where a caveat does not reach that standard, it constitutes evidence that the invention had reached the stage of development shown in the caveat, at the time the caveat was executed.<sup>2</sup>

Omission to file a caveat does not impair the ultimate rights of an inventor;<sup>3</sup> and omission to consider a caveat does not invalidate a patent granted to another in pursuance of the oversight.<sup>4</sup>

<sup>1</sup> Revised Statutes, Section 4902; *Bell v. Daniels*, 1 Fisher, 372, 1858.

<sup>2</sup> *Jones v. Wetherell*, 1 McArthur's Patent Cases, 413, 1855.

<sup>3</sup> *Heath v. Hildreth*, 1 McArthur's Patent Cases, 25, 1841.

<sup>4</sup> *Cochrane v. Waterman*, 1 McArthur's Patent Cases, 59, 1844.

But whether an immature invention is provisionally protected by a caveat or not, it should not be made the subject of an application for a patent until it reaches maturity; for it has happened in the past, and may otherwise happen hereafter, that a patent granted on an application, based on an immature invention, is not strong enough or broad enough to give any valuable exclusive right, while being significant enough to weaken or to narrow the operation of any subsequent patent granted to the same inventor, on a mature invention, in the same department of the useful arts.

§ 144. No appeal lies from any decision of the Court of Appeals of the District of Columbia, on an appeal to that tribunal from the Commissioner of Patents. But an appeal does lie from any decision of any United States Circuit Court, or of the Supreme Court of the District of Columbia, on any bill in equity which may be filed to compel the issuance of a patent, after an unsuccessful appeal to the Court of Appeals of the District of Columbia, from the rejection of an application by the Commissioner of Patents. Where such a bill is filed and adjudicated in some Circuit Court of the United States, an appeal lies from its decision to the Circuit Court of Appeals of the circuit to which that Circuit Court belongs.<sup>1</sup> And where such a bill is filed and adjudicated in the Supreme Court of the District of Columbia, an appeal lies to the Court of Appeals of the District of Columbia.<sup>2</sup> And where a decree of the latter tribunal, in disposing of such an appeal, involves the validity of any patent, as it may in the case of an interference between a patent and an application, an appeal apparently lies from that tribunal, to the Supreme Court of the United States.<sup>3</sup>

§ 145. An application for a patent may be abandoned. That abandonment may be actual, or it may be constructive. The facts which constitute an actual abandonment of an application, may also constitute an actual abandonment of

<sup>1</sup> 26 Statutes at Large, Ch. 517, Sec. 7, p. 435.  
Sec. 6, p. 828.

<sup>3</sup> 27 Statutes at Large, Ch. 74,

<sup>2</sup> 27 Statutes at Large, Ch. 74, Sec. 8, p. 436.



the invention covered thereby; and a constructive abandonment of an application, may or may not work a constructive abandonment of the invention.

Actual abandonment of an application does not always follow from the fact that the applicant withdrew it from the Patent Office. If, when withdrawing it, he intended to file a new application for the same invention, and accordingly does so, the two are held to constitute one continuous application within the meaning of the law.<sup>1</sup> This doctrine applies, even if the new application is not filed till long after the old one was withdrawn, provided there was no laches chargeable to the applicant on account of the delay.<sup>2</sup>

Nor does actual abandonment of an application necessarily follow from the fact that it was rejected by the Patent Office, and then allowed to lie dormant by the applicant. If, in such a case, the applicant always expected to secure a patent, either on the original application or on another, and if, without laches, he made and prosecuted another application for the same invention, and secured a patent thereon; the two applications are considered, in the eye of the law, to be one.<sup>3</sup>

Laches, if it intervenes, between a withdrawn or rejected application and a new application covering the same invention, will, however, be fatal to any claim of continuity.<sup>4</sup> It will constitute evidence that the first application was actually abandoned, and equally good evidence of the actual abandonment of the invention itself.<sup>5</sup>

§ 146. Constructive abandonment of an application occurs whenever two years intervene between the filing of the

<sup>1</sup> *Godfrey v. Eames*, 1 Wallace, 317, 1863; *International Crown Co. v. Richmond*, 30 Fed. Rep. 779, 1886; *Dederick v. Fox*, 56 Fed. Rep. 715, 1892.

<sup>2</sup> *Howes v. McNeal*, 3 Bann. & Ard. 376, 1878.

<sup>3</sup> *Smith v. Dental Vulcanite Co.* 93 U. S. 500, 1876; *Blandy v. Griffith*, 3 Fisher, 617, 1869; *Graham*

*v. McCormick*, 5 Bann. & Ard. 244, 1880; *Ligowski Clay Pigeon Co. v. Clay Bird Co.* 34 Fed. Rep. 334, 1887.

<sup>4</sup> *Bevin v. Bell Co.* 9 Blatch. 61, 1871; *Weston v. White*, 13 Blatch. 452, 1876.

<sup>5</sup> *Planing Machine Co. v. Keith*, 101 U. S. 484, 1879.

application and its being made complete enough to entitle it to examination, according to the rules of the Patent Office; and such an abandonment also occurs if the applicant allows two years to pass without regularly prosecuting his application, after any particular action is taken thereon by the Patent Office, and notified to him; provided, in either case, the Commissioner of Patents is not convinced that the delay was unavoidable.<sup>1</sup> If he is so convinced he may condone the delay by granting a patent; and if he grants a patent, his decision on the point is conclusive.<sup>2</sup>

All applications, also, which were rejected or withdrawn prior to July 8, 1870, and not revived within six months after that day, were thereby constructively abandoned.<sup>3</sup> The statutory provision just cited, did not operate to renew any right to any abandoned invention.<sup>4</sup> Nor did it fix any time after which any invention should be held to be abandoned, for it provided no result from six months' delay, except that the application should be held to have been abandoned.

So, also, constructive abandonment of his application occurs when an applicant fails to pay the final fee within six months from the time at which a patent is allowed, and notice of such allowance is sent to him or to his agent.<sup>5</sup>

Where a patent is issued, notwithstanding a prior constructive abandonment of the application therefor; the question will arise whether the patent can be invalidated on that ground in an infringement suit, or only in a bill in equity to repeal the patent. In the only case in which the question has arisen, the Circuit Court decided that the defence could not be made in an infringement suit;<sup>6</sup> but on an appeal of the

<sup>1</sup> Revised Statutes, Section 4894; *Kirk v. Commissioner of Patents*, 37 Off. Gaz. 451, 1885.

<sup>2</sup> *M'Millin v. Barclay*, 5 Fisher, 199, 1871.

<sup>3</sup> 16 Statutes at Large, Ch. 230, Section 35, p. 202.

<sup>4</sup> *Planing Machine Co. v. Keith*, 101 U. S. 483, 1879.

<sup>5</sup> Revised Statutes, Section 4885.

<sup>6</sup> *Lamprey Protector Co. v. Economy Heater Co.*, 62 Fed. Rep. 592, 1894.



case, the Circuit Court of Appeals for the first circuit, expressly passed over the point without deciding it.<sup>1</sup>

§ 147. Constructive abandonment of an application will work constructive abandonment of the invention covered thereby, where the abandonment of the application arose from either of the causes stated in the first paragraph of the last preceding section, if no new application is filed soon enough to independently avoid the statute relevant to public use or sale more than two years before application for a patent.<sup>2</sup> The same thing is true, for the same reason, where the abandonment of the application arose from the cause stated in the second paragraph of the last preceding section. But the same reason does not exist relevant to the cause of constructive abandonment stated in the third paragraph of that section. If, therefore, an applicant fails to pay the final fee within six months after an allowance of a patent to him, and if he files a new application for a patent, on the same invention, within two years after that allowance, but more than two years after that invention was first in public use or on sale, the question arises whether the constructive abandonment of the first application will prevent the two applications from being regarded as one, on the principles stated in the second and third paragraphs of Section 145 in this chapter. No answer to that question is found in any adjudicated case; and as the point is unlikely to arise, and as its solution involves much argument, no answer is attempted in this book.

But in every case where a new application is made within two years after the invention was first in public use or on sale, a patent, if granted on that new application, will not be unfavorably affected by the fact that a former application was made, and was constructively abandoned.

<sup>1</sup> Economy Heater Co. v. Lamprey Protector Co. 65 Fed. Rep. 1000, 1895.

913, 1882; Western Electric Co. v. Sperry Electric Co. 58 Fed. Rep. 191, 1893.

<sup>2</sup> Lindsay v. Stein, 10 Fed. Rep.

§ 148. Patents are authorized by law, only on compliance with the statutory prerequisites to their issue. The Commissioner has therefore no jurisdiction to grant any patent, except where all those prerequisites have been substantially performed. If he inadvertently grants a patent in any other case, he exceeds his jurisdiction, and it is therefore open to every person who is sued as an infringer of that patent, to successfully defend against such an action, by pleading and proving the particular fault or omission with which the applicant was chargeable.<sup>1</sup> In all cases, however, where the application was complete enough to give the Commissioner jurisdiction, the patents will be unaffected by evidence that the Commissioner was improvident or injudicious in the exercise of his discretionary powers over these applications. If, for example, he omits to require that specimens of the ingredients shall be furnished, with a particular application for a patent for a composition of matter, it is not open to any infringer to show that the public interest would have been better subserved had such a requirement been made.<sup>2</sup> The same rule also governs the same point in cases where the Commissioner omits to require a model.<sup>3</sup> But it is probably open to any defendant to defeat a recovery for infringement, by pleading and proving that no drawing of the invention was filed in the Patent Office, and that the nature of the case admitted of drawings. This must be the law, unless the Commissioner is the sole and final judge of this last point of fact; and it is not probable that Congress intended to make him so, for no such intention is expressed in the statute,<sup>4</sup> and no such intention is consistent with public policy.

<sup>1</sup> *Grant v. Raymond*, 6 Peters, 218, 1832; *Parks v. Booth*, 102 U. S. 101, 1880; *Ransom v. New York*, 1 Fisher, 257, 1856.

<sup>2</sup> *Tarr v. Folsom*, 1 Bann. & Ard. 24, 1874.

<sup>3</sup> Revised Statutes, Section 4891.

<sup>4</sup> Revised Statutes, Section 4889.



## CHAPTER VII.

### LETTERS PATENT.

149. No exclusive right to inventions at common law.
150. Constitutional exclusive right to inventions in the United States.
151. Patent sare property.
152. Dignity of property in patents.
153. Patents are not odious monopolies.
154. Patent rights are absolute, not qualified.
155. Patent rights are beyond State interference.
156. Patent rights are not subject to common law executions, but may be subjected to creditors' bills in equity.
157. Patent rights are as exclusive of the government, as they are of any citizen.
158. Patents do not cover specimens purchased of the inventor, or made with his knowledge and consent, before application therefor.
159. The foregoing rule has no application to patents for processes.
160. Territorial scope of United States patents.
161. Operation of United States patents on the decks of ships.
162. Duration of patents.
163. Duration of United States patents for inventions first patented in a foreign country, according to the statute of 1870.
164. Duration of United States patents for inventions first patented in a foreign country, according to the statute of 1839.
165. Duration of United States patents for inventions first patented in a foreign country, according to the statute of 1861.
170. Beginning of the terms of United States patents.
171. To whom letters patent are granted by the government.
172. Letters patent as documents.
173. The specification.
174. The description.
175. The description.
176. The claim or claims.
177. The claim or claims.
178. Particularity in descriptions and claims, are conditions precedent to validity.
179. Questions of sufficiency of particularity of descriptions and claims, are questions of fact, and not of law.
180. Plurality of inventions in a single letters patent.
- 180a. Plurality of letters patent for different parts or combinations in a machine or apparatus.
181. Construction of letters patent.
182. Claims to be construed in the light of descriptions.
- 182a. Construction of claims which employ reference letters or numerals.
183. Construction of functional claims.

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| 184. Claims construed in the light of the state of the art.<br>185. Proper liberality of construction.<br>186. Proper strictness of construction.<br>187. Construction in the light of contemporaneous understanding of the inventor.<br>187 <i>a</i> . Patent Office limitations.<br>188. Construction in the light of | contemporaneous statutes.<br>189. Questions of construction are questions of law, and not of fact.<br>190. Letters patent presumed to be for same invention as the application therefor.<br>191. Letters patent are constructive notice of their contents to every person. |
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§ 149. No inventor has any special right to his invention at common law.<sup>1</sup> This is not a virtue in that law. It is an imperfection; an omission. That omission is due to the fact that the common law came into being in the middle ages, and in England. New and useful inventions were seldom produced in those ages, and most of those which were produced, were produced in Italy or on the continent of Europe. There was little or no occasion or opportunity in England, for the creation or recognition of any exclusive, or otherwise paramount, customary right in inventions. Even in those countries where new and useful things were more frequently invented, their inventors were oftener persecuted as heretics than rewarded as benefactors. Despotic kings were wont, in many countries, to confer monopolies upon their favorites, regardless of any meritorious right to the things monopolized; and it sometimes happened, in England and elsewhere, that, in pursuance of this practice, a monopoly of an invention was granted to its true inventor. Such a grant, however, was always a matter of kingly grace, and never a matter of legal right. In the reign of James the First, the English parliament limited this exercise of royal prerogative to cases of inventions, and thus laid the foundation of the patent laws of England. The limiting statute did not purport to confer upon inventors, any inchoate right which they might

<sup>1</sup> *Brown v. Duchesne*, 19 Howard, 195, 1856; *Dable Grain Shovel Co. v. Flint*, 137 U. S. 41, 1890.



perfect and make absolute by proceeding in any manner pointed out by law. It recognized the power of the king to secure to any inventor, an exclusive right to his invention, if his royal pleasure prompted him so to do. But the exercise of that power was so infrequent for more than a century, that Blackstone, in his Commentaries on the Laws of England, devoted but one sentence to the branch pertaining to patents for inventions.

§ 150. In the United States of America, the superior right of an inventor to his invention has a far better foundation than could be furnished by the prerogative of any king. That foundation is the consent of the people of the United States : a consent primarily expressed in the Federal Constitution, and elaborately defined in the federal statutes. The Constitution was established as the supreme law of the United States, on the twenty-first day of June, 1788. It conferred power upon Congress to promote the progress of the useful arts, by securing, for limited times, to inventors, the exclusive right to their respective inventions.<sup>1</sup> In exercise of that power, Congress, on the tenth day of April, 1790, enacted the first federal statute on the subject ; and provided therein that the exclusive right in contemplation, should be secured to the respective inventors, by means of a written grant from the United States, to be named letters patent.<sup>2</sup> It is the office of this chapter to explain the nature, the extent, and the duration of the right secured by such a document ; to outline the general form and necessary characteristics of such a document itself ; and to set forth the rules by which such documents are properly construed.

§ 151. Patents are property ;<sup>3</sup> and the owner of a patent is both legally and equitably entitled to the same protection

<sup>1</sup> Article 1, Section 8.

<sup>2</sup> 1 Statutes at Large, Ch. 7, p. 109.

<sup>3</sup> *Brown v. Duchesne*, 19 Howard, 195, 1856; *Seymour v. Osborne*, 11 Wallace, 533, 1870; *Consolidated*

*Fruit Jar Co. v. Wright*, 94 U. S. 96, 1876; *Cammeyer v. Newton*, 94 U. S. 226, 1876; *James v. Campbell*, 104 U. S. 357, 1881; *Marsh v. Nichols*, 128 U. S. 612, 1888.

for that property, that the owner of any other species of property may enjoy,<sup>1</sup> and he cannot be constitutionally deprived of that property without due process of law.<sup>2</sup> Due process of law includes the constitutional judgments and decrees of courts; but it does not include any act of Congress, or of any other legislature.<sup>3</sup> Patent rights, once vested, are therefore incapable of being divested by act of Congress.<sup>4</sup> Nor can Congress do indirectly, that which it is forbidden to do with directness. It cannot destroy nor seriously impair the value of a patent right, under the guise of altering or repealing the existing remedies applicable to its enforcement, any more than it can so treat any other kind of property.<sup>5</sup>

§ 152. The right of property which an inventor has in his invention, is excelled, in point of dignity, by no other property right whatever. It is equalled, in point of dignity, only by the rights which authors have in their copyrighted books. The inventor is not the pampered favorite or beneficiary of the government, or of the nation. The benefits which he confers, are greater than those which he receives. He does not cringe at the feet of power, nor secure from authority an unbought privilege. He walks everywhere erect, and scatters abroad the knowledge which he created. He confers upon mankind a new means of lessening toil, or of increasing comfort; and what he gives cannot be destroyed by use, nor lost by misfortune. It is henceforth an indestructible heritage of posterity. On the other hand, he receives from the government, nothing which cost the government or the people a dollar or a sacrifice. He receives nothing but a contract, which provides that for a limited time he may exclusively enjoy his own. Compared with

<sup>1</sup> Thomson v. Citizens National Bank, 53 Fed. Rep. 252, 1892.

<sup>2</sup> Fifth Amendment to the Constitution.

<sup>3</sup> Barron v. Baltimore, 7 Peters, 247, 1833; Kent's Commentaries, Lecture 24, p. 13; Taylor v. Porter,

4 Hill (N. Y.), 147, 1843.

<sup>4</sup> McClurg v. Kingsland, 1 Howard, 202, 1843.

<sup>5</sup> Green v. Biddle, 8 Wheaton, 75, 1823; Bronson v. Kinzie, 1 Howard, 317, 1843.



those who acquire property by devise or inheritance; compared with those who acquire property by gift or marriage; compared with those who acquire property by profits on sales, or by interest on money; the man who acquires property in inventions, by creating things unknown before, occupies a position of superior dignity. Even the man who creates value by manual labor, though he rises in dignity above the heir, the donee, the merchant, and the money-lender, falls in dignity below the author and the inventor. The inventor of the reaper is entitled to greater honor than his father who used the grain cradle; and the inventor of the grain cradle is entitled to greater honor than his ancestors, who, for a hundred generations, had used the sickle. Side by side stand the inventor and the author. Their labor is the most dignified and the most honorable of all labor; and the resulting property is most perfectly theirs.

SIR FRANCIS BACON gave the weight of his opinion, to views somewhat similar to the foregoing. The following is a translation of one of his Latin paragraphs.

“The introduction of great inventions appears one of the most distinguished of human actions, and the ancients so considered it; for they assigned divine honors to the authors of inventions, but only heroic honors to those who displayed civil merit; such as the founders of cities and empires, legislators, the deliverers of their country from lasting misfortunes, the quellers of tyrants and the like. And if any one rightly compare them, he will find the judgment of antiquity to be correct; for the benefits derived from inventions may extend to mankind in general, but civil benefits to particular lands alone; the latter, moreover, last but for a time, the former forever. Civil reformation seldom is carried on without violence and confusion, while inventions are a blessing and a benefit without injuring or afflicting any.”<sup>1</sup>

<sup>1</sup> *Novum Organum*, Book 1, Section CXXIX.

§ 153. "Letters patent are not to be regarded as monopolies, created by the executive authority at the expense and to the prejudice of all the community except the persons therein named as patentees, but as public franchises granted to inventors of new and useful improvements, for the purpose of securing to them, as such inventors, for the limited term therein mentioned, the exclusive right and liberty to make and use, and vend to others to be used, their own inventions, as tending to promote the progress of science and the useful arts, and as matter of compensation to the inventors for their labor, toil and expense in making the inventions, and reducing the same to practice for the public benefit, as contemplated by the Constitution and sanctioned by the laws of Congress." Such is the accepted doctrine as formulated by Justice CLIFFORD when speaking for the Supreme Court.<sup>1</sup> The same ideas were more concisely expressed in an earlier case by Justice DANIEL.<sup>2</sup> Speaking of the inventor's exclusive right, he said: "This was at once the equivalent given by the public for benefits bestowed by the genius and meditations and skill of individuals, and the incentive to further efforts for the same important objects." Writing an opinion of the Supreme Court, and referring to the doctrine of patents, Justice MILLER said: "It is no longer a scarcely recognized principle, struggling for a foothold, but it is an organized system, with well-settled rules, supporting itself at once by its utility, and by the wealth which it creates and commands."<sup>3</sup> These opinions of the Supreme Court agree, therefore, in holding, with all fair and thoughtful men, that patent rights are not hurtful monopolies, but are rights of property at once dignified, honorable, and strong.

§ 154. A patent right is an absolute, and not a qualified, right. During the term of his patent, a patentee may, if he pleases, decline to allow any other person to make, use, or

<sup>1</sup> Seymour v. Osborne, 11 Wallace, 322, 1858.  
533, 1870.

<sup>2</sup> Merrill v. Yeomans, 94 U. S.

<sup>3</sup> Kendall v. Winsor, 21 Howard, 573, 1876.



sell the invention which it covers, and at the same time may refrain from making, using and selling his invention himself.<sup>1</sup> From July 1832, until July 1870, there was an exception to this rule. Under the statute of 1790, aliens, as well as citizens, might receive United States patents;<sup>2</sup> but the statute of 1793 confined that privilege to citizens of the United States.<sup>3</sup> The statute of 1800 extended the right to aliens who had resided two years within the United States, and provided that patent rights should be obtained, used, and enjoyed by such persons, in as full and ample a manner, and under the same conditions, limitations, and restrictions, as in the case of citizens.<sup>4</sup> That continued to be the state of the law on the point till July 13, 1832; when Congress provided that still another class of aliens might have patents; namely, aliens who were residents of the United States, and had declared their intention, according to law, to become citizens thereof. It was, however, expressly provided, that any patent, granted to an alien of this class, should determine and become absolutely void, without resort to any legal process to annul or cancel the same, in case of failure on the part of the patentee, for the space of one year from the issuing thereof, to introduce into public use in the United States the invention covered by the patent; or in case such public use be discontinued for any period of six months; or in case of failure of the patentee to become a citizen of the United States as soon as the law allowed.<sup>5</sup> Four years later, however, this statute was repealed by that of 1836. The latter statute extended

<sup>1</sup> *Pitts v. Wemple*, 1 Bissell, 93, 1855; *American Bell Telephone Co. v. Service Co.* 45 Off. Gaz. 1193, 1888; *Consolidated Roller Mill Co. v. Coombs*, 39 Fed. Rep. 805, 1889; *Campbell Printing Press Co. v. Manhattan Ry. Co.* 49 Fed. Rep. 935, 1892; *Edison Electric Light Co. v. Sawyer-Man Electric Co.* 53 Fed. Rep. 598, 1892; *Edison Electric Light Co. v. Mt. Morris Electric*

*Light Co.* 57 Fed. Rep. 644, 1893; *Masseth v. Reiber*, 59 Fed. Rep. 614, 1894.

<sup>2</sup> 1 Statutes at Large, Ch. 7, Section 1, p. 109.

<sup>3</sup> 1 Statutes at Large, Ch. 11, Section, 1, p. 318.

<sup>4</sup> 2 Statutes at Large, Ch. 25, Section 1, p. 37.

<sup>5</sup> 4 Statutes at Large, Ch. 203, Section 1, p. 577.

the right to obtain United States patents to all inventors ; but it provided that an effectual defence to an action for infringement might be based on the fact that the patentee, if an alien at the time the patent was granted, had failed and neglected, for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reasonable terms, the invention for which the patent issued.<sup>1</sup> But no such qualification of any patent right is contained in the consolidated Patent Act of 1870,<sup>2</sup> nor in the Revised Statutes ;<sup>3</sup> so that the rule stated at the head of this section applies to all existing patents.

§ 155. No State has any power to make a law interfering with the sale of any patent right,<sup>4</sup> but every State has power to regulate the making, the selling and the using of the things covered by any patent to the same extent that it lawfully regulates the making, selling, and using of similar unpatented things. Things covered by patents are as much subject to the law of common carriers,<sup>5</sup> the revenue laws,<sup>6</sup> and other public laws<sup>7</sup> of a State or municipality, as any other things. A patent for a dynamite powder, or for a deadly poison, or for an explosive oil, does not oust nor affect the power of local authorities to prescribe the place and manner of the manufacture, storage and sale of those dangerous substances. Nor does a patent on a sewing-machine exempt the patentee from any State tax on the machines he may make, use or sell within the boundaries of that State. The reason why a State may regulate the sale of a patented thing, and may not regulate the sale of the patent covering that thing, is explainable as follows. A patentee has two kinds of rights in his invention. He has a right to make, use, and sell specimens of the invented thing ; and he has a right to

<sup>1</sup> 5 Statutes at Large, Ch. 357, Sections 6 and 15, pp. 119 and 123.

<sup>2</sup> 16 Statutes at Large, Ch. 230, Section 61, p. 208.

<sup>3</sup> Revised Statutes, Section 4920.

<sup>4</sup> *Ex parte* Robinson, 2 Bissell 313, 1870; *Castle v. Hutchinson*, 25

Fed. Rep. 394, 1885.

<sup>5</sup> *Delaware Telephone Co. v. Delaware*, 50. Fed. Rep. 677, 1892.

<sup>6</sup> *Weber v. Virginia*, 103 U. S. 347, 1880.

<sup>7</sup> *Patterson v. Kentucky*, 97 U. S. 505, 1878.



prevent all other persons from doing either of those acts. The first of these rights is wholly independent of the patent laws; while the second exists by virtue of those laws alone.<sup>1</sup> A patentee therefore holds the first of these rights subject to the police powers, and the taxing powers, of the State; while the second being the creature of the laws of Congress, is wholly beyond State control or interference.<sup>2</sup>

§ 156. Patent rights, being, as they are, intangible property, cannot be seized and sold under the authority of any writ of *fiery facias*, or other common-law execution.<sup>3</sup> They may, however, be reached by a creditor's bill in equity, and thus be applied to the payment of the debts of the owners; the same as trust property, choses in action, or stock of a debtor in a corporation, may be reached and applied. A court of equity may, in pursuance of its powers in such cases, decree that the debtor patentee pay the judgment upon which the bill is based, or, in default thereof, that his patent right be sold under the direction of the court, and an assignment thereof be executed by him, and, in default of his executing such an assignment, that some suitable person be appointed trustee to execute the same in his place,<sup>4</sup> or that the master in chancery of the court, shall perform that function.<sup>5</sup>

§ 157. Patent rights are exclusive, not only of citizens and residents of the United States, but also of the government itself, and of its agents. The government has no more right than any private citizen; to make, use, or sell a patented invention, without the license of the patentee.<sup>6</sup> When

<sup>1</sup> *Bloomer v. McQuewan*, 14 Howard, 539, 1852; *In re Brosnahan*, 18 Fed. Rep. 62, 1883; *United States v. Bell Telephone Co.* 29 Fed. Rep. 43, 1886.

<sup>2</sup> *May v. County of Buchanan*, 29 Fed. Rep. 473, 1886.

<sup>3</sup> *Stephens v. Cady*, 14 Howard, 528, 1852; *Stevens v. Gladding*, 17 Howard, 447, 1854.

<sup>4</sup> *Ager v. Murray*, 105 U. S. 126, 1881.

<sup>5</sup> *Wilson v. Fire Alarm Co.* 52 Off. Gaz. 901, 1890.

<sup>6</sup> *United States v. Burns*, 12 Wallace, 252, 1870; *Cammeyer v. Newton*, 94 U. S. 234, 1876; *Solomons v. United States*, 137 U. S. 346, 1890.

the government grants letters patent for an invention, it confers upon the patentee an exclusive property therein, which cannot be appropriated or used by the government itself, without just compensation, any more than land which has been patented to a private purchaser can, without compensation, be appropriated or used by the government.<sup>1</sup>

§ 158. No patent right covers any use or sale of any specimen of the patented thing which was purchased of the inventor, or made by another with his knowledge and consent, before his application for a patent therefor.<sup>2</sup> Where another than the inventor, surreptitiously obtains knowledge of an invention, and, without the consent of the inventor, makes a specimen of the invented thing before any patent thereon is applied for, that specimen is covered by a patent for that invention, as truly and as fully as it would be if it had been made by an infringer after the date of that patent. Such a case is clearly outside of the rule just stated, and of the statute upon which that rule is based. Indeed Justice STORY,<sup>3</sup> and afterward the full Supreme Court,<sup>4</sup> held such a case to be outside the corresponding provision of the Patent Act of 1839,<sup>5</sup> though that provision did not literally exclude such a case.

Where another than the first inventor, re-invents and constructs a specimen of an invention, before any patent is applied for thereon, and does so without any knowledge of the inventor, or of his doings, and without the knowledge or consent of the inventor himself, he cannot invoke the rule stated at the beginning of this section; because knowledge and consent of the inventor is an express element in the statute which supports that rule. If, however, such a re-invention and such a construction occurred before July 8,

<sup>1</sup> James v. Campbell, 104 U. S. 356, 1881; United States v. Palmer, 128 U. S. 271, 1888.

<sup>2</sup> Revised Statutes, Section 4899; Wade v. Metcalf, 129 U. S. 202, 1889; Dable Grain Shovel Co. v. Flint, 137 U. S. 41, 1890.

<sup>3</sup> Pierson v. Screw Co. 3 Story. 402, 1844.

<sup>4</sup> Kendall v. Winsor, 21 Howard, 326, 1858.

<sup>5</sup> 5 Statutes at Large, Ch. 88, Section 7, p. 354.



1870, the thing so constructed is outside of any patent afterward applied for, because the Patent Act of 1839 can be invoked in its behalf, and because the corresponding provision of that act was not limited to cases where the inventor had knowledge and gave consent. Where such a re-invention and construction occurred after July 8, 1870, it is probable that the specific thing, so constructed, is taken out of the operation of a patent afterward applied for, by the direct action of the fifth amendment to the Constitution of the United States. That amendment provides that no person shall be deprived of property without due process of law. Things independently re-invented and innocently made, before the first inventor applied for a patent thereon, are the lawful property of him who thus made them. To deprive him of the right to use and to sell those things, would be to lessen or to destroy their value, and thus to deprive him of property rights. If such an act is ever done at the suit of the first inventor, after he gets his patent, it will be done by virtue of that patent. Now, a patent is the creature of a statute. No statute is "due process of law,"<sup>1</sup> and no patent can be "due process of law" unless a creature can be greater than its creator: unless a statute can authorize a contract to accomplish, upon the rights of third parties, a result which the statute itself is forbidden to accomplish. If this reasoning and this conclusion, are correct, it will not follow therefrom, that such a re-inventor may construct any specimen of the invention after the first inventor has obtained a patent thereon. To deprive a re-inventor of such a privilege, is not to deprive him of property, for no re-inventor has any property right in an invention which he was the second in the United States to make, any more than he would have if he had learned of that invention from a newspaper or from a book.

§ 159. The rule stated at the head of the last section does not apply to any process patent. The provision of 1870,<sup>2</sup>

<sup>1</sup> *Barron v. Baltimore*, 7 Peters, 247, 1833; *Taylor v. Porter*, 4 Hill (N. Y.) 147, 1843.

<sup>2</sup> 16 Statutes at Large, Ch. 230, Section 37, p. 203.

and Section 4899 of the Revised Statutes, treat only of machines or other patentable articles, and confer exemption from the operation of patents upon nothing but specific things. Now, a process is neither an article nor a thing. It is a series of acts. It is therefore outside the language of the law on this subject. It is also outside the reason of that law. That reason is as follows. Where another than the first inventor of a particular tangible thing, buys from the inventor a specimen of that thing, or makes such a specimen with his consent, or re-invents and makes such a specimen independently of the first inventor, that specimen ought to be exempt from any patent afterward applied for by the first inventor; because, if it is not so exempt, it will become worthless in the hands of one who honestly expended of his substance to procure it, and who procured it without violating any patent or any law. Processes are not subjects of these considerations. A process cannot be purchased. The right to practice a patented process can indeed be purchased; but the right to practice an unpatented process, while it remains unpatented, cannot be the subject of a sale, because that right belongs to every one without any purchase. So also, if an inventor of a process consents that another person may practice that process, before the inventor applies for a patent, that fact furnishes no reason why that person should be allowed to practice that process, against the will of that inventor, after the date of his patent. To deprive such a person of such a privilege, is not to deprive him of the use of a thing. It is only to deprive him of the privilege of repeating a series of acts. These considerations apply also to cases where a re-inventor produces and practices a process, after its production by the first inventor, and before any application is made for a patent thereon, and without any knowledge of the first inventor or his doings. Such a re-inventor has no more natural right to practice that process, after a patent is granted to the first inventor, than any other person has. He has no such right growing out of the fact that he was a re-inventor, because the patent laws do not reward



re-inventors, and because patents to first inventors are exclusive of re-inventors, as well as of other persons. He has no such right growing out of rights of property, because to deprive him of the privilege of repeating the process is not to deprive him of the use of any tangible property, and because he has no tangible property in the process itself.

The language of the Patent Act of 1839<sup>1</sup> was, however different from that of the Act of 1870, and of the Revised Statutes, on the point treated in this section. The earlier Act contained a considerable clause which is not in either of the others, and which induced the Supreme Court to decide that the earlier statute applied to patents for processes, as well as to patents for things.<sup>2</sup> The reasoning of Justice BALDWIN, in the case, was never convincing to the present textwriter. It was spoken of by Justice STORY as "certainly general;"<sup>3</sup> and Judge WHEELER has well said that "It is not probable that *McClurg v. Kingsland* would be followed beyond cases of its class, upon the same statute."<sup>4</sup> As far as *McClurg v. Kingsland* construed the Act of 1839, and applied that Act to the very case then at bar, it is entitled to loyal respect and obedience, even from those who cannot follow its reasoning. But *McClurg v. Kingsland* is no guide to the meaning of the present statute on the subject, because that statute is substantially different from the one construed in that case, and because the reasoning of that case has no convincing force when applied to the language of the now existing statute.

§ 160. Every United States patent is in general co-extensive, in point of the territory it covers, with the territory covered by the jurisdiction of the United States.<sup>5</sup> Every such patent, therefore, covers the use of the patented thing in or under the tide-waters of the United States; and that,

<sup>1</sup> 5 Statutes at Large, Ch. 88, 408, 1844.  
Section 7, p. 354.

<sup>2</sup> *McClurg v. Kingsland*, 1 Howard, 202, 1843.

<sup>3</sup> *Pierson v. Screw Co.* 3 Story,

<sup>4</sup> *Brickill v. New York*, 5 Bann. & Ard 547, 1880.

<sup>5</sup> Revised Statutes, Section 4884.

too, even in cases where the government has granted, to others than the patentee, the exclusive right to do, at a particular place, the particular thing which the patented invention is adapted to accomplish.<sup>1</sup> In the case just cited the complainant had a patent on a certain submarine telegraph cable; and the defendant had a grant from Congress, giving it the sole right, for fourteen years, to lay, construct, land, maintain, and operate telegraphic cables in and over the waters, reefs, islands, shores, and lands over which the United States have jurisdiction, from the shores of Florida to the Island of Cuba. Under these circumstances, Justice BLATCHFORD decided that the defendant acquired, by its grant, no right to use the patented cables of the complainant; and he intimated that the complainant acquired by its patent, no right to use his cables between Florida and Cuba. His honor supported this intimation by saying that no patent confers upon its owner any right to make or use his invention in the house of another; and he supported his decision by saying that the fact just mentioned does not confer upon another than the patentee any right to make or use the invention of the latter in the house of the former.

§ 161. No United States patent right extends to the mere use of the patented invention on any foreign ship while temporarily in a harbor of the United States for the purposes of commerce; though such a right would be infringed by making or selling the patented article on board any foreign vessel while in either of our ports.<sup>2</sup> United States patent rights extend to the decks of United States ships, even when those ships are on the high seas, as fully as they extend to the solid earth of the United States.<sup>3</sup>

§ 162. The regular duration of a United States patent for a process, machine, manufacture, or composition of matter, was fourteen years under the statutes prior to that of 1861; but it was enacted, in Section 16 of the Patent Act of March

<sup>1</sup> *Colgate v. Ocean Telegraph Co.* 196, 1856.

17 *Blatch.* 310, 1879.

<sup>3</sup> *Gardner v. Howe*, 2 *Cliff.* 464,

<sup>2</sup> *Brown v. Duchesne*, 19 *Howard*, 1865.



2 of that year, that all patents thereafter granted should remain in force for seventeen years from the date of issue.<sup>1</sup> Section 22 of the consolidated Patent Act of 1870 provided that every patent should grant to the patentee, his heirs or assigns, for the term of seventeen years, the exclusive right to make, use, and vend the invention covered thereby.<sup>2</sup> Section 4884 of the Revised Statutes makes the same provision as that made on this point by the Act of 1870. The phrase "every patent" is not to be understood in its literal signification. It means every patent, the duration of which is not otherwise prescribed by statute. In the latter category, design patents fall. Such patents are grantable for fourteen years, or for seven years, or for three years and six months, as the applicant may in his application elect.<sup>3</sup> In the same category, also, fall patents for inventions for which their owners previously obtained one or more foreign patents. United States patents of this class cannot be granted for more than seventeen years, and they generally have to be limited to some shorter length of time.

§ 163. "Every patent granted for an invention which has previously been patented in a foreign country, shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years."<sup>4</sup> Such is the present statute on this subject, and the corresponding provision of the Patent Act of 1870 was substantially the same.<sup>5</sup>

These enactments apply only to cases wherein the foreign patent was taken out by the United States patentee, or at least with his knowledge and consent. No foreign patent obtained by another, without that knowledge and that consent, after the inventor made his invention, and before

<sup>1</sup> 12 Statutes at Large, Ch. 88, Section 16, p. 249.

<sup>2</sup> 16 Statutes at Large, Ch. 230, Section 22, p. 201.

<sup>3</sup> Revised Statutes, Section 4931.

<sup>4</sup> Revised Statutes, Section 4887.

<sup>5</sup> 16 Statutes at Large, Ch. 230, Section 25, p. 201.

the United States patent was granted, can operate to limit the duration of the latter.<sup>1</sup>

These enactments apply to a case where a foreign patent was granted before the granting of the corresponding United States patent, even if the foreign patent was made a secret one at the request of the applicant therefor;<sup>2</sup> but they do not apply to a case where a foreign patent was dated before the granting of the corresponding United States patent, but not sealed nor published till afterward;<sup>3</sup> though they do apply to a case where the United States patent was granted after the foreign patent was sealed, upon an application filed before that event.<sup>4</sup>

Whether these enactments apply where the invention claimed in the United States patent was not claimed but only described in the prior foreign patent, was a question which was once decided in the affirmative,<sup>5</sup> and once in the negative,<sup>6</sup> but is now settled in the affirmative.<sup>7</sup>

In a case to which these enactments apply, the United States patent will not expire with the first term of the foreign patent, if the foreign patent is extended before the expiration of its first term, in pursuance of a statute which was in force when the United States patent was applied for and when it was issued, and which conferred an absolute right to such an extension, and if the extension or extensions of the foreign patent cover a continuous space of

<sup>1</sup> *Kendrick v. Emmons*, 2 Bann. & Ard. 210, 1875.

<sup>2</sup> *Gramme Electrical Co. v. Electric Co.* 17 Fed. Rep. 838, 1883.

<sup>3</sup> *Gold & Stock Telegraph Co. v. Telegram Co.* 23 Fed. Rep. 340, 1885; *Emmerson v. Lippert*, 31 Fed. Rep. 911, 1887; *Seibert Oil Co. v. Powell Co.* 35 Fed. Rep. 591, 1888; *Holmes Alarm Tel. Co. v. Telephone Co.* 42 Fed. Rep. 228, 1890; *American Bell Telephone Co. v. Cushman*, 57 Fed. Rep. 843, 1893; *Edison Electric Light Co. v. War- ing Electric Co.* 59 Fed. Rep. 364,

1894.

<sup>4</sup> *Bate Refrigerating Co. v. Sulzberger*, 157 U. S. 1, 1895; *Bate Refrigerating Co. v. Gillett*, 13 Fed. Rep. 553, 1882; *Gramme Electrical Co. v. Electric Co.* 17 Fed. Rep. 838, 1883; *Edison Electric Light Co. v. United States Electric Lighting Co.* 35 Fed. Rep. 135, 1888.

<sup>5</sup> *Commercial Mfg. Co. v. Canning Co.* 27 Fed. Rep. 87, 1886.

<sup>6</sup> *Holmes Protective Co. v. Alarm Co.* 22 Fed. Rep. 341, 1884.

<sup>7</sup> *Commercial Mfg. Co. v. Fairbank Co.* 135 U. S. 194, 1890.



time.<sup>1</sup> And it has been decided in several Circuit Courts, that the United States patent will not expire with the first term of the foreign patent, if the foreign patent might have been extended before the expiration of its first term, in pursuance of a statute which was in force when the United States patent was applied for and when it was issued, and which conferred an absolute right to such an extension, whether the foreign patent was actually extended or not.<sup>2</sup> But it has also been decided on the Circuit, that where the patentee has no absolute right to an extension of the first term of his foreign patent, no such extension has any effect upon the duration of his United States patent.<sup>3</sup>

The termination of a foreign patent, prior to its appointed end, because of an omission of the patentee to do what the foreign laws require in order to keep it in force, has no effect upon the duration of a corresponding United States patent.<sup>4</sup> Nor will any such effect result from the expiration of a prior foreign patent, on account of the expiration of a patent of another foreign country on the same invention.<sup>5</sup> But where the corresponding foreign patent terminated before the United States patent for the same invention was issued, the latter is void *ab initio*;<sup>6</sup> though a repeal *ab initio* of a foreign patent which would otherwise limit the duration of a corresponding United States patent, restores the latter to its full term of seventeen years.<sup>7</sup>

It is not necessary, to the validity of a United States patent granted for an invention which has previously been patented in a foreign country, that it shall be so limited on its face, as to appear to expire at the same time with the

<sup>1</sup> Bate Refrigerating Co. v. Hammond, 129 U. S. 151, 1889.

<sup>2</sup> Consolidated Roller Mill Co. v. Walker, 43 Fed. Rep. 581, 1890; Pohl v. Heyman, 58 Fed. Rep. 568, 1893.

<sup>3</sup> Henry v. Tool Co. 3 Bann. & Ard. 501, 1878.

<sup>4</sup> Pohl v. Anchor Brewing Co. 134 U. S. 381, 1890; Holmes Pro-

tective Co. v. Alarm Co. 21 Fed. Rep. 458, 1884; Paillard v. Bruno, 29 Fed. Rep. 864, 1886.

<sup>5</sup> Edison Electric Light Co. v. Perkins Electric Lamp Co. 42 Fed. Rep. 327, 1890.

<sup>6</sup> Huber v. Nelson Mfg. Co. 148 U. S. 275, 1893.

<sup>7</sup> Bate Refrigerating Co. v. Gillett, 20 Fed. Rep. 192, 1884.

foreign patent which limits its life.<sup>1</sup> The statute is satisfied when the courts decline to enforce it after the expiration of that foreign patent, whether or not it appears on its face to be so limited.<sup>2</sup>

And the duration of a patent should never be limited because of the expiration of a foreign patent, if there is any doubt about the invention covered by the two patents, being substantially the same.<sup>3</sup> But differences of description do not necessarily involve substantial differences of invention;<sup>4</sup> and the true test of identity consists in ascertaining and deciding whether the practice of what is described in the foreign patent, would constitute an infringement of the United States patent.<sup>5</sup>

The law set forth in this section applies to no patent which was originally granted prior to July 8, 1870; and applies to no reissue of any patent which was originally granted before that date, even though the reissue itself was granted after that date.<sup>6</sup> The duration of such patents, where they were granted for inventions which had previously been granted in some foreign country, was governed by certain earlier statutes which it is now in order to explain.

§ 164. Section 8 of the Patent Act of 1836 provided that nothing therein contained should be construed to deprive any original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters patent therefor in a foreign country, and the same having been published, at any time within six months next

<sup>1</sup> Telephone Cases, 126 U. S. 572, 1888; Bate Refrigerating Co. v. Hammond, 129 U. S. 151, 1889.

<sup>2</sup> New American File Co. v. Nicholson File Co. 8 Fed. Rep. 816, 1881; Canan v. Mfg. Co. 23 Fed. Rep. 185, 1885.

<sup>3</sup> Brush Electric Co. v. Julien Electric Co. 41 Fed. Rep. 696, 1890; Brush Electric Co. v. Accumulator

Co. 47 Fed. Rep. 52, 1891.

<sup>4</sup> Commercial Mfg. Co. v. Fairbank Co. 135 U. S. 192, 1890.

<sup>5</sup> Commercial Mfg. Co. v. Fairbank Co. 135 U. S. 194, 1890; Accumulator Co. v. Julien Electric Co. 57 Fed. Rep. 609, 1893.

<sup>6</sup> Badische Anilin and Soda Fabrik v. Hamilton Mfg. Co. 3 Bann. & Ard. 235, 1878.



preceding the filing of his specification and drawings.<sup>1</sup> Section 6 of the Patent Act of 1839 provided that no person should be debarred from receiving a patent for any invention, as provided in the Act of 1836, by reason of the same having been patented in a foreign country more than six months prior to his application, provided, among other things, that every such patent should be limited to the term of fourteen years from the date or publication of such foreign letters patent.<sup>2</sup> The effect of these enactments was to allow an inventor to take out a patent in the United States, for an invention which he had previously patented in a foreign country, no matter how long previously that foreign patent was granted;<sup>3</sup> but the duration of the United States patent was limited to the term of fourteen years from the date or publication of the foreign patent, unless the United States patent was applied for within six months after the foreign patent was taken out, and within six months after the foreign patent was published. This law applied only to cases where the foreign patent was published,<sup>4</sup> or, if it was a British patent, was sealed,<sup>5</sup> before the United States patent was applied for. It did not therefore, affect any United States patent for an invention which was patented in a foreign country while the application for the United States patent was pending in the Patent Office. It was not necessary under the law stated in this section, any more than it is necessary under the law stated in the last, that a patent should be limited on its face, so as to appear to expire when it really ceased to be in force. Whether so limited or not, the courts would limit it to its legal life, when called upon to enforce it after the end of that life; but its validity for the term of fourteen years from the date of the foreign patent, was unaffected by the

<sup>1</sup> 5 Statutes at Large, Ch. 357, Section 8, p. 121.

<sup>2</sup> 5 Statutes at Large, Ch. 88, Section 6, p. 354.

<sup>3</sup> *De Florez v. Reynolds*, 17 Blatch, 444, 1880.

<sup>4</sup> *French v. Rogers*, 1 Fisher, 136, 1051.

<sup>5</sup> *Gold & Stock Telegraph Co. v. Telegram Co.* 23 Fed. Rep. 343, 1885.

fact that on its face the United States patent purported to run for fourteen years from its own date.<sup>1</sup>

§ 165. Section 16 of the Patent Act of March 2, 1861, provided that all patents thereafter granted should remain in force for the term of seventeen years from the date of issue; and the Supreme Court has decided that this enactment modified the statute of 1839 precisely as it would have done had it expressly substituted the word "seventeen" for the word "fourteen" in the earlier statute; thus making it read: "every such patent shall be limited to the term of seventeen years from the date or publication of such foreign letters patent."<sup>2</sup> The law which was established on the subject by the Patent Act of 1836, as modified by the Patent Act of 1839, was still further modified to that extent by the Patent Act of March 2, 1861; and as thus modified it is the law which governs the point, in respect of patents granted between the latter date and July 8, 1870.

§ 170. The terms of all United States patents begin at their respective dates.<sup>3</sup> Those dates are selected by the Commissioner of Patents, but they cannot be later than six months after the time at which the respective applications are allowed;<sup>4</sup> and cannot be earlier than the time of such allowance: that is to say, patents cannot now be antedated.<sup>5</sup>

Section 8 of the Patent Act of 1836 provided that whenever the applicant should request it, the patent should take date from the time of the filing of the specification and drawings, not however exceeding six months prior to the actual issuing of the patent.<sup>6</sup> This continued to be the law for nearly a quarter of a century; and patents so antedated conferred rights of action upon the patentees, for infringe-

<sup>1</sup> *O'Reilly v. Morse*, 15 Howard, 62, 1853.

<sup>2</sup> *Siemens' Adm'r v. Sellers*, 123 U. S. 276, 1887.

<sup>3</sup> *Rein v. Clayton*, 37 Fed. Rep. 355, 1889.

<sup>4</sup> Revised Statutes, Section 4885.

<sup>5</sup> *De Florez v. Reynolds*, 17 Blatch. 444, 1880.

<sup>6</sup> 5 Statutes at Large, Ch. 357, Section 8, p. 121.



ments occurring after their respective dates, and before the respective days of their actual issue.<sup>1</sup> Section 16 of the Patent Act of March 2, 1861, provided a change in this law: provided that thereafter the terms of patents should begin with the dates of their respective issue, and such has ever since been the law on the subject.<sup>2</sup> In actual practice, patents are now dated and issued on the third or the fourth Tuesday after the applicant pays the final Patent Office fee. And all the patents which are issued in one day are contemporaneous, regardless of the order of the numbers which they respectively receive.<sup>3</sup>

§ 171. The grantee of the government in cases of letters patent for inventions may be the inventor himself; <sup>4</sup> or his assignee; <sup>5</sup> or an assignee of an assignee; <sup>6</sup> or an assignee who has assigned the invention; <sup>7</sup> or a guardian of an insane inventor; <sup>8</sup> or if an inventor dies before any patent is granted for his invention, the right to obtain the patent devolves on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will disposing of the invention, then in trust for his devisees.<sup>9</sup> In this last case the patent may be granted to the executor by his proper personal name, without any declaration that he takes in his representative capacity; <sup>10</sup> and the same thing is equally true in cases where the patent is granted to an administrator.

<sup>1</sup> *Burdett v. Estey*, 3 Fed. Rep. 566, 1880.

<sup>2</sup> 12 Statutes at Large, Ch. 88, Section 16, p. 249.

<sup>3</sup> *Electrical Accumulator Co. v. Brush Electric Co.* 52 Fed. Rep. 137, 1892.

<sup>4</sup> Revised Statutes, Section 4886.

<sup>5</sup> Revised Statutes, Section 4895.

<sup>6</sup> *Selden v. Gas Burner Co.* 19 Blatch. 544, 1881.

<sup>7</sup> *Consolidated Electric Light Co.*

*v. Edison Electric Light Co.* 25 Fed. Rep. 719, 1885; *Consolidated Electric Light Co. v. McKeesport Light Co.* 84 Fed. Rep. 335, 1888.

<sup>8</sup> *Whitcomb v. Coal Co.* 47 Fed. Rep. 658, 1891.

<sup>9</sup> Revised Statutes, Section 4896.

<sup>10</sup> *Stimpson v. Rogers*, 4 Blatch. 336, 1859; *Northwestern Fire Extinguisher Co. v. Philadelphia Extinguisher Co.* 1 Bann. & Ard. 177, 1874.

Where an inventor applies for a patent to be issued to himself, and then dies before any patent is granted; the patent may be granted in his name as patentee, and will be valid notwithstanding his prior death; and the title thereto will vest in his executor or administrator, if there is any, whoever he may be; and if there is no executor or administrator, the title will ultimately vest in the heirs or legatees of the inventor, whoever they may be.<sup>1</sup>

Where an inventor assigns his invention before making an application for a patent, and then makes such an application, coupled with a request that the patent be granted to the assignee, and accompanied with an entry of the assignment on the records of the Patent Office, and then dies before any patent is granted; there appears to be no reason why the patent should not be granted to the assignee, though the statute literally provides that in all cases where the inventor dies before the patent is granted, the right to the patent devolves on his executor or administrator in trust for his heirs or devisees.<sup>2</sup> But this statute must receive a reasonable construction, and it is not reasonable to hold that the death of an inventor, who has sold and assigned his inchoate right to a patent, should operate to divest his assignee of that right, and devolve it upon another person, in trust for still another party. Nor is there any propriety, in such a case, in granting the patent to the executor or administrator, on the theory that he will take as trustee for the assignee. The assignee requires no trustee, for his inchoate title, is a legal, and not a merely equitable one;<sup>3</sup> and the executor or administrator, if he takes at all, must take as trustee for the heirs or devisees of the inventor.

Where an inventor assigns his invention and dies before making any application for a patent, a difficulty arises for which the statute affords no clear solution. In such a case,

<sup>1</sup> *De La Vergne Machine Co. v. Featherstone*, 147 U. S. 211, 1893.

<sup>3</sup> *Hendrie v. Sayles*, 98 U. S. 549, 1878.

<sup>2</sup> Revised Statutes, Section 4896.



it is provided that the application must be made and sworn to by the executor or administrator, for an assignee cannot apply for a patent except on the oath of the inventor himself.<sup>1</sup> It is also provided, that where an executor or administrator applies for a patent, he must take that patent, if granted, in trust for the heirs or devisees of the inventor.<sup>2</sup> Now under these circumstances, the law must do one of three things. It must ignore this last provision, and hold that the executor or administrator takes in trust for the assignee; or it must impose a trust upon a trust, by holding that the executor or administrator takes in trust for the heirs or devisees, and they take in trust for the assignee; or it must deprive the assignee of his right altogether. The first alternative flies in the face of the statute, and the third flies in the face of justice. The second is consistent with conscience, and can probably be adopted and enforced by courts of equity.

§ 172. Letters patent are documents consisting of the grant and the specification; and where drawings form a part of the application, they also form a part of the letters patent. The grant is a paper, issued in the name of the United States, under the seal of the Patent Office, and signed by the Secretary of the Interior, or under his direction by one of the Assistant Secretaries of the Interior,<sup>3</sup> and countersigned by the Commissioner of Patents. It contains a short title of the invention, and purports to grant to the patentee, his heirs or assigns, for the term of seventeen years, the exclusive right to make, use, and vend the invention, throughout the United States and the territories thereof; and it refers to the specification, for the particulars of the invention covered by the grant,<sup>4</sup> and each of the three rights granted by letters patent is a separate substantive right.<sup>5</sup>

<sup>1</sup> Revised Statutes, Sections 4895, 4896.

<sup>2</sup> Revised Statutes, Section 4896.

<sup>3</sup> 25 Statutes at Large, Ch. 15, p. 40.

<sup>4</sup> Revised Statutes, Sections 4883, 4884.

<sup>5</sup> *Adams v. Burke*, 17 Wall. 453, 1873; *Tuttle v. Matthews*, 28 Fed. Rep. 98, 1886.

Letters patent are valid where the grant is signed by an Acting Secretary of the Interior, or countersigned by an Acting Commissioner of Patents; and letters patent, so signed, are admissible in evidence without any pleading or proof of the title of such officers to their respective offices. Courts take judicial notice of the persons who preside over the departments or bureaus of the government, whether permanently or temporarily; and the production of their commissions is not necessary to support their official acts.<sup>1</sup> But if letters patent are issued without any signature of the Secretary of the Interior, or of an Acting or Assistant Secretary of the Interior, the omission is fatal to the validity of those letters patent; and the same effect would result from an omission of the counter-signature of the Commissioner of Patents, unless an Acting Commissioner of Patents should countersign in his stead.<sup>2</sup> Such an error may, however, be corrected by affixing the omitted signature; but such a correction will affect only the future, and not the past, portion of the term of the patent.<sup>3</sup> A misnomer of the patentee, in a grant, does not invalidate the patent, if he can be identified by means of any description which the letters patent may contain.<sup>4</sup> If the letters patent contains no means for correcting the misnomer, it may be corrected by the proper officers of the government, whenever those officers become convinced of the mistake.<sup>5</sup>

But regularly executed letters patent cannot be altered in character by the Commissioner of Patents, except after a surrender, and by means of a reissue, and any such alteration otherwise made, is void for want of jurisdiction in the Commissioner to make it.<sup>6</sup> But where an alteration has

<sup>1</sup> York and Maryland Line Railroad Co. v. Winans, 17 Howard, 30, 1854.

<sup>2</sup> Marsh v. Nichols, 128 U. S. 605, 1888.

<sup>3</sup> Marsh v. Nichols, 128 U. S. 605, 1888.

<sup>4</sup> Northwestern Fire Extinguisher

Co. v. Philadelphia Extinguisher Co. 1 Bann. & Ard. 177, 1874.

<sup>5</sup> Bell v. Hearne, 19 Howard, 262, 1856.

<sup>6</sup> Edison Electric Light Co. v. U. S. Electric Lighting Co. 52 Fed. Rep. 312, 1892.



been actually made by the Commissioner of Patents, at the request of the patentee, and where some party has relied upon the validity of that alteration, to the extent of embarking in business because of it, the patentee may be estopped from denying that validity, as against that particular party.<sup>1</sup>

§ 173. The word "specification," whenever it is used in the statute without the word "claim," covers both the claim and the description; and whenever it is used with the word claim, it covers the description only.<sup>2</sup> The first is its more general meaning, and to avoid confusion it is never used in any other sense in this book. The proper characteristics of specifications are herein explained by explaining the proper characteristics of descriptions and claims, which are the component parts of specifications.

§ 174. The description of the invention, which forms a part of every specification, is required to set forth that invention, and the manner and process of making and using it, 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 and use the same; and in case of a machine, the description is required to explain the principle thereof, and the mode of applying that principle which the inventor believes to be the best.<sup>3</sup> The phrase "any person skilled in the art or science" is not confined to the most eminent scientists, nor the most able experts in that science or art; but it also indicates persons whose skill may stop short of the highest excellence.<sup>4</sup>

It is not necessary that the description should be intelligible to every intelligent man, nor to every skilful mechanic. If it can be understood by those who possess full knowledge of the prior inventions in the same department of art or science, it is full, clear, concise, and exact enough to

<sup>1</sup> Edison Electric Light Co. v. Buckeye Electric Co. 59 Fed. Rep. 699, 1894.

1880,

<sup>3</sup> Revised Statutes, Section 4888.

<sup>2</sup> Wilson v. Coon, 18 Blatch. 532,

<sup>4</sup> Tannage Patent Co. v. Zahn, 66 Fed. Rep. 989, 1895.

comply with the statute.<sup>1</sup> In explaining this point of law, Justice BRADLEY, in the first cited decision, used a particularly felicitous illustration. His Honor said: "When an astronomer reports that a comet is to be seen with the telescope, in the constellation of Auriga, in so many degrees of declination, and so many hours and minutes of right ascension, it is all Greek to the unskilled in science; but other astronomers will instantly direct their telescopes to the very point in the heavens where the stranger has made his entrance into our system. They understand the language of their brother scientist. If a mechanical engineer invents an improvement on any of the appendages of a steam-engine, such as the valve-gear, the condenser, the steam-chest, the walking-beam, the parallel motion, or what not, he is not obliged, in order to make himself understood, to describe the engine, nor the particular appendage to which the improvement refers, nor its mode of connection with the principal machine. These are already familiar to others skilled in that kind of machinery. He may begin at the point where his invention begins, and describe what he has made that is new, and what it replaces of the old."

These observations are particularly applicable to descriptions of machinery; but they also suggest the true principles on which to judge of the sufficiency of descriptions of processes, manufactures, and compositions of matter.<sup>2</sup> Relevant to this last class of subjects of patents, it has been held that descriptions should state the component parts thereof, and the proportions in which they are to be mixed or combined, and should do this with clearness and precision, and should not leave the public to ascertain any such fact by experiment.<sup>3</sup> But where proportions must vary with circumstances, a description of an invention is

<sup>1</sup> *Loom Co. v. Higgins*, 105 U. S. 580, 1881; *Celluloid Mfg. Co. v. Russell*, 37 Fed. Rep. 679, 1889; *Lalance & Grosjean Mfg. Co. v. Haberman Mfg. Co.* 55 Fed. Rep. 296, 1893.

<sup>2</sup> *Seabury v. Am Ende*, 152 U. S. 567, 1894.

<sup>3</sup> *Wood v. Underhill*, 5 Howard, 1, 1847; *Tyler v. Boston*, 7 Wallace, 327, 1868.



sufficient, if it states the proportions proper under ordinary circumstances, and points out the direction in which they must be varied when circumstances are changed.<sup>1</sup> And in the case of an article of manufacture, where proportion is important to operativeness, the proper proportions may be indicated in any way that is substantially correct, and need not be stated mathematically.<sup>2</sup>

§ 175. An inventor need not explain in his description, or know in point of fact, what laws of nature those are which cause his invention to work;<sup>3</sup> nor is a patent void on the ground that the principle of the invention is not fully understood; or if understood by any one, not understood alike by all.<sup>4</sup> Neither is any description insufficient in the eye of the law, on account of any mere errors it may be found to contain, where those errors would at once be detected and their remedies be known, by any person skilled in the art, when making specimens of the invention set forth, or when practicing that invention, if that invention is a process;<sup>5</sup> nor where such errors consist in mistaken statements of immaterial facts;<sup>6</sup> nor where such errors relate to the degree of efficiency of the invention.<sup>7</sup> Nor need a description state every use to which the described and claimed invention is applicable, in order to cover every such use.<sup>8</sup> Neither is it necessary in a description in a patent for a process to set forth all the modes in which that process may be performed, nor all the kinds of apparatus which may be used in performing it, in order to cover that process with the patent. It is enough to describe one particular mode and one particular apparatus

<sup>1</sup> *Consolidated Valve Co. v. Valve Co.* 113 U. S. 177, 1884.

<sup>2</sup> *Edison Electric Light Co. v. U. S. Electric Lighting Co.* 52 Fed. Rep. 309, 1892.

<sup>3</sup> *Saint Louis Stamping Co. v. Quinby*, 4 Bann. & Ard. 195, 1879; *Haffcke v. Clark*, 46 Fed. Rep. 770, 1891; *Dixon-Woods Co. v. Pfeifer*, 55 Fed. Rep. 395, 1893.

<sup>4</sup> *Knickerbocker Co. v. Rogers*,

61 Fed. Rep. 297, 1894.

<sup>5</sup> *Singer v. Walmsley*, 1 Fisher, 559, 1860; *Kendrick v. Emmons*, 2 Bann. & Ard. 210, 1875.

<sup>6</sup> *Maryland Hominy Co. v. Dorr*, 46 Fed. Rep. 776, 1891.

<sup>7</sup> *Michaels v. Roessler*, 34 Fed. Rep. 325, 1888.

<sup>8</sup> *Piko v. Potter*, 3 Fisher, 55, 1859.

by means of which the process may be performed with at least some beneficial result.<sup>1</sup> Nor is a description fatally defective merely because it omits to mention something which contributes only to the degree of benefit, provided the invention will work beneficially without it.<sup>2</sup> But the omission of anything absolutely material to the utility of the invention described, is a fatal defect in a description,<sup>3</sup> unless that omission would naturally be supplied by any person skilled in the art when making the invention, if it be a thing, or when using it, if it be a process. Accordingly, it has been held that where one element of a new combination covered by a patent must have a certain form in order to operate in that combination, and where another form of that element is known to persons skilled in the art; a description is insufficient which merely states that such old element is a part of the combination, without saying or showing which of its known forms is applicable to the case.<sup>4</sup> On the other hand, no excess of description is injurious to the validity of a patent, unless the redundant matter was introduced with fraudulent intention.<sup>5</sup>

§ 176. The claim or claims of a specification are necessarily inserted in order to conform to the statutory requirement that the patentee shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention.<sup>6</sup> A distinct and formal claim is necessary to ascertain the scope of a patented invention,<sup>7</sup> and a patent grants no exclusive right, except to what is thus distinctly claimed.<sup>8</sup>

A claim covers and secures a process, a machine, a manufacture, or a composition of matter, and never the function

<sup>1</sup> *Tilghman v. Proctor*, 102 U. S. 728, 1880; *Pittsburgh Reduction Co. v. Cowles Co.* 55 Fed. Rep. 316, 1893; *Rapid Service Store Co. v. Taylor*, 43 Fed. Rep. 251, 1890.

<sup>2</sup> *Sewall v. Jones*, 91 U. S. 185, 1875.

<sup>3</sup> *Carr v. Rice*, 1 Fisher, 204, 1856.

<sup>4</sup> *Schneider v. Thill*, 5 Bann. &

Ard. 565, 1880.

<sup>5</sup> *Sewall v. Jones*, 91 U. S. 186, 1875.

<sup>6</sup> Revised Statutes, Section 4888.

<sup>7</sup> *Grant v. Walter*, 148 U. S. 554, 1893.

<sup>8</sup> *Ashton Valve Co. v. Muffler Co.* 8 U. S. App. 226, 1893.



or result of either.<sup>1</sup> A claim may cover the entire process, machine, manufacture, or composition of matter, which is set forth in the description, or it may cover such parts, or such sub-processes, or such combinations as are new and useful inventions; and the specification may contain a claim for the whole, and other claims for separate parts, and still other claims for separate sub-processes or combinations.<sup>2</sup> And the subject of a claim needs not to be operative alone,<sup>3</sup> for utility is justly ascribed to things which have their use in co-operating with other things to perform a useful work. But in order to be sustained, each claim must be able to withstand the tests of invention, of novelty, and of utility, which are stated in the second, third, and fourth chapters of this book, respectively.

All claims are required to be specific, so that the public may know what they are prohibited from doing during the existence of the patent, and what they are to have at the end of the term, as a consideration for the grant.<sup>4</sup> The necessary degree of particularity in claims may be reached in various modes. Where the invention is an entire machine, the claim is sufficient if it is clearly co-extensive with the machine; and where the invention is a part of a machine or manufacture, that part must be clearly indicated in the claim which covers it.<sup>5</sup> Claims for combinations of a plurality of the described devices, but less than all of them, should use the word "combination," and should state the devices of which it is composed.<sup>6</sup> But though this degree

<sup>1</sup> *Corning v. Burden*, 15 Howard, 252, 1853; *O'Reilly v. Morse*, 15 Howard, 62, 1853; *Carver v. Hyde*, 16 Peters, 513, 1842; *Le Roy v. Tatham*, 14 Howard, 156, 1852.

<sup>2</sup> *Railroad Co. v. Dubois*, 12 Wallace, 47, 1870; *National Machine Co. v. Thom*, 25 Fed. Rep. 500, 1885.

<sup>3</sup> *Deering v. Winona Harvester Works*, 155 U. S. 302, 1894; *Hancock Inspirator Co. v. Jenks*, 21

Fed. Rep. 915, 1884; *Rapid Service Store Co. v. Taylor*, 43 Fed. Rep. 251, 1890; *Roberts v. Nail Co.* 53 Fed. Rep. 920, 1892; *Holloway v. Dow*, 54 Fed. Rep. 516, 1893.

<sup>4</sup> *Brooks v. Fiske*, 15 Howard, 212, 1853; *Buffington's Iron Bldg. Co. v. Eustis*, 65 Fed. Rep. 807, 1895.

<sup>5</sup> *Seymour v. Osborne*, 11 Wallace, 516, 1870.

<sup>6</sup> *Brown Mfg. Co. v. Bradley Mfg. Co.* 51 Fed. Rep. 226, 1892.

of obvious certainty is highly desirable in a combination claim, it is not absolutely necessary to the validity of such an one; for a claim may declare that it covers so much of the described mechanism as effects a particular specified result, without specifying those parts themselves. In such a case it is a question of fact to be determined in court, if necessary, which parts those are which effect that result and are therefore covered by the claim.<sup>1</sup> So, also, two or more claims in substance may sometimes be combined in one claim in form.<sup>2</sup> This may be accomplished in different ways, and among others by inserting in the claim the words "with or without" before the name or other designation of one or more of the enumerated parts of the process, machine, combination, manufacture, or composition of matter covered by that claim.<sup>3</sup> The claim of the Charles Goodyear rubber patent had this characteristic. It was a claim for vulcanized India rubber, whether with or without other ingredients, chemically altered by the application of heat, substantially as described.<sup>4</sup> But a process and its product, though they may be secured by separate claims in one patent, cannot be covered by one claim.<sup>5</sup>

§ 177. Letters patent may be valid as to one or more claims while being invalid as to one or more other claims in the same specification.<sup>6</sup> And where a patent contains two claims which are alike, except that the narrower one of them calls for an unpatentable addition to what is called for by the other, the narrower claim is void.<sup>7</sup> But two claims which may appear to be alike will, if practicable, be construed to differ rather than agree, because there is a

<sup>1</sup> *Silsby v. Foote*, 14 Howard, 218, 1852; *Fay v. Cordesman*, 109 U. S. 420, 1883; *Hoe v. Knap*, 27 Fed. Rep. 208 1886.

<sup>2</sup> *Telephone Cases*, 126 U. S. 537, 1888.

<sup>3</sup> *Tuck v. Bramhill*, 6 Blatch. 95, 1868.

<sup>4</sup> *Rubber Co. v. Goodyear*, 9 Wallace, 795, 1869.

<sup>5</sup> *Durand v. Schulze*, 61 Fed. Rep. 820, 1894.

<sup>6</sup> *Russell v. Place*, 94 U. S. 606, 1876.

<sup>7</sup> *Featherstone v. Cycle Co.* 53 Fed. Rep. 116, 1892.



presumption that no applicant will do so useless and inexpedient an act as to repeat a claim.<sup>1</sup>

Letters patent which contain a needless multiplication of nebulous claims, calculated to mislead the public, are void for that reason, if for no other.<sup>2</sup> This word "calculated" is the word used by the justice who announced the opinion of the Supreme Court upon the point. It is itself somewhat nebulous, for it is questionable whether it means apt, or means intended. Judge W. D. SHIPMAN was quite explicit when deciding a similar question. He held that a patent is not void merely because it contains a plurality of claims, each of which covers the same thing, and covers nothing else, where there is no evidence that the double claim was made with intention to mislead.<sup>3</sup> And Judge McKENNA has lately followed that example.<sup>4</sup> In the light of these decisions the word "calculated" in the Supreme Court decision is seen to signify intended, and the Supreme Court decision is therefore to be read with that explanation.

If all the claims of a particular patent are void, either for want of particularity or for want of invention, novelty, or utility, or for any other reason or reasons, that patent is also void, even though one or more valid claims might have been made and allowed on the basis of the descriptive part of the specification.<sup>5</sup>

§ 178. The statutory requirements relevant to particularity in the descriptions and claims of letters patent, are conditions precedent to the authority of the Commissioner of Patents to issue such documents;<sup>6</sup> and if such a document is issued, the descriptions or claims in which do not conform to these requirements, then that document is void.<sup>7</sup>

<sup>1</sup> *Campbell Printing Press Co. v. Marden*, 64 Fed. Rep. 784, 1894; *National Cash Register Co. v. American Cash Register Co.* 53 Fed. Rep. 370, 1892.

<sup>2</sup> *Carlton v. Bokee*, 17 Wallace, 463, 1873.

<sup>3</sup> *Tompkins v. Gage*, 5 Blatch. 270, 1861.

<sup>4</sup> *Bowers v. Von Schmidt*, 63 Fed. Rep. 581, 1894.

<sup>5</sup> *Wisner v. Grant*, 5 Bann. & Ard. 215, 1880.

<sup>6</sup> *Seymour v. Osborne*, 11 Wallace, 516, 1870.

<sup>7</sup> *O'Reilly v. Morse*, 15 Howard, 62, 1853; *Ames v. Howard*, 1 Sumner, 492, 1833.

But where the inventions, which are covered by part of the claims of a patent, are sufficiently described, those claims may be valid, though other claims in the same patent are void for want of sufficient description.<sup>1</sup> Such invalidity does not depend on the intention of the inventor, but is a legal inference from his failure to give to his description and claims the statutory particularity.<sup>2</sup> It is a question of jurisdiction in the Commissioner of Patents; not a question of fraudulent intent in the delinquent patentee. The Commissioner is authorized to issue letters patent only on adequate specifications. If he issues them on inadequate specifications, their invalidity cannot be removed by showing that the inadequacy arose from ignorance and not from fraud. This point of law is not shaken by the fact that Section 4920 of the Revised Statutes, in providing for special defences to patent suits, under the general issue in pleading, provides that among such defences the defendant may prove "that for the purpose of deceiving the public, the description filed by the patentee in the Patent Office was made to contain less than the whole truth relative to the invention or discovery, or more than is necessary to produce the desired effect." There are several grounds for this opinion of the text writer. First: An omission to state the whole truth relative to an invention is not necessarily the same thing as an insufficient description of that invention. A specification might have one or more of several faults belonging to the first category, and be free from objection on the latter score. One of these would be an omission to state some double use of which the invention is capable. Such an omission, if made in ignorance of that double use, ought not to invalidate the patent, but if made with a fraudulent intention to keep that double use forever secret, it ought to have that effect. The defence in Section 4920 is aimed at such cases, and not at cases of insufficiency of specification. Second: The defences provided for in

<sup>1</sup> *Bene v. Jeantet*, 129 U. S. 683, 1888.

<sup>2</sup> *Grant v. Raymond*, 6 Peters, 218, 1832.



Section 4920 are not all the defences that may be interposed in infringement cases. They are merely the defences that may be interposed under the general issue. The defence of insufficient specification, as well as any other legal defence, may be interposed by a special plea.<sup>1</sup>

§ 179. It is a question of fact for a jury in an action at law, or for a chancellor in an action in equity, to determine whether the specification, including the claim, of a patent conforms to the statutory requirements relevant to particularity.<sup>2</sup> That question is, in both tribunals, a question of evidence, and not a question of construction.<sup>3</sup>

§ 180. Two or more inventions, if they relate to the same subject, or are in their nature and operation connected together, may be covered by a corresponding number of claims in a single letters patent.<sup>4</sup> Thus two or more separate inventions, which may be used as parts of a particular machine, may be separately claimed in a single letters patent, and two or more processes which may be successively used to produce a particular product, may likewise be secured; but two or more products, even in the same department of manufactures, cannot be patented together. So also apparatus claims and process claims may sometimes be joined, and a process claim and a product claim may sometimes be assembled; but a machine claim and a product claim cannot both be made in a single patent.

On the other hand, separate letters patent may be granted for different parts of the same machine.<sup>5</sup> In such cases it is proper to describe the whole machine in each of the specifications, and to picture the whole machine in each set of drawings, thus causing the separate letters patent to

<sup>1</sup> *Reckendorfer v. Faber*, 92 U. S. 347, 1875.

<sup>2</sup> *Battin v. Taggert*, 17 Howard, 74, 1854.

<sup>3</sup> *Fisk, Clark & Flagg v. Hollander, MacArthur & Mackey*, 355, 1883.

<sup>4</sup> *Hogg v. Emerson*, 6 Howard,

483, 1848; *Dobson v. Carpet Co.* 114 U. S. 446, 1884; *McComb v. Brodie*, 1 Woods, 153, 1871; *Stevens v. Pritchard*, 2 Bann. & Ard. 390, 1876.

<sup>5</sup> *Graham v. McCormick*, 11 Fed. Rep. 859, 1880; *Graham v. Mfg. Co.* 11 Fed. Rep. 138, 1880.

differ from each other only in their claims.<sup>1</sup> A plurality of patents cannot, however, be granted for different uses of the same invention.<sup>2</sup> Indeed, all the uses of an invention are covered and secured by a single letters patent for that invention.<sup>3</sup>

§ 180*a*. Only one valid original patent can be granted to an inventor on one invention; and if a plurality of such patents are thus granted, all except the first are void.<sup>4</sup> Where a plurality of similar or approximating original patents have been granted to an inventor, the question of the identity or the non-identity of the inventions may therefore arise; and when such a question arises, it must be determined by the application of the relevant rule of law. The rule for ascertaining whether a reissue patent is for "the same invention" within the meaning of the reissue statute, is not applicable to determining the question of identity between two original patents; because a reissue patent is held to be for "the same invention," within that meaning, where that invention was described in the original patent, and appears therein to have been intended to be secured thereby, whether it was thus secured or not;<sup>5</sup> and because a man does not have two original patents for the same invention, unless each of those patents purports to secure to him a monopoly of that invention. And no monopoly of any invention is secured to any patentee, by any patent, otherwise than by

<sup>1</sup> *Millin v. Rees*, 5 Bann. & Ard. 269, 1880.

<sup>2</sup> *McComb v. Brodie*, 1 Woods, 153, 1871.

<sup>3</sup> *Roberts v. Ryer*, 91 U. S. 157, 1875; *Western Electric Co. v. La Rue*, 139 U. S. 606, 1891; *Potts v. Creager*, 155 U. S. 606, 1893; *Ligowski Clay Pigeon Co. v. Clay Bird Co.* 34 Fed. Rep. 331, 1888; *Thompson v. Gildersleeve*, 34 Fed. Rep. 45, 1888; *Stegner v. Blake*, 36 Fed. Rep. 183, 1888; *Thompson v. Donnell Mfg. Co.* 40 Fed. Rep. 383,

1889; *Steiner Extinguisher Co. v. Adrian*, 52 Fed. Rep. 733, 1892; *New Departure Bell Co. v. Mfg. Co.* 64 Fed. Rep. 862, 1894; *Wright & Colton Wire-Cloth Co. v. Wire-Cloth Co.* 67 Fed. Rep. 792, 1895.

<sup>4</sup> *Suffolk Co. v. Hayden*, 3 Wall, 315, 1865; *Miller v. Eagle Co.* 151 U. S. 197, 1894.

<sup>5</sup> *Parker & Whipple Co. v. Yale Clock Co.* 123 U. S. 99, 1887; *Freeman v. Asmus*, 145 U. S. 240, 1892; *Corbin Lock Co. v. Eagle Lock Co.* 150 U. S. 42, 1893.



a claim in that patent, which is co-extensive with that invention.<sup>1</sup> Therefore the rule for ascertaining the identity or the non-identity of the invention or inventions of a plurality of resembling original patents granted to one inventor, is the same as the rule for ascertaining the identity or non-identity of the invention or inventions of a plurality of resembling original patents granted to a plurality of inventors. And that rule consists in comparing the claims of the patents in question, and finding identity or non-identity of invention, according as those claims are found to be co-extensive or not co-extensive.<sup>2</sup>

Claims are co-extensive which specify the same combination, of the same number, of the same parts, with the same features; though the functions which are mentioned in the claims are not co-extensive.<sup>3</sup> That was held to be the character of the respective claims of two patents to the same inventor, in the case of *Miller v. Eagle Co*; and therefore the second of those patents was held to have been granted for the same invention as the first, and to be void. But two claims are not co-extensive, which specify different combinations of parts of a process, machine, or manufacture, even where some of those parts are in each of the combinations;<sup>4</sup> because the claim which specifies fewest of those parts, may be infringed by what will not infringe any claim

<sup>1</sup> *M'Millin v. Rees*, 5 Bann. & Ard. 269, 1880; *Delaware Coal & Ice Co. v. Packard*, 5 Bann. & Ard. 296, 1880; *Blades v. Rand*, 27 Fed. Rep. 97, 1886; *Roemer v. Peddie*, 27 Fed. Rep. 702, 1886; *Allison v. Brooklyn Bridge*, 29 Fed. Rep. 517, 1886; *McBride v. Plow Co.* 44 Fed. Rep. 77, 1890; *Maddock v. Coxon*, 45 Fed. Rep. 579, 1891.

<sup>2</sup> *Gold & Silver Ore Co. v. Disintegrating Ore Co.* 6 Blatch. 311, 1869; *Morris v. Kempshall Mfg. Co.* 20 Fed. Rep. 121, 1884; *Pentlarge v. New York Bushing Co.* 20 Fed. Rep. 314, 1884; *Nathan*

*Mfg. Co. v. Craig*, 49 Fed. Rep. 370, 1892; *Dederick v. Fox*, 56 Fed. Rep. 718, 1893; *Stonementz Mach. Co. v. Brown Mach. Co.* 57 Fed. Rep. 605, 1893.

<sup>3</sup> *Miller v. Eagle Co.* 151 U. S. 189, 1894; *Fassett v. Ewart Mfg. Co.* 58 Fed. Rep. 366; and 62 Fed. Rep. 407, 1894.

<sup>4</sup> *Suffolk Co. v. Hayden*, 3 Wall. 315, 1865; *Wheeler v. McCormick*, 11 Blatch. 334, 1873; *Graham v. McCormick*, 5 Bann. & Ard. 244, 1880; *Graham v. Crawford Mfg. Co.* 11 Fed. Rep. 138, 1880.

specifying more of those parts.<sup>1</sup> That was held to be the character of the respective claims of two patents to the same inventor, in the case of *Suffolk Co. v. Hayden*; and therefore the second of those patents was held to have been granted for another invention than the first, and to be valid. And two claims are not co-extensive, where one of them specifies all the features of any or all of the parts of its subject, while the other omits one of those features;<sup>2</sup> because the latter may be infringed by processes or mechanisms which lack that feature, while the former cannot.<sup>3</sup>

Where a plurality of approximating original patents have been granted to an inventor; and where the question of identity of subject has been decided in the negative, or must evidently be so decided; the question may arise whether the ascertained difference between the two subjects is a patentable difference.<sup>4</sup> In investigating that question, the patent which was applied for last, even if granted first, will be treated as the junior patent; since the dates of the applications, and not the dates of the patents, control in determining the legal effect to be given to two patents issued at different dates, to the same inventor, and the order in which they are to be considered.<sup>5</sup>

§ 181. To construe letters patent, is to determine precisely what inventions they cover and secure. Nothing described in letters patent, is secured thereby, unless it is

<sup>1</sup> *Vance v. Campbell*, 1 Black, 430, 1861; *Eames v. Godfrey*, 1 Wall. 78, 1863; *Case v. Brown*, 2 Wall. 320, 1864; *Dunbar v. Meyers*, 94 U. S. 187, 1876; *Fuller v. Yentzer*, 94 U. S. 297, 1876; *Fay v. Cordesman*, 109 U. S. 420, 1883; *Rowell v. Lindsay*, 113 U. S. 102, 1884; *Sargent v. Lock Co.* 114 U. S. 86, 1884; *Shepard v. Carrigan*, 116 U. S. 597, 1885; *Yale Lock Co. v. Sargent*, 117 U. S. 378, 1885; *Derby v. Thompson*, 146, U. S. 482, 1892; *Weatherhead v. Coupe*, 147 U. S. 335, 1893; *Dobson v. Cubley*, 149 U. S. 120, 1893.

<sup>2</sup> *Thompson-Houston Co. v. Elmira Ry. Co.* 69 Fed. Rep. —, 1895.

<sup>3</sup> *Prouty v. Ruggles*, 16 Peters, 341, 1842; *Sharp v. Reissner*, 119 U. S. 636, 1886; *McClain v. Ortmyer*, 141 U. S. 425, 1891; *Wright v. Yuengling*, 155 U. S. 52, 1894; *Black Diamond Coal Co. v. Excelsior Co.* 156 U. S. 617, 1895.

<sup>4</sup> *Reynolds v. Standard Paint Co.* 68 Fed. Rep. 487, 1895; *Russell v. Kern*, 72 Off. Gaz. 590, 1895.

<sup>5</sup> *Barbed Wire Patent*, 143 U. S. 281, 1892.



covered by a claim.<sup>1</sup> And a claim which is clearly narrower than the invention which it was designed to cover, cannot be broadened by construction to correspond with that invention.<sup>2</sup> The construction of letters patent depends therefore upon the construction of their respective claims;<sup>3</sup> and the established rules by means of which claims are properly construed may constitute the next subject of discussion.

§ 182. The phrase "substantially as described," or its equivalent, when such a phrase occurs in a claim, throws the investigator back to the description for means of construction;<sup>4</sup> and that phrase is always implied in claims wherein it is not expressed.<sup>5</sup> The words "substantially as specified" mean substantially as specified in regard to the particular matter which is the subject of the claim;<sup>6</sup> and the same rule applies with the same force to the words "substantially as described." But neither of those phrases will import into a claim any unessential feature of the subject thereof;<sup>7</sup> nor even a detail, which was said to be best

<sup>1</sup> *M'Millin v. Rees*, 5 Bann. & Ard. 269, 1880; *Delaware Coal & Ice Co. v. Packard*, 5 Bann. & Ard. 296, 1880; *Blades v. Rand*, 27 Fed. Rep. 97, 1886; *Roemer v. Peddie*, 27 Fed. Rep. 702, 1886; *Allison v. Brooklyn Bridge*, 29 Fed. Rep. 517, 1886; *McBride v. Plow Co.* 44 Fed. Rep. 77, 1890; *Maddock v. Coxon*, 45 Fed. Rep. 579, 1891.

<sup>2</sup> *Smith v. Macbeth*, 67 Fed. Rep. 140, 1895; *New Home Sewing Machine Co. v. Singer Mfg. Co.* 68 Fed. Rep. 226, 1895.

<sup>3</sup> *Maddock v. Coxon*, 45 Fed. Rep. 579, 1891.

<sup>4</sup> *Seymour v. Osborne*, 11 Wallace, 516, 1870; *Corn-Planter Patent*, 23 Wallace, 181, 1874; *Telephone Cases*, 126 U. S. 537, 1887; *Consolidated Roller Mill Co. v. Walker*, 138 U. S. 133, 1891.

<sup>5</sup> *Matthews v. Schoneberger*, 4 Fed. Rep. 635, 1880; *Westinghouse*

*v. Air Brake Co.* 2 Bann. & Ard. 57, 1875; *Olds v. Brown*, 41 Fed. Rep. 704, 1890; *Foos Mfg. Co. v. Thresher Co.* 44 Fed. Rep. 599, 1891; *Bundy Mfg. Co. v. Columbian Co.* 59 Fed. Rep. 294, 1894.

<sup>6</sup> *Lake Shore R. R. Co. v. Car Brake Shoe Co.* 110 U. S. 235, 1883; *Page Fence Co. v. Land*, 49 Fed. Rep. 943, 1891; *Edison Electric Light Co. v. U. S. Electric Lighting Co.* 52 Fed. Rep. 309, 1892; *McKay & Copeland Lasting Machine Co. v. Claffin*, 58 Fed. Rep. 354, 1893; *Reece Button-Hole Mach. Co. v. Globe Mach. Co.* 61 Fed. Rep. 961, 1894.

<sup>7</sup> *Campbell Printing Press Co. v. Marden*, 64 Fed. Rep. 786, 1894; *Temple Pump Co. v. Mfg. Co.* 30 Fed. Rep. 442, 1887; *Edison Electric Light Co. v. U. S. Electric Lighting Co.* 52 Fed. Rep. 309, 1892; *Pacific Cable Ry. Co. v. Butte City Ry. Co.* 55 Fed. Rep. 763, 1893.

in the specification, but was afterwards found to be useless.<sup>1</sup> The implication of such a phrase, where it is not expressed, follows from the rule that while descriptions are considered in this connection only for the purpose of construing claims,<sup>2</sup> a claim should always be construed in the light of the description;<sup>3</sup> and the certainty of that implication indicates the propriety of omitting, for the sake of brevity, all such phrases from claims. An uncommon word in a claim is to be construed in the light of the description, rather than in the light of the dictionary;<sup>4</sup> because the patentee presumably knew the description, and may not have known the dictionary; and because the reader of a patent may reasonably be expected to consult the description, before he consults the dictionary, when engaged in trying to learn the meaning of one of its claims.

The phrase "for the purpose set forth" is never implied in a claim, because an inventor is entitled to the exclusive use of his invention for all purposes, whether he sets them all forth in his specification or not.<sup>5</sup> And such a phrase ought never to be expressed in a claim, because it cannot impart validity to a claim otherwise void,<sup>6</sup> and because it may enable persons to avoid infringement, who would otherwise infringe.<sup>7</sup>

The drawings attached to letters patent may be referred to for explanation of anything which the description leaves obscure,<sup>8</sup> but not to supply a total omission of description.<sup>9</sup>

<sup>1</sup> American Dunlop Tire Co. v. Erie Rubber Co. 66 Fed. Rep. 558, 1895.

<sup>2</sup> Pitts v. Wemple, 1 Bissell, 87, 1855.

<sup>3</sup> Smith v. Dental Vulcanite Co. 93 U. S. 493, 1876; Howe Machine Co. v. National Needle Co. 134 U. S. 395, 1890; Pacific Cable Railway Co. v. Butte City Ry. Co. 58 Fed. Rep. 423, 1893.

<sup>4</sup> Standard Paint Co. v. Bird, 65

Fed. Rep. 510, 1894.

<sup>5</sup> Roberts v. Ryer, 91 U. S. 157, 1875.

<sup>6</sup> Crescent Brewing Co. v. Gotfried, 127 U. S. 168, 1888.

<sup>7</sup> Keystone Bridge Co. v. Iron Co. 95 U. S. 278, 1877.

<sup>8</sup> Hogg v. Emerson, 11 Howard, 587, 1850.

<sup>9</sup> Gunn v. Savage, 30 Fed. Rep. 369, 1887; Wilkin v. Covel, 16 Fed. Rep. 926, 1891.



And neither drawings nor descriptions can enlarge claims,<sup>1</sup> unless it be where a claim is limited on its face to the use of the invention in a particular environment, and where the description shows that it was intended to be claimed in other environments also.<sup>2</sup> Claims may be narrowed by limitations in the description,<sup>3</sup> and also by importation by construction of described elements which are necessary to invention or novelty as well as operativeness;<sup>4</sup> but not by inference from the description, where the state of the prior art does not require such an implied limitation.<sup>5</sup>

182*a*. Reference letters or numerals, when used in a claim to indicate, or help indicate, a part or combination covered thereby, do not limit that claim to the specific mechanism shown in the patent; unless the claim must be thus limited by the prior state of the art.<sup>6</sup> But where the novelty of a part or combination, shown in the drawings of a patent, resides entirely in all its particular characteristics, and where that part or combination is specified in a claim by reference letters or numerals, that claim is limited to a part or combination having those particular characteristics; for if not thus restricted, the claim would be void for want of novelty.<sup>7</sup> But the same rule applies, in an otherwise similar case, for the same reason, where the part or combination, covered by a claim, is indicated therein in some other way than by reference letters or numerals. A rule which would give, to a reference letter or numeral in a claim, a more narrowing effect than is called for by the prior state of the art, would

<sup>1</sup> *Railroad Co. v. Mellon*, 104 U. S. 112, 1881; *White v. Dunbar*, 119 U. S. 51, 1886; *Howe Machine Co. v. National Needle Co.* 134 U. S. 394, 1890; *McClain v. Ortmyer*, 141 U. S. 419, 1891.

<sup>2</sup> *LaRue v. Electric Co.* 28 Fed. Rep. 85, 1886; *LaRue v. Electric Co.* 31 Fed. Rep. 83, 1887.

<sup>3</sup> *Sargent v. Lock Co.* 114 U. S. 86, 1884; *Crawford v. Heysinger*, 123 U. S. 606, 1887; *McClain v. Ort-*

*mayer*, 141 U. S. 419, 1891.

<sup>4</sup> *Hartshorn v. Barrel Co.* 119 U. S. 679, 1886; *Consolidated Roller Mill Co. v. Walker*, 138 U. S. 132, 1891.

<sup>5</sup> *Campbell Printing Press Co. v. Marden*, 64 Fed. Rep. 785, 1894.

<sup>6</sup> *Campbell Printing Press Co. v. Marden*, 64 Fed. Rep. 785, 1894.

<sup>7</sup> *Knapp v. Morss*, 150 U. S. 228, 1893; *Lehigh Valley Railroad Co. v. Kearney*, 158 U. S. 469, 1895.

be an artificial rule of interpretation ; but the object of the patent law is to secure to inventors what they have invented, and that object is not to be defeated by the application of any such rule.<sup>1</sup>

§ 183. Claims which are functional in form ; that is to say, claims which literally purport to cover a result rather than a process or a thing, are properly construed to cover only the process of the thing which produces that result, for otherwise such claims would be void.<sup>2</sup> And a claim which literally purports to cover a process performed by machinery, is properly construed to cover the machinery itself, and not any process performed thereby.<sup>3</sup>

§ 184. The state of the art, to which an invention belongs, at the time that invention was made, must be considered in construing any claim for that invention,<sup>4</sup> although the art may have been advanced to that stage, by a prior invention of the same inventor.<sup>5</sup> The leading cases on this subject are *McCormick v. Talcott*,<sup>6</sup> and *Railway Co. v. Sayles*,<sup>7</sup> and *Morley Machine Co. v. Lancaster*.<sup>8</sup>

The doctrine of the first of these cases is as follows. The original inventor of a machine, will have a right to treat as infringers all who make machines operating on the same

<sup>1</sup> *Topliff v. Topliff*, 145 U. S. 171, 1892.

<sup>2</sup> *Fuller v. Yentzer*, 94 U. S. 288, 1876; *Parham v. Buttonhole Co.* 4 Fisher, 468, 1871; *Hitchcock v. Tremaine*, 4 Fisher, 508, 1871; *Coes v. Collins Co.* 9 Fed. Rep. 905, 1882; *Henderson v. Stove Co.* 2 Bann. & Ard. 608, 1877; *Palmer v. Gatling Gun Co.* 8 Fed. Rep. 513, 1881. *Columbus Watch Co. v. Robbins*, 64 Fed. Rep. 395, 1894.

<sup>3</sup> *Smith & Egge Mfg. Co. v. Bridgeport Chain Co.* 46 Fed. Rep. 395, 1891.

<sup>4</sup> *Carlton v. Bokee*, 17 Wallace, 463, 1873; *Washing-Machine Co. v. Tool Co.* 20 Wallace, 342, 1873;

*Florsheim v. Schilling*, 137 U. S. 71, 1890; *The Roller Mill Patent*, 156 U. S. 269, 1895; *Dederiek v. Seigmund*, 51 Fed. Rep. 235, 1892; *Brush Electric Co. v. Electric Imp. Co.* 52 Fed. Rep. 972, 1892; *Boston Lasting Mach. Co. v. Woodward*, 53 Fed. Rep. 481, 1893; *Stirrat v. Excelsior Mfg. Co.* 61 Fed. Rep. 981, 1894.

<sup>5</sup> *Celluloid Mfg. Co. v. Cellonite Mfg. Co.* 42 Fed. Rep. 906, 1890.

<sup>6</sup> *McCormick v. Talcott*, 20 Howard, 402, 1857.

<sup>7</sup> *Railway Co. v. Sayles*, 97 U. S. 554, 1878.

<sup>8</sup> *Morley Machine Co. v. Lancaster*, 129 U. S. 273, 1889.



principle, and performing the same functions, by analogous means, or equivalent combinations; even though the infringing machine be an improvement on 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 any other improvement which is not a mere colorable invasion of the first.

The doctrine of the Sayles case is as follows. If one inventor, in a particular art, precedes all the rest, and strikes out something which underlies all that they produce, he subjects them to tribute. But if the advance toward the thing desired is gradual, so that no one can claim the complete whole, then each inventor is entitled to the specific form of device which he produced, 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 doctrine of the Morley case is as follows: Where an invention is primary, any subsequent improvement which employs substantially the same means, to accomplish the same result, is within the scope of a proper patent on the primary invention, although the subsequent contrivance may contain valuable improvements; but secondary patents must be more narrowly construed than primary patents.

The meaning of these three cases seems to be that every inventor is entitled to claim whatever he was the first to invent. If A. B. is the first to invent mechanism to perform a particular work, and if his mechanism is substantially incorporated into subsequent machines which do that work, then A. B. is entitled to such a construction of his patent as will be infringed by those later machines; but if C. D. is a mere improver on A. B.'s machine, C. D. is not entitled to such a construction of his patent, as will cover the machines of still later inventors, who have improved on A. B.'s

machine in a substantially different manner. It follows from these doctrines that C. D.'s patent must be construed in the light of A. B.'s machine, and indeed of every other similar and older structure; which is the same thing as saying that every patent must be construed in the light of the state of the art, at the time the invention it covers was produced.

§ 185. "A patent should be construed in a liberal spirit to sustain the just claims of the inventor. This principle is not to be carried so far as to exclude what is in it, or to interpolate anything which it does not contain. But liberality, rather than strictness, should prevail where the fate of the patent is involved, and the question to be decided is whether the inventor shall hold or lose the fruits of his genius and his labors."<sup>1</sup> "Patents for inventions are to receive a liberal construction, and under the fair application of the rule, *ut res magis valeat quam pereat*, are, if practicable to be so interpreted as to uphold and not to destroy the right of the inventor."<sup>2</sup> "While it is undoubtedly true that a patentee may so restrict his claim as to cover less than what he invented, or may limit it to one particular form of a machine, excluding all other forms, though they also embody his invention, yet such an interpretation should not be put upon his claim if it can fairly be construed otherwise."<sup>3</sup> "In a case of doubt, where the claim is fairly susceptible of two constructions, that one will be adopted, which will preserve to the patentee his actual invention."<sup>4</sup> "The object of the patent law is to secure to inventors, a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation."<sup>5</sup>

<sup>1</sup> Rubber Co. v Goodyear, 9 Wal-  
lace, 788, 1869.

<sup>2</sup> Turrill v. Railroad Co. 1 Wal-  
lace, 491, 1863.

<sup>3</sup> Winans v. Denmead, 15 Howard,

830, 1853.

<sup>4</sup> McClain v. Ortmayer, 141 U. S.  
425, 1891.

<sup>5</sup> Topliff v. Topliff, 145 U. S. 171,  
1892.



These are the declarations of the Supreme Court relevant to the proper liberality to be observed in construing patents. That liberality as often shows itself in a narrow construction as in a broad one; for narrow construction may be as necessary to establish the validity of a patent, as a broad construction is to lay the foundation for proof of its infringement. Therefore when it becomes necessary to construe a claim narrowly, in order that its novelty may not be negatived by the prior art, or its validity otherwise overthrown, courts will give such a narrow construction, if they can do so consistently with the language of the claim and of the description.<sup>1</sup> On the other hand, a claim will not be narrowed by importing into it, by construction, any dispensable element, in order to enable an infringer to escape the consequences of his infringement.<sup>2</sup>

§ 186. "It is well known that the terms of the claim in letters patent are carefully scrutinized in the Patent Office. Over this part of the specification the chief contest generally arises. It defines what the office, after a full examination of previous inventions and the state of the art, determines the applicant is entitled to. The courts therefore, should be careful not to enlarge, by construction, the claim which the Patent Office has admitted, and which the patentee has acquiesced in, beyond the fair interpretation of its terms."<sup>3</sup> "As patents are procured *ex parte*, the public is not bound by them, but the patentees are. And the latter cannot show that their invention is broader than the terms of their claim; or, if broader, they must be held to have surrendered the surplus to the public."<sup>4</sup> "If the language of the specification and claim shows clearly what the patentee desired to secure as a monopoly, nothing can be held

<sup>1</sup> Klein *v.* Russell, 19 Wallace, 433, 1873; Jones *v.* Barker, 11 Fed. Rep. 600, 1882; Stevenson *v.* Marrowan, 31 Fed. Rep. 826, 1887; Consolidated Roller Mill Co. *v.* Coombs, 39 Fed. Rep. 30, 1889; Steam Gauge and Lantern Co. *v.* Williams, 50

Fed. Rep. 931, 1892.

<sup>2</sup> Lamson Cash Reg. Co. *v.* Keplinger, 45 Fed. Rep. 249, 1890.

<sup>3</sup> Burns *v.* Myer, 100 U. S. 672, 1879.

<sup>4</sup> Keystone Bridge Co. *v.* Iron Co. 95 U. S. 278, 1887.

to be an infringement, which does not fall within the terms which the patentee has himself chosen to express his intention."<sup>1</sup>

These are the declarations of the Supreme Court relevant to the proper strictness to be observed in construing patents; and they apply to primary patents as much as to secondary patents.<sup>2</sup> Therefore, when a claim clearly covers a combination of certain elements, it cannot, by construction, be so altered as to cover more elements, so as not to be invalid,<sup>3</sup> or to cover fewer elements, and thus be rendered more likely to be infringed,<sup>4</sup> or to cover other elements in place of some that may be omitted, but which are not equivalents therefor.<sup>5</sup> So also, a claim for a process, substantially as described, cannot be construed to cover an incidental process set forth in the description, but merely recommended there, instead of being required or being stated to be essential to the principal process of the patent.<sup>6</sup>

§ 187. Letters patent may be construed in the light of the contemporaneous intention of the inventor and of the Patent Office; and to this end recourse may be had to the files of the application papers to see what changes were made in the description and claims while the application was pending in the Patent Office.<sup>7</sup> And where such a change was a broadening one, it cannot be construed away in order to

<sup>1</sup> *McClain v. Ortmyer*, 141 U. S. 425, 1891.

<sup>2</sup> *Groth v. Postal Supply Co.* 61 Fed. Rep. 287, 1894.

<sup>3</sup> *Howe Machine Co. v. National Needle Co.* 134 U. S. 394, 1890; *Morgan Envelope Co. v. Albany Paper Co.* 152 U. S. 429, 1894; *Stiles v. Rice*, 29 Fed. Rep. 445, 1887; *Wollensak v. Sargent*, 41 Fed. Rep. 55, 1890; *Westinghouse v. Edison Electric Light Co.* 63 Fed. Rep. 592, 1894.

<sup>4</sup> *Shepard v. Carrigan*, 116 U. S.

597, 1885; *Sutter v. Robinson*, 119 U. S. 541, 1886; *McClain v. Ortmyer*. 141 U. S. 425, 1891.

<sup>5</sup> *Sackett v. Smith*, 42 Fed. Rep. 852, 1890.

<sup>6</sup> *Sewell v. Jones*, 91 U. S. 185, 1875; *Holliday v. Pickhardt*, 29 Fed. Rep. 858, 1887.

<sup>7</sup> *Crawford v. Heisinger*, 123 U. S. 602, 1887; *Trader v. Messmore*, 1 Bann. & Ard. 639, 1875; *Bate Refrigerating Co. v. Eastman*, 24 Fed. Rep. 649, 1885; *Williams v. Rubber Shoe Co.* 49 Fed. Rep. 251, 1892.



ascribe validity to the patent.<sup>1</sup> But no subsequent application by the same inventor for another patent is admissible in this behalf;<sup>2</sup> except where the patent contains a disclaimer of matter said therein to be claimed in another patent or application of the same inventor, in which case that other patent or application is admissible to aid in ascertaining the scope of the disclaimer.<sup>3</sup>

§ 187*a*. Where an applicant, on the rejection of his application, inserted in consequence of that rejection, limitations and restrictions into his specification, for the purpose of obtaining his patent, he cannot, after he has obtained it, claim that it shall be construed as it would have been if such limitations and restrictions were not contained in it.<sup>4</sup> And where an applicant materially modified a claim, in obedience to a requirement of the Patent Office, it will not be construed as it would have been if it had not been modified.<sup>5</sup> Neither can a patentee who cancelled a claim in his application, after it was rejected by the Patent Office for want of invention or for want of novelty, afterwards successfully contend that some other claim of his patent shall be construed to be co-extensive with the one rejected.<sup>6</sup> Nor can a disclaimer, which was inserted by an applicant in his application in pursuance of a requirement of the Patent Office, be eliminated from his patent by construction.<sup>7</sup> And where an applicant cancelled a portion of his application, in pursuance of a decision in the Patent Office that it could not be covered by one application with the other portions

<sup>1</sup> *Morgan Envelope Co. v. Albany Paper Co.* 152 U. S. 429, 1894; *Johnson v. Olsen*, 61 Fed. Rep. 833, 1894.

<sup>2</sup> *Edison Electric Light Co. v. U. S. Electric Lighting Co.* 47 Fed. Rep. 462, 1891.

<sup>3</sup> *National Typographic Co. v. New York Typograph Co.* 46 Fed. Rep. 115, 1891.

<sup>4</sup> *Roemer v. Peddie*, 132 U. S. 317, 1889.

<sup>5</sup> *Phoenix Caster Co. v. Splegel*,

133 U. S. 368, 1890; *Williams v. Rubber Shoe Co.* 49 Fed. Rep. 251, 1892.

<sup>6</sup> *Royer v. Coupe*, 146 U. S. 532, 1892; *Corbin Cabinet Lock Co. v. Eagle Lock Co.* 150 U. S. 40, 1893; *Douglas v. Abraham*, 50 Fed. Rep. 422, 1892; *J. L. Mott Iron Works v. Standard Mfg. Co.* 53 Fed. Rep. 821, 1893.

<sup>7</sup> *Stahl v. Williams*, 52 Fed. Rep. 651, 1892.

thereof, a patent granted upon the application thus reduced, cannot be construed to be co-extensive with what it would have been but for such cancellation.<sup>1</sup> And these rules apply even where the action of the Patent Office was erroneous, or that of the applicant unnecessary.<sup>2</sup>

But merely incidental amendments, which are not made in pursuance of any references or real reasons given by the Patent Office, but are made in deference to Patent Office preferences for particular phraseology, will not be construed to limit claims so as to make them narrower than the inventions they were designed to cover.<sup>3</sup> And no amendment made to meet an objection of the Patent Office will be construed to disclaim the patentee's actual invention, if that construction can be avoided without doing violence to the obvious meaning of the language.<sup>4</sup>

§ 188. The laws which were in force when any particular patent was granted, are the laws according to which it must be construed;<sup>5</sup> and a special statute relevant to any particular patent is ingrafted on the general patent statutes, and must be construed harmoniously with them.<sup>6</sup>

§ 189. Questions of construction are questions of law for the judge, not questions of fact for the jury.<sup>7</sup> As it cannot be expected, however, that judges will always possess the requisite knowledge of the meaning of the terms of art or science used in letters patent, it often becomes necessary that they should avail themselves of the light furnished by experts relevant to the significance of such words and phrases.<sup>8</sup> The judges are not, however, obliged to blindly follow such testimony. They may disregard it if it appears

<sup>1</sup> *Macbeth v. Gillinder*, 54 Fed. Rep. 170, 1889.

<sup>2</sup> *Lapham Dodge Co. v. Severin*, 40 Fed. Rep. 763, 1889; *Shaw Stocking Co. v. Pearson*, 48 Fed. Rep. 236, 1891.

<sup>3</sup> *Rhodes v. Lincoln Press Drill Co.* 64 Fed. Rep. 220, 1894.

<sup>4</sup> *Westinghouse v. Brake Co.* 66 Fed. Rep. 1006, 1895.

<sup>5</sup> *McClurg v. Kingsland*, 1 Howard, 202, 1843.

<sup>6</sup> *Evans v. Eaton*, 3 Wheaton, 454, 1818; *Bloomer v. McQuewan*, 14 Howard, 539, 1852.

<sup>7</sup> *Winans v. Denmead*, 15 Howard, 330, 1853; *Coupe v. Royer*, 155 U. S. 565, 1894.

<sup>8</sup> *Loom Co. v. Higgins*, 105 U. S. 580, 1881.



to them to be unreasonable.<sup>1</sup> While the testimony of experts relevant to the meaning of particular words or phrases in letters patent is to this extent admissible, such testimony is wholly inadmissible relevant to the construction of the letters patent as a whole.<sup>2</sup>

§ 190. In the absence of contrary evidence, the invention covered by a particular letters patent is presumed to be identical with that covered by the application on which those letters patent were granted.<sup>3</sup>

§ 191. All persons are bound to take notice of the contents of all letters patent of the United States, because those letters patent are matters of public record.<sup>4</sup>

<sup>1</sup> *Winans v. Railroad Co.* 21 Howard, 88, 1858.

<sup>2</sup> *Corning v. Burden*, 15 Howard, 252, 1853.

<sup>3</sup> *Loom Co. v. Higgins*, 105 U. S. 580, 1881.

<sup>4</sup> *Boyden v. Burke*, 14 Howard, 575, 1852.

## CHAPTER VIII.

### DISCLAIMERS.

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| 192. Statutory authorization of disclaimers.           | tion   |
| 193. Statutory prescriptions, relevant to disclaimers. | 203. Effect of unreasonable delay to file a disclaimer.      |
| 194. Errors which justify disclaimers.                 | 204. Beginning of unreasonable delay to file a disclaimer.   |
| 195. Mistakes of fact, relevant to novelty.            | 205. Costs, where a necessary disclaimer has not been filed. |
| 196. Mistakes of law, relevant to invention.           | 206. Extent of disclaimant's interest.                       |
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§ 192. THE statutory provisions relevant to disclaimers originated in 1837, and have never been substantially changed. Sections 7 and 9 of the Patent Act of that year,<sup>1</sup> embodied those provisions; and those sections continued in force till July 8, 1870, when they were substantially re-enacted as Sections 54 and 60 of the Consolidated Patent Act of that date.<sup>2</sup> In 1874, the latter sections were, in their turn, re-enacted, without any material change, as Sections 4917 and 4922 of the Revised Statutes. It would have been better statute writing, if those two sections had always been blended together into one clear and comprehensive paragraph. Referring to the same subject, and standing, as they always have, in the same statute, they must undoubtedly

<sup>1</sup> 5 Statutes at Large, Ch. 45, Sections 7 and 9, p. 193.

<sup>2</sup> 16 Statutes at Large, Ch. 230,

Sections 54 and 60, p. 206; *Taylor v. Archer*, 8 Blatch, 318, 1871.



be construed together;<sup>1</sup> and the law they embody, must be set forth, by extracting from both sections, all the material meaning of both, and by incorporating that meaning, together with the case law of the subject, into one systematic explanation. Let that therefore be the present attempt.

§ 193. Whenever through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has, in his specification, claimed materially more than that of which he was the first inventor, his patent shall be valid for whatever is justly his own; and every such patentee, his executors, administrators, or assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of such part, if it is a material and substantial part of the thing patented, and is definitely distinguishable from the parts claimed without right. But in every such case, in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered, unless the proper disclaimer was entered in the Patent Office, before the commencement of the suit. But no patentee shall be entitled to maintain any such suit, if he has unreasonably neglected or delayed to enter a disclaimer. And any such patentee, his heirs or assigns, whether of the whole or of any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the subject-matter of the patent, as he shall not choose to longer claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office, and shall thereafter be considered a part of the original specification, to the extent of the interest possessed by the disclaimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may

<sup>1</sup> *Halles v. Stove Co.* 123 U. S. 145 U. S. 41, 1892.  
588, 1887; *Sessions v. Romadka*,

relate to the question of unreasonable neglect or delay in filing it.<sup>1</sup>

§ 194. The primary fact which brings the law stated in the last section into play, is the claiming by a patentee of materially more in his patent than he was entitled to claim.<sup>2</sup> Such errors may spring from inadvertence. That is to say, they may spring from failure, on the part of the writer of the claims, to exercise proper care in penning them. So also, they may arise from accident: from chances against which even diligent care cannot always guard. But mistake is the most common source of such errors; and such errors may arise from mistake of fact or from mistake of law.<sup>3</sup>

§ 195. Mistakes of fact, relative to how much of a described process, machine or manufacture was first invented by its patentee, frequently follow from lack of full information touching what was previously invented by others in the same department of the useful arts. Litigation may alone disclose the fact that the patentee's claims are too numerous or too broad to be consistent with novelty. Whenever this occurs, it is clear that the patentee ought no longer to appear to hold an exclusive right to anything which he was not the first to invent. To this end, the statute provides that he must disclaim that part, within a reasonable time, or, in default thereof, must suffer the statutory consequences. On the other hand it is equally clear, that if the patentee is willing to eliminate from his claims, everything which later information shows had been invented before him, he ought to be allowed to retain his exclusive right to the residue. To this end, the statute provides, that if within a reasonable time, he disclaims what was another's, he shall be enabled to enforce his patent as far as it covers what was his own invention. But a disclaimer cannot confine

<sup>1</sup> Revised Statutes, Sections 4917 and 4922 blended together. Rep. 835, 1889.

<sup>2</sup> *Hailes v. Stove Co.* 123 U. S. 588, 1887; *Brush Electric Co. v. Ft. Wayne Electric Light Co.* 40 Fed. Rep. 134, 1889. <sup>3</sup> *Electrical Accumulator Co. v. Julien Electric Co.* 38 Fed. Rep.



a claim to ground which does not appear in the patent to constitute an invention; even where that ground is narrower than that which was originally claimed in the patent.

§ 196. A mistake of law, which consists in claiming something not patentable, may also be remedied by disclaimer.<sup>1</sup> The law which requires and permits a patentee to disclaim, is not penal but remedial. It is intended for the protection of the patentee, as well as for the protection of the public. The evil to be remedied is the same, where a patentee has claimed more than he ought, whether that result sprang from the fact that another invented it before him, or sprang from the fact that what he produced was not an invention at all. For this reason, the Supreme Court held that the eighth claim of Morse might be disclaimed, after having been held void for want of patentability, with the same effect as though it had been held void for want of novelty. The same reason would also permit a patentee to disclaim any claim which is void for want of invention. Indeed the statute expressly applies to such a case, for no man can be the first inventor of anything which is not an invention. He may be its first discoverer, if it is a law of nature, or its first constructor, if it is a product of mere mechanical skill, but its first inventor he cannot be. And a mistake of law, which consisted in unlawfully claiming, in one patent, several independent inventions, may be remedied by disclaiming enough claims to give to the patent the necessary unity.<sup>2</sup>

§ 197. There appears to be no warrant in the statute, for disclaiming any claim which is void for want of utility, and for no other cause. An inventor of a new thing may generally ascertain its character in point of utility before applying for a patent. If he can do so, he ought to do so, and thus shield the public from a waste of time involved in examining and judging useless contrivances. Where a patent has but one claim, and where the matter covered by

<sup>1</sup> O'Reilly v. Morse, 15 Howard, 120, 1853.

<sup>2</sup> Sessions v. Romadka, 145 U. S. 40, 1892.

that claim is useless, no disclaimer could make that patent valid. Where a part only of the claims of a patent are void for want of utility, and for no other cause, the void claims are not injurious to the valid ones, and therefore no disclaimer is needed in any such case. Where a claim purports to cover a thing constructed in either of several ways, and where that thing is useless if constructed in one of those ways, and useful if constructed in another, the claim cannot be limited to the useful construction, by means of any disclaimer; for it is not the office of a disclaimer to reform or to alter the description or claim of an invention.<sup>1</sup> Its function is to eliminate from letters patent all claims for inventions which were not new with the patentee, and all claims for things which were not inventions with him.<sup>2</sup> And no disclaimer is necessary where some, but not all, of the claims of a patent are void, by reason of constructive abandonment, resulting from public use or sale of the subjects of those particular claims, more than two years prior to the application for the patent.<sup>3</sup>

Where two patents are applied for on the same day, and are granted on the same day, to the same inventor, for the same invention; the owner of them has the lawful power to choose which one of those patents he will retain, but he must somehow relinquish the other.<sup>4</sup> He cannot rid himself of his superfluous patent, in such a case, by means of a disclaimer under the disclaimer statutes; but he can undoubtedly do so by means of a surrender of his superfluous patent uncoupled with any application for a reissue thereof.

§ 198. The right to file disclaimers is expressly limited to cases where the actual invention of the patentee is a material and substantial part of the thing patented.<sup>5</sup> Parts of

<sup>1</sup> *Hailes v. Stove Co.* 123 U. S. Fed. Rep. 72, 1892.

587, 1887; *White v. Mfg. Co.* 24 Off. Gaz. 205, 1883.

<sup>2</sup> *Cartridge Co. v. Cartridge Co.* 112 U. S. 642, 1884.

<sup>3</sup> *Whitney v. B. & A. R. Co.* 50

<sup>4</sup> *Electrical Accumulator Co. v. Brush Electric Co.* 52 Fed. Rep. 138, 1892.

<sup>5</sup> Revised Statutes, Sections 4917 and 4922.



combinations do not come within this category, for a combination is an entirety; and if one of the elements is given up, the thing claimed disappears. The disclaimer provisions cannot be made to modify and thereby save combination claims, for unless the combination is maintained, the whole of the invention fails.<sup>1</sup>

§ 199. The statutes also provide, that in order to save a patent by a disclaimer, the part retained must be definitely distinguishable from the part eliminated. It does not follow, however, that each claim of a patent must be wholly disclaimed or wholly retained. On the contrary, there are cases where two or more inventions are covered by one claim; and in such cases, a disclaimer may be made to expunge one of those inventions from that claim, without disturbing the others.<sup>2</sup>

In the first of the cases just cited, the claim was: "The forming of packing for pistons or stuffing boxes of steam engines, and for like purposes, out of saturated canvas, so cut that the thread or warp shall run in a diagonal direction from the line or centre of the roll of packing, and rolled into form, either in connection with the india-rubber core, or other elastic material, or without, as herein set forth." Litigation showed that such a thing, without a core, was old, and the patentee therefore entered a disclaimer to that part of the claim which covered the packing without the core. Justice BLATCHFORD held that disclaimer to be proper, and to be effectual.

In the second case cited, the claim was "The use and application of glue, or glue composition, in the tubing, substantially as described, for the purpose of making the flexible tubing gas tight, whether of cloth or rubber or other gum." During the pendency of the suit, and after considerable testimony had been taken, a disclaimer was entered to

<sup>1</sup> *Vance v. Campbell*, 1 Black, 429, 1861.

<sup>2</sup> *Tuck v. Bramhill*, 6 Blatch. 95, 1868; *Taylor v. Archer*, 8 Blatch.

318, 1871; *Electrical Accumulator Co. v. Julien Electric Co.* 38 Fed. Rep. 134, 1389.

that part of the claim of the patent which claimed as an improvement in flexible tubing for illuminating gas, the use and application of glue; thereby limiting the claim to the use and application of glue composition in the tubing, substantially as described. This disclaimer was also upheld by the same distinguished chancellor who upheld the disclaimer in the other case.

§ 200. There is one difference between the two disclaimer sections, of the Revised Statutes, which it is now requisite to mention. Section 4917 contemplates disclaimers as being proper whenever a patentee has claimed more than that of which he was the first inventor; while Section 4922 attends only to cases wherein the excess is a material or substantial part of the thing patented. This qualification should be inserted in the two sections, as construed together, because Section 4922 is the only one that prescribes any evil result from a failure to disclaim. Neither section visits any infliction on the patentee, for omitting to disclaim anything which is an immaterial part of the thing patented. If, therefore, a patentee omits to disclaim such a part when he discovers it to have been known before his invention thereof, or learns that it is not an invention at all, he thereby loses no right, and incurs no inconvenience.<sup>1</sup> To file a disclaimer, in such a case, is an act which is at once harmless and unnecessary.

§ 201. Reissue patents, as well as original patents, are entitled to the benefits of the law relevant to disclaimers; and that too, even where the matter disclaimed was not claimed in the original, but only in a reissue granted upon its surrender.<sup>2</sup> But no claim which was in an original patent, and is absent from a reissue thereof, can be reclaimed by a disclaimer of the changes made by the

<sup>1</sup> Hall v. Wiles, 2 Blatch. 199, 1851; Peek v. Frame, 5 Fisher, 212, 1871.

<sup>2</sup> O'Reilly v. Morse, 15 Howard, 62, 1853; Gage v. Herring, 107 U. S. 646, 1882; Yale Lock Co. v. Sar-

gent, 117 U. S. 553, 1886; Schilinger v. Gunther, 17 Blatch. 69, 1879; Tyler v. Galloway, 12 Fed. Rep. 567, 1882.



reissue.<sup>1</sup> Where an original patent was surrendered, and then reissued in several divisions; that is to say, where several reissue patents were granted for separate inventions described in an original patent, a suit based upon one of those divisions will be unaffected by the fact that a claim in another division, is invalid for want of novelty, or for want of invention. The statute relevant to disclaimers has no application to such cases.<sup>2</sup>

§ 202. Fraudulent or deceptive intention, if it existed on 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. The 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. 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.<sup>3</sup> If, however, there is reasonable ground for difference

<sup>1</sup> *McMurray v. Mallory*, 111 U. S. 109, 1883.

<sup>2</sup> *Elastic Fabrics Co. v. Smith*, 100 U. S. 111, 1879.

<sup>3</sup> *O'Reilly v. Morse*, 15 Howard, 121, 1853; *Singer v. Walmsley*, 1 Fisher, 558, 1860; *Parker v. Stiles*, 5 McLean, 44, 1849.

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.<sup>1</sup> Even a still further very short delay is not fatal to the right to disclaim;<sup>2</sup> and if the patent has expired when the occasion for a disclaimer is established, no disclaimer can be filed or is necessary.<sup>3</sup> 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 from the court.<sup>4</sup> In the case of *Seymour v. McCormick*,<sup>5</sup> 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,<sup>6</sup> 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

<sup>1</sup> *Seymour v. McCormick*, 19 Howard, 106, 1856; *Potter v. Whitney*, 1 Lowell, 87, 1866; *Hill v. Biddle*, 27 Fed. Rep. 561, 1886.

<sup>2</sup> *Kittle v. Hall*, 30 Fed. Rep. 39, 1887.

<sup>3</sup> *Yale Lock Co. v. Sargent*, 117 U. S. 553, 1885.

<sup>4</sup> *Brooks v. Jenkins*, 3 McLean, 449, 1844; *Washburn v. Gould*, 3

*Story*, 122, 1844; *Burden v. Corning*, 2 Fisher, 477, 1864; *Office Specialty Co. v. Globe Co.* 65 Fed. Rep. 605, 1895.

<sup>5</sup> *Seymour v. McCormick*, 19 Howard, 106, 1856.

<sup>6</sup> *Singer v. Walmsley*, 1 Fisher, 558, 1860; *Parker v. Stiles*, 5 McLean, 44, 1849.



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.<sup>1</sup> This rule applies even to cases where the delay to enter the disclaimer was not unreasonable.<sup>2</sup> 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.<sup>3</sup>

Judge LOWELL remarked 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, and thus to escape costs.<sup>4</sup> His Honor based this opinion on the fact that more expense might be incurred in 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.

<sup>1</sup> 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.

<sup>2</sup> O'Reilly v. Morse, 15 Howard,

121, 1853; Yale Lock Co. v. Sargent, 117 U. S. 553, 1885.

<sup>3</sup> Peek v. Frame, 5 Fisher, 212, 1871.

<sup>4</sup> American Bell Telephone Co. v. Spencer, 8 Fed. Rep. 512, 1881.

§ 206. Disclaimers are required to state the extent of the interest which is held by the disclaimant in the patent involved.<sup>1</sup> 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.<sup>2</sup> 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.<sup>3</sup> But if only one 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.<sup>4</sup>

§ 207. The construction of a patent after a disclaimer has been properly entered, must be the same that it would have been if the matter so disclaimed had never been claimed.<sup>5</sup> 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.<sup>6</sup>

§ 208. Disclaimers may be filed pending a suit on the patent,<sup>7</sup> but in that event the plaintiff, even if he prevails in the suit, can recover no costs.<sup>8</sup> 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

<sup>1</sup> Revised Statutes, Section 4917.

<sup>2</sup> *Silby v. Foote*, 14 Howard, 221, 1852.

<sup>3</sup> *Brooks v. Jenkins*, 3 McLean, 432, 1844.

<sup>4</sup> *Wyeth v. Stone*, 1 Story, 294, 1840.

<sup>5</sup> *Dunbar v. Myers*, 94 U. S. 187,

1876; *Schwarzwalder v. Filter Co.* 66 Fed. Rep. 157, 1895.

<sup>6</sup> *Schillinger v. Gunther*, 17 Blatch. 69, 1879.

<sup>7</sup> *Filley v. Stove Co.* 30 Fed. Rep. 434, 1887.

<sup>8</sup> *Smith v. Nichols*, 21 Wallace, 117, 1874.



not there was unreasonable delay before filing it.<sup>1</sup> 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.<sup>2</sup> The sooner a necessary disclaimer is filed, the less danger exists that the precoding 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 refuse an injunction, and grant a decree for an account? The second of these courses has been the practice followed by Justice BLATCHFORD;<sup>3</sup> and by Judge WALLACE;<sup>4</sup> Judge SHIPMAN<sup>5</sup> and Judge WHEELER,<sup>6</sup> and also by Justice MATTHEWS and

<sup>1</sup> Revised Statutes, Section 4917; *Sessions v. Romadka*, 145 U. S. 41, 1892; *Tuck v. Bramhill*, 6 Blatch. 95, 1868.

<sup>2</sup> *Reed v. Cutter*, 1 Story, 590, 1841.

<sup>3</sup> *Myers v. Frame*, 8 Blatch. 446, 1871; *Burdett v. Estey*, 15 Blatch. 349, 1878; *Christman v. Rumsey*, 17 Blatch. 148, 1879.

<sup>4</sup> *Brainard v. Cramme*, 12 Fed.

Rep. 621, 1882; *Union Paper Bag Mach. Co. v. Waterbury*, 39 Fed. Rep. 392, 1889; *Steam Gauge & Lantern Co. v. Kennedy*, 41 Fed. Rep. 39, 1889; *Smead v. School District*, 44 Fed. Rep. 617, 1890.

<sup>5</sup> *Tyler v. Galloway*, 12 Fed. Rep. 567, 1882.

<sup>6</sup> *Matthews v. Spangenberg*, 14 Fed. Rep. 350, 1882; *Hake v. Brown*, 37 Fed. Rep. 788, 1889.

Judge SAGE.<sup>1</sup> But Judge COXE said, in 1891,<sup>2</sup> that this practice had always seemed to him to be an arbitrary one ; and in 1893 he spoke of it as "the arbitrary and, to my mind, unjust rule which obtains in this circuit."<sup>3</sup> And in speaking of the case in which Judge COXE used the language just quoted, Judge DALLAS said in 1894, "That decree, however, was in fact entered without disclaimer being made, and doubtless for the reason that the learned judge had observed, after his opinion had been delivered, that, while the statute deprives the plaintiff of costs, in such cases, it does not authorize the requirement of the disclaimer of unfounded claims, as a condition of granting relief upon those which are supported."<sup>4</sup> The third course was that adopted by Judge CADWALLADER.<sup>5</sup> The point has never been decided by the Supreme Court; though the action of that tribunal, in *O'Reilly v. Morse*,<sup>6</sup> appears to favor the first of the four suggested views. The subject is interesting, and when the law relevant thereto is finally settled, a number of considerations will require to be weighed.

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

<sup>1</sup> *Odell v. Stout*, 22 Fed Rep. 169, 1884.

<sup>2</sup> *Brush Electric Co. v. Accumulator Co.* 47 Fed. Rep. 56, 1891.

<sup>3</sup> *Ballard v. McCluskey*, 58 Fed. Rep. 884, 1893.

<sup>4</sup> *Williames v. McNeely*, 64 Fed. Rep. 768, 1894.

<sup>5</sup> *Aiken v. Dolan*, 3 Fisher, 207, 1867.

<sup>6</sup> *O'Reilly v. Morse*, 15 Howard, 121, 1853.



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 sometimes wanting.

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 an appellate 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 appellate 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 appellate 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.<sup>1</sup>

<sup>1</sup> Revised Statutes, Section 699.

## CHAPTER IX.

### REISSUES.

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| 210. Beginning of the history of reissues.  | templated by the doctrine of <i>Miller v. Brass Co.</i>   |
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| 250. Executors, administrators, and assigns may procure reissues.<br>251. One of several executors may procure a reissue.<br>252. Rights of assignees in reissues. | 253. The rights of grantees in reissues.<br>254. The legal effect of reissued patents. |
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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*<sup>1</sup> 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. 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

<sup>1</sup> *Grant v. Raymond*, 6 Peters, 243, 1832.

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."

In pursuance of the doctrines of the first four sentences quoted above from Chief Justice MARSHALL, the Commissioner may cancel a patent and issue a corrected one in its stead, where the first one was caused, by an inadvertent error in the Patent Office, to grant less to the inventor than he had applied for and was entitled to receive, and where the inventor refuses to accept the patent thus limited.<sup>1</sup>

§ 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.<sup>2</sup> 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

<sup>1</sup> *Railway Register Mfg. Co. v. Railroad Co.* 23 Fed. Rep. 593, 1885.

<sup>2</sup> 4 Statutes at Large, Ch. 162. Section 3, p. 559.



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

§ 212. The Patent Act of 1836<sup>1</sup> 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 1837<sup>2</sup> 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 pat-

<sup>1</sup> 5 Statutes at Large, Ch. 857, p. 117.

<sup>2</sup> 5 Statutes at Large, Ch. 45, p. 191.

ents; and that the Commissioner should not grant any re-issue, 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 by way of appeal, that the law provided in cases of original applications.

§ 214. The Patent Act of 1870<sup>1</sup> 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.<sup>2</sup> 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<sup>3</sup> prescribed, that the provision of Section 33, just mentioned should not be construed to apply to any patent, is-

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

<sup>2</sup> 16 Statutes at Large, Ch. 182, p.

<sup>3</sup> 16 Statutes at Large, Ch. 230, 588.



sued 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 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."<sup>1</sup>

§ 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.<sup>2</sup> All patents that are invalid, are also inoperative. If the two words had,

<sup>1</sup> 16 Statutes at Large, Ch. 132, Section 53, p. 206.

<sup>2</sup> Act of 1832, Section 3; Act of

1836, Section 13; Act of 1870, Section 53; Revised Statutes, Section 4916.

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 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.<sup>1</sup> Ever since 1837, therefore, faults in patents, arising from patentees claiming more than they had a right to claim, have generally been curable by disclaimers.

§ 216*a*. But in some cases, the matter in a patent which the patentee had no right to claim as new, is so blended with the other matter in the patent, that it cannot be simply cut away by a disclaimer, and can best be removed by re-writing part or all of the specification. In such cases the remedy by reissue is undoubtedly lawful, and can probably be invoked regardless of any supposed intervening rights of others, for others can hardly have a right to object to a patentee reducing the area of his patented claims. But the remedy by disclaimer in such cases cannot be invoked after an unreasonable delay to invoke it; and it is probable that the remedy by reissue in such cases is subject to a similar limitation; but such delay will not be held to begin till the patentee is informed of the facts which make a narrower claim necessary.<sup>2</sup> The remedy by disclaimer, where it can

<sup>1</sup> 5 Statutes at Large, Ch. 45, Sections 7 and 9, p. 193.

Rep. 834, 1885; *Electrical Accumulator Co. v. New York & Harlem R.*

<sup>2</sup> *Matthews v. Flower*, 25 Fed.

R. Co. 57 Fed. Rep. 82, 1892.



be applied, is better than the other, because the remedy by reissue involves the loss of the rights of action under the patent for infringements committed before the reissue is granted.

§ 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.<sup>1</sup> 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."<sup>2</sup> 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 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

<sup>1</sup> *Wilson v. Coon*, 18 Blatch. 535, 1880.

<sup>2</sup> *Wilson v. Coon*, 18 Blatch. 536, 1880.

all cases.<sup>1</sup> Assuming it to be satisfied in all, and passing the provisions relevant to reissues when the patentee has claimed too much, it appears that the remaining 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.

§ 218*a*. Invalidity arising from defective description, or from insufficient description, or from defective claims, where that invalidity arose by inadvertence, accident or mistake, and without any fraudulent or deceptive intention, may undoubtedly be remedied by a reissue, where the reissue does not add nor broaden any claim. No reissue of this class has ever been held to be void, as a reissue, in any adjudicated case. Such reissues are indeed particularly consistent with the policy of the patent law, because they improve the information of an invention, which the public can derive from a patent, and thus increase the benefit which the public will enjoy on account of the patent after it shall have expired. There appears to be no reason why the remedy of reissue may not be invoked, in a case of this class, at any time during the life of a patent, and no reason why any other than the patentee can have any intervening right accrue after the date of the original, and before the date of the reissue, which can render the reissue invalid.<sup>2</sup>

§ 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

<sup>1</sup> *Coon v. Wilson*, 113 U. S. 277, 1884; *Parker & Whipple Co. v. Yale Clock Co.* 123 U. S. 103, 1887.

<sup>2</sup> *Sewing Machine Co. v. Frame*, 24 Fed. Rep. 596, 1884.



foundation of a right to a reissue.<sup>1</sup> And where an inventor claims his invention only in combination with something else, his patent is inoperative as to that invention alone.<sup>2</sup> Reissues granted in these classes of 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;<sup>3</sup> and have been upheld by the Supreme Court in many cases;<sup>4</sup> and have been expressly approved by that tribunal.<sup>5</sup>

§ 220. Inadvertence, accident or mistake, must have been the source of the fault in letters patent, in order to make them reissuable.<sup>6</sup> Such inadvertence or accident may have been suffered, or such mistake may have been committed, by the patentee or by the Commissioner of Patents.<sup>7</sup> The statute is satisfied on this point, where the patent was inoperative by 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,<sup>8</sup> or because the patentee or his solicitor, when concerting the claims, inadvertently failed to make them as extensive as the invention.<sup>9</sup> 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,<sup>10</sup> or

<sup>1</sup> *Thompson v. Wooster*, 11½ U. S. 115, 1884; *Anilin v. Higgin*, 15 Blatch. 291, 1878; *Wilson v. Coon*, 18 Blatch. 535, 1880; *Giant Powder Co. v. Nitro Powder Co.* 19 Fed. Rep. 510, 1884.

<sup>2</sup> *Jenkins v. Stetson*, 32 Fed. Rep. 400, 1887.

<sup>3</sup> *Miller v. Brass Co.* 104 U. S. 354, 1881.

<sup>4</sup> *Battin v. Taggert*, 17 Howard, 74, 1854; *Morey v. Lockwood*, 8 Wallace, 230, 1868; *Rubber Co. v. Good-year*, 9 Wallace, 788, 1869; *Corn-*

*Planter Patent*, 23 Wallace 217, 1874; *Marsh v. Seymour*, 97 U. S. 356, 1877.

<sup>5</sup> *Topliff v. Topliff*, 145 U. S. 170, 1892.

<sup>6</sup> Revised Statutes, Section 4916.

<sup>7</sup> *Grant v. Raymond*, 6 Peters, 218, 1832.

<sup>8</sup> *National Spring Co. v. Mfg. Co.* 12 Blatch. 89, 1874.

<sup>9</sup> *Miller v. Brass Co.* 104 U. S. 352, 1881.

<sup>10</sup> *Morey v. Lockwood*, 8 Wallace, 230, 1868.

because of an erroneous decision made by him in an interference proceeding.<sup>1</sup> But the statute is not satisfied where the applicant or his attorney cancels a rejected claim and afterward seeks to reclaim it by a reissue;<sup>2</sup> even where the rejected claim was cancelled from a prior application of the same inventor, and not from the particular application for the original of the reissue.<sup>3</sup> Nor is the statute satisfied in any case where the new claims of the reissue were intentionally omitted from the original patent.<sup>4</sup>

§ 221. The Supreme Court has recognized the fact that patents have been reissued by the Commissioner of Patents in some cases where there was no statutory ground therefor; 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 the decision of the Commissioner, that the existence of the statutory ground for a reissue exists when he grants a reissue, is conclusive; or is a subject of review and possible reversal in a suit for infringement of a reissue. This question arose in the great case of *O'Reilly v. Morse*,<sup>5</sup> where the defendant contended that Morse's reissue patent was void, because his surrendered patent was neither inoperative nor invalid. The Supreme Court decided that the reissue patent was not void, but the court did not explain whether it agreed in opinion with the Commissioner touching the invalidity or inoperativeness of the surrendered patent, or found itself without power to review his decision on that point. It was a misfortune that the court did not decide the question of the power of courts in

<sup>1</sup> *American Shoe-tip Co. v. Protector Co.* 2 Bann. & Ard. 551, 1877.

<sup>2</sup> *Union Paper Bag Mach. Co. v. Waterbury*, 39 Fed. Rep. 392, 1889.

<sup>3</sup> *Yale Lock Co. v. Berkshire*

*Bank*, 135 U. S. 379, 1890.

<sup>4</sup> *Dobson v. Lees*, 137 U. S. 265, 1890.

<sup>5</sup> *O'Reilly v. Morse*, 15 How. 62, 1853.



such cases; for such a decision would have established the law upon the subject, from and after about the middle of the nineteenth century, and would have obviated the numerous controversies which have ranged through the courts upon the point since that time, and the numerous contradictory and inharmonious *obiter dicta* which the Supreme Court and many of the Circuit Courts have since promulgated about the matter, without plainly and authoritatively deciding the question.

In former editions of this book, the then existing deliverances of the courts upon this subject, were marshaled and explained on the sides of the question which they respectively support; because in the years of those editions, the question was one of much practical importance. But the decision of the Supreme Court in *Miller v. Brass Co.*, which was made early in 1882, on another part of the law of reissues, operated so strongly to discourage patentees from surrendering their original patents and applying for reissues thereof, that only fifteen hundred reissues have been granted during the thirteen years and a half which have passed since then; though nearly three hundred thousand original patents have been issued during that time. And the comparatively few reissues which have not now expired, were granted with more circumspection than was formerly exercised in the Patent Office, in such cases; so that the question whether the courts have any authority to review the decision of the Commissioner of Patents, that some statutory ground exists therefor, when he grants a reissue, is a question of much diminished import. If any lawyers have occasion to argue, or any judges have occasion to decide that question hereafter, they can consult the principal cases which support the negative,<sup>1</sup> and the

<sup>1</sup> *Philadelphia and Trenton Railroad Co. v. Stimpson*, 14 Peters, 448, 1840; *Stimpson v. Railroad Co.* 4 Howard, 404, 1846; *Seymour v. Osborne*, 11 Wallace, 516, 1870; *Collar Co. v. Van Dusen*, 23 Wallace, 558, 1874; *Ball v. Langles*, 102 U. S. 129, 1880; *Topliff v. Topliff*, 145 U. S. 171,

1892; *Smith v. Merriam*, 6 Fed. Rep. 713, 1881; *Selden v. Gas Burner Co.* 9 Fed. Rep. 390, 1881; *Peoria Target Co. v. Cleveland Target Co.* 58 Fed. Rep. 239, 1893; *Beach v. American Box Machine Co.* 63 Fed. Rep. 603, 1894.

principal cases which support the affirmative of the issue.<sup>1</sup>

§ 226. *Miller v. Brass Co.*,<sup>2</sup> 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 lapse of some 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.<sup>3</sup> 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 begin when the fault of the original patent is discovered. This difference is a substantial one; because reissuable faults in

<sup>1</sup> *Burr v. Duryee*, 1 Wallace, 571, 1863; *Rubber Co. v. Goodyear*, 9 Wallace, 795, 1869; *James v. Campbell*, 104 U. S. 371, 1881; *Mahn v. Harwood*, 112 U. S. 359, 1884; *Coon v. Wilson*, 113 U. S. 277, 1884; *Yale Lock Co. v. Berkshire Bank*, 135 U. S. 378, 1890; *Dobson v. Lees*, 137 U. S. 265, 1890; *Electric Gas Co. v. Boston Electric Co.* 139 U. S. 502, 1891; *Huber v. Nelson Mfg. Co.* 148 U. S. 290, 1893; *Olin v. Timken*, 155 U. S. 148, 1894; *Eby*

*v. King*, 158 U. S. 371, 1895; *Whitely v. Swayne*, 4 Fisher, 123, 1865; *Wicks v. Stevens*, 2 Bann. & Ard. 318, 1876; *Odell v. Stout*, 22 Fed. Rep. 161, 1885, *Peoria Target Co. v. Cleveland Target Co.* 47 Fed. Rep. 737, 1891; *Featherstone v. Cycle Co.* 57 Fed. Rep. 635, 1893.

<sup>2</sup> *Miller v. Brass Co.* 104 U. S. 350, 1881.

<sup>3</sup> *Knight v. Railroad Co.*, Taney's Circuit Court Decisions, 107, 1840.



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 professional 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.

But that doctrine has been emphatically reaffirmed by the Supreme Court in the use of the following language. "We deem it proper to say, once for all, that the views announced in *Miller v. Brass Co.*, on the subject of reissuing patents for the purpose of extending and enlarging the claim, were deliberately expressed and are still adhered to."<sup>1</sup>

The Supreme Court has also decided and announced that the rule in *Miller v. Brass Co.* is not qualified by any question relevant to the presence or absence of intervening rights of other inventors, accruing between the date of the original patent, and the date of the application for a reissue thereof;<sup>2</sup> and that Court has also held that the operation of the rule is not ousted by the fact that the invention sought to be covered by a broadened reissue, had, during the preceding life of the original patent, been apparently, though erroneously, secured to the same patentee, in another patent.<sup>3</sup>

§ 227. The length to which delay must be drawn out, in order to lose the right to apply for a broadened reissue, cannot be fixed and laid down for all cases. Where the specification is complicated, and the claim is ambiguous or involved, the patentee may be entitled to greater indulgence than he would be if the case were simpler or clearer; and the courts will always exercise a proper liberality on this point in favor of patentees.<sup>4</sup> In *Miller v. Brass Co.* itself,

<sup>1</sup> *Mahn v. Harwood*, 112 U. S. 358, 1884.

<sup>2</sup> *White v. Dunbar*, 119 U. S. 52, 1886.

<sup>3</sup> *Hartshorn v. Barrel Co.* 119 U. S. 674, 1886.

<sup>4</sup> *Mahn v. Harwood*, 112 U. S. 361, 1884.

the delay continued for fifteen years. In three later Supreme Court cases, the delay was for fifteen, fourteen and thirteen years, respectively.<sup>1</sup> In still later Supreme Court cases much shorter delays have been held to be fatal to broadened reissues;<sup>2</sup> and indeed, in one simple case where adverse rights had intervened, a delay of ninety-seven days was decided to have a fatal effect on such a reissue.<sup>3</sup> The general rule is that a delay for two years or more invalidates a broadened reissue, unless that delay is accounted for and excused by special circumstances.<sup>4</sup> What special circumstances will have that effect, cannot now be stated, because none such have yet been found by the Supreme Court to have that operation, and because one case in which a Circuit Court sustained so late a broadened reissue,<sup>5</sup> on account of such circumstances, was disapproved in the Supreme Court.<sup>6</sup> In a later case a delay of nearly three years was excused; because the inventor was in poor health, and at times mentally deranged, and once wholly insane, during the delay.<sup>7</sup> But the reception of erroneous advice from a solicitor of patents, not to apply for a particular reissue, is no excuse for waiting a long time, and then doing so.<sup>8</sup> A delay of less than two years is enough to defeat a broadened reissue in a plain case, even in the absence of intervening rights;<sup>9</sup> and in such a case, six months is probably as long a delay as can be excused.<sup>10</sup>

<sup>1</sup> *Johnson v. Railroad Co.* 105 U. S. 539, 1881; *Mathews v. Machine Co.* 105 U. S. 54, 1881; *Bantz v. Frantz*, 105 U. S. 160, 1881.

<sup>2</sup> *Leggett v. Standard Oil Co.* 149 U. S. 292, 1893; *Dunham v. Dennison Mfg. Co.* 154 U. S. 110, 1894.

<sup>3</sup> *Coon v. Wilson*, 113 U. S. 277, 1884.

<sup>4</sup> *Wollensak v. Reiher*, 115 U. S. 101, 1884; *Hoskin v. Fisher*, 125 U. S. 222, 1887; *Topliff v. Topliff*, 145 U. S. 171, 1892.

<sup>5</sup> *Hartshorn v. Roller Co.* 18 Fed. Rep. 92, 1883.

<sup>6</sup> *Hartshorn v. Barrel Co.* 119 U. S. 674, 1886.

<sup>7</sup> *Whitcomb v. Coal Co.* 47 Fed. Rep. 658, 1891.

<sup>8</sup> *Wollensak v. Sargent*, 151 U. S. 227, 1894.

<sup>9</sup> *Farmer's Mfg. Co. v. Corn-Planter Co.* 128 U. S. 506, 1888; *New v. Warren*, 22 Off. Gaz. 588, 1882; *Haines v. Peck*, 26 Fed. Rep. 625, 1884; *Union Paper Bag Machine Co. v. Waterbury*, 39 Fed. Rep. 391, 1891.

<sup>10</sup> *McArthur v. Supply Co.* 19 Fed. Rep. 263, 1884.



§ 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 reissue patents, and the applications therefor.<sup>1</sup> The reissue application is considered as appended to the original application,<sup>2</sup> and the two years cease 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.<sup>3</sup> 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.<sup>4</sup> Patents surrendered since July 8, 1870, were also cancelled thereby if reissues were granted thereon, but not otherwise.<sup>5</sup> But a surrendered patent cannot be enforced while the application for a reissue is pending.<sup>6</sup> 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.<sup>7</sup> Nor will any such cancellation

<sup>1</sup> *Shaw v. Lead Co.* 11 Fed. Rep. 714, 1882.

<sup>2</sup> *Grant v. Raymond*, 6 Peters, 218, 1832.

<sup>3</sup> *Dental Vulcanite Co. v. Wetherbee*, 2 Cliff, 563, 1866.

<sup>4</sup> *Moffitt v. Garr*, 1 Black. 273, 1861; *Peck v. Collins*, 103 U. S. 664, 1880.

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

<sup>6</sup> *Burrell v. Hackley*, 35 Fed. Rep. 833, 1888.

<sup>7</sup> *Moffitt v. Garr*, 1 Black. 273, 1861; *Eby v. King*, 158 U. S. 373, 1895.

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 or decree, and not on his patent.<sup>1</sup>

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 grantees' 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.<sup>2</sup>

§ 232. A reissue patent may be surrendered and again reissued, under the same circumstances as those which make an original patent reissuable,<sup>3</sup> and the last reissue may be identical with the original patent.<sup>4</sup> 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.<sup>5</sup> But patents reissued during their respective extended terms will be more likely

<sup>1</sup> *Mevs v. Conover*, 125 U. S. 144, 1876.

<sup>2</sup> *Littlefield v. Perry*, 21 Wallace, 205, 1874.

<sup>3</sup> *French v. Rogers*, 1 Fisher, 136, 1851; *Selden v. Gas Burner Co.* 9 Rep. Fed. 390, 1881.

<sup>4</sup> *Giant Powder Co. v. Nitro*

*Powder Co.* 19 Fed. Rep. 510, 1884.

*Celluloid Mfg. Co. v. Zylonite Co.* 27 Fed. Rep. 291, 1886; *Sawyer Spindle Co. v. Eureka Spindle Co.* 33 Fed. Rep. 836, 1888.

<sup>5</sup> *Wilson v. Rousseau*, 4 Howard, 646, 1846; *Gibson v. Harris*, 1 Blatch. 167, 1846.



to suffer from the doctrine of *Miller v. Brass Co.*<sup>1</sup> 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; 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.<sup>2</sup>

§ 233. Only "the same invention" can be covered by a reissued patent.<sup>3</sup> 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 indicate 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 to whatever invention was described in the original letters patent, and appears therein to have been intended to be secured thereby; or refers to whatever invention was actually claimed by the inventor in his original patent. During many years, debate ranged in the courts around these various constructions; and large masses of *obiter dicta* and many actual adjudications can be collected out of the books, in favor of each of them. But the Supreme Court put a period to the controversy in the case of the *Parker & Whipple Co. v. the Yale Clock Co.* decided in 1887.<sup>4</sup> That decision adopted the

<sup>1</sup> *Miller v. Brass Co.* 104 U. S. 350, 1881.

<sup>2</sup> *C. W. Siemens' Appeal*, 11 Off. Gaz. 1107, 1877.

<sup>3</sup> Patent Act of 1832, Section 3;

Patent Act of 1836, Section 13;

Patent Act of 1870, Section 53;

Revised Statutes, Section 4916.

<sup>4</sup> *Parker & Whipple Co. v. Yale*

*Clock Co.* 123 U. S. 99, 1887.

fifth of the above stated constructions, and thus established the meaning of the phrase "the same invention" to be whatever invention was described in the original letters patent, and appears therein to have been intended to be secured thereby. This rule has already been repeatedly reaffirmed and reapplied by the Supreme Court,<sup>1</sup> and is now as well established as its companion rule in *Miller v. Brass Co.* Therefore no reissue claim can stand any longer upon a model alone, nor even alone upon a drawing of an original patent;<sup>2</sup> and indeed neither models, drawings nor descriptions, nor all of them together, can support a reissue claim, except where the description in the original letters patent shows that the invention covered by that claim was intended to be secured in the original.<sup>3</sup>

§ 239. The last clause of Section 4916, of the Revised Statutes provides, that "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." 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.<sup>4</sup>

§ 240. The provision, first enacted in 1870,<sup>5</sup> 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.<sup>6</sup> That provision, therefore, neither enlarged nor restricted the reissuability of

<sup>1</sup> *Hoskins v. Fisher*, 125 U. S. 223, 1887; *Flower v. Detroit*, 127 U. S. 571, 1887; *Pattee Plow Co. v. Kingman & Co.* 129 U. S. 294, 1889; *Freeman v. Asmus*, 145 U. S. 240, 1895; *Corbin Cabinet Lock Co. v. Eagle Lock Co.* 150 U. S. 42, 1893.

<sup>2</sup> *Hailes v. Stove Co.* 133 U. S.

587, 1887.

<sup>3</sup> *Carpenter Machine Co. v. Searle*, 52 Fed. Rep. 814, 1892.

<sup>4</sup> *Powder Co. v. Powder Works*, 98 U. S. 128, 1878.

<sup>5</sup> 16 Statutes at Large, Ch. 230, Section 53, p. 206.

<sup>6</sup> *Powder Co. v. Powder Works*, 98 U. S. 138, 1878.



letters patent; and, accordingly, it is not new matter, within its meaning, to state a new use of the invention shown in the original;<sup>1</sup> nor to explain, in a reissue, the operation of a device which in the original was only described;<sup>2</sup> nor to vary the description of anything described in the original.<sup>3</sup>

§ 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.<sup>4</sup>

§ 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.<sup>5</sup> That can be done only by introducing the original letters patent in evidence.<sup>6</sup>

§ 244. To omit from a reissue, anything which the original specification stated to be essential to the invention, is fatal to identity of invention.<sup>7</sup> 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.<sup>8</sup> A process is not the same invention as a machine which may perform that process;<sup>9</sup> and a process consisting of one stage is not the same as a process consisting of that stage and one or more others.<sup>10</sup> Where, however, an original patent described and claimed

<sup>1</sup> *Broadnax v. Transit Co.* 5 Bann. & Ard. 611, 1880.

<sup>2</sup> *Putnam v. Yerrington*, 2 Bann. & Ard. 243, 1876; *Potter v. Stewart*, 18 Blatch. 561, 1881.

<sup>3</sup> *O'Reilly v. Morse*, 15 Howard, 62, 1853.

<sup>4</sup> *Knight v. Railroad Co.*, Taney's Circuit Court Decisions, 106, 1840.

<sup>5</sup> *O'Reilly v. Morse*, 15 Howard, 62, 1853; *Klein v. Russell*, 19 Wallace, 433, 1873.

<sup>6</sup> *Seymour v. Osborne*, 11 Wallace, 516, 1870.

<sup>7</sup> *Gill v. Wells*, 22 Wallace, 1, 1874; *Russell v. Dodge*, 93 U. S. 460, 1876; *Atwood v. Portland Co.* 10 Fed. Rep. 286, 1880.

<sup>8</sup> *Kirby v. Mfg. Co.* 10 Blatch. 307, 1872.

<sup>9</sup> *Eachus v. Broomall*, 115 U. S. 436, 1885.

<sup>10</sup> *Wood-Paper Patent*, 23 Wallace, 599, 1874.

several different inventions, one or more of those inventions may be omitted from the claims of a reissue of that patent.<sup>1</sup> It is necessary to the requisite identity of invention, that the reissue should claim no invention not described and intended to be claimed in the original; but it is not necessary to that identity, that the original should describe or claim no invention not described or claimed 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.<sup>2</sup> 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.<sup>3</sup> 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.

§ 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, and appears therein to have been intended to be secured thereby.<sup>4</sup>

<sup>1</sup> Rubber Co. v. Goodyear, 9 Wallace, 788, 1869.

<sup>2</sup> 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; Odell v. Stout, 22 Fed. Rep. 163, 1884; Jenkins v. Stetson, 32 Fed. Rep. 398, 1887.

<sup>3</sup> Gill v. Wells, 22 Wallace, 24, 1874; Johnson v. Railroad Co. 105 U. S. 539, 1881.

<sup>4</sup> Parker & Whipple Co. v. Yale Clock Co. 123 U. S. 87, 1887; Galahue v. Butterfield, 10 Blatch. 237, 1872.



§ 247. Whether a patentee, in effecting a reissue, may describe an equivalent of one of the elements of the originally patented combination, and may claim the combination broadly enough to cover that equivalent, is a question which depends upon the effect, in particular cases, of the application of the rule in *Miller v. Brass Co.* Where such a reissue is applied for promptly after the granting of the original patent, it may be sustained;<sup>1</sup> but the right to obtain such a reissue, is lost by long lapse of time after the date of the original, and before the application for that reissue.<sup>2</sup>

§ 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 avert that result.<sup>3</sup> Courts are accordingly inclined, where claims apparently illegal are inserted in reissue patents, to modify those claims by construction, in order to make them conform to propriety.<sup>4</sup> This inclination is not, 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 void for want of novelty, as well as for want of identity with the original invention.<sup>5</sup>

§ 249. Where some, but not all, of the claims of a reissue 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, provided there is no unreasonable delay to file a proper disclaimer of them.<sup>6</sup>

<sup>1</sup> *McArthur v. Supply Co.* 19 Fed. Rep. 263, 1884.

<sup>2</sup> *White v. Dunbar*, 119 U. S. 51, 1886.

<sup>3</sup> *Milligan & Higgins Glue Co. v. Upton*, 1 Bann. & Ard. 505, 1874.

<sup>4</sup> *Mfg. Co. v. Ladd*, 102 U. S. 412, 1880; *Brainard v. Cramme*, 12 Fed. Rep. 624, 1882.

<sup>5</sup> *Wisner v. Grant*, 7 Fed. Rep. 922, 1880.

<sup>6</sup> *Gage v. Herring*, 107 U. S. 640, 1882; *Gould v. Spicer*, 15 Fed. Rep. 344, 1882; *Cote v. Moffit*, 15 Fed. Rep. 345, 1882; *Schillinger v. Brewing Co.* 24 Off. Gaz. 495, 1883; *National Pump Cylinder Co. v. Gunnison*, 17 Fed. Rep. 812, 1883; *Have-meyer v. Randall*, 21 Fed. Rep. 405, 1884; *International Terra Cotta Co. v. Maurer*, 44 Fed. Rep. 622, 1890.

§ 250. Executors, administrators or assigns have the same right to surrender and reissue a patent, that the patentee himself has ;<sup>1</sup> 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,<sup>2</sup> and sane.<sup>3</sup> 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 ;<sup>4</sup> 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 needed to take no part in the application for a reissue, even though the applicant received his assignment from an intermediate owner after that day.<sup>5</sup> It however always was, and still is, proper for the patentee to make the application for a reissue, instead of his assignee 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.<sup>6</sup> 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.<sup>7</sup>

§ 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

<sup>1</sup> Revised Statutes, Section 4916.

<sup>2</sup> Revised Statutes, Section 4895.

<sup>3</sup> *Whitcomb v. Coal Co.* 47 Fed. Rep. 659, 1891.

<sup>4</sup> 16 Statutes at Large, Ch. 132, p. 583.

<sup>5</sup> *Selden v. Gas Burner Co.* 9 Fed. Rep. 390, 1881.

<sup>6</sup> *Dental Vulcanite Co. v. Wetherbee*, 2 Cliff. 563, 1866; *Wing v. Warren*, 5 Fisher, 548, 1872.

<sup>7</sup> *Woodworth v. Hall*, 1 Woodbury & Minot, 248, 389, 1846; *McBurney v. Goodyear*, 11 Cushing (Mass.) 569, 1853.



vest exclusively in him.<sup>1</sup> A grant of a reissue to a person as administrator, is conclusive evidence in an infringement suit that the person was in fact administrator;<sup>2</sup> 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.<sup>3</sup>

§ 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.<sup>4</sup> A reissue may be granted to an assignee of the executor or administrator of the patentee;<sup>5</sup> or to an assignee of an assignee;<sup>6</sup> or indeed to an assignee of any degree, however far removed from the original patentee by mesne assignments;<sup>7</sup> and if the reissued patent recites those assignments, it becomes at least *prima facie* evidence thereof, in an infringement suit.<sup>8</sup> 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 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.<sup>9</sup>

<sup>1</sup> Rubber Co. v. Goodyear, 9 Wallace, 788, 1869.

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

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

<sup>4</sup> Sections 274, 287, and 296 of this book.

<sup>5</sup> Carew v. Fabric Co. 1 Holmes, 45, 1871.

<sup>6</sup> Swift v. Whisen, 2 Bond, 115, 1867.

<sup>7</sup> Selden v. Gas Burner Co. 9 Fed. Rep. 390, 1881.

<sup>8</sup> Middletown Tool Co. v. Judd, 3 Fisher, 141, 1868; Hoffheins v. Brandt, 3 Fisher, 218, 1867.

<sup>9</sup> Potter v. Holland, 4 Blatch 206, 1858; Forbes v. Stove Co. 2 Cliff. 379, 1864; Meyer v. Bailey, 2 Bann & Ard. 73, 1875.

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;<sup>1</sup> 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.<sup>2</sup>

§ 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.<sup>3</sup> 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 in the statute. The remedy would be 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

<sup>1</sup> *Smith v. Mercer*, 3 Penn. L. J. Reports, 529, 1846.

<sup>2</sup> *Commissioner of Patents v. Whiteley*, 4 Wallace, 522, 1866.

<sup>3</sup> *Washburn v. Gould*, 3 Story, 122, 1844; *Woodworth v. Stone*, 3 Story, 749, 1856; *Potter v. Holland*, 4 Blatch, 206, 1858.



time to time been in force. The phrasology 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."<sup>1</sup> 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."<sup>2</sup> The provision of the Revised Statutes upon the same subject is as follows: "Every patent so re-issued, together with the corrected specification, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form."<sup>3</sup>

It follows from these provisions, that a reissued patent cannot be affected, in point of novelty, by anything done after the date of the original application. Novelty still dates from the original invention.<sup>4</sup> 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 a reissued patent.<sup>5</sup> On the other hand, when reissued patents are introduced in evidence to negative the novelty or limit the scope of other

<sup>1</sup> 4 Statutes at Large, Ch.162, Section 3, p. 559.

<sup>2</sup> 5 Statutes at Large, Ch.357, Section 13, p. 122.

<sup>3</sup> Revised Statutes Section 4916.

<sup>4</sup> Grant v. Raymond, 6 Peters, 218, 1832.

<sup>5</sup> Carroll v. Morse, 9 Off. Gaz. 453, 1876.

patents, they operate as of their own dates, and not as of the dates of the originals.<sup>1</sup>

It follows also from the foregoing statutory provisions that persons who use or sell, after the date of a reissued patent, 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.<sup>2</sup>

<sup>1</sup> United States Stamping Co. v. King, 17 Blatch. 64, 1870.

<sup>2</sup> Stimpson v. Railroad Co. 4 Howard, 380, 1846; Agawam Co. v. Jor-

dan, 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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§255. THE constitutional provision relevant to the duration of patent rights, is that such rights, when granted, shall be granted for limited times.<sup>1</sup> The Patent Act of 1790<sup>2</sup> provided, that under the circumstances and conditions prescribed therein, the Secretary of State, and the Secretary of War, and 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.<sup>3</sup> Under that law, patents

<sup>1</sup> Constitution of the United States, Article I. Section 8.

<sup>2</sup> 1 Statutes at Large, Ch. 7, Sec-

tion 1, p. 109.

<sup>3</sup> 1 Statutes at Large, Ch. 11, Section 1, p. 321.

were generally, if not universally, 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."<sup>1</sup> 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,<sup>2</sup> 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.<sup>3</sup> 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.<sup>4</sup> This power was exercised as early as 1808.<sup>5</sup> In one later case such an extension was granted nearly three years before the then existing exclusive right was to expire;<sup>6</sup> 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.<sup>7</sup> 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.

<sup>1</sup> 4 Statutes at Large, Ch. 162, Section 2, p. 559.

<sup>2</sup> The Fire Extinguisher Case, 21 Fed. Rep. 42, 1884.

<sup>3</sup> 5 Statutes at Large, Ch. 357, Section 21, p. 125.

<sup>4</sup> Bloomer v. Stolley, 5 McLean, 161, 1850; Jordan v. Dobson, 2 Ab-

bott, 407, 1870; The Fire Extinguisher Case, 21 Fed. Rep. 42, 1884.

<sup>5</sup> Evans v. Jordan, 9 Cranch, 199, 1815.

<sup>6</sup> Bloomer v. McQuewan, 14 Howard, 539, 1852.

<sup>7</sup> Agawam Co. v. Jordan, 7 Wallace, 583, 1868.



§ 257. Some special acts, for the extension of patents, merely extend their duration by a simple legislative edict, and do no more.<sup>1</sup> 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.<sup>2</sup> When patents are extended in this latter method, those provisions of the special act which limit the operation of the extension, need not 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.<sup>3</sup>

§ 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.<sup>4</sup> Such Acts are considered as engrafted on the general patent laws, and are to be construed in connection with them.<sup>5</sup> 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.<sup>6</sup>

§ 259. Patent Office extensions of patents, were first authorized by the Patent Act of July 4, 1836.<sup>7</sup> By the Patent Act of March 3, 1861, they were prohibited, as to all patents

<sup>1</sup> *Bloomer v. McQuewan*, 14 Howard, 539, 1852; *Woodworth v. Edwards*, 8 Woodbury and Minot, 123, 1847.

<sup>2</sup> *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868.

<sup>3</sup> *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868.

<sup>4</sup> *Gibson v. Gifford*, 1 Blatch. 529,

1850.

<sup>5</sup> *Bloomer v. McQuewan*, 14 Howard, 539, 1852; *Jordan v. Dobson*, 2 Abbott, 408, 1870.

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

<sup>7</sup> 5 Statutes at Large, Ch. 357, Section 18, p. 124.

thereafter granted.<sup>1</sup> The last extension of the kind, was 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 some 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,<sup>2</sup> 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

<sup>1</sup> 12 Statutes at Large, Ch. 88, Section 16, p. 249.

<sup>2</sup> 5 Statutes at Large, Ch. 357, Section 18, p. 124.



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 renewal 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 1848<sup>1</sup> 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,<sup>2</sup> and again re-enacted in the Revised Statutes.<sup>3</sup> 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.<sup>4</sup> 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

<sup>1</sup> 9 Statutes at Large, Ch. 47, Section 1, p. 231.

<sup>2</sup> 16 Statutes at Large, Ch. 230 ; Sections 63 to 67, p. 208.

<sup>3</sup> Revised Statutes, Sections 4924 to 4928.

<sup>4</sup> 5 Statutes at Large, Ch. 45, Section 6, p. 193.

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. Where the inventor would have an equitable interest in the extension if granted, it was proper for him to apply for that extension alone.<sup>1</sup> 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.<sup>2</sup>

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.<sup>3</sup>

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 living; and if any were dead, the legal representatives of the deceased had to unite in such an application.<sup>4</sup>

§ 262. No Patent Office extension was ever grantable after the expiration of the original term.<sup>5</sup> Such extensions could

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

<sup>2</sup> *Wilson v. Turner*, Taney's Circuit Court Decisions, 292, 1845.

<sup>3</sup> *Wilson v. Rousseau*, 4 Howard, 673, 1846.

<sup>4</sup> *Wickersham's Case*, 4 Off. Gaz. 155, 1873.

<sup>5</sup> Act of 1836, Section 18; Act of



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.<sup>1</sup> Patents limited in law to the 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;<sup>2</sup> 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.<sup>3</sup>

§ 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*.<sup>4</sup> 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.<sup>5</sup>

§ 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.<sup>6</sup> 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

1870, Section 63; Revised Statutes, Section 4924.

<sup>1</sup> *Johnson v. McCullough*, 4 Fisher, 170, 1870.

<sup>2</sup> *Tilghman v. Mitchell*, 9 Blatch. 27, 1871.

<sup>3</sup> *New American File Co. v. Nicholson File Co.* 8 Fed. Rep. 816, 1881.

<sup>4</sup> *Wilson v. Rousseau*, 4 Howard 673, 1846.

<sup>5</sup> *Potter v. Braunsdorf*, 7 Blatch. 97, 1869; *Crompton v. Belknap Mills*, 3 Fisher, 536, 1869.

<sup>6</sup> *Wilson v. Turner*, Taney's Circuit Court Decisions, 292, 1845.

satisfy the policy of the law in this respect.<sup>1</sup> 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.<sup>2</sup> Moreover, inventors are presumed in law to have had a sufficient interest to support extensions actually granted, unless the contrary is proved to have been the fact.<sup>3</sup>

§ 265. The certificate of extension which was provided for by the statute,<sup>4</sup> 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.<sup>5</sup>

§ 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;<sup>6</sup> 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.<sup>7</sup> 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.<sup>8</sup> 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

<sup>1</sup> *Gear v. Grosvenor*, 1 Holmes, 215, 1873.

<sup>2</sup> *Sayles v. Dubuque and Sioux City Railroad Co.* 3 Bann. & Ard. 220, 1878.

<sup>3</sup> *Ruggles v. Eddy*, 10 Blatch. 56, 1872.

<sup>4</sup> Patent Act of 1836, Section 18.

<sup>5</sup> *Potter v. Braunsdorf*, 7 Blatch.

108, 1869.

<sup>6</sup> *Gear v. Grosvenor*, 1 Holmes, 218, 1873.

<sup>7</sup> *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868.

<sup>8</sup> 16 Statutes at Large, Ch. 2<sup>nd</sup> Section 63, p. 208; Revised Statutes, Section 4924.



Commissioner, relevant to the existence of his jurisdiction, was never conclusive in any case.' 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 granting of the extension.<sup>2</sup> 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.<sup>3</sup>

§ 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.<sup>4</sup> 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.<sup>5</sup>

§ 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

<sup>1</sup> *Wilson v. Rousseau*, 4 Howard, 687, 1846.

<sup>2</sup> *Brooks v. Bicknell*, 3 McLean, 250, 1843.

<sup>3</sup> *Grant v. Raymond*, 6 Peters, 244, 1832.

<sup>4</sup> Patent Act of 1836, Section 18; Patent Act of 1870, Section 66; Revised Statutes, Section 4927.

<sup>5</sup> *Clum v. Brewer*, 2 Curtis, 506, 1855; *Jordan v. Dobson*, 2 Abbott, 408, 1870.

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.<sup>1</sup>

§ 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.<sup>2</sup>

§ 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."<sup>3</sup> This enactment, in almost precisely the same words, has always found a place in statutes relevant to extensions of patents.<sup>4</sup> 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

<sup>1</sup> Brooks v. Jenkins, 3 McClean, 485, 1844; Colt v. Young, 2 Blatch. 473, 1852; Tilghman v. Mitchell, 9 Blatch. 27, 1871.

<sup>2</sup> Rubber Co. v. Goodyear, 9 Wal-

lace, 796, 1869; Mowry v. Whitney, 14 Wallace, 434, 1871.

<sup>3</sup> Revised Statutes, Section 4928.

<sup>4</sup> Patent Act of 1836, Section 18; Patent Act of 1870, Section 67.



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 more than fifty years have passed since its enactment, the text writer can collate the 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.'

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 sell specimens of the patented thing. 3. The rule does not apply to any patent for a process.' 4. The rule confers no right under an extension, that

<sup>1</sup> *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. 89, 1877.

<sup>2</sup> *Wetherill v. Zinc Co.* 6 Fisher, 50, 1872.

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.' 5. The rule confers no right to make or use or sell any new specimen of the patented thing;'<sup>2</sup> though it does confer a right to repair the articles to which it applies.' 6. The rule does not apply where the right to use, when granted by the patentee, was expressly limited to the existing term of the patent.' 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.'<sup>3</sup>

<sup>1</sup> *Union Mfg. Co. v. Lounsbury*, 41 New York, 368, 1869.

<sup>2</sup> *Hodge v. Railroad Co.* 6 Blatch. 165, 1868; *Wood v. Railroad Co.* 2 Bls. 62, 1868.

<sup>3</sup> *Wilson v. Simpson*, 9 Howard, 109, 1850; *Aiken v. Print Works*, 2

Clif. 485, 1865; *Farrington v. Detroit*, 4 Fisher, 216, 1870.

<sup>4</sup> *Mitchell v. Hawley*, 16 Wallace, 544, 1872.

<sup>5</sup> *Woodworth v. Curtis*, 2 Woodbury and Minot, 524, 1847.



## CHAPTER XI.

### TITLE.

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| 279. Reformation of assignments.                                 | 290. Title by bankruptcy.                               |
| 280. Assignments of extensions.                                  | 291. Title by death.                                    |
| 281. Recording and notice.                                       | 292. Tenancy in common. Joint-tenancy.                  |
| 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 those: 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 complete; 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 patents 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, composition of matter or design, and by applying for and obtaining a patent thereon. During the 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.<sup>1</sup> 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.<sup>2</sup> This rule applies not only to cases where the assignments are recorded before the granting of the patents,<sup>3</sup> but also to cases where, though executed before, they are not recorded till after that event.<sup>4</sup> So also, it applies to cases where applications are divided after they are assigned,<sup>5</sup> and to cases where the assignments are executed after the applications for patents are rejected, and before those rejections are reversed.<sup>6</sup> The inchoate right to a Patent Office extension of a patent, when such a right was provided by law,<sup>7</sup> was also a proper subject of assignment, even while it remained inchoate;<sup>8</sup> 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.<sup>9</sup>

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

<sup>2</sup> *Gayler v. Wilder*, 10 Howard, 493, 1850.

<sup>3</sup> *Consolidated Electric Light Co. v. Edison Electric Light Co.* 25 Fed. Rep. 719, 1885.

<sup>4</sup> *United States Stamping Co. v. Jewett*, 7 Fed. Rep. 869, 1880.

<sup>5</sup> *Puetz v. Bransford*, 31 Fed. Rep. 461, 1887.

<sup>6</sup> *Gay v. Cornell*, 1 Blatch. 510, 1849.

<sup>7</sup> From July 4, 1836, to March 2, 1861.

<sup>8</sup> *Nicholson Pavement Co. v. Jenkins*, 14 Wallace, 456, 1871.

<sup>9</sup> *Railroad Co. v. Trimble*, 10 Wallace, 380, 1870.



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;<sup>1</sup> for persons employed, as much as employers, are entitled to their own independent inventions.<sup>2</sup> 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;<sup>3</sup> 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.<sup>4</sup>

§ 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.<sup>5</sup> An assignment may purport to convey the ownership of the patent, or an undivided share of that ownership, or it may purport to convey the exclusive right, or an undivided share thereof, to make, use and sell the invention throughout the United States. Such a document, in the latter form, is as truly an assignment, as is a document which employs the other phraseology.<sup>6</sup> And an assignment in either form, is not less an assignment because it is coupled with a license back to the assignor.<sup>7</sup>

Assignments of legal titles to patents must be in writing, because the statute provides no other method of effecting such an assignment;<sup>8</sup> and because, since patent rights are creatures of statute and not of common law, the transfer of

<sup>1</sup> *Hapgood v. Hewitt*, 119 U. S. 226, 1886; *Solomons v. United States*, 137 U. S. 346, 1890; *Dalzell v. Dueber Mfg. Co.* 149 U. S. 320, 1893.

<sup>2</sup> *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868.

<sup>3</sup> *Fischer v. Neil*, 6 Fed. Rep. 89, 1881.

<sup>4</sup> *Washburn & Moen Mfg. Co. v. Halsh*, 4 Fed. Rep. 900, 1880.

<sup>5</sup> *Gayler v. Wilder*, 10 Howard,

477, 1850; *Waterman v. Mackenzie*, 138 U. S. 255, 1891; *Pope Mfg. Co. v. G. & J. Mfg. Co.* 144 U. S. 249, 1892.

<sup>6</sup> *Rapp v. Kelling*, 41 Fed. Rep. 792, 1890; *Johnson Signal Co. v. Union Signal Co.* 59 Fed. Rep. 23, 1893.

<sup>7</sup> *Pope Mfg. Co. v. Clark*, 46 Fed. Rep. 792, 1891; *Russell v. Kern*, 58 Fed. Rep. 384, 1892.

<sup>8</sup> Revised Statutes, Section 4898.

the legal title thereto cannot be regulated by the rules of the latter system.<sup>1</sup> But an equitable title may be created by parol;<sup>2</sup> and such a title may, perhaps, by parity of reasoning, be transferred by the same method. But a recital in a writing that a particular person is an owner with the subscriber of a patent granted to the latter, is not even an equitable assignment.<sup>3</sup>

Titles conveyed by assignments are usually unconditional, but they may also be held upon special tenures. One instance of such a tenure is presented where the assignment contains a condition that the assignee shall pay a specified royalty to the assignor during the life of the patent assigned,<sup>4</sup> or shall sell the patent and pay the proceeds to the assignor, or to others for his benefit,<sup>5</sup> or shall not make any assignment of the patent or license under it.<sup>6</sup> And other estates than a complete one, may be created in patents by assignments. An estate for years and an estate in remainder are examples of these.<sup>7</sup>

§ 275. The patent assigned ought to be described in the assignment by its number and date, and by the name of the patentee, and by 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 excludes doubt as to the patent intended to be conveyed.<sup>8</sup> The designation of the assignee in an assignment, is also sufficient where the person intended can be identified, even where evidence outside

<sup>1</sup> *Gayler v. Wilder*, 10 Howard, 498, 1850.

<sup>2</sup> *Dalzell v. Dueber Mfg. Co.* 149 U. S. 320, 1893; *Whiting v. Graves*, 3 Bann. & Ard. 225, 1878.

<sup>3</sup> *Kearney v. Railroad Co.* 27 Fed. Rep. 701, 1886.

<sup>4</sup> *Littlefield v. Perry*, 21 Wallace, 220, 1874; *Boesch v. Graff*, 133 U. S. 701, 1890.

<sup>5</sup> *Jonathan Mills Mfg. Co. v.*

*Whitehurst*, 56 Fed. Rep. 594, 1893.

<sup>6</sup> *Platt v. Fire Extinguisher Co.* 59 Fed. Rep. 901, 1894.

<sup>7</sup> *Solomons v. United States*, 21 Court of Claims, 481, 1886.

<sup>8</sup> *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.



of the assignment is required for that purpose.<sup>1</sup> 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.<sup>2</sup> An assignment by a natural person requires no other authentication than the assignor's signature; and where such an assignment is executed by an attorney in fact, it must be executed in the name of the assignor, and cannot lawfully be executed by the attorney in his own name.<sup>3</sup> Assignments are sometimes acknowledged before magistrates; 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 was acknowledged.<sup>4</sup> 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.<sup>5</sup> An assignment to a corporation confers no title upon any stockholder therein;<sup>6</sup> 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.<sup>7</sup>

A married woman, an infant, or a person under guardianship may be the assignee of an invention or of a patent. Such persons may also assign their inventions or patents by complying, not only with the United States law which requires assignments of patents to be in writing, but also

<sup>1</sup> *Fisk Clark & Flagg v. Hollander, MacArthur & Mackay*, 360, 1883.

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

<sup>3</sup> *Machesney v. Brown*, 29 Fed. Rep. 145, 1886.

<sup>4</sup> *New York Pharmaceutical Associa-*

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

<sup>5</sup> *Gottfried v. Miller*, 104 U. S. 527, 1881.

<sup>6</sup> *Gottfried v. Miller*, 104 U. S. 528, 1881.

<sup>7</sup> *Dyer v. Rich*, 1 Metcalf (Mass.), 180, 1840.

with those laws of their particular States which govern analogous acts of such persons.<sup>1</sup>

§ 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;<sup>2</sup> but no assignment which has been acted upon by the parties thereto can be revoked on the ground of a partial failure to pay the promised price.<sup>3</sup>

§ 277. Rights of action for past infringements of a patent are not conveyed by any mere assignment of that patent;<sup>4</sup> but they may be conveyed by any assignment which purports to convey them, whether that document purports also to convey the patent,<sup>5</sup> or purports to convey the rights of action alone.<sup>6</sup>

§ 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;<sup>7</sup> and if that language is clear in the eye of the law, its effect cannot be varied by any parol evidence;<sup>8</sup> 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

<sup>1</sup> *Fetter v. Newhall*, 17 Fed. Rep. 843, 1883.

<sup>2</sup> *Railroad Co. v. Trimble*, 10 Wallace, 380, 1870.

<sup>3</sup> *Hartshorn v. Day*, 19 Howard, 222, 1856; *Mackaye v. Mallory*, 12 Fed. Rep. 328, 1882.

<sup>4</sup> *Moore v. Marsh*, 7 Wallace, 515, 1868; *May v. County of Juneau*, 30 Fed. Rep. 245, 1887; *Koalatype Co. v. Hoke*, 30 Fed. Rep. 444, 1887;

*May v. County of Saginaw*, 32 Fed. Rep. 629, 1888.

<sup>5</sup> *Hamilton v. Rollins*, 3 Bann. & Ard. 160, 1877; *Jones v. Berger*, 58 Fed. Rep. 1007, 1893.

<sup>6</sup> *Hayward v. Andrews*, 12 Fed. Rep. 786, 1882.

<sup>7</sup> *Washburn v. Gould*, 3 Story, 122, 1844.

<sup>8</sup> *Railroad Co. v. Trimble*, 10 Wallace, 367, 1870.



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 evidence 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;<sup>1</sup> or show that both parties to that assignment, practically construed it, after its execution, and in so doing construed it alike.<sup>2</sup> 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, in a suit between him and the grantee, or their respective privies, as he is supposed to have written the document, and therefore to be chargeable with the obscurity;<sup>3</sup> but as between the grantee or his privies, and strangers to the assignment, ambiguities in such cases are solved against the grantee.<sup>4</sup>

§ 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

<sup>1</sup> *Read v. Bowman*, 2 Wallace, 591, 1864; *Phelps v. Classen*, 1 Woolworth, 212, 1868; *Wetherell, v. Zinc Co.* 6 Fisher, 50, 1872; *Lowrey v. Cowles Co.* 56 Fed. Rep. 492, 1893, and 68 Fed. Rep. 366, 1895.

<sup>2</sup> *Topliff v. Topliff*, 122 U. S. 131, 1886; *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; *Levy v. Dattlebaum*, 63 Fed. Rep. 994, 1894.

<sup>3</sup> *Smith v. Selden*, 1 Blatch. 475, 1849; *May v. Chaffee*, 2 Dillon, 385, 1871; *Falley v. Giles*, 29 Indiana, 114, 1867.

<sup>4</sup> *Levy v. Dattlebaum*, 63 Fed. Rep. 994, 1894.

reformation on proof of what his intention was, unless he also proves that the intention of the other party was the same.<sup>1</sup> 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.<sup>2</sup>

§ 280. No extension of a patent is conveyed by an assignment of the first term thereof.<sup>3</sup> 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."<sup>4</sup> But if, at the time such an assignment is made, the patent statutes do provide for extensions of patents of the class to which the assigned patent belongs, then the word "renewal" is a sufficient word to convey such an extension.<sup>5</sup> 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.<sup>6</sup> 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 courts will take the step required to pass from the one doctrine to the other, whenever the question arises.

§ 281. Recording in the Patent Office, within three months after its date, is necessary to the validity of an assignment or grant of a patent as against any subsequent purchaser or mortgagee, for a valuable consideration, without notice.<sup>7</sup>

<sup>1</sup> *Downton v. Allis*, 9 Fed. Rep. 771, 1881.

<sup>2</sup> *Gibson v. Cook*, 2 Blatch. 149, 1850; *Woodworth v. Cook*, 2 Blatch. 151, 1850.

<sup>3</sup> *Wilson v. Rousseau*, 4 Howard, 646, 1846.

<sup>4</sup> *Wilson v. Rousseau*, 4 Howard,

646, 1846.

<sup>5</sup> *Pitts v. Hall*, 3 Blatch. 201, 1854; *Goodyear v. Cary*, 4 Blatch, 303, 1859; *Chase v. Walker*, 3 Fisher, 122, 1866.

<sup>6</sup> *Hendrie v. Sayles*, 98 U. S. 554, 1878.

<sup>7</sup> Revised Statutes, Section 4898.



This statutory provision operates to give constructive notice to subsequent purchasers and mortgagees, of the assignments which are duly recorded thereunder ; but it 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 also identifies with certainty the invention conveyed thereby.<sup>1</sup> But where an assignment conveys a patent, and also conveys all improvements that the assignor may thereafter make on the invention claimed therein, the due recording of that assignment operates to give constructive notice, not only of the sale of that patent, but also of the sale of those improvements.<sup>2</sup> Nor does the provision apply to any assignment made by a judge or register in bankruptcy, under title LXI. of the Revised Statutes ; but 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.<sup>3</sup> Neither does the provision apply to any assignment which conveyed accrued rights of action only.<sup>4</sup> In such a case, the assignee, in order to protect his right, should give the infringer notice of the assignment ; 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.<sup>5</sup> Recording an assignment of a patent, is not necessary to its validity, as between the parties to

<sup>1</sup> *Wright v. Randal*, 8 Fed. Rep. 599, 1881; *New York Paper Bag Co. v. Union Paper Bag Co.* 32 Fed. Rep. 788, 1887.

<sup>2</sup> *Aspinwall Mfg. Co. v. Gill*, 32 Fed. Rep. 701, 1887.

<sup>3</sup> *Prime v. Mfg. Co.* 16 Blatch. 456, 1879.

<sup>4</sup> *Gear v. Fitch*, 3 Bann. & Ard. 578, 1878.

<sup>5</sup> *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; *Murdock v. Finney*, 21 Missouri, 138, 1855; *McWilliams v. Webb*, 32 Iowa, 577, 1871.

that assignment;<sup>1</sup> nor as against an infringer of the patent;<sup>2</sup> 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;<sup>3</sup> nor as against any subsequent purchaser who had actual notice thereof, when purchasing;<sup>4</sup> nor as against any subsequent purchaser who paid no valuable consideration for the assignment which he took.<sup>5</sup> 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 of whatever title the maker, user, or seller may possess.<sup>6</sup> Whether such constructive notice may also be based on the fact that the subsequent purchaser was a corporation in which the assignor was a director, is a question upon which the precedents are now opposing.<sup>7</sup>

<sup>1</sup> *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.

<sup>2</sup> *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.

<sup>3</sup> *Gibson v. Cook*, 2 Blatch. 144, 1850

<sup>4</sup> *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.

<sup>5</sup> *Saxton v. Aultman*, 15 Ohio State, 471, 1864

<sup>6</sup> *Prime v. Mfg. Co.* 16 Blatch. 455, 1879; *Dueber Watch Case Co. v. Dalzell*, 38 Fed. Rep. 597, 1889.

<sup>7</sup> *Continental Windmill Co. v. Empire Windmill Co.* 8 Blatch. 295, 1871; *Cutter Co. v. Sheldon*, 10 Blatch. 1, 1872; *Davis Wheel Co. v. Davis Wagon Co.* 20 Fed. Rep. 700, 1884.



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.<sup>1</sup> If this rule were otherwise, titles thus derived might become valueless for want of qualified purchasers.<sup>2</sup>

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 these 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;<sup>3</sup> if indeed it can prevail against one which left no such interest.<sup>4</sup>

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;<sup>5</sup> and the three months within which, after that date, an assignment is required to be recorded, are calendar months.<sup>6</sup>

§ 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

<sup>1</sup> *Wright v. Randall*, 8 Fed. Rep. 599, 1881.

<sup>2</sup> *Varick v. Briggs*, 6 Paige (N.Y.) 329, 1837; *Empire State Nail Co. v. Faulkner*, 55 Fed. Rep. 824, 1893.

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

*Vapor Engine Co. v. Pacific Gas Engine Co.* 47 Fed. Rep. 513, 1891.

<sup>4</sup> *Oliver v. Platt*, 3 Howard, 363, 1845; *May v. LeClaire*, 11 Wallace, 232, 1870.

<sup>5</sup> *Dyer v. Rich*, 1 Metcalf (Mass.), 180, 1840.

<sup>6</sup> *Guaranty Trust Co. v. Railroad Co.* 139 U. S. 145, 1890.

transfer whatever title the assignor may subsequently acquire by purchase or otherwise.<sup>1</sup> 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.<sup>2</sup>

§ 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.<sup>3</sup>

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.<sup>4</sup> 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 some defect he has been able to discover in the patent, would be very unjust.<sup>5</sup> 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

<sup>1</sup> *Faulks v. Kamp*, 17 Blatch. 433, 1880. *Brush Electric Co. v. California Electric Light Co.* 52 Fed. Rep. 963, 1892.

<sup>2</sup> *Perry v. Corning*, 7 Blatch. 195, 1870.

<sup>3</sup> *Hiatt v. Twomey*, 1 Devereux &

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

<sup>4</sup> *Thomas v. Quintard*, 5 Duer (N. Y.), 80, 1855.

<sup>5</sup> *Milligan v. Mfg. Co.* 21 Fed. Rep. 570, 1884.



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.<sup>1</sup>

§ 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.<sup>2</sup> 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;<sup>3</sup> 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.<sup>4</sup> In such a case, however, the assignee's right of action rests upon the fraud and not upon the parol warranty.<sup>5</sup> 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 a patent is granted to an inventor,<sup>6</sup> or to a subsequent assignee chargeable with notice,<sup>7</sup> for an invention made or

<sup>1</sup> Parsons on Contracts, Book 2, Ch. 1, Sec. 2.

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

<sup>3</sup> Van Ostrand v. Reed, 1 Wendell, (N. Y.), 432, 1828; Jolliffe v. Collins, 21 Missouri, 341, 1855.

<sup>4</sup> McClure v. Jeffrey, 8 Indiana, 83, 1856.

<sup>5</sup> Rose v. Hurley, 39 Indiana, 78, 1872.

<sup>6</sup> 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.

<sup>7</sup> Pontiac Boot Co. v. Merino Shoe Co. 31 Fed. Rep. 286, 1887.

completed or patented, after the execution of an assignment adapted to convey it; and a document which conveys a patent, and which also purports to convey all improvements on the invention covered thereby which may thereafter be made by the assignor, is an example of such an assignment.<sup>1</sup> 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.<sup>2</sup> 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.<sup>3</sup> Such a title accrues to a consolidated corporation in patents owned by its constituent corporations.<sup>4</sup> Such a title accrues to an employer, where an employee makes an invention in pursuance of a contract to invent for that employer;<sup>5</sup> and such a contract may be an oral one, and not be within the statute of frauds.<sup>6</sup> 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 have arisen, it will be translated into a legal title in a proper case,<sup>7</sup> by means of a bill for specific performance

<sup>1</sup> *Aspinwall Mfg. Co. v. Gill*, 32 Fed. Rep. 699, 1887.

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

<sup>3</sup> *Cook v. Bidwell*, 8 Fed. Rep. 452, 1881.

<sup>4</sup> *Edison Electric Light Co. v. New Haven Electric Co.* 35 Fed. Rep. 236, 1888.

<sup>5</sup> *Bonsack Mach. Co. v. Hulse*, 57 Fed. Rep. 523, 1893; *Hulse v. Bonsack Mach. Co.* 65 Fed. Rep. 864, 1894.

<sup>6</sup> *Dalzell v. Dueber Mfg. Co.* 149 U. S. 320, 1893.

<sup>7</sup> *Kennedy v. Hazleton*, 128 U. S. 667, 1888.



of contract or other action in equity;<sup>1</sup> and where no affirmative relief is sought by the holder of an equitable title to a patent, such a title will be upheld by a court of equity, as against all claims made under 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 encumbrance.<sup>2</sup> One district judge has decided this point the other way, holding that the maxim *caveat emptor* applies to such a case.<sup>3</sup> 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 legal title at the time of his purchase, he will be entitled to priority in equity, as well as in law.<sup>4</sup> The maxim of *caveat emptor* applies where a seller has no title whatever.<sup>5</sup> 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.<sup>6</sup> The subject matter of letters patent is not divisible in any other category than a territorial one;<sup>7</sup> and therefore grants can not be made to convey one of several inventions covered

<sup>1</sup> *Hapgood v. Rosenstock*, 23 Fed. Rep. 87, 1885; *New York Paper Bag Machine Co. v. Union Paper Bag Machine Co.* 32 Fed. Rep. 783, 1887.

<sup>2</sup> *Hendrie v. Sayles*, 98 U. S. 549, 1878.

<sup>3</sup> *Consolidated Fruit Jar Co. v. Whitney*, 2 Bann. & Ard. 385. 1876.

<sup>4</sup> *Bispham's Principles of Equity*, Section 40.

<sup>5</sup> *Abbett v. Zusi*, 5 Bann. & Ard.

38, 1879.

<sup>6</sup> *Gayler v. Wilder*, 10 Howard, 494, 1850; *Moore v. Marsh*, 7 Wallace, 521, 1868; *Littlefield v. Perry*, 21 Wallace, 219, 1874.

<sup>7</sup> *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.

by a patent;<sup>1</sup> 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.<sup>2</sup> 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.<sup>3</sup> And a grant is not forfeited by failure to pay a royalty; or to keep some other promise made by the grantee therein, unless the grant provides that such a failure shall work such a forfeiture.<sup>4</sup> Nor is it inconsistent with a grant that it is subject to an outstanding license;<sup>5</sup> or 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.<sup>6</sup> But no instrument can be a grant which reserves a right to the grantor to make, but not to sell or use,<sup>7</sup> or to sell, but not to make or use,<sup>8</sup> specimens of the

<sup>1</sup> *Pope Mfg. Co. v. Gormully Mfg. Co.*, 144 U. S. 250, 1892.

<sup>2</sup> *Washburn & Moen Mfg. Co. v. Haish*, 4 Fed. Rep. 908, 1880.

<sup>3</sup> *Littlefield v. Perry*, 21 Wallace, 220, 1874.

<sup>4</sup> *Atkins v. Park*, 61 Fed. Rep. 957, 1894.

<sup>5</sup> *Russell v. Kern*, 58 Fed. Rep. 884, 1893.

<sup>6</sup> *Wilson v. Rousseau*, 4 Howard, 646, 1846; *Waterman v. Mackenzie*, 138 U. S. 256, 1891; *Washburn v. Gould*, 3 Story, 122, 1844; *Ritter v. Serrell*, 2 Blatch. 379, 1852.

<sup>7</sup> *Waterman v. Mackenzie*, 138 U. S. 256, 1891.

<sup>8</sup> *Pitts v. Jameson*, 15 Barbour (N. Y. Supreme Court), 315, 1853.



patented thing, within the territory covered by the instrument.

§ 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 and sell, anywhere within the United States, those specimens of that invention which are made and sold under the grant, and within the territory covered thereby.<sup>1</sup> And an agreement between grantees, not to sell or use the patented article in the territory of each other, is not binding upon purchasers from either of the grantees,<sup>2</sup> unless they buy with notice of the restriction. But a lawful sale in a foreign country, of an article patented in that country, and also in the United States, does not authorize the use or sale in the United States of the article thus sold in the foreign country,<sup>3</sup> except possibly where the patents of the two countries, on that article, are owned by the same party, and the foreign sale was made by him. And a patentee owning a United States patent, and also a patent of some foreign country, on the same article, may couple his sales of that article in any foreign country, with a restriction prohibiting its importation into the United States; and that restriction will be binding upon all persons in the United States who have knowledge or other notice thereof.<sup>4</sup>

§ 288*a*. A mortgage may be executed to cover an entire patent, or an undivided part thereof; or the entire right, or an undivided interest therein, within a certain specified part of the United States. And the due recording of such a mortgage in the Patent Office makes the title of the mortgagee complete; so that he is entitled to grant licenses, receive royalties, bring suits against infringers, and recover profits or damages from them, as long as his mortgage continues in force; and it will continue in force until it is

<sup>1</sup> *Adams v. Burke*, 17 Wallace, 453, 1873; *Hobbie v. Jennison*, 149 U. S. 355, 1893; *Keeler v. Folding Bed Co.* 157 U. S. 659, 1895.

<sup>2</sup> *Pratt v. Mareen*, 25 Ill. App.

516, 1888.

<sup>3</sup> *Boesch v. Graff*, 133 U. S. 703, 1890.

<sup>4</sup> *Dickerson v. Matheson*, 57 Fed. Rep. 524, 1893.

ended by a payment of the debt secured thereby, at the time provided for therein, or by redemption, on a bill in equity, within a reasonable time thereafter.<sup>1</sup> But such a mortgage will not affect an outstanding license, particularly where the mortgagee is chargeable with notice thereof.<sup>2</sup>

§ 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 or master to execute a proper assignment.<sup>3</sup> 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.<sup>4</sup> 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.<sup>5</sup>

§ 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,<sup>6</sup> and all rights of 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

<sup>1</sup> *Waterman v. Mackenzie*, 138 U. S. 256, 1891.

<sup>2</sup> *Waterman v. Shipman*, 55 Fed. Rep. 984, 1893.

<sup>3</sup> *Ager v. Murray*, 105 U. S. 126, 1881; *Wilson v. Fire Alarm Co.* 52 Off. Gaz. 901, 1890.

<sup>4</sup> *Ryan v. Lee*, 10 Fed. Rep. 917, 1882.

<sup>5</sup> *Pacific Bank v. Robinson*, 57 California, 522, 1881.

<sup>6</sup> *Kittle v. Hall*, 29 Fed. Rep. 510, 1887.



the commencement of the bankruptcy proceedings.<sup>1</sup> But a title to a patent passed to an assignee in bankruptcy, under the law of 1867, subject to his election not to accept it, if in his opinion it was worthless, or would be burdensome and unprofitable.<sup>2</sup> Though this bankruptcy law was repealed in 1878, many titles to patents lately 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 legal title to the patent rights of the insolvent.<sup>3</sup> 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.<sup>4</sup>

And the title to the patents of dissolved corporations will generally pass, under the operation of State laws, to the receivers, or other officials who are appointed to wind up their affairs.<sup>5</sup>

§ 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.<sup>6</sup> Such an inchoate title has several of the same qualities, in the hands of the executor or administrator, that it had in

<sup>1</sup> Revised Statutes, Sections 5046, 5053, 5045.

<sup>2</sup> *Sessions v. Romadka*, 145 U. S. 37, 1892.

<sup>3</sup> *Ashcroft v. Walworth*, 1 Holmes, 154, 1872; *McCulloh v. Association*, 45 Fed. Rep. 479, 1891.

<sup>4</sup> *Ager v. Murray*, 105 U. S. 131, 1881.

<sup>5</sup> *McCulloh v. Association*, 45 Fed. Rep. 479, 1891.

<sup>6</sup> Revised Statutes, Section 4896; *De La Vergne Mach. Co. v. Feathstone*, 147 U. S. 209, 1893.

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.<sup>1</sup> 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.<sup>2</sup> 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.<sup>3</sup> 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;<sup>4</sup> 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.<sup>5</sup>

§ 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

<sup>1</sup> *Northwestern Extinguisher Co. v. Philadelphia Extinguisher Co.* 1 Bann. & Ard. 177, 1874.

<sup>2</sup> *Brooks v. Jenkins*, 3 McLean, 441, 1844; *Hodge v. North Missouri Railroad Co.* 1 Dillon, 104, 1870; *Shaw Valve Co. v. New Bedford*, 19 Fed. Rep. 753, 1884; *Bradley v.*

*Dull*, 19 Fed. Rep. 913, 1884.

<sup>3</sup> *Brooks v. Jenkins*, 3 McLean, 441, 1844.

<sup>4</sup> *Wintermute v. Redington*, 1 Fisher, 239, 1856.

<sup>5</sup> *Newell v. West*, 13 Blatch. 114, 1875.



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; unless such an answer can be based upon the fact that the courts, without examining the question, generally treat such mutual ownership as though it were, undeniably, tenancy in common. It is therefore 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.<sup>1</sup>

§ 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.<sup>2</sup> 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.<sup>3</sup> 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;<sup>4</sup> and doubted by another;<sup>5</sup> though it has been

<sup>1</sup> Blackstone, Book 2, Ch. 25, last paragraph.

<sup>2</sup> *Clum v. Brewer*, 2 Curtis, 523, 1855; *Aspinwall Mfg. Co. v. Gill*, 32 Fed. Rep. 697, 1887; *Grier v. Baynes*, 49 Fed. Rep. 367, 1892.

<sup>3</sup> *Dunham v. Railroad Co.* 7 Bissell, 223, 1876.

<sup>4</sup> *Pitts v. Hall*, 3 Blatch. 207, 1854.

<sup>5</sup> *Dunham v. Railroad Co.* 7 Bissell, 223, 1876.

enforced by a third,<sup>1</sup> and by the Supreme Court of Massachusetts;<sup>2</sup> and by the Supreme Court of New York.<sup>3</sup> Either one of several co-tenants in a patent right may of course sell his right independently of the others;<sup>4</sup> 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.<sup>5</sup>

§ 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, except possibly in a court of equity. This rule follows from the fact that no partition of estates held by tenancy in common was compellable at common law;<sup>6</sup> 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 property which is held under the laws of the States, cannot apply to any property which is created by the laws of the nation. Whether a compulsory partition of a patent right, held by tenants in common, is within the power of courts of equity, is a question upon which there is probably no precedent in the reports.

<sup>1</sup> *Whiting v. Graves*, 3 Bann. & Ard. 225, 1878.

<sup>2</sup> *Vose v. Singer*, 4 Allen (Mass.), 282, 1862.

<sup>3</sup> *De Witt v. Mfg. Co.* 5 Hun (N. Y.), 301, 1875.

<sup>4</sup> *May v. Chaffee*, 2 Dillon, 388, 1871.

<sup>5</sup> *Wiscott v. Agricultural Works*, 11 Fed. Rep. 302, 1882.

<sup>6</sup> Blackstone, Book 2, Ch. 12.



## CHAPTER XII.

### LICENSES.

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|---|---|
| 296. Licenses defined and described.  | 303. Written and oral licenses.   |
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|   | 314. Implied license from actual recovery of a full license fee.  |

§ 296. ANY conveyance of a right under a patent, which does not amount to an assignment or to a grant, is a license.<sup>1</sup> 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.<sup>2</sup> Consistently with this definition, the following have been held to constitute licenses only: an exclusive right to make and sell, but not to use;<sup>3</sup> an exclusive right to make and use, but not to

<sup>1</sup> *Waterman v. Mackenzie*, 138 U. S. 255, 1891; *Seibert Oil Cup Co. v. Lubricator Co.* 34 Fed. Rep. 221, 1888; *Hatfield v. Smith*, 44 Fed. Rep. 355, 1890; *Rice v. Boss*, 46 Fed. Rep. 195, 1891.

<sup>2</sup> *Gayler v. Wilder*, 10 Howard,

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

<sup>3</sup> *Hayward v. Andrews*, 106 U. S. 673, 1882; *Dorsey Rake Co. v. Mfg. Co.* 12 Blatch. 203, 1874.

sell :<sup>1</sup> an exclusive right to use and sell, but not to make :<sup>2</sup> an exclusive right to make, to use, and to sell to be used, for certain purposes, but for no other :<sup>3</sup> and the exclusive conveyance of some, but not all, of the claims of a patent.<sup>4</sup> "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."<sup>5</sup> Any one or two of those 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 practice 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.<sup>6</sup> This practice 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.<sup>7</sup>

§ 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

<sup>1</sup> *Mitchell v. Hawley*, 16 Wallace, 544, 1872; *Rice v. Boss*, 46 Fed. Rep. 195, 1891.

<sup>2</sup> *Hamilton v. Kingsbury*, 17 Blatch. 265, 1879; *Brush Electric Co. v. California Electric Light Co.* 52 Fed. Rep. 959, 1892.

<sup>3</sup> *Gamewell Telegraph Co. v. Brooklyn*, 14 Fed. Rep. 255, 1882; *Jaros Underwear Co. v. Fleece Underwear Co.* 60 Fed. Rep. 623,

1894.

<sup>4</sup> *Pope Mfg. Co. v. Gormully Mfg. Co.* 144 U. S. 249, 1892.

<sup>5</sup> *Adams v. Burke*, 17 Wallace, 456, 1873.

<sup>6</sup> *Greenleaf on Evidence*, Section 277.

<sup>7</sup> *Steam Stone Cutter Co. v. Short-sleeves*, 16 Blatch. 382, 1879; *Brush Electric Co. v. California Electric Light Co.* 52 Fed. Rep. 960, 1892.



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 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.<sup>1</sup> 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.<sup>2</sup>

§ 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.<sup>3</sup> 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.<sup>4</sup>

<sup>1</sup> *Steam Cutter Co. v. Sheldon*, 10 Blatch. 8, 1872.

<sup>2</sup> *Troy Nail Factory v. Corning*, 14 Howard, 193, 1852.

<sup>3</sup> *Steam Stone Cutter Co. v. Short-sleeves*, 16 Blatch. 381, 1879; *Johnson Signal Co. v. Union Switch &*

*Signal Co.* 55 Fed. Rep. 487, 1893.

<sup>4</sup> *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.

§ 299. An express license to sell specimens of a patented thing, does not imply any right to make those specimens, if it can be presumed that they may be obtained by purchase; 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.

§ 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.<sup>1</sup> Nor does a sale, coupled with an express license to use, give any right to use after the license has been forfeited or has expired.<sup>2</sup> 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.<sup>3</sup> And the purchaser of a thing which is useful only in producing a patented article,<sup>4</sup> or in being combined with other things to constitute a patented article,<sup>5</sup> or when used to perform a patented process,<sup>6</sup> gets thereby no right to use his purchased thing for such a purpose.

§ 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

<sup>1</sup> *Wilson v. Stolley*, 3 McLean, 277, 1847.

<sup>2</sup> *Wortendyke v. White*, 2 Bann. & Ard. 25, 1875; *Porter Needle Co. v. National Needle Co.* 17 Fed. Rep. 536, 1883.

<sup>3</sup> *Chambers v. Smith*, 5 Fisher, 14 1870.

<sup>4</sup> *Stevens v. Cady*, 14 Howard, 528,

1852; *Stevens v. Gladding*, 17 Howard, 447, 1854; *Elgin Wind Power Co. v. Nichols*, 65 Fed. Rep. 220, 1894.

<sup>5</sup> *Roosevelt v. Electric Co.* 20 Fed. Rep. 724, 1884.

<sup>6</sup> *United Nickel Co. v. Electrical Works.* 25 Fed. Rep. 479, 1885.



secured by the patent, and may be used as long, or sold as often, as though it had never been subject to a patent.<sup>1</sup> And a restriction is not operative, upon a purchaser of the patented thing, who has no notice of the restriction.<sup>2</sup> The same results 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.<sup>3</sup> 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.<sup>4</sup> Nor can a purchaser lawfully repair his purchased machine, by replacing parts which are patented alone,<sup>5</sup> or which are the main elements of patented sub-combinations;<sup>6</sup> but a purchaser may repair a patented machine which he has purchased, by replacing worn out unpatented parts, so long as the identity of the machine is not destroyed.<sup>7</sup>

§ 302. Express licenses which, if unrestricted, would convey implied rights, may be so restricted that they will not have that effect.<sup>8</sup> 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

<sup>1</sup> *Morgan Envelope Co. v. Albany Paper Co.* 152 U. S. 432, 1894; *Bloomer v. McQuewan*, 14 Howard, 589, 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; *Holiday v. Mattheson*, 24 Fed. Rep. 185, 1885.

<sup>2</sup> *Edison Electric Light Co. v. Goelet*, 65 Fed. Rep. 614, 1894.

<sup>3</sup> *Wilder v. Kent*, 15 Fed. Rep.

217, 1883.

<sup>4</sup> *American Cotton Tie Co. v. Simmons*, 106 U. S. 89, 1882; *Davis Electrical Works v. Edison Electric Light Co.* 60 Fed. Rep. 276, 1894.

<sup>5</sup> *Morgan Envelope Co. v. Albany Paper Co.* 152 U. S. 435, 1894.

<sup>6</sup> *Singer Co. v. Foundry Co.* 34 Fed. Rep. 394, 1888.

<sup>7</sup> *Young v. Foerster*, 37 Fed. Rep. 203, 1889.

<sup>8</sup> *Hamilton v. Kingsbury*, 15 Blatch. 64, 1878; *Hamilton v. Kingsbury*, 17 Blatch. 264, 1879.

sell the patented thing any where in the United States, with intent to have it exported to a foreign country.<sup>1</sup> 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,<sup>2</sup> and cannot be used anywhere in the United States, during certain specified spaces of time.<sup>3</sup>

§ 303. Licenses may be written, or they may be oral.<sup>4</sup> The former have advantages over the latter, because they can be made exclusive, and can usually be proved with more ease and more certainty, and because the latter may sometimes be invalid because obnoxious to some statute of frauds. These points constitute abundant reasons for embodying all such contracts in plain black and white documents, rather than committing them to the "slippery memory of man." And a written license, which purports to be exclusive, will operate as a non-exclusive license, if it was given by one who had authority to give the latter, but not the former kind of license.<sup>5</sup> A license is valid, if made before the patent is issued, as well as if made afterward;<sup>6</sup> and a contract for a license is enforceable as a license, if no formal license is ever given in pursuance of the contract.<sup>7</sup>

§ 304. No license is required to be recorded,<sup>8</sup> and no record of a license affects the rights of any person; for a license is good against the world,<sup>9</sup> whether it is recorded or not,<sup>10</sup> and a purchaser of a patent takes it subject to all

<sup>1</sup> *Dorsey Rake Co. v. Mfg. Co.* 12 Blatch. 204, 1874.

<sup>2</sup> *Wicke v. Kleinknecht*, 1 Bann. & Ard. 608, 1874.

<sup>3</sup> *Mitchell v. Hawley*, 16 Wallace, 544, 1872.

<sup>4</sup> *Jones v. Berger*, 58 Fed. Rep. 1007, 1893; *Union Switch & Signal Co. v. Johnson Signal Co.* 61 Fed. Rep. 944, 1894.

<sup>5</sup> *Union Switch and Signal Co. v. Johnson Signal Co.* 61 Fed. Rep. 943, 1894.

<sup>6</sup> *Brush Electric Co. v. California*

*Electric Light Co.* 52 Fed. Rep. 963, 1892.

<sup>7</sup> *American Paper Bag Co. v. Van Nortwick*, 52 Fed. Rep. 752, 1892.

<sup>8</sup> *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; *Jones v. Berger*, 58 Fed. Rep. 1007, 1893.

<sup>9</sup> *Chambers v. Smith*, 5 Fisher, 14, 1870.

<sup>10</sup> *Farrington v. Gregory*, 4 Fisher, 221, 1870.



outstanding licenses.<sup>1</sup> 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, nor even of its existence. Nor will the fact that the broader document was recorded, and the narrower one unrecorded, alter or affect the operation of this rule.<sup>2</sup> 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.<sup>3</sup>

§ 305. A license from one of several owners in common of a patent right, is as good as if given by all those owners;<sup>4</sup> 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.<sup>5</sup>

§ 306. The construction of a license in writing depends upon the same general rules as the construction of other written contracts.<sup>6</sup> For example, it is to be construed in the light of the circumstances which surrounded its execution.<sup>7</sup> 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.<sup>8</sup> And this is the rule even where the licensor's title accrued to him, after the date of the license.<sup>9</sup>

<sup>1</sup> *Pratt v. Wilcox Mfg. Co.* 64 Fed. Rep. 592, 1893.

<sup>2</sup> *Hamilton v. Kingsbury*, 17 Blatch. 264 and 460, 1880.

<sup>3</sup> *Continental Windmill Co. v. Empire Windmill Co.* 8. Blatch. 295, 1871.

<sup>4</sup> *Dunham v. Railroad Co.* 7 Bissell, 224, 1876.

<sup>5</sup> *Bigelow v. Louisville*, 3 Fisher.

603, 1869.

<sup>6</sup> *Wetherell v. Zinc Co.* 6 Fisher, 50, 1872.

<sup>7</sup> *Burdell v. Denig*, 92 U. S. 722, 1875.

<sup>8</sup> *Dey v. Stellman*, 1 Fisher 487, 1859.

<sup>9</sup> *Pratt v. Wilcox Mfg. Co.* 64 Fed. Rep. 591, 1893.

§ 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.<sup>1</sup> 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 doing by offering to prove the patent to be void.<sup>2</sup> And the licensee must pay the promised royalty, not only on the exact invention claimed in the patent, but also on whatever is near enough like that invention to infringe the patent.<sup>3</sup> Nor can a licensee renounce his license without the consent, acquiescence or fault of the licensor;<sup>4</sup> but a false representation by the licensor to the licensee, of the rate of the royalty paid by other licensees, is such a fault as will entitle the licensee to renounce his license.<sup>5</sup> A license implies 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.<sup>6</sup>

Such an eviction occurs whenever the patent is adjudged void in an interference suit prosecuted in equity in pursuance of Section 4618 of the Revised Statutes, or whenever the patent is repealed by the decree of a court in which an action is brought by the United States for that purpose.<sup>7</sup> Such eviction also occurs whenever the licensee is enjoined from acting under it at the suit of the owner of a senior patent;<sup>8</sup> and, by parity of reasoning, it occurs whenever a judgment or decree is obtained by the owner of a senior

<sup>1</sup> *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; *Pope Mfg. Co. v. Owsley*, 27 Fed. Rep. 105, 1886.

<sup>2</sup> *Burr v. Duryee*, 2 Fisher, 285, 1862.

<sup>3</sup> *St. Paul Plow Works v. Starling*, 140 U. S. 195, 1891.

<sup>4</sup> *St. Paul Plow Works v. Starling*, 140 U. S. 195, 1891.

<sup>5</sup> *Hat-Sweat Mfg. Co. v. Waring* 46 Fed. Rep. 106, 1891; *Hat-Sweat Mfg. Co. v. Porter*, 46 Fed. Rep. 757, 1891.

<sup>6</sup> *White v. Lee*, 14 Fed. Rep. 791, 1882.

<sup>7</sup> *McKay v. Smith*, 39 Fed. Rep. 557, 1889.

<sup>8</sup> *Pacific Iron Works v. Newhall*, 34 Connecticut, 67, 1867.



patent, against the licensee, for an infringement which consisted of acting under the license, but not when such a suit is merely proposed to be brought by the owner of a senior patent.<sup>1</sup>

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. But a single successful defiance is not enough to constitute such an eviction.<sup>2</sup> Nor does such an eviction result from the patentee granting later licenses at lower rates.<sup>3</sup>

§ 308. A license not expressly limited in duration, continues till the patent expires or the license is forfeited.<sup>4</sup> 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.<sup>5</sup> 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 relative to the place of payment, and from lack of demand from the licensor.<sup>6</sup> 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

<sup>1</sup> *American Electric Co. v. Consumers Gas Co.* 47 Fed. Rep. 43, 1891; *Consumers Gas Co. v. Electric Co.* 50 Fed. Rep. 778, 1892.

<sup>2</sup> *Pope Mfg. Co. v. Owsley*, 27 Fed. Rep. 108, 1886.

<sup>3</sup> *McKay v. Smith*, 39 Fed. Rep. 557, 1889; *National Rubber Co. v. Rubber Shoe Co.* 41 Fed. Rep. 48, 1890.

<sup>4</sup> *St. Paul Plow Works v. Starling*, 140 U. S. 195, 1891.

<sup>5</sup> *White v. Lee*, 5 Bann. & Ard. 572, 1880; *Consolidated Purifier Co.*

*v. Wolf*, 28 Fed. Rep. 814, 1886; *Densmore v. Tanite Co.* 32 Fed. Rep. 544, 1887; *Seibert Oil Cup Co. v. Lubricator Co.* 34 Fed. Rep. 221, 1888; *Hammacher v. Wilson*, 26 Fed. Rep. 241, 1886; *Washburn and Moen Mfg. Co. v. Wire Fence Co.* 42 Fed. Rep. 675, 1890; *Brush Electric Co. v. California Electric Light Co.* 52 Fed. Rep. 964, 1892; *Platt v. Fire Extinguisher Mfg. Co.* 59 Fed. Rep. 900, 1894.

<sup>6</sup> *Dare v. Boylston*, 6 Fed. Rep. 493, 1880

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.<sup>1</sup> 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;<sup>2</sup> and an injunction will issue to prevent a threatened wrongful declaration of forfeiture.<sup>3</sup>

§ 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.<sup>4</sup> 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.<sup>5</sup> If there is an exception to this rule, that exception exists where 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 the point has been raised and considered.<sup>6</sup> 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.<sup>7</sup> If the licensor selects the second of the remedies mentioned in this section he must sue at law and not in equity.<sup>8</sup>

<sup>1</sup> *Wood v. Wells*, 6 Fisher 383, 1873; *Steam Cutter Co. v. Sheldon*, 10 Blatch, 1, 1872.

<sup>2</sup> *Insurance Co. v. Eggleston*, 96 U. S. 572, 1877.

<sup>3</sup> *Baker Mfg. Co. v. Washburn & Moen Mfg. Co.* 18 Fed. Rep. 172, 1883.

<sup>4</sup> *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; *Starling v. Plow Works*, 32 Fed. Rep. 290, 1887.

<sup>5</sup> *Woodworth v. Cook*, 2 Blatch.

160, 1850; *Burr v. Duryee*, 2 Fisher, 283, 1862, *Brown v. Lapham*, 27 Fed. Rep. 77, 1886.

<sup>6</sup> *Wooster v. Mfg. Co.* 23 Off. Gaz. 2513, 1883.

<sup>7</sup> *Pope Mfg. Co. v. Gormully*, 144 U. S. 232, 1892.

<sup>8</sup> *Consolidated Purifier Co. v. Wolf*, 28 Fed. Rep. 816, 1886; *Crandall v. Plano Mfg. Co.* 24 Fed. Rep. 738, 1885; *Washburn & Moen Mfg. Co. v. Freeman Wire Co.* 41 Fed. Rep. 410, 1890; *Washburn & Moen Mfg. Co. v. Barbed Wire Co.* 42 Fed. Rep. 675, 1890.



§ 310. No license is assignable by the licensee to another, unless it contains words which show that it was intended to be assignable.<sup>1</sup> 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."<sup>2</sup> 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.<sup>3</sup> So also, a license to a corporation, will protect a receiver who is authorized to manage its business during its embarrassments.<sup>4</sup> But a receiver who is appointed in supplementary proceedings, under the New York Code of Civil Procedure, to settle the business of an insolvent individual, does not acquire any right to an unassignable license which belonged to the insolvent person.<sup>5</sup>

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;<sup>6</sup> but where such a dissolution ends the business of the partnership, the license

<sup>1</sup> *Troy Factory v. Corning*, 14 Howard, 193, 1852; *Rubber Co. v. Goodyear*, 9 Wallace, 788, 1869; *Hapgood v. Hewitt*, 119 U. S. 226, 1886; *Baldwin v. Sibley*, 1 Clifford, 150, 1858; *Searls v. Bouton*, 12 Fed. Rep. 143, 1882; *Bull v. Pratt*, 1 Connecticut, 342, 1815; *Adams v. Howard*, 22 Fed. Rep. 657, 1884; *Waterman v. Shipman*, 55 Fed. Rep. 986, 1893.

<sup>2</sup> *Hamilton v. Kingsbury*, 15 Blatch. 69, 1878.

<sup>3</sup> *Lightner v. Railroad Co.* 1 Lowell, 338, 1869.

<sup>4</sup> *Emigh v. Chamberlin*, 2 Fisher, 192, 1861.

<sup>5</sup> *Waterman v. Shipman*, 55 Fed. Rep. 985, 1893.

<sup>6</sup> *Belding v. Turner*, 8 Blatch. 321, 1871.

lapses;<sup>1</sup> except that a receiver appointed to wind up the partnership affairs, may invoke the license to protect him in so doing.<sup>2</sup> But a license to one person gives no right to any partner of that person, or to any corporation organized by the licensee;<sup>3</sup> and if it authorizes the licensee to act only at a particular place, it will not protect any of his doings elsewhere.<sup>4</sup> And no license to a man and any partner he may take, will protect any assignee of that man when acting alone.<sup>5</sup> Nor does an unassignable license pass to an executor or administrator of a deceased licensee.<sup>6</sup> 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 license;<sup>7</sup> or ratifies the transfer of the license, by otherwise treating the assignee as the licensee was entitled to be treated.<sup>8</sup>

Assignable licenses are assignable only in their entirety; unless they expressly or impliedly authorize their assignment in parts, and to a plurality of persons.<sup>9</sup> And the royalties payable to a licensor are assignable by him; and the assignee's rights to those royalties follow the license, when it is assigned to a person who has notice of those rights.<sup>10</sup> The purchaser of a license takes it subject to all the restrictions connected therewith, whether he has notice of those restrictions or not;<sup>11</sup> and subject to liability for the same rate of royalty for his doings, that the licensee

<sup>1</sup> *Haffcke v. Clark*, 50 Fed. Rep. 531, 1892.

<sup>2</sup> *Montrose v. Mabie*, 30 Fed. Rep. 234, 1887.

<sup>3</sup> *Eclipse Windmill Co. v. Windmill Co.* 24 Fed. Rep. 650, 1885.

<sup>4</sup> *Rubber Co. v. Goodyear*, 9 Wallace, 788, 1869.

<sup>5</sup> *Gibbs v. Hoefner*, 19 Fed. Rep. 324, 1884.

<sup>6</sup> *Oliver v. Chemical Works*, 109 U. S. 81, 1883.

<sup>7</sup> *Bloomer v. Gilpin*, 4 Fisher, 55, 1859.

<sup>8</sup> *Hammond v. Organ Co.* 92 U. S. 724, 1875; *Lane & Bodley Co. v. Locke*, 150 U. S. 196, 1893.

<sup>9</sup> *Brooks v. Byam*, 2 Story, 545, 1843; *Consolidated Fruit Jar Co. v. Whitney*, 1 Bann. & Ard. 356, 1874; *Adams v. Howard*, 22 Fed. Rep. 656, 1884; *Brush Electric Co. v. California Electric Light Co.* 52 Fed. Rep. 964, 1892.

<sup>10</sup> *Grier v. Baynes*, 46 Fed. Rep. 524, 1891.

<sup>11</sup> *Chambers v. Smith*, 5 Fisher, 12, 1870.



would have had to pay for similar acts ;<sup>1</sup> 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.<sup>2</sup>

§ 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 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.<sup>3</sup> 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 proved 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* or a royalty, than to imply that the

<sup>1</sup> Paper Stock Co. v. Disinfecting Co. 147 Mass. 323, 1888.

<sup>2</sup> Goodyear v. Rubber Co. 3 Blatch. 449, 1856.

<sup>3</sup> Blanchard v. Sprague, 1 Cliff.

297, 1859; Seibert Oil Cup Co. v. Lubricator Co. 34 Fed. Rep. 221, 1888; Keyes v. Eureka Mining Co. 158 U. S. 150, 1895.

patentee donated the use of his invention to the user, or to imply that the user unlawfully seized upon the invention of the patentee.<sup>1</sup> But where the patentee was specially employed by the user to develop the business of the latter, at the time the former made the invention used in that business; the law implies a license to continue that use without paying royalty.<sup>2</sup> In no case, however, can a license be implied from acquiescence, unless the licensor had knowledge of the thing acquiesced in; nor can acquiescence 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.<sup>3</sup> 6. That act must be hurtful to the party acting, in case the estoppel is not enforced in his favor.<sup>4</sup>

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

<sup>1</sup> *United States v Palmer*, 128 U. S. 269, 1888; *McKeever v. United States*, 23 Off. Gaz. 1527, 1883; *Drainage Construction Co. v. Chelsea*, 41 Fed. Rep. 47, 1890.

<sup>2</sup> *Solomons v. United States*, 137 U. S. 346, 1890; *Lane & Bodley Co. v. Locke*, 150 U. S. 198, 1893; *McAler v. United States*, 150 U. S. 431, 1893; *Barry v. Mfg. Co.* 22 Fed. Rep. 397, 1884; *Herman v. Herman*, 29 Fed. Rep. 94, 1886; *Solomons v. United States*, 21 Court of Claims,

483, 1886; 22 Court of Claims, 342, 1887; *Withington-Cooley Mfg Co. v. Kinney*, 68 Fed. Rep. 505, 1895.

<sup>3</sup> *M'Millin v. Barclay*, 5 Fisher, 201, 1871; *Bigelow on Estoppel*, Ch. 18, p. 437.

<sup>4</sup> *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.



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. And where a person sells a patent which employs an invention which infringes a prior patent; the person selling is estopped from bringing an action against his grantee for that infringement; and that estoppel operates as a license, not only as against the seller but also as against owners in common with him of the prior patent.<sup>1</sup> And where an inventor before applying for a patent thereon, sells a specimen of his invention to a manufacturer, who avowedly buys it to copy it, by making other specimens for sale, and where the seller gives the buyer no notice of intention to apply for a patent on that invention; the inventor is estopped from bringing an action on such a patent against any one, for using or selling a specimen of the invention which was made by the purchaser from him.<sup>2</sup>

§ 314. An actual recovery of a full license fee for making, and selling to others to be used, though not an unsatisfied judgment or decree therefor, operates as an implied license to any purchaser of the thing thus made and sold, to use it to the same extent that he could lawfully have

<sup>1</sup> *Curran v. Burdsall*, 20 Fed. Rep. 835, 1883.

<sup>2</sup> *Anderson v. Eiler*, 50 Fed. Rep. 775, 1892

done, if the maker had been licensed to make and sell it.<sup>1</sup> But where the money recovered in an infringement suit for unlicensed making and selling a specimen of a patented thing, is recovered as damages for such making and selling alone; that recovery does not operate as an implied license authorizing the use of that specimen.<sup>2</sup> And where an action in equity, against an infringing user of a patented thing, is brought to recover the profits which he derived from that use; that action cannot be successfully resisted on the ground that the profits, which the infringing maker, or an infringing seller of that thing, derived from his infringement, have already been recovered from him; because each infringer is liable, in equity, for his own profits only;<sup>3</sup> and because the payment to the owner of a patent, of the profits which one infringer has reaped from infringement, cannot operate in equity, to relieve another infringer from liability to the owner of the patent for other profits which he derived, either from the same infringement or from a different infringement, connected or disconnected therewith. Therefore the existence of a decree for profits against a manufacturer for making and selling a patented article, does not constitute any defence to a suit for infringement brought against a user of the very same article.<sup>4</sup> And no action of a patentee, by way of suit, or by way of amicable collection of money for infringement against an infringing maker or seller of a patented article, can deprive

<sup>1</sup> *Spaulding v. Page*, 1 Sawyer, 709, 1871; *Gilbert & Barker Mfg. Co. v. Bussing*, 12 Blatch. 426, 1885; *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; *Stutz v. Armstrong*, 25 Fed. Rep. 147, 1885; *Fisher v. Amador Mine*, 25 Fed. Rep. 201, 1885; *Tuttle v. Matthews*, 28 Fed. Rep. 98, 1886; *American Bell Telephone Co. v. Albright*, 32 Fed. Rep. 287, 1887.

<sup>2</sup> *Birdsell v. Shaliol*, 112 U. S. 445, 1884; *Kolley v. Ypsilanti Mfg. Co.* 44 Fed. Rep. 21 1890; *New York Filter Co. v. Schwarzwald*, 58 Fed. Rep. 579, 1893; *Philadelphia Trust Co. v. Edison Electric Light Co.* 65 Fed. Rep. 554, 1895.

<sup>3</sup> *Elizabeth v. Pavement Co.* 97 U. S. 140, 1877; *Tatham v. Lowber*, 4 Blatch. 87, 1857; *Covert v. Sargent*, 38 Fed. Rep. 238, 1889.

<sup>4</sup> *Tuttle v. Matthews*, 28 Fed. Rep. 98, 1886.



any licensee of the patentee, who has the exclusive right to use the patented article in a given territory, of the right to collect money from the user in that territory, of the very infringing article which was involved in the suit or settlement between the patentee and the manufacturer or seller of that article. 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.<sup>1</sup>

<sup>1</sup> *Suffolk Co. v. Hayden*, 3 Wall. 315, 1865.

## CHAPTER XIII.

### INTERFERING PATENTS.

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

§ 315. PATENTS which contain one or more claims in common, are interfering patents.<sup>1</sup> But a generic claim, and a specific claim, the first of which secures a particular process or mechanism, with its indispensable characteristics, with or without its minor features, and the last of which secures the same process or mechanism, with but not without its minor features, are not co-extensive claims, and therefore do not interfere with each other.<sup>2</sup> All but one of several interfering 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.<sup>3</sup> 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 erro-

<sup>1</sup> Nathan Mfg. Co. v. Craig, 49 Fed. Rep. 370, 1892; Dederick v. Fox, 56 Fed. Rep. 717, 1893.

<sup>2</sup> Stonementz Mach. Co. v. Brown

Mach. Co. 57 Fed. Rep. 605, 1893.

<sup>3</sup> Gold and Silver Ore Co. v. Disintegrating Ore Co. 6 Blatch. 311, 1869.



neous 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, and if, in that interference proceeding, the latter 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.<sup>1</sup> The Commissioner has however no authority to recall the patent theretofore 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.<sup>2</sup> Such an action may be joined with an action for infringement,<sup>3</sup> where the complainant's patent was issued first. But where the defendant's patent was issued first, an action for infringement of the complainant's patent by the defendant, cannot be joined with such an interference action.<sup>4</sup> And where such a suit in equity is brought without joining an action for infringement therewith; a cross bill, based on alleged infringement by the complainant of the defendant's patent, is not proper.<sup>5</sup> Nor is a cross bill proper, which seeks to institute an interference action, in response to an action for infringement alone.<sup>6</sup> The

<sup>1</sup> Revised Statutes, Section 4904; *Hubel v. Dick*, 28 Fed. Rep. 139, 1886.

<sup>2</sup> Revised Statutes, Section 4918.

<sup>3</sup> *Leach v. Chandler*, 18 Fed. Rep. 262, 1883; *Swift v. Jenks*, 29 Fed. Rep. 642, 1887; *Holliday v. Pick-*

*hardt*, 29 Fed. Rep. 853, 1887.

<sup>4</sup> *American Roll-Paper Co. v. Knopp*, 44 Fed. Rep. 611, 1891.

<sup>5</sup> *Stonemetz Mach. Co. v. Brown Mach. Co.* 46 Fed. Rep. 851, 1891.

<sup>6</sup> *New Departure Bell Co. v. Hardware Co.* 62 Fed. Rep. 462, 1894.

complainant in an interference suit may be the patentee or assignee of either of the interfering patents, or a grantee or licensee thereunder; for all 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 are inhabitants of the district where the suit is brought, or who shall be found in that district.<sup>1</sup>

A bill cannot be filed in an interference suit until the complainant's patent is actually granted;<sup>2</sup> and until the defendant'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.<sup>3</sup> And the defendant's right to such relief prevents the complainant from dismissing his bill without the defendant's consent.<sup>4</sup>

<sup>1</sup> 18 Statutes at Large, Part 3, Ch. 137, Sec. 1, p. 470. *In re Hohorst*, 150 U. S. 661, 1893.

<sup>2</sup> *Hoeltge v. Hoeller*, 2 Bond, 388, 1870.

<sup>3</sup> *Lockwood v. Cleveland*, 6 Fed. Rep. 721, 1884.

<sup>4</sup> *Electric Accumulator Co. v. Brush Electric Co.* 44 Fed. Rep. 606, 1890.

§ 317. There may be an issue of law in an interference suit depending upon the construction of the various letters patent involved therein, and consisting of the question of the presence or absence of interference between them; and such an issue when it arises in such a suit, may be decided on a demurrer.<sup>1</sup> 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.<sup>2</sup> And the complainant's interfering claim is void for want of novelty, if the defendant's invention is found to antedate the other.<sup>3</sup> 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 could attack the complainant's patent on the ground that a third person anticipated the complainant's invention, he could, 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

<sup>1</sup> *Morris v. Mfg. Co.* 20 Fed. Rep. 121, 1884

<sup>2</sup> *Pacific Cable Ry. Co. v. Butte City Ry. Co.* 52 Fed. Rep. 865, 1892.

<sup>3</sup> *National Cash Register Co. v. Lamson Store Service Co.* 60 Fed. Rep. 603, 1894:



misapprehend its purpose and misconstrue its language.<sup>1</sup>

§ 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.<sup>2</sup> The Commissioner's decision is weighty,<sup>3</sup> but 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 the residue of the world.<sup>4</sup>

The law of evidence, if applicable to depositions taken in a Patent Office interference, would make those depositions admissible in a subsequent interference suit between the same parties on the same question of priority.<sup>5</sup> But Judge SHIRAS has held that such depositions are not thus admissible, where there is no insuperable obstacle to retaking the testimony of the deponents.<sup>6</sup>

§ 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,

<sup>1</sup> *Pentlarge v. Pentlarge*, 19 Fed. Rep. 817, 1884; *Lockwood v. Cleveland*, 20 Fed. Rep. 164, 1884; *American Clay Bird Co. v. Clay Pigeon Co.* 31 Fed. Rep. 467, 1887; *Nathan Mfg. Co. v. Craig*, 47 Fed. Rep. 522, 1891.

<sup>2</sup> *Pacific Cable Ry. Co. v. Butte City Ry. Co.* 52 Fed. Rep. 865, 1892; *Wire Book Sewing Machine Co. v. Stevenson*, 11 Fed. Rep. 155,

1882; *Chicopee Folding Box Co. v. Rogers*, 32 Fed. Rep. 695, 1887.

<sup>3</sup> *Appleton v. Ecaubert*, 62 Fed. Rep. 747, 1894.

<sup>4</sup> *Union Paper Bag Machine Co. v. Crane*, 1 Holmes, 429, 1874.

<sup>5</sup> 1 Greenleaf on Evidence, Section 553.

<sup>6</sup> *Clow v. Baker*, 36 Fed. Rep. 692, 1888.

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."<sup>1</sup> 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."<sup>2</sup> 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 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.<sup>3</sup> 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

<sup>1</sup> *Potter v. Dixon*, 5 Blatch. 165, 1876.  
1863.

<sup>2</sup> *Asbestos Felting Co. v. Salamander Felting Co.* 13 Blatch. 454,

1876.  
<sup>3</sup> *Gilmore v. Golay*, 3 Fisher, 522, 1869; *Sturges v. Van Hagan*, 6 Fisher, 572, 1873.

such a decree does not necessarily involve any such conclusion.<sup>1</sup> 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.

<sup>1</sup> *Tyler v. Hyde*, 2 Blatch. 310, 1851.



## CHAPTER XIV.

### REPEAL OF PATENTS.

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,<sup>1</sup> or constitute a mistake.<sup>2</sup> 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.<sup>3</sup> 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 Courts will repeal a patent which United States 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 inventions where they were obtained by fraud, whenever

<sup>1</sup> Railroad Co. v. Dubois, 12 Wallace, 64, 1870.

1869.

<sup>2</sup> Doughty v. West, 6 Blatch, 433,

<sup>3</sup> Mowry v. Whitney, 14 Wallace, 439, 1871.

the United States files a bill stating the facts and praying that the letters may be annulled.<sup>1</sup> And the same jurisdiction exists, where such letters patent are issued by any such mistake as those for which courts of equity grant relief, except so far as the peculiar provisions of the patent statutes may limit the general rule; but this jurisdiction to repeal letters patent, which may be claimed to have been issued by mistake, does not extend to error of judgment in deciding any debatable question of difference of invention.<sup>2</sup>

§ 323. A bill to repeal a patent must be filed by the United States;<sup>3</sup> acting through the United States district attorney of the district wherein it is filed;<sup>4</sup> and he acts under the direction of the Attorney General of the United States;<sup>5</sup> and it must be filed in the Circuit Court of the United States for that district;<sup>6</sup> and be filed before the expiration of the patent which it seeks to repeal.<sup>7</sup> 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.<sup>8</sup> The mere pendency of a bill to repeal a patent, will not affect the progress of an infringement suit based on that patent;<sup>9</sup> and no injunction will issue to restrain a patentee from bringing infringement suits, pending a bill in equity to repeal the patent upon which he proposes to bring them.<sup>10</sup>

<sup>1</sup> *United States v. Bell Telephone Co.* 128 U. S. 373, 1888.

<sup>2</sup> *Bell Telephone Co. v. United States*, 68 Fed. Rep. 565, 1895.

<sup>3</sup> *Mowry v. Whitney*, 14 Wallace, 440, 1871.

<sup>4</sup> *Attorney General v. Rumford Chemical Works*, 2 Bann. & Ard. 308, 1876.

<sup>5</sup> *United States v. Bell Telephone Co.* 128 U. S. 350, 1888.

<sup>6</sup> Revised Statutes, Section 629,

p. 9.

<sup>7</sup> *Bourne v. Goodyear*, 9 Wallace, 811, 1869.

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

<sup>9</sup> *American Bell Telephone Co. v. National Telephone Co.* 27 Fed. Rep. 666, 1886.

<sup>10</sup> *United States v. Colgate*, 21 Fed. Rep. 318, 1884.

## CHAPTER XV.

### QUI TAM ACTIONS.

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|--|---|
| 324. <i>Qui tam</i> actions, defined and described as they exist in the patent laws.                                       | 329. The amount of the recoverable penalty.   |
| 325. The wrongs which are the foundations of such actions.   | 330. The parties in <i>qui tam</i> patent cases.  |
| 326. The first two of those three classes of wrongs.   | 331. The forum for <i>qui tam</i> patent actions.   |
| 327. The third of those three classes of wrongs.   | 332. The form of the suit, and the requisites of a declaration, in such an action.        |
| 328. Wrongs of either class are completed when the articles are illegally marked, without any subsequent using or selling. | 333. Injunctions to restrain the commission of wrongs of either of the first two classes. |
|  | 334. Appeals in <i>qui tam</i> patent cases.  |

§ 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 can not 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;"<sup>1</sup> and that other persons shall not so mark such articles.<sup>2</sup> 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. But the second of the forbidden acts is not committed by marking the word "patented" upon a case containing patented articles of such a character that they could have been thus marked.<sup>3</sup>

§ 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

<sup>1</sup> Revised Statutes, Section 4900.

<sup>3</sup> *Smith v. Walton*, 51 Fed. Rep.

<sup>2</sup> Revised Statutes, Section 4901.

17, 1892; 56 Fed. Rep. 499, 1893.

as being patented. When an unpatented thing is so marked, it is immaterial whether it is a patentable thing or not.<sup>1</sup> This point is so clear that it would not be thought to require or admit elaboration, had not a judge in one case expressed a contrary opinion.<sup>2</sup> 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 upon 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 must exist at the time of the marking;<sup>3</sup> and it does not exist when the person marking, is himself mistaken relevant to his right so to mark;<sup>4</sup> 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.<sup>5</sup> 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.<sup>6</sup> That burden can be carried

<sup>1</sup> *Olliphant v. Salem Flouring Mills Co.* 5 Sawyer, 128, 1878; *Winne v. Snow*, 19 Fed. Rep. 509, 1844.

<sup>2</sup> *United States v. Morris*, 2 Bond, 1866.

<sup>3</sup> *Hotchkiss v. Wooden Ware Co.* 53 Fed. Rep. 1018, 1891.

<sup>4</sup> *Walker v. Hawxhurst*, 5 Blatch. 494, 1867; *Russell v. Newark Machine Co.* 55 Fed. Rep. 300, 1893.

<sup>5</sup> *Wilson v. Mfg. Co.* 12 Fed. Rep. 57, 1882.

<sup>6</sup> *Brig Struggle v. United States*, 9 Cranch, 74; 1815.

by showing that the person marking, honestly believed that the thing marked was really patented by a particular patent; but it cannot be carried by showing that the person marking did not know whether the article marked was patented or not; and the question whether a particular thing marked patented is really patented by a particular patent, is a question of construction for the Court.<sup>1</sup> Where the defendant is a corporation, the intent to deceive the public may be that of an officer or agent, who acted within the scope of his authority, in causing the marked article to be made and prepared for sale.<sup>2</sup> The forbidden act treated in this section, is not committed by marking upon a patented article the number and date of a patent which does not cover it, where it is also marked with the number and date of a patent which does cover it.<sup>3</sup>

§ 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 offence is complete, and is not condoned by a subsequent omission to profit by that offence; but where a person marks an article without any intent to deceive, and afterward uses the article so marked for purposes of deception, he does not violate the statute.<sup>4</sup> Where a person illegally marks an article in one judicial district of the United States, and offers it for sale in another, he violates the statute in the former district but not in the latter.<sup>5</sup>

§ 329. The penalty prescribed by the statute for either of the forbidden acts is "not less than one hundred dollars;"

<sup>1</sup> *Tompkins v. Butterfield*, 25 Fed. Rep. 556, 1885.

<sup>2</sup> *Tompkins v. Butterfield*, 25 Fed. Rep. 559, 1885; *Hotchkiss v. Wooden Ware Co.* 53 Fed. Rep. 1018, 1891.

<sup>3</sup> *Russell v. Newark Machine Co.* 55 Fed. Rep. 300, 1893.

<sup>4</sup> *Nichols v. Newell*, 1 Fisher, 647, 1853.

<sup>5</sup> *Pentlarge v. Kirby*, 19 Fed. Rep. 504, 1884.



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.<sup>1</sup> And Judge THAYER instructed a jury that where several unpatented articles are marked "patented" on the same day, and at the same time, so that the act of marking is practically continuous, but one offence is committed under the statute, and only a single penalty is recoverable for all the articles thus marked.<sup>2</sup>

§ 330. The plaintiff in a *qui tam* action for illegally marking a patented or unpatented article may be any "person,"<sup>3</sup> whether he was injured by the doings of the defendant or not.<sup>4</sup> 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.<sup>5</sup> 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,<sup>6</sup> though it is not improper for him to state that he sues for the United States, as well as for himself.<sup>7</sup>

The defendant may be the particular natural person who did the marking complained of. The death of the defendant will end a *qui tam* patent case, and will terminate the right of action on which it is based.<sup>8</sup>

§ 331. Jurisdiction in *qui tam* actions, unlike that in other kinds of patent suits, is conferred upon District Courts, not

<sup>1</sup> *Simpson v. Pond*, 2 Curtis, 502, 1846.  
1855.

<sup>2</sup> *Hotchkiss v. Wooden Ware Co.*  
53 Fed. Rep. 1021, 1891.

<sup>3</sup> Revised Statutes, Section 4901.

<sup>4</sup> *Winne v. Snow*, 19 Fed. Rep.  
508, 1884.

<sup>5</sup> *Ferrett v. Atwill*, 1 Blatch. 153,

<sup>6</sup> *United States v. Morris*, 2 Bond  
27, 1866.

<sup>7</sup> *Winne v. Snow*, 19 Fed. Rep.  
508, 1884.

<sup>8</sup> *Schreiber v. Sharpless*, 17 Fed.  
Rep. 589, 1883.

upon Circuit Courts, of the United States, and is conferred upon the particular court within the district of which the forbidden act was committed.<sup>1</sup>

§ 332. The proper form of common law action in *qui tam* cases is that of debt.<sup>2</sup> 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.<sup>3</sup> 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;<sup>4</sup> and to charge that the act was contrary to the form of the statute in such cases made and provided.<sup>5</sup> It is not enough to charge that the act was contrary to the law in such cases made and provided,<sup>6</sup> 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.<sup>7</sup> It is not necessary to aver the uses to which the penalty, when recovered, is to be applied.<sup>8</sup> A declaration, complaint or petition in a *qui tam* patent case, is tested in point of sufficiency by the rules applicable to civil actions in the State in which the District Court is established, when that sufficiency is drawn in question in that court.<sup>9</sup>

§ 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

<sup>1</sup> Revised Statutes, Section 4901; *Winne v. Snow*, 19 Fed. Rep. 509, 1884; *Pentlarge v. Kirby*, 19 Fed. Rep. 505, 1884.

<sup>2</sup> *Stimpson v. Pond*, 2 Curtis, 505, 1855; *Jacob v. United States*, 1 Brockenbrough, 520, 1821.

<sup>3</sup> Revised Statutes, Sections 721, 914.

<sup>4</sup> *Ferrett v. Atwill*, 1 Blatch. 155, 1846.

<sup>5</sup> *Sears v. United States*, 1 Gallison, 259, 1812.

<sup>6</sup> *Smith v. United States*, 1 Gallison, 264, 1812.

<sup>7</sup> *Kenrick v. United States*, 1 Gallison, 273, 1812.

<sup>8</sup> *Sears v. United States*, 1 Gallison, 259, 1812.

<sup>9</sup> *Fish v. Manning*, 31 Fed. Rep. 340, 1887.

used. So also, such acts may enable infringers to palm off on the public an inferior article, the using of which will disappoint the purchaser, 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.<sup>1</sup>

§ 334. A writ of error lies to the Circuit Court of Appeals for the circuit from the final judgment of a District Court in a *qui tam* patent case; but no such writ of error lies from a Circuit Court of Appeals to the Supreme Court of the United States; though such a case may go to the latter tribunal upon a certificate from the former, or upon a certiorari from the Supreme Court.<sup>2</sup>

<sup>1</sup> Washburn & Moen Mfg. Co. v. Halsh, 4 Bann. & Ard. 571, 1879.

<sup>2</sup> 26 Statutes at Large, Chap. 517, Sec. 6.



## CHAPTER XVI.

### INFRINGEMENT.

335. Infringement of process patents, illustrated by the case of *Tilghman v. Proctor*.
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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,<sup>1</sup> and whether he uses the materials prescribed by the patent, or uses equivalents therefor.<sup>2</sup> 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 containing 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

<sup>1</sup> *Tilghman v. Proctor*, 102 U. S. 780, 1880.

<sup>2</sup> *Schwarzwalder v. Filter Co.* 66 Fed. Rep. 158, 1895.



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*.<sup>1</sup> The patent in that case covered a process, which consists 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. 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

<sup>1</sup> *Mowry v. Whitney*, 14 Wallace, 620, 1871.



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*<sup>1</sup> 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

<sup>1</sup> *Cochrane v. Deener*, 94 U. S. 787, 1876.

by the supposed infringer, unless some equivalent act is substituted for the one omitted.<sup>1</sup> 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.<sup>2</sup> An addition to a patented process does not avert infringement, even where the addition is an improvement.<sup>3</sup>

§ 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;<sup>4</sup> because a patent covers only what it claims. But whoever infringes any one claim of a patent infringes the

<sup>1</sup> *Royer v. Coupe*, 148 U. S. 531, 1892; *Dittmar v. Rix*, 1 Fed. Rep. 342, 1880; *Hammerschlag v. Garrett*, 10 Fed. Rep. 479, 1882; *Cotter v. Copper Co.* 13 Fed. Rep. 234, 1882; *Arnold v. Phelps*, 20 Fed. Rep. 315, 1884; *Brush Electric Co. v. Jullen Electric Co.* 41 Fed. Rep. 679, 1890; *Brush Electric Co. v. Accumulator Co.* 47 Fed. Rep. 49, 1891.

<sup>2</sup> *Roberts v. Roter*, 5 Fisher, 206, 1872.

<sup>3</sup> *Lalanc & Grosjean Mfg. Co. v.*

*Habermann Mfg. Co.* 53 Fed. Rep. 380, 1892; *Tuttle v. Matthews*, 28 Fed. Rep. 98, 1886; *New York Filter Co. v. Schwarzwald* 58 Fed. Rep. 579, 1893; *Edison Electric Light Co. v. Philadelphia Trust Co.* 60 Fed. Rep. 398, 1894.

<sup>4</sup> *Howe v. Williams*, 2 Cliff. 262, 1868; *Waterbury Brass Co. v. Miller*, 9 Blatch. 93, 1871; *Toohy v. Harding*, 4 Hughes, 253, 1880; *Buffington's Iron Building Co. v. Eustis*, 65 Fed. Rep. 807, 1895.



patent, whether or not it contains other claims which he does not infringe.<sup>1</sup>

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 sometimes 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.<sup>2</sup> To hold the contrary of this rule would be to retard, and not to promote the progress of the useful arts.<sup>3</sup> So also, on the other hand, the result of an alleged infringing machine or manufacture may be entirely different from the result described in the patent without causing that machine or manufacture 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

<sup>1</sup> *Moody v. Fiske*, 2 Mason, 115, 1820; *Wyeth v. Stone*, 1 Story, 278, 1840; *Pitts v. Whitman*, 2 Story, 609, 1848; *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. Bro-*

*die*, 1 Woods, 158, 1871; *McComb v. Ernest*, 1 Woods, 195, 1871.

<sup>2</sup> *O'Reilly v. Morse*, 15 Howard, 62, 1853; *Steam Gauge & Lantern Co. v. Mfg. Co.* 29 Fed. Rep. 447, 1886.

<sup>3</sup> *Smith v. Downing* 1 Fisher, 84, 1850.



patent to use any machine or manufacture claimed therein, though such use is for a purpose which is not mentioned in the patent.<sup>1</sup> But it has been held that a machine, which can do a particular kind of work, is not an infringement of a patent on a different machine, which cannot do the same work.<sup>2</sup>

§ 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;<sup>3</sup> 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 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 patent<sup>4</sup> covered a machine which

<sup>1</sup> Mable v. Haskell, 2 Cliff. 511, 1865; McComb v. Brodie, 1 Woods, 169, 1871; Zinn v. Weiss 7 Fed. Rep. 916, 1881; Union Stone Co v. Allen, 14 Fed. Rep. 853, 1882; Cincinnati Ice Machine Co. v. Brewing Co. 81 Fed. Rep. 472, 1887.

<sup>2</sup> Norton v. Jensen, 49 Fed. Rep.

875, 1892.

<sup>3</sup> Field v. De Comeau, 116 U. S. 187, 1886; Yale Lock Co. v. Sargent, 117 U. S. 378, 1886; Smith v. Downing, 1 Fisher, 83, 1850; Eames v. Cook, 2 Fisher, 149, 1860.

<sup>4</sup> Cawood Patent, 94 U. S. 706, 1876.

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 practiced by driving into the ground a long tube closed and pointed at its lower 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 rarefies the air in the tube, and outside of the tube in the neighborhood of its lower end, and that rarefaction causes the air above the ground to force the water in several millions of cubic feet of the surrounding earth, into and up the tube.

The alleged infringer in one case,<sup>1</sup> 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 auger larger than the tube which he placed in the hole after the auger was withdrawn. This apparently slight

<sup>1</sup> *Andrews v. Long*, 12 Fed. Rep. 871, 1880.



change caused the well to have a substantially different mode of operation from that covered by the patent. The pump, indeed, rarefied the air in the tube as before, but that rarefaction did not extend into the ground around the outside of the tube, because the space outside of the lower end of the tube was in direct communication with 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.

§ 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 case<sup>1</sup> 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,

<sup>1</sup> Blanchard v. Reeves, 1 Fisher, 103, 1850.



secured to the frame of the lathe, and having special devices to make it work 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 case<sup>1</sup> 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.<sup>2</sup> 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*,<sup>3</sup> 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

<sup>1</sup> *Waterbury Brass Co. v. Miller*, 1868.  
9 Blatch. 94, 1871.

<sup>2</sup> *Burr v. Duryee*, 1 Wallace, 581,      <sup>3</sup> *Winans v. Denmead*, 15 How-  
ard, 380, 1853.

which they stated were deducible from that score of instances. Among those doctrines the fourth was this: 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. 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.

§ 346a. The Pope electric railroad signal consisted of the combination of an electric battery; a peculiar arrangement of electric circuits; and two or more circuit closers, operating two or more visual or audible signals, situated at intervals along the line of a railroad. That peculiar arrangement of electric circuits essentially consisted in attaching two line wires to the positive and negative poles of a battery, respectively; and in extending both of those wires any required distance in a direction substantially parallel to the line of the railroad; and insulating both from the earth and from each other; and in connecting one of them at intervals with insulated rails in one of the two lines of rails of the railroad track; and in connecting the other one of those wires at the same intervals with insulated rails in the other line of rails in the same track; and interposing an electro-magnet at some point in each of these latter connections. An alleged infringer in one case<sup>1</sup> used an electric

<sup>1</sup> *Electric Signal Co. v. Hall Signal Co.* 114 U. S. 87, 1885.



railroad signal differing from that of Pope mainly in the peculiar arrangement of the electric circuits. That difference consisted mainly in disconnecting the negative pole of the battery from its line wire, and in connecting that pole with the earth adjacent thereto, and in connecting the remote end of the disconnected line wire with the earth adjacent to that end. These changes of arrangement changed the mode of operation of the apparatus, in that they caused the electricity to traverse circuits of equal length when the series of circuit closers were successively operated, whereas Pope's arrangement caused the electricity to traverse circuits of widely variant lengths at such times. This change of mode of operation resulted in a uniformity of electrical resistance among all the circuits, and thus much increased the utility of the apparatus. The Supreme Court therefore held the alleged infringer's combination to be an independent invention, substantially different from that of Pope, and not an infringement of his patent.

§ 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.<sup>1</sup> This is true even where the added device facilitates the working of one of the parts of the patented combination, and thus make the latter perform its function with more excellence and greater speed;<sup>2</sup> or where the added part hinders the patented combination from having some of its minor merits.<sup>3</sup> But 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

<sup>1</sup> *Western Electric Co. v. LaRue*, 139 U. S. 607, 1891; *Carr v. Rice*, 1 Fisher, 209 1856; *Roemer v. Simon*, 20 Fed. Rep. 197, 1884; *Royer v. Coupe*, 29 Fed. Rep. 366, 1886; *Filley v. Stove Co.* 30 Fed. Rep. 434, 1887; *Willames v. Barnard*, 41

Fed. Rep. 858, 1890.

<sup>2</sup> *Cochrane v. Deener*, 94 U. S. 786, 1876; *Wirt v. Brown*, 30 Fed. Rep. 187, 1877.

<sup>3</sup> *Sawyer Spindle Co. v. Morrison Co.* 52 Fed. Rep. 593, 1892.



the part which the patented combination omitted, would not constitute an infringement of the latter.<sup>1</sup>

§ 348. Changing the relative positions of the parts of a machine or manufacture does not avert infringement, where the parts transposed perform the same respective functions after the change as before.<sup>2</sup> 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.<sup>3</sup> 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.<sup>4</sup> The owner of a patent for a combination cannot suppress a newer, better, and substantially different combination of the same ingredients.<sup>5</sup>

§ 349. Omission of one ingredient of a combination covered by any claim of a patent, averts any charge of infringe-

<sup>1</sup> Shoemaker v. Merrow, 61 Fed. Rep. 948, 1894.

<sup>2</sup> Adams v. Mfg. Co. 3 Hann. & Ard. 1, 1877; Knox v. Quicksilver Mining Co. 6 Sawyer, 438, 1878; North Western Horse Nail Co. v. Horse Nail Co. 28 Fed. Rep. 234, 1886; Consolidated Rolling Mill Co. v. Coombs, 39 Fed. Rep. 33, 1889; Devlin v. Paynter, 64 Fed. Rep.

400, 1894.

<sup>3</sup> Brooks v. Fisk, 15 Howard, 221, 1853.

<sup>4</sup> Gill v. Wells, 22 Wallace, 14, 1874; Snow v. Railway Co. 121 U. S. 629, 1886; Singer Mfg. Co. v. Brill, 54 Fed. Rep. 384, 1892.

<sup>5</sup> Seymour v. Osborne, 11 Wallace, 555, 1870.

ment based on that claim.<sup>1</sup> 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.<sup>2</sup> The patentee makes all the parts of a combination material, when he claims them in combination and not separately.<sup>3</sup> 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.<sup>4</sup> 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

<sup>1</sup> *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; *Rowell v. Lindsay*, 113 U. S. 102, 1884; *Shepard v. Carrigan*, 116 U. S. 597, 1885; *Sharp v. Riessner*, 119 U. S. 636, 1886; *Derby v. Thompson*, 146 U. S. 482, 1892; *Weatherhead v. Coupe*, 147 U. S. 335, 1893; *Dobson v. Cublely*, 149 U. S. 120, 1893; *Wright v. Yuengling*, 155 U. S. 52, 1894; *Black Diamond Coal Co. v. Excelsior Coal Co.* 156 U. S. 617, 1895.

<sup>2</sup> *Vance v. Campbell*, 1 Black 430, 1861; *Fay v. Cordesman*, 109 U. S. 420, 1883; *Sargent v. Lock Co.* 114 U. S. 86, 1884; *Shepard v. Carrigan*, 116 U. S. 597, 1885; *Yale Lock Co. v. Sargent*, 117 U. S. 378, 1885; *McClain v. Ortmyer*, 141 U. S. 425, 1891.

<sup>3</sup> *Water-Meter Co. v. Desper*, 101 U. S. 332, 1879; *Brown v. Davis*, 116 U. S. 249, 1885; *Williams v. Stolzenbach*, 23 Fed. Rep. 41, 1885; *Otley v. Watkins*, 36 Fed. Rep. 324, 1888.

<sup>4</sup> *Silsby v. Foote*, 14 Howard, 218, 1852.



a patent for a last of the same shape, but which is made in three sections instead of in two.<sup>1</sup>

§ 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.<sup>2</sup> But like substitution of something which is not an equivalent, will have that effect.<sup>3</sup> The doctrine of equivalents may be invoked by any patentee, whether he claimed equivalents in his claim,<sup>4</sup> or described any in his specification,<sup>5</sup> or omitted to do either or both of those things. The patentee, having described his invention and shown its principles, and claimed it in that form which most perfectly embodies it, is, in contemplation of law, deemed to claim, every form in which his invention may be copied, unless he manifests an intention to disclaim some of these forms.<sup>6</sup> Combination patents would generally be 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.<sup>7</sup> 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

<sup>1</sup> *Mable v. Haskell*, 2 Cliff. 511, 1865; *White v. Walbridge*, 46 Fed. Rep. 526, 1891.

<sup>2</sup> *O'Reilly v. Morse*, 15 Howard, 62, 1853; *Imhaeuser v. Buerk*, 101 U. S. 355, 1879; *Reed v. Chase*, 25 Fed. Rep. 94, 1885; *American Box Machine Co. v. Day*, 32 Fed. Rep. 585, 1887; *Ligowski Clay Pigeon Co. v. Clay Bird Co.* 34 Fed. Rep. 331, 1888.

<sup>3</sup> *Railway Co. v. Sayles*, 97 U. S.

562, 1878.

<sup>4</sup> *Dental Vulcanite Co. v. Davis*, 102 U. S. 229, 1880; *Hunt Bros. Fruit Packing Co. v. Cassidy*, 53 Fed. Rep. 261, 1892.

<sup>5</sup> *Union Metallic Cartridge Co. v. United States Cartridge Co.* 2 Bann. & Ard. 594, 1877.

<sup>6</sup> *Western Electric Co. v. La Rue*, 139 U. S. 606, 1891.

<sup>7</sup> *Turrell v. Spaeth*, 3 Bann. & Ard. 458, 1878.



as an equivalent of the one recommended in the patent.<sup>1</sup>

§ 352. One thing, to be the equivalent of another, must perform the same functions as that other.<sup>2</sup> If it performs the same function, the fact that it also performs another function is immaterial to any question of infringement.<sup>3</sup> 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 invention or novelty in the latter.<sup>4</sup> 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.<sup>5</sup> 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.<sup>6</sup>

§ 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.<sup>7</sup> This substantial sameness of way is not necessarily

<sup>1</sup> *Aiken v. Bemis*, 3 Woodbury & Minot, 348, 1847; *Harris v. Allen*, 15 Fed. Rep. 106, 1883; *Schillinger v. Cranford*, 37 Off. Gaz. 1349, 1885; *Reece Button-Hole Mach. Co. v. Globe Button-Hole Mach. Co.* 61 Fed. Rep. 965, 1894.

<sup>2</sup> *Machine Co. v. Murphy*, 97 U. S. 125, 1877; *Rowell v. Lindsay*, 118 U. S. 103, 1884; *Roller Mill Patent* 156 U. S. 271, 1895; *Railway Mfg. Co. v. Railroad Co.* 30 Fed. Rep. 238, 1887; *Seeley v. Brush Electric Co.* 44 Fed. Rep. 420, 1890.

<sup>3</sup> *Foss v. Herbert*, 2 Fisher, 81, 1856; *Sarven v. Hall*, 9 Blatch. 524, 1872; *Wheeler v. Reaper Co.* 10 Blatch. 195, 1872; *Kendrick v. Emmons*, 3 Bann. & Ard. 623, 1878; *Norton v. California Can Co.* 45 Fed. Rep. 638, 1891; *Masseth v. Palm*, 51 Fed. Rep. 825, 1892.

<sup>4</sup> *In re Hebard*, 1 McArthur's Patent Cases, 550, 1857; *Loercher v. Crandall*, 11 Fed. Rep. 857, 1881; Section 36 of this book.

<sup>5</sup> *Bliss v. Haight*, 3 Fisher, 626, 1869.

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

<sup>7</sup> *Burr v. Duryee*, 1 Wallace 573, 1863; *Werner v. King*, 96 U. S. 230, 1877; *Dryfoos v. Wiese*, 124 U. S. 37, 1887; *Fornerook v. Root*, 127 U. S. 181, 1887; *Sargent v. Burgess*, 129 U. S. 19, 1889; *Sickels v. Borden*, 3 Blatch. 535, 1856; *Peard v. Johnson*, 23 Fed. Rep. 509, 1885; *Tonduer v. Chambers*, 37 Fed. Rep. 337, 1889; *Pacific Railway Co. v. Butte City Railway Co.* 58 Fed. Rep. 420, 1893.

an identity of merit,<sup>1</sup> nor a theoretical scientific sameness.<sup>2</sup> 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.<sup>3</sup> But one thing may be an equivalent of another in one environment, and not such an equivalent in another situation.<sup>4</sup> Springs and weights are generally equivalents;<sup>5</sup> but where the environment is such that a spring will operate successfully while a weight will not so operate, there they are not equivalents.<sup>6</sup> 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.<sup>7</sup> But infringement is averted by using a hand, instead of a lever of a claimed combination, to work a rod.<sup>8</sup> However, 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

<sup>1</sup> *Brush v. Condit*, 132 U. S. 49, 1889; *Roosevelt v. Telegraph Co.* 33 Fed. Rep. 510, 1887; *Standard Folding Bed Co. v. Osgood*, 58 Fed. Rep. 584, 1893.

<sup>2</sup> *Gordon v. Warder*, 150 U. S. 52, 1893.

<sup>3</sup> *Turrell v. Spaeth*, 3 Bann. & Ard. 458, 1878.

<sup>4</sup> *Cochrane v. Deener*, 94 U. S. 789, 1876; *Hubel v. Dick*, 28 Fed. Rep. 136, 1886.

<sup>5</sup> *Imhaeuser v. Buerk*, 101 U. S. 656, 1879; *American Roll Paper Co. v. Weston*, 45 Fed. Rep. 692, 1891.

<sup>6</sup> *Cross v. Mackinnon*, 11 Fed. Rep. 601, 1882.

<sup>7</sup> *Corn-Planter Patent*, 23 Wallace, 235, 1874; *Steam Gauge & Lantern Co. v. Mfg. Co.* 28 Fed. Rep. 619, 1886.

<sup>8</sup> *Brown v. Davis*, 116 U. S. 249, 1885.



arm, toggle joint, and other mechanical devices, when used to transmit vibratory power.<sup>1</sup>

§ 354. Whether a device, in order to be an equivalent of another, must have been known at the time of the invention of the machine which contains the latter, is a question which was elaborately investigated and discussed in Sections 354 to 358 of the former editions of this book; because it then appeared to be not only very important, but also unsettled. But the weight of reason was always much on the side of the negative of that question; and the weight of authority has now accumulated so preponderatingly upon the same side, that the question may now be held to be settled in the negative.<sup>2</sup> It is therefore 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.<sup>3</sup> A primary invention is one which performs a function never performed by

<sup>1</sup> *Blake v. Robertson*, 94 U. S. 782, 1876.

<sup>2</sup> *O'Reilly v. Morse*, 15 Howard, 123, 1853; *Burr v. Duryee*, 1 Wall. 573, 1863; *Mason v. Graham*, 23 Wall. 275, 1874; *Cochrane v. Deener*, 94 U. S. 780, 1876; *Union Paper Bag Machine Co. v. Murphy*, 97 U. S. 125, 1877; *Clough v. Mfg. Co.* 106 U. S. 178, 1882; *Cantrell v. Wallick*, 117 U. S. 695, 1885; *Sickles v. Borden*, 3 Blatch. 535, 1856; *Cahoon v. Ring*, 1 Cliff. 620, 1861; *Roberts v. Harnden*, 2 Cliff. 506, 1865; *Graham v. Mason*, 5 Fisher, 11, 1869; *Harwood v. Mfg. Co.* 3 Fisher, 530, 1869; *Vogler v. Semple*, 7 Bissell, 382, 1877; *Potter v. Stewart*, 18 Blatch. 568, 1881; *Evory v.*

*Burt*, 15 Fed. Rep. 112, 1883; *United Nickel Co. v. Pendleton*, 15 Fed. Rep. 745, 1883; *Murphy v. Trenton Rubber Co.* 45 Fed. Rep. 570, 1891; *Norton v. California Can Co.* 45 Fed. Rep. 638, 1891; *Jones Co. v. Munger Co.* 49 Fed. Rep. 67, 1891; *National Cash Register Co. v. American Cash Register Co.* 53 Fed. Rep. 373, 1893; *Merrow v. Shoemaker*, 59 Fed. Rep. 128, 1893; *Beach v. Box Machine Co.* 63 Fed. Rep. 606, 1894; *Edison Electric Light Co. v. Boston Lamp Co.* 62 Fed. Rep. 399, 1894; *Stahl v. Williams*, 64 Fed. Rep. 124, 1894.

<sup>3</sup> *Miller v. Eagle Co.* 151 U. S. 207, 1894; *Dederick v. Seigmund*, 51 Fed. Rep. 285, 1892.



any earlier invention;' while 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.<sup>2</sup> The three leading Supreme Court cases, which have attended to the distinction now under treatment, attended thereto in the following terms:

In the first of these cases the court said: "If 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."<sup>3</sup>

In the second of these cases the court said: "In such cases, if 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."<sup>4</sup>

<sup>1</sup> Norton v. Jensen, 49 Fed. Rep. 862, 1892; National Cash Register Co. v. American Cash Register Co. 53 Fed. Rep. 372, 1892; Boston Lasting Mach. Co. v. Woodward, 53 Fed. Rep. 481, 1893; Celluloid Mfg. Co. v. Arlington Mfg. Co. 44

Fed. Rep. 86, 1890.

<sup>2</sup> Butz Thermo-Electric Co. v. Electric Co. 36 Fed. Rep. 192, 1888.

<sup>3</sup> McCormick v. Talcott, 20 Howard, 405, 1857.

<sup>4</sup> Railway Co. v. Sayles, 97 U. S. 556, 1878.

In the third of these cases the court said: "Where an invention is one of a primary character, and the mechanical functions performed by the machine are, as a whole, entirely new, all subsequent machines which employ substantially the same means to accomplish the same result, are infringements, although the subsequent machine may contain improvements in the separate mechanisms which go to make up the machine." And the court also said that secondary patents ought to receive a narrower construction than this.<sup>1</sup>

§ 362. The three leading cases and the other cases which follow them,<sup>2</sup> teach general doctrines rather than precise rules; and those general doctrines may be concisely stated as follows.

There are two tests of equivalency. 1. Identity of function. 2. Substantial identity of way of performing that function.<sup>3</sup> 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.<sup>4</sup> 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.<sup>5</sup> If fewer inventions preceded

<sup>1</sup> *Morley Machine Co. v. Lancaster*, 129 U. S. 273, 1889.

<sup>2</sup> *Pope Mfg. Co. v. Gormully Mfg. Co.* 144 U. S. 242, 1892; *Sessions v. Romadka*, 145 U. S. 45, 1892; *Knapp v. Morss*, 150 U. S. 280, 1893; *Miller v. Eagle Co.* 151 U. S. 204, 1894.

<sup>3</sup> *Steam Gauge and Lantern Co. v. Rogers*, 29 Fed. Rep. 453, 1886; *Clark v. Wilson*, 30 Fed. Rep. 373, 1887; *Butz Thermo-Electric Co. v. Electric Co.* 36 Fed. Rep. 195, 1888; *Harmon v. Struthers*, 43 Fed. Rep. 443, 1890; *National Typographic Co. v. New York Typograph Co.* 46 Fed. Rep. 116, 1891; *New Depart-*

*ure Bell Co. v. Bevin Mfg. Co.* 64 Fed. Rep. 864, 1894.

<sup>4</sup> *Miller v. Eagle Co.* 151 U. S. 207, 1894.

<sup>5</sup> *Duff v. Pump Co.* 107 U. S. 639, 1882; *Knapp v. Morss*, 150 U. S. 280, 1893; *Boyd v. Janesville Hay Tool Co.* 158 U. S. 267, 1895; *Dederick v. Selgmund*, 51 Fed. Rep. 235, 1892; *Standard Folding Bed Co. v. Osgood*, 51 Fed. Rep. 676, 1892; *Joslin v. Northern Pacific Ry. Co.* 55 Fed. Rep. 68, 1893; *Bundy Mfg. Co. v. Time Recorder Co.* 64 Fed. Rep. 853, 1894; *Schuyler Electric Co. v. Electric Supply Co.* 68 Fed. Rep. 315, 1895.



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.<sup>1</sup> 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.<sup>2</sup>

§ 363. A change of form does not avoid an infringement of a patent, unless the patentee specifies a particular form as the means by which the effect of the invention is produced,<sup>3</sup> or otherwise confines himself to a particular form of what he describes.<sup>4</sup> 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. *Strowbridge v. Lindsay*<sup>5</sup> 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,

<sup>1</sup> *Hubel v. Dick*, 28 Fed. Rep. 136, 1886; *Brush Electric Co. v. Ft. Wayne Electric Co.* 40 Fed. Rep. 833, 1889; *Rapid Store Service Ry. Co. v. Taylor*, 43 Fed. Rep. 256, 1887; *Harmon v. Struthers*, 43 Fed. Rep. 443, 1890; *Brush Electric v. Electric Co.* 43 Fed. Rep. 541, 1890; *Brush Electric Co. v. Electric Imp. Co.* 52 Fed. Rep. 977, 1892; *National Cash Register Co. v. American Cash Register Co.* 53 Fed. Rep. 872, 1892; *Mergenthaler Co. v. Press Pub. Co.* 57 Fed. Rep. 505, 1893; *Reece Button-Hole Mach. Co. v. Globe Button-Hole Mach. Co.* 61 Fed. Rep. 964, 1894; *Bowers v. Von Schmidt*, 63 Fed. Rep. 580,

1894; *Beach v. Box Mach. Co.* 63 Fed. Rep. 606, 1894; *Rogers Typograph Co. v. Mergenthaler Co.* 64 Fed. Rep. 803, 1894.

<sup>2</sup> *The Telephone Cases*, 126 U. S. 581, 1888; *American Bell Telephone Co. v. Spencer*, 8 Fed. Rep. 509, 1881; *American Bell Telephone Co. v. Dolbear*, 15 Fed. Rep. 488, 1883.

<sup>3</sup> *O'Reilly v. Morse*, 15 Howard, 123, 1853; *Ewart Mfg. Co. v. Iron Co.* 31 Fed. Rep. 150, 1887; *Pacific Cable Ry. v. Butte City Ry. Co.* 55 Fed. Rep. 763, 1893.

<sup>4</sup> *Pope Mfg. Co. v. Mfg. Co.* 34 Fed. Rep. 890, 1888.

<sup>5</sup> *Strowbridge v. Lindsay*, 6 Fed. Rep. 510, 1881.



and 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*<sup>1</sup> 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 a 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*,<sup>2</sup> 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 fluid 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

<sup>1</sup> *Ives v. Hamilton*, 92 U. S. 481, 1875.

<sup>2</sup> *Morey v. Lockwood*, 8 Wallace, 280, 1868.

placed above the axial line of the two flexible tubes, and received the fluid 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.*,<sup>1</sup> 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 partly 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 invention, but it was held not to avoid infringement of a claim which did not mention the annular form of the implement.

§ 368. *Elizabeth v. Pavement Co.*<sup>2</sup> 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

<sup>1</sup> *American Diamond Rock Boring Co. v. Sullivan Machine Co.* 14 Blatch. 119, 1877.

<sup>2</sup> *Elizabeth v. Pavement Co.* 97 U. S. 137, 1877.



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. Infringement 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.<sup>1</sup> 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.<sup>2</sup> 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.<sup>3</sup>

§ 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.<sup>4</sup> 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.<sup>5</sup> Where the composition of matter involved, is a compound of metals, an equivalent of either of those, is another metal

<sup>1</sup> *Otley v. Watkins*, 36 Fed. Rep. 1858.  
324, 1888.

<sup>2</sup> *Byam v. Eddy*, 2 Blatch. 521,  
1858.

<sup>3</sup> *Rich v. Lippincott*, 2 Fisher, 6,

1858.  
<sup>4</sup> *Woodward v. Morrison*, 1 Hol-  
mes, 181, 1872.

<sup>5</sup> *Tyler v. Boston*, 7 Wallace,  
380, 1868.



having similar properties, and producing substantially the same effect in that composition.<sup>1</sup> And a substitute is not less than an equivalent, because it is derived from a different source than that for which it is a substitute, or because the patentee had no knowledge of it when he received his patent.<sup>2</sup>

§ 371. A substituted ingredient may perform the required function better than the patented ingredient, and may perform that function in a somewhat different manner, and still be an equivalent for the latter.<sup>3</sup> 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 in 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 Hoosic 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,<sup>4</sup> 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

<sup>1</sup> *Matthews v. Skates*, 1 Fisher, 609, 1860.

<sup>2</sup> *Standard Paint Co. v. Bird*, 65 Fed. Rep. 511, 1894.

<sup>3</sup> *Atlantic Giant Powder Co. v.*

*Mowbray*, 2 Bann. & Ard. 447, 1876.

<sup>4</sup> *Atlantic Giant Powder Co. v. Goodyear*, 8 Bann. & Ard. 161,

1877.

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 the 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 composition, the substitution of that ingredient for one of those covered by the patent, is enough to avoid infringement, even though the two ingredients perform that 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.<sup>1</sup> And where a particular construction is disclaimed that disclaimer is binding even if it was unnecessary.<sup>2</sup>

§ 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.<sup>3</sup>

§ 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 general observers interested in the subject, or to purchasers of things of similar design, has the same appearance

<sup>1</sup> *Byam v. Farr*, 1 Curtis, 260, 112 U. S. 624, 1884.  
1852.

<sup>2</sup> *Eastman v. Hinckel*, 5 Bann. &

<sup>3</sup> *Cartridge Co. v. Cartridge Co.* Ard. 1, 1879.



as that of the design covered by the patent,<sup>1</sup> but no other.<sup>2</sup> 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 has been held that the superiority or inferiority of utility in a defendant's machine, does not necessarily import non-infringement, even where it can be traced to slight differences in mode of operation.<sup>3</sup> No man is permitted to evade a patent by simply constructing the patented thing so imperfectly that its utility is diminished.<sup>4</sup> 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.<sup>5</sup> 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

<sup>1</sup> *Gorham v. White*, 14 Wallace, 528, 1871; *Perry v. Starrett*, 8 Bann. & Ard. 485, 1878; *Dryfoos v. Friedman*, 18 Fed. Rep. 824, 1884; *Tomkinson v. Mfg. Co.* 23 Fed. Rep. 805, 1894; *Redway v. Ohio Stove Co.* 38 Fed. Rep. 584, 1889; *Sutro Bros. Braid Co. v. Schloss*, 44 Fed. Rep. 857, 1890; *Macbeth v. Gillinder*, 54 Fed. Rep. 172, 1891; *Smith v. Stewart*, 55 Fed. Rep. 488, 1898.

<sup>2</sup> *New York Belting Co. v. New*

*Jersey Rubber Co.* 53 Fed. Rep. 815, 1898.

<sup>3</sup> *Waterbury Brass Co. v. Miller*, 9 Blatch. 77, 1871; *Shaver v. Mfg. Co.* 30 Fed. Rep. 72, 1887.

<sup>4</sup> *Chicago Fruit House Co. v. Busch*, 2 Bissell, 472, 1871; *Roberts v. Harnden*, 2 Cliff. 506, 1865.

<sup>5</sup> *Pitts v. Wemple*, 1 Bissell, 87, 1855; *Carter v. Baker*, 1 Sawyer, 512, 1871.

things produced by the machine of the plaintiff, and was thus enabled to produce a larger number in an equal space of time.<sup>1</sup> The superiority or inferiority of a defendant's process, machine, manufacture, or composition 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.<sup>2</sup> 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.<sup>3</sup> If considered alone, it is likely to mislead, because difference of utility often springs from causes which do not constitute substantial difference of invention.

§ 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;<sup>4</sup> or, knowing of its existence, it is not necessary that he should have known his doings to constitute an infringement.<sup>5</sup>

<sup>1</sup> *Blanchard v. Beers*, 2 Blatch. 420, 1852.

<sup>2</sup> *Many v. Sizer*, 1 Fisher 27, 1849.

<sup>3</sup> *Singer v. Walmsley*, 1 Fisher, 585, 1860.

<sup>4</sup> *Parker v. Haworth*, 4 McLean, 378, 1848; *Matthews v. Skates*, 1 Fisher, 608, 1860; *National Car*

*Brake Shoe Co. v. Mfg. Co.* 19 Fed. Rep. 520, 1884; *Royer v. Coupe*, 29 Fed. Rep. 361, 1886; *Bate Refrigerating Co. v. Gillett*, 31 Fed. Rep. 815, 1887.

<sup>5</sup> *Parker v. Hulme*, 1 Fisher, 54 1849; *Norton v. Automatic Can Co.* 57 Fed. Rep. 933, 1903.



And infringement is not averted by the fact that the infringer contrived his own process, machine, manufacture, or composition of matter, as the case may be, without any knowledge of the patent infringed thereby.<sup>1</sup>

<sup>1</sup> United States *v.* Berdan Fire Arms Co. 156 U. S. 506, 1895.

## CHAPTER XVII.

### COURTS, PARTIES AND CAUSES.

378. Introductory explanation.
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380. Non - jurisdiction of State courts in patent cases.
388. Jurisdiction of State courts over controversies growing out of contracts relevant to patents.
389. Jurisdiction of individual United States courts of first resort in patent cases.
390. Qualifications of the rule of the last section.
391. Jurisdiction of the Court of Claims.
392. Absence of Jurisdiction of the Court of Claims over causes of action based on unauthorized making, using, or selling by the United States Government of specimens of a patented process or thing.
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| <p>412. Stockholders of corporations.<br/> 413. Officers of corporations.<br/> 414. Directors of corporations.<br/> 415. Statutory liability of officers, directors, and stockholders of corporations.<br/> 416. Consolidated corporations as</p> | <p>defendants in actions based on infringements committed by their constituent corporations.<br/> 417. Causes of action based on a plurality of patents or on both terms of an extended patent, or on a patent and a trade-mark.</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, regardless of the amount involved, of all suits at law or in equity, arising under the patent laws of the United States.<sup>1</sup> The same jurisdiction belongs also to the District Courts of the Territories of the United States,<sup>2</sup> and to the Supreme Court of the District of Columbia.<sup>3</sup>

§ 380. Whether State courts have any jurisdiction of actions for infringements of patents was a question which, under the Revised Statutes of 1874, was clearly answerable in the negative.<sup>4</sup> 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

<sup>1</sup> Revised Statutes, Section 629; *Miller-Magee Co. v. Carpenter*, 34 Fed. Rep. 484, 1888.

<sup>2</sup> Revised Statutes, Section 1910, and Section 1911, as amended June 29, 1876, 19 Statutes at Large, Ch.

154, p. 62.

<sup>3</sup> Sections 760 and 764 of the Revised Statutes relating to the District of Columbia; *Cochrane v. Deener*, 94 U. S. 782, 1876.

<sup>4</sup> Revised Statutes, Section 711.

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."'. This statute of 1875 appeared to assume that, in the absence of congressional prohibition, the State courts would inherently have concurrent jurisdiction with the Federal courts of all suits of a civil nature, at common law or in equity, arising under the Constitution or laws of the United States; and it seemed to remove the prohibition contained in the Revised Statutes. Accordingly, in the former editions of this book, Sections 381 to 387 were devoted to the great question whether, in the absence of congressional prohibition, State courts would have jurisdiction of civil actions arising under the Constitution or laws of the United States. In those sections it was shown that ALEXANDER HAMILTON and Justice WASHINGTON held the affirmative of that question, while Justice STORY, Chancellor KENT, and Justice FIELD held the negative; and that the Supreme Court had never decided the question; but that the strongest relevant reasons supported the negative opinion. But, independent of that great question, the Supreme Court has now decided that the statute of 1875, as amended in 1887 and 1888, does not affect the jurisdiction granted by earlier statutes to any court of the United States over specified cases arising under the Constitution and laws of the United States; and therefore the later statute does not apply to any case arising under the patent laws of the United States.<sup>2</sup> Thus it is now established that State courts have no jurisdiction of such cases. And it accordingly has been so said by several Federal judges,<sup>3</sup> and by several State courts.<sup>4</sup>

<sup>1</sup> 18 Statutes at Large, Part 3, Ch. 137, Section 1, p. 470.

<sup>2</sup> *In re Hohorst*, 150 U. S. 661, 1893.

<sup>3</sup> *White v. Rankin*, 144 U. S. 636, 1892; *Myers v. Cunningham*, 44 Fed. Rep. 347, 1890; *Elgin Wind Power & Pump Co. v. Nichols*, 65 Fed. Rep.

217, 1895; *Hupfeld v. Automaton Piano Co.* 66 Fed. Rep. 789, 1895.

<sup>4</sup> *Continental Store Service Co. v. Clark*, 100 N. Y. 370, 1886; *Waterman v. Shipman*, 130 N. Y. 308, 1891; *Havana Press Drill Co. v. Ashurst*, 148 Ill. 137, 1893.



§ 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.<sup>1</sup> And actions to set aside such contracts fall in the same category.<sup>2</sup> These rules of law are well established, and are unchallenged. But a majority of the Supreme Court has gone further, and in spite of a vigorous dissent from the minority, has held another doctrine which 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; then the action is not one arising under the patent laws of the United States.<sup>3</sup> 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

<sup>1</sup> *Brown v. Shannon*, 20 Howard, 56, 1857; *Albright v. Teas*, 106 U. S. 613, 1882; *Marsh v. Nichols*, 140 U. S. 344, 1891.

<sup>2</sup> *Wilson v. Sandford*, 10 Howard, 101, 1850.

<sup>3</sup> *Hartell v. Tilghman*, 99 U. S. 547, 1878.



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 could not be tolerated; and the Supreme Court has unanimously decided that where a plaintiff decides to sue a defendant as a naked infringer, the Federal courts have jurisdiction, and that such jurisdiction cannot be ousted by any answer which the defendant may decide to interpose.<sup>1</sup>

§ 389. Actions for infringement of patents, being transitory in their nature, could formerly be brought in any district in which the defendant was an inhabitant or should be found.<sup>2</sup> But a statute of March 3, 1887, appeared to restrict such suits to the district in which the defendant is an inhabitant;<sup>3</sup> and that statute was construed to exempt corporations from such suits outside of the district or districts of the States in which they are respectively incorporated,<sup>4</sup> though it was also held that a defendant waived this restriction and exemption, unless he invoked it as promptly as possible.<sup>5</sup> But the Supreme Court has now decided that the clause of the statute of March 3, 1887, defining the district in which a suit shall be brought, is not applicable to

<sup>1</sup> *White v. Rankin*, 144 U. S. 628, 1892; *Elgin Wind Power and Pump Co. v. Nichols*, 65 Fed. Rep. 217, 1895.

<sup>2</sup> 18 Statutes at Large, Part 3, Ch. 137, Section 1, p. 470.

<sup>3</sup> 24 Statutes at Large, Ch. 373, p. 552.

<sup>4</sup> *Halstead v. Manning*, 34 Fed. Rep. 565, 1888; *Miller v. Wheeler*

& *Wilson Mfg. Co.* 46 Fed. Rep. 882, 1891; *Adriance v. McCormick Mach. Co.* 55 Fed. Rep. 287, 1892; *National Typewriter Co. v. Pope Mfg. Co.* 56 Fed. Rep. 849, 1893.

<sup>5</sup> *McBride v. Plow Co.* 40 Fed. Rep. 163, 1889; *Vermont Farm Mach. Co. v. Gibson*, 50 Fed. Rep. 424, 1892.

patent cases.<sup>1</sup> And therefore, actions for infringements of patents may again generally be brought in any district in which the defendant is an inhabitant, or shall be found. 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.<sup>2</sup> 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.<sup>3</sup> 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.<sup>4</sup> 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.<sup>5</sup> 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 distinguished Judge DRUMMOND, in which still more

<sup>1</sup> *In re Hohorst*, 150 U. S. 662, S. 378, 1877.  
1893.

<sup>2</sup> *Bank of Augusta v. Earle*, 13 Peters, 519, 1839.

<sup>3</sup> *Ex parte Schollenberger*, 96 U.

<sup>4</sup> *Williams v. Empire Transportation Co.* 3 Bann. & Ard. 533, 1878.

<sup>5</sup> *Wilson Packing Co. v. Hunter*, 4 Bann. & Ard. 184, 1879.



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.<sup>1</sup>

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.<sup>2</sup> 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

<sup>1</sup> *Sayles v. Grand Trunk Railway Co.* Manuscript, 1879.

<sup>2</sup> *Wilson Packing Co. v. Hunter*, 4 Bann. & Ard. 187, 1879.



corporation shall consent to be "found" within that State, in order to give the proper courts jurisdiction to administer a remedy.

§ 390. A number of qualifications exist to the general rule of the last section; and this section is devoted to stating and explaining those qualifications.

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.<sup>1</sup>

Where a district contains more than one division, every such action brought in that district, against a single defendant, who is an inhabitant of the State, in which that district is, 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. For this provision exists in all of the various statutes which divide sundry of the judicial districts of the United States. Those districts include the Northern and the Southern of Ohio; the Northern of Illinois; the Eastern and the Western of Michigan; the Eastern and the Western of Tennessee; the Southern of Georgia; the Southern of Mississippi; the Eastern and the Western of Louisiana; the Western of Missouri; the District of South Dakota; the District of Iowa; the District of Minnesota; the District of Kansas; the District of Montana; and the District of Idaho.

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.<sup>2</sup> But it has been held in one case that where such a suit is brought in the Southern District, the court will proceed to

<sup>1</sup> Revised Statutes, Section 740.      *Hodge v. Railroad Co.* 6 Blatch. 85,

<sup>2</sup> Revised Statutes, Section 657;      1868.

judgment unless the defendant sets up the want of jurisdiction in his pleadings.<sup>1</sup>

§ 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.<sup>2</sup> Such suits are subject to a six year statute of limitation ; and in the absence of an established royalty the claimant is entitled to recover what a reasonable royalty for an express license would have been.<sup>3</sup>

§ 392. What remedy a patentee has when the government makes or uses specimens of his patented invention without his consent, is a question which was long debated. But it has now been settled that the Court of Claims has no jurisdiction of an infringement suit brought against the United States.<sup>4</sup>

§ 393. The Court of Claims having no jurisdiction of a case based upon an unauthorized making or using by the government, of a patented invention, it is important to know whether, in such a case, an action will lie against those agents of the government who personally committed the infringement. That question was long unsettled ; but it has now been decided in the affirmative, in a learned and elaborate opinion of Judge COLT ;<sup>5</sup> and it is not probable that his conclusion will be reversed by the Supreme Court, or by the majority of the Circuit Courts of Appeals.

§ 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.<sup>6</sup> It is not necessary for the plaintiff, in an action

<sup>1</sup> Black v. Thorn, 10 Blatch. 84, 1872.

<sup>2</sup> United States v. Palmer, 128 U. S. 269, 1888.

<sup>3</sup> United States v. Berdan Fire Arms Co. 156 U. S. 569, 1895.

<sup>4</sup> Schillinger v. United States, 155 U. S. 169, 1894.

<sup>5</sup> Head v. Porter, 48 Fed. Rep. 481, 1891.

<sup>6</sup> Revised Statutes, Section 4919; Wilson v. Rousseau, 4 Howard, 646, 1846; Stein v. Goddard, 1 McAllister 82, 1856; Slebert Oil Cup Co. v. Beggs, 32 Fed. Rep. 790, 1887.



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.<sup>1</sup> 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.<sup>2</sup> Though where a complainant owns a patent infringed, when he files his bill for an injunction and a money recovery, jurisdiction will not lapse when he assigns the future of his patent.<sup>3</sup>

§ 395. Actions at law brought by assignees or grantees, for infringements committed prior to the time they obtained title, must, according to the common law, 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 rule was not abrogated by the Federal statutes which permitted suits to be brought by assignees, unless Justice CLIFFORD was in error in saying, in substance, that the assignees which were contemplated by that statute, are assignees of patents and not assignees of rights of action under patents.<sup>4</sup> But Judge SAGE has held that where an assignment of a patent, assigns also rights of action for prior infringements of that patent, the assignee may maintain an action at law in his own name for those infringements, as well as for subsequent infringements of that patent.<sup>5</sup> And actions in equity, 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

<sup>1</sup> Moore v. Marsh, 7 Wallace, 515, 505, 1891.  
1888.

<sup>2</sup> Waterman v. Mackenzie, 138 U. S. 255, 1891.

<sup>3</sup> New York Belting Co. v. New Jersey Rubber Co. 47 Fed. Rep.

<sup>4</sup> Moore v. Marsh, 7 Wall. 515, 1868.

<sup>5</sup> Adams v. Stamping Co. 25 Fed. Rep. 270, 1885.



committed before that event.<sup>1</sup> An action in equity will also be maintainable in such a case, if the assignor of the right of action was a corporation, and has been dissolved or has expired;<sup>2</sup> or if for any reason it is impossible for the assignee of the right of action to sue in the name of the assignor.<sup>3</sup> 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.<sup>4</sup>

§ 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,<sup>5</sup> 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.<sup>6</sup> But it is not certain that, when beginning a patent action in a Federal court in a State other than that of his appointment,

<sup>1</sup> *Dibble v. Augur*, 7 Blatch. 86, 1869; *Henry v. Stove Co.* 2 Bann. & 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.

<sup>2</sup> *Lenox v. Roberts*, 2 Wheaton, 373, 1817.

<sup>3</sup> *Hayward v. Andrews*, 106 U. S. 675, 1882.

<sup>4</sup> *Riddle v. Mandeville*, 5 Cranch, 329, 1809.

<sup>5</sup> *May v. County of Logan*, 30 Fed. Rep. 253, 1887.

<sup>6</sup> *Rubber Co. v. Goodyear*, 9 Wallace, 791, 1869; *Wilkins v. Ellett*, 108 U. S. 256, 1882; *Picquet v. Swan*, 8 Mason, 472, 1824.

an executor or administrator must conform to the conditions, or give the guarantees, prescribed by the local laws.<sup>1</sup> 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.<sup>2</sup>

§ 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,

<sup>1</sup>Hodge v. Railroad Cos., 4 Fisher, 177, 1874.

162, 1870; Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co. 1 Bann. & Ard.

<sup>2</sup>Rubber Co. v. Goodyear, 9 Wallace, 791, 1869.



provided he can sue in his own name.<sup>1</sup> 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 whether the laws of the particular State authorize assignees of rights of action to bring actions at law in their own respective names.<sup>2</sup>

§ 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.<sup>3</sup>

§ 399. Owners in common of patent rights must sue jointly for their infringement, or the defendant may plead in abatement or demur.<sup>4</sup> This rule applies where a patentee has assigned an undivided part of his patent,<sup>5</sup> 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. And it has been held in one case, that the owner of a patent right in a part of the territory of the United States, may join with the owner of the same patent right in another part of that territory, in

<sup>1</sup> *Harper v. Butler*, 2 Peters, 238, 1829; *Trecothick v. Austin*, 4 Mason, 36, 1825; *Leake v. Gilchrist*, 2 Devereaux (N. C.), 73, 1829; *Peterson v. Chemical Bank*, 32 N. Y. 21, 1865; *Riddick v. Moore*, 65 N. C. 382, 1871; *May v. County of Logan*, 30 Fed. Rep. 253, 1887.

<sup>2</sup> *May v. County of Logan*, 30

Fed. Rep. 253, 1887.

<sup>3</sup> *Goldsmith v. Collar Co.* 18 Blatch. 82, 1880.

<sup>4</sup> *Van Orden v. Nashville*, 67 Fed. Rep. 332, 1895.

<sup>5</sup> *Moore v. Marsh*, 7 Wallace, 515, 1868; *Waterman v. Mackenzie*, 138 U. S. 255, 1891; *Dick v. Struthers*, 25 Fed. Rep. 104, 1885.

suing for infringement of the patent in the territory of the latter, on the ground that all the owners of territorial rights under the patent are interested in having it sustained.<sup>1</sup> But there is no occasion for a person who has only an interest in the proceeds of a patent, without having any title in the patent itself, to join in a suit for its infringement.<sup>2</sup>

§ 400. Licensees under patents cannot bring actions for their infringement.<sup>3</sup> 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;<sup>4</sup> and all actions in equity must be brought by the owner of the patent right and the exclusive licensees suing together as joint complainants,<sup>5</sup> but the holder of a license less than exclusive must not join in an action in equity for an infringement of the patent under which he is licensed,<sup>6</sup> even where the infringement consisted in making and selling one form of the patented invention, which the licensee was exclusively licensed to make and sell.<sup>7</sup> 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.<sup>8</sup> And where an exclusive licensee brings an action in equity in the

<sup>1</sup> *Otis Mfg. Co. v. Crane Mfg. Co.* 27 Fed. Rep. 558, 1886.

<sup>2</sup> *Bogart v. Hinds*, 25 Fed. Rep. 485, 1885.

<sup>3</sup> *Gayler v. Wilder*, 10 Howard 477, 1850; *Paper-Bag cases*, 105 U. S. 766, 1881; *Blanchard v. Eldridge*, 1 Wallace Jr. 837, 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.

<sup>4</sup> *Littlefield v. Perry*, 21 Wallace, 223, 1874; *Goodyear v. McBurney*, 3 Blatch. 32, 1853.

<sup>5</sup> *Waterman v. Mackenzie*, 138 U. S. 255, 1891; *Hammond v. Hunt*, 4 Bann. & Ard. 113, 1879; *Huber v. Sanitary Depot*, 34 Fed. Rep. 752, 1888.

<sup>6</sup> *Blair v. Lippincott Glass Co.* 52 Fed. Rep. 226, 1892.

<sup>7</sup> *Pope Mfg. Co. v. Clark*, 46 Fed. Rep. 792, 1891.

<sup>8</sup> *Goodyear v. Bishop*, 4 Blatch. 438, 1860.